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**Datasheet for the decision
of 15 November 2022**

Case Number: T 0650/21 - 3.2.03

Application Number: 15162038.2

Publication Number: 2930269

IPC: E01C11/14, E01C11/08

Language of the proceedings: EN

Title of invention:

STRUCTURAL JOINT

Patent Proprietor:

Hengelhoef Concrete Joints NV

Opponents:

CONNECTO Spółka z ograniczona odpowiedzialnoscia
Peikko Group Corporation
HSD Industriebeläge GmbH

Headword:

Relevant legal provisions:

EPC Art. 100(c), 108, 113(1), 123(2)
EPC R. 103, 115(2)
RPBA 2020 Art. 15(3)

Keyword:

Admissibility of patent proprietor's appeal - statement of grounds - filed within time limit (no)

Admissibility of appeal - (no) - Prohibition of reformatio in peius

Reimbursement of appeal fee - (no)

Amendments - added subject-matter (yes) - extension beyond the content of the parent application as filed (yes)

Decisions cited:

G 0009/92, G 0001/99, G 0001/18, T 0179/18

Catchword:



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Case Number: T 0650/21 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 15 November 2022

Appellant: Hengelhoef Concrete Joints NV
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
24 March 2021 concerning maintenance of the
European Patent No. 2930269 in amended form.

Composition of the Board:

Chairman C. Herberhold
Members: B. Goers
E. Kossonakou

Summary of Facts and Submissions

- I. European patent No. 2 930 269 relates to a structural joint comprising at least two profile elements for engagement with slabs made of moldable material as well as the use of the joint in a floor for fork lift trucks and other transport means. The patent is based on a divisional application of the parent application EP 06 75 43 06.
- II. With the impugned decision, the opposition division concluded that the patent as amended on the basis of auxiliary request V then on file complies with the requirements of the EPC.
- III. This decision was appealed by the patent proprietor, opponent 1 and opponent 3.
- IV. With its communication of 25 August 2021, the board notified the proprietor that it had failed to file a statement of grounds of appeal within the time limit pursuant to Article 108, third sentence, EPC. With a letter dated 3 November 2021, the proprietor submitted for the first time a statement setting out its grounds of appeal together with its explanations as to why it had failed to comply with the time limit for filing the grounds of appeal.
- V. With a letter dated 26 January 2022, opponent 1 requested a separate decision on the admissibility of the patent proprietor's appeal.
- VI. With its communication under Article 15(1) RPBA the board expressed its preliminary view on the case. It informed the parties, *inter alia*, that the proprietor's

appeal was preliminarily deemed inadmissible and that a separate decision could not be issued before the oral proceedings.

VII. Oral proceedings before the board were held on 15 November 2022. As announced with letters dated 10 October 2022 and 7 November 2022 respectively, neither opponent 2 (party as of right) nor the patent proprietor attended. Pursuant to Rule 115(2) EPC, the proceedings were continued without the duly summoned yet absent parties. In accordance with Article 15(3) RPBA, the proprietor was treated as relying only on its written case.

VIII. The final requests were as follows:

Opponents 1 and 3 requested that the decision under appeal be set aside and that the patent be revoked.

The patent proprietor requested (see its letter dated 20 December 2021, page 28, point 3) that the decision under appeal be set aside and that the patent be maintained on the basis of auxiliary request I as filed during the opposition proceedings and underlying the contested decision, or alternatively that the opponents' appeals be dismissed (maintenance in amended form on the basis of auxiliary request V as per the contested decision). It also requested reimbursement of the appeal fee in case its appeal were found to be inadmissible.

For simplicity, opponents 1 and 3 and the patent proprietor are referred to as such in this decision.

IX. The following evidence is relevant for this decision:

A1: WO 2007/144008 A1 (A-publication of the parent application EP 06 75 43 06)
A2: EP 2 930 269 A1 (A-publication of the patent application as filed)
D4: BE 1 015 453 A3

X. Claim wording as far as it is relevant for the decision

Claim 1 of auxiliary request V reads as follows (with feature numbering added in "[]", amendments over claim 1 of the parent application as filed marked in **bold**, and amendments over claim 1 of the patent application as filed marked in bold and underlined):

"[1.1] *A structural joint adapted to be engaged with slabs made of a moldable material*
[1.2] *comprising at least two profile elements, each adapted to be integral with one of the edges of two adjacent slabs*
[1.3] **and provided with horizontal guiding means, which guarantee that the horizontal level of the two adjacent slabs is always maintained at the same height;**
[1.4] *each profile having a substantial vertical stem adapted for extending at least partly along the edges up to a sharp edge of an upper surface of the slab, characterized in that*
[1.4a] **both profile elements have vertical flanges provided with horizontal grooves and an intermediate flange part is positioned between the opposing grooves**
[1.5] **wherein** *the top edge of each vertical stem of the profile elements of two adjacent slabs as seen along the line between the two adjacent slabs is composed of*
continuous non-linear elements."

XI. The arguments of opponents 1 and 3, where relevant to the present decision, can be summarised as follows.

(a) Admissibility of the patent proprietor's appeal

The appeal of the patent proprietor was inadmissible since the statement of grounds of appeal was filed only after the time limit prescribed in Article 108, third sentence, EPC had passed. The issue of admissibility of the patent proprietor's appeal should be decided in a separate decision before oral proceedings since opponent 1 was sued by the patent proprietor for infringement of the patent in parallel proceedings before the Paris Court of First Instance (TGI de Paris).

(b) Auxiliary request V - added subject-matter

The subject-matter of claim 1 extended beyond the parent application as filed. Feature [1.3] was only based on a reference to D4. According to established case law, features disclosed in a referenced document only form part of the original disclosure of the invention if the skilled person unambiguously recognised that protection was sought for these features and that no other essential features of this disclosure were omitted - conditions that were not met in the case at hand. In particular, the fact that the guiding means are disclosed in the embodiments of the parent application only in connection with the vertical flanges had been omitted. Moreover, features [1.3] and [1.4a] lacked any interconnecting link, therefore disclosing two different unrelated entities, which was not disclosed either in the parent application or in the application underlying the opposed patent.

XII. The patent proprietor's arguments, where relevant to the present decision, can be summarised as follows.

(a) Admissibility of the patent proprietor's appeal and reimbursement of the appeal fee

The appeal of the patent proprietor was admissibly filed. Although the statement of grounds of appeal was inadvertently only submitted after the time limit according to Article 108, third sentence, EPC, the examination of the appeal had not yet started and none of the parties involved was seriously affected by this. However, if the appeal was considered inadmissible, the appeal fee should be reimbursed.

(b) Auxiliary request V - added subject-matter

Claim 1 of auxiliary request V did not extend the subject-matter beyond the parent application and the patent application as filed. The variety of embodiments of horizontal guiding means described in A1 as well as the examples of D4 incorporated by reference showed that the invention was not limited to a particular embodiment of the horizontal guiding means. This was also reflected by referring to "other known types". Furthermore, feature [1.4a] was disclosed in the first paragraph on page 3 of D1.

Reasons for the Decision

Admissibility of the patent proprietor's appeal

1. The patent proprietor's appeal is found inadmissible.
 - 1.1 The patent proprietor filed the notice of appeal and paid the appeal fee within the prescribed time limit in accordance with Article 108, second sentence, EPC. By these acts the appeal is deemed to have been filed (see also G 1/18, OJ EPO 2020, A26, point VII). Once the existence of the appeal has been established, it remains to be decided, in a second step, whether it is admissible.
 - 1.2 The submission intended by the proprietor to be regarded as the statement of grounds of appeal was filed on 3 November 2021 and thus not within the time limit given in Article 108, third sentence, EPC. Neither the notice of appeal of the proprietor nor the submission dated 9 July 2021 (an amended version of the notice of appeal comprising the proprietor's address) contain anything that can be regarded as such a statement. This is not disputed by the patent proprietor.
 - 1.3 The failure to submit the statement of grounds of appeal in time results in the appeal being inadmissible pursuant to Rule 101(1) EPC (cf. G 1/18, point VII.). After the prescribed period has expired, no legal remedy is available apart from re-establishment of rights (Article 122 EPC). However, re-establishment was not requested within the time limit and under the conditions mentioned in Rule 136(1) EPC.

- 1.4 The patent proprietor's arguments that at the time of submitting the statement of grounds of appeal "the appeal proceedings [had] not yet started" and that "none of the involved parties would [have been] seriously affected by the present submission" are not relevant in view of these legal provisions.
- 1.5 The board has decided not to issue a separate decision on the admissibility of the proprietor's appeal as requested by opponent 1. In view of the requirements of Article 113(1) EPC and the patent proprietor's request for oral proceedings, separate oral proceedings would have to be arranged solely for the question of admittance of the patent proprietor's appeal. The board considered this detrimental to the economy of the appeal proceedings.

Reimbursement of the patent proprietor's appeal fee

2. The patent proprietor's request for reimbursement of the appeal fee is refused.

According to established case law, the appeal fee paid for a validly filed appeal is not refundable in case the appeal is found inadmissible (Case Law of the Boards of Appeal, 10th edition 2022, V.A.11.3.1, confirmed in G 1/18, point VIII.). As the proprietor has not withdrawn the appeal, the provisions of Rule 103 (3) and (4) EPC are not applicable.

Prohibition of reformatio in peius - non-admissibility of auxiliary request 1

3. In view of its appeal being inadmissible (see above), the patent proprietor is merely a respondent. Thus, according to the principle of prohibition of *reformatio in peius* (see G 9/92 and G 1/99), the proprietor is primarily restricted to defending the patent as maintained, i.e. on the basis of auxiliary request V according to the decision under appeal. This is equivalent to the request that the opponents' appeals be dismissed.

Auxiliary request I comprises all of the features of claim 1 of auxiliary request V except for feature [1.4a] and is thus broader in scope than the maintained auxiliary request V. Hence, it has to be regarded as comprising amendments which are neither appropriate nor necessary within the meaning of G 9/92, headnote 2, last sentence. This request is thus inadmissible.

Auxiliary request V - added subject-matter

4. Auxiliary request V is not allowable since the subject-matter of claim 1 extends beyond the content of the earlier application as filed (parent application EP 06 75 43 06) as well as the application as filed.
 - 4.1 Claim 1 of auxiliary request V fails to establish a link between the "horizontal guiding means" defined in feature [1.3] and the further structural features defined in feature [1.4a]. The consequence of this missing link is that feature [1.4a] cannot be considered a further restriction of feature [1.3]. Instead, as will be explained in more detail in the

following, the two features define two independent structures which are not clearly and unambiguously derivable, individually and in combination, using common general knowledge, and considered objectively and relative to the date of filing, from the entirety of the application documents as filed, i.e.:

- (a) the "horizontal guiding means" without a limitation to a location at the vertical flange and
- (b) the "horizontal grooves and intermediate flange parts" without a limitation to the horizontal guiding function.

4.2 With the filing of the divisional patent application feature [1.3] was added as compared to claim 1 of the parent application. It defines a "horizontal guiding means" by its general function, namely to "guarantee that the horizontal level of the two adjacent slabs is always maintained at the same height". This amendment finds a literal basis in the parent application A1 on page 1, lines 12 to 15. However, features from cross-referenced documents can be added to a claim only under particular conditions, e.g., *inter alia*, when the description of the invention as filed leaves the skilled reader in no doubt that protection was sought for those features (cf. Case Law of the Boards of Appeal, 10th edition, 2022, II.E.1.2.4). Indeed, the passage on page 1, lines 12 to 15, is related to the description of the state of the art represented by document D4 and not to the most general embodiment of the horizontal alignment function of the invention and is thus not a suitable basis for feature [1.3].

The disclosure of D4 is explicitly incorporated by reference in A1 at another part of the specification,

i.e. the description of the specific embodiments (cf. page 2, lines 25 to 27).

D4 discloses a specific solution for a structural joint comprising a vertical stem and a distinct vertical flange as also defined by features [1.4] and [1.4a] of claim 1 (cf. also T 179/18, Reasons 3.1.1 and 3.1.2, discussing the construction of the features "vertical stem" and "vertical flange" in the parent appeal case). This particular structure is found in the embodiments of D4, Figures 2 to 4, wherein the vertical stem corresponds to the "fer plat continu" (3,8)" and the vertical flange to the "tôle verticale (4)". In the embodiments of both of A1 and D4, the "horizontal guiding means" are disclosed as a system of vertical flanges either provided with cooperating grooves or with a groove and a further horizontal flange, restrictions which are missing from feature [1.3].

As far as "other known types" are referred to on page 2, line 32, of A1, it is not disclosed how these can be embodied other than the ways disclosed on page 3, lines 1 and 2, i.e. as a system of vertical flanges either provided with cooperating grooves or with a groove and a further horizontal flange. Consequently, this passage does not provide a general disclosure of the broad functional definition of feature [1.3]. Since feature [1.3] is not supported by the incorporation by reference of D4 or any of the further described embodiments, it has no basis in the parent application as originally filed.

- 4.3 The omission of these restrictions in feature [1.3] is not rectified by the inclusion of feature [1.4a]. Contrary to what was concluded in the decision under appeal, feature [1.4a] is not a further restriction of

feature [1.3] but rather an independent second feature. The wording of feature [1.4a] is substantially based on paragraphs [0012] and [0013] of A2, or page 2, line 29, to page 3, line 2, of A1. However, the herein disclosed interaction of the horizontal grooves with the intermediate flange requires that the groove(s) have to "accommodate" the flange, a feature which has been omitted in feature [1.4a]. It is merely defined in feature [1.4a] that the intermediate flange is "positioned between" the grooves. The wording of feature [1.4a] thus does not clearly and unambiguously define explicitly or implicitly a horizontal guiding function, thereby resulting in an unallowable intermediate generalisation with respect to the application as filed.

4.4 Hence, the subject-matter extends beyond the content of the parent application, A1 (restriction a, Article 100(c) EPC), as well as the content of the present application as filed, A2 (restriction b, Article 123(2) EPC). Consequently, the patent cannot be maintained on the basis of auxiliary request V.

5. It follows that the appeals of opponents 1 and 3 are allowable and that the patent must be revoked.

Order

For these reasons it is decided that:

1. The patent proprietor's appeal is rejected as inadmissible.
2. The patent proprietor's request for reimbursement of the appeal fee is refused.
3. The decision under appeal is set aside.
4. The patent is revoked.

The Registrar:

The Chairman:



C. Spira

C. Herberhold

Decision electronically authenticated