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**Datasheet for the decision
of 7 November 2014**

Case Number: T 0207/12 - 3.2.01

Application Number: 05016411.0

Publication Number: 1621422

IPC: B60R25/02

Language of the proceedings: EN

Title of invention:

Steering lock

Patent Proprietor:

KABUSHIKI KAISHA TOKAI RIKAI DENKI SEISAKUSHO

Opponent:

Ehlers, Jochen

Headword:

Relevant legal provisions:

EPC 1973 Art. 54
RPBA Art. 13(1), 13(3)

Keyword:

Main request - novelty (no)
Late-filed auxiliary requests - admitted (no)
Interruption of the oral proceedings to have the opportunity
to file a further auxiliary request (denied)

Decisions cited:

T 0681/01, T 0881/01, T 0299/09

Catchword:



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Chambres de recours**

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Case Number: T 0207/12 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 7 November 2014

Appellant: Ehlers, Jochen
(Opponent) Johannes-Brahms-Platz 1
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Representative: Eisenführ Speiser
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Respondent: KABUSHIKI KAISHA TOKAI RIKAI DENKI SEISAKUSHO
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Representative: Isarpatent
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 6 December 2011
rejecting the opposition filed against European
patent No. 1621422 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: Y. Lemblé
D. T. Keeling

Summary of Facts and Submissions

I.

II. The appeal is directed against the decision of the Opposition Division to reject the opposition against European patent No. 1 621 422.

III. The patent was opposed under Art. 100 (a) EPC 1973. In its decision the opposition division held that the subject-matter of the patent as granted met the requirements of novelty and inventive step having regard to, *inter alia*, the following prior art document:

E3: EP-A-1 029 754.

IV. In the oral proceedings held on 7 November 2014 the Appellant requested that the decision under appeal be set aside and the patent be revoked.
The Respondent (Patent Proprietor) requested that the appeal be dismissed (main request), or in the alternative, that the decision under appeal be set aside and the patent maintained in amended form on the basis of one of Auxiliary Requests 1 to 8 filed with letter of 23 October 2014. Towards the end of the oral proceedings and after the Board announced the result of its deliberation on the main and the auxiliary requests, the Respondent requested the opportunity to file a further auxiliary request to overcome the objection of lack of novelty over E3.

V. Claim 1 of the main request reads as follows (delimitation of features as proposed by the Opposition Division):

- 1a) A steering lock for selectively disabling steering by engaging a steering shaft (2) of a vehicle, the steering lock (1) comprising:
- 1b) a lock bar (61) for disabling rotation of the steering shaft (2) when engaged with the steering shaft (2),
- 1c) a drive source (31) for driving the lock bar (61), the drive source (31) including an input terminal;
- 1d) a circuit board (113) including an electric circuit for controlling the drive source (31), and
- 1e) a case (110) for accommodating the circuit board (113),
the steering lock being characterized by:
- 1f) a first terminal (116) formed integrally with the case (110) and electrically connected to the input terminal of the drive source (31) without via an additional connecting component.

VI. The Appellant's submissions may be summarised as follows:

The Opposition Division made an incorrect interpretation of feature 1f) of claim 1 when it decided that this feature was not known from prior art document E3. For obvious technical reasons (short circuit) the term "formed integrally with the case" could not mean that the terminal was made of the same material as the case. The interpretation made by the Opposition Division that the first terminal was directly fixed in the material of the casing (see page 9, third paragraph of the decision under appeal) was not a fair interpretation, since it was too narrow. Within the technical context of the claimed steering lock, the term "formed integrally with the case" should be interpreted as meaning that the first terminal and the case were fixedly connected such a to form one

piece. With this interpretation, the subject-matter of claim 1 was not novel over the steering lock of prior art document E3.

The auxiliary requests 1 to 8, filed shortly before the date of the oral proceedings, should be rejected as belated. In view of the modifications made in these requests and the fact that they contained features coming from the description, it was not possible to properly prepare a reply or to finalise any search for additional prior art relating to these eight auxiliary requests. Moreover, the Respondent had not given any indication as to why the objections presented in respect of the previous requests should now be overcome.

VII. The counter-arguments of the Respondent may be summarized as follows:

Document E3 did not disclose feature 1f) that the first terminal 18 was formed integrally with the case. Even if the contacts 18 were embedded in a potting compound (see paragraph [0026] of E3), the potting compound was anyway not part of the case. Hence, the embodiments shown and described in E3 would not disclose feature 1f), as the connectors were not integrally formed with the case of the circuit board, but either with the circuit board 16 itself or with the potting compound. Moreover, feature 1c) was not disclosed in E3, because the contacts 19 were not input terminals included in the drive source (motor 6), the electric lines 20 shown in Fig. 1 of E3 being an additional connecting component to the input terminal of the motor 6.

The auxiliary requests 1 to 8 should be admitted into the proceedings. Especially the auxiliary requests 1 to

5 were already filed in opposition proceedings so that the arguments of the Appellant that it was taken by surprise and was not able to prepare a reply, were not justified.

The request to have the opportunity to file a further request was justified. A patent proprietor should be free to amend its case until all possibilities to defend its patent were exhausted. In view of the numerous pieces of prior art invoked by the Appellant against the present patent, it was not efficient to prepare a request which could take into account all these attacks.

Reasons for the Decision

1. The appeal is admissible.
2. Novelty over document E3
 - 2.1 The Opposition Division considered in its decision that most of the features of claim 1 were known from document E3 and that the sole distinguishing feature was that the first terminal is formed integrally with the case (see point 2.3.1 of the decision of the Opposition Division).
 - 2.2 In the reply to the appeal, the Respondent denied that E3 disclosed feature 1c). In the annex to the summons to oral proceedings, the Board wrote the following preliminary opinion: "Concerning document E3, the Board shares the opinion of the Opposition Division that feature 1c) is disclosed in E3. In Fig. 1 of E3, the entity defined by the "first housing 5", with the exception of the movably driven lock bar 8 projecting

therethrough, seems to be covered by the broad term "drive source". Moreover, the electrical connection to this drive source (contact having the reference numeral 19) can be considered as an "input terminal" included in this drive source. The discussion will therefore mainly concentrate on the question whether feature 1f) is known from E3". Following this preliminary opinion of the Board, the Respondent did not argue any more that feature 1c) was not known from document E3. Thus, the Board sees no reason to deviate from its preliminary opinion.

The question which remains to examine is therefore whether the first terminal 18 of Figure 1 of E3 is formed integrally with the case 17 or not (see feature 1f) of claim 1).

- 2.3 In respect of the first terminal, different interpretations of the expression "formed integrally with the case" were in dispute.
- 2.3.1 For obvious technical reasons, "formed integrally with the case" cannot mean that the terminal was made of the same material as the case because this would lead the skilled person to conclude that there would be an electrical short circuit between the first terminal 116 and the casing if they were made of metal, or that the terminal would not conduct electrical current if it was made of a resin. This interpretation is also technically wrong because claim 3 requires as well "a second terminal formed integrally with the case". This would lead to an electrical short circuit between the first 116 and the second 117 terminals and render useless the circuit board which controls the drive source. This interpretation must therefore be excluded.

2.3.2 Relying on paragraph [0025] of the patent specification which indicates that the first terminal 116 is insert-molded in the case, the Respondent argued that "formed integrally with the case" meant that the first terminal is directly fixed in the material of the case. The Board cannot agree with this point of view.

It is established case law of the Boards of Appeal of the EPO that an example cited in the description cannot be used to read into the wording of a claim a particular meaning and to then rely on this feature to provide a distinction over the prior art (see T 881/01, T 681/01, T 299/09). For the Board, the disputed wording should be taken as it is in the claim for defining the protection to be sought and objectively assessed in the context of the invention, i.e. of providing a steering lock which is easy to assemble (see paragraph [0009] of the patent specification). It is not justified to interpret the expression "formed integrally with the case" as narrowly as contended by the Respondent. Therefore, the Board agrees with the Appellant that the expression simply means: "formed as one single piece with the case".

On a reading of E3 (see paragraphs [0020] and [0026] of E3), the contact 18 (which is the "first terminal electrically connected to the input terminal of the drive source" within the meaning of the claim) is formed integrally with the case 17 which encloses the circuit board 16 since it is "fixed completely in the case 17 by means of an insulating potting compound so that only the electrical contacts project on the side facing toward the locking device"; i.e. the electrical contacts form a single piece with the case.

Hence, the Board concludes that claim 1 lacks novelty over the content of E3 (Article 54 EPC).

3. Admissibility of the auxiliary requests 1 to 8

The auxiliary requests 1 to 8 were filed by the Respondent with letter dated 23 October 2014, i.e. 15 days before oral proceedings, without any substantiation as regards novelty and inventive step of the claimed subject-matter, the main issues of this appeal.

As conceded by the Respondent itself, claim 1 of the multiple late-filed auxiliary requests 1 to 8 is amended by adding features from the description and therefore relates to specific steering lock arrangements which were not claimed previously. Where such late requests take up subject-matter only available from the description, it cannot automatically be assumed that they are covered by the initial search and it is practically impossible for the Appellant/Opponent to perform a specific search. Moreover, in the Board's view, the Appellant could not have anticipated that these auxiliary requests would be filed. Thus, the admission of a claim including new features from the description at such a late stage of the appeal proceedings would call into question the procedural fairness towards the Appellant. It would also raise issues which the Board or the Appellant could not reasonably be expected to deal with without adjournment of the oral proceedings. Thus, the Board exercised its discretion not to admit these auxiliary requests into the proceedings (Article 13 (3) of the Rules of Procedure of the Boards of Appeal (RPBA)).

As regards the argument that the auxiliary requests 1 to 5 were already filed in opposition proceedings, Article 12 (2) RPBA clearly states that the statements

of grounds of appeal or the reply shall contain a party's complete case. The former auxiliary requests 1 to 5 filed in opposition proceedings were not filed in the reply to the statement of grounds of appeal and are thus to be considered as newly filed with letter of 23 October 2014 and thus as late-filed in the appeal proceedings. Filing such new requests just before oral proceedings is contrary to the principle that both sides should set out their complete case at the outset of the proceedings and to the equal distribution of rights and obligations upon both sides in inter-partes proceedings. Both principles are clearly established by the Rules of Procedure of the Boards of Appeal (see Article 12 RPBA).

Moreover, such late requests are contrary to procedural economy and, taking account of the state of the proceedings, cannot be reasonably dealt with by the Board and the other party without adjournment of the proceedings or remittal to the department of first instance, contrary to Article 13(1) and 13(3) RPBA.

4. Request to have the opportunity to further amend the claims

It is only after deliberation of the Board and the announcement of the assessment of the Board in respect of all the available requests that the Respondent requested the opportunity to further amend the claims. In the Board's view, a patent proprietor should not be allowed to wait for the result of the deliberation of the Board before reacting to an objection which was an issue from the beginning of the appeal proceedings. Should the Respondent be allowed to file a further request and to substantiate it despite the absence of any valid reason for its lateness and in clear

contradiction with the relevant obligations established by the Rules of Procedure (see Article 12(2) RPBA), this would encourage patent proprietors in the future to simply delay their reaction to the grounds of appeal until the latest possible stage in the proceedings, contrary to the principles of efficient proceedings and, more importantly, of equal treatment of the parties in *inter partes* proceedings. In such a situation, the Board implicitly loses its neutrality, since the oral proceedings could in fact be misused to explore what, under the Board's view, could be seen as patentable. Hence, the Board decided, in the exercise of its discretion under Article 13(1) RPBA, to deny the Respondent the opportunity to file a further auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated