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**D E C I S I O N**  
**of 18 July 1994**

**Case Number:** T 0459/93 - 3.2.3

**Application Number:** 84201124.9

**Publication Number:** 0135221

**IPC:** E04D 5/12

**Language of the proceedings:** EN

**Title of invention:**  
Roofing-material

**Patentee:**  
CBL Consolidated Ltd, Basel

**Opponent:**  
vdd Industrieverband Bitumen-Dach-und Dichtungsbahnen e.V.

**Headword:**  
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**Relevant legal norms:**  
EPC Art. 56, 100

**Keyword:**  
"Inventive step denied (obvious combination of documents)"  
"Amendments not necessitated by grounds of opposition".

**Decisions cited:**  
T 0127/85

**Catchword:**  
-



Case Number: T 0459/93 - 3.2.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.3  
of 18 July 1994

**Appellant:** vdd Industrieverband Bitumen-Dach-und  
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**Respondent:** CBL Consolidated Ltd., Basel  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office dated 4 March 1993 posted  
on 23 March 1993 rejecting the opposition filed  
against European patent No. 0 135 221 pursuant to  
Article 102(2) EPC.

**Composition of the Board:**

**Chairman:** C. T. Wilson  
**Members:** F. Brösamle  
W. Moser

### Summary of Facts and Submissions

I. European patent No. 0 135 221 was granted with Claims 1 to 6 on 8 May 1991.

II. Claim 1 thereof reads as follows:

"1. A process for covering a roof comprising the steps of covering a substratum on said roof with roofing material consisting of a bitumized carrier having a non-sticking lower surface and being provided with perforations, followed by the step of applying to this roofing material an upper layer consisting of a carrier which is bituminized with modified bitumen, characterized in that in said first step a roofing material is used comprising a carrier which is bituminized with modified bitumen, the perforations in said carrier being so large that in the second step by using a torch the upper layer is made to adhere to the substratum via the perforations."

III. An opposition filed against the patent in suit was rejected by the Opposition Division on 4 March 1993, whereby the written decision was posted on 23 March 1993.

IV. The Opposition Division came in its decision pursuant to Article 102(2) EPC to the result that (even) in the light particularly of the documents

(D2) GB-A-1 083 845

(D11) DE-A-3 145 266 and

(D13) Publication titled, "Richtlinien für die Planung und Ausführung von Dächern mit Abdichtungen", Issue January 1982, Verlagsgesellschaft Rudolf Müller GmbH, Köln, pages 15, 17, 18 and 20,

the subject-matter of granted Claim 1 has to be seen as non-obvious in the meaning of Article 56 EPC so that the attacked patent was upheld unamended.

V. The Appellant (Opponent) with letter of 14 May 1993, received on 17 May 1993, lodged an appeal against the decision of the Opposition Division and paid the fee on the same day. The Statement of Grounds of Appeal was received on 30 July 1993 (Telefax). It was argued that the subject-matter of granted Claim 1 is obvious in the light of documents (D2), (D11) and (D13).

VI. Following a communication of the Board pursuant to Article 11(2) RPBA dated 18 May 1994 the Respondent (Proprietor) filed new documents and requested, (see letter received on 17 June 1994), to set aside the impugned decision and to maintain the patent in amended form on the basis of:

(a) Main request:

- Claim 1 as granted
- Figure 1 as granted
- Description as received on 17 June 1994.

(b) Auxiliary request:

- Claim and description as received on 17 June 1994 in combination with Figure 1 as granted.

VII. The claim according to the auxiliary request reads as follows:

"A process for covering a roof, comprising a first step of covering a substratum on said roof with a first layer of roofing material, consisting of a bitumized carrier having a non-sticking lower surface and being provided with perforations, followed by a second step of

applying to this first layer a second layer of roofing material which is fixed to the substratum by means of molten bituminous material which penetrates through the perforations of the first layer to the substratum and thus fixes the second layer thereto, characterized in that the first layer is bitumized with modified bitumen and the second layer is also bitumized with modified bitumen, the perforations in the first carrier being so large that in the second step by using a torch the second, upper layer is made to adhere to the substratum via the perforations."

- VIII. It was held by the Respondent that the subject-matter of the above independent claims is non-obvious, since modified bitumen though known in the art was not used in combination with roofing-material before the priority date of the attacked patent.

It was moreover held that the problem as set out in the patent as granted does not contain a hint to the solution thereof.

With telefax of 7 July 1994 the Respondent informed the Appellant and the Board that he would not attend the oral proceedings to be held on 18 July 1994 and that the decision should be based on the requests on file.

- IX. In the oral proceedings of 18 July 1994 in which the Respondent though duly summoned did not appear (as communicated to the Appellant and to the Board) the Appellant upheld his request to revoke the patent be it on the basis of the main or the auxiliary request.

His arguments can be summarised as follows:

- From document (D2) a two-layer roofing-material is known, one layer thereof being perforated so that bitumen can pass and can adhesively bond the roofing material to the underlying substratum;
- the only differences between the subject-matter claimed and document (D2) are seen in the choice of a modified bitumen instead of a "bituminous material" as in document (D2) and in the way in which the roofing material is applied to the substratum;
- from document (D2) it is known that the bituminous material and its reinforcement are brittle, see page 1, line 63 to page 2, line 2 thereof;
- document (D11) seeks to improve this situation by prescribing the use of **modified** bitumen - unknown before the seventies - instead of blown bitumen and the use of, for example, organic fibres; both features enhance the elasticity of the roofing-materials as a whole and contribute to a better product;
- from document (D13), see page 15 and particularly column 7 of the table thereon titled "Polymer-Bitumen-Schweißverfahren", it is known to either use a pouring or welding process for applying roofing-material to a substratum so that choosing the welding process as claimed according to the present claims is no more than making the choice between only two possibilities;

- since document (D13) already discloses modified bitumen in combination with the welding process this document could and would be combined by a skilled person with the teachings of documents (D2) and (D11) so that no invention can be seen in the claimed roofing process.

### Reasons for the Decision

1. The appeal is admissible.
2. *Main request*
  - 2.1 The only claim of this request is Claim 1 in its granted form. Since no objections under Article 123(2) and under Article 54 EPC have been raised, it is not necessary to discuss these items in any detail. The crucial question is therefore the issue of inventive step.
  - 2.2 The Board comes to the following result in this respect:
    - 2.2.1 Starting point of the invention is the process for covering a roof using the roofing material known from document (D2), namely a perforated layer having a non-sticking lower surface, which is applied to the substratum and which is covered by a further layer. The holes of the perforated layer allow the cover layer to adhere to the substratum by means of bitumen poured onto the perforated layer. The presence of the distributed holes and the non-sticking lower surface provides a discontinuous adhesion of the roofing material to the

substratum which allows water vapour - if present- to freely escape from under the perforated layer without deteriorating the adhesion of the roofing-material to the substratum.

2.2.2 The subject-matter of Claim 1 seeks to improve the known roofing process by allowing a bitumen with better characteristics than the known blown bitumen to be used for the complete roofing; such a bitumen is a modified bitumen as exemplified in EP-B1-0 135 221, see column 2, lines 15 to 19.

2.2.3 Claim 1 is therefore characterized by the features that in a first step a roofing material bituminized with modified bitumen is used which is covered by a layer also bituminized with modified bitumen by using a torch to adhere the upper layer to the substratum via the perforations.

2.2.4 The Board and the Respondent were of different opinions whether or not the object of the invention as worded in the patent specification, see column 2, lines 12 to 25 of EP-B1-0 135 221, already contains a hint to the claimed solution thereof. In the absence of Respondent's representative in the oral proceedings before the Board, the Board was bound to the documents filed by the Respondent as main and as auxiliary request, (see letter received on 17 June 1994), in which documents the object to be solved appears to be to develop a process in which modified bitumen is used for the complete roofing.

2.2.5 According to the subject-matter of claim 1 two layers of roofing material are superposed and applied to a substratum by a welding process ("using a torch") via holes in the perforated (lower) layer of roofing



material. Both layers are bituminized with modified bitumen, thus making use of its advantageous characteristics.

2.2.6 It has now to be assessed whether or not the process claimed in Claim 1 is based on an inventive step within the meaning of Article 56 EPC. The relevant documents in this context are documents (D2), (D11) and (D13) as already emphasized in the Board's communication pursuant to Article 11(2) RPBA. The Board follows in principle the chain of arguments as presented by the Appellant.

2.2.7 The subject-matter of Claim 1 differs from the disclosure of document (D2) in that:

(a) all layers used are bituminized with modified bitumen and

(b) a welding process is the process for adhering the layers to the substratum.

2.2.8 Feature (a) merely specifies further the more general term of document (D2) namely "bituminous material", see page 1, lines 54 to 55 thereof, and feature (b) constitutes no more than the choice of one of the two well known alternatives for applying a roofing material to a substratum, namely by a pouring process or by a welding process.

2.2.9 The Appellant pointed to the fact that modified bitumen was not available in 1967 when document (D2) was published, and that document (D11) could be seen to relate to a consequent improvement of difficulties reported in document (D2), namely the frigidity and brittleness of glass tissue, see page 1, line 63 to page 2, line 2 thereof. According to document (D2) these

difficulties are overcome by the provision of fibres with **higher elasticity** such as animal and/or vegetable fibres or flexible asbestos fibres.

- 2.2.10 In document (D11), see page 2, paragraph 4, this improvement of document (D2) is referred to by mentioning mineral fibres or organic fibres as a possibility to improve the quality of bituminous roofing material.

Document (D11) is, however, not restricted to the improvement of fibres used in combination with roofing material since it also contains the teaching that in this context a **modified** bitumen instead of the bituminous material mentioned in document (D2) produces outstanding effects namely by consequently improving the elastic behaviour of the roofing material, see document (D11) page 4, lines 4 to 17 and Claim 1, where it is set out that the modified bitumen in combination with elastic fibres produces a reasonable elastic behaviour of the roofing material.

- 2.2.11 Without the exercise of inadmissible hindsight documents (D2) and (D11) can be combined since both documents deal with the improvement of the elasticity of the roofing material. A skilled person could and would have made the step to use modified bitumen - the elastic behaviour thereof being known from document (D11) - in combination with roofing material as soon as it was available on the market.

Using modified bitumen in combination with roofing material can therefore only be seen as a logical step within the general attempt of improving roofing material without the exercise of inventive endeavour.

- 2.2.12 What remains to be assessed in the context of using a roofing material being completely based on **modified** bitumen is the question whether or not it is inventive to apply a welding process when adhering the two layers of roofing material to the substratum.
- 2.2.13 In document (D13) it is clearly indicated, see page 17, remarks 6.2.1 and 6.2.2, that the methods available in this context can be either pouring or welding ("using a torch") so that the choice of the welding process as claimed is nothing other than the choice between only two alternatives. That the application of a welding process is not at all surprising in combination with a layer covered by **modified** bitumen is clearly acknowledged in document (D13), see the table on page 15, column 7, entitled "Polymer-Bitumen-Schweißbahn". The term "Polymer-Bitumen" is nothing less than a synonym for a modified bitumen as claimed in Claim 1. The term "Schweißbahn" clearly relates to the welding process.
- 2.2.14 The skilled person would therefore immediately derive from document (D13) the teaching that a welding process can be used in combination with layers covered with modified bitumen so that there is also a direct link to the teaching of document (D11) in which roofing material using modified bitumen is disclosed. Another approach demonstrating that the use of a welding process would be obvious is the fact that in all cases where a bitumen-heater is a nuisance the choice of a welding process would be readily available for a skilled person knowing document (D13).
- 2.2.15 As a result of the foregoing observations Claim 1 does not contain inventive subject-matter since the documents (D2), (D11) and (D13) seen in combination render it

obvious, Article 56 EPC. Claim 1 is therefore not valid and the main request not allowable.

3. *Auxiliary request*

3.1 The single claim thereof is cast in two-part form based on the disclosure of document (D2).

3.2 Apart from recasting this claim in a differing two-part form from granted Claim 1 according to the main request, this claim is identical in its teaching with granted Claim 1 so that a non-valid Claim 1 as granted can only result in the same findings in respect to the claim according to the auxiliary request.

3.3 Moreover, the modification of the claim according to the auxiliary request is not caused by the grounds of opposition as defined in Article 100 EPC. The rewording of an independent claim without changing its scope of protection can only be seen as tidying up, not allowable in opposition/appeal proceedings, see decision T 127/85 published in OJ EPO 1989, 271.

3.4 As a consequence of the foregoing observations the single claim of the auxiliary request is also not valid and the auxiliary request is therefore rejected.

4. No allowable request being on file the patent EP-B1-0 135 221 cannot be upheld in the forms requested by the Respondent.

5. In the above reasons of the decision no arguments are used which were not known to the Respondent. The negative findings of the Board are only based on documents (D2), (D11) and (D13) which documents were indicated in the Board's communication pursuant to

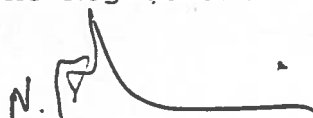
Article 11(2) RPBA as relevant in respect of the assessment of inventive step, see in particular remark 5, thereof. Article 113(1) EPC is therefore complied with in spite of the absence of the Respondent from the oral proceedings.

**Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:



N. Maslin

The Chairman:



C. T. Wilson

