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Bezeichnung der Erfindung: A railway vehicle brake block holder

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : B61H 13/38

**ENTSCHEIDUNG / DECISION**

vom / of / du 7 December 1987

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet : SAB Industri AB

Einsprechender / Opponent / Opposant : Knorr Bremse GmbH

Stichwort / Headword / Référence : Vehicle brakes/SAB

EPO/EPC/CBE Rule 64(b), Article 123(3) EPC

Kennwort / Keyword / Mot clé : "Interpretation of notice of appeal" -  
"Amendment extending the protection conferred"

Leitsatz / Headnote / Sommaire

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : T 89 /85

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.1  
of 7 December 1987

**Appellant :**  
(Proprietor of the patent) SAB Industri AB  
Legal Service, PO Box 515  
S-26124 Landskrona (SE)

**Representative :**  
Petri, Stellan  
SAB Industri AB, Box 515  
S-26124 Landskrona (SE)

**Respondent :**  
(Opponent) Knorr Bremse GmbH  
Postfach 401060  
8 München 40

**Representative :**

**Decision under appeal :** Decision of Opposition Division of the European Patent Office dated 29 January 1985 revoking European patent No. 0 018 050 pursuant to Article 102(1) EPC.

**Composition of the Board :**

**Chairman :** P. Delbecque  
**Members :** C.T. Wilson  
G.D. Paterson

### Summary of Facts and Submissions

- I. European patent No. 0 018 050 was granted with eight claims on the basis of European patent application No. 80 200 345.9 on 28 July 1982.
  
- II. The opponent filed a notice of opposition on 8 April 1983, in which he requested revocation of the patent under Article 100(a) EPC both on grounds of lack of novelty and of inventive step. The opposition was based upon the following prior documents:

- (1) US-A-175 886
- (2) US-A-3 017 960

During the course of the opposition proceedings the Opponent also referred to the following documents:

- (3) DE-U-1 977 451
- (4) US-A-3 572 475
- (5) UD-A-2 940 533
- (6) US-A-3 430 740
- (7) US-A-3 707 208
- (8) DE-C-390 083

The notice of opposition was duly communicated to the Patentee together with an invitation to file amendments, where appropriate, in accordance with Rule 57(1) EPC. In his response filed on 22 August 1983 the Patentee filed an amended Claim 1 and requested that the patent be maintained with this amended Claim 1 and Claims 2 to 8 as granted, having regard to the arguments which were also submitted.

Such amended Claim 1 reads as follows:

"1. A railway vehicle brake block holder for a tread brake unit (1), with brake block hangers (9) pivotally attached to a bracket (8) of the brake unit and to the brake block holder (11), and with an arrangement substantially at or near the center of the brake block holder for connection to a brake force applying push rod (3) movable for brake force transmission in its longitudinal direction, characterized in that, from its pivotal attachment to the bracket (8) of the brake unit, each brake block hanger (9) extends downwardly beyond the center of the brake block holder (11) and is pivotally attached (at 12) to the lower part of the brake block holder and in that said connection arrangement includes means (23) for holding the brake block holder automatically stabilized in a position substantially parallel with the tread of the wheel to be braked."

III. On 9 April 1984 the Opposition Division issued a Communication pursuant to Article 101(2) and Rule 58(1) to (3) EPC, in which it was stated that Claim 1 had been amended in such a way as to extend the protection conferred, which was contrary to Article 123(3) EPC, and that the amended Claim 1 was therefore not acceptable. It was also stated that even if Claim 1 was further amended in a way which did not contravene Article 123(3) EPC, such an amended claim would appear not to contain an inventive step, contrary to Article 56. The Communication ended by saying that an amended Claim 1 containing all of the essential features of Claims 1, 4 and 7 as set out in the specification would appear to be acceptable. The Communication invited the Patentee to file observations and amendments.

In his response filed on 21 July 1984, the Patentee contested the objections raised under Articles 123(3) and 56 EPC, and stated that he did not consider that limitation of the scope of Claim 1 so as to include the features of Claims 1, 4 and 7 was justified.

- IV. By a Decision dated 29 January 1985 the Opposition Division revoked the European patent in accordance with Article 102(1) EPC on the grounds that the amended Claim 1 contravened Article 123(3) EPC and that Claim 1 without amendment did not involve an inventive step in the light of US-A-175 886 together with US-A-3 572 475 and the general knowledge of the person skilled in the art.

In its Decision the Opposition Division pointed out that it had informed the Patentee that a combination of the granted Claims 1, 4 and 7 would have been judged as involving an inventive step, but that the Patentee had been unwilling to amend the present Claim 1 as suggested.

- V. The Patentee filed a letter headed "Notice of Appeal" on 22 March 1985, at the same time paying the appeal fee. In his notice of appeal the Patentee stated as follows: "By decision ... dated ... our European Patent No. ... was revoked. This decision is hereby appealed, and the relevant appeal fee ... is paid... It is requested that "the revoked patent is reinstated on the basis of claims limited in a way earlier suggested by the Opposition Division". In a statement of grounds of appeal filed on 17 May 1985 the Patentee argued for maintenance of the patent with the amended Claim 1 filed on 22 August 1983 as his main request, and as a subsidiary request he asked for maintenance of the patent with amended Claims 1 to 6 as filed with the statement of grounds of appeal. The new Claim 1 of the subsidiary request is based on a

combination of the granted Claims 1, 4 and 7 and reads as follows:

"1. A railway vehicle brake block holder for a tread brake unit (1), with brake block hangers (9) pivotally attached to a bracket (8) of the brake unit and to the brake block holder (11), and with an arrangement substantially at or near the center of the brake block holder for connection to a brake force applying push rod (3) movable for brake force transmission in its longitudinal direction, wherein - from its pivotal attachment to the bracket (8) of the brake unit - each brake block hanger (9) extends downwardly beyond the center of the brake block holder (11) and is pivotally attached (at 12) to the lower part of the brake block holder and wherein said connection arrangement includes means (23) for holding the brake block holder automatically stabilized in a substantially vertical position, characterized in that in the brake block holder (11) is attached a curved cradle (14), in which is arranged a force transmitting member (15) having a front surface with a shape corresponding to the cradle and a flat back surface for force receiving cooperation with a push plate (5) attached to the end of the push rod (3), and in that the connection arrangement between the push rod (3) and the brake holder (11) includes resilient elongated holding means, preferably a bundle of leaf springs (23), abutting spaced apart support means (22) in the brake block holder with its ends and the push plate (5) with its central part."

VI. In his observations in response to the statement of grounds of appeal, the Respondent stated that whereas he would raise no objections against the maintenance of the patent with claims in accordance with subsidiary request as filed on 17 May 1985, he considered that the main

request was not allowable. He submitted that the notice of appeal was quite clearly restricted to maintenance of the patent with narrower claims as previously suggested by the Opposition Division, and that since the grounds of appeal were only filed after the two-month period allowed for filing the notice of appeal, third parties would be entitled to assume that the broader protection had been abandoned. He therefore requested that the main request be refused.

VII. In a communication dated 8 September 1987, the Board set out its preliminary view, namely:

- i) the notice of appeal should be interpreted as requesting, in accordance with Rule 64(b) EPC, that the decision to refuse should be cancelled in its entirety, without providing any limitation as to the grounds for such request,
- ii) Claim 1 of the main request did not appear allowable, since it extends the protection conferred, and
- iii) the Board would consider submitting the case to the Opposition Division in order that it should examine and decide on the subsidiary request.

VIII. Both Parties replied that they had no objections to the further processing of the case on the basis of the subsidiary request.

#### **Reasons for the Decision**

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible. However, in respect of Rule 64(b) EPC, an examination to determine how the notice of appeal is to be interpreted, is necessary.

## 2. Interpretation of notice of appeal

The first question to be decided is whether the content of the notice of appeal is such as to preclude the Appellant from requesting that his patent should be maintained with claims in accordance with the main request set out in the statement of grounds of appeal, as was submitted by the Respondent for the reasons set out in paragraph VI above.

The Decision of the Opposition Division dated 29 January 1985 was that, in accordance with Article 102(1) EPC, the European patent including Claim 1 as submitted on 22 August 1983 should be revoked. The grounds for such decision are set out on pages 1 to 10 attached to the Decision, and these must be distinguished from the decision itself.

The minimum essential contents of a notice of appeal are set out in Rule 64 EPC. Sub-paragraph (b) requires "a statement identifying the decision which is impugned and the extent to which amendment or cancellation of the decision is requested". As was stated in Decision J 22/86 "Disapproval/Medical Biological" (OJ EPO 1987, page at paragraph 2), these requirements for a notice of appeal are essentially formal in nature.

In the present case the notice of appeal clearly identified the impugned decision. In addition it stated (so far as relevant) (i) "This decision is hereby appealed", and (ii) "It is requested that the revoked patent is reinstated on the basis of claims limited in a way earlier suggested by the Opposition Division".



As stated above, the Decision of the Opposition Division was that the patent including Claim 1 as submitted on 22 August 1983 should be revoked. In this circumstance, if the Appellant is to achieve maintenance of his patent with any form of text by way of his appeal, it is clearly essential that such Decision to revoke is cancelled. "Amendment" of the decision to revoke is meaningless in this context.

In the Board's view, whether or not the requirement in Rule 64(b) EPC set out above has been fulfilled must be decided having regard to the particular circumstances of each case. In other words, the particular wording of the notice of appeal must be interpreted in the context of its case, and in particular having regard to the nature of the decision under appeal.

In the present case, the Respondent has submitted that the statement (ii) above is a statement of "the extent to which amendment or cancellation of the decision is requested", and should be interpreted as stating that the Appellant only requests the decision to be amended or cancelled to the extent that the claims previously suggested by the Opposition Division should be allowed. The Board does not agree with this submission. In the Board's judgement the proper interpretation of the notice of appeal is as follows:

- (a) The statement (i) set out above should be interpreted as being a request for cancellation of the decision (in its entirety).
- (b) The statement (ii) should be interpreted, not as being a statement in accordance with Rule 64(b) EPC, but as being a statement additional to the notice of appeal, and in effect being a ground for the appeal.

In other words, the notice of appeal as a whole should be interpreted as saying that the decision of the Opposition Division should be cancelled; furthermore, that as a ground of appeal, the Appellant requests grant of the patent with claims as previously suggested by the Opposition Division. The inclusion of statement (ii) does not limit the notice of appeal, and does not preclude the submission of further grounds of appeal.

This interpretation of the notice of appeal in the present case is consistent with the approach which was adopted by the Board of Appeal in Decision T 07/81 "Dyeing of linear polyamides/CIBA-GEIGY", OJ EPO 3/1983, page 98.

### 3. Main Request

3.1 The amended Claim 1 differs from the granted Claim 1 in the following ways:

3.1.1 The following feature of the granted Claim 1

"including means (23) for holding the brake block holder stabilised in a substantial vertical position"

has been replaced by the feature

"including means (23) for holding the brake block holder automatically stabilised in a portion substantially parallel with the tread of the wheel to be braked".

Insofar as the claim is no longer restricted to stabilising the holder in a substantially vertical position, this amendment clearly extends the protection conferred.

The Appellant contends that the question of whether an amendment extends the protection conferred (Article 123(3)) is dependent on the question of whether the amendment is made within the content of the application as filed (Article 123(2)). These are however completely different questions, quite independent of each other. In the present case, it is quite obvious that the arrangement of the holder could be defined in Claim 1 in many ways (see for example column 3, lines 33-37 or column 5, lines 49-53), but the Appellant had chosen his particular definition before grant and, unless he can show an obvious error, he is unable to change this definition in a way which would extend the protection conferred.

The correction of errors is provided for by Rule 88. However, to allow a correction to a claim under this Rule, it must be evident that an error has occurred and it must be evident that nothing other than the proposed correction would have been intended. It is not clear in the present case that an error has occurred, and clearly therefore no correction could be obvious.

3.1.2 In the granted Claim 1, lines 3-5, it is clear that the hangers are "pivotally attached to a fixed part, preferably a bracket". In the amended claim the hangers are defined as being "pivotally attached to a bracket", i.e. it is no longer necessarily restricted to a fixed part". This constitutes an unallowable extension of the protection conferred.

3.2 Claim 1 of the main request is not therefore allowable, since it extends the protection conferred, and no consideration of its possible patentability need be undertaken.

#### 4. **Subsidiary request**

Amendment of the claims during an opposition proceeding (including during the appeal stage of an opposition proceeding) is a matter of discretion under Rules 57 and 58 EPC - see in particular Rules 57(1) and 58(2) EPC, which provide for amendment only by invitation.

In the circumstances of this case, and having regard to its views as set out in paragraph 3 above in relation to the main request, the Board has therefore decided to exercise its power under Article 111(1) EPC, to remit this case to the Opposition Division in order that it should examine and decide:

(i) whether in the exercise of its discretion under Rule 58 EPC the further amendments to the claims proposed by way of the subsidiary request can be made;

(ii) if such amendments can be made, whether such amended claims are allowable.

#### **Order**

**For these reasons, it is decided that:**

- (i) the contested decision is set aside;
- (ii) the main request has been rejected;

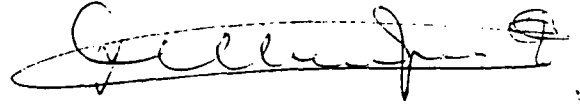
(iii) the case is remitted to the Opposition Division for further prosecution in relation to the proposed Claims 1 to 6 filed with the statement of grounds on 17 May 1985.

The Registrar

The Chairman

*S. Fabiani*

S. Fabiani



P. Delbecque

