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**Datasheet for the decision
of 9 June 2015**

Case Number: T 0138/13 - 3.2.01

Application Number: 03799047.0

Publication Number: 1545920

IPC: B60J10/08, B60J10/10,
B60J10/00, B60J10/04

Language of the proceedings: EN

Title of invention:
SEALING, TRIMMING OR GUIDING STRIPS

Patent Proprietor:
Henniges Automotive Sealing Systems
North America, Inc.

Opponent:
Cooper Standard GmbH

Headword:

Relevant legal provisions:
EPC Art. 123(2), 56

Keyword:
Amendments - added subject-matter (no)
Priority validly claimed (yes)
Inventive step - (yes)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0138/13 - 3.2.01

**D E C I S I O N
of Technical Board of Appeal 3.2.01
of 9 June 2015**

Appellant:
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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
21 November 2012 concerning maintenance of the
European Patent No. 1545920 in amended form.**

Composition of the Board:

Chairman G. Pricolo
Members: Y. Lemblé
P. Guntz

Summary of Facts and Submissions

- I. The appeal of the Opponent is directed against the interlocutory decision of the Opposition Division, posted on 21 November 2012, to maintain European patent No. 1 545 920 in amended form.
- II. In its decision, the Opposition Division held that the claims amended in accordance with the third auxiliary request filed with letter dated 10 July 2012 met the requirements of Article 123 EPC and that the subject-matter of the amended claims met the requirements of novelty and of inventive step having regard to the prior art cited by the Appellant/Opponent.

In coming to this conclusion, the Opposition Division considered, *inter alia*, that the method of claim 1 according to this request was entitled to the priority GB 0222817 (PD1), dated 2 October 2002.

- III. In its written statement setting out the grounds of appeal the Appellant referred to prior art already cited in opposition proceedings, namely documents D1 (US-A-4 908 989), D9 (EP-A-0 895 494), and the alleged prior use of a sealing strip according to documents D10a-D10d and D11 in connection with the car model VW-Touran (prior use "VW Touran") which was introduced into the market in February 2003. The Appellant invoked for the first time the prior use of a sealing and guiding strip (hereinafter called prior use "VW Phaeton") which, according to the allegations of the Appellant, was mounted on the back door of a VW-Phaeton, a car model which was on the market from May 2002 onwards and was manufactured according to the teaching of method claim 1. In support of these

allegations, the Appellant offered the testimony of Mr. Stefan Hemauer and presented the following documents:

D12a: Extract from Wikipedia "VW Phaeton"

D12b: Drawing of guiding strip in the region of the rear door of a VW Phaeton.

IV. Oral proceedings were held on 9 June 2015.

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

The Respondent (Patent Proprietor) requested that the appeal be dismissed.

V. Claim 1 of the patent as maintained by the Opposition Division reads as follows (delimitation of features as proposed by the Appellant):

A method of forming a sealing, trimming or guiding strip for a window frame,

1.1 the strip comprising

1.1.1 a length of material (19) forming part of the strip, and which includes a channel (23) for receiving a flange (25) of the window frame and a rigid reinforcing carrier (31) embedded within the material (19) in the region corresponding to the channel (23); and

1.1.2 the strip further comprising a first window pane (58) receiving surface for the interior side of the window pane (58),

1.1.3 a second window pane (58) receiving surface for the exterior side of the window pane (58) and

1.1.4 a generally oppositely facing surface directly visible from the exterior of the vehicle when mounted;

1.2 the method including

- 1.2.1 extruding the material (19) to form said length;
- 1.2.2 removing a portion of the extruded material along part only of said length; and
- 1.2.3 replacing the said portion with moulded material (63,93,103,107,200) which is moulded onto and thereby connected to the extruded material (19),
- 1.2.4 the channel (23) remaining as part of the strip after removal of said portion of the extruded material;
- 1.2.5 wherein the moulded material (63,93,103,107,200) forms the first window pane (53) receiving surface and
- 1.2.6 wherein the extruded material (19) extends from the channel (23) and forms the second window pane (58) receiving surface and the generally opposite facing surface,
- 1.2.7 these two surfaces of the extruded material also remaining as part of the strip after removal of said portion of the extruded material.

VI. The Appellant's submissions can be summarised as follows:

Claim 1 of the patent was amended in such a way that it contained subject-matter which extended beyond the content of the application as originally filed (Article 123(2) EPC). More particularly, features 1.1.2, 1.1.3 and 1.1.4 of claim 1 could not be directly and unambiguously derived from the content of the application as originally filed (E3: WO 2004/030965). Nowhere in the originally filed documents was there any basis for the wording of the following features: "a receiving surface for the interior side of the window pane", "a receiving surface for the exterior side of the window pane" and "a generally oppositely facing surface directly visible from the exterior of the vehicle when mounted". Moreover, features 1.1.2 to 1.1.4 were structural characteristics of the strip

itself and, when construed in combination with features 1.2.5 to 1.2.7 of claim 1, related to the position of the extruded portion and of the moulded portion in a particular zone which coexisted with the window pane of the quarter light window 11 only. These features were not disclosed in E3 in the general context of the claimed method for forming the strip. Thus, the introduction of these features in method claim 1 led to an intermediate generalisation which contravened the dispositions of Article 123 (2) EPC.

Since the requirement for claiming priority of the same invention in respect of claim 1 was similar to the requirement in respect of Article 123 (2) EPC (see G 2/98, OJ EPO 1990, 413), method claim 1 was not entitled to the priority date of 2 October 2002. For the same reasons as explained above in respect of the admissibility of the amendments under Article 123(2) EPC, the method of claim 1 could not be derived directly and unambiguously from the previous priority documents PD1. The prior use "VW Touran" was therefore a prior art within the meaning of Article 54 (2) EPC and it took away the novelty of method claim 1.

The method according to claim 1 lacked an inventive step in view of document D9 and either the knowledge of the person skilled in the art or the teaching of document D1.

Starting from the method of forming a sealing and guiding strip as shown in document D9, the claimed method was only distinguished therefrom in that

- a portion of extruded material was removed before its replacement by the moulded portion, and
- the moulded portion was located on the interior side of the window pane.

Paragraph [0029] of D9 explicitly mentioned that it was advantageous to use the moulded part either on the inwardly and/or on the outwardly facing surface of the strip. Thus, there was no inventive step involved in locating the moulded portion on the interior side of the window pane and forming there a window pane receiving surface.

Looking at the cross-sectional views according to Fig. 2 and Fig. 3 of D9, the skilled person would readily recognise that one of the different sections (Fig.2) of the extruded strip could readily be obtained by simply removing a portion of extruded material along a part of the length of the originally extruded strip (Fig. 3). Thus, although D9 did not explicitly mention the removal of a portion of the extruded material along part of the length of the strip, it was implicit or at least obvious to do so.

The contention made with the statement of grounds of appeal that the sealing strip of the prior use "VW Phaeton" was manufactured according to the teaching of method claim 1, was *prima facie* highly relevant. In fact, this prior use was novelty destroying. Moreover, the citation of documents D12a, D12b as well as the offer to hear the witness Hemauer represented sufficient substantiation of the allegation made . D12a proved that the invoked prior use was available to the public before the priority date of the opposed patent. In drawing D12b the extruded parts were colored in blue and the moulded parts in pink. A skilled person would clearly recognise that the sealing strip of that prior use was manufactured according to the teaching of method claim 1, i.e. that a portion of the extruded material was removed and replaced with moulded material. This could be confirmed by the witness.

VII. The Respondent (Patent Proprietor) countered essentially as follows:

The conclusion of the Opposition Division that the amended claims did not violate the requirements of Article 123(2) was correct. There was a clear basis for the amendments in the original disclosure E3. Independent claim 1 was clearly entitled to the priority date of 2 October 2002.

The method according to claim 1 involved an inventive step over the content of document D9 or the combination D9/D1.

The overall assertion made by the Appellant that the sealing or guiding strip according to the "prior use Phaeton" was formed in accordance with the features of claim 1, was not supported by the evidence adduced with the statement setting out the ground of appeal. The Board should disregard this prior use.

Reasons for the Decision

1. The appeal is admissible.
2. Admissibility of the amendments under Article 123(2) EPC
 - 2.1 The Board does not agree with the Appellant when it contends that the application as originally filed E3 does not provide a basis for the amendments in method claim 1.
 - 2.2 A general basis for method claim 1 is especially to be found in claims 21, 24, 36, 37 and 40 of E3 which also

refer to the method of forming the strip. On a reading of E3, the skilled person will automatically construe the structural features of the strip in conjunction with the method features for forming the strip. In this regard, the skilled person will also understand how the strip is mounted on the flange 25 of the window frame and how it is formed to receive the window panes. For obvious technical reasons (aerodynamic of the vehicle and air drag), he also knows how the window pane receiving surface has to be arranged with respect to the channel receiving the flange of the window frame. More particularly, claim 40 mentions that the extruded strip is provided with a glass pane receiving channel/recess (which is to be distinguished from the channel receiving the flange of the window frame). Moreover, in the paragraph bridging pages 5 and 6 of E3 it is stated that:

"The limb 43 carries a lip 53 extending towards lip 57 formed integrally on the extruded material defining the channel 23. Lips 53 and 57 together form a chamber or recess for receiving the edge of the window pane 58 of the window 9. Lip 53 contacts the **inside surface of the window pane 58** when the window is closed. Lip 57 contacts **the outer surface of the window pane 58.**" (bold characters by the Board)

It is therefore clear to the skilled person that the window pane 58 receiving channel/recess has a first window pane receiving surface for the interior side/surface of the window pane and a second window pane receiving surface for the exterior side/surface of the window pane (see Fig. 4-5 of E3). Thus, although there is no explicit basis for the wording: "a receiving surface for the interior side of the window pane", "a receiving surface for the exterior side of the window pane" this wording conveys the same technical

information disclosed in the application as filed, i.e. this wording does not introduce new subject-matter.

2.3 It is also to be noted that the expression "window pane receiving surface" is used in dependent claim 4 of E3 in relation to the moulded material (feature 1.2.5 of claim 1).

2.4 The paragraph bridging pages 5 and 6 of E3 clearly discloses that the lip 57 is formed integrally as part of the extruded material and forms part of the channel/recess for receiving the window pane 58. It is explained that the lip 57 contacts the outer surface of the window pane 58. It is also clear from Figure 4 and 5 of the drawings that the surface of the extruded material opposite to the window pane receiving surface for the exterior side of the window pane, which receiving surface is also made of the extruded material, is directly visible from the exterior of the vehicle. This is also explained on page 4 at lines 14 to 15 of E3, where it is stated:

"The continuously extruded part 19 forms the outer face of the strip, which is visible from the exterior of the vehicle."

Feature 1.1.4 has therefore a clear basis in E3.

2.5 The skilled person would also recognise that the channel/recess which receives the window pane 58 is the same as the one which receives the glass pane of the quarter light window and that, in the context of the method for forming the strip, it is not justified under Article 123 (2) EPC to require that features relating to the position of the window pane 58 and/or the quarter light window pane in that channel/recess be introduced in method claim 1. The method is clearly of

general nature and not limited to this particular arrangement(see also last paragraph of E3).

- 2.6 The Board concludes from the above considerations that features 1.1.2, 1.1.3 and 1.1.4 taken in combination with the features 1.2.5 to 1.2.7 of claim 1 have a basis in E3 and do not infringe Article 123(2) EPC.
3. The elements of E3 relied upon in point 3 above to demonstrate basis for claim 1 are all present in the priority documents PD1 of 2 October 2002. Hence for the same reasons independent claim 1 is entitled to the priority date of 2 October 2002. It follows that, even if the prior use "VW Touran" were confirmed, it would not belong to the prior art relevant for the assessment of novelty and inventive step since it allegedly took place after February 2003.
4. Inventive step
 - 4.1 The Appellant argued that, in view of the multiplicity of properties achievable nowadays by modern extrudable plastics materials as well as by modern plastics mouldings, replacing a portion of extruded material by a portion of moulded material on an extruded strip cannot justify an inventive step.

The Board does not share this view which is contradicted by the citation D9 itself. It is precisely for its good appearance and because of its mouldability (see D9: column 2, lines 35-42) that a thermoplastic material is moulded onto the face of an extruded sealing strip and that this moulding is intended to be located on the exterior face of the vehicle in use. The person skilled in the art knows that, in the field of sealing, trimming or guiding strips for a window frame of a motor vehicle, extruded parts are usually made of

a material (usually rubber or EPDM) that has particular properties (elasticity, flexibility, sealing ability) that moulded parts do not necessarily have (D9: column 4, lines 39-40) and that, vice-versa, moulded parts may have a mechanical strength and stability that cannot be easily obtained with extruded parts. If the skilled person chooses to use a particular material or a particular technique for forming such a strip, this choice is not arbitrary but motivated by specific reasons. It is with these considerations in mind that the question of inventive step should be appreciated and the method of claim 1 be construed.

In this respect, the Board also cannot agree with the Appellant when it contends that features relating to the mounting of the strip on the window frame of the vehicle have no bearing when examining patentability of the method for forming that strip. Since according to feature 1.1.1 of claim 1 the extruded strip includes a channel for receiving a flange of the window frame, there are clear links between the method features, the structure of the strip and the positioning of the strip with respect to the window frame. How the strip is mounted on the flange of the window frame and is formed to receive the window panes is clearly of technical significance (for example with respect to the aerodynamic qualities and/or the external appearance of the vehicle) and cannot be ignored. All these technical aspects, referring to the way the strip is formed and how it is positioned in the window frame as well as with respect to the window pane, are necessarily reflected in the method features where they find their counterparts, and vice-versa.

4.2 As shown in Fig. 1 the strip of document D9 extends around the whole of the window frame, including both

openings 6,8 (see Fig. 1), and is obtained by moulding thermoplastic material (TPO) to form a strip of moulded material around the quarter side window and around the opening 6 for the movable window pane, whereby the whole of the moulded material is intended to be on the outside of the vehicle in use (paragraph [0008] of D9). The strip around the opening 6 comprises a section AB obtained by moulding TPO on the outer face of a first extruded part 54 (see Fig. 3 section III-III and paragraph [0017]), a section BC obtained by moulding TPO on the outer face of a second, separate extruded part 11 (see Fig. 2 section II-II and paragraph [0009]) and a moulded cross piece 9 which is common to both openings 6,8 (see also claim 1 of D9).

- 4.3 The Board agrees with the Appellant when it notes that D9 does not disclose features 1.2.2, i.e. to remove a portion of the extruded material along part only of the length of the extruded part. The Board, however, does not share the view of the Appellant that this feature was implicit or at least obvious from the content of D9. As shown in the sectional views of Fig. 2 and 3 of D9, it is not possible to obtain the extruded part 11 by removing a portion of the extruded material along the length of the extruded part 54 because part 11 comprises a lip 12 that is not present in part 54. Document D9 necessarily requires to extrude the first and the second parts 11,54 separately, each extending along a respective separate length of the strip. Thus, feature 1.2.2 cannot be derived from D9 and there is no reason in D9 to remove a portion of extruded material along part of the length of the strip, let alone to replace it by a moulded portion (see feature 1.2.3).
- 4.4 As already mentioned, there is in D9 the insistent recommendation to the skilled reader that the moulded

portion be on the outwardly facing surface of the strip because of its pleasing appearance (see paragraphs [0008], [0022], [0029] and [0032] of D9). This dissuades the skilled person to mould the moulding portion to form the first window pane receiving surface located on the interior side of the recess for the window pane (features 1.2.5, 1.2.6 and 1.2.7). Thus, the teaching of document D9 is not compatible with the claimed method.

4.5 Combination D9/D1

Document D1 apparently discloses that a portion of extruded material can be notched from an extruded strip 11 and partly be replaced by a moulding 19 (see Fig. 8). The notched portion 13 preserves a design lip 12 of the extruded strip such that the moulding 19 is located behind the design lip 12. The purpose of this, is to keep the pleasing appearance of the design lip 12 (column 3, lines 36-44). This teaching is not compatible with that of D9 which, as mentioned above, proposes that the moulded portion be on the outwardly facing surface of the strip because of its pleasing appearance. In fact, in D1 the notch 13 is made in the sealing and guiding strip 11 to permit the moulding of a moulded portion 19 which connects the strip 11 to a branched division bar 18 which is branched from the strip and has a glass-slide groove. Thus, the skilled person would not consider combining D9 with D1.

5. Admissibility of the prior use "VW Phaeton"

5.1 The Appellant submitted that the filing of material relating to this prior use in appeal proceedings was in reaction to the unexpected finding of the Opposition

Division that the position of the strip when mounted in the vehicle was relevant for inventive step. Even if this were the case, the filing of material relating to the prior use "VW Phaeton" would not constitute an appropriate reaction, as is explained hereinbelow, and thus the allegation of prior use filed with the statement of grounds of appeal is not admitted into the appeal proceedings pursuant to Article 12(4) of the Rules of Procedure of the Boards of Appeal.

- 5.2 According to established case law of the boards of appeal of the EPO, allegations of prior use are sufficiently substantiated if the submitted facts and the evidence presented make it possible to determine the date of the prior use, what has been used, and the circumstances relating to the alleged use (see e.g. T 328/87, OJ EPO 1992, 701).

As regards the object of the alleged prior use (i.e. "what has been used"), the appellant submitted its own drawing D12b made in 2013. This drawing is very schematic and hardly allows deducing any specific features of the strip or of the method for its manufacture. In the statement of grounds of appeal, the Appellant explained that the figures of D12b show that the prior used strip has all the essential features of claim 1, such as the cutting of a portion of extruded material, and the moulding of material onto the extruded material at the outer side thereof (see page 8 of the statement of grounds of appeal, first paragraph). This later statement was corrected by the Appellant during the oral proceedings, stating that clearly the "inner" rather than the "outer" side was meant. The Appellant further stated that the extruded material was shown in blue in D12b and the moulded material in pink (page 8, first paragraph, and page 12,

items aa and bb, of the grounds of appeal).

In the Board's view, irrespective of the correction made during the oral proceedings, these submissions represent a very summary description of the prior used object which, even taken in combination with the drawing D12b, does not allow an objective comparison between specific features of the object and those of the claimed subject-matter.

In the absence of a more detailed description of the allegedly prior used strip, it is not possible for the Board to objectively establish the relevance thereof to the claimed subject-matter.

The Appellant submitted that in the statement of grounds of appeal it was stated that the prior use had all the features of claim 1 and that this could be confirmed by the witness. However, whether an alleged embodiment shows all the features of a claim is a question of law and is to be answered by the Board. In contrast, it is the party's obligation to submit the facts, i.e. a detailed description of the embodiment so as to enable the Board to establish whether the features in question are given. Thus, pretending the existence of all features of a claim without submitting any details of the embodiment, is tantamount to requesting the Board to rely on the Appellant's (or the witness's) own assessment of the relevance of the alleged prior use, i.e. on the Appellant's own comparison of the specific features of the prior use with the features of the claim.

6. It follows from the above that the Appellant's arguments fail to convince the Board that the findings

of the Opposition Division in the decision under appeal are not correct. Accordingly, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

G. Pricolo

Decision electronically authenticated