

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 24 August 2017**

Case Number: T 2100/14 - 3.2.03

Application Number: 06764563.0

Publication Number: 1907641

IPC: E04B1/00, E04B5/40

Language of the proceedings: EN

Title of invention:

BALCONY STRUCTURE AND METHOD FOR MANUFACTURING IT

Applicant:

Insinööri-toimisto CM-Rakentajat OY

Headword:

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 12(4), 13(1), 13(3)

Keyword:

Amendments - extension beyond the content of the application as filed (yes) - deletion of features (yes)
Late-filed request - procedural economy - admitted (no) - request could have been filed in first instance proceedings (yes) - request withdrawn before the examining division

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 2100/14 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 24 August 2017

Appellant: Insinööritoimisto CM-Rakentajat OY
(Applicant) Mechelininkatu 39, A 7
FI-00250 Helsinki (FI)

Representative: Salomäki, Juha Kari Ensio
Salomaki Oy
Kankurinkatu 4-6
05800 Hyvinkää (FI)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 5 June 2014 refusing European patent application No. 06764563.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman C. Donnelly
Members: Y. Jest
D. Prietzel-Funk

Summary of Facts and Submissions

I. By its decision dated 5 June 2014 the examining division refused the European application Nr. 06764563.0 (based on International application PCT/FI2006/050339 published with the International Publication WO2007/006872 and claiming the priority from the Finnish application 20050749 filed on 13 July 2005). In its decision, the examining division held that the subject-matter of the independent product and method claims according to the main request as well as the four auxiliary requests did not meet the requirements of Article 123(2) EPC since it extended beyond the content of the application as filed.

The applicant (appellant) lodged an appeal against this decision in due form and time.

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, the Board gave a preliminary assessment of the case. The Board explained in detail why the definition of the subject-matter of claims 1 and 10 of the main and (first) auxiliary requests was considered to go beyond the disclosure of the application as originally filed.

By letter dated 4 August 2017 in reply to the board's communication, the appellant informed the board that nobody from appellant's side would attend the oral proceedings.

The oral proceedings were duly held as scheduled on 24 August 2017 in the absence of the appellant (Rule 115(2) EPC).

II. The appellant's requests from the written procedure are as follows:

- to set aside the contested decision and to grant a patent on the basis of the set of claims according to the main request filed with the grounds of appeal dated 2 October 2014 or, alternatively, on the basis of the set of claims according to a first auxiliary request filed with letter of 6 March 2015, or further alternatively,
- to remit the application to the examining division for further examination on the basis of the second auxiliary request filed on 4 August 2017.

III. Independent claims 1 and 10 of the three requests submitted by the appellant read as follows:

(the amendments in the auxiliary requests as compared to the main request are made visible by striking out or underlining):

(a) Main request

1. "A balcony structure (1) for a building, having at least a support structure (5 and/or 6), railing structures (3a, 3b, 4, 4a) and a pre-fabricated load-bearing structure formed by auxiliary reinforcements and concrete, which load-bearing structure has been fitted to form a composite slab acting as a balcony slab (2) with steel support beams (14), concrete and auxiliary reinforcements after the concrete cast has set, which balcony slab (2) has at its both ends a load-bearing support beam (14) having at least one horizontal flange (14a) and at least one vertical part (14b), characterized in that the height of the vertical part (14b) of the support beam (14) is substantially greater than the thickness of the concrete cast of the balcony slab (2)."

10. "A method for manufacturing a balcony structure (1), having at least a support structure (5 and/or 6), railing structures (3a, 3b, 4, 4a) and a pre-fabricated load-bearing structure formed at least by auxiliary reinforcements and concrete, which load-bearing structure consists after the concrete cast has set of a composite slab acting as a balcony slab (2) formed by the auxiliary reinforcements and concrete and supported by steel support beams (14) at its both ends, the steel support beams having at least one horizontal flange (14a) and at least one vertical part (14b), characterized in that the height of the vertical part (14b) of the support beam (14) is made substantially greater than the thickness of the concrete cast of the balcony slab (2)."

(b) First auxiliary request

1. "A balcony structure (1) for a building, having at least a support structure (5 and/or 6), railing structures (3a, 3b, 4, 4a) and a pre-fabricated load-bearing structure formed by auxiliary reinforcements and concrete, which load-bearing structure has been fitted to form a composite slab acting as a balcony slab (2) with steel support beams (14), concrete and auxiliary reinforcements after the concrete cast has set, which balcony slab (2) has at its both ends a load-bearing support beam (14) having at least ~~one horizontal flange 14a) and at least one~~ vertical part (14b), **characterized in that** the fixing elements of the balcony slab (2) have been fitted to the support beam (14), and that the height of the vertical part (14b) of the support beam (14) of the balcony slab (2) is substantially greater than the thickness of the concrete cast of the balcony slab (2)."

10. "A method for manufacturing a balcony structure (1), having at least a support structure (5 and/or 6), railing structures (3a, 3b, 4, 4a) and a pre-fabricated load-bearing structure formed at least by auxiliary reinforcements and concrete, which load-bearing structure consists after the concrete cast has set of a composite slab acting as a balcony slab (2) formed by the auxiliary reinforcements and concrete and ~~supported by~~ fastened to steel support beams (14) at its both ends, the steel support beams having at least ~~one horizontal flange (14g) and at least one vertical part (14b),~~

characterized in that the fixing elements of the balcony slab (2) are fitted to the support beam (14), and that the concrete cast of the balcony slab (2) is made substantially thinner than the height of the vertical part (14b) of the support beam (14) is made substantially greater than the thickness of the concrete cast of the balcony slab (2)."

(c) Second auxiliary request

1. "A balcony structure (1) for building, having at least a support structure (5 and/or 6), railing structures (3a, 3b, 4, 4a) and ~~a pre-fabricated load-bearing structure formed by~~ a self-supporting balcony slab (2), comprising a unit formed by at least a corrugated plate (10) of steel sheet mounted to be supported by steel support beams (14) and auxiliary reinforcement and concrete, which load-bearing structure has been fitted to form a composite slab acting as a balcony slab with steel support beams (14), concrete and auxiliary reinforcements after the concrete cast has set, which balcony slab (2) has at its both ends a load-bearing support beam (14) having at least one horizontal flange (14a) and at least one

~~vertical part (14b)~~ unit is adapted to form a connection plate of reinforced concrete after the concrete has set, in which the corrugated plate (10) of steel sheet is mounted in the longitudinal direction of the balcony, and wherein a load-bearing support beam (14) is provided at both ends of the balcony slab (2), said support beam having at least one horizontal flange (14a) and at least one vertical part (14b), **characterized in that** the height of the vertical part (14b) of the support beam (14) is substantially greater than the thickness of the concrete cast of the balcony slab (2)."

10. "A method for manufacturing a balcony structure (1), having at least a support structure (5 and/or 6), railing structures (3a, 3b, 4, 4a) and ~~a pre-fabricated load-bearing structure formed at least by auxiliary reinforcements and concrete, which load-bearing structure consists after the concrete cast has set of a composite slab acting as a balcony slab (2) formed by the auxiliary reinforcements and concrete and supported by steel support beams (14) at its both ends, the steel support beams having at least one horizontal flange (14a) and at least one vertical part (14b),~~ a self-supporting balcony slab (2), said balcony slab (2) being manufactured as a unit comprising at least a corrugated plate (10) of steel sheet and appertaining auxiliary reinforcement and concrete, said unit forming a connection plate of reinforced concrete after the concrete has set, in which the corrugated plate (10) of steel sheet is mounted in the longitudinal direction of the balcony, and wherein a load-bearing support beam (14) is provided at both ends of the balcony slab (2), said support beam having at least one horizontal flange (14a) and at least one vertical part (14b), and the

ends of the corrugated plate (10) are fitted to abut to the lower flange (14a) of the support beams (14),
characterized in that the height of the vertical part (14b) of the support beam (14) is made substantially greater than the thickness of the concrete cast of the balcony slab (2)."

IV. The substantive arguments advanced by the appellant in the statements setting out the grounds of appeal can be summarised as follows:

(a) Main request

The deletion of the features A and B:

- A) "a unit formed by at least a corrugated plate (10) of steel sheet mounted to be supported by steel support beams (14)"
- B) "in which the corrugated plate (10) of steel sheet is mounted in the longitudinal direction of the balcony"

from the independent claims 1 and 10 did not infringe the requirement of Article 123(2) EPC because these features relating to a corrugated plate were obviously non-essential for the definition of the invention as originally filed for the following reasons.

(i) Embodiment of figure 2

The basic type of the balcony structure in accordance with the invention was presented on page 4, line 16 to 18 in relation to figure 2. In this embodiment the load-bearing structure consisted of a connection plate 2 of reinforced concrete, serving as a balcony slab as

defined in the independent claims. The features A and B were not essential to this embodiment of the invention. The skilled reader would immediately understand that the embodiment of figure 3, which comprised a corrugated plate 10 in accordance with features A and B, was unambiguously directed to another embodiment of the invention, thus to an alternative to the slab shown in figure 2.

As mentioned above the solution according to figure 2 depicted one typical balcony structure in accordance with the invention. In that solution the load-bearing structure was a composite slab 2 of reinforced concrete, serving as a balcony slab. This solution did not mention a corrugated plate at all, and in reality the corrugated plate was not necessarily needed in composite slabs that were in general structural members composed of two or more dissimilar materials joined together to act as a unit. The corrugated plate was therefore not the only element that could be used to form composite slabs in the meaning of the invention.

(ii) Translation error

An error occurred when translating the originally-filed Finnish language PCT-application into English at page 5, lines 1 to 6 of the WO-publication.

The quoted text at page 5 of the WO-publication:

"Figure 3 shows ... a unit comprising a corrugated plate 10 of steel sheet, as known **e.g.** from Finnish publication FI 921642, or a corresponding corrugated plate mounted to abut to steel support beams 14..."

was not accurately translated because the term "e.g." was not in the right place. The correct translation reads:

"Figure 3 shows ... a unit comprising **e.g.** a corrugated plate 10 of steel sheet, as known from Finnish publication FI 921642, or a corresponding corrugated plate mounted to abut to steel support beams 14 ..."

The correct translation indicates clearly that the corrugated plate 10 was not essential, but only represented an option for the balcony structure.

The violation of Article 123(2) EPC, if any, was thus only due to the translation error and would be rendered obsolete by the appropriate corrected translation of the quoted passage of the description.

(b) First auxiliary request

The Finnish Patent Office, after reconsideration of the case, agreed with the applicant that the feature of a "corrugated plate" was not relevant to the invention as filed and therefore decided to grant the patent on the basis of a set of amended claims corresponding to the first auxiliary request on file.

The major amendment consisted in deleting the feature defining "at least one horizontal flange (14a)" from the preamble portion and in characterising the invention by the additional feature that "the fixing elements of the balcony slab (2) have been fitted to the support beam".

These amendments were supported by the description and by claims 3 and 12 as originally filed since the application obviously covered two alternative embodiments:

- a first embodiment corresponding to the described example with a balcony slab supported by the horizontal

flange (14a) of the support beam when using a corrugated plate in the slab structure (figure 3), and - another embodiment, wherein for example, the balcony slab is supported no longer by the horizontal flange, but by the threaded bars (22) when using other composite slab structures (figure 3).

The claims of the first auxiliary request were directed to this second disclosed embodiment and therefore did not contravene the requirement of Article 123(2) EPC.

(c) Second auxiliary request

The second auxiliary request corresponds in substance to the request filed in examination proceedings and is obviously able to meet the objection pursuant to Article 123(2) EPC since the features A and B have been integrated into the independent claims.

Reasons for the Decision

1. Main request and first auxiliary request

Features A and B of claim 1 as filed or as published in WO-A-2007/006872 (WO):

- A) a unit formed by at least a corrugated plate (10) of steel sheet mounted to be supported by steel support beams (14);
- B) in which the corrugated plate (10) of steel sheet is mounted in the longitudinal direction of the balcony"

are omitted in claim 1 of both the main and the first auxiliary requests.

Corresponding features of independent method-claim 10 as filed/published have also been deleted in independent claim 10 of both the main and the auxiliary requests.

- 1.1 In its decision to refuse the application, the examining division arrived at the conclusion that the omission of features A and B in the independent device and method claims constituted a violation of Article 123(2) EPC by applying the essentiality test referred to in the EPO Guidelines H-V, 3.1.
- 1.2 For the reasons detailed hereinafter, the board arrives at the same conclusion when applying the three-point essentiality test, namely that features A and B cannot be omitted in the independent claims without infringing Article 123(2) EPC (see Case Law of the Boards of Appeal, 8th edition, 2016, II.E1.1.2.4, page 409).
- 1.3 The mere fact that features A and B were specified in the preamble portion of the independent claims does not mean that the presence of a corrugated plate was not mandatory for the invention. A feature of the preamble portion of an independent claim is part of the definition of the claimed subject-matter which is deemed to solve the technical problem assessed in the application. Therefore, features A and B, relating to the corrugated plate, contribute to the definition of the invention as originally filed and are thus presented as essential in the application as originally filed.
- 1.4 The skilled reader understands from the introductory part of the application that the provision of a corrugated plate in the balcony slab provides important

advantages, such as reduction of manufacturing and mounting costs, which are presented as being the main aims of the present invention (see page 2, line 17 to 20).

The person skilled in the art further recognises that by providing a corrugated plate of steel sheet, especially if mounted in the direction specified by feature B, strength and fire resistance of the balcony slab are improved, which are also mentioned as being aims of the present invention (see WO publication, page 2, line 27 to page 3, line 1). The essential character of features A and B is also confirmed by the fact that feature B was comprised in the characterising portion of independent claim 10 as originally filed.

- 1.5 The general indication in the description (see page 3, line 17 to 23 of the WO publication or page 4, line 8 to 10 of the application as filed), that the "features of the different embodiments of the invention can also be applied in connection with other embodiments within the scope of the basic inventive idea" does not provide a basis for demonstrating that features A and B were presented as being non-essential.
- 1.6 The skilled reader also receives a clear indication that the presence of a corrugated plate is mandatory at the end of the description, page 8, line 5 to 7 of WO publication, where it is stated after a series of generalisations that "However, what is essential is that the ends of the corrugated plate 10 abut either directly or indirectly to the support beam 14".
- 1.7 The appellant argues that the balcony slabs shown in figures 2 and 3 concern two separate alternative embodiments; one with a corrugated plate (figure 3) and the other without (figure 3), thereby providing in its

opinion a basis for the disclosure of the invention without features A and B.

However, this argument is not convincing because the skilled reader unambiguously derives from the application that figure 3 does not illustrate a second and alternative embodiment, but rather is a top view of the same and unique embodiment of figure 2.

This interpretation is supported by the text at page 4, lines 30-31:

"Figure 3 depicts part of the balcony solution 1 in accordance with the invention in a simplified top view"

together with the definition given page 4, line 16 of the "solution 1":

"Figure 2 depicts a typical balcony solution 1 in accordance with the invention".

- 1.8 In summary, the board considers that, even if the description were not to mention features A and B explicitly as being essential, the person skilled in the art directly and unambiguously recognises that the balcony structure disclosed in the application requires a corrugated plate as defined by features A and B.

Therefore, the first criteria of the three-step essentiality test, which requires that the features were not presented as being essential in the disclosure is not met. Consequently, the requirements of Article 123(2) EPC are not met.

- 1.9 Erroneous translation from Finnish to English

- 1.9.1 The board agrees with the appellant concerning the correct position of English expression "e.g." in the sentence of lines 1 to 5 of page 5 of the published application WO ("a unit comprising a

corrugated plate 10 of steel sheet, as known e.g. from Finnish publication").

As requested by the appellant, the positioning of the expression "e.g.", which is obviously wrong in the published WO-text, is to be corrected within the terms of the translation dated 28 September 2012 made by the authorized translator Marja Hyssy and annexed to the applicant's letter of 1 October 2012 of the examination proceedings.

Consequently, the board agrees that the corrected text of page 5, lines 1 to 5 of WO should read:

"Figure 3 shows the balcony slab 2 which is the load-bearing structure of the balcony solution 1 in accordance with the invention and which is a unit comprising e.g. a corrugated plate 10 of steel sheet as known from Finnish publication FI 921642, or a corresponding ("vastaavan" = "equivalent") corrugated plate mounted to abut to steel support beams 14 at both ends, auxiliary reinforcement and concrete, said unit forming a connection plate ("liittolaatta" = "composite slab") known per se after the concrete has set."

1.9.2 However, the board disagrees with the interpretation made by the appellant of the teaching or content of the corrected text.

In the board's view, the sentence defines the components of the unit forming the balcony slab.

The skilled reader unambiguously derives from the text that the unit is defined as comprising three mandatory components listed as follows:

- **a corrugated plate**, either as known from FI publication or any other equivalent corrugated plate,
- **auxiliary reinforcement**, and
- **concrete**.

If the expression "**e.g.**" referring to "the corrugated plate 10 of steel sheet as known from Finnish publication FI 921642" applied also to the other features of the unit, that is "a corresponding ("vastaavan" = "equivalent") corrugated plate mounted to abut to steel support beams 14 at both ends, auxiliary reinforcement and concrete", as suggested by the appellant, the unit defined would be empty/void. Such an interpretation is clearly based on an erroneously applied syntax of the text. Moreover, the sentence as interpreted by the appellant would *de facto* lack any meaningful content.

Therefore, in the board's view, there can be no real doubt that the text unambiguously defines the list of the components forming the "*unit forming a composite slab known per se after the concrete has set*" as set out above

1.9.3 In conclusion, the corrected wording of the sentence at page 5, lines 1 to 5, does not form a basis for omitting from the amended claims the feature defining the corrugated plate of steel sheet comprised in claim 1 as filed.

1.10 The board took note of the appellant's argument that the Finnish Patent Office eventually reconsidered its position and agreed with the applicant that the feature of a "corrugated plate" was not relevant to the invention as filed and therefore decided to grant the patent on the basis of a set of claims corresponding to the first auxiliary request on file.

Besides the fact that decisions of national patent offices are in no way binding on the Boards of Appeal of the EPO (see for instance T2496/11), it is in the

present case not clear what kind of examination criteria the Finnish Patent Office applied and for which reasons it changed its first opinion and granted a patent on the basis of independent claims in which features A and B were omitted.

1.11 Thus, the board concludes that the grounds and arguments supporting the impugned decision of the examination division were correct, namely that independent claims 1 and 10 of the main request and of the first auxiliary requests infringed the requirements of Article 123(2) EPC.

2. Second auxiliary request

As indicated by the appellant, the set of claims of the second auxiliary request filed with letter dated 4 August 2017 corresponds to the set of claims submitted on 9 March 2009 during examination proceedings.

2.1 The board decides not to admit the second auxiliary request for the following reasons.

2.2 First it is to be noted that the second auxiliary request is late-filed and that the appellant has neither indicated the amendments made to the claims nor explained where these amendments find support for their disclosure in the application as originally filed. Consequently, the board is not in a position to conclude that the set of claims of the second auxiliary request *prima facie* meets the requirement of Article 123(2) EPC, unique ground of the contested decision. These deficiencies alone could lead to the non-admittance of the second auxiliary request.

Additionally, the board notes that in the event that the revised set of claims were to be finally considered as fulfilling the requirements of Article 123(2) EPC, the board would necessarily have to remit the case to the examining division for further examination as requested by the appellant.

The admission of such a belated request would therefore clearly contravene Articles 13(1) and (3) of the Rules of Procedure of the Boards of Appeal (RPBA).

2.3 Furthermore, the set of claims according to the second auxiliary request is a resubmitted request. Indeed, as confirmed by the appellant itself in the letter dated 4 August 2017, the same set of claims was submitted by the applicant with letter of 9 March 2009 during the examination proceedings.

This request was then withdrawn by the applicant of its own volition with letter dated 14 June 2010, prior to any examination of its merits by the examination division.

In application of the established case law (see Case Law IV.E.4.3.3.c, 8th edition 2016, page 1150) the board, by using its discretion pursuant to Articles 12(4) and 13 RPBA, decides not to admit the second auxiliary request which has been withdrawn during first instance proceedings.

If the board were to admit such a request, it would be contrary to the main purpose of ex-parte appeal proceedings, which are primarily concerned with examining the contested decision (cf. G 10/93, OJ 1995, 172), i.e. with providing the adversely affected party (the applicant) with the opportunity to challenge the decision on its merits and to obtain a judicial ruling as to whether the first-instance decision was correct (see also T 2278/08, T 1306/10).

Even if the withdrawal of the present second auxiliary request during the examination procedure were not considered an abandonment of this request for subsequent appeal proceedings, the fact that the request was withdrawn before the issue of a reasoned decision on its merits by the examining division means that reinstating this request upon appeal would compel the board either to give a first ruling on the critical issues, which runs contrary to the purpose of a second-instance ruling, or to remit the case to the department of first instance for further examination, which is clearly contrary to procedural economy.

It is precisely with the purpose of forestalling these unsatisfactory options that Art. 12(4) RPBA provides the board with the discretionary power to hold inadmissible requests which could have been presented (and examined) (or were not admitted) in the first-instance proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Spira

C. Donnelly

Decision electronically authenticated