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Aktenzeichen / Case Number / N^o du recours : T 419/88 - 3.2.2

Anmeldenummer / Filing No / N^o de la demande : 82 900 836.6

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Bezeichnung der Erfindung: Method for mounting a roof, floor or similar
Title of invention: structure and a structure adapted to be mounted
Titre de l'invention : according to the method

Klassifikation / Classification / Classement : E04B 1/74, E04B 7/00

ENTSCHEIDUNG / DECISION

vom / of / du 5 June 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Profoment Utvecklings AB

Einsprechender / Opponent / Opposant :

Novotherm AB

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Articles 54, 56

Schlagwort / Keyword / Mot clé :

"Novelty (yes)" -

"Inventive step (yes) - document related to exceptional technical field not relevant in normal technical field"

Leitsatz / Headnote / Sommaire



Case Number : T 419/88 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 5 June 1990

Appellant : Profoment Utvecklings AB
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Decision under appeal : Decision of the Opposition Division of the European
Patent Office dated 1 July 1988 revoking
European patent No. 0 074 971 pursuant to
Article 102(1) EPC.

Composition of the Board :

Chairman : G. Szabo
Members : K. Stamm
L. Mancini

Summary of Facts and Submissions

- I. European patent No. 74 971 was granted on 18 December 1985 with two independent and eight dependent claims in response to the European application No. 82 900 836.6, filed on 15 March 1982.
- II. A Notice of Opposition was filed against the European patent on 17 September 1986 requesting the revocation of the patent in view of the following documents:
 - (1) US-A-4 038 788
 - (2) US-A-3 415 260
 - (3) US-A-3 534 511.
- III. In its decision of 1 July 1988 the Opposition Division revoked the patent on grounds that the subject matter of Claim 1 was obvious to the skilled man when he started from document (1) and that the subject-matter of Claim 2 was not new against document (1).
- IV. A Notice of Appeal was filed on 18 August 1988 by the Proprietor of the patent against this revocation. The appeal fee had been paid on 1 September 1988, and the Statement of Grounds was filed on 4 October 1988.

The Appellant is of the opinion, that the decision of the Opposition Division did not correctly interpret document (1) and that the assessment of inventive step was based on an analysis using hindsight. Referring to the differences between the known movable roof and the contested fixed structure he emphasizes that a man skilled in roofing and flooring, aiming at improving the methods of prefabrication, would not be expected to consult solutions

proper to movable roof constructions. Contrary to the allegations contained in the decision, document (1) did not mention the possibility of the structure being pre-fabricated in a factory. The closing and opening principle of document (1) is no mounting principle in the sense of the patent.

The Appellant also submitted amended Claims 1 to 10.

V. Amended Claim 1 reads as follows:

"1. A method of making a permanent fixed roof or floor comprising the manufacture of a structure containing a number of girders (10) by interconnecting the girders at their lower side with a flexible sheet (5, 15), moving the girders close together and folding the sheet to lie in gaps between the girders to form a transportable unit, transporting the unit from its place of manufacture to a building site, forming a building structure including supporting beams, resting the unit on the supporting beams, moving the girders apart to their final position wherein the flexible sheet is tautly stretched and determines the girder spacing, and fixing at at least some of the girders in their final position to the beams."

VI. In his letter of 2 March 1990 the Respondent (Opponent) disagreed with the grounds given by the Appellant and confirmed the reasoning of the contested Decision. It was submitted that the sliding roof according (1) could also be permanent and that this is no distinctive feature. As to the suggested interpretation, according to which such roof's actual state might not be intended to be changed once it has been mounted, no basis could be found in the description. The statement in the description of the invention "the method and structure can of course be used in all types of roofs, floors and similar" was a clear

indication that the disclosed matter was not restricted to permanent structures.

According to the Respondent the amended claims were not supported by the specification, claims and drawings as originally filed and the amendment was in contravention of Article 123(2) EPC. No basis was seen for the terms "permanent fixed", "fixing at least some of the girders in their final position to the beams" (Claim 1), and "to which at least some of the girders are fixed" (Claim 2).

VII. In his answer filed on 8 May 1990 to a Communication of the Board, the Appellant presented an amended Claim 2 with Claims 1 and 3 to 10 as already submitted. Amended Claim 2 reads:

"2. A permanent fixed roof or floor comprising a structure containing a number of girders (10) which are interconnected at their lower side by a flexible sheet (15, 115) having permitted the girders to be pushed together and moved apart before fixing by folding and unfolding the sheet, wherein said roof or floor further comprises supporting beams, above which the structure is located and to which at least some of the girders are fixed, with the flexible sheet stretched between the girders." (emphasized amendments added).

VIII. The Appellant requests that the decision be set aside and the patent be maintained on the basis of the claims submitted in his letter of 8 May 1990.

He also requests that the appeal fee be reimbursed in the event he would be successful.

- IX. The Respondent has indicated by telecopy, received on 8 February 1990 and confirmed by letter of 13 February 1990 ("crossing" the notification of the Communication mentioned under VII) that he "withdraws the opposition".

Reasons for the Decision

1. The Appeal is admissible.

The Respondent withdrew his arguments in a later stage of the case. Nevertheless, the Board feels obliged to continue and complete the examination of the appeal on the basis of submissions presented earlier in accordance with Article 114(1) EPC.

2. Amendments

- 2.1 The expression "permanent fixed" (roof or floor) is added to the granted Claims 1 and 2 to meet the Respondent's arguments related to movable roofs. In order to distinguish therefrom the claimed subject-matter, the term "a permanent fixed roof" appears to be appropriate, distinctive and necessary. The contrast expressed by it is clearly implied by the originally filed application, since nothing in the disclosure points to the type of roofs acting normally as movable, i.e. which are opened and closed at will after installation.
- 2.2 The words "fixing at least some of the girders in their final position to the beams" and "to which at least some of the girders are fixed" concern technically necessary features which are self-evident to any normal roof or floor having girders supported by beams. Since the originally filed application does not refer to structures which are movable in their normal working state, these features, added to the original claims, are necessarily

implied in the original disclosure and result in limitation of the granted claim.

The amendments emphasized in Claim 2 (VII.) are corrections which clarify the real sequence of activities implied by reference to the method as originally disclosed. They are relevant to the question of the inventive step and restrict the scope of the claim as granted.

- 2.3 It follows from the above that the amendments in Claims 1 and 2 comply with Article 123(2) and (3) EPC and thus are admissible.
- 2.4 The one-part form of Claims 1 and 2 is justified since the formally closest document (1) belongs to a remote specialized technical field. This state of the art implies features united in structural and functional relationship not compatible with the invention. This document is, therefore, not to be taken as an appropriate starting point when a normal roof or floor is to be built.

3. Novelty

The clarification introduced in amended Claims 1 and 2 leaves no doubt that the sliding roof disclosed in document (1) is different from the claimed subject matter. The structure of document (1) does not represent a fixed roof. In the usual technical meaning as well as in the meaning supported by the description, the rather rare and extraordinary special construction of a movable roof is not a simple equivalent of the commonly used fixed roof: the two types of a structure differ to a great extent with regard to basic functional conditions and as the technical means necessitated therefore. Furthermore, it does not contain all the features of Claims 1 and 2 in the present

case. None of the other documents referred to during examination and opposition procedure discloses all the features of these claims either.

The claims, therefore, meet the requirements of Article 54(1) EPC.

4. State of the art, problem and solution

According to the description, the technical situation forming the basis of the invention is given by the relationship of construction work to be performed in situ, on the one hand, and of prefabrication, on the other. Prefabrication of floors, walls and roofs results in gain of working time and rising the level of quality. This also applies to any permanent fixed roof construction in the state of the art, including those cited in the search report before grant. However, this also results in drawbacks related to problems with tightness, joints, transports, handling and adaptability. The objective technical problem to be solved with such fixed roofs remains therefore to achieve a better balance between advantages and drawbacks of that situation.

Method Claim 1 and product Claim 2 suggest to use prefabricated girders connected with a sheet at the lower side, and shifted together in a transportable unit in the form of a package. After transport to the site the packages are lifted up and placed on supporting beams. Then a traction force is applied to one of the outer girders which is pulled and equally the following girders are pulled. In the final state, the girders are evenly distributed along the supporting beams and the sheet is stretched to form the appropriate enclosure of the building.

According to these suggestions, elements of the final construction (roof covering) which usually are regarded only as to be mounted in situ are here already mounted in the prefabrication-phase. Therefore, by such a semi-manufacturing the advantages of prefabrication are combined with those of construction in-situ in an effective and new way which, therefore, presents a solution of the posed problem.

5. Inventive step

5.1 Document (1) shows the widest-going conformity with the the subject-matter of the contested claims as regards essential structural elements. This document, however, describes a sliding roof, i.e. neither a normal roof nor a normal floor as claimed.

5.2 In the Opinion of the Board it is questionable whether the skilled man would have been expected to investigate closely the teachings of movable roof structures as disclosed in documents (1), (2) and (3) - when desiring to rationalize the methods of constructing ordinary roofs and walls. The skilled man is not expected to take into account remote specialized fields as long as there is no linkage between his problem and such a special field to be determined (seen without the knowledge of the invention). Movable roofs according to document (1) are by themselves not to be regarded as especially interesting in respect of rationalisation of normal roofs. Just the opposite is the case: They require various special means for the movement and the sliding and have to take account of additional circumstances when compared with ordinary roofs. They present, therefore, actually far more complicated and clumsy constructions than normal roofs or floors. A skilled man who wants to improve the possibilities of such prefabrication methods had, therefore, no reasonable

ground as to rely on a such a considerably different type of construction.

- 5.3 But even assumed, the skilled man would have tried to follow the teaching of (1) in respect of possible contributions to improve prefabrication, he would not receive information sufficient to arrive at the method of Claim 1. In this document, nothing is said in detail about the way of erecting the disclosed structure; the problems of prefabrication are not mentioned at all. In particular, the idea of forming compact units of girders linked with a flexible sheet and transporting them to the building site is not to be deduced from this document - without the knowledge of the invention. This idea, however, leads to one of the basic features comprised in Claim 1.

The apparent similarity between document (1) and Claim 1 may suggest that an obvious relationship would exist between their teachings. However, before the inventive concept has been found, document (1) has to be understood in the first place as bound to particular conditions in the remote peculiar field of movable roofs. Since, as mentioned above, no information can be found which were directed to rationalized erecting methods or to improved prefabrication of roofs, the skilled man could not find any definite encouragement therein which might have guided him to the claimed solution.

Therefore, even assuming the teaching of (1) were taken into account, the method according to Claim 1 - if an ex post introduction of inventive aspects is strictly avoided - is no derivation determined by this document and, therefore, is it not obvious having regard to it.

- 5.4 Since in document (1) no hint is to be found relating to improvements in the manufacture of ordinary roofs and

floors, since (1) itself presents a heavy, complicated machine-operated structure which is certainly far more difficult to build than any normal roof, the skilled man had no professional reason for amending the known movable roof in such a way as to arrive at the content of Claim 2. In the Board's view, the structure of Claim 2 can be understood as a transposition of an especially focused entity of features, separated out of their context within a known complex of structural and functional features, shown in a remote, specialized technical field, into a general field, answering a long-known general problem. Such a transposition, however, is not a result the skilled man is expected to find but a result involving an inventive step.

Therefore, the subject-matter of Claims 1 and 2 was not obvious to the skilled man having regard to document (1).

5.5 Document

(4) US-A-2 603 171

mentioned in the description also relates to roofs adapted to be opened and closed. Since here no sheet is disclosed, this roof is less relevant than the one of document (1).

5.6 The documents mentioned in the Search Report which disclose no movable roofs do not refer to methods of mounting roofs or to appropriately adapted structures. They deal with the influence of weather conditions (DE-A-1 242 356), reduction of the necessary number of different structural elements (DE-A-2 224 232), temperature isolation (CH-A-380 343) or even more remote questions. They do not disclose any technical relevant similarity closer to the contested invention.

5.7 The subject-matter of Claims 1 and 2 is, therefore, not obvious to the skilled man concerned with the posed problem having regard to the cited documents and meets the requirements of Articles 52(1) and 56 EPC.

Based on Claim 2, dependent Claims 3 to 10 remain valid.

Reimbursement of Appeal fee

The contested decision does not violate any procedural rules. The mere use of a questionable argumentation is no procedural violation. Therefore, according to Rule 67 EPC, the requirements for reimbursement are not met.

Order

For these reasons, it is decided that:

1. The contested decision is set aside.
2. The case is remitted to the Opposition Division with the order to grant the patent on the basis of the claims according to Appellant's letter of 8 May 1990 and the description as granted.
3. The Appeal fee is not to be remitted.

The Registrar:

The Chairman:

S. Fabiani

S. Fabiani

G. Szabo
G. Szabo

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