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**Datasheet for the decision
of 2 May 2013**

Case Number: T 1287/10 - 3.2.06

Application Number: 02738196.1

Publication Number: 1397304

IPC: B66B11/00, B66B7/06, B66B15/04

Language of the proceedings: EN

Title of invention:
ELEVATOR

Patent Proprietor:
Kone Corporation

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

Relevant legal provisions:
EPC 1973 Art. 84
EPC Art. 123(2)
RPBA Art. 13(1)

Keyword:
Clarity - no
Request admitted into the proceedings - no



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1287/10 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 2 May 2013

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 18 May 2010
revoking European patent No. 1397304 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: M. Harrison
Members: G. Kadner
 W. Sekretaruk

Summary of Facts and Submissions

- I. The mention of grant of European patent No. 1 397 304, with 16 claims, on the basis of European patent application No. 02738196.1 filed on 07 June 2002, and claiming a Finnish priority of 21 June 2001, was published on 14 May 2008.
- II. Three notices of opposition, in which revocation of the patent on the grounds of Article 100(a), 100(b) and 100(c) EPC was requested, were filed against the granted patent by the opponents.

Claim 1 of the patent as granted reads as follows:

"Elevator, preferably an elevator without machine room, in which elevator a hoisting machine (6) engages a set of hoisting ropes via a traction sheave, said set of hoisting ropes (3) having a load-bearing part twisted from steel wires of circular and/or non-circular cross-section, and in which elevator the hoisting ropes support a counterweight (2) and an elevator car (1) moving on their tracks, characterized in that the weight of the hoisting machine of the elevator is at most 1/5 of the weight of the nominal load of the elevator, that the outer diameter of the traction sheave (7) driven by the hoisting machine of the elevator is at most 250 mm and that the elevator car and counter-weight are supported under use of multiple rope passages."

With its decision posted on 18 May 2010, the opposition division revoked the patent. The opposition division held that the ground of opposition according to Article 100(b) EPC prejudiced maintenance of the patent.

III. Two notices of appeal were filed against this decision by appellant I (patentee) on 8 June 2010 and by appellant II (opponent 01) on 27 July 2010, and the appeal fees were paid respectively on the same day as the appeals were filed. The grounds of appeal were filed on 9 July 2010 and on 28 September 2010 respectively.

Appellant I (patentee) pursued its request for maintenance of the patent and filed an amended main request and three auxiliary requests. Appellant II requested that the part of the decision relating to the ground for opposition according to Articles 100(a) and 100(c) EPC be overturned and that the part of the decision relating to the ground of opposition under Article 100(b) EPC be reconsidered. On 8 July 2011 it requested refund of the appeal fee in case the appeal were deemed inadmissible.

Together with its reply to appellant II's appeal, appellant I filed four additional auxiliary requests.

IV. In a communication accompanying the summons to oral proceedings, the Board expressed its preliminary view that appellant I's appeal seemed to be admissible whereas appellant II's appeared to be inadmissible since it was not adversely affected. There was however doubt as to whether the amendments made to claim 1 of all requests met the requirement of Article 123(2), 123(3) or 84 EPC, respectively. The Board also stated that it considered the opposition division's conclusion in respect of lack of novelty to be correct.

V. Oral proceedings were held on 2 May 2013, during which appellant I replaced all former requests by one new main request.

Appellant I (patent proprietor) requested that the decision under appeal be set aside and that the European patent be maintained on the basis of the main request of 2 May 2013.

Appellant II (opponent 01) withdrew its appeal and its request for refund of the appeal fee. Together with the other respondents (opponents 02 and 03) it requested that the appeal be dismissed.

Claim 1 reads as follows (amendments with respect to granted claim 1 underlined)

"Elevator, preferably an elevator without machine room, in which elevator a hoisting machine (6) engages a set of thin, substantially round hoisting ropes via a traction sheave, said set of hoisting ropes (3) having a load-bearing part twisted from steel wires of circular and/or non-circular cross-section, and in which elevator the hoisting ropes support a counterweight (2) and an elevator car (1) moving on their tracks, characterized in that the weight of the hoisting machine of the elevator is at most 1/5 of the weight of the nominal load of the elevator, that the outer diameter of the traction sheave (7) driven by the hoisting machine of the elevator is at most 250 mm and that the elevator car and counter-weight are supported under use of multiple rope passages, and that the cross-sectional area of the steel wires of the hoisting ropes is larger than 0.015 mm² and smaller than 0.2 mm², and that the steel wires of the hoisting ropes have a strength exceeding 2000 N/mm²."

VI. The arguments of the appellant can be summarized as follows:

The newly filed request should be admitted into the proceedings. Although the amendment "thin, substantially round (hoisting ropes)" was taken from the description, it was clearly and unambiguously disclosed in the application as originally filed, and was in line with the subject-matter claimed. In the mind of the skilled person, the term "thin" in combination with steel wires of high strength as disclosed in claim 3 as granted would be understood as being thinner than the prior art ropes. Thus there was no need to specify a particular dimension of a "thin rope" because the dimension also depended on the nominal load capacity of the elevator. The deletion of the feature "rope of circular cross-section", introduced in claim 1 of the main request filed together with the appeal grounds, was made so as to produce a clearer formulation of the claim, and was anyway redundant since a "substantially round rope" had been defined.

No objection had been raised against the addition of the features of granted claim 3. In combination with the newly introduced features, claim 1 was clear and met the requirements of Articles 84 and 123(2) EPC.

- VII. The respondents argued that the introduction of the feature taken from the description and relating to "thin, substantially round (hoisting ropes)" contravened the requirements of clarity and original disclosure in Articles 84 and 123(2) EPC respectively. The term "thin" was unclear because, according to varying embodiments, it was related to different values such as 3 to 5 mm or 5 to 8 mm, and depended on a specific nominal load of the elevator which was not included in the claim. The newly filed claim 1 was based on former auxiliary request IV which included the term "rope of circular cross-section". This feature was deleted and replaced by

"substantially round rope". A round rope was not identical with a rope of circular cross-section, because "round" was much broader in its meaning than "circular". Thus the claim contained new subject-matter of high complexity.

Moreover, since the late filed request did not overcome the deficiencies objected to and was not clearly allowable, it should not be admitted into the proceedings in accordance with Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA).

Reasons for the Decision

1. The patent proprietor's appeal is admissible.
2. *Main Request (Articles 84 EPC 1973, 123(2) EPC, Article 13(1) RPBA)*
 - 2.1 According to Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the Board's discretion. The discretion has to be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.
 - 2.2 This discretion is usually exercised by the Boards of Appeal, according to the established case law, in the manner that an amendment to a party's case, by means of a request which is filed after the period specified is only admitted into the proceedings if it is *prima facie* allowable in the sense that it at least overcomes all previous deficiencies and does not give rise to new objections.

2.3 The appellant's request was filed during the oral proceedings before the Board, i.e. at a very late stage of the proceedings. This request also gives rise to new problems such that it is not *prima facie* clearly allowable.

2.4 One amendment to claim 1 reading "thin, substantially round hoisting ropes" has been taken from the description (application page 4, lines 12 to 13) and has no corresponding disclosure in an originally filed or granted claim. The term "thin" used in the claim itself is not a clear term but a relative one. No clear relationship exists concerning what might be "thicker" or "thinner" in the context of the claim.

The appellant argued the skilled person would clearly understand what was meant since the ropes were described as thinner than those "used before" (see the PCT publication of the application, page 22, lines 10 to 11). However the Board finds this argument unconvincing since not only is no such relationship to prior art ropes defined in the claim, but there is anyway no clear indication as to which dimensions the prior art ropes would have had.

2.5 In the general description (page 5, lines 17 to 20) some dimensions for these ropes are mentioned: "E.g. in elevators for a nominal load below 1000 kg and a speed below 2 m/s, the thin and strong steel wire ropes of the invention have a diameter of the order of only 3-5 mm". In the description of a particular embodiment (page 22, lines 12 to 17) a rope diameter of about 4 mm is mentioned. Further on in the same paragraph, when a 2:1 suspension ratio is used, the thin and strong steel ropes of the invention preferably have a diameter of

about 2,5-5 mm in elevators for a nominal load below 1000 kg, and preferably about 5-8 mm in elevators for a nominal load above 1000 kg. These diameters are however disclosed in specific relation to nominal loads which are not present in the claim. Moreover, the ranges of rope diameters are not coherent since 3-5 mm and 2.5-5 mm are different ranges yet both are quoted for the same nominal load, and the ranges "about 2.5-5 mm" and "about 5 - 8 mm" are different ranges yet overlapping to a certain extent due to the word "about", without any specific information being given as to what rope diameters should be used.

All these examples demonstrate that the term "thin" is not sufficiently clear for defining what rope diameters are to be understood thereby.

- 2.6 At least for these reasons the amendment made to claim 1 contravenes Article 84 EPC 1973, with the consequence that the request is at least *prima facie* not clearly allowable. Therefore the Board exercised its discretion not to admit this request into proceedings (Article 13(1) RPBA).

3. The appellant's sole request not being admitted into proceedings, the decision by the opposition division to revoke the patent must be confirmed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated