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**D E C I S I O N**  
**of 27 November 2002**

**Case Number:** T 0952/00 - 3.2.3  
**Application Number:** 91901265.8  
**Publication Number:** 0517702  
**IPC:** E06B 3/20, E05D 15/10, E06B 3/36,  
E06B 3/96

**Language of the proceedings:** EN

**Title of invention:**  
Pultruded Fiberglass Framing Sections

**Patentee:**  
ROKICKI, Stanley

**Opponent:**  
OMNIGLASS Ltd.

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 84, 123(2), 104  
EPC R. 29(7), 63

**Keyword:**  
"Particular expression not allowable under Articles 84 and  
123(2) EPC, (main request and auxiliary requests I to III)"  
"Auxiliary request IV: too late filed and feature not  
searched"  
"Apportionment of costs (yes)"

**Decisions cited:**  
T 0926/93, G 0010/91

**Catchword:**  
-



Case Number: T 0952/00 - 3.2.3

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.3**  
**of 27 November 2002**

**Appellant:** OMNIGLASS Ltd.  
(Opponent) 1205 Sherwin Road  
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**Representative:** Croston, David  
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**Respondent:** ROKICKI, Stanley  
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**Representative:** Weber-Bruls, Dorothee, Dr.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 17 July 2000  
rejecting the opposition filed against European  
patent No. 0 517 702 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** C. T. Wilson  
**Members:** J. du Pouget de Nadaillac  
J. P. B. Seitz  
U. Krause  
M. K. S. Aúz Castro

## Summary of Facts and Submissions

I. The appeal is directed against the decision posted 17 July 2000 of an opposition division of the EPO, which rejected the opposition filed against the European patent EP-B-0 517 702 concerning pultruded fiberglass framing sections since the different prior uses, which were alleged by the opponent as being novelty-destroying for the subject-matter of the patent, were considered as not being sufficiently proven to have been available to the public, in particular the sales and installation of patio doors in a building owned by Dondeb Construction Co. Ltd. in Orillia, Ontario (CA). In one affidavit, namely that of Mr Monaghan, provided on 24 August 1998 by the opponent, also sales of patio doors by **Willmar Windows**, a window center located in Winnipeg, Manitoba (CA), were mentioned as an example of various sales which would have occurred in 1987 and 1988, thus before the priority date of 21 December 1989 claimed by the opposed patent.

The notice of appeal was filed on 7 September 2000 and the appeal fee paid on 12 September 2000.

II. Together with the statement of grounds of appeal which was received on 22 November 2000 by fax (confirmation by post on 24 November 2000), the opponent, hereinafter the appellant, filed seven affidavits, one statutory declaration, other evidence items and two video cassettes, all relating to five patio doors sold by **Willmar Windows** in the years 1987-1989, two of said sold doors being owned by private proprietors and having been removed, dismantled and inspected in the presence of at least:

- a Notar,
- Mr Prohaska - a representative of the patentee, hereinafter the respondent, and
- members of an investigation firm, who labelled the important pieces and placed them in storage containers.

III. In response to these grounds of appeal, the respondent argued in a statement received on 10 January 2002 that the above sold doors were supplied by the company owned by the respondent, namely the Inline Ltd. company, to Willmar Windows in confidence for test purposes. Several affidavits were filed as evidence.

IV. In a communication attached to the summons dated 29 July 2002 for oral proceedings, the board expressed its provisional opinion that the alleged Willmar Windows prior use seemed to constitute prior art under Article 54(2) EPC and to anticipate at least the embodiments of the claimed invention according to Figures 1 to 21 of the patent in suit.

V. In response thereto, new sets of claims as main and auxiliary requests I to V and including new descriptions and drawings were filed by the respondent on 5 November 2002.

VI. Claim 1 of the **main request** reads as follows:

"1. A load-bearing frame for a closure assembly, comprising framing sections (eg. 111, 112) and means fastening together adjacent framing sections to form a frame, or for fastening frame hardware

(K<sub>1</sub>, K<sub>2</sub>) to a said framing section (112), at least one framing section being a thin-walled fibre glass pultrusion (eg. 112) of thickness greater than 0.25mm and up to 5.7mm, and the fastening means comprising a reinforcing means in form of a bracket (140, 150) having portions conforming to complementary-shaped portions of pultrusions disposed orthogonally to each other and connecting said pultrusions to form a corner of said frame such that the reinforcing means receives concentrated fastening loads in preference to the pultrusions and transmits said concentrated loads to the pultrusions as a load, which is distributed in three dimensions through the cross-sections of the pultrusions and absorbed by the pultrusions without structural damage."

Claim 1 of the **first auxiliary request** corresponds to claim 1 of the main request with moreover the following feature added at the end of said claim:

(...without structural damage) ", a reinforcing member having compatible flanges, channels or grooves which engage with a pultrusion and allow fastening thereof adjacent pultrusions proximate the end of the pultrusions."

Claim 1 of the **second auxiliary request** first comprises the wording of the above **main** request and continues with the following wording:

"..., the bracket (140, 150) being insertable into openings of the pultrusions (106, 107, 111, 112), the bracket (140, 150) including openings (140a, 140b, 147, 148, 150a, 150b) for fasteners (107b, 107c, 108a,

108b, 111a, 112a), and either the bracket (140) comprising flanges (144, 145, 145a) resting upon corresponding flanges (106i, 106ii, 107i, 107ii) of the respective pultrusion (106, 107) and a portion (141) extending in use within an opening (106iii, 107iii) of the respective pultrusion (106, 107) or the bracket (150) having portions (154, 155) wherein the portions of the generally L-shaped bracket (150) meet, the portions (154, 155) comprising flanges (151, 152) engaging with cooperative channels (111a, 112a) of the respective pultrusion (111, 112) and being reinforced by reinforcing ribs (153) disposed at the sides of a top and a bottom of the bracket (150)."

Claim 1 of the **third auxiliary request** also comprises the wording of claim 1 of the main request first and continues as follows:

"..., and the fastening means comprising a further load-distributing reinforcing means (200) for fastening an assembled frame (106, 107) within an opening, said reinforcing means including a portion (203) which engages an outer flange of the pultrusion to stiffen the pultrusion and to further provide an external flange (200a) for fastening the frame within an opening such that said reinforcing means (200) receives concentrated fastening loads in preference to the pultrusions and transmits said concentrated loads to the pultrusions as distributed loads which are absorbed by the pultrusions without structural damage."

VII. Oral proceedings took place on 27 November 2002. A container containing elements of the above mentioned dismantled doors was opened during the proceedings. The

respondent, after examination of the elements, withdrew the above mentioned auxiliary requests IV and V and submitted a new and last auxiliary request IV.

Claim 1 of this request reads as follows:

"1. A load-bearing frame for a closure assembly, comprising framing sections (eg. 111,112) and means fastening together adjacent framing sections to form the frame, or for fastening frame hardware ( $K_1, K_2$ ) to a said framing section (112), wherein at least one framing section is a thin-walled fibre glass pultrusion (eg. 112) of thickness greater than 0.25mm (0.010 inches) and up to 5.7mm (0.225 inches) and the fastening means is a reinforcing means (150,160) shaped to conform to complementary-shaped portions of a said pultrusion such that the reinforcing means receives concentrated fastening loads in preference to the pultrusion and transmits said concentrated loads to the pultrusion as a distributed load which is absorbed by the pultrusion without structural damage, and the frame further comprises load-distributing reinforcing means (200) for fastening an assembled frame (106,107) within an opening, whereby the further reinforcing means receives concentrated fastening loads in preference to the pultrusion and transmits said concentrated loads to the pultrusion as distributed loads which are absorbed by the pultrusion without structural damage, wherein the further reinforcing means (200) includes detent portions (201,202,203) which engage outer flanges of the pultrusion to stiffen the pultrusion and to further provide an external flange (200a) for fastening the frame with an

opening, such that the further reinforcing means (200) connected to the pultrusion forms a strengthening box beam with the pultrusion and a nailing flange."

VIII. The arguments of the appellant can be summarized as follows:

The feature "bracket having portions conforming to complementary-shaped portions of pultrusions ... such that it transmits said concentrated loads to the pultrusions as a load which is distributed in three dimensions through the cross-sections of the pultrusions" is unclear and is not disclosed in the patent application as originally filed.

It is not possible to conclude from the drawings alone that the shape of the bracket exactly conforms to the shape of the pultruded profiles. Thus, claim 1 according to the main request should not be admissible having regard to Article 123(2) EPC. The subject-matter of claim 1 of auxiliary request IV constitutes a shifting of the invention as previously claimed and should therefore not be admissible at this late stage of the proceedings, see in this respect the decision T 926/93. Moreover, this claim introduces a combination of features which was not searched and adds subject-matter, since it cannot be derived from the patent application as originally filed which parts of the pultruded profile are engaged by the detent means.

Although the door concerned was widely on sale in 1987 and 1988 and evidence in this respect provided, the respondent during more than five years has denied these facts. Each of the great number of steps which were



necessary in order to prove these sales which have occurred more than twelve years ago, could have been avoided if the respondent had admitted these sales. It may be that a respondent, having his patent opposed, has the right to remain silent, but this was not the case here, since in several affidavits the respondent made false and contradictory statements, setting forth that the first commercial sale occurred in 1990, that all previous sales were made under confidentiality or merely that he could not remember what had happened. It is difficult to imagine a more clear abuse of procedure.

IX. The respondent defended his patent by essentially arguing as follows:

Claim 1 according to the main request is a mere combination of the granted claims 1, 6 and 7. In the granted dependent claim 7, the references 140 and 150 were mentioned and both concern brackets to form a corner of the load-bearing frame, whereas the reference 44, which is mentioned in granted claim 6 together with the reference 150, does not concern such a bracket, so that it was clear that this reference 44 was an error and should have been 140, as mentioned in claim 7. Granted claims imply that they fulfill the requirements of the EPC, in particular that their features are clear, supported by the patent application as originally filed and were considered by the search examiner. It is clear for a person skilled in the art that the corner element or bracket 70 of Figure 12 of the patent in suit with its alignment tabs 72 and 74, which provide no reinforcing function, reinforces each pultrusion only in two dimensions. The vertical pultrusion only abuts against three side walls of the

corner, so that the loads are only distributed on three sides of the perimeter of the vertical pultrusion, which can be tilted on one side. In contrast the brackets 140 of Figures 23 to 25 and 150 of Figure 29 provide a three-dimensional reinforcement, since they fit snugly into the internal openings of the pultrusions. According to the passage of the description relating to the bracket 150 of Figure 29, the internal wall 111g of the vertical pultrusion abuts against the surface 154 and the surfaces 154 and 155 of the bracket comprise flanges which extend into the openings 111a and 112a of the pultrusions. These flanges imply a complete abutment of the whole surfaces of the pultrusions with the surfaces of the bracket, as is the case with the surfaces of the bracket 140 as shown in Figure 24, so that the loads can be transmitted by the bracket to the four sides of the pultrusions.

According to claim 1 of the fourth auxiliary request, detent portions of the further reinforcing means engage outer flanges of the pultrusion, so that a strengthening box is formed with the pultrusion. This feature can be seen in Figures 25 and 22 of the patent in suit and is supported by the passage of column 25, lines 5 to 15.

He, the patentee, always acted in good faith. He considered that all the prior uses, which were alleged before the first instance, were in fact tests and assumed that test purposes would not make the invention available to the public. In his view, the first commercial sale occurred in 1990, since all earlier supplies were not commercial sales, being made in confidence. The respondent was pursuing a consistent

policy of confidential experimental testing. It is the opponent's task to prove its case beyond reasonable doubt and before the first instance he failed to do so, making contradictory assertions as was recognised by the first instance. He, the patentee, had no knowledge of the sales made by Willmar Windows. It is to be noted that it is the sole prior use which was proven. These sales took place in Winnipeg, that is to say in the place of the appellant's company, not in that of the respondent. Thus, the abuse of procedure comes from the appellant, who should have evidenced this prior use before the first instance, and not only at a late stage, namely in the appeal proceedings. In contrast, the patentee has immediately reacted as soon as this alleged prior use was presented and filed an auxiliary request for the case that it was clearly established that the Willmar doors were sold without an obligation of confidentiality. Therefore, apportionment of costs should be ordered in favour of the respondent.

- X. The appellant requested that the decision under appeal be set aside and that the European patent Nr 0517702 be revoked, and that an apportionment of the costs he has incurred before the first and the second instance be ordered.

The respondent requested that the decision under appeal be set aside and that the patent be maintained on the basis of either his main request or of one of his auxiliary requests I to III filed on 5 November 2002 , or on the basis of his fourth auxiliary request filed during the oral proceedings. He also requested that an apportionment of the costs he has incurred for the appeal procedure be ordered.

## Reasons for the Decision

1. The appeal is admissible.

*Admissibility of the claims according to the requests of the respondent*

2. *Main request*

2.1 The respondent no longer disputed the Willmar Windows prior use and has recognised that the patio doors sold by the window center had been made available to the public before the priority date of the patent in suit the invention as shown in Figures 1 to 21 of this patent, in particular the reinforcing means referenced (44) of Figure 7 and those in the form of a corner bracket referenced (70) and shown in Figures 11 and 12. Claim 1 of the new main request is therefore directed to the corner or L-shaped bracket embodiments, which are shown in Figures 22 to 29, 29A of the patent specification. According to the respondent, the essential difference between the known corner bracket (70) and those now claimed, namely those referenced (140) and (150), is that the claimed brackets spread the fastening loads to each of the hollow pultrusions, which are connected together by them, **in three dimensions** throughout the internal perimeter thereof. The respondent has admitted that this essential difference was not disclosed expressis verbis in the description of the patent specification, but he submitted that this feature was unmistakably and fully derivable from Figures 22 to 29A of the patent in suit.

2.2 In the patent in suit **as granted**, a disclosure of a distribution of the fastening loads in three dimensions

through the cross-section of the pultrusion can be found in the two following places:

- in the passage of the description which introduces the invention as granted, that is to say the invention according to all figures of the patent in suit, the specific paragraph (column 5, lines 14 to 16) being worded as follows:

"A said reinforcing means may be shaped to distribute a said fastening load in three dimensions through the cross-section of the pultrusion".

- and in the dependent claim 6, which reads:

"The frame of any preceding claim wherein a said reinforcing portion (eg. 44,150) is shaped to distribute a said fastening load in three dimensions through the whole section of the pultrusion."

Apart from these two passages, no other reference to this three dimensional distribution of load appears in the patent in suit. In particular, there is no explanation as to the meaning of this expression and no disclosure of structural features which would be necessary to fulfill this function. The above referred-to passage in the description does not make clear whether any of the disclosed embodiments are considered to have this property or whether it is simply intended to disclose the possibility of amending any of these embodiments in an unspecified way so that they do have this property. The second reference, in claim 6, is confusing since the use of the reference numerals

suggests that the reinforcing portion 44 has this property, but this is now denied by the patentee. It is therefore even not possible to deduce the meaning of this feature, or property, by comparison of the various embodiments. There is therefore no clear definition in the patent as to what this feature means.

The Board would also point out that, in the patent application **as originally filed**, there is no passage corresponding to either of the two above mentioned passages of the patent as granted and that, in fact, this function itself was nowhere explicitly disclosed in the original documents of the patent in suit. Even the expression "load-bearing frame" or indeed the term "load" does not appear in these documents. The specific problem as set out in the description as originally filed was to improve pultruded fibreglass framing sections so that they may not be expensive, but nevertheless strong enough to support fastening means although fibreglass is very brittle. The solution as originally disclosed consists of thin walled fibreglass pultrusions used for forming framing sections for doors or windows, associated with reinforcing means which are at least located in predetermined portions of the pultrusions where fastening means are needed and strengthen the frame. It is not immediately clear how a problem of distribution of loads in three or two dimensions can be suggested by this problem and its solution.

- 2.3 The argument of the respondent that the litigious feature was disclosed by a claim of the patent as granted so that it must for this reason alone be considered to be implicitly supported by the patent application as originally filed and an objection under

Article 123(2) EPC cannot be raised against it cannot be followed. The main claim together with the description and drawings of the patent in suit being substantially amended, the legal framework of the case supported on appeal is different from that upon which the decision under appeal was based, so that the board has to consider all possible objections under the EPC insofar, as the amendments are concerned (see G 10/91, OJ EPO, 1993, 408, point 19). Moreover, it is the content of the application as filed which is to be considered for the purpose of Article 123(2) EPC.

- 2.4 The wording of claim 1 according to the main request specifies that the reinforcing means in form of a bracket should have portions conforming to complementary-shaped portions of pultrusions disposed orthogonally to each other and connecting said pultrusions to form a corner of said frame. Corresponding brackets can be seen in Figures 2 to 5 (bracket 40), Figures 11 and 12 (bracket 70), Figures 23 to 25 (bracket 140), Figure 28 (bracket 107b) and Figures 29, 29A (bracket 150) of the patent specification as originally filed. However, in the detailed part of the description, the term "bracket" is only used in connection with the reinforcing means (70), (140), (107b) and (150).
- 2.5 The respondent has argued that, for a person skilled in the art, the feature "distribution of the fastening loads to each of the pultrusions in three dimensions throughout the perimeter thereof by means of the bracket reinforcing means" is clearly to be seen in Figures 29 and 29A (bracket 150), whereas the bracket 70 shown in Figure 12 reinforces each pultrusion only in two dimensions. As evidence, the affidavit of the

expert Mr Hildebrand was filed.

Both reinforcing means (70) and (150) have in common that they are right angled brackets, comprising two portions or arms having four sides, which extend inwardly into the two hollow pultruded profiles, which are to be connected in order to form a corner of the load-bearing frame. The L-shaped form of bracket (150) is more pronounced than that of bracket (70), so that each arm of bracket (150) clearly extends in one pultrusion, whereas with bracket (70) it is the whole bracket as such which extends partly in one pultrusion and partly in the other, implying therefore only a difference in quality between the respective engaging portions of brackets (70) and (150). The bracket (70) is provided on its upper side with a vertical stop plate, which abuts the upper forward edge of the horizontal pultrusion according to page 27, line 9 of the original description. Another abutment means is provided slightly on one side. Both these abutting means are said to interconnect with the mitred edges of the vertical pultrusion. However, it is not clear from Figure 12 how these parts are really interconnected with the pultrusions, in particular whether the top abutting plate (72) is positioned in front of or behind the internal wall of the vertical pultrusion, so that already the fact that, in the mere assembled position, that is to say being still not fastened, the vertical pultrusion can be tilted - as argued by the respondent - cannot be deduced alone from the drawing; the description also provides no suggestion of a possible tilting movement of a pultrusion. It is further noted that, in Figure 12, a protruding appendage referenced (75) comprises in the region corresponding to the interior wall of the vertical pultrusion a nose; the



function of this nose could be understood as to block said wall, if this wall in the assembled state is positioned between this nose and the abutting plate (12). Moreover, according to the introductory part of the description, page 12, one function of the abutting means is to reduce the free play in the assembly. The person skilled in the art in view of this information and being further informed by the description that the bracket (70) is made of galvanised metal has no possibility to deduce that at least the stop plate 72 has no reinforcing function as asserted by the expert in his affidavit. It may be that the expert, who was provided with samples of the corners in addition to the drawings of the patent, could deduce this by seeing these samples, but on the sole basis of Figure 12 such a disclosure is not at least unmistakably and fully derivable.

- 2.6 A further argument of the respondent concerns the snug fit of the bracket (150) inside the hollow pultrusions, since this bracket embodiment comprises flanges on one side and is said to have the surfaces of its arms, which are directed toward the interior of the frame, abutting the corresponding interior walls of the pultrusions. It is not clear for which reason flanges cooperating with openings of the pultrusions should necessarily lead to a snug fitting of the bracket and, moreover the bracket (70) also comprises means equivalent to flanges such as stepped ramps and the already above mentioned protruding plates or appendages, which are also abutment means, so that no relevant difference can be seen in this respect. In Figure 29, moreover, the reference lines 111g and 112g rather show the forward edges of the internal walls of the pultrusions, so that it is doubtful whether the

term "surface 111g" in line 3 of page 35 of the original description is to be understood as meaning the internal wall of the pultrusion. Thus, an abutment between the walls of the bracket (150) and those of the pultrusions is not clearly disclosed. For all these reasons, a fitting of the bracket (150) inside the pultrusions which should be superior to that of the bracket (70), cannot be derived from the drawings and the corresponding passages of the description.

- 2.7 It follows that the meaning of the expression "distributed in three dimensions" is not clear in the context of the patent in suit, since it is not possible to see which structural features are clearly implied by this expression. Apart from the more pronounced extensions of the arms of the bracket (150) inside the pultrusions compared to those of the arms of bracket (70), leading thereby only to a difference in quality, it cannot in particular be deduced from these two embodiments that loads are distributed in one case in three dimensions and in the other case only in two dimensions.

Moreover, as seen above, the original documents of the patent in suit are silent as to the distribution of loads by means of the bracket means, so that it is doubtful, whether the person skilled in the art regarding these documents would have thought to analyse the disclosed embodiments in this respect.

For all these reasons, the litigious feature is not allowable under Articles 84 and 123(2) EPC, so that the main request is not admissible.

*Auxiliary requests I to III*

3. Claim 1 of each of these requests comprises the same litigious feature, so that for the same reason they are not admissible.

*Auxiliary request IV*

4. This request was filed during the oral proceedings, thus at a very late stage of the proceedings, and was a reaction of the respondent after seeing elements of the dismantled prior use window withdrawn from the container. However, more than two years ago, these elements were seen by a representative of the respondent, who was present when the doors were dismantled, so that the respondent could, therefore, have reacted and filed such a request much earlier. Moreover, claim 1 of this request, which primarily is based on a combination of the granted claims 1, 4 and 5, said combination being recognised by the respondent to be anticipated by the Willmar prior use, comprises further a particular technical feature taken from the description, namely that the reinforcing means is connected with the pultrusion so as to form a strengthening box beam and a nailing flange. This feature was never claimed before, was not searched and substantially shifts the invention, so that it would be necessary to remit the case to the first instance, although almost thirteen years have elapsed since the filing date of the patent in suit. Under these circumstances and following the jurisprudence of the boards of appeal, see decision T 926/93 (OJ OEB 1997, 447), it is decided not to admit this request into the proceedings.

*Apportionment of costs*

5. Under Article 104 EPC, each party must meet the costs he has incurred, unless the body hearing the case decides otherwise and orders, for reasons of equity, a different apportionment of costs incurred during taking of evidence or in oral proceedings. The equity requirement is a matter for the body hearing the case to decide at its discretion in the light of the facts. It is to be seen as the compensation one party owes another as a result of his negligence or culpable irresponsibility, or a wrongful act carried out with intent to cause the other party harm and leading to damage requiring that party to request oral proceedings or the taking of evidence which would otherwise have been unnecessary. The wrongful act, whether intentional or simply the result of culpable negligence, must be judged in relation to what the normal behaviour of an ordinarily diligent party would have been. It must also be clearly and obviously the direct cause of the costs which should not have been incurred.

In the present case, it is important to compare the evidence given by the opposing party at first instance with the additional evidence he had to give at the appeal stage, bearing in mind the evidence to the contrary given by the patent proprietor at both instances. It is noteworthy in this respect that, in his response to the statement setting out the grounds of appeal, the patent proprietor specifically states:

"the patentee does not retract any previous submissions made to the opposition division or any of the detailed statements therein. The application itself, its prosecution through to allowance and all submissions in connection with the opposition were made in good faith and were based on the facts as known by the patentee at

the time."

It is therefore the Board's task to establish whether, in the successive statements made by the patent proprietor and placed on file, he has expressed himself in terms that go beyond those that can legitimately be expected of a patent proprietor defending his patent, in particular by concealing all or part of the truth in the face of evidence of prior use of the invention's subject-matter, or by even alleging facts subsequently revealed to be contrary to the truth.

The Board finds that the statements made by the patent proprietor on the accuracy of the opponent's allegations during successive discussions have varied considerably over time, whereas the opponent's allegations have remained consistent. In fact, the opponent has stated since the notice of opposition (see point 5) that "prior to the priority date of the patent (21 December 1989), the patio doors (of Inline) described in the patent were widely on sale to contractors, dealers and the public." As evidence of such prior uses that he was required to supply to prejudice the novelty of the invention's subject-matter, the opponent has provided no less than seven statements in support of his allegations, and these have been corroborated by various documents.

These prior uses are referred to as (A), (B), (C) and (E) in the impugned decision. They were contested by the patentee in the following manner, as set out in paragraph 3.2 of the communication dated 28 May 1999 of the opposition division:

"- the first shipment of production lineals by

opponent to Inline did not occur until March 1988 (Affidavit Prohaska II dated 20 August 1997, point 3);

- the opponent grossly exaggerates the quantity of the pultruded profiles manufactured by the opponent and delivered to Inline;
- these profiles were substantially all defective and scrapped and only sufficient for prototypes;
- the prototype frames were not in accordance with the patent;
- the first commercial sale of the product was only made in 1990 to Commercial Glass and Aluminum of St Catharines (Affidavit M. Rokicki, page 3)."

In response to this the opponent filed a further affidavit from Mr Monaghan in which he stated that, (again as set out in the communication):

- "- in 1987 S. Rokicki/Inline sold a number of fiberglass patio doors (both fully assembled and knocked-down versions for assembly) to Inline International Inc., which held exclusive rights to the sale and manufacture of the Inline Fiberglass Sliding Patio Door in the United States (Affidavit Monaghan, point 7);
- these doors were embodiments of the patented invention (cf. Affidavit Monaghan, points 4 to 6);
- these doors were sold to various customers in USA (inter alia, to Energy Lok (Ohio), to Door and

Window Superstore (Ohio), to Primax (Kentucky) and to one individual (Mrs Warren) (cf. Affidavit Monaghan, point 7)".

Mr Rokicki's response to this was given in paragraph 5 of his supplementary affidavit dated 20 October 1999:

"Referring to the Affidavit of Mr Monaghan I agree that we had business relations through Inline International. However, Mr Monaghan has erred in the dates and contents of his Statements. Inline, as stipulated in my prior Affidavit originally sold aluminum patio doors. How could fiberglass doors be sold in 1987 if PPG did not start shipping pultrusions to Inline until 1988, which was as stated in my prior affidavit. Conveniently Mr Monahan does not provide any invoices or shipping documents to corroborate his statements. In 1989 Mr Monahan signed on behalf of Inline International, a release of liability for nonperformance with PPG and Inline Fiberglass Systems Ltd. and received about \$100,000 USD, having never received any usable product. Also, Mr Monahan has an interest in having my European Patent set aside, in that he is a Sales Agent for Omniglass in North America."

The two most damaging points on which the opposition division appear to have concentrated are as set out above in respect of the supply of production lineals and the first commercial sales. These points must however now be looked at a little more closely in the light of the fact that the opponent has now proven beyond all doubt that Willmar Windows did in fact sell a number of doors supplied by Inline without any confidential agreement, for example in September 1987 and in June 1988 as set out in paragraph above.

The first point relating to the shipment of production lineals not until March 1988, confirmed by Mr Rokicki in his affidavit, is now seen as the disingenuous statement that it was. Mr Rokicki has misled the opposition division since he was clearly able to construct the doors according to the present patent before March 1988, whether this was with lineals from the opponent or with material from a different source. It should also be pointed out in this respect that the statement of Mr Prohaska referring to these shipments was not quite as definite as is represented above, see his affidavit in which he admits that there were "prior" shipments: "There is no possibility whatsoever that any shipments to Inline Ltd. of materials for Inline's production purposes could have been made before March 9, 1988. **Prior** shipments would have been in small amounts and for test purposes only."

In respect of the second and more important point, namely the first commercial sale, this clearly was a most misleading statement. If a witness swears an affidavit he must be extra careful that he tells the whole truth. In this case the affidavit has been made with a less than careful, not to say reckless, disregard for the whole truth. Clearly, in the light of the evidence which the opponent has been forced to assemble in the appeal proceedings, it is clear that this statement is not correct. Quite clearly earlier sales had taken part. This is not a case in which a witness has been mistaken in his recollection. Indeed, Mr Rokicki does not rely on his recollection but files a computer printout summary to "prove" that this first sale really did take place in 1990. The "fact" that Mr Rokicki does not just rely on his recollection is again emphasised in the submission of his



representative dated 25 October 1999:

"In contrast, Mr Rokicki has stated that the first commercial sale (not to the best of his recollection, but according to actual records from the company, as verified by the affidavit of Marianna Rokicki) was in 1990"

As the Board now knows, this is simply not true, and Mr Rokicki must have known this from his leading position in the Inline company.

Without these false statements the Board is convinced that the opposition division would not have been so receptive to the arguments of the patentee in respect of the alleged confidentiality of these other probable prior uses, such confidentiality making no sense when the doors were freely available elsewhere, so that the opponent would not have been required to go to the expense of gathering further evidence as they have had to in the present appeal.

The patentee has continued this behaviour in the appeal proceedings, maintaining his request for maintenance of the patent as granted until one month before the appointed oral proceedings when a new representative was appointed, and this all in the face of overwhelming evidence gathered in Canada in the presence of a representative of the patentee and submitted with the grounds of appeal two years before the oral proceedings.

The request of the opponent for an apportionment of costs in respect of the costs incurred by the appellant (opponent) during taking of evidence after notification of the decision of the first instance is therefore to be granted.

The request of the respondent (patentee) for an apportionment of costs due to the late-filing of evidence during the appeal proceedings is to be refused. As set out above the late-filing was caused by the behaviour of the respondent himself.

## **Order**

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

1. The decision under appeal is set aside.
2. The European patent No. 0 517 702 is revoked.
3. The respondent shall bear 100% of costs incurred by the appellant during taking of evidence after notification of the decision of the first instance.
4. The request for apportionment of costs by the respondent is refused.

The Registrar:

The Chairman:

A. Counillon

C. T. Wilson