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**Datasheet for the decision
of 6 February 2007**

Case Number: T 0822/04 - 3.2.01

Application Number: 95650048.2

Publication Number: 0719674

IPC: B60Q 3/02

Language of the proceedings: EN

Title of invention:

Vehicle instrumentation/console lighting assembly

Patentee:

DONNELLY CORPORATION

Opponents:

Reitter & Schefenacker

Dr. Ing. h.c.F. Porsche Aktiengesellschaft

Headword:

-

Relevant legal provisions:

EPC Art. 56, 123

Keyword:

"Improvement of patentee's position (yes)"

"In agreement with G 1/99 (yes)"

"Inventive step (yes)"

Decisions cited:

G 0004/93, G 0001/99, T 0752/93

Catchword:

-



Case Number: T 0822/04 - 3.2.01

DECISION
of the Technical Board of Appeal 3.2.01
of 6 February 2007

Appellant: Reitter & Schefenacker
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Representative: -

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
5 May 2004 concerning maintenance of European
patent No. 0719674 in amended form.

Composition of the Board:

Chairman: S. Crane
Members: J. Osborne
S. Hoffmann

Summary of Facts and Submissions

I. The appeal by opponent I is directed against the interlocutory decision posted 5 May 2004 according to which, account being taken of the amendments made by the patent proprietor during the opposition procedure, European patent No. 0 719 674 and the invention to which it relates were found to satisfy the requirements of the EPC.

II. The following evidence played a role during the appeal procedure:

D1: EP-B-0 254 435

D5: US-A-4 935 665

D14: Publicity brochure "High Performance LEDs from Hewlett-Packard", 1994

D15: Wiring diagram for an Opel Kadett

D16: Operating instructions for a fire-service vehicle type LF 3500/42/312.027 built in 1954, pages 8 to 11, 52, 53

PU17: Alleged public prior use of an interior lamp of a military tank "Leopard 1".

III. The board summoned the parties to oral proceedings and in a communication pursuant to Article 11(1) RPBA *inter alia* addressed the matter of an apparent contravention of the provision of Article 123(3) EPC in the claims held allowable by the opposition division.

IV. At oral proceedings on 6 February 2007 the appellant and the party as of right (hereafter "opponents") requested that the decision under appeal be set aside and the patent revoked. The respondent (hereafter "patent proprietor") requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 20, description (pages 2 to 9) and figures 1 to 19 of the sole request, all filed during the oral proceedings.

V. Claim 1 according to the patent proprietor's request reads:

"An interior rearview mirror assembly for a vehicle comprising a light emitting source (90), for providing illumination in the vehicle interior, characterised in that the light emitting source (90) is a non-incandescent light emitting source, for providing low level illumination in the vehicle interior, and in that the light emitting source (90) is positioned in said assembly to provide directed low level illumination to an instrument panel area (130) or a console area (121, 125, 134, 136) of the vehicle, and in that the light emitting source (90) provides constant illumination of the instrument panel area (130) or console area (121, 125, 134, 136) at all times when the ignition switch is turned to the ignition on position or to the accessory on position."

Claims 2 to 20 specify features additional to those of claim 1.

VI. The submissions of the opponents may be summarised as follows:

Claim 1 held allowable by the opposition division contravened the requirement of Article 123(2) EPC. Although the patent proprietor did not appeal against that decision it attempts with its present request to overcome the deficiency by simply deleting the offending feature and in so doing fails to satisfy the conditions set out in decision G 1/99. The effect of G 1/99 is that a non-appealing patent proprietor can only in exceptional circumstances amend a claim by removing a deficiency. Moreover, when judging conformity with the requirement of Article 123(3) EPC the comparison must be made not between the final and granted versions of the claim but between the final version and that which was held allowable by the opposition division. In this latter form the subject-matter was effectively restricted to a vehicle comprising an interior rear-view mirror. Claim 1 according to the present request has been broadened to now once again specify merely the interior rear-view mirror. Moreover, there has been a lateral shift in the subject-matter of the claim.

Claim 1 according to the present request moreover offends the provision of Article 123(2) EPC in as far as there was an original disclosure of switching the light source by means of the ignition and accessory positions only when the light source was an LED. This

form of the light source has not been introduced into the claim.

As regards inventive step, the closest state of the art is known from D1. This discloses a lamp in an interior rear-view mirror which is positioned to provide directed illumination to a console area of the vehicle when the headlamps are in operation. A comparison of the light intensities specified in D1 and in the patent specification illustrates that the prior art lamp provides low level illumination. Each of D15, D16 and PU17 is an example of a vehicle having a lamp providing low level illumination and which provides constant illumination at all times when the ignition switch is turned to the ignition on position. Such constant operation of the lamp would also be well known to a skilled person aware of D1 because vehicles supplied to Scandinavia have for many years been required to operate at all times with their headlamps switched on. D5 and D14 both show that it was obvious for the skilled person to employ an LED in place of the low intensity bulb of D1.

VII. The patent proprietor's reply may be summarised as follows:

The claim held allowable by the opposition division contravened the requirement of Article 123(3) EPC only because of an attempt to reformulate the claim in the correct two-part form. The appellant made no objection when filing its appeal and is not disadvantaged by the present amendment. It would be inequitable to prevent rectification of the situation.

As regards the alleged intermediate generalisation, there were many references in the application as originally granted to various non-incandescent light sources. Whilst LEDs were used to illustrate the embodiments it was clear to the skilled person that the claimed switching arrangement was in no way limited to use with that particular non-incandescent light source.

There is nothing in the cited prior art which anticipates the concept of directed low level illumination. This concept was correctly summed up in the appealed decision page 10, third paragraph and it permits recognition of controls without any action on the part of the driver whilst preventing unwanted glare. The lower powered lamp according to D1 would provide light which is diffusely distributed, not 'directed' within the meaning of the present claim. As a result it would merge in with the general interior illumination. As regards the opponents' assertions in respect of intensity of illumination, map reading lights provide high intensity illumination at a relatively large distance, namely at the occupants' laps. The console is somewhat closer and could be more brightly illuminated by the lower power lamp. The prior art relating to LEDs confirms that the trend always has been to attempt to provide as much light as possible. The present invention is counter to that normal practice.

Reasons for the Decision

Admissibility of the amendments

1. The subject-matter of present claim 1 has been amended in comparison with the claim as granted by addition of the feature that "the light emitting source (90) provides constant illumination of the instrument panel area (130) or console area (121, 125, 134, 136) at all times when the ignition switch is turned to the ignition on position or to the accessory on position". This feature was disclosed on page 18, lines 22 to 28 of the description as originally filed.

- 1.1 In the application as originally filed the invention is presented generally as relating to the use of non-incandescent light sources. The concept of their operation whenever the ignition switch is in the ignition on or the accessory on position was disclosed in page 5, lines 2 to 12 and in respect of a preferred embodiment of figure 8. According to the passage on page 5 powering a non-incandescent light source whenever the ignition switch is in the ignition on or the accessory on position is rendered suitable by properties such as the creation of virtually no heat and low power consumption. Whilst in the preferred embodiment the light source is an LED, the disclosure extends more generally to other non-incandescent light sources such as vacuum fluorescence and electroluminescence (page 3, lines 18 to 23). There is no suggestion that an LED would be the only non-incandescent light source exhibiting the properties which render suitable the presently claimed switching arrangement.

- 1.2 It follows from the foregoing that the amendment of claim 1 in comparison with its form as granted does not offend the provision of Article 123(2) EPC. The same is true also of the description and drawings which have been amended only for consistency with the claims.
2. Claim 1 as granted, which was the sole independent claim, specified "An assembly for a vehicle comprising a ... light emitting source ... characterised in that the assembly is an interior rear view mirror assembly (10) ... and in that the light emitting source (90) is positioned in said assembly ...". It is clear from this wording firstly that the subject-matter of the claim is an interior rear-view mirror assembly and secondly that a light emitting source is positioned in the rear-view mirror assembly. Claim 1 as held allowable by the opposition division (hereafter "first amended") reads: "An assembly for a vehicle comprising an interior rear view mirror assembly (10), having a light emitting source (90) positioned in said assembly ...". According to this first amended wording there are two assemblies, a first which is designated as "for a vehicle" and which comprises a second designated as the "rear view mirror assembly". The statement that the light emitting source is positioned in "said assembly" implies that the light emitting source is positioned not in the rear-view mirror assembly as required by the claim as granted but in the first assembly. The wording of claim 1 according to the patent proprietor's present request ("second amended") reads: "An interior rearview mirror assembly for a vehicle comprising a light emitting source ... positioned in said assembly ...".

2.1 The scope of protection afforded by the patent (cf. Article 123(3) EPC) has not been extended because the subject-matter of claim 1 as granted has been limited by the addition of a feature and the description has been amended accordingly. The opponents argue that compliance with the provision of Article 123(3) EPC should be judged by comparing the second amended claim not with the granted claim but with the first amended claim. However, the essential purpose and guiding principle behind the provision of Article 123(3) EPC is that once a European patent has been granted, an act by a third party which would not infringe the patent as granted should not be able to become an infringing act as a result of amendment after grant (Paterson, "The European Patent System", 2nd edn., London, Sweet & Maxwell, 2001, 383). It was stressed also in decision T 752/93 (not published in OJ EPO; reasons 2.1) that the provision of Article 123(3) EPC refers to the patent as granted and not to the version approved by the opposition division. Indeed, decision G 1/99 (OJ EPO 2001, 389) arose from a referral in a case in which the opposition division had approved the addition of a feature to a claim and the competent board was faced with a request in which the feature was again deleted and whose approval would run counter to the prohibition of *reformatio in peius* according to decision G 4/93 (OJ EPO 1994, 875). Application of the provision of Article 123(3) EPC in the way suggested by the opponents in the present case would have rendered the referral to the Enlarged Board of Appeal redundant. Moreover, in decision G 1/99 the Enlarged Board of Appeal set out three possibilities for requests by the non-appealing patent proprietor, the second of which states that an amendment may "extend the scope of the

patent as maintained" but must remain "within the limits of Article 123(3) EPC".

- 2.2 The opponents consider also that the second amended claim broadens the scope of protection in comparison with the first amended claim, thereby resulting in *reformatio in peius* which is prohibited in accordance with the decision of the Enlarged Board of Appeal G 4/93 subject to the exceptions set out in decision G 1/99 which in the present case are not met.

Decision G 1/99 concerns a situation similar to that of the present case in as far as the opponent is the sole appellant and an objection put forward during the appeal proceedings results from an amendment which was held allowable by the opposition division but which is prejudicial to maintenance of the patent during the appeal proceedings. Decision G 1/99 creates an exception to the prohibition of *reformatio in peius* in this situation and sets out requests which the patent proprietor may make and an order of making them. The first and second of those requests are:

- "to make an amendment which introduces one or more originally disclosed features which would limit the scope of the first amended patent"; and
- "if such a limitation is not possible, for an amendment introducing one or more originally disclosed features which extend the scope of the patent as maintained, but within the limits of Article 123(3) EPC".

2.2.1 In the present case claim 1 as granted was first amended in such a way that it introduced a further, unidentified, "assembly" which comprised the mirror assembly and in which the light source was located. In making this first amendment the scope of the patent was extended in contravention of the provision of Article 123(3) EPC because the light source no longer was specified as being within the mirror assembly. In the view of the opponents, however, the further "assembly" could only effectively be the vehicle itself since no other was disclosed and as the amended claim did not specify this then it offended against both Article 123(2) EPC and Article 84 EPC. As a consequence therefore the only amended claim which would meet the conditions of decision G 1/99 would be one that was limited to a vehicle comprising the mirror assembly, in which assembly the light source was positioned.

Contrary to the view of the opponents, the further "assembly" cannot possibly be considered as the vehicle itself for the simple reason that the wording specifies "an assembly for a vehicle ...". Moreover, since there was no original disclosure of what the further "assembly" might be no feature can be added which would rectify the situation and the first possibility according to G 1/99 is not applicable.

2.2.2 The present, second amended claim returns the light source to the mirror assembly, as originally disclosed and as claimed at grant but no longer implies a further "assembly". The scope of the patent in its second amended form is thereby arguably broadened in comparison with the first amended form in one respect, insofar as no reference is made to a further,

unidentified, "assembly", but is clearly limited in another, namely the location of the light source in the mirror assembly. For the reasons explained in point 2.1 above a comparison between the two amended forms is not the appropriate yardstick for assessing conformity with Article 123(3) EPC, and since the second amended form is clearly restricted with respect to granted claim 1 it is apparent that the requirement of Article 123(3) EPC is met. Thus the requested amendment corresponds to the second possibility according to G 1/99.

Inventive step

3. The parties are in agreement that the closest state of the art is known from D1. This discloses an interior rear-view mirror assembly which incorporates two light sources operable to direct illumination primarily to the occupants' laps, commonly known as map reading lights, and a further, lower power light source which is independently operable to illuminate the centre console area. It is this lower power light source mounted in the interior rear-view mirror which forms the closest state of the art for present claim 1. D1 designates the lower power light source merely as a bulb and suggests that it may be operated together with the vehicle lights.

3.1 Present claim 1 specifies that the light emitting source is positioned "to provide directed" illumination and in the embodiments a lens is provided which may be any of a Fresnel lens, a binary optic, a refractive optic or a holographic optic (column 9, lines 40 to 42). In D1 the bulbs of the map reading lights are provided with lenses which are profiled to direct the light

obliquely. The lower power lamp, on the other hand, is provided with no reflector and with a lens which apparently has no optical properties other than being clear. The aperture is stated to be shaped and oriented to direct the light from the lower power light source onto the console area directly below but in the absence of any elements having the ability to direct the light, the illumination would be diffuse. D1 therefore cannot be considered as disclosing that the light from the lower power lamp is "directed" within the meaning of the present claim.

- 3.2 As regards the feature in present claim 1 of "low-level" lighting, it is clear in the light of column 1, lines 36 to 48 and column 2, lines 16, 17 of the specification as granted that this is intended to represent a level of illumination which enables the driver to identify controls during driving at night or other conditions of low light but which prevents glare. Specific values are at most less than about 60 lux (column 2, lines 16 to 20). D1 discloses that the lower power lamp may operate whenever the vehicle lights are switched on and since this must be compatible with use at night it is implicit that it also would provide a level of illumination which prevents glare. More explicitly, D1 states that the lower power lamp, which apparently has no reflector, "produces less light" than the map-reading lights which have reflectors and which according to figure 18 produce an illumination intensity over the area of the console of about 60 lux maximum. Since the respective bulbs are closely positioned in the interior rear-view mirror assembly the lower power lamp will produce a correspondingly lower intensity of illumination at the console area

than will the map reading lamps, particularly in view of the more diffuse nature of the lower power illumination, cf. 3.1 above. It follows that the illumination provided by the lower power lamp would generally correspond to the luminous intensity attributed to the presently claimed light emitting source, namely less than 60 lux. The board therefore considers that D1 does disclose the concept of low level illumination to the console area.

- 3.3 On the basis of the foregoing the board finds that the subject-matter of present claim 1 differs from the disclosure of D1 by the feature of a non-incandescent light emitting source which provides constant, directed illumination to the instrument panel area or the console area of the vehicle at all times when the ignition switch is turned to the ignition on position or to the accessory on position. This feature allows the provision of a reliable illumination of the console area or the instrument panel whenever it may be necessary to locate a control positioned thereon.
4. As set out in the patent specification, non-incandescent light emitting sources exhibit a low power consumption, produce little heat and have a very long life. The directed nature of the illumination results in a more efficient utilisation of the emitted light. This when combined with the inherent efficiency of the non-incandescent light source results in a source of illumination which is suitable for operation at all times without the need for it to be linked to the use of any particular vehicle system such as the lights. For this reason the differentiating feature must be considered as a whole when considering inventive step.

4.1 The use of an LED for illumination of an instrument or control is known *per se*, as documented by both D5 and D14. In D5 this aspect is merely mentioned as the background to the main disclosure which relates to maximising the brightness of light emitted from LEDs in order to permit their use in applications such as vehicle stop lamps. D14 on page 4 stresses the long life of LEDs, rendering them suitable for use in vehicle instrument cluster lighting. However, there is no suggestion that an LED could be used to produce light which is directed in the form of a floodlight. Both D5 and D14 are silent as regards any different switching arrangements which may be associated with the use of an LED.

4.2 D15, D16 and PU17 were cited by the opponents as evidence that it was already known to operate lamps in a vehicle whenever the ignition switch is in the ignition on or accessory on position.

4.2.1 According to the opponents the wiring diagram according to D15 shows that the illumination for the clock receives power via the cigar lighter from the ignition feed. The board disagrees. The cigar lighter 48 and the lamp 50 for the clock 49 share a common earth. However, the lamp for the clock is fed along a connection designated as "0.5GR" via fuse number 1 which in turn is fed from the light switch 45 and is therefore a conventional arrangement different from that presently claimed.

4.2.2 D16 relates to a fire service vehicle built in 1954. According to the opponents a reading lamp 4 is operated

at all times when the ignition switch is in the on position. In the board's view this cannot be derived from the documents present in the file. In particular, since the reading lamp is not shown on the circuit diagram it cannot be determined that no switch is provided which would be capable of interrupting the feed to the reading lamp. Moreover, in the present case the skilled person is seeking to improve the closest state of the art according to D1 which already has reading lamps producing high level illumination. It follows that the skilled person wishing to improve the low level illumination of the console area of D1 anyway would not consider the switching arrangement of a reading lamp, particularly one which does not render such a switching arrangement attractive by virtue of using a non-incandescent light source.

4.2.3 The opponents argue that the alleged public prior use of a Leopard military tank having an interior lamp would render obvious the switching arrangement presently claimed. However, the documents supplied in respect of PU17 are clear and consistent in stating that the interior lamp in question includes a three-position switch for *inter alia* switching the lamp off. The switching arrangement therefore does not correspond to that presently claimed.

4.3 The opponents also take the view that the skilled person would be aware that before the priority date of the present patent it was required that vehicles supplied to Scandinavia operate at all times with their headlamps illuminated and that consequently the lower power lamp according to D1 would operate as presently claimed. However, there is no evidence available that

the rear-view mirror assembly according to D1 was ever produced, let alone built into a vehicle which was supplied to Scandinavia. Moreover, even if the mirror assembly were built into a vehicle supplied to Scandinavia there is no evidence that the lower power lamp would have been operated as suggested in D1.

5. The board concludes from the foregoing that the subject-matter of present claim 1 involves an inventive step (Article 56 EPC). Since each of claims 2 to 20 contains all features of claim 1 this conclusion applies equally to those claims.

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 with the order to maintain the patent on the basis of the following documents filed as sole request during the oral proceedings:
 - claims 1 to 20

 - description (pages 2 to 9)

 - figures 1 to 19.

The Registrar:

The Chairman:

A. Vottner

S. Crane