BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [ ] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 28 March 2000

Case Number: T 0828/98 - 3.2.4

Application Number: 93106636.9

Publication Number: 0567948

IPC: A63C 17/14

Language of the proceedings: EN

Title of invention:
Braking device on a roller skate

Patentee:
Benetton Sportsystem S.p.A.

Opponents:
Mag. L.P. Ribarits & Bertram Burian

Headword:
-

Relevant legal provisions:
EPC Art. 100(b), 56
EPC R. 67

Keyword:
"Disclosure of the invention - yes"
"Inventive step - yes"
"Substantial procedural violation - no"

Decisions cited:
T 0435/91, T 0870/92

Catchword:

-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0828/98 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 28 March 2000

Appellants: (Opponents)
Mag. L.P. Ribarits & Bertram Burian
Schwedenplatz 4/18
AT-1010 Wien (AT)

Representative:
-

Respondent: (Proprietor of the patent)
Benetton Sportsystems S.p.A.
Via Montebelluna 5/7
I-31040 Trevignano (Treviso) (IT)

Representative:
Modiano, Guido, Dr.-Ing.
Modiano & Associati SpA
Via Meravigli, 16
I-20123 Milano (IT)

Decision under appeal:
Decision of the Opposition Division of the European Patent Office posted 23 June 1998 rejecting the opposition filed against European patent No. 0 567 948 pursuant to Article 102(2) EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: M. G. Hatherly
R. E. Teschemacher

Summary of Facts and Submissions

I. The decision of the opposition division to reject the opposition against European patent No. 0 567 948 was posted on 23 June 1998. On 21 August 1998 the appellants (opponents) filed an appeal against this decision and simultaneously paid the appeal fee. The appellants filed the statement of grounds of appeal on 23 October 1998.

II. Claim 1 as granted reads:

"Braking device on a roller skate comprising an item of footgear (3,103,203) having a quarter (4,204) articulated to a shell (5,205) which is associated with a supporting frame (6,206) for a plurality of wheels (7,207), characterized in that it comprises a rod member (9,109, 209) associated with said quarter and slideable with respect to said shell, said rod member having a braking end (18a,18b,118b,211) adapted to act on at least one of said wheels when said quarter is rotated."

III. The prior art documents discussed during the appeal proceedings are:

D1: US-A-4 275 895

D2: US-A-1 402 010

D3: EP-A-0 465 222

IV. In the appeal proceedings the appellants argued that the claimed invention was not inventive over the cited

prior art and had not been disclosed sufficiently for the skilled person to be able to carry it out.

The appellants added that the opposition division, by dealing in the opposition oral proceedings with the sufficiency of disclosure objection before the inventive step objection, had committed a substantial procedural violation justifying reimbursement of the appeal fee.

The respondent (proprietor) explained in the appeal proceedings why he considered the appellants' arguments were wrong.

Both parties attended oral proceedings on 28 March 2000.

V. The appellants requested that the decision be set aside and the patent revoked. Furthermore, they requested that the appeal fee be reimbursed.

The respondent requested that the appeal be dismissed and the patent maintained as granted. Alternatively it was requested that the decision be set aside and the patent maintained on the basis of a modified claim 1 in the version of auxiliary request 1 or 2 as submitted with the letter dated 24 February 2000 with a spelling mistake corrected by the replacement of "breaking" by "braking".

Reasons for the Decision

1. *Designation of the appellants*

The original designation of the appellants was "Mag.L.P. Ribarits und Bertram Burian GesnbR". In a communication the board pointed out that, under Austrian law, a "Gesellschaft nach bürgerlichem Recht" was apparently neither a legal person nor a body equivalent to a legal person and so the "Gesellschaft" could not be a party to proceedings before the EPO. The appellants replied by requesting a correction under the first sentence of Rule 88 EPC to designate them as "Mag.L.P. Ribarits und Bertram Burian". No objections were raised by the respondent. This correction is duly made (cf. T 870/92, cited in Case Law of the Boards of Appeal of the EPO, VII.C.8.4.1).

2. The appeal is admissible.

3. *Novelty - Articles 52(1) and 54 EPC - claim 1 as granted (main request)*

No prior art document discloses all the features of claim 1 as granted. The appellants do not dispute this.

The subject-matter of claim 1 as granted is thus considered novel within the meaning of Article 54 EPC.

4. *Disclosure of the invention - Article 100(b) EPC - claim 1 as granted (main request)*

4.1 The appellants argue that, in two respects, the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, i.e. contrary to Article 100(b) EPC.

4.2 The first objection concerns the part of claim 1 as granted that specifies "a braking end (18a,18b,118b,211) adapted to act on **at least one** of said wheels", this wording also being present in claim 1 as originally filed.

4.2.1 Figures 1 and 2 of the patent specification as granted show pads 20a and 20b acting on disks 21a and 21b on the wheel 7 whereas Figures 6 and 7 show arms 214 and 215 acting on lateral surfaces 217a and 217b of the wheel. Thus the braking devices particularly disclosed by the granted patent act only on a single wheel, namely the rearmost wheel of the single row of four wheels.

The appellants maintain that, while it would not be impossible to design a braking device to brake more than one wheel, the necessary information is not present in the patent specification and the design would be beyond the normal capabilities of the skilled person i.e. he would need to be inventive.

4.2.2 However column 1, lines 24 to 37 of the patent specification refers to D1 which discloses a roller skate whose rear row of **two** wheels is braked, see Figure 3 and column 5, lines 15 to 33 of D1. Thus the skilled person reading the present patent specification is pointed to one way of braking two wheels on a prior art roller skate and the board cannot see that he would have any difficulty in applying this teaching to the roller skate of the present invention if it had two rows of two wheels each instead of one row of four wheels.

Moreover, the respondent filed during the oral proceedings a modified version of Figure 6 of the present patent specification which adds a second pair of arms to the terminal end 211 so that the rearmost wheel and the wheel immediately in front of the rearmost wheel are braked. Also this modification to brake more than one wheel would seem well within the normal capabilities of the skilled person.

4.2.3 The appellants maintain that, while claim 1 as granted covers any or all of the wheels being braked i.e. including the front wheel or wheels, there is no disclosure in the patent specification of how to do this.

The board however points to the granted claim 2 that specifies "clamp-like blocking means (18a,18b,20a,20b) which interact with a pair of disks (21a,21b) laterally associated with at least one of said wheels". This indicates that the blocking means can act on more than one wheel and the board considers that it would be obvious to the skilled person to add further clamp-like assemblies of arms 17a and 17b, rods 18a and 18b and pads 20a and 20b like that shown in Figure 2 to act on the disks 21a and 21b of other wheels as well. The substantial supporting frame 6 has the shape in cross section of an inverted U and therefore would provide space to house a longitudinal member to receive the downward force provided by plate 14 and to apply it to these further clamp-like assemblies. The resultant linkage would still be relatively simple in design and would not be beyond the normal design capabilities of the skilled person who with his general mechanical background is familiar with linkages.

4.2.4 Thus the board considers that, even without being inventive, the skilled person could arrive at a brake design on a roller skate for braking any wheel or wheels at any position he wanted.

4.3 The second objection under Article 100(b) EPC concerns the part of claim 1 as granted that specifies "a rod member (9,109,209) associated with said quarter", this wording also being present in claim 1 as originally filed.

4.3.1 The appellants argue that the wording "a rod member ... associated with said quarter" would include a non-fixed connection whereas only a fixed connection is disclosed. They maintain that an association of rod member and quarter in all imaginable mechanical variations is not sufficiently disclosed and therefore cannot be carried out.

4.3.2 According to column 3, lines 20 to 25 of the patent specification, Figures 1 and 2 show a rod member 9 "connected to the quarter 4 by means of one or more suitable fixing means such as for example first screws or rivets 10." This fixed connection of rod member to quarter is one example of their "association".

4.3.3 The board can also envisage an "association" of rod member and quarter allowing some relative movement.

It is clear from lines 3 to 14 of column 4 of the patent specification that, when the quarter 4 is rotated backwards, the rods 18a and 18b only start to move when the pivot 13 makes contact with the upper end of the slots 16a and 16b in the plate 14 attached to

the rod member 9, i.e. once the slack in the linkage has been taken up.

The board finds that it would be obvious to the skilled person, instead of providing the slack by slots at the **lower** end of the rod member, to provide slack at the **upper** end of the rod member 9 by making slots in it, so that the rod member 9 and hence the rods 18a and 18b would only move downwards when the screws or rivets 10 had reached the ends of the slots.

4.3.4 Moreover the "association" is not unrestricted in the claim, the association must be such that the braking end of the rod member is "adapted to act on at least one of said wheels when said quarter is rotated". The board considers that in the context of the patent the term "association" would mean connected in some way, perhaps with relative displacement but in any case so that at least a part of the rod member rotates with the quarter, so that the rod member slides relative to the shell and so that a braking movement is achieved.

4.3.5 The applicant has disclosed one simple way of achieving an association of rod member and quarter, and the board has shown another simple way that it considers would be obvious to the skilled person. The board finds that the definition of "a rod member (9,109,209) associated with said quarter" taken with the other requirements of the claim does not contravene Article 100(b) EPC.

4.4 The appellants argue that according to decision T 435/91 (OJ EPO 1995, 188) all alternatives must be available to the skilled person if a claim covering these alternatives is to satisfy Article 100(b) EPC.

They consider that a patent's scope cannot extend to subject-matter which would not be available to the skilled person reading the patent specification and that the latter must contain a technical teaching which can be generalised and puts him in a position to achieve without unreasonable effort the desired result over the whole range of the claim.

The board however points out that there is a world of difference between, in T 435/91, the specialised field of additives forcing a detergent composition into the hexagonal crystal phase and, in the present invention, the rather simple and basic mechanical components, connections and linkages which are well known per se in the general mechanical field. Whereas in T 435/91 it was not contested that, on the basis of the information contained in the patent specification and taking into account the common general knowledge, the person skilled in the art was not in a position to find alternatives to the single disclosed embodiment in order to meet the functional requirement (supra, Reasons 2.2.1, penultimate paragraph), in the present case the board is convinced that there was a variety of means at the skilled person's disposal to achieve a connection of the rod member and the quarter.

4.5 Thus the board finds that the appellants' objections under Article 100(b) EPC are unjustified.

5. *Closest prior art, problem and solution - claim 1 as granted (main request)*

5.1 The appellants consider that the prior art closest to the present invention is the roller skate disclosed by

D2.

It can be seen from Figure 1 of D2 that a backward movement of a leg strap 26 causes a lever made up of side member 24 and frame 21 to pivot at 22 and to push a brake shoe 19 into contact with a tire 4.

The roller skate of D2 is a wheeled supporting frame into which the user steps using his normal shoe or boot. Thus, while the Figures of D2 do not actually show footgear, D2 does implicitly disclose footgear. However D2 does not disclose, explicitly or implicitly, that this footgear has a quarter articulated to a shell. The leg strap 26 and pivot 22 are part of the wheeled supporting frame and not part of the footgear.

5.2 It is immediately apparent that the type of roller skate shown in D2, consisting of a frame to take the normal shoe or boot, is very old fashioned. Even D1, published in 1981, refers in column 1, lines 60 to 64 to the D2 skate as being "ancient" and adds in column 2, lines 7 to 20 that it is "not compatible with the modern skate".

5.3 The board considers that the skilled person would have had no reason to believe that he could develop a marketable product from such an old fashioned skate. He would have started neither from the skate of D2 nor from the skate of D1 but from the skate of the 1990's which is a more or less permanent assembly of wheeled frame and footgear.

5.4 Figure 1 of D3 shows such a roller skate 10, with a brake assembly 25, a boot 12 having a cuff 30

articulated to a shell 36 and 58 which is attached to a frame 16 supported by wheels 24.

5.5 The board considers that the problem faced by the skilled person when starting from this skate is to improve the braking function and that this problem is solved by the features of claim 1 as granted, in particular by the features of the characterising portion.

6. *Inventive step - claim 1 as granted (main request)*

6.1 Starting from the skate of D3

6.1.1 The skilled person wishing to improve the braking function of the skate of D3 would of course be aware of older braked skate designs such as that of D2. The board doubts however whether he would make use of the D2 design because, by requiring additional normal footgear, it differs so much in basic concept from that of D3 with its integral special footgear.

6.1.2 If nevertheless the skilled person did modify the D3 skate using the teachings of D2, then the most obvious way would be to remove the braking assembly 25 shown on Figure 1 of D3 and add the braking device shown on Figure 1 of D2 i.e. the assembly of cross piece 25, a leg strap 26, side members 24, sleeves 23, pivots 22, heel guard 12, frame 21 and brake shoe 19. Plainly however this way would not yield the claimed invention e.g. because the resulting skate would have two pivot pairs, namely 31 for D3 and 22 for D2.

The board cannot see that the skilled person would

realise that these two separate pairs of pivots could be replaced by a single pair having both functions of allowing the shoe or boot to flex and of applying the brake. Firstly, D3 discloses "a pair of pivot points located below and rearward of the ankle" (see column 4, lines 42 to 44) whereas D2's pivots 22 are "about in line with the ankle" (see page 2, lines 86 to 88), so that in the combination of D2 and D3 the pivots (31 of D3 and 22 of D2) would not exactly be collinear. Secondly, the D3 boot is somewhat flexible (see column 6, lines 7 to 10) and so the pivots 31 might be expected to move relative to the frame 16 during use whereas the heel guard 12 of D2 provides a fixed location for the pivots 22 for accurate operation of the D2 brake.

6.1.3 The board considers that the argument that the skilled person would combine the pivot pairs and retain the cuff 30 of D3 without adding the heel guard 12 of D2 relies on a comparison of these documents **once the present invention is known**. Without knowledge of the invention, the skilled person would not equate the heel guard of the **skate** of D2 with the shell 36 and 58 of the **boot** of D3 and he would not equate the leg strap 26 and side member 24 of the **skate** of D2 with the cuff of the **boot** of D3.

6.1.4 If, despite the above reasoning, it is assumed that the skilled person would combine the pivots of D3 and D2 then he might arrive at a skate with a quarter (i.e. the cuff 30 of D3) whose rotation turned something (i.e. the frame 21 of D2) about the common pivot axis to apply a brake (i.e. the brake shoe 19 of D2) to a wheel.

6.1.5 In this postulated combination the frame 21 would be **rotatable** with respect to the boot shell whereas the appellants agree that claim 1 as granted specifies that the rod member is "**slideable** with respect to said shell". However they argue that rotation and sliding are mere equivalents.

While replacement of something by its equivalent may well not be inventive, the board considers the equivalency argument insufficient in the present case. What matters is whether it would be obvious to substitute sliding for rotation **in this specific case**. Looking at the braking mechanism on Figure 1 of D2, the frame 21 plainly has to rotate as the pivot pin 22 rotates and the board cannot see an obvious way of making it slide instead. Rotation and sliding are different movements achieved by different components and the change to sliding enables - at least in the case of the embodiment of Figures 6 and 7 - a simplified brake construction compared with the prior art rotationally applied brake constructions.

6.1.6 Thus the board cannot accept that, starting from the skate of D3 and using the teaching of D2, the skilled person would arrive in an obvious manner at the claimed subject-matter.

6.1.7 This conclusion would not be changed if the skilled person modified the skate of D3 using D1 instead of D2. In D1 the lever arm 18 and brake shoe 16 also rotate and do so about a pivot axis 32 which is spaced well below the ankle, see Figure 2. Combination of the boot of D3 and the braking device of D1 would yield two well spaced pivot axes and neither D3 nor D1 would give the

skilled person the idea that he could combine these axes.

6.2 Starting from the skate of D2

6.2.1 The appellants argue that the subject-matter of claim 1 as granted is not inventive over D2 taken on its own.

The appellants see the cross piece 25, leg strap 26 and side members 24 shown on Figure 1 as constituting the quarter referred to in the claim. This quarter is connected to the heel guard 12 and clamps 14 which constitute the claimed shell. The frame 21 constitutes the claimed rod-like member. This member 21 rotates relative to the shell. Rotation of the quarter causes the braking shoe 19 to be applied to a wheel.

Thus the appellants consider that D2 discloses all the features of claim 1 as granted except that the rod member of D2 is rotatable rather than slidable with respect to the shell but sliding and rotation are merely equivalents. Therefore in their view the claimed subject-matter is obvious.

6.2.2 The board feels the situation here is similar to that already discussed in the above section 6.1.3.

The skate of D2 would be used with a conventional shoe or boot. It is this shoe or boot that corresponds to the "item of footgear" specified in claim 1 as granted. The parts in D2 that the appellants consider as the claimed quarter are however not parts of the footgear, they are parts of the braking device while the parts in D2 that the appellants consider as the claimed shell

are not parts of the footgear, they are more parts of the supporting frame.

Only with knowledge of the present invention would the skilled person see any similarities at all between what is claimed and what is disclosed by D2.

6.2.3 The equivalents argument has already been discussed in section 6.1.5 above.

6.2.4 The board does not consider that the teaching of D2 renders the subject-matter of claim 1 as granted obvious.

6.3 Accordingly the board concludes that the prior art documents on file, taken singly or in any combination, would not lead the skilled person to the subject-matter of claim 1 as granted which thus involves an inventive step as required by Article 56 EPC.

7. The patent may therefore be maintained as granted, i.e. according to the respondent's main request.

Since the patent documents of the main request are allowable it is not necessary to discuss the respondent's auxiliary requests.

8. *Reimbursement of the appeal fee - Rule 67 EPC*

8.1 The appellants object that they were disadvantaged in the opposition oral proceedings by the opposition division dealing with inventive step before lack of disclosure. Since the appellants expected to be successful with the ground of lack of inventive step

they did not press hard on the ground of lack of disclosure. They consider that the order of dealing with these grounds was a substantial procedural violation justifying reimbursement of the appeal fee.

8.2 The board however considers that, unless there were good reasons for doing otherwise, the chairman in the opposition oral proceedings had the discretion to decide in which order matters were to be discussed. There is no indication either in the opposition division's decision or in the minutes of the oral proceedings that the appellants gave any such reasons at the time or even that they objected at that time to the order in which the matters were discussed.

8.3 Moreover the board finds that the opposition division followed the usual practice in the EPO, which is to deal with the three grounds for opposition set out in Article 100 EPC in the order of extension of subject-matter (Article 100(c) EPC), followed by lack of disclosure (Article 100(b) EPC) and then lack of patentability (Article 100(a) EPC).

8.4 Accordingly the board cannot agree that a substantial procedural violation occurred in the opposition proceedings and so the request for reimbursement of the appeal fee must fail. In any case the fee could only be reimbursed if the appeal were to be allowed and this is not the case.

Order

For these reasons it is decided that:

1. The original designation of the opponents is corrected by the deletion of the abbreviation "GesnbR".

2. The appeal is dismissed.

3. The request for reimbursement of the appeal fee is refused.

The Registrar: The Chairman:

G. Magouliotis C. Andries