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**Datasheet for the decision
of 27 August 2021**

Case Number: T 1027/18 - 3.2.06

Application Number: 09783009.5

Publication Number: 2342152

IPC: B66B1/18

Language of the proceedings: EN

Title of invention:

METHOD AND APPARATUS FOR MODERNIZING AN ELEVATOR INSTALLATION

Patent Proprietor:

Inventio AG

Opponent:

TK Elevator Innovation and Operations GmbH

Headword:

Relevant legal provisions:

EPC Art. 111(1), 113(1)

EPC R. 103(1) (a)

RPBA 2020 Art. 11

Keyword:

Substantial procedural violation - appealed decision reasoned
(no) - violation of the right to be heard (yes) -
reimbursement of appeal fee (yes)

Decisions cited:

G 0007/93

Catchword:



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Case Number: T 1027/18 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 27 August 2021

Appellant: TK Elevator Innovation and Operations GmbH
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Representative: Paustian & Partner Patentanwälte mbB
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Respondent: Inventio AG
(Patent Proprietor) Seestrasse 55
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
9 March 2018 concerning maintenance of the
European Patent No. 2342152 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
W. Ungler

Summary of Facts and Submissions

- I. An appeal was filed by the appellant (opponent) against the interlocutory decision of the opposition division in which it found that European patent No. 2 342 152 in an amended form met the requirements of the EPC.
- II. The appellant requested that the decision under appeal be set aside and the patent be revoked. It further requested that the appeal fee be reimbursed due to substantial procedural violations having been committed by the opposition division in reaching its decision not to admit E6 to E16. The respondent (patent proprietor) requested that the appeal be dismissed.
- III. The following documents, referred to by the appellant in its grounds of appeal, are relevant to the present decision:
- E6 WO-A-02/46081
 - E7 Fachbegriffe der Aufzugstechnik, Part 1, Udo Thews, 5th Edition, January 2013
 - E8 Fachbegriffe der Aufzugstechnik, Part 2, Udo Thews, 4th Edition, October 2011
 - E9 US-A-2004/0246891
 - E10 DE-A-10 2006 027680
 - E11 DE-U-20 2006 013486
 - E12 WO-A-2007/061913
 - E13 DE-A-10 2006 037029
 - E14 EP-A-1 783 084
 - E15 EP-A-1 777 192
 - E16 DE-C-198 15 222
- IV. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional

opinion. It indicated that the opposition division had seemingly used the right principles in its decision not to admit E7 and E8, but that it had failed to use the right principles in its decision not to admit E6 and E9 to E16. In failing to address the opponent's objection based on E6 and E9 to E16, the decision was unreasoned which amounted to a fundamental deficiency. It further indicated that the opponent appeared to have been denied its right to be heard before the opposition division due to not having been given the opportunity to present arguments as to why E6 and E9 to E16 were to be admitted. The Board thus stated that it intended to cancel the scheduled oral proceedings and remit the case to the opposition division for further prosecution together with reimbursement of the appeal fee. The parties were invited to comment.

- V. With letter of 26 April 2021 the respondent agreed to the cancellation of the scheduled oral proceedings and remittal of the case to the opposition division for further prosecution on the condition that the appellant similarly agreed.
- VI. With letter of 5 May 2021 the appellant agreed that oral proceedings were unnecessary provided that the Board maintained its preliminary opinion and remitted the case on the basis of the opposition division having committed a substantial procedural violation.
- VII. With communication of 19 August 2021 the scheduled oral proceedings before the Board were cancelled.
- VIII. Claim 1 of the sole request reads as follows, with feature annotation as used by the opposition division in its decision having been added:

M1.0 Method of modernizing an elevator installation, which elevator installation comprises an elevator (A, B, C) including at least one elevator car (11, 11', 11") and an elevator control (5, 5', 5"), wherein the method of modernizing comprises the following steps:

M1.1 installing at least one destination call control (6) which receives a destination call signal and/or an identification code,

M1.1a said destination call control (6) generating at least one start floor signal for a journey of the elevator car to an input floor and

M1.1b at least one destination floor signal for a journey of the elevator car from said input floor to a destination floor associated with the destination call signal and/or the identification code; and

M1.2 connecting the destination call control (6) with at least one elevator control (5, 5', 5") of the elevator installation

M1.3 by way of a serial maintenance interface (5.3, 5.3', 5.3") of the elevator control

M1.4 such that the start floor signal and the destination floor signal are communicated by the destination call control (6) via the interface (5.3, 5.3', 5.3") to the elevator control (5, 5', 5").

Claim 10 of the sole request, corresponding to claim 11 as granted, reads as follows:

M11.0 System for modernizing an elevator installation, which elevator installation comprises an elevator (A, B, C) including at least one elevator car and an elevator control (5, 5', 5"), comprising:

M11.1 a programmed processor (60);

M11.2 a memory (61, 61') for containing a series of instructions to be executed by the programmed processor (60),

M11.3 whereby the programmed processor (60) is operative to install at least one destination call control (6) for receiving a destination call signal and/or an identification code and for generating at least one start floor signal for a journey of the elevator car to the input floor and at least one destination floor signal for a journey of the elevator car from the input floor to a destination floor associated with the destination call signal and/or the identification code

characterised by further comprising

M11.4 a serial maintenance interface (5.3, 5.3', 5.3") for connecting the destination call control (6) with at least one elevator control (5, 5', 5") of the elevator installation

M11.5 such that the start floor signal and the destination floor signal are communicated by the destination call control (6) via the interface (5.3, 5.3', 5.3") to the elevator control (5, 5', 5").

IX. The appellant's arguments may be summarised as follows:

The opposition division was wrong not to admit E7 and E8 due to their being published after the priority date of the patent. E7 and E8 showed the general knowledge of the skilled person and thus, even if published three to four years after the priority date, validly showed what the skilled person knew at that time.

The opposition division was also wrong not to admit E6 and E9 to E16, since these were filed in reaction to the preliminary opinion of the opposition division in which it indicated that a serial interface was different to a serial maintenance interface. These documents were filed to counter this opinion, not in order for these to be used to attack the novelty or

inventive step of the claimed subject-matter in a new way. The basis used for the non-admittance finding was thus incorrect since these documents were not intended to disclose specific features of claim 1 or 11.

At oral proceedings, the opposition division failed to indicate that it maintained its preliminary opinion of there being a difference between a serial interface and the claimed serial maintenance interface. An opportunity to present arguments on this point was also not offered, resulting in the opponent's right to be heard being denied. In the decision, the arguments and evidence presented in this regard were not addressed, such that the decision was unreasoned.

Each of the foregoing resulted in the opposition division having committed a substantial procedural violation. The appeal fee should consequently be reimbursed.

X. The respondent's arguments may be summarised as follows:

The opposition division's decision not to admit E6 to E16 was a discretionary decision which, according to G7/93, should only be questioned in respect of whether it had exercised its discretion in accordance with the right principles or that it had exercised its discretion in a reasonable way. In considering all relevant facts surrounding the admittance of these documents, particularly *prima facie* relevance, the opposition division had evidently exercised its discretion in accordance with the right principles. E7 and E8 were post published and thus were not part of the state of the art. E6 and E9 to E16 lacked at least features M1.4 and M11.5 and so were not *prima facie*

relevant for objecting to the claimed subject-matter.

The opposition division also respected the opponent's right to be heard. It was under no obligation to indicate its opinion prior to reaching its conclusion and had considered the opponent's arguments in detail e.g. in sections 2.3.1.2 and 2.3.1.3 of its decision.

Reasons for the Decision

1. *Non-admittance of E6 to E16 before the opposition division*
 - 1.1 During the opposition procedure and in support of its objections under Article 100(a) EPC, the opponent filed E6 to E16 as evidence of common general knowledge, which allegedly proved that any serial interface could be considered a serial maintenance interface. The opposition division correctly identified these documents as late filed and, in order to decide on their admittance, considered the *prima facie* relevance of the documents. It concluded (see point 3.1 of its decision) that E7 and E8 were not part of the state of the art and that none of E6 or E9 to E16 disclosed two essential features of claims 1 and 11. The opposition division therefore exercised its discretion not to admit E6 to E16 into the proceedings.
 - 1.2 As pointed out by the respondent, where a department of first instance has exercised its discretion, it is not the function of a Board of Appeal to review all the facts and circumstances of the case as if it were in the place of the first instance department, in order to decide whether or not it would have exercised such

discretion in the same way. Rather, its competence should be limited to establishing whether the first instance department has exercised its discretion in accordance with the right principles or that it has exercised its discretion in a reasonable way (see G7/93, point 2.6).

1.3 With respect to E7 and E8, the opposition division identified that these were published after the priority date of the patent, were thus not part of the state of the art under Article 54(2) EPC and consequently were not admitted into the proceedings. E7 was published in January 2013, E8 in October 2011, more than four years and more than three years respectively after the priority date of the patent (16 September 2008). In its decision, the opposition division thus used the right principles, a post-published document not *prima facie* being suited to proving what was known at the priority date.

1.3.1 The appellant's argument on appeal, that E7 and E8 showed the general knowledge of the skilled person and thus, even if published after the priority date, validly showed what the skilled person knew at this time is not accepted in such generality. Even though a publication showing common general knowledge will actually relate to what was known on a date prior to publication, it cannot unambiguously show what was common general knowledge over three years earlier which would be required in the present case for the disclosure of E7 or E8 to be considered relevant for the purpose intended. The argument that the terms discussed in E7 and E8 were not 'new' but rather had been in use for many years is a mere allegation for which no concrete evidence was supplied.

1.3.2 The Board thus finds that the opposition division exercised its discretion in accordance with the right principles when deciding not to admit E7 and E8.

1.4 With respect to the admittance of E6 and E9 to E16, the opposition division found as follows:

"None of the documents discloses both the essential features M1.3 and M1.4 or M11.4 and M11.5. Already for this reason, none of the documents is considered to be prima face relevant as this would imply that the envisaged decision of the opposition division were about to change because of these documents. This is however not the case. As a consequence documents E6 to E16 are not allowed into the procedure."

1.4.1 In reaching this decision, the opposition division indeed applied the wrong principles. The opponent filed E6 and E9 to E16 to counter the opposition division's preliminary opinion that a 'serial interface' was different to a 'serial maintenance interface'. They were thus solely filed as evidence that a 'serial interface' was the same thing as a 'serial maintenance interface'. In reaching its decision, however, the opposition division identified the features of claims 1 and 10 which each of E6 and E9 to E16 failed to disclose i.e. considered the suitability of these documents to in some way question anew the novelty or inventive step of the claimed subject-matter. However, these documents were not alleged to disclose features 1.3 and 1.4 of claim 1 or features 11.4 and 11.5 of claim 10, rather they were filed to provide evidence of a 'serial interface' being no different to a 'serial maintenance interface'. The purpose of these documents being filed and the arguments based on these, as also explained by the opponent when filing these (see the

letter of 11 September 2017 page 6 *et seq*), were thus not taken into account by the opposition division and consequently the principles applied in its decision not to admit E6 and E9 to E16 were incorrect. In this regard it should be added that although the opposition division indeed mentioned E6 to E16 in item 2.3.1.3 and stated that "the opponent's assertion that any serial interface can be considered as a maintenance interface is not appropriate", this has not dealt with the opponent's written arguments beyond implying that the opposition division does not agree with them (as for any oral arguments - see item 1.5 below).

1.4.2 In failing to address the opponent's objection based on E6 and E9 to E16, the opposition division's decision is unreasoned with respect to this objection which is a procedural violation. The violation is also a substantial procedural violation because the aspect for which E6 and E9 to E16 were cited was central to the conclusions reached on novelty and inventive step by the opposition division (as also recognised by the opposition division in item 2.3.1.1 of its decision).

1.5 *Denial of right to be heard*

1.5.1 A party's right to be heard is enshrined in Article 113(1) EPC and reads: "The decisions of the European Patent Office may only be based on grounds of evidence on which the parties concerned have had an opportunity to present their comments".

1.5.2 The appellant maintains that, at oral proceedings, it was denied its right to be heard insofar as no opportunity was provided to explain the relevance of E6 to E16 and thus why there was no difference between a serial interface and the claimed serial maintenance

interface.

- 1.5.3 The minutes of the oral proceedings before the opposition division indeed suggest this to have been the case. Novelty and inventive step were discussed and concluded (see points 2 and 3 of the minutes of the oral proceedings) with no mention being made of E6 to E16, nor of the opponent's contention that there was no difference between a serial interface and a serial maintenance interface. The sole mention in the minutes of E6 to E16 is in point 5 where it is simply stated that 'the chairman informed the parties that documents E6 to E16 were not admitted into the proceedings'. The Board can only conclude from this, as argued by the appellant, that no opportunity was afforded the opponent at oral proceedings to present arguments as to the relevance of E6 to E16 and why they should be admitted.
- 1.5.4 The respondent's contention that the opposition division had fully dealt with the opponent's arguments relating to E6 to E16, as evidenced in sections 2.3.1.2 and 2.3.1.3 of its decision, does not provide any evidence relating to the opponent's right to be heard being respected. Whilst the referenced sections of the decision do touch upon the arguments of the opponent submitted during the written procedure, these fail to address why E6 and E9 to E16 were not admitted and also do not provide any indication that the opponent was provided an opportunity at oral proceedings to argue why E6 and E9 to E16 should be admitted.
- 1.5.5 One of the primary purposes of oral proceedings is for parties to be able to ensure that their case has been fully presented prior to a decision being taken. Since the minutes indicate that no opportunity was given at

the oral proceedings to present arguments as to why E6 to E16 should be admitted, it follows that the opponent's right to be heard was denied, contrary to the requirement of Article 113(1) EPC. This is also a substantial procedural violation (for the same reasons as stated in item 1.4.2 above).

- 1.6 In summary, therefore, the Board finds that the opposition division committed a substantial procedural violation firstly in failing to reason its decision not to admit E6 and E9 to E16 (see points 1.4 to 1.4.2), and secondly in not granting the opponent its right to be heard with respect to the possible admittance of these documents (see points 1.5 to 1.5.5) in particular for the purpose for which they had been supplied.

2. *Remittal*

With the opposition division having committed a substantial procedural violation, this is a fundamental deficiency of the opposition proceedings which constitutes a 'special reason' (see Article 11 RPBA 2020) for remitting the case under Article 111(1) EPC to the opposition division for further prosecution.

3. *Reimbursement of the appeal fee*

According to Rule 103(1)(a) EPC, the appeal fee shall be reimbursed in full ... where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. With the above conditions having been met and the appellant having requested reimbursement, the appeal fee is to be reimbursed.

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 for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated