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**Datasheet for the decision
of 7 April 2011**

Case Number: T 1050/09 - 3.2.08

Application Number: 02100569.9

Publication Number: 1277977

IPC: F16C 33/66

Language of the proceedings: EN

Title of invention:
Rotational device

Patentee:
IMN Co., Ltd.

Opponent:
Kieninger Technologie GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
EPC Art. 54(1)(2), 56

Keyword:
"Remittal to first instance (no)"
"refund of appeal fee (no)"
"Added subject-matter (no)"
"Novelty (yes)"
"Inventive step (no)"

Decisions cited:
T 0209/88, T 0795/91, T 0686/92

Catchword:

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Case Number: T 1050/09 - 3.2.08

D E C I S I O N
of the Technical Board of Appeal 3.2.08
of 7 April 2011

Appellant: IMN Co., Ltd
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 March 2009
revoking European Patent No. 1277977.

Composition of the Board:

Chairman: T. Kriner
Members: M. Alvazzi Delfrate
U. Tronser

Summary of Facts and Submissions

- I. By its decision posted on 20 March 2009 the opposition division revoked European patent No. 1 277 977 for lack of novelty.
- II. The appellant (patent proprietor) lodged an appeal against this decision on 12 May 2009, paying the appeal fee on 19 May 2009. The statement setting out the grounds for appeal was filed on 17 July 2009.
- III. Oral proceedings before the board of appeal were held on 7 April 2011.
- IV. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the request submitted with letter dated 15 March 2010 or that the case be remitted to the opposition division for further prosecution. It also requested reimbursement of the appeal fee.

The respondent (opponent) requested that the appeal be dismissed.

- V. Claim 1 of the main request reads as follows:

"A rotational device comprising:
an inner part (1) and an outer part (2), one of which is rotatable relative to the other;
one or more main rotational bearings (3) disposed between the inner part (1) and the outer part (2);
a lubricant supply controller (6) containing a memory (61) which stores the number of revolutions made by the or each bearing and a predetermined number of

revolutions required between sequential lubrications for the or each rotational bearing (3), and providing a signal to initiate lubrication of a bearing when the number of revolutions made after a lubrication and stored in the memory (61) reaches the predetermined number of revolutions for that bearing; wherein the memory (61) updates the predetermined number of revolutions if the time actually required between lubrications is less than that suggested by the predetermined number of revolutions stored in the memory (61)."

VI. The following documents are relevant for the present decision:

D1: JP -A- 6 307 458 and its English translation D1A.

VII. The arguments of the appellant can be summarised as follows:

Remittal to the first instance and reimbursement of the appeal fee

The opposition division took the appealed decision without appointing oral proceedings, despite the fact that they had been unconditionally requested by the opponent. It was true that the appellant itself did not request oral proceedings. However, such a request was not necessary since the appellant could rely on the opponent's request. The failure to appoint the oral proceedings represented a substantial procedural violation, as established by the case law and in particular by T 795/91, which justified the remittal of

the case to the first instance and the refund of the appeal fee.

Article 123(2) EPC 2000

Claim 1 was based on originally filed claims 1 and 3, while the features added by dependent claim 3 could be found in originally filed claim 4. Even if in the application as originally filed claim 4 did not depend on claim 3, it was clear to the person skilled in the art that said claims related to two different embodiments which concerned two unrelated features and could be combined. Therefore, the application as originally filed disclosed also the combination of features of present claims 1 and 3. Accordingly, Article 123(2) EPC 2000 was complied with.

Novelty

D1/D1A did not disclose that the rotational device comprised a memory for storing the number of revolutions of the bearing.

Moreover, not all memories could be updated. For instance, this was not possible for some kinds of mechanical memories. Therefore, as D1 did not mention that a memory was updated, this document did not disclose either that the memory of the claimed device was capable of being updated, so that the predetermined number of revolutions could be corrected. Accordingly, the subject-matter of claim 1 was novel.

Inventive step

Starting from the device disclosed in D1/D1A, which required the measurement of temperature and rotational frequency, the object underlying the claimed invention was to provide a simpler device. Said object was achieved by choosing the number of revolutions as a parameter for deciding when lubrication was necessary.

This choice was not obvious, since D1 not only did not mention the number of revolutions of the bearing, but also, by referring in paragraph [0011] to a predetermined period, which had to be understood as a time period, between two successive lubrications, actually led away from its use. Accordingly, the subject-matter of claim 1 also involved an inventive step.

VIII. The arguments of the respondent can be summarised as follows:

Remittal and reimbursement of the appeal fee

The respondent was the sole party who had requested oral proceedings during the opposition proceedings. Since the patent had been revoked by the opposition division in accordance with its request, said oral proceedings would have served no purpose. Accordingly, no substantial procedural violation had occurred.

Article 123(2) EPC 2000

Claim 1 was based on originally filed claims 1 and 3. Although the features added by present claim 3 were to

be found in originally filed claim 4, the latter claim did not depend on originally filed claim 3. Therefore, the combination of the features of present claims 1 and 3 was not disclosed in the application as filed. Accordingly, Article 123(2) EPC 2000 was not complied with.

Novelty

D1/D1A disclosed a device in accordance with present claim 1. In particular, it implicitly disclosed a controller containing a memory, which was necessary to store the predetermined period for lubrication and check if said period had elapsed or not. Moreover, it was possible to update said memory, for instance to take into account the measurements of the temperature sensor and rotational frequency counter.

Additionally, even if the number of revolutions of the bearing was not explicitly mentioned in D1, it was clear that, since a rotational frequency counter was used, the period for lubrication was measured as a number of revolutions. Hence, the subject-matter of claim lacked novelty over D1.

Inventive step

In the event that the subject-matter of claim 1 was considered to be novel over D1 by virtue of the choice of the number of revolutions for measuring the period between successive lubrications, it did not involve an inventive step. Said choice was an obvious one for realising the device of D1, since the adoption of this commonly used parameter was suggested by the

measurement of the rotational frequency. Hence, the subject-matter of claim 1 did not involve an inventive step.

Reasons for the Decision

1. The appeal is admissible.
2. Remittal and refund of the appeal fee.

In deciding to revoke the patent the opposition division did not commit a substantial procedural violation.

The right to oral proceedings regulated by Article 116(1) EPC forms a substantial part of the right to be heard granted by Article 113(1) EPC. From this it follows that non-compliance with a request for oral proceedings deprives the party of an important opportunity for presenting his case in the manner he wishes and using the possibilities open to him under the EPC (see T 209/88, point 4.3 of the reasons for the decision).

Article 113(1) EPC, however, does not confer a formal position on a party to proceedings before the EPO but serves to ensure fair conduct of those proceedings. A successful party has no reason to doubt the correctness of the procedure leading to the decision in its favour. In accordance with the established case law of the boards of appeal (see Case Law, 6th edition, chapter VI.C.2.) the board consequently states that in the case of a request for oral proceedings by a party the

opposition division has no power to issue a decision adversely affecting such party without first appointing oral proceedings (see T 686/92, point 3 of the reasons for the decision; T 795/91, point 3 of the reasons for the decision).

In the present case, however, in view of the positive conclusion in favour of the opponent the opposition division had reached regarding the question of novelty (see its communication dated 23 May 2008), oral proceedings at the unconditional request of the opponent would have served no purpose. The opposition division thus treated the opponent's request for oral proceedings as merely conditional in accordance with Articles 113(1) and 116(1) EPC (see T 494/92, point 2 of the reasons for the decision).

As stated above, it is true that a party to proceedings before the EPO has the right to present its case in the manner it wishes and using the possibilities open to it under the EPC. The party's right to oral proceedings, however, is subject to a clear request for such proceedings. With communication dated 23 May 2008 the opposition division informed the parties of its opinion that claim 1 was not novel and that revocation of the patent could be expected. Having received this communication without summons to oral proceedings it was up to the appellant to make a clear request for oral proceedings. The opposition division had no reason to investigate the proprietor's motivation with regard to procedural requests made by the opponent.

3. Article 123(2) EPC 2000

Claim 1 is based on claims 1 and 3 as originally filed. The latter claim relates to an embodiment allowing the possibility of updating the memory (see also paragraphs [0038] and [0039] of the application as published). Present dependent claim 3 adds the features disclosed in claim 4 as originally filed, which concerns an embodiment allowing the use of a plurality of rotational devices (see also paragraph [0043] of the application as published).

It is true that the application as filed does not state *expressis verbis* that said embodiments can be combined with each other. Nevertheless, it is apparent to the person skilled in the art that they relate to two independent preferred aspects of the claimed invention which can be combined without any difficulty.

Therefore, the possibility of combining the features of originally filed claims 1, 3 and 4 is disclosed in the application as filed.

4. Novelty

4.1 D1/D1A discloses a rotational device comprising: an inner part (1) and an outer part (7), one of which is rotatable relative to the other; and main rotational bearings (2) disposed between the inner part and the outer part.

According to D1/D1A a lubricant is supplied to the bearing, which is mounted on a space flying object, by operating a pump at intervals of predetermined period or by a command from a ground installation (see

abstract). This implies some sort of lubricant supply controller which provides a signal to initiate lubrication of the bearing when the period after lubrication reaches the predetermined period required between sequential lubrications for the bearing. Moreover, to perform this function the controller must comprise a memory which stores a measurement of the period elapsed since the last supply of lubricant and the predetermined period required between sequential lubrications of the rotational bearing (see in particular paragraphs [0011] and [0012]).

4.2 The appellant submitted that, since not all memories could be updated, a memory capable of being updated could not be seen as implicitly disclosed in D1/D1A. However, this argument is not convincing, since a memory not capable of being updated would not be used in a system of the type disclosed in D1, i.e. one which is partly mounted on a space flying object and can react to the data from a temperature sensor and rotational frequency counter (see paragraph [0012]). Therefore, the memory of the device disclosed in D1/D1A is capable of updating the predetermined period required between sequential lubrications if the time actually required between lubrications is less than that suggested by the predetermined period stored in the memory.

4.3 However, D1/D1A does not describe that the period elapsed since the last supply of lubricant and the predetermined period required between sequential lubrications are measured as a number of revolutions. Nor is this feature implicitly disclosed by the fact that the rotational frequency is measured, as D1 does

not describe how exactly this measurement is used to decide that lubricant is needed. Accordingly, the subject-matter of claim 1 is novel.

5. Inventive step

5.1 Starting from the device disclosed in D1/D1A, the object underlying the claimed invention can be seen in selecting a unit for measuring the period elapsed since the last supply of lubricant and the predetermined period required between sequential lubrications. This object is achieved by selecting the number of revolutions of the bearing to measure said periods.

Contrary to the appellant's submission, the object underlying the claimed invention cannot be seen as simplifying the device of D1, since the measurements of the temperature and rotational frequency of the bearing in addition to the number of revolutions are not excluded in the claimed bearing.

5.2 It is true, as argued by the appellant, that D1/D1A does not mention the number of revolutions of the bearing. However, this parameter was commonly used when assessing the need for lubrication of a bearing, for instance when considering the so-called "Dmn value", whose use was common in the art, as acknowledged in the patent itself (see paragraph [0004]). Moreover, it is apparent that the number of revolutions can be used to express the length of the interval between two successive lubrications, since lubricant consumption increases with the number of revolutions.

Contrary to the appellant's submission, D1 does not lead away from the use of this parameter, since the wording "predetermined period" in paragraph [0011] merely indicates the predetermined length of the interval between two successive lubrications, without defining how said length is to be measured.

- 5.3 Therefore, it was obvious to achieve the object above by selecting, when realising the device shown in D1/D1A, the number of revolutions of the bearing as a unit for measuring the period elapsed since the last supply of lubricant and the predetermined period required between sequential lubrications. Accordingly, the subject-matter of claim 1 does not involve an inventive step.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:

V. Commare

T. Kriner