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**Datasheet for the decision
of 2 September 2020**

Case Number: T 1439/16 - 3.2.07

Application Number: 09169230.1

Publication Number: 2161223

IPC: B65G23/08, H02K7/10

Language of the proceedings: EN

Title of invention:

Motorized roller and motor unit for motorized roller

Patent Proprietor:

Itoh Denki Co., Ltd.

Opponents:

Interroll Holding AG
EBM-PAPST ST. GEORGEN GmbH & Co. KG

Headword:

Relevant legal provisions:

EPC Art. 54, 56, 70(1), 113(1), 123(2)

EPC R. 115(2)

RPBA Art. 12(2), 15(1), 13(3)

RPBA 2020 Art. 12(2), 12(3), 13(1), 15(3), 25(1), 25(3)

Keyword:

Oral proceedings - non-attendance of party
Late-filed auxiliary requests - amendments after arrangement
of oral proceedings - admitted (yes)
Late-filed argument - amendments at the oral proceedings -
admitted (no) - procedural economy
Novelty - (yes)
Inventive step - (yes)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

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Case Number: T 1439/16 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 2 September 2020

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
6 April 2016 concerning maintenance of the
European Patent No. 2161223 in amended form.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Pieracci
 S. Watson

Summary of Facts and Submissions

- I. Opponent 1 (appellant) lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division maintaining European patent No. 2 161 223 in amended form.
- II. The opposition had been filed against the patent as a whole based on Article 100 (a) (lack of novelty and inventive step), (b) (insufficiency of disclosure) and (c) EPC (added subject-matter). The opposition division considered the patent as amended according to auxiliary request 2 to comply with the requirements of the EPC.
- III. In the present decision reference is made to the following documents also considered in opposition proceedings:
- D1: Catalogue ECI-Motor, ECI 24.42, ebmpapst, pages 76 to 83;
- D2: Catalogue Binder Steckverbinder, Serie 423, pages 423-2 to 423-16;
- D7: US 3 892 144 A;
- D13: Technical drawing ECI 24.42 R35i-1000, ebmpapst;
- D14: Catalogue Nr. 1005-1-a-e, ODU MINI-SNAP Miniature Cylindrical Connectors with Push-Pull-Locking, Series L, K and B, ODU, pages 2 to 138.
- IV. To prepare for the oral proceedings scheduled at the request of the appellant and the patent proprietor (respondent) , the Board communicated its preliminary assessment of the case to the parties by means of a

communication pursuant to Article 15(1) RPBA 2007. The Board indicated *i.a.* that claim 1 of the patent as maintained in opposition proceedings appeared to contain subject-matter extending beyond the content of the application as originally filed, while the subject-matter of claims 8 and 9 appeared to be new and the subject-matter of claim 1, 2, 8 and 9 appeared to be inventive.

V. With letter dated 30 December 2019 the respondent filed substantive comments and auxiliary requests 1 to 6.

VI. Oral proceedings before the Board took place on 2 September 2020 at the end of which the decision was announced and for further details of which reference is made to the minutes thereof. Opponent 2, also party to the proceedings as of right, did not attend the oral proceedings.

VII. The appellant's final requests were:

that the decision under appeal be set aside and that the patent be revoked.

VIII. The respondent's final requests were:

that, when setting aside the decision under appeal, the patent be maintained in amended form on the basis of auxiliary request 6 filed with letter dated 30 December 2019.

IX. Opponent 2 did not file any requests or make any submissions.

X. As far as relevant for the decision at hand, the parties' written and oral submissions are discussed in the Reasons.

XI. Claim 1 according to auxiliary request 6 reads:

A motorized roller (60), comprising:

- a roller body (11) having two ends;
- a plurality of fixed shafts (61) protruding out of the two ends of the roller body (11); and
- a motor (12) housed in the roller body (11),
- wherein rotation of the motor (12) is adapted to rotate the roller body (11) around the fixed shafts (61),
- at least one of the fixed shafts (61) having a cavity (86) and having a first connector (75) which is a female connector having pin holes and provided at an inside or a distal end of the fixed shaft (61) so as to electrically conduct between inside and outside of the roller body (11) by connection of a separately prepared second connector (62) to the first connector (75),
- the fixed shaft (61) has a first engaging part (67) being formed on an inner wall of the cavity (86) of the fixed shaft (61) for preventing disengagement of the second connector (62), so that a part (70) of the second connector (62) is mechanically engaged with the first engaging part (67), wherein
- the first connector (75) and the second connector (62) are electrically connected to each other by insertion of a connector body (80) of the second connector (62) into the cavity (86) of the fixed shaft (61), and
- including the second connector (62) which is male connector having pins and having a second engaging part (70) at an outer periphery of the second connector (62), so that the second connector (62) is attached to

the fixed shaft (61) by engagement of the first engaging part (67) with the second engaging part (70),
- the second engaging part (70) being an elastic nail (72), and the first engaging part (67) being a projection to be engaged with the nail (72).

XII. Claim 7 according to auxiliary request 6 reads:

A motor unit (1) for a motorized roller (3), being inserted into a roller body (11) so as to constitute the motorized roller (3),
- wherein the motor unit (1) comprises: a cylindrical casing (2); a motor (12) housed in the casing (2); a first shaft (4) protruding out of a distal end of the casing (2); a first holder (10) fixing a proximal end portion of the first shaft (4) to a distal end portion of the casing (2); and a driving shaft (8) protruding out of a proximal end of the casing (2), so that a rotational force of the motor (12) is transmitted to the driving shaft (8),
- the first shaft (4) being hollow, protruding out of the distal end of the casing (2) while being held by the first holder (10), and having a first connector (25) at an inside or a distal end of the first shaft (4), so as to electrically conduct between inside and outside of the roller body (11) by connection of a separately prepared second connector (33) to the first connector (25),
- wherein the first connector (25) is a female connector having pin holes, and the fixed shaft (20) has a first engaging part (24) for preventing disengagement of the second connector (33) which is a male connector having pins, so that a part (37) of the second connector (33) is mechanically engaged with the first engaging part (24), wherein

- the fixed shaft (20) has an inside screw on the inner surface thereof serving as a first engaging part (24) for preventing disengagement of the second connector (33), so that an outside screw (37) of the second connector (33) is mechanically engaged with the inside screw (24) of the fixed shaft.

XIII. Claim 8 according to auxiliary request 6 reads:

A motor unit (1) for a motorized roller (3), being inserted into a roller body (11) so as to constitute the motorized roller (3),

- wherein the motor unit (1) comprises: a cylindrical casing (2); a motor (12) housed in the casing (2); a first shaft (61) protruding out of a distal end of the casing (2); a first holder (10) fixing a proximal end portion of the first shaft (4) to a distal end portion of the casing (2); and a driving shaft (8) protruding out of a proximal end of the casing (2), so that a rotational force of the motor (12) is transmitted to the driving shaft (8),

- the first shaft (4) being hollow, protruding out of the distal end of the casing (2) while being held by the first holder (10), and having a first connector (75) at an inside or a distal end of the first shaft (4), so as to electrically conduct between inside and outside of the roller body (11) by connection of a separately prepared second connector (62) to the first connector (75),

- wherein the first connector (75) is a female connector having pin holes, and the fixed shaft (61) has a first engaging part (67) for preventing disengagement of the second connector (62) which is a male connector having pins, so that a part (72) of the second connector (62) is mechanically engaged with the first engaging part (67), wherein

- the fixed shaft (61) has a projection on an inner surface thereof serving as a first engaging part (67), for preventing disengagement of the second connector (62), so that an elastic nail (72) at an outer periphery of the second connector (62) is mechanically engaged with the projection of the fixed shaft.

Reasons for the Decision

1. Oral proceedings without the participation of one of the parties

According to Rule 115(2) EPC and Article 15(3) RPBA 2020, oral proceedings took place without opponent 2 attending, although they were duly summoned. The principle of the right to be heard pursuant to Article 113 (1) EPC is observed since that provision only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity (see Case Law of the Boards of Appeal, 9th edition 2019, sections III.B.2.7.3 and V.A.4.5.3 with further references to the jurisprudence).

2. Admittance into the proceedings of auxiliary request 6

The appellant argues that auxiliary request 6 was filed after the summons to oral proceedings as a reaction to the communication of the Board and was thus filed late and should therefore not be admitted into the proceedings.

The Board concurs with the appellant that auxiliary request 6 has been filed late, since, according to

Article 12(3) RPBA 2020, which essentially corresponds to Article 12(2) RPBA 2007, the respondent's complete case should have been submitted with the reply to the statement setting out the grounds of appeal.

However, amendments to a party's case filed after the summons to oral proceedings are not to be dismissed *a priori*, but their admittance is subject to the Board's discretion according to Article 13(1) RPBA 2020 and to the provisions of Article 13(3) RPBA 2007, in combination with Article 25(1) and (3) RPBA 2020.

In the present case, by deleting claim 1, the respondent has not introduced new subject-matter to be discussed but rather has reduced the disputed subject-matter, in particular resolving the issue of added subject-matter, so that the amendment is not at all detrimental to the procedural economy, but rather in its favour.

In view of the above the Board considers it appropriate to exercise its discretion by admitting auxiliary request 6 into the proceedings.

3. Admittance of the objection of added subject-matter, raised at the oral proceedings, for claim 7 of auxiliary request 6

The Board cannot follow the argument of the appellant that the objection of added subject-matter under Article 123(2) EPC against claim 7 should be admitted into the proceedings since claim 7 corresponds essentially to claim 1 of the patent as maintained in opposition proceedings, which was objected to on this ground with the statement setting out the grounds of appeal. The appellant also argues that claim 7 is

identical to claim 8 of the patent as maintained, which was objected to for added subject-matter in opposition proceedings, so that this objection is also implicitly part of the appeal proceedings.

The Board does concur with the appellant that, according to Article 12(2) RPBA 2020, the appeal proceedings should be based on the appealed decision and that a decision was taken in opposition proceedings with respect to the objection of added subject-matter of the then claim 8, corresponding to present claim 7.

However, as argued by the respondent, it is the appellant who defines the extent of the appeal and according to Article 12(3) RPBA 2020, which essentially corresponds to Article 12(2) RPBA 2007, the statement of grounds of appeal shall contain a party's complete case. It was the choice of the appellant to make an objection for added subject-matter only to claim 1 and not to claim 8 in the statement setting out the grounds of appeal (see point 1. a) and 1.b) thereof), while objecting to both claims for lack of inventive step (see point 3. a) thereof).

Furthermore the Board notes that submitting this objection for the first time at the oral proceedings is detrimental to procedural economy, since the appellant was aware of auxiliary request 6 some six months before the oral proceedings and, thus, could have submitted the objection well before the oral proceedings to allow both the respondent and the Board to prepare for a substantial discussion. Furthermore, by waiting until the date of oral proceedings the appellant confronted the respondent with a surprising attack that, for reasons of procedural fairness and the respondent's right to be heard, would have necessitated giving the

respondent an opportunity to react to the new objection, for example by filing additional (auxiliary) requests, which undoubtedly would delay the proceedings.

In view of the above the Board considers it appropriate to exercise its discretion pursuant to Article 13(1) RPBA 2020 and Article 13(3) RPBA 2007 and to not admit the objection of added subject-matter for claim 7 into the proceedings.

4. Novelty of the subject-matter of claims 7 and 8 (Article 54 EPC)

The Board cannot share the view of the appellant that the first sentence of both claims 7 and 8, namely:

"A motor unit (1) for a motorized roller (3), being inserted into a roller body (11) so as to constitute the motorized roller (3)",

when considering the teaching of the whole patent specification, should be understood as being directed to a motor unit suitable for a motorized roller and suitable for being inserted into a roller body and therefore as being directed to a motor unit as such.

The Board notes that the wording of claims 7 and 8 is clear and does not require any construction, the motor unit is unambiguously claimed as being inserted into a roller body so as to constitute the motorized roller.

The fact that the French translation of granted claims 8 and 9 is in line with the interpretation suggested by the appellant is not relevant to this issue since according to Article 70(1) EPC the text to be

considered authentic in the present proceedings is that of the language of the proceedings, i.e. the English text.

The fact that the title of the patent in suit reads "motorized roller and motor unit for motorized roller" and that from the description of the patent specification the reader could gain the impression that the patent proprietor might have had an interest in requesting protection for a motor unit for a motorized roller as such, does not change the fact that the wording of the claim is unambiguous and refers to a motor unit "being inserted" into a roller body and not to a motor unit "being insertable" or "for being inserted" into a roller body.

The appellant concurs with the Board that when following the Board's interpretation of claims 7 and 8, documents D1 and D13 do not deprive of novelty the subject-matter of these claims.

The Board therefore has no reason not to conclude that the subject-matter of claims 7 and 8 is new.

5. Inventive step of the subject-matter of claim 7 (Article 56 EPC)

5.1 The appellant argues that the subject-matter of claim 7 is not inventive in view of the teaching of document D7 in combination with the teaching of document D2.

The appellant argues that the features distinguishing the subject-matter of claim 7 from document D7 are those related to the male and female connectors wherein the female connector is inserted into the cavity of the fixed shaft and the male connector comprises a screw

ring rotatable relative to the connector body and comprising an outside screw to be engaged with the inside screw at the fixed shaft.

The distinguishing features provide the technical effect of a quicker installation of the electrical connection without the electrical connection becoming disengaged due to vibration.

The technical problem according to the appellant is to provide a faster installation of a motorized roller.

The appellant argues that the male and female connectors of D2 show the same structural characteristics of the female and male connectors according to the claim and that it is clear that the aim of the features of the connectors of D2 is that of preventing disengagement.

The appellant argues that following the teaching of D2 the person skilled in the art would adapt the inside screw of the motor of D7 and would arrange the first connector and the second connector accordingly, so that they would arrive at the subject-matter of claim 7.

The appellant also argues that the person skilled in the art would arrive at the claimed subject-matter by inserting the whole female plug disclosed in D2 into the fixed shaft of D7, since the coupling ring female connector of D2 would become part of the fixed shaft and the inside screw would then be formed on the inner surface of the fixed shaft.

- 5.2 The Board cannot follow the argument of the appellant and substantially concurs with the respondent for the following reasons.

The Board concurs with the respondent that there is no motivation for the person skilled in the art to modify the motorized roller of D7 so as to provide a female connector with pin holes at an inside or at a distal end of the fixed shaft, the fixed shaft having an inside screw for engaging with the second connector.

Document D2 is a catalogue of connectors, each shown as a separate entity with its own housing.

Even if the person skilled in the art would realize that these connectors allow easy connection and disconnection while preventing unwanted disengagement, they are provided with no indication or hint to modify the structure of the cabling and of the junction box (10) of D7 (see column 1, line 66 - column 2, line 2) in any way, especially not in the way suggested by the appellant. In particular the person skilled in the art obtains no indication from D2 to replace the junction box (10) of D7 by any of the connectors therein described.

The only information that the person skilled in the art would derive from D2 is that of the properties of these connectors as such, i.e. as they are shown in D2.

The arguments of the appellant that the person skilled in the art would adapt the female connector shown in D2 in such a way as to introduce the female connector of D2 in the motorised roller of D7 whilst retaining the inside screw of D7, or that he would insert the whole female plug disclosed in D2 into the fixed shaft of D7, whereby the coupling ring female cable connector of D2 becomes part of the fixed shaft, are considered as the results of an ex-post facto analysis. There is no indication apparent in document D2 for the person

skilled in the art to proceed in the way suggested by the appellant.

The Board therefore considers that the teaching of documents D7 and D2 does not deprive the subject-matter of claim 7 of an inventive step.

6. Inventive step of the subject-matter of claims 1 and 8 (Article 56 EPC)

6.1 The appellant argues that the subject-matter of claim 1 and 8 differs from the disclosure of D7 in that, instead of a screw connection, an engagement of a nail with a projection inside the cavity of the fixed shaft is used.

Document D14 indicates at page 12 that locking fingers are engaged with a protrusion so that the connection between pin and pin holes is secured.

Considering the teaching of D14, the person skilled in the art would understand that securing the junction box from outside with a screw engagement as in D7, is a corresponding function to the engagement of the locking fingers with the protrusion as in D14, whereby by introducing the locking fingers and protrusion disclosed in D14 into D7 they would arrive at the subject-matter of claims 1 and 8 following the same objective technical problem formulated for claim 7.

The appellant also argues that the person skilled in the art would eliminate the junction box (10) of D7 and replace it with the connectors shown on page 12 of D14. Furthermore, the appellant submitted that the teaching on page 6 of D14 indicating that the connectors of D14 allow quick and easy mating and demating, explicitly

motivates the person skilled in the art to combine the teaching of documents D7 and D14.

- 6.2 The Board cannot follow the opinion of the appellant and substantially concurs with the respondent, that whilst it is true that document D14 shows male and female connectors which are latched together by locking fingers cooperating with protrusions, and that on page 6 it is mentioned that easy mating and demating is provided by such connectors, an indication for the person skilled in the art to combine the teaching of D14 with that of D7 and to integrate the structure of the female connector of D14 at an inside or at a distal end of the fixed shaft of D7, is not present. The only information that the person skilled in the art would derive from D14 is that of the properties of these connectors as such, i.e. as they are shown in D14.

That the person skilled in the art would eliminate the junction box (10) of D7 to replace it with the connectors shown in D14 is an allegation which remains unsubstantiated, no hint or indication in this regard can be found in D14.

The arguments of the appellant are thus considered to be the result of an ex-post facto analysis.

The Board is thus of the opinion that the teaching of the documents D7 and D14 does not deprive the subject-matter of claims 1 and 8 of an inventive step.

7. In the absence of any other admissible objection to auxiliary request 6, as confirmed during the oral proceedings, the Board is in a position to decide on the present case by remitting the case to the

opposition division with the order to maintain the patent with the claims of auxiliary request 6 and a description to be adapted thereto.

Order

For these reasons it is decided that:

1. **The decision under appeal is set aside.**
2. **The case is remitted to the opposition division with the order to maintain the patent with the following claims and a description to be adapted thereto:**

No. 1 to 9 according to auxiliary request 6 filed with the letter dated 30 December 2019.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated