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**Datasheet for the decision
of 25 August 2020**

Case Number: T 2092/18 - 3.2.01

Application Number: 12714090.3

Publication Number: 2688832

IPC: B66D1/74, B66D1/50, B66D1/52

Language of the proceedings: EN

Title of invention:
A DEVICE FOR TIGHTENING ROPE

Patent Proprietor:
Flamek Ltd

Opponent:
Rolls-Royce Marine AS

Headword:

Relevant legal provisions:
EPC R. 80
EPC Art. 123(2), 111(1)

Keyword:

Amendment occasioned by ground for opposition - Main request and auxiliary requests I-IV, VII and IX - (no)
Amendments - Auxiliary request V - added subject-matter (yes)
- Auxiliary request VI - added subject-matter (no)
Appeal decision - remittal to the department of first instance (yes)

Decisions cited:

G 0002/10

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 2092/18 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 25 August 2020

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 8 June 2018
revoking European patent No. 2688832 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: J. J. de Acha González
O. Loizou

Summary of Facts and Submissions

- I. The appeal of the patent proprietor lies against the decision of the Opposition Division revoking European patent 2688832.

In its decision the Opposition Division found that none of the requests satisfied the requirements of Article 123(2) EPC and Rule 80 EPC with respect to amendments carried out to claim 1 and dependent claim 3.

- II. Oral proceedings in accordance with Rule 115(2) EPC and Article 15(3) RPBA 2020 (Rules of Procedure of the Boards of Appeal OJ EPO 2019, A63) were held in the absence of the parties as notified with letter dated 21 August 2020 (patent proprietor) and with email dated 10 August 2020 (opponent) respectively. Accordingly, the parties were treated as relying only on their written case.

- III. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request, or in the alternative on the basis of any one of the auxiliary requests I to VII filed with letter dated 22 May 2020 or according to auxiliary request IX filed with letter dated 24 August 2020. In case of a remittal to the department of first instance the appellant requested a different composition than the one that decided the decision under appeal. Further the appellant requested reimbursement of the appeal fee. Auxiliary request V had been replaced with auxiliary request V filed with letter dated 21 August 2020.

The respondent (opponent) requested that the appeal be dismissed. In case the decision under appeal is set aside the respondent requested remittal to the department of first instance for the assessment of novelty and inventive step.

IV. The main request and the auxiliary requests I to IV as well as the auxiliary requests VII and IX all include the following dependent claim 3 (amendments with respect to granted claim 3 highlighted by the Board):

"3. The device of claim 1 or 2, additionally comprising separate guide sheaves (9, 9').".

Auxiliary request V comprises 9 claims corresponding to granted claims 1 to 8 and 10, wherein claims 1, 6, 7, 8 and 9 read as follows (differences with respect to claims 1, 6, 7, 8 and 10 as granted highlighted by the Board):

"1. A device for tensioning of a rope, the device comprising two or more sheaves (6, 6'), ~~each sheave (6, 6')~~ being operated by a motor ~~(7, 7')~~ ~~having a breaking capability~~, where a rope (10) to be tensioned may be arranged so that it sequentially rests against the sheave surface of the sheaves of the device, the sheaves (6, 6') being movable in order to vary the contact angle of the rope around each sheave, ~~characterized in that~~ wherein the sheaves (6, 6') are arranged in pairs on a rotatable support (2), said rotatable support (2) being rotatable between a first rotational position in which the rope (10) may pass unhindered between the pair of sheaves (6, 6'), and a second, variable rotational position in which the rope (10) has been wound to a substantially equal contact angle about the sheaves, characterized in that each

sheave (6,6') is operated by a separate motor (7,7') having a braking capability, and that a rolling-element bearing in the form of a slewing ring is arranged between the rotatable support (2) and a stationary main body (1) for providing a rotatable connection there between."

"6. The device of any one of the preceding claims 1-4, wherein two or more rotatable supports (2) are operated by one common actuator (3).",

"7. The device of any one of the preceding claims, wherein ~~the axes of rotation of~~ the sheaves (6, 6') are placed on either side of the axis of rotation (14) of the rotatable support (2) and equidistant therefrom.",

"8. The device according to any one of the preceding claims 1-6, wherein the axis of rotation of one of the sheaves (6') coincides with the axis of rotation (14) of the rotatable support (25).", and

~~"109~~. The device according to any one of the preceding claims, wherein the device is oriented vertically and is pivotally mounted about a vertical axis at the side of a ship so that it can be swung out from the side of the ship."

Auxiliary request VI differs from auxiliary request V in that the feature "being operated by a motor" of claim 1 has been replaced by "being motor operated", claim 7 has been deleted and claims 8 and 9 renumbered to claims 7 and 8. Further, claim 7 refers back to any of the preceding claims.

Reasons for the Decision

1. Admissibility of amendments - Rule 80 EPC

The main request and the auxiliary requests I to IV, VII and IX comprise all the same dependent claim 3 which differs from granted dependent claim 3 in that it further includes the wording "separate" before "guide sheaves". In its decision the Opposition Division took the view that this amendment contravened the requirements of Rule 80 EPC (see points 2.3.2 and 2.4 of the contested decision).

According to Rule 80 EPC claims of a European patent may be amended during opposition proceedings, provided that the amendments are occasioned by a ground for opposition under Article 100 EPC, even if that ground has not been invoked by the opponent. Further, pursuant to Rule 100(1) EPC said provision applies also to the appeal proceedings.

The appellant alleged that the amendment to dependent claim 3 aimed at establishing novelty and inventive step with respect to the objections raised by the opponent in the notice of opposition to granted claim 3 and, accordingly, occasioned by the ground of opposition pursuant to Article 100(a) EPC.

The Board disagrees. The amendment to the granted dependent claim 3 which remains a dependent claim in the amended patent cannot be used to restore novelty and inventive step of the claimed subject-matter, as it does not limit the scope of independent claim 1. The amendment namely provides a further limitation for the

particular embodiment (Rule 43(3) EPC) defined by claim 3 but does not restrict the matter for which protection is sought, which is defined in its broadest terms by independent claim 1. Consequently, the amendment to dependent claim 3 is not occasioned by a ground for opposition and does not thus meet the requirements of Rule 80 EPC.

Accordingly, the main request and auxiliary requests I to IV, VII and IX are not allowable for this reason.

2. Auxiliary request V - Article 123(2) EPC

2.1 *Claim 1*

2.1.1 Claim 1 of auxiliary request V is based on claim 1 as originally filed and it additionally includes the following feature:

- (i) "a rolling-element bearing in the form of a slewing ring is arranged between the rotatable support (2) and a stationary main body (1) for providing a rotatable connection there between."

2.1.2 Pursuant to Article 123(2) EPC a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. According to the established case law of the Boards of Appeal the criterion for assessing whether the amendment introduces subject-matter extending beyond the content of the application as originally filed is the "gold standard", i.e. whether the claimed subject-matter is derivable directly and unambiguously for the skilled person using common general knowledge from the European patent application as originally filed (see e.g. point 4.3 in the Decision

of the Enlarged Board of Appeal G 2/10, OJ EPO 2012, 376).

In the case at hand, the added feature (i) to claim 1 does not result in subject-matter which is not present in its general form in the application as originally filed. Specifically, according to all embodiments of the invention disclosed in the application as originally filed (see international publication of the application, in particular page 5, last paragraph, page 7, fourth paragraph and page 8, third paragraph) the disclosure of the slewing ring is such that it is placed between the rotatable support and the main body of the device. The slewing ring represents merely the means for rotating of the rotatable support which can be substituted by any other suitable means fulfilling that function. Consequently, there is no functional and structural relationship between the slewing ring and the other features shown in the specific embodiments since the slewing ring can be replaced by any other suitable means. There is thus no further technical information added with respect to the application as originally filed.

2.1.3 The Opposition Division in its decision and the respondent argued that the subject-matter of claim 1 represents a intermediate generalisation of the two preferred embodiments disclosed in the application as originally filed since feature (i) has been taken in isolation from others features disclosed in combination within the description of those two embodiments. In particular, the slewing ring in the first embodiment is part of the rotatable support and placed between the static member of the rotatable support and its rotary member. The slewing ring in the second embodiment is arranged at an end of the rotatable support arm.

2.1.4 The Board disagrees and shares the view of the appellant. Specifically, the skilled person derives directly and unambiguously from the application as originally filed that the at least two sheaves are arranged on a support that is rotatable between the first and second positions claimed. The two specific embodiments in the description show two possible ways of carrying out the invention and in both of them the rotatable support rotates between the two mentioned positions with respect to the main body. Further, the description of the two embodiments discloses the use of a slewing ring as a possible way of rotatably mounting the support to the main body. As a consequence, the skilled person derives from the application as originally filed that a slewing ring is a suitable and possible way for mounting the support to the main body for its relative rotation irrespective of the other features of the tensioning device. Accordingly, there is no further technical information added with feature (i). This is confirmed by the third paragraph on page 8, disclosing that for the relative rotation between support and main body other known means are available to the skilled person.

2.2 *Dependent claims 7, 8 and 9*

2.2.1 Dependent claims 7, 8 and 9 correspond to granted claims 7, 8 and 10, wherein claim 7 the feature "the axes of rotation of" has been deleted. These claims do not represent originally filed dependent claims and were added when the international application entered the European phase.

2.2.2 The respondent argued that the features of these claims lack proper basis in the original patent application as

they are isolated features taken from the particular embodiments described in the specification. These features were originally disclosed in combination with further features.

2.2.3 The same criterion as presented above under point 2.1.2 applies to evaluate whether the subject-matter of these dependent claims extends beyond the content of the application as originally filed.

2.2.4 The features of claim 7 - "the sheaves (6, 6') are placed on either side of the axis of rotation (14) of the rotatable support (2) and equidistant therefrom" - are based on the first paragraph of page 6 of the description of the application as originally filed (reference is made to the international publication of the application). According to that passage, the following underlined features are in functional and structural relationship with those features, which together define the position and function of the sheaves within the rotatable support:

"Two sheaves 6, 6' are arranged on each of the rotatable supports 2, both having an axis of rotation that is substantially parallel to the axis of rotation 14 of the turntable(s). The two sheaves are arranged on a common diameter of the turntable 2, one on either side of and at equal distance to the axis of rotation 14 for the turntable 2 and with a distance to each other to allow a rope to be placed or removed by displacement in the direction of the axis of rotation. The drums 6, 6' are operated by motors 7, 7', such as electrical or hydraulic motors that also act as brakes."

The omission of the features represents an unallowable intermediate generalisation of the position of the sheaves within the rotatable support derived from the originally filed documents and consequently the amendment according to claim 7 contravenes the provisions of Article 123(2) EPC.

For this reason auxiliary request V is not allowable.

- 2.2.5 Regarding the subject-matter of dependent claims 8 and 9 the Board shares the view of the appellant that this subject-matter does not extend beyond the content of the application as originally filed (Article 123(2) EPC).

The subject-matter of dependent claim 8 finds support in paragraph 4 of page 7 of the application as originally filed. This paragraph reads:

"Figures 4 and 5 illustrate a further embodiment of the invention. The rotatable support 5 for the sheaves 6, 6' here takes the form of an arm of plate material. The components for rotating the support 5 are located at one end of the support and may take a form similar to that of Figure 3, e.g. with a slewing ring and driving motor. One of the sheaves 6' is arranged with its axis of rotation coincident with the axis of rotation 14 of the support arm 5. The other sheave 6 is arranged at the opposite end of the support arm. Upon bringing the device from inactivated to activated condition, the support arm 5 is rotated counterclockwise from the position in Figure 4 to the position in Figure 5."

Since according to claim 1 the rope passes between the two sheaves in the first position of the support and the rope is wound to a substantially equal contact

angle about the sheaves in its second position, the omission of the other sheave being arranged at the opposite end of the support does not add further technical information since this position is implicit from the other features of claim 8 in view of its dependency to claim 1.

The subject-matter of dependent claim 9 is based on the last paragraph of page 7. According to that passage the device according to the invention is oriented vertically and mounted pivotally about a vertical axis at the side of the ship so that it may be swung outwards to reach over the side of the ship. The Board in line with the appellant cannot identify any unallowable intermediate generalisation in the subject-matter of claim 9.

Consequently, the subject-matter of claims 8 and 9 meets the requirements of Article 123(2) EPC.

3. Auxiliary request VI

Since claim 1 of auxiliary request VI differs from claim 1 of auxiliary request V in that the feature "being operated by a motor" has been replaced by "being motor operated", its resulting subject-matter does not change because the claim also specifies that each sheave is operated by a separate motor. Therefore, for the same reasons as for the auxiliary request V, the subject-matter of claim 1 does not extend beyond the content of the application as originally filed (Article 123(2) EPC).

Moreover, as dependent claim 7 of auxiliary request V has been deleted, the subject-matter of the claims of auxiliary request VI meets the requirements of Article 123(2) EPC (see point 2 above).

Further, the reasons under Rule 80 EPC for claims 1 and 3 of the contested decision maintained by the respondent in its reply to the grounds of appeal do not apply because the amendments in question are no longer present in claim 1 and claim 3. The Board is satisfied that the amendments to claim 1 according to auxiliary request VI comply with the requirements of Rule 80 EPC since they are at least occasioned by the ground of opposition of novelty (Article 100(c) EPC). The respondent did not raise any objections for claim 1 of auxiliary request VI under Rule 80 EPC.

As a consequence, the decision under appeal must be set aside since the reasons for the revocation of the patent do not apply to auxiliary request VI.

4. Remittal to the Opposition Division

The impugned decision is only based on Article 123(2) EPC for the subject-matter of claim 1 and Rule 80 EPC for claims 1 and 3 of all the requests then pending before the Opposition Division.

Under Article 111(1) EPC the Board of Appeal may either decide on the appeal or remit the case to the department which was responsible for the decision appealed.

Under Article 11 RPBA 2020 the Board may remit the case to the department whose decision was appealed if there are special reasons for doing so.

The appellant requested to not remit the case to the Opposition Division to discuss novelty and inventive step since it would be a financial burden and unfair to

the patent proprietor who was a private person and, additionally, since it would be highly unlikely that such a remittal would render a negative decision on novelty or inventive step by the Opposition Division bearing in mind the state of the art at hand. If the Board decided to remit the case to the Opposition Division, the appellant further requested that the further prosecution of the case be done with another composition of the Opposition Division than that which took the contested decision.

The Board holds that the special reasons under Article 11 RPBA 2020 are immediately apparent in the present case as the contested decision does not deal with the issues of novelty and inventive step (Article 54 and 56 EPC) for any of the requests that were considered. The primary object of the appeal procedure is to review the decision of the first instance department in a judicial manner (see Article 12(2) RPBA 2020).

The Board further shares the view of the respondent that if particular concern were to be taken to the financial situation of a party, that would go against the principle of procedural equality of the parties to the proceedings. Such a reason cannot justify depriving the respondent (opponent) of a two instance procedure with respect to issues never considered by the Opposition Division. In this context, the argument that a negative decision on novelty and inventive step would be issued, as put forward by the appellant, is rather speculative since the Opposition Division neither presented its preliminary view on novelty and inventive step nor decided on it.

Regarding the request for changing the composition of the Opposition Division, the appellant did not give any reasons and the Board does not see any defects in the

first-instance proceedings that might justify such change. In particular, the Opposition Division neither gave a preliminary opinion of the remaining issues, i.e. novelty and inventive step, nor did it discuss them during the oral proceedings before it (see Case Law of the Boards of Appeal of the EPO, 9th Edition, III.J.4.2). The Board thus does not identify any need for a change of composition of the Opposition Division upon remittal.

It still remains to be discussed whether the amendments to dependent claims 6 and 7 satisfy the requirements of Rule 80 EPC. However, since the Opposition Division in its decision only decided on those requirements for claims 1 and 3 of all requests before it and since the objection to the other dependent claims of the respondent in the reply appear to be unsubstantiated and purely formalistic (reference numbers and claim references added or amended; see first paragraph on page 4 of the reply to the statement of grounds of appeal) the Board considers that these issues can be dealt with more expediently by the Opposition Division.

Under these circumstances, the Board considers it appropriate to remit the case to the Opposition Division for further prosecution on the basis of auxiliary request VI.

5. Reimbursement of the appeal fee

The appellant requested with the notice of appeal the reimbursement of the appeal, however they did not justify the request. Further, with letter of 22 May 2020 the reimbursement would be justified since *"the opposition division, on their own motion,*

inventing in our view a groundless objection they would not reconsider."

According to Rule 103(1)(a) EPC the appeal fee shall be reimbursed in full where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

In the present case, the appellant requested the reimbursement of the appeal fee merely by reason of an alleged error of judgement of the Opposition Division and did not substantiate any substantial procedural violation carried out by the first instance department (see Case Law of the Boards of Appeal of the EPO, 9th Edition, V.A.9.5.10). The Board does not identify any substantial procedural violation in the opposition proceedings that would justify such a reimbursement. Accordingly, the request for reimbursement is refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of the claims of auxiliary request VI filed with letter dated 22 May 2020.

The Registrar:

The Chairman:



D. Magliano

G. Pricolo

Decision electronically authenticated