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D E C I S I O N
of 5 November 2003

Case Number: T 0014/02 - 3.2.7

Application Number: 96200762.1

Publication Number: 0720896

IPC: B28B 3/02

Language of the proceedings: EN

Title of invention:
Isostatic die means

Patentee:
Algeri, Maris

Opponent:
Officine Meccaniche f.lli Rossi fu Cesare S.p.A.

Headword:
-

Relevant legal provisions:
EPC Art. 56, 83, 123(2)

Keyword:
"Fresh grounds filed for the first time in appeal proceedings
- not admitted"
"Request at oral proceedings to file further auxiliary
requests - not allowed"
"Inventive step - main and auxiliary requests (no)"

Decisions cited:
G 0010/91, T 0051/90, T 0270/90, T 0048/91

Catchword:

During oral proceedings before the board a party, here the respondent, asked permission to file further requests aimed at defining more narrowly the claimed subject-matter. This request was refused for two reasons:

firstly, the need for further requests had been foreseeable before the oral proceedings, since the Board, in a communication, had given a negative reasoned provisional opinion why the main request did not appear to involve an inventive step and

secondly, the proposed subject-matter of the requests could lead to further searches being necessary by the other party with the possibility of remittal so that the requests were not prima facie allowable.



Case Number: T 0014/02 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.1.1
of 5 November 2003

Appellant: Officine Meccaniche f.lli Rossi fu Cesare
(Opponent) S.p.A.
Via Mazzini 43
I-4219 Scadiano (Reggio Emilia) (IT)

Representative: elisati, Francesco
Internazionale Brevetti
Ingg. Zini, Maranesi & Co. S.r.l
Piazza Castello 1
I-20121 Milano (IT)

Respondent: Algeri, Maris
(Proprietor of the patent) Via Radici in Monte, 175
I-42010 Roteglia di Castellarano (Reggio
Emilia) (IT)

Representative: Luppi, Luigi
Luppi Crugnola Bergamini & Partners S.r.l
Viale Corassori, 54
I-41100 Modena (IT)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
6 November 2001 concerning maintenance of
European patent No. 0720896 in amended form.

Composition of the Board:

Chairman: C. Holtz
Members: P. A. O'Reilly
H. E. Hahn

Summary of Facts and Submissions

- I. The appellant (opponent) filed an appeal against the decision of the Opposition Division to maintain amended the European patent No. 0 720 896.
- II. Opposition was filed against the patent as a whole and based on Article 100(a) EPC (lack of novelty and lack of inventive step).

The Opposition Division held that the subject-matter of claim 1 of the main request (maintenance in amended form) was novel and involved an inventive step.

The most relevant prior art documents for the present decision are:

- D1: IT-A-01 257 658
D2: "Fachwissen des Ingenieurs", pages 162 - 165, VEB
Fachbuchverlag, Leipzig 1989
D3: IT-U-212 838
D4: DE-C-34 10 721
D5: GB-A-1 160 590

- III. The appellant requested that decision of the Opposition Division be set aside and the patent be revoked. The appellant further requested that grounds under Articles 83 and 123(2) EPC be admitted into the appeal proceedings.

The respondent requested that the appeal be dismissed and the patent be maintained in amended form in accordance with the main request as maintained by the Opposition Division, or alternatively, that the decision

under appeal be set aside and the patent be maintained in accordance with the auxiliary request filed with letter of 5 October 2003. During the oral proceedings before the Board the respondent requested permission to file further auxiliary requests.

IV. The independent claim according to the main request reads as follows:

"1. Die means, particularly for pressing ceramic tiles, comprising two dies, punch and matrix, at least one die (P) having a cavity (108) containing an incompressible fluid (11) flowable through corresponding passageways, said cavity (108) being closed on the side facing the clay mixture (204, 232) to be pressed by means of an elastic membrane (5; 16; 17), said elastic membrane (5; 16; 17) comprising central anchoring zones (2, 3, 4, 20; 2, 20; 102, 208, 209) and a peripheral anchoring zone (103a) said central anchoring zones (2, 3, 4, 20; 2, 20; 102, 208, 209) and said peripheral anchoring zone (103a) being anchored to the body of said die (P), characterized in that said central anchoring zones (2, 3, 4, 20; 2, 20; 102, 208, 209) are reciprocally isolated so that said passageways are defined between each central anchoring zone (2, 3, 4, 20; 2, 20; 102, 208, 209) and adjacent central anchoring zones (2, 3, 4, 20; 2, 20; 102, 208, 209) and/or said peripheral anchoring zone (103a) and in that said central anchoring zones are defined by a plurality of grooves (102, 208) in which appendages (103a, 209) of the membrane (5; 16; 17) are received."

The independent claim of the first auxiliary request reads as follows:

"1. Die means, particularly for pressing ceramic tiles; comprising two dies, punch and matrix; at least one die (P) having a cavity (108) containing an incompressible fluid (11) flowable through corresponding passageways; said cavity (108) being closed on the side facing the clay mixture (204, 232) to be pressed by means of an elastic membrane (5; 16; 17); said elastic membrane (5; 16; 17) comprising central anchoring zones (2, 3, 4, 20; 2, 20; 102, 208, 209) and a peripheral anchoring zone (103a); said central anchoring zones (2, 3, 4, 20; 2, 20; 102, 208, 209) and said peripheral anchoring zone (103) being anchored to the body of said die (P); said central anchoring zones (2, 3, 4, 20; 2, 20; 102, 208, 209) being reciprocally isolated so that said passageways are defined between each central anchoring zone (2, 3, 4, 20; 2, 20; 102, 208, 209) and adjacent central anchoring zones (2, 3, 4, 20; 2, 20; 102, 208, 209) and/or said peripheral anchoring zone (103); said central anchoring zones (2, 3, 4, 20; 2, 20; 102, 208, 209) being defined by a plurality of grooves (102, 208) in which appendages (103a, 209) of the membrane (5; 16; 17) are received, **such that said passageways are provided between each groove (102, 208) and adjacent grooves (102, 208).**"

V. The appellant argued in written and oral submissions essentially as follows:

- (i) The nearest prior art is document D1. This document discloses all the features of claim 1 of the main request except the feature that the anchoring zones are defined by a plurality of grooves in which appendages of the elastic membrane are received. The problem to be solved by

this feature is to improve the fixing of the membrane to the substrate. Such a form of anchoring is well known to the skilled person as shown by document D2. Document D2 shows the connection as a standard form of anchor. There is no surprising advantage gained in the combination of documents D1 and D2. Claim 1 also lacks an inventive step over the combination of documents D1 and D3. Document D3 discloses a tongue and groove anchor and indicates that this form of anchor solves the problem of improving anchoring and sealing. Also, a combination of documents D1 and either of documents D4 or D5 takes away the inventive step of the subject-matter of claim 1. Each of documents D4 and D5 shows the use of tongue and groove joints which would lead the skilled person to provide this feature also in a die as known from document D1. The arguments of the respondent are not based on the features of the claim, but rather are based on the features of individual embodiments. There is no feature in the claim which necessarily avoids a need to form side walls.

- (ii) With regard to the extra feature of claim 1 of the auxiliary request this is not in fact a real extra feature. The claim already specifies that the passageways are defined between the anchoring zones. The extra feature that the passageways are provided between the grooves restates the same feature with respect to the grooves as already specified with respect to the anchoring zones.

(iii) Dependent claims 2 to 8 extend beyond the scope of the original disclosure and/or are not sufficiently clearly described. Claim 1 has been limited to specific embodiments and these embodiments do not show the features claimed in some of the dependent claims.

(iv) The request of the respondent to file further auxiliary requests should not be accepted.

VI. The respondent argued in written and oral submissions essentially as follows:

(i) The subject-matter of claim 1 of the main request involves an inventive step. Because the membrane appendages are received in grooves there is allowed a certain compensation of the pressure in these areas without however deforming too much. In contrast to the die disclosed in document D1 the die according to the patent in suit does not require the manufacture of conduits by removal of metal from the punch body. The die according to document D1 requires the production of side walls for the conduits which is not required for a die in accordance with claim 1. Document D2 states that tongue and groove connections are expensive. This document therefore creates a prejudice against their use. Document D3 does not address the problem of providing passageways for incompressible fluids. Moreover, if the skilled person did consider document D3 he would only attach the periphery of the membrane disclosed in document D1 with the tongue and groove joints. Document D4 lies in the field of feeding and

discharging bulk material which is far away from dies for pressing ceramic tiles and moreover deals with a different problem. Document D5 discloses a seal only at the periphery and the elastic membrane is not received in a groove but merely rests on a shoulder.

- (ii) Claim 1 of the auxiliary request more clearly defines that the passageways are formed by the appendages inserted into the grooves.
- (iii) The respondent does not agree to the introduction into the appeal proceedings of the new grounds under Articles 83 and 123(2) EPC.
- (iv) The respondent should be allowed to file further auxiliary requests with further definitions of the features of the anchoring zones.

Reasons for the Decision

1. *Admissibility of new grounds under Articles 83 and 123(2) EPC*
 - 1.1 These grounds were raised by the appellant in his appeal grounds against the dependent claims. The grounds do not arise out of amendments made to the dependent claims. According to the appellant they arise because some embodiments disclosed in the description are not within the scope of claim 1 as amended. In the opinion of the Board however such arguments do not relate to Articles 83 or 123(2) EPC but rather to the form of the description, i.e. whether some embodiments

should be deleted. For this reason the Board does not consider that grounds under Articles 83 or 123(2) EPC arise out of the amendments and thus could be considered in view of Article 102(3) EPC. The respondent has not agreed to the introduction of these new grounds into the appeal proceedings. In accordance with Enlarged Board of Appeal Opinion G 10/91 the Board therefore has decided not to admit the grounds into the appeal proceedings.

Main Request

2. *Inventive step*

2.1 Closest prior art

As agreed by the parties the closest prior art is represented by document D1. It is also agreed by the parties that document D1 discloses the following features of claim 1:

Die means for pressing ceramic tiles, comprising two dies, punch and matrix, at least one die having a cavity containing an incompressible fluid flowable through corresponding passageways, said cavity being closed on the side facing the clay mixture to be pressed by means of an elastic membrane, said elastic membrane comprising central anchoring zones and a peripheral anchoring zone said central anchoring zones and said peripheral anchoring zone being anchored to the body of said die, wherein that said central anchoring zones are reciprocally isolated so that said passageways are defined between each central anchoring

zone and adjacent central anchoring zones and/or said peripheral anchoring zone.

2.2 Problem to be solved

According to the appellant the problem to be solved is to improve the fixing of the membrane.

According to the respondent the problem to be solved is to create passageways for the incompressible fluid without the need to create side walls.

The Board concurs with the appellant concerning the problem to be solved. The problem suggested by the respondent cannot be the objective problem as the claim does not contain any features which would solve this problem. The mere provision of a tongue and groove type of anchor does not mean that there are no side walls since the positions of the anchoring zones and passageways are merely defined with respect to the outer periphery of the die. There is no definition of the positions of the anchoring zones with respect to the faces of the dies, i.e. that the grooves are provided in the face of a die. Thus, the claim does not exclude that there may be side walls for the anchoring zones.

2.3 Solution to the problem

The solution to the problem is that the central anchoring zones are defined by a plurality of grooves in which appendages of the membrane are received.

2.4 The solution to the problem is obvious for the following reasons:

The Board would first note that in the device known from document D1 each anchoring zone in fact comprises an appendage received in a groove; albeit the groove is formed in the elastic membrane and the appendage is received into the groove in the membrane. This construction is thus the inverse of the construction specified in the claim. In the view of the Board however it would be obvious to the skilled person that the known construction can also be provided in the inverse manner, i.e. with the appendage being formed in the elastic member instead of being formed in the groove. A prejudice against such a modification has not been shown to exist. On the contrary, document D3, which is also concerned with the production of ceramic articles, discloses the attachment of an elastic membrane by means of an appendage of the elastic membrane entering a groove formed in the surface of the die.

The respondent has argued that the appendage and groove known from document D3 were provided in order to seal the periphery of the elastic membrane and not to form passageways. The Board cannot agree with this argument of the respondent. The Board notes that the claim does not specify that the anchoring zones form the passageways but rather that the passageways are formed between them, so that the claim does not contain a feature corresponding to this argument. Also, if the appendage and groove arrangement known from document D3 is provided as a sealing means then this would illustrate its suitability for forming passageways.

2.5 Therefore, the subject-matter of claim 1 of the main request does not involve an inventive step in the sense of Article 56 EPC.

3. *Auxiliary request*

3.1 The Board cannot follow the arguments of the respondent that the extra feature of this request clarifies that the passageways are defined between the appendages by the grooves. The feature merely states that the passageways are provided between the grooves, i.e. the position of the passageway is indicated and not its origin. This position is also merely somewhere between the grooves. In fact, the grooves are part of the anchoring means and the passageways have already been defined to be between the anchoring means in the earlier part of the claim, which is acknowledged to be known from document D1. This extra feature therefore does not form a limitation to the claim but repeats an earlier feature. The use of the term "provided" as opposed to "defined" does not in the opinion of the Board effect any material difference on the meaning of the claim since the feature is still considered to define the position of the passageways and not their manner of formation.

3.2 Therefore, the subject-matter of claim 1 of the auxiliary request does not involve an inventive step in the sense of Article 56 EPC.

4. *Request to file further auxiliary requests*

4.1 During the oral proceedings before the Board the respondent asked permission to file further auxiliary requests directed to the specific definitions of the manner in which the grooves are formed. The appellant objected to this request. The Board also does not agree with this request.

4.2 In the oral proceedings no new matter arose which had not already been addressed in the preceding written appeal proceedings. In the provisional opinion of the Board as expressed in the communication accompanying the invitation to oral proceedings the Board expressed the opinion that the subject-matter of claim 1 of the main request did not appear to involve an inventive step for reasons which were expressed in detail. The respondent was thus aware well before the oral proceedings that the patent could be revoked but chose to file a single auxiliary request, which in fact did not represent any limitation of claim 1 of the main request (see point 3.1).

4.3 The intended requests as suggested by the respondent in the oral proceedings would not just involve a minor change in wording of claim 1 but rather major limitations of the claim which in all likelihood would require a new search by the appellant and could cause a remittal to the first instance (cf. decisions T 51/90, T 270/90, OJ EPO 1993, 725, and T 48/91). Therefore, the suggested amendments could not be seen as *prima facie* allowable (cf. T 270/90).

4.4 In the absence of any mitigating circumstances, such as a good reason why the requests could not have been filed earlier, the Board sees no reason for admitting them so late in the proceedings.

4.5 Consequently the only requests examined in the appeal were the main and auxiliary requests (see point III).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. European patent No. 0 720 896 is revoked.

The Registrar:

The Chairman:

D. Spigarelli

C. Holtz