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**Datasheet for the decision
of 16 November 2007**

Case Number: T 1424/04 - 3.2.01

Application Number: 97301048.1

Publication Number: 0792766

IPC: B60J 10/06

Language of the proceedings: EN

Title of invention:

Exterior decorative surround molding module

Patentee:

THE STANDARD PRODUCTS COMPANY

Opponent:

Metzeler Automotive Profile Systems North America

Headword:

-

Relevant legal provisions:

EPC Art. 54, 56

Keyword:

"Novelty (yes)"
"Inventive step (yes)"

Decisions cited:

T 0848/93

Catchword:

-



Case Number: T 1424/04 - 3.2.01

D E C I S I O N
of the Technical Board of Appeal 3.2.01
of 16 November 2007

Appellant: Metzeler Automotive Profile Systems
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
2 November 2004 concerning maintenance of
European patent No. 0792766 in amended form.

Composition of the Board:

Chairman: S. Crane
Members: C. Narcisi
G. Weiss

Summary of Facts and Submissions

- I. The European patent No. 792 766 was maintained in amended form by the interlocutory decision of the Opposition Division posted on 2 November 2004. Against this decision an appeal was filed by the Opponent on 10 December 2004 and the appeal fee was paid at the same time. The statement of grounds of appeal was filed on 25 February 2005.
- II. Oral proceedings were held on 16 November 2007. The Appellant requested the revocation of the patent in its entirety. The Respondent requested the dismissal of the appeal as unfounded. The request that the appeal be dismissed as inadmissible was withdrawn.

Claim 1 reads as follows:

"A method for installing and attaching a glass run channel (26) and surround molding (24) to a vehicle (23) having a window aperture for a translational glass pane (104), the method comprising:
providing a module (20) having a one-piece surround molding (24) fully surrounding said window aperture and having a belt line portion providing a channel, and a glass run channel (26) secured to said surround molding (24) for guiding and supporting said translational glass pane (104);
placing said belt line portion of said surround molding (24) over a flange (62) of said vehicle (23), said flange (62) generally defining said window aperture, such that said flange (62) is positioned within said channel provided in said belt line portion of said surround molding (24);

rotating said module (20) toward said vehicle (23) about a line created by contact between said flange (62) and said channel of said belt line portion; and fastening said module (20) to said vehicle (23) using a means for fastening said surround molding (24) to said flange (62) on said vehicle (23); said fastening means being a fastening means of said module (20), thereby producing a decorative surround molding module (20) for said vehicle having said window aperture, said window aperture having a perimeter and the surround molding (24) defining said perimeter of the window aperture, and the glass run channel (26) guiding and supporting the translational glass pane (104)."

III. The arguments presented by the Appellant may be summarized as follows:

The subject-matter of claim 1 lacks novelty over prior art E5 (EP-A-524 447). To begin with, contested method claim 1 essentially includes four separate steps, a first step of providing a module comprising a first rigid component and a second resilient component, a second step of positioning said module on said flange, a third step of rotating said module towards said vehicle, and a fourth step of fastening said module to said flange of the vehicle. These four steps are all known from E5, as can be seen for instance from column 1, lines 36-47 and column 4, lines 12-43. Further, the structural features of the claimed subject-matter which are regarded as being essential for performing the method are that said module is constituted by one piece, that a channel is formed in the module's frame, that a flange is provided on the vehicle to be inserted into said channel and that

fastening means are included on said module for fixing said module on the vehicle's flange. All these structural features are clearly disclosed in E5 which shows with reference to the figures and the corresponding parts of the description a one-piece module 6 consisting of structural units 7 and 8, a channel formed in frame portion 19 of module 6, a vehicle flange 4 and fastening elements 31,44 for fixing said module to the vehicle's flange (E5, column 7, lines 34-47). Hence all features of claim 1 are known from E5. Even if the wording "one-piece surround molding" were construed as implying a constructional element integrally made of a single material this would not make the subject-matter of method claim 1 novel over E5 since this feature evidently pertains exclusively to the product (module) and it is not necessary for performing the claimed method. This feature has thus to be disregarded when assessing the novelty of the subject-matter of method claim 1 in order to comply with the clarity requirements of Article 84 EPC.

Even if regarded as new, the subject-matter of claim 1 is in any case not inventive over E5. In particular, considering that the object of E5 is to obtain a window frame module which can easily be mounted on the vehicle (E5, column 1, lines 24-28) the skilled person would go one step further in this direction and would envisage providing a window frame which has a simpler structure with respect to E5. The skilled person would then realize that the window frame module 6 of E5 can be produced as a single one-piece frame which defines the window opening in the vehicle and he would thus arrive in an obvious manner to the claimed subject-matter without any inventive steps being involved.

IV. The arguments presented by the Respondent may be summarized as follows:

The structural unit 6 of E5 could possibly in some general sense be called a module, however even in this case it is self-evidently not a module provided in accordance with claim 1. The structural unit 6 of E5 has a complex structure and is provided by a series of steps which do not parallel the steps specified in claim 1 and even the finished structure of the structural unit 6 is clearly not that required by claim 1. Moreover, the clamps 44 and the screws 31 of E5 are not part of the unit structure 6 contrary to the requirement of claim 1 that "said fastening means being a fastening means of said module". Insofar as the Appellant considers said one-piece surround molding of claim 1 as being formed exclusively by the structural unit 8 of E5 and not by the combination of the two structural units 7 and 8 it is noted that again the structural unit 8 does not constitute a one-piece surround molding within the meaning of claim 1 since it consists of several different parts. Moreover, the structural unit 8 cannot be considered as being equivalent to the one-piece surround molding of the invention since it is formed of resilient elastic material (E5, column 5, lines 27-31) and does not have the necessary structural rigidity required by a window frame module. Such a rigidity is in fact imparted to the module 6 of E5 solely by the structural unit 7 and not by the structural unit 8. For these reasons the subject-matter of claim 1 is new over E5. This subject-matter is also inventive over E5 since this fails to disclose, suggest or in any way hint

towards the provision of a module as required by claim 1. The aim of E5 is merely to provide a simplified way of assembling said window frame module onto the vehicle. No mention is made in E5 of possible measures directed at modifying for any reason whatsoever the structure of the module 6. Consequently it appears that the skilled person could not arrive at the claimed subject-matter without the benefit of hindsight.

Reasons for the Decision

1. The appeal meets the requirements of Articles 106 to 108 EPC in conjunction with Rule 64 EPC and is therefore admissible.

2. The novelty of the subject-matter of claim 1 over the disclosure of prior art E5 essentially depends on whether the window frame module 6 of E5 can be considered as being a "one-piece surround molding" within the meaning of claim 1. In the judgement of the Board the term "one-piece surround molding" implies a constructional part which is produced essentially by molding appropriate material to form a single integral unit which by itself is capable of fully surrounding the window aperture. This clearly does not include constructional parts which are separately formed during separate steps and put together only afterwards as this is evidently the case for the structural unit 6 of E5 consisting of separate units 7 and 8 (E5, column 5, lines 27-31), where constructional unit 8 itself further comprises three distinct constructional elements 17, 18 and 19 (E5, column 5, lines 55-58).

Therefore, even if the elements 17 and 19 (E5, column 6, lines 30-40) and possibly even 18 (E5, column 7, lines 15-21) are stated in E5 to be connected together as if they were integrally made, nevertheless this is, as seen above, undoubtedly a different forming process from the one implied by a "one-piece surround molding" and also results in a different product structure. Consequently, the window frame module 6 of E5 cannot be regarded as being equivalent to the "one-piece surround molding" of claim 1.

Moreover, the window frame module 6 of E5 cannot be regarded as being equivalent to the "one-piece surround molding" of claim 1 for the further reason that it includes the structural unit 8, which itself comprises the glass run channel 18 (E5, column 5, lines 55-58), whereas according to claim 1 the glass run channel 26 is not part of the "one-piece surround molding" but is merely "secured" thereto.

In conclusion the subject matter of claim 1 is new over E5 (Article 54 EPC).

3. It is noted that the above conclusions would not be any different if the structural unit 8 of E5, instead of the module 6 of E5, were to be considered by way of argument as being equivalent to the "one-piece surround molding" of claim 1. In fact, in the first place, as already mentioned above (see point 2) the "one-piece surround molding" of claim 1 does not include the glass run channel, whereas the structural unit 8 of E5 clearly includes the glass channel. In the second place, the structural unit 8, since it is made of resilient elastic material (E5, column 5, lines 29-31) does not inherently have a sufficient structural rigidity and

stability for it to define the perimeter of the window aperture and to be mounted on the vehicle by rotating it toward the vehicle as required by claim 1. Indeed, in order to make this possible, a sufficient structural rigidity has to be imparted to the structural unit 8 according to E5 by the further structural unit 7 (E5, column 5, lines 27-29) to thus form the window frame module 6. Therefore, it has again to be concluded that no structural unit equivalent to the "one-piece surround molding" of claim 1 is disclosed in E5, thus confirming that the subject-matter of claim 1 is novel over E5.

The Appellant's further contention based on Article 84 EPC that features of a method claim not related to the method itself should be disregarded when assessing novelty of the claimed subject-matter is not acceptable in the Board's view and is contrary to established case law of the Boards of Appeal (see for instance the decision T 848/93, not published in OJ EPO). Following the Appellant's argumentation would lead to method claims being construed in a largely arbitrary manner, thus casting doubts and uncertainty on the actually claimed features and on the scope of protection of the claimed subject-matter. In fact, it would prove to be very difficult if not altogether impossible, as for instance concerning the present invention, to decide in each specific case which features are related to the claimed method and which are not. In any case, with regard to present claim 1 it is noted that the property of being molded in one piece undoubtedly improves the ease of handling and facilitates the installation of the window frame module on the vehicle. Thus, regarding

this feature as being irrelevant to method claim 1 would clearly be arbitrary and erroneous.

4. For the assessment of inventive step the central question is whether the skilled person in view of closest prior art E5 would envisage providing a window frame module comprising a "one-piece surround molding" and a glass run channel secured thereto, said two components respectively having the already mentioned rigidity and elasticity properties. Considering the module 6 of E5 and both its structural units 7 and 8 it was already noted that the structural unit 8 comprises three components 17,18 and 19 made of resilient elastic material, where the belt line portion 19 includes the channel required by claim 1 for mounting the module 6 on the vehicle and the glass run channel 18 acts as a flexible seal contacting the window pane. In order to arrive at the claimed subject matter the skilled person would thus have to split up the structural unit 8 and to include its sub-units 17 and 19 into the structural unit 7, while securing glass run channel 18 to the structural unit 7. These technical measures, which would additionally entail the choice of a different material for the structural sub-units 17 and 19, clearly involve a radical change in the structure of the module 6 of E5 which is, as already described, of a very specific kind. This structure is moreover presented in E5 as being the essence of its technical teaching distinguishing the module of E5 from the prior art and this is reflected by the inclusion of said structure of the module 6 in the characterizing portion of claim 1 of E5. On these premises the Board sees no reason and no incentive for the skilled person to fundamentally modify the technical teaching of E5 in

order to arrive at the subject-matter of claim 1 according to the invention. Even if, with the benefit of hindsight, the module's structure according to claim 1 might appear merely as one among several possible alternatives to the structure disclosed in E5, nevertheless there is a priori no convincing and compelling reason why the skilled person would embark upon the undertaking of arriving at the subject-matter of claim 1 by a series of cumbersome technical measures starting from the technical teaching of E5. It is therefore concluded that the subject-matter of claim 1 is not obvious in view of the cited prior art (Article 56 EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Vottner

S. Crane