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**D E C I S I O N**  
of 19 March 1996

**Case Number:** T 0035/94 - 3.2.3

**Application Number:** 87304990.2

**Publication Number:** 0249411

**IPC:** F27B 9/38, F27D 3/00

**Language of the proceedings:** EN

**Title of invention:**  
Improvements in or relating to kilns

**Patentee:**  
British Ceramic Service Company Limited

**Opponent:**  
Riedhammer GmbH & Co. KG

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 104(1), 111(1)

**Keyword:**  
"Decision re appeals - remittal (yes)"  
"Costs - apportionment (no)"

**Decisions cited:**  
T 0273/84

**Catchword:**  
-



Case Number: T 0035/94 - 3.2.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.3  
of 19 March 1996

**Appellant:**  
(Proprietor of the patent) British Ceramic Service  
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**Respondent:**  
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**Representative:**  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 26 November 1993  
revoking European patent No. 0 249 411 pursuant to  
Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** C. T. Wilson  
**Members:** H. Andrae  
L. C. Mancini

### Summary of Facts and Submissions

- I. European patent No. 0 249 411 was granted on 23 January 1991 on the basis of European patent application No. 87 304 990.2 filed on 5 June 1987.
- II. With Notice of Opposition filed by telefax on 22 October 1991, the Respondent (Opponent) requested revocation of the patent on the basis that its subject-matter did not fulfil the requirement of inventive step.

In support of the opposition the following documents were cited:

D1: DE-A-3 243 695 (▲ GB-A-2 113 639), and

a prior use, Riedhammer-Hutschenreuther, supported by drawing No. 54.0.02183 dated 20 May 1985 (Appendix 0 submitted by telefax on 22 October 1991).

After expiry of the nine-month opposition period the following further documents were cited by the Respondent:

D2: Brunklaus: "Industrieöfen Bau und Betrieb" 4th edition, 1979, pages 650, 651

D3: US-A-1 490 396

D4: Letter addressed to Action International, Sabin Industries Inc., Mount Clemens, Michigan (US), written by R. Baker of Dryton Kiln Co., Stoke on Trent (GB) and dated 9 January 1986, together with a copy of Drawing No. P 1557, filed on 30 June 1993 with the letter dated 29 June 1993

D5: A tender and Specification, dated 12 July 1985, from Drayton Kiln Co. (R. Baker) to Royal Doulton Tableware Ltd., Stoke on Trent (GB), filed on 15 July 1993 with the letter dated 13 July 1993.

- III. By decision dated 26 October 1993 and posted with written reasons on 26 November 1993, the Opposition Division revoked the patent. According to the decision, the subject-matter of claims 1 and 4 according to both the main request and the auxiliary request was novel, but did not involve an inventive step in the light of the document (D1).
- IV. The Appellant (Patentee) lodged an appeal against this decision on 20 January 1994, the appeal fee being paid on 21 January 1994. The Statement of Grounds of Appeal was filed on 24 March 1994.
- V. In the communication pursuant to Article 110(2) EPC dated 10 November 1995, the Board set out its provisional opinion that the subject-matter of granted Claims 1 and 4 would not seem to be obvious in the light of (D1), but that the subject-matter of granted Claim 4 of the category "method" would not seem to be maintainable with regard to the disclosure of (D3) due to the absence of an inventive step.

Furthermore, the Board pointed out that the alleged public prior uses according to (D4) and (D5) appeared to be relevant to the subject-matter claimed and as these documents had not been examined by the first instance, the Board would consider it appropriate to remit the case for further prosecution.

In respect of the Appellant's request that costs should be awarded against the Respondent for an alleged abuse of the proceedings with regard to the late filing of the

alleged prior public uses, the Board held that no such abuse could be recognised since these objections were submitted a sufficient time in advance of the oral proceedings before the first instance so that the request for award of costs would probably have to be rejected.

VI. In reply to the Board's communication the Appellant maintained the independent Claims 1 and 4 in the version as granted according to the main request and submitted a new Claim 4 according to an auxiliary request.

If the Board's decision accords with the provisional opinion outlined in the Board's communication, the Appellant requests that the matter be remitted to the Opposition Division with regard to the allegations of public prior use. He argued that his letters and respective enclosures of 7 and 11 October 1993 make it quite clear that the subject-matter of the patent in suit was not made available to the public in any way before the priority date and accordingly the patent should be maintained, perhaps with the amendment to claim 4 according to the auxiliary request.

The independent Claims 1 and 4 according to the main request are worded as follows:

"1. A kiln assembly including a plurality of wheeled car assemblies (18) adapted to carry ware to be fired along rails through the kiln, the cars (18) being arranged such that their dimension transverse to the direction of movement through the kiln is greater than their dimension parallel to the kiln, receiving and feeding means (16, 12) for respectively receiving cars exiting from the kiln and cars to be fed to the kiln, and conveyor means (26) for moving cars between the receiving and feeding means, the receiving and feeding

means (16, 12) each have a device for lifting and lowering kiln cars (18) from and to rails running through the kiln, said receiving and feeding means (16, 12) incorporating a car turning arrangement (24) whereby after leaving the kiln and prior to re-introduction to the kiln each car is rotated through 90° such that as it travels from the receiving means (16) to the feeding means (12) its shortest dimension is transverse to the direction of travel through the kiln."

"4. A method of continuously cycling kiln cars through a kiln assembly comprising running a wheeled car (18) through a kiln on rails between receiving and feeding means, receiving the car at said receiving means on its discharge from the kiln exit (14), elevating it and rotating it through 90°, depositing it on a return conveyor arrangement returning it to said feed means, elevating it and rotating it through 90° and redepositing it on the kiln rails at the entrance to the kiln."

In Claim 4 according to the auxiliary request, after the term "feeding means" of Claim 4 in the version as granted the following wording should be inserted: "with the car arranged such that its dimension transverse to the direction of movement through the kiln is greater than its dimension parallel to said direction". Additionally, after the first occurrence of the term "through 90°" in this claim the wording should be inserted: "so that its shortest dimension is transverse to the direction of movement".

VII. In his letter dated 2 January 1996 the Respondent requested that the Board reconsider its provisional opinion as to remittal of the case to the first instance, since this would lead to a substantial delay of the further procedure. Remittal of the case would

also not seem to be required because the documents underlying the objections as to prior public use had already been filed during opposition proceedings. The Respondent requests that the appeal be dismissed.

### Reasons for the Decision

1. The appeal is admissible.
2. The document (D1) on which the first instance based its finding as to the absence of an inventive step in the subject-matter of granted Claims 1 and 4, discloses a method and a system of firing ceramic materials such as ceramic tiles, the tiles being supported on load carrying plates which are introduced into the kiln and circulated in a closed cycle. The load-carrying plates are passed through an automatic loading and an automatic unloading station for taking up and delivering respectively, the tiles.

The primary object underlying (D1) is to afford implementation of the processing cycle on a continuous basis, regardless of the duration of processing shut-off periods upstream and/or downstream of the firing treatment station, and with substantially reduced requirements for the load-carrying plates. Further objects are concerned with the ability to take in imbalances in the operation of the system as deriving from possible incidental shut-offs and with the reduction of the required energy and investment costs.

As already pointed out in the Board's communication of 10 November 1995, no hint is provided in (D1) to the problem of facilitating loading and unloading of kiln cars of the type such that their dimension transverse to

the direction of movement through the kiln is greater than their dimension parallel to the kiln. According to the patent in suit (see col. 3, lines 36 to 43), a particular aspect of the inherent problem resides in the requirement that it should be possible to load the kiln cars by hand or by certain automatic mechanised loading arrangements. A manual operator has only a limited reach and consequently cannot easily set ware to be fired on areas of the kiln car out of his reach.

Load-carrying plates as described in (D1) are not comparable with wheeled kiln car assemblies due to the differences in the size, the construction, the load capacity and the means for transporting them through the kiln. Furthermore, (D1) is concerned exclusively with automated loading and unloading (see Claim 1 and page 4, paragraph 1 of (D1)) where the width of the firing ware carrier is not of importance since there is no limitation of the reach of the loading equipment.

The argument of the Respondent that the feature "manual loading/unloading" cannot be found in the claims of the patent in suit does not convince the Board. As explained above, manual loading/unloading of the kiln cars is a particular aspect of the inherent problem. As stipulated in Rule 27(1)(c) EPC, the description shall disclose the invention such that the technical problem can be understood. Hence, it suffices that the aspect of manual loading/unloading is elucidated in the description, as in the present case.

Summing up, the Board concludes that, as (D1) does not concern a kiln including wheeled car assemblies adapted to carry ware to be fired along rails through the kiln



in a widthwise orientation and as the specific problem of facilitating loading and unloading of the kiln cars is not addressed therein, the subject-matter of Claim 1 of the patent in suit is not obvious from this citation.

3. Having regard to the subject-matter of independent Claim 4 in the version as granted, the further citation (D3) describes a kiln assembly comprising wheeled kiln cars (25) moved on rails from a preheating chamber (6) comprising a rotatable platform (12) via a turntable (26) to the kiln entrance, then through the kiln to turntables (27, 29) where the kiln cars are rotated through 90°, and thence back into the preheating chamber.

Thus, (D3) describes all the method steps according to Claim 4 with the exception of the step of elevating the kiln car in connection with the rotation thereof through 90°.

Whenever a wheeled car running on rails has to be moved from a first set of stationary rails to a second set of such rails being angularly displaced with respect to the first set of rails it would come within the normal practice of the skilled person to elevate the car from the rails prior to rotating it into the desired angular position. Without such an elevating step prior to rotating the car, a particularly complex arrangement of the rail crossing region would be required which the skilled person would avoid for reasons of a simple, reliable and low-cost construction.

It follows from the foregoing considerations, that Claim 4 according to the main request cannot be maintained in the light of the disclosure of (D3) and of the common knowledge of the skilled person, due to lack of inventive step of its subject-matter.

4. Due to its finding with regard to the relevance of the document (D1) to the claimed subject-matter, the first instance did not consider it necessary to examine the other documents, in particular (D4) and (D5) (see Section 10 of the decision under appeal).

The subject-matter of the alleged public prior uses (D4) and (D5), respectively, puts the maintenance of the patent, at least according to Claim 1 as granted, at risk. Examination of the case as to patentability needs to be resumed taking account of these objections.

It is true that (D4) and (D5) do not concern new material in the sense that it had not been known to the parties. However, due to the fact that the first instance did not examine these documents, the Appellant had no possibility to defend himself against these objections in the frame of an ordinary examination procedure.

As is clear from the Appellant's letters dated 7 October and 11 October 1993, the question whether the alleged prior uses are relevant to the subject-matter of the patent in suit is not in dispute between the parties. The issue in dispute is rather the question whether the alleged prior uses were of public character and whether a breach of confidence occurred.

5. According to Article 111(1) EPC, in the decision on the appeal, the Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. In the exercise of such discretion in the present case, an

important viewpoint is that the subject-matter of the alleged prior uses could raise serious doubts as to the presence of an inventive step, or even novelty, in the claimed subject-matter.

In a similar situation in which the apparently closest prior art had not been examined in the proceedings before the first instance (see decision T 273/84 OJ EPO, 1986, 346) the case was remitted to the first instance for further examination.

If, in the present case, the Board itself carried out the examination as to patentability, the Appellant would lose the opportunity of having an examination of the claimed subject-matter before two instances. For this reason, the Board considers that in cases like this in which, due to apparently relevant prior art, the validity of the patent is at stake, the interest of the Appellant (Patentee) in having an examination at two levels of jurisdiction has to be given priority over the interest of the Respondent (Opponent) in having short proceedings.

6. The Board, therefore, sets aside the decision of the first instance and avails itself of the power under Article 111(1) EPC in order to refer the case back to the Opposition Division for further examination on the basis of the requests on file (see section VI above).

In respect of the auxiliary requests of the parties for oral proceedings, the Appellant has withdrawn his request for oral proceedings subject to remittal of the matter. In the present case, the Board considers it neither necessary nor appropriate to appoint such

proceedings before the Board at present, since the matter is remitted to the first instance for further prosecution during which oral proceedings at the request of any party to the proceedings can take place.

7. The Appellant requested that costs should be awarded against the Respondent. He argued that the allegations of public prior use made by the Respondent on 29 June and on 13 and 15 July 1993 were raised at too late a date to be considered in opposition proceedings and caused the Appellant to carry out a not insignificant amount of work in defending the allegations. Further according to the Appellant, this late filing of further grounds for opposition was an abuse of proceedings and a breach of good faith.

As already set out in the Board's communication dated 10 November 1995, the objections of public prior use (D4) and (D5) were submitted more than three months before the date of the oral proceedings before the first instance which took place on 26 October 1993. Thus, the Appellant had the possibility to comment on these documents already before the date of the oral proceedings which in fact he did, (see the filing of the Statutory Declarations on 8 and 12 October 1993). Thus, the relevance of the alleged public prior uses could have been decided upon in the proceedings before the first instance. Moreover, the alleged public prior uses were filed in response to the, for the Respondent, negative communication of 26 February 1993.

The Board cannot, therefore, recognise any abuse of the proceedings or breach of good faith on the part of the Respondent which might justify a different apportionment of costs pursuant to Article 104(1) EPC. Hence, the request for awarding costs cannot be allowed.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further examination of the opposition with particular attention being paid to the documents (D4) and (D5).
3. The request of the Appellant to award costs against the Respondent is rejected.

The Registrar:



N. Maslin

The Chairman:



C. T. Wilson

