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**Datasheet for the decision
of 3 July 2018**

Case Number: T 0976/15 - 3.2.06

Application Number: 04724394.4

Publication Number: 1731468

IPC: B66B1/30, B66B3/00

Language of the proceedings: EN

Title of invention:
CONTROL DEVICE OF ELEVATOR

Patent Proprietor:
MITSUBISHI DENKI KABUSHIKI KAISHA

Opponent:
Otis Elevator Company

Headword:

Relevant legal provisions:
EPC Art. 123(2)
EPC 1973 Art. 111(1)
RPBA Art. 13(1)

Keyword:

Amendments - added subject-matter - main request, auxiliary requests 1, 11, 15 (yes), auxiliary request 16 (no)
Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:



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Case Number: T 0976/15 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 3 July 2018

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
3 March 2015 concerning maintenance of the
European Patent No. 1731468 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
W. Ungler

Summary of Facts and Submissions

- I. An appeal was filed by the appellant (opponent) against the interlocutory decision of the opposition division in which it found that European patent No. 1 731 468 in an amended form met the requirements of the EPC.
- II. The appellant requested that the decision under appeal be set aside and the patent be revoked. The respondent (proprietor) requested that the appeal be dismissed, or that the patent be maintained according to one of auxiliary requests 1 to 7.
- III. The Board issued a summons to oral proceedings.
- IV. With letter of 29 May 2018 the appellant submitted further arguments with respect to the main request and commented on the auxiliary requests for the first time.
- V. The Board issued a communication containing its provisional opinion, in which it indicated *inter alia* that the subject-matter of claim 1 appeared not to meet the requirement of Article 123(2) EPC.
- VI. With letter of 26 June 2018 the respondent filed replacement auxiliary requests 3 to 16.
- VII. Oral proceedings were held before the Board on 3 July 2018, during which the appellant filed replacement auxiliary requests 1 and 16 and withdrew auxiliary requests 2 to 10 and 12 to 14.

The final requests of the parties were thus as follows:

The appellant requested that the decision under appeal be set aside and the European patent be revoked.

Furthermore, it requested that the case be remitted to the opposition division for further prosecution.

The respondent requested that the appeal be dismissed (main request), auxiliarily that the patent be maintained in amended form on the basis of auxiliary request 1 filed during the oral proceedings of 3 July 2018, or on the basis of one of auxiliary requests 11 and 15 filed with letter dated 26 June 2018, or on the basis of auxiliary request 16 filed during the oral proceedings of 3 July 2018.

VIII. Claim 1 of the main request reads as follows:

"An elevator control device comprising running performance table means (10) having a plurality of running performance tables preset to achieve desired running performances, running condition acquiring means (11) for acquiring the car running conditions when the car starts to running, table selecting means (12) for selecting one running performance table from the running performance table means (10) on the basis of the car running conditions, control means for causing the car to travel in accordance with a running pattern determined by the running performance table selected by the table selecting means (12), and running performance informing means (15) for informing an expected running performance, characterized in that the car running condition is one of or a combination of any of car load, running direction, next stopping floor, and temperature status of a power driving device."

Claim 1 of auxiliary request 1 reads as for claim 1 of the main request except that the words 'characterized

in that' are replaced by 'wherein' and the following features are appended to the claim:

"wherein in said plurality of running performance tables parameters classified according to running performances of a car and determining running patterns for the car are tabulated according to running conditions for the car,
and wherein said running performance informing means (15, 23, 24) are for further informing at least one of an interior of the car (6), a hall, or an elevator centralized superintending device (25), of the selected running performance table,
wherein the running performance table means is one of or a combination of maximum speed and both acceleration and deceleration, and the running pattern is the waveform of a speed target signal for the car."

Claim 1 of auxiliary request 11 reads as for claim 1 of the main request except that the words 'characterized in that' are replaced by 'wherein' and the following features are appended to the claim:

"the device further comprising running performance setting means (16, 21) installed in a car operation panel and in a hall operation panel (19, 20) to display classified running performances so that any passenger can select from the running performances to set one of the plurality of running performance tables, priority determining means (17) for giving top priority to either of the running performance tables selected by the car operation panel (19) and the hall operation panel (20), and running performance informing means (15, 23, 24) for informing the interior of the car (6), the hall, or the elevator centralized superintending device (25), of the running performance in the

preferentially selected running performance table."

Claim 1 of auxiliary request 15 reads as follows:

"An elevator control device comprising running performance table means (10) having a plurality of running performance tables in which parameters classified according to running performances of a car and determining running patterns for the car are tabulated, the plurality of running performance tables being preset to achieve desired running performances, wherein the running performance table means is one of or a combination of maximum speed and both acceleration and deceleration, running condition acquiring means (11) for acquiring the car running conditions when the car starts to running, table selecting means (12) for selecting one running performance table from the running performance table means (10) on the basis of the car running conditions, control means for causing the car to travel in accordance with a running pattern determined by the running performance table selected by the table selecting means (12), wherein the running pattern is a waveform of a speed target signal for the car or one of or a combination of the maximum speed and the acceleration and deceleration for the speed target signal, and running performance informing means (15) for informing an expected running performance, wherein the car running condition is a combination of any of car load, running direction, next stopping floor, and temperature status of a power driving device, the device further comprising running performance setting means (16, 21) installed in a car operation panel and in a hall operation panel (19, 20) to display classified running performances so that any passenger can select from the running performances to set one of the plurality of running performance tables, priority

determining means (17) for giving top priority to either of the running performance tables selected by the car operation panel (19) and the hall operation panel (20), and running performance informing means (15, 23, 24) for informing the interior of the car (6), the hall, or the elevator centralized superintending device (25), of the running performance in the preferentially selected running performance table."

Claim 1 of auxiliary request 16 reads as for claim 1 of auxiliary request 15 with the words 'according to running conditions for the car' inserted after the word 'tabulated'.

IX. The appellant's arguments relevant for the present decision may be summarised as follows:

Main request

The subject-matter of claim 1 failed to meet the requirement of Article 123(2) EPC. The selection of features out of paragraph [0010] of the application as filed for inclusion in claim 1 resulted in subject-matter which was an unallowable intermediate generalisation of the original disclosure.

Auxiliary request 1

This request should not be admitted since the subject-matter of claim 1 *prima facie* failed to meet the requirement of Article 123(2) EPC.

Auxiliary request 11

The subject-matter of claim 1 met with identical objections under Article 123(2) EPC to those raised, and found to hold, for the subject-matter of claim 1 of the main request.

Auxiliary request 15

This request should also not be admitted since the subject-matter of claim 1 *prima facie* did not meet the requirement of Article 123(2) EPC.

Auxiliary request 16

The request should not be admitted since the subject-matter of claim 1 did not meet the requirement of Article 123(2) EPC. The features added to claim 1 from col. 2, lines 20 to 25 as filed were taken from a summary of the invention which did not include the 'plurality of running performance tables being preset to achieve desired running performances', such that the adopted features from this paragraph were not directly and unambiguously combinable with the further features of claim 1 which included the 'preset' condition. Paragraph [0005] also included an automatic selection of the running performance by the control device, yet this had not been taken up into claim 1.

If this request were admitted, the case should be remitted to the opposition division for consideration of the matter of inventive step.

- X. The respondent's arguments relevant to the present decision may be summarised as follows:

Main request

The subject-matter of claim 1 met the requirement of Article 123(2) EPC. Paragraph [0010] of the application as filed disclosed each of the three features separated into its own sentence, such that not all three features would be considered by the skilled reader as 'according to the present invention'. If the intention of the drafter had been to have all three features as part of the invention these would have been separated with

semi-colons rather than with full stops. The skilled person would also understand from the disclosure as a whole (see for example col. 7, from line 49 onwards) that the car running condition dictated the running performance table to be selected, rather than the specific speed, acceleration and deceleration of the car; the three features in paragraph [0010] were thus, also from a technical point of view, not interlinked.

Auxiliary request 1

The subject-matter of claim 1, being based on claims as granted uncontested under Article 100(c) EPC, could not be objected to. Admitting an objection under Article 123(2) EPC to the present claim 1 would be tantamount to admitting a new ground for opposition. A *prima facie* examination under Article 123(2) EPC was not the appropriate standard to apply when considering the admittance of the present request. If the objection under Article 123(2) EPC were admitted, the case should be remitted to the opposition division since it had not raised an objection to this point.

Auxiliary request 11

Based on auxiliary request 7 filed in response to the grounds of appeal, the subject-matter of claim 1 found basis in claims 1 and 3 as granted, further reliance being placed on the arguments presented with regard to claim 1 of the main request.

Auxiliary request 15

The subject-matter of claim 1 found basis in claims 1, 3 and 7 as filed and should thus be admitted.

Auxiliary request 16

The subject-matter of claim 1 found basis in claims 1, 3 and 7 as filed with the addition of features taken

from col. 2, lines 20 to 25 of the description as filed.

Reasons for the Decision

1. *Main request*

1.1 *Article 123(2) EPC*

The subject-matter of claim 1 does not meet the requirement of Article 123(2) EPC.

1.1.1 The alleged basis for the subject-matter of claim 1 was given by the respondent as being a combination of claim 1 as filed with the details of the car running condition disclosed in paragraph [0010] of the application as filed. This amendment to claim 1 as filed is however not what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application as filed.

1.1.2 Paragraph [0010] of the application as filed discloses details of the car running condition, the running performance table means and the running pattern. These three features are introduced in the paragraph with the wording, 'Specifically, according to the present invention, ...', followed in the same sentence by a clause disclosing that 'the car running condition is ...', and then two sentences starting as follows: 'The running performance table means is ...' and 'The running pattern is ...'. The Board finds that the structure of the paragraph is to be understood as the three features, with all their respective details, in combination being part of the present invention, due to

the indication at the start of the paragraph, which can only unambiguously be understood as applying to the whole paragraph.

- 1.1.3 The respondent's suggestion that only semi-colons separating the sentences would allow such an interpretation is not accepted. The use of semi-colons may grammatically provide a stronger link between the features than does the use of full stops, yet the reading of paragraph [0010] as a whole is nonetheless unambiguously that the three features in combination are 'according to the present invention'.
- 1.1.4 This view is further reinforced by the paragraph immediately following paragraph [0010] which starts with the wording 'Further, the present invention reflects ...' which confirms that all that was disclosed before (i.e. all of the foregoing paragraph [0010]) was indeed to be understood as being 'according to' the present invention.
- 1.1.5 Even setting aside this linguistic interpretation of how paragraph [0010] is to be understood, the skilled person would furthermore see the three features in paragraph [0010] as being inextricably linked, thus prohibiting the isolation of just one of the features for inclusion in claim 1. This link between the features is not least confirmed by the elevator control device of claim 1 as originally filed including each one of these three features (albeit without the detail provided in paragraph [0010]), which underlines their importance in combination to the claimed device. Selecting the detail of just a single one of the three features i.e. the car running condition from paragraph [0010] for inclusion in claim 1, rather than the detail of all the three features in combination, results in

the claimed subject-matter being an unallowable intermediate generalisation of the originally filed disclosure.

1.1.6 The Board does not accept the respondent's argument that for any given running condition chosen, solely the performance table was thereby defined but not the specific speed, acceleration or deceleration. Since each performance table includes data relating to the target speed, acceleration and deceleration (see the tables in Figs. 2 and 3), the selection of a performance table directly and unavoidably includes selection of target speed, acceleration and deceleration for various car load percentages. This reinforces the understanding that the car running condition of paragraph [0010] is disclosed in combination with the detail of the running performance table means and the running pattern which themselves include speed, acceleration and deceleration data.

1.1.7 In summary, therefore, the disclosure of the 'present invention' in paragraph [0010] is directly and unambiguously a disclosure of all the features recited in the paragraph in combination. The selection of detail relating just to the car running condition and including this in claim 1 thus amounts to an unallowable intermediate generalisation of the original disclosure. The subject-matter of claim 1 thus fails to meet the requirement of Article 123(2) EPC. Consequently the main request is not allowable.

2. *Auxiliary request 1*

2.1 *Admittance*

- 2.1.1 Article 12(2) of the Rules of Procedure of the Boards of Appeal (RPBA) specifies that the statement of grounds of appeal and reply shall contain a party's complete case. After filing the grounds of appeal or reply, any amendment to a party's case may be admitted and considered at the Board's discretion, which is set out in Article 13(1) RPBA, such discretion being exercised *inter alia* in view of the need for procedural economy. As is established case law of the Boards of Appeal, such procedural economy implies that amended requests should at least be *prima facie* allowable in order to be admitted.
- 2.1.2 The respondent filed auxiliary request 1 during oral proceedings. The request thus represented a change to the respondent's complete case (as defined in Article 12(2) RPBA) and its admittance may be considered at the Board's discretion under Article 13(1) RPBA.
- 2.1.3 The basis for the subject-matter of claim 1 provided by the respondent was a combination of claims 1, 2 and 7 as granted. The ground for opposition under Article 100(c) EPC was raised against claim 1 as granted but notably not against *inter alia* claims 2 and 7. Despite no objection under Article 100(c) EPC having been raised against claim 2, at least at first sight an objection appeared justified since, as originally filed, claim 2 was an independent claim, whilst as granted it was dependent upon claim 1.
- 2.1.4 The respondent's argument that admitting an objection under Article 123(2) EPC to the present claim 1 would be tantamount to admitting a new ground for opposition is not accepted. The ground for opposition under Article 100(c) EPC was indeed already raised in the opposition procedure against claim 1 as granted. Such

an objection is also *per se* relevant to claims dependent upon claim 1, if the additional features included in the dependent claims are not suited to overcome the objection to claim 1. Such was the case with the claims 1 to 8 as granted in the opposed patent, such that the investigation, at the time of filing the opposition, of further possible objections under Article 100(c) EPC in the dependent claims is seen as unnecessary by the Board as these would already suffer from the same deficiency under Article 100(c) EPC as claim 1. It can in particular not be a requirement on an opponent, requesting revocation of a patent in its entirety, to specify every possible objection to claims of a patent, merely in order to anticipate potential but unknown auxiliary requests.

- 2.1.5 As a consequence the Board finds that, at least in the present case, raising objections under Article 123(2) EPC against claim 1 of auxiliary request 1, which is a combination of claims as granted, does not amount to admitting a new ground for opposition.
- 2.1.6 The basis for the subject-matter of claim 1 cannot *prima facie* be a combination of claims 1, 2 and 7 as filed since claim 2 as filed is an independent claim. The respondent failed to provide further arguments demonstrating a basis for the claimed subject-matter in claim 1 of this request.
- 2.1.7 The respondent's further contention that a *prima facie* examination under Article 123(2) EPC was not the appropriate standard to apply, is also not accepted. The objection under Article 100(c) EPC has been at issue since the very start of the opposition proceedings. The same objection, albeit under Article 123(2) EPC to the amended claim 1, was raised by the

appellant in its grounds of appeal, the reasons for the subject-matter of claim 1 not meeting this requirement being identified in section II thereof. Despite this, when supplying its response to the grounds of appeal, the respondent did not present an auxiliary request addressing all of the objections raised under Article 123(2) EPC despite this having been explicitly indicated. With the respondent filing the present request aimed at overcoming this objection after having filed its complete case, this request must be clearly (i.e. *prima facie*) allowable in order to be admitted (see e.g. Case Law of the Boards of Appeal, IV.E. 4.1.3).

2.1.8 From the above, it follows that a *prima facie* examination is appropriate and that indeed the subject-matter of claim 1 is not *prima facie* allowable, which would be necessary for fulfilling the need for procedural economy and consequently admitting the request into the proceedings. Accordingly, the Board exercised its discretion under Article 13(1) RPBA not to admit this request.

3. *Remittal to the opposition division*

3.1 After the Board had decided not to admit auxiliary request 1 into the proceedings, the respondent requested that the case be remitted to the opposition division on the basis of auxiliary request 1 to consider the issue of compliance with Article 123(2) EPC.

3.2 With the Board having already decided not to admit auxiliary request 1 into the proceedings, a remittal of the case to the opposition division at this juncture would not make sense, as there would be no text upon

which remittal of the case and further examination by the first instance could be based. It is noted that, even had the respondent requested remittal prior to the decision of the Board not to admit the request, the outcome would have been the same since a case such as this will usually only be remitted on the basis of claims in a request which *prima facie* satisfy at least the requirement of Article 123(2) EPC, which is not the case here, noting additionally that this was also a matter decided by the opposition division at least in regard to claim 1 as granted (under Article 100(c) EPC).

3.3 The request to remit the case to the opposition division at the present stage of the proceedings was thus refused.

4. *Auxiliary request 11*

4.1 *Article 123(2) EPC*

The subject-matter of claim 1 does not meet the requirement of Article 123(2) EPC.

4.2 As found above for the subject-matter of claim 1 of the main request, that request failed to meet the requirement of Article 123(2) EPC due to all the features of paragraph [0010] of the application as filed not being included in claim 1. With the respondent simply referring to claims 1 and 3 as granted as a basis, the Board cannot follow why claim 1 of auxiliary request 11 has addressed this problem, the same features of paragraph [0010] still being omitted from claim 1. The features which have been added to claim 1 over claim 1 of the main request also do not compensate for this omission; nor was it argued that

they did. The Board thus finds that the subject-matter of claim 1 of auxiliary request 11 fails to meet the requirement of Article 123(2) EPC for the same reasons as those given for the subject-matter of claim 1 of the main request.

4.3 Auxiliary request 11 is thus not allowable.

5. *Auxiliary request 15*

5.1 *Admittance*

5.1.1 Having been filed by the respondent after the filing of its complete case, the admittance of this request may also be considered at the Board's discretion under Article 13(1) RPBA. In order to be admitted, the request should, as also explained above, at least be *prima facie* allowable.

5.1.2 The basis for the subject-matter of claim 1 was given by the respondent in writing as claims 1, 3 and 7 as filed. However, these claims fail to disclose that the claimed device includes running performance tables 'in which parameters classified according to running performances of a car and determining running patterns for the car are tabulated'. Even if this feature were considered to be disclosed in col. 2, lines 20 to 25 of the published version of the application as filed, this passage includes a further feature that the tabulation occurs 'according to running conditions for the car'. The respondent provided no further argument at oral proceedings in defence of the basis for claim 1 of this request, the Board therefore having no argument before it in support of the omission of this 'further feature'. Thus, at least on a *prima facie* basis, the subject-matter of claim 1 does not meet the requirement

of Article 123(2) EPC.

5.1.3 Consequently the Board exercised its discretion not to admit auxiliary request 15 into the proceedings (Article 13(1) RPBA).

6. *Auxiliary request 16*

6.1 *Admittance*

6.1.1 The *prima facie* basis for the subject-matter of claim 1 is a combination of claims 1, 3 and 7 as filed with the addition of features from col. 2, lines 20 to 25 of the published version of the application as filed.

6.1.2 The appellant's argument that the word 'preset' was not disclosed in col. 2, lines 20 to 25 and that the feature adopted into claim 1 from this passage was thus not disclosed directly and unambiguously in combination with the remaining features in claim 1 is not accepted. The entire disclosure of the application as filed suggests nothing other than the running performance tables having preset data tabulated in them. This is also implicitly the case since the primary object of the invention is to enable an appropriate running performance to be selected (see paragraph [0004] of the application as filed), the running performance comprising elevator speed, acceleration and deceleration stored in various running performance tables as disclosed in Figs. 2 and 3, this data being 'preset' i.e. predetermined according to the particularly targeted running performance. There is also no indication in the application as filed as to how the target speed, acceleration or deceleration could be decided by a user should these not be 'preset', as explicitly included in claim 1. The

'preset' nature of the running performance tables is thus implicit throughout the application, including in the passage in col. 2, lines 20 to 25 from which the feature adopted into claim 1 has been extracted.

6.1.3 The appellant's further contention, that col. 2, lines 36 to 38 disclosed an automatic running performance selection and that this had not been included in claim 1 does not change the above conclusion. The automatic selection of running performance disclosed in this passage is an optional feature of the disclosure due to the wording 'This makes it possible to inform passengers of the running performance automatically selected ...' i.e. it is possible, but not mandatory for this to occur. Additionally, it may be added that the original disclosure encompasses both an automatic and a passenger selection of running performance such that a basis also exists for leaving the unspecified method for selection of running performance as claimed without the need to limit this to an automatic selection.

6.1.4 At least on a *prima facie* basis, the requirement of Article 123(2) EPC is thus met in the subject-matter of claim 1. With no further objections under Article 84 EPC 1973 being raised by the appellant against this request, the Board exercised its discretion to admit auxiliary request 16 into the proceedings (Article 13(1) RPBA).

7. *Remittal to the opposition division*

7.1 Auxiliary request 16 was filed at oral proceedings before the Board, based on a previous auxiliary request 16 which was filed for the first time just one week prior to the oral proceedings. Claim 1 of this request

is significantly different to that decided by the opposition division as meeting the requirements of the EPC and, being based on a combination of three granted claims and features extracted from the description, presents subject-matter for the discussion of inventive step which is significantly different to that of previous requests on file.

7.2 According to Article 111(1) EPC 1973, when deciding on an appeal, the Board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

7.3 In the exercise of such discretion in the present case, if the Board itself carried out the examination as to patentability, the parties would lose the opportunity of having an examination of the claimed subject-matter before two instances. Also, at present, the parties have not yet had the opportunity to develop their arguments with respect to the subject-matter of claim 1 of auxiliary request 16, in particular as regards inventive step, and indeed the respondent has as yet filed no arguments in support of the presence of an inventive step in the subject-matter of claim 1 of this request. With remittal having been requested by the appellant and this course of action not being objected to by the respondent, the Board avails itself of its power under Article 111(1) EPC 1973 to remit the case back to the department of first instance for further prosecution.

7.4 For the avoidance of doubt, it should be noted that the Board has not decided that claim 1 of auxiliary request 16 meets any requirement of the EPC, but has merely found that claim 1 of the request is not *prima facie*

open to objection under Article 123 EPC or Article 84 EPC 1973.

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.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated