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**Datasheet for the decision  
of 1 March 2016**

**Case Number:** T 1370/14 - 3.2.08  
**Application Number:** 08425591.8  
**Publication Number:** 2161402  
**IPC:** E06B1/02, E06B1/32, E06B1/56,  
E06B1/60  
**Language of the proceedings:** EN

**Title of invention:**

Prefabricated door or window frame unit with an insulating surround

**Patent Proprietor:**

Südtirol Fenster S.r.l.

**Opponents:**

HELLA Sonnen- und Wetterschutztechnik GmbH  
ROVERPLASTIK S.P.A./ALPAC S.R.L. UNIPERSONALE/  
WOLF FENSTER S.P.A.

**Headword:**

**Relevant legal provisions:**

EPC Art. 54, 56, 83, 84, 123(2)  
RPBA Art. 12(1), 12(4)

**Keyword:**

Novelty - (yes)

Inventive step - (yes)

Sufficiency of disclosure - (yes)

Claims - clarity (yes)

Amendments - added subject-matter (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 1370/14 - 3.2.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.08**  
**of 1 March 2016**

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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
23 April 2014 concerning maintenance of the  
European Patent No. 2161402 in amended form.

**Composition of the Board:**

**Chairman** I. Beckedorf  
**Members:** M. Foulger  
C. Herberhold

## **Summary of Facts and Submissions**

I. With the decision dated 23 April 2014, the opposition division found that, account being taken of the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it relates met the requirements of the EPC.

In particular the claims of the main request were found to be clear, the amendments met the requirements of Articles 123(2) and (3) EPC, and the subject-matter of independent claims 1 and 19 was found to be new and to involve an inventive step.

II. Appellant I (opponent 1) and Appellant II (opponent 2) filed appeals against this decision. The notices of appeal and the statements setting out the grounds of appeal were filed within the given time limits and in due form.

III. Oral proceedings took place before the Board of Appeal on 1 March 2016. Regarding the course of the oral proceedings, reference is made to the minutes.

IV. The appellants requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the appeals be dismissed, in the alternative, that in setting aside the decision under appeal, the patent be maintained in amended form on the basis of auxiliary requests I and II filed with letter of 21 January 2014, of auxiliary requests III to VII filed with letter of 19 January 2015, of the method claims according to the main request and auxiliary requests I to V, or of auxiliary requests IIa, IVa, Va

and VIa filed with letter of 1 February 2016.

V. Claim 1 of the main request reads as follows:

"[P1] Use of a counter-frame structure for door/window frames for insertion into an opening in an external wall (5) of a building, the counter-frame structure comprising:

[P2] - a counter-frame (10) for a door/window frame;

[P3] - an insulating surround (12) in a heat insulation material, which encloses the counter-frame (10) at least on the sides facing said wall (5) and the exterior of the building,

[C1] characterised in that said counter-frame (10) and insulating surround (12) are interconnected in such a way as to form a single block (1; 2) to be inserted in the opening in the wall (5),

[C2] at least a housing (18) for a box (40) of a blind (42,48) being made frontally, towards the exterior of the building, in an upper part (12') of the insulating surround (12),

[C3] wherein the wall (5) consists in part of masonry (6) and an external protective skin (7) and in which [C4] said insulating surround (12) is of such thickness as to extend between the internal side (5') and the external side (5") of the wall (5) in which the structure is inserted, [C5] such that the insulating surround extends frontally to the level of the skin (7) in such a way as to create a continuous insulation between the heat insulation material of the insulating surround (12) and that of the skin (7)."

(Feature references added by the Board.)

The remaining requests are not relevant for this

decision.

VI. The following documents are referred to in this decision:

E5 - DE 100 40 497 C1

E15 - EP 0 132 779 A2

E16 - DE 199 05 622 A1

E23 - FR 2 822 495 A1

VII. The appellants argued essentially the following:

a) Clarity (Article 84 EPC) and sufficiency of disclosure (Article 83 EPC)

The amendments made to claim 1 during the opposition proceedings resulted in a lack of clarity because it was not clear which parts of the wall were to be made of masonry. Moreover it was not clear whether the scope of the claim was intended to cover a wall consisting only of masonry and a protective skin or whether the scope also covered walls comprising partly masonry. Claim 1 was therefore not clear.

Moreover, the person skilled in the art could not carry out the invention because he did not know to what extent the wall should be of masonry. Thus the requirements of Article 83 EPC were also not fulfilled.

b) Article 123(2) EPC

The amendments to claim 1 were based partly on paragraph [0028] of the published application. Paragraph [0029] however followed directly on from this with the phrase "[t]o this end". The features of paragraph [0029] were therefore directly and inextricably linked with those of

paragraph [0028]. These features had however been omitted from claim 1. This omission constituted an unallowable intermediate generalisation.

The lack of clarity discussed above also meant that there was not an unambiguous disclosure of feature C3.

The requirements of Article 123(2) EPC were therefore not fulfilled.

c) Admission of E23 into the proceedings

E23 was prima facie relevant for the novelty of the subject-matter of claim 1. This document could not have been filed within the nine-month opposition period because the claim under consideration had only been filed one month before the oral proceedings before the opposition division.

d) Novelty

E15 disclosed the use of a counter-frame structure for door/window frames for insertion into an opening in an external wall of a building. As shown in Figs. 7 and 8, the counter-frame structure comprised a counter-frame 37 for a door/window frame 14 and an insulating surround 28,38,29 in a heat insulation material (page 8, 1st paragraph). It was implicit that the wall consisted in part of masonry. An external protective skin was shown as "Außenputz", 33. The counter-frame and insulating surround were interconnected in such a way as to form a single block - see claim 1 - and comprised a housing for a box of a blind 44. Thus all features of claim 1 were known from E15.

E23 disclosed the use of a counter-frame structure for



door/window frames for insertion into an opening in an external wall 4 of a building. As shown in Fig. 1, the counter-frame structure comprised a counter-frame 1 and an insulating surround 10,11. The further features of claim 1 such as the housing for a box of a blind were also shown in Fig. 1.

Therefore, the subject-matter of claim 1 was not new (Article 54 EPC).

e) Inventive step

E5 disclosed all features of claim 1 other than that the counter-frame structure was inserted into an opening in an external wall of a building. As could be appreciated in Fig. 1, the counter-frame was the face of the abutment 22 and the insulating surround was formed by the elements 3 and 22. E15 taught that it was possible to provide the counter-frame structure as a unit for insertion into an opening in an external wall of a building. Thus following this teaching would lead the person skilled in the art to the subject-matter of claim 1 without the exercise of inventive skill.

Moreover, the person skilled in the art would - starting from E23 - simply add an insulating skin as taught by E5, E15 and/or E16 and thereby arrive at the subject-matter of claim 1.

Furthermore, as was argued in the written proceedings, the subject-matter of claim 1 was obvious in view of E15, as closest prior art, in combination with the teaching of E5.

The subject-matter of claim 1 did not therefore involve

an inventive step in the sense of Article 56 EPC.

VIII. The respondent argued essentially the following:

a) Clarity (Article 84 EPC) and sufficiency of disclosure (Article 83 EPC)

Claim 1 was clear in the sense of Article 84 EPC. The construction of a wall consisting in part of masonry was well within the capabilities of the person skilled in the art who therefore would not have had any problem putting the invention into practice. Thus the requirements of Article 83 EPC were met.

b) Article 123(2) EPC

The features of paragraph [0028] of the application as originally filed could not be seen as inextricably linked to those of paragraph [0029] because paragraph [0029] specified that the insulating surround had a portion corresponding to the insulating skin and a portion corresponding to the masonry part. Both parts were in insulating material. In the drawings, the insulating surround was shown as being continuous right across the width of the window. Thus, this paragraph must be taken to mean that the insulating surround had the same width as the insulating skin and the masonry of the wall. This feature was however already present in feature C4 of the claim. Therefore, there was no intermediate generalisation.

The feature "consisting of a part in masonry" (paragraph [0028] of the application) meant the same as "consists in part of masonry" (in claim 1).

Thus these amendments did not introduce subject-matter

which went beyond that of the application as originally filed.

c) Admission of E23 into the proceedings

This document was late-filed. It was requested therefore that this document not be admitted into the proceedings.

d) Novelty

In E23, the frame 1 was not enclosed by the insulation material - in the lower part of the window the insulation was enclosed by the frame and in the upper part the frame extended around the insulation into the protective skin. Thus E23 did not disclose feature P3 of claim 1 whereby the counter-frame was enclosed by the insulating surround at least on the sides facing the wall and the exterior of the building.

E15 did not disclose feature P3 of claim 1 because the insulating surround was not enclosed by the counter-frame on the side facing the wall.

The subject-matter of claim 1 was therefore new.

e) Inventive step

E5 did not disclose the use of a structure for insertion into an opening because E5 concerned a window frame that was bricked around *in situ*. Moreover, E5 did not disclose a counter-frame. The term "frame" clearly implied some form of structure which a mere surface did not fulfill. The claim required that the counter-frame be enclosed by the insulating surround at least on the sides facing the wall and the exterior of the building. Thus the projecting part ("Anschlag" 22) could not be

regarded as being the counter-frame because it was not enclosed by the insulating surround on the side facing the exterior of the building.

The structure of E15 was completely different to that of E5 so that the person skilled in the art would not have considered that the teaching of this document could be applied to the counter-frame of E5. The same applied to the combination of the teaching of E5 and E15 starting from E15 as closest prior art.

Simply adding an extra insulation layer on the exterior to the window of E23 would not lead to the subject-matter of claim 1 because the frame 1 would still not be enclosed by the insulating surround on the side facing the wall.

The subject-matter of claim 1 therefore involved an inventive step.

## **Reasons for the Decision**

1. Articles 83 and 84 EPC

1.1 Article 84 EPC

The feature of claim 1 wherein the wall consists in part of masonry and an external protective skin, is in itself clear. Although the person skilled in the art is not told exactly to what extent the wall should consist of masonry, this feature is verifiable and the person skilled in the art would know whether such a wall fell within the scope of the claim. Claim 1 therefore meets

the requirements of Article 84 EPC.

1.2 Article 83 EPC

The person skilled in the art is a person from the building trades and as such would be able to build a wall consisting in part of masonry. The invention is therefore sufficiently disclosed such that the person skilled in the art would be able to carry it out.

2. Article 123(2) EPC

The features of claim 1 which are in dispute are C3 and C5.

Regarding C3, paragraph [0028] of the application as originally filed reads "wall 5 consisting of a part in masonry 6". This has been inserted in the claim as "wall 5 consists in part of masonry". The verb "consist" is used in patent practice at the EPO to denote a closed composition from which elements other than those listed were excluded. However, in the originally filed description merely at least part of the wall had to consist of masonry. In the claim under consideration this is also the case.

Feature C5 is based on paragraph [0028] of the application. Although paragraph [0029] starts "[t]o this end..", contrary to the appellant's view, the features of [0029] have not been excluded from the claim because they are already included in feature C4 which specifies that the insulating surround is of such thickness as to extend between the internal side and the external side of the wall. This is effectively the same information which is contained in paragraph [0029] which specifies that the surround has a frontal portion corresponding to

the width of the skin and a rear portion corresponding to the width of the masonry part - i.e. that the surround has the same width as the wall.

The amendments have not therefore introduced any subject-matter which extends beyond that of the application as originally filed. The requirements of Article 123(2) EPC are thus met.

3. Admission of E23 into the proceedings

This document was filed with the statement setting out the grounds of appeal and the Board saw no reason not to admit it into the proceedings (Article 12(4) in combination with Article 12(1) RPBA).

4. Novelty

4.1 E15 discloses a structure for a window frame for insertion into an opening in an external wall of a building (see Figs. 7 and 8). Here, if part 37 is viewed as the counter-frame then it is enclosed by an insulating surround 38 on the side facing the exterior of the building and by insulating surround 36 on the side facing the interior of the building. However on the side facing the wall, i.e. beneath part 37 in Fig. 7 or to the side of part 37 in Fig. 8, there is no insulating surround. Moreover, the insulating surround 36, 38 is not of such thickness so as to extend between the internal and the external sides of the wall in which the structure is inserted because it is interrupted by the counter-frame 37.

4.2 E23 describes a window with a metallic frame 1. This frame may be regarded as a counter-frame. E23 further describes insulation 22,23,24 around a box of a blind 6

and insulation 10,11 in the lower part of the window frame - see Fig. 1. However claim 1, feature P3, also requires that the counter-frame be enclosed by the insulating surround least on the sides facing the wall and the exterior of the building. The counter-frame 1 disclosed in E23 does not fulfill this condition because, in the upper part of Fig. 1, the counter-frame 1 is shown as extending around to the right hand side of the insulation 24 (see the arrows from reference 1 in this figure). Thus in this case the insulating surround does not enclose the counter-frame on the side facing the exterior of the building. Moreover, in the lower part of the window, the insulation 10 is shown as being enclosed by the counter-frame 1 (see the arrows from reference 1 in this figure) with the counter-frame being provided above and below the insulation. Here, there is no insulating surround enclosing the counter-frame neither on the side facing the wall, i.e. below the counter-frame, nor on the side facing the exterior of the building. Also, given the above, the feature that the the insulating surround extends frontally to the level of the skin in such a way as to create a continuous insulation between the heat insulation material of the insulating surround and that of the skin is also not disclosed in E23.

The subject-matter of claim 1 is therefore new (Article 54 EPC).

5. Inventive step

5.1 E5 as closest prior art

E5 discloses a structure for door/window frames which is designed to be installed and bricked around during construction, see paragraph [0018]. E5 does not however

relate to the use of a counter-frame structure for door/window frames for insertion into an opening in an external wall of a building as required by feature P1 of claim 1.

E5 moreover does not disclose a counter-frame within the meaning of the claim because feature C1 requires that the counter-frame and insulating surround are interconnected to form a single block. To be interconnected means that there are two distinct objects that are connected. It is to be noted that the complete projecting part ("Anschlag" 22) cannot be regarded as the counter-frame because then counter-frame would not be enclosed by an insulating surround on the side facing the exterior of the building - as required by feature P3 of the claim. Moreover the term "frame" requires some form of structure and this is not met by a mere surface.

The frame disclosed in E5 would have to be changed in construction as explained above and moreover the purpose of the window frame would have to be changed (from being bricked around to installed in an existing opening). Thus it can only be concluded that the teaching of E5 would have to be so radically altered that the person skilled in the art would not have had any motivation, even should E15 have been consulted, that would have led him to the subject-matter of claim 1. The subject-matter of claim 1 therefore involves an inventive step.

## 5.2 E15 as closest prior art

As discussed above E15 does not disclose the features P3 and C4 of claim 1 because the insulating surround does not enclose the counter-frame on the side facing the wall and because the insulating surround does not extend between the internal and external sides of the wall.



The problem to be solved is to improve the insulation of the arrangement of E15.

The skilled person would not however look to E5 for a solution to this problem because of the different purpose and the different construction of the window frame disclosed in this document.

The subject-matter of claim 1 therefore involves an inventive step starting from E15 as closest prior art.

### 5.3 E23 as closest prior art

Moreover, as discussed above, E23 does not disclose feature P3 in that the insulating surround does not enclose the counter-frame on the sides facing the wall, i.e. at the lower part of Fig. 1, and the exterior of the building, i.e. as shown in the upper right hand part of Fig. 1.

The problem to be solved may be regarded as being to improve the insulation provided by the window frame of E23.

E16 does indeed teach, column 1, 3rd paragraph, that modern buildings must comply with regulations on heat insulation (WSVO). It is also true that the person skilled in the art would seek to improve the building insulation. However simply adding insulation to the window shown in E23 would still result in the counter-frame not being enclosed on the side facing the wall.

Also the combination of the teachings of E23 and E15 would not lead the person skilled in the art to the subject-matter of claim 1 at least because both

documents fail to disclose that the insulating surround encloses the counter-frame on the side facing the wall.

Moreover, a combination of the teachings of E23 and E5 would not render the subject-matter of claim 1 obvious for the same reason as mentioned in point 5.1 above with regard to the different design of the frame according to E5.

Therefore the subject-matter of claim 1 involves an inventive step in the sense of Article 56 EPC.

## **Order**

### **For these reasons it is decided that:**

The appeals are dismissed.

The Registrar:

The Chairman:



C. Moser

I. Beckedorf

Decision electronically authenticated