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**Datasheet for the decision  
of 25 June 2009**

**Case Number:** T 1490/07 - 3.2.05

**Application Number:** 99200254.3

**Publication Number:** 1023986

**IPC:** B29C 70/24

**Language of the proceedings:** EN

**Title of invention:**

Reinforcing member of composite workpieces and associated methods

**Patentee:**

McDONNELL DOUGLAS CORPORATION

**Opponent:**

Airbus SAS

**Headword:**

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**Relevant legal provisions:**

EPC Art. 104(1), 111(1), 114(1)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Admissibility of late-filed document (yes)"

"Remittal (yes)"

"Apportionment of costs (no)"

**Decisions cited:**

T 0416/87

**Catchword:**

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Case Number: T 1490/07 - 3.2.05

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.05  
of 25 June 2009

**Appellant:** Airbus SAS  
(Opponent) 1 Rond-Point Maurice Bellonte  
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**Representative:** Stankoff, Hélène  
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**Respondent:** McDonnell Douglas Corporation  
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**Representative:** Land, Addick Adrianus Gosling  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 20 June 2007  
rejecting the opposition filed against European  
patent No. 1023986 pursuant to Article 102(2)  
EPC 1973.

**Composition of the Board:**

**Chairman:** W. Zellhuber  
**Members:** P. Michel  
E. Lachacinski

## Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division rejecting the opposition filed against European Patent No. 1 023 986.
- II. Oral proceedings were held before the Board of Appeal on 25 June 2009.

The appellant requested that the decision under appeal be set aside and that the European patent No. 1 023 986 be revoked.

The respondent (patentee) requested as a main request that the appeal be dismissed, or, as an auxiliary measure, that the decision under appeal be set aside and the patent in suit be maintained on the basis of any of the sets of claims filed as auxiliary requests 1 to 3 on 25 May 2009.

The respondent further requested that document D4 be not admitted into the proceedings, that the case be remitted to the first instance and that a different apportionment of costs be ordered.

- III. The following documents are referred to in this decision:

D1: US-A-5,589,015

D2: EP-A-0 556 088

D3: US-A-4,206,895

D4: FR-A-2 655 976

IV. Claim 1 according to the main request (as granted) reads as follows:

"1. A reinforcing member for reinforcing at least one workpiece, whereby said reinforcing member (20) comprises

- a connecting member (16); and
- a plurality of pins (12), each of said pins being formed of a hardened fiber reinforcing thread which is sufficiently stiff to allow the respective free end of the pin to be driven into the workpiece, **characterized in that**

- said connecting member (16) is also formed of a hardened fiber reinforcing thread, and **in that** each pin (12) has an end integrally connected to said connecting member (16), and extending from it, and an opposite free end."

Claim 1 of the first auxiliary request includes the additional feature as compared with claim 1 of the main request:

"wherein the fiber reinforcing thread of the connecting member is impregnated with a curable resin which is at least partially cured so as to form a pliable structure which can be conformed to accommodate irregularities in the surface of the workpiece."

Claim 1 of the second auxiliary request includes the additional feature as compared with claim 1 of the main request:

"wherein said plurality of pins are arranged in a grid pattern having a plurality of rows and columns."

Claim 1 of the third auxiliary request includes the additional feature as compared with claim 1 of the main request:

"wherein the fiber reinforcing thread of the connecting member is impregnated with a curable resin which is at least partially cured so as to form a pliable structure which can be conformed to accommodate irregularities in the surface of the workpiece, wherein the free ends of the pins are sharpened to facilitate being driven into the workpiece, wherein said plurality of pins are arranged in a grid pattern having a plurality of rows and columns."

- V. In the written and oral proceedings, the appellant has argued substantially as follows:

Document D4 is *prima facie* very relevant. It is directed to the same object as the patent in suit and discloses all the features of claim 1 of the main request of the respondent.

Document D4 was introduced into the proceedings with the grounds of appeal in order to address the arguments contained in the decision under appeal. In particular, the document discloses a staple made of a composite material, which is used not only to connect workpieces, but also as a reinforcement.

The opposition division had given no indication before the oral proceedings of the arguments contained in the decision.

Document D4 should accordingly be admitted into the procedure.

Document D4 is not a complex document and, for reasons of procedural economy, the case should not be remitted to the department of first instance.

Since the introduction of document D4 into the procedure does not represent an abuse of the procedure, nor an unjustified late filing, it is appropriate for each party to bear their own costs.

VI. In the written and oral proceedings, the respondent has argued substantially as follows:

Document D4 is late filed and should not be admitted into the procedure, since it is not *prima facie* relevant. The staples disclosed in document D4 are intended for joining elements together and are not reinforcing members and are unsuitable for reinforcing a workpiece. In fact, the staple would have the effect of weakening a workpiece. Since they are machined to their final form, the orientation of the fibres is disturbed and broken off fibres are exposed. It is also not possible to break a staple away from the strip of staples without disturbing the fibres. As a result, it is difficult to insert the staples into a workpiece and fault lines in the staple and workpiece will be formed.

Further, the staples of document D4 are not formed of a hardened fiber reinforcing thread which is sufficiently stiff to allow the respective free end of the pin to be driven into the workpiece.

The introduction of document D4 gives rise to a completely new case. Paragraph [0007] of the patent in suit provides an impetus to search for documents relating to staples of composite material.

Arguments based on general knowledge, as opposed to documents D1 to D3, were only raised by the appellant at the oral proceedings before the opposition division. It was thus not possible to address this issue earlier in the proceedings.

Document D4 should thus have been filed at an earlier date and should accordingly not be admitted into the procedure.

Document D4 gives rise to a new line of opposition which should be examined at two instances for the sake of procedural fairness. The case should accordingly be remitted to the department of first instance.

The late filing of document D4 was not justified and has given rise to increased costs for preparation for the oral proceedings. An apportionment of costs is thus appropriate.

## **Reasons for the Decision**

### **1. *Admissibility of late filed document***

Document D4 was filed for the first time by the appellant with the grounds of appeal.

Document D4 relates to a staple for reinforcing connections between composite elements, as stated at page 2, lines 11 to 16. This is the same object as that of the patent in suit, which refers in paragraph [0013] to "a reinforcing member which can be used for securing two or more reinforced components together". This function is illustrated in Figure 11 of document D4 and Figure 6 of the patent in suit.

The question of whether or not the staple has the function of a reinforcing element depends upon the relative stiffness and strength of the staple as compared with the workpieces. Since the claim is directed to a reinforcing member *per se* and the nature of the at least one workpiece is not specified, the staple must be regarded as being capable of reinforcing at least some workpieces.

There is no evidence to indicate that the person skilled in the art would be unable to produce a staple which would have the function of reinforcing at least one workpiece following the teaching of document D4. In particular, whilst document D4 teaches that the strip of staples 46 should be machined so as to attain its final form (see page 6, lines 24 to 34), there is nothing to indicate that this cannot be carried out, or that a staple cannot be separated from the strip of staples, without resulting in fibres protruding from the pins of the staple. It is further not established that, even if such protruding fibres were present, this would inevitably lead to the staple weakening, as opposed to reinforcing, any workpiece with which it was used.



The staple disclosed in document D4 can thus be regarded as constituting a reinforcing member comprising a connecting member and a plurality of pins (22) formed integrally therewith, manufactured in the manner described in document D4 with reference to Figures 4A to 10. The connecting member and each of the pins is formed of a hardened fiber reinforcing thread (40) which is sufficiently stiff to allow the free ends of the pins to be driven into the workpiece, in the manner illustrated in Figure 3.

The decision of the opposition division in connection with the issue of inventive step was based on documents D1 to D3. These documents are significantly less relevant than document D4, since they relate either to the use of individual pins (document D1) or to the use of stitching (documents D2 and D3).

The disclosure of document D4 is thus regarded as being *prima facie* relevant.

In the decision under appeal, the opposition division gives as part of the grounds for finding that the subject-matter of claim 1 involves an inventive step, their reasoning as to why forming a staple from fibre reinforced plastic as opposed to metal involves an inventive step. Document D4 was filed by the appellant with the grounds of appeal in response to this argument (see below).

The Board therefore considers it appropriate to exercise their discretion in accordance with Article 114(1) EPC to admit document D4 into the proceedings.

2. *Remittal to the department of first instance*

The introduction of document D4 into the proceedings gives rise to a fundamental change in the factual framework of the case, giving rise to a new line of argument in connection with the issue of inventive step, document D4 playing a decisive role in this argument.

Whilst it is accepted that remittal to the department of first instance conflicts with the desirability for procedural economy, the Board is of the opinion that this consideration is outweighed by the need for fairness vis-à-vis the respondent. Similarly, the fact that document D4 is not a complex document does not change the fact that the introduction of this document results in a fundamental change in the factual framework of the case.

It is accordingly considered appropriate for the Board to exercise its discretion in accordance with Article 111(1) EPC and remit the case to the Opposition Division, so that the respondent is not deprived of the possibility of having the new line of argument considered at two instances.

3. *Apportionment of costs*

In the decision under appeal, the opposition division gives as part of the grounds for finding that the subject-matter of claim 1 involves an inventive step, their reasoning as to why forming a staple from fibre reinforced plastic as opposed to metal involves an inventive step. However, the communication of

14 December 2006, attached to the invitation to oral proceedings gives no indication that this line of argument would be relevant to the decision. Accordingly, it can be accepted that it was necessary for the appellant to carry out a further search in order, if possible, to counter this argument.

Whilst arguments based on the general knowledge of the person skilled in the art, as opposed to the disclosure of documents D1 to D3, were only raised by the appellant at the oral proceedings before the opposition division, this cannot be regarded as being an abuse of procedure. It is to be expected that new aspects of an argument may arise during the course of a debate. In particular, the discussion of the prior art in paragraph [0007] of the patent in suit cannot be seen as providing a suggestion that it would be necessary to supply a document disclosing a thermoplastic staple. The sentence at column 2, lines 11 to 18 is concerned with individual pins.

It is noted that, contrary to the situation in T 416/87 (OJ 1990, 415), the appellant does not rely exclusively on documents only introduced in the appeal proceedings. The actions of the appellant are not regarded as constituting an abuse of procedure.

There are thus no reasons of equity which would make it appropriate to order a different apportionment of costs, and each party should bear the costs it has occurred in accordance with Article 104(1) EPC.

**Order**

**For these reasons it is decided that:**

The decision under appeal is set aside.

The case is remitted to the department of first instance for further prosecution.

The request for apportionment of costs is refused.

The Registrar:

The Chairman:

D. Meyfarth

W. Zellhuber