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**Datasheet for the decision
of 29 January 2015**

Case Number: T 2176/10 - 3.4.02

Application Number: 06716819.5

Publication Number: 1846783

IPC: G02B6/00, F21V8/00

Language of the proceedings: EN

Title of invention:

LIGHTING FITTING

Applicant:

Skoff Spolka Z O.O.

Headword:

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (yes) -
disclosure in drawings

Decisions cited:

T 1011/07

Catchword:



Beschwerdekammern
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Case Number: T 2176/10 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 29 January 2015

Appellant: Skoff Spolka Z O.O.
(Applicant) Ul Legionow 243 A
43 500 Czechowice-Dziedzice (PL)

Representative: Karczmitowicz, Teresa Ewa
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 17 May 2010
refusing European patent application No.
06716819.5 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman B. Müller
Members: A. Hornung
H. von Gronau

Summary of Facts and Submissions

- I. The applicant appealed against the decision of the examining division refusing European patent application No. 06716819.5 on the basis of Article 54(1) and (2) EPC.
- II. In its statement setting out the grounds of appeal, filed with a letter of 17 September 2010, the appellant requested that the decision of the examining division be set aside. No amendments to the application documents having been filed, the board considered that the appellant requested that a patent be granted on the basis of the request filed with its letter dated 25 March 2009 being the subject of the decision under appeal.

With a letter dated 30 April 2014, the appellant "declares that his position expressed in this letter shall exchange the one reported in the letter of appeal of 17 September 2010". Together with the letter of 30 April 2014, the appellant filed a new main request comprising description pages 1-6 to replace pages 1-3 as originally filed, an amended claim 1 and new dependent claims 2-10 to replace sole claim 1 underlying the appealed decision, and amended figures 2 and 3 to replace figures 2 and 3 as originally filed.

As a precaution, the appellant requested oral proceedings.

- III. In a communication annexed to the summons to oral proceedings, the board informed the appellant about its provisional and non-binding opinion according to which the board intended to exercise its discretion under Article 13(1) RPBA in not admitting the amendment of the application documents into the appeal proceedings.

The board's opinion was worded as follows (see point 5 of the communication annexed to the summons):

5. *"Admissibility of the amendment to the applicant's case*

5.1 *Pursuant to Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA; OJ EPO 2007, 536) "any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy."*

5.2 *The board is confronted with a prima facie completely "fresh case", contrary to the requirement of Article 12(2) RPBA, according to which the applicant's initial statement of grounds of appeal filed within the four months time limit specified in Article 108 EPC "shall contain a party's complete case".*

Not only has the argumentation filed with letter dated 30 April 2014 exchanged the entire grounds of appeal, but the applicant appears to declare the initial grounds of appeal to be invalid since, e.g., "the Applicant agrees that this document [D4] destroys novelty of formerly claimed invention" (see point 2.3.2. of the letter dated 30 April 2014 and, more generally, point 2.2. of that letter).

5.3 *A very large number of words in the present description and the present set of claims 1-10 have been modified, added or deleted with respect to the application documents as originally filed and/or with respect to the application documents underlying the initial grounds of appeal. As a consequence of the substantial amount of amendments, the application documents now on file do prima facie not appear to be clearly allowable. Each modification of new claim 1*

would require an assessment of whether it extends the resulting subject-matter beyond the content of the application as filed (Article 123(2) EPC) and of whether the subject-matter defined by the new wording is clear (Article 84 EPC 1973), even before evaluating novelty and inventive step of new claim 1. Therefore, the new subject-matter appears to imply a high degree of complexity within the meaning of Article 13(1) RPBA.

...

5.4 If the subject-matter of present claim 1 were novel and inventive, as stated by the applicant in its letter dated 30 April 2014, then the new and inventive feature of present claim 1 would have had to be taken from the description, since the previous set of claims consisted of a single claim 1, which was acknowledged by the applicant as lacking novelty. This raises the question of whether the original search was complete and covered all features of the description or whether an additional search must be carried out.

5.5 In conclusion, the board is currently of the view that the high degree of complexity of the new subject-matter submitted and the new procedural issues to be considered are such that it should exercise its discretion under Article 13(1) RPBA in not admitting the amendment into the appeal proceedings."

IV. In response to the summons to oral proceedings, the appellant, with a letter dated 16 December 2014 and received on 22 December 2014, filed comments concerning the board's preliminary opinion as annexed to the summons, together with new auxiliary requests 1 and 2. The appellant concluded the letter by saying that it would not be attending the oral proceedings.

V. Following the appellant's letter of 16 December 2014, the board issued a communication, dated 22 January 2015, sent by fax on 19 January 2015, informing the appellant that the board maintained its preliminary opinion that the main request was not admissible under Article 13(1) RPBA and that claim 1 of all requests on file infringed the requirements of Article 123(2) EPC.

a) Concerning the issue of admissibility of the main request, the board's opinion was worded as follows (see point 4 of the communication dated 22 January 2015):

4. *"Main request*

Concerning the main request, the board maintains its preliminary opinion expressed in the annex to the summons to oral proceedings that it is confronted with a "fresh case" and, hence, the main request does not appear to be admissible under Article 13(1) RPBA for at least the reasons given in point 5 of the annex of the summons. Indeed, the applicant, in its letter of response of 16 December 2014, explains why the amendments are reasonable but does not seem to deny that the board is confronted with a fresh case and that a very large number of words in the application documents have been modified, added or deleted."

b) Concerning the issue under Article 123(2) EPC, the board's opinion was worded as follows (see point 8 of the communication dated 22 January 2015):

8. *"Article 123(2) EPC*

Notwithstanding the issues about admissibility of a "fresh case" and the late filing of the auxiliary requests, the board informs the applicant about its preliminary opinion according to which claim 1 of all current requests appears to

contain subject-matter which extends beyond the content of the application as filed, contrary to the requirement of Article 123(2) EPC.

The original application neither contains the explicit wording of, nor a clear hint towards the features of the characterizing portion of claim 1, which are all related to the physical relationship between the "optical waveguide" and the "casing". The description as originally filed discloses some details about the "optical waveguide" (has the form of a shaped plate; forms a front wall, a back wall and edges; its relationship with a light source) and the "casing" (one side open; light source placed inside) but discloses no details about the physical relationship between the "optical waveguide" and the "casing" other than the statement that "on the side of the casing opening, there is an optical element in the form of a shaped plate" (page 2, lines 15-16).

According to the applicant, the basis for these features is to be found in the drawings.

However, in the board's preliminary view, since the description does not contain any suggestion that a specific physical relationship between the "optical waveguide" and the "casing" is relevant at all for the invention, the skilled person could not directly and unambiguously recognize such physical relationship as being effectively a technical feature of the lighting fitting shown in the figures 1 to 4 which is the deliberate result of the technical considerations directed to the solution of a technical problem involved, rather than an accidental expression of the draughtsman's artistic freedom (see e.g. T 1011/07, point 1.4 of the Reasons).

In conclusion, even if the board would consider that it was not confronted with a "fresh case" as to one or several of

the pending requests and admit the respective request(s) into the proceedings, none of the requests appears to be allowable since claim 1 of all pending requests appears to infringe Article 123(2) EPC."

VI. Independent claim 1 of the appellant's main request reads as follows:

"1. An electric powered lighting fitting comprising a casing (1) with a source of light (2) placed inside said casing and an light guide (4) in the form of a plate mounted to this casing, said light guide (4) having a transparent front wall (5), a transparent proximal wall (3), abutting the source of light (2), a transparent distal wall (7) on the opposite side of the light guide (4), a back wall (6) where at least a part of the surface of the back wall (6) is matted or covered with a light reflecting material or fluorescent material, characterized in that the light guide (4) is mounted at its one end to the casing (1), and a part of the front wall (5) of the light guide (4) is covered by a part of the front side (8) of the casing (1), the back side (9) of the casing (1) is open and the back wall (6) of the light guide (4) and the open back side (9) of the casing (1) are coplanar."

Independent claim 1 of the appellant's first auxiliary request reads as follows:

"1. An electric powered lighting fitting comprising a casing (1) with a source of light (2) placed inside said casing and an optical waveguide (4) in the form of a plate mounted to this casing, said optical waveguide (4) having a transparent front wall (5), a transparent proximal edge (3), abutting the source of light (2), a transparent distal edge (7) on the opposite side of the optical waveguide (4), a back wall (6) where at least a part of the surface of the back wall (6) is matted or covered with a light reflecting material or

fluorescent material, characterized in that the optical waveguide (4) is mounted at its one end to the casing (1), and a part of the front wall (5) of the optical waveguide (4) is covered by a part of the front side of the casing (1), the back side of the casing (1) is open and the back wall (6) of the optical waveguide (4) and the open back side of the casing (1) are coplanar."

Independent claim 1 of the appellant's second auxiliary request reads as follows:

"1. An electric powered lighting fitting comprising a casing (1) with a source of light (2) placed inside said casing and an optical waveguide (4) in the form of a plate mounted to this casing, said optical waveguide (4) having a transparent front wall (5), a transparent proximal edge (3), abutting the source of light (2), a transparent distal edge (7) on the opposite side of the optical waveguide (4), a back wall (6) preferably parallel to the front wall (5) where at least a part of the surface of the back wall (6) is matted or covered with a light reflecting material or fluorescent material, characterized in that the optical waveguide (4) is mounted at its one end to the casing (1), and a part of the front wall (5) of the optical waveguide (4) is covered by a part of the front side of the casing (1), the back side of the casing (1) is open and the back wall (6) of the optical waveguide (4) and the open back side of the casing (1) are coplanar."

Reasons for the Decision

In the communication annexed to the summons to oral proceedings, the board expressed its provisional view that in particular the high degree of complexity of the new subject-matter encompassed by the main request, i.e. the amended

application documents filed with the letter of 30 April 2014, was such that it should exercise its discretion under Article 13(1) RPBA in not admitting that request into the appeal proceedings. Furthermore, in the communication dated 22 January 2015 and notified in advance by fax on 19 January 2015, the board informed the appellant that the appellant's arguments in favour of admissibility of the main request, filed with its letter dated 16 December 2014, were not convincing. See point V.a) above.

In the communication dated 22 January 2015, the board also expressed its provisional view, along with the underlying reasons, in respect of Article 123(2) EPC, notwithstanding the issue of admissibility of the late filed auxiliary requests. The board said that claim 1 of **all** current requests, i.e. the main request, filed with the letter of 30 April 2014, and both auxiliary requests 1 and 2, filed with the letter of 16 December 2014, contravened the requirements of Article 123(2) EPC. See point V.b) above. The appellant neither attempted to rebut this provisional view, nor submitted any new requests aiming at overcoming the objections. The board sees no reason to deviate from its provisional view regarding Article 123(2) EPC, which therefore becomes final.

It follows that, irrespective of whether or not any of the pending requests (in particular the main request) can be admitted into the proceedings, claim 1 of all pending requests does not meet the requirements of Article 123(2) EPC for the reasons set out in the board's provisional opinion notified on 19 January 2015.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Kiehl

B. Müller

Decision electronically authenticated