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**Datasheet for the decision
of 25 April 2023**

Case Number: T 1743/20 - 3.2.03

Application Number: 14163023.6

Publication Number: 2787144

IPC: E04F11/18

Language of the proceedings: EN

Title of invention:

Lower profile for balcony railing

Patent Proprietor:

Alutec Oy

Opponent:

Lumon Invest Oy

Headword:

Relevant legal provisions:

EPC Art. 123(2), 111

RPBA 2020 Art. 11

Keyword:

Amendments - added subject-matter (no)

Appeal decision - remittal to the department of first instance
(yes)

Remittal - special reasons for remittal

Decisions cited:

Catchword:



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Case Number: T 1743/20 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 25 April 2023

Appellant: Alutec Oy
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 10 June 2020
revoking European patent No. 2787144 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman B. Miller
Members: R. Baltanás y Jorge
D. Prietzel-Funk

Summary of Facts and Submissions

- I. European patent No. 2 787 144 B1 relates to a lower profile for a balcony railing.
- II. An opposition was filed against the patent, based on Articles 100(a) EPC in conjunction with Articles 54 EPC and 56 EPC.
- III. This appeal is against the decision of the Opposition Division to revoke the patent. The Opposition Division decided that the amendments made to the main request and auxiliary requests 1 and 2 - all filed on 19 July 2019 - contravened Article 123(2) EPC.
- IV. This decision was appealed by the patent proprietor (appellant).
- V. Requests

The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form based on the main request or auxiliary request 1 to 5, all filed with the statement setting out the grounds of appeal. The main request and auxiliary requests 2 and 3 correspond, respectively, to the main request and auxiliary requests 1 and 2 dealt with in the contested decision.

The opponent (respondent) requested that the appeal be dismissed.

- VI. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA 2020),

the Board indicated its preliminary opinion that the main request fulfilled the requirements of the EPC.

VII. Claim 1 of the main request, including the numbering of its features based on that proposed by the respondent, reads as follows (amendments compared to originally filed claim 1 are underlined; amendments compared to granted claim 1 are also marked in **bold**).

- 1.1 *A lower profile (21) for a balcony railing,*
- 1.2 *comprising a first support structure (210-213) extending in a longitudinal direction of the lower profile for supporting a bottom part of one or more railing posts (41 to 45),*
- 1.3 *wherein the lower profile (21) for the balcony railing for supporting the railing posts from below further comprises a second support structure (310, 312, 313) in the same profile, the second support structure (310, 312, 313) extending in the longitudinal direction of the lower profile for supporting a bottom part of a cover plate structure (50) of the balcony railing,*
- 1.4a *and wherein the lower profile (21), said lower profile (21) being installed on top of the balcony slab, for a balcony railing also comprises*
- 1.4b *a water control surface (401) in the same profile;*
- 1.4c *and wherein the water control surface (401) comprises a descending surface (401a) receding outwards from the lower profile, said descending surface (401a) being oriented diagonally downwards,*
- 1.4d *and that the water control surface (401) further comprises a substantially vertical second surface*

(401b) serving as an extension of the descending surface (401a),

1.5a and wherein said water control surface (401) in the lower profile (21), said lower profile (21) being installed on top of the balcony slab,

1.5b belongs to the same integral entity as said first support structure (210-213) for supporting the bottom part of one or more railing posts and said second support structure (310, 312, 313) for supporting the bottom part of the cover plate structure (50) of the balcony railing.

VIII. The appellant's arguments can be summarised as follows.

The contested decision was erroneous since the allegedly omitted feature "*i.e. in the direction of outdoor air*" was actually contained in the subject-matter of claim 1. The omitted wording was merely an alternative way of defining the same subject-matter already defined in claim 1, as is immediately apparent by the use of the abbreviation "*i.e.*" in originally filed paragraph [0019].

The interpretation of the feature "*receding outwards from the lower profile*" by the respondent was artificial and purpose-oriented since the water control surface in the context of paragraph [0019] of the application as filed could not protrude inwards in relation to the lower profile or balcony. The only interpretation of feature 1.4c which made technical sense in view of the context of claim 1 was that the control water surface receded outwards from the edge of the balcony, thus complying with the definition "*in the direction of outdoor air*".

IX. The respondent's arguments can be summarised as follows.

The arguments of the Opposition Division in point 3.4 of the impugned decision were correct and explained why the omission of the feature "*i.e. in the direction of outdoor air*" was not allowable. This feature was disclosed in paragraph [0019] of the patent application as filed, which was the only basis for feature 1.4c. Paragraph [0019] disclosed the feature "*receding outwards from the lower profile*" - which defined a first direction with respect to the lower profile - only in combination with the omitted feature - which defined a second direction with regard to the balcony. Consequently, the omission of the feature at hand resulted in an unallowable intermediate generalisation.

The use of the abbreviation "*i.e.*" had to be considered in the context of paragraph [0019]. When doing so, it had to be concluded that the phrase "*i.e. in the direction of outdoor air*" did not describe a synonym but represented a more precise and better definition.

The interpretation of the feature "*receding outwards from the lower profile*" as defining a first direction with respect to the lower profile made technical sense for the skilled person since it was generally known that different elements of a profile could protrude inwards with respect to the profile. Also, water control surfaces could protrude inwards since it was usual that water tended to accumulate in the hollow profile of a railing because of holes, grooves, slots, etc. As water also needed to be guided outside in such situations, the internal space of a lower profile could easily comprise water control surfaces as defined in claim 1.

Reasons for the Decision

1. Main request - Article 123(2) EPC
 - 1.1 As indicated in the communication to the parties in the preliminary opinion, the Board agrees with the arguments brought forward by the respondent in its reply to the statement setting out the grounds of appeal that the meaning of the abbreviation "i.e." ("id est") in originally filed paragraph [0019] amounts to "in other words" or other equivalent expressions.
 - 1.2 The respondent proposed during the oral proceedings that the abbreviation "i.e." meant "a more precise and better definition" in light of the context of paragraph [0019]. However, this is not convincing.
 - 1.2.1 Firstly, the respondent has failed to explain why paragraph [0019] of the application as filed provides a context which may change the usual meaning of the abbreviation "i.e." (see preceding point 1.1). The cited paragraph merely contains the abbreviation and does not further specify its meaning in any direct or indirect way. This means that - from a purely semantic point of view - the skilled person reading paragraph [0019] learns that "*in the direction of outdoor air*" is intended as an **alternative, explanatory** way of expressing the feature "*receding outwards from the lower profile*" in feature 1.4c of claim 1. The omission of an alternative wording (that is, the orientation of the descending surface in the direction outwards of the balcony and towards outdoor air) for describing the same feature already defined in claim 1 does not change or, in particular, extend the technical teaching of the

application as filed and, therefore, does not entail an unallowable intermediate generalisation.

- 1.2.2 Secondly, even if the abbreviation "i.e." were to be interpreted as proposed by the respondent, this would not lead to the conclusion that the omission of the phrase "i.e. in the direction of outdoor air" resulted in an unallowable intermediate generalisation either.

Assuming for the sake of argument that the **alternative** definition of the feature "*receding outwards from the lower profile*" were better or more precise, the EPC does not contain any provision requiring the use of the best or most precise wording when amending a claim. The only requirement of Article 123(2) EPC is that the subject-matter resulting from an amendment should not extend beyond the teaching of the application as originally filed. Since the feature "*receding outwards from the lower profile*" was originally disclosed in paragraph [0019] of the description, the omission of an allegedly better or more precise way of defining **the same feature** cannot result in an unallowable extension of subject-matter.

- 1.3 In view of the conclusions above based on the disclosure in originally filed paragraph [0019], it can be left open whether the feature "*receding outwards from the lower profile*" encompasses an embodiment in which the descending surface of the water control surface is represented by a protrusion of the profile that protrudes outwards in relation to the profile but inwards in relation to the balcony on which the profile is mounted.

1.4 Consequently, the omission of the wording "i.e. in the direction of outdoor air" in claim 1 does not result in an unallowable extension of subject-matter compared to the application as originally filed. The main request therefore fulfils the requirements of Article 123(2) EPC.

2. Remittal - Article 111 EPC, Article 11 RPBA 2020

2.1 Article 11 RPBA 2020 provides that "*the Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so*".

The Board holds that such special reasons exist in this case for the following reasons.

2.2 The reasoning of the contested decision focuses on the allowability of the amendments (Article 123(2) EPC). The Board thus concludes that the Opposition Division did not reach a final conclusion on the remaining grounds for opposition.

Under Article 12(2) RPBA 2020, the primary object of the appeal proceedings is "*to review the decision under appeal in a judicial manner*". This principle would not be observed if the Board were to conduct a complete examination of the opposition which goes substantially beyond the extent of the examination carried out by the Opposition Division.

2.3 Furthermore, both the respondent and the appellant agreed to the remittal of the case.

2.4 The Board thus considers it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the department of first instance for further prosecution.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



H. Jenney

B. Miller

Decision electronically authenticated