Internal distribution code:

(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

Datasheet for the decision of 10 February 2015

Case Number: T 0310/13 - 3.2.08

Application Number: 00109571.0

Publication Number: 1052421

IPC: F16D25/10

Language of the proceedings: EN

Title of invention:
Multiple clutch system for a transmission

Patent Proprietor:
BorgWarner, Inc.

Opponent:
ZF Friedrichshafen AG

Headword:

Relevant legal provisions:
EPC Art. 100(c), 123(2), 123(3)

Keyword:
Amendments - inescapable trap (no)

Decisions cited:

Catchword:

Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0310/13 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 10 February 2015

Appellant: (Patent Proprietor)	BorgWarner, Inc. Powertrain Technical Center 3800 Automation Drive Suite 100 Auburn Hills MI 48326-1782 (US)
Representative:	Neunert, Peter Andreas Patentanwälte Westphal, Mussgnug & Partner Am Riettor 5 78048 Villingen-Schwenningen (DE)
Respondent: (Opponent)	ZF Friedrichshafen AG Graf-von-Soden-Platz 1 88046 Friedrichshafen (DE)
Representative:	Jordan, Volker Otto Wilhelm Weickmann & Weickmann Patentanwälte Postfach 860 820 81635 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 11 December 2012 revoking European patent No. 1052421 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	I. Beckedorf
Members:	C. Herberhold
	M. Alvazzi Delfrate

Summary of Facts and Submissions

I. By its decision posted on 11 December 2012 the Opposition Division revoked European patent EP-B 1052421, on the grounds of Articles 100(c), 123(2) and (3) EPC.

II. The appellant (patent proprietor) lodged an appeal against that decision in the prescribed form and within the prescribed time limit.

III. Oral proceedings before the Board of Appeal were held on 10 February 2015. For the course taken by the proceedings, in particular the issues discussed with the parties and the parties' requests, reference is made to the minutes of the oral proceedings.

At the end of the oral proceedings the requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, alternatively, that the patent be maintained in amended form on the basis of auxiliary request 2, filed with letter dated 11 April 2013 or, as a further alternative, that the questions filed with letter of 9 January 2015 be referred to the Enlarged Board of Appeal.

The respondent (opponent) requested that the appeal be dismissed and, implicitly, that no questions be referred to the Enlarged Board of Appeal.

IV. Claim 1 of the main request reads as follows (emphasis by the Board):

"Multiple Clutch System for a Transmission;
• with two multi-disk clutches (4,5) that are coaxial with each other; wherein each clutch (4,5) is assigned to one of two shafts (8, 9), of which the one (8) is a hollow shaft and encloses the other (9); wherein
• one (4) of the two clutches (4,5) is connected with the hollow shaft (8), and the other (5) with the inner shaft (9);
characterized in that
• **a torsional oscillation damper (3) having two centrifugal masses (3.1, 3.2) is connected to the two clutches (4, 5) which on their part can rotate circumferentially against each other**, whereas
• one (3.2) of the two centrifugal masses (3.1, 3.2) is connected to the bell (5.3) of one (5) of the two clutches (4,5) so that it is torsionally fixed, and wherein
• not only the torsional oscillation damper (3), but also the two clutches (4,5) are arranged in a common sealed chamber (1.2), which contains lubrication oil."

V. Claim 1 of auxiliary request 2 has been amended to define that both the two centrifugal masses and the two clutches can rotate circumferentially against each other. The feature now reads:

"a torsional oscillation damper (3) having two centrifugal masses (3.1, 3.2) which on their part can rotate circumferentially against each other is connected to the two clutches (4, 5)which on their part can rotate circumferentially against each other,..."

VI. The following document played a role in the proceedings:

D15: DE-A-44 15 664.

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

Main request

Even if - taking a formal grammatical approach - the word "which" might appear to relate to the term "two clutches", such an interpretation was immediately ruled out as illogical by the person skilled in the art in view of the further features defined in the claim. In particular, the torsional oscillation damper was defined as connected to the two clutches, such that a rotation of the clutches against each other did not make any technical sense. Indeed, the person skilled in the art would immediately realise that the word "which" had to refer to the "two centrifugal masses", an interpretation which - according to the appellant - was grammatically equally conceivable. Thus, even if a formal ambiguity existed, it would be immediately resolved by the technical understanding of the person skilled in the art, resulting in a claimed subject-matter in accordance with the original disclosure.

Auxiliary request 2

With respect to claim 1 as granted, claim 1 of auxiliary request 2 had been amended to further define centrifugal masses "which on their part can rotate circumferentially against each other". Basis for this feature was in claim 1 as originally filed, the

amendment further narrowing the scope of claim 1 as granted and thus being in accordance with Article 123(3) EPC. Regarding the feature defining the two clutches as on their part being able to rotate circumferentially against each other, the skilled person would – in accordance with the teaching in the description and taking also into account that the claim defined the torsional oscillation damper as being connected to the two clutches – inevitably interpret said feature as relating to nothing more than a trivial property of any multiple clutches system, i.e. that the inner disks and hubs on the torque exit side of the different clutches could rotate circumferentially against each other. This was not only an intrinsic feature of any multiple clutch system but also clearly disclosed in the application as filed. Consequently, claim 1 of auxiliary request 2 was in accordance with Article 123(2) EPC.

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

Main request

In view of the rules of English grammar, it was clear that the word "which" referred to the term "two clutches" immediately before. The feature so defined made technical sense, such that there was no lack of clarity giving rise to any need for interpretation. In fact, document D15 disclosed a multiple clutch system according to the preamble of claim 1 comprising two clutches which could rotate circumferentially against each other. Therefore, the definition in claim 1 had to be seen as a clear technical teaching. The grammatical construction of the claim resulted - with respect to claim 1 as originally filed - not only in the addition

of a feature further defining the two clutches, but also in the omission of an essential feature defining the torsional oscillation damper. Neither for the addition nor for the omission of the original features was there a basis in the application as originally filed.
Even if there was any ambiguity as to the term actually referred to by the word "which", it was established case law that both alternatives had to fulfil the requirements of Article 123(2), which was not the case here as pointed out above.
Thus, Article 100(c) EPC prejudiced the maintenance of the patent as granted.

Auxiliary request 2

Even though the amendment by omission had been overcome by reintroducing the respective definition of the torsional oscillation damper, claim 1 of auxiliary request 2 had still been amended by defining the two clutches as being able to rotate circumferentially against each other.

Said feature could not be seen as an intrinsic trivial property of the multiple clutch system. The definition was placed in the characterising portion of the claim, thus emphasising its technical contribution over the prior art. The skilled person would thus derive that it was in fact the clutches in their entirety which were able to rotate circumferentially against each other. As evidenced by D15, this was to be seen as a meaningful technical feature, for which, however, there was no basis in the application as filed. Consequently, the opposition ground under Article 100 (c) prejudiced the maintenance of the patent as granted.

Reasons for the Decision

1. The appeal is admissible.

2. Background

In the claims as originally filed the torsional oscillation damper was defined using two separate sentences:

"A torsional oscillation damper (3) is connected to the two clutches (4, 5). It has two centrifugal masses (3.1, 3.2), which on their part can rotate circumferentially against each other."

During examination proceedings, the appellant reformulated the feature into a single sentence:

"A torsional oscillation damper (3) having two centrifugal masses (3.1, 3.2) is connected to the two clutches (4, 5) which on their part can rotate circumferentially against each other,..."

As a consequence, the word "which", that in the original version was positioned directly behind the term "two centrifugal masses", in claim 1 as granted is positioned directly behind the term "two clutches".

3. Main request, Article 100(c) EPC:

The Board is convinced that - applying the normal rules of English grammar - the word "which" has to be construed as referring to the term "clutches" immediately before. Therefore, with respect to claim 1

as originally filed, the ability to rotate circumferentially against each other, in claim 1 as granted, has been assigned to the two clutches instead of to the torsional oscillation damper masses.

Thus, with respect to the torsional oscillation damper masses a characteristic has been omitted, whereas with respect to the two clutches a new characteristic has been added. Both changes have raised concerns on the respondent's part in view of the requirements of Article 123(2) EPC.

Whereas with respect to the amendment by addition an interpretation of the claim feature is necessary (see point 4 below), the Board sees no way to interpret a non-existing claim feature such that it has to be considered as included in the subject-matter of the claim. As a result, the ability of the two centrifugal masses to rotate circumferentially against each other has been omitted from the subject-matter of claim 1 as originally filed. Said feature is however essential for the functioning of the torsional oscillation damper, as it is the ability of the two centrifugal masses to rotate against each other which allows the centrifugal masses to exercise their torsional oscillation damping function. The omission of this functionally essential feature from the subject-matter of claim 1 as originally filed results in an amendment of the claimed subject-matter beyond the content of the application as filed.

The opposition ground according to Articles 100(c) EPC thus prejudices the maintenance of the patent as granted.

4. Auxiliary request 2, Article 100(c), 123(2), 123(3) EPC

Claim 1 of auxiliary request 2 comprises all the features of claim 1 as granted. In view of the amended additional feature according to which the centrifugal masses on their part can rotate circumferentially against each other, the protection conferred is narrowed, the requirements of Article 123(3) EPC thus being fulfilled. Furthermore, said added feature finds a basis in claim 1 as originally filed (see point 2 above), the requirements of Article 123(2) EPC thus being equally satisfied in view of the amended definition of the centrifugal masses.

It thus remains to be judged whether defining the two clutches as on their part being able to rotate circumferentially against each other has to be considered an unallowable amendment.

In this respect, both the opposition division and the respondent were of the opinion that the feature required the two clutches to be able to rotate circumferentially against each other in their entirety.

However, such an interpretation is in contradiction with the existence of a torsional oscillation damper **connected** to **both** clutches. Because such an oscillation damper is meant to reduce vibrations from the engine drive shaft, it is placed between both clutches and the drive shaft, thereby excluding free rotation of the clutches in their entirety. The person skilled in the art would thus - at least for this reason - refer to the description and the drawings in order to interpret the feature in question. However, neither the description nor the drawings support the interpretation of both clutches being able to freely rotate against

each other in their entirety. Instead, the skilled person would realise that the only rotation of the clutches circumferentially against each other is on the torque exit side of the clutches, i.e. on the part of the inner disks and hubs.

While it is true that the feature in question is positioned in the characterising portion of the claim, this does not mean that it can be interpreted without due regard of its further context.

The respondent has further argued that D15 showed a multiple clutch system having several clutches of which two were able to rotate against each other in their entirety. Said feature thus made technical sense and could not be interpreted in the above way. However, the D15 multiple clutch system does not have a torsional oscillation damper connected to said two clutches allegedly able to freely rotate against each other in their entirety (clutches 5 and 36 of D15, Figure 1, see page 9, first paragraph of the respondent's submission dated 31 July 2013). The respondent's argument that such a torsional oscillation damper connected to both said clutches could be provided remains purely speculative and without basis in the D15 disclosure. Hence, the situation in D15 is different and cannot be used to interpret a claim feature which stands in a significantly different context.

In view of the overall disclosure of the application and in the context of present claim 1, the claim feature under debate has to be interpreted in the sense that the ability of the clutches on their part to rotate circumferentially against each other defines nothing more than the ability of the structures on the torque exit side of the two clutches to rotate

circumferentially against each other. Therefore, the feature does not add anything over the other features of the claim, such that it has to be considered redundant and can effectively be ignored in the further prosecution of the case.

Following the above derived interpretation of the claim, the feature under debate cannot be considered an amendment over the disclosure as originally filed. Consequently, Article 100(c) EPC does not prejudice the maintenance of the patent as amended according to auxiliary request 2.

5. As the appellant's auxiliary request 2 is sufficient to overcome the objection on which the decision under appeal is based, there is no need to decide on the request to refer questions to the Enlarged Board of Appeal.

6. Novelty and inventive step have not yet been discussed before the opposition division. In order to give the parties the possibility to have the case treated by two instances, as already announced in the communication accompanying the summons to oral proceedings, the Board finds it appropriate to remit the case to the opposition division for further prosecution (Article 111(1) EPC), taking into account the *ratio decidendi*, see in particular the penultimate paragraph of point 4 above (Article 111(2) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division for further prosecution on the basis of auxiliary request 2, filed with letter of 11 April 2013.

The Registrar: The Chairman:

V. Commare I. Beckedorf

Decision electronically authenticated