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D E C I S I O N
of 25 November 1998

Case Number: T 1106/97 - 3.2.1
Application Number: 89202863.0
Publication Number: 0418431
IPC: B63H 21/22

Language of the proceedings: EN

Title of invention:
Remote control of engine functions

Patentee:
W. H. Den Ouden N.V.

Opponent:
Mathers Micro Commander (MMC Inc)

Headword:
-

Relevant legal provisions:
EPC Art. 99(1)
EPC R. 55(c), 56(1)

Keyword:
"Admissibility of opposition (yes)"

Decisions cited:
T 0328/87

Catchword:
-



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Boards of Appeal

Chambres de recours

Case Number: T 1106/97 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 25 November 1998

Appellant:
(Opponent) Mathers Micro Commander (MMC Inc)
675 Pease Road
Burlington, WA 98233 (US)

Representative: de Vries, Erik Eduard
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P.O. Box 29720
2502 LS 's-Gravenhage (NL)

Respondent:
(Proprietor of the patent) W. H. Den Ouden N.V.
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Representative: Lips, Hendrik Jan George, Ir.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 3 September 1997
rejecting the opposition filed against European
patent No. 0 418 431 as inadmissible pursuant to
Rule 56(1) EPC.

Composition of the Board:

Chairman: F. A. Gumbel
Members: S. Crane
V. Di Cerbo

Summary of Facts and Submissions

- I. European patent No. 0 418 431 was granted on 9 February 1994 on the basis of European patent application No. 89 202 863.0.

Granted claim 1 reads as follows:

"Device for the remote control of engine functions by applying push-pull cables (3,4) connected to the operating levers (15,16) of a fuel engine for operating the reverse clutch and the fuel supply resp., said device comprising an electronic control unit (19) connected to a direct voltage source (17) with a housing (2) with in it two control systems, each comprising an adjusting motor (5,5a) for moving the related push-pull cable (3,4) which via a bushing is passed to outside the housing (2) and with its other end is connected to the related operating lever (15,16) of the engine, at least one control mechanisme (21) comprising an operating handle (22) being positioned at a distance of the control unit (19) and connected to this by means of an electric cable (20), characterised in that each of said control systems consists of a switch shaft coupled with a swinging arm mechanisme comprising a gear wheel segment (7) the tothing of which engages the tothing of a gear wheel (8) with which a first rotating control potentiometer (9,9a) is coupled which is electrically connected to a second control potentiometer coupled with the operating handle (22), said electronic control unit (19) comparing the electric signals derived from said first and said second control potentiometer, the related adjusting motor (5,5a) rotating the switch shaft when the difference exceeds a setting threshold value so far till the difference between the first and second potentiometer is readjusted."

Dependent claims 2 to 4 relate to preferred embodiments of the device according to claim 1.

- II. The granted patent was opposed by the present appellants who requested that it be revoked in its entirety for lack of inventive step.
- III. With its decision posted on 3 September 1997 the Opposition Division rejected the opposition as inadmissible.
- IV. A notice of appeal against this decision was filed on 3 November 1997 and the fee for appeal paid at the same time. The statement of grounds of appeal was received on 24 November 1997.

In this statement the appellants argued that the Opposition Division had not taken proper account of the fact that the documents submitted with the notice of opposition were intended to illustrate more fully the closest state of the art already recognised as such in the patent specification and on which the preamble of claim 1 was based. Furthermore, the contested decision did not pay due regard to the fact that two prior art documents, D1 and D10, had been referred to in the notice of opposition in relation to the question of inventive step.

- V. The statement of grounds of appeal was sent to the respondents (proprietors of the patent) with an official communication dated 5 December 1997. They did not reply and have taken no part in the appeal proceedings.

Reasons for the Decision

1. The appeal complies with the formal requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is therefore admissible.

2. In the course of the pre-grant examination proceedings the appellants, with a letter dated 14 August 1991, filed observations under Article 115 EPC as a third party. The observations concerned their product the (Mathers) "Micro Commander Control" which they alleged had been introduced to the public at the Miami Boat Show in February 1987 and of which 7000 units had since been sold.

With a communication dated 21 September 1992 the Examining Division stated that it considered the "Micro Commander Control" to belong to the state of the art and that it used the same principles as suggested in the application. The applicants (present respondents) were therefore requested "to complete the description according to Rule 27(1)(b)" and "present an independent claim having due regard (Rule 29(1)) to the Micro Commander Control."

With a reply dated 18 March 1993 the applicants submitted new claims and a revised description. The first and second sentences of the description, which correspond to those of the granted patent specification read:

"The invention relates to a device according to the preamble of the main claim. Such a device is known as the MATHERS Micro Commander Control."

3. In the notice of opposition the appellants refer in the first place to the communication of the Examining Division of 21 September 1992 and the reply of 18 March 1993, mentioned above, and comment that in the light of these there can be no doubt about the fact that the "Mathers Micro Commander Control" belongs to the state of the art.

They then go on to analyse the characterising clause of claim 1 into three main features labelled (a), (b) and (c) concerning respectively the coupling of a switch shaft with a swinging arm mechanism comprising a gear wheel segment; the engagement of the gear wheel segment with a gear wheel coupled to a first rotating control potentiometer; and the coupling of a second control potentiometer with the operating handle, with the electronic control unit comparing the signals derived from the first and second control potentiometers and actuating the adjusting motor when the difference between the signals exceeds a threshold value.

The appellants argue in the notice of opposition with reference to documents D7 and D9 (designated Enclosures VI and VIII in the opposition letter) that the features (b) and (c) were also present in the prior used "Micro Commander Control". With regard to feature (c) they also refer to the disclosures of documents D1 (US-A-4 739 236) and D10 (GB-A-320 078). They therefore conclude that the only difference between the known "Micro Commander Control" and the claimed device is feature (a), in other words that the known worm drive has been replaced by a swinging arm mechanism comprising a gear wheel segment. They acknowledge that this feature confers novelty on the subject-matter of claim 1 but argue, with reference to document D8 (Enclosure VII), that it is merely one of several simple design possibilities open to the person skilled in the art and does not involve an inventive step.

4. In the contested decision the Opposition Division quotes from the Guidelines for Examination in the EPO, Part D, V-3.1.2 that in order to determine whether prior use has taken place before the priority date of the patent at issue it is necessary to be able to identify the following:

- The date on which the alleged use occurred, i.e. whether there was any instance of use before the relevant filing date.
- What has been used, in order to determine substantive correspondence between the object used and the subject-matter of the Patent.
- All the circumstances relating to the use, by which it was made available to the public, as for example the place of use and the manner of use.

In the opinion of the Opposition Division the only occasion of alleged prior use occurring before the relevant date was at the Miami Boat Show in 1987. On the basis of the evidence submitted with the notice of opposition there was however no way of knowing what features the exhibited "Micro Commander Control" possessed or whether those features had actually been made available to the public by means of the device having been exhibited. The Opposition Division therefore came to the conclusion that the indication of facts and evidence contained in the notice of opposition were insufficient to enable a determination of the essential details of the alleged prior use to an extent that permitted the proprietors of the patent (present respondents) and the Opposition Division to identify the case to be answered (cf. Guidelines, D-IV, 1.2.2.1(e)), so that the requirements of Article 99(1) and Rule 55(c) EPC had not been met.

5. In general terms the approach adopted by the Opposition Division corresponds with that espoused by the Boards of Appeal, see for example T 328/87 (OJ EPO 1992, 701), and is not to be criticised. However, it is apparent that insufficient consideration has been given to the highly significant peculiarity of the present case in which it is not in dispute that there has indeed been public prior use of the "Micro Commander Control" and that the prior used device comprised at least all of the features of the preamble of granted claim 1. The main thrust of the attack on the patent, coherently argued in the notice of opposition, is that the prior used device also comprised several features of the characterising clause of the claim, which were in any case well known in the art, and that the remaining distinguishing feature was of a trivial nature. As can be seen from their reply to the notice of opposition dated 10 April 1995, the respondents had no difficulty in understanding what the attack on their patent was. Indeed they state explicitly that "it is not necessary to prove that the features in the preamble of claim 1 of the opposed patent are known from the system of opponent" (ie the "Mathers Micro Commander Control"). What they dispute is that the appellants had demonstrated that the features set out in the characterising clause of the claim were known in combination with the features set out in the preamble. In the opinion of the Board the evaluation of that issue, in particular whether the evidence submitted by the appellants in this respect was appropriate proof of what they were alleging, belongs to the substantive examination of the merits of the opposition rather than to the question of its admissibility, which was the line taken by the Opposition Division.

For completeness it should also be noted that the documents D3 (Enclosure II) and D4 (Enclosure III), referred to in the notice of opposition as evidence of the prior use of the "Micro Commander Control", are in any case pre-published documents which belong to the state of the art and disclose, at least in general terms, a remote control device for a marine engine comparable to that set out in the preamble of claim 1. These documents in combination with the pre-published documents D1 and D10 could also be considered as sufficient "facts and evidence" for supporting the argued ground of opposition of lack of inventive step.

For the above reasons the Board has reached the conclusion that the notice of opposition meets the requirements of Article 99(1) and Rule 55(c) EPC and is therefore admissible. The Opposition Division should accordingly proceed to the substantive examination of the opposition.

Order

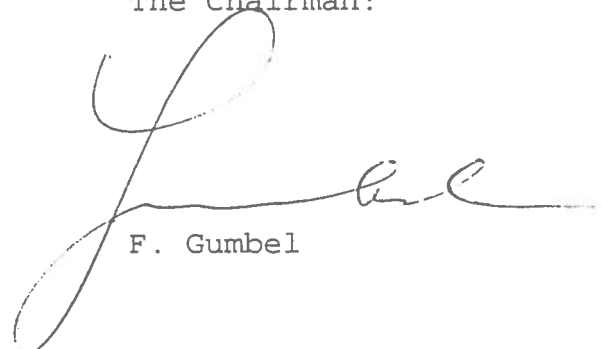
For these reasons it is decided that:

1. The contested decision is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:


S. Fabiani

The Chairman:


F. Gumbel