

Internal distribution code:

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

**Datasheet for the decision
of 4 July 2019**

Case Number: T 1588/16 - 3.2.01

Application Number: 09779100.8

Publication Number: 2401191

IPC: B62D25/04, B62D29/00

Language of the proceedings: EN

Title of invention:
STRUCTURAL REINFORCEMENT SYSTEM

Patent Proprietor:
Sika Technology AG

Opponent:
L & L Products Europe S.A.S.

Headword:

Relevant legal provisions:
EPC Art. 54
RPBA Art. 12(4)

Keyword:

Novelty (no)

Admission of auxiliary requests 6,7,9,10 (late filed or not admitted in opposition proceedings) (no)

Decisions cited:

T 0339/06

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1588/16 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 4 July 2019

Appellant:
(Patent Proprietor)

Sika Technology AG
Zugerstrasse 50
6340 Baar (CH)

Representative:

Sika Patent Attorneys
c/o Sika Technology AG
Corp. IP Dept.
Tüffenwies 16
Postfach
8048 Zürich (CH)

Respondent:
(Opponent)

L & L Products Europe S.A.S.
1 Rue Lindberg
ZA Activeum, Altorf
67129 Molsheim, cedex (FR)

Representative:

Wolff, Felix
Kutzenberger Wolff & Partner
Waidmarkt 11
50676 Köln (DE)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 12 May 2016
revoking European patent No. 2401191 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: C. Narcisi
P. de Heij

Summary of Facts and Submissions

- I. European patent No. 2 401 191 was revoked by the decision of the Opposition Division posted on 12 May 2016. Against this decision an appeal was lodged by the Patentee in due form and in due time pursuant to Article 108 EPC.

- II. Oral proceedings were held on 4 July 2019. The Appellant (Patentee) requested that the impugned decision be set aside and that the patent be maintained as granted (main request) or, alternatively, on the basis of auxiliary requests 1 to 7, 9 or 10 (filed with the statement of grounds of appeal on 9 September 2016). Subsidiarily, the Appellant requested that the case be remitted to the Opposition Division for further prosecution on the basis of auxiliary requests 7, 9 and 10. The Respondent (Opponent) requested that the appeal be dismissed.

- III. Granted claim 1 reads as follows: "A structural reinforcement system (30), comprising:
a rigid carrier (32), the carrier (32) is configured to fit within a cavity (40) within a vehicle frame (10);
an expandable material (34);
an adhesive (36);
and characterized in that the expandable material (34) is disposed adjacent to the rigid carrier (32) and the adhesive (36), the adhesive (36) is placed on top of the expandable material (34), the expandable material (34) and the adhesive (36) are disposed such that the expandable material (34) causes the adhesive (36) to move away from the carrier and into contact with an exterior surface of the carrier (32) and an interior wall of the cavity (40) to bond both the rigid carrier

(32) and the wall cavity (40), when the expandable material (34) expands.”

Claim 1 of auxiliary request 4 reads as follows:

“A structural reinforcement system (30), comprising:
a rigid carrier (32) having a holding area, wherein the carrier (32) is configured to fit within a cavity (40) within a vehicle frame (10);
an expandable material (34) disposed within a holding area (38) of the carrier (32);
an adhesive (36) disposed within the holding area (38) of the carrier (32);
and characterized in that the expandable material (34) is disposed adjacent to the rigid carrier (32) and the adhesive (36), the adhesive (36) is placed on top of the expandable material (34), the expandable material (34) and the adhesive (36) are disposed such that the expandable material (34) causes the adhesive (36) to move away from the holding area (38) and into contact with an exterior surface of the carrier (32) and an interior wall of the cavity (40) and bond to both the rigid carrier (32) and the wall of the cavity (40), when the expandable material (34) expands.”

Claim 1 of auxiliary request 5 reads as follows:

“A structural reinforcement system (30), comprising:
a rigid carrier (32) having a holding area that is defined by a plurality of ribs, wherein the carrier (32) is configured to fit within a cavity (40) within a vehicle frame (10);
an expandable material (34) disposed within the holding area (38) of the carrier (32);
an adhesive (36) disposed within the holding area (38) of the carrier (32);

and characterized in that the expandable material (34) is disposed adjacent to the rigid carrier (32) and the adhesive (36), the adhesive (36) is placed on top of the expandable material (34), the expandable material (34) and the adhesive (36) are disposed such that the expandable material (34) causes the adhesive (36) to move away from the holding area (38) and into contact with an exterior surface of the carrier (32) and an interior wall of the cavity (40) and bond to both the rigid carrier (32) and the wall cavity (40), when the expandable material (34) expands."

IV. The Appellants' arguments, as far as relevant to the present decision, may be summarized as follows:

The subject-matter of granted claim 1 (main request) is new over D1.

First, the Opposition Division considered in an impermissible way the combination of D1 and D2 for the assessment of novelty of the claimed subject-matter. Even though D2 is cited in D1 (column 6, lines 12-19), nevertheless it is not allowed to combine features from both documents in an arbitrary manner. The novelty analysis in the appealed decision includes features from D1 (e.g. "cavity") and features from D2 (e.g. "expandable material", "adhesive") alike.

Further, even the combination of D1 and D2 does not disclose the features M2 (i.e. "a rigid carrier, the carrier is configured to fit within a cavity within a vehicle frame"), M5 (i.e. "the expandable material is disposed adjacent to the rigid carrier and the adhesive"), M6 (i.e. "the adhesive is placed on top of the expandable material") and M7 (i.e. " the expandable material (34) and the adhesive (36) are disposed such that the expandable material (34) causes the adhesive (36) to move away from the cavity and into contact with

an exterior surface of the carrier (32) and an interior wall of the cavity (40) to bond both the rigid carrier (32) and the wall cavity (40), when the expandable material (34) expands”).

In relation to feature M2 it is noted that the container shown in D1 is not a carrier since it encloses the expandable material and hampers or hinders (by contrast to the invention) the controlled expansion of the expandable material and of the adhesive disposed on top of it. Feature M5 is not fulfilled in D1, for D1 discloses that the adhesive is interposed between the expandable material and the container, therefore the expandable material is not disposed adjacent to the rigid carrier (or to the container). Feature M6 is not fulfilled in D1, as the adhesive encloses and surrounds the expandable material according to D1. Finally, as a result of the aforesaid constructional features distinguishing the claimed subject-matter from D1, functional feature M7 is likewise not derivable from D1 (and D2). Indeed, it is not disclosed in D1 and it is unclear how the expansion of the expandable material (i.e. pellets) would affect the pellets (enclosed by the adhesive) in the system of D1, i.e. the pellets being disposed in the container.

The subject-matter of claim 1 of auxiliary request 4 is new over D1 (in conjunction with D2). The features added by way of amendment further contribute to the novelty of the claimed subject-matter, since the container D1 does not have a “holding area” for holding the expandable material.

The subject-matter of claim 1 of auxiliary request 5 is new over D1 (in conjunction with D2). The features added by way of amendment further contribute to the novelty of the claimed subject-matter since D1

discloses no ribs, which by definition are longitudinal reinforcements of a surface structure protruding from said surface. D1 merely shows longitudinal elements bridging and connecting oppositely located constructional elements of the container, and moreover they do not have any "holding" function.

It is acknowledged that auxiliary requests 1 to 3 correspond to auxiliary requests 1 to 3 filed on 30 March 2016 which were withdrawn during oral proceedings before the Opposition Division. No specific circumstances are advocated or invoked for reintroducing these requests in appeal proceedings.

Auxiliary request 6, corresponding with an auxiliary request 3 which was not admitted by the Opposition Division, should be admitted into the appeal proceedings. This auxiliary request should have been admitted by the Opposition Division, for it was filed in response to the negative opinion of the Opposition Division on the preceding requests and it solely included features intended to further clarify the claimed subject-matter, particularly in relation to the expansion of the expandable material.

Auxiliary requests 7, 9 and 10 should be admitted into the appeal proceedings, for in these requests the independent product claim was cancelled, thus leaving only the independent method claim. These requests cannot take the Respondent by surprise and clearly contribute to simplify the discussion. These auxiliary requests could not be submitted earlier since the Patentee had clearly the impression and had no doubts during oral proceedings that the Opposition Division would not accept any further auxiliary requests.

V. The Respondent's arguments may be summarized as follows:

The subject-matter of granted claim 1 is not new over D1 in conjunction with D2. The relevant features of D2 are cited and disclosed in D1, such that the appealed decision is correct, no combination of D1 and D2 having been considered.

The subject-matter of claim 1 of auxiliary request 4 is known from D1 (and D2), for D1 obviously and inherently discloses a "holding area" for the expandable material within the container.

The subject-matter of claim 1 of auxiliary request 5 is not new over D1 (and D2), for the "holding area" is likewise formed by ribs in the container.

Auxiliary requests 1 to 3 were withdrawn during oral proceedings, auxiliary request 6 was not admitted by the Opposition Division and auxiliary requests 7, 9 and 10 should have been filed already in opposition proceedings and were late filed. Hence these requests should not be admitted into the appeal proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. The subject-matter of granted claim 1 is not new over D1 (Article 54 EPC), given that disputed features M2, M5, M6 and M7 are disclosed in D1.

Feature M2 ("i.e. "a rigid carrier, the carrier is configured to fit within a cavity within a vehicle frame") is known from D1, given that the container 12 (see D1, figures 1, 2) in D1 carries the expandable material 30 (D1, column 4, lines 18-30) and is to be rightly considered as being a "carrier", this term being broader than and encompassing or including the term "container". In particular (contrary to the Appellant's view), the presence of outer walls or enclosures in a carrier is by no means excluded.

Feature M5 (i.e. "the expandable material is disposed adjacent to the rigid carrier and the adhesive") is known from D1. In effect, D1 states that "while the expandable material is configured as pellets in fig. 2, the expandable material may be placed within any container ... in a variety of different configurations ... For example, the expandable material may be provided as single mass or multiple masses .." (see D1, column 4, lines 39-45) and (D1, column 6, lines 12-19) "in another embodiment, the expandable material is provided in an encapsulated or partially encapsulated form, which may comprise a pellet, which includes an expandable foamable material, encapsulated or partially encapsulated in an adhesive shell. An example of one such system is disclosed in commonly owned, co-pending U.S. application Ser. No. 09/524,298 ("Expandable Pre-Formed Plug") (i.e. D2), hereby incorporated by reference". Thus it is absolutely evident that the expandable material 30 being shown placed in the container 12 in figure 2 of D1 may have "a variety of different configurations", in particular it can have the form of pellets, partially or completely encapsulated in an adhesive shell.

It ensues that the novelty analysis in the appealed decision is correct in this respect, since the mentioned feature is disclosed in D1, D2 merely being used for illustration purposes (identifying the expandable material and the adhesive with reference signs from figure 2 in D2). In other words, there is no need to refer to the disclosure of D2 when assessing whether feature M5 is known from D1, the technical information for concluding on lack of novelty being present in D1 alone.

In particular, it ensues that the expandable material is disposed adjacent to the rigid carrier and to the adhesive, the expandable material being surrounded by and adjacent to the adhesive, and also adjacent to the container 12 ("carrier"), given that it is placed in the container, i.e. in its immediate vicinity. The term "adjacent" does not require direct contact, and this is also not specified in claim 1.

Feature M6 (i.e. "the adhesive is placed on top of the expandable material") is known from D1, for the adhesive encapsulates the expandable materials (see above) and therefore irrespective of the specific arrangement of the expandable material in the container the adhesive will always be on top of the expandable material it. In effect, feature M6 does not require the adhesive to be located exclusively on top of the expandable material.

Finally, feature M7 (i.e. "the expandable material (34) and the adhesive (36) are disposed such that the expandable material (34) causes the adhesive (36) to move away from the carrier and into contact with an exterior surface of the carrier (32) and an interior wall of the cavity (40) to bond both the rigid carrier

(32) and the wall cavity (40), when the expandable material (34) expands") is likewise known from D1.

The Appellant's contentions are not convincing, particularly relating to the allegedly unknown way and manner in which the expandable material, being placed in the container, would expand in the cavity. Indeed, D1 repeatedly emphasizes that "upon activation, the pellets 30 of expandable material expand, combine and travel through the openings 20 (i.e. of the container 12) to contact the one or more walls of the structure 52", and "upon cooling, the expandable material adheres to the walls thereby securing the container and the expandable material within the cavity 50 (i.e. of the pillar structure 52)" (D1, column 6, line 63-column 7, line 3, figure 4). The same concepts are disclosed in connection with the embodiments of figures 5A, 5B (see column 8, lines 6-11; "upon activation of the expandable material, the expandable material expands and flows through the openings 122 of the peripheral wall 108 to contact the walls of the structure"), of figures 6A, 6B (column 8, lines 33-40) and of figure 7 (column 8, lines 59-64: "the expandable material may be activated to expand and flow through openings 182 of the container 170 to contact and wet walls of the structure. Upon curing, the expandable material adheres itself and the container 170 to the walls of the structure"). Finally, the same concept is repeated in more general terms, i.e. "Generally, for the various embodiments of the present invention, the walls or materials of the container, and particularly the walls or materials having the openings, will have a relatively large transmittance for allowing easier flow of the expandable material through the opening" (column 9, lines 1 to 5).

Therefore, it is self-evident that these concepts apply to all disclosed embodiments and that upon activation and expansion of the expandable material the adhesive (encapsulating and surrounding the expandable material) will "move away from the carrier and into contact with an exterior surface of the carrier (32) and an interior wall of the cavity (40) to bond both the rigid carrier (32) and the wall cavity (40)". In particular, the "rigid carrier" and the wall cavity will be bonded together after curing, either through direct bonding by the adhesive, or through the joint and combined action of the adhesive and of the expandable material, both alternatives being encompassed by the broad wording of feature M7.

3. Auxiliary requests 1 to 3 are not admitted into the appeal proceedings pursuant to Article 12(4) RPBA (Rules of Procedure of the Boards of Appeal), for these requests were already submitted and withdrawn during opposition proceedings. This was a deliberate choice and procedural act by the Appellant which cannot be reversed in appeal according to established case law of the Boards of Appeal. In particular, under the given circumstances this would be tantamount to warranting the Appellant freedom of choice to arbitrarily deciding to submit a given request either in opposition or in appeal proceedings. Moreover, the Appellant was not aware of and did not invoke any specific circumstances which could exceptionally lead to different conclusions.

4. The subject-matter of claim 1 of auxiliary request 4 is not new over D1 (Article 54 EPC). The amendment stating that the expandable material is disposed within a "holding area" cannot contribute to distinguish the claimed subject-matter from D1, as D1 discloses that

the expandable material (pellets) is placed within the container 12 (i.e. carrier) (figures 1,2) and is held therein by the top and bottom wall 24, 26 and by the outer circumferential walls. Therefore, a holding area is implicitly and inherently disclosed in D1, e.g. the inner surface of the bottom or top wall of the container.

5. The subject-matter of claim 1 of auxiliary request 5 is not new over D1 (Article 54 EPC). The further amendment indicating that the holding area is defined by a "plurality of ribs" does not render new the claimed subject-matter over D1, given that the longitudinal elements 20 connecting the bottom and top walls of the container 12 ("carrier") are to be regarded as ribs, very much the same as human ribs likewise designate and are constituted by (curved) longitudinal elements. Moreover, the ribs 20 in D1 likewise define a holding area, as they form the outer peripheral walls of the container, thus delimiting an inner volume or area (e.g. the inner surface of the top or bottom wall) in the container for holding the expandable material (pellets).

6. Auxiliary request 6 is not admitted into the appeal proceedings in view of Article 12(4) RPBA. This request was late filed during oral proceedings as auxiliary request 3 and considered inadmissible by the Opposition Division and it can only be admitted into appeal proceedings if the Opposition Division exercised its discretion in an improper way, i.e. if its decision is not based on the proper principles, or if these principles were applied in an unreasonable way. In the case in point the Board takes the view that the Opposition Division properly exercised its discretion, for it considered that claim 1 was prima facie not

clearly allowable for several reasons, and that the amendments were based on the description and were such that the Opposition Division and the Opponent could not be reasonably expected to be able to adequately consider and deal with the new submissions during the oral proceedings.

7. Auxiliary requests 7, 9 and 10 were submitted by the Appellant with the statement of grounds of appeal and the Board has pursuant to Article 12(4) RPBA a discretionary power not to admit these requests, if these requests could and should have been filed in opposition proceedings, thus being late filed. The Board considers that these auxiliary requests could and should have been filed already during opposition proceedings for the following reasons.

The appealed decision leading to revocation of the patent is based on independent claim 1 of the main request, and of the first, second and third auxiliary request, all these requests likewise including an independent method claim not discussed and decided upon in the appealed decision. It would have been obvious for the Patentee, as it presently occurred with auxiliary requests 7, 9 and 10, to submit an auxiliary request including only one independent method claim, thereby eliminating product claim 1, against which most of the objections of the Opponent were raised. Evidently the Patentee deliberately opted not to submit these requests during opposition proceedings, thus being satisfied with a decision based exclusively on independent claim 1, the Patentee obviously being aware of this fact. It is clear that the submission of corresponding requests, lying within the responsibility of the Patentee, generally determines to a major extent the course of the opposition and appeal proceedings,

and in the present case this led to a decision being taken only on the product claim. Thus, auxiliary requests 7, 9 and 10 could and should have been filed earlier, if the Patentee exercising its freedom of choice had deliberately chosen to seek protection only for the method of the independent claim, which he decided not to do since the main request as well as auxiliary requests 1 to 3 all included product claim 1 (see e.g. T 339/06, Reasons, 8.2).

The Board decided to exercise its discretionary power not to admit these requests into the appeal proceedings, given that the subject-matter of the method claim by its very nature considerably differs from the product claim and would require the Board to decide for the first time on all objections and all issues at stake in relation to this claim. However, this would be contrary to the general principles of the appeal proceedings (as set out in the decision G 9/91 of the Enlarged Board of appeal, Reasons, point 18) implying that it is not the purpose of the appeal proceedings to consider grounds for opposition on which the decision of the Opposition Division has not been based. In addition, to admit a new request under the given circumstances would give patentees the opportunity to compel a remittal to the first instance department as they pleased, which not only puts the opponent at a disadvantage but would also run counter to the principle of procedural economy.

As auxiliary requests 7, 9 and 10 are not admitted into the proceedings, the request to remit the case to the Opposition Division cannot be granted.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated