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

Case Number: T 0480/20 - 3.2.01

Application Number: 08850822.1

Publication Number: 2212155

IPC: B60R1/072

Language of the proceedings: EN

Title of invention:

MOUNTING CONSTRUCTION FOR AN OUTSIDE MIRROR UNIT

Patent Proprietor:

MCi (Mirror Controls International)
Netherlands B.V.

Opponent:

SMR Patents S.à.r.l.

Headword:

Relevant legal provisions:

RPBA 2020 Art. 12(4), 13(2)

EPC R. 139

EPC Art. 54, 56, 83

Keyword:

Amendment to case - reasons for submitting amendment in appeal proceedings (yes)

Correction of error - (yes) - obvious error

Sufficiency of disclosure - main request (yes)

Novelty - main request (yes)

Inventive step - main request (yes) - ex post facto analysis

Amendment after summons - cogent reasons (no) - taken into account (no)

Decisions cited:

G 0003/89, G 0011/91

Catchword:



Beschwerdekammern

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Case Number: T 0480/20 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 17 March 2022

Appellant 1: MCI (Mirror Controls International)
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
20 December 2019 concerning maintenance of the
European Patent No. 2212155 in amended form.**

Composition of the Board:

Chairman G. Pricolo
Members: A. Wagner
O. Loizou

Summary of Facts and Submissions

- I. The appeals by the patent proprietor (appellant 1) and the opponent (appellant 2) are directed against the decision of the opposition division to maintain European Patent No. 2212155 in amended form.
- II. The opposition division decided among others that the correction of claim 1 as granted as proposed with auxiliary requests 1A and 1C was allowable under Rule 139 EPC (decision, point 2.1) and that such a corrected claim met the requirements of Article 83 EPC (decision, page 7, 6th paragraph, and point 4.2). However, the (identical) subject-matter of claim 1 of these requests was not novel over D8A (decision, point 4.3). Furthermore, the opposition division held that document D14 disclosed all the features of the more restricted claim 1 in accordance with auxiliary request 2C (decision, point 7.3.2, analysis of features 1 to 1.8). The opposition division concluded that auxiliary request 3 was allowable.
- III. The following documents are relevant for this decision:
- D8: WO 2007/128468
 - D8A: ES 1062843 U
 - D12: DE 2971 153 9 U1
 - D13: Wikipedia "Bajonettverschluss"
 - D14: WO 2005/076932 A2
 - D15: CH 3134
 - D16: DE 10 2006 026 198 A1
- IV. Oral proceedings by videoconference were held before the Board on 17 March 2022.

V. The final requests of the parties were the following:

The appellant 1 (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of auxiliary request 3B, filed with letter dated 30 December 2020.

Appellant 2 (opponent) requested that the decision under appeal be set aside and the patent be revoked.

VI. Claim 1 of auxiliary request 3B filed with letter dated 30 December 2020 (main request) reads as follows (feature numbering added in bold by the Board):

1. A mounting construction

1.1 for mounting an adjustment instrument (1) to a carrier (2) for an outside mirror unit, comprising

1.2 first mounting parts (3) on the adjustment instrument (1) and

1.3 second mounting parts (4) on the carrier (2),

1.4 which mounting parts guide the adjustment instrument (1) from a first position to a second position in a direction along the carrier,

1.5 the mounting parts (3, 4) cooperating with each other in the second position to fix movement of the adjustment instrument (1) relative to the carrier (2) in a direction transverse to the carrier,

characterized in that

1.6 in the first position the adjustment instrument (1) and the carrier (2) are clear of each other and in that

1.7 the work to displace the adjustment instrument (1) from the second position to the first position is greater than the work to displace the adjustment instrument (1) from the first position to the second position,

characterized in that

1.8 the mounting parts (3, 4) comprise a clamped connection and in that

1.9 the adjustment device is moved from the first position to the second position through a pivoting movement.

VII. The appellant's 1 (patent proprietor's) arguments relevant to the present decision may be summarized as follows:

Admission of auxiliary request 3B

Auxiliary request 3B was based on auxiliary request 3B filed with the statement of grounds of appeal, wherein the wording "adjustment device" was amended to "adjustment instrument". This amendment was in reaction to a clarity objection raised by the appellant 2 (opponent) with their reply to the statement of grounds of appeal. Auxiliary request 3B was filed with the statement of grounds of appeal in order to further distinguish the subject-matter of claim 1 from the disclosure of document D8A. This request could not have been filed earlier, since D8A was filed by the opponent at a late stage of the opposition proceedings and was only admitted during oral proceedings.

Even if D8, a family member of D8A, was filed with the notice of opposition, this document did not belong to the state of the art, as pointed out by the patent proprietor in the reply to the preliminary opinion of the opposition division. Being confronted with D8A as a document under Article 54(2) EPC, admittedly with the same content as D8, only few days before the oral proceedings before the opposition division, was a new and surprising fact for the patent proprietor.

Correction under Rule 139 EPC

The opposition division was right in concluding that claim 1 as granted comprised an obvious error. Clearly, the wording "*the work to displace the adjustment instrument (1) from the second position to the first position is greater than the work to displace the adjustment instrument (1) from the second position to the first position*" did not make sense. The skilled person reading the passage on page 2, lines 18, 19 of the original application: "*The work to displace the adjustment from the second position to the first position may be greater than the work in the opposite direction*" would immediately realize that nothing else was intended than what was recited by feature 1.7 of the main request on file.

Article 83 EPC

As found by the opposition division feature 1.7 does not result in an insufficient disclosure of the invention. Feature 1.7 could be carried out by the skilled person over the whole range of the claim. Clamped connections which did not fulfill feature 1.7 would simply be disregarded.

New objection under Article 123(2) EPC

During oral proceedings before the board the appellant 2 (opponent) raised for the first time an objection of added subject-matter (Article 123(2) EPC) in respect of the combination of original claims 4 and 6 (features 1.8 and 1.9). Such a late filed objection should not be admitted.

Novelty over D14

D14 did not disclose at least feature 1.4. The opposition division erred in defining the adjustment instrument as comprising the backing plate 54 and the retention ring 66 (see figure 2). The adjustment instrument actually was the backing plate as disclosed on page 8, lines 3 to 8. Feature 1.4 defined that the adjustment instrument was guided from a first position to a second position. However the backing plate was not displaced at all when the retention ring was rotated around the post 40 as could be seen by comparing figures 5 and 7.

Inventive step

The appellant 2 (opponent) referred to D12 as closest prior art. Claim 1 differed from D12 by feature 1.7. On page 7 of D12, penultimate paragraph, it was mentioned that a bayonet joint might substitute the screw connection (5,7) shown in figure 1. However this substitution did not render feature 1.7 obvious as a bayonet joint did not automatically include feature 1.7. Furthermore, the substitution did not implicitly result in an adjustment instrument 3 moved by a pivoting movement from a first position to a second position.

The skilled person would not consider a known Storz-coupling which was only disclosed in the context of hose couplings. Combining D12 with the general knowledge as e.g. disclosed in D13 or D15 or with D15, D16 was based on hindsight.

VIII. The appellant's 2 (opponent's) arguments relevant to the present decision may be summarised as follows:

Admission of auxiliary request 3B

The main request on file should have been filed in the first instance proceedings. D8 was already discussed during examination proceedings, and at that time the patent proprietor assumed D8 to be state of the art under Article 54(3) EPC. In any case, D8 was on file from the beginning of the opposition proceedings. As acknowledged by the patent proprietor, D8A was identical to D8. Thus the technical content of D8A could not be surprising for the patent proprietor.

Furthermore, the patent proprietor failed to explain why the main request would overcome the objections raised by the appellant 2 (opponent). The main request only addressed novelty over D8A, not over D14, and gave rise to new objections under Article 123(2) EPC. As the RPBA 2020 apply, the main request on file was not admissible.

Correction under Rule 139 EPC

The amendments made to feature 1.7 of auxiliary request 3B in comparison to the wording of granted claim 1 could not be considered as a correction of an obvious error under Rule 139 EPC. The general wording "*in opposite direction*" on page 2, lines 18, 19, of the original application did not directly and unambiguously disclose the specific movement "*from the first position to the second position*" defined in feature 1.7 of the main request. Hence the amendments contravened Article 123(2) and (3) EPC.

Article 83 EPC

The opposition division erred in assuming that the nature of a clamped connection would result in feature 1.7. A clamped connection did not implicitly fulfill feature 1.7. The skilled person could not put into practice the clamped connection according to feature 1.7 over the whole claimed range. Further information was needed, which was not disclosed in the patent, concerning the inclination and the texture of the contact surfaces, the position of the carrier and the adjustment instrument in view of gravity, elasticity etc.

New objection under Article 123(2) EPC

Claim 1 combined the features of original claims 4 and 6. However a pivoting movement of the adjustment instrument was only originally disclosed in combination with a snap connection (page 5, last paragraph to page 6, first paragraph).

Objections under Article 123(2) EPC were on file since the beginning of the opposition proceedings and auxiliary request 3B was specifically objected to in writing in the appeal proceedings.

Novelty over D14

The interpretation of D14 made by the opposition division was correct. The adjustment instrument (figure 2) comprised the backing plate 54 and the retention ring 66. The wording of claim 1 did not define that the whole adjustment instrument had to be moved through a pivoting movement. Therefore also features 1.4 and 1.9 were known from D14 as the retention ring was moved from the first position to the second position through

a pivoting movement (see figures 5 and 7 with page 7, lines 15 to 19).

Inventive step

The only missing feature in the closest prior art document D12 was feature 1.7 (see figure 1). Feature 1.9 was implicitly disclosed by the bayonet joint mentioned on page 7, penultimate paragraph.

When realizing the mentioned bayonet joint the skilled person would obviously select a Storz-coupling, which was a very well known type of a bayonet joint, see e.g. D13. A Storz-coupling always presented the features 1.4 to 1.9.

Alternatively the skilled person would consider D15 or D16 both disclosing a Storz-coupling. D15 being more than 130 years old was a further proof that a Storz-coupling was well known. D12 itself hinted the use of a bayonet joint. When implementing the bayonet joint in D12, the skilled person would use the joint according to D15 or D16 and would arrive in an obvious manner at the claimed subject-matter.

Reasons for the Decision

1. **Admission of auxiliary request 3B (main request)**
 - 1.1 The board exercised its discretion under Article 13(1) RPBA 2020 and admitted auxiliary request 3B filed with letter dated 30 December 2020 into the appeal proceedings.
 - 1.2 The main request under consideration is based on auxiliary request 3B, which was filed with the patent

proprietor's statement of grounds of appeal, and which admissibility was objected to in the opponent's reply under Article 12(4) RPBA 2020. Besides a correction of an obvious error already submitted before, and allowed by, the opposition division (see point 2.1 of the impugned decision), claim 1 of auxiliary request 3B filed with the statement of grounds of appeal was amended by adding the features of granted claim 6 (feature 1.9) to granted claim 1.

This request was further amended on 30 December 2020 by filing a new auxiliary request 3B, in which the term "adjustment device" in claim 1 was replaced by the term "adjustment instrument" (feature 1.9).

1.3 The amendment made to claim 1 of auxiliary request 3B filed with the patent proprietor's statement of grounds of appeal addresses the novelty objection against granted claim 1 in view of D8A. D8A was submitted 5 days before the opposition hearing, which took place on 8 October 2019, and was only admitted into the proceedings by the opposition division during the hearing (decision, point 4.1). The board takes the view that the submission of a new request with the statement of grounds of appeal that addresses the objections regarding D8A is to be regarded as a direct reaction to the late-filing of document D8A.

1.4 Contrary to the arguments of the appellant 2 (opponent), the appellant 1 (patent proprietor) had no reason to address an objection with regard to document D8 at an earlier stage in the first instance proceedings.

Before the filing of D8A the patent proprietor was only confronted with D8 which did not belong to the state of

the art under Article 54 EPC. Even though the opposition division erroneously stated in their preliminary opinion in preparation for the oral proceedings that D8 was prior art (and novelty destroying) under Article 54(3) EPC, the patent proprietor correctly pointed out with letter of 6 August 2019 that D8 was not prior art (D8 is actually a PCT application that did not enter the European phase) and thus had no reasons to prepare auxiliary requests addressing a novelty objection based on this document.

The fact that the opponent countered by filing document D8A, which is prior art under Article 54(2) EPC and which technical content is identical to that of D8, does not imply that the patent proprietor was not taken by surprise when confronted with the change in the factual situation few days before the oral proceedings. Accordingly, the board takes the view that it would not have been justified to disregard auxiliary request 3B filed with the patent proprietor's statement of grounds of appeal under Article 12(4) RPBA 2020.

- 1.5 As regards the amendment made at a later stage in appeal by replacing the term "adjustment device" in claim 1 by the term "adjustment instrument", it is in reply to the appellant 2's objection under Article 84 EPC submitted with their reply, according to which the preamble of claim 1 recited adjustment "instrument" whereas the characterising portion recited adjustment "device".

Accordingly, the board takes the view that this amendment is justified by the course of the appeal proceedings and exercises its discretion under Article 13(1) RPBA 2020 in the sense to admit it.

2. **Correction under Rule 139 EPC**

2.1 In claim 1 of the main request on file, the wording of feature 1.7 *"the work to displace the adjustment instrument (1) from the second position to the first position is greater than the work to displace the adjustment instrument (1) from the first position to the second position"* replaces the wording of granted claim 1 *"the work to displace the adjustment instrument (1) from the second position to the first position is greater than the work to displace the adjustment instrument (1) from the second position to the first position"* (terms underlined by the board for highlighting the changes made).

2.2 It is clear that there is an error in the wording of granted claim 1 as the displacement referred to is in both cases from the second position to the first position. From the wording of claim as granted it is not immediately apparent which displacement work has to be greater, the one from the second to the first position or the one from the first to the second position. However *"before a correction can be made under R. 139, second sentence, EPC it has to be established what a skilled person would derive, on the date of filing, from the parts of the European patent application relating to the disclosure."* (see Case Law, 9th Edition, II.E.4.2.1, G3/89 and G11/91). Considering that the passage on page 2, lines 18 to 24, of the application as filed discloses that *"the work to displace the adjustment instrument from the second position may be greater than the work in opposite direction"* and that *"this is to prevent the possibility of the adjustment instrument, prior to placement of the reflecting surface, being inadvertently displaced back into the first position again"* it is immediately

evident that nothing else was intended than the wording of feature 1.7 of the present main request.

- 2.3 The opponent's argument that the wording "*in opposite direction*" in the above-mentioned passage of the application as filed does not render the correction obvious in the sense of Rule 139 EPC is not convincing.

It is clear from the above-mentioned passage of the application as filed that the "opposite direction" can only be the direction from the first to the second position, in which the adjustment instrument is fixed relative to the carrier. As a matter of fact, what is to be avoided is an inadvertent displacement from the second position to the first position, and this is achieved if it is more difficult to move the adjustment instrument from the second position to the first than it is to move it from the first to the second.

- 2.4 The admissible correction of feature 1.7, being of declaratory nature only, does not infringe the requirements of Article 123 EPC (see in particular G 3/89).

3. Article 83 EPC

- 3.1 The appellant 2's (opponent's) submissions in respect of insufficient disclosure correspond to those considered by the opposition division in the contested decision (see point 4.2). The board agrees with the finding of the opposition division that the invention is sufficiently disclosed. In particular, an embodiment of a mounting construction with a clamped connection fulfilling feature 1.7 is disclosed in the context of figure 5 of the patent in suit.

3.2 The argument that the skilled person can not put into practice the clamped connection over the whole claimed range because not all clamped connections automatically fulfill feature 1.7 is not convincing. Claim 1 limits the clamped connections to those which fulfill feature 1.7. Clamped connections which do not fulfill feature 1.7 do not fall under the scope of the claim and would not be considered by the skilled person.

4. **Admissibility of a new objection under Article 123(2) EPC**

4.1 The objection raised by the appellant 2 (opponent) under Article 123(2) EPC for the first time during oral proceedings is not admitted into the proceedings pursuant to Article 13(2) RPBA 2020.

4.2 The objection raised by appellant 2 (opponent), according to which a clamped connection, recited in claim 4 as originally filed, in combination with the adjustment device being movable through a pivoting movement, recited in claim 6 as originally filed, was only originally disclosed in combination with a snap connection, is an objection under Article 123(2) EPC directed against the patent as granted, because the above mentioned features are recited in granted claims 1 and 6, respectively. Accordingly, such objection could have been raised already with the notice of opposition.

The appellant (opponent) did not provide any cogent reason why this objection was only raised at the oral proceedings before the board. The fact that Article 100(c) was a ground for opposition and that objections under Article 123(2) EPC were submitted in writing against auxiliary request 3B is irrelevant, because the

new specific objection under Article 123(2) EPC was never raised before and constitutes an amendment to the appellant 2's (opponent's) appeal case.

5. Novelty over D14

5.1 The subject-matter of claim 1 of auxiliary request 3B is novel over D14.

5.2 D14 does not disclose feature 1.4. D14 (see e.g. figure 2) teaches that the part that allows to adjust the mirror 86 is the backing plate 54 (see figures 7, 8 and 9). The retention ring 66 has the function of fixing the backing plate 54 to the carrier ("support portion 30", page 7, lines 15 to 19).

When reading feature 1.4 defining that the adjustment instrument is guided from a first position to a second position, the skilled person would expect that at least the part allowing the adjustment is moved from a first to a second position. However, according to the teaching of D14, the backing plate 54 - being the essential part of the adjustment instrument - does not move when the retention ring 66 is rotated from a first to a second position. Thus, irrespective of the appellant 2's arguments of whether the retention ring 66 is considered as part of the adjustment instrument or whether the wording of claim 1 covers the possibility that only parts of the adjustment instrument are moved, feature 1.4 is not derivable from D14.

6. Inventive step

6.1 Claim 1 of the auxiliary request 3B involves in inventive step in the sense of Article 56 EPC.

- 6.2 D12 as closest prior art and feature 1.7 as at least one distinguishing feature are undisputed.
- 6.3 D12 discloses in figure 1 an adjustment instrument 3 mounted to a carrier 4. While in figure 1 an embodiment is shown in which the adjustment instrument is fixed by screws 5 and lock nuts 7, an alternative mounting by a bayonet joint is mentioned on page 7, penultimate paragraph (*"In anderen Ausführungsformen der Erfindung wird statt einer Schraube und einer Mutter ein Verbindungselement aus zwei Verbindungsteilen mit ineinandergreifenden Abschnitten verwendet, welche zusammen einen Bayonettverschluß bilden."*).
- 6.4 The board considers that only in an ex-post-facto approach the skilled person would combine a car mirror as disclosed in D12 with a specific type of a bayonet joint (Storz-coupling) disclosed in the context of hoses (see D13, page 2 *"Auch die Schlauchkupplungen bei genormten deutschen Feuerwehrschräuchen sind ausschließlich mit einem Bajonettverschluss-Prinzip zusammenzukupplen. Das hier eingesetzte Kupplungssystem heißt Storz-Kupplung."*, title of D15 *"Schlauchverkupplung für Hochdruck- und Saugleitungen"* or title of D16 *"Schlauchkupplung mit Sicherung"*). Already for this reason the inventive step attack based on D12 combined with general knowledge as disclosed in D13, or combined with D15 or D16 fails.
- 6.5 Furthermore D12 is silent about how the bayonet joint is realized. The general disclosure neither automatically leads to the adjustment instrument 3 being pivoted from a first to a second position nor to a clamped connection in which the work to displace the adjustment instrument from the second position to the first position is greater than the work to displace the

adjustment instrument from the first position to the second position.

As can be derived from D13 (page 1), the concept of a bayonet joint is not even based on a clamping effect but primarily on form fit.

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 in amended form on the basis of the claims of auxiliary request 3B filed with letter dated 30 December 2020 and a description to be adapted.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated