

Decision of Technical Board of Appeal 3.2.03 dated 23 March 2006**T 1040/04 - 3.2.03**

(Language of the proceedings)

Composition of the board:

Chairman: U. Krause

Members: Y. Jest

J. Seitz

Patent proprietor/Respondent: Unilin Beheer B.V.

Opponent/Respondent: Berry Finance N.V.

Opponent/Intervening party: ROYSOL

Opponent/Party as of right: Otger Terhürne Holzwerke GmbH & Co. KG

Headword: Floor covering/UNILIN

Article: 76(1), 100(c) EPC

Keyword: "Amendment of a patent granted on a divisional application -Referral to the Enlarged Board of Appeal"

Headnote

The following question is referred to the Enlarged Board of Appeal:

Can a patent which has been granted on a divisional application which did not meet the requirements of Article 76(1) EPC because at its actual date of filing it extended beyond the content of the earlier application, be amended during opposition proceedings in order to overcome the ground of opposition under Article 100(c) EPC and thereby fulfil said requirements?

Summary of facts and submissions

I. According to the decision dated 2 August 2004 the Opposition Division maintained European Patent No. 1 024 234 in amended form on the basis of the fourth auxiliary request with the following claim 1, which had been amended, with respect to claim 1 as granted, by the addition of the passages in bold and by the omission of the text in square brackets:

"Floor covering,

(a) consisting of hard floor panels (1)

(b) which are rectangular, i.e. elongated or square, and

(c) which have a first pair as well as a second pair of opposite sides (2-3, 26-27),

(d) said panels (1) at least at the edges of the second pair of opposite sides, being provided with coupling parts (4-5, 28-29), substantially in the form of a tongue (9-31) and a groove (10-32),

(e) whereby these coupling parts (4-5, 28-29) are provided with integrated mechanical locking means (6) comprising respective locking elements (11-13, 33-34, 46-47) extending in the longitudinal direction of the related edges,

- (f) which locking means (6) are made in one piece with the core (8) of the panels (1),
- (g) whereby, in the coupled condition of two of such panels (1), the coupling parts (4-5, 28-29) together with said locking means (6) provide a locking
- g1) in a direction perpendicular to the plane of the panels (1),
- g2) as well as in a direction perpendicular to the coupled edges and parallel to the plane of the panels (1),
- (h) whereby the basic material of the floor panels (1), in other words, the material of the core (8), [substantially] consists of HDF-board or MDF-board,

wherein

(i) said coupling parts and locking means (6) being formed out of said core (8) are realized in such a manner that two of these floor panels (1) can be engaged by shifting them laterally in a substantially planar fashion towards each other, thereby providing

(i1) a snap-together connection

(i2) in which said locking elements grip behind each other and

(i3) in which the coupling parts (4-5,28-29) and the locking means (6) provide for an interlocking, free from play, according to all the directions in the plan which is situated perpendicular to the panel edges, so that the subsequent development of gaps on the upper surface of the floor covering is excluded."

The description of the patent according to the fourth auxiliary request, as maintained by the Opposition Division, contained amendments, one of which was the deletion of paragraph [0016].

II. The disputed patent was granted on the basis of European divisional patent application No. 00 201 515.4 filed in accordance with Article 76 EPC on the basis of earlier European patent application No. 97 928 169.8 filed on 7 June 1997 and published as WO-A-97/47834.

The earlier EP application No. 97 928 169.8 claimed the following priorities:

BE 9600527 filed on 11 June 1996, and

BE 9700344 filed on 15 April 1997.

III. Grant of the patent was opposed by opponents OI, OI' and OII - OVII. At the conclusion of the opposition proceedings, the Opposition Division found that the grounds of opposition, namely insufficient disclosure (Article 100(b) EPC), added subject-matter (Article 100(c) EPC) and lack of novelty and inventive step (Article 100(a) EPC), did not prejudice the maintenance of the patent in amended form.

During the assessment of novelty and inventive step, the Opposition Division further found that the invention as claimed was entitled, not only to the second claimed priority (BE 9700344 of 15 April 1997), but also to the first claimed priority (BE 9600527 filed on 11 June 1996).

IV. An appeal was lodged against this decision by the Proprietor of the patent. Appeals were also filed by Opponents OI, OI', OII, OV, OVI, OVII. However, during the appeal proceedings Opponents OI, OI', OII, OIII, OV and OVI withdrew their opposition.

A further opposition was filed by an intervening party (OVIII) during the appeal procedure in accordance with Article 105 EPC.

To summarise, the parties remaining in the appeal proceedings and the corresponding relevant dates are:

- Appellant I: Proprietor;

Appeal filed on 4 October 2004, appeal fee paid on the same day and the statement of the grounds of appeal received on 9 December 2004;

- Appellant II: Opponent OVII:

Appeal filed on 4 August 2004, appeal fee paid on the same day and the statement of grounds of appeal received on 10 December 2004;

- Intervening Party: Opponent OVIII:

Intervention filed on 14 February 2006, appeal and opposition fees paid on the same day and the statement of grounds of appeal received on the same day;

- Party as of right: Opponent OIV.

V. Appellant I requested that the decision under appeal be set aside (except for the fifth auxiliary request) and that the patent be maintained on the basis of the main request or one of four auxiliary requests filed on 9 December 2004, or of one of the sixth or seventh requests filed on 9 March 2006, or of one of the auxiliary requests eight to eleven filed on 21 February 2006.

According to the fifth auxiliary request, Appellant I requested that the appeal of Appellant II be dismissed.

VI. Claim 1 of the main request has the following wording:

"Floor covering,

(a) consisting of hard floor panels (1)

(b) which are rectangular, i.e. elongated or square, and

(c) which have a first pair as well as a second pair of opposite sides (2-3, 26-27),

(d) said panels (1) at least at the edges of the second pair of opposite sides, being provided with coupling parts (4-5, 28-29), substantially in the form of a tongue (9-31) and a groove (10-32),

(e) whereby these coupling parts (4-5, 28-29) are provided with integrated mechanical locking means (6) comprising respective locking elements (11-13, 33-34, 46-47) extending in the longitudinal direction of the related edges,

(f) which locking means (6) are made in one piece with the core (8) of the panels (1),

(g) whereby, in the coupled condition of two of such panels (1), the coupling parts (4-5, 28-29) together with said locking means (6) provide a locking

g1) in a direction perpendicular to the plane of the panels (1),

g2) as well as in a direction perpendicular to the coupled edges and parallel to the plane of the panels (1),

(h) whereby the basic material of the floor panels (1), in other words, the material of the core (8), consists of HDF-board or MDF-board,

characterized in that

(i) said coupling parts and locking means (6) being formed out of said core (8) are realized in such a manner that two of these floor panels (1) can be engaged by shifting them laterally in a substantially planar fashion towards each other, thereby providing

i1) a snap-together connection

i2) in which said locking elements grip behind each other and

i3) in which the coupling parts (4-5,28-29) and the locking means (6) are configured such that the panels (1) in coupled condition, at the related edges, are connected in a manner free of play."

This claim is similar to claim 1 of the main request dated 8 June 2004, which had been refused by the Opposition Division, but with the difference that the term "substantially" has been deleted in the pre-characterising feature (h).

The Opposition Division considered that the main request dated 8 June 2004 comprised subject-matter, which extended beyond the content of the earlier application as filed, contrary to Article 76(1) EPC. This objection was then deemed to be overcome by the amendments (mainly in feature i3) made to claim 1, which was submitted as the fourth auxiliary request and was duly maintained by the Opposition Division (see paragraph I above).

VII. Appellant II and the Intervening Party requested that the decision under appeal be set aside and that the patent No. 1 024 234 be revoked.

Appellant II further requested that the proceedings be suspended until the Enlarged Board of Appeal (EBA) had reached a decision in pending case G 1/05.

VIII. During the oral proceedings held on 23 March 2006, the sole item of discussion was whether the filing of divisional European patent application No. 00 201 515.4 and the subsequent grant of patent No. 1 024 234 met the requirements of Articles 76(1) and 100(c) EPC respectively.

(a) Appellant II argued as follows:

The description of the divisional application as filed and of the patent as granted contained a relatively long paragraph ([0017] in the application as published and paragraph [0016] in the granted patent), which had been added to the description as filed in the earlier application WO-A-97/47834.

The added paragraph listed a large number of additional features of the invention, which were to be taken into consideration either in isolation or in any possible combination. Some of these combinations defined new embodiments, which had not been disclosed in the earlier application.

Additionally, the feature defined at column 3, lines 51 to 56 of the published divisional application (EP-A-1 024 234) relating to an angle (A) "different from 90 degrees", had no support in the earlier application WO-A-97/47834, where the same angle (A) had been limited to "smaller than 90 degrees" (see page 13, lines 13 to 16).

Since the referral under consideration in G 1/05 deals with the same type of deficiency with respect to Article 76(1) EPC, the proceedings should be suspended until the decision of the EBA is issued.

(b) Appellant I argued as follows:

Firstly, the objection under Article 76(1) EPC was not set out in the statements of grounds of appeal by the Opponents. It was only raised because of the referral G 1/05, which occurred a year later. This is a new objection and a new ground of appeal and as such should not be allowed into the proceedings.

Secondly, the feature of defining an angle different from 90 degrees does not provide the skilled person with new information, which cannot be derived from the earlier application. An angle greater than 90 degrees would not allow a lateral snap-in connection or an angling engagement of the panel couplings, so that for the skilled person "different" clearly means less than 90 degrees. In addition, even if angle (A) were greater than 90 degrees, there would always be an angle smaller than 90 degrees between the horizontal plane and the tangent line (L), i.e. the complementary angle to (A).

Appellant I emphasised that if the Board were to consider the possibility of a deficiency with respect to Article 76(1) EPC, mere suspension of the appeal procedure would not be appropriate in view of the question before the EBA in G 1/05, but rather, that an additional question should be referred to the EBA.

(c) After the debate on the issue related to Articles 76(1) and 100(c) EPC had been closed and after due deliberation the Board announced that:

"With regard to the pending referral in case G 1/05 it will of its own motion refer a further question of law to the Enlarged Board of Appeal in respect of an already granted patent."

(d) The other formal and substantive issues to the appeal have not been considered at this stage of the appeal procedure.

Reasons for the decision

1. The appeals comply with the provisions of Articles 106 to 108 EPC and of Rules 1(1) and 64 EPC and are, therefore, admissible.

The intervention complies with the provisions of Article 105 EPC and is also admissible. This was not contested by the parties to the proceedings.

2. The issue of Article 76(1) EPC has already been discussed during the opposition proceedings and concerned both the claims and the description.

It appears from the annex to the summons to attend oral proceedings issued by the Opposition Division on 13 February 2004 (see especially item 5 on pages 4 and 5) that paragraph [0016] of the description of the patent as granted was, along with other parts of the patent, deemed to contain fresh subject-matter over the earlier application.

By letter dated 8 June 2004, in reply to this summons, the proprietor deleted paragraph [0016].

In its decision, the Opposition Division further objected that claim 1 of the main request covered embodiments wherein a visible gap could be present after initial laying of the floor panels (see for instance the last paragraph of item 2.1.2 of the reasons, page 13 of the decision), and that these embodiments would not have solved the problem defined on page 3 of the description of the earlier application.

The Opposition Division reasoned that feature i3) of claim 1:

"in which the coupling parts (4-5,28-29) and the locking means (6) are configured such that the panels (1) in coupled condition, at the related edges, are connected in a manner free of play"

made no mention of the absence of gaps and the prevention of their subsequent development.

It is apparent from the decision as a whole, that the Opposition Division considered that in order to meet the requirements of Article 76(1) EPC, independent claim 1 needed to include in the definition of the invention feature i3), as set out in claim 1 of the fourth auxiliary request.

Feature i3) reads:

"in which the coupling parts (4-5,28-29) and the locking means (6) provide for an interlocking, free from play, according to all the directions in the plan which is situated perpendicular to the panel edges, so that the subsequent development of gaps on the upper surface of the floor covering is excluded."

3. During the appeal proceedings, the question arose as to whether a granted patent based on a divisional application could be amended in the opposition phase in order to overcome the objection under Article 100(c) in combination with Article 76(1) EPC. This issue became of relevance as a consequence of the referral to the

Enlarged Board of Appeal (G 1/05, see decision T 39/03 - 3.4.2 dated 26 August 2005), which raises in question (1) a similar point of law, but in the context of examination proceedings.

3.1 In the present case, the facts relating to the requirements of Article 76(1) EPC are as follows.

During the opposition procedure, paragraph **[0016]** of the description of the patent as granted was deleted.

This paragraph was part of the divisional application, as filed, (see paragraph **[0017]** of the published application) but was not present in the earlier application WO-A-97/47834.

For the following reasons, the Board considers that there is at least one feature present in said paragraph, which defines subject-matter extending beyond the content of the earlier application.

The feature concerned is the angle (A), which is defined as being between the tangent line (L) determined by the contact surfaces of the locking elements and the underside of the floor panels; this angle is illustrated in figures 7, 9 and 23. In paragraph **[0017]**, column 3, lines 51 to 56 of the published divisional application (EP-A-1 024 234), and in paragraph **[0016]**, column 3, lines 50 to 55 of the patent specification, the value of angle (A) is defined as being "different from 90 degrees", whereas in the earlier application (WO-A-97/47834), the angle (A) was either defined as being smaller than 90 degrees (embodiment of figures 5 to 7 and for instance page 13, line 16, and page 14, lines 27 to 29), or as being 90° (embodiment of figure 8).

The extended subject-matter thus resides in the new embodiments having an angle (A) greater than 90 degrees.

3.2 The arguments of Appellant I, that the feature defining an angle different from 90 degrees did not provide the skilled person with new information, are not convincing. As observed by Appellant II, it would seem possible to permit a lateral snap-in connection or an angling engagement of the panel couplings with an angle (A) greater than 90 degrees.

Accordingly, the skilled person would not implicitly and automatically read "different from 90 degrees" as meaning "smaller than 90 degrees". Since angle (A), as illustrated in figures 7, 9 and 23, is always shown as the angle formed in counter clockwise direction between the horizontal plane and the tangent line (L), there is no room for interpretation of this definition as suggested by Appellant I by referring to the complementary angle.

3.3 The Board therefore concludes that the requirements of Article 76(1) EPC were neither met by the divisional application at its filing date, nor by the patent as granted.

4. This conclusion is relevant to the maintenance of the patent in amended form according to any one of the requests filed by Appellant I irrespective of any other possible objections under Article 76(1) EPC concerning the claims or other parts of the description.

5. Referral

5.1 Having regard to the wording of Article 100 EPC which reads:

"Opposition may only be filed on the grounds that:

(a) ...

(b) ...

(c) the subject-matter of the European patent extends beyond the content of the application as filed, or if the patent was granted on a divisional application ..., beyond the content of the earlier application as filed."

the infringement of this provision, which corresponds exactly to the wording of Article 76 EPC, constitutes *expressis verbis* a ground of opposition to a European patent granted on a divisional application.

In G 1/95 (OJ EPO 1996, 615, see paragraphs 4.1 and 4.2 of the Reasons) the Enlarged Board of appeal construed the function of Article 100 EPC as being to provide, within the framework of the Convention, a limited number of legal bases, i.e. a limited number of objections on which an opposition can be based.

All grounds for opposition mentioned in Article 100 EPC have their counterpart in other Articles of the EPC, which have to be met during the procedure up to grant.

In particular, the grounds of opposition in Article 100(c) EPC relates to a single separate and clearly delimited legal basis on which an opposition can be based, i.e. unallowable amendment before grant.

On the other hand, Article 123 EPC, in conjunction with Rule 57a EPC, allows the proprietor to amend a European patent after it has been granted, provided that the amendment is occasioned by one of the grounds of opposition specified in Article 100 EPC, i.e. including the aforesaid grounds set out in Article 100(c) EPC.

A purely syllogistic approach would then lead to the logical conclusion, from the combination of Article 100 and Rule 57a EPC, that the proprietor may amend his patent, in order to overcome the objection that the divisional application on which it was granted extended beyond the content of the earlier application as filed. This right has been constantly acknowledged and put into practice by the Boards of Appeal.

5.2 Nevertheless the following first question of law was referred to the Enlarged Board of Appeal by Board 3.4.02 in their decision T 39/03 dated 26 August 2005:

"(1) Can a divisional application which does not meet the requirements of Article 76(1) EPC because, at its actual filing date, it extends beyond the content of the earlier application, be amended later in order to make it a valid divisional application?"

5.3 Although this referral in G 1/05 deals with the corresponding deficiency in respect of the requirements of Article 76(1) EPC, it applies only to examination proceedings.

It is in the interest of the proper administration of justice not to prejudge in any way a future decision of the Enlarged Board. It is also not appropriate to suspend the appeal proceedings until said decision had been reached, since the possibility that the first question in G 1/05 (above) be answered in the negative cannot be excluded. If that were to be the outcome of G 1/05, the present Board would remain confronted with the important point of law of the possible prohibition on amending a granted patent, i.e. a title deed to intellectual property, as compared with an application. To answer the question while the aforesaid referral is still pending would, in fact, amount to an usurpation of the competence "ratione legis" of the EBA.

5.4 The present Board therefore refers the following question to the Enlarged Board of Appeal of its own motion.

Order

For these reasons it is decided that:

The following question is referred to the Enlarged Board of Appeal:

Can a patent which has been granted on a divisional application which did not meet the requirements of Article 76(1) EPC because at its actual date of filing it extended beyond the content of the earlier application, be amended during

opposition proceedings in order to overcome the ground of opposition under Article 100(c) EPC and thereby fulfil said requirements?