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**Datasheet for the decision
of 9 February 2024**

Case Number: T 2548/19 - 3.5.02

Application Number: 07866812.6

Publication Number: 2232657

IPC: H02G1/04

Language of the proceedings: EN

Title of invention:

Synchronization Device for Machines for Laying Cables, such as for Example Conductors, Optical Fibres, Ropes or suchlike, and Cable Laying Plant Adopting said Device

Patent Proprietor:

Tesmec SpA

Opponent:

Zeck Holding GmbH

Relevant legal provisions:

EPC Art. 56

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

Keyword:

Inventive step - auxiliary request 1 (no)

Statement of grounds of appeal - party's complete case



Beschwerdekammern

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Case Number: T 2548/19 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 9 February 2024

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
15 July 2019 concerning maintenance of the
European Patent No. 2232657 in amended form.**

Composition of the Board:

Chairman R. Lord
Members: G. Flyng
W. Ungler

Summary of Facts and Submissions

- I. The contested decision is the opposition division's interlocutory decision dated 15 July 2019 in respect of European patent no. 2 232 657. The opponent is the appellant and the patent proprietor is the respondent.
- II. In the contested decision, the opposition division found that account being taken of the amended claims 1 to 6 that were filed as "1st Auxiliary Request" during oral proceedings on 24 May 2019, the patent and the invention to which it related met the requirements of the EPC. The Board will refer to this request hereinafter as the "**first auxiliary request**".
- III. The findings in the contested decision in so far as they are relevant for the present decision may be summarised as follows:
- (a) The subject-matter of claim 1 of the patent as granted was not new in the sense of Article 54 EPC over the prior art document **EP 1 282 210 A1 (document D9)**.
- (b) The opposition division held that the first auxiliary request met the requirements of Articles 54 and 56 EPC. In particular, they found that the subject-matter of claim 1 of the first auxiliary request was novel over document D9 and involved an inventive step, being not obvious starting from document D9 and taking account of common general knowledge.

(c) In view of the findings on the first auxiliary request, the contested decision did not address the claims 1 and 2 that were filed as "2nd Auxiliary Request" during oral proceedings on 24 May 2019 (**hereinafter the "second auxiliary request"**). According to paragraph 7.9 of the minutes of the oral proceedings, the opposition division decided to admit "the requests".

IV. Claim 1 of the first auxiliary request reads as follows (feature references added):

- M1: "Plant for laying two or more cables (11) such as electric conductors, optical fibres, ropes or suchlike, and comprising
- M2: a synchronization device (20) and
- M3: two or more laying machines (12, 13), distinct and independent with respect to each other and
- M4: each comprising unwinding means (12) consisting of at least a pair of capstans (14) able to unwind said cables (11), and corresponding traction/collection means (13) consisting of at least a pair of capstans (14) able to wind said cables (11) fed from the relative unwinding means (12),
- M5: said unwinding means (12) and said traction/collection members (13) selectively performing both the function of a winch and the function of a brake,
- M6: wherein said unwinding members [sic] (12) and said traction/collection members [sic] (13) are configured to be positioned on opposite sides of pylons (23) on which said cables (11) are to be hung,
- M7: characterized in that the synchronization device comprises automatic adjustment means (20) able to

adjust the speed of rotation of the capstans (14) of at least two traction/collection means (13), or alternatively of at least two unwinding means (12) of said laying machines, so as to maintain the winding/unwinding speed of the cables (11) stretched by each machine (12, 13) substantially equal,

M8: wherein said synchronization device (20) comprises position detection elements (21) each associated with a relative pair of capstans (14), and a unified control unit (22), associated with every pair of capstans (14) and able to receive the position signals from said position detection elements (21), and to condition the drive of motor members (15) of said traction/collection means (13), or of said unwinding means (12), in order to obtain substantially equal speeds of rotation of said capstans (14), wherein said control units (22) of each of said traction/collection means (13), or of said unwinding means (12), are connected with each other by means of connections (22a)."

V. Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that the following feature has been added at the end (feature references added):

M9: ", wherein every motor member comprises a hydraulic motor (15) fed by relative pump feed means (15b) and a relative command joystick (15a)".

VI. The appellant requested that the decision under appeal be set aside and that the patent be revoked in its entirety.

VII. The appellant's submissions in the statement of grounds of appeal in so far as they are relevant for the present decision may be summarised as follows:

- (a) The appellant concurred with the opposition division's finding that claim 1 of the patent as granted was not novel over document D9.

- (b) Considering novelty under Article 54 EPC, the appellant submitted that if claim 1 was interpreted such that the synchronisation device had only one unitary control unit, which comprised control sub-units ("Steuerteileinheiten") that were each associated with an individual pair of capstans, then the subject-matter of claim 1 of the first auxiliary request was not new compared to D9. According to the appellant, it was derivable from paragraphs [0032] to [0038] of D9 that such control sub-units were present, and that there would have to be connections between them in order for them to function.

- (c) Considering the question of inventive step starting from document D9, the appellant pointed to the disclosure in paragraph [0025] of D9 that:
"the invention allows to interrupt the drive of a single capstan, or of a single pair, without necessarily having to interrupt the functioning of the machine".
According to the appellant, this showed that D9 already solved the objective problem that was identified in the contested decision (i.e. "to allow for separation of the at least two machines while maintaining control reliability"). Furthermore, the appellant maintained that a

plurality of (e.g. software-implemented) control sub-units would be functionally necessary in D9, with one for each pair of capstans.

- (d) Considering the second auxiliary request, the appellant submitted that if this was pursued in the appeal proceedings, it should not be admitted for the same reasons as the first auxiliary request.

VIII. The respondent's submissions in the reply to the appeal may be summarised as follows:

- (a) Replying to the appellant's substantive objections under Articles 54 and 56 EPC, the respondent made reference almost exclusively to the findings in the contested decision, adding merely that the appellant's objections referred to an interpretation of the wording of the claims that was not correct and was not how they would be understood by a person skilled in the art by reading the whole description with reference to the drawings.

- (b) The respondent stated that they "also maintain on file, as a First Auxiliary Proposal, the Second Auxiliary Proposal filed during the hearing before the Opposition Division", but did not submit any substantive arguments in this respect.

IX. The Board summoned the parties to attend oral proceedings, setting out their preliminary observations in a communication pursuant to Article 15(1) RPBA.

The Board stated that from the submissions in the reply to the appeal, they understood the respondent's requests to be that the appeal be dismissed,

alternatively that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the second auxiliary request (i.e. claims 1 and 2 filed as "2nd Auxiliary Request" during oral proceedings on 24 May 2019).

In their preliminary observations the Board made comments on the construction of claim 1 of the first auxiliary request before expressing the view that the first auxiliary request did not meet the requirements for inventive step (Article 56 EPC). The Board stated that they were inclined not to take the second auxiliary request into account as the respondent has not presented anything that met the requirements in Article 12(2) RPBA 2007.

- X. In a letter dated 12 January 2024 the respondent's representative informed the Board that they had been given instructions by the Applicant [*respondent*] to abandon the contested patent in all Countries in which it was validated and, consequently, not to attend the oral proceedings. In a further letter dated 5 February 2024 the respondent withdrew their request for oral proceedings.
- XI. Consequently, the oral proceedings were cancelled.

Reasons for the Decision

First auxiliary request - Interpretation of claim 1

1. According to the first part of feature M8 (emphasis added):

"said synchronization device (20) comprises position detection elements (21) each associated with a relative pair of capstans (14), and a unified control unit (22), associated with every pair of capstans (14)".

Considering this feature in isolation, the skilled person would normally understand it as meaning that the synchronisation device has only one "control unit", that the one control unit is in some way "unified", and that the one control unit is associated with all of the pairs of capstans. That would be a plain understanding of the word "every".

2. However this interpretation is in stark contradiction with the last part of feature M8, according to which (emphasis added):

"said control units (22) of each of said traction/collection means (13), or of said unwinding means (12), are connected with each other by means of connections (22a)".

From this last part of feature M8 it is unequivocal from the term "control units" that the synchronisation device has more than one "control unit". Furthermore, the word "of" suggests that the control units are in some way associated with each traction/collection means (13) or each unwinding means (12).

3. According to the established case law, the skilled person should try, in a constructive way, to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent (Case Law of the Boards of Appeal, 10th edition, 2022, II.A.6.1).
4. With reference to the preferred embodiment, paragraph [0053] of the patent discloses the following (emphasis added):

"The synchronization device 20 also comprises, for each member 13, a control card 22, for each pair of independent capstans 14, connected to the relative encoder 21; the control cards 22 are connected with each other by connections 22a and the combination thereof constitutes the control unit in its entirety".
5. Taking this disclosure into account, the Board considers that feature M8 of claim 1 should be construed in such a way that the claimed "control units (22)" correspond (in broader terms) to the "control cards 22" in the embodiment and the claimed "unified control unit" corresponds to the "control unit in its entirety" in the embodiment. With this interpretation, claim 1 has to be construed such that the combination of the claimed "control units 22" constitutes the claimed "unified control unit".
6. It has to be noted, however, that whereas in the embodiment the control units are embodied as control "cards", there is no such limitation in claim 1. Also, whereas in the embodiment there is a control card for each pair of independent capstans 14, there is no such limitation in claim 1. According to established case law, for the purposes of judging novelty and inventive

step, Article 69 EPC and its Protocol cannot be relied on to read into a claim an implicit restrictive feature that is not suggested by the explicit wording of the claim. In proceedings before the EPO, where the patentee has the opportunity of cutting down the claims to accord with stricter limits given in the description, the scope of a claim should not be cut down by implying into it features which appear only in the description, as this would deprive claims of their intended function (Case Law, II.A.6.3.4).

First auxiliary request - Inventive step, Article 56 EPC

7. According to the decision, section 13.3, the patent proprietor disputed that document D9 disclosed feature M3 of claim 1. The Board concurs with the findings in section 13.3 of the contested decision that in figure 2 of document D9, the four pairs of capstans 14 of the traction/collection means 13 are distinct and independent from one another, and that together with the corresponding four distinct and independent pairs of capstans of the unwinding means 12 located on the opposite side of the pylons (figure 1) they form four distinct and independent laying machines within the meaning of feature M3.
8. It is not in dispute that document D9 discloses the features M1, M2 and M4 to M7 of claim 1.
9. Considering feature M8 of claim 1, the synchronization device 20 of D9 comprises position detection elements 21 that are each associated with a relative pair of capstans 14. Furthermore, the control unit 22 disclosed in D9 can be considered to be a "unified control unit" in the sense of feature M8, at least in so far as that

it is associated with every pair of capstans 14 and able to receive the position signals from the position detection elements 21, and to condition the drive of motor members 15 of the traction/collection means 13 in order to obtain substantially equal speeds of rotation of the capstans 14.

10. However, as set out in paragraph 5. above, feature M8 of claim 1 has to be construed such that the combination of the claimed "control units (22)" constitutes the claimed "unified control unit". It is not directly and unambiguously derivable from document D9 that the (unified) control unit 22 shown in figure 2 is constituted by "control units" of each of the traction/collection means 13, or of the unwinding means 12, that are connected with each other by means of connections. There is no suggestion in document D9 that the control unit 22 is sub-divided in this way.
11. Thus the sole distinguishing feature of claim 1 of auxiliary request 1 over D9 is that the "unified control unit" is constituted by "control units" of each of the traction/collection means 13, or of the unwinding means 12, that are connected with each other by means of connections 22a. It must therefore be considered what technical effect is achieved by this feature.
12. The Board concurs with the appellant that the disclosure in paragraph [0025] of D9 suggests that it already solves the objective problem that was identified in the contested decision (i.e. *"to allow for separation of the at least two machines while maintaining control reliability"*). According to paragraph [0025], *"the invention allows to interrupt the drive of a single capstan, or of a single pair,*

without necessarily having to interrupt the functioning of the machine". This would allow the machines to be operated separately, improving reliability.

13. It is not clear to the Board what technical effect might be achieved by the "unified control unit" being constituted by control units of each of the traction/collection means 13, or control units of each of the unwinding means 12, that are connected with each other by means of connections 22a. Particularly given the general way in which these "control units" are defined, without any technical features defining how they are implemented, it is difficult to see this subdivision of control units as anything other than a routine implementation of the control unit 22 of D9. The Board stated this in the communication pursuant to Article 15(1) RPBA and the respondent did not put forward any counter argument.
14. For these reasons the Board finds that the subject-matter of claim 1 of the first auxiliary request is obvious to the person skilled in the art in view of document D9, and that the requirement of Article 56 EPC is not met.
15. In view of this finding, other issues which were raised by the appellant in respect of the first auxiliary request do not need to be addressed in the decision.

Second auxiliary request

16. According to Article 12(4) RPBA 2007, which according to Article 25(2) RPBA 2020 continues to apply in this case, everything presented by the parties under Article 12(1) RPBA 2007 shall be taken into account by the

Board if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA 2007. According to Article 12(2) RPBA 2007, the statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on.

17. In the statement of grounds of appeal, the appellant submitted reasoned arguments as to why they considered that the second auxiliary request did not meet the requirements of the EPC.
18. In the reply to the appeal, the respondent stated that they maintained the second auxiliary request on file, but failed to submit any arguments in respect of that request, either in general, or in response to the appellant's reasoned arguments. Thus, in respect of the second auxiliary request, the respondent has not presented anything that meets the requirements in Article 12(2) RPBA 2007. For this reason the Board decided not to take the second auxiliary request into account (Article 12(4) RPBA 2007).

Conclusion

19. For these reasons the Board considered that the decision under appeal should be set aside and the patent should be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated