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Datasheet for the decision of 18 November 2008

Case Number: T 1757/06 - 3.2.03

Application Number: 98500018.1

Publication Number: 0933487

IPC: E04B 7/20

Language of the proceedings: EN

Title of invention:
Insulation panel for attachment of tiles

Patentee:
Poliglas, S.A.

Opponent:
THE DOW CHEMICAL COMPANY
BASF SE

Headword:
-

Relevant legal provisions:
EPC Art. 56
RPBA Art. 13(1)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Inventive step (yes)"
"Late-filed document admitted (no)"

Decisions cited:
-

Catchword:
It is expected that companies of the same commercial group would have knowledge of their own patent documents (see point 4 of the reasons).

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1757/06 **-** 3.2.03

D E C I S I O N
of the Technical Board of Appeal 3.2.03
of 18 November 2008

Appellant: (Opponent)
BASF SE
Patentabteilung - C6
Carl-Bosch-Strasse 38
D-67056 Ludwigshafen (DE)

Representative:
-

Respondent: (Patent Proprietor)
Poliglas, S.A.
Ctra. de Barcelona, 66
08210 Barbera del Valles
Barcelona (ES)

Representative:
HOFFMANN EITLE
Patent- und Rechtsanwälte
Arabellastrasse 4
D-81925 München (DE)

Other Party: (Opponent)
THE DOW CHEMICAL COMPANY
P.O. BOX 1967
Midland, MI 48641 - 1967 (US)

Representative:
Fleischer, Holm Herbert
polypatent
Postfach 40 02 43
D-51410 Bergisch Gladbach (DE)

Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 12 September 2006 concerning maintenance of European patent No. 0933487 in amended form.

Composition of the Board:

Chairman: U. Krause
Members: G. Ashley
I. Beckedorf

Summary of Facts and Submissions

I. European patent EP-B-0 933 487 concerns an insulation panel for attaching roofing tiles. Grant of the patent was opposed by The Dow Chemical Company (Opponent OI) and BASF Aktiengesellschaft (Opponent OII) on the basis that the claimed subject-matter was not new and did not involve an inventive step (Article 100(a) EPC), and that it extended beyond the content of the application as originally filed (Article 100(c) EPC).

II. The Opposition Division concluded that the set of claims filed during the oral proceedings as the patent proprietor's main request met the requirements of the EPC, and consequently decided that the patent should be maintained on this basis; the decision was posted on 12 September 2006.

III. On 16 November 2006, Opponent OII (Appellant) filed notice of appeal against this decision. The appeal fee and a statement setting out the grounds of appeal were received by the European Patent Office on the same day.

IV. In accordance with Article 15(1) of the Rules of Procedure of the Boards of Appeal, the Board issued a preliminary opinion, together with a summons to attend oral proceedings, setting out its view on inventive step. The oral proceedings were duly held on 18 November 2008.

V. Requests

The Appellant and Opponent OI (who is a party as of right to the appeal proceedings) request that the

decision under appeal be set aside and European patent No. 0 933 487 be revoked.

The main request of the Respondent (Patent Proprietor) is that the appeal be dismissed; alternatively, that in setting aside the decision under appeal, the patent be maintained on the basis of claim 1 filed as an auxiliary request with the letter dated 18 September 2008.

VI. Claims

Claim 1 of the Respondent's main request, which was also the subject of the opposition proceedings, reads as follows:

"1. Insulation panel for the attachment of tiles (4) of the type which are coupled to the tiling roof (1), wherein the panel is configured by a body which includes:

1) horizontal parallel tie-down grooves (3) for the tiles (4), with a module, equidistant and intended to receive and couple the tiles (4);

2) parallel vertical tie down grooves (2) for tiles (4), of another module, which are perpendicular to the horizontal tie-down grooves (3), having an equidistant arrangement and being placed at different distances to the corresponding ones between the horizontal grooves(3) and

3) vertical parallel ventilation grooves (7), wherein the vertical parallel ventilation grooves (7) form a

lattice work (5) together with horizontal parallel ventilation grooves (6) wherein the lattice work (5) is included between the horizontal tie-down grooves (3) and the vertical tie-down grooves (2); wherein both the vertical parallel ventilation grooves (7) and horizontal parallel ventilation grooves (6) are smaller than the horizontal parallel tie-down grooves (3) and the parallel vertical tie-down grooves (2) and wherein the horizontal parallel ventilation grooves (6) and vertical parallel ventilation grooves (7) are uniformly distributed below the location of the tiles (4) and constitute locations for the attachment of mortar for the tiles (4) which are adjustable by this means."

Dependent claim 2 defines a preferred embodiment of the insulation panel of claim 1.

VII. Prior Art

The following documents are of relevance:

D1: DE-A-3038490
D7: DE-A-3030841
D10: EP-A-0516012

Documents D1 and D7 were cited during the opposition proceedings. D10 was submitted by Opponent OI with the letter of 18 September 2008.

VIII. Submissions of the Parties

The Appellant and Opponent OI contend that the claimed subject-matter lacks an inventive step in the light of

either D7, D1 or D10. Their arguments and those of the Respondent are summarised as follows.

(a) Document D7

The Appellant argued that D7 discloses an insulation panel having horizontal groves (11) and vertical grooves (17). Although the former are said to be for attaching tiles and the latter for draining water, either type can be used for attaching tiles or for ventilation; the function of the grooves is not a feature of the insulation panel *per se*, but merely depends on how the grooves are used. In addition, neither claim 1 nor the description of the contested patent provide a definition of the sizes of the grooves, so this is incapable of providing a distinguishing feature. Opponent OI emphasised that claim 1 is only directed to insulation panel, hence the roof construction, in terms of the tiles and their means of attachment, is not part of the invention.

Compared with D7, the subject-matter of claim 1 therefore differs only in that there is an additional set of horizontal parallel grooves, which form an additional lattice work.

Starting from D7, the objective problem is to improve the versatility of the panel by enabling it to be used with tiles of different sizes. This problem is solved by the obvious step of providing extra horizontal grooves, the spacing of which can be determined by reference to the size of commercially available tiles. Consequently, the claimed subject-matter lacks an inventive step.

The Respondent acknowledged that the insulation plate of D7 has horizontal grooves (11) and broader vertical water channels (17). However, D7 discloses neither a lattice of smaller sized grooves within larger grooves, nor vertical tie-down grooves having a different spacing to the horizontal tie-down grooves. The tie-down grooves of D7 are not dimensioned so that they can receive and couple roofing tiles, rather they receive profiled metal strips, and it is these that are used for anchoring the tiles.

The Respondent submitted that the problem addressed in the contested patent is not as defined by the Appellant, but concerns the improvement of both versatility and ventilation.

Although D7 addresses the problem of providing an insulation panel for attaching tiles of different sizes, this is achieved by spacing the tie-down grooves relatively close together. According to the present invention, the horizontal and vertical spacing of the tie-down grooves is different, meaning that the insulation panel can be rotated through 90° in order to accommodate tiles of different sizes. This is a different solution to that taught in D7.

Compared with the water channels of D7, the ventilation grooves referred to in claim 1 are for the removal of moist air, thereby preventing condensation, and are therefore smaller and form a lattice work. The water channels (17) of D7 are not ventilation grooves in this sense, as their purpose is to collect and remove water. Figure 2 of D7 shows that the tiles are spaced away

from the surface of the insulating plate. Given that there is a relatively large space between the tiles and the insulating plate, neither water channels (17) nor grooves (11) would function as ventilation grooves. The conclusion is that D7 does not disclose an insulation plate having a lattice of ventilation grooves.

Consequently, the system of D7 for attaching tiles to insulating panels is so utterly different to that of the contested patent, that starting from this document, the subject-matter of claim 1 is not obvious.

(b) Document D1

The Respondent and Opponent OI submitted that D1 is a relevant starting point for the assessment of inventive step for the following reasons. D1 concerns wall insulation panels, however this is within the field of building technology, and hence would be taken into consideration by the skilled person, especially as claim 1 is directed to insulation panels rather than a roof construction. In addition, D1 addresses the same problems as set out in the contested patent, namely ventilation and the attachment of the tiles, in particular the problem of using mortar to fix tiles to foamed panels, and this problem is specifically mentioned in dependent claim 2 of the contested patent.

D1 discloses an insulation panel having a vertical and horizontal arrangement of large and small grooves (4 and 4' respectively). These grooves provide a means for ventilation and for attaching the tiles (paragraph bridging pages 6 and 7).

The subject-matter of claim 1 thus differs only in that the relative distance between the large horizontal and vertical grooves is specified. This, however, is an obvious measure for the skilled person, who merely has to adapt the distance to the tiles.

The Respondent argued that the insulation panels of D1 have grooves in both sides. On the one side they are used for attaching the panels to a wall, on the other they are used for adhering a layer of plaster; they are not used for the attachment of tiles. D1 does not disclose a module of tie-down grooves and there is no lattice of smaller grooves within larger grooves in the sense of the contested patent.

There is no indication in D1 how it would be possible to attach tiles of different sizes. Hence a solution to the problem of improving the versatility of the panel is not obvious from D1.

(c) Document D10

Document D10 was submitted during the appeal proceedings by Opponent OI. D10 is a patent publication disclosing the subject-matter of a sales brochure that had been submitted by Opponent OI during the oral proceedings before the Opposition Division, but which had not been admitted into the proceedings. The patent attorney for Opponent OI argued that he had only recently been made aware of the document and, given the high relevance of the document, it should now be taken into consideration.

D10 discloses an insulation panel having ventilation grooves and anchoring (tie-down) grooves for tiles; the ventilation grooves are described as being smaller than the anchoring grooves (column 2, lines 10 to 27). Whether the grooves are actually used for anchoring or ventilation depends on the types of tiles, for example metal tiles (as in D7) require only narrow grooves. Since the skilled person is fully aware that differently sized tiles require different anchoring distances, ranging typically from 130 mm to 1900 mm, adaption of the distance between the tie-down grooves is an obvious measure. Hence the solution to the objective problem faced by the skilled person starting from D7 is taught in D10.

The Respondent submitted that D10 was late-filed without proper justification for its tardiness, and given that D10 was a patent application from the same company as Opponent OI, it should have been presented earlier.

In any event, the Respondent argued that D10 is not *prima facie* relevant, as it does not disclose the features of vertical tie-down grooves and a lattice of small grooves within larger grooves. In addition, D10 teaches that the distance between the tie-down grooves is adapted according to the size of tiles being used. The idea of being able to attach tiles of different sizes to a panel without the need for modification is not mentioned in D10.

Reasons for the Decision

1. The appeal is admissible.

2. *Document D7*

2.1 D7 discloses an insulation panel to which roof tiles are attached and which has horizontal and vertical grooves. The vertical grooves (17) provide channels for the drainage of water (page 12, lines 14 to 21). The horizontal channels are narrower and form slits into which profiled metal strips (14) are slotted (Figures and page 11, lines 23 to 32).

According to D7, the roof tiles are attached to metal strips, which in turn are fixed to the insulating panels. In the case of ceramic tiles having spigots (21), the spigots rest against the metal strip, as shown in Figure 2; if flat plates or sheets (25) are used for the roof covering, then these can be screwed to the metal strips, as is also shown in Figure 2.

2.2 Claim 1 requires that the horizontal tie-down grooves are intended to receive and couple the tiles. This is not the case in D7. Firstly, the tiles of D7 are attached to the metal strips and are positioned on or above the insulation panel; in Figure 2, for example, the spigots of the tile (21) do not sit in a groove. Secondly, the horizontal grooves (11) are little more than slits designed for receiving thin metal sheet and thus are too narrow for spigots, so they are not suitable for directly receiving and coupling the tiles, contrary to the submission of the Appellant.

2.3 The insulation panel of claim 1 differs primarily from that of D7 in that it has horizontal grooves for accommodating spigots of roof tiles, thereby coupling the tiles to the panel. The claimed subject-matter is thus novel over D7 (Article 54 EPC).

2.4 Turning to inventive step, both the contested patent (paragraph [0002]) and D7 (page 6, lines 22 to 31) address the problem of attaching tiles of various sizes. However, the manner in which this problem is solved in the contested patent and D7 is completely different. In D7 the grooves (11) are relatively close together, meaning that the metal strips can easily be spaced apart according to the size of the tiles (page 6, line 33 to page 7, line 15). According to claim 1 the distance between the horizontal grooves is different to that between the vertical grooves, meaning that the insulation panel can be turned through 90° for accommodating tiles of a different size (paragraphs [0014] and [0015]).

The Respondent and Opponent OI are correct in saying that claim 1 is directed to an insulation panel and not a roofing system that includes the tiles. However, the insulation panel of D7 is not suitable for solving the problem according to the contested patent without further modification - at very least by enlarging grooves 11 so that they would be suitable for receiving the tiles. The skilled person reading D7 is given no incentive to make any such modifications, and thus, starting from D7, the subject-matter of claim 1 is not obvious and hence has an inventive step (Article 56 EPC).

3. *Document D1*

3.1 D1 discloses wall insulation panels rather than roof panels. The panels are provided with grooves on both sides (see Figures 1 to 3). On the side of the panel that is attached to the wall the grooves (4, 4') provide ventilation and, in the areas indicated by reference numeral 9 (Figure 2), narrower grooves serve to provide an anchor for attaching the panel by means of mortar. The grooves (3) on the front enable the panel to be covered by a layer of plaster.

3.2 As argued by Opponent OI, claim 1 is directed to an insulation panel, thus the insulation panel of D1 should be taken into consideration. Nevertheless, D1 does not lead the skilled person to the invention, and in particular to the subject-matter of claim 1.

Firstly, the pattern of grooves on both sides of the panel of D1 is symmetrical. This means that the distance between horizontal grooves does not differ from that between the vertical grooves, as required by claim 1, with the consequence that there is not the same flexibility for accommodating tiles of different sizes.

Secondly, the grooves of D1 have a dove-tail cross-section, the purpose of which is to enable the mortar or plaster to be bonded mechanically to the panels. There is no indication that these grooves would be suitable for receiving and coupling roof tiles.

Consequently, starting from D1, the insulation panel of claim 1 has an inventive step.

4. *Admissibility of D10*

4.1 During the oral proceedings before the Opposition Division, Opponent OI sought to introduce into the proceedings an Italian catalogue having the title "Thermanto System". Given that the document was filed late and that the Opposition Division had doubts about its content, it not being in an official language of the EPO, and was also uncertain as to whether it had been published in time, it exercised its discretion under Article 114(2) EPC not to admit it into the proceedings.

4.2 Two months before the oral proceedings before the Board of Appeal and about 4 years after the expiry of the time limit for filing an opposition under Article 99(1) EPC, Opponent OI submitted patent publication D10, which is said to disclose the same subject-matter as the Italian catalogue.

4.3 Opponent OI is the Dow Chemical Company of Midland, Michigan USA; D10 is a European patent application filed by Dow Italia of Milan, Italy.

It may well be the case that the patent attorney representing Opponent OI was only recently made aware of the existence of D10, and that Opponent OI and the applicant of D10 are separate corporate entities, but nevertheless it would be expected that companies of the same commercial group would have knowledge of their own patent documents.

Normally the attempt of a party to file at a late stage one of its own publications will fail, as this is considered to be an abuse of procedure. The Board would not go so far as to say that there has been an abuse of procedure in the present case, but the filing at a very late stage of a document that Opponent OI should have been aware of from the outset of the proceedings before the department of first instance cannot be condoned.

4.4 In addition, D10 is not considered to be a highly relevant document. On the plain reading of D10 (column 2, lines 14 to 30) the insulation panel has no vertical tie-down grooves, and the distance between the horizontal anchoring grooves is set according one particular tile size; there is no possibility of rotating the panel through 90° to accommodate different sized tiles.

4.5 For these reasons, the Board exercises its discretion in accordance with Article 13(1) of the Rules of Procedure of the Boards of Appeal not to admit D10 into the procedure.

5. *Auxiliary Request*

Given that the main request of the Respondent can be allowed, there is no reason to consider the auxiliary request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

A. Counillon U. Krause