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**Datasheet for the decision
of 16 March 2021**

Case Number: T 2600/17 - 3.4.02

Application Number: 08736289.3

Publication Number: 2142951

IPC: G02B6/38

Language of the proceedings: EN

Title of invention:

OPTICAL CONNECTOR

Patent Proprietor:

Huber+Suhner AG

Opponent:

ROSENBERGER Hochfrequenztechnik GmbH & Co. KG

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(3)

RPBA Art. 13

Keyword:

Main request - Grounds for opposition - extension of subject-matter (yes)
Late-filed auxiliary request 1 - admitted (yes) - broadening of claims (yes)
Late-filed auxiliary request 2 - request clearly allowable (no) - admitted (no)

Decisions cited:

R 0016/09, T 0667/08, T 0801/13

Catchword:



Beschwerdekammern

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Case Number: T 2600/17 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 16 March 2021

Appellant: ROSENBERGER Hochfrequenztechnik GmbH & Co. KG
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 20 November 2017 rejecting the opposition filed against European patent No. 2142951 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman R. Bekkering
Members: C. Kallinger
T. Karamanli

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the opposition division to reject the opposition and requested that the decision be set aside and that the patent be revoked in its entirety.
- II. In its reply to the appellant's statement of grounds of appeal, the respondent (patent proprietor) requested that the appeal be dismissed and that the patent be maintained as granted.
- III. On 24 October 2019, a summons to oral proceedings was issued. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal in the version of 2020 (RPBA 2020, OJ EPO 2019, A63) dated 5 March 2020, the board gave its preliminary opinion on certain aspects of the appeal.
- IV. In a letter dated 9 April 2020, the appellant commented on the board's preliminary opinion.
- V. In a letter dated 14 April 2020, the respondent commented on the board's preliminary opinion and requested as an auxiliary measure that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the set of claims of auxiliary request 1 or auxiliary request 2, both requests as filed by letter dated 14 April 2020.
- VI. In a letter dated 12 February 2021, the appellant commented on the respondent's reply and requested that auxiliary requests 1 and 2 not be admitted into the appeal proceedings and provided arguments against the allowability of all requests.

VII. On 16 March 2021, the oral proceedings before the board were held by video conference.

VIII. The parties' final requests are as follows:

The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed and, as an auxiliary measure, that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the set of claims of auxiliary request 1 or auxiliary request 2, both requests as filed by letter dated 14 April 2020.

IX. Claim 1 of the patent as granted reads:

"Optical connector (10), in particular for outside use, for detachably frontal connecting at least two optical cables along a connector axis (43), comprising a socket portion (11) and a plug portion (27), which portions are substantially of cylindrical design with respect to the connector axis (43), can be detachably plugged into one another along the connector axis (43, x) and can be locked in the plugged-in state, whereby a locking mechanism (19, 20, 32, 33, 36, 46), which is equipped with a latch function and which latches automatically during insertion, is provided for the purpose of rapid locking, wherein the locking mechanism (19, 20, 32, 33, 36, 46) comprises an elastically expandable locking ring (33), which is arranged concentrically with the connector axis (43) supported in a fixed position in one of the two connector portions (11, 27) in the axial

direction and latches, for locking purposes, behind a peripheral latching step (20) on the other one of the two connector portions (11, 27) during insertion by elastical expansion, characterized in that an actuating element (32), by means of which the locking ring (33) can be lifted over the latching step (20) for unlocking purposes, is arranged on one of the two connector portions (11, 27)."

- X. Claim 1 of auxiliary request 1 reads as follows
(amendments in comparison to the main request marked by the board):

"Optical connector (10), in particular for outside use, for detachably frontal connecting at least two optical cables along a connector axis (43), comprising a socket portion (11) and a plug portion (27), which portions are substantially of cylindrical design with respect to the connector axis (43), can be detachably plugged into one another along the connector axis (43, x) and can be locked in the plugged-in state, whereby a locking mechanism (19, 20, 32, 33, 36, 46), which is equipped with a latch function and which latches automatically during insertion, is provided for the purpose of rapid locking, wherein the locking mechanism (19, 20, 32, 33, 36, 46) comprises an elastically expandable slit locking ring (33), which is arranged concentrically with the connector axis (43) supported in a fixed position in one of the two connector portions (11, 27) in the axial direction and latches, for locking purposes, behind a peripheral latching step (20) on the other one of the two connector portions (11, 27) during insertion by elastical expansion at a shoulder, characterized in that an actuating element (32), by means of which the locking ring (33) can be lifted over the latching step (20) for unlocking purposes, is

arranged on one of the two connector portions (11, 27)."

XI. Claim 1 of auxiliary request 2 reads as follows (amendments in comparison to the main request marked by the board):

"Optical connector (10), in particular for outside use, for detachably frontal connecting at least two optical cables along a connector axis (43), comprising a socket portion (11) and a plug portion (27), which portions are substantially of cylindrical design with respect to the connector axis (43), can be detachably plugged into one another along the connector axis (43, x) and can be locked in the plugged-in state, whereby a locking mechanism (19, 20, 32, 33, 36, 46), which is equipped with a latch function and which latches automatically during insertion, is provided for the purpose of rapid locking, wherein the locking mechanism (19, 20, 32, 33, 36, 46) comprises an elastically expandable slit locking ring (33), which is arranged concentrically with the connector axis (43) supported in a fixed position in one of the two connector portions (11, 27) in the axial direction, wherein, during insertion, the locking ring (33) is elastically expanded at a shoulder (1) and then latches, in a locking manner, behind ~~and latches, for locking purposes, behind~~ a peripheral latching step (20) on the other one of the two connector portions (11, 27) ~~during insertion by elastical expansion~~, characterized in that an actuating element (32), by means of which the locking ring (33) can be lifted over the latching step (20) for unlocking purposes, is arranged on one of the two connector portions (11, 27)."

Reasons for the Decision

1. The appeal is admissible.

2. Main request - Ground for opposition under Article 100(c) EPC - Added subject-matter

The patent relates to an optical connector with a locking mechanism comprising a locking ring. Claim 1 of the granted patent defines *"an elastically expandable locking ring (33), which is arranged concentrically with the connector axis (43) supported in a fixed position in one of the two connector portions (11, 27) in the axial direction and latches, for locking purposes, behind a peripheral latching step (20) on the other one of the two connector portions (11, 27) during insertion by elastical expansion,.. "*.

- 2.1 The opposition division came to the conclusion that the subject-matter of claim 1 of the granted patent did not extend beyond the content of the application as originally filed.

The opposition division concluded in particular that the added feature *"by elastical expansion"* was originally disclosed because originally filed claim 2 disclosed the locking ring as being elastically expandable. In addition, claim 1 and the description (see page 5, lines 3 to 25 and figures 3, 5, 11 and 12) disclosed that the locking action used the elastic properties of the locking ring.

- 2.2 The appellant argued that the feature *"by elastical expansion"* was not disclosed in the context of the

claimed locking action, i.e. the action in which the elastic element latches behind the peripheral latching step.

The wording of claim 1 was clear in itself and defined that a locking ring *"latches, for locking purposes, behind a peripheral latching step (20) [...] during insertion by elastical expansion"*. This was also confirmed by the German version of claim 1, which was provided by the patent-proprietor upon grant of the patent and which defined that the locking ring (*"Verriegelungsring"*) *"... zum Verriegeln hinter einen umlaufenden Rastabsatz (20) [...] beim Einsetzen durch elastisches Ausdehnen einrastet."*

However, the description (see e.g. page 5, lines 3 to 16 and page 12, lines 19 to 21) disclosed that the latching, for locking purposes, happened by a contraction of the locking ring after it had been elastically expanded at the shoulder. An elastical expansion of the locking ring was only disclosed in the context of the unlocking operation by using the actuating element.

Therefore, the claimed feature that the *"elastically expandable locking ring [...] latches, for locking purposes, behind a peripheral latching step [...] by elastical expansion"* was not disclosed in the application as originally filed.

The appellant further argued that also originally filed claim 2, although referring to an *"elastically expandable locking ring (33)"*, failed to disclose the feature *"by elastic expansion"* in the context of the claimed latching action.

Neither did the description disclose that the claimed latching (for locking purpose) behind a peripheral latching step during insertion happened by elastical expansion of the locking ring. The features "*elastically expandable locking ring*" and "*by elastical expansion*" were clearly not synonymous. Otherwise, the respondent would not have added the feature during the examination of the patent.

Therefore, the description (see e.g. page 12, lines 19 to 21) explicitly described that during insertion, the locking ring "*... is elastically expanded at the shoulder 19 and then latches in a locking manner behind the latching step 20*". This was clearly different from the claimed locking function which required that the locking ring "*latches, for locking purposes, behind a peripheral latching step (20) on the other one of the two connector portions (11, 27) during insertion by elastical expansion*".

In conclusion, the subject-matter of the granted patent extended beyond the content of the application as filed.

2.3 The respondent argued that the appellant's argumentation was flawed because it referred to the wording of singled out passages from the description and re-interpreted them completely out of context in order to create the alleged contradictions between the claimed subject-matter and the disclosure of the patent as a whole. For the determination of the scope of the claim according to Article 69 EPC, the skilled person had to read the application with a mind willing to understand, i.e. he would try to understand the individual text passages (in combination with the

figures) such that they gave a conclusive and logical overall picture.

With this in mind, the claim had to be read such that the feature "*by elastic expansion*" did not refer to the latching of the ring behind the latching step but to the immediately preceding feature "*during insertion*", *i.e.* the features "*during insertion by elastic expansion*" were inextricably linked together.

If at all, claim 1 as granted could be read in two variants: One that corresponded to that brought forward by the appellant and which required a latching by elastic expansion of the locking ring. The other variant included an elastic expansion of the locking ring during insertion and a subsequent latching of the locking ring behind the latching step. If in doubt, the skilled person would interpret the claim in the latter variant which was in full accordance with the locking mechanism as clearly disclosed in the application as a whole.

With respect to added subject-matter, the respondent argued further with reference to decisions T 801/13 and T 667/08 that a literal disclosure of the feature "*by elastical expansion*" was not necessary.

As a consequence, the subject-matter of claim 1 corresponded to the locking mechanism as disclosed in the application as filed (see e.g. page 5, lines 3 to 16, page 9, lines 3 to 5 or page 12, lines 19 to 21).

In conclusion, the claimed elastic expansion of the locking ring during insertion was fully supported by the description as a whole and therefore the subject-

matter of claim 1 as granted did not extend beyond the content of application as filed.

2.4 The board agrees with the respondent's and the appellant's interpretation of the locking action as it can be derived from the description (see page 5, lines 3 to 16, page 12, lines 19 to 21 and figures 3, 10 and 11) which discloses that the locking process is realised by first expanding the elastically expandable locking ring at the shoulder. For locking purpose, the ring then latches, by contraction, behind a latching step. During unlocking, the locking ring is then again expanded in order to be lifted over the latching step. No other embodiments are disclosed in the application as filed.

However, in contrast to this locking action as it is disclosed in the description and the figures, claim 1 of the granted patent has been amended to define that the locking ring *"... latches, for locking purposes, behind a peripheral latching step (20) [...] during insertion by elastical expansion"*.

The board is not convinced by the respondent's line of argument and is of the opinion that the feature *"by elastic expansion"* clearly refers to the latching action of the locking ring. Claim 1 is clear in itself and there is no need to refer to the description for interpretation of the wording of claim 1. As a consequence, claim 1 defines that the latching of the locking ring behind the latching step, which is the final step in the locking process, is based on an elastical expansion of the locking ring. Such a latching by elastic expansion is however not disclosed in the application as filed.

The respondent argued with reference to Article 69(1) EPC that the claims had to be interpreted in view of the description and the drawings and that therefore the claimed subject matter was disclosed for the skilled person, who read the disclosure with a mind willing to understand.

The board is not convinced by this argument. Article 69(1) EPC concerns only the extent of the protection conferred by the patent. This provision, however, does not apply when it has to be determined whether the subject-matter of the granted patent extends beyond the application as filed. As discussed above, the board is of the opinion that the wording of claim 1 is clear in itself and defines that the locking ring "*... latches, for locking purposes, behind a peripheral latching step (20) [...] during insertion by elastical expansion*". Such a locking process is however not disclosed in the application as filed.

The opposition division argued that it was clear from the claims and the description that the locking ring was expanded during locking by moving over the latching step and during unlocking by the actuating element. Therefore, it was disclosed that the locking action also used the elastic properties of the locking ring, which could not be "*switched off during the locking operation*".

The board agrees with this argument as far as it relates to the elastic properties of the locking ring. In this context, the respondent also referred to decisions T 801/13 and T 667/08. In these decisions, it was held that literal support in the application as filed was not required for an amendment in a patent, insofar as the amended or added features reflected the

technical information that the skilled person reading the original disclosure would have derived from its content (description, claims and drawings) considered in its entirety (see e.g. decisions T 667/08, point 4.1.4, and T 801/13, point 6 of the Reasons; see also Case Law of the Boards of Appeal of the European Patent Office ("Case Law"), 9th edition 2019, II.E.1.3.2). The board agrees with the respondent that the application as filed (see e.g. claim 2 as filed) discloses that the locking ring is elastically expandable.

However, in contrast to this disclosure, the claim defines that the locking ring *"latches, for locking purposes, behind a peripheral latching step [...] during insertion by elastical expansion"*. Such a latching by expansion of the locking ring is, however, neither explicitly nor implicitly disclosed in the application as filed.

The respondent further argued with reference to an elastic rubber band that it was not conceivable how such an elastic rubber band could latch, for locking purposes, behind a peripheral locking step by expansion. Therefore, the skilled person would not read claim 1 as to relate to a latching by expansion as alleged by the appellant.

The board agrees that a locking by elastic expansion is not possible for a rubber band. However, claim 1 defines a locking ring and the board agrees with the appellant's argument that the wording of claim 1 is clear and encompasses a variant in which an (elastic) locking ring expands, for locking purposes, in an outward direction in order to latch e.g. into a notch of the other part of the connector. Such a variant,

although not disclosed in the application as filed, is claimed in claim 1 and technically possible.

In summary, the application as filed, on which the patent in suit is based, does not disclose a locking ring which latches, for locking purposes, behind a peripheral latching step on the other one of the two connector portions during insertion by elastical expansion.

In conclusion, the subject-matter of claim 1 of the granted patent extends beyond the content of the application as filed and thus the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted.

3. Auxiliary request 1

3.1 Admittance - Article 13 RPBA 2007

3.1.1 In the case in hand, the summons to oral proceedings was notified before the date on which RPBA 2020 entered into force, i.e. 1 January 2020 (Article 24(1) RPBA 2020). Thus, in accordance with Article 25(1) and (3) RPBA 2020, Article 13(2) RPBA 2020 does not apply. Instead, Article 13 of the Rules of Procedure of the Boards of Appeal in the version of 2007 (RPBA 2007 - see OJ EPO 2007, 536) applies to the question of whether to admit the respondent's auxiliary request 1, which was filed after notification of the summons to oral proceedings.

3.1.2 The respondent argued that the added features "at the shoulder" and "slit locking ring" in claim 1 of auxiliary request 1 were based on the description (see

page 12, lines 19 to 21 and page 17, lines 11 to 13). The amendments were simple in substance, clarified the feature "*during insertion by elastical expansion*" and addressed in addition any remaining objections with respect to novelty and inventive step.

Auxiliary request 1 was filed in reaction to the board's preliminary opinion given in the communication pursuant to Article 15(1) RPBA 2020, which diverged from the opposition division's decision and which therefore could not have been anticipated by the respondent. Therefore, the filing of auxiliary request 1 in reaction to the board's communication was the first possibility for the respondent to file amended claims which took into consideration the board's preliminary view.

- 3.1.3 The appellant argued that the amendment in claim 1 was directed to overcome the ground for opposition under Article 100(c) EPC. As this objection had already been discussed in the first-instance opposition proceedings, claims with this amendment should have been filed at that time or at the latest with the reply to the grounds of appeal.

Furthermore, the amendment was *prima facie* not suitable to overcome the objections under Article 100(a) and (b) EPC brought forward by the appellant and discussed in the board's communication. Finally, the amendment led to a new objection under Article 123(3) EPC.

Therefore, auxiliary request 1 should not be admitted into the appeal proceedings.

- 3.1.4 According to Article 13 RPBA 2007, any amendment to a party's case after it has filed its grounds of appeal

or reply may be admitted and considered at the board's discretion. The discretion must 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.

Article 13(1) RPBA 2007 merely lists examples of factors to be considered by the board in exercising its discretion and not an exhaustive set of criteria which must be cumulatively met (R 16/09, point 2.2.4 of the Reasons). It is at the discretion of the board to decide which criterion it attaches primary importance to on the basis of the circumstances of the individual case (R 16/09, point 2.2.11 of the Reasons).

In the case in hand, the board is of the opinion that the amendments in claim 1 are not complex. Therefore, the board exercised its discretion under 13 RPBA 2007 and decided to admit auxiliary request 1 into the appeal proceedings.

3.2 Extension of scope of protection - Article 123(3) EPC

3.2.1 The appellant argued that amended claim 1 now related to a locking action in which the locking ring was elastically expanded at the shoulder before it latched, for locking purposes and by contraction after elastical expansion, behind the latching step. This was however different from the locking action as defined in claim 1 of the granted patent, in which the locking ring latched, for locking purposes, behind the latching step by elastical expansion. The subject-matter of claim 1 of auxiliary request 1 therefore related to an *aliud*. As a consequence, the patent as granted was amended in a way as to extend the protection it confers contrary to the requirement of Article 123(3) EPC.

3.2.2 The respondent argued that the scope of protection had not been extended because the amendment only reduced the scope of claim 1 and now only allowed the interpretation of the locking process that was clearly disclosed in the patent as a whole.

3.2.3 The board is not convinced by the respondent's argument. As discussed above for the main request (see point Error: Unable to retrieve cross-reference value!), the board is of the opinion that the wording of claim 1 of the main request is clear in itself and needs no further interpretation based on the description. Compared to claim 1 as granted, amended claim 1 no longer requires that the locking ring *"latches, for locking purposes, behind a peripheral latching step [...] during insertion by elastical expansion"*.

Therefore, the amendment in claim 1 of auxiliary request 1 extends the protection conferred by the patent as granted and does not meet the requirements of Article 123(3) EPC.

4. Auxiliary request 2 - admittance - Article 13 RPBA 2007

4.1 Auxiliary request 2 was filed after notification of the summons to oral proceedings. Therefore, Article 13 RPBA 2007 applies (see also point 3.1.1 above).

4.2 The respondent argued that the amendments were based on the exact wording of the description (see page 12, lines 19 to 21), were directed at overcoming all remaining objections and did not raise any new questions,

Auxiliary request 2 was also filed in reaction to the board's preliminary opinion given in the communication pursuant to Article 15(1) RPBA 2020, which diverged from the opposition division's decision and which therefore could not have been anticipated by the respondent. Therefore, the filing of auxiliary request 2 in reaction to the board's communication was the first possibility for the respondent to file amended claims which took into consideration the board's preliminary view.

- 4.3 The appellant argued that the amendments in claim 1 led to the same objection under Article 123(3) EPC as discussed for auxiliary request 1. Therefore, in view of the current state of the proceedings and for reasons of procedural economy, auxiliary request 2 should not be admitted according to Article 13 RPBA .
- 4.4 The board finds the appellant's line of argument convincing. Therefore, the board exercised its discretion under Article 13 RPBA 2007 and decided not to admit auxiliary request 2 into the appeal proceedings.
5. As the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted and none of the respondent's auxiliary requests is allowable, the patent has to be revoked (Article 101(2), first sentence, EPC and Article 101(3) (b) EPC).

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:



L. Gabor

R. Bekkering

Decision electronically authenticated