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**Datasheet for the decision
of 15 December 2021**

Case Number: T 1766/18 - 3.2.01

Application Number: 11782253.6

Publication Number: 2640590

IPC: B60K11/04, B60K11/08

Language of the proceedings: EN

Title of invention:

ADJUSTMENT DEVICE FOR AIR INLET, METHOD FOR ADJUSTING AN AIR
INLET WITH AN ADJUSTMENT DEVICE, MOTOR VEHICLE PROVIDED WITH
AN AIR INLET HAVING AN ADJUSTMENT DEVICE

Patent Proprietor:

MCi (Mirror Controls International)
Netherlands B.V.

Opponents:

Magna Auteca AG
Brose Fahrzeugteile GmbH & Co.
Kommanditgesellschaft Coburg

Headword:

Relevant legal provisions:

EPC Art. 100(a), 54, 56, 123(2)

Keyword:

Novelty - main request (no) - auxiliary request 1 (yes)
Late-filed auxiliary request 1 not admitted by the Opposition
Division - admitted (yes)
Amendments - auxiliary request 1 - extension beyond the
content of the application as filed (no)
Inventive step - auxiliary request 1 (yes)

Decisions cited:

G 0007/93

Catchword:



Beschwerdekammern
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Chambres de recours

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Case Number: T 1766/18 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 15 December 2021

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 May 2018
revoking European patent No. 2640590 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: J. J. de Acha González
 A. Jimenez

Summary of Facts and Submissions

- I. The appeal of the patent proprietor lies against the decision of the Opposition Division concerning the revocation of the European Patent No. 2640590.

The Opposition Division decided among others that:

- the subject-matter of granted claim 1 was not new in view of **D7** (DE 3506156 C1); and
- the late-filed auxiliary request 1 was not admitted under Rule 116(1) EPC since it *prima facie* did not fulfill the requirements of Article 123(2) EPC.

- II. With the statement of grounds of appeal, the appellant (patent proprietor) requested to set the decision of the Opposition Division aside and to maintain the patent as granted, or, in the alternative, to admit the claims according to the first auxiliary request, as filed during the oral proceedings before the Opposition Division, and to decide that their subject-matter is allowable under Article 123(2) EPC, and, if considered allowable, to remit the case to the Opposition Division for further prosecution, or, further in the alternative, to decide that one of the Auxiliary Requests 2 to 10 filed with the statement of grounds of appeal is allowable under Article 123(2) EPC, and, if considered allowable, to remit the case to the Opposition Division for further prosecution.

The respondent (opponent 1) did not file any submissions or requests in reply to the appellant's statement of grounds of appeal.

The opponent 2 withdrew the opposition during the opposition proceedings and therefore is not a party to these appeal proceedings.

- III. Following the summons to oral proceedings issued on 22 February 2021, the respondent informed with letter of 1 March 2021 that they would not attend the oral proceedings.
- IV. With communication of 13 September 2021 pursuant to Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal OJ EPO 2019, A63) the Board expressed its preliminary opinion according to which the main request was not allowable for lack of novelty over D7, but auxiliary request 1 was allowable. The Board further pointed out that a decision without oral proceedings could be issued if the appellant withdrew the request for oral proceedings.
- V. With letter of 13 October 2021 the appellant did not submit comments on the preliminary opinion but withdrew the request for oral proceedings and requested the continuation of the proceedings in writing and the reimbursement of the appeal fee at 25% under Rule 103(4)(c) EPC.
- VI. Oral proceedings scheduled for 13 January 2022 were thus cancelled.
- VII. Granted claim 1 according to the main request reads as follows:

"An adjustment device (1) for adjusting an air inlet of a motor compartment of a motor vehicle between at least a first position in which the air inlet is substantially open and a second position in which the

air inlet is substantially closed, comprising a drive unit (2) for adjusting the air inlet between at least the first position and the second position, characterised by comprising an auxiliary unit (4) which is arranged for adjusting the air inlet in case of a calamity for bringing the air inlet to a predefined position, comprising at least one energy storage element (5)."

Independent claims 1 and 11 according to auxiliary request 1 read as follows (differences with respect to claims 1 and 14 as originally filed highlighted by the Board):

"1. An adjustment device (1) for adjusting an air inlet of a motor compartment of a motor vehicle between at least a first position in which the air inlet is substantially open and a second position in which the air inlet is substantially closed, comprising a drive unit (2), comprising a drive and a drive train, wherein the drive is connected to the air inlet via the drive train, for adjusting the air inlet between at least the first position and the second position during normal use, characterized by comprising an auxiliary unit (4) which is arranged to couple with the air inlet for adjusting the air inlet in case of a calamity, for example in case of failure of the drive unit, for bringing the air inlet to a predefined position, comprising at least one energy storage element (5), wherein, during normal use the energy storage element (5) is free of the air inlet and/or the drive unit so that the drive unit does not experience any influence of the energy storage element (5), wherein, in the event of a calamity, the energy storage element, via an operating element, or via a part of the drive train of the drive unit, couples with the air inlet for

adjusting the air inlet, further comprising an activation element for activating the energy storage element, wherein the energy storage element provides energy for coupling with the air inlet and adjusting the air inlet, wherein the drive unit (2) is included in a housing and the energy storage element is also included in the housing of the drive unit."

"11. A method for adjusting an air inlet of a motor vehicle between at least a first position in which the air inlet is substantially open and a second position in which the air inlet is substantially closed by means of an adjustment device comprising a drive unit, comprising a drive and a drive train, wherein the drive is connected to the air inlet via the drive train for adjusting the air inlet between at least the first position and the second position during normal use and furthermore comprising an auxiliary unit which in case of failure of the drive unit couples with the air inlet for moving the air inlet to a predefined position, wherein the auxiliary unit comprises an energy storage element wherein, during normal use the energy storage element (5) is free of the air inlet and/or the drive unit so that the drive unit does not experience any influence of the energy storage element (5), wherein, in the event of a calamity, the energy storage element, via an operating element, or via a part of the drive train of the drive unit, couples with the air inlet for adjusting the air inlet, further comprising an activation element for activating the energy storage element, wherein the energy storage element provides energy for coupling with the air inlet and adjusting with the air inlet, wherein the drive unit (2) is included in a housing and the energy storage element is also included in the housing of the drive unit."

Reasons for the Decision

1. *Patent as granted - Novelty*

1.1 The Board sees no reason for deviating from the opinion put forward in the communication pursuant to Article 15(1) RPBA and thus confirms the view of the Opposition Division that the subject-matter of granted claim 1 is not new over the disclosure of D7 (Articles 100(a) and 54 EPC).

1.2 The appellant contested the reasoning of the opposition division, according to which "*claim 1 according to the main request does not indicate that the auxiliary unit works totally independent from the drive unit*". The appellant argued that it was clear that the auxiliary unit claimed was nothing else than an independent unit with its own energy supply for bringing the air inlet to a predefined position in case of calamity, when construing the patent by a mind willing to understand, not a mind desirous of misunderstanding. The spring 7, which was considered by the Opposition Division as the energy storage element of the auxiliary unit, exerted a force on a lid 6 of the air inlet to keep it closed in normal use. In case of a calamity (overheating) the lid 6 was opened against the spring force by an actuator ("Stellglied 8") activated by a temperature element ("Dehnstoffelement"). The spring 7 was actually part of the system that operated the air inlet in normal use and not an energy storage element being part of an auxiliary unit in accordance with the claim.

1.3 As set out in the communication pursuant to Article 15(1) RPBA, the Board agrees with the appellant that the claim should be read with a mind willing to understand as implying that the energy storage element supplies energy to the auxiliary unit in order to adjust the air inlet in case of a calamity. As also set out in the above-mentioned communication, however, D7 discloses that the element 8 of the auxiliary unit (which consists of lid 6, spring 7 and actuator ("Stellglied") 8), can be made of an expansion element ("Dehnstoffelement", see col. 3, l. 40 ff.), which itself provides the necessary force by releasing energy when (over)heated. Such an expansion element is also contemplated as a suitable energy storage element in the patent: as explained in para. 43 and claim 8 of the patent in dispute, the energy storage element may be in particular a memory metal element or a bimetal element, which, when an unduly high temperature is detected, releases the energy for adjusting the air inlet. As also stated in para. 43 of the patent, this expansion element functions as activation element, energy storage element and operating element.

As further stated in the above-mentioned communication, the auxiliary unit (7, 6, 8) of D7 represents a unit with an actuator 8 that works independently from the not further specified drive unit of the adjustment device (namely the drive unit for the friction drum 5, see col. 2, l. 65 ff.).

The disclosure in D7 of the remaining features of claim 1 was not contested by the appellant.

2. *Auxiliary request 1*

- 2.1 Auxiliary request 1 corresponds to auxiliary request 1 of the impugned decision. The Opposition Division did not admit the request because *prima facie* it did not fulfill the requirements of Article 123(2) EPC.

According to established case law of the Boards of Appeal, the Board should only overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion either that the first instance department in its decision has not exercised its discretion in accordance with the right principles, or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper limits of its discretion (see G 7/93, point 2.6).

In the Board's view the Opposition Division erred in its *prima facie* analysis as it is based on the false premise that claim 1 does not mention an operating element. However, claim 1 (see lines 15-16) is limited to the energy storage element being coupled with the air inlet via an operating element, or via a part of the drive unit, which in any case and also according to the patent itself, see col. 7, l. 34-36, is an operating element. Accordingly, an operating element is present and not optional. The Board thus judges that by disregarding a feature of the claim when making a *prima facie* assessment of the requirements of Article 123(2) EPC the Opposition Division exercised its discretion in an unreasonable way.

Consequently, the Board admits auxiliary request 1 into the proceedings.

2.2 The Board further shares the view of the appellant that the subject-matter of claims 1 and 11 does not extend beyond the content of the application as originally filed (Article 123(2) EPC). Claims 1 and 11 of auxiliary request 1 are based on originally filed claims 1 and 14 respectively and further on page 6, lines 9-17; page 10, line 24; page 9, lines 10-14; page 4, lines 20-25; claim 4; page 5, lines 11-13 and claim 13 of the application as originally filed. Its subject-matter does not thus go beyond the content of the application as originally filed.

2.3 Moreover, the subject-matter of claims 1 and 11 is new in view of the device of D7 since D7 fails at least to disclose the feature of a housing including the drive unit (drive and drive train) and the energy storage element in it (Article 54 EPC).

2.4 Additionally, the respondent did not raise any objections regarding novelty or inventive step for the subject-matter of auxiliary request 1 since the respondent did not file neither a reply to the appeal of the patent proprietor nor any submissions in this respect.

Also, the Board of its own motion has no reasons to question the allowability of the auxiliary request 1.

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 with the order to maintain the patent on the basis of the following documents:
 - claims 1 to 13 of the auxiliary request 1 filed with the statement of grounds of appeal;
 - drawings 1 to 3 as granted; and
 - a description to be adapted.

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated