

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 24 September 2010**

Case Number: T 1979/08 - 3.2.03

Application Number: 02726331.8

Publication Number: 1392939

IPC: E04G 1/00

Language of the proceedings: EN

Title of invention:

Rolling platform

Patentee:

Xena Systems Limited

Opponent:

Cantideck

Headword:

-

Relevant legal provisions:

EPC Art. 56, 84

RPBA Art. 12(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Document referred to for the first time in appeal proceedings during oral proceedings before the Board - not admitted (point 3 of reasons)"

"Article 84 - description not in agreement with claims (main request)"

"Removal of brackets in claim is not contrary to doctrine of reformatio in peius (point 5 of reasons)"

"Inventive step (yes) - definition of an objective problem starting from closest prior art"

Decisions cited:

-

Catchword:

-



Case Number: T 1979/08 - 3.2.03

DECISION
of the Technical Board of Appeal 3.2.03
of 24 September 2010

Appellant: Cantideck
(Opponent) Clifton House
Bunnian Place
Basingstoke
Hampshire RG21 7JE (GB)

Representative: Preuss, Udo
Kramer - Barske - Schmidtchen
Landsberger Straße 300
D-80687 München (DE)

Respondent: Xena Systems Limited
(Patent Proprietor) Dinsdale House
Riverside Park Road
Middlesbrough, Cleveland TS2 1UT (GB)

Representative: Murnane, Graham John
Murgitroyd & Company
165-169 Scotland Street
Glasgow G5 8PL (GB)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
12 August 2008 concerning maintenance of the
European patent No. 1392939 in amended form.

Composition of the Board:

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

Summary of Facts and Submissions

- I. European patent EP-B1-1 392 939 relates to a rolling platform typically used to provide access for building materials and equipment to the floors of buildings during their construction. Grant of the patent was opposed on the grounds of lack of novelty and inventive step (Article 100(a) EPC).
- II. The Opposition Division concluded that the amended claims filed by the Patent Proprietor (Respondent in the present case) during the oral proceedings as its main request met the requirements of the EPC. The Opposition Division thus decided that the patent could be maintained on the basis of this set of claims.
- III. The above decision was posted on 12 August 2008. The Opponent (Appellant) filed notice of appeal on 7 October 2008, paying the appeal fee on the same day. A statement containing the grounds of appeal was filed on 22 December 2008.
- IV. In accordance with Article 15(1) of the Rules of Procedure of the Boards of Appeal, the Board issued a preliminary opinion of the case, together with a summons to attend oral proceedings.
- V. In response to the provisional opinion, the Respondent filed new claims and an amended description (see letter dated 20 July 2010).
- VI. Oral proceedings were held on 24 September 2010.

VII. Requests

The Appellant requests that the decision under appeal be set aside and that the patent be revoked.

The Respondent requests that, in setting aside the decision under appeal, the patent be maintained in amended form on the basis of claims 1 and 2 filed with the letter of 20 July 2010 (main request), or alternatively, on the basis of said claims with paragraph 18 being deleted from the description as amended during the opposition procedure (auxiliary request).

VIII. Claims

Claim 1 of both the main and auxiliary request reads as follows:

"1. A rolling platform for use in providing access platforms extending past the edge of floors of buildings during their construction, the platform comprising:

a first, static outer frame (11) which is securable to the building;

a second, moveable inner frame (20) which is telescopically slidable within the first outer frame (11) between an extended and a retracted position;

first roller means (30,31a,31b) positioned between the frames (11, 20) comprising rollers (31a,31b) at the rear of the inner frame (20) bearing on the outer frame

(11), and rollers (30) at the front of the outer frame (11) bearing on the inner frame (20) to permit relative sliding movement between the frames (11, 20);

characterised in that

the second inner frame (20) is longer than the first outer frame (11);

and

further roller means (32) are provided, said further roller means (32) comprising rollers arranged at the rear of the first, outer frame (11) to engage with a rail (40) at the rear of the second, inner frame (20) and support the second, inner frame (20) as it is moved toward and is in the fully retracted position."

Dependent claim 2 of both requests is as follows:

"2. A rolling platform according to claim 1 in which, when the second moveable frame (20) is fully retracted, no part of the rolling platform extends outwardly (away from the building) from the edge of the floor."

IX. Prior Art

The following documents were cited, amongst others, in the contested decision:

D1: WO-A1-98/53161

D2: WO-A1-95/06794.

X. Submissions of the Parties

(a) Admissibility of Respondent's Main Request

On 20 July 2010 the Respondent filed amended claims and an amended description in which paragraph [0018] had been deleted. At the oral proceedings the Respondent set out its main request as being maintenance of the patent on the basis of the claims filed on 20 July 2010 and a description containing paragraph [0018]. The Appellant objected to the Respondent's main request, as being filed late, and amounting to a reversal of the request set out in the letter of 20 July 2010, in which the paragraph had been deleted.

The Respondent argued that the intention of the amendments proposed in the letter of 20 July 2010 was to avoid the necessity of having oral proceedings. However, since the Appellant still intended to contest the patent at the oral proceedings, it was only fair that the Respondent had an opportunity to defend the inclusion of paragraph [0018] in the description.

(b) Admissibility of Document D2

During the oral proceedings before the Board the Appellant referred to D2. Although the document had been considered by the Opposition Division, this was the first time in appeal proceedings that it had been mentioned. The Appellant said that became aware that the Board had not taken D2 into consideration only on receipt of the provisional opinion. In addition, the Respondent had not filed detailed arguments, which the

Appellant could address using D2. However, given the relevance of D2, the document cannot be overlooked.

The Respondent submitted that D2 is not *prima facie* more relevant than D1, a view that was also held by the Opposition Division. Further, the Appellant had not provided any evidence of the relevance of D2.

Main Request

(c) Article 84 EPC

Claim 1 defines the inner moveable frame as being longer than the outer static frame, and the first embodiment described in the patent specification describes a retracted position in which the inner frame has to be supported by rollers 32 (at the rear of the outer frame), as the outer static frame is no longer in contact with rollers 31a, 31b at the rear of the inner movable frame.

Paragraph [0018] of the patent specification then refers to an alternative embodiment, in which the lengths of the inner movable and outer static frames are similar, and the inner frame is supported both by rollers 32 on the outer static frame as well as by rollers 31a, 31b on the inner moveable frame.

The Appellant submitted that the real problem addressed by the disputed invention only arises if the length of inner movable frame is clearly longer than that of the outer static frame. When the lengths are similar, there is no problem of lack of support in the retracted position for the inner frame. Paragraph [0018]

therefore concerns an embodiment that is in contradiction with the subject-matter of claim 1.

The Respondent argued that the invention relates to a range of differences in lengths; the first embodiment concerns the situation where the difference is large, and the second embodiment relates to when the difference is small. "Similar" does not mean "same", and implies a difference, so that the inner frame is both longer and similar in length to the outer frame. Claim 1 defines rollers 31a, 31b as being "at the rear of the inner frame"; this means that, given the practical considerations of mounting the rollers, they are actually set in from the rear of the inner frame. Paragraph [0018] is not dealing just with the fully retracted position of the inner movable frame, but describes the provision of transitional support from both sets of rollers during retraction or extension of the inner frame.

Auxiliary Request

(d) Amendment of Dependant Claim 2

During opposition proceedings the brackets in dependent claim 2 (which were present in the granted claims) were deleted. The Board gave a provisional opinion that this amendment had not been occasioned by a ground of appeal and hence seemed to be unallowable. The Respondent then re-instated the brackets to claim 2. The Appellant submitted that by allowing the Respondent to return to the form of the granted claims, the Respondent has improved its position, contrary to the doctrine of *reformatio in peius*. The Respondent argued that there

is no improvement in its position, as the wording of the claims is the same and that the scope of protection has not been extended.

(e) Inventive Step (Article 56 EPC)

The Opposition Division considered that, starting from D1, the objective problem to be solved was to enable the rolling frame to retract fully to be flush with the edge of the building whilst still being supported by the static frame. It concluded that neither the problem nor its solution could be derived from D1.

The Appellant disagreed with the definition of the problem given by the Opposition Division, arguing that there is no requirement in claim 1 for the platform to be flush with the building, as this feature is only defined in dependent claim 2. In addition, no inventive step can be associated with this particular problem, as it is already solved in D1 simply by moving the platform back until it is flush with the outer side of the building. Consequently, the objective problem set out in the disputed decision is incorrect.

The Appellant submitted that, starting from the rolling platform of D1, the skilled person would recognise the disadvantage of restricted space behind the stationary frame. The objective technical problem to be solved is therefore how to shorten the static outer frame when the inner frame is in the extended position.

Regarding the problem of shortening the static outer frame, it is immediately apparent that when the inner moveable frame approaches the retracted position, the

rolls at the end of the inner frame will lose contact with the static outer frame. The skilled person knows that this difficulty is easily addressed by mounting extra rolls at the end of the static outer frame. In addition, mounting extra rolls at the end of the static outer frame is mere duplication of the support provided by the corresponding rolls mounted at the front end of the static frame and, as such, is obvious.

The platform of claim 1 therefore lacks an inventive step in light of D1.

The Respondent agreed with the Opposition Division's view that the objective problem concerned the positioning of the platform with respect to a building. The Respondent explained that this is not defined in claim 1, as the claim relates to the platform itself and identifies all the features necessary for a platform to achieve the required result.

The Respondent argued further that the mere provision of an extra set of rolls at the end of the static frame would result in interference with the rolls attached to the moveable frame; D1 gives no hint of the claimed arrangement of rolls, and in particular the use of a rail (40) to avoid such interference.

The claimed subject-matter is thus inventive.

Reasons for the Decision

1. The appeal is admissible.
2. Admissibility of Respondent's Main Request
 - 2.1 With the letter of 20 Jul 2010, the Respondent filed amended claims and description (deletion of paragraph [0018]) without identifying them as a main or auxiliary request. At the beginning of the oral proceedings the Respondent defined its main request as being maintenance of the patent on the basis of the claims filed with the letter of 20 July 2010, that is with a description that includes paragraph [0018]; the auxiliary request relates to the same claims, but with paragraph [0018] deleted from the description. The Appellant objected to admission of this main request into the proceedings, as it was filed very late, and a reversal of the request set out in the letter of 20 July 2010, in which paragraph [0018] had been deleted.
 - 2.2 Paragraph [0018] formed part of both the description of the patent as granted and the description decided upon by the Opposition Division, hence it should come as no surprise to the Appellant that the Respondent might wish to argue for its reintroduction into the description. In addition, the inclusion of paragraph [0018] in a request does not raise any new issues that have not been addressed before. The Board therefore admits the Respondent's main request into the proceedings.

3. Admissibility of Document D2
 - 3.1 D2 had been mentioned in the decision of the Opposition Division. However, reference to D2 was made for the first time in appeal proceedings during the oral proceedings before the Board.
 - 3.2 No mention of D2 had been made in the statement of grounds of appeal. According to Article 12(2) of the Rules of Procedure of the Boards of Appeal (RPBA), the statement of grounds of appeal shall contain a party's complete case; they should specify expressly all the facts, evidence and arguments relied upon. The failure to cite D2 in the grounds of appeal is contrary to Article 12(2) RPBA.
 - 3.3 The Appellant said that he was only aware that D2 had been "overlooked" on reading the provisional opinion of the Board, which only referred to D1. In such a situation, the Appellant should have filed D2 immediately in response to the provisional opinion. The Board has a discretion under Article 13(1) to allow a party to amend its case if, for example, a document is found to be highly relevant, sound reasons are given for its late introduction and procedural economy is taken into account. In this case, introduction of D2 for the first time during the oral proceedings is simply too late.
 - 3.4 The Appellant also argued that it could not develop its case, for example by referring to D2, as the Respondent had not filed any detailed arguments setting out its position. However, the judicial nature of appeal proceedings means that it is for the Appellant alone to

make out its case as to why the decision at first instance was wrong; a Respondent has no obligation to make any submission.

- 3.5 For these reasons, document D2 is not admitted into the proceedings.

Main Request

4. Article 84 EPC

- 4.1 Paragraph [0018] of the granted patent reads as follows:

"Alternatively, if the inner moveable frame 20 and the outer static frame 11 are similar in length, the further roller means 32 can still be utilised to give additional support to the inner movable frame 20 even though the rollers 31a and 31b may still be in contact with the outer static frame 11."

- 4.2 So, whereas claim 1 defines the inner frame (20) as being longer than the outer frame (11), this paragraph in the description refers to an alternative embodiment where the inner and outer frames are similar in length. The Appellant submits that paragraph [0018] is in contradiction to claim 1, and consequently the requirements of Article 84 EPC are not met.

- 4.3 The Opposition Division held that there was no objection under Article 84 EPC, and also commented that the objected wording was already present in the granted patent, implying that any lack of clarity could not be objected to, as it is not a ground of opposition and does not arise out of an amendment. Granted claim 1,

however, made no reference to the respective frame lengths (this was present in dependent claim 3). Since claim 1 has now been amended to contain a new combination of features that include the respective frame lengths, it is appropriate to consider clarity issues.

4.4 The Respondent and the Opposition Division are of the view that "similar in length" does not mean "equal in length", so that the length of the two frames can differ by a small amount, and that the skilled person would recognise the advantage of the third set of rollers even if the difference in length was small; hence the paragraph [0018] is not in contradiction with claim 1.

4.5 According to the embodiment of the invention described in paragraphs [0011] to [0017] the inner movable frame is supported in the fully retracted position by rollers 32 (at end of outer frame), as rollers 31a, 31b at the rear of the inner frame are no longer in contact with the outer static frame (see paragraph [0011]).

Paragraph [0018] describes an alternative embodiment in which the inner frame is supported in the retracted position both by rollers 32 and by rollers 31a, 31b.

4.6 Whether or not the inner frame remains supported in the retracted position by rollers 31a and 31b depends how far away from the rear of the inner frame they are mounted. Indeed in the drawing provided by the Respondent during the oral proceedings, showing the inner frame supported in the retracted position by both rollers 32 and rollers 31a, 31b, rollers 31a, 31b are

shown to be placed at some distance from the rear of the inner frame.

Claim 1 clearly states that rollers 31a, 31b are at the rear of the inner frame 20. When the inner frame is appreciably longer than the outer frame, and not similar in length as described in paragraph [0018], it is clear that rollers 31a, 31b are positioned at the rear of the inner frame, as defined in claim 1 and described in the first embodiment.

However paragraph [0018] leads to ambiguity in that it is not known how far from the rear the rollers can be mounted when the lengths are similar. Hence, when claim 1 is considered in light of paragraph [0018] a lack of clarity arises, and the claim does not meet the requirements of Article 84 EPC. Consequently, the main request of the Respondent is not allowable.

Auxiliary Request

5. Amendment of Dependent Claim 2

5.1 Dependent claim 2 reads as follows:

"2. A rolling platform according to claim 1 in which, when the second moveable frame (20) is fully retracted, no part of the rolling platform extends outwardly (away from the building) from the edge of the floor."

5.2 During the opposition proceedings the brackets (emphasised in the claim above), which were present in the granted and originally filed claims, were deleted for the purpose of clarity. In its provisional opinion,

the Board was of the view that the deletion of the brackets was not occasioned by a ground of opposition, and hence the amendment did not seem to be admissible (see Rule 80 EPC). In the present claims before the Board, the Respondent has reinstated the brackets.

5.3 The Appellant argues that by allowing the Respondent to revert to the form of the claim as granted, ie with brackets, the position of the Respondent is improved, and since the Respondent had not filed an appeal, this is contrary to the doctrine of *reformatio in peius*.

5.4 The wording of the claims, however, remains identical, and the scope of protection has not changed, as the amendment concerns a dependent claim. The Board therefore agrees with the Respondent, that there is no improvement in its position and hence there is no *reformatio in peius*.

6. Inventive Step (Article 56 EPC)

6.1 Closest Prior Art:

Document D1 is seen as being the closest prior art, and is identified in the patent specification as being the starting point for the disputed invention (see paragraph [0002]).

6.2 D1 discloses a rolling platform that corresponds to the preamble of claim 1; the claimed platform differs in that

(a) the second inner frame 20 is longer than the first outer frame 11; and

(b) further rolling means 32 are provided, which comprise rollers arranged at the rear of the first outer frame 11 to engage with a rail 40 at the rear of the second inner frame 20 and to support the second inner frame as it is moved forward and is in the fully retracted position.

6.3 Objective Problem to be Solved:

6.3.1 Starting from D1, the Opposition Division and the Respondent formulated the objective problem as being the provision of a platform wherein the rolling frame fully retracts to be flush with the edge of the floor of the building, whilst still being supported by the static frame. This corresponds to the problem set out in the introduction to the patent in paragraphs [0003] and [0004].

6.3.2 The Appellant submits that this cannot be the objective problem, as the requirement that no part of the platform extends beyond the edge of the building is not a feature of claim 1, but of dependent claim 2; the Appellant also argues that this problem is already solved in D1 by moving the platform back until it is flush with the outer side of the building. The Appellant sees the problem to be solved starting from D1 as how to make the static outer frame shorter than the moveable inner frame, which has the effect that the outer frame requires less space in the building when the inner frame is extended.

6.3.3 However, the Appellant's definition of the problem hints at the solution (make the static outer frame shorter than the moveable inner frame). In addition, the space-saving effect only occurs when the inner moveable frame is extended; when retracted, it would occupy the space immediately behind the shortened outer frame, and hence be of limited use. For both of these reasons, the problem suggested by the Appellant is not considered to be objective.

6.3.4 It is well established case law of the boards of appeal that an objective definition of the problem to be solved should normally start from the problem described in the contested patent (see section I.D.4.3.2 of the 5th Edition of the Case Law of the Boards of Appeal of the European Patent Office). As mentioned above, this is the provision of a platform that retracts to be flush with the edge of the building.

6.3.5 This effect concerns the relationship of the claimed platform to an undefined object, namely the building. The features of the platform, as defined in claim 1, must therefore be capable of producing the required effect. Whether or not the effect itself is explicitly defined in claim 1 is not of importance for the purpose of analysing inventive step. The patent sets out a problem to be solved and claim 1 defines a piece of equipment that has the features necessary for solving the problem.

6.4 Solution:

6.4.1 Claim 1 defines the solution as being the shortening of the static outer frame 11 and the provision of a

additional set of rollers 32 at the rear of frame 11, which engage with a rail 40 at the rear of the inner frame 20 to support the inner frame as it is moved into the fully retracted position.

6.4.2 The platform of D1 comprises a ladder frame (7), which is fixed to the underside of moveable inner frame, and which abuts against the floor of the building (see page 3, lines 10 to 14, page 6, lines 9 to 12 and Figures). The intention of D1 is that the platform projects beyond the building by about one and a half metres, which is the minimum distance by which crane drivers space the crane rope from a building (see the last paragraph on page 6).

6.4.3 In order to move the platform back so that it rests flush with the outside of the building, as suggested by the Appellant, it is necessary to remove the ladder frame, which is contrary to the teaching of D1.

Even if the skilled person were to do so, the result would be to restrict the extension of the platform away from the building. As set out in the decision of the Opposition Division (paragraph 6.3), D1 gives no hint to make the static inner frame shorter and compensate for the loss of support when the outer movable frame is retracted by using a further roller means at the rear of the outer frame and a rail. This allows the outer movable frame to be retracted flush with the building whilst maintaining the desired extension of the platform.

6.5 Even if the problem defined by the Appellant (making the static outer frame shorter than the moveable inner

frame) is considered, the mere provision of an extra set of rollers at the rear of the static frame in order to support the moveable frame in the retracted position does not alone provide an obvious solution, since without rail 40 such rollers would interfere with those mounted at the rear of the inner moveable frame, as argued by the Respondent.

6.6 For these reasons, the claimed subject-matter has an inventive step.

7. Summary

Paragraph [0018] has been deleted from the description, hence the above objection concerning Article 84 EPC does not apply. Since the claimed subject-matter has an inventive step in light of D1, the auxiliary request of the Respondent is allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to maintain the patent in the following version:
 - Claims 1 and 2 filed with the letter of 20 July 2010;
 - Description pages 2 and 3 as amended by the patent proprietor during the opposition procedure, with paragraph 18 being deleted;
 - Figures 1 to 11a, as granted.

The Registrar:

The Chairman:

A. Counillon

U. Krause