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**Datasheet for the decision
of 13 June 2013**

Case Number: T 2069/11 - 3.2.08
Application Number: 02252017.5
Publication Number: 1245761
IPC: E05B 7/00, E05B 65/20,
H03K 17/96
Language of the proceedings: EN

Title of invention:
Vehicle outer handle system

Patent Proprietors:
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HONDA GIKEN KOGYO KABUSHIKI KAISHA
Stanley Electric Co., Ltd.

Opponent:
Huf Hülsbeck & Fürst GmbH & Co. KG

Headword:
-

Relevant legal provisions:
EPC Art. 54, 100(a), 123(2), 114(2)

Keyword:
"Main request and auxiliary requests 1 and 2 (novelty - no)"
"Auxiliary request 3 (added subject-matter - yes)"
"Request for interruption of the oral proceedings to prepare
a further auxiliary request (not granted)"

Decisions cited:
-

Catchword:
-



Case Number: T 2069/11 - 3.2.08

D E C I S I O N
of the Technical Board of Appeal 3.2.08
of 13 June 2013

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
25 July 2011 concerning maintenance of the
European patent No. 1245761 in amended form.

Composition of the Board:

Chairman: T. Kriner
Members: M. Alvazzi Delfrate
D. T. Keeling

Summary of Facts and Submissions

- I. By decision posted on 25 July 2011 the opposition division decided that the European patent No. 1 245 761 in amended form according to the main request then on file and the invention to which it related met the requirements of the EPC.
- II. The appellant (opponent) lodged an appeal against this decision on 23 September 2011, paying the appeal fee on the same day. The statement setting out the grounds for appeal was filed on 25 November 2011.
- III. Oral proceedings before the Board of Appeal were held on 13 June 2013.
- IV. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietors) requested that the appeal be dismissed and the patent be maintained with claims according to the main request filed with letter dated 11 April 2012 (corresponding to the request allowed during the oral proceedings of 16 June 2011) or, in the alternative, in accordance with the first, second or third auxiliary request filed with letter dated 11 April 2012. Furthermore, it requested an interruption of the oral proceedings in order to prepare a further auxiliary request.

- V. Claim 1 according to the **main request** reads as follows:

"A vehicle outer handle system comprising:

a handle main body (7) formed from a synthetic resin and comprising a grip part (7a), one end of the handle main body (7), when mounted to a door outer panel (6), being swingably supported in the door outer panel (6); an electrode (21) for detecting a change in capacitance, the electrode being housed within the grip part; a grounded electrostatic shield plate (22) disposed outwardly of the electrode; and a retaining member (20) inserted in said grip part (7a), said electrode (21) and said electrostatic shield plate (22) being disposed on opposite surfaces of said retaining member (20), with the electrode (21) being disposed on the inside surface of the retaining member (20) that faces the outer panel (6), and the electrostatic shield plate (22) being disposed on the outside surface of the retaining member (20) that faces a direction opposite from the outer panel (6)."

Claim 1 of the **auxiliary request 1** reads as follows (differences in respect of the main request emphasised):

"A vehicle outer handle system comprising:
a handle main body (7) formed from a synthetic resin and comprising a grip part (7a), one end of the handle main body (7), when mounted to a door outer panel (6), being swingably supported in the door outer panel (6); an electrode (21) for detecting a change in capacitance relative to ground, the electrode being housed within the grip part;
a grounded electrostatic shield plate (22) disposed outwardly of the electrode; and

a retaining member (20) inserted in said grip part (7a), said electrode (21) and said electrostatic shield plate (22) being disposed on opposite surfaces of said retaining member (20), with the electrode (21) being disposed on the inside surface of the retaining member (20) that faces the outer panel (6), and the electrostatic shield plate (22) being disposed on the outside surface of the retaining member (20) that faces a direction opposite from the outer panel (6), so as to be housed within the grip part (7a) outwardly of the electrode."

Claim 1 of the **auxiliary request 2** reads as follows (differences in respect of the main request emphasised):

"A vehicle outer handle system comprising:

a handle main body (7) formed from a synthetic resin and comprising a grip part (7a), one end of the handle main body (7), when mounted to a door outer panel (6), being swingably supported in the door outer panel (6); an electrode (21) for detecting a change in capacitance, the electrode being housed within the grip part;

a grounded electrostatic shield plate (22) disposed outwardly of the electrode in order to prevent any increase in the capacitance between the electrode and ground when the outside of the grip part is directly touched by a human hand or is touched by a human body via clothes or a glove; and

a retaining member (20) inserted in said grip part (7a), said electrode (21) and said electrostatic shield plate (22) being disposed on opposite surfaces of said retaining member (20), with the electrode (21) being

disposed on the inside surface of the retaining member (20) that faces the outer panel (6), and the electrostatic shield plate (22) being disposed on the outside surface of the retaining member (20) that faces a direction opposite from the outer panel (6)."

Claim 1 of the **auxiliary request 3** reads as follows (differences in respect of the main request emphasised):

"A vehicle outer handle system comprising:
a handle main body (7) formed from a synthetic resin and comprising a grip part (7a), one end of the handle main body (7), when mounted to a door outer panel (6), being swingably supported in the door outer panel (6);
an electrode (21) for detecting a change in capacitance, the electrode being housed within the grip part;
a grounded electrostatic shield plate (22) disposed outwardly of the electrode; and
a retaining member (20) inserted in said grip part (7a), said electrode (21) and said electrostatic shield plate (22) being disposed on opposite surfaces of said retaining member (20), ~~with the electrode (21) being disposed on the inside surface of the retaining member (20) that faces the outer panel (6), and the electrostatic shield plate (22) being disposed on the outside surface of the retaining member (20) that faces a direction opposite from the outer panel (6) to form an insert with the electrode (21) forming the inside of the insert facing towards the outer panel (6) and the electrostatic shield plate (22) forming the outside of the insert facing a direction opposite from the outer panel (6).~~"

VI. The following documents played a role for the present decision:

D2: WO -A- 02/33203; and

D2': application No. DE 100 51 055.8 (priority of D2).

VII. The arguments of the appellant can be summarised as follows:

Admissibility of the main request

The main request was filed during the oral proceedings before the opposition division. There was no valid reason for this delay, since no new objection had been raised at those oral proceedings. Moreover, features taken from the description had been introduced in claim 1, which rendered necessary an additional search. However, this was not possible any more, since the patent proprietor had waited until the oral proceedings to present this request. Therefore, its introduction into the proceedings ran contrary to the principle of fairness and the opposition division did not exercise its discretion correctly. Hence, the main request should be dismissed as inadmissible.

Main request - Novelty

In any event the subject-matter of claim 1 of the main request was not novel. In particular the prior right D2 disclosed a handle system with all the features according to claim 1 of the main request. In the embodiment shown in Figure 6 a grounded electrostatic shield plate 50 was situated between a first and a

second electrode 11, 12, outwards of electrode 11. Moreover, according to page 11, lines 13 to 16, the electrodes 11 and 12 were separated by a multilayer circuit board. For the person skilled in the art this meant that those electrodes were disposed on the surfaces of the multilayer board. Indeed the respondent itself had understood the disclosure of D12 in this way according to its submission of 28 July 2008, page 5, second full paragraph.

In this assembly the portion of the multilayer circuit board comprised between the electrode 11 and the electrostatic shield plate 50 could be regarded as a retaining member having on its opposite surfaces the electrode 11 and the electrostatic shield plate 50.

Since claim 1 did not exclude that the electrostatic shield plate was further covered by a further element, such as for instance another portion of the multilayer circuit board, its subject-matter was disclosed in D2.

Admissibility of auxiliary requests 1 to 3

Auxiliary requests 1 to 3 were late-filed and comprised features taken from the description, which rendered necessary a supplementary search. Hence, they should not be admitted into the proceedings.

Auxiliary requests 1 and 2 - Novelty

The subject-matter of claim 1 of each of the auxiliary requests 1 and 2 was also disclosed in D2.

In particular, as far as auxiliary request 2 was concerned, the disclosure on page 3, lines 21 to 28 of D2 was relevant. According to this passage, the field of each electrode was stopped by the ground electrode, i.e. the electrostatic shield plate, so that the field of the one electrode was not affected by an approach on the other side respectively. Therefore, D2 disclosed that the grounded electrostatic shield plate prevented any increase in the capacitance between the electrode and the ground when the outside of the grip part was directly touched by a human hand or by a human body via clothes or a glove.

Auxiliary request 3 - Article 123(2) EPC

The features introduced in claim 1 of auxiliary request 3 were not comprised in the application as originally filed. In particular, paragraph [0014] disclosed merely that the electrode 21 was disposed on the inside of the retaining plate 20, while a grounded electrostatic shield plate was disposed on its outside. Even if this assembly were to be realised outside the handle and then inserted inside it, there was no explicit disclosure that the electrode and the shield plate formed respectively the inside facing towards the outer panel and the outside facing a direction opposite to that panel of the insert. Hence, auxiliary request 3 introduced subject-matter that extended beyond the content of the application as filed.

Request to interrupt the oral proceedings in order to prepare a further auxiliary request

All the objections which led to the rejection of the main request and auxiliary requests 1 to 3 had been put forward well in advance of the oral proceedings. Hence, there was no reason for the submission of a request which had not even been prepared yet and might render necessary an adjournment of the oral proceedings. Therefore, the request to interrupt the oral proceedings should be dismissed.

VIII. The arguments of the respondent can be summarised as follows:

Admissibility of the main request

The main request was admitted into the proceedings by the opposition division making use of its discretionary power. The reasons underlying this decision, as set out under point 5 of the decision under appeal, were correct. Hence, there was no reason to dismiss the main request as inadmissible.

Main request - Novelty

D2 did not disclose a handle system with all the features of claim 1 of the main request. It was true that according to page 11, lines 13 to 16, the electrodes 11 and 12 were separated by a multilayer circuit board. However, this passage did not clearly and unambiguously disclose that those electrodes, especially electrode 11, were disposed on the surface of that multilayer board: electrode 11 could be

separated from the multilayer board by air or another material, such as for instance injection-moulded plastics.

In any event, claim 1 required the shield plate to be on the outside surface of the retaining member, while in an assembly with electrodes disposed on the surfaces of the multilayer circuit board the plate 50 would be embedded in the board.

Hence, the subject-matter of claim 1 of the main request was novel.

Admissibility of auxiliary requests 1 to 3

Auxiliary requests 1 to 3 were filed together with the reply to the statement of grounds of appeal and there was no reason to dismiss them as inadmissible.

Auxiliary requests 1 and 2 - Novelty

The subject-matter of claim 1 of auxiliary request was novel for the same reason given for the main request.

In respect of auxiliary request 2 it was also to be considered that D2 merely taught that the influence of electrode 12 on electrode 11 was to be shielded and that Figure 6 was a sectional view. An arrangement as shown in the drawing on page 18 of the letter of 11 April 2012, wherein the electrostatic shield did not completely cover the inner electrode, was also in accordance with the teaching of D2. Hence, this document did not clearly and unambiguously disclose the prevention of any increase in the capacitance between

the electrode and the ground when the outside of the grip part was directly touched. The subject-matter of claim 1 of auxiliary request 2 was novel also for this reason.

Auxiliary request 3 - Article 123(2) EPC

Auxiliary request 3 clarified the difference in relation to D2. It was true that the application as originally filed did not literally disclose that the electrode and the electrostatic shield plate were disposed on opposite surfaces of the retaining member to form an insert with the electrode forming its inside facing towards the outer panel and the electrostatic shield plate forming its outside facing a direction opposite from the outer panel. However, according to paragraph [0014] the retaining member was inserted in the handle. It was clear to the person skilled in the art that the electrode and the electrostatic shield plate were to be disposed on the surfaces of the retaining member before insertion, and thus formed an insert with it. Moreover, since no further layers were disclosed, it was clear that they formed the inside and the outside of that insert. Accordingly, auxiliary request 3 complied with the requirement of Article 123(2) EPC.

Request to interrupt the oral proceedings in order to prepare a further auxiliary request

In its communication of 8 February 2013 the Board acknowledged the novelty of the subject-matter of the main request over D2. Therefore, the change of view in this respect during the oral proceedings came as a

surprise. Since the auxiliary requests had also been regarded as not allowable and in particular auxiliary request 3 was considered to be contrary to Article 123(2) EPC, it was necessary to prepare a new auxiliary request at this late stage. It was intended to base also this request on paragraph [0014] so that its consideration would not require an adjournment of the proceedings. Therefore, the request to interrupt the oral proceedings to prepare and file that further auxiliary request was justified.

Reasons for the Decision

1. The appeal is admissible.
2. Admissibility of the main request

The main request was filed during the oral proceedings before the opposition division, which admitted it into the proceedings making use of its discretionary power under Article 114(2) EPC.

A Board of Appeal should only overrule the way in which a department of first instance has exercised its discretionary power if the Board concludes that it has done so according to the wrong principles or in an unreasonable way.

In the decision under appeal, under point 5, the opposition division explained why it considered that the submission of the main request was a reaction to an objection raised one month before the oral proceedings, and why the opponent could not have been taken by

surprise by that request, which did not involve unsearched subject-matter.

Under these circumstances, there is no reason to conclude that, in deciding to admit the main request into the proceedings, the opposition division exercised its discretionary power according to the wrong principles or in an unreasonable way. Accordingly, that request is also admitted into the appeal proceedings.

3. Main request - Novelty

3.1 The patent in suit claims the priority date of 28 March 2001 and designates the contracting states DE FR and GB.

D2 is a Euro-PCT application filed on 11 October 2001 and claiming the priority of D2' (14 October 2000). It was published in German and the designation fees for the contracting states DE, FR, GB IT have been paid.

Accordingly, D2 belongs, as far as its priority is validly claimed, to the prior art to be considered for assessing novelty under Article 54(3), Article 54(4) EPC 1973 and Article 158(1) and (2) EPC 1973, which apply to the patent in suit (see Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000).

3.2 D2 undisputedly discloses a vehicle outer handle system which comprises a handle main body formed from a synthetic resin and comprising a grip part (34). One end of the handle main body, when mounted to a door

outer panel, is swingably supported in the door outer panel (see Figure 2).

The handle system further comprises an electrode (11) for detecting a change in capacitance housed within the grip part (see page 3, lines 11 to 19). A grounded electrostatic shield plate (50) is disposed outwardly of the electrode (see page 3, lines 21 to 28, page 6, lines 4 to 8, page 11, lines 6 to 16 and Figure 6). A multilayer circuit board separates that electrode (11) from a further electrode (12) disposed outwardly of the shield plate (see page 11, lines 13-16).

- 3.3 D2 does not expressly mention whether the electrodes and the electrostatic shield plate are in contact with the multilayer circuit board.

However, the person skilled in the art is aware that a multilayer circuit board is a circuit board comprising a plurality of layers, used to mechanically support and electrically connect a plurality of electronic components by conductive pathways. It is thus implicit to him that the components of D2, including the electrodes 11 and 12 and the shield 50, are to be arranged on or embedded in that multilayer circuit board.

Therefore, it is clear to the person skilled in the art that the electrodes separated by the multilayer circuit board are arranged on opposite surfaces of that board. By contrast, the arrangement put forward by the respondent, with the electrode 11 separated from the multilayer circuit board by air or another material, although theoretically possible, would be discarded by

the person skilled in the art, who knows the function of a multilayer circuit board.

As a matter of fact the respondent itself acknowledged, in its letter of 28 July 2008, that from the disclosure of Figure 6 and page 11, lines 13 to 16 of D2, "the skilled man would understand that the first electrode 11, second electrode 12 and the ground electrode 50 are provided as components of laminated layers of a circuit board making up a multi-layer circuit board 36."

Indeed this is in agreement with the rest of the disclosure of D2, which on page 10, line 34 to page 11, line 2, albeit referring to another Figure, discloses that the multilayer circuit board 36 carries arranged on it the electrodes 11 and 12.

Therefore, the person skilled in the art clearly and directly derives from D2 that the electrodes 11 and 12 are disposed on the surfaces of the multilayer circuit board 36 and the electrostatic shield 50 is embedded between two of its substrate layers.

- 3.4 In this arrangement the layer (or layers) of the multilayer circuit board comprised between the electrode 11 and the electrostatic shield plate can be regarded as a retaining member.

It is true that the electrostatic shield plate (50) is covered by further layers, since it is embedded between two substrate layers of the multilayer circuit board. However, claim 1 of the main request merely stipulates that the electrostatic shield plate is disposed on the outside surface of the retaining member, without

excluding the presence of further layers outwards of it.

- 3.5 Therefore, D2 discloses a handle system with all the features of claim 1 of the main request. Moreover, all the parts of D2 relevant to that disclosure, namely Figure 6, page 3, lines 21 to 28, page 6, lines 4 to 8, page 10, line 34 to page 11, line 2 and page 11, lines 6 to 16 are to be found in identical terms in its priority document D2' (see Figure 6, paragraphs [0007], [0015], [0023] and [0024]). Hence, a handle system according to claim 1 belongs to the prior art under Article 54(3) and (4) EPC1973.

Accordingly, the subject-matter of claim 1 of the main request lacks novelty.

4. Auxiliary request 1

In the arrangement shown in Figure 6 of D2 the electrode is for detecting a change in capacitance relative to ground and the electrostatic shield plate is disposed so as to be housed within the grip part outwardly of the electrode. Accordingly, the subject-matter of claim 1 of auxiliary request also lacks novelty.

5. Auxiliary request 2

It is true that Figure 6 of D2 is merely a sectional view, showing an arrangement wherein the electrostatic shield does not necessarily completely cover the inner electrode.

However, according to the passage on page 3, lines 24 to 27, (to be found in identical terms in paragraph [0007] of the priority D2') the field of each electrode is stopped by the electrostatic shield (Massenelektrode), so that the field of the one electrode is not affected by an approach on the other side respectively.

Therefore, the prior art D2 clearly and unambiguously discloses that the electrostatic shield plate prevents any increase in the capacitance between the electrode and the ground when the outside of the grip part is directly touched. Hence, the subject-matter of claim 1 of auxiliary request 2 is also not novel.

6. Auxiliary request 3

It is undisputed that the application as originally filed does not literally disclose that the electrode and the electrostatic shield plate are disposed on opposite surfaces of the retaining member to form an insert, with the electrode forming the inside of the insert facing towards the outer panel and the electrostatic shield plate forming the outside of the insert facing a direction opposite from the outer panel.

The respondent pointed out that paragraph [0014] discloses that a retaining plate is inserted in the handle. However, even assuming that the electrode and the grounded electrostatic shield plate are disposed on the surfaces of the retaining plate before inserting it in the handle, there is no disclosure in the application that no further layers are disposed on the

electrode and the electrostatic shield. Also the fact that such further layers are not mentioned does not exclude their presence, for instance to protect the electrode and the electrostatic shield during insertion. Accordingly, it is not clearly and unambiguously derivable from the application as filed that the electrode forms the inside of the insert facing towards the outer panel and the electrostatic shield plate forms the outside of the insert facing a direction opposite from the outer panel.

Therefore, auxiliary request 3 has been amended contrary to Article 123(2) EPC.

7. Request to interrupt the oral proceedings in order to prepare a further auxiliary request

After closure of the debate on auxiliary request 3, i.e. at an extremely late stage of the proceedings, the representative of the respondent requested an interruption of the oral proceedings so that he could prepare a further auxiliary request.

The debate in the oral proceedings up to that point had been limited to objections already raised during the written proceedings. Accordingly, no unexpected matter had arisen during the oral proceedings creating new circumstances which could justify the respondent's request.

It is true that the Board indicated in its communication of 8 February 2013 that D2 did not appear to disclose that the electrode and the electrostatic shield plate are disposed on opposite surfaces of the

multilayer circuit board. However, the Board did not state that the main request or one of the auxiliary requests could form the basis for the maintenance of the patent. Moreover and most important, the communication of the Board merely set out its provisional opinion without any binding effect, and did not imply that the Board might not subsequently find differently when deciding on the case. Therefore, there was no justification for interrupting the oral proceedings so that the respondent could prepare a new set of claims at this late stage.

Moreover, the respondent indicated that the further request would be based on paragraph [0014]. The claims would thus incorporate features from the description. As a consequence, they would require an examination not only of the issues of novelty and inventive step but also of the requirements enshrined in Articles 123(2) and 84 EPC, and possibly require a postponement of the oral proceedings to allow an additional search. Therefore, the submission of such claims at this late stage could not be conducive to an efficient procedure.

Under these circumstances, the Board did not allow the respondent's request to interrupt the oral proceedings in order to prepare a further auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

V. Commare

T. Kriner