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D E C I S I O N
of 14 November 2000

Case Number: T 0264/99 - 3.2.1
Application Number: 94830527.1
Publication Number: 0656289
IPC: B60S 3/06, F16D 1/033
Language of the proceedings: EN

Title of invention:

Tubular element for supporting washing brushes, for application to automatic motor-vehicle washing systems and the like

Patentee:

Favagrossa Edoardo S.r.l.

Opponent:

- (OI) Otto Christ AG
(OII) Kullen & Mez GmbH & Co.
(OIII) California Kleindienst Autowaschtechnik GmbH

Headword:

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Relevant legal provisions:

EPC Art. 54, 56, 111(1), 123(2)

Keyword:

"Claimed feature derivable from drawings (yes)"
"Prior use - need to hear witnesses - remittal"

Decisions cited:

T 0169/83, T 0170/87, T 0782/92

Catchword:

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Case Number: T 0264/99 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 14 November 2000

Appellant:
(Opponent OI)

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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted 9 February
1999 concerning maintenance of European patent
No. 0 656 289 in amended form.

Composition of the Board:

Chairman: F. A. Gumbel

Members: S. Crane
J. H. Van Moer

Summary of Facts and Submissions

- I. European patent No. 0 656 289 was granted on 19 February 1997 on the basis of European patent application No. 94 830 527.1, which claimed a priority date of 2 December 1993.
- II. The granted patent was opposed by the present appellants (opponents OI and OIII) and the other party to the proceedings under Article 107 EPC (opponents OII). They requested that the patent be revoked in its entirety for lack of novelty and/or inventive step (Article 100(a) EPC).

In the main the state of the art relied upon was constituted by allegedly publicly prior used washing brush support elements designed for motor vehicle automatic washing systems. These were

"Prior use E1": a support element shown in cross-section in the drawing No. 1022814 of opponents OI;

"Prior use E2": a support element shown in cross-section in the drawing No. 1022833 of Hoogovens Aluminium Profiltechnik GmbH;

"Prior use E2*": a support element with the cross-section visible in photograph 15 of Anlage 5 to the notice of opposition of opponents OI;

"Prior use E3": the sale in June 1993 of washing brushes by the proprietors of the patent (present respondents) to opponents OIII, the support elements of these washing brushes allegedly corresponding to that shown in the drawings of the contested patent.

III. In its decision posted on 9 February 1999 the Opposition Division held that the prior uses E1 and E2 had been adequately proven but the prior uses E2* and E3 not. On the basis of the thus established state of the art it was held that the subject-matter of claim 1 as granted was not new and the subject-matter of claim 1 according to a first auxiliary request lacked inventive step. The patent could however be maintained in amended form on the basis of the documents according to a second auxiliary request, claim 1 of which reads as follows:

"A tubular element (2) for supporting washing brushes (20), particularly designed for motor vehicle automatic washing systems, said tubular elements (2) comprising a single extruded tubular body, of circular cross-section, provided with integral longitudinal ribs (3) on an inner surface thereof, in said ribs (3) there being provided recesses (4) for engaging therein affixing means for connecting coupling flange means (10) for coupling an electric motor (11) to rotatively drive said tubular body, said ribs (3) directly projecting in an approximately semi-circular way from the inner surface of said tubular element (2) into the inside of said tubular element (2), and said recesses (4) being formed by closed circular section cylindrical hollows."

- IV. Notices of appeal against this decision were filed by opponents OI (first appellants) on 4 March 1999 and by opponents OIII (second appellants) on 25 March 1999 respectively. In both cases the fee for appeal was paid at the same time. The statement of grounds of appeal of the first appellants was filed on 17 June 1999 and that the second appellants on 10 June 1999.
- V. In a communication pursuant to Article 11(2) RPBA dated 9 June 2000 the Board addressed *inter alia* the question of whether it had been adequately proven that the washing brushes delivered by the respondents to the second appellants in June 1993 were equipped with support elements having the cross-section defined in claim 1. The Board also indicated its intention according to Article 114(2) EPC not to deal with the new allegations in the statement of grounds of the second appellants of a further public prior use of the claimed invention by the respondents and to disregard the late-submitted evidence of the first appellants concerning the alleged prior use of tubular elements filed with their letter dated 12 October 1999.
- VI. In a reply to this communication received on 12 October 2000 the second appellants submitted further evidence directed to the form of the tubular support elements of the washing brushes supplied to them by the respondents. In this context they offered one of their former employees, Mr Josef Schwab, who had already been named in the notice of opposition, as a witness. As a further witness to the nature of the tests performed by the second appellants with the washing brushes supplied to them they offered another of their employees, Mr Maximilian Bentenrieder.

VII. Oral proceedings before the Board were held on 14 November 2000. Opponents OII, who had taken no part in the appeal proceedings did not attend, although duly summoned.

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

The respondents requested that the appeals be dismissed and the decision of the Opposition Division to maintain the patent in amended form be confirmed.

VIII. The arguments of the appellants can be summarised as follows:

Claim 1 in the form accepted by the Opposition Division infringed Article 123(2) EPC in two respects. Firstly, there was no clear basis in the original application for the requirement that these be only a "single" tubular body of circular cross-section; the mere absence of a second such body in the drawings could not justify the formulation of a negative limitation in this respect. Secondly, and more importantly, the definition of the ribs as being "approximately semi-circular", which was also purportedly derived from the drawings, was in the first place deliberately obscure and moreover did not actually correspond with what could clearly be seen in them. Decision T 169/83 (OJ EPO 1985, 193) had laid down strict conditions as to the allowability of the incorporation of a feature allegedly derived from the drawings into a granted claim. These conditions were certainly not met in the present case.

According to the first appellants the subject-matter of

claim 1 lacked inventive step with respect to the prior uses E1 and E2 and the common general knowledge of the person skilled in the art. Both of these prior used tubular support elements solved the problem with which the alleged invention was concerned, namely to provide means allowing the direct attachment of the coupling flange of a drive motor, and in general terms the solution involved corresponded to that claimed, namely providing the tubular elements with ribs having a preformed channel for accepting fixing bolts. In comparison with this state of the art the claimed tubular element exhibited a simpler cross-section but offered no other technical advantage. The person skilled in the art had to be considered as someone who was familiar with the technology of extruding aluminium sections. For this person the claimed cross-section was no more than a routine development of what had already been proposed, devoid of any inventive merit.

The second appellants relied on their allegation that the respondents, before the priority date of the contested patent, had sold them, without any fetter of confidence, a number of washing brushes having tubular support elements which corresponded exactly to those illustrated in the drawings of the patent specification, so that the subject-matter of claim 1 lacked novelty. In their view the evidence they had furnished in the course of the opposition and appeal proceedings was adequate to demonstrate both the form of the tubular support elements involved and the nature of the prior uses. If there were any remaining doubts in these respects then the offered witnesses should be heard.

IX. In reply the respondents argued substantially as

follows:

The person skilled in the art would readily recognise from the drawings of the original application that each of the ribs on the inner surface of the tubular support element had an approximately semi-circular cross-section. It was evident that in the region of the junctions between the rib and the cylindrical inner surface there was some departure from a true semi-circular shape which was dictated by the geometry involved and manufacturing considerations. This was what the attribute "approximately" was intended to cover. The person skilled in the art would also be in no doubt from the original application read as a whole that the support element comprised a single tubular body of circular cross-section.

The evidence filed by the second appellants purporting to demonstrate that the tubular support elements of the washing brushes supplied to them by the respondents in June 1993 was completely unreliable. In any case, the supply of the washing brushes, whatever their form may have been, had been for test purposes only and accordingly was subject to a tacit understanding of confidentiality. The alleged circumstances surrounding the disclosure of the form of the support elements to third parties by the second appellants were wholly unconvincing.

The arguments of the first appellants concerning the obviousness of the claimed subject-matter with respect to the prior uses E1 and E2 were without any objective basis and relied solely on hindsight knowledge of the invention. The fact of the matter was that with respect to the state of the art the cross-section of the

claimed support element represented a striking simplification in which the available material of the cross-section was distributed in an optimal way.

Reasons for the Decision

1. The appeals comply with the formal requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. They are therefore admissible.
2. Two of the amendments made to granted claim 1 to arrive at the claim accepted in the Opposition Division have been objected to by the appellants.

The first is the requirement that the tubular support element comprises a "single" extruded tubular body of circular cross-section. This requirement was added in order to help distinguish the claimed subject-matter from prior use E2, this support element comprising coaxial inner and outer tubular bodies. The appellants argue that the "negative" feature of there being only one tubular body cannot be derived from the absence of a second tubular body in the drawings of the application. In decision T 170/87 (OJ EPO 1989, 441) it was held that the absence of a feature in a figure which serves only to give a schematic explanation of the principle of the invention could not be used as the basis for the incorporation into a claim of a statement excluding the presence of such a feature. The circumstances considered in this decision are however in no way comparable with those of the present case. Although Figure 3 of the drawings is designated as a "schematic cross-sectional view" of the tubular element there can be no doubt in the circumstances that it is

intended to provide a definitive illustration of the cross-section of the tubular element according to the preferred embodiment of the invention. Equally there can be no doubt that this preferred embodiment comprises a single tubular body of circular cross-section provided with integral longitudinal ribs on its inner surface.

The second amendment objected to by the appellants concerns the addition of the requirement of the ribs "directly projecting in an approximately semi-circular way" from the inner surface of the tubular element. As the Board understands it, the only sensible interpretation of this requirement is that each rib has an approximately semi-circular cross-section. It is common ground that if a basis for this amendment is to be found then it can only be sought in the drawings of the original application, in particular Figure 3 as mentioned above. Now, as established in decision T 169/83 (supra), although it is in principle permissible to incorporate into a claim a feature only found in the drawings of the original application, this feature must be clearly, unmistakably and fully derivable from the drawings in terms of structure and function by the person skilled in the art and so relatable by him to the content of the description as a whole to be manifestly part of the invention. The appellants argue that the clear and unmistakeable derivation of an "approximate" relationship is in any case a contradiction in terms. For the Board, that is not necessarily true. It depends on the circumstances. In the present case the person skilled in the art looking at Figure 3 of the original application will immediately recognise that the recess in each rib is of circular cross-section and that the radially inner

surface of the rib has a semi-circular profile centred on the centre of the recess, giving a constant wall thickness in this region. The centre of the recess lies however somewhat radially inwardly of the inner surface of the tubular body so that the rib, in addition to its radially inner semi-circular portion, also has relatively short transitional portions adjacent the inner surface of the tubular body, where the wall thickness of the rib increases. The first question that needs to be answered is therefore whether the shape of rib just described can be fairly defined as having an approximately semi-circular cross-section. In the opinion of the Board, having regard to the relative extent of the semi-circular and transitional portions of the cross-section involved, this question should be answered in the affirmative. The second question is whether the person skilled in the art would discern that the form of ribs shown in the Figure 3 of the drawings has not been merely arbitrarily chosen at the whim of the draftsman but constitutes a technical teaching related to the solution of the technical problem with which the claimed invention is concerned, namely providing cheap and effective means enabling connection of the tubular support element to a drive motor. Again, the Board sees this requirement as being met since the skilled person will recognise that the simple and compact form of the ribs contributes to an optimization of the distribution of the available material of the cross-section of the tubular element considered as a whole.

Accordingly, the Board comes to the conclusion that claim 1 as accepted by the Opposition Division does not offend against Article 123(2) EPC.

Independently of its impact on this issue of added subject-matter the appellants also argued that the use of the term "approximately" in claim 1 went against the requirement of Article 84 EPC that the claims be clear. However, as explained above, it is apparent from the patent specification considered as a whole that the degree of departure from a semi-circular cross-section of the rib is determined by technical considerations which effectively circumscribe the ambit of the term "approximately" as used in the claim. This objection of the appellants also therefore fails.

3. In the normal sequence of events considerations concerning the novelty of the subject-matter of a claim would be dealt with before turning to inventive step. In the circumstances of the present case, however, it is clearly appropriate to address first the question of whether the subject-matter of claim 1 is obvious having regard to the uncontested prior uses E1 and E2, as argued by the first appellants. In this context it should be noted that at the oral proceedings before the Board the alleged prior use E2* was no longer pursued.

The tubular support element of prior use E1 has a complex cross-section comprising three equiangularly disposed rib portions joined by corrugated wall segments, the radial height of the corrugations corresponding in essence to that of the ribs. Each of the ribs is provided with a recess for receiving fixing means by which the tubular element is coupled to the coupling flange of a drive motor. The recesses are not closed but are open to the radially outside surface of the respective rib.

The tubular support element of prior use E2 is simpler

than that of prior use E1. In cross-section it comprises inner and outer circular walls which are interconnected by three bridges. Each of these bridges has an enlarged central portion of circular cross-section provided with a closed recess of circular cross-section for receiving fixing means.

It is evident from prior uses E1 and E2 that the basic idea underlying the claimed invention, namely to dispense with separate flange elements which had to be attached, eg by welding, to the ends of the tubular support element and instead to provide means directly within its cross-section for receiving fixing bolts or the like, was known in the art. It does not follow from this, however, as the first appellants have in effect argued, that any cross-section which achieves the same end, including that presently claimed, is a mere design variation devoid of an inventive merit. The respective cross-sections of the prior used tubular support elements have evidently been carefully and specifically designed not only to provide recesses for fixing means, but also having regard to the overall structural stiffness required from the element when it is in service. Each of them represents a complete and self-contained technical solution in its own right and neither of them can give any hint to the person skilled in the art that a different solution corresponding to that claimed would be advantageous. As a consequence, the subject-matter of claim 1 cannot be seen as being obvious to the person skilled in the art having regard to prior uses E1 and E2, this being the appropriate yardstick for judging inventive step (Article 56 EPC).

No different conclusion would be reached if account were taken of the allegedly prior used aluminium

tubular elements referred to by the first appellants in their letter of 12 September 1999. Not only are the fields of application of the tubular elements involved in no way comparable to that of the claimed subject-matter but also are the ribs of the illustrated cross-section neither closed, nor of approximately semi-circular form.

4. Having regard to the above it is apparent that the fate of the contested patent depends on the alleged prior use E3. As a starting point it is useful to establish here the little which is common ground between the second appellants and the respondents: following discussions between representatives of the two companies at the end of 1992 an offer to supply to the second appellants washing brush sets comprising either flanged steel "pipes" (ie tubular support elements) or flangless aluminium pipes was made by the respondents by fax of 4 June 1993 ("Anlage E1"); in the same month a delivery to the second appellants of two sets of washing brushes was made at a total price of ITL 1 744 000 (see "Anlage E2"); in the spring of 1994, after the priority date of the contested patent, the second appellants introduced a new series of automated car washes incorporating washing brush sets purchased from the respondents, the tubular support elements of these washing brushes corresponding to the contested patent. The rest is in contention. In particular, the respondents argue that the second appellants have not proven that the support elements of the washing brushes delivered before the priority date of the patent had the form defined in present claim 1. After the length of time that has elapsed they themselves are however unfortunately not in a position to provide documentary evidence that this was otherwise. Furthermore, they

contend that this initial delivery of a small number of washing brushes was for preliminary testing and development only, with the consequence of a tacit understanding of confidentiality between the two companies.

The Opposition Division, citing decision T 782/92 (not published in OJ EPO), found this latter contention convincing. However, the Board sees significant distinctions between the circumstances considered in that earlier case and the present one. Here, there is no indication from the evidence on file that the washing brushes were sold to the second appellants as anything other than finished products; there is no suggestion that any joint development of the washing brushes took place; the only purpose of the testing was to see how the washing brushes performed under service conditions. Furthermore, the second appellants argue that the area where this testing took place was frequently visited by external customers for their products under development, so that the basic underlying requirement for a tacit understanding of confidentiality could never have existed; in the present case, given that the development of the new series of automated car washes was very well advanced, there had been every reason to discuss all technical advances, with the potential customers including the new form of support element for the washing brushes. In contrast to the opposition proceedings, where the second appellants provided no evidence in this latter respect, they have now named the previous head of their test department (Mr Bentenrieder) as a witness. Thus, if there are any remaining doubts as to whether the sale of the washing brushes to the second appellants in itself constituted public prior use within the meaning

of Article 54(2) EPC it will be necessary to hear this witness.

Since the Opposition Division took the view that there had been no public prior use of the washing brushes delivered to the second appellants in June 1993 it was not necessary for it to make a finding on what the form of the tubular support elements of those brushes was. In the opinion of the Board there is still, despite the submission of further documentary evidence, room for residual doubt here. The only piece of evidence purportedly dating from before the priority date of the patent which shows a cross-section directly equivalent to that of Figure 3 of the patent specification is "Anlage 1/4" to a fax from the respondents to the appellants with a date of typing of 12 October 1993. However, neither the content of this fax, nor the circumstances surrounding why it was sent, are sufficiently clear to allow a definitive correlation between the cross-section shown in "Anlage 1/4" and the form of the support elements of the washing brushes actually delivered in June 1993. Aware of the relative weakness of the documentary evidence which they could supply, after all they were not the manufacturers of the products involved, the second appellants had already named in their notice of opposition Mr Schwab as a witness in this respect. In view of the decision that the Opposition Division arrived at it was not necessary for him to be heard. This is however unavoidable now.

For completeness it is necessary for the Board to deal with three further more peripheral aspects of the case made out by the second appellants. The first is that the meeting in December 1992 between employees of the

two companies involved, at which the possibility of flangeless aluminium support elements was discussed, already constituted a public prior use of the invention. Notwithstanding the difficulty in establishing with sufficient certainty what was actually discussed and on what basis, the Board is in any case of the opinion that the contents of such an exploratory discussion is subject to implicit confidentiality. The second is that the fax dated 12 October 1993 (if that indeed was when it was sent) not only represented significant evidence as to the form of the support elements of the washing brushes which has been delivered, for which purpose it had originally been filed, but also in itself constituted a prior publication of the claimed invention. As already indicated above the circumstances concerning the sending of this fax are however obscure and there can be no suggestion of it constituting a publication in any normal sense. Lastly, the further alleged prior use mentioned briefly in the statement of grounds of appeal was explained at the oral proceedings as being by way of a false delivery to another company of washing brushes, having tubular support elements as claimed, intended for the second appellants. The circumstances surrounding this alleged prior use are so nebulous that the Board saw no reason to depart from its already signalled intention not to admit this into the proceedings.

5. In summary, therefore, the Board comes to the conclusion that the issues surrounding the alleged prior use E3 can only be satisfactorily clarified by hearing Mr Schwab and possibly Mr Bentenrieder. In the circumstances it is appropriate that this be done by the Opposition Division rather than the Board itself in

order to allow the questions involved to be aired fully before two instances.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

S. Fabiani

F. Gumbel