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**Datasheet for the decision
of 22 November 2012**

Case Number: T 2430/09 - 3.2.01

Application Number: 00300107.0

Publication Number: 1077144

IPC: B60C 23/04

Language of the proceedings: EN

Title of invention:

Tire inflation pressure monitor and monitoring method

Patentee:

Pacific Industrial Co., Ltd.

Opponent:

BorgWarner BERU Systems GmbH

Headword:

-

Relevant legal provisions (1973):

EPC Art. 84

EPC R. 67

Keyword:

"Clarity (no)"

"Reimbursement of appeal fee (no)"

Decisions cited:

G 0009/91, T 0092/92, T 0341/92, T 1002/92, T 0861/93,

T 0131/01, T 0604/01

Catchword:

-



Case Number: T 2430/09 - 3.2.01

DECISION
of the Technical Board of Appeal 3.2.01
of 22 November 2012

Appellant: BorgWarner BERU Systems GmbH
(Opponent) Mörikestr. 155
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Representative: Twelmeier, Ulrich
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Respondent: Pacific Industrial Co., Ltd.
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Representative: Green, Mark Charles
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
26 November 2009 concerning maintenance of
European patent No. 1077144 in amended form.

Composition of the Board:

Chairman: G. Pricolo
Members: C. Narcisi
T. Karamanli

Summary of Facts and Submissions

- I. The European patent No. 1 077 144 was maintained in amended form by the decision of the Opposition Division posted on 26 November 2009. A notice of appeal was filed by the Opponent on 17 December 2009 and the appeal fee was paid. The statement of grounds of appeal was filed on 11 January 2010.
- II. In first-instance proceedings the Patentee filed amended claims with a letter dated 27 March 2006. In a reply dated 28 January 2008 to the summons to oral proceedings of 8 November 2007, the Opponent argued that the subject-matter of amended claims 1 and 6 was not novel in view of documents D1 (EP 0 763 437 B1) and D2 (WO 98/05518 A). At the end of its reply, the Opponent submitted, without giving any reasons, that the amended set of claims contravened Articles 123(3) and 84 EPC as well as Rule 80 EPC.
- III. In its decision the Opposition Division referred to decision T 1002/92 and found *inter alia the following*:
- (a) The objection according to Rule 80 EPC had been raised by the Opponent without substantiating this objection and was therefore not admissible. The Opposition Division regarded the amendments in claims 1, 3 and 6 being in line with Rule 80 EPC because they were filed to overcome objections according to Article 100(a) and (b) EPC raised by the Opponent (point 2 of the Reasons).
- (b) The claims as amended fulfilled the requirements of Article 123 EPC. The Opponent's request to

revoke the patent because the claims did not fulfil the requirements of Article 123(3) EPC was not admissible due to lacking substantiation. The Opponent had not provided any facts, evidence or arguments supporting its objection (point 3 of the Reasons).

IV. Claim 1 as upheld by the appealed decision reads as follows:

"A receiver (17) for receiving radio waves that carry data representing a physical state, the radio waves being transmitted by a transmitter (15a-15d), the receiver comprising:
at least four reception antennas (31a-31d) that respectively induce voltage signals based on reception of the radio waves;
a synthesizer (32) for selecting the highest level signal of the induced voltage signal; and
a processing device (33, 34) for processing the selected signal to obtain the data, characterized in that
the synthesizer (32) selects the highest level signal of the voltage signals that are simultaneously input from the reception antennas (31a-31d) in steps and outputs the highest level signal."

V. In a communication dated 25 January 2011 pursuant to Rule 84(1) EPC the Board informed the Appellant (Opponent) that the patent had expired for all the designated contracting states and that the appeal proceedings would be discontinued unless a request for continuation was filed by the Appellant within two months from notification of said communication.

- VI. With a letter received on 28 January 2011, the Appellant informed the Board that continuation of the appeal proceedings was requested.
- VII. In a reply letter dated of 20 August 2012 to the summons to oral proceedings before the Board, the Appellant withdrew its request for oral proceedings and requested that the decision be issued in written proceedings. Further the Appellant advised the Board that it would not attend oral proceedings if they were to be held.
- VIII. Oral proceedings were held on 22 November 2012 in the absence of the duly summoned parties. The Appellant (Opponent) had requested in writing that the decision under appeal be set aside, that the European patent be revoked and that the appeal fee be reimbursed. The Respondent (Patentee) had filed no submissions in the present appeal proceedings.
- IX. The Appellant's submissions may be summarized as follows:

The subject-matter of Claim 1 as amended during opposition proceedings offends against Article 123(3) EPC. In effect, the characterizing portion of present claim 1 merely states that the synthesizer "outputs the highest level (voltage) signal" whilst in claim 1 as granted it was stated that "the synthesizer selects and outputs the highest level signal in steps". Claim 1 as granted thus does not solely imply that the synthesizer outputs the highest level signal, as implied by amended claim 1, but that it outputs the highest level signal

in steps. It follows that claim 1 as amended has an extended scope of protection when compared to granted claim 1.

The set of claims as amended and as upheld by the Opposition Division, in particular amended claim 3, does not comply with Rule 80 EPC since these amendments are not occasioned by a ground for opposition.

Claim 1 as amended lacks clarity since the above mentioned features of the characterizing portion of claim 1 can be interpreted in different ways. In particular, the term "in steps" may be associated either with the wording "the synthesizer selects the highest level signal of voltage signals" or with the wording "voltage signals that are simultaneously input from the reception antennas". Each association leads to a possible and different interpretation of said characterizing features. The latter association and interpretation of said characterizing features implies that voltage signals are simultaneously input in steps from the reception antennas. This is so for instance if each antenna is provided with a separate and distinct data input channel connecting the antenna with the synthesizer, an analogue/digital converter being provided within the antenna (or between the antenna and the synthesizer) for transferring the digitalized data stepwise to the synthesizer. Consequently, in addition to the first interpretation as set out in the impugned decision, a second interpretation of the characterizing features is possible and therefore the claim lacks clarity.

The reimbursement of the appeal fee is requested since the Opposition Division did not admit the objections based on Article 123(3) EPC and Rule 80 EPC to the opposition proceedings, and this amounts to a substantial procedural violation because these objections constitute new arguments and not new facts. According to the case law of the Boards of Appeal (T 92/92, T 604/01, T 861/93, T 131/01), these arguments should have been admitted to the opposition proceedings. In particular, according to decision T 341/92, an objection under Article 123(3) EPC is even admissible when it is raised for the first time in oral proceedings and the patent proprietor is absent.

Reasons for the Decision

1. The appeal is admissible.
2. The duly summoned parties did not attend the oral proceedings. According to Rule 71(2) EPC 1973, the proceedings could however continue without them. In accordance with Article 15(3) RPBA (Rules of procedure of the Boards of Appeal of the European Patent Office, OJ EPO 2007, 536), the Board relied for its decision only on the parties' written submissions. The Board was in a position to decide at the conclusion of the oral proceedings, since the case was ready for decision (Article 15(5) and (6) RPBA), and the voluntary absence of the parties was not a reason for delaying a decision (Article 15(3) RPBA).
3. Claim 1 of the patent as upheld by the Opposition Division does not meet the requirement of clarity

(Article 84 EPC 1973). In particular, the feature stating that (i) "the synthesizer selects the highest level signal of the voltage signals that are simultaneously input from the reception antennas in steps and outputs the highest level signal" is ambiguous and vague. In effect, the term "in steps" may be considered as relating to the wording "selects the highest level signal", in which case the above feature (i) implies that the synthesizer selects the highest level signal of the voltage signals in steps. According to an equally sensible reading of said feature (i), if the term "in steps" is regarded as relating to the wording "signals that are simultaneously input from the reception antennas", the voltage signals are simultaneously input from the reception antennas in steps. This situation may arise for instance if the synthesizer comprises an input data transmission channel for each antenna, which data are input in steps, as set out by the Appellant.

The aforementioned lack of clarity cannot be remedied by invoking Article 69 EPC and by using the description to interpret the claims. Indeed, use of Article 69 EPC and its Protocol is primarily limited to cases where the extent of protection has to be determined. This obviously does not include such cases as the case in point, where the independent claim is unclear per se.

For the given reasons claim 1 does not comply with the requirements of Article 84 EPC 1973.

4. The Board considers that a reimbursement of the appeal fee in accordance with Rule 67 EPC 1973 is not equitable by reason of a substantial procedural violation in the present case because an error of

judgement has occurred in first-instance proceedings which, however, is not a procedural violation within the meaning of said provision (see also "Case Law of the Boards of Appeal of the European Patent Office", 6th edition 2010, VII.E.17.4.5).

The Opposition Division referred to decision T 1002/92 (OJ EPO 1995, 605) and found the Opponent's objections based on Rule 80 and Article 123(3) EPC to be inadmissible since both objections had not been substantiated. In appeal proceedings, the Appellant has not disputed that its objections under Rule 80 and Article 123(3) EPC had not been substantiated in first-instance proceedings. Nor has the Appellant contended that it had been hindered by the Opposition Division from substantiating its objections during the oral proceedings before the Opposition Division.

In decision T 1002/92, the Board of Appeal held that, *"following the principles set out in Opinion G 10/91, as regards proceedings before the Opposition Divisions, late-filed facts, evidence **and related arguments**, which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to Rule 55(c) EPC in support of the grounds of opposition on which the opposition is based, **should only exceptionally be admitted into the proceedings by the Opposition Division, if prima facie, there are clear reasons to suspect that such late-filed material would prejudice the maintenance of the European patent"*** (point 3.3 of the Reasons and Headnote I; emphasis added). Decision T 1002/92 further states: *"indication of the facts, evidence and arguments" in support of the stated grounds of opposition is often referred to as*

the "substantiation" of the grounds of opposition"
(point 3.1 of the Reasons).

It is clear from the impugned decision (see point 3 of the Reasons and point III above) and the minutes of the oral proceedings before the Opposition Division (see point 3 on pages 1 to 2) that the Opposition Division applied the afore-mentioned principles developed in decision T 1002/92 to the objections under Rule 80 and Article 123(3) EPC raised by the Opponent against the amended claims filed by the Patentee.

In the board's view, the Opposition Division erred when it applied the principles developed in decision T 1002/92. As regards the first-instance proceedings, it is clear from the reasoning in decision T 1002/92 that these principles concern the admissibility of **late-filed facts, evidence and related arguments in support of a ground for opposition under Article 100 EPC 1973** which go beyond the facts, evidence and arguments submitted in the notice of opposition in support of a ground for opposition under Article 100 EPC 1973 (see in particular point 3.2, second paragraph, of the Reasons). In the present case, however, the Opponent's objections were not raised in support of a ground for opposition under Article 100 EPC 1973 but under Rule 80 and Article 123(3) EPC against the amended claims filed by the Patentee. Thus the principles developed in decision T 1002/92 did not apply to the case which the Opposition Division had to decide. However, as stated above, such an error of judgement does not amount to a procedural violation within the meaning of Rule 67 EPC 1973.

5. According to the decisions cited by the Appellant, the Opposition Division should have considered the Opponent's new objections. Arguments have to be considered, whenever they were brought forward in first-instance proceedings (see decisions T 92/92, T 604/01, T 861/93 and T 131/01 (OJ EPO 2003, 115)). In decision T 604/01, the board held that objections under Article 123(2) and (3) EPC which the opponent raised during the opposition proceedings but did not further explain until oral proceedings could not be excluded under Rule 71a(1) EPC 1973 because these objections were a matter of argument. Further, pursuant to Article 101(3)(a) EPC, taking into consideration the amendments made by the Patentee, the patent and the invention to which it relates must meet the requirements of the EPC. Thus in case of amendments of the claims of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with e.g. the provisions of Article 123(2) and (3) EPC (see G 9/91, OJ EPO 1993, 408, point 19 of the Reasons). Therefore, even if the Opponent (Appellant) did not substantiate its submissions of lack of compliance with Rule 80 and Article 123(3) EPC, the Opposition Division should not have decided that these new objections, filed with letter of 28 January 2008, were not admitted to the opposition proceedings. However, it is clear from the impugned decision that the Opposition Division considered the patent as amended to fulfil the requirements of Rule 80 and Article 123(3) EPC (see points 3 and 4 of the Reasons). Under these circumstances it is evident that the Opposition

Division has examined the issue of Rule 80 and Article 123(3) EPC ex officio.

6. From the foregoing it follows that due to its error of judgement, the Opposition Division decided not to admit the Opponent's objections into the opposition proceedings. Hence a reimbursement of the appeal fee is not equitable in the present case. Thus the Appellant's request for a reimbursement of the appeal fee must be refused.

Order

For these reasons it is decided that:

1. The decision is set aside.
2. The patent is revoked.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

A. Vottner

G. Pricolo