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Datasheet for the decision of 1 October 2013

Case Number: T 1297/11 - 3.2.03

Application Number: 03101666.0

Publication Number: 1380691

IPC: E01C 11/22, E03F 3/04, D03F 5/06

Language of the proceedings: EN

Title of invention:
Wide channel drainage system

Patentee:
ACO SEVERIN AHLMANN GMBH & CO. KG

Opponent:
HAURATON GmbH & Co. KG

Headword:
-

Relevant legal provisions:
-

Keyword:
"Ground for opposition under Article 100(a) EPC withdrawn in opposition proceedings - not admitted in the appeal proceedings"
"Product according to a prior art document - not admitted"
"Inventive step - (yes)"

Decisions cited:
G 0010/91

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1297/11 - 3.2.03

D E C I S I O N
of the Technical Board of Appeal 3.2.03
of 1 October 2013

Appellant: (Patent Proprietor)
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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted on 24 May 2011 concerning maintenance of European patent No. 1380691 in amended form.**

Composition of the Board:

Chairman: U. Krause
Members: V. Bouyssy
K. Garnett

Summary of Facts and Submissions

I. European patent No. 1 380 691 (in the following: "the patent") concerns a drainage channel section comprising *inter alia* a longitudinal channel which defines a longitudinal slot that lies, in use, in a surface to be drained.

II. The patent as a whole was opposed on the grounds of Article 100(a) EPC for lack of novelty and inventive step. The opposition division held that the subject-matter of claim 1 as granted lacked an inventive step (Article 100(a) together with Articles 52(1) and 56 EPC) and that the patent could be maintained on the basis of auxiliary request 3a as filed during the oral proceedings (Article 101(3)(a) EPC). The interlocutory decision was posted on 24 May 2011.

III. The opponent (here appellant I) lodged an appeal against this interlocutory decision on 14 June 2011, paying the fee for appeal on the same day. The statement setting out the grounds of appeal was received on 26 September 2011.

IV. The proprietor (here appellant II) lodged an appeal against the above decision on 25 July 2011, paying the fee for appeal on the same day. The statement of the grounds of appeal was received on 26 September 2011.

V. With the summons to oral proceedings, the board sent a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) indicating to the parties its preliminary, non-binding opinion of the case.

VI. Oral proceedings before the board were held on 1 October 2013.

VII. Requests

Appellant I requested that the decision under appeal be set aside and the patent be revoked.

Appellant II requested that the decision under appeal be set aside and that the patent be maintained as granted.

VIII. Claim 1 as granted is directed to the following subject-matter:

" A drainage channel section (2) comprising a longitudinally extending pipe portion (6), a plurality of longitudinally spaced hollow projections (22) communicating with the pipe portion (6) and a longitudinal channel (24), wherein said longitudinal channel (24) communicates with the projections (22) and defines a longitudinal slot (26) that lies in use in a surface to be drained, characterised in that said longitudinal channel (24) is supported by said projections (22). "

IX. The following document was relied on by the parties in the proceedings:

A2: AU 733 361 B

X. The arguments of the parties in the written and oral proceedings can be summarised as follows:

(a) Admissibility of the ground of lack of novelty

Appellant II contended that the opponent had expressly withdrawn the ground of lack of novelty during the oral proceedings before the opposition division, so that the ground of lack of novelty constituted a fresh ground of opposition in the appeal proceedings. Since the proprietor objected to the re-introduction of this ground, it could not be considered in the appeal proceedings, pursuant to G 10/91.

Appellant I contended that, at the oral proceedings before the opposition division, it had only renounced its wish to discuss lack of novelty; this was done to shorten the oral proceedings because it seemed to be more productive to discuss inventive step. It had not renounced to challenge the patent on the ground of lack of novelty. Appellant I concluded that the ground of lack of novelty was not a fresh ground of opposition.

(b) Admissibility of a product allegedly based on A2

In its reply to the statement of grounds of appeal of appellant II, appellant I said that it had received a drainage channel section in conformity with A2 from the patent owner of A2 and that it intended to demonstrate in the oral proceedings how this product could be installed to support its allegations of lack of inventive step. At the oral proceedings, appellant I stated that it had received evidence from the patent owner of A2 proving that this product was public prior art. Appellant I then also requested that this product

be admitted in the proceedings because it was *prima facie* as relevant as A2.

Appellant II contested that the product constituted public prior art and that it was in conformity with A2. Appellant II submitted also that any submission of appellant I in respect to this product was irrelevant to the disclosure of A2 and the appeal proceedings and thus should be disregarded.

(c) Interpretation of claim 1

Appellant II's case:

Claim 1 should be read with a mind willing to understand it. In particular, the final feature of claim 1, i.e. "that said longitudinal channel is supported by said projections", was not a mere functional or "suitable for" requirement, but rather a positive technical requirement of the structure of the drainage channel section. This feature neither described a storage arrangement of the drainage channel section prior to its installation nor a transitional arrangement of the drainage channel section during its installation in a trench. This feature clearly implied that the projections were physically connected to the channel to actually hold the channel at its intended use position relative to the pipe portion.

Appellant I's case:

The final feature of claim 1 could be read as defining a transitional arrangement of the drainage channel section during its installation. In particular, it

followed from the disputed patent that, when the channel section was embedded in concrete, the weight of the channel, as well as heavy vehicle loads, would be taken up by the reinforced concrete slab and not by the projections. Thus, the final feature of claim 1 could be read in a broad manner wherein the projections would provide any kind of support for the channel, for instance possibly only in a transitional installation phase.

The final feature of claim 1 could also be read as a functional feature meaning merely that the channel is to be suitable for being supported by the projections. In fact, this feature was not a technical feature but rather the expression of an intended use.

(d) Inventive step vs. A2

Appellant II's case:

The opposition division stated that the parties agreed that the subject-matter of claim 1 differed from A2 only in that the longitudinal channel was supported by the projections and that a skilled person would arrive at this distinguishing feature in an obvious manner when installing the drainage apparatus of A2 in a trench. However, the opposition division was incorrect because it based its decision on a hypothesised method of installation of the drainage apparatus of A2, without any evidence that this method had ever been used or that it was at all a reasonable method of installation. In fact, there was no suggestion in the cited prior art, nor in any of the declarations supplied by the proprietor during the opposition

proceedings, that the skilled person would install the drainage apparatus of A2 as suggested by the opposition division.

The final feature of claim 1 could not be derived from A2. This document only taught that, in use, the channel was supported by the concrete slab. It could not be derived from A2 that the hollow projections formed by spigots 3 and sockets 4 (Figure 1), or alternatively spigots 3, sockets 4 and downpipes 6 (Figure 2), would/could support the channel 2 and hold it at its intended use position relative to the pipe portion 5, before and during the installation of the drainage apparatus in a trench, in particular while pouring concrete around the channel section. In practice, this would be achieved only by use of additional means, such as a temporary support structure or a supporting formwork. The connection between spigots 3 and sockets 4 (Figure 1), or alternatively between spigots 3, sockets 4 and downpipes 6 (Figure 2), was just a fluid connection which did not necessarily imply that the hollow projections could bear the weight of the channel 2. Finally, even if the drainage apparatus in Figure 1 of A2 could be positioned onto the pipe 5 in such a way that the bottom of the channel 2 would rest on the upper edges of the sockets 4, in practice this configuration would be excluded for at least three reasons. Firstly, this configuration would not allow the installation of the channel 2 level and the pipe 5 with a fall, as instructed by A2. Secondly, this configuration would result in a limited space between pipe 5 and channel 2, so that a reinforcement for the concrete slab could not be passed above the pipe 5 and thus this configuration would create a risk of loading

damage in this area. Thirdly, this configuration would inevitably result in damage to the sockets 4 under heavy vehicle loads since the sockets would then have to bear at least a part of these loads.

Starting from A2, the effect of the final feature of claim 1 was an easy installation of the drainage channel section without alignment problems (paragraph [0014] in the patent specification). The problem solved by this feature over A2 could thus be seen as how to overcome the problems of alignment upon installation (see paragraph [0005] in the patent specification).

The claimed solution was not obvious in the light of A2. In particular, the skilled person had no motivation to modify A2 in the claimed manner since doing so would no longer allow adjustment of the projection heights and installation of the channel level and the pipe with a fall, as instructed by A2.

Appellant I's case:

A2 disclosed, in Figure 1, a drainage apparatus comprising all structural means defined in the preamble of claim 1, in particular hollow projections formed by spigots 3 and sockets 4. In the alternative drainage apparatus as shown in Figure 2 of A2, wherein downpipes 6 connect the spigots 3 to the sockets 4, the hollow projections were formed by the spigots, downpipes and sockets.

It could be derived from page 3, line 8 and Figure 1 of A2, that the channel 2 was intended to be installed onto the pipe 5 in such a way that the spigots 3 would

be completely inserted into the sockets 4 and the bottom of the channel 2 would rest on the upper edges of the sockets 4. Under the weight of the channel 2, the sockets 4 would then inevitably bear the weight of the channel 2, so that, in use, the longitudinal channel 2 would be supported by the sockets 4. A2 also disclosed other installed conditions of the draining apparatus, wherein the spigots 3 were adjusted partially out of the sockets (page 3, line 8 and Figure 1), or alternatively wherein downpipes 6 connected the spigots 3 and the sockets (page 3, lines 9 and 10 and Figure 2). In these other installed conditions, it was implicit that the projections formed by spigots 3 and sockets 4, or alternatively by spigots 3, sockets 4 and downpipes 6, held the channel 2 in its intended use position, as otherwise the channel, spigots and/or downpipes would move around while concrete was poured around the channel section. Thus, it was disclosed in A2 that, in use, the channel 2 was supported either by the sockets 4, or by the sockets 4 and spigots 3, or by the sockets 4, spigots 3 and downpipes 6. In conclusion, the drainage apparatus of A2 disclosed also the final feature of claim 1.

Moreover, the drainage apparatus of A2 was suitable for being installed, without any constructional change, in such a manner that the channel 2 would rest on the sockets 4, see Figure 1 and page 3, line 8. For this reason too, the drainage apparatus of A2 would anticipate the final feature of claim 1.

Thus, the drainage apparatus of A2 disclosed all features of claim 1, so that claim 1 lacked an inventive step over A2.

Finally, the above arrangement wherein the channel 2 sits directly on the upper edges of the sockets 4 was the most probable arrangement when installing the drainage apparatus in Figure 1 of A2. In fact, any installation method of the drainage apparatus wherein the channel 2 would not sit on the sockets 4, at least in a transitional installation step, would not be technically sound since it would require the provision of additional means to hold the channel 2 in position and this was neither disclosed in A2 nor realistic.

Reasons for the Decision

1. The appeals are admissible.

2. Admissibility of the ground of lack of novelty

2.1 In its notice of opposition, the opponent requested revocation of the patent as a whole under Article 100(a) EPC for lack of novelty and inventive step.

2.2 It is stated in the minutes of the oral proceedings before the opposition division that, at the start of the oral proceedings, the opposition division asked the opponent "whether he would be further pursuing the novelty objection raised in the Notice of Opposition" and that "the Opponent replied that he was dropping his novelty objection, preferring to move immediately to the question of the presence of inventive step" (see point 2 of the minutes).

2.3 The board considers that, by way of this declaration, the opponent expressly renounced its challenge to the patent on the ground of lack of novelty.

The ground of lack of novelty is thus a fresh ground of opposition which cannot be considered in the appeal proceedings, since the proprietor (here appellant II) objected to its re-introduction (see G 10/91).

2.4 The opposition division also understood this declaration to mean that the ground of lack of novelty was withdrawn, since the appealed decision is silent with respect to novelty. In fact, the opposition division held that the parties agreed that the subject-matter of claim 1 differed from A2 only in that the longitudinal was supported by the projections (see appealed decision, point 2.1 of the reasons).

2.5 Appellant I did not contest the correctness of the minutes but rather the above interpretation of its declaration. Appellant I argued that its declaration just meant that, to shorten the oral proceedings, the opponent had preferred to move directly to the question of inventive step and not to argue against novelty orally, whereby the opponent had reserved its right to present its novelty objection if need be. Thus, according to appellant I, the above declaration was a conditional withdrawal of its novelty objection and not a binding withdrawal. In fact, the declaration being open to interpretation, the opposition division should have clarified whether or not the opponent abandoned the ground of lack of novelty.

This argument is not convincing. On its ordinary and plain reading the above declaration by the opponent made it clear that the opponent dropped, i.e. abandoned, its objection of lack of novelty. Thus, no further clarification was required by the opposition division.

3. Admissibility of a product allegedly based on A2

3.1 In its reply to the statement of grounds of appeal of appellant II, appellant I said that it had received a drainage channel section in conformity with A2 from the patent owner of A2 and it intended to demonstrate in the oral proceedings how this drainage channel section could be used to support its allegations of lack of inventive step. At the oral proceedings, appellant I requested that this product be admitted into the proceedings because it was *prima facie* as relevant as A2.

3.2 This product allegedly based on A2 constitutes independent prior art which is late-filed as it could have been presented in the opposition proceedings. Indeed, the reference to this product constitutes neither a reaction to new facts, arguments or evidence relied on by appellant II nor a reaction to the appealed decision but rather an attempt to support appellant I's argument of lack of inventive step, on which the appealed decision was already based.

In fact, appellant I intended to use this product only to demonstrate that, in the drainage apparatus as illustrated in Figure 1 of A2, the channel 2 is suitable for being directly supported by the sockets 4 when the spigots 3 are fully inserted therein, as

argued by appellant I. This argument is easily understandable from A2, without the need for demonstration. Hence, the product is *prima facie* not more relevant than A2 taken alone.

Finally, it has not been proven that the product was public prior art and that it is in conformity with the teaching of A2. Appellant I did not provide any evidence in support of these allegations, even though appellant II contested them.

Therefore, the Board exercised its discretion under Article 114(2) EPC and Articles 12(4), 13(1) and (3) RPBA to not admit this product into the appeal proceedings, as well as to not admit the demonstration of this product during the oral proceedings.

4. Interpretation of claim 1

4.1 The interpretation of the final feature of claim 1 was disputed by the parties. Before turning to the question of inventive step, it is essential to decide how this feature is to be construed.

4.2 In this respect, it is established case law that a skilled reader, when considering a claim, should try to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent, thereby ruling out interpretations which are illogical or which do not make technical sense. Of course, this does not mean that the disclosure of the patent may be used to give a different meaning to a claim feature which itself

imparts a clear credible technical teaching to the skilled reader.

4.3 Thus, in the present context, it is clearly not permissible to read the final feature of claim 1 alone, i.e. isolated from the other features of claim 1. This feature must be read in combination with all other features of claim 1 in an attempt to make technical sense out of the claim.

4.4 On a normal reading, claim 1 requires *inter alia* that the projections communicate with the pipe portion and that the longitudinal channel is supported by and communicates with the projections and defines a longitudinal slot that lies, in use, in a surface to be drained. From this it follows clearly that the projections support the longitudinal channel at an intended position relative to the pipe portion, which position is such that the longitudinal slot defined by the channel, in use, lies in a surface to be drained. Hence, the final feature of claim 1, when read in combination with all other features of this claim, implies that the projections support the channel at its intended use position relative to the pipe portion. In this context, the term "support" is clear and, in the absence of any other specific indication in the claim, it can only be given its normal meaning of "bear the weight" or "keep/hold in position".

4.5 The above understanding of the final feature of claim 1 is confirmed by the teaching in the patent specification: see paragraphs [0012], [0013] and [0014] and the illustrated embodiments, especially paragraphs [0025] and [0029] and Figures 1 and 2. In particular,

the patent specification makes clear that the final feature of claim 1 enables an easy installation of the drainage channel section as a whole in one step, without the problem of aligning/levelling the channel relative to the pipe portion *in situ* (see paragraph [0014], referring back to "the alignment problems of Hodkin & Jones two part channels" as defined in paragraph [0005]; see paragraphs [0034] to [0037] describing the installation of the claimed channel section). In practice, thanks to the final feature of claim 1, the channel is always correctly positioned relative to the pipe portion and, *in situ*, the channel can be simply aligned/levelled with the surface to be drained by adjusting the pipe portion against the base of the trench (see paragraph [0021], col. 4, lines 25-28 and paragraph [0036], col. 6, lines 15-17).

4.6 The opposition division and appellant I took the view that the final feature of claim 1 could be read as describing a transitional arrangement of the drainage section that only existed upon installation of the drainage section. Moreover, appellant I held that the final feature of claim 1 could be read as a functional feature meaning merely that the channel shall be suitable for being supported by the projections. These interpretations, however, are not in conformity with the above understanding of the claim. In fact, these interpretations appear to be derived from the wording of the final feature of claim 1 read alone, disregarding its context, and are considered not technically sound.

5. Inventive step vs. A2

5.1 In the disputed patent, the claimed invention addresses the problems of limited hydraulic efficiency of drainage channel systems, of weakness in the load bearing concrete slab covering such systems in use and of alignment/levelling during the installation of such systems, see paragraphs [0003] to [0010] in the patent specification. It follows from the patent specification that the drainage channel section as claimed is easy to install without alignment/levelling problems (see section 4.5 above) and provides a high hydraulic efficiency without creating weakness in the load bearing slab, since slab reinforcements can be passed through the openings which are created between the spaced projections, the channel and the pipe portion, see e.g. paragraphs [0014] and [0015].

5.2 Appellant I contends that the subject-matter of claim 1 lacks an inventive step over A2.

5.3 A2 discloses a drainage apparatus for surface drainage. It is undisputed by the parties that this drainage apparatus forms a drainage channel section according to the preamble of claim 1. In particular, the drainage apparatus in Figures 1 and 2 of A2 comprises: a longitudinally extending pipe portion 5; a plurality of longitudinally spaced hollow projections formed by spigots 3 and sockets 4 (Figure 1), or alternatively by spigots 3, sockets 4 and downpipes 6 of varying length (Figure 2), wherein the hollow projections communicate with the pipe portion 5; and a longitudinal channel 2 which communicates with the projections and defines a

longitudinal slot that lies, in use, in the surface to be drained.

5.4 The parties have however disputed whether A2 discloses the final feature of claim 1, namely that "said longitudinal channel is supported by said projections". The board considers that A2 does not disclose this feature, as interpreted above, for the following reasons:

5.5 With respect to the supporting of the channel, the only information which can be derived from A2 is that the channel "is supported by concrete or other material under the channel" (see page 3, lines 23-24) or "by concrete 9 and steel reinforcing 10 placed between channel 2 and pipe 5" (see page 5, lines 10-12).

5.6 There is no disclosure in A2 that the channel is intended to be installed so that it rests on the upper edges of the spigots, as argued by appellant I, even though it is stated on page 3, line 8 of A2 that "channel spigots can be adjusted partially out of pipe sockets". This feature can also not be derived from the schematic representation in Figure 1.

In fact, A2 is mainly concerned with the problems of the flow in a drainage channel being "impeded or stopped completely by debris in the channel" and of achieving a fall in a drainage channel in a concrete slab (see page 2, lines 15-23). A2 teaches that these problems are overcome or reduced *inter alia* by adjusting the spigots partially out of the sockets, or alternatively by connecting spigots and sockets via downpipes of varying length, as "this allows the

channel to be installed level and the drain pipe to have sufficient fall to be self cleaning" (see page 3, lines 8-12). Thus, A2 teaches away from installing the channel so that it rests on the spigots, since this would not allow "the channel to be installed level and the drain pipe to have sufficient fall to be self cleaning". For this reason, such an installation method clearly is not disclosed in A2.

In the light of this teaching of A2, the statement on page 3, line 8 of A2 that "channel spigots can be adjusted partially out of pipe sockets" only defines the ability of the spigots to be adjusted partially out of the sockets. It cannot be inferred from this statement that, in use, the spigots may be completely inserted into the sockets, as argued by appellant I.

5.7 There is also no disclosure in A2 that the hollow projections formed by spigots and sockets (see page 3, line 8 and Figure 1), or alternatively by spigots, sockets and downpipes (see page 3, lines 9-10 and Figure 2), support/hold the channel in its intended use position above the pipe portion. In fact, there is no hint that these projections have any supporting function beyond their draining and height adjusting functions. More precisely, the connection between spigots and sockets, or alternatively between spigots, sockets and downpipes, is just a fluid connection and it cannot be derived from A2 that this connection is inherently adapted to hold the channel in its intended use position above the pipe portion. Finally, since the ability to easily adjust the height of the projections by sliding the spigots in the sockets or by using connecting downpipes of varying length is presented as

essential in A2 (see section 5.6 above), appellant II's argument can be accepted that it is implicit in A2 that in practice the channel must be supported, upon installation and pouring the concrete, by additional means, such as a temporary support structure or a supporting lost formwork.

5.8 The Board can accept appellant I's argument that the drainage apparatus of A2 is a promising starting point for the assessment of inventive step, in particular because, as with the claimed invention, the apparatus of A2 provides a high hydraulic efficiency without creating weakness in the load bearing slab. Indeed, the drainage apparatus of A2 allows the efficient draining of surface water from the channel to the pipe portion via the hollow projections (see page 2, lines 27-29, page 3, lines 14-16 and page 5, lines 13-14) and also the placing of slab reinforcements between the channel and the pipe portion (see page 5, lines 10-12 and Figure 2, in particular steel reinforcing 10).

5.9 The effect of the final feature of claim 1, which distinguishes claim 1 from A2, is that the channel section is easily installed without the alignment/levelling problem (see section 4.5 above). Thus, the objective technical problem solved by this feature over A2 is to ease installation (see also paragraphs [0003] and [0004] in the patent specification).

5.10 For a skilled person starting from A2 and facing this objective technical problem, it was not obvious to arrive at the claimed solution.

5.11 Firstly, the skilled person gains no indication from A2 itself to solve the objective technical problem in the claimed manner. In fact, A2 does not address the objective technical problem but is mainly concerned with the above mentioned flow and fall problems (see section 5.6).

5.12 Secondly, A2 leads away from the claimed solution since it teaches that these flow and fall problems are overcome or reduced by adjusting the spigots partially out of the sockets, or alternatively by connecting spigots and sockets via downpipes of varying length (see section 5.6 above). Hence, in A2, the adjustment of the height of the projections is presented as essential. Therefore, starting from A2, the skilled person would not modify the connection between spigots and sockets (see Figure 1), or alternatively between spigots, sockets and downpipes (see Figure 2), so that the projections can support/hold the channel in its intended use position, as in the claimed invention, since doing so would inevitably remove the ability to easily adjust the height of the projections by sliding the spigots in the sockets or by using downpipes of varying length, as instructed in A2.

5.13 Thirdly, as reasoned above in section 4.5, the skilled person will certainly not consider installing the drainage apparatus of A2 so that, in use, the channel rests directly upon the sockets, since this would go directly against the thrust of the teaching of A2 that the channel is installed level while the pipe portion has sufficient fall to be self cleaning.

5.14 In conclusion, the subject-matter of claim 1 involves an inventive step over A2, so that the request of appellant II 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 opposition division with the order to maintain the patent as granted.

The Registrar The Chairman

C. Spira U. Krause