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**Datasheet for the decision
of the Enlarged Board of Appeal
of 14 November 2011**

Case Number: R 0011/11
Appeal Number: T 0144/09 - 3.2.06
Application Number: 99113776.1
Publication Number: 0957061
IPC: B66B 11/00
Language of the proceedings: EN

Title of invention:
Traction sheave elevator

Patentee:
Kone Corporation

Opponents:
INVENTIO AG
ORONA E.I.C S. Coop.
Otis Elevator Company

Headword:
Petition clearly unallowable

Relevant legal provisions:
EPC Art. 112a, 113 (1), (2)
RPBA Art. 12(4)

Keyword:
"Non-admission of requests timely filed with the statement of the grounds of appeal constitutes a violation of right to be heard (no)"

Decisions cited:
G 0007/93, R 0001/08, R 0010/08, R 0010/09, R 0009/10,
R 0020/10, T 1854/08



Case Number: R 0011/11

D E C I S I O N
of the Enlarged Board of Appeal
of 14 November 2011

Petitioner:
(Patent Proprietor)

Kone Corporation
Kartanontie 1
FI-00330 Helsinki (FI)

Representative:

Graf Glück Habersack Kritzenberger
Patentanwälte
Wotanstraße 64
D-80639 München (DE)

Other party:
(Opponent 0I)

INVENTIO AG
Seestrasse 55
CH-6052 Hergiswil (CH)

Representative:

Körfer, Thomas
Mitscherlich & Partner
Patent- und Rechtsanwälte
Sonnenstrasse 33
D-80331 München (DE)

Other party:
(Opponent 0II)

ORONA E.I.C S. Coop.
Poligono Lastaola, s/n
E-20120 Hernani (Guipúzcoa) (ES)

Representative:

Carpintero Lopez, Francisco
Herrero & Asociados, S.L.
Alcalá 35
ES-28014 Madrid (ES)

Other party:
(Opponent 0III)

Otis Elevator Company
Ten Farm Springs Road
Farmington, CT 06032-2568 (US)

Representative:

Höhfeld, Jochen
Klunker Schmitt-Nilson Hirsch
Patentanwälte
Destouchesstraße 68
D-80796 München (DE)

Decision under review: **Decision of the Technical Board of Appeal
3.2.06 of the European Patent Office of
4 May 2011.**

Composition of the Board:

Chairman: J.-P. Seitz
Members: K. Garnett
 D. H. Rees

Summary of Facts and Submissions

- I. This petition for review concerns decision T 144/09 of the Board of Appeal 3.2.06, inter alia dismissing the appeal of the petitioner against the decision of the opposition division revoking European patent No. 0 957 061. The patent was granted in respect of a divisional application stemming originally from a great-grandparent application.
- II. The subject matter of the patent in suit is a traction sheave elevator. The eventual requests filed by the petitioner during the opposition proceedings (a main request and first, second and third auxiliary requests) were for maintenance of the patent in amended form whereby the following feature, taken from the description, had been added to claim 1 of the granted claim:
- "so that the space requirement in the building is substantially limited to the space required by the elevator car and counterweight on their paths including the safety distances and the space needed for the hoisting ropes."
- This feature will be referred to in this decision as "the space requirement feature".
- III. These requests were filed in the opposition proceedings approximately one month before the date scheduled for oral proceedings, namely 7 October 2008. The space requirement feature had not previously formed part of any claim; nor had it been mentioned by the opposition division in its communications to the parties.

- IV. In the course of the oral proceedings on 7 October 2008, the opposition division indicated its view that the addition of the space requirement feature without the further limiting feature that the drive unit for the elevator was a "flat" drive unit contravened Article 123(2) EPC. (This latter feature will be referred to in this decision as the "flat drive unit feature"). The same was true for the auxiliary requests on file. The minutes (page 5) record that the Chairman then asked the petitioner's representative whether he would file any further requests but that the petitioner "did not avail himself of the opportunity to file any request which would overcome the ground of opposition under Article 100(c)EPC". A decision revoking the patent was then announced.
- V. The petitioner filed a notice of appeal against this decision on 19 December 2008. With its statement of grounds of appeal the petitioner filed inter alia a main request and first and second auxiliary requests for maintenance of the patent in which the space requirement feature was now omitted altogether. (These requests will be referred to in this decision as "the Requests")
- VI. The Board of Appeal issued a communication on 21 March 2011 indicating its provisional opinion that the Requests were considered to be inadmissible having regard to Article 12(4) of the Rules of Procedure of the Boards of Appeal ("RPBA"). The opposition division had offered the petitioner the chance during the oral proceedings to file further requests to meet the Article 123(2) EPC objection and no reason could be

seen why the space requirement feature could not have been deleted by way of an auxiliary request at that stage. The petitioner had been aware of the opposition division's view and the reason for it.

VII. In the oral proceedings before the Board of Appeal on 4 May 2011 the Board in the event did not admit the Requests, for the reasons given in its communication. Making reference to Rule 106 EPC, the petitioner then objected that this was a violation of Articles 113(1) and (2) EPC. This objection was dismissed by the Board. Detailed reasons for not admitting the Requests were set out under point 1 of the written reasons deemed notified to the petitioner on 4 June 2011.

VIII. The present petition was filed on 14 July 2011 and the prescribed fee was paid on the same day.

IX. The petitioner alleges that the refusal of the Board of Appeal to admit the Requests was a fundamental violation of its rights according to Articles 113(1) and (2) EPC. The petitioner's arguments in this respect can be summarised as follows:

- (a) The restrictive interpretation of Article 12(4) RPBA taken by the Board of Appeal leads to a situation in which no patent claims can be advanced in appeal proceedings which were not also filed in the first instance proceedings. This cannot have been the intention behind Article 12(4) RPBA and unduly restricts the freedom of a party to modify its requests, particularly in the light of what it has learned from the actual decision of the first instance department. The non-admission

of requests which have been timely filed in appeal proceedings thus means that the party's right to be heard is violated.

- (b) The opposition division had indicated in a written communication dated 11 January 2008 that the flat drive feature was not an essential feature of the invention but had then changed its mind during the oral proceedings in the light of the introduction of the space requirement feature. The petitioner was taken by surprise; the space requirement feature had been present in the great-grandparent application and in other family members and had never been the subject of such an Article 123(2) EPC objection. The opposition division had then essentially invited the petitioner to introduce the flat drive unit feature into the claims. However, the petitioner had had good reasons not to file a new request during the oral stage of the opposition proceedings, in particular a request in which the space requirement feature was omitted altogether, which is what the Board of Appeal in effect criticised the petitioner for not doing. This feature had played an essential role in the opposition proceedings as regards other family members and its omission at that stage would not just have been a large step but would also have amounted to a complete change in strategy.
- (c) Further, the petitioner did not at that stage know the reasons why the flat drive unit feature had suddenly been considered by the opposition division to be necessary and the petitioner therefore was not in a position to file an

appropriate response to meet this objection. It was only later when the written reasons for the decision were received that the necessity to drop the space requirement feature became clear.

- (d) In any event, the filing of a new request in which the space requirement feature was dropped altogether would have been objected to by the opponent as being late filed. The petitioner did not therefore have a real chance to react in an appropriate way to the changed view of the opposition division.
- (e) The non-admission of the Requests thus prevented the petitioner from reacting to the reasons given by the opposition division for revoking the patent. This was a violation of Article 113(1) EPC.
- (f) Further, there was a violation of Article 113(2) EPC since the Board of Appeal had not examined the patent with the claims as agreed by the petitioner, i.e., on the basis of the Requests. In this respect the petitioner referred to the decision in T 1854/08.

- X. The petitioner requests that the decision of the Board of Appeal be set aside and the case be remitted to the Board of Appeal for further deliberation as regards the Requests.

Reasons for the Decision

1. The petition is admissible.
2. However, for the following reasons the Enlarged Board of Appeal considers that the petition is clearly unallowable and must therefore be rejected (see Rule 109(2) EPC).
3. The petitioner in essence argues that the non-admission of the Requests, which had been timely filed with the statement of the grounds of appeal, violated its right to be heard.
4. When refusing to admit the Requests, the Board of Appeal relied on the discretion which is referred to in Article 12(4) RPBA. This article reads as follows:

"(4) Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties under [Article 12(1)] shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in [Article 12(2)]."
5. The petitioner does not argue that a Board of Appeal does not have a discretion to hold inadmissible requests which could have been presented in the first instance proceedings. Rather, the Enlarged Board understands the petitioner to be arguing along two lines. First, that the petitioner could not have

presented the Requests in the first instance proceedings since it was taken by surprise and did not know the reasons for the opposition division's view regarding the flat drive unit feature. There was therefore no proper basis for the exercise of the discretion. Second, the discretion was not in any event properly exercised.

6. As to the first line of argument, the petitioner's right to be heard cannot have been infringed in this respect since it is not disputed that the issue of admissibility of the Requests was debated during the oral proceedings held before the Board of Appeal. See point XVIII of the Facts and Submissions of the decision of the Board of Appeal, where the petitioner's arguments on this issue are summarised, and the decision in R 10/09, point 2.2 of the Reasons. Even if the Board of Appeal had been wrong to consider that the Requests could have been presented in the first instance proceedings (as to which, see the following paragraph), this cannot form a basis of a complaint that the petitioner's right to be heard was not respected. The Enlarged Board cannot in petition proceedings act as a third instance or second tier appellate tribunal: see, e.g., the decisions in R 1/08, point 2.1 of the Reasons, and R 9/10, point 10 of the Reasons.
7. In any event, and for the sake of completeness, the Enlarged Board does not accept that the Requests could not have been presented during the oral proceedings before the opposition division. The petitioner knew that the Article 123(2) EPC objection arose from the introduction of the space requirement feature in

isolation without the further limitation of the flat drive unit feature. It was given the opportunity to file a request to meet the objection. It could then have filed a request or requests in the form of those later filed with the grounds of appeal. It did not need to know the detailed reasons why the opposition division had taken this view. In fact, part of the petitioner's argument is that it had good reasons not to file such requests during the oral stage of the opposition proceedings (see point IX(b), above), not that it could not have done so. Again, the fact that the opponent might have objected to such new requests (see point IX(d), above) does not mean that the petitioner could not have filed them.

8. As to the second line of argument, the jurisprudence of the Enlarged Board of Appeal under Article 112a EPC has made it clear that a petition may only be used as a vehicle to review the merits of a decision relating to a procedural issue if one of the procedural defects listed in Articles 112(2)(a) - (d) is alleged to have occurred: see, e.g., R 20/10, points 2.1 and 2.5 of the Reasons. This applies all the more to an attempt to have the Enlarged Board review the way in which a judicial body such as a Board of Appeal has exercised its discretion in relation to a procedural matter: see R 10/09, point 2.2 of the Reasons. In the present case, the petitioner's right to be heard cannot have been infringed in this respect since, as already pointed out, the issue of admissibility of the Requests was debated during the oral proceedings held before the Board of Appeal. See point 6, above.

9. In any event, the petitioner's argument that the manner in which this discretion was exercised by the Board of Appeal means that no patent claims can be advanced in appeal proceedings which were not already filed in the first instance proceedings is clearly not correct. The discretion was exercised by the Board of Appeal having regard to the particular facts of the case; no such general proposition as that suggested by the petitioner follows from the Board's decision. The same is true of the petitioner's argument that Article 12(4) RPBA should not be read so as to unduly restrict the freedom of a party to modify its requests in appeal proceedings, particularly in the light of what it has learned from the actual decision of the first instance department. The matter remains one of discretion to be exercised on the basis of the facts of the individual case.
10. The petitioner also argues that there was a fundamental violation of its right under Article 113(2) EPC since the Board of Appeal did not examine the patent with the claims as agreed by the petitioner. The Enlarged Board does not accept this. As was made clear in G 7/93 (OJ EPO 1994, 775, point 2.1), "this provision of the EPC does not give any right to an applicant in the sense that the EPO is in any way bound to consider a request for amendment put forward by the applicant. The effect of this provision is merely to forbid the EPO from considering and deciding upon any text of an application **other than that** 'submitted to it, or agreed, by the applicant or proprietor ...'. See also R 10/08, point 7 of the Reasons. The Board of Appeal in the present case did not decide upon the patent on the basis of any text which was not submitted to it or agreed by the petitioner and it was not bound to

consider the Requests as a basis for amendment given that they were not admitted into the proceedings. The petitioner referred to the decision in T 1854/08 in this respect. In that case, however, the examining division had decided upon the application on the basis of a set of claims which had been clearly replaced by different sets of claims. The case has no bearing on the present petition.

Order

For these reasons it is unanimously decided that:

The petition is rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

J.-P. Seitz