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**Datasheet for the decision
of 16 March 2021**

Case Number: T 2261/17 - 3.2.03

Application Number: 08166656.2

Publication Number: 2009195

IPC: E04F15/02, E04F15/04

Language of the proceedings: EN

Title of invention:

A flooring material comprising sheet-shaped floor elements
which are joined by means of joining members

Patent Proprietor:

Unilin Nordic AB

Opponent:

Dienwiebel, Thomas

Headword:

Relevant legal provisions:

EPC Art. 113(1), 100(b), 114(2), 100(a), 56

Keyword:

Right to be heard - opposition procedure - opportunity to
comment (yes) - violation (no)

Grounds for opposition - fresh ground for opposition (yes)

Inventive step - (yes) - non-obvious modification

Decisions cited:

G 0009/91, G 0010/91

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 2261/17 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 16 March 2021

Appellant: Dienwiebel, Thomas
(Opponent) sgb europe
Lechnerstraße 25a
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Respondent: Unilin Nordic AB
(Patent Proprietor) Hyllie Boulevard 39
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 28 July 2017 rejecting the opposition filed against European patent No. 2009195 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman G. Patton
Members: R. Baltanás y Jorge
N. Obrovski

Summary of Facts and Submissions

- I. European patent No. 2 009 195 relates to a flooring material comprising sheet-shaped elements which are joined by means of joining members.
- II. An opposition was filed against the patent based on Article 100(a) EPC together with Article 56 EPC.
- III. The appeal lies from the decision of the opposition division to reject the opposition.

The opponent (hereafter "appellant") filed an appeal against the above-mentioned decision of the opposition division.

- IV. In a communication dated 25 June 2020 pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), the Board gave its preliminary opinion that the appeal was likely to be dismissed.
- V. With a letter dated 26 January 2021, the appellant withdrew its previous request for oral proceedings.
- VI. In a communication dated 1 February 2021, the Board announced the cancellation of the oral proceedings scheduled for 10 February 2021 and that the decision would follow in writing.
- VII. Requests

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The patent proprietor (hereafter "respondent") requested that the appeal be dismissed, or alternatively that the patent be maintained in amended form on the basis of one of the sets of claims filed as auxiliary requests 1 to 9 with the reply to the statement setting out the grounds of appeal.

VIII. Prior art

The following documents were cited, both in the grounds of appeal and during the opposition proceedings, and are relevant to this decision:

- D1:** WO 01/02669 A1; and
- D2:** WO 00/47841 A1.

IX. Claim 1 as granted, including the numbering of its features as adopted by the parties, reads as follows:

- a)** Flooring material comprising
- b)** sheet-shaped floor elements (1) with a mainly square or rectangular shape,
- c)** which floor elements (1) are provided with
- ca)** edges (2), a lower side (5) and an upper decorative layer (3),
- cb)** wherein the floor elements (1) are so constructed as to be joined by means of joining members (10),
- cc)** wherein the floor elements (1) are provided with male joining members (10^I) on a first edge (2^I),
- cd)** while a second edge (2^{II}) of the floor elements (1) is provided with a female joining member (10^{II}),
- d)** whereby the male joining member (10^I) is provided with a tongue (11) and a lower side (5) groove (12)

- e) while the female joining member (10^{II}) is provided with a groove (13) and a cheek (14), the cheek (14) being provided with a lip (15),
- f) whereby the floor elements (1) are intended to mainly be joined together by tilting a floor element (1) to be joined with an already installed floor element (1) or a row of already installed floor elements (1), with the male joining member (10^I) of the floor element (1) angled downwards and the first edge (2^I) is allowed to be mainly parallel to the second edge (2^{II}) of the already installed floor element (1) or elements (1), whereby the tongue (11) of the tilted floor element (1) is inserted into the groove (13) of the female joining member (10^{II}) of the already installed floor element (1) or elements (1), whereby the tilted floor element (1) is turned downwards, with its lower edge as a pivot axis, so that the lip (15) eventually snaps or falls into the lower side (5) groove (12) where the decorative upper layer (3) of the floor elements (1) are mainly parallel,
- g) a third edge (2^{III}) of the floor elements is provided with a male vertical assembly joining member (10^{III}),
- h) while a fourth edge (2^{IV}) is provided with a female vertical assembly joining member (10^{IV}),
- i) the fourth edge (2^{IV}) being arranged on a side opposite to the third edge (2^{III}),
- j) the male vertical assembly joining members (10^{III}) are provided with mainly vertical lower cheek surfaces (21) arranged parallel to the closest edge (2), which lower cheek surfaces (21) are intended to interact with mainly vertical upper cheek surfaces (22) arranged on the female vertical assembly joining members (10^{IV}) so that

two joined adjacent floor elements (1) are locked against each other in a horizontal direction,

- k)** two adjacent edges (2) of a floor element (1) can be joined with a floor element (1) adjacent to the first edge (2^I) and a floor element adjacent to the third or fourth edge (2^{III} and 2^{IV} respectively) at the same time, and in the same turning motion;
- l)** the male and female vertical assembly joining members (10^{III} and 10^{IV} , respectively) are provided with one or more snapping hooks (23) with matching under cuts (24);
- m)** characterized in that said one or more snapping hooks (23) with matching under cuts (24) are provided with mainly horizontal locking surfaces which limit the vertical movement between two joined adjacent floor elements (1),
- n)** the joint between two joined floor elements (1) also comprises cavities (6);
- o)** and the snapping hook (23) is constituted by a separate spring part which is placed in a cavity (6).

X. Claim 2 as granted is identical to granted claim 1, with the exception of feature o), which reads: "and the under cut (24) is constituted by a separate spring part which is placed in a cavity (6)".

XI. The appellant's arguments can be summarised as follows:

(a) Right to be heard - Article 113(1) EPC

It was only at the oral proceedings before the opposition division that the appellant was confronted for the first time with the arguments relevant to the decision, namely the alleged synergistic effect of

features m), n) and o), and the alleged impossibility of combining D1 and D2. The lack of any indication concerning these arguments in the preliminary opinion issued by the opposition division and in the submissions of the respondent prior to the oral proceedings deprived the appellant of their right to be heard, contrary to the provisions of Article 113(1) EPC.

(b) Sufficiency of disclosure - Article 100(b) EPC

The ground for opposition in connection with Article 100(b) EPC raised in the statement setting out the grounds of appeal should be admitted even without the agreement of the patent proprietor, contrary to the conclusions of the Enlarged Board of Appeal decisions G 9/91 and G 10/91.

The fact that the opposition division at the oral proceedings changed its mind concerning the assessment of the technical effect of features m), n) and o) from its preliminary opinion and that these effects are not disclosed in the patent would justify such a departure from the criteria set by the Enlarged Board of Appeal.

(c) Inventive step - Articles 100(a) and 56 EPC

The subject-matter of claims 1 and 2 is obvious in the light of D1 in combination with D2.

A document disclosing a snapping hook built in one piece with a floor panel actually discloses that the snapping hook is constituted by a separate spring part (feature o)). The similarities between figure 6 of the patent and figure 4 of D2 confirm this finding.

There was a contradiction between the selection of figures 11 and/or 12 of D1 as a starting point by the opposition division and consideration II.3.2.1.5.1 of the contested decision, in which other parts of the disclosure of D1 are taken into account in assessing the plausibility of a combination with D2.

Contrary to the finding of the impugned decision (point II.3.2.1.1 of the reasons), a single technical effect was linked with the differentiating features, namely the limitation of a vertical movement between connected floor panels. The objective technical problem would thus be to improve the restriction of vertical movements.

The first paragraph of page 7 of D2 discloses that the embodiment shown in figures 2a and 2b can be modified. This would be a hint for the skilled person to carry out the necessary modifications in this embodiment in order to render it compatible with the device of D1, contrary to the findings of the opposition division in consideration 3.2.2.2.

XII. The respondent's arguments can be summarised as follows:

(a) Right to be heard - Article 113(1) EPC

The position of the opposition division concerning the technical effects of features m), n) and o) was laid out in the preliminary opinion issued by the opposition division more than six months prior to oral proceedings. No violation of the appellant's right to be heard can thus be ascertained.

(b) Sufficiency of disclosure - Article 100(b) EPC

Irrespective of the purported contravention of the appellant's right to be heard, G 10/91 provides no legal basis for admitting a new ground of opposition into appeal proceedings without the permission of the patent proprietor. The respondent said that it would not approve the introduction of the new ground of opposition based on Article 100(b) EPC.

(c) Inventive step - Articles 100(a) and 56 EPC

In order to determine the closest prior art, all the features of the floor element considered have to be ascertained. Figures 11 and 12 of D1 illustrate only the short edges of the floor elements. In order to establish all the features of these floor elements, it is necessary to determine what is present along the long edges, and this is illustrated in figures 1 to 3 of the same document. It would be inappropriate to isolate figures 11 and 12 from the overall context.

D1 discloses floor panels with holding profiles on all four sides made in one piece with the edges of the panels. The long edges are connected by a fold-down movement, whereas the floor panels of D2 are joined by being pressed downwards whilst being kept horizontal.

The skilled person is taught by D1 that the embodiment of figure 12 can be modified by providing a protruding nose with a bevel instead of a bulge. Figure 4 of D2 discloses such a protruding nose, which is made in one piece with the floor panel, as the bulge of D1. Irrespective of whether the objective technical problem when starting from D1 is that proposed by the opposition division or that proposed by the appellant,

the outcome concerning inventive step of the subject-matter of claims 1 and 2 is the same, since the skilled person would adopt the embodiment of figure 4 of D2 to implement the nose and bevel mechanism suggested by D1. Neither figure 6 of the opposed patent nor figure 4 of D2 discloses a snapping hook in the form of a separate spring part placed in a cavity.

Further modifications of D1 in the direction of the invention would require ignoring the teaching of a one-piece construction of the floor element and the need for multiple installation.

Reasons for the Decision

Main request

1. *Right to be heard - Article 113(1) EPC*

The preliminary opinion issued by the opposition division on 28 November 2016 included a statement concerning the distinguishing features m), n) and o) (see point 4.1), a statement concerning the technical effect of each (see point 4.3.1.1), and a reference to their synergistic effect (see point 4.3.1.2). These points could thus not have come as a surprise to the appellant during the oral proceedings before the opposition division.

The appellant is right in that the preliminary opinion of the opposition division stated that "The subject-matter of of [sic] claim 1 therefore seems not to involve an inventive step" (point 4.3.1.6). However, by the very nature of a preliminary opinion (see first

paragraph of the preliminary opinion itself) and as indicated by the word "seems", this position could not be interpreted as final and was open to revision, all the more so as further arguments were submitted afterwards by the other party.

More particularly, the patent proprietor filed a reply on 21 April 2017 contesting this preliminary opinion, in which the *ex-post facto* nature of the inventive step analysis (see point 2.2) was explained, and it also stated that the panels of D2 are designed to be joined by a push-down movement rather than a fold-down movement (see points 2.8 to 2.10). These two points were essential in the decision of the opposition division (see points II.3.2.1.5.2 and II.3.2.1.5.3). The appellant was thus informed about these essential arguments forming the basis of the contested decision prior to the oral proceedings.

The arguments at stake were also discussed at the oral proceedings before the opposition division, and the appellant was given the opportunity to comment on them then (see points 2 and 3 of the minutes).

Thus the impugned decision was not based on grounds or evidence on which the appellant did not have the opportunity to present their comments. Consequently, the requirements of Article 113(1) EPC are met.

2. *Fresh ground for opposition - G 10/91*

2.1 The ground for opposition based on Article 100(b) EPC was raised for the first time by the opponent in the statement setting out the grounds of appeal. Thus it is a fresh ground for opposition.

The appellant makes reference to the decisions of the Enlarged Board of Appeal G 9/91 and G 10/91 in the context of admitting this fresh ground for opposition.

- 2.2 Even if the proceedings of G 9/91 and G 10/91 were consolidated (see point X of both decisions), and even if the considerations of both cases were the same, the questions to be answered and the final order or opinion were different in each case. G 9/91 dealt with a question about the power of an opposition division or a board of appeal to examine and decide on the maintenance of a European patent dependent on the extent to which the patent was opposed in the notice of opposition. G 10/91 dealt with the conditions for a fresh ground for opposition to be considered in appeal proceedings, as in the present case. Therefore reference will be made to decision G 10/91.

G 10/91 established that, in view of the purpose of the appeal procedure *inter partes*, which is mainly to give the losing party a possibility to challenge the decision of the opposition division on its merits, "*It is not in conformity with this purpose to consider grounds for opposition on which the decision of the Opposition Division have not been based*". The Enlarged Board of Appeal considered that such grounds may in principle not be introduced at the appeal stage. The only exception to this principle which was contemplated by the Enlarged Board of Appeal is the case where the patentee agrees that a fresh ground for opposition may be considered (see point 18 of the reasons and point 3 of the headnote).

- 2.3 The conclusions of the Enlarged Board of Appeal in decision G 10/91 do not depend on any other particular circumstance of the opposition procedure apart from the

fact that the fresh ground for opposition was not raised during this procedure. The alleged change of mind of the opposition division at a late stage of the opposition procedure is thus irrelevant in the context of decision G 10/91. A fresh ground for opposition cannot be introduced at appeal without the approval of the patentee.

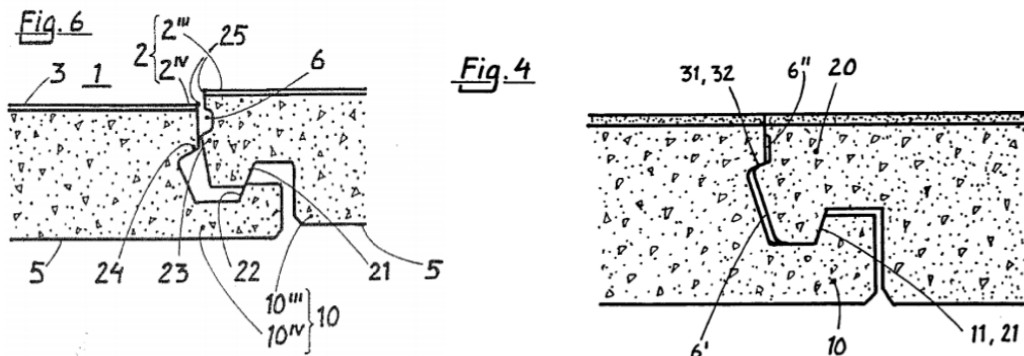
2.4 The patent proprietor has expressly refused introduction of the fresh ground for opposition based on Article 100(b) EPC (see point 4.1.4 of the reply to the statement setting out the grounds of appeal, and also point 2.1 of the letter of the respondent dated 16 January 2020).

2.5 In view of the above, the fresh ground for opposition concerning Article 100(b) EPC cannot be considered in the appeal proceedings, in accordance with the well-established case law of the Boards of Appeal (see Case Law of the Boards of Appeal, 9th Edition 2019, V.A. 3.2.1.h), first paragraph).

3. *Inventive step - Articles 100(a) and 56 EPC*

3.1 Interpretation of feature o) of claim 1 (separate spring part)

The appellant argues that a document disclosing a snapping hook built in one piece with a floor panel actually discloses that the snapping hook is constituted by a separate spring part (feature o) of claim 1; see paragraph bridging pages 15 and 16 of the statement setting out the grounds of appeal). The appellant bases its assertion on the similarities between figure 6 of the patent and figure 4 of D2 (both figures are reproduced below).



However, this is not persuasive for the following reasons:

Neither figure 6 of the patent nor figure 4 of D2 depicts a snapping hook in the form of a separate spring part as defined in claim 1. This has been confirmed by the respondent itself (see reply to the statement of grounds of appeal, point 4.2.4).

However, feature o) of claim 1 is unambiguous and requires no interpretation by means of figure 6 of the patent, which can only be understood as disclosing an embodiment not belonging to the claimed invention.

Thus a document disclosing a snapping hook built in one piece with a floor panel does not disclose a snapping hook as defined in feature o) of claim 1, since the feature requires that the snapping hook be built as a **separate** spring part which is placed in a cavity.

3.2 Claim 1: Combination of D1 and D2

3.2.1 Point of departure: figures 11 and/or 12 of D1

The Board agrees with the appellant and with the opposition division (see consideration II.3.2.1) that

the embodiment of figures 11 and/or 12 of D1 is a realistic point of departure for assessing the inventive step of the invention.

3.2.2 Actual content in the embodiment forming the point of departure

There is no contradiction between the selection of the above-mentioned embodiment as a point of departure by the opposition division and the consideration II.3.2.1.5.1 of the contested decision, in which other parts of the disclosure of D1 are taken into account for assessing the plausibility of a combination with D2.

D1 concerns a system for connecting floor panels comprising a first type of connection for the long side of the floor panel (see corresponding profiles 4 and 5, together with protrusion 6 and concave bulge 23, and also figures 1 to 7) based on a fold-down approach, and a second type of connection for the short side of the floor panel (see hook element 44 and bar 49, and also figures 8 to 12) to be used in combination with the first type of connection.

The skilled person departing from the embodiment of figures 11 and/or 12 could thus not ignore the context in which the connection for the short sides of the floor panels is to be used. This context is decisive for the skilled person when assessing how the floor panel of D1 incorporating the type of connection shown in figures 11 and/or 12 could be combined with other types of connections.

3.2.3 The appellant and the opposition division consider that D1 discloses all the features of the preamble of claim

1. The respondent does not contest this, and the Board is in agreement as well. The floor panel shown in figures 11 and/or 12 of D1 thus comprises:

Flooring material comprising sheet-shaped floor elements (2, 3) with a mainly square or rectangular shape,

which floor elements (2, 3) are provided with edges (10), a lower side and an upper decorative layer (see figures 1, 11 and 12),

wherein the floor elements (2, 3) are so constructed as to be joined by means of joining members (4, 5, 44, 49), wherein the floor elements (2, 3) are provided with male joining members (6) on a first edge, while a second edge of the floor elements (2, 3) is provided with a female joining member (20, 21),

whereby the male joining member (6) is provided with a tongue (see e.g. figure 2) and a lower side groove (24) while the female joining member (20, 21) is provided with a groove (20) and a cheek (21), the cheek (21) being provided with a lip (see e.g. figure 2, upper left portion of cheek 21),

whereby the floor elements (2, 3) are intended to mainly be joined together by tilting a floor element (3) to be joined with an already installed floor element (2) or a row of already installed floor elements (see figures 2 and 3), with the male joining member (6) of the floor element (3) angled downwards and the first edge is allowed to be mainly parallel to the second edge of the already installed floor element (2; see figures 1 and 3) or elements,

whereby the tongue of the tilted floor element (3) is inserted into the groove (20) of the female joining member (20, 21) of the already installed floor element (2), whereby the tilted floor element (3) is turned downwards (see figure 3, and page 12, lines 22 to 25), with its lower edge as a pivot axis, so that the lip (see figure 2, upper left portion of cheek 21) eventually snaps or falls into the lower side groove (24) where the decorative upper layer of the floor elements (2, 3) are mainly parallel (see figure 2),

a third edge (see figures 11 and 12) of the floor elements (2, 3) is provided with a male vertical assembly joining member (67), while a fourth edge is provided with a female vertical assembly joining member (64), the fourth edge being arranged on a side opposite to the third edge (see figures 11 and 12),

the male vertical assembly joining members (67) are provided with mainly vertical lower cheek surfaces (69) arranged parallel to the closest edge (see figures 11 and 12), which lower cheek surfaces (69) are intended to interact with mainly vertical upper cheek surfaces (68) arranged on the female vertical assembly joining members (64) so that two joined adjacent floor elements (2, 3) are locked against each other in a horizontal direction,

two adjacent edges of a floor element (2) can be joined with a floor element (3) adjacent to the first edge and a floor element adjacent to the third or fourth edge at the same time, and in the same turning motion (see page 7, line 30 to page 8, line 4, and also page 22, lines 15 to 29);

the male and female vertical assembly joining members (67, 64) are provided with one or more snapping hooks (65, 73) with matching under cuts (66, 74).

3.2.4 The subject-matter of claim 1 thus differs from the embodiment of figures 11 and/or 12 of D1 in that:

one or more snapping hooks with matching under cuts are provided with mainly horizontal locking surfaces which limit the vertical movement between two joined adjacent floor elements (feature m);

the joint between two joined floor elements also comprises cavities (feature n);

and the snapping hook is constituted by a separate spring part which is placed in a cavity (feature o)).

3.2.5 Irrespective of whether the objective technical problem when starting from D1 is that proposed by the appellant (restriction of vertical movements) or that formulated by the opposition division (achieving the technical effect of limiting the vertical movement of adjacent floor elements while simultaneously making the connecting process for their short sides easier), the combination of D1 with D2 would not lead the skilled person to the claimed invention. The reasons for this are as follows:

(a) Figure 4 of D2

Document D1 prompts the skilled person to find connecting means based on the presence of a sloped heel ("Nase": see page 23, lines 24 to 30). When looking for connecting means comprising such a sloped heel in order to implement such a suggestion, the skilled person

would consult D2, since it concerns connections for floor panels such as those of D1.

Figure 4 of D2 discloses connecting means comprising a heel 31 and a recess 32 which are suitable for use on the short side of the floor panels of D1, since the implicit elasticity of the material (see page 6, lines 1 to 4) hints at compatibility with the fold-down connecting means on the long side of the floor panels of D1.

However, even after combining the embodiment of figure 4 of D2 with figures 11 and/or 12 of D1, no separate spring part would be present in the resulting device as defined in feature o) (see point 3.1 above).

(b) Figures 2a and 2b of D2

The embodiment of figures 2a and 2b of D2 discloses a separate spring part (resilient part 7) placed in a cavity 6 and forming a snapping hook (portion defining recess 32).

However, the separate spring part disclosed in D2 would be regarded by the skilled person as incompatible with the requirements of D1, which is based on a one-piece construction of floor board and connecting means (see e.g. page 6, lines 31 to 33, or page 12, lines 1 to 10), in particular in view of allowing a multiple installation of the floor panels (see e.g. page 10, lines 11 to 21).

Even if there is a general hint in D2 to modify the specific embodiment of figures 2a and 2b (see page 7, last two lines of the first paragraph), there is no

precise teaching about such modifications or what purpose they should serve.

Thus in order to arrive at the claimed invention the skilled person would first have to think about using an embodiment which goes against the general aims of D1 with regard to the one-piece construction and the multiple installation of the floor panels, and then, in a second step, would have to modify the features of figures 2a and 2b of D2 in an undefined way in order to ensure that the aims of D1 can be met despite the composite construction of the joining members. These undefined modifications are not suggested in D2, and would constitute further steps which the skilled person would have to take in their path towards the invention.

In view of the lack of motivation and of any teaching about how to implement the combination in a compatible way, it cannot be considered that the proposed course of action would lead the skilled person towards the claimed invention in an obvious manner.

3.3 Claim 2

Since claim 2 concerns the mere kinematic inversion of snapping hooks and under cuts in feature o), the same reasoning as above is applicable to it concerning the presence of an inventive step, *mutatis mutandis*.

3.4 Conclusion

In view of the above, the subject-matter of claims 1 and 2 involves an inventive step with regard to the proposed combinations of prior art.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Spira

G. Patton

Decision electronically authenticated