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**Datasheet for the decision
of 4 May 2011**

Case Number: T 0144/09 - 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

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

Headword:
-

Relevant legal provisions:
RPBA Art. 12(4), 13(1), 16(1)(e)
EPC Art. 123(2), 112a, 113(1)(2), 104(1)
EPC R. 106, 100(1)

Relevant legal provisions (EPC 1973):
EPC Art. 112(1)(a)

Keyword:

"Main request and first, second, fourth and sixth auxiliary requests - not admitted (Art. 12(4) RPBA)"
"Third auxiliary request - added subject-matter (Art. 123(2) EPC)"
"Fifth auxiliary request - not admitted (Art. 13(1) RPBA)"
"Referral of question to Enlarged Board of Appeal - rejected"
"Objection under Rule 106 EPC - dismissed"
"Apportionment of costs - requests rejected"

Decisions cited:

T 0545/01, T 1854/08, G 0001/05, G 0001/95, J 0015/85,
T 0910/92

Catchword:

1. A request can be held inadmissible under Article 12(4) RPBA when added subject-matter held unallowable during proceedings before the opposition division is not removed at least by way of an auxiliary request filed in those proceedings, but only by way of a request filed during the appeal proceedings (Reasons 1.4).

2. The applicability of Article 12(4) RPBA is not restricted by the time limit for filing the grounds of appeal or any reply thereto (Reasons 1.17).



Case Number: T 0144/09 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 4 May 2011

Appellant: Kone Corporation
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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 30 October 2008 revoking European patent No. 0957061 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: M. Harrison
W. Sekretaruk

Summary of Facts and Submissions

I. The appellant (patent proprietor) filed an appeal against the opposition division's decision dated 30 October 2008 revoking European patent No. 0 957 061. This decision resulted from the further examination of the opposition pursuant to the remittal order in decision T 687/05 concerning an appeal on the previous decision of the opposition division in respect of this patent.

European patent No. 0 957 061 was granted in respect of application No. 99113776.1 which is a divisional application of application No. 98117858.5 (parent application), itself being a divisional application of application No. 96115655.1 (grandparent application), which in turn is a divisional application of application No. 94109887.3 (great-grandparent application).

II. With its decision of 30 October 2008, the opposition division found with respect to claim 1 of the main request, that the requirement of Article 123(2) EPC was not met, because the feature

"so that the space requirement in the building is substantially limited to the space required by the elevator car and counterweight on their paths including safety distances and the space needed for the hoisting ropes",

which the proprietor had added to claim 1, was found to be a functional feature only achievable in combination

with a flat drive machine unit, which unit was however not included in claim 1.

III. The aforementioned feature "so that the space requirement..." was introduced into claim 1 by the proprietor with its submission dated 26 August 2007(*sic*) received at the EPO on 8 September 2009, subsequent to the issue of a summons to oral proceedings together with the provisional opinion of the opposition division dated 11 January 2008.

IV. The minutes of the oral proceedings (held before the opposition division on 7 October 2008) include the following statements:

"11:40 The chairman resumed the proceedings and announced the opposition division's finding that the subject-matter of claim 1 of the new main request indeed extended the content of the original application. The chairman also stated that in the view of the opposition division, the omission of the feature that the drive machine unit was a "flat" drive machine unit together with the addition to amended claim 1 of the feature "...so that the space requirement in the building is substantially limited to the space required by the elevator car and counterweight on their paths including safety distances and the space needed for the hoisting ropes..." contravened Article 123(2) EPC.

The chairman then clarified that the auxiliary requests currently on file seemed to have the same problem and asked the patent proprietor for any request that could overcome the mentioned Art. 123(2) EPC objection.

11:50 The chairman asked the patent proprietor whether he would file any further requests. However, the patent proprietor did not avail himself of the opportunity to file any request which could overcome the ground of opposition under Article 100(c) EPC. Thus the chairman announced the decision to revoke the patent-in-suit."

- V. Together with its grounds of appeal dated 17 December 2008, the appellant requested that the patent should be maintained on the basis of its (new) main request or alternatively on the basis of claim 1 of one its first to third auxiliary requests (new auxiliary requests I, II and III) respectively.

In claim 1 of the main request and of the first and second auxiliary requests, the feature "so that the space requirement...", was not present.

- VI. Subsequent to summoning the parties to oral proceedings, the Board issued a communication dated 21 March 2011 stating its provisional opinion. With regard to the main request and the first and second auxiliary requests, the Board referred to Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA) and stated why these requests were considered inadmissible. The Board mentioned *inter alia* that no reason could be seen for not having simply deleted the objected feature by way of an auxiliary request during the oral proceedings before the opposition division, not least since the proprietor was aware of the finding of the opposition division and the reason for it. In regard to the third auxiliary request, the Board also stated why the inclusion of at least a flat drive machine appeared to be a requirement when considering the only direct

and unambiguous disclosure in the filed application, and also why a flat machine appeared to be a structural feature implicitly required in the context of paragraph [0005] of the application as filed.

VII. With its submission of 20 April 2011, the appellant filed fourth and fifth auxiliary requests (auxiliary requests IV and V), whereby claim 1 of the fourth auxiliary request also lacked the feature "so that the space requirement...".

Further, the appellant objected that the non-admission of the main request and the first and second auxiliary requests was a violation of Article 113(1) and (2) EPC and would be forwarded for revision to the Enlarged Board of Appeal in accordance with Article 112a EPC. Arguments as to why the requirements of Article 113 EPC were considered violated were also made.

The appellant additionally filed:

GGP1: EP-A2-0 631 967 (great-grandparent application)

GGP2: EP-B1-0 631 967

GGP3: EP-B2-0 631 967

GP1: EP-A2-0 779 233 (grandparent application)

GP2: EP-B1-0 779 233

GP3: EP-B2-0 779 233

P1: EP-A1-0 890 541 (parent application)

S1: EP-A2-0 784 030 (a further divisional application of GGP1)

S2: EP-B1-0 784 030

S3: EP-B2-0 784 030,

and a copy of decision T 545/01.

- VIII. During the oral proceedings of 4 May 2011, the appellant filed a sixth auxiliary request, labelled "auxiliary request Va".
- IX. The appellant requested that the decision under appeal be set aside and the European patent be maintained on the basis of the main request or one of auxiliary requests I to III filed 17 December 2008, or on the basis of one of auxiliary requests IV or V of 20 April 2011 or on the basis of auxiliary request Va filed during the oral proceedings on 4 May 2011. Further, reference was made to its objection concerning Article 112a EPC with regard to Article 113 EPC filed with letter of 20 April 2011.

The respondents requested dismissal of the appeal and apportionment of costs in their favour.

- X. Respondent/opponent OII further requested referral of a question to the Enlarged Board of Appeal in accordance with its written submission of 22 June 2009, which question reads as follows:

"In order that subject matter be considered 'unequivocally and definitively abandoned' in the sense of G 1/05, point 11.2 of the Reasons for the Decision,

a) is it necessary that the subject matter has been 'abandoned' by an explicit declaration of abandonment

filed by the applicant and/or by non-payment of claims fees,

or

b) is it sufficient if, at some stage of the prosecution of an application or a sequence of divisional applications, it is clear for the skilled practitioner, considering the circumstances of the case, that the applicant had no longer any 'real intention' to obtain protection for certain parts (such as aspects or embodiments of the invention) of the subject-matter of the application as filed."

XI. Claim 1 of the main request 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 (6) 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."

XII. Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the wording "essential parts of the drive machine unit (6) of the elevator are" replaces the wording "essential part of the drive machine unit (6) of the elevator is".

XIII. Claim 1 of the second auxiliary request reads as follows, whereby additions compared to claim 1 of the first auxiliary request are shown underlined and deletions are shown struck-out:

"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) in the top part of the elevator shaft (15) comprising a traction sheave (7) driven by the drive machine and engaging the hoisting ropes (3), wherein the essential parts of the drive machine unit (6) of the elevator are 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~~ and that adjoined to the drive machine unit (6) 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."

XIV. Claim 1 of the third auxiliary reads as follows, whereby this claim differs from claim 1 of the second auxiliary request by the insertion of the underlined wording:

"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) in the top part of the elevator shaft (15) comprising a traction sheave (7) driven by the drive machine and engaging the hoisting ropes (3), wherein the essential parts of the drive machine unit (6) of the elevator are 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), so that the space requirement in the building is substantially limited to the space required by the elevator car and counterweight on their paths including the safety distances and the space needed for the hoisting ropes, and that adjoined to the drive machine unit (6) 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."

XV. Claim 1 of the fourth auxiliary request differs from claim 1 of the second auxiliary request in that the wording "wherein the essential parts of the drive machine unit (6) of the elevator are placed" is replaced by the wording "wherein the drive machine unit (6) of the elevator is placed".

XVI. Claim 1 of the fifth auxiliary request reads as follows, whereby the underlined portion has been inserted into the expression "so that the space requirement in the building is substantially limited ... for the hoisting ropes", which expression itself has been repositioned in the claim compared to its position in claim 1 of the third auxiliary request:

"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) in the top part of the elevator shaft (15) comprising a traction sheave (7) driven by the drive machine and engaging the hoisting ropes (3), wherein the drive machine unit (6) of the elevator is placed 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), and that adjoined to the drive machine unit (6) 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), so that the

space requirement in the building, irrespective of the hoisting height, is substantially limited to the space required by the elevator car and counterweight on their paths including the safety distances and the space needed for the hoisting ropes, 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."

XVII. Claim 1 of the sixth auxiliary request (auxiliary request Va), differs from claim 1 of the fifth auxiliary request in that the wording

"drive machine unit (6) of the elevator is placed in the space...",

has been amended to read:

"drive machine unit (6) of the elevator is of a flat construction as compared to its width and is placed in the space...".

XVIII. The appellant's arguments may be summarised as follows:

During the oral proceedings before the opposition division, the opposition division had objected that there was no disclosure of the feature "so that the space requirement in the building is substantially limited to the space required by the elevator car and counterweight on their paths including safety distances and the space needed for the hoisting ropes" (*hereafter referred to by the Board as the "space requirement feature"*) without also including a flat drive machine

unit. That had come as a complete surprise to the proprietor, because the annex to the summons to oral proceedings had stated that this feature was not considered essential. Moreover, the space requirement feature had been an essential part of the whole "machine room-less" concept, as was shown by the proceedings relating to the GGP, GP and P family members and the resulting GGP3, GP3 patents, as well as the proceedings in the S1, S2 and S3 further divisional case, and also in T 545/01 which was the appeal case dealing with the GGP case. Thus, the proprietor had understood its inclusion to be a pre-requisite for successful maintenance of the present patent. This being the case, and in respect of the opposition division's invitation to file a request to overcome the objection, the proprietor "did not want to follow this invitation, as the limitation to 'flat machines' would have effectively reduced the scope of protection to the content of maintained EP 784 030 (S3)...". Also, the proprietor did not know the reasons why the opposition division had reached its conclusion and this meant the proprietor had to completely revise its defence strategy.

To have deleted the space requirement feature during those oral proceedings would also have resulted in objections from the opponents due to late filing. The proprietor thus had no real chance to react in a proper way.

The necessity to drop the space requirement feature only became clear after receiving the decision, albeit that it should be recognised that the objection was

incorrect, because the flat motor feature was never claimed in any previous application.

Further, the Board (in the present case) was disrespecting the fact that examination of a patent had to be on claims agreed by the proprietor. Thus, the Board's non-admittance of certain requests was in violation of Article 113(2) EPC as was made evident in T 1854/08.

Generally speaking, any request could have been filed in the first instance proceedings. The restrictive use of Article 12(4) RPBA to prevent the proprietor from filing amended claims in appeal proceedings would lead to a situation where claims could not be forwarded which have not already been forwarded in the first instance. This was not the intention of Article 12(4) RPBA.

The RPBA should not be applied in such a way that violates the essential procedural rights as laid out in Article 113 EPC.

Agreeing with the accusations of the opponents and not allowing the proprietor's requests gives an impression of lacking neutrality.

After decision G 1/05 and the revision of the implementing regulations, the possibility of filing serial divisional applications over the lifetime of the patent has been removed. Because the new regulations only applied to Art. II of the decision of the Administrative Council, the present patent was filed in

line with the EPC, so that no reservations should apply in handling the present case.

In regard to the fourth and fifth auxiliary requests, these were a reaction to the communication issued by the Board, whereby specific objections were addressed.

In regard to the sixth auxiliary request (auxiliary request Va) filed during the oral proceedings, this should be admitted into proceedings since the amendment introduced came from a dependent claim and it had been the discussion at oral proceedings which had led to the filing of this request. It was also not complex.

As regards the substantive content of the third auxiliary request, the basis in the disclosure for the introduced feature was paragraph [0005] of the filed application. This neither disclosed nor required a flat drive machine unit. The same wording of this paragraph was present in the GGP, the GP and the P applications and the concept of efficient cross-sectional space utilisation allowed different types of drive machine unit to be used, not just flat ones; for example, elongated drive units would fit in the confines of the moving paths of the car and counterweight with their respective safety distances; other drive machine types could be envisaged. Flat drive machine units were the only ones mentioned, but these were only mentioned in the embodiments. As regards the sequence of family applications GGP1, GP1 and P, it was clear that the subject matter of current claim 1 was in each of these applications, since the description which was carried over from one application to the next would be understood in the content of the claims of any

application so that any features claimed in those preceding applications could be removed if not essential to the other inventions covered by the description. It was also clear from this that the claims of the GGP, GP and P applications covered the basic concept of having the most efficient use of the cross-sectional area of the elevator shaft.

There was no reason to apportion costs in the respondents' favour; the oral proceedings were a normal part of the procedure when the proprietor was trying to overcome the decision under appeal; no extra costs had arisen because of this.

There was no reason to put a question to the Enlarged Board. The proposed question was not a question of law, nor was it important to decide the present case.

The objection (Rule 106 EPC) under Article 112a with respect to Article 113(1) and (2) EPC, as mentioned in the written submissions, was maintained.

XIX. The arguments of the respondents may be summarised as follows:

The main request and first and second auxiliary requests should not be admitted into proceedings. The appellant was abusing the procedure by trying to have them introduced, because it was clear for all parties at the opposition oral proceedings why the claim was not allowable, as was evident from the minutes of those oral proceedings. The fact that the proprietor had at that stage specifically turned down the offer of filing an auxiliary request to remove the feature giving rise

to the objection or to add the feature which the opposition division had stated was necessary in combination therewith, was entirely the decision of the proprietor.

Also, the proprietor had added the space requirement feature to claim 1 of its requests about one month before the oral proceedings took place, i.e. long after the opposition division had issued the summons/annexed opinion. The appellant should thus not have been surprised that an objection under Article 123(2) EPC was raised in that regard for the first time during the oral proceedings before the opposition division. The comments in the annex to the summons concerned a differently worded claim and thus did not indicate that a flat motor was not required irrespective of the claimed invention. The appellant's comment that the patent would have become more limited and less useful was not a reason for failing to file at least auxiliary requests during those proceedings, particularly when the chairman of the opposition division had asked whether any further requests would be filed to overcome the objection which had been explained.

The fourth auxiliary request contained the same removal of the space requirement feature and should thus not be allowed for the same reason.

The fifth auxiliary request did not contain the feature of a flat drive machine unit either, but instead used different wording.

The sixth auxiliary request contained exactly what the opposition division had stated was required. To file it

first during the appeal should not be allowed for that reason alone. Moreover the requirement to include such a feature was confirmed by the Board's communication prior to oral proceedings.

The third auxiliary request lacked the feature of a flat motor contrary to Article 123(2) EPC, so the objection of the opposition division simply remained. The objections mentioned in the Board's provisional opinion were agreed. Further, the subject matter of the claim was also not present in the entire sequence of family applications, where different inventions were presented.

Cost apportionment should be made in favour of the respondents. All of the requests could have been filed in the opposition proceedings and it was an abuse of procedure to file them e.g. with the grounds of appeal; the cost of the appeal proceedings could then have been avoided.

Respondent/opponent OII additionally argued that a question should be referred to the Enlarged Board of Appeal as it concerned an important point of law which affected the present case. G 1/95, Reasons 11.2, stated that only subject matter which was not "unequivocally and definitively abandoned" in an earlier application or a sequence of earlier applications could be used as a basis for a further divisional application. G 1/95 cited J 15/85 as an example of a case where an amendment to remove certain claims was regarded as an abandonment of subject matter, whereas in T 910/92 the "real intention" of the applicant was taken into account and claims were allowed to be reintroduced in a

divisional application. It was important to decide which case was correct and, as the case may be, how to determine the real intention of the applicant. This was important in the present case, because the real intention of the appellant in the GPP application was an implicit abandonment of the subject matter leading to the current patent, since it had stated the subject matter for which it intended to file divisional applications and that subject matter was not the subject matter of the present patent.

Reasons for the Decision

1. *Non-admittance of the main request and the first, second, fourth and sixth auxiliary requests into the appeal proceedings - Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA)*
- 1.1 The opposition division issued a summons to oral proceedings dated 11 January 2008. This did not mention the need to include the space requirement feature (i.e. the feature "so that the space requirement in the building is substantially limited to the space required by the elevator car and counterweight on their paths including safety distances and the space needed for the hoisting ropes"). In its submission dated 26 August 2007 (sic), which was received at the EPO on 8 September 2008, a new main request and three new auxiliary requests were filed, each of which included the space requirement feature. It may also be noted that the written submission with which these requests were filed made no mention at all of having included

the space requirement feature, nor where it had its basis in the application as filed.

The fact that during the oral proceedings of 7 October 2008 an objection under Article 123(2) EPC was found to exist by the opposition division concerning the inclusion of the space requirement feature, is thus considered to be entirely in line with the normal course of proceedings.

1.2 The opposition division, as also indicated in the minutes of the oral proceedings at 11:40 and 11:50, not only explained the reason for its finding under Article 123(2) EPC but also asked the proprietor explicitly whether he would file any request that would overcome the objection.

1.3 The proprietor's choice not to file any amended or auxiliary request in light of these circumstances is found by the Board to be of importance in considering the admissibility of certain new requests in the appeal proceedings in accordance with Article 12(4) RPBA.

1.4 Article 12(4) RPBA reads as follows:

"(4) Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first-instance proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirement in (2)."

It follows from Article 31 of the Vienna Convention on the Law of Treaties that the EPC should be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of the treaty's object and purpose (see J 9/07, Reasons, item 13). The same applies to the interpretation of the Implementing Regulations on the Grant of European Patents and the Rules of Procedure of the Boards of Appeal, as they are part of the EPC (Article 164(1)) or have their basis in the Implementing Regulations (Rule 12(3) EPC). Article 12(4) RPBA thus allows the Board, to hold any such request as inadmissible if it could have been presented in the first-instance proceedings. Thus, when deciding on this issue, the Board should state the facts that show why the specific request(s) now on file could have been presented in first instance proceedings. In particular, the Board should take into account all relevant circumstances. It is evident that a request can be held inadmissible under Article 12(4) RPBA when, as in the present case, added subject-matter held unallowable during proceedings before the opposition division is not removed at least by way of an auxiliary request filed in those proceedings, but only by way of a request filed during the appeal proceedings.

- 1.5 The amendments made by way of the main request and the first and second auxiliary requests, all involved *inter alia* deletion of the space requirement feature. However, the simple removal of that feature which the proprietor had itself added as an amendment during the opposition proceedings, could evidently have been done by way of presenting a request to this effect during oral proceedings before the opposition division so as to

overcome the objection of the opposition division. This is particularly so in light of the fact that the opposition division chairman explicitly asked the proprietor whether he would file a request which overcame the objection.

1.6 Although the proprietor argued that it was a complete surprise to be presented with an Article 123(2) EPC objection because the annex to the summons had stated that a flat drive machine unit was not essential, this does not provide an overriding reason as to why the proprietor, when offered the chance of filing requests to overcome that objection, did not do so. Not only can an opposition division depart from its preliminary opinion, in view of argumentation by the parties for example, but in the Board's view the proprietor should not at all have been surprised that a feature it introduced by way of amendment was subject to objection. Moreover, the opposition division had not indicated in its annex to the summons that a flat drive machine unit was not essential in combination with the space requirement feature, because the space requirement feature was not in any of the claims on file at that time. Any comment in the annex to the oral proceedings summons concerned a differently worded claim.

1.7 The appellant's contention that the space requirement feature had been an essential part of the whole "machine room-less" concept in the other family members is not found to be convincing in relation to admissibility of the various requests in appeal proceedings, since by the amendments made in the main request and the first and second auxiliary requests, the space requirement feature has been entirely removed,

whereas the opposition division did not object to the space requirement feature being introduced into the claims *per se*, but instead that the application as filed required that a flat drive machine unit also be included when considering the space requirement feature.

1.8 Further, in regard to the reliance placed on decision T 545/01 by the appellant, the independent claim found allowable by the Board in that case (see page 3 of that decision) included not only the space requirement feature but also the drive machine unit of a flat construction. In the Reasons 1.3 of that decision, it is also stated that the application as originally filed disclosed to the skilled person that a flat machine was essential. Even on this basis alone, the appellant should thus not have been surprised that the opposition division also found that a flat drive machine was an essential feature of the disclosure.

1.9 The appellant's argument that the proprietor "did not want to follow this invitation, as the limitation to 'flat machines' would have effectively reduced the scope of protection to the content of maintained EP 784 030", shows only that the proprietor had made a conscious and deliberate choice not to overcome the objection made by the opposition division for reasons unconnected with the objection itself. The Board therefore does not find such an argument persuasive. On the contrary, the proprietor's deliberate choice not to file any request to overcome the objection, despite the offer to do so, is a further indication as to why a request filed only with the appeal grounds should not be admitted into the appeal proceedings.

- 1.10 The further argument that the proprietor did not know the reasons why the opposition division had reached its conclusion and that this meant the proprietor had to completely revise its defence strategy is also found unconvincing in relation to why no further request was filed during opposition proceedings. The amendment to the claim to include the space requirement feature was made of the proprietor's own volition at a late stage of proceedings (about 1 month before the oral proceedings) and it should have been expected that objections may have arisen and it could thus likewise be expected that the proprietor should have taken this possibility into account.
- 1.11 The further argument of the appellant that a deletion of the space requirement feature during those oral proceedings would have resulted in objections from the opponents due to late filing is also unconvincing. Merely because an objection might be raised, whether or not such an objection would be justified, is not a hindrance to filing a request, not least when the chairman invited the proprietor to do so.
- 1.12 The Board is also not convinced by the appellant's argument that the necessity to drop the space requirement feature only became clear after receiving the decision, because the opposition division explained at the oral proceedings what the objection was. Indeed, the opposition division explained in detail the nature of the objection, as is clear from the minutes of those proceedings.
- 1.13 The appellant's argument that the Board, by not admitting certain requests, would be disrespecting the

proprietor's right to have its patent examined on claims it has agreed and would thus be in violation of Article 113(2) EPC as made evident in T 1854/08, is also not found convincing.

Article 113(2) EPC does not require that a request must be found admissible, merely because it has been filed. Nor is the Board deciding on requests which have not been submitted to it. Merely because a request is filed, does not prevent the Board from finding the request inadmissible. This is evident from the straightforward wording of Article 12(4) RPBA.

Further, the case T 1854/08 cited by the appellant concerns an ex parte matter, in which new requests were filed and, due to a perceived lack of clarity of the claims in those requests reported to the applicant by email, a decision was taken on a previous set of claims which had however been replaced. In the present case, the Board would not be deciding on a previous set of claims, since those claims are not the subject of this decision. T 1854/08 thus concerns an entirely different matter and does not add any support to the appellant's argument.

- 1.14 The appellant further argued that any new request made on appeal could, as a general rule, have been filed in the first instance proceedings, so that a restrictive use of Article 12(4) RPBA in this manner to prevent the proprietor from filing claims in this case would lead to a situation where claims could never be forwarded which have not already been forwarded in the first instance, and that this could not have been the intention of Article 12(4) RPBA.

This interpretation of Article 12(4) RPBA is not considered to be in line with the intention addressed by this Article. Although from the very wording of Article 12(4) RPBA it is clear that such claims can be held inadmissible, it is up to the Board to exercise its discretion in such matters, having regard to the particular circumstances of the case. It is certainly not so that any request not filed in the first instance proceedings should not be admitted into the appeal proceedings; far from it. The Board has also (see below) admitted a new request, the third auxiliary request, into proceedings.

In so far, the circumstances of the present case are particularly noteworthy, since the considered and deliberate choice made by the proprietor not to file a further request, despite being given the opportunity to do so after the objection had been explained, is found by the Board to precisely correspond to the intention of Article 12(4) RPBA. Indeed, the primary purpose of an appeal is to provide the opportunity for a final instance review of the decision of a previous instance, thereby (in *inter partes* proceedings) allowing the losing party to challenge the decision of an opposition division on its merits and to obtain a judicial ruling as to whether the decision of the opposition division is correct (G 9/91 and G 10/91 - OJ EPO 1993, 408, 420). The appeal proceedings do not have the purpose of starting a new examination of different subject matter, in particular where such subject matter involves broadening of claims considered by an opposition division.

For an interpretation in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of the treaty's object and purpose (see point 1.4. above), additional reference is made to CA/133/02 e, the document put to the Administrative Council concerning the change to the RPBA when introducing Article 10a(4) (which later became Article 12(4)), where the following is stated (see page 12):

"... and the boards will retain their discretion, as a review instance, to refuse material excluded at first instance or not submitted during first instance proceedings."

Also from this, it is evident that the function of the Boards of Appeal was not only recognised to be that of a review instance, but that one way of ensuring this function was respected was codifying, in the Rules of Procedure, that material not submitted at first instance could be refused. Article 10a(4) refers to such material as "facts, evidence or requests" (see CA/133/02 e, page 15), as does current Article 12(4) RPBA.

- 1.15 The appellant also stated that a contravention of Article 113(1) EPC would occur if the requests were not admitted. However, the Board fails to see any such contravention. The appellant, in writing (by means of its response of 20 April 2011) and orally during the oral proceedings, both had and took the opportunity to present its arguments as to why its requests should be found admissible and allowed into the appeal proceedings. The fact that the Board finds its

arguments unconvincing does not mean that the appellant has not had an opportunity to present its arguments on the matter or that the Board had ignored the appellant's submissions in this respect.

1.16 In consequence of the foregoing, the Board decided not to admit the main request and the first and second auxiliary requests into the appeal proceedings, based on the provisions of Article 12(4) RPBA.

1.17 For the same reasons, the Board also holds the fourth auxiliary request filed by the appellant with its submission of 20 April 2011 as inadmissible with respect to Article 12(4) RPBA, as claim 1 of this request also omits the space requirement feature. In this regard it should be noted that Article 12 RPBA is entitled "Basis of Proceedings", and whilst Article 12(4) RPBA makes a reference to Articles 12(1) and (2) RPBA, this reference only concerns which matters are to be taken into account when considering the appeal. It does not state that Article 12(4) RPBA is restricted in its application by the time limit for filing the grounds of appeal or any reply thereto. Indeed, a restriction in that sense would not seem to serve any useful purpose and might even result in a possibility of artificially circumventing Article 12(4) RPBA, irrespective of whether Article 13(1) RPBA might be a further provision of the Rules of Procedure that could provide a different barrier to filing such requests.

1.18 The sixth auxiliary request, filed during the oral proceedings after discussion of the previous requests, does include the space requirement feature as per the

claim considered by the opposition division in its decision. Additionally the further feature is added that the drive machine unit "is of a flat construction as compared to its width" (in addition to the space requirement being "irrespective of hoisting height" which was added first in the fifth auxiliary request).

A claim including this particular combination of features, in view of the objection made by the opposition division during oral proceedings and the offer to file amendments, is a claim which the Board finds could have been filed during opposition proceedings in order to overcome the Article 123(2) EPC objection.

Again, the deliberate choice of the appellant not to file such a claim with this or similar wording during the oral proceedings before the opposition division, in the knowledge of the Article 123(2) EPC objection, is held by the Board to result in this being an inadmissible request in appeal proceedings, for the same reasons as given above on the basis of Article 12(4) RPBA.

The appellant's arguments that the subject matter of the claim was the subject matter of a dependent claim and was not complex do not alter the foregoing conclusion on admissibility of the request, since neither the complexity of the request nor the fact that the feature was in a dependent claim relates to the reasons for the Board's conclusion.

- 1.19 The appellant's arguments concerning G 1/05 and the subsequent revision of the implementing regulations

limiting the possibility of filing serial divisional applications over the lifetime of an application do not alter any of the foregoing conclusions. The findings in G 1/05 do not relate to the finding of non-admissibility of certain requests under Article 12(4) RPBA, even if the conclusions reached therein may have been of importance had any request been both admitted and found to meet the requirement of Article 123(2) EPC. The appellant also did not further explain why G 1/05 would be of consequence for the present decision in this regard.

2. *Third auxiliary request*

2.1 Claim 1 of the third auxiliary request includes the space requirement feature but does not define a flat drive machine unit. Other amendments are made to the claim as well, but these are unrelated to the combination of the flat drive machine unit in combination with the space requirement feature and thus do not affect the matter of Article 123(2) EPC. The appellant also did not argue that these other features were of any significance in that regard.

2.2 As also stated in the Board's communication of 21 March 2011, the space requirement feature as included in claim 1 failed to include the terminology "irrespective of the hoisting height" which was however contained in paragraph [0005] as follows: "for which the space requirement in the building, irrespective of the hoisting height, is substantially limited to...". That missing terminology, in the context of paragraph [0005], can only be understood in the light of the whole disclosure to relate to the presence of a flat drive

machine unit, since the only disclosure of a drive machine unit in the entire application as filed which meets such space requirement is one which is of a flat construction (see e.g. the published application at paragraph [0011]). The appellant also did not dispute the fact that a flat drive machine unit was the only type of drive disclosed specifically in any embodiment.

The appellant however argued that a skilled person reading the application would understand that the claims were broad enough to cover different types of drive units such as elongated ones which could be fitted into the space between the elevator car and the elevator shaft wall, the cross-sectional area of which not being greater than the footprint of the counterweight and its guiding means including safety distances. A skilled person would recognise that any such drive unit would correspond to the basic principle of the invention, which was efficient space utilization.

However, the Board finds this argument unconvincing, because it is not based on any direct and unambiguous disclosure in the application as filed, but rather on a non-disclosed intention of how paragraph [0005] could be interpreted. Paragraph [0005] of the application refers *inter alia* to the problem of efficient space utilization being solved by a "new type of traction sheave elevator" as the invention, and that invention being defined by the features of the characterizing part of claim 1. Not only did the invention defined in claim 1 as filed not include the space requirement feature, but nowhere is there any indication that a general idea of the invention was merely to provide coverage for all types of drive unit as long as they

could fit into the cross-sectional area provided by the elevator car and the counterweight on their paths including safety distances.

The appellant further argued that it could be seen in the GPP, GP and P applications as filed, that the underlying concept of space utilization was common throughout the family of applications in particular when looking at the claims as filed. However (and irrespective of the matter that a comparison of the disclosures of the GPP, GP and P applications might itself give rise to further objections in relation to Article 76(1) EPC when considering the subject matter of claim 1 of the third auxiliary request), in as far as concerns Article 123(2) EPC, the content of the family applications and their possible disclosures is not a matter for consideration.

- 2.3 Thus, based on the content of the application as filed, the Board can find no disclosure of the space requirement feature without requiring the presence of a flat drive machine. Since claim 1 does not also define a flat drive machine in addition to the space requirement feature, the requirement of Article 123(2) EPC is not met.

The third auxiliary request is therefore not allowable.

3. *Fifth auxiliary request - non-admittance into proceedings in accordance with Article 13(1) RPBA*

- 3.1 The fifth auxiliary request was filed in response to the Board's communication of 21 March 2011 and supplemented the space requirement feature with the

expression from paragraph [0005] of "irrespective of the hoisting height".

- 3.2 However, it was already stated in the Board's communication (item 2.1.3) that at least a flat drive machine was a structural feature implicitly required in the context of paragraph [0005] (from where the space requirement feature had been taken).

Instead of including that feature, the appellant chose to include the feature "irrespective of hoisting height", even though the Board had stated in 2.1.2 of that communication that the space requirement feature could only seemingly be fulfilled by the inclusion of a flat drive machine.

The feature "irrespective of the hoisting height" is however an unclear functional indication of an additional result to be achieved by the space requirement feature, rather than defining a clear structural feature in accordance with the application as filed.

Since the inclusion of this feature would give rise to at least a further objection (under Article 84 EPC 1973) and was thus not *prima facie* allowable, the Board, in exercising its discretion under Article 13(1) RPBA, did not admit this request into proceedings as it was not procedurally economical to examine a request in detail that already at first sight could not be the basis for the maintenance of a European patent.

4. *Request for referral of a question to the Enlarged Board of Appeal - Article 112(1)(a) EPC 1973*

The request of respondent/opponent OII to refer a question to the Enlarged Board of Appeal is not of relevance to the outcome of the present case, since all the requests of the appellant are either not admitted into proceedings or not allowable. Thus, no decision is required to clarify an important point of law, since it is not of relevance to the decision to be taken. Further, the Board finds that the question formulated by the respondent is anyway not a question which needs to be answered to ensure uniform application of the law, since there is no contradictory case law. The question as to whether subject matter of an application can be regarded as having been unequivocally and definitively abandoned, even more so in relation to a "real intention of an applicant" (see part (b) of the proposed question), will depend on the facts and circumstances of each individual case and is thus not a question of law.

The proposed question therefore fails to meet the requirements of Article 112(1)(a) EPC 1973.

5. *Requests for apportionment of costs in favour of the respondents*

Under Article 104(1) and Rule 100(1) EPC each party to the opposition proceedings shall bear the costs it has incurred, unless decided differently for reasons of equity. In this respect, Article 16(1)(e) RPBA mentions abuse of procedure as a possible reason for ordering payment of costs. The respondents argued that all of

the requests could have been filed in the opposition proceedings and it was an abuse of procedure to file them e.g. with the grounds of appeal. If this had been done, the entire appeal proceedings and its associated costs could allegedly have been avoided.

However, the appeal procedure is a procedure in which the decision of a first instance department may be challenged. The fact that the Board finally judged the appellant's challenge unsuccessful on the grounds of non-admittance, inadmissibility or non-allowability of certain requests has not per se caused the respondents any additional unexpected costs in the appeal procedure, nor did it make the appeal procedure superfluous. Also, the oral proceedings were a necessary part of the procedure and all parties availed themselves of the opportunity to make arguments on the various requests. In the case at hand, the respondents did not put forward any facts that could be regarded as equitable reasons for apportionment of costs in their favour. The Board also cannot find any facts underlying a direct abuse of procedure. But it is true that the non-admittance decision under Article 12(4) RPBA involves the assessment of elements of this nature. However, these procedural situations must be differentiated. Abuse of procedure as such is procedurally unfair and consequently there is a special need for protection of the other party to the proceedings that can result in a decision for apportionment of costs in the other party's favour. The non-compliance with Rule 12(4) RPBA already has severe consequences in itself that result in a restriction concerning the filing of further amended versions of the patent for consideration. In such circumstances there is no equitable need for an

additional decision on costs in favour of the other party.

Thus, the Board finds no reason to apportion costs in favour of the respondents.

6. *Article 112a / Rule 106 EPC*

6.1 In response to the Board's communication of 21 March 2011 in which the Board provisionally considered the main request and the first and second auxiliary requests inadmissible with respect to Article 12(4) RPBA, the appellant responded with its submission of 12 April 2011 by stating that the non-admission of its requests would be forwarded for review by the Enlarged Board of Appeal in accordance with Article 112a EPC, based on a violation of Article 113(1) and (2) EPC.

6.2 At the oral proceedings, and having heard the parties on this matter, the Board decided not to admit the main request and the first and second auxiliary requests, and additionally the fourth and sixth auxiliary requests, into the proceedings.

6.3 The appellant then stated that it maintained its objection, in accordance with Rule 106 EPC, as explained in writing.

6.4 As explained e.g. in Reasons 1.13 and 1.15 *supra*, the Board has considered the appellant's objections with respect to Article 113(1) and (2), and the appellant was able to comment on these matters. The Board however does not find that they lead to the need for any different procedure to have been adopted by the Board.

The Board thus finds that the appellant's objection under Rule 106 EPC is void of substance and must be rejected.

Order

For these reasons it is decided that:

1. The objection of the appellant under Rule 106 EPC is dismissed.
2. The request of the respondent/opponent OII for referral of a question to the Enlarged Board of Appeal is rejected.
3. The appeal is dismissed.
4. The requests of the opponents for apportionment of costs are rejected.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau