

Internal distribution code:

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

D E C I S I O N
of 28 February 2002

Case Number: T 1162/98 - 3.2.1

Application Number: 93203564.5

Publication Number: 0602755

IPC: B60J 1/14

Language of the proceedings: EN

Title of invention:
Double walled window

Patentee:
POLYPLASTIC B.V

Opponent:
Para Press S.A.

Headword:
-

Relevant legal provisions:
EPC Art. 54, 56

Keyword:
"Prejudice in the art (no)"
"Public prior use to be proved up to the hilt (no)"
"Public prior use (yes)"
"Novelty (no, main request)"
"Inventive step (no, first and second auxiliary requests)"

Decisions cited:
T 0472/92

Catchword:
-



Case Number: T 1162/98 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 28 February 2002

Appellant:
(Opponent)

Para Press S.A.
Route de Luxembourg
L-3201 Bettembourg (LU)

Representative:

Meyers, Ernest
Office de Brevets
Meyers & Van Malderen
261 route d'Arlon
B.P. 111
L-8002 Strassen (LU)

Respondent:
(Proprietor of the patent)

POLYPLASTIC B.V.
Vlaardingweg 98
NL-3044 CK Rotterdam (NL)

Representative:

Jilderda, Anne Ayolt
Octrooibureau LIOC B.V.
Postbus 13363
NL-3507 LJ Utrecht (NL)

Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 9 November 1998
rejecting the opposition filed against European
patent No. 0 602 755 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: F. Gumbel
Members: M. Ceyte
J. Van Moer

Summary of Facts and Submissions

- I. The respondent is proprietor of European patent No. 0 602 755 (application No. 93 203 564.5).

Claim 1 as granted reads as follows:

"1. A double-walled window (5) comprising a substantially transparent outer pane (11) and an inner pane (10) which are interconnected at an edge portion (13) of the window by means of at least an adhesion or fusion joint (15), while at least one of the two panes (10, 11) comprises a central portion which is in an offset position relative to the edge portion of the window, characterized in that the window is provided with an opaque screening layer (16) at the area of the edge portion, which screening layer (16) is applied to the inside (17) of the outer pane (11)."

- II. The patent was opposed by the appellant (opponent) on the grounds of lack of novelty and inventive step.

The following state of the art was cited:

XA1: International deposit certificate No. DM/023 483, published in bulletin No. 7/92,

XA2: "Resart-Journal" Zeitschrift für Kunden und Interessenten, 3/85

XA3: Catalogue of Para press S.A, allegedly printed and made available to customers in 1987.

- III. By its decision posted on 9 November 1998 the Opposition Division rejected the opposition.

IV. On 14 December 1998 the appellant (opponent) lodged an appeal against that decision, with the appeal fee being paid at the same time.

In its statement of grounds of appeal filed on 4 March 1999 the appellant submitted the additional evidence

- XA4 a statutory declaration of 14 January 1999 signed by Mr Henri Hengen.

V. In a communication dispatched on 18 January 2001 the Board referred to the further prior art document:

- XA5: EP-A-0 298 788 (cited in the search report)

In response to the Board's communication, the respondent (patent proprietor) filed a declaration dated 29 January 2002 of Mr Raymond Resibois, a former employee of the Appellant's company.

VI. Oral proceedings before the Board were held on 28 February 2002.

The appellant requested that the decision under appeal be set aside and the European patent be revoked in its entirety.

The respondent (patentee) requested that the appeal be dismissed and the patent be maintained as granted or, in the alternative, as amended according to the first and second auxiliary requests submitted during the oral proceedings.

Claim 1 of the first auxiliary request reads as follows:

"1. A double-walled window (5) comprising a substantially transparent outer pane (11) and an inner pane (10) which are interconnected at an edge portion (13) of the window by means of a direct glue or fusion joint (15), while at least one of the two panes (10, 11) comprises a central portion which is in an offset position relative to the edge portion of the window, characterized in that the window is provided with an opaque screening layer (16) at the area of the edge portion, which screening layer (16) is applied to the inside (17) of the outer pane (11) covering the area of the joint (15)."

Claim 1 of the second auxiliary request reads as follows:

"1. A double-walled window (5) comprising a substantially transparent outer pane (11) and an inner pane (10) which are interconnected at an edge portion (13) of the window by means of a direct glue or fusion joint (15), while at least one of the two panes (10, 11) comprises a central portion which is in an offset position relative to the edge portion of the window, characterized in that the window is provided with an opaque screening layer (16) at the area of the edge portion, which screening layer (16) is applied to the inside (17) of the outer pane (11) covering the area of the joint (15) and in that the screening layer (16) is locally provided with interruptions (20)."

VII. In support of its request the appellant submitted in essence the following:

The declaration signed by Mr Resibois, which was submitted by the respondent (patentee) itself, unambiguously shows that the model 8600 window was manufactured and sold before the priority date of the European patent. The subject-matter of granted claim 1 and that of claim 1 according to the first auxiliary request are not patentable over this prior art.

As to claim 1 of the second auxiliary request, the design model XA1 discloses a window for vehicles with a silk-screen frame forming a pattern and thus comprising interruptions. There is no doubt that the function of this printed silk-screen pattern is to give the window a nice and stylish look as well as to conceal from sight the accessories provided at the edges of the window. Therefore, it would have been obvious for the skilled person to replace the continuous screening layer of the model 8600 window by such printed silk screen pattern so as to arrive at the claimed invention.

VIII. The respondent (patent proprietor) rejected in detail the arguments brought forward by the appellant:

The declaration signed by Mr Resibois should not be considered as an acknowledgement on behalf of the patentee that the model 8600 window was in fact a prior use. Publication XA2 states that a model 8600 window was exhibited during a trade fair in Essen. But according to catalogue XA3 there are two versions of this window, only one version carrying the screening layer on the inside of the outer pane. It has not been made clear which version was exhibited at the trade fair.

The declaration signed by Mr Hengen merely indicates that the model 8600 window was manufactured by the Appellant's company since 1985 without stating whether

it was actually sold. As evidenced by the declaration signed by Mr Resibois this kind of window was on a technical point of view not satisfactory so that it is conceivable that such windows were never sold in order to avoid any liability.

As required by the jurisprudence of the Boards of Appeal an alleged prior public use has to be proved "up to the hilt". As it is apparent from the above submissions this is clearly not the case here, the alleged prior public use of the model 8600 window should be disregarded.

In any case the claimed invention would be patentable over this alleged prior public use. Before the priority date of the European patent, there was a prejudice in the art against the provision of a screening layer at the inside of the outer pane at the same area where the glue joint between the two panes is provided. It was believed that the ink or paint of the screening layer and the glue used for connecting the two panes would negatively interfere, with the result that the two panes could not be held together only by the glue joint.

This prejudice in the art was clearly evidenced by the declaration signed by Mr Resibois, who at the relevant time was employed by the Appellant's company. The model 8600 window illustrates this prejudice: a double sided adhering tape, not a direct glue bond, was employed to connect the two panes together and since this connection was not sufficient, it was necessary to provide this kind of window with an aluminium frame clamping profile in order to firmly hold the two panes together.

Claim 1 of the second auxiliary request requires the provision of interruptions in the screening layer. As

stated in the European patent specification these interruptions provide areas of direct contact between the glue material and the outer pane and guarantee, without impairing the visually pleasant appearance of the window, a reliable connection between the two panes even if the screening layer is not fully compatible with the glue material. There was no disclosure or suggestion of this advantageous solution in the opposed prior art.

Reasons for the Decision

1. The appeal is admissible.
2. *The alleged prior public use of the model 8600 window*
 - 2.1 Journal XA2 dated March 1985 is said to be for customers and interested parties ("Zeitschrift für Kunden und Interessenten") that is members of the public. It is further stated that 7000 copies of this Journal have been issued and distributed in 14 countries. Therefore it cannot be assumed that this document was merely an "internal magazine" and thus had not been made available to the public before the priority date (December 1992) of the present patent.

This prior publication discloses on page 5 a double-walled window model 8600 ("Austellfenster 8600 für Wohnwagen mit Acryl-Doppelverglasung") comprising an outer pane and an inner pane. One of the two panes has a central portion which is in an offset portion relative to the edge portion. Moreover, the depicted model 8600 window is provided with an inner opaque screening layer ("U.V-beständige Innenlackierung") which is thus applied between the outer pane and the

inner pane. This prior publication mentions that this model 8600 window, that is with the inner screening layer, will be exhibited at the 24 International Caravan Trade Fair in Essen from 5 to 13 October 1985.

In the signed declaration by Mr Henri Hengen, it was confirmed that the model 8600 referred to in the prior publication XA2 is the same as the model 8600 window depicted in the catalogue XA3.

Furthermore, the respondent (patentee) has filed a declaration signed by Mr Resibois who was employed by the appellant's company from 1972 to 1997. To this signed declaration are annexed two pages of the catalogue XA3 showing a cross sectional view of the model 8600 window and that of the previous model 8400. From this declaration it can be derived that the model 8600 was in fact manufactured and sold to customers, ("Unfortunately the customers did not like this aluminium profile" (of model 8600)... "This was another reason for customers' complaints".)

- 2.2 It is true that the Boards of Appeal have applied a very strict standard of proof of an alleged prior use in some particular situations where, as emphasized in decision T 472/92 OJ EPO 98, 161, practically all of evidence in support of the alleged prior use lay within the power and knowledge of the opponent, so that the patentee did not have any ready or indeed any access to it at all. All he could in practice do was to challenge that evidence by pointing out any inconsistencies contained in it or to draw attention to any gaps in the chain of commercial transactions that needed to be established by the opponent in order to succeed in this

ground. The Boards concluded that in such cases an opponent had to prove its case up to the hilt for little if any counterevidence would be available to the patentee to establish that no prior public use had taken place (see point 3.1 of the reasons).

In the present case however, the patentee (respondent) was clearly in a position to provide counterevidence e.g in the form of a statutory declaration that no public use of the model 8600 window had taken place prior to the claimed invention. In fact, in the declaration signed by Mr Resibois which originates from the patentee itself, the model 8600 window was said to be developed under the direct supervision and responsibility of Mr Resibois. This clearly means, that the patentee was in a position to challenge the prior public use of the model 8600 window. In his declaration however Mr Resibois did not do that and argued in favour rather than against the existence of a public prior use. Reference is made to the following passage:

"Unfortunately the customers did not like this aluminium profile [of the model 8600 window] because it made the window more thick, more heavy, more expensive and less attractive in design. After fitting the windows in the caravan the windows were quite sensitive on getting condensation in the space between the acrylic sheets. This was another reason for the customers' complaints" (emphasis added).

For the above reasons, the Board concludes that the prior public use of the model 8600 windows does not need to be proven up to the hilt and the normal standard of proof should therefore be applied in the present case.

Following this principle, there cannot be any reasonable doubt that in view of the above considerations the model 8600 referred to in the prior publication XA2, the catalogue XA3 as well as in both declarations signed by Mr Hengen and Mr Resibois, was exhibited publicly or sold to customers before the claimed priority date.

Therefore the Board is satisfied that on the evidence at its disposal the model 8600 window was made available to the public before the claimed priority date.

3. *Novelty (main request)*

According to the declaration signed by Mr Resibois "a double-sided glue tape was applied.... With the model 8600 it was now possible to have a painted exterior sheet with paint on the inside, to cover the rubber and also the accessories, without the paint being destroyed by the glue. It was however necessary to hold the two sheets together with an additional aluminium frame clamped around the window as the adhesive tape only was not strong enough".

Expressed differently, the outer and inner panes of the model 8600 window are interconnected at an edge portion of the window by means of at least an adhesive joint (a double-sided glue tape). Moreover the model 8600 window is also provided with an opaque screening layer applied at the inside of the outer plane.

It follows that all the technical features of the window according to granted claim 1 are disclosed by the prior model 8600.

Accordingly the Board comes to the conclusion that the subject-matter of claim 1 as granted lacks novelty over

this prior art. The main request must therefore fail.

4. *Novelty (first and second auxiliary requests)*

In the auxiliary requests claim 1 has been formulated so as to state in its preamble that the inner and outer panes are interconnected by means of a direct glue or fusion joint. In the Board's view the double sided glue tape of the model 8600 window is not to be considered as a "direct glue joint" between the two panes.

It follows that Claim 1 according to the first and second auxiliary requests is novel over this prior art.

5. *Inventive step (first auxiliary request)*

As has been explained above , the claimed window differs from the prior model 8600 window only by virtue of a direct glue or fusion joint between the two panes.

This distinguishing feature is to be interpreted as meaning what it says, that is the provision of a direct glue or fusion joint, without the interposition of a tape between the two panes. There is however no reason for an interpretation that the two panes are exclusively held together by a glue joint without the aid of external clamping elements. This kind of window is namely intended to be positioned against an opening in a caravan wall in fixed, sliding or hinged relationship. In the embodiment disclosed in the European patent in suit, the window is in fact connected to the vehicle wall by means of a hinge comprising a U-shaped bar which clamps the whole upper edge side of the window. The direct glue connection is thus strengthened by this U-shaped clamping bar.

According to the European patent specification a double-walled window in which the two panes are

interconnected by a glue joint suffers from the problem that the glue may flow fairly irregularly during glueing, which may lead to disturbing stains and inclusions which are both visible through the outer pane and render the window considerably less attractive (see column 1 third paragraph of the patent specification).

The problem underlying the European patent, which is to overcome this disadvantage, is also solved in the prior model 8600 window by the screening layer or printed coating which covers the area of the double sided glue tape.

Concerning the issue whether it is within the capabilities of a skilled person to replace the double sided glue tape with a strip of glue, the following is to be said:

There is no proper basis for the respondent's allegations according to which in order to arrive at this solution a prejudice had to be overcome and that it was surprising that in spite of the presence of the screening layer, a satisfactory glue connection between the two panes was nevertheless achieved. Reference is made in this respect to EP-A-0 298 788 (cited in the search report), particularly to Figure 1 to 3 and the passage bridging column 3 and 4, where a screening layer (7) lies between the strip of glue (8) and the laminated windscreen for motor vehicle. It is also applied to the inside of the windscreen and functions as a decorative frame, preventing the glueing area from being seen through the windscreen. It is expressly stated that the screening layer also enhances adherence between the strip of glue (8) and the surface of the glass and protects the strip against the action of ultraviolet rays (see column 4, lines 4 to 7).

The prejudice in the art alleged by the respondent is contradicted by the above statement that the screening layer enhances the adherence between the glue material and the laminated windscreen. In any case the respondent has failed to demonstrate that such alleged prejudice was widely or universally held by experts in that field, as required by the well established jurisprudence of the Boards of appeal.

Accordingly the Board concludes that the subject-matter of claim 1 according to the first auxiliary request lacks an inventive step as required by Article 56 EPC.

Therefore claim 1 is not allowable and the first auxiliary request must fail.

6. *Inventive step (second auxiliary request)*

Compared with claim 1 according to first auxiliary request, claim 1 according to the second auxiliary request contains the additional feature that the screening layer is locally provided with interruptions.

According to the European patent specification, these interruptions enhance the adhesion between the glue material and the outer pane, given that the glue or molten material can come directly into contact with the outer pane at the area of these interruptions.

Reference is made in this respect to the design model XA1 also concerning a window for vehicles. As indicated by the title of this design model the depicted window is provided on its edges with a frame-shaped pattern made by silk screen printing (serigraphy). Obviously this silk-screen pattern which comprises interspaces between the printed spots, serves to conceal the accessories of the depicted window and to render its design more attractive.

The skilled person searching for a solution to the technical problem underlying the invention and thus having in mind the necessity of improving the aesthetic aspect of double walled windows whose panes are interconnected by a glue joint, while maintaining an adequate glue connection therebetween, gets from this citation the teaching that a printed silk screen pattern despite its interruptions serves to hide from view the accessories of the window and to improve its aesthetic aspect. For this reason it would have been obvious for the skilled person at least to try, with a reasonable expectation of successfully solving the technical problem adressed to, to replace the continuous screen layer of the prior model 8600 window by the silk screen pattern of the design model XA1. Such experiment apparently would not require more than the ordinary skills in this field and in making such experiment the skilled person would recognise that because of the interspaces between the printed spots of the pattern a better adhesion may be achieved between the glue material and the outer pane without impairing the aesthetic aspect of the window.

Therefore the Board comes to the conclusion that the subject-matter of claim 1 according to the second auxiliary request does not involve an inventive step either (Article 56 EPC). Consequently the second auxiliary request must also fail.

7. There being no allowable request, it follows that the patent must be revoked.

Order

For these reasons it is decided that:

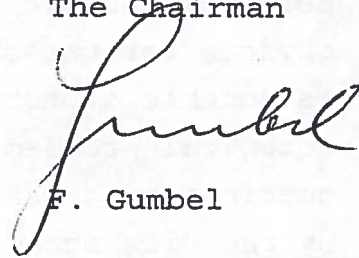
1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:



S. Fabiani

The Chairman



F. Gumbel