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Datasheet for the decision of 20 March 2025

Case Number: T 0428/23 - 3.2.03

Application Number: 16154742.7

Publication Number: 3054066

IPC: E04H17/20, E04H15/34

Language of the proceedings: EN

Title of invention:
FENCE STRUCTURE

Patent Proprietor:
Cracco S.r.l.

Opponent:
Praxi Intellectual Property S.p.A.

Headword:

Relevant legal provisions:
EPC Art. 56
RPBA 2020 Art. 13(2)

Keyword:
Inventive step - obvious alternative - could-would approach - problem and solution approach - common general knowledge - technical prejudice in the art (no) - main request (no)
Amendment after summons - exceptional circumstances (no) - exercise of discretion - taken into account (no)

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Catchword:

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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

Case Number: T 0428/23 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 20 March 2025

Appellant: (Opponent)	Praxi Intellectual Property S.p.A. C.so Vittorio Emanuele II, no. 3 10125 Torino (IT)
Representative:	Pretato, Filippo De Gaspari Osgnach s.r.l. Via Altinate, 33 35121 Padova (IT)
Respondent: (Patent Proprietor)	Cracco S.r.l. Via 1°Maggio, 10 36070 Castelgomberto - Vicenza (IT)
Representative:	Feltrinelli, Secondo Andrea APTA S.r.l. Patent Department Via Ca' di Cozzi, 41 37124 Verona (IT)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 5 January 2023 concerning maintenance of the European Patent No. 3054066 in amended form.**

Composition of the Board:

Chairman	C. Herberhold
Members:	R. Baltanás y Jorge
	N. Obrovski

Summary of Facts and Submissions

I. European patent No. 3 054 066 B1 relates to a fence structure.

II. An opposition was filed against the patent based on Articles 100(b) and 100(c) EPC, and 100(a) EPC in conjunction with Articles 54 and 56 EPC.

III. The present appeal is against the interlocutory decision of the opposition division, which found that auxiliary request 5, submitted on 9 September 2022, met the requirements of the EPC.

This decision was appealed by the opponent (appellant).

IV. In a communication pursuant to Article 15(1) RPBA, the Board indicated its preliminary opinion.

Oral proceedings were held on 20 March 2025.

V. Requests

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

The patent proprietor (respondent) requested that the appeal be dismissed or, in the alternative, that the patent be maintained in amended form on the basis of the claims of one of auxiliary requests 1 to 3 as filed with the reply to the statement of grounds of appeal or, if documents A1 and A2 were admitted into the appeal proceedings, on the basis of the claims of auxiliary request 4, in which case auxiliary request 4 was to be considered before auxiliary requests 1 to 3.

VI. Claim 1 of the main request (i.e. auxiliary request 5 maintained in opposition proceedings), including the numbering of its features as adopted by the Board, reads as follows:

1.1 *Fence structure,*
1.2 *comprising a plurality of transverse elements (2) arranged on one or more superimposed horizontal rows and supported by vertical uprights (3),*
1.3 *whereby said uprights (3) are constituted by first tubular metallic sections with substantially rectilinear axis,*
1.4 *characterized in that said first metallic sections (3) are made of COR-TEN steel,*
1.5 *and in that said first metallic sections (3) have upper heads with saddle-like working, i.e. delimiting a substantially U-shaped seat facing upward for the abutment of an end (2a) of at least one transverse element (2) or of a section of the latter.*

Independent claim 3 of the main request is based on claim 1 of the main request, but wherein feature 1.5 has been replaced by the following feature 3.5:

3.5 *and in that said first metallic sections (3) comprise one or a series of housing holes (5) within which the end (2a) of one of said transverse elements (2) is insertable*

Independent claim 15 of the main request, including the numbering of its features as adopted by the Board, reads as follows:

15.1 *Upright for obtaining a fence,*

15.2 *comprising a first tubular metallic section (3) with substantially rectilinear axis delimiting at least one housing hole (5, 5a, 5b) for the insertion and anchorage or the constraining of a first transverse element (2) or delimiting a saddle-like end or upper head (3g) for the abutment of an end or of a section of at least one transverse element (2),*

15.3 *characterized in that said first metallic section (3) is made of COR-TEN steel,*

15.4 *and in that it comprises, at a respective housing hole (5, 5a, 5b) or at a saddle-like end or upper head (3g), at least one ear or tab or tongue (3d) delimiting a third through hole (3e), said at least one ear or tab (3d) projectingly extended starting from a portion of the delimitation edge of said at least one housing hole (5, 5a, 5b) or delimitation edge of said saddle-like end or upper head (3g).*

VII. Auxiliary request 4 (to be considered after the main request in the event of A1 and A2 being admitted into the proceedings according to the requests of the respondent) comprises just one independent claim, which corresponds to claim 3 of the main request.

VIII. Claim 1 of auxiliary request 1 (comprising just one independent claim) is based on claim 3 of the main request, with the incorporation of the following features at the end of the claim:

1.6 *wherein it comprises locking means (3f) for locking said transverse elements (2) to said first metallic sections (3),*

1.7 *wherein at least one upright (3), at a respective housing hole (5) of an end (2a) or of a section of a transverse element (2) and/or at a saddle-like end or upper head (3g) for the abutment of an end (2a) or of a section of a transverse element (2), has at least one ear or tab or tongue (3d) delimiting at least one third through hole (3e),*

1.8 *wherein said locking means comprise at least one screw or bolt or rivet (3f) engaged in said third through hole (3e) and in said at least one transverse element (2),*

1.9 *and wherein said at least one ear or tab or tongue (3d) substantially encloses or flanks the end (2a) or the fitted or abutted section of said transverse element (2),*

1.10 *wherein said at least one ear or tab or tongue (3d) is projectingly extended starting from a portion of the delimitation edge of said at least one housing hole (5) or delimitation edge of said saddle-like end or upper head (3g),*

1.11 *wherein said at least one ear or tab or tongue (3d) extends towards the outside of the respective upright (3).*

IX. Prior art

The following documents were cited in the statement of grounds of appeal and during the opposition proceedings and are relevant to the present decision:

D1: EP 0 810 325 A2

D2: Brochure "Esterni Eterni" by Margaritelli, July 2013

D4: US 5,671,584 A

D5: CA 2 640 858 A1

D6: US 7,571,897 B2

D7: US 6,932,539 B2

D15: US 4,149,701 A

D16: US 2003/0222257 A1

D32: Printout of the website Wayback Machine with a capture of the Internet address "https://en.wikipedia.org/wiki/Weathering_steel" on 23 April 2013

X. The appellant's arguments relevant to the present decision can be summarised as follows:

(a) Main request - inventive step

The only distinguishing feature of claims 1, 3 or 15 over D15 or D16 was that the uprights were made of Corten steel (features 1.4 and 15.3).

The objective technical problem addressed by this distinguishing feature was how to improve resistance to the corrosion caused by weather agents.

The use of Corten steel for solving this technical problem was well-known to the skilled person since the advantages of this material in terms of corrosion resistance had been applied for decades in all kinds of uses as derivable from D32, which is evidence of common general knowledge. According to this common general knowledge the use of Corten steel for all kinds of applications, including some which are closely related to the technical field of fences (see D1, D2, D4, D5, D6 or D7), was generally known.

The skilled person trying to solve the problem posed and possessing the above-mentioned common general knowledge would adopt Corten steel for the production of the uprights disclosed in D15 or D16 in order to obtain the predictable result associated with its well-known properties, thus arriving at the subject-matter of claims 1, 3 and 15 in an obvious manner.

The skilled person did not need an incentive in the closest prior art to look for other materials since the problem-solution approach was based on the motivation provided by the secondary teaching - in this case, the well-known anti-corrosion properties of Corten steel - to solve the particular objective technical problem defined as a function of the distinguishing features.

The technical prejudices alleged by the respondent were not credible since the patent itself disclosed the same kind of upright construction as D15 or D16. The patent specification did not disclose any corrosion problem linked to this construction and did not elaborate on any solution to this alleged problem. It was noted that claims 1, 3 and 15 defined uprights of "tubular metallic sections", which included rectangular structures as in D15 (see Figures 3 and 7) or D16 (see Figures 2 and 8). Moreover, the alleged problem of water accumulation in D15 and D16 did not arise since the transverse elements fitted tightly in the holes of the respective uprights and a cap was arranged on top of the tubular uprights to avoid the entry of water.

(b) Auxiliary request 1 - admittance of objections

The oral proceedings before the Board constituted the first occasion on which auxiliary request 1 was discussed. There had been no earlier opportunity for

the appellant to respond to auxiliary request 1 since its letter dated 28 December 2023 was filed for a different main purpose, namely to comment on other objections raised against the main request. Therefore, it had not been possible to raise any objections against auxiliary request 1 before the oral proceedings and the objections raised at this stage should be admitted into the proceedings in order to respect the appellant's right to reply to the respondent's arguments.

Moreover, the objections relating to added subject-matter and sufficiency of disclosure were highly relevant, which also provided justification for their admittance.

(c) Auxiliary request 1 - inventive step

No technical advantage or solved problem was disclosed in the contested patent in relation to the incorporated feature 1.11 ("*said at least one ear or tab or tongue extends towards the outside of the respective upright*"), let alone regarding improved corrosion resistance or easier assembly, as proposed by the respondent.

Thus, according to well-established case law, no inventive activity could be acknowledged if the skilled person had not been in a position to acknowledge the technical contribution of the distinguishing feature at the application date. If the technical contribution could be recognised from the disclosure using common general knowledge, it would, "by definition", be obvious in view of that same common general knowledge.

Even if a technical effect could be acknowledged with respect to feature 1.11, it would be limited to how to provide an easier connection of the transverse elements, which is unrelated to the first objective technical problem addressed by the use of Corten steel (i.e. how to improve corrosion protection). The inventive-step analysis would thus have to be carried out in consideration of two partial problems, the first of which has already been dealt with in the context of the main request.

Concerning the second partial problem, D15 disclosed a tab ("flap" (6)) suitable to be used as defined in claim 1. It would have been obvious to the person skilled in the art to bend this tab (6) outwards instead of inwards (as disclosed in Figure 3) since this was a mere design choice in their hands when assembling the fence. This modification was a well-known solution for fixing pieces together more easily in the construction field and no inventive activity could be seen in this respect. Indeed, D6 disclosed such bending of a flap ("flange" (56)) outwards of a closed structure to assemble a transverse element (see Figure 4).

(d) Auxiliary request 1 - added subject-matter and sufficiency of disclosure

The combination of features defined in claim 1 was not originally disclosed. The figures of the originally filed application related to different embodiments, which could not be combined at will to justify a basis for the subject-matter of claim 1.

Moreover, Figure 15 did not disclose an outwardly extending tab that was connected with the upper

transverse element, the reference number (3f) indicating merely some undefined "locking means".

Furthermore, Figure 16 disclosed a vertically extending tab for the saddle-like end of the upright, making an assembly with a transverse element impossible. The skilled person would not know how to connect this vertically extending tab to the upper transverse element either, the invention thus not being sufficiently disclosed. Even if the skilled person assumed that the tab of Figure 16 had to be bent somehow, the patent contained no information about how this bending should take place and to which extent.

XI. The respondent's arguments relevant to the present decision can be summarised as follows:

(a) Main request - inventive step

The distinguishing feature "Corten steel" in the uprights of D15 or D16 was specifically defined for the "tubular metallic sections" constituting the uprights. Consequently, what had to be assessed was whether it would have been obvious to the skilled person to produce the "tubular metallic sections" of D15 or D16 from Corten steel.

The tubular metallic sections of D15 and D16 comprised complex connections working in association with the holes of the rectangular uprights (see, e.g., Figures 1 to 3 and paragraphs [0025] to [0027] of D16).

Corten steel had never been proposed for this kind of application even though the material itself had been known for several decades. In retrospect, it might appear obvious to use Corten steel, but this was a

hindsight-based analysis and multiple decisions of the Boards of Appeal had warned against such an approach. D32 disclosed several uses of Corten steel, but none of these related to tubular metallic sections like those of D15 or D16. Furthermore, it was disclosed on page 5 of D32 that the use of Corten steel entailed disadvantages in applications with water accumulation or in salty environments. Thus, it was not obvious to the skilled person that this material could be used for any conceivable application without reservations. On the contrary, the use of Corten steel required an in-depth study before its suitability for a particular application could be confirmed.

D15 and D16 disclosed uprights comprising several points where water or humidity were likely to accumulate and where problems were to be expected if Corten steel was used. The edges around the holes would be one of these spots where water could stagnate and also where friction could occur due to dilatation, this resulting in an increase in temperature and favouring corrosion. The transverse elements crossing the uprights of D15 and D16 as well as the inner flap (6) of D15 presented the same risk of water and humidity accumulation.

Against this background, the skilled person would not have chosen Corten steel for the uprights, in particular since other materials were available which did not present such problems, like the materials cited in D15 and D16 themselves. The fact that the contested patent did not discuss the problems caused by water or humidity accumulation was not relevant to the discussion about inventive step since the skilled person would not look at the contested patent when

assessing the feasibility of a particular combination of prior art.

The prior art cited by the appellant disclosed solutions using Corten steel in different structures, involving particular connections, which did not correspond to those of D15 or D16. The use of Corten steel in such solutions - such as in the posts of the wall structure disclosed in D4 or in the stanchions of the groynes disclosed in D7 - could not be arbitrarily isolated from the rest of the construction disclosed without using a hindsight-based approach.

Finally, neither D15 nor D16 provided an incentive to look for other materials since each of these documents already disclosed materials resistant to corrosion. The skilled person would need a reason to change the material used in the proposed closest prior art and, in any case, the appellant did not justify why the skilled person would disregard the problems entailed in the use of Corten steel in D15 and D16.

(b) Auxiliary request 1 - admittance of objections

The objections raised for the first time during the oral proceedings before the Board were not to be admitted under Article 13(2) RPBA on account of their late submission, namely at the latest possible moment in the proceedings. The appellant had ample opportunity to comment on auxiliary request 1, which was submitted with the reply to the appeal, but chose not to do so, even when sending a further letter, dated 28 December 2023, in which no reference was made to this auxiliary request.

(c) Auxiliary request 1 - inventive step

The further distinguishing feature over D15 is feature 1.11 ("*said at least one ear or tab or tongue extends towards the outside of the respective upright*"). The technical effects of this distinguishing feature were providing easier access from outside when assembling, in particular, the lower transverse element, and improving corrosion resistance. The first technical effect was derivable by the skilled person when looking at the figures and the description of the patent. Indeed, the skilled person would have realised that the tab was located outside the tubular metallic element, thus improving accessibility. Concerning corrosion protection, this was the main aim of the patent, and the skilled person would have noted that the position of the tab outside the tubular metallic element avoided water accumulation.

No prior art provided motivation to modify the flap (6) of D15 by folding it outwards. In the absence of corresponding evidence, the arguments of the appellant about an alleged "mere design choice" were unsubstantiated allegations. D6 did not relate to a tubular element comparable to that of D15 since the former did not comprise any holes receiving transverse elements.

(d) Auxiliary request 1 - added subject-matter and sufficiency of disclosure

Figure 15 disclosed the connection between the outwardly extending tab and the transverse element, including the screw (3f) passing through the hole of the tab, as described in paragraphs [0056] and [0065] of the A1 publication of the originally filed

application. The skilled person knew from the originally filed application that the tabs were to be bent in order to assemble the fence (see paragraphs [0019], [0059] and [0065] and also Figure 10) and would thus understand that Figure 16 - which related to "*an upright for the fence of Figure 15*" (see paragraph [0019]) - disclosed the corresponding tab before it was bent.

Claim 1, and in particular feature 1.11 thereof, was thus originally disclosed in a complete manner and the skilled person would be in a position to reproduce the invention when considering the information in the patent specification, which comprised the same passages as those cited in support of Article 123(2) EPC.

Reasons for the Decision

1. Main request, inventive step - Article 56 EPC

1.1 Claim 1

1.1.1 Disclosure of D16

It is undisputed that D16 discloses a fence structure (see paragraph [0002]) (feature 1.1),
comprising a plurality of transverse elements (30, 50, 70) arranged on one or more superimposed horizontal rows (see Figure 1) and supported by vertical uprights (posts) (10) (feature 1.2),
whereby said uprights (10) are constituted by first tubular metallic sections (see penultimate sentence of paragraph [0025]) with substantially rectilinear axis (see Figures 1 and 2) (feature 1.3),

wherein the first metallic sections (10) have upper heads with saddle-like working (see "post top aperture" (16)), i.e. delimiting a substantially U-shaped seat facing upward (see Figure 2) for the abutment of an end of at least one transverse element (30) or of a section of the latter (see Figure 1) (feature 1.5).

1.1.2 Distinguishing features and related technical problem

It is undisputed that the subject-matter of claim 1 differs from the embodiment of D16 based on an upright made of metal in feature 1.4 ("*said first metallic sections are made of COR-TEN steel*").

The respondent did not dispute that the technical effect of distinguishing feature 1.4 is that corrosion resistance increases. The associated objective technical problem to be considered is thus - as argued by the appellant - how to improve resistance to corrosion caused by weather agents.

1.1.3 Alleged lack of motivation in the closest prior art

The opposition division considered in the contested decision that the skilled person would not have arrived at the invention starting from D16 since this document did not provide any incentive to adapt or modify the fence disclosed therein to improve its corrosion resistance, in particular since this closest prior art teaches the use of various materials already having good corrosion resistance (see point II.20.4 of the contested decision).

The respondent agreed with this consideration and remained adamant that D16 did not provide any incentive

to look for other materials, no reason being apparent for the skilled person to envisage a change of material. Any change of material was thus purely hindsight-driven.

This is not persuasive for the following reasons:

The problem-solution approach is based on what the skilled person would do when looking for a solution to the objective technical problem, which is defined on the basis of the technical effect produced by the distinguishing features.

The closest prior art is the starting point for the analysis according to the problem-solution approach, but the skilled person starting from the embodiment of D16 based on an upright made of metal - which results in an objective technical problem only relating to improving corrosion resistance - is not prevented from looking for other materials just because this document discloses several alternative materials. The fact that some of these materials may exhibit good anti-corrosion properties is not an indication to the skilled person that they are the only materials to be used for the embodiments disclosed therein. In other words, D16 does not teach away from considering other materials.

It is a conceptual error to consider that the closest prior art must provide an incentive to modify the same in order to justify an absence of inventive step. The motivation to modify (if any) can also be - and usually is - found in the secondary teaching consulted by the skilled person when looking for a solution to the objective technical problem. Indeed, a teaching in the secondary document is usually the pointer which incites the person skilled in the art to apply the prior-art

teaching disclosed in the secondary document in order to overcome the objective technical problem. Such a pointer or incentive is precisely what differentiates the obvious solution from a hindsight-based solution or the "would" from the "could". In the present case, the known anti-corrosive properties of the Corten-steel metal provide a motivation or pointer to use the material to improve corrosion resistance. There is thus no hindsight in the analysis, contrary to what has been argued by the respondent with reference to case law, which concerned, however, different factual circumstances.

1.1.4 Alleged technical prejudice against using Corten steel

The respondent argued that the appellant did not justify why the skilled person would not see the problems allegedly entailed in the use of Corten steel in D16.

This is not persuasive since the burden of proof lies with the party making the allegation in this respect. It was the respondent that had the obligation to show that a technical prejudice against the use of Corten steel in a fence upright like that of D16 existed before the priority date and that this would have dissuaded the skilled person from considering this material for this particular application.

The respondent put forward that it was part of the common general knowledge of the skilled person that the use of Corten steel entailed disadvantages in applications with water accumulation or in salty environments, as disclosed on page 5 of D32.

This is generally true, but it is not persuasive when considering in detail what the common general knowledge in this respect was when considering a construction as in D16.

The point "Disadvantages", bridging pages 4 and 5 of D32, discloses that the use of Corten steel **in construction** presents "several challenges". D32 does indeed disclose that "[i]*f water is allowed to accumulate in pockets, those areas will experience higher corrosion rates, so provision for drainage must be made*", but this statement is made in the context of applications in construction. As noted by the respondent during the oral proceedings, D32 cites in this respect two constructions that have been affected by such problems as illustrative examples, namely Hawaii's Aloha Stadium and the Omni Coliseum in Atlanta.

This common general knowledge with respect to the technical field of construction does not result in a generalised technical prejudice against all applications. Instead, it is restricted to the existence of reservations regarding the use of Corten steel in this particular field, namely in an application which implies certain dimensions and requirements for the elements involved. This does not mean that it was common general knowledge that any water accumulation or humidity concentration in an element differing from a construction element - e.g. a fence upright, as disclosed in D16 - rendered the application of Corten steel unsuitable for it. The same applies to the case of the disclosed disadvantages linked to a use in "salty environments", the fence of D16 furthermore not being disclosed as being intended for such environments.

The patent specification does not support the alleged technical prejudice either, since it contains no reference to any problems caused by water accumulation or humidity, let alone to any means of countering these alleged problems. It is true that the skilled person cannot look at the contested patent when considering what was obvious before the priority date, as argued by the respondent. However, in the absence of any evidence and without there even being any mention of alleged technical prejudice in the cited prior art, it is not convincing that the precise contribution of the invention was to be seen in overcoming such technical prejudice. Rather, the upright construction disclosed in the contested patent is actually analogous to that of D16. Both upright constructions consist of metallic tubular sections which are closed on all sides, whether this be by transverse elements penetrating the holes in the upright in a close manner (compare Figures 8 and 9 of the patent and Figures 1 and 5 of D16) or by a closing element on the top (compare "covers" (4) in the patent and "post cap" (12) in D16). The Board is not persuaded that such an upright construction would result in critical accumulations of water or humidity which would jeopardise the stability of the upright in an analogous manner to the case of the construction ele ments mentioned in D32, in particular in view of the closed structure of the upright once the fence is assembled. The argument about an increase in temperature due to friction caused by thermal dilatation, which would encourage corrosion, is merely speculative and not based on any disclosure in the patent. This effect would thus not be seen as encompassed by that original disclosure.

Consequently, the Board concludes that the skilled person had no technical prejudice against using Corten steel for an upright as disclosed in D16 since it has not been proven that it was common general knowledge that Corten steel was an unsuitable material for producing such an upright construction (on the contrary, it was used in comparable structures - see point 1.1.5 below, in particular the reference to D1, D2, D4 and D7).

1.1.5 Obviousness in view of common general knowledge

It is not disputed that the advantageous properties of Corten steel in relation to corrosion were part of the common general knowledge before the priority date of the contested patent.

The skilled person looking for a solution to the problem posed (how to improve the resistance of the metallic upright of D16 to corrosion caused by weather agents) would thus consider Corten steel as a possible metallic material for producing the uprights (10) of D16 in an obvious manner. This applies particularly since Corten steel has been used for all kinds of metallic elements, even including tubular elements comparable to the uprights (10) of D16 (see, in particular, the fence-like groyne sections disclosed in D7 - see column 7, lines 33 to 40), which counters the alleged technical prejudice related to producing tubular elements for a fence from this material.

The respondent argued that Corten steel was always disclosed in connection with particular constructions in the cited prior art and that isolating this material from the particular construction could only be carried out with hindsight.

This argument is not relevant since the Board finds that the use of Corten steel for producing the uprights (10) of D16 would be obvious on account of the common general knowledge of the skilled person about this material. Hence, it would not necessarily require a combination thereof with a particular piece of prior art. Nevertheless, it is worth noting that Corten steel is cited in a general manner in each of the cited patent documents as just another material in the list of possible materials, and it is thus not disclosed as being inextricably linked to any particular construction disclosed therein based on technical considerations (see, e.g., D1: column 4, lines 32 to 34; D2; D4: column 2, lines 12 to 16; D5: page 6, last paragraph; or D7: column 7, lines 33 to 40).

1.1.6 Conclusion

In view of the above, the subject-matter of claim 1 does not involve an inventive step with respect to the combination of D16 and the common general knowledge (Article 56 EPC).

1.2 Claim 3

The objections of the appellant against claim 3 were based on the use of document D15 as the closest prior art. The same objective technical problem and secondary sources of information for the skilled person were proposed as for the objections based on D16.

Document D15 discloses tubular uprights made from a metallic material ("posts" (1)) of an analogous construction to those of D16 (see Figures 3 and 7 disclosing the tubular construction and the provision

of housing holes (8) receiving the transverse elements (3); see also column 1, lines 63 to 68).

It is undisputed that the only distinguishing feature is feature 1.4 ("*first metallic sections are made of COR-TEN steel*"), as in the case of D16.

Consequently, the same considerations as in point 1.1 above apply here, *mutatis mutandis*.

1.3 Claim 15

The object of claim 15 is an upright for obtaining a fence comprising a first tubular metallic section basically corresponding to the one defined in claim 1 or claim 3.

The objections of the appellant against claim 15 were based on the use of document D15 as the closest prior art. The same objective technical problem and secondary sources of information for the skilled person were proposed as for the objections against claim 3.

Therefore, the same considerations as explained in points 1.1 and 1.2 above apply here, *mutatis mutandis*.

2. Auxiliary request 4

The respondent requested that auxiliary request 4 be handled immediately after the main request if A1 and A2 were taken into consideration in the appeal proceedings.

This was not the case and, therefore, auxiliary request 4 is not to be discussed. In any case it would have to be assessed like the main request, since claim 1 of

auxiliary request 4 corresponds to claim 3 of the main request (see point 1.2 above).

3. Auxiliary request 1, admittance of objections - Article 13(2) RPBA

3.1 Legal basis

It is undisputed that none of the appellant's objections against auxiliary request 1 raised during the oral proceedings before the board had been previously presented during the written phase of the proceedings.

They are thus amendments, the admittance of which is subject to the discretion of the Board under Article 13(2) RPBA. This provision specifies that such amendments shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

3.2 Reasons for the late submission of the objections

The appellant argued that the oral proceedings before the Board constituted the first occasion on which auxiliary request 1 was discussed in substance and that there had been no earlier opportunity for it to respond to auxiliary request 1 since its letter dated 28 December 2023 had been filed for a different main purpose, namely to comment on other objections raised against the main request. Therefore, according to the appellant, it had not been possible to raise any objections against auxiliary request 1 before the oral proceedings and the objections raised at this stage

should be admitted in order to respect the appellant's right to reply to the respondent's arguments.

This is not persuasive.

Auxiliary request 1 was submitted by the respondent on 6 October 2023 with its reply to the statement setting out the grounds of appeal. It was after receiving this reply that the appellant should have reacted, namely by raising its objections against this request already in the written appeal proceedings. It is noteworthy that the appellant actually submitted a letter on 28 December 2023, which included arguments relating to the main request, but which did not address auxiliary request 1 despite the appellant already being aware of this request at that point in time.

Furthermore, the Board explicitly stated in its communication under Article 15(1) RPBA that the appellant had not raised any objections against auxiliary request 1 (see point 12 of the communication), but the appellant did not react in this context either.

Therefore, the board cannot accept the argument about the appellant not being able to raise objections against auxiliary request 1 prior to the oral proceedings before the Board. The appellant could have replied to the respondent's arguments - which were explained in point 11.1 of the respondent's reply to the appeal - once it became aware of the respondent's submission. However, by not doing so until the latest possible moment in the appeal proceedings, the appellant itself has made its submissions subject to the strict requirements of Article 13(2) RPBA.

3.3 *Prima facie* relevance of the objections related to inventive step

The appellant argued that no technical advantage or solved problem was disclosed in the contested patent in relation to incorporated feature 1.11 ("*said at least one ear or tab or tongue extends towards the outside of the respective upright*"), let alone regarding improved corrosion resistance or easier assembly, as proposed by the respondent. According to the appellant, this implied that no inventive activity could be acknowledged in relation to this distinguishing feature.

This is not persuasive since the skilled person with a background in mechanics understands from the content of the patent (see, e.g., Figure 8 and paragraph [0056]) that the engagement of the "screw or bolt or rivet" (3f) is rendered easier by the location of the tab's through hole (3e) outside the tubular metallic section. This technical effect is self-explanatory for the skilled person in view of the figures of the patent.

The Board notes that this does not mean that the technical contribution of the invention would thus, "by definition", necessarily be obvious in view of that same common general knowledge. The skilled person looking at a particular disclosure can infer technical effects deriving from what they see in view of their technical background, which allows them to understand the technical implications behind the disclosed solution. However, this does not imply that they would necessarily have thought of this as a solution to a particular technical problem before having an opportunity to observe it for the first time.

As a second line of attack, the appellant argued that D15 disclosed a tab ("flap" (6)) suitable to be used as defined in claim 1, and that the skilled person would have contemplated in an obvious manner bending this tab (6) outwards instead of inwards (as disclosed in Figure 3) since this was a mere design choice in their hands when assembling the fence. This modification was allegedly a well-known solution for fixing pieces together more easily in the construction field and no inventive contribution could be seen in this respect. According to the appellant, D6 disclosed such folding of a flap ("flange" (56)) outwards of a closed structure to assemble a transverse element (see Figure 4).

This is not persuasive either, since D6 relates to a completely different construction, namely a flange (54) connected to a post member (18) of a guard rail. No tubular metallic structure comprising holes for insertion of the transverse elements is disclosed in D6, from the edge of which the alleged "flap" would extend as in D15 (see Figure 3). The skilled person would thus not find any teaching in D6 that incited them to fold the flap (6) of D15 outwards instead of inwards.

Furthermore, the alleged existence of common general knowledge of the skilled person about "a well-known solution for fixing pieces together more easily in the construction field" has not been substantiated by the appellant.

Consequently, the raised objections related to inventive step are not *prima facie* relevant to the outcome of the proceedings.

3.4 *Prima facie* relevance of the objections related to added subject-matter and sufficiency of the disclosure

3.4.1 The appellant argued that the combination of features defined in claim 1 was not originally disclosed since the figures of the originally filed application related to different embodiments, which could not be combined at will to justify a basis for the subject-matter of claim 1. Moreover, according to the appellant, Figure 15 did not disclose an outwardly extending tab which was connected with the upper transverse element, the reference number (3f) indicating only some undefined "locking means".

This is not, *prima facie*, persuasive.

Inserted features 1.6 to 1.10 result from the incorporation into claim 1 of the subject-matter of originally filed claims 5 (feature 1.6), 9 (features 1.7, 1.8 and 1.9) and 13 (feature 1.10), the combination of these features thus being originally disclosed. Concerning incorporated feature 1.11, Figure 15 of the originally filed application (reproduced below) discloses the screws (3f) - thus, not just some "undefined locking means" -, which are explicitly disclosed as being intended to be engaged in the third through hole (3e) of the tabs (3d), be it in a horizontal or vertical direction (see paragraphs [0054], [0056], [0061] and lines 43 and 44 on page 5 of the A1 publication of the application). The skilled person understands from Figure 15 (and the corresponding description) that the screws (3f) connected to the upper transverse element (2) must be arranged vertically - according to one of the two possibilities explicitly disclosed - in view of the

disclosed position of the screw (3f) indicated by the arrow linked to the corresponding reference number in the figure.

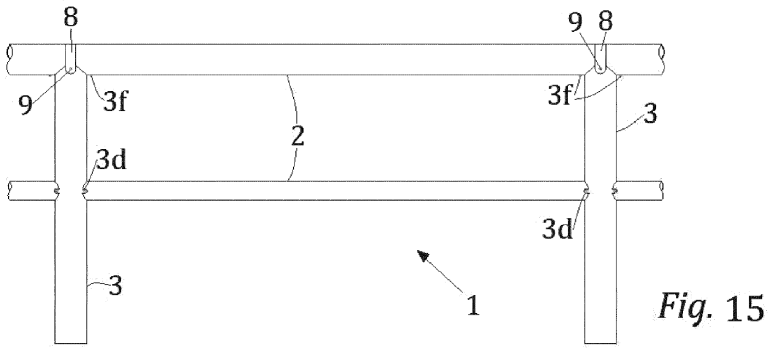

Fig. 15

Feature 1.11 ("*said at least one ear or tab or tongue extends towards the outside of the respective upright*") thus has a basis in the originally filed application both for the case of the "ear or tab or tongue" projectingly extending from a portion of the delimitation edge of the at least one housing hole and for the case of the "ear or tab or tongue" projectingly extending from the delimitation edge of the saddle-like end or upper head. The skilled person reading the originally filed application would have no reason to consider that this feature was inextricably linked to other features (not specified by the appellant) of the particular embodiment in view of their technical function. On the contrary, the skilled person would understand that this type of fixation means was intended to be combined with the invention defined in its more general terms (see the originally filed claims, from which the vast majority of the subject-matter of claim 1 stems), in which - see claim 13 as filed - the subject-matter was already generalised towards at least one ear or tab or tongue being "projectingly extended".

3.4.2 Concerning sufficiency of disclosure, the appellant put forward that the skilled person would not know how to connect the vertically extending tab of Figure 16 of the contested patent to the upper transverse element, and that, even if the skilled person assumed that the tab of Figure 16 had to be bent somehow, the patent contained no information about how this bending should take place and to which extent.

This is not persuasive since the contested patent makes it abundantly clear that the "ears or tabs or tongues" (3d) are bent before assembly of the fence in order to achieve the right orientation allowing the "screw or bolt or rivet" (3f) to penetrate their third through hole (3e) and the corresponding transverse element (2) (see paragraphs [0059] and [0065]). Figure 16 corresponds to "*an enlarged-scale view of an upright for the fence of fig. 15*" (see column 3, lines 8 and 9) and the skilled person thus understands that, since this figure shows a tab (3d) extending vertically upwards whereas Figure 15 shows (implicitly; see point 3.4.1 above) the tab extending horizontally, the tab (3d) of Figure 16 must be bent as explicitly described in the patent to reach the required position. The skilled person with an average knowledge of mechanics needs no further information to reproduce the disclosed arrangement.

3.4.3 In view of the above, neither the objection based on the grounds of extension of subject-matter (Article 123(2) EPC), nor the objection based on the grounds of sufficiency of disclosure (Article 83 EPC) is *prima facie* relevant.

3.5 Since the objections were filed late without any reason justifying this and are furthermore not *prima facie* relevant, they are not admitted into the proceedings under Article 13(2) RPBA.

4. Adapted description

The appellant had no objections as regards the adapted description filed with respect to auxiliary request 1.

The Board sees no reason to object either.

5. Article 101(3)(a) EPC

Since, taking into account the amendments made by the respondent to auxiliary request 1, the requirements of the EPC are met, the patent can be maintained as amended according to Article 101(3)(a) EPC.

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 with the order to maintain the patent as amended in the following version:

   - claims 1-9 according to auxiliary request 1 filed with the reply to the statement of grounds of appeal

   - description paragraphs [0001] to [0069] as filed during the oral proceedings before the Board

   - figures 1-16 of the patent specification

The Registrar: The Chairman:

D. Grundner C. Herberhold

Decision electronically authenticated