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**Datasheet for the decision
of 3 May 2013**

Case Number: T 1300/10 - 3.2.06

Application Number: 03722650.3

Publication Number: 1511683

IPC: B66B11/00, B66B7/06

Language of the proceedings: EN

Title of invention:

ELEVATOR

Patent Proprietor:

Kone Corporation

Opponents:

Otis Elevator Company
INVENTIO AG

Relevant legal provisions:

EPC 1973 Art. 84
EPC Art. 123(2)
RPBA Art. 13(1)

Keyword:

Requests admitted into the proceedings (main, first and second auxiliary requests) - no



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Case Number: T 1300/10 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 3 May 2013

Appellant:
(Patent Proprietor)

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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. 1511683 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. 1 511 683, with 18 claims, on the basis of European patent application No. 03722650.3 filed on 8 May 2003, and claiming a Finnish priority of 7 June 2002, was published 18 July 2007.
- II. Two 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 engages a set of hoisting ropes (3) via a traction sheave (7), 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 there is diverting pulleys (9) of which some is made larger than traction sheave(7), and the weight of said hoisting machine being at most about 1/5 of the weight of the nominal load of the elevator."

With its decision posted on 18 May 2010, the opposition division revoked the patent, holding 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 23 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 pursued its request for maintenance of the patent as granted and filed auxiliary requests I to X. Appellant II requested that the part of the decision relating to the ground for opposition according to Article 100(a) be overturned and that the ground for opposition under Article 100(b) EPC be reconsidered. On 6 October 2011, appellant II requested refund of the appeal fee in case that its appeal were deemed inadmissible.

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

- 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 that of appellant II appeared to be inadmissible since it was not adversely affected. The Board however expressed doubt as to whether the amendments made to claim 1 of all requests met the requirement of Articles 123(2), 123(3) or 84 EPC, respectively, and that in respect of an apparent lack of a valid claim to priority, the subject-matter of claim 1 according to each of the auxiliary requests I to XXI appeared to lack novelty. The Board further stated that discussion of inventive step would depend on an admissible request being on file.
- V. Oral proceedings were held on 3 May 2013, during which appellant I filed a new main request (based on auxiliary request XI), a new first auxiliary request (based on auxiliary request XIII), and changed the order in which

the former main request (patent as granted) should be considered, so that it became the second auxiliary 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 3 May 2013 or on the basis of auxiliary request XIII of 3 May 2013 or as granted.

Appellant II (opponent 01) withdrew its appeal and its request for refund of the appeal fee. Together with the other respondent (opponent 02), it requested that the appeal of appellant I be dismissed.

Claim 1 according to the main request reads as follows (amendments with respect to granted claim 1 underlined or ~~deleted~~)

"Elevator, preferably an elevator without machine room, in which elevator a hoisting machine engages a set of hoisting ropes (3) via a traction sheave (7), 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 counterweight and an elevator car are carried by the elevator guide rails, and in which elevator there are ~~is~~ diverting pulleys (9) at least ~~of which~~ some of them ~~is~~ made larger than the traction sheave(7), and the weight of said hoisting machine being at most about 1/5 of the weight of the nominal load of the elevator."

In claim 1 of the first auxiliary request the passage "... diverting pulleys (9) at least ~~of which~~ some of them ~~is~~ made larger ..." has been changed to:

"... diverting pulleys (9) of which some are made larger ..."

and the following text has been added:

"... and in which elevator multiple rope passages are used between the upper part of the elevator shaft and the counterweight or elevator car."

Claim 1 of auxiliary request 2 is the same as claim 1 as granted.

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

The newly filed requests should be admitted into the proceedings. The amendments to claim 1 had been made in response to objections which arose during the oral proceedings. It was evident to the skilled person that the feature "in which elevator the hoisting ropes support a counterweight and an elevator car moving on their tracks" included in the former version of the claim were clearly indicated by the newly introduced feature "in which elevator the counterweight and an elevator car are carried by the elevator guide rails" because the guide rails had the function of tracks. The term "weight" disclosed in connection with "counterweight and elevator car" had been omitted due to its redundancy, since the hoisting ropes were part of the system and clearly carried the cabin itself and the counterweight or at least part of their weight. No lack of clarity resulted, nor was there a contravention of Article 123(2) because Figure 2 disclosed these features, as did page 5, lines 12 to 14 of the application as originally filed; from page 3, lines 23 and 24, it was furthermore clear that not every feature had to be included, since this stated that "one or more"

advantages could be achieved by the invention, not all advantages at once.

The right to priority should be acknowledged because when considering the requirement of "the same invention" not only claim 1 should be considered, but the invention disclosed as a whole. For example, Fig. 2 in both the priority document and the patent was the same, and this Figure showed the essential elements which were now claimed.

It was also evident to the skilled person that the hoisting ropes in any case had to be suspended in the upper part of the elevator shaft so as to be able to carry the counterweight and the elevator car during their movement. In respect of the first auxiliary request, it was clear to a skilled person where the "upper part" was because a skilled person knew where to fix the ropes. It was therefore also clear which part was therefore "between" this upper part and the car or counterweight. Thus no lack of clarity resulted in the meaning of Article 84 EPC. The basis for the amendment was clearly disclosed, when the application as originally filed was considered by a skilled person. Whether the invention could be applied to an elevator without a machine room, was an optional embodiment of the invention, and did not contradict the subject-matter claimed.

By the reintroduction of claim 1 as granted as the second auxiliary request, the right to priority was re-established, and features regarded as being redundant in the mind of the skilled person with respect to the preceding requests had been removed. The request was thus convergent with respect to the previous requests,

at least in regard to overcoming any perceived objection with lack of a valid claim to priority.

VII. The respondents argued that the feature taken from the description (page 5, lines 12 to 14) "in which elevator the counterweight and an elevator car are carried by the elevator guide rails" had been isolated from the disclosed context in an inadmissible manner since, for example, the "weight" of the elevator car and counterweight had been omitted. It was unclear what was carried by the guide rails and how that should be performed. In any case, the claim to priority was lost because the feature of claim 1 of the priority document "in which elevator the hoisting ropes support a counterweight and an elevator car moving on their tracks" had been removed. A "guide rail" was different from a "track", with the consequence that Article 123(2) EPC was contravened.

The feature concerning "larger diverting pulleys" was not part of the content of the priority document. Additionally, this feature had anyway been isolated out of the specific context in which it was disclosed in the application as originally filed. As a consequence, the right to priority was lost and a further violation of Article 123(2) EPC had occurred.

With respect to the first auxiliary request, in an elevator with machine room there was no identifiable "upper part of the elevator shaft" such that this feature lacked clarity.

The second auxiliary request as a new auxiliary request was not convergent with respect to the preceding requests and gave rise to new problems at a very late stage of the proceedings.

Since none of the late filed requests overcame the deficiencies of the previous requests, none of the requests was clearly allowable. Consequently they 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. *New Requests (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 overcomes all previous deficiencies, does not give rise to new objections and is *prima facie* clearly allowable.
 - 2.3 The appellant's requests were filed during the oral proceedings before the Board, i.e. at a very late stage of the proceedings.

For the reasons given below, none of the requests was admitted into the proceedings.

3. *Main Request*

3.1 The former feature from granted claim 1 "the hoisting ropes support a counterweight and an elevator car moving on their tracks" was replaced by the feature "in which elevator the counterweight and an elevator car are carried by the elevator guide rails". The original disclosure of the newly introduced feature (page 5, lines 12 to 14) reads:

"All or at least part of the weight of the elevator car and counterweight can be carried by the elevator guide rails."

3.2 The omission of the "weight" of the elevator car and counterweight from the foregoing expression leads to a lack of clarity (Article 84 EPC 1973) as well as to a contravention of Article 123(2) EPC. It is first not clear, in which manner the weight of the elevator car and counterweight is supported by the hoisting ropes defined earlier in the claim. Although a set of hoisting ropes engaged by a traction sheave is mentioned in line 2 of the claim, any information in respect of suspension of, or support for, the elevator car and counterweight is lacking in regards to how these elements are then carried by the elevator guide rails. No information is given or can be derived by the skilled person concerning any relation between "guide rails" and "hoisting ropes" in this respect. Furthermore, since the "weight" (of the elevator car and counterweight) has been omitted, the newly introduced feature is isolated out of the context of its disclosure resulting in an inadmissible intermediate generalisation of the content of the

application as originally filed, contrary to Article 123(2) EPC.

- 3.3 The appellant had argued that clarity was present because it was clear to a skilled person that hoisting ropes would carry some of the weight and the elevator guide rails would carry the rest, so there was no need to define this more closely. However, this argument is not convincing since the claim does not define that each carries part of the weight in some way, but merely that the car and counterweight are "carried by" the elevator guide rails, without any further indication of what should be carried and how. Indeed the appellant's own argument that the guide rails were the same as "tracks" would itself imply that no weight need be carried. It thus remain unclear what is to be interpreted by "carried by" and thus what structural limitations this might or might not imply for the guide rails.

In terms of Article 123(2) EPC, the appellant argued that page 5, lines 12 to 14 provided sufficient basis for the disclosure of the defined feature and that not every feature had to be defined, particularly where it was redundant, which was allegedly the case with the term "weight" which had been excluded. Again, the Board cannot agree. As explained already above, it is not clear what "carried by" implies structurally in the context of claim 1, so it cannot be implicit that the omission of the term "weight" is redundant and therefore can be omitted. Although the appellant also cited page 3, lines 23 and 24 as an indication that not all features needed to be included, the broad statement "By applying the invention, one or more of the following advantages, among others, can be achieved:", does not provide any direct and unambiguous disclosure that, for example, the term "weight" can be omitted from the

expression used on page 5, lines 12 to 14. It may also be added in regard to page 3 lines 23 and 24 that this is also entirely unspecific as to which features may in fact be responsible for any of the alleged "advantages".

4. *First auxiliary request*

The same deficiencies as those in respect to claim 1 of the main request are present in claim 1 of the first auxiliary request. The additional features added at the end of the claim have no influence on the foregoing reasoning, nor did the appellant argue that they did. In addition, a further lack of clarity arises with regard to the terminology "the upper part of the elevator shaft". Such an upper part is not previously defined in the claim nor can it be determined from the patent specification exactly which part is meant (not least in the case of elevators which have a machine room), and no structural relationship is defined as to how the multiple rope passages are "used" between the upper part of an elevator shaft and the counterweight or elevator car.

5. *Second auxiliary request*

The introduction of claim 1 as granted as an auxiliary request during the oral proceedings before the Board has to be regarded as an amendment to the party's case at a very late stage of the proceedings. Since the restricting features made as amendments to each claim 1 of the preceding requests have been removed, the request is not convergent with respect to those requests and causes a new, complex situation because the case is changed entirely and many issues are fully open again. All considerations made in respect of the main and first auxiliary request would in fact be in vain. Further,

previously discussed issues of the right to priority would need to be reopened. Furthermore, the patent was revoked in opposition before the department of first instance where maintenance of the patent on the basis of granted claim 1 had been requested. Therefore the identical request is also not immediately allowable.

6. For at least these reasons none of the requests is at least *prima facie* clearly allowable, so the Board exercised its discretion under Article 13(1) RPBA not to admit any of them into the proceedings.

Since no request for maintenance of the patent filed by the appellant has been admitted into the 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