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**D E C I S I O N**  
**of 4 January 1999**

**Case Number:** T 0679/97 - 3.2.3  
**Application Number:** 89108820.5  
**Publication Number:** 0348653  
**IPC:** E03C 1/06, A47K 3/22

**Language of the proceedings:** EN

**Title of invention:**  
Shower cubicle with control centralising column

**Patentee:**  
Cesana S.p.A.

**Opponent:**  
Kermi GmbH,

**Headword:**  
Shower cubicle/CESANA

**Relevant legal provisions:**  
EPC Art. 52(1), 56, 111(1), 113(1), 116(1)  
EPC R. 67

**Keyword:**  
"Inventive step (denied)"

**Decisions cited:**  
T 0951/91, T 0892/92, T 1002/92, T 0255/93, T 0731/93, T 0810/93, T  
0047/94, T 0114/94

**Catchword:**





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Boards of Appeal

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Case Number: T 0679/97 - 3.2.3

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.3**  
**of 4 January 1999**

**Appellant:** Kermi GmbH  
(Opponent) Pankofen-Bahnhof 1  
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**Representative:** Schwabe, Hans-Georg, Dipl.-Ing.  
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**Respondent:** Cesana S.p.A.  
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**Representative:** Caregaro, Silvio, Ing.  
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**Decision under appeal:** Decision of the Opposition Division of the European Patent Office posted 18 April 1997 rejecting the opposition filed against European patent No. 0 348 653 pursuant to Article 102(2) EPC.

**Composition of the Board:**

**Chairman:** F. E. Brösamle  
**Members:** J. B. F. Kollar  
M. K. S. Aúz Castro

## Summary of Facts and Submissions

I. The respondent is proprietor of European patent No. 0 348 653 (application No. 89 108 820.5).

The single independent Claim 1 as granted, in the form of the feature analysis, reads as follows:

"1. Shower cubicle comprising

- a) a shower base (12),
- b) a peripheral frame (16, 18),
- c) side walls (17, 19) comprising a door and designed to enclose at least two contiguous sides of said cubicle and
- d) at least one water sprinkler (24, 28, 29) connected, via a mixing unit or separate taps (23), to pipes (21, 22) supplying hot and cold water,
- e) said shower cubicle, in at least one corner (13) of the shower base (12) comprising an upright column (20) supporting said sprinkler (24, 28, 29),

characterized in that

- f) said column (20) is in the form of hollow member housing the pipes (21, 22, 25) supplying hot and cold water, as well as the mixed water, and mixing unit or the control taps (23),

- g) control taps for said mixing unit being operable from inner and outer sides of said column,
- h) the sprinkler (24, 28, 29) on the cubicle frame being oriented towards the inside of the cubicle in a direction facing away from the door panel (19) of the peripheral frame (16, 18), and
- i) a thermometer (26) indicating the temperature of the mixed water having the display located on the outside of the cubicle."

II. This patent was opposed by the appellant (opponent) on the ground of lack of inventive step in view of the following prior art documents:

D1: DE-A-3 400 962,

D2: DE-A-2 707 622,

D3: DE-A-3 137 406,

D4: DE-B-2 717 648,

D5: EP-A-0 178 453,

D6: EP-A-0 035 044,

D7: DE-A-3 329 830,

D8: FR-A-2 375 858,

D9: GB-A-776 064,

D10: DE-A-3 600 945.

III. By a decision dispatched on the 5 July 1993, the Opposition Division rejected the opposition. Comparing the features of Claim 1 with the cited prior art the Opposition Division held that none of the cited documents D1 to D10 disclosed features (g) or (i) which enable a user to manually set the water temperature before entering the shower cubicle. The Opposition Division came to the conclusion that it would not be obvious for a person skilled in the art to combine the teaching of documents D1 to D10 and to thereby arrive at the invention of Claim 1.

IV. Notice of Appeal was lodged against this decision on 6 September 1993. In his Statement of the Appeal the appellant requested that the contested decision be set aside and the patent be revoked in its entirety. In support the appellant introduced into the appeal proceedings two new documents,

D11: US-A-2 527 852, and

D12: US-A-1 785 636.

The respondent requested dismissal of the appeal.

Oral proceedings were subsidiarily requested by both parties.

V. By its decision T 810/93, dated 15 March 1995, the Board considered documents D11 and D12 sufficiently relevant to justify exercising its discretion under Article 111(1) EPC to refer the matter back to the

Opposition Division to consider the whole matter afresh, including the admissibility of these late filed documents.

In its decision, the Board referring to T 47/94 of 16 January 1995 (not published) found it neither necessary nor appropriate to appoint oral proceedings before the Appeal Board merely for the question whether to remit the case to the Opposition Division or not.

VI. Thereafter, and without further notification or invitation to the parties for comments in written form or during oral proceedings, subsidiarily requested by both parties, the Opposition Division rejected the opposition by its decision of 7 December 1995. The Opposition Division held that the late filed documents D11 and D12 did not prejudice the maintenance of the patent unamended and invoked its powers under Article 114(2) EPC not to admit these late-filed documents into the proceedings.

VII. On 6 February 1996 the appellant lodged an appeal against this decision. He argued that the manner in which the case had been handled by the Opposition Division after the Board had remitted it was contrary to the provision of Article 113(1) EPC since the case was decided without inviting the parties to file their observations.

Referring to T 892/92, OJ EPO 1994, 664 the appellant stated that the proceedings before the first instance suffered from a substantial procedural violation.

Both parties forwarded the same requests as in the

previous appeal proceedings.

VIII. By its decision T 120/96, dated 6 February 1997, the Board set aside the decision of the Opposition Division dated 7 December 1995 and remitted the case to the first instance for the two following reasons:

Firstly, referring to decision T 892/92, it was pointed out that Article 113(1) EPC required that an express opportunity to present observations be given to the parties by the Opposition Division after remittal to it of a case by the Board of Appeal for further prosecution on the basis of new evidence, even if submissions with respect to this new evidence have already been made during the preceding appeal proceedings. The immediate termination of the opposition proceedings following the remittal was not in accordance with the provision of Article 113(1) EPC and, therefore, constituted a substantial procedural violation within the meaning of Rule 67 EPC.

Secondly, it was found that the appellant's original subsidiary request for oral proceedings, which has never been withdrawn or amended, became once more effective after the remittal, so that the Opposition Division should not have taken a decision adversely affecting the appellant, without giving him an opportunity to present his case orally (Article 116(1) EPC).

IX. In its decision issued shortly after the second remittal, on 18 April 1997, the Opposition Division, referring to Appeal Board decisions T 951/91, T 892/92, T 1002/92, T 255/93, T 731/93 and T 114/94 as well as



to E-III, VI and X of the Guidelines, again decided not to admit documents D11 and D12 into the proceedings without giving the parties an opportunity to comment in written or oral form on this issue and rejected the opposition as unfounded under Article 102(2) EPC.

X. On 17 June 1997 the appellant lodged an appeal against the above decision and paid the prescribed fee on the same day. The Statement of Grounds of Appeal was filed on 6 August 1997.

XI. During the oral proceedings held on 4 January 1999, after a discussion of the question whether documents D11 and D12 should be admitted into the proceedings, or be disregarded (Article 114 EPC), the respondent filed a new Claim 1 as his auxiliary request. This new Claim 1 reads as follows:

"1. A shower cubicle corner structure, suitable for fastening to permanent corner walls (10, 11) of the room in which said shower cubicle is installed, comprising:

- a) a shower base (12),
- b) a peripheral frame and
- c) two side walls including an access door (16, 17, 18, 19), designed to enclose two contiguous sides of said cubicle,
- d) at least one water sprinkler (24, 28, 29) connected, via a pipe (25) and a mixing unit or separate taps (23), to pipes (21, 22) supplying

hot and cold water,

- e) said shower cubicle, in one corner (13) of the shower base (12) comprising an upright column (20) supporting said sprinkler (24, 28, 29) and housing said pipes (21, 22, 25) as well as said mixing unit or control taps (23),

characterized in that

- f) said column (20) is in form of a hollow member, has fastened thereto the adjacent vertical sides of said two side walls (17,19) and is located at the front corner of the shower cubicle corner structure, whereby the sprinkler (24, 28, 29) on the cubicle frame is oriented towards the inside of the cubicle in a direction facing away from the door panel (19) of the peripheral frame (16,18),
- g) said control taps for said mixing unit being operable from the sides of said hollow member positioned inside and outside of said shower cubicle, and
- h) a thermometer (26) indicating the temperature of the mixed water having the display located on the outside of said hollow member (20)."

XII. The arguments presented by the appellant in writing and orally were substantially as follows:

The way in which the case had been dealt with by the first instance was contrary to Article 111(2), Article 113(1) and Article 116(1) EPC and suffered from

three substantial violations within the meaning of Rule 67 EPC.

As to the late introduction of D11 and D12 the appellant argued that it had been difficult to trace said documents owing to their "age" and stressed that they constituted cogent and weighty state of the art at the time of filing of the patent in suit and should on the ground of their relevance be admitted into the proceedings.

As for inventive step the only distinction between the subject-matter of Claim 1 according to either the main or auxiliary request and the disclosure of D12 was the provision of the characterising features (g) and (h) of Claim 1 according to said requests, respectively. These features were known from D11. The appellant stressed that the subject-matter of Claim 1 according to the main and auxiliary request lacked an inventive step in view of the obvious combination of the disclosure of documents D12 and D11.

XIII. In response to the appeal, the respondent argued essentially as follows:

The introduction of documents D11 and D12 into the proceedings should not be allowed

- because of their late submission allegedly due to the difficulty of finding documents of this date - 1930 and 1950 respectively; the lateness of filing such old documents in itself constituting an abuse of the procedure, and

- because of their insufficient relevance.

As to the question of inventive step the respondent admitted that the features by which the main claim according to both requests differed from D12 were known from D11. However, he pointed out that D12 related to a combination of bath and shower and D11 to a conventional shower cabinet without a hollow column while the patent in suit related to a self supporting shower cubicle. The appellant trying to combine references D11 and D12 failed to demonstrate why the skilled person was invited to combine these two references. D12 was already known in the art at the filing date of D11, but the inventor of D11 did not take into consideration or even remotely suggest the possibility that the features (g) and (i) might be applied to a corner column instead of positioning said features in a full wall on the cabinet.

The combination of D12 and D11 suggested by the appellant thus resulted from an ex-post facto analysis of these documents which did not anticipate the combination of features of the main claim according to the requests on file.

XIV. The appellant requested that the decision under appeal be set aside and the patent be revoked and that the appeal fee be reimbursed.

The respondent requested that the appeal be dismissed, by way of auxiliary request with the proviso that the patent be maintained on the basis of Claim 1, filed during oral proceedings, and Claims 2 to 10, together with the description and the drawings as granted.

## Reasons for the Decision

1. The appeal is admissible.
2. *Violation of Articles 111(2), 113(1) and 116(1) EPC*
  - 2.1 If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall - pursuant to Article 111(2) EPC - be bound by the ratio decidendi of the decision of the Board of Appeal in so far as the facts are the same.
  - 2.2 In case T 120/96 the ratio decidendi, i.e. the reason why this Board referred the case back to the Opposition Division was, that it considered that the Opposition Division had committed a substantial procedural violation by not observing Articles 113(1) and 116(1) EPC in so far as it did not give the parties an opportunity to present further arguments and did not comply with the opponent's request for oral proceedings, and that after the referral the Opposition Division should carry out these omitted procedural steps. This was explained in detail in points 2.2 and 2.3 of that decision, these two grounds being the only purpose of the decision.
  - 2.3 Notwithstanding this ratio decidendi the Opposition Division has again issued a decision immediately after the referral without any intervening communication announcing the resumption of the proceedings, let alone any invitation to make submissions or any clarification concerning the oral proceedings requested by the

appellant (opponent).

2.3.1 The reasons of the impugned decision start as follows:

"1. In the absence of explicit instructions to the contrary, when an Opposition Division further examines or prosecutes a case after remittal from a Board of Appeal, it remains bound by the requirements of the Guidelines for Examination."

Apart from the fact that no legal basis is given for this affirmation the Opposition Division did not even examine whether the Board's decision contained such instructions, but based its decision on the assumption that it did not. Such a manner of handling a case meets with considerable legal concern.

The Opposition Division should be aware of the legal situation that in a case of remittal the question is not whether the Board's decision contains any explicit instructions or not, but what is the ratio decidendi of the decision of the Board by which the Opposition Division is bound according to Article 111(2) EPC, in so far as the facts are the same. This requirement was fulfilled. Since the first decision of remittal the facts have not changed. Therefore, the Opposition Division was bound by the ratio decidendi of the decision of the Board. In paragraph 2 of the reasons of the impugned decision the Opposition Division refers to Article 114(2) EPC and the Guidelines for Examination E-VI, 2 concerning the problem of late-filed evidence. This again is of no relevance in the present case. The ratio decidendi of the decision of the Board was not whether the late filed evidence should be disregarded

or not, but only that the Opposition Division should give the parties the possibility of making submissions after the referral.

- 2.3.2 The same applies to paragraph 3 of the reasons of that decision where the Opposition Division considers whether the right of the opponent to be heard (not "to a hearing") according to Article 113(1) EPC was fulfilled with respect to the documents D11 and D12. These evaluations are again not to the point.

As already explained above, the ratio decidendi of the decision of the Board, in T 120/96 was that Article 113(1) EPC had to be interpreted in that way,

"that an express opportunity to present observations be given to the parties by the Opposition Division after remittal to it of a case by a Board of Appeal for further prosecution on the basis of new evidence, even if submissions with respect to this new evidence have already been made during the preceding appeal proceedings. The term 'opportunity' in this article can only be given effective meaning by applying the principle of good faith and the right to a fair hearing.

However, it is obvious in the light of these principles that no such opportunity can exist where, as in the present case, a remittal by a Board of Appeal for further prosecution on the basis of new evidence is immediately, i.e. without any intervening communication announcing the resumption of proceedings, followed by the rejection of the opposition. For such opportunity to exist, it is therefore necessary that the parties be

expressly asked whether or not they wish to present, within a fixed period of time, their comments, or if, as in the present case, the parties have already made detailed submissions during the preceding appeal proceedings, whether or not these submissions should be regarded as complete."

The quotation shows that the ratio decidendi of the decision of the Board concerned the possibility of making submissions after a referral, in general, and not the question whether the requirements of Article 113(1) EPC were observed with regard to a specific document.

- 2.3.3 With respect to the violation of Article 116(1) EPC it has to be recapitulated that this Board, in its first decision of remittal - T 810/93 - had decided not to appoint oral proceedings following the reasoning of decision T 47/94 which had held that for discussing only the question of remittal the appointment of oral proceedings was neither necessary nor appropriate in view of the fact that the requesting party would in any case have the opportunity of having oral proceedings before the Opposition Division.

The Opposition Division did not take into account the opponent's auxiliary request for oral proceedings.

In its second decision - T 120/96 - the ratio decidendi of the Board's decision with respect to Article 116(1) EPC was in substance clearly expressed as follows:

"..... In this context, the Board finds that the appellant's request for oral proceedings during former



proceedings had been revived on remittal and was therefore legally effective, but, contrary to Article 116(1) EPC, had not been taken into account by the Opposition Division. . . . . Consequently, the appellant's original requests, among them his subsidiary request for oral proceedings, which have never been withdrawn or amended, became once more effective after remittal, so that the Opposition Division should not have taken a decision adversely affecting the appellant, without giving him an opportunity to present his case orally (Article 116(1) EPC)."

The Opposition Division, however, did not comply with it and stated that there had been no further request for oral proceedings before it, but only before the Appeal Board, which, following decision T 114/94 (not published) had no effect in further proceedings before the Opposition Division.

The Board points out to the Opposition Division that if there is no resumption of the proceedings after the remittal no requests for oral proceedings can be forwarded. Furthermore, the Board emphasizes that the Opposition Division is not permitted to argue against the ratio decidendi of the decision of the Board; but according to Article 111(2) EPC is **bound** by it.

3. Although this is a very serious case of a substantial procedural violation the Board, in view of the interest of the parties to have the case finally decided has judged it necessary to exercise the powers of the Opposition Division and to proceed with the appeal itself (Article 111(1) EPC).

4. *Admission of documents D11 and D12*

Whilst the Board recognises that the introduction of new documents after the expiry of the nine month opposition period might in certain cases be objectionable (depending especially upon the degree of relevance), in the present appeal proceedings the Board, after considering the parties arguments - those presented in the oral proceedings included -, decided to admit documents D11 and D12 into the appeal proceedings having regard to their relevance (Article 114(1) EPC).

5. *Novelty*

After examination of the cited prior art the Board is satisfied that the subject-matter of Claim 1 and of the alternative Claim 1 is novel. Since this has never been disputed, there is no need to further detailed substantiation on this matter.

6. *Inventive step*

6.1 The Board considers document D12 as the closest state of the art in the case. The features specified in the preamble of Claim 1 as granted are known from this document.

6.2 According to the introductory part of the patent specification (column 1, line 48 to column 2, line 9) the technical problem underlying the invention is seen in the provision of an improved shower cubicle in which

(i) it is possible to have a centralised site for

the water-supply pipes, for the various control means and for the other cubicle accessories, inside the shower cubicle frame,

- (ii) the mixed water sprinkler is mounted on the shower cubicle structure and is positioned so that the water jet is facing in a direction which is wall away from the side walls of the cubicle,
- (iii) one or more water sprinklers can be variously positioned and directed with respect to one another, and
- (iv) some accessories can be made accessible both from the inside and from the outside of the shower cubicle.

6.3 A closer study of document D12 reveals that this document discloses besides the subject-matter of the precharacterising portion of Claim 1 the characterising features (f) and (h) of said claim so that the problems indicated above as (i), (ii) and (iii) of the patent specification have thus already been solved by the prior art shower cubicle.

6.4 With regard to the aforementioned teaching of D12 the remaining problem to be solved by the present invention is the one specified in point 6.2(iv) above.

Regarding this problem, it is desirable to provide components for accessories controlling supply of the mixed water so that a user would be able to set the water temperature before entering the shower cubicle.

- 6.5 This partial problem is overcome by features (g) and (i) in the characterising portion of Claim 1.
- 6.6 Since the elimination of deficiencies which come to light during use is a constant preoccupation in technical circles, the aim set by the present invention cannot be regarded as contributing to the inventive merits of the solution.

If the person skilled in the art working on the improvement of shower cubicles does not possess the technical knowledge to overcome such difficulties, he can be expected to consult the relevant prior art for components which are able to meet the requirements.

Such consultation would reveal document D11 relating to a shower cubicle provided with a thermometer indicating the temperature of water flowing from a mixing unit on a display located on the outside of the cubicle, said unit being provided with control taps operable from inner and outer sides of said cubicle, through a single conduit to the spray head.

The skilled person would be led by D11 to provide the shower cubicle as disclosed in document D12 with a thermometer and taps as known from D11 and thus to achieve that the water temperature can be set before entering the shower cubicle, (the problem to be solved). It would accordingly be obvious for the skilled person to combine these teachings to arrive at the solution as set forth in the subject-matter of the claim, which accordingly lacks an inventive step as required in Article 56 EPC.

Therefore, Claim 1 is not valid having regard to Article 52(1) EPC.

7. With respect to Claim 1 according to the auxiliary request it must be stressed that all the features of the preamble are known from document D12. There is clearly disclosed therein a shower cubicle corner structure, suitable for fastening to permanent corner walls of the room in which said shower cubicle is installed.

To modify the location of the thermometer "on the outside of said hollow column (2)" as specified in feature (h) of this Claim 1 seems to be a simple matter of choice. Since no further substantially distinguishing features are contained in the characterising part of Claim 1 of the auxiliary request compared with that of Claim 1 of the main request, this Claim 1 is likewise deemed to lack an inventive step in its subject-matter for precisely the reasons stated in point 6 above.

Claim 1 of the auxiliary request also is not valid having regard to Article 52(1) EPC.

8. The further arguments submitted by the respondent in support of inventiveness are not sufficiently persuasive to reverse the above conclusion of obviousness.
  - 8.1 The respondent is of course correct when he alleges that the mere fact that a skilled person would not encounter unsurmountable difficulties in providing a characterising feature of a claim does not lead

(necessarily) to the conclusion that there is no inventive step. However, when the feature is known from a document in the same specialised field, and when it solves the same problem, then the fact that the skilled person would not encounter unsurmountable difficulties in applying this known feature to a known device from a second document does demonstrate that the documents are not conflicting and that an inventive step is lacking. The problem solved does not have to be stated *expressis verbis* in the prior art.

Regarding the respondent's argumentation against the relevance of documents D11 and D12 due to their age the Board points out that the age of documents known for a long time before the filing date may only be an indication of inventive step if a need for the solution of an unsolved problem had existed for the whole time between the date of the documents and that of the invention. However, since the purpose of features relating to the control taps and the thermometer of the shower cubicle according to document D11 is the same as in the pursuant invention it cannot be denied that the problem of D11 and that of the patent do not differ fundamentally and that the afore-mentioned features of D11 thus already offered the skilled person a teaching for the solution of the problem.

8. For these reasons the patent cannot be maintained.
9. *Reimbursement of the appeal fee*

Pursuant to Rule 67 EPC, reimbursement of the appeal fee shall be ordered where the Board of Appeal deems an appeal to be allowable, if such reimbursement is

equitable by reason of a substantial procedural violation.

All three requirements are fulfilled here. The appeal is allowable, a substantial procedural violation took place which was the reason for the appeal and therefore the reimbursement is equitable.

### **Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

N. Maslin

F. Brösamle