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**Datasheet for the decision
of 13 January 2011**

Case Number: T 2195/08 - 3.2.03
Application Number: 01600021.8
Publication Number: 1197704
IPC: F21V 21/16, F21S 4/00,
F21W 121/00
Language of the proceedings: EN

Title of invention:

Frame for decorations of streets, poles, squares and shops

Patentee:

Palaiohorinos, Ioannis

Opponent:

BLACHERE ILLUMINATION (SAS)
MK Illumination Handels GmbH

Headword:

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Relevant legal provisions:

EPC Art. 56, 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Lack of inventive step: main request"
"Inadmissible extension: auxiliary requests"

Decisions cited:

-

Catchword:

-



Case Number: T 2195/08 - 3.2.03

D E C I S I O N
of the Technical Board of Appeal 3.2.03
of 13 January 2011

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 11 September 2008
revoking European patent No. 1197704 pursuant
to Article 101(2) EPC.

Composition of the Board:

Chairman: U. Krause
Members: Y. Jest
K. Garnett

Summary of Facts and Submissions

I. By its decision dated 11 September 2008 the opposition division revoked European Patent No. 1197704 on the grounds that the claimed subject-matter of the patent as granted (main request) lacked novelty as compared to D17 and that the auxiliary request did not meet the requirements of Rule 80 EPC and was therefore not admissible.

The opposition division considered that document D17, which was filed by opponent OI after the expiry of the nine months time limit set in Article 99(1) EPC for notice of opposition, was relevant and introduced it into the opposition proceedings in exercise of its discretion under Article 114 EPC.

The proprietor did not appear and was not represented during the oral proceedings before the opposition division.

II. The patentee, hereinafter the appellant, lodged the appeal on 11 November 2008 and paid the appeal fee on the same day.

In the statement of grounds received on 9 January 2009 the appellant requested that the decision of the opposition division to revoke the patent be set aside and the patent be maintained in amended form on the basis of claim 1 of a main or of the auxiliary request filed with the grounds of appeal.

The appellant argued that the claimed subject-matter according to the newly filed requests met the requirements of novelty and inventive step as compared to D17, which was considered in the impugned decision to disclose the closest prior art.

III. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to the summons to attend oral proceedings dated 12 June 2009, the Board gave a preliminary assessment of the case.

In the letter of 20 December 2010, the appellant filed in reply an amended claim 1 according to a new main request and a new auxiliary request and further requested that the late filed document D17 be disregarded.

IV. During the oral proceedings which took place on 13 January 2011, the parties made the following requests:

The appellant (patent proprietor) requested:

- (a) document D17 be not admitted into the proceedings;
- (b) the decision under appeal be set aside; and
- (c) the patent be maintained in amended form on the basis of the main request, alternatively the auxiliary request, both filed with the letter dated 20 December 2010, alternatively on the basis of the second auxiliary request filed during the oral proceedings.

The respondents (opponents OI and OII) requested the appeal be dismissed.

V. The independent claim 1 according to the appellant's requests read as follows:

(a) Main request

"A frame (1) onto which are placed the lighting elements of the garland (2), said frame being attached by means of latches or rings (4) onto a rope wire (3) which is tightened with the help of a vice (9) and tensor (8) and is then attached onto a pole with special nails (7),

characterised in that said frame

- is made of aluminium or iron;
- is coated in transparent or coloured plastic (6) according to purpose;
- can be combined using hinges (10) with as many frames as desired according to the desired length;
- can be attached directly onto a pole (5) using nails (11)."

(b) Auxiliary request 1

"A combination of a plurality of frames (1) onto each of which are placed the lighting elements of the garland (2), each of said frames being attached by means of latches or rings (4) onto a rope wire (3) which is tightened with the help of a vice (9) and tensor (8) and is then attached onto a pole with special nails (7),

characterised in that each said frames

- is made of aluminium or iron;
- is coated in transparent or coloured plastic (6) according to purpose;
- can be attached directly onto a pole (5) using nails (11);

wherein the frames are combined using hinges (10) with each other as desired according to the desired length."

(c) Auxiliary request 2

"A combination of a plurality of frames (1) in which are placed the lighting elements of the garlands (2), each of said frames being attached by means of latches or rings (4) onto a rope wire (3) which is tightened with the help of a vice (9) and tensor (8) and is then attached onto a pole with special nails (7),

characterised in that each said frames

- is made of aluminium or iron;
- is coated in transparent or coloured plastic (6) according to purpose;
- can be attached directly onto a pole (5) using nails (11);

wherein the frames are combined using hinges (10) with each other as desired according to the desired length."

VI. Relevant prior art considered in the appeal proceedings:

D3: US-A-5876111

D14: FR-A-2777344

D17: Catalogue "BLACHERE[®] Illumination, Edition 1993, Imprimerie de l'Hexagone, Aix-en-Provence, France, 03/93", 3 pages:

- Title page,
- page "Sommaire", and
- page 27: "Fixations des Décors Lumineux et des Guirlandes"

VII. The arguments presented by the appellant can be summarised as follows:

(a) Document D17

Document D17, which was a copy of some pages of a catalogue of opponent OI itself with a hardly readable printing date, was late filed during the opposition proceedings. Since this document must have been known to the respondent, its delayed filing consisted in an abuse of proceedings. D17 should therefore be disregarded by the board.

(b) Main request

The difference of the claimed subject-matter as compared to D17, namely the coating of the frame in transparent or coloured plastics, was not obviously derivable and involved an inventive step. The bars of the frame of D17 were made of galvanised iron so that no further protection of the frame was required. The skilled person would not have considered D3 or D14 because the plastic coating described therein was not provided for electrical insulation, i.e. for preventing electrical leakage or short-circuits, but purely for esthetical or design purpose.

(c) First and second auxiliary requests

Claim 1 was now directed to a combination of a plurality of frames. The wording of their respective features:

- "onto each of which are placed the lighting elements of the garland (2)"; and
- "in which are placed the lighting elements of the garlands (2)";

was to be construed in accordance with the description, namely that a garland was attached in or onto a single frame.

The requirements of Article 123(2) EPC were thus obviously met and the second auxiliary request, which was filed during the oral proceedings before the board, was to be admitted into the proceedings.

VIII. The respondents argued essentially the following:

Besides the formal deficiencies of the main request (Articles 100(b) and 84 EPC) the subject-matter of its claim 1 lacked inventive step when compared to D17, which had been considered as closest prior art by the opposition division. To coat an object with plastics material in order to protect it from bad weather conditions or for a decorative purpose was part of the general knowledge of the skilled person or at least obvious from the teaching of D3 or D14.

The amendment made to claim 1 of the first and second auxiliary requests covered embodiments where a single garland was no longer placed onto a single frame but possibly onto several frames. These claimed arrangements introduced fresh-matter and did not meet the requirements of Article 123(2) EPC.

IX. At the end of the oral proceedings which took place on 13 January 2010 the Board announced its decision.

Reasons for the Decision

1. The appeal is admissible.
2. State of the art - Document D17

The catalogue from which document D17 is issued was printed in 1993 as indicated in the footnote of the page entitled "Sommaire". It is general and constant jurisprudence of the boards of appeal to consider that, without any objective reason or proof of the contrary, technical catalogues are made public shortly after their printing. The opposition division was thus correct in considering that D17 was made public before the priority date (10 October 2000) claimed by the contested patent. D17 was an opponent OI's own document and filed after the nine months period of opposition but before the opposition division summoned the parties to oral proceedings. This alone cannot, however, be seen as evidence for any abuse by deliberate late filing.

The opposition division, by applying correctly its discretionary power, considered that D17 was prima facie relevant and decided to introduce it into the proceedings under Article 114(1) EPC.

This decision of the opposition division was not challenged by the appellant in his grounds of appeal; D17 was actually discussed in detail by the appellant when addressing the issue of inventive step. It was only with the letter dated 20 December 2010, thus less than one month before the oral proceedings, that the appellant first contested the introduction of D17 into

the proceedings because of the alleged abuse of proceedings from opponent OI.

The board cannot see any objective reason for departing from the decision taken by the opposition division in this respect or for not taking D17 into account as state of the art under Article 54(2) EPC, on which the grounds for revocation of the patent had been based.

3. Main request

3.1 Claim 1 of the main request defines a frame:

- onto which are placed the lighting elements of the garland (2),
- which is attached by means of latches or rings (4) onto a rope wire (3) which is tightened with the help of a vice (9) and tensor (8) and is then attached onto a pole with special nails (7),
- which is made of aluminium or iron, and
- which is coated in transparent or coloured plastic (6) according to purpose.

The remaining part of claim 1, namely that the frame can be combined using hinges (10) with as many frames as desired according to the desired length and can be attached directly onto poles (5) using nails (11), defines purely optional features, which are thus to be disregarded when evaluating inventive step.

3.2 The closest prior art is disclosed in D17, see page 27 (drawing and accompanying text of the upper half of the page), and defines a frame onto which are placed the lighting elements of garlands (see upper left photograph on page 27). The frame is attached by means

of latches or rings onto a rope wire which is attached and tightened between two supports (poles) with the help of a vice and tensor (see text below the upper left photograph). The frame is made of galvanised iron (see text under title "Fixations des décors lumineux et des guirlandes").

3.3 The claimed subject-matter differs from this closest prior art in that the frame is further coated in transparent or coloured plastic according to purpose. This feature can be construed as a coating covering the entire structure, i.e. the frame and the garland attached to it (as illustrated in Figure 2 of the patent), or as a coating of the sole iron bars forming the frame.

The technical effect of such a coating - and thus the technical problem derivable there from - consists in the protection of the coated device, i.e. the entire structure or just the iron bars, from bad weather conditions and/or in the provision of a decorative effect for the case that the coating plastics is coloured.

3.4 The galvanising of the iron bars of the frame according D17 actually protects the iron bars from exposure to bad weather conditions. The person skilled in the art manufacturing iron components knows equivalent and alternative techniques other than galvanisation for protecting iron bars from the effects of weather, one of which consists in covering the bars with a transparent or coloured plastics layer.

3.5 The state of the art disclosed in D3 (see Figures 9A to 9C, column 4, lines 50 to 55) or in D14 (see Figure 3,

page 2, lines 31 to 34) teaches the person skilled in the art to cover the entire lighting structure made of a frame and lighting elements attached thereon with a decorative coating of plastics material. It would be quite obvious for the skilled person that by providing a decorative coating covering the whole structure as shown in D3 and D14, a further and additional effect is incidentally also achieved, namely also a protection or isolation of the lighting structure against bad weather conditions.

The person skilled in the art would thus have envisaged as a normal practice the covering of the entire structure of the lighting system of D17 with a plastics coating for either decorative or protective purpose.

- 3.6 The subject-matter of claim 1 of the main request, lacking inventive step, does not meet the requirements of Article 52(1) or 100a) EPC.

4. Auxiliary requests

The change of the claimed subject-matter from a single frame (main request) to the combination of a plurality of linked frames introduces a problem under Article 123(2) EPC in the sense that the claim now covers embodiments in which a single garland is attached to more than one frame and thus extends over more than one frame.

Thus is due to the wording of the corresponding feature in said claims, namely:

- "a plurality of frames (1) onto each of which are placed the lighting elements of the garland (2)" (first auxiliary request);

- "a plurality of frames (1) in which are placed the lighting elements of the garlands (2)" (second auxiliary request).

However, the invention as originally disclosed in the application (and in the patent) did not concern other embodiments than those having a garland entirely attached to a single frame (see original claim 1 and paragraph [0007] of the published application).

Thus the auxiliary requests introduce an unallowable extension within the meaning of Article 123(2) EPC and therefore can not be allowed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Counillon

U. Krause