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D E C I S I O N
of 11 July 1996

Case Number: T 0575/94 - 3.2.1

Application Number: 87305407.6

Publication Number: 0251582

IPC: F16C 1/22, B60K 26/04

Language of the proceedings: EN

Title of invention:
Control cables

Patentee:
Gill's Cables Limited

Opponent:
VOFA-WERK Xavier Vorbrüggen GmbH & Co KG

Headword:
-

Relevant legal provisions:
EPC Art. 100(a), 100(c), 54(2)

Keyword:
"Added subject-matter - (no)"
"Public prior use - (yes)"
"Novelty - (no)"
"Late-filed auxiliary requests - (rejected)"

Decisions cited:
T 0095/83, T 0153/85, T 0406/86, T 0328/87, T 0093/89, T 0482/89, T 0270/90, T 0109/91, T 0782/92

Catchword:
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Case Number: T 0575/94 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 11 July 1996

Appellant: (Opponent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 7 June 1994 rejecting the opposition filed against European patent No. 0 251 582 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman: F. A. Gumbel
Members: P. Alting van Geusau
J. C. M. De Preter
F. J. Pröls
B. J. Schachenmann

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 251 582 based on European patent application No. 87 305 407.6, filed on 18 June 1987 and claiming a priority of 25 June 1986 (GB 8 615 512), was published on 27 December 1990.

Claim 1 of the granted patent reads as follows:

"1. A control cable assembly (16) comprising:
a) an outer cable sheath (42);
b) an inner cable core (24) slidable within said sheath;
c) an adjustment member (18) to permit adjustment of the setting of the assembly for proper control of a mechanism (12) to be actuated; and
d) said adjustment member being engageable with said sheath and being steplessly position-adjustable lengthwise thereof by application of a load to the assembly to effect position-adjustment of the adjustment member relative to the sheath; characterised in that
e) said adjustment member (18) is in the form of a collar comprising a flexible or resilient polymeric material, such as rubber; and
f) a tubular sleeve member (50) is provided at one end of said cable sheath (42), said sleeve member being slidably received within said collar;
g) said sleeve member (50) comprising formations (56) to receive a movable clip (66) to lock the adjustment member (18) in its working position after automatic adjustment;
h) the dimensions of said sleeve member (50) and of the internal bore of said collar being such that the frictional sliding characteristics between the two members permits lenghtwise sliding movement of the collar with respect to the sleeve at loads greater than

the normal working load for the cable assembly, while preventing such sliding movement at loads up to said normal maximum for the cable assembly."

II. Notice of opposition was filed by the appellant on 25 September 1991 on the grounds of Article 100(a) EPC. The opposition was supported by the prior art documents:

D0: GB-A-1 358 012

D1: EP-A-0 183 338

D2: DE-A-2 905 342

D3: GB-A-2 081 411

D4: US-A-3 622 617

and an alleged prior use initially substantiated by:

D5: (a) drawing "Seilzug für Gasbetätigung" (Teil-Nr. 811 721 555 AL),

(b) report of two employees of VOFA-WERK (appellant) visiting VOLKSWAGENWERK AG (VW), dated 30 April 1985,

(c) report of an employee of VOFA-WERK visiting AUDI AG, dated 28 May 1985.

Concerning the alleged prior use the following documents were filed during the opposition proceedings:

D6: "Produkt Detail Montageanweisung" PDM 443 721 A3 and drawing N900956 of VW AG. and Audi AG.,

This document called "Anlage 6", filed with a letter dated 27 November 1992 concerns the alleged prior use of D5 and shows the mounting clip for stepwise adjustment of the cable,

D7: "Arbeitsauftrag der PEK" of Adam Opel AG. dated 14 June 1983 ("Anlage 7", filed with a letter dated 27 November 1992),

D9: Affidavit of Jürgen Grittner, employed by Adam Opel AG.,

D10: Affidavit of Günter Nawratil, employed by Audi AG.

In response to the alleged prior use the respondent filed with a letter dated 20 December 1993

D8: statutory declaration by I.G. Timpson, the inventor mentioned in the patent in suit, to which declaration exhibits 1 to 4 were attached.

The Opposition Division arranged for the taking of evidence on 9 February 1994 in accordance with Article 117 EPC for further substantiation of the alleged prior use. The following minutes resulted therefrom:

D11: Minutes of the taking of evidence of the witness Norbert Reinhold, employee of VW AG.,

D12: Minutes of the taking of evidence of the witness Herbert Gröbmeyer, employee of the appellant (opponent).

III. By a decision which was given at the end of oral proceedings held on 9 February 1994 and issued in writing on 7 June 1994 the Opposition Division rejected the opposition.

In respect of a new ground for opposition based on Article 100(c) EPC, which ground was raised during oral proceedings and essentially concerned an objection to the term "steplessly" in claim 1, the Opposition Division was of the opinion that the original disclosure of both the GB priority document and the European application implicitly contained both a stepped and stepless alternative of control cable adjustment even though the terms were not present per se, and that therefore limiting the subject-matter of granted claim 1 to the "stepless" alternative did not infringe the requirements of Article 123(2) EPC .

The Opposition Division was further of the opinion that the control cable assemblies resulting from the alleged prior use were either not part of the state of the art as defined in Article 54(2) EPC or did not prejudice novelty or inventive step of the subject-matter of claim 1.

Since the prior art resulting from the documents D0 to D4 did not lead to the combination of features of the claimed device either the Opposition Division considered that the requirements of novelty and inventive step were met by the control cable assembly in accordance with claim 1 of the patent in suit.

IV. Notice of appeal was filed against this decision on 13 July 1994 with payment of the appeal fee on the same day.

The appellant requested that the decision under appeal be set aside and that the European patent be revoked.

The statement of grounds of appeal was filed on 8 October 1994.

V. In a communication for preparation of oral proceedings, auxiliarily requested by both parties, the Board expressed the provisional opinion that the appellant's objection based on Article 100(c) EPC was not supported by the facts.

In respect of the alleged lack of novelty and inventive step (Article 100(a) EPC) the Board took the view that at least the embodiment of the allegedly prior used control cable having an adjustment member with a reduced bore diameter (called PU3 in the decision under appeal), would appear to anticipate the subject-matter of claim 1.

In respect of this alleged prior use, the question had to be discussed whether the installation of the respective control cables in 100 motor vehicles produced by VW AG and the subsequent delivery to customers was in itself sufficient reason to presume that such a control cable was made available to the public in respect of all the features specified in claim 1 of the patent in suit.

Furthermore, it had to be considered whether the business partners involved in the alleged prior use concerning PU3, i.e. the companies VW, VOFA and WOCO themselves represented the public or if the co-operation between these companies involved confidentiality.

The Board's communication posted on 24 November 1995 contained a note that any further submission in preparation of the oral proceedings should be filed one month before the date of oral proceedings.

V1. On 10 June 1996 the respondent (patent proprietor) filed a second statutory declaration (D13) by I. G. Timpson.

New sets of claims in accordance with auxiliary requests 1 and 2 were filed on 21 June 1996 and auxiliary request 3 on 28 June 1996.

Auxiliary request 1 differs from the main request in that feature h) of claim 1 is further specified (see sentence in italics) in the following manner:

"h) the dimensions of said sleeve member (50) and of the internal bore of said collar being such that the frictional sliding characteristics between the two members *at the time of adjustment on an assembly line* permits lenghtwise sliding movement of the collar with respect to the sleeve at loads greater than the normal working load for the cable assembly, while preventing such sliding movement at loads up to said normal maximum for the cable assembly."

Claim 1 of the auxiliary request 2 is essentially a combination of claims 1 and 3 of the auxiliary request 1 and reads:

"1. A control cable assembly (16) comprising:
a) an outer cable sheath (42);
b) an inner cable core (24) slidable within said sheath;
c) an adjustment member (18) to permit adjustment of the setting of the assembly for proper control of a mechanism (12) to be actuated; and
d) said adjustment member being engageable with said sheath and being steplessly position-adjustable lengthwise thereof by application of a load to the assembly to effect position-adjustment of the adjustment member relative to the sheath; characterised in that
e) said adjustment member (18) is in the form of a collar comprising a flexible or resilient polymeric material, such as rubber; and

f) a tubular sleeve member (50) is provided at one end of said cable sheath (42), said sleeve member being slidably received within said collar;
g) said sleeve member (50) comprising formations (56) to receive a movable clip (66) to lock the adjustment member (18) in its working position after automatic adjustment;
h) the dimensions of said sleeve member (50) and of the internal bore of said collar being such that the frictional sliding characteristics between the two members at the time of adjustment on an assembly line permits lenghtwise sliding movement of the collar with respect to the sleeve at loads greater than the normal working load for the cable assembly, while preventing such sliding movement at loads up to said normal maximum for the cable assembly; and said adjustment member (18) comprises resilient polymeric material such as rubber and is adapted to resiliently deform at least slightly under said loads up to the normal maximum for the cable assembly, whereby position-adjusting the adjustment member lengthwise of the cable in the direction of decreasing cable tension is automatically followed by a slight increase in tension caused by elastic recovery of the adjustment member."

Claim 1 of auxiliary request 3 is formulated as *the use of* a control cable assembly in accordance with the granted claim 1 and is characterised by

"i) said use being for the purpose of effecting adjustment of said cable assembly with respect to a mechanism to be actuated, and said use comprising the step of causing said lengthwise sliding movement of said collar with respect to said sleeve to an adjusted position by loading said cable assembly above said normal working load."

VII. Oral proceedings before the Board were held on 11 July 1996.

The respondent requested that the appeal be dismissed and that the patent be maintained as granted (main request) or on the basis of one of the auxiliary requests 1 to 3 on file or of the fourth auxiliary request orally submitted during oral proceedings i.e. auxiliary request 2 with replacement of the words "such as rubber" by "other than rubber".

VIII. In support of its request for revocation of the patent the appellant relied essentially on the following submissions:

Article 100(c) EPC

The Opposition Division admitted that the feature "steplessly" was not mentioned in the application in its originally filed form.

Considering the originally filed claim 9 in which a stepped adjustment was claimed and the preceding claims 6 to 8 relating to the frictional engagement of the adjustment member and cable, the skilled person could only derive a stepped adjustment of the control cable assembly. Moreover, in view of the fact that a removable clip for locking the adjustment member in its working position was used, the application in its originally filed form only gave information in the direction of a stepped adjustment and therefore the introduction of a stepless adjustment was beyond the content of the application as filed and is therefore not in agreement with the requirements of Articles 123(2) and 100(c) EPC, respectively.

Article 100(a) EPC

Considering the different embodiments of the previously used control cable assemblies in accordance with the evidence of documents D5 and D9 to D12, at least the assembly indicated by PU3 in the decision under appeal comprised all the features of the granted claim 1 of the patent in suit and since this control cable was readily available to the public the claimed subject-matter lacked novelty.

The conclusion drawn by the Opposition Division according to which the assembly of PU3 was not part of the prior art was not supported by any of the reasons given in the decision.

The sale of 100 motorcars in which the assembly in accordance with PU3 was installed was sufficient reason to conclude that the assembly was publicly available, in particular since the functioning of the self-adjustment was immediately apparent to the skilled person. Moreover, the companies which were involved in the development of the cable, i.e. VW, VOFA and AUDI as well as the supplier of the rubber adjustment collar WOCO, were not subject to any agreement on confidentiality and therefore these companies should also be considered as forming part of the public.

The auxiliary requests were filed late without any reason being given for the delay. These requests should be refused for this reason alone.

IX. The respondent contested the appellant's view and in support of its requests argued essentially as follows:

Article 100(c) EPC

In the application as it was originally filed frictional engagement of the adjustment member (collar) and cable were referred to in general and without any restriction to a stepwise adjustment. The function of the clip was merely described in terms of enabling the self-adjusted position of the assembly to be readily re-established after disassembly, for example during maintenance and to guarantee that changes of the collar properties with time did not have an effect on the adjustment position.

Article 100(a) EPC

In respect of the embodiment PU3 no drawing of the exact design of the adjustment collar was presented by the appellant. Considering that the collar itself was the key to the solution of the problem solved by the present invention it was inconceivable that such a collar would be considered so unimportant as not even to be the subject of a separate drawing. The relevant features were thus only supported by the oral evidence of two witnesses given before the Opposition Division and recorded in D11 and D12, which, could not be considered unequivocal proof of such a fact.

Furthermore there was no record or other proof provided by the appellant concerning the actual number of samples supplied and it appeared likely that the round number of 100 was open to question as was also the date of supply mentioned by witness N. Reinhold in D11.

Even assuming that the device in accordance with PU3 was installed in motorcars which had been sold to the public, feature h) would not be apparent to the skilled person since the claimed friction properties were only apparent on the production line, and due to stretching

of the collar as a result of the substantial amount of interference, the broaching effect of the setting procedure and temperature influences, the frictional properties of the adjustment member changed dramatically within a relatively short time. Therefore, in practice the skilled person would not find a sliding force difference between the adjustment members in accordance with non-self-adjusting cables such as the assembly in accordance with the drawing D5(a) (PU1) and a self-adjusting cable in accordance with PU3.

As regards the credibility of the witnesses it had to be taken into account that the witnesses had a common interest in the revocation of the patent in suit and as such could not be considered independent.

In accordance with the case law of the Boards of appeal it has been common practice to allow late filed claims even if these claims were filed at the oral proceedings. In the present case the late-filing was regretted but in fact resulted from the discussions between the representative and patent proprietor for the preparation of the oral proceedings.

Reasons for the Decision

1. The appeal is allowable.

2. *Ground of opposition based on Article 100(c) EPC*

2.1 The appellant mainly based his objection on the allegation that, since there was no explicit mention of "steplessly" in the application as it was originally filed, the introduction of this feature in claim 1 gave rise to the objection that the subject-matter of the patent extended beyond the content of the application as filed.

2.2 Although there is indeed no explicit mention of "steplessly", this feature is implicit from the functioning of the adjustment member 18 disclosed on page 4, third paragraph, to page 6, second paragraph of the application as it was originally filed, in particular in view of the disclosure that the adjustment member has a central bore in which cable portion 50 is slidably received and frictionally grips said cable.

Attention is also drawn to the last part of the originally filed description on page 7, lines 6 to 13, in which some modifications of the earlier discussed embodiment are referred to. One of the modifications concerns the provision of an ungrooved structure of the cable casing instead of a grooved structure resulting in a stepwise adjustment which latter embodiment is only claimed in the originally filed claim 9.

Considering the entire disclosure of the application documents the Board therefore concurs with the Opposition Division that the originally filed application discloses a self-adjustment both in a stepless and in a stepped way, depending on the structure of the inter-engaging surfaces of the adjustment member and the cable. The limitation to a stepless adjustment during the grant proceedings of the patent does not therefore infringe the requirement of Article 123(2) EPC and consequently the patent is not open to objection under the ground of opposition according to Article 100(c) EPC.

3. *Grounds of opposition based on Article 100(a)*

3.1 As a consequence of the above conclusions in respect of the stepless adjustment of the lenghtwise position-adjustment of the claimed control cable assembly and the common meaning of the term "bore" as used in

feature h) of claim 1, the subject-matter of claim 1 is considered to be clearly limited to a smooth internal bore of the collar and therefore only those prior art disclosures or alleged prior uses that show an adjustment member (collar) with a smooth bore are relevant when deciding upon the novelty of the subject-matter of claim 1.

3.2 When considering the novelty of the subject-matter of claim 1, the alleged prior use of the control cable assembly designated PU3 in the decision under appeal is obviously the most relevant objection and thus the Board will consider this first.

3.3 According to the witnesses' statements in D11 and D12, the control cable assembly PU3 was a further development of the control cable assembly, which was the subject of the prior use designated PU1, details of which are apparent from drawing D5(a).

The control cable assembly PU1 according to drawing D5(a) broadly corresponds with the claimed control cable assembly as defined in claim 1 of the main request with the exception that, in contrast to the self-adjustment properties defined in feature h) of the granted claim, longitudinal adjustment of the rubber adjustment member on the sleeve member of the control cable before setting the adjustment member by inserting a clip in the appropriate groove of the sleeve member was carried out manually by an operator. The use of a clip is substantiated by the evidence in D6 and the declarations of G. Nawratril in D10 and witness N. Reinhold in D11.

The respondent did not dispute that this type of control cable formed part of the state of the art (see also the decision under appeal, page 13, point a.1)).

In this respect reference can also be made to point 4 of the statutory declaration of the inventor I. G. Timpson filed with a letter dated 20 December 1993 (D8) which confirms that a non self-adjusting cable assembly which was in most respects identical to that disclosed in the present patent, but which differed in that the mechanism relied entirely upon manual adjustment during the assembly process, was widely used in industry before the priority date of the patent in suit.

The control cable assembly PU1 is therefore considered to form part of the state of the art within the meaning of Article 54(2) EPC.

3.4 The further development of the cable assembly PU1 leading to cable assembly PU3 involved a reduction of the inner bore of the adjustment member so as to provide "self-adjustment properties" to the cable assembly.

This further development is mentioned as an existing concept in D9 and D10, both on page 2, second paragraph. According to D11, page 2, line 31 to page 3, line 12 and D12 page 11, line 32 and page 12, cars equipped with cable assemblies in accordance with this concept were actually fabricated and sold.

In this context "self-adjustment" clearly means that the friction between the adjustment member and the ribbed sleeve member was increased to a value that a force higher than the normal force for throttle valve actuation was necessary to move the adjustment member along the sleeve member. The throttle cable assembly was installed in the motor car and simply by pressing on the throttle pedal the adjustment member was moved to its adjusted position where it stayed by friction.

The functioning of the self-adjusting procedure referred to in the above documents put forward as evidence necessarily implies the presence of feature h) for the control cable assembly as defined in claim 1 of the patent in suit.

The respondent disputed that the device PU3 behaved in the manner of feature h) of claim 1 mainly because the degree of interference between the adjustment member and the ribbed sleeve was not high enough (see second statutory declaration D13, page 10, lines 8 to 26).

However, in the Board's opinion, the amount of interference is not the only parameter for determining the amount of friction between the adjustment member and sleeve but friction also depends largely on the material properties used for the adjustment member. Since the concept of self-adjustment in the manner explained in D9 to D12 takes account of a frictional sliding of the adjustment member in relation to the normal working load of the cable assembly, such that the force for moving the adjustment member must exceed the normal throttle opening load, which is exactly the idea of self-adjustment properties behind feature h) in claim 1, the respondent's arguments in support of the contrary cannot be followed.

3.5 Witness N. Reinhold stated (D11, page 3, lines 8 to 12 and page 6, last paragraph) that 100 throttle cable assemblies in accordance with PU3 were installed in VW motorcars between the years 1982 and 1984, which cars were then sold to the public. This is confirmed by the statement of witness H. Gröbmeyer (see D12, page 12).

The respondent argued that the lack of technical record of the respective test work threw doubt on the credibility of the witnesses statements.

However, considering that the control cable assembly in accordance with PU3 was not fully satisfactory because 5 to 8 of 100 samples did not function as required (D11 and D12) and that for this reason self-adjustment on the basis of PU3 cables was considered to be a short "dead-end" development of the PU1 assembly after which the cables in accordance with PU1 were used again, the Board takes the view that under these circumstances a missing technical record is not in conflict with practice in industry when small changes of a product are tried out first in a relatively small batch before production is adapted to a new standard. Moreover, the cable assembly in accordance with PU3 differed from the PU1 arrangement only in that the size of the bore of the adjustment member was smaller than that of the adjustment member used in the PU1 arrangement, the shape of which is apparent from drawing D5(a), so as to provide self-adjustment of the cable assembly. For such a minor change of the adjustment member with unchanged outer shape, a new drawing was no necessity to be able to manufacture a batch of 100 adjustment members with smaller bores.

3.6 In the present case the self-adjustment property of the adjustment member of the form as used in PU1, but with a reduced bore to increase friction with the sleeve member, was referred to not only, by the witnesses N. Reinhold and H. Gröbmeyer (D11 and D12) but is also in agreement with the affidavits D9 and D10.

Moreover, the further development of PU3 to improve the self-adjusting properties of the adjustment member, still based on the PU1 collar but having different forms of ribbed interior surfaces, and the sequence of development stages to provide self-adjustment properties starting from the adjustment member shown in drawing D5(a), are in logical order and consistently supported by the statements in D9 to D12.

In view of such consistent evidence the Board has no reason to doubt that the control cable in accordance with PU3 was indeed installed in 100 motorcars produced by VW and sold to the public before the priority date of the patent in suit.

3.7 From the above considerations it clearly follows that, contrary to the respondent's opinion, the principal issue of proof is not solely based upon recollection of a witness but is supported by further documentation.

It is to be noted in this context that the EPC does not contain any provisions restricting acceptable means of proof. Neither are there particular provisions about the evaluation of evidence or about how the outcome of taking of evidence should be assessed. In accordance with the case law of the Boards of appeal the principle of free evaluation of evidence applies. This means that the Board must reach its decision on the basis of the whole of the evidence provided and in the light of the conclusion it reaches after careful evaluation of that evidence.

The decision need not be based on absolute proof which, particularly where it is alleged that a prior use took place a long time ago, would amount to an unreasonable burden, but should be based on a degree of probability which, in human experience, verges on certainty.

The principle of free evaluation of evidence also applies to the hearing of witnesses under Article 117(1)(d) EPC. Hearing the employees of an opponent (H. Gröbmeyer) or of a company whose involvement is as a client of the opponent, as in case of the witness N. Reinhold, an employee of VW AG, is not precluded by the EPC (see T 482/89, OJ EPO 1992, 646, T 270/90 OJ EPO 1993, 725 and T 109/91 not published).

3.8. According to the established case law of the Boards, generally the unconditional sale of a product or device is sufficient to render it available to the public within the meaning of Article 54(2) EPC (see T 482/89 supra).

However in the present case the question arises whether feature h) of claim 1, which feature actually needed to be present during installation of the control cable only, was still recognisable in the motorcars which were sold to the public.

In this respect the respondent submitted that due to the level of interference the properties of the adjustment member changed quickly so that only a few hours after installation the frictional characteristics claimed may no longer have existed, in particular when taking account of the effects of other variables such as heat, oil and dampness or humidity or of the broaching effect of the setting operation.

It is to be noted that when referring to the existence of a high level of interference the respondent exclusively addressed the embodiment of the control cable actually produced by himself, a sample of which was filed on 29 December 1989 (see also the letter dated 8 December 1989, filed during the examining proceedings and the drawings attached to the respondent's letter dated 13 July 1992, which drawings originated from the patentee and give details of the article produced in particular in respect of the amount of interference). In accordance with the submissions during the oral proceedings (see also the statements in the statutory declaration D8 point 9) in this embodiment the adjustment member (also called grommet or collar) is made of a thermoplastic rubber sold under

the trade name "Santoprene", produced by the company Monsanto (see D8 exhibit IGT 3) which material proved to be particularly suitable for the adjustment member.

Furthermore, this control cable was delivered with the adjustment member mounted on a part of the sleeve with a reduced diameter to avoid any tension on the adjustment member before installation in the motor car.

However, these particularities of the adjustment member are not specified in claim 1 and cannot therefore be taken into account when evaluating patentability of the control cable claimed in claim 1 of the patent in suit over the cable assembly in accordance with PU3.

The effects referred to by the respondent do not necessarily apply to the control cable known from PU3, in which the adjustment member was made of rubber and, considering its specific use (a throttle control cable for a motor car), most certainly of a rubber of sufficient quality to withstand years of use in the environment of the motor compartment of a vehicle. For such material an immediate deterioration of the rubber properties after installation of the cable as contended by the respondent does, in the Board's opinion, not occur.

The self-adjustment property of the PU3 throttle control cable depended exclusively on an increased friction being essentially the result of a reduction of the inner-diameter of the adjustment member known from PU1. This difference in sliding friction between the adjustment members used in PU1 and PU3 would be immediately apparent to any person acquainted with control cables. Simply by taking away the clip and pressing the throttle pedal, e.g. in order to effect readjustments during servicing, feature h) as specified in claim 1 would have become apparent, particularly

since the idea of self-adjustment of control cables is in itself well known in the automotive art (see D0 to D4).

3.9 In respect of the delivery of 100 cables the respondent further drew attention to the decision T 782/92 (not published) concerning an alleged prior use in which 15 dampers were delivered to Daimler Benz AG in Stuttgart, Germany. There, in the absence of details about the use of the dampers and the condition of this transaction, the Board decided that the damper in question could not be considered to belong to the prior art.

However, in the present case the circumstances concerning the prior use are quite different since the 100 cables in question were delivered to the general public by unconditional sales.

In view of the statements of two witnesses according to which 100 control cables of the type PU3 were installed in motorcars that were sold to the public and considering that there was no reason to replace the PU3 cables before sale even if during installation the self-adjustment ability proved not fully satisfactory on all 100 samples (5 to 8% were defective), there cannot be any serious doubt that a great number of motorcars with the control cable in accordance with PU3 was made available to the public.

Therefore the conclusions arrived at in decision T 782/92 do not apply here.

3.10 Summarising, considering the evidence presented and the circumstances involved, the Board comes to the conclusion that the alleged prior use device PU3 is sufficiently substantiated and that the device according to PU3 in particular was publicly available before the priority date of the patent in suit.

Since this prior use device takes away the novelty of the subject-matter of claim 1 the respondent's main request must be rejected.

3.11 Since the public availability of the control cable assembly in accordance with PU3 is considered to be sufficiently substantiated by the sale of the motorcars comprising the control cable PU3, it is not necessary to determine whether the employees of the various companies involved in the development of the control cable PU3 should themselves be considered as members of the public, as was submitted by the appellant, or whether some sort of confidentiality existed, as was argued by the respondent.

4. *Auxiliary requests*

4.1 In accordance with the case law of the boards of appeal late-filed amendments or auxiliary requests during the appeal procedure should be admitted only if and when there is some clear justification for their late submission and when they are clearly allowable (see T 95/83, OJ EPO 1985, 75; T 406/86, OJ EPO 1989, 302 and T 153/85, OJ EPO 1988, 1).

The decisions specifically relied upon by the respondent according to which late auxiliary requests were accepted, are not at variance with this line of case law.

4.2 In the present case the summons to oral proceedings were sent to the parties on 24 November 1995. The issues to be discussed at the oral proceedings were apparent from the accompanying communication, in particular in respect of the fact that the alleged prior use in accordance with PU3 might become relevant under Article 54 EPC.

The auxiliary requests 1 and 2 were filed on 21 June 1996 and, auxiliary request 3 was filed on 28 June 1996, thus after the one month period in advance of the oral proceedings mentioned in the communication. Auxiliary request 4 was only filed during the oral proceedings.

The reason given for the delay was that the activities and contacts between the representative and the patent proprietors in preparation for the imminent oral proceedings gave rise to new instructions. The Board cannot accept this reason without further substantiation of any specific difficulties concerning the interaction between the respondent and its representative. In the absence of such substantiation and having regard to the early date of despatch of the board's communication and the explicit reference in the communication to the effect that any further submission in preparation of the oral proceedings should be filed 1 month before the date of oral proceedings, some negligence on the respondent's side cannot be denied.

Considering the second criterion, i.e. the allowability of the late-filed auxiliary requests in relation to novelty and inventive step, the amendments proposed in auxiliary requests 1 to 3 are not considered suitable to define a clear difference with respect to the prior use control cable PU3.

As follows from the discussion of the functioning of the PU3 control cable, this known control cable was also intended for self-adjustment of the control cable during assembly on the assembly line of the motorcar exactly in the manner as defined in the supplementary feature of claim 1 of the first auxiliary request and in feature i) of claim 1 of the third auxiliary

request. Neither the subject-matter of claim 1 of auxiliary request 1 nor the one of auxiliary request 3 is therefore novel with respect to the PU3 control cable.

Since the adjustment member of the PU3 control cable was made of rubber the inherent elastic recovery after adjustment necessarily led to the features as defined in claim 3 of the granted patent which were added to the features of granted claim 1 in claim 1 of the auxiliary request 2.

4.3 The subject matter of claim 1 of auxiliary request 4, filed during the oral proceedings, differs from claim 1 of the second auxiliary request in that the words "such as rubber" were amended to read "other than rubber".

Since it is apparent to the skilled person that it is the elastic properties of the adjustment member material which is important for the effect to be achieved, the Board has serious doubts that the mere replacement of the rubber adjustment member known from PU3 by an adjustment member not made of rubber but of any kind of other resilient polymeric material having comparable properties, involves an inventive step.

Thus, when applying the criterion of "clear allowability", the late-filed auxiliary requests 1 to 4 are also to be excluded from consideration at this stage of the appeal proceedings.

4.4 Consequently, the respondent's auxiliary requests 1 to 4 were to be rejected, too.

Order

For these reasons it is decided that:

The decision under appeal is set aside and the patent is revoked.

The Registrar: The Chairman:

S. Fabiani F. Gumbel