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D E C I S I O N
of 1 December 1997

Case Number: T 0063/97 - 3.2.4

Application Number: 89311251.6

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IPC: A45B 17/00

Language of the proceedings: EN

Title of invention:
Umbrella frame

Patentee:
Hoyland Fox Limited

Opponent:
Kortenbach Verwaltungs- und Beteiligungsgesellschaft mbH & Co.

Headword:
-

Relevant legal provisions:
EPC Art. 54, 56, 123

Keyword:
"Main request (refused): amendments neither appropriate nor necessary"
"Novelty (yes)"
"Inventive step (yes)"

Decisions cited:
"G 0009/92, T 0002/83, T 0056/87, T 0005/81

Catchword:
-



Case Number: T 0063/97 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 1 December 1997

Appellant:
(Opponent) Kortenbach Verwaltungs- und
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Respondent:
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 27 December
1996 concerning maintenance of European patent
No. 0 368 539 in amended form.

Composition of the Board:

Chairman: C. A. J. Andries
Members: R. E. Gryc
M. Lewenton

Summary of Facts and Submissions

I. The appellant (opponent) lodged an appeal, received at the EPO on 14 January 1997 against the interlocutory decision of the Opposition Division, dispatched on 27 December 1996, which maintained the patent No. 0 368 539 in an amended form.

The appeal fee was paid simultaneously and the statement setting out the grounds of appeal was received at the EPO on 22 February 1997.

II. Opposition was filed against the patent as a whole and based on Article 100(a), (b) and (c) EPC. The Opposition Division held that the grounds for opposition cited in Article 100 EPC did not prejudice the maintenance of the patent in an amended version, having regard in particular to the following documents:

E1: US-A-3 182 673

E2: US-A-3 410 285

E3: US-A-3 464 431

E6: FR-A-1 145 042

E7: CH-A-47 008 and

E14: US-A-2 605 778.

Late filed document E15 (Spanish Utility Model 260 506) was not taken into consideration.

III. In his statement setting out the grounds of appeal, the appellant (opponent) pointed out that an umbrella frame of the kind described in the pre-characterising part of

claim 1 as accepted by the first instance was already known from E1 before the priority date and that the advantages given by the use of a ball-and-socket joint as a tilting means for an umbrella were also already known from E6 and E7. The appellant was therefore of the opinion that to replace the pivoting means of the umbrella according to E1 by a ball-and-socket joint according to E6 or E7 does not involve the exercise of any ability beyond that to be expected of the skilled person when the advantages given by such a joint are needed.

In subsequent statements, the appellant alleged that the opposed patent does not clearly state the problem to be solved and that nothing hindered the skilled person to replace the pivoting articulation of the post of the umbrella known from E15 by a ball-and-socket joint of the type shown in E6 and E7.

He also pointed out that E14 disclosed an umbrella having tilting means located between the top of the frame and the set position of the location body and that the tilting means allow also the upper part of the shaft of the frame to be tilted in different planes angularly spaced around the axis of the other part of said frame.

- IV. With his letter dated 31 October 1997, the respondent (patentee) filed as a main request a new claim 1 limited, with respect to the granted claim 1, in a way somewhat different from claim 1 as accepted by the first instance.

In a communication sent by telecopy on 21 November 1997, the Board gave notice to the parties of the Decision of the Enlarged Board of Appeal G 9/92 (OJ

EPO, 1994, 875) and clearly stated that a refusal of claim 1 of the respondent's main request should be expected.

V. Oral proceedings took place on 1 December 1997.

The respondent filed an auxiliary request comprising a new independent claim 1 and dependent claims 2 to 9.

The respondent did not recognise in E1 the concept of the invention. He contended that the problem to be solved by the invention as regards the conventional tilting umbrellas is not only to improve the flexibility in operation in order to get the possibility of tilting the umbrella in every direction when the shaft is fixed with respect to its support, but also to improve the stability because, when the known tilt facility is used, the centre of gravity of the conventional umbrellas is displaced some way off the shaft axis, leading to instability and difficulties in handling.

The appellant on the other hand considered E7 as the closest state of the art, since, in the embodiment represented in Figure 3, the button of the trigger (12) did not fit within the confines of the shaft diameter and prevented therefore the runner to pass over it to fold and unfold the umbrella. Therefore, this button with the trigger and the ball-and-socket joint must necessarily be located at a point above the upper position of the runner. The appellant was therefore of the opinion that this known embodiment of E7 anticipated implicitly and completely the invention.

In the case that lack of novelty with respect to E7 would not be acknowledged by the Board, the appellant contended further that the subject-matter of claim 1 of both respondent's requests lacks inventive step with

respect to the teachings of E1 and E7. He pointed out that the skilled person would learn from E1 that, for stability reasons, the upper portion of the articulated post of the umbrella should be the shortest as possible and therefore located above the runner near the top. Therefore, in the appellant's opinion, the skilled person would be incited to apply the teaching of E1 to the umbrellas according to E7 and would arrive at the invention without the exercise of an inventive step.

The appellant did not refer anymore to the state of the art disclosed in E14.

VI. The appellant requested that the decision under appeal be set aside and the patent No. 0 368 539 be revoked.

The respondent requested that the decision under appeal be set aside and the patent be maintained on the basis of claims 1 to 10 as filed with letter dated 31 October 1997 (main request) or on the basis of claims 1 to 9 as filed during the oral proceedings (subsidiary request).

VII. The wording of claim 1 of the main request reads as follows:

"A frame for an umbrella, having a shaft (5), ribs (7) extending radially from the top (3) of the shaft, and stretchers extending from a location body (2) on the shaft (5) to attachment points on the ribs (7), means being provided for holding the location body in place at a set position on the shaft for holding an umbrella cover open, wherein the shaft (5) comprises first and second parts connected by a tilting means (1) to allow the axis of the one part of the shaft to be set in a position inclined to the axis of the other part of the shaft, and the tilting means (1) is located at a position between the top of the shaft and the set position of the location body (2), whereby the cover of

the umbrella can be tilted without accompanying tilting of the location body, characterised in that the tilting means (1) is adapted to be operated by the application of pressure to the respective shaft parts."

The wording of claim 1 of the subsidiary request reads as follows:

"A frame for an umbrella, having a shaft (5), ribs (7) extending radially from the top (3) of the shaft, and stretchers (6) extending from a location body (2) on the shaft (5) to attachment points on the ribs (7), means being provided for holding the location body in place at a set position on the shaft for holding an umbrella cover open, wherein the shaft (5) comprises first and second parts connected by a tilting means (1) to allow the axis of the first part of the shaft to be set in a position inclined to the axis of the second part of the shaft, and the tilting means (1) is located at a position between the top of the shaft and the set position of the location body (2), whereby the cover of the umbrella can be tilted without accompanying tilting of the location body, characterised in that the tilting means (1) allows the first part of the shaft to be tilted in different planes passing through the axis of the second shaft part, these planes being angularly spaced with respect to the second shaft part."

Reasons for the Decision

1. Admissibility of the appeal.

After examination the appeal has been found to be admissible.

2. *Respondent's main request*

The pre-characterising portion of claim 1 of the main request is constituted by the whole content of claim 1 as granted and is identical to the pre-characterising portion of claim 1 as accepted by the first instance. However, its characterising portion is completely different from and does not comprise any feature of the characterising portion of the independent claim as accepted by the Opposition Division.

In the communication of the Board sent by telecopy on 21 November 1997 the respondent has been given notice of the Decision of the Enlarged Board of Appeal G 9/92 (particularly sections 15 and 16), which decided that if the opponent is the sole appellant against an interlocutory decision maintaining a patent in amended form, the patent proprietor is primarily limited to defending the version accepted by the Opposition Division and that amendments which are neither appropriate, nor necessary, which is the case if the amendments do not arise from the appeal, may be rejected by the Board of Appeal.

In this communication, the respondent has also been given notice of the Board's provisional opinion according to which, in the present case, it was neither appropriate nor necessary to limit claim 1 as granted in a way different from the amendment accepted by the first instance.

In the oral proceedings, the respondent maintained his main request unchanged and contended that the amendment was made just to better reflect the scope of the invention. To express differently the same inventive concept of an invention may be more an answer to a clarity problem than an amendment which takes into account a ground for opposition. Such appropriate or necessary amendments, resulting from the fact that grounds for opposition are taken into account, normally result in a restricting of the scope of protection of the subject-matter as maintained by the Opposition Division. Consequently, the amendment of claim 1 filed with respondent's letter of 31 October 1997 (main request) does not arise from the necessity to take account of a ground for opposition and the Board therefore has no reason to depart from its previous opinion. The modification cannot be accepted and the main request is therefore refused.

3. *Respondent's auxiliary request*

3.1 Amendments (Article 123 EPC)

- 3.1.1 With respect to claim 1 as granted, a feature (the whole characterising portion) concerning the tilting means has been added in present claim 1.

This claim 1 filed during the oral proceedings corresponds to the independent claim as accepted by the Opposition Division with minor amendments. These amendments are considered by the Board as appropriate and necessary in the meaning of the decision G 9/12. In particular, the two parts of the shaft (5) of the umbrella frame have been referred to throughout the claim as first and second parts and the definition of the tilting means given in the characterising portion has been completed in order to make clear that the

first part can adopt different angular positions in planes angularly spaced all around the axis of the second part as described in the application as filed (see page 4, lines 10 to 15).

- 3.1.2 Claims 2 to 9 correspond to claims 2 and 4 to 10 as granted.
- 3.1.3 The description and the drawings (deletion of Figure 9) have been adapted to the new claim 1.
- 3.1.4 These modifications thus fulfil the requirements of Article 123(2) and (3) EPC and are thus allowable.
- 3.2 Novelty (Article 54 EPC)

During the oral proceedings, the appellant has contended that the subject-matter of claim 1 was anticipated implicitly by the disclosure of E7.

The Board could not accept this argumentation since there is no indication in E7 that the tilting means could possibly be located at a position between the top of the shaft and the set position of the runner. On the contrary, since on page 1 of E7, left column, lines 16 to 19, it is stated that the metallic tube (5) (i.e. the portion of the shaft located above the ball-and-socket joint) is intended to receive the usual frame of an umbrella and since a conventional frame comprises not only the ribs and the stretchers but also the runner, it appears that E7 is concerned with tilting umbrellas having the runner situated in a conventional position i.e. above the tilting means.

Therefore, E7 does not anticipate the subject-matter of claim 1 even implicitly.

None of the other documents filed during the proceedings discloses a frame for umbrella having a tilting means which, at one and the same time, is located between the top of the shaft and the set position of the location body and allows one part of the shaft to be tilted in different planes angularly spaced around the axis of the other part. Since this has not been disputed by the appellant, there is no need for further detailed substantiation.

The subject-matter of claim 1 of the auxiliary request is therefore new in the meaning of Article 54 CBE.

3.3 The closest state of the art

Taking into account the argumentations presented by the parties during the oral proceedings, particularly the fact that the umbrella involved is a commonly known, conventional umbrella, i.e. in the meaning of the present patent, an umbrella with a runner which is directly actuated manually, and not an umbrella with a mechanical actuation of the runner, cf. D1, D2 and D15: crank units, the Board is now of the opinion that the state of the art closest to the invention was not embodied by the specific large umbrellas described in E1, E2 or E15 but rather by a conventional umbrella as represented on Figure 1 of the application as filed i.e. a tilting umbrella having a pivot joint which is situated below the runner and allows a tilt in only one direction (see the application as filed: from page 6, line 15 to page 7, line 8).

The subject-matter of claim 1 differs from this closest state of the art in that the tilting means is located above the runner and allows one part of the shaft to be tilted in different planes angularly spaced around the axis of the other part.

• 3.4 Problem to be solved and solution

The Board sees the problem as objectively determined when starting from a conventional umbrella as being to improve its stability when the upper part of the shaft is tilted and also its flexibility in operation when the post is fixed.

The Board is satisfied that the implementation of the measures claimed in claim 1 brings a solution to the above-mentioned problem.

3.5 Inventive step (Article 56 EPC)

3.5.1 The questions to be answered as regards the inventive step in relation to the modification of a conventional tilting umbrella according to Figure 1 of the application as filed are whether the state of the art seen in the light of the general common knowledge of the skilled person would provide him with enough information about the essential means of the invention and whether, in the state of the art, he would find clues to applying this teaching to said conventional tilting umbrella in expectation of the result he was seeking (see decision T 2/83, OJ EPO 1984, 265).

3.5.2 Prior art document E1 does not relate to conventional tilting umbrellas but to tiltable umbrellas wherein the runner is mechanically actuated through a gear and rack drive. Moreover, this document deals more particularly with a structure of this type wherein movement of the runner at the upper portion of the post of the umbrella leads to a tilt of the umbrella top (see E1: column 1, lines 9 to 16).

On these known umbrellas, the kind of tilting means (single-axial), its particular position (above the runner) and the use of a gear and rack driver are

tightly dependent from each other and cannot be dissociated without a particular hint. Since such a hint cannot be found in the cited prior art document, the technical teaching of E1 should be considered in its entirety and it is not justified arbitrarily to isolate parts of this document from their context in order to derive therefrom a technical information which would be distinct from the integral teaching of E1 (see decision T 56/87, OJ EPO 1990, 188).

Since, moreover, it appears from the state of the art cited in the proceedings that the tilting means are positioned above the runner only in combination with the mechanical actuation drive of large umbrellas (see E1, E2 and E15), the skilled person has, a priori, no reason to isolate and pick up just the feature concerning the location of the runner from the integral teaching of E1 and to transpose only this feature on conventional umbrellas or on an umbrella shaft according to E7 (as argued by the appellant).

3.5.3. As regards E7, it should also be recalled that the assessment of inventive step must consider solely the limited teaching of the prior documents. An interpretation of the documents as influenced by the problem solved by the invention while the problem was neither mentioned or even suggested must be avoided, such an approach being merely the result of an a posteriori analysis (see decision T 5/81, OJ EPO 1982, 249). Therefore the teaching of the state of the art disclosed in E7 should thus be examined strictly, only in the context of the integral teaching of this document and without any interpretation not clearly supported by its content. Since, as already stated in section 3.2 above, there is no indication in E7 that the tilting means could possibly be located at a position between the top of the shaft and the set position of the runner and since, on the contrary, the

portion of the shaft located above the ball-and-socket joint is supposed to support the usual frame of an umbrella (see E7: page 1, left column, lines 16 to 19), there is also no reason for the person skilled in the art to adopt for the tilting means, without any hint, a position different from the conventional one which normally lies under the runner.

3.5.4 Reciprocally, since the shaft disclosed in E7 is a simple one conceived to support an usual frame of umbrella, the person skilled on the art would not envisage to apply the teaching of E7, i.e. the use of a ball-and-socket joint, on an umbrella according to E1 all the more since such a joint could not suit the actuating means (gear and rack drive) without substantial adaptations to be done.

3.5.5 Although the fact that ball-and-socket joints were known in the technical field of umbrellas, a certain reluctancy to use such joints was apparently present, particularly since instability was feared. The claimed solution, which uses such a joint above the runner, is based on the idea that on the one hand, by locating the articulation above the runner, the instability, due to a shifting of the gravity point of the tilted portion of the umbrella away from the shaft, was reduced, so that on the other hand, not only that instability aspect became less important, but also that under these circumstances such a specific kind of joint could now be used without having to fear the instability. This idea was not disclosed either explicitly, or implicitly in the available prior art.

4. *Conclusion*

For the foregoing reasons, the Board considered that to improve a conventional umbrella according to the teaching of claim 1 does not follow plainly and logically from the cited prior art and that the reasons stated by the appellant did not prejudice the maintenance of the patent in the amended version of the auxiliary request filed at the oral proceedings.

Starting from other documents as closest prior art would in the present circumstances not modify the above conclusions (cf. 3.5.2 to 3.5.5).

The patent therefore can be maintained on the basis of the patentable claim 1 of the auxiliary request, and the **dependent** claims 2 to 9 concerning particular embodiments of the invention (cf. Rule 29(3) and (4) 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 in the following version (subsidiary request):

claims: 1 to 9 filed during the oral proceedings;

description: columns 1 to 8 and page 2a filed during the oral proceedings;

drawings: 1 to 8 filed during the oral proceedings.

The Registrar:



N. Maslin

The Chairman:



C. Andries