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D E C I S I O N
of 16 March 1999

Case Number: T 0967/96 - 3.2.3
Application Number: 90830489.2
Publication Number: 0432105
IPC: E04B 2/96, E06B 3/54

Language of the proceedings: EN

Title of invention:
Aluminium section member building continuous front

Proprietor:
Metra Metallurgica Trafilati Alluminio S.p.A.

Opponent:
Schüco International KG

Headword:
-

Relevant legal provisions:
EPC Art. 56

Keyword:
"Inventive step - obvious combination of known features"

Decisions cited:
T 0410/91

Catchword:
-



Case Number: T 0967/96 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 16 March 1999

Appellant: Metra Metallurgica Trafilati Alluminio S.p.A.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 4 September 1996
revoking European patent No. 0 432 105 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: C. T. Wilson

Members: F. Brösamle
J.-P. Seitz

Summary of Facts and Submissions

- I. With decision of 4 September 1996 the opposition division revoked European patent No. 0 432 105 for reasons of Article 123(3) and 56 EPC.
- II. On 28 October 1996 the proprietor - appellant in the following - lodged an appeal against the above decision paying the appeal fee in due time and filing the statement of grounds of appeal on 2 January 1997.
- III. The appellant requested to set aside the impugned decision and to maintain European patent No. 0 432 105 in amended form.
- IV. The opponent - respondent in the following - requested to dismiss the appeal and by way of an auxiliary petition oral proceedings.
- V. In the communication pursuant to Article 110(2) RPBA dated 12 June 1997 the board gave its provisional opinion with respect to the requirements of Articles 123 and 100(c) EPC and also to Articles 56 and 100(a) EPC.
- VI. With telefax of 8 October 1997 (confirmation received on 15 October 1997) the appellant filed new corrected claims 1 to 3 which should form the basis for maintenance of the patent in amended form.
- VII. Claim 1 thereof reads as follows:

"1. A continuous front for buildings and the like, made of aluminium section members, said front comprising a main framework (1) including uprights and cross-members co-operating for providing a grid structure in which can be engaged either fixed or openable elements, comprising a frame of section members provided with means for connecting to said section members at first and second plate-like elements, characterised in that said coupling means comprise a trapezoidal cross-section member (31) to which there being coupled structural silicone (32) for coupling said first plate-like elements (35) and said trapezoidal cross-section member (31) is engaged in a mating recess (30) formed on a front portion of a frame section member the front portion of a frame section further comprises an inner bottom joint (36) made of a polyethylene like material, arranged between a front leg (25) of said frame section member and an inner sheet of said first plate-like elements (35), said second plate-like elements comprising an outer plate (54b) and an inner plate (54a) coupled to one another by a structural silicone layer (55), said coupling means comprising a coupling pin (53) projecting from a front leg (52) of the section member of said frame and engageable between the inner plate (54a) and the outer plate (54b), with said pin (53) being associated a coupling gasket (60) engaging between said inner plate (54a) and said outer plate (54b)."

VIII. The essential arguments of the parties with respect to their requests can be summarized as follows:

(a) appellant:

- according to column 2, lines 1 to 4, of EP-B1-0 432 105 "a preferred embodiment ... is illustrated ... in the accompanying drawing" so that it is not justified to conclude that the two embodiments of Figure 1 are alternative embodiments of the invention or are two inventions;
- the general inventive concept linking granted claims 1 and 5, 6 is based on "said coupling means" (of granted claims 1 and 5) and not on "the plate - like elements" (see characterising part of granted claim 1);
- granted claims 5 and 6 refer to granted claim 1 without, however, defining alternative forms of the invention instead one invention only;
- under these circumstances the new claims are considered to be in line with Articles 123(2) and 100(c) EPC;
- for reasons of clarity the term "at least a plate-like element (35)" of granted claim 1 has been clarified by defining them as "first and second" plate-like elements, Article 84 EPC;
- claim 1 is considered to define novel and inventive subject-matter inter alia in the light of documents

(D1) US-A-4 809 475

(D2) GB-A-2 179 391 and

(A1) EP-A-0 297 952;

- in the technical field of fronts for buildings even minor amendments of the prior art justify the acknowledgement of an inventive step.

(b) respondent:

- combining the features of granted claims 1, 5 and 6 leads to a product which cannot be derived from the documents as originally filed, (see the two embodiments of the patent for fixing elements "35" and "54" which cannot be claimed in a single claim);
- under these circumstances it is not possible to refer in granted claim 5 to granted claim 1 so that this reference is erroneous and misleading;
- nearest prior is (D1) which in combination with (A1) renders obvious the first alternative of EP-B1-0 432 105, (see single Figure left half);
- the second alternative of EP-B1-0 432 105, (see single Figure right half), is rendered obvious by the combination of (D1) and (D2);
- summarising the above observations the appellant's appeal should be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*
 - 2.1 New claim 1 combines the features of granted claims 1, 5 and 6 whereby the structural silicone layer "55" for coupling the inner and outer plates "54a" and "54b" to one another can be seen from EP-B1-0 432 105, column 3, lines 17 to 22, and single Figure right half.
 - 2.2 The feature "at least a plate-like element" of granted claim 1 and "said plate-like element" of granted claim 5 are seen as a basis by the appellant for the feature "first and second plate-like elements" according to the preamble of new claim 1.
 - 2.3 Apart from the question whether EP-B1-0 432 105 seen as a whole forms a basis for this amendment of the independent claim it has to be observed that granted claims 1 and 5 **seen in combination** are misleading.
 - 2.4 While in granted claim 1 the plate-like element is accompanied by reference sign "35" - clearly pointing to the **first** embodiment described in combination with the **left** half of the single Figure - granted claim 5 uses reference sign "54" - thereby pointing to the **second** embodiment described in combination with the **right** half of the single Figure. For a skilled reader reciting the "plate-like element" of granted claim 5 as

"said" is confusing.

- 2.5 On the other hand it cannot be denied that granted claim 5 is a dependent claim (see also granted claim 6) and that there is under these circumstances a basis for incorporating their features into the independent claim.
- 2.6 It appears that the plate-like elements "35" and "54" are completely different in that element "35" is more or less a single block without any lateral access for a mounting means whereas element "54" is an element which allows a lateral mounting by an appropriate holding means.
- 2.7 The appellant argued that granted claim 1 contains the feature "means for coupling ... a plate-like element", (see preamble thereof), and that the "said coupling means" according to its characterising clause is a link between the coupling means substantiated in granted claims 1 and 5 respectively.
- 2.8 The board has outlined the problems which would have to be solved under Article 123 EPC, but is not convinced that it has to be finally decided in **the present case** whether or not new claim 1 clearly complies with the requirements of Article 123 EPC. The board had already set out in the provisional opinion expressed in its communication of 20 May 1997 the reasons why the appeal was likely to be dismissed (see remark 4 thereof in respect of Articles 56 and 100(a) EPC), and that is now the board's decision for the reasons set out below.

3. *Novelty*

Since novelty is not disputed by the respondent or the board it is not necessary to discuss this issue in detail.

4. *Inventive step*

4.1 From new claim 1 it is immediately clear that it contains two separate combinations of features so that the claim could also have been drafted as **two** independent claims. In cases where an independent claim is based on an **aggregation of features** it is clearly allowable to examine each combination of features separately with respect to the available prior art, see T 410/91 (unpublished).

4.2 The **first** combination of new claim 1 to be considered is characterised by the features trapezoidal cross-section member "31", structural silicone "32", mating recess "30" of a frame section member, inner bottom joint "36" of polyethylene like material and a first plate-like element "35", (see **left** embodiment of the single Figure of EP-B1-0 432 105).

4.3 Starting from (D1) as the nearest prior art document the claimed invention seeks a possibility to structurally connect plate-like elements in a very quick and simple way so as to provide a firm and stable assembly, (see EP-B1-0 432 105, column 1, lines 29 to 41).

4.4 From (A1), (see in particular Figures 1 and 2 and

reference signs "18, 18a" for trapezoidal cross-section member, "13" for structural silicone, "16, 19, 20" for mating recess of a frame section member, "14" for inner bottom joint of suitable material and "2, 4, 5" for a (first) plate-like element), the features of the characterising clause of new claim 1 are known. It is obvious for a skilled person that from (A1) a **complete solution** to the above problem according to remark 4.3 is available so that its use in combination with a continuous front for buildings cannot be protected without violating the requirements of Articles 56 and 100(a) EPC, since the material for the inner bottom joint is comprised by the knowledge of a skilled person in the art although not specified in detail in (A1).

4.5 The **second** combination of features of new claim 1 is characterized by a plate-like element with an outer plate "54b" and an inner plate "54a" coupled by a structural silicone layer, a coupling pin "53" of the section member of the frame engaging between said inner and outer plate whereby said pin "53" is associated with a coupling gasket "60" engaging between said inner and outer plate.

4.6 The combination of (D1) and (D2) renders obvious the second combination of features solving the problem according to above remark 4.3 for the following reasons:

(D2) discloses in its Figures 1 to 3 inner and outer plate-like elements "17, 18" coupled by a structural silicone layer "13" and held by a pin projecting from the section member "10" of the frame and engageable

between the inner and outer plate, whereby said pin is associated with a coupling gasket "11, 14".

4.7 Again is it obvious that (D2) discloses a **complete solution** to the problem according to above remark 4.3 so that a skilled person confronted with this problem to be solved would use this teaching without any inventive endeavour. For this reason the second alternative of new claim 1 does not meet the requirement of inventive step within the meaning of Articles 56 and 100(a) EPC.

4.8 Both alternatives of new claim 1 being obvious within the meaning of Articles 56 and 100(a) EPC claim 1 is not valid and cannot justify maintenance of the patent in amended form.

5. Since the respondent's request to dismiss the appeal is to be followed by the board his auxiliary petition for oral proceedings is meaningless.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

N. Maslin

C. T. Wilson