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**Datasheet for the decision  
of 17 October 2022**

**Case Number:** T 2442/17 - 3.2.07

**Application Number:** 05825117.4

**Publication Number:** 1951439

**IPC:** B05D3/00, E04C3/30, B66B11/04

**Language of the proceedings:** EN

**Title of invention:**

ELEVATOR LOAD BEARING ASSEMBLY HAVING A JACKET WITH MULTIPLE  
POLYMER COMPOSITIONS

**Patent Proprietor:**

Otis Elevator Company

**Opponent:**

INVENTIO AG

**Headword:**

**Relevant legal provisions:**

EPC Art. 107, 123(2)  
EPC R. 103(4)(a), 116(2)  
RPBA 2020 Art. 13(2), 15(1)

**Keyword:**

Correct exercise of discretion (yes)

Amendments - extension beyond the content of the application  
as filed (yes)

Amendment after summons - taken into account (no)

**Decisions cited:**

G 0007/93

**Catchword:**



**Beschwerdekammern**

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**Case Number: T 2442/17 - 3.2.07**

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 17 October 2022**

**Respondent:** Otis Elevator Company  
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**Appellant:** INVENTIO AG  
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**Representative:** Ernicke, Klaus Stefan  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
28 August 2017 concerning maintenance of the  
European Patent No. 1951439 in amended form.**

**Composition of the Board:**

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

## **Summary of Facts and Submissions**

- I. Appeals were filed by both the patent proprietor and the opponent in the prescribed form and within the prescribed time limit against the decision of the opposition division maintaining European patent No. 1 951 439 in amended form according to the then auxiliary request 1.
- II. The opposition division found that the subject-matter of claims 1 and 5 of auxiliary request 1 filed at the oral proceedings before the opposition division met the requirements of the EPC.
- III. In preparation for oral proceedings the Board communicated its preliminary assessment of the case to the parties in a communication pursuant to Article 15(1) RPBA 2020 to which the patent proprietor responded in substance with submission of 27 September 2022 and the opponent with submissions of 31 August 2022 and 12 October 2022.
- IV. Oral proceedings before the Board took place on 17 October 2022. The patent proprietor withdrew its appeal at the oral proceedings. At the conclusion of the proceedings the decision was announced. Further details of the oral proceedings can be found in the minutes.
- V. The final requests of the parties are as follows:  
  
for the patent proprietor:  
  
that the appeal of the opponent be dismissed;

or alternatively when setting aside the decision under appeal, that the patent be maintained according to the set of claims of one of auxiliary requests 1 to 3, filed on 27 September 2022 or auxiliary request 4 filed during oral proceedings on 17 October 2022;

for the opponent:

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

VI. The arguments of the parties are dealt with in detail in the reasons for the decision.

VII. Claim 1 of the main request (patent as maintained in opposition proceedings) reads as follows:

"Use of a load bearing assembly (30) in an elevator system, said load bearing assembly (30) comprising: at least one elongated tension member (32); and a polymer jacket (34) at least partially surrounding the tension member (32), the polymer jacket having a first portion (36) that interfaces with the tension member (32) and a second portion (38) that defines an exterior surface (40) of the jacket (34), the first portion (36) comprising a first polymer composition and the second portion (38) comprising a second, at least partially different polymer composition; wherein the first polymer composition includes a base component comprising at least one of a polyurethane, nylon, polyester, polyolefin, fluorinated polymer, halogenated polymer, vulcanizable natural rubber, synthetic rubber or silicone; characterised in that:  
the second polymer composition comprises the at least one base component of the first polymer composition and

at least one additive which is distinct from components in the first composition; and  
the additive comprises at least one anisotropic material that includes molecules that align in a pattern that allows slip between the molecules in a first direction and resists slip in a generally perpendicular direction".

VIII. Claim 1 of auxiliary request 1 reads as follows:

"A load bearing assembly (30) for use in an elevator system, comprising:  
at least one elongated tension member (32); and  
a polymer jacket (34) at least partially surrounding the tension member (32), the polymer jacket having a first portion (36) that interfaces with the tension member (32) and a second portion (38) that defines an exterior surface (40) of the jacket (34), the first portion (36) comprising a first polymer composition and the second portion (38) comprising a second, at least partially different polymer composition; wherein the first and second polymer compositions comprise the same base polyurethane; characterised in that:  
the second polymer composition comprises at least one additive which is distinct from components in the first composition; and  
the additive comprises at least one anisotropic material that includes molecules that align in a pattern that allows slip between the molecules in a first direction and resists slip in a generally perpendicular direction".

IX. Claim 1 of auxiliary request 2 reads as follows:

"A load bearing assembly (30) for use in an elevator system, comprising:

at least one elongated tension member (32); and a polymer jacket (34) at least partially surrounding the tension member (32), the polymer jacket having a first portion (36) that interfaces with the tension member (32) and a second portion (38) that defines an exterior surface (40) of the jacket (34), the first portion (36) comprising a first polymer composition and the second portion (38) comprising a second, at least partially different polymer composition; wherein the first polymer composition includes a base component comprising at least one of a polyurethane, nylon, polyester, polyolefin, fluorinated polymer, halogenated polymer, vulcanizable natural rubber, synthetic rubber or silicone; characterised in that:  
the second polymer composition comprises the at least one base component of the first polymer composition and at least one additive which is distinct from components in the first composition; and  
the additive comprises at least one anisotropic material that includes molecules that align in a pattern that allows slip between the molecules in a first direction and resists slip in a generally perpendicular direction, wherein the at least one anisotropic material comprises at least one of paraffin, polyethylene, beeswax, fluorinated linear polymer, a fluorinated copolymer, an amide derivative of a fatty acid, an ester derivative of a fatty acid, cholesteric liquid crystals, nematic liquid crystals".

X. Claim 1 auxiliary request 3 reads as follows:

"A load bearing assembly (30) for use in an elevator system, comprising:  
at least one elongated tension member (32); and  
a polymer jacket (34) at least partially surrounding the tension member (32), the polymer jacket having a

first portion (36) that interfaces with the tension member (32) and a second portion (38) that defines an exterior surface (40) of the jacket (34), the first portion (36) comprising a first polymer composition and the second portion (38) comprising a second, at least partially different polymer composition; wherein the first and second polymer compositions comprise the same base polyurethane; characterised in that: the second polymer composition comprises at least one additive which is distinct from components in the first composition; and the additive comprises at least one anisotropic material that includes molecules that align in a pattern that allows slip between the molecules in a first direction and resists slip in a generally perpendicular direction, wherein the at least one anisotropic material comprises at least one of paraffin, polyethylene, beeswax, fluorinated linear polymer, a fluorinated copolymer, an amide derivative of a fatty acid, an ester derivative of a fatty acid, cholesteric liquid crystals, nematic liquid crystals".

XI. Claim 1 of auxiliary request 4 reads as follows:

"Use of a load bearing assembly (30) in an elevator system, said load bearing assembly comprising: at least one elongated tension member (32); and a polymer jacket (34) at least partially surrounding the tension member (32), the polymer jacket having a first portion (36) that interfaces with the tension member (32) and a second portion (38) that defines an exterior surface (40) of the jacket (34), the first portion (36) comprising a first polymer composition and the second portion (38) comprising a second, at least partially different polymer composition; wherein



the first polymer composition includes a base component comprising at least one of a polyurethane, nylon, polyester, polyolefin, fluorinated polymer, halogenated polymer, vulcanizable natural rubber, synthetic rubber or silicone; characterised in that:

the second polymer composition comprises the at least one base component of the first polymer composition and at least one additive which is distinct from components in the first composition; and

the additive comprises at least one anisotropic material that includes molecules that align under shear conditions in a pattern that allows slip between the molecules in a first direction along the axis of the molecular chains and resists slip at right angles to the molecular axis, wherein the at least one anisotropic material comprises at least one of paraffin, polyethylene, beeswax, fluorinated linear polymer, a fluorinated copolymer, an amide derivative of a fatty acid, an ester derivative of a fatty acid, cholesteric liquid crystals, nematic liquid crystals".

XII. The wording of the other independent claims of the main request and of auxiliary requests 1 to 4 do not need to be reproduced here since they are not relevant for the decision.

## **Reasons for the Decision**

### 1. Procedural aspects

The patent proprietor withdrew its appeal during the oral proceedings, continuing as a party as of right according to Article 107, second sentence, EPC. Since the patent proprietor's appeal was withdrawn before the decision was announced at the oral proceedings, the

appeal fee paid by the patent proprietor is reimbursed at 25% pursuant to Rule 103(4) (a) EPC.

2. Exercise of discretion of the opposition division in admitting the main request (auxiliary request 1 in opposition proceedings) into the proceedings

2.1 The opponent requests the reversal of the exercise of discretion by the opposition division, *i.e.* to consider auxiliary request 1 in opposition proceedings as being not admitted, due to it being late-filed (see point 3 of the statement setting out the grounds of appeal). The opponent argued that it was taken by surprise by the change of claim category and that it could not have prepared for this new situation before the oral proceedings.

The opponent also argued that the patent proprietor should have reacted before the oral proceedings since a lack of novelty objection in view of document D3 (DE 695 28 476 T2) had already been raised with the grounds of opposition.

2.2 The Board cannot follow the line of argument of the opponent for the following reasons.

According to Rule 116(2) EPC the opposition division has the discretion to admit new documents, *i.e.* new amendments to the description, claims and drawings, filed after the final date for making written submissions fixed by the opposition division in the annex to the summons to oral proceedings.

The discretionary power conferred by Rule 116 EPC necessarily implies that the opposition division must have a certain degree of freedom in exercising its power. A Board of Appeal should only overrule the way

in which the opposition division has exercised its discretion when deciding on a particular case if it concludes that it has done so according to the wrong principle, or without taking into account the right principles, or in an unreasonable way, and has thus exceeded the proper limit of its discretion (see Case Law of the Boards of Appeal, 10th edition, 2022, V.A. 3.4.1 b) and G 7/93).

The Board is of the opinion that the opposition division took into account the right criteria, since it considered the amendment to the claim to be suitable to overcome the objection of lack of novelty and also that the subject-matter of the claim was more restricted than that of claim 1 as granted, due to the change of claim category (see point 7.3 of the reasons for the decision).

The opposition division also considered the amendment to be a reaction to the course of the proceedings, since in the annex to the summons to oral proceedings it had referred to the possible relevance of D3 without elaborating on the matter.

The Board agrees with the opponent (see page 14, third paragraph of the statement setting out the opponent's grounds of appeal) that an objection of lack of novelty had been raised with the notice of opposition with respect to D3. However, as argued by the patent proprietor, that objection was not fully substantiated, since it was not indicated why the load bearing assembly of D3 should be considered to be suitable for use in an elevator system (see the fifth complete paragraph, last sentence, on page 5 of the reply to the opponent's statement setting out the grounds of appeal and page 8, last sentence, of the notice of opposition).

The Board thus does not find fault in the opposition division's finding that the filing of auxiliary request 1 at the oral proceedings is to be seen as a reaction to the course of those proceedings.

The Board cannot share the opinion of the opponent (see point 3, page 14, of the statement setting out the grounds of appeal and point 3, page 12, of the submissions dated 4 August 2020) that it was disadvantaged since, due to the amendments made, a different line of argumentation was required and that it was unable to prepare accordingly before the oral proceedings.

According to the minutes of the oral proceedings, see point 5 thereof, the opponent did not request an adjournment of the oral proceedings nor did it request additional time to prepare a new line of argumentation.

It therefore appears that at that time the opponent considered itself able to deal with the amended situation without delay.

- 2.3 The above considerations of the Board were communicated to the parties with the Board's communication pursuant to Article 15(1) RPBA 2020. No further submissions were provided by the parties on this issue.

The Board, taking into account all the facts of the case, considers that the opposition division exercised its discretion according to the right principles and in a reasonable way.

Hence, the Board concludes that there is no reason to overrule the discretionary decision of the opposition

division to admit the then auxiliary request 1 into the proceedings.

3. Admittance into the proceedings of the objection of added subject-matter in relation to the main request

3.1 The patent proprietor argued (see letter dated 27 September 2022, page 2, fourth to sixth paragraph) that the objection of added subject-matter against the patent as maintained in opposition proceedings was raised by the opponent for the first time with letter dated 31 August 2022, thus after the summons to oral proceedings, so that Article 13(2) RPBA 2020 is to be applied. According to the patent proprietor, with the statement setting out the grounds of appeal the opponent objected to added subject-matter only for the patent as granted, as was evident by its reference to point 3.3.3 of the appealed decision. No objection of added subject-matter was made to the patent in the form maintained by the opposition division.

3.2 The Board disagrees.

The opponent clearly indicated that it contested the decision of the opposition division to maintain the patent in amended form (see the statement setting out the grounds of appeal, page 1, last paragraph). The part of the decision relating to the main request was referred to by the opponent because the issue of added subject-matter was discussed in opposition proceedings in relation to the claims according to that request for the same combination of features. The Board is thus of the opinion that the objection of added subject-matter was raised by the opponent with its statement setting out the grounds of appeal. Therefore Article 13(2) RPBA 2020, which refers to amendments of a party's case filed after notification of the summons to oral

proceedings, is not applicable and the objection of the patent proprietor to the admittance of the objection of added subject-matter cannot be followed.

4. Added subject-matter of claim 1 according to the main request (Article 123(2) EPC)

4.1 The opponent contested that the combination of features of claim 1 was not originally disclosed as such and that therefore subject-matter had been added which extended beyond the content of the application as originally filed. In particular the opponent objected to the combination of features that:

"...the second polymer composition comprises ... at least one additive which is distinct from components in the first composition; and the additive comprises at least one anisotropic material that includes molecules that align in a pattern that allows slip between the molecules in a first direction and resists slip in a generally perpendicular direction".

The opponent argued (see its statement of grounds of appeal, page 2, second to fourth paragraph) that an additive comprising an anisotropic material as claimed in claim 1 is not directly and unambiguously derivable from the original PCT application.

4.2 The patent proprietor indicated as basis for the combination of features of claim 1 of the main request the combination of the features of claims 1, 7, 8 and 14 of the original PCT application. The discussion of the anisotropic material on page 9, line 20, to page 10, line 17, would also lead the person skilled in the art to understand that the features of the above claims

can be combined independently from their formal dependencies, in particular it was clear that the anisotropic material mentioned in claim 14 is in fact the additive mentioned in claim 8 of the original PCT application (see item 1.1 of the reply to the statement setting out the grounds of appeal).

4.3 The Board cannot follow the line of argument of the patent proprietor and substantially concurs with the opponent that subject matter has been added. Claim 8 of the original PCT application depends on claim 7 which depends on claim 1, while claim 14 depends on claim 1 only. Therefore the claim structure of the original PCT application presents two different embodiments, a first embodiment corresponding to the combination of the features of claims 1, 7 and 8 and a second embodiment corresponding to the combination of the features of claims 1 and 14. The combination of the features of claims 1, 7, 8 and 14 of the original PCT application has therefore not been disclosed by the claim structure of that application.

The passage on page 9, line 20, to page 10, line 17, of the original PCT application does not disclose or suggest the combination of features of claim 1, in particular not an additive comprising an anisotropic material according to claim 1.

The argument of the patent proprietor that the person skilled in the art would read in combination claims 1, 7, 8 and 14 independently from the dependencies is an allegation which remains unsubstantiated and thus not convincing.

The Board therefore shares the opinion of the opponent that the subject-matter of claim 1 of the patent according to the main request extends beyond the content of the application as originally filed.

4.4 The maintenance of the patent as amended and held by the opposition division to meet the requirements of the EPC is therefore prejudiced by the fact that it contains added subject-matter, the decision under appeal is to be set aside.

5. Added subject-matter of claim 1 according to auxiliary request 2 (Article 123(2) EPC)

5.1 The patent proprietor indicated as basis for the combination of features of claim 1 of auxiliary request 2 the combination of the features of claims 1, 7, 8, 9 and 14 of the original PCT application, wherein only certain materials have been taken from claim 9 in view of the passage on page 10, lines 1 to 6 of the description of the original PCT application.

5.2 The opponent objected that the combination of features of claim 1:

"...the second polymer composition comprises ... at least one additive which is distinct from components in the first composition; and the additive comprises at least one anisotropic material that includes molecules that align in a pattern that allows slip between the molecules in a first direction and resists slip in a generally perpendicular direction",

which was objected to for claim 1 of the main request is also present in claim 1 of the present request and cannot be directly and unambiguously derived from the original disclosure and in particular not from the basis indicated by the patent proprietor.



5.3 The Board concurs with the opponent that the claims of the original PCT application indicated by the patent proprietor as a basis for the combination of features of claim 1 do not provide the necessary support to that claim. Analogously to what discussed above for claim 1 of the main request, claim 9 is dependent on claim 8, which is dependent on claim 7, which is dependent on claim 1, while claim 14 is only dependent on claim 1. Therefore the claim structure of the original PCT application presents two different embodiments, a first embodiment corresponding to the combination of the features of claims 1, 7, 8 and 9 and a second embodiment corresponding to the combination of the features of claims 1 and 14. A single embodiment combining the features of all five claims is not directly and unambiguously disclosed. Furthermore an additive comprising an anisotropic material according to claim 1 is also not derivable from the passage on page 10, lines 1 to 6 of the original PCT application.

The Board therefore shares the opinion of the opponent that the subject-matter of claim 1 of the patent according to auxiliary request 2 extends beyond the content of the application as filed.

6. Added subject-matter of claim 1 of auxiliary requests 1 and 3 (Article 123(2) EPC)

The patent proprietor acknowledged at the oral proceedings that claim 1 of auxiliary request 1 and claim 1 of auxiliary request 3 do not overcome the issues of added subject-matter of claim 1 of the main request and of auxiliary request 2, respectively. Therefore, auxiliary requests 1 and 3 do not fulfill the requirements of Article 123(2) EPC analogously to the main request and to auxiliary request 2.

7. Admittance into the proceedings of auxiliary request 4
- 7.1 The patent proprietor filed at a late stage of the oral proceedings a fourth auxiliary request, justifying its late filing by the allegedly surprising course of the proceedings. The patent proprietor argued that the Board's negative conclusions regarding the issue of added subject-matter were unexpected given that the Board had indicated in its preliminary opinion the intention not to admit the objection of added subject-matter into the appeal proceedings.
- 7.2 The submission of auxiliary request 4 constitutes an amendment, made at the oral proceedings, of the patent proprietor's case and is thus subject to Article 13(2) RPBA 2020 and as such should, in principle not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons.
- 7.3 The Board concurs with the opponent that the issue of added subject-matter had already been raised in opposition proceedings, and was still contested by the opponent with its statement setting out the grounds of appeal (see point 1.1) and with its last submission of 31 August 2022 (see point 1.1). Furthermore the Board had indicated in its communication pursuant to Article 15(1) RPBA 2020 that its opinion given therein was preliminary (see page 1, second paragraph). It should thus have been clear to the patent proprietor that a change of opinion of the Board could take place which, as a result, would require that the issue of added subject-matter be addressed.

That the Board could deviate from its preliminary opinion is something that a party, in particular in inter-partes proceedings, should always take into account and be prepared to react to.

The Board is thus of the opinion that the patent proprietor has submitted neither exceptional circumstances nor cogent reasons justifying the submission of auxiliary request 4 at the oral proceedings. The Board therefore decided not to admit auxiliary request 4 into the proceedings, pursuant to Article 13(2) RPBA 2020.

8. Since the requests of the patent proprietor are either not allowable (main request and auxiliary requests 1 to 3) or not admitted (auxiliary request 4), the appealed decision must be set aside and the patent revoked.

## Order

**For these reasons it is decided that:**

1. **The decision under appeal is set aside.**
2. **The patent is revoked.**
3. **The appeal fee paid by the patent proprietor is reimbursed at 25%.**

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated