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D E C I S I O N
of 21 July 2004

Case Number: T 1180/02 - 3.2.1
Application Number: 96300895.8
Publication Number: 0730999
IPC: B60R 13/08, B29C 44/18,
B62D 29/00
Language of the proceedings: EN

Title of invention:

Support structure for supporting foamable material on hollow structural member

Patentee:

NEO-EX LAB. INC.

Opponent:

SIKA SCHWEIZ AG

Headword:

-

Relevant legal provisions:

EPC Art. 104(1), 123(2)

Keyword:

"Costs - apportionment - (no)"

"Amendments - added subject-matter - (yes)"

Decisions cited:

T 0326/87, T 0514/88, T 0527/88, T 0685/90, T 1016/93

Catchword:

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Case Number: T 1180/02 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 21 July 2004

Appellant: SIKA SCHWEIZ AG
(Opponent) Tüffenwies 16-22
CH-8048 Zürich (CH)

Representative: Isler, Jörg
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Respondent: NEO-EX LAB. INC.
(Proprietor of the patent) 19-6, Jinnaka-machi 2-chome
Toyota-shi
Aichi-ken (JP)

Representative: Nicholls, Michael John
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 September 2002
rejecting the opposition filed against European
patent No. 0730999 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: S. Crane
Members: J. Osborne
S. U. Hoffmann
Y. A. F. Lemblé
A. Pignatelli

Summary of Facts and Submissions

- I. The appeal is directed against the decision posted 20 September 2002 to reject the opposition against European patent No. 0 730 999.
- II. The patent had been opposed *inter alia* on the ground that its subject-matter extends beyond the content of the application as filed (Article 100(c) EPC).
- III. The Board summoned the parties to oral proceedings to be held on 21 July 2004 and set a time limit of one month before that date for filing any further requests or written submissions. The appellant filed per fax on 18 June 2004 a letter and supporting evidence relating to two new allegations of public prior use. A copy of the correspondence was faxed directly to the respondent.
- IV. During the oral proceedings the appellant requested that the impugned decision be set aside and that the patent be revoked. The respondent requested that the appeal be dismissed and that the patent be maintained as granted (main request) or in the alternative that it be maintained in amended form on the basis of the sets of claims according to first and second auxiliary requests submitted with a letter dated 14 June 2004. Apportionment of costs associated with the filing on 18 June 2004 of the new evidence was also requested.
- V. The claims as granted include a single independent claim directed to a product, which reads as follows:

"1. A support structure (10,15,60,65) for supporting a foamable material (21,71) in a cavity (6,50) of a

hollow structural member (1,51) so that the foamable material (21,71) blocks the cavity of the hollow structural member (1,51) when it is foamed by external heating, comprising:

a support member (10,60) disposed in the cavity (6,56) so as to be perpendicular to a longitudinal direction of the cavity (6,56) and adapted to retain the foamable material (21,71) in such a manner that at least one side surface of the foamable material (21,71) is restrictively covered by said support member (10,60); and

an engagement pin (15,65) integrally provided on said support member (10,60) and adapted to engage an aperture (7,57), formed in the hollow structural member (1,51), characterised in that

the support member (10,60) is provided with at least one support piece (13,25), and the foamable material (21,71) is formed with at least one engagement slot (24,26) which is engageable with the support piece (13,25) when the foamable material (21,71) is applied to the support member (10,60). "

The claims according to the first auxiliary request include two independent claims, each directed to a product and which read as follows:

"1. A support structure (10,15) for supporting a foamable material (21) in a cavity (6) of a hollow structural member (1,51) so that the foamable material (21) blocks the cavity of the hollow structural member (1) when it is foamed by external heating, comprising: a support member (10) comprising a pair of support plates (11) spaced apart to receive the foamable material (21) therebetween, said support plates (11)

being disposed in the cavity (6) so as to be perpendicular to a longitudinal direction of the cavity (6) and adapted to retain the foamable material (21) therebetween in such a manner that both side surfaces of the foamable material (21) are restrictively covered by said support plates (11); and an engagement pin (15) integrally provided on said support member (10) and adapted to engage an aperture (7), formed in the hollow structural member (1), characterised in that the support plates (11) are provided with at least one support piece (13,14), and the foamable material (21) is formed with at least one engagement slot (24) which is engageable with the support piece (13,14) when the foamable material (21) is applied to the support member (10)."

"7. A support structure (60,65) for supporting a foamable material (71) in a cavity (56) of a hollow structural member (51) so that the foamable material (71) blocks the cavity of the hollow structural member (51) when it is foamed by external heating, comprising: a support member (60) comprising a support plate (61) disposed in the cavity (56) so as to be perpendicular to a longitudinal direction of the cavity (56) and adapted to retain the foamable material (71) on both of the side surfaces thereof in such a manner that one side surface of the foamable material (71) is restrictively covered by said support member (60); and an engagement pin (65) integrally provided on said support member (60) and adapted to engage an aperture (57), formed in the hollow structural member (51), wherein

the support plate (61) is provided with at least one support piece (25) at each side surface thereof, and the foamable material (71) is formed with at least one engagement slot (26) which is engageable with the support piece (25) when the foamable material (71) is applied to the support member (60)."

The claims according to the second auxiliary request contain a single independent claim directed to a product, which reads as follows:

"1. A support structure (10,15,60,65) for supporting a foamable material (21,71) in a cavity (6,50) of a hollow structural member (1,51) so that the foamable material (21,71) blocks the cavity of the hollow structural member (1,51) when it is foamed by external heating, comprising:
a support member (10,60) disposed in the cavity (6,56) so as to be perpendicular to a longitudinal direction of the cavity (6,56) and adapted to retain the foamable material (21,71) in such a manner that at least one side surface of the foamable material (21,71) is restrictively covered by said support member (10,60);
and
an engagement pin (15,65) integrally provided on said support member (10,60) and adapted to engage an aperture (7,57), formed in the hollow structural member (1,51), characterised in that
the support member (10,60) is provided with at least one support piece (13,25), and the foamable material (21,71) is formed with at least one engagement slot (24,26), wherein the engagement slot (24,26) is configured and dimensioned to be complementary to the support piece (13,25) so as to be closely engageable

with the support piece (13,25) when the foamable material (21,71) is applied to the support member (10,60)."

VI. The appellant argued in respect of the ground for opposition according to Article 100(c) EPC essentially as follows:

The independent claims according to all requests contain the feature of "at least one support piece" which is a generalisation of the disclosure of the application as originally filed. In that application two embodiments are shown and described. In the first embodiment four parts described as "connecting pieces" engage in slots in the block of foamable material but there is no disclosure either of only one such connecting piece or that the connecting pieces provide a support function. Moreover, the original disclosure, in respect of the second embodiment, is of at least one "support strip" which implies a certain shape whereas the presently claimed "support piece" is of unspecified shape.

As regards the respondent's request for apportionment of costs the appellant explained that:

The evidence which was filed shortly before the oral proceedings previously had not been readily available since it related to public prior use which had occurred before the two companies supplying the components belonged to the appellant. Attempts to obtain information directly from the companies to which the components were supplied had proved difficult.

VII. The respondent's rebuttal of the arguments in respect of the objections under Article 100(c) EPC may be summarised as follows:

The term "support" has a very broad meaning and, in as far as the first embodiment is concerned, it is perfectly clear to the skilled person when considering figure 1 that the connecting pieces would have at least a secondary supporting function. Moreover, it is explicitly stated that the slots in the block "engage" the connecting pieces and it is clear from the description that support is provided between parts which "engage". The requirement in the independent claims according to all requests that the support pieces be engageable by the slots is a clear restriction on the shape of the support pieces. The original disclosure is of support being provided both by the connecting pieces of the first embodiment and by the support strips of the second embodiment and thereby provides a fair basis for the feature of "support pieces". Furthermore, the claimed wording "at least one ..." is a fair generalisation of the original disclosure to the skilled person who would realise that only one connecting piece would be necessary in the first embodiment.

In support of its request for apportionment of costs the respondent essentially argued as follows:

According to decision T 326/87 (OJ EPO 1992, 522) costs should be apportioned in favour of the proprietor when the opponent files a document for the first time in appeal proceedings unless there exist strong mitigating circumstances for the late filing. In the present case

the evidence relates to instances of prior use by the opponent itself and so were available during the opposition period. The evidence had been filed in a mixture of German and French only shortly before the one month time limit set by the Board. The resulting need to expedite translation led to higher costs. Moreover, additional research amongst case law had been necessary in order to prepare a defence.

Reasons for the Decision

Addition of subject-matter (Article 100(c) EPC

Main request

1. The patent relates to a structure for supporting foamable material in the cavity of a hollow structural member such as a roof side panel of a vehicle body. The foamable material is in the form of a block and when subjected to heat it foams and expands to close the cavity. The structure includes a support member for the foamable material and claim 1 contains the feature at the beginning of the characterising portion that the support member is provided with "at least one support piece" with which at least one engagement slot in the foamable material is engageable.
2. In the application as originally filed two embodiments of the structure are described. In the first a support member comprises two mutually spaced support plates between which the block of foamable material is located. The support plates are joined by five "connecting pieces" of varying lengths which extend upwards from

the lower edges of the plates and span the space between them. The block is inserted from above and comprises slits which "engage" the connecting pieces as it moves into the space. The block furthermore comprises lateral projections which engage in holes in the plates to "position and retain" the block. In the second embodiment a single support plate is provided and the block is located on a pair of "support strips" which project from the surface of the support plate. The block of foamable material comprises a pair of slots which are "configured and dimensioned to be closely engaged" with the support strips. A single independent claim covers both embodiments and defines the support member as being "adapted to retain" the foamable material. Claim 6 relates to the first embodiment and defines "apertures and projections ... to position and retain" the foamable material. Claim 2 relates to the second embodiment and defines "at least one support strip ... to position and retain" the foamable material. The claims contain no feature in respect of the connecting pieces.

3. The expression "at least one support piece" is not contained in the application as originally filed and the appellant is challenging the basis in the original disclosure for this expression in three respects:

- firstly, that there is no disclosure in respect of the first embodiment that the elements which engage the slits provide support and argues that the attribution of this function to the "connecting pieces" extends the teaching of the disclosure;

- secondly, that there is no disclosure in respect of the first embodiment of only one connecting piece, as defined by the wording "at least one" in claim 1;
- thirdly, that there is no disclosure of a support "piece" of undefined form.

The Board will now consider each of these objections individually.

- 3.1 The expression "support piece" in present claim 1 is being used by the respondent to represent both the feature originally disclosed as a connecting piece in the first embodiment and the feature originally disclosed as a support strip in the second embodiment. It is stated on page 2, lines 43 to 45 of the A-publication that the support strip is provided to position and retain the foamable material on the support plate and that it prevents the foamable material from moving on and dropping out from the support plate. Similarly, page 5, lines 14 to 16 and lines 47 to 51 explains that pairs of the support strips position and retain the foamable material on the support plate. The term "support" therefore is originally disclosed as having the meaning of positioning and retaining. The corresponding function of positioning and retaining the foamable material and preventing it rotating and dropping out in the first embodiment is performed not by the connecting pieces but by the engagement of projections on the foamable material in apertures on the support plates (page 3, lines 7 to 9 and page 4, lines 36 and 37). By using the term "support piece" to represent the element originally disclosed as a "connecting piece" the

respondent is attributing to the latter the function of positioning and retaining the foamable material. The respondent's view that the term "support" has a very broad meaning overlooks the fact that the term had already been given a particular interpretation in the original application. The application of that interpretation to the function of the connecting pieces of the first embodiment extends the subject-matter of the patent beyond that of the original application.

The respondent also takes the view that the description page 2, lines 12 to 14 teaches that a part which engages another provides "support" for it and that the disclosed engagement between the slits and connecting pieces of the first embodiment therefore discloses providing support. The passage referred to by the respondent reads: "The foamable material 121 is engaged ... **by sticking** ... Thus the foamable material is supported in a cavity" (emphasis added). In the Board's view this text does not serve to define the term "support" within the meaning of the patent because it concerns an adhesive engagement, which is not the case in the present patent.

Moreover, the Board cannot accept the respondent's argument that it is implicit for the skilled person when seeing figure 1 that the connecting pieces support the foamable material. It is established case law that the disclosure in the original application of a feature which is to be introduced as an amendment must be direct and unambiguous (see T 514/88 (OJ EPO 1992, 570), T 527/88 and T 685/90 (both not published in OJ EPO)). This requirement is not satisfied in the present case.

3.2 The support plates in the first embodiment are formed of a synthetic resin by injection moulding and the connecting pieces are explicitly disclosed as serving to space apart the support plates by a desired distance. Five connecting pieces are shown in figure 1, equally spaced across the width of the support plates and it is implicit that the connecting pieces act to stabilise them. There is no disclosure in the original application that only one connecting piece would be sufficient to stabilise the support plates. The disclosure of "at least one" in the original application is an explicit one in respect of the support strips of the second embodiment which, as explained under 3.1 above, have a different function to the connecting pieces and the skilled person would perceive no relationship between the respective disclosed quantities. It follows that the specification in claim 1 of "at least one" of the elements originally disclosed only as connecting pieces also extends the subject-matter of the patent beyond that of the original application.

3.3 The appellant's third challenge relates to the disclosure of a support "piece", i.e. of undefined form. As already set out under 3.1 above the original disclosure provides no basis for attributing to the connecting pieces a support function within the meaning of the application. It follows that any argument which is based on the disclosure in respect of the first embodiment of a support element of a different form to the support strip in the second embodiment must fail. Moreover, even if this were not the case, the connecting pieces in the first embodiment are also in the form of strips and so provide no basis in

themselves for generalisation. Furthermore, it is clear to the skilled person that the formation of the support element in the second embodiment as a strip serves in combination with the slot in the foamable material to rotationally position the latter relative to the support plate. There is nothing in the original disclosure which would lead the skilled person to understand that any shape of support element, as falls within the definition "support piece", could satisfactorily locate the foamable material. In this respect the Board notes that the requirement in claim 1 that the support piece engages with a slot in the foamable material does not limit the form of the support piece since it is not specified that the form of the latter must correspond in any way with that of the slot. It follows that also in this respect the subject-matter of the patent extends beyond that of the original application.

4. In the light of the foregoing the main request must be refused.

Auxiliary requests

5. Each independent claim according to the auxiliary requests contains the feature of "at least one support piece". In the first auxiliary request claim 1 relates only to the first embodiment and results in extension of subject-matter for the reasons explained under 3.1 and 3.2 above. Claim 7 relates only to the second auxiliary request and results in extension of subject-matter as explained under 3.3 above. In the second auxiliary request claim 1 covers both embodiments and results in extension of subject-matter as explained

under 3.1 to 3.3 above. Moreover, claim 1 according to the second auxiliary request specifies that the engagement slot in the foamable material is configured and dimensioned so as to be closely engageable with the support piece. Whilst this is explicitly disclosed in respect of the second embodiment there is no such disclosure in respect of the first embodiment.

It follows that the auxiliary requests also must be refused.

Apportionment of costs

6. According to Article 104(1) EPC each party to the proceedings normally shall meet the costs he has incurred. The board may, for reasons of equity, order a different apportionment of costs.

6.1 In a number of decisions it has been found that the late filing of a relevant document by one party, without giving any convincing explanation for the late introduction of the document, normally calls for an apportionment of costs in the other party's favour. According to T 326/87 (*supra*), cited by the respondent itself, there may be mitigating circumstances, for example where evidence introduced was obscure and therefore difficult to get hold of (reasons 2.3, final sentence). The present Board, albeit in a different composition, has already considered a case in which evidence was filed only four weeks before the date set for oral proceedings (T 1016/93, not published in OJ EPO). It based its judgement of whether costs should be awarded upon the matter of whether the appellant's reasons for the late citation pointed towards

negligence or circumstances that would amount to an abuse of procedure. The matter to be considered in the present case is therefore whether the particular circumstances justify a different apportionment.

6.2 In the present case the evidence whose filing has led to the respondent's request for apportionment of costs relates to two instances of alleged public prior use. They involve the supply of parts by the companies Happich S.A. and Ymos Belgium S.A. for fitment to automobiles. The appellant does not dispute that it presently owns the supplying companies Happich and Ymos. However, it states that this was not the case until at least five years after the alleged instances of public prior use took place. The appellant states that an attempt had been made to obtain information directly from the automobile manufacturers to which the parts were supplied but this had been unsuccessful.

6.3 The Board finds the appellant's explanation for the reasons behind the late filing plausible and there is nothing which points towards negligence or an abuse of the procedure. The Board therefore takes the view that the circumstances in this case do not justify a departure from the normal principle that each party shall bear its own costs.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for apportionment of costs is rejected.

The Registrar:

The Chairman:

A. Vottner

S. Crane