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**Datasheet for the decision
of 28 September 2007**

Case Number: T 0687/05 - 3.2.06

Application Number: 99113776.1

Publication Number: 0957061

IPC: B66B 11/00

Language of the proceedings: EN

Title of invention:
Traction sheave elevator

Patentee:
Kone Corporation

Opponent:
INVENTIO AG
ORONA E.I.C. S. Coop.
Otis Elevator Company

Headword:
-

Relevant legal provisions:
EPC Art. 100(c), 76(1), 111, 113(1) and (2)
EPC R. 67

Keyword:
"Basis of decision under Article 100(c) EPC leading from
G 0001/05 and G 0001/06"
"Procedural violation (no)"
"Remittal to first instance"

Decisions cited:
G 0001/05, G 0001/06, T 1158/01

Headnote:

The findings of the Enlarged Board of Appeal in G 0001/05 and G 0001/06, although made in regard to patent applications, are also valid for granted patents. Thus, in order to meet the requirements of Article 100(c) EPC, it is a necessary and sufficient condition that anything disclosed in the granted patent must be directly and unambiguously derivable from not only the application on which the patent has been granted but also from what is disclosed in each of the preceding applications as filed (see item 3.1 of the Reasons).



Case Number: T 0687/05 - 3.2.06

DECISION
of the Technical Board of Appeal 3.2.06
of 28 September 2007

Appellant: Kone Corporation
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 9 May 2005
revoking European patent No. 0957061 pursuant
to Article 102(1) EPC.

Composition of the Board:
Chairman: P. Alting Van Geusau
Members: M. Harrison
R. Menapace

Summary of Facts and Submissions

I. By its decision of 9 May 2005, the opposition division revoked European patent number 0 957 061 based on European application number 99 113 776.1.

Application number 99 113 776.1 was a divisional application of European application number 98 117 858.5 (hereafter the "parent application"), which itself was a divisional application of European application number 96 115 655.1 (hereafter the "grandparent application").

II. Under the heading Article 100(c) EPC of its decision, the opposition division concluded that claim 11 of the patent in suit was identical to claim 11 of the parent application and that claim 11 of the parent application, when taken in combination with certain features of claim 1 (on which claim 11 was dependent), was subject matter which extended beyond the content of the grandparent application as filed. It therefore found that the parent application did not meet the requirements of Article 76(1) EPC, such that, based on the findings made in T 1158/01, the parent application was not a valid divisional application. Since the patent in suit was based on application 99 113 776.1, i.e. a divisional of the invalid parent application, the opposition division held that it was also not a valid divisional application to start with.

III. The appellant (proprietor) filed an appeal against the decision of the opposition division, requesting *inter alia* that the patent be maintained as granted and that the appeal fee be reimbursed due to a substantial

procedural violation due to contravention of Article 113 EPC.

With its grounds of appeal, a new main request was filed including an amended dependent claim 11.

- IV. In the Board's communication prior to oral proceedings, reference was made to the Enlarged Board of Appeal decisions G 1/05 and G 1/06 which had been issued subsequent to the decision of the opposition division, noting that these decisions overrule the interpretation of Article 76(1) EPC given in the decision under appeal. The Board also addressed the issue of whether amended claim 11 was *prima facie* allowable.
- V. In its submission of 9 August 2007, the appellant filed new main and auxiliary requests.
- VI. During the oral proceedings of 28 September 2007 before the Board, the appellant filed a replacement main request containing an amended claim 1 and whereby claim 11 was deleted and replaced by granted dependent claim 12. Additionally, the appellant maintained its request for reimbursement of the appeal fee and requested remittal of the case to the first instance for examination of the opposition with respect to Article 100(a) and 100(c) EPC.
- VII. During the oral proceedings, the respondents (opponents OI, OII and OIII) requested dismissal of the appeal and revocation of the patent.
- VIII. Claim 1 as filed during the oral proceedings reads as follows:

"Traction sheave elevator comprising an elevator car (1) moving along elevator guide rails (10), a counterweight (2) moving along counterweight guide rails (11), a set of hoisting ropes (3) on which the elevator car and the counterweight are suspended, and a drive machine unit (6) comprising a traction sheave (7) driven by the drive machine and engaging the hoisting ropes (3), wherein the essential part of the drive machine unit (6) of the elevator is placed in the top part of the elevator shaft (15) in the space between the shaft space needed by the elevator car on its path and/or its overhead extension and a wall of the elevator shaft (15), characterized in that adjoined to the drive machine unit (6) or elsewhere in the elevator shaft (15) is a control panel (8) containing the equipment needed for the control of the elevator and the power supply to the motor driving the traction sheave (7), and that the position of the control panel (8) is such that ordinary service operations on the drive machine unit and the control panel can be performed while standing on the top of the elevator car."

IX. The appellant's submissions may be summarised as follows:

(i) As claim 11 has been deleted, remittal of the case for reaching a decision on Article 100(c) and 100(a) EPC was appropriate.

(ii) Reimbursement of the appeal fee was equitable, based on a substantial procedural violation by the opposition division. In the first instance oral proceedings, the proprietor had not been able to present arguments supporting its main and auxiliary

requests with respect to Article 100(c) EPC, because the opposition division had not discussed the subject matter of the claims of the patent nor the claims of the auxiliary requests, but instead had only considered the parent application and its relationship to the grandparent application in view of Article 76(1) EPC, i.e. not with respect to a ground of opposition listed in Article 100(c) EPC. Thus, whilst the patent had been revoked nominally under Article 100(c) EPC, no examination had actually been made as to whether the requirements of Article 100(c) EPC were met.

Furthermore, having resumed oral proceedings after its last adjournment, the opposition division simply announced the decision without giving an opportunity for defending the main request or the already filed auxiliary requests in terms of Article 100(c) EPC. Likewise, no possibility for further amendment to overcome the objection under Article 76(1) EPC was given. Thus, no opportunity to present comments on the requests as filed had been given, contrary to Article 113(1) and (2) EPC.

The procedural autonomy of the parent patent had also been violated, since the opposition division had pronounced that the "parent application" was not a valid divisional application, even though the opposition proceedings related to an entirely different patent. Further, the opposition proceedings concerning the patent in suit did not allow amendment of the parent application to meet any alleged defects.

- X. In respect of the reasons underlying the decision, the respondents' arguments can be summarised as follows:

(i) Not only claim 11 as granted, which had now been deleted, but also *inter alia* claim 1 as now amended still contained subject matter extending beyond the content of the application as filed. The requirements of Article 100(a) EPC were also not met.

Reasons for the Decision

1. *Basis for the decision under appeal*

The cause of objection underlying the decision of the opposition division was that the subject matter of claim 11 of the parent application was considered to extend beyond the content of the grandparent application. Leaving aside whether this is in itself a valid ground under Article 100(c) EPC which applies to the patent rather than to the application, claim 11 of the granted patent is substantially identical to that of the parent application such that the decision also implicitly impinges upon the subject matter of claim 11 of the granted patent.

By deleting claim 11 entirely and replacing it by claim 12 as granted, any cause of objection arising under Article 100(c) EPC to the subject matter of claim 11 *per se*, has however now been removed.

2. *Remittal*

The appellant requested remittal of the case to the first instance for consideration of objections made under Article 100(c) and 100(a) EPC. The respondents

did not present any concrete reasons as to why the case should not be remitted.

Since no decision has been issued by the opposition division in relation to the remaining subject matter of the patent and the grounds of opposition raised, the Board finds it appropriate, in accordance with the appellant's request, to remit the case back to the opposition division for further prosecution of the opposition (Article 111 EPC).

In this regard, it should however be emphasised that although an amended claim 1 was filed during the appeal proceedings, no examination of the subject matter of this claim or any other subject matter, apart from previous claim 11, has taken place during the appeal proceedings, also not in respect of Article 100(c) EPC.

3. *Request for reimbursement of the appeal fee*

- 3.1 The appellant alleged that he received no opportunity to present his comments on the main and auxiliary requests in relation to the ground of opposition under Article 100(c) EPC, such that his rights under Article 113(1) and (2) were not respected.

However, it is clear from the minutes of oral proceedings of the opposition division (see item 6) that the matter of Article 100(c) EPC was indeed discussed as the ground of opposition under consideration, albeit that the opposition division had interpreted this to include a requirement concerning Article 76(1) EPC necessitating the comparison of the grandparent application and the parent application. The

proprietor had thus been given an opportunity to present its comments on this issue, even if its comments were insufficient to overcome a problem concerning the patent in suit which was found to be dependent on an allegedly invalidly filed divisional (parent) application.

The Enlarged Board of Appeal decisions G 1/05 and G 1/06 (in particular items 2.9, 3.6, 8, 11.2 and 12.2 and the "Order") relate to patent applications, more specifically to the compliance of divisional applications with the second sentence of Article 76(1) EPC, namely that they "may only be filed in respect of subject matter which does not extend beyond the content of the earlier application as filed". It is logical that the same requirement must exist for a patent granted on a divisional application, and in fact, under Article 100(c) EPC it is a ground for opposition that "the subject matter of the European patent extends..., if the patent was granted on a divisional application,... beyond the content of the earlier application as filed". The requirement under Article 76 EPC and that under Article 100(c) EPC thus being identical in this respect, the findings in the above cited decisions of the Enlarged Board are also valid for the latter provision. That means that in order for the requirements of Article 100(c) EPC to be met, it is a necessary and sufficient condition that anything disclosed in the granted patent must be directly and unambiguously derivable from not only the application on which the patent has been granted but also from what is disclosed in each of the preceding applications as filed.

As the decision under appeal (albeit incorrectly) was based on the fundamental invalidity of the parent application *per se*, the amended wording in any claims of the auxiliary requests was entirely irrelevant for the purposes of Article 113(1) EPC.

The fact that the decision under appeal is based on an incorrect interpretation of Article 100(c) EPC due to its reasoning being based on examination of the requirements under Article 76(1) EPC with respect to the parent application, does not constitute a "procedural" violation, but is simply an error in the application of the law. Thus, the requirements of Rule 67 EPC for reimbursement of the appeal fee are not fulfilled, at least for this reason.

- 3.2 The appellant's further argument that the procedural autonomy of the parent application had been violated, is not found convincing by the Board.

First, the opposition division did not take a decision which resulted in any legal consequence for the parent application. Indeed such a possibility is not even available under the EPC. Further, a decision taken by an opposition division in one case has no binding effect on another case. True, the fulfilment of the requirements of Article 100(c) EPC necessarily requires comparing the subject matter of the patent also with what is disclosed in each of the preceding applications as filed (see item 3.1 above), which by itself may reveal added subject matter in one or more of these preceding applications, but such findings by themselves do not qualify under Article 111(2) EPC to bind the examining or opposition division in those other cases.

3.3 Regarding the appellant's allegation that no opportunity had been given to overcome the objection made with respect to Article 76(1) EPC, the Board finds that the minutes of oral proceedings show that the opposition division had already given all the parties an opportunity to present their comments on the matter and was thus able to reach a decision. It is also noted that item 10 of the minutes states: "Neither the opponents nor the patentee made any further statement or further request". Based on the facts of the present case, the Board therefore sees no reason for the opposition division to have offered the proprietor a further chance to overcome the objection.

3.4 Consequently, the Board finds that no substantial procedural violation has occurred, such that the requirements of Rule 67 EPC for reimbursement of the appeal fee are not met.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for continuation of the opposition proceedings.
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau