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D E C I S I O N
of 27 June 2001

Case Number: T 0154/99 - 3.4.2

Application Number: 92924935.7

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Title of invention:
Advertising Sign

Patentee:
HANSEN, Jarle

Opponent:
Reklamidé Värmland AB

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Inadmissible amendment in claims as granted - (no)"

Decisions cited:
-

Catchword:
-



Case Number: T 0154/99 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 27 June 2001

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 December 1998
revoking European patent No. 0 570 562 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: M. A. Rayner
B. J. Schachenmann

Summary of Facts and Submissions

- I. The present appeal is against the decision of the opposition division revoking European patent number 570 562 (application number 92 924 935.7, International Publication number WO 93/12514). Claim 1 of the patent as granted is directed to an advertising sign and includes as its last feature the following wording "the stop means of the profile (25) comprises more than one track (27) with a view to establishing alternative points of rotation for the tightening member (16) during the swinging thereof."
- II. The original opposition so far as based on Article 100(c) EPC (Article 123(2) EPC) concerned the term "establishing alternative points of rotation" in claim 1, which was argued to be added subject matter, claim 1 as originally filed reciting "tightening means..., in abutment with the stop means, are caused to swing in the direction away from the front", it being argued that neither in this claim nor the remainder of the documents as filed was there any defined point of rotation for the tightening member, the movement of which was a complex motion. In the reply to the statement of opposition, the patent proprietor (=appellant) remarked both that the term "points of rotation" did not occur anywhere in the original documents and that the movement of the tightening member was a complex motion not able to be described as a mere rotation having a certain fixed centre. Subsequently, the patent proprietor suggested an amendment to claim 1 and requested maintenance of the patent amended accordingly.
- III. In the decision under appeal, the opposition division

declared itself to be of the same opinion as both parties that no basis could be found for the term "points of rotation" and explained that it had come to the conclusion that the subject matter of claim 1 as granted would not fulfil the requirements of Article 123(2) EPC. The actual reason provided for the revocation of the patent was however that claim 1 of the amended request before the opposition division had been amended in such a way as to extend the protection conferred (Article 123(3) EPC).

- IV. The appellant requested setting aside of the decision and as main request maintenance of the patent as granted. The appellant also requested maintenance of the patent in amended form on the basis of one of four auxiliary requests. The respondent (=opponent) requested the board to dismiss the appeal of the appellant. Oral proceedings were requested by both parties.
- V. In the written appeal procedure, the appellant referred to "swinging" of the tightening member as disclosed on page 4, lines 13 to 15 (with respect to Figure 1) or page 5, lines 10 to 16 (with respect to Figure 2) of the published application. Swinging like any other movement can be decomposed into a rotation and a translation, the rotation always implies a point of rotation. Therefore swinging as referred to in the documents as filed implicitly discloses a rotational movement around a point of rotation. According to the respondent, "swinging" is understood as a periodic rotation or translation where the swinging body passes a point of equilibrium and thus does not automatically imply any rotation. A rotation around a fixed point is moreover not a complex motion which can be described as

a composition of a translation and a rotation where the point of abutment changes in a complex motion.

Accordingly, the subject matter of claim 1 as granted infringes Article 123(2) because subject matter has been added thereto.

VI. During the oral proceedings before the board of appeal, appointed consequent to auxiliary requests filed, the parties argued as follows:

According to the appellant, while it is true that the explicit wording "points of rotation" is not present in the documents as filed, there is an implicit disclosure thereof because of the swinging disclosed for example in Figure 1. In practice, the skilled person easily sees that there is a rotation point which simply moves a little. The "swinging of the tightening member" would never be understood by the skilled person as argued by the respondent as a mere translation, nor would a rotation be considered to have an infinite radius and thus amount to a translation.

The respondent explained that the feature "points of rotation" had been important in establishing patentability and also observed that the feature "swingable around said abutment point" was not present in the documents as filed. The skilled person addressed by the patent is not a mathematician or theoretical physicist but a design engineer, who from the claim in dispute learns with respect to the fixed point simply - "I must provide a point of rotation." However, the skilled person would not find such a fixed point in the complex movement shown in Figures 1 or 2, where translation is also involved. Consequently, what he is taught by claim 1 as granted is added subject matter in

infringement of Article 123(2) EPC.

Both parties also commented on the disclosure of documents of the prior art.

VII. Claim 1 according to the main request of the appellant (claim as granted) is worded as follows:

Main request

An advertising sign comprising a rigid apparatus (1), preferably having sources of light (11) mounted therein, and on a visible front (2) thereof a relatively thin and flexible canopy (7) comprising at least one peripheral side edge, a desired message having been applied onto said canopy; and a profile (25) mounted on frame struts (6) of the apparatus (1), said profile being provided with stop means for one or more tightening members (16) holding one or more of said side edges of the canopy (7), said tightening members in abutment against the stop means (27) of the profile being swingable around said abutment point in the direction away from the front (2) and toward sides (3,4) of the apparatus (1) with a view to fastening and tightening the canopy (7), and said tightening members (16) being secured to the profile by locking means, wherein the stop means of the profile (25) comprises more than one track (27) with a view to establishing alternative points of rotation for the tightening member (16) during the swinging thereof.

[Note: The wording of the other independent claims as granted is not given because they are not dealt with in this decision]

Auxiliary requests

Since the auxiliary requests are not addressed by the present decision (see point 3 of the Reasons below), the wording of the claims concerned is not given.

Reasons for the Decision

1. The appeal complies with the provisions mentioned in Rule 65(1) EPC and is therefore admissible.

2. *Main request - Admissibility of amendments*
Article 123(2)
 - 2.1 Although the procedure before the first instance developed in such a way that no decision had actually to be given in relation to the admissibility of amendments introduced into granted claim 1 during the examination procedure, it can be concluded from the reasons that this issue became focussed on whether the specific wording "points of rotation" was present in the documents as filed and whether the complex movement of the tightening member could "be described as a mere rotation having a certain fixed centre". The board considers this approach as incomplete, because it ignores the overall disclosure of the documents as filed, i.e. including implicit disclosure in the light of the wording used in the description as well as what is shown in the drawings. Moreover, the wording "mere rotation having a fixed centre" differs from that of the claim in dispute. Consequently, it is necessary to take a step back from this position and to determine the overall disclosure of the documents filed in relation to the wording really at issue, so that a

proper and complete assessment in the context of Article 123(2) can be made.

2.2 In the view of the board, the starting point for this assessment can only be whether or not a rotation is disclosed in the documents as filed, since in the negative case, there would be infringement of Article 123(2). With reference to the International published application WO 93/12514 (taken as the application as originally filed), reference has been made in the opposition or appeal proceedings to the published claim 1, parts of pages 4 and 5 and the drawings. The most relevant passages for consideration in this assessment are worded as follows:

- (a) Page 4, lines 11 to 17 - "Tightening member 16 is then placed in approximately perpendicular position inside edge 14 with its bend 17 against cover panel 9. When tightening member 16 is then swung in the direction toward the rear side 5 and inward toward sides 3,4, canopy 7 is tightened, and the tightening member can then be fastened to the cover panel 9, e.g, with the aid of pins, screws, or the like."

- (b) Page 5, lines 9 to 18 - "When canopy 7 is attached to tightening member 16, the latter is set down in an upright position, as shown on the drawing, so that the bend 17 bears against partition wall 28', 28" or the bottom 26, depending on which of the tracks 27 one chooses to use. Then tightening member 16 is swung inward from front 2 and toward the bottom 26 of profile 25. When the tightening of canopy 7 has been completed, tightening members 16 may be locked by means of a lock fitting 32,

which one then inserts into an appropriate groove 29 while grasping the upward bent part 33."

(c) The characterising part of claim 1 as originally filed - "the canopy (7) is tightened by fastening one or more of the sides of the canopy (7) to one or more tightening members (16) which, in abutment with stop means, are caused to swing in the direction away from the front (2) and toward the sides (3,4) of the apparatus (1) so that the angle between the tightening member(s) (16) and the sides (3,4) of the apparatus (1) becomes smaller than at the starting point, and that the tightening member(s) (16) is/are then secured to the sides (3,4) of the apparatus (1) or prevented by other means from swinging back again."

(d) In addition to the above passages, the drawings of the documents as filed also contain relevant disclosure, for example, the tightening member mentioned in the passage cited in 2.2(b) above is shown dotted in its upright position and in full lines when locked. Inspection of Figure 2 reveals that the abutment on the partition wall changes between these two positions. In the drawings, sides 3 and 4 are shown as the top and bottom sides and the front 2 is at the right, the rear side 5 being at the left.

2.3 Having regard to the disclosure cited, the board reached the view that the skilled person is directly and unambiguously taught that the "swinging" does indeed entail a rotation because of the movement towards and change of angle of the tightening member with respect to the top and bottom sides. Accordingly,

the submission of the respondent in the direction that rotation is not disclosed in the application documents as filed fails to convince the board. Having once reached the view that rotation is disclosed in the documents as filed, the board shares the view of the appellant that a point of rotation is necessarily implied, since this is by definition always the case, irrespective of any translational movement which may be involved. Consequently, the skilled person knows a point of rotation is provided and thus the submission of the respondent that such is absent in the motion of the tightening member also fails to convince the board. Therefore, the board concluded that the recitation of "points of rotation" in the context of claim 1 does not amount to added subject matter. Moreover, the two positions of the tightening member, together with the passages cited above directly and unambiguously show that the swinging is around the abutment point (see for example 2.2(b) - "bears against partition wall" or 2.2(c) - "in abutment with stop means, are caused to swing" as well as the positions shown in the drawings). Accordingly, the board is satisfied with respect to claim 1 as granted that no amendment contrary to the requirements of Article 123(2) EPC (Article 100(c) EPC) took place.

- 2.4 The entire discussion about admissibility of the term "points of rotation" with respect to the understanding of a design engineer, mathematician or theoretical physicists and concerning defined and fixed points, complex motion and infinite radii involved wording differing from that used in the granted claim itself, the clarity of which is not open to opposition. In the view of the board, consideration of such differing wording does not detract from the support in the

documents as filed for the term actually in dispute, i.e. "points of rotation", which is present as set out in point 2.3 above. Consequently, whatever their factual merit, statements such as "the movement of the tightening member is a complex motion and cannot be described as a mere rotation having a certain fixed centre" are not pertinent to the amendment concerned. Accordingly, lines of argument advanced by the respondent and based on any of the differing wordings also fail.

- 2.5 The board refrains from reference to prior art documents, because the question of added subject matter of claim 1 as granted, which is all that is at issue in connection with the main request in the present appeal proceedings, can be decided on the basis of the documents as filed. Moreover, remarks about the prior art might improperly influence the in the light of this decision in other respects completely open further prosecution of the case before the first instance for example with respect to novelty and inventive step.

Auxiliary requests

3. In view of the positive conclusion reached by the board with respect to the main request of the appellant, consideration of the auxiliary requests is not necessary in the present decision.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

P. Martorana

E. Turrini