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D E C I S I O N
of 31 May 2001

Case Number: T 0397/99 - 3.2.1

Application Number: 90311783.6

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Title of invention:
Mount system for elevator guide rails

Patentee:
OTIS ELEVATOR COMPANY

Opponent:
INVENTIO AG

Headword:
-

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

Keyword:
"Admissibility of the opposition (yes)"
"Remittal of the case to the first instance for further
decision on the unexamined issue of patentability"

Decisions cited:
T 0222/85, T 0550/88

Catchword:
-



Case Number: T 0397/99 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 31 May 2001

Appellant: INVENTIO AG
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Respondent: OTIS ELEVATOR COMPANY
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 22 February 1999
rejecting the opposition filed against European
patent No. 0 425 313 as inadmissible on the basis
of Rule 56(1) EPC.

Composition of the Board:

Chairman: F. Gumbel
Members: M. Ceyte
G. Weiss

Summary of Facts and Submissions

I. The respondent is proprietor of European patent No. 0 425 313 (application No. 90 311 783.6).

Claim 1 reads as follows:

"1. An elevator hoistway (2) having spaced apart horizontal building structural beams (6) and a mount assembly for mounting an elevator guide rail (16), said mount assembly comprising:

- (a) a basal beam (10) connected to a said structural beam (6), said basal beam (10) extending vertically in the hoistway (2) and including upper and lower ends thereof off-set upwardly and downwardly of the structural beam (6) respectively;
- (b) elongated extension arms (12) mounted on said upper and lower ends of said basal beam (10) extending horizontally into the hoistway above and below the structural beam (6); and
- (c) a guide rail mounting clip assembly (14) secured to each of said extension arms (12) at an end thereof distal of said basal beam (10), said guide rail mounting clip assembly being operable to mount a guide rail (16) in place in the elevator hoistway (2)."

II. The appellant (opponent) filed a notice of opposition with a letter dated 4 September 1995 citing two additional documents

D6: US-A-5 119 908

D7: WO 89/04807

Document D6 was published on 9 June 1992, that is well after the priority date of the European patent (16 October 1989).

The notice of opposition was based on three lines of argument:

- (i) lack of novelty vis-à-vis document D6,
- (ii) lack of inventive step with respect to the combination of documents D6 and D7,
- (iii) lack of inventive step in the light of document D7 and common general knowledge.

In respect of line (iii) the notice of opposition sets out the following (in the terms of the English version of claim 1).

"Figure 3 (of document D7) discloses the preamble and the features (a) and (c) of claim 1: an elevator hoistway having spaced apart structural beams (structural wall) of a building and a mount assembly for mounting an elevator guide rail (15), said mounting assembly comprising:

- (a) a basal beam (25) connected to a said structural beam (5), said basal beam (10) extending vertically in the hoistway and including upper and lower ends thereof offset upwardly and downwardly of the structure beam respectively;

(c) a guide rail mounting clip assembly, secured to each of said extension arms at an end thereof distal of said basal beam (the clip assembly, extensions arms and basal beam are united in 25), said guide rail mounting clip assembly being operable to mount a guide rail (15) in place in the elevator hoistway.

Feature (b) which is not disclosed in this citation may be found without any inventive merit by any one skilled in the art as it is common procedure in elevator engineering for compensating inaccuracies in buildings."

III. In a decision dated 22 February 1999 the opposition division rejected the opposition as inadmissible in accordance with Rule 56(1) EPC, on the ground that the notice of opposition did not comply with Rule 55(c) EPC.

IV. On 15 April 1999 the appellant (opponent) lodged an appeal against this decision, with the appeal fee being paid at the same time.

The statement of grounds of appeal was filed on 22 June 1999.

V. Oral proceedings before the Board were held on 31 May 2001 in the absence of the respondent (patent proprietor).

The appellant requested that the contested decision be set aside and the patent be revoked, alternatively that the case be remitted to the first instance for a further decision on the unexamined issue of patentability. It further elaborated its written

submissions according to which its notice of opposition of 4 September 1995 complied with all the requirements of Rule 55(c) and was therefore admissible.

VI. The respondent requested (in writing) that the appeal be dismissed and the patent be maintained.

In support of this request the respondent submitted in writing the following arguments:

(i) As to the requirements of Rule 55(c) EPC the Guidelines D-IV, 1.2.2.1(v) state that:

"An opposition is adequately substantiated only if ... the opponent adduces facts, evidence and arguments establishing a possible obstacle to patentability under the EPC The content of the statement of grounds must be such as to enable the patent proprietor and the opposition Division to examine the alleged ground for revocation without recourse to independent enquiries. Unsubstantiated assertions do not meet this requirement ..."

Subsequently published document D6 does not form part of the state of the art and therefore the opponent's allegation in its notice of opposition that claim 1 lacks novelty over D6 must be disregarded as being unsubstantiated.

(ii) The same applies to the opponent's further allegation that the subject-matter of claim 1 lacks an inventive step with respect to the combination of documents D6 and D7, since any argument which relies on D6 forming part of the

state of the art must be wholly disregarded as being unsupported.

- (iii) In its third line of argument the opponent alleges that the subject-matter of claim 1 lacks an inventive step in the light of prior art document D7 and common general knowledge. More precisely, it submits that D7 discloses all the features of claim 1 with the exception of feature (b) which is however "common procedure in lift engineering".

The opponent failed to submit evidence to support its allegation of what is "common procedure" in the art. Thus even if D7 were as relevant to the invention as the opponent suggests, the argument that the claimed subject-matter lacks an inventive step in the light of D7 and common general knowledge is nothing more than an unsupported and unfounded assertion. As has been already mentioned in relation to the requirement of Rule 55(c) the Guidelines D-IV, 1.2.2.1(v) state that "unsubstantiated assertions do not meet this requirement".

- (iv) As discussed in the introductory part of the patent specification the present invention recognises that problems arise when horizontal structural beams are used for anchoring elevator guide rails in building hoistways. The invention solves the problem by means of the features specified in claim 1.

In contrast to this, D7 describes the use of a jig to assist in installing an elevator inside a

building. As may be seen from Figure 3, the lift shaft has planar walls and the guide rails are connected directly to these walls. There is no suggestion whatsoever that the guide rails are connected to "building structural beams" as specified in claim 1. Since the connection of guide rails to such beams lies at the heart of the problem solved by the invention, it is difficult to see what possible relevance document D7 could have to the validity of the claims. Thus, not only has the opponent failed to provide any prior art that discloses the features of the invention, it has not even provided a document that forms a credible starting point for considering the existence of an inventive step.

It can therefore be seen that the only ground of opposition that relates to the prior art is an unsubstantiated allegation that it would be obvious to modify the teaching of an irrelevant document (D7) in the light of unsubstantiated allegations of common procedure in the art. Therefore, the notice of opposition clearly fails to provide "sufficient indication of the relevant facts, evidence and arguments ... for the reasoning and merits of the opponents' case in relation to the grounds of opposition to be understood by the opposition division and the patentee" (cf. T 222/85, OJ EPO 1988, 128 and the Guidelines as quoted above). The objections to claim 1 are therefore inadmissible.

Claim 1 is the only independent claim in the patent, and in the absence of an admissible novelty or inventive step objection in relation

to this claim, there can be no such admissible objection to the claims dependent thereon. The notice of opposition contains no other grounds of opposition, and therefore the opposition as a whole is inadmissible.

Reasons for the Decision

1. The appeal is admissible.
2. *Admissibility of the opposition*
 - 2.1 Under Rule 56(1) EPC the opposition division rejects an opposition as inadmissible if it finds that it does not comply with Rule 55(c) EPC.

Rule 55(c) requires that a notice of opposition shall contain *inter alia* a statement of

- (i) "the grounds on which the opposition is based",
and
- (ii) "an indication of the facts, evidence and
arguments presented in support of the grounds."

As stated in decision T 550/88 OJ EPO 1992, 117, "a notice of opposition which contains a statement of grounds of opposition and which indicates facts, evidence and arguments which are **alleged** to support such grounds, is not necessarily admissible. The admissibility is not merely a question of its form, but is a question of substance."

The decision goes on to state "Conversely, if the only facts and evidence indicated in a notice of opposition cannot as a matter of law support the grounds of opposition alleged, the opposition is inadmissible. In such a case the notice of opposition necessarily contains nothing which could possibly lead to the patent be revoked" (see point 4.2 of the reasons).

This decision is in line with the above quoted passage of the Guidelines (Facts, point VI) which states that "An opposition is adequately substantiated only if ... the opponent adduces facts, evidence and arguments establishing a possible obstacle to patentability under the EPC".

2.2 As has been already said the notice of opposition is based on the following three lines of argument:

- (i) lack of novelty vis-à-vis document D6,
- (ii) lack of inventive step with respect to the combination of documents D6 and D7,
- (iii) lack of inventive step in the light of document D7 and the common knowledge of the skilled person.

Document D6 (US-A-5 119 908) was published on 9 June 1992, that is well after the priority date of the European patent (16 October 1989). It is clear that this subsequently published document does not form part of the state of the art.

It follows that subsequently published document D6 is wholly irrelevant to the alleged ground of lack of

novelty (part (i) of the notice of opposition) or to the alleged ground of obviousness in combination with prior published document D7 (part (ii) of the notice of opposition). Thus it "cannot as a matter of law support the grounds of opposition alleged" (T 550/88 as quoted above) or establish "a possible obstacle to patentability under the EPC" (Guidelines as quoted above). Therefore the parts (i) and (ii) of the notice of opposition do not comply with Rule 55(c) EPC.

2.3 In the part (iii) of the notice of opposition, prior published document D7 is relied upon in relation to the ground of lack of inventive step. In such a case the decision T 222/85 relied upon by the respondent (Facts, point VI) emphasizes that

"depending upon the circumstances of each individual case requirement (3) of Rule 55(c) will only be satisfied if there is sufficient indication of the relevant "facts, evidence and arguments" for the reasoning and merits of the opponent's case in relation to the grounds of opposition relied upon to be properly understood by the Opposition Division and the patentee. This must be assessed on an objective basis, from the point of view of a reasonably skilled man in the art to which the opposed patent relates" (cf. point 4 of the reasons).

It is true that D7 does not explicitly disclose "spaced apart structural beams". However it is clear that the elevator disclosed therein is used for raising or lowering persons or things to different floors of a building. From the point of view of a skilled person it appears to be not fully unreasonable to assimilate these spaced apart horizontal floors to "spaced apart

horizontal structural beams "as specified in claim 1, since they are both structural elements which form a part of the building itself. Vertically extending basal beams (25) are connected to these structural beams. As is apparent from the right-hand part of Figure 3 of D7, these basal beams comprise also an horizontal elongated extension arm. The basal beam, the elongated extension arm and the guide rail mounting clip are designated by the same numeral reference "25" in document D7.

From the foregoing it is apparent that D7 cannot be considered as being clearly irrelevant to the features of the claim, in particular features (a) and (c) and perhaps part of feature (b).

It is true that the depicted basal beam comprises only one horizontal extension arm, whereas according to feature (b) the basal beam comprises **two** elongated extension arms mounted on its upper and lower ends. In the notice of opposition it is stated that this feature is "common procedure in lift engineering". Such an allegation may appear to amount to an unfounded and unsupported assertion that the feature (b) is common general knowledge in the art. However in the present case it was accompanied by some reasoning, i.e. that it would be normal practice to make use of such arms if necessary in view of building inaccuracies.

Moreover, evidence as to what is common general knowledge is often difficult and normally not even requested during substantive examination of an admissible novelty or obviousness objection. There is thus all the less reason for requesting such proof during examination of the admissibility of an opposition.

Therefore, the objection concerning lack of inventive step based on the line of argument (iii) is supported by sufficient facts and evidence in respect of Figure 3 of D7 and the elements of Figure 3 which are referred to in the notice of opposition. The substantiation of this line of argument is thus such as to enable the patent proprietor and the Opposition Division to properly understand the reasoning as to the alleged lack of inventive step. It follows that the line of argument (iii) and hence the notice of opposition comply with Rule 55(c) EPC.

The assertion of the respondent that D7 is of very little relevance to the present invention concerns the merits or the substantive allowability of the opposition, not its admissibility. It is therefore immaterial, as far as the question of admissibility of an opposition is concerned, whether the opposed prior published document is not sufficiently relevant to prejudice the maintenance of the patent in its granted form.

2.4 In view of the above in the Board's judgement the opposition is admissible and the contested decision must therefore be set aside.

3. The opposition division issued a decision based on inadmissibility of the opposition and consequently did not decide upon the substantive allowability of the opposition.

In view of the fact that the respondent did not attend the oral proceedings before the Board and in accordance with the appellant's request, the Board remits the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

S. Fabiani

F. Gumbel