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**Datasheet for the decision
of 26 July 2013**

Case Number: T 2098/11 - 3.2.05

Application Number: 04801584.6

Publication Number: 1725805

IPC: F16S3/00

Language of the proceedings: EN

Title of invention:

Molded article with metal reinforcing and method for its
manufacture

Applicant:

Keter Plastic Ltd.

Headword:

Relevant legal provisions:

EPC 1973 Art. 111(1)
EPC Art. 123(2)
RPBA Art. 13(1), 13(3)

Keyword:

Late filed request - admitted (yes)
Amendments - added subject-matter - main request (no)
Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2098/11 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 26 July 2013

Appellant: Keter Plastic Ltd.
(Applicant) 2 Sapir Street, Industrial Area
Herzelyia 46852 (IL)

Representative: Paolo Banfi
Bianchetti Bracco Minoja S.r.l.
Via Plinio, 63
20129 Milano (IT)

Decision under appeal: Decision of the examining division of the
European Patent Office posted on 7 April 2011
refusing European patent application No.
04801584.6 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: M. Poock
Members: P. Lanz
G. Weiss

Summary of Facts and Submissions

- I. The appeal of the patent applicant (appellant) is against the decision of the examining division to refuse the application because the added feature *"wherein said plastic coating forms ribs along at least a portion of the inner side of the reinforcing element at the open side of the channel"* present in independent claims 1 and 24 of the only set of claims on file did not comply with the provisions of Article 123(2) EPC.
- II. In the statement setting out the grounds of appeal the appellant requested that the appealed decision be set aside, since the objected feature was clearly and unambiguously disclosed in the drawings of the application as filed.
- III. In the annex to the summons to oral proceedings dated 7 May 2013, the board expressed the preliminary view that the application as originally filed did not provide a clear and unambiguous basis for the disputed feature.
- IV. With letter received on 26 June 2013 the appellant filed a new main request and new first and third auxiliary requests, while maintaining the previously filed set of claims as second auxiliary request.
- V. On 23 July 2013 the board informed the appellant by telephone that the main request would be admitted into the proceedings and that its claims met the requirements of Article 123(2) EPC. It was the board's intention to set aside the impugned decision and to remit the case for further prosecution to the department of first instance. During the telephone

conversation it was also mentioned that the concerns regarding the second auxiliary request remained.

VI. With telefax dated 24 July 2013 the appellant withdrew the second auxiliary request. It was requested that the decision be set aside and that the case be remitted to the department of first instance for further prosecution on the basis of the main request or the first or third (renumbered as new second) auxiliary request on file.

VII. The independent claims of the main request read as follows:

"1. A composite article, suitable to be incorporated in various constructive elements and products, comprising a metal reinforcing element (12) and a molded plastic coating (14), made by injection molding, firmly attached thereto, wherein said reinforcing element is formed to define an open channel (16) having a longitudinal axis and an open side (5) parallel to said axis, and said plastic coating includes a portion formed as a relatively thin wall (18) mechanically closing said open side of the channel."

"24. A method for manufacturing the composite article of Claim 1, where the form of said metal reinforcing element allows insertion, via the open side of the channel, of a mold core snugly fitting said reinforcing element, the method including:

- providing said metal reinforcing element ;
- providing said mold core;
- providing a mold comprising at least two parts formed to define a mold cavity therebetween when the mold is assembled, said mold being adapted to accommodate said metal reinforcing element fixedly

- in said cavity, allowing space for said plastic coating;
- inserting said mold core in said metal reinforcing element via said open side, so that said mold core snugly fits said element ;
 - assembling said mold parts and said metal reinforcing element with the inserted core therein so as to fix said reinforcing element in the cavity of said mold;
 - injecting flowable and settable plastic coating into said space to form said composite article;
 - releasing the obtained article including the reinforcing element, the set plastic coating and said mold core, by disassembling said mold ; and
 - removing said mold core from said article in direction along said channel axis."

VIII. The arguments of the appellant can be summarized as follows:

Claim 1 of the main request differed from claim 1 as originally filed in that following features were added, wherein each of the added features had a proper basis in the application as filed:

"suitable to be incorporated in various constructive elements and products" (cf. page 8, lines 7 and 8 of the application as filed),

"made by injection molding" (cf. page 6, lines 11 and 21 of the application as filed),

"relatively thin wall" (cf. page 8, line 1 of the application as filed).

The requirements of Article 123(2) EPC were thus met for the main request.

Reasons for the Decision

1. Admissibility of the main request
 - 1.1 According to Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA), any amendments to a party's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion, wherein the discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

Moreover, Article 13(3) RPBA requires that amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues the board cannot reasonably be expected to deal with without adjournment of the oral proceedings.
 - 1.2 In the present case, the appellant filed the claims according to the main request after having been summoned to oral proceedings and informed of the board's preliminary opinion. It is noted that in the main request the feature considered unallowable by the board is deleted from both independent claims and replaced by features which have a clear and unambiguous basis in the application as originally filed. Hence, the main request filed in advance of the oral proceedings constitutes a serious attempt to overcome the objections expressed in the annex to the summons to oral proceedings. Moreover, it is provided with reasons in support thereof. Finally, in view of the provisions

of Article 13(3) RPBA, the board is satisfied that it is able to deal with the request in substance without adjournment of the scheduled oral proceedings. The main request filed on 26 June 2013 is thus admitted into the proceedings.

2. Added subject-matter

The wording of present claim 1 according to the main request essentially differs from the originally filed version in that following features were added:

"suitable to be incorporated in various constructive elements and products",

"made by injection molding",

"relatively thin wall".

Each of the added features has a clear and unambiguous basis in the patent application as filed. Particular reference is made to page 8, lines 7 and 8, page 6, lines 11 and 21 as well as page 8, line 1 in combination with the cross-sectional drawings of the application. The board is also satisfied that, for a person skilled in the art, the features of present claim 1 were originally disclosed in combination.

Compared to the originally filed application, claims 2 to 30 are unamended.

The claims according the main request are thus in line with the provisions of Article 123(2) EPC.

3. Remittal to the department of first instance

As regards the main request, the ground for refusing the application has been overcome. The decision of the examining division is therefore set aside. The board notes that claim 1 of the main request includes features taken from the description. Hence, it cannot be established whether the amended subject-matter has been fully searched and examined. Under these circumstances, the board considers it appropriate to follow the appellant's request and to exercise its discretion under Article 111(1) EPC 1973 to remit the case to the examining division for further prosecution.

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 for further prosecution.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated