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**Datasheet for the decision
of 7 March 2017**

Case Number: T 1681/14 - 3.2.03

Application Number: 07826326.6

Publication Number: 2066965

IPC: F21S8/10, F21V11/16, H01K1/26,
H01K9/08

Language of the proceedings: EN

Title of invention:
LAMP FOR MOTOR VEHICLES

Applicant:
Philips Intellectual Property & Standards GmbH
Koninklijke Philips N.V.

Headword:

Relevant legal provisions:
RPBA Art. 12(4), 13(1), 13(3)

Keyword:

Decisions cited:

Catchword:



Beschwerdekammern
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Case Number: T 1681/14 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 7 March 2017

Appellant: Philips Intellectual Property & Standards GmbH
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Appellant: Koninklijke Philips N.V.
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Representative: Rüber, Bernhard Jakob
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 27 January 2014 refusing European patent application No. 07826326.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Ashley
Members: Y. Jest
E. Kossonakou

Summary of Facts and Submissions

I. The appeal is against the decision of the examining division to refuse European patent application No. 07826326.6.

II. First instance procedure

The examining division had issued a communication pursuant to Article 94(3) EPC and a summons to attend oral proceedings pursuant to Rule 115(1) EPC, all raising objections *inter alia* under Article 56 EPC. These objections were founded on the fact that, when starting from D10 (JP61183001U) as closest prior art, it was obvious for the skilled person to add to the claimed main headlamp of a motor vehicle a colour filter for colouring a light beam as generally known in the art in order to reduce the risk of glare for the oncoming traffic.

These objections were addressed to the main request as well as to the auxiliary requests filed by the applicant during the examination procedure.

In a letter of 11 November 2013, the applicant informed the examining division that it would not be attending the oral proceedings and requested a decision based on the state of the file of the application.

The decision under appeal was based *inter alia* on the ground that claim 1 of the main request did not meet the requirements of Article 56 EPC and that the same objection applied to claim 1 of the auxiliary requests A and B, which raised additional objections under Articles 84 and 123(2) EPC.

III. The applicant appealed and requested in the notice of appeal that the decision under appeal be set aside.

Oral proceedings and remittal to the examining division were requested as auxiliary measures.

With the statement of grounds of appeal the appellant filed three sets of claims according to a main request and to auxiliary requests 1 and 2. Claim 1 of the main request was identical to claim 1 of the main request as rejected by the examining division and claim 1 of auxiliary request 2 corresponded to claim 1 of auxiliary request A also rejected by the examining division. Claim 1 of auxiliary request 1 was based on claim 1 of the main request completed by an additional feature taken from the description.

The appellant requested that a patent be granted on the basis of one of the sets of claims filed with the statement of grounds of appeal.

IV. In a communication dated 24 November 2016 the board gave its provisional opinion. It considered that none of the sets of claims filed with the grounds of appeal appeared to meet the requirements of the EPC and that the contested decision was therefore to be confirmed.

V. Requests

During the oral proceedings the appellant confirmed its requests made in its letter of 20 February 2017, namely:

- that the decision under appeal be set aside and
- that a patent be granted based on the set of claims filed with the letter dated 20 February 2017 as its sole request, alternatively
- that the case be remitted to the examining division for further prosecution.

(a) Claim 1 of the request reads:

"A lamp for a main headlamp of a motor vehicle, at least comprising

- a first incandescent filament (2) for producing a light beam having a light/dark cutoff line, and
- a shielding cap (4) for restricting the light emitted by the incandescent filament (2) to a given angular range,
- the shielding cap (4) having at least one opening (5) for producing a light beam above the light/dark cutoff line by light emitted by the incandescent filament (2) and passing through the opening (5),
- the outline of the opening (5) being incorporated in the outline of the shielding cap (4),
- the opening (5) being approximately slotted in form with an approximately rectangular shape,
characterized in that
- the longitudinal axis of the opening (5) is arranged approximately perpendicular to the longitudinal axis of the lamp,
- the opening (5) is situated approximately centrally and opposite the central region of the incandescent filament (2), and
- the width of the opening(5) is $\leq 1,5$ mm."

(b) Dependent claim 8 of the request reads:

"A lamp as claimed in any one of the preceding claims, **characterized in that** the opening (5) and further openings in the shielding cap (4) are in such a manner sized and arranged that the light beam having the light/dark cutoff line contains lighted strips above the light/dark cutoff line at three points (A, B, C) located approximately 30 m, 60 m and 80 m in front of the motor vehicle."

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

In its letter of 20 February 2017 the appellant, after a change of representative, agreed:

- that the lamp known from D10 disclosed all the features of claim 1 as originally filed,
- that D4 (DE10004701A1) addressed the object of illuminating road and guiding signs well above the eye line of the oncoming traffic, as did the embodiment of figures 3 and 4 of the application and which was defined in claim 8 as filed, and
- that it was well-known to the person skilled in the art that light coloured yellow alleviates glare, while blue colouring improves intelligibility of road and guiding signs.

Taking these findings into consideration, the appellant filed a revised set of claims in which claim 1 was restricted to the variant illustrated by figures 1 and 2 of the application.

By claiming the variant of figures 1 and 2 of the application, the invention no longer concerned improved illumination above the bright/dark cutoff line (figures 3 and 4), but was now focused on the signal effect achieved by light flashes informing the oncoming traffic of an approaching vehicle, thereby improving safety for the traffic on the road.

This variant, which was disclosed in the application, defined new subject-matter which was neither known nor derivable from the cited prior art.

The set of claims filed with letter of 20 February 2017 should therefore be admitted into the appeal proceedings.

- VII. At the end of the oral proceedings held on 7 March 2017 the board pronounced the decision.

Reasons for the Decision

1. Admission of the set of claims into the proceedings.

The set of claims of the sole request was filed with the letter of 20 February 2017, thus two weeks before the oral proceedings held on 7 March 2017.

The admission of the request is therefore a matter of discretion to be exercised by the board pursuant to the provisions set out in Articles 12 and 13 of the Rules of Procedure of the Boards of Appeal (RPBA), and especially Articles 12(4), 13(1) and 13(3) RPBA.

- 1.1 Article 12(4) RPBA

Article 12(4) RPBA expressly refers to the boards' power to exclude requests which could have been filed in the first-instance proceedings.

The board when exercising its discretion over whether or not to admit the request which could have been presented to the first instance, but was not, takes into consideration the procedural aspects of the examination proceedings.

- 1.1.1 During the examination procedure, including the international phase of the application, the applicant had been given ample opportunity to file a set of

claims directed to the embodiment illustrated in figures 1 and 2 of the application, that is to light flashes for warning the oncoming traffic.

However, the sets of claims filed by the applicant during examination were only directed to a lamp as shown in figures 3 and 4, which has the feature that the light beam generated by the opening in the shielding cap passes through a colour filter.

As far as Article 56 EPC was concerned, the decisive issue in the communications and replies, as well as in the summons to attend oral proceedings before the examining division, was whether the only difference over the closest state of the art (D10), namely a filter colouring the light beam above the bright/dark cutoff line, was sufficient to confer inventive step on the claimed subject-matter. With respect to claim 1 the applicant chose to maintain in substance the same subject-matter in all the requests filed in examination proceedings. The applicant decided not to attend the oral proceedings before the examining division and merely requested a decision according to the file. Since the applicant's arguments did not convince the examining division, the application was ultimately refused.

- 1.1.2 With its grounds of appeal the applicant/appellant filed a main and two auxiliary requests all restricted to the same embodiment as dealt with in the examination proceedings, namely the embodiment illustrated in figures 3 and 4.
- 1.1.3 Under these circumstances, in the board's view, the set of amended claims subsequently filed with letter of 20 February 2017, and which replaced all the sets filed

with the grounds of appeal, is not a reaction to the reasoning underlying the appealed decision.

It is instead the result of the applicant's decision to no longer pursue the embodiment that was subject of the examination proceedings and the grounds of appeal.

In doing so, the appellant submits a fresh case to the board of appeal in the sense that:

- the amended set of claims extends the scope of discussion beyond that determined by the grounds of appeal, and
- claim 1 clearly diverges from the claims filed with the grounds of appeal, since it incorporates different features that restrict the claimed subject-matter to a completely different technical aspect relating to figures 1 and 2.

1.1.4 In the board's view, the appellant should have submitted a set of amended claims directed to the embodiment of figures 1 and 2 in the examination proceedings. By presenting its sole and amended request for the first time in the appeal proceedings and only at a late thereof, the applicant is making it impossible for the board to examine the contested decision. This is contrary to the main purpose of *ex parte* appeal proceedings, namely that "*[p]roceedings before the boards of appeal in ex parte cases are primarily concerned with examining the contested decision*" (see point 4 of the reasons for the decision of the Enlarged Board of Appeal G 10/93, OJ EPO 1995, 172).

1.1.5 The appellant has not submitted any arguments as to why the present case is an exception justifying that the set of claims be admitted and that the board carry out a full examination of the application as to patentability requirements. Nor does the board see any

reason why the present case might be treated as such an exception.

1.1.6 In view of the above the board has exercised its discretion under Article 12(4) RPBA by not admitting the claims filed with the letter of 20 February 2017 into the appeal proceedings.

1.2 Article 13(1), (3) RPBA

For the sake of completeness the board also considered the issue of admissibility in the light of Article 13 RPBA as follows.

Under Article 12(2) RPBA, the statement of grounds of appeal and the reply must contain a party's complete case and should, *inter alia*, specify expressly all the facts, arguments and evidence relied on.

Under Article 13(1) RPBA, the boards have a discretion to admit and to consider any amendment to a party's case after it has filed its grounds of appeal or reply. Article 13(3) RPBA adds that amendments sought to be made after oral proceedings have been arranged may not be admitted "if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings".

1.2.1 Article 13(1) RPBA

Article 13(1) RPBA thus governs the implications of an initially incomplete case and the admission of later amendments.

Under Article 13(1) RPBA any amendment to a party's submissions after it has filed its statement of grounds of appeal or reply may be admitted and considered at

the board's discretion. The discretion is 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.

According to established jurisprudence of the Boards of Appeal relating to these criteria, requests filed shortly before or during oral proceedings, may be refused if they are not clearly allowable.

In the present case the set of claims *prima facie* contravenes the requirements of Articles 84 and 123(2) EPC for the following reasons.

(a) Claim 1

The feature, that the light beam produced by the opening formed in the shielding cap (4) is situated above the light/dark cutoff line, is not supported by the application as originally filed in the sense that said light beam(s) contribute to limiting the light/dark cutoff line D as shown in figure 2 and described page 5, lines 9 to 11. The light beam(s) are thus not located above the light/cutoff line D achieved by the lamp shown in figure 1. The light beam(s) is merely located above a cutoff line E corresponding to a conventional lamp in which the shielding cap has no opening (page 5, lines 11 to 13).

Therefore this feature *prima facie* does not meet the requirements of Articles 84 and 123(2) EPC.

The feature defining that the opening is situated approximately centrally and opposite the central region of the incandescent filament *prima facie* lacks clarity under Article 84 EPC because the central/opposite location cannot be defined without the indication of the direction to be considered.

Last but not least, there is no explicit disclosure of the last feature of claim 1 (the width of the opening is $\leq 1,5$ mm). The description merely teaches that very wide openings, i.e. wider than 1,5mm, are not appropriate (page 3, line 13). Claiming 1,5 mm as upper limit for the width of the opening value thus *prima facie* adds fresh subject-matter and contravenes the requirements of Article 123(2) EPC.

(b) Claim 8

Dependent claim 8, which is an additional claim as compared to the set of claims as filed, comprises features which are not unambiguously derivable from the application as originally filed.

There is no disclosure in the originally filed documents of the presence of several openings in the shielding cap. What is disclosed is that the filament 2 of the lamp shown in figure 1, in which the shielding cap 4 has a single opening 5, produces a light cutoff line D resulting in light beams having multiple peaks as represented in figure 2 (see page 5, lines 4 to 22). Without entering a discussion of a possible incompatibility between the embodiment of figure 1 and the resulting light beams with cutoff line D as shown in figure 2, it follows from the above considerations that the addition of dependent claim 8, and in particular the definition of further openings in the shielding cap, contravenes the requirement of Article 123(2) EPC.

1.2.2 Article 13(3) RPBA

In the present case the board considers that the amended claims, which did not appear to fulfill the requirements of Articles 84 and 123(2) EPC, and hence

be allowable, also do not fulfill the conditions governed by Article 13(3) RPBA (paragraph 1.2 *supra*) for the following reasons.

Claim 1 comprises a large number of technical and detailed features derived solely from the description. This raises the question of whether such features were included in the original search, or whether an additional search would be necessary.

The board considers that admitting the set of claims, which was filed with letter of 20 February 2017, thus 2 weeks before the oral proceedings, and which would necessitate an additional search because it shifted the claimed invention in a divergent manner to other technical matter, would *de facto* require a new study of the existing prior art and even a review of the search itself, in order to assess novelty and inventive step. Admitting the belated request into the appeal proceedings would give the applicant "carte blanche" to get oral proceedings postponed, or have the whole examination procedure reopened. That would be at odds with the requisite procedural economy.

This situation would contradict the provision of Article 13(3) RPBA which, in this case, leaves the decision-making board no room for discretion.

Therefore the set of claims cannot be admitted under Article 13(3) RPBA since it raises issues which the board cannot reasonably be expected to address without an adjournment of the oral proceedings.

1.3 Change of representative

The reason given by the appellant for the late submission of the amended set of claims was that the representative had only recently taken over the case.

In application of the established case law that a new representative is expected to take over from where the previous one had left off (see Case Law 8th Edition IV.C.1.3.18), the board considers that this reason could not be accepted as a justification for tardiness.

- 1.4 In view of all these considerations the board has exercised its discretion under Articles 12(4), 13(1) and 13(3) RPBA not to admit into the appeal proceedings the set of claims filed with the letter of 20 February 2017.
2. The board notes that no other amended set of claims has been filed by the appellant.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated