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Datasheet for the decision of 10 July 2019

Case Number: T 1624/16 - 3.2.01

Application Number: 07123489.2

Publication Number: 2072363

IPC: B60T13/74, B60T17/22

Language of the proceedings: EN

Title of invention:
Method and device for controlling the intervention of the electric parking brake of a vehicle, in condition of dynamic functioning

Patent Proprietor:
IVECO S.p.A.

Opponents:
WABCO GmbH
Knorr-Bremse Systeme für Nutzfahrzeuge GmbH

Headword:

Relevant legal provisions:
EPC Art. 14(2), 54(1), 100(a), 113(1)
EPC R. 103(1)(a), 111(2)
RPBA Art. 13(1)

Keyword:

Novelty - (no)
Late-filed auxiliary requests - request clearly allowable (no)
- justification for late filing (no)
Appealed decision sufficiently reasoned - (yes)
Right to be heard - substantial procedural violation (no)
Reimbursement of appeal fee - (no)

Decisions cited:

G 0001/10, R 0019/10, R 0001/12, J 0020/85, T 0856/91, T 0446/00, T 1843/11, T 0516/12

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 1624/16 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 10 July 2019

Appellant: (Opponent 2)	Knorr-Bremse Systeme für Nutzfahrzeuge GmbH Moosacher Str. 80 80809 München (DE)
Representative:	von Bülow & Tamada Rotbuchenstraße 6 81547 München (DE)
Respondent: (Patent Proprietor)	IVECO S.p.A. Via Puglia 35 10156 Torino (IT)
Representative:	Franzolin, Luigi Studio Torta S.p.A. Via Viotti, 9 10121 Torino (IT)
Party as of right: (Opponent 1)	WABCO GmbH Am Lindener Hafen 21 30453 Hannover (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 2 May 2016 rejecting the opposition filed against European patent No. 2072363 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	H. Geuss
Members:	W. Marx
	P. de Heij

Summary of Facts and Submissions

I. The opponent's appeal is directed against the decision of the opposition division rejection its opposition against European patent No. 2 072 363.

II. In its decision the opposition division held that the patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a skilled person and that the subject-matter of the independent claims 1, 3, 5 and 6 was new and involved and inventive step.

III. The appellant relied, *inter alia*, on the following evidence filed during the opposition procedure:

D2: US 4,629,043

IV. Oral proceedings before the board took place on 10 July 2019.

The appellant requested that the decision under appeal be set aside, that the patent be revoked and that the appeal fee be reimbursed.

The respondent requested that the appeal be dismissed or, alternatively, that the patent be maintained on the basis of the set of claims of one of the first to sixth auxiliary requests, filed during the oral proceedings of 10 July 2019 or, further alternatively, that the case be remitted to the opposition division for further prosecution.

V. The independent claims 1 and 3 as granted read as follows:

"1. Method for controlling the intervention of the electric parking brake of a vehicle, in condition of dynamic functioning, **characterized in that** it comprises a step of prevention of the intervention of the electric parking brake in case of proper functioning of the service brake of the vehicle."

"3. Device for controlling the intervention of the electric parking brake of a vehicle, in condition of dynamic functioning, **characterized in that** it comprises means for preventing the intervention of the electric parking brake in case of proper functioning of the service brake of the vehicle."

The amendment of the independent claims according to the first auxiliary request consisted in replacing in claim 1 the term "prevention" by "inhibition" and in claim 3 the term "preventing" by "inhibiting". Moreover, claim 3 now reads "Device configured for...".

The claims according to the second auxiliary request, as compared to the first auxiliary request, remained unchanged except for the deletion of the device claims.

The claims according to the third to sixth auxiliary request were derived from the first auxiliary request and modified by adding further features.

VI. The appellant's submissions in as far as they are relevant to this decision may be summarised as follows:

Novelty over D2

The term "to prevent" (German: "vermeiden") used in claims 1 and 3 merely indicated that a technical function of a technical system was passively not

executed, but that it was still available, including a bypassing step as known from D2. The contested decision (see point 4.2.3) construed the feature "step of prevention" as an active feature meaning that the technical function was blocked (German: "sperren") through an active intervention in the system, i.e. only when the parking brake was activated.
D2 disclosed all the steps required by the wording of claim 1, namely detecting a failure in the main brake system (step S1 in Figure 3A in D2) and bypassing the application of the electric parking brake in case of no failure and at a vehicle speed greater than a preset value (step S2). For this one example falling under the wording of claim 1, D2 showed a step of prevention of the intervention of the electric parking brake "in any case" and was novelty-destroying. Claim 1 reading "*in case of proper functioning*" did not require proper functioning of the service brake in all cases, but only in "a case" of proper functioning. No control being effected (as in D2) was encompassed by the generic term "prevention". Regarding the feature "*in condition of dynamic functioning*", it was not clear whether it related to the parking brake or to the vehicle.

Auxiliary request filed during oral proceedings

The auxiliary requests filed during oral proceedings should not be admitted. The patent proprietor had already recognised the translation error in the opposition phase, but never had filed auxiliary requests to address this issue until discussed at the oral proceedings in appeal. Correction of translation errors was also not possible in view of decision G 1/10. Moreover, the auxiliary requests were considered *prima facie* not allowable. Replacing the term "prevention" by "inhibition" might change the

scope of protection, as the technical understanding of the term "inhibition" in the context of the claim wording was not immediately clear, thus raising doubts whether it created an *aliud* or not and whether Article 123 (3) EPC was complied with. These issues had to be discussed with the client, so it was requested to remit the case to the first instance in case the auxiliary requests were admitted into the proceedings.

Alleged procedural violation

Firstly, the decision was insufficiently reasoned as regards sufficiency of disclosure of the feature "*proper functioning of the service brake*", contrary to the requirements of Rule 111(2) EPC. All relevant facts and evidence and all considerations with respect to the legal and factual framework of the case had to be appreciated in a reasoned decision. The opposition division interpreted the feature "*proper functioning of the service brake*" on the basis of the common general knowledge of the skilled person (see point 3.5 of the contested decision), which had to be assessed objectively. The relevant evidence or facts on which the decision was based had to be provided by the opposition division or the patent proprietor (see Guidelines, F-II-4.1). A mere allegation what the skilled person understood was not sufficient but had to be proven. The appellant had a right to know before the decision was announced on which grounds the decision was to be based and which facts, evidence and arguments were relevant to the decision (see R1/12, point 2.1).

Furthermore, the decision was insufficiently reasoned as, according to the contested decision (point 3.3), the skilled person reading "*proper functioning of the service brake*" would not expect that it was functioning

without any possible defect, but only to a certain probability. This unproven allegation did not satisfy the requirements for a reasoned decision, so the opposition division had been asked for evidence to enable the appellant to ascertain what objectively belonged to the common general knowledge (see J 20/85 in this respect) to separate it from any subjective or personal view of the opposition division.

In addition, the technical effect provided by the distinguishing features of the claimed subject-matter over the prior art (electric parking brake, proper functioning of the service brake) had not been put forward by the patent proprietor, which was necessary to apply the problem-solution approach. It could be expected that at least the opposition division would state the technical effect (by citing a passage in the patent specification). Distinguishing features not contributing to a technical effect were mere design and had to be ignored. As this argument had been ignored and the contested decision did not even give a rough idea of the technical effect, the contested decision was insufficiently reasoned and came as a surprise to the appellant.

VII. The respondent countered essentially as follows:

Novelty over D2

The terms "inhibition" and "prevention" could be considered as synonyms, but as admitted during oral proceedings, "inhibition" (the term used in the application as originally filed in the Italian language) was the more specific term. However, the wording of the claim had to be read in its context. In the present case, "*prevention of the intervention*" was

an active step because "intervention" was an action and not a state (see also paragraph 4.2.3 of the contested decision), meaning that something was avoided when a parking brake application command arose.

Claim 1 required two conditions to be verified (dynamic condition of the vehicle AND proper functioning of the service brake) in order to prevent the intervention of the electric parking brake (see annex to the minutes: the AND-combination provided an inhibit command to the electric parking brake). The effect of the method of claim 1 was not the engagement or disengagement of the parking brake, but basically its "prevention", which operated regardless of the positive intervention of the driver or any other system (see point 4.2.3 of the contested decision). The effect of the prevention was appreciated when the driver or any other system attempted to actuate the parking brake (as described in the patent in paragraph [0003]), by discovering that it did not respond to the command. The prevention step was a positive action executed to avoid the activation of the electric parking brake, e.g. by means of opening a contact or a relay.

The invention aimed at avoiding an activation of the electric parking brake when a vehicle was moving. The problem solved in D2 (release of the electric parking brake on a gradient) was a different one. D2 showed (see Figure 3A) a loop S1-S2-S1 for a vehicle speed greater than a preset level, so the system just kept waiting and did not provide an inhibit function, i.e. no "prevention" within the meaning of claim 1 (which required a step of preventing or a prevention block) was positively disclosed. According to D2 (column 5, line 23; column 7, line 39), "*no control over the parking brake*" was effected in this case, which did not

mean "inhibition" or "prevention". Moreover, these terms were completely absent in D2.

D2 did not show a "prevention in any case" (see also contested decision, paragraph 4.3.4). According to Figure 3A in D2 (when Speed > V and Main brake Not in failure condition, steps S1 and S2 were executed cyclically), the "manual switch" was only ignored when certain conditions were checked, which did not provide any prevention action within the meaning of claim 1, i.e. "the prevention concept operating on the electric parking brake" was missing. Other conditions (steps S4 to S6; see column 5, line 22 ff) could independently determine the activation of the parking brake (based on the position of the manual switch) even in case of proper functioning of the main brake and when the vehicle was moving. Moreover, block S2 did not check if the vehicle speed was ZERO, i.e. the control of D2 did not check if the vehicle was in dynamic condition, which required the identification of the relative motion between the caliper and the brake disk (see paragraphs 4.2.2 and 4.3.6 of the contested decision). Therefore, the subject-matter of claims 1, 3 was new.

Auxiliary request filed during oral proceedings

Replacing "prevention" by "inhibition" was a formal amendment to better specify the invention by a more specific term, meaning "not letting something do something" (see interpretation of "prevention" in the contested decision, point 4.2.3), which distinguished the invention from the bypass path or loop shown in D2.

A basis for the term "inhibition" was to be found in the originally filed application which was filed in Italian language and thus in a non-official language of

the EPO, the translation of which contained the term "prevention". According to Article 14(2) EPC, the translation may be brought into conformity with the originally filed application throughout the proceedings before the EPO. The patent proprietor had already pointed out during opposition proceedings in its letter dated 10 December 2014 that the originally filed Italian application used the expression "inibizione".

Late filing of the auxiliary requests was justified, since it was the respondent's last chance to save its patent. Moreover, the interpretation of "prevention" was not so clearly given in the board's preliminary opinion, and so far the terms "prevention" and "inhibition" were considered to be synonyms. Only the discussion during the oral proceedings made clear that "to prevent" was understood as "not controlling", which was different from "to inhibit" meaning "sending an inhibit signal".

Alleged procedural violation

The opposition division correctly linked the interpretation of the feature "proper functioning" to the common general knowledge of the skilled man, in particular since the skilled man in the field of braking systems was aware of regulations and standards concerning brakes.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is therefore admissible.

2. Novelty (Article 54(1) EPC, Article 100(a) EPC)

2.1 The subject-matter of claim 1 as granted is not new having regard to document D2 (Article 54(1) EPC).

The board cannot follow the limited interpretation of the subject-matter of claim 1 as granted as adopted by the respondent and the opposition division.

2.2 Claim 1 specifies in its preamble rather general a "*method for controlling the intervention of the electric parking brake of a vehicle, in condition of dynamic functioning*".

2.2.1 D2 relates to an electric parking brake (see Figure 1) and shows (Figures 3A and 3B) a method which defines conditions which either prohibit or allow actuation (application or release) of the parking brake, thereby disclosing a method for controlling the intervention of the electric parking brake of a vehicle.

The last feature of the preamble of claim 1 "*in condition of dynamic functioning*" provides a limitation with regard to the driving situation, namely limiting the control to a vehicle in motion, as specified in the patent specification in paragraph [0004] (in contrast to a static functioning when the vehicle is stationary). This passage also indicates that the electric parking brake is "*used as an emergency brake when the vehicle is in motion, for example in case of failure of the service brake*" in dynamic functioning.

However, the board finds that "dynamic functioning" does not necessarily mean that an emergency situation must be present, e.g. that the service brake must have failed, but merely describes the typical situation when

the parking brake might be used while driving (which function has to be provided according to safety regulations). In fact, this has not been contested and seems to be in line with the interpretation of the term "dynamic functioning" in the contested decision (see point 4.2.2: "*corresponds to the possibility of using the parking brake as an emergency brake when the vehicle is in motion*").

Figure 3A in D2 shows that the parking brake can be applied or released (step S8 or S10) by the manual operation of a switch (steps S7 and S9; see column 5, lines 14-16). This intervention of the electric parking brake is not allowed in D2 under certain conditions, e.g. as long as no failure of the main brake is detected (step S1) and vehicle speed is greater than a preset level V (step S2 would then always decide on returning to step S1, thus creating a loop S1-S2-S1), even if the driver manually operates the switch while driving (e.g. trying to use the electric parking brake as an emergency brake), i.e. any intervention of the parking braking is prohibited under these conditions.

The loop S1-S2-S1 prohibiting the actuation of the electric parking brake in case of a vehicle speed greater than a preset level therefore might be a specific example of controlling the intervention of the electric parking brake under certain conditions of dynamic functioning, which does not exclude activation of the electric parking brake at low vehicle speeds. However, the board finds that the wording of the preamble of claim 1 does not provide a limitation with regard to the whole speed range of dynamic functioning of the electric parking brake. In particular, it does not require that any movement of the vehicle has to be excluded, or to check if the vehicle is stationary

(i.e. vehicle speed ZERO), as argued by the respondent and apparently assumed by the opposition division when acknowledging novelty over D2 (see contested decision, point 4.3.6: "*condition of dynamic functioning in the claim 1 ... is clearly referring to the electric parking brake, and defined in paragraph 4 of the corresponding description [...]. Neither the step S2, nor the step S3 of the method of document D2 refer to such a dynamic functioning, whereby reaching the step S7 is not excluded for the conditions defined in claim 1 of the patent.*"). However, this finding does not contradict the opposition division's interpretation of "dynamic functioning" (see opposition division's point 4.2.2) as argued already further above, since it is possible to operate the manual switch in D2 for actuating or releasing the electric parking brake while running in the loop S1-S2-S1 and thus in any condition of dynamic functioning.

2.2.2 The board notes that the electric parking brake in D2 might be applied when detecting in step S2 a vehicle speed below the preset level, irrespective of the manual operation of the parking brake switch, depending on the result of the evaluation in steps S3 to S6, e.g. when the travelling direction does not accord with the gear position (step S6), which indicates a vehicle rolling back down a slope after stopping (see column 2 and the problem mentioned therein). In this case, the parking brake functions as an automatic emergency brake when a vehicle is unintentionally moving off, i.e. still falling under the definition of "dynamic functioning" given in the contested patent (paragraph [0004]) and thus even showing an example at lower speed values which falls under the wording of the preamble of claim 1.

Therefore, D2 discloses a control of the intervention of the electric parking brake in dynamic functioning according to the preamble of claim 1 for speed values above and below a preset level, in which the parking brake either might be used as an emergency brake (see point 2.2.1) or is automatically used as an emergency brake (see point 2.2.2), in accordance with the definition of "dynamic functioning" as given in the contested patent in paragraph [0004].

2.3 The characterising portion of claim 1 specifies that the method "comprises *a step of prevention of the intervention of the electric parking brake in case of proper functioning of the service brake of the vehicle*". In view of the term "comprises a step", the board finds that the characterising portion only requires "a step" within the method according to the preamble of claim 1, i.e. not necessarily relating to all conditions of dynamic functioning or to any vehicle speed different from ZERO.

2.3.1 According to the characterising portion of claim 1, it has to be decided in a first step (as expressed by "in case of ...") whether the service brake is functioning properly, i.e. without failure. This is known from D2 showing a step (S1) of checking whether there is a main brake failure. In this case, claim 1 requires "*a step of prevention of the intervention of the electric parking brake*". Such a step is also known from D2 (see step S2), since for greater speed values the method of D2 results in a loop created by steps S2-S1-S2 which avoids any application or release of the parking brake, irrespective of whether the driver actuates the manual switch or whether conditions for automatically applying the parking brake are fulfilled.

2.3.2 The board cannot see any difference between what the respondent asserts to be the technical meaning of claim 1 and what is disclosed in D2. The flow chart shown in Figure 3A of D2 describes for the skilled reader (see also column 3, lines 9-12) the flow of operations of the electric parking brake performed by the controller shown in Figures 1 and 2. Step S2 is to be considered as an action or active step (as required according to the respondent) checking cyclically a speed condition, which decides on directing the flow of operations back to step S1 at greater speed values and is cyclically repeated as long as this speed condition prevails. As in claim 1, the method known from D2 requires two conditions to be verified (no main brake failure AND vehicle moving at greater speed, i.e. a dynamic condition) in order to prevent - by means of a positive action (step S2) - any intervention of the parking brake, be it a manual or automatic activation. This step of prevention is operated regardless of any driver or system intervention. Moreover, the effect of the prevention in D2 is also appreciated as soon as the driver or any other system in D2 tries to actuate the parking brake, as the parking brake does not respond to any command, i.e. it has an effect when a parking brake application command precisely arises (which is also in accordance with the interpretation in the contested decision under point 4.2.3). Since claim 1 leaves open how the prevention step is realised in more detail, i.e. whether a dedicated inhibit signal must be generated or a relay opened, no further limitation can be read into the subject-matter of claim 1. Also the fact that D2 might be concerned with a different problem does not play a role when assessing novelty.

2.3.3 The respondent also pointed to passages in D2 (see column 5, line 23 ff; column 7, line 39 ff) reciting

that "*no control over the parking brake is effected as in steps S2 and S3 when the vehicle speed is greater than the preset level V or ...*", which allegedly meant no "prevention". However, these passages have to be read in their context, which relates to the control of the parking brake by the manual switch in accordance with steps S7 to S10 (see e.g. column 5, line 7 ff). Therefore, the term "*no control over the parking brake is effected*" only indicates that manual control over the parking brake is "prevented" or "avoided" or "not allowed" in case the speed condition of step S2 is fulfilled. Nothing more is required by the wording of claim 1 as argued further above.

2.3.4 Finally, the respondent contested that D2 did not show a "prevention in any case", as other conditions (see steps S4 to S6) could still lead to an activation of the parking brake even when the main brake functioned properly and the vehicle was moving.

First of all, the board agrees with the contested decision (see *inter alia* under point 3.3) that "proper functioning" does not mean the absolute absence of any defect, since the patent specification itself discloses a single criterion for checking proper functioning, namely based on the detection of the pressure level in the hydraulic circuit. Therefore, the disclosure of D2 deciding on a failure in the main brake system (step S1) by "*detecting any failure in the main brake system from the level of the brake fluid*" (see column 4, lines 7-9) discloses detecting a case of proper functioning of the service brake as required by the criterion specified in the characterising portion of claim 1.

Secondly, as argued already above (point 2.2.1), the wording of claim 1 does not require that any movement

of the vehicle has to be excluded. Therefore, novelty over D2 cannot be acknowledged on the basis that D2 might show conditions where the vehicle is still moving and parking brake intervention is not prohibited. The wording of claim 1 does not require an intervention of the electric parking brake to be prevented in ANY case of proper functioning of the service brake, so the board does not agree with the finding of the opposition division in this respect (see contested decision, point 4.3.4).

2.4 Since D2 shows an electric parking brake, arguments submitted in writing concerning the differences between a parking brake and an emergency brake have not to be dealt with, as they related to prior art documents which allegedly did not show an electric parking brake.

3. First to sixth auxiliary requests - admissibility

3.1 The first to sixth auxiliary requests were filed during the oral proceedings, after the board had given its negative opinion with regard to novelty of the subject-matter of claim 1 as granted. As compared to the previous first to sixth auxiliary requests filed with the respondent's letter dated 27 June 2019, the term "prevention" in claim 1 has been replaced in all requests by the term "inhibition".

3.2 Under Article 13(1) RPBA, the boards have discretion to admit and consider any amendment to a party's case after it has filed its grounds of appeal or reply. The discretion shall 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.

In this context, according to well-established case law of the Boards of Appeal, amended claims filed only shortly before or during the oral proceedings must in general be *prima facie* allowable in order to be admitted in the sense that it is immediately apparent to the board that they overcome all outstanding issues without raising new ones (see Case Law of the Boards of Appeal (CL), 8th edition, IV.E.4.1.3, 4.2.2).
In any case, it should be considered whether there is a proper justification for their late filing.

3.3 In the present case, the board observes that the respondent had ample opportunities to file auxiliary requests at an earlier stage of the proceedings. As acknowledged by the respondent, the interpretation of the term "prevention" in view of the translation from the originally filed Italian application had already been discussed in proceedings before the opposition division. In the reply of the patent proprietor to the notices of opposition with its letter dated 10 December 2014, the patent proprietor had argued that the translation of the Italian verb "inibire" was "to prevent from" or "to inhibit from". The appellant contested in its grounds of appeal (page 5, first to third paragraph) that the term "inhibited" or a similar term was disclosed in the application documents as originally filed. However, if the respondent wanted to rely on the allegedly more limited or specific term "inhibition" as compared to "prevention", it could and should have filed a correction on the basis of the originally filed Italian application documents under Article 14(2) EPC with its reply to the grounds of appeal, provided that such correction satisfied the requirements of Article 123(3) EPC (see e.g. T 516/12).

The respondent had even more good reasons to file respective auxiliary requests at least in appeal proceedings at an earlier stage, at least with its letter of reply, since the appellant argued in its grounds of appeal (see page 5, third and fourth paragraph) that the term "to prevent" did not mean "to block" or "to lock" or any active intervention of the technical system as found in the contested decision under point 4.2.3. Having failed to do so, the respondent waited until the last possible moment to take into account the objections which had been discussed at length during the entire opposition and appeal proceedings to amend its case.

On this ground alone, the board has already difficulties to see how its discretion can be exercised in the respondent's favour in view of the "current state of the proceedings" (see Article 13(1) RPBA).

Contrary to the respondent's assertion, the board has indicated quite clearly in its preliminary opinion that it has difficulties in following the interpretation of the contested decision under point 4.2.3 and that document D2 appears to be highly relevant for assessing novelty of the subject-matter of claims 1 and 3 (points 4 and 5).

As regards the respondent's argument that late filing of the auxiliary requests was justified as a "last chance" to save its patent, the board notes that submissions of the parties are subject to Articles 12 and 13 RPBA and admissibility of late requests is always a matter of the board's discretion (see e.g. T 446/00, point 3.3 of the Reasons). There is no established "last chance" doctrine or any absolute right of a patentee to such a "last chance".

3.4 Moreover, changing the wording of e.g. claim 1 by replacing the term "prevention" by "inhibition" would start a new discussion on whether the claimed subject-matter has changed or not. On the one hand, assuming that "inhibition" implied a more specific meaning than "prevention" as argued by the respondent, it had to be discussed in particular whether the modification in the respective method step of claim 1 merely limited the claimed subject-matter as compared to the subject-matter of claim 1 as granted, or whether the claimed scope of protection might have shifted and Article 123(3) EPC was violated, as suspected by the appellant. On the other hand, the respondent itself has argued in its written submissions that both terms were synonyms, which already raises the question how the amendment in claims 1 in auxiliary requests 1 and 2 (which only consists in replacing "prevention" by "inhibition") could establish novelty over D2, i.e. how these auxiliary requests could be *prima facie* clearly allowable.

In addition, claims 1 and 3 of the third to sixth auxiliary requests (similar to the auxiliary requests previously filed with letter of 27 June 2019) have been amended by either adding features taken from the description, or - in case of the sixth auxiliary request - features from granted claims 2 and 4. Apart from indicating in its letter of 27 June 2019 (page 6) where the support for the amendments is to be found and stating (last paragraph) that "*all the amendments are directed to matter which was extensively dealt in the Opposition and Appeal proceedings*", the respondent has failed to present any arguments why, in its view, any of these requests should be *prima facie* allowable, although e.g. claims 2 and 4 as granted were already

objected to for lack of inventive step in the grounds of appeal. Moreover, the conformity of amendments with the requirements of Articles 123(2) and 84 EPC is an issue when extracting features from the description.

The board finds that dealing with these issues of allowability of amendments and patentability for the first time during the oral proceedings would run counter to the "need for procedural economy" (see Article 13(1) RPBA) and therefore also speaks against admission of the auxiliary requests into the appeal proceedings.

3.5 Under these circumstances, having regard to the state of the proceedings and the need for procedural economy, the board exercised its discretion under Article 13(1) RPBA in not admitting the first to sixth auxiliary requests into the proceedings.

The appellant's request for remittal to the first instance cannot be granted as no further prosecution is needed.

4. Procedural violation, reimbursement of appeal fee

4.1 The appellant requested reimbursement of the appeal fee in view of the contested decision being not sufficiently reasoned in respect of sufficiency of disclosure and inventive step and also coming as a surprise to the appellant, since it did not provide evidence on common general knowledge and did not state any technical effect supporting an inventive step.

4.2 The appellant's objection relates to Rule 111(2) EPC, which requires that decisions of the EPO open to appeal shall be reasoned. According to the established

jurisprudence, the reasoning given in a decision open to appeal has to enable the appellant and the board of appeal to examine whether the decision was justified or not and therefore should discuss the facts, evidence and arguments which are essential to the decision in detail. It has to contain the logical chain of reasoning which led to the relevant decision (see Case Law of the Boards of Appeal of the EPO, 8th edition, III.K.4.2.1). The decision should contain at least some reasoning on crucial points of dispute, in order to give the party concerned a fair idea of why its submissions were not considered convincing (see e.g T 1843/11, point 5.6 of the Reasons).

4.3 Contested decision - sufficiency of disclosure

4.3.1 As derivable from the minutes of the oral proceedings before the opposition division, after sufficiency of disclosure had been discussed between the parties, the opposition division found that the description was clear enough to allow the person skilled in the art to carry out the invention. At that stage of proceedings, the opposition division referred explicitly to "*the same arguments provided in the Annex to the Summons, under point 2.3*" (see minutes, point 4.1), where basically the same arguments can be found which form the basis for the contested decision (see point 3.3). In particular, the opposition division was of the opinion that excluding any possible defect in a real system was impossible, and that (point 3.3, under c)) "*for brake systems, the skilled person had the knowledge to assess, by checking certain, generally known parameters, the proper functioning of the service brake, a detailed definition of these parameters was thus not necessary to carry out the present invention*".

4.3.2 The appellant complains that the opposition division has failed to provide any proof of the common general knowledge of the skilled person. As derivable from the contested decision (see point 3.3, under c)), the opposition division referred to the skilled person for brake systems, i.e. identified at least the technical field the skilled person was working in. Moreover, it was concluded that it was impossible to exclude any possible defect in a real system, thereby apparently referring to common general knowledge in the art which was deemed sufficiently notorious as not to require substantiation by evidence. This reasoning given by the opposition division was not insufficient as it is understandable why the appellant's argument was not considered convincing.

Even assuming that the appellant could expect further proof of the knowledge of the skilled person in the field of brake systems in this respect, the contested decision might only be deficient and incomplete in this sole aspect. However, according to the established case law, it is sufficient for a decision to be reasoned in some way; an incomplete and deficient reasoning does not constitute a breach of Rule 111(2) EPC (see e.g. T 856/91, point 6.2 of the Reasons, dealing with a similar case in which the knowledge of the skilled person was in question).

4.3.3 According to decision R 1/12 (see point 2.1), cited by the appellant, Article 113(1) EPC requires that decisions of the EPO may only be based on grounds, facts, evidence and arguments on which the parties concerned have had an ample opportunity to present their comments, taking into account also the written submissions. However, in view of the foregoing, the board cannot find any indication that the contested

decision was based on evidence and related arguments which were not known to the appellant-opponent so that its right to heard might have been violated. Decision J 20/85 which was cited by the appellant to corroborate its view that all evidence on which the decision is based must be indicated is therefore not relevant in the present case.

4.4 Contested decision - inventive step

4.4.1 As regards the reasoning required when deciding upon inventive step, in accordance with the general principles of jurisprudence as set out further above, it was found in decision T 292/90 (and confirmed in many decisions) that "*the logical chain of reasoning used to justify the conclusion that the claimed subject-matter does not involve an inventive step should have been included in the decision, so that it could be readily comprehended why the Appellants' arguments in support of an inventive step had to fail*".

4.4.2 In the present case, the contested decision recites under point 5.4 (referred to by the appellant):
"*None of the documents cited by the Opponents as valid prior art documents discloses a method step or means of/for preventing the intervention of a parking brake in case of proper functioning of the service brake of a vehicle, neither for an electric parking brake, nor for any other kind of parking brake.*
Therewith, there is no obvious combination of two or more of the mentioned documents which could include all the features defined at least in one of the claims 1, 3, 5 or 6 of the contested patent."

This passage explains what the opposition division considered to be the distinguishing feature over the

prior art. However, it cannot be read in isolation, but in connection with the following passages (points 5.5 to 5.10) which make clear that the appellant submitted three lines of attack starting from either document D1, D2 or D3 as the closest prior art, as confirmed by the minutes of the oral proceedings (point 7.2). The board therefore finds that the contested decision clearly identifies the feature which distinguishes the claimed subject-matter from the closest prior art. Moreover, the opposition division found that the distinguishing feature was not disclosed in any of the documents of prior art so that a combination of these documents could not lead to the subject-matter of the independent claims.

The board regards this reasoning as being sufficient as it can be understood why the appellant's arguments had to fail. Although the reasoning given in point 5.4 of the contested decision, without explicitly stating a technical effect (which in the problem-solution approach helps to define the objective technical problem and might give a pointer to combine different documents of prior art) might be rather short, it does not necessarily imply that the reasoning is insufficient or even surprising.

4.4.3 The appellant alleges that the opposition division has failed to state in the contested decision the technical effect provided by the distinguishing features of the claimed subject-matter. Allegedly, a distinguishing feature not contributing to a technical effect was mere design and had to be ignored, which argument had been ignored by the opposition division.

Insofar the appellant's objection applies to the difference between an electric parking brake as claimed

and an emergency brake as known from D1 or D3 (see contested decision, points 5.6 and 5.10), there might have been an issue that changing from one design to a different design of a brake circuit cannot establish inventiveness. However, the reasoning given by the opposition division (see point 5.4) does not solely rely on this difference, but on a further feature not disclosed in the prior art, namely "*preventing the intervention of a parking brake in case of proper functioning of the service brake*". The board therefore understands that, for this reason alone, the line of argument starting from D1 or D3 had to fail, so no deficiency in reasoning is apparent in this respect. It is noted that the opposition division is not required to address each and every argument of a party (see T 1843/11, supra, point 5.6.1, referring also e.g. to R 19/10 of 16 March 2011, point 6.2).

As regards the line of argument starting from D2 as the closest prior art (which according to point 4.3.2 of the contested decision shows an electric parking brake), the opponent O2 explicitly raised the objection that no additional technical effect was provided to the method of D2 "*by the fact that the method is to be applied in condition of dynamic functioning*" (see point 5.7 of the contested decision). This argument is explicitly rebutted in the contested decision and therefore has not been ignored by the opposition division in the contested decision, which makes clear that this feature was not to be disregarded (under point 5.8: "*the dynamic functioning of the parking brake is in fact a feature of the system on which the method of the patent is to be applicable*"). Moreover, the contested decision stresses that, even disregarding this feature, the method of D2 would still not provide a prevention of the intervention of the parking brake

in case of proper functioning of the service brake (point 5.8, last sentence).

As regards the distinguishing feature of prevention of the intervention of the parking brake in case of proper functioning of the service brake, the board cannot find any indication in the contested decision or the minutes of oral proceedings that there was a discussion in first-instance proceedings on disregarding this feature for not contributing to a technical effect. Even if this might have been the case, it is clear from the entire reasoning in the contested decision that the opposition division regarded this feature to be a technical feature which cannot be ignored.

4.5 For the above reasons, the board concludes that the decision under appeal complies with the requirements of Rule 111(2) EPC and Article 113(1) EPC and that therefore no fundamental deficiency is apparent in this respect, contrary to the appellant's allegation.

4.6 As the board considers that no substantial procedural violation has occurred, reimbursement of the appeal fee is refused in accordance with Rule 103(1)(a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

3. The request for reimbursement of the appeal fee is refused.

The Registrar: The Chairman:

A. Vottner H. Geuss

Decision electronically authenticated