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File Number: T 251/91 - 3.2.3

Application No.: 86 309 369.6

Publication No.: 0 228 822

Title of invention: Shutter

Classification: E06B 9/08

D E C I S I O N  
of 22 October 1992

Applicant: Bolton Brady Limited

Headword:

EPC Articles 87, 88; Rule 67

Keyword: "First disclosure - right to priority - novelty test"  
"Refund of appeal fee (refused)"



**Case Number : T 251/91 - 3.2.3**

**D E C I S I O N  
of the Technical Board of Appeal 3.2.3  
of 22 October 1992**

**Appellant :** Bolton Brady Limited  
Bowling Old Lane  
Bradford  
West Yorkshire BD5 7JP (GB)

and

Turton Street  
Bolton BL1 2SP (GB)

**Representative :** Healy, Cecilia Patricia  
33 Prince of Wales Road  
Coventry CV5 8GR (GB)

**Decision under appeal :** Decision of Examining Division 2.3.03.109 of the  
European Patent Office dated 3 October 1990,  
posted on 8 November 1990 refusing European  
patent application No. 86 309 369.6 pursuant to  
Article 97(1) EPC.

**Composition of the Board :**

**Chairman :** C.T. Wilson  
**Members :** F. Brösamle  
L. Mancini

**Summary of Facts and Submissions**

- I. The Appellant's European patent application No. 86 309 369.6 was filed on 2 December 1986 claiming priority of 24 December 1985 from GB-8 531 813 - (D2) in the following.
- II. With decision of 3 October 1990, dispatched in writing on 8 November 1990, the Examining Division refused the application according to Article 97(1) EPC since it was felt that (D2) was not the first disclosure of the subject-matter of Claim 1 filed with letter of 15 June 1988, received on 23 June 1988, and reading as follows:

"1. A roller shutter comprising a roller mounted vertically and comprising an inner shaft and an outer tube; a shutter curtain adapted to be wound on said outer tube in a withdrawn condition; and horizontal guide means for the curtain;

characterized in that

resilient tensioning means for the curtain (10) are disposed between the inner shaft (18) and the outer tube (19) of the roller (17); and in that drive means (21) are provided, having driving engagement (22) with the curtain (10) to drive the curtain along the guide means (14) between the withdrawn condition and an extended condition in which it is unwound from the roller (17), and also having driving engagement with the inner shaft (18), the shutter curtain (12) and inner shaft (18) being simultaneously driven so as to retain the tension of said resilient tensioning means substantially constant irrespective of the degree of opening or closing of the curtain."

- III. The Examining Division in their decision to refuse the application argued that GB-A-2 172 327 based on GB-application No. 8 506 345 filed on 12 March 1985 - (D1) in the following - was "the first document disclosing the subject-matter of Claim 1 ... and that, consequently, the claim to (D2) as the priority document fails".
- IV. On 2 January 1991, the Appellant (Applicant) filed a notice of appeal against that decision, paying the appeal fee on the same day. The Statement of Grounds of Appeal was filed on 5 March 1991.

The Appellant points to the fact that his "Appendix 6" filed with the Statement of Grounds of Appeal is a certified copy of British Patent Application 8 506 345 as filed on 12 March 1985. The claims and an abstract were filed at a later date i.e. on 25 February 1986, and 13 March 1986 for the formal drawings. "Appendix 6" should therefore be considered as the document relevant for finding a correct answer to the question of first disclosure. Reading "Appendix 6" without the benefit of hindsight and of later amendments to it leads to the result that it relates to horizontally operating escalator type shutter curtains and not to shutter curtains more generally. On page 2 of "Appendix 6" it is pointed out "According to the present invention ... intended for use in horizontally operating escalators..." so that there cannot be any doubt that this document deals with a roller the axis of which is arranged horizontally.

The Appellant comes to the conclusion that the findings of the impugned decision are incorrect so that the Board of Appeal should reverse the decision and grant a patent on the basis of documents underlying the impugned decision (main request) or on the basis of claims according to

"Appendix 8" and "Appendix 9" filed with the Statement of Grounds of Appeal as first and second auxiliary requests.

Without giving specific reasons the Appellant requests that the application be reinstated with refund of the appeal fee.

### Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is admissible.

2. Main request

2.1 This request contains ten claims, Claim 1 being the only independent claim. In Claim 1 a roller shutter is defined which comprises a vertically mounted roller. Such vertical rollers are known from US-A-3 490 514 and US-A-2 934 139. What is claimed as novel and inventive in combination with a roller shutter according to the features of the precharacterising clause of Claim 1 is a drive and tensioning means for the roller and curtain as defined in the characterising clause of Claim 1.

2.2 It has now to be assessed whether or not the refused application can validly claim priority from document (D2). That is to say whether (D2) is the first disclosure of the subject-matter claimed in present Claim 1, or whether this subject-matter had in fact already been disclosed in (D1), its original version being in the form of "Appendix 6".

2.3 "Appendix 6" discloses a roller shutter for use in horizontally operating escalators, see page 1, first paragraph and page 2, lines 2 to 4. The orientation of the roller is therefore horizontal.

In contrast thereto present Claim 1 relates to a roller shutter whose roller is oriented vertically. Beside the differing orientation of the roller axis in "Appendix 6" and in present Claim 1 there is no further difference between these two shutters. However, it is clear that the subject-matter of "Appendix 6" does not destroy the novelty of the shutter according to present Claim 1, Article 54 EPC, since the vertical orientation of the roller is not known from "Appendix 6".

- 2.4 The novelty test therefore leads to the result that prima facie two distinct inventions are disclosed in "Appendix 6" and in present Claim 1.

The distinguishing feature clearly is a technical feature whose importance is obvious since in the one case gravity plays no role when winding and unwinding the curtain, whereas in the other case gravity has to be considered when dimensioning the winding/unwinding drive means of the roller and curtain respectively.

- 2.5 From "Appendix 6", see page 1, first paragraph, one could derive from the text "This invention relates to shutter curtains" a general disclosure as to shutter curtains irrespective of the orientation of the roller axis. Even if, however, this interpretation of "Appendix 6" is followed then novelty of the subject-matter of present Claim 1 is not destroyed when applying the principles laid down in the "Guidelines", C-IV, 7.4, ("metal" as a general disclosure is not novelty-destroying to "copper" as a specific disclosure), so that even this statement of "Appendix 6" is irrelevant as far as novelty of the subject-matter claimed is concerned.

- 2.6 Summarising the above observations, "Appendix 6", forming the originally filed version of (D1), cannot destroy the novelty of the disclosure of present Claim 1.
- 2.7 It has now to be decided whether under these circumstances (D2) validly can form a priority document for the subject-matter of present Claim 1. In this respect the following has to be observed:
- 2.7.1 Claiming priority is a question of novelty as is set out in the decisions T 116/84 of 3.2.1 dated 28 November 1984 and T 184/84 of 3.3.1 dated 4 April 1986, (see also "Singer - Europäisches Patentübereinkommen, Carl Heymanns Verlag KG-Köln-Berlin-Bonn-München", page 315, remark "3").
- 2.7.2 From the above decisions and from "Singer" it is clear that for the question of first disclosure the principles of the novelty test have to be applied, i.e. it has to be decided whether any document prior to the document whose priority is claimed can be seen as a novelty destroying document.
- 2.7.3 In summary therefore, it can be seen from the above findings that "Appendix 6" (or (D1)) does not destroy the novelty of present Claim 1 since the vertical roller axis is a distinguishing feature of the claim which is clearly related to the function and effect of the invention and cannot therefore be ignored, see paragraph 2.5 above, (T 73/88, OJ EPO 1990/05), and "Appendix 6" cannot therefore form the priority document for the present application.
3. Document (D2) on the other hand, discloses a roller shutter having a roller mounted vertically and all other features of the present Claim 1. It therefore discloses a

different invention for the first time and can, consequently, act as a document whose priority can be validly claimed.

For these reasons, it is decided that the present application can validly claim the priority of (D2) so that the main request is allowable in this respect.

4. The substantive examination of the application is not yet completely carried out by the Examining Division so that the Board remits the case back to the first instance for further prosecution in order not to deprive the Appellant from having his case dealt with in two instances, Article 111(1) EPC.

5. Auxiliary requests

The main request already being allowable, as far as the right to a priority claim is concerned, the auxiliary requests need not be dealt with in detail by the Board since the application has to be remitted to the Examining Division for further prosecution.

6. The Appellant - without giving detailed arguments - has requested that the appeal fee be reimbursed.

In principle such reimbursement is due in cases in which the proceedings suffer from a substantial procedural violation.

The Board cannot recognise such a substantial procedural violation in the present case. The impugned decision and the preceding proceedings show that the Examining Division clearly has prepared its negative decision to the Appellant so that the requirements of Article 113(1) EPC are met. The impugned decision moreover enables the reader



to follow a line of arguments for not allowing (D2) as a valid priority document. Whether these reasons are convincing and have to be followed by the Board or not is another question and has nothing to do with a substantial procedural violation.

The preconditions for a reimbursement of the appeal fee are therefore not fulfilled in the present case, so that the request in this respect has to be rejected, Article 67 EPC.

**Order**

**For these reasons, it is decided that:**

1. The contested decision is set aside.
2. The case is remitted to the Examining Division for further prosecution.
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:



N. Maslin

The Chairman:



C.T. Wilson