

Publication in the Official Journal Yes / No

File Number: T 231/89 - 3.2.2
Application No.: 83 200 171.3
Publication No.: 0 086 023
Title of invention: Pivoting gauze screen door

Classification: E06B 9/54

D E C I S I O N
of 14 June 1991

Former patent Proprietor: van Wesenbeeck
Proprietor of the patent: Bruynzeel Plastics B.V.

Opponent/Respondent: 01 Hamstra Weesp B.V.
02 Bruynzeel Plastics B.V.

Headword: Flat torsion spring/BRUYNZEEL

EPC Articles 69(1), 123(2), 123(3)

Keyword: "Conflict between Article 123(2) and 123(3) EPC" -
"Extent of protection is not influenced by a feature without
technical meaning" - "Deletion of feature in a granted claim
(allowable)" - "Relevance of Article 69(1) EPC, Protocol on
Interpretation"

Headnote

I. It would be unjustified to declare a patent invalid on ground of Article 100(c) EPC for the reason alone that an amendment introducing a limiting feature during prosecution with the approval or recommendation of the Office extended the subject-matter of the patent beyond the content of the application whilst the removal of the same feature is, on the other hand, to be prevented under Article 123(3) EPC. In such cases a reasonable and balanced interpretation of the two sub-articles (2) and (3) of Article 123 EPC is necessary. As long as such scope limiting feature in a claim is meaningful but immaterial in respect of the novelty and inventive step of the claimed subject-matter, Article 123(3) EPC is to be regarded as dominant over Article 123(2) EPC and the feature may therefore remain in the claim notwithstanding its character of added matter (cf. paragraph 3.1 of the decision).

II. On the other hand, the extent of protection determined by a claim having a specific feature without technical meaning is independent of such a feature and of its deletion, i.e. the same can be deleted without contravention of Article 123(3) EPC (cf. paragraph 3.5 of the decision).

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DECISION
of 14 June 1991

Proprietor of the patent: Bruynzeel Plastics B.V.

Headword: Flat torsion spring/BRUYNZEEL

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Keyword: "Conflict between Article 123(2) and 123(3) EPC" -
"Extent of protection is not influenced by a feature without
technical meaning" - "Deletion of feature in a granted claim
(allowable)" - "Relevance of Article 69(1) EPC, Protocol on
Interpretation"

Headnote follows



Case Number : T 231/89 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 14 June 1991

Appellant :
(former Proprietor
of the patent)

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Respondent :
(Opponent 01)

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Representative :

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Respondent:
(Opponent 02, present
Proprietor)

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Decision under appeal :

Decision of the Opposition Division of the
European Patent Office dated 31 January 1989
revoking European patent No. 86 023 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. 0 086 023 was granted on 27 August 1986 with one claim in response to European patent application No. 83 200 171.3, filed on 1 February 1983.

II. The claim reads:

"A gauze screen door to keep out insects, comprising a rectangular wire gauze (5) being higher and wider than the doorway and affixed with one end at a roll-up shaft (1) and winding and unwinding around it and with the other end to a beam (6) said roll-up shaft having at one end a flat torsion spring and being enclosed by a longitudinal box (3), affixed in a vertical position against the door frame bar, said box having a substantially U-shaped profile in cross-section and being kept by cradles (2) affixed upon the door frame, characterized in that the torsion spring is held in any desired position by means of a cog-wheel and rack with a locking lobe pitching into the dents, while the side face of said longitudinal box (3) at the doorway side is shorter than the opposite side, said side face having a smoothly beaded edge (4), and the roll-up shaft (1) is pivotable by bearings in bushes at its ends, protruding through a ring bolt, the wire gauze (5) being affixed at the other end between a hollow beam (6) having a rectangular cross-section, and a flat strip (7) having a bet fixing brim, and the rims of the screen when unwound, slide in top and bottom rails (8) respectively, which are provided at the upper and lower edge of said wire gauze (5), said hollow beam (6) being provided with rubber brackets (9) at each end guided in said rails (8), and with two handles (10)" (emphasis in pre-characterizing portion added).

III. Two Notices of Opposition against the European patent were filed on 5 February (O1) and 27 May 1987 (O2). Opponent 1

requested revocation of the patent on the grounds of Article 100(a) EPC. Opponent 2 requested revocation of the patent on the grounds of Articles 100(a) and (b). During oral proceedings held on 31 January 1989, Opponent 1 objected that the claim contained subject-matter (viz. caused by the word "flat") which extended beyond the content of the application as filed, forming an additional ground for opposition according to Article 100(c) EPC.

Opponent 01 was of the opinion that no inventive step was needed to adapt the features of

(1) NL-A-6 905 341

to a gauze screen door according to

(2) NL-A-7 614 313

and, thus, to arrive at the subject-matter of the contested claim.

IV. In its decision of 31 January 1989, issued on 22 February 1989, the Opposition Division revoked the patent on the grounds that the granted claim was amended by addition of the feature "flat" (torsion spring) and that the amendment offended Article 123(2) EPC; however, that a deletion of the added feature was not allowable since it contravened Article 123(3) EPC.

V. A Notice of Appeal was filed on 16 March 1989 by the former Proprietor of the patent against this revocation. The appeal fee was paid on 14 March 1989; the Statement of Ground was filed on 5 June 1989.

The Appellant is of the opinion that the characteristic "flat" is redundant. In a reply filed on 9 January 1991 answering a Communication pursuant to Article 110(2) EPC

issued by the Board, the Appellant observes that the word "flat" in Claim 1 was introduced accidentally during prosecution. He agrees with the deletion of this word.

- VI. In a letter filed on 15 August 1990 Opponent O2 withdrew his opposition. In a letter filed on 16 August 1990 the representative of the proprietor informed the EPO that the former proprietor had legally transferred his property rights to Opponent O2 who is now identical with the Appellant. Copy of the communication of transfer was duly registered according to Rule 20 EPC.

With Telefax received 6 February 1991 (confirmed by letter of 9 February 1991) Opponent O1 withdrew his opposition.

- VII. The Appellant requests to delete the word "flat" in the claim and to maintain the patent with such an amended claim.

Reasons for the Decision

1. The Appeal is admissible. Since both Opponents withdrew their oppositions, the only request to be decided upon is the request of the new Appellant (VII above).
2. **Article 123(2) EPC**

The word "flat" related to "torsion spring" contained in the pre-characterising portion of granted Claim 1 is not to be found in the application as originally filed. Also, no information is identifiable there which would include such a term by technical implication. Therefore, this word represents added matter and results in the claim contravening paragraph (2) of Article 123 EPC.

The claim appears only acceptable if the word "flat" is deleted.

3. Conflict between Articles 123(2) and 123(3) EPC

3.1 The Opposition Division regarded deletion of the word "flat" in the granted claim as contravening Article 123(3) EPC, thus not allowable, and consequently revoked the patent. The Board is of the opinion, however, that it would be unjust to declare a patent invalid on ground of Article 100(c) EPC for the reason alone that an amendment introducing a limiting feature during prosecution with the approval or recommendation of the Office extended the subject-matter of the patent beyond the content of the application whilst the removal of the same feature is, on the other hand, to be prevented under Article 123(3) EPC.

In such cases a reasonable and justified interpretation of the two sub-articles (2) and (3) of Article 123 EPC is necessary. The conjunctive application of both paragraphs taken absolutely and independently one of the other would, however, lead to a paradox result ending in the revocation of the granted patent in such cases, a measure which the Board considers not appropriate and not intended by the Convention. The contradictory situation is then only avoidable if the two paragraphs are interpreted in their mutual relationship, i.e. one being applied as primary, i.e. independent, and the other as subsidiary i.e. dependent. Two alternative possibilities then arise:

- a) sub-article (2) is taken as independent, therefore the added feature is to be deleted in the granted claim notwithstanding sub-article (3) or

- b) sub-article (3) is taken as independent, therefore the added feature can remain in the granted claim notwithstanding sub-article (2).

The Board is of the opinion that when such scope limiting feature in a claim is irrelevant in respect of novelty and inventive step of the claimed subject-matter, the application of alternative b) appears appropriate and reasonable. This interpretation regards Article 123(3) EPC protecting third parties as crucial i.e. "absolute" compared with the consequences of an unsupported limitation, provided this does not influence decisively the assessment of the inventive step, i.e. no invention was belatedly created in contravention of Article 123(3) EPC. It is known that in practice disclaimers are allowed to restore novelty, without the disclaiming feature itself having been part of the content of the original disclosure. The purpose of such measures is to mitigate the consequences of situations which were beyond the real control of the applicant.

On the other hand, if a factually added feature in a claim is void of technical meaning within the given context, the above mentioned alternative a), i.e. deletion of such feature, would appear justified (cf. paragraph 3.5 below).

The above suggested interpretation appears to comply also with the principle expressed in the Protocol on the Interpretation of Article 69 EPC to ensure "a fair protection for the patentee with a reasonable degree of certainty for third parties".

- 3.2 In the present case the feature "flat" appears, at least prima facie, to be irrelevant to the question of novelty or inventive step since its position and any conceivable role relate to matters beyond the basic character of the

claimed subject-matter. This could then in principle be tolerated in view of the above.

The technical quality of the feature in question, however, also arises doubts regarding its factual contribution to the granted scope of protection.

Already the term "torsion spring" in itself appears to be problematic. This term means normally a spring under torsional stresses exerted by the applied forces. Such springs may have the form of straight bars having round or rectangular cross-sections subjected to a torque within the cross-section, or of coiled wires under elongating forces in the central longitudinal axis. It is evident that such springs would not be the ones a skilled person would think of, since they are hardly applicable in the given technical situation. Thus, the word "torsion" cannot be interpreted here as having its normal meaning.

Therefore, the expression "torsion" itself is not used in the patent for the purpose of defining the constructional type of a spring, but only as defining the functional meaning of the spring. As such, it determines a spring by which the roll-up-shaft is to be rotated so that the shaft itself may be subjected to torsional stresses. Such an interpretation is supported by the disclosure of the published patent specification since not the slightest information is available concerning any features defining the special constructional type or shape of the spring. Even the drawing does not show a spring as a structural component. The Board assumes therefore that the skilled person - hence the public - will definitely not understand "torsion" in the above mentioned normal sense, when reading the published patent, but will construe it necessarily as having a functional meaning only.

3.3 The adjective "flat" as such describes a geometric property. In the given context of "flat torsion spring" in the claim, however, "flat" appears prima facie lacking an unequivocal adequate technical meaning. As observed above, the sense of this expression is to be interpreted as: "flat spring for the purpose of rotating the shaft". The word "flat" to be used for defining a spring the construction of which is not specified at all appears disparate in relation to the factual context and of doubtful technical meaning.

Having regard to the description, the following findings arise: The adjective "flat" is present in the claim only, but neither mentioned nor implied elsewhere in the granted patent; it is thus not supported by the description. It was introduced during prosecution and appears only as part of the pre-characterising portion of the claim, evidently intended to specify the prior art. In document (2), referred to in the description, springs b3 and b4 (Fig. 1) having the shape of coils are merely schematically depicted. No constructional details are indicated. The adjective "flat" is, therefore, neither related to any feature essential to the characteristics of the invention nor to the prior art. It appears as superfluous and devoid of real meaning.

Since no technically comprehensive basis for "flat" is identifiable in the claim and in the description, speculative interpretation is encouraged. Any appropriate group of longer and shorter dimensions of the spring as a whole may be regarded as representing a "flat" torsion spring, as well as of any portion or section of it. However, each one among such various possibilities would appear as arbitrarily speculative and devoid of any reliable factual interpretation.

3.4 The above analysis results in the following:

The skilled person is not in a position to attribute a definite necessary technical function to the word "flat" in the contested claim. Since the function of the spring within the given technical situation is clear enough, the isolated and disparate geometrical term "flat" implies no applicable technical information to define in fact the spring. The skilled person will, therefore, necessarily disregard this term as superfluous and meaningless when understanding the text of the claim. In the given context, the factual technical-functional meaning of the term "flat" is, as well as its extension, to be regarded as zero. The extent of protection conferred by the claim is, therefore, independent of the presence or absence of the word "flat".

3.5 According to Article 69(1) EPC the extent of protection conferred by a European patent shall be determined by the terms of the claims. Following the Protocol on the Interpretation of Article 69, integrated in the EPC by Article 164(1), the terms of a claim are to be interpreted between two extreme positions: the strict, literal meaning of the wording used in the claims on the one hand - and what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated on the other. Consequently the extent of protection determined by a specific feature in a claim lies between the two extremes. In the view of the Board, this is achieved, if a specific feature in the claim is interpreted taking account of its technical meaning according to the description. It follows in particular: The extent of protection determined by a claim having a specific feature without any relevant technical meaning is independent of such a feature.

Since the extension of the term "flat" is to be regarded as zero, the deletion of "flat" in the granted claim does not influence the extent of protection of the granted claim and consequently cannot contravene Article 123(3) EPC. The deletion of the word "flat" in the claim is, thus, allowable and in accordance with alternative a) mentioned above under paragraph 3.1.

Order

For these reasons, it is decided

1. The contested decision is set aside.
2. The case is remitted to the first instance with the order to maintain the patent with the word "flat" in the claim to be deleted.

The Registrar

The Chairman



S. Fabiani



G. Szabo

