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**Datasheet for the decision
of 17 February 2023**

Case Number: T 1326/21 - 3.2.01

Application Number: 13791654.0

Publication Number: 2999920

IPC: F21V14/02, F21V17/02, F21V21/14

Language of the proceedings: EN

Title of invention:
APPARATUS, METHOD, AND SYSTEM FOR INDEPENDENT AIMING AND
CUTOFF STEPS IN ILLUMINATING A TARGET AREA

Patent Proprietor:
Musco Corporation

Opponent:
Engelhardt, Volker

Headword:

Relevant legal provisions:
RPBA 2020 Art. 12(4), 12(6)

Keyword:

Late-filed requests - should have been submitted in first-
instance proceedings (yes) - circumstances of appeal case
justify admittance (no)
Amendment to case - complexity of amendment (yes) - amendment
overcomes objection (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1326/21 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 17 February 2023

Appellant: Musco Corporation
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Respondent: Engelhardt, Volker
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 16 June 2021
revoking European patent No. 2999920 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: J. J. de Acha González
A. Jimenez

Summary of Facts and Submissions

- I. The appeal of the patent proprietor lies against the decision of the Opposition Division revoking the European patent No. 2999920.
- II. With the notice of opposition the opponent (respondent) raised under the ground for opposition pursuant to Article 100(c) EPC three objections for the subject-matter of granted claim 1 directed to feature F1.3, features F1.11 and F1.15, and features F1.16 to F1.19 (see notice of opposition point V.1), as well as among others two objections for the subject-matter of granted claim 6 directed to features F6.1 and F6.7 (see point V.4 of the notice of opposition).

In its decision the Opposition Division found that, taking into consideration the amendments made during the opposition proceedings according to the sole request of the patent proprietor (claim 1 of this request being identical to granted claim 1), the European patent did not meet the requirements under Article 100(c) and 123(2) EPC. In particular, the Opposition Division found the objections directed to features F1.3, F1.16 to F1.19 and to features F6.1 and F6.7 justified (see points 2.3.1 and 2.3.4 of the contested decision).

- III. Oral proceedings before the board took place on 17 February 2023 as a videoconference.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form according to the main request, or, in the alternative, according to the first

or second auxiliary requests, all requests filed with the statement of grounds of appeal.

The respondent (opponent) requested that the appeal be dismissed, or that the case be remitted to the Opposition Division for further prosecution if any of the requests were found to comply with Article 123(2) EPC.

IV. Claim 1 of the main request reads as follows (feature numbering according to the appellant, added features with respect to claim 1 as originally filed underlined, deleted features struck through):

- F1.1 *A method of illuminating a target area*
- F1.2 *according to a composite beam pattern*
- F1.3 *using independently pivotable light directing and light redirecting means comprising:*
- F1.4 *a. identifying one or more factors related to the target area;*
- F1.5 *b. developing a plurality of individual beam patterns which, when assembled, approximates the composite beam pattern;*
- F1.6 *c. developing a lighting system comprising a plurality of lighting fixtures (10) each of which produces an output which contributes to at least one individual beam pattern and comprises:*
- F1.7 *i. one or more LED modules ~~light sources~~ (501)*
- F1.8 *pivotable about at least one axis;*
- F1.9 *ii. one or more light directing means (502)*
- F1.10 *pivotable about at least one axis;*
- F1.11 *wherein said light directing means (502)*
 - comprises one or more of:*
 - 1. a lens;*
 - 2. a structural component of the lighting system; or*

3. a filter;

- F1.12 *iii. one or more light redirecting means (503)*
F1.13 *pivotal about at least one axis and*
F1.14 *independently pivotal of said light directing*
means (502)
F1.15 *wherein said light redirecting means (503)*
comprises one or more of:
1. a reflective device;
2. a diffuser; or
3. a light absorbing device;
characterized by
F1.16 *d. housing the LED modules (501) compactly,*
F1.17 *wherein the step of housing the LED modules (501)*
compactly comprises:
F1.18 *i. mounting a plurality of LED modules (501) in a*
housing (100) elongated along an axis; and
F1.19 *ii. sealing the housing (100) with a lens (400)*
along the LED modules (501);
iii. tapering the housing (100) from the
longitudinal axis to a laterally extended edge to
promote an aerodynamic and compact profile and
F1.16 *e. installing the lighting system at the target*
area so to produce the composite beam pattern.

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that feature F1.3 reads as follows:

"using pivotal light directing means and independently pivotal light redirecting means comprising".

The set of claims of the second auxiliary request differs from that of the first auxiliary request in that claims 4 to 11 have been deleted.

Reasons for the Decision

Admissibility of the requests in appeal proceedings

1. The Board exercising its discretion under Article 12(4) and (6) RPBA 2020 (Rules of Procedure of the Boards of Appeal OJ EPO 2019, A63) does not admit any of the requests filed by the appellant in these appeal proceedings.
2. All of the appellant's request in the present case were filed with the statement of grounds of appeal; none of them corresponds to the request underlying the impugned decision.
3. Under Article 12(6) RPBA 2020 the Board shall not admit requests, facts, objections or evidence which should have been submitted, or which were no longer maintained, in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance.

Further, under Article 12(4) RPBA 2020 requests on which the decision under appeal is not based are to be regarded as an amendment, unless the party demonstrates that these were admissibly raised and maintained in the proceedings leading to the decision under appeal. Any such amendment may be admitted only at the discretion of the Board and the Board shall exercise its discretion in view of, inter alia, the complexity of the amendment, the suitability of the amendment to address the issues which led to the decision under appeal, and the need for procedural economy.

4. *Main request*

4.1 The appellant essentially argued that the amendments made to claim 1 of the main request were intended to overcome the Opposition Division's negative findings as regards features F1.16 to F1.19. As regards the negative findings concerning feature F1.3, arguments were provided in the statement of grounds. Taking into consideration that all objections on inadmissible extension for the subject-matter of granted claim 1 had been discussed during opposition proceedings and then decided upon, the subject-matter of the current main request was not completely new. Additionally, it was not possible for the appellant to submit such a request during the oral proceedings before the Opposition Division because the Opposition Division came to the conclusion that the opponent's objection directed to feature F1.3 was justified, and submitting the current main request merely addressing the objection directed to features F1.16 to F1.19 would clearly have been found *prima facie* unallowable. Accordingly, the appellant chose to contest in appeal only that part of the Opposition Division's decision concerning feature F1.3. The appellant should not be penalised for this choice, since this would imply that only requests corresponding exactly to requests submitted before the Opposition Division could be filed in appeal. This was not procedurally efficient. Consequently, the main request should be admitted.

4.2 The Board judges that the circumstances of the case do not justify the admittance of the main request for the following reasons (Article 12(6) RPBA 2020). The Board accepts that the amendments carried out to claim 1 represent an attempt to overcome the objections of inadmissible extension concerning features F1.16 to

F1.19. However, these objections were raised and substantiated already at the outset of the opposition proceedings in the notice of opposition of the respondent. Moreover, in the annex to the summons to attend oral proceedings dated 3 February 2020, the Opposition Division gave a preliminary opinion in respect of all objections of admissible extension. Even though in their opinion the amendments in features F1.16 to F1.19 were allowable, still it was clear that this was a matter to be discussed at the oral proceedings. At the oral proceedings, following the discussion on added subject-matter, the chairman *"explained that F1.3, and F1.16-F1.19 extend beyond the original application"* (see point 2.8 of the minutes). After an interruption of the oral proceedings (point 2.9 of the minutes), the patent proprietor asked to continue discussing the other claims of the main request (point 2.10 of the minutes) and eventually stated that they had no further requests (point 5 of the minutes). Accordingly, the appellant had ample opportunities to file requests overcoming the objections of added subject-matter, in particular the objection concerning features F1.16 to F1.19. It is also to be noted that the patent proprietor filed several (auxiliary) requests in opposition proceedings, none of them, however, addressing any of the above mentioned objections under Article 100(c) EPC. Accordingly, the patent proprietor deliberately chose not to file in opposition proceedings any amendments aimed at overcoming the objections under Article 100(c) EPC, in particular the objection concerning features F1.16 to F1.19, but to respond solely with arguments. Finally, the appellant deliberately chose at the oral proceedings before the Opposition Division to maintain their main request only. Hence the Board takes the view that the main request in

appeal proceedings should have been submitted in the opposition proceedings and that there are no circumstances of the appeal case justifying their admittance in appeal proceedings.

- 4.3 At the oral proceedings before the Board, the appellant submitted that during the oral proceedings before the Opposition Division they did not file a request corresponding to the present main request aimed at overcoming the objection concerning features F1.16 to F1.19, as the division came to the conclusion that also feature F1.3 was no allowable; accordingly it was likely that such a request would not have been admitted because prima facie not allowable in view of feature F1.3.

However, the patent proprietor could have filed in advance of the oral proceedings auxiliary requests aimed at overcoming some or all of the objections of added subject-matter but, as explained above, chose not to do so.

- 4.4 Moreover, the amendments made to claim 1 do not clearly solve the above mentioned issues of added subject-matter and thus they are also not admissible for reasons of procedural economy (Article 12(4) RPBA 2020).

In particular, as pointed out by the respondent in their reply when discussing amended features F1.16 and F1.17, it is doubtful whether the feature of claim 1 "one or more LED modules pivotable about at least one axis" is supported by the application as filed which is apparently silent about only one LED module being pivotable about at least one axis. Indeed claim 1 as originally filed recites "one or more light sources pivotable about at least one axis" and claim 13 as

originally filed recites "a plurality of led modules" but there seems to be no disclosure of one of the plurality of such LED modules being one of the light sources mentioned in claim 1.

5. *The auxiliary requests*

5.1 Claim 1 of the first auxiliary request differs from claim 1 of the main request only by way of amending feature F1.3, and the second auxiliary request differs from the first auxiliary request in that claims 4 to 11 have been deleted. However, the amendments made to features F1.16 to F1.19 of claim 1 of both auxiliary requests should have been submitted in first instance proceedings as already explained above and therefore also the auxiliary requests are not admitted pursuant to Article 12(6) RPBA 2020. Furthermore, Article 12(4) RPBA 2020 applies analogously for these requests as for the main request.

6. It follows from the above that the appeal is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated