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File Number: T 921/90 - 3.2.3
Application No.: 83 301 345.1
Publication No.: 0 095 226
Title of invention: Convertible exercising apparatus

Classification: A63B 21/00

D E C I S I O N
of 14 April 1992

Proprietor of the patent: Brown Fitzpatrick Lloyd Patent Limited

Opponent: 01 Heinz Kettler Metallwarenfabrik GmbH & Co.
02 C.A.R.E. S.A.

Headword:

EPC Articles 54 and 56

Keyword: "Public prior use" -
"Novelty (yes); Inventive step (yes)"



Case Number : T 921/90 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 14 April 1992

Appellant :
(Proprietor of the patent)

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Respondent :
(Opponent 01)

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Decision under appeal :

Decision of Opposition Division of the European Patent Office taken on 4 October 1990 and forwarded on 15 October 1990 revoking European patent No. 0 095 226 pursuant to Article 102(1) EPC.

Composition of the Board :

Chairman : C.T. Wilson
Members : R.E. Gryc
L.C. Mancini

Summary of Facts and Submissions

- I. European patent No. 95 226 comprising seventeen claims was granted to the Appellant on 11 March 1987 on the basis of the European patent application No. 83 301 345.1 filed on 11 March 1983 claiming priority of 25 May 1982.

Claim 1 as granted reads as follows:

A portable free-standing physical exercising apparatus capable of use in a generally horizontal or generally upright position and adapted to be selectively used as a rowing machine or for performing other types of exercises, and having a frame (1), a pivoted movable lever operatively connected to said frame and having a handle (5) adapted to be grasped and moved by a user, resistance means (6) operatively coupled to said lever for providing resistance to the movement of said handle, a longitudinal track (9) attached to said frame, a seat (12) slidable along said track, means (11) for bracing the user's feet, a user support (15), and means (13, 13a) for firmly attaching said user support (15) to the apparatus substantially perpendicular to said frame such that when the frame is upright the user can grasp and move said handle while supported at least in part by said user support to stabilize the apparatus during exercise."

- II. By a decision of the Opposition Division taken at the oral proceedings of 4 October 1990 and notified by post on 15 October 1990 the patent was revoked. The Ground for revocation was lack of novelty of the subject-matter of patent Claim 1 in view of a prior used apparatus called "Beacon 3002" put on sale in the USA in April 1981 through document:

D1: Montgomery Ward Catalogue "Fall and Winter 81",
page 675, article 60C 25813 R.

In order to prove that the Beacon 3002 apparatus was publicly used in the upright position the Respondents presented the following documents:

D2: Deposition dated 17 August 1985 of John Kucera, a
~~buyer for Montgomery Ward,~~

D3: eidesstattliche Versicherung dated 2 March 1989 of
John Kucera, and

D4: Set of 41 photos filed on 19 May 1989 showing the
Beacon 3002 apparatus used in the vertical position.

The Appellant contradicted the Respondent's allegations and filed the following documents to support his argumentation:

D5: pages 55 and 56 of the decision dated 30 July 1987 of
the Federal Court of Canada,

D6: Affidavit dated 4 May 1989 of Eugene Weiss, brother
of the president of the firm that manufactured the
prior used apparatus, and

A videotape (D7) was filed on 11 May 1989 showing a
demonstration of the use of the Beacon 3002 apparatus
in the upright position.

III. The Appellant (Patentee) lodged an appeal on 28 November 1990 and paid the relevant fee the day before.

In his statement of grounds filed on 14 February 1991 he contended that the Opposition Division misinterpreted Claim 1 and that the prior used apparatus depicted in document D1 was never designed for use in the upright position as can be seen on D7 where the lack of stability

and the poor performance of the apparatus are clearly demonstrated.

Respondent 01 (Opponent 01) objected that Claim 1 was inadmissibly amended before grant (Articles 123(2) and 100(c)) as far as the following sentence is concerned:

"means for firmly attaching said user support" (see column 5, lines 55 and 56 of the European patent specification).

Both Respondents 01 and 02 referred to documents D1 and D4 to support the following contentions:

- the Beacon 3002 apparatus comprises all the features described in Claim 1;
- document D2 supplies demonstrations that this apparatus is stable enough for use in the upright position;
- the footrest of the known apparatus has an upholstery for use as a user support in the sense of the patent in suit.

Furthermore, they argued that it is irrelevant whether the known apparatus is designed or not for use in a vertical position. It suffices that its structure is identical to that of the apparatus according to Claim 1 and allows its use in an upright position.

IV. In a communication sent to the parties on 24 March 1992, the Board clearly stated that it could not put too much weight on the evidence represented by document D2 since it has never been proven to the satisfaction of the Board that the photos were taken before the priority date of the patent in suit and that the apparatus shown is a

sample of a genuine prior used Beacon 3002 device. As far as document D1 is concerned, the Board pointed out that no indication could be found therein which suggests that the apparatus shown was designed for use in the upright position.

The Board concluded that the state of the art closest to the invention was to be found in documents concerning ~~apparatus specifically designed to be used in the~~ horizontal and vertical positions such as documents:

D8: US-A-3 586 322

D9: GB-A-1 326 263

both cited in the search report.

- V. In reply, to support their contentions that in the autumn of 1980 the Beacon 3002 apparatus depicted in document D1 was demonstrated in both the horizontal and a free-standing upright position in the presence of John Kucera, Eugene Weiss, Carl Stroh (a buyer for Sears Roebuck, a firm that sold training apparatuses) and Leonard Weiss (president of the Beacon Enterprises Inc. which manufactured the prior used apparatus), the Respondents filed a new document:

D10: Deposition before a Notary public dated 19 July 1985 made by Leonard Weiss.

- VI. Oral proceedings took place on 14 April 1992.

The Appellant presented a list of questions to be answered by the Respondent according to which the main following points were emphasised:

- upright use of the Beacon 3002 apparatus is not mentioned either in the Montgomery Ward Catalogue or in the User Manual and the apparatus is shown nowhere in an upright position;
- to improve stability, the footrest of the Beacon 3002 apparatus should have been designed much longer with perpendicular orientation to the frame;
- the allegation of Leonard Weiss concerning the demonstration of the prior used apparatus in an upright position was contradicted by his own brother Eugene Weiss and also by Mr Carl Stroh, the buyer for Sears Roebuck;
- the testimony of Mr Kucera was found very weak by the Canadian court during an infringement process;
- the short legs of the prior used apparatus cannot give sufficient stability and do not allow the user to perform properly the conventional exercises with the apparatus in an upright position.

The Respondents contended first that Claim 1 was not clear as far as the expressions "capable of", "substantially perpendicular" and "during exercise" are concerned and needed to be interpreted.

Moreover, they argued mainly that:

- there was not enough space in the Ward catalogue to show the apparatus also in the upright position and the low interest of the customers for multi-purpose apparatuses explains why no brochure was printed;

- the essential thing is that legs are existing and, for some exercises, the support should not be exactly perpendicular to the frame;
 - Mr Kucera and Leonard Weiss clearly stated that the prior used apparatus was demonstrated vertically and neither Eugene Weiss nor Carl Stroh denied it; they just do not recall the fact;
-
- the catalogue of Montgomery Ward shows that the machine has front legs and can be thus used in an upright position even if the product may be inferior.

VII. At the end of the oral proceedings the Appellant requested that the patent be maintained as granted with the following amendments to Claim 1:

Line 3: Replace "or" by "and"

Line 6: Replace "a" by the words "at least one"

Line 19: Replace "by" by "on"

and corresponding amendments to the description in column 2, lines 43, 46 and 58.

The Respondents requested that the appeal be dismissed.

Reasons for the Decision

1. Admissibility of the appeal

The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.

2. Amendments of Claim 1

2.1 Before grant (Article 100(c))

In the application as filed, the user support (15) was described in Claim 1 as "connected to" the frame and the apparatus was characterised in Claim 6 by coupling means for "detachably coupling" said user support (15) to said frame.

The term "connected" is general and does not exclude any means of connection; moreover, the fact that claim 6 specifies that the means are detachable clearly shows that the term "connected" of Claim 1 covers both detachable and non-detachable coupling means.

In addition, it should be noticed that in the description of the application as filed (see page 4, lines 2 and 3 respectively 9 and 10) it is explicitly described that the socket member 13 is "secured" to the main beam and that the bench 17 is "securely pinned or bolted" to the socket member (see also the patent specification, column 4, lines 39 and 40 respectively 49 and 50).

Consequently, it appears clearly allowable to replace the general term "connected to" by the more restrictive "firmly attached" which is to be read as "securely connected to" in the light of the description, and thus to refer to the fixed angular relationship between the user support (15) and the frame (1) when the latter is configured for upright use (see Appellant's letter dated 4 June 1986). Claim 1 as granted has not been inadmissibly amended in contravention of Article 123(2) as objected to by Respondent 01 but on the contrary its subject-matter has been restricted in comparison with that of the original Claim 1 and remains in the content of the application as filed.

2.2 After grant (Article 123(2) and 3))

It is clear from the description and the drawings of the application as filed that the apparatus according to the invention is capable of being used in both the horizontal and vertical positions and not only in just one of them. Consequently, the replacement of the term "or" by "and" on line 3 of Claim 1 is justified and restricts the ~~scope of the protection since an alternative is~~ suppressed.

As described and represented on the drawings the apparatus comprises two pivoted movable levers, a left one and a right one and in Claim 1 of the application as filed, "at least" one handle was claimed. Therefore, to return to the text as originally filed is not objectionable in view of Article 123(2). Since, in the light of the description, the term "a" could not have been any way interpreted in the sense of "only one", this amendment also does not contravene Article 123(3).

The replacement of the term "by" by "on" clarifies the type of support the apparatus is provided with, said support being described as a "bench" (see col. 4, lines 48 and 53 and col. 5, line 10) i.e. a support for taking downwardly the weight of the user (see also Fig. 6a to d). The corresponding amendments have been made in the description to adapt it to the claims.

The Board is satisfied that none of the above-mentioned amendments contravenes Article 123(2) and (3) EPC.

3. Interpretation of Claim 1

In the context of the description, the following expressions should be interpreted accordingly:

3.1 Capable of use: Applied to an exercising apparatus, this expression clearly means "capable of being used in a normal, stable and secure way while generally recognised exercises are being performed on it".

3.2 "User support" (lines 54-56 and 60)

This support is described as a bench in the specification (cf. col. 4, lines 48, 53, 58, 61 and col. 5, line 10) and it is clear from the Figures 2, 3 and 6a-e that the function of this element is to support from underneath the user sitting, lying or standing on it.

3.3 "Substantially perpendicular" (line 57)

This expression means that the user support is attached to the apparatus so as to extend in a direction making an angle of 90° with the frame with the usual manufacturing tolerances generally accepted on this type of apparatus or so near to 90° that the intended result is still obtained, viz. so that the user support allows use of the apparatus in an upright position in a normal, stable and secure way.

3.4 "during exercise" (line 61)

It is clear from the description that the apparatus according to the invention is adaptable so that a range of different exercises are possible (cf. col. 2, lines 35-39) when the frame is upright (cf. Figs. 6a-d). The expression "during exercise" is therefore to be interpreted as "while exercising" i.e. when performing a range of conventional exercises and not only a specific one.

4. The public prior use

It cannot be contested that in the autumn of 1980, i.e. prior to the priority date of the European patent, document D1 made available to the public an hydraulic rower represented in a horizontal position on the three corresponding photos of the catalogue.

~~According to the short accompanying description, this~~ prior apparatus comprises a padded footrest that doubles as a back rest and it can be seen on the photos that short legs substantially perpendicular to the frame are provided at both ends of the rowing board.

The photos of document D1 also clearly show that the footrest/backrest is not perpendicular to the rowing board but has some inclination thereto.

Concerning now the question of whether or not the use of this piece of apparatus in an upright position has been made available to the public at the relevant date, it has been established that there is no prepublished record, in the form of photographs or manuals showing the so-called Beacon 3002 rower for use in the upright position and there is also no written description of such use.

The only indications in favour of the existence of such a use come from documents D2, D3 and D10 wherein the authors, John Kucera and Leonard Weiss, both contend that the Beacon 3002 apparatus put on sale through document D1 was indeed demonstrated in the upright position in the autumn of 1980 before themselves and Eugene Weiss and Carl Stroh.

Nevertheless, it should be borne in mind that long intervals of time (5 years and 9 years respectively) took place between the alleged demonstration and the deposition

of the witnesses (see documents D2, D10 and D3 respectively) and that meanwhile the witness had the opportunity of seeing an embodiment of the apparatus according to the impugned patent at the Chicago Show in 1983 (see document D6, paragraphs 12 and 14). Moreover, on page 55 of document D5 it is stated that Carl Stroh, who was designated as witness by Leonard Weiss in his deposition (see pages 48 and 50) could not recollect the exercising apparatus being demonstrated in a vertical position and, in paragraph 10 of document D6, Eugene Weiss also designated as witness by Leonard Weiss explicitly stated that he did not recall any form of vertical demonstration of the Beacon 3002 apparatus to John Kucera or anybody else. Indeed, he went further to say "Had it happened I would have certainly remembered because it would have been something different and new - it would have been an additional feature of importance".

The above-mentioned considerations and contradictory allegations must be considered by the Board, and weighed against the depositions of John Kucera and Leonard Weiss. They introduce into the proceedings such a high degree of uncertainty that the Board cannot consider the alleged prior use in a vertical position as being sufficiently proven to be taken into consideration when considering the patentability of the subject-matter of the impugned patent.

5. The state of the art (Article 54(2))

In the present case, the state of the art taken into consideration by the Board is thus composed by the teaching of all the patents and brochures cited during the proceedings and in particular documents D1, D8 and D9 but not by the alleged prior demonstration of the Beacon 3002 apparatus in the upright position.

6. Novelty

The main objection raised by the Respondents against the grant of the impugned patent is lack of novelty against the Beacon 3002 apparatus depicted on document D1.

The Board cannot follow this argumentation for the following reasons:

- 6.1 It appears clearly from the photos of document D1 that the backrest is not "substantially perpendicular" to the frame as specified in Claim 1 within the meaning given in section 3.3 above, but extends obliquely thereto. Indeed, the backrest/footrest must be inclined (at 116° or 64°) to perform its proper function.

For this first reason alone the subject-matter of Claim 1 is already to be considered as novel compared to the Beacon 3002 apparatus depicted in document D1.

- 6.2 Moreover, as already stated under section 4, document D1 gives absolutely no indication or hint which suggests that the Beacon 3002 apparatus can be used in another position other than the horizontal one. This known machine looks like a usual rowing apparatus whose usual working position is having its frame substantially parallel to the floor (see photos). This is confirmed by the fact that it comprises supporting feet perpendicular to its frame; since supporting feet are generally oriented substantially vertically, the normal position of the frame presumably should be horizontal.

The provision of a cushion on the footrest is justified by the fact that it has also the second function of a backrest; the interpretation according to which it can be

used as a support in the sense of the invention (see section 3.2) is not supported by any indication and appears to be the result of ex post facto analysis.

Consequently, nothing in document D1 permits the conclusion that the Beacon 3002 apparatus has been designed for use in both the horizontal and vertical positions and even if it can be used in these positions, the Respondent failed to prove that it is capable of such a use in the meaning of the invention (see section 3.1 above).

- 6.3 Finally, document D1 gives no indication that the footrest/backrest of the known apparatus is a support in the meaning of the invention (see section 3.2).

Therefore the exercising apparatus called "Beacon 3002" depicted in document D1 does not destroy the novelty of the subject-matter of Claim 1. Since among the other cited documents, none of them discloses in combination all the features of Claim 1, its subject-matter should be considered as novel in the meaning of Article 54(1) EPC.

7. The closest state of the art

- 7.1 Since the Beacon 3002 apparatus is not capable of use in horizontal and vertical positions (see above section 6.1) in the sense of the invention, document D1 does not appear to describe the prior state of the art closest to the invention.

Such prior art can only be found in documents such as D8 and D9 concerning apparatuses expressly designed to be used horizontally as a rowing machine and vertically for performing other exercises and, among these documents, D8 appears to describe the closest prior art.

The apparatus according to Claim 1 differs from it in that it is free-standing in both horizontal and vertical positions and not only in the horizontal one; in that it comprises at least a pivotable resisting lever instead of a system of springs, cables and pulleys; and in that means for bracing the user's feet are provided together with a user support firmly attached to the frame in a perpendicular direction.

8. The problem and the solution

When starting from the above-mentioned closest prior art, the problem to be solved by the person skilled in the art appears to be as set out in column 2, lines 35-39 of the patent. That is, the provision of a simple and compact exercising apparatus which is adaptable so that a range of different exercises including rowing exercises are possible with one machine.

The Board is satisfied that the subject-matter of Claim 1 solves the said problem.

9. Inventive step

It should be noticed and emphasised first that absolutely no hint can be found in the background art for using an exercising apparatus in a free-standing upright position. According to the teaching of all the cited documents, the training apparatus should be used either lying on the floor for use in the horizontal position or fixed on a wall (see documents D8 and D9) for use in the upright position. A priori, it seems unthinkable to use such an exercising apparatus vertically without being fixed when consideration is taken of the not inconsiderable forces exerted by the user on the machine.

Consequently, alone the idea of using a free-standing apparatus in the upright position is already indicative of an inventive step per se.

Moreover, it is to be noticed that the known versatile training apparatuses capable of being used in an upright position are usually equipped with sets of tension springs and cables (see documents D8 and D9). The use of pivoted movable levers appears to be reserved for conventional rowing apparatuses lying in a horizontal position and to combine resisting pivoted levers to a free-standing frame is suggested nowhere in the prior art. Such a combination contrary to the teachings of the background art documents thus implies also an inventive step per se.

Finally, to provide a user support firmly connected perpendicularly to the frame so that the user's weight can be used to stabilise the apparatus during exercising in the upright position is suggested in none of the documents cited during the proceedings. On the contrary, as already mentioned above, according to the teaching of the documents relating to vertically used training apparatus, the stabilisation of the device is obtained through the fixing means of the frame to the wall. In the absence of any hint in the prior art, it would not be obvious for the skilled person to abandon said conventional attaching means and to use the user's own weight for stabilisation.

The aforementioned reasons lead the Board to the conclusion that the subject-matter of Claim 1 implies an inventive step in the sense of Article 56 EPC and is patentable according to Articles 52 and 102(3) EPC.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent as granted with the following amendments:

to Claim 1:

- Line 3, "or" is replaced by "and",
- Line 6, "a" is replaced by "at least one",
- Line 19, "by" is replaced by "on";

to the description:

the same amendments to column 2, lines 43, 46 and 58 respectively.

The Registrar:



N. Maslin

The Chairman:



C.T. Wilson

R. G.
R. G.