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D E C I S I O N
of 16 May 2002

Case Number: T 1053/99 - 3.2.3

Application Number: 95915709.0

Publication Number: 0756654

IPC: E01C 19/40, E04F 21/24, E04G 21/01

Language of the proceedings: EN

Title of invention:
Machine for levelling concrete

Patentee:
Drion constructie, BVBA

Opponent:
Wirtgen GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 56, 113(2), 114(2)

Keyword:
"Late submitted facts relating to an alleged prior use - not admitted inventive step - yes"

Decisions cited:
T 0951/91

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1053/99 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 16 May 2002

Appellant: (Opponent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 7 July 1999 rejecting the opposition filed against European patent No. 0 756 654 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman: C. T. Wilson
Members: U. Krause
J. P. B. Seitz

Summary of Facts and Submissions

I. The appeal contests the decision of the Opposition Division dated 24 August 1999 and issued in writing on 7 September 1999 to reject the opposition against European patent 0 756 654. This patent relating to a machine for levelling concrete comprises 15 claims, the single independent claim 1 reading as follows:

"1. Machine for levelling concrete, of the type whereby poured concrete (2) is spread over a predetermined width and whereby this concrete (2) is skimmed off at a certain height, said machine (1) being adjustable in width and contains an element (45) which can make a to-and-fro-movement in the width by being moved over a guide (36), characterized in that the length of said guide (36) can be telescopically adjusted as a function of the required working width of the machine, whereby said element (45) can make a continuous movement over the entire length of the guide (36) without the transition or transitions between the different telescopic guide parts (26,27) being an obstacle."

II. The opposition was based on the single ground that the subject-matter of the patent was not patentable within the terms of Articles 52 to 57 EPC (lack of novelty and inventive step) in view of seven documents D1 to D7. Further documents D8 and D9 submitted on 20 August 1999 were disregarded by the Opposition Division as being late-filed and irrelevant.

III. The Opponent (hereinafter denoted Appellant) filed the notice of appeal on 4 November 1999 and paid the appeal fee on the same day. A statement of the grounds of appeal was submitted on 14 January 2000.

With its communication pursuant to Article 11(2) RPBA the Board informed the parties of its intention to take the late-filed documents US-A-4 392 574 (D8) and DE-A-2 138 923 (D9) into consideration as disclosing telescopic guides designed for the free translation of a moveable element therealong, and to focus on document US-A-3 970 405 (D1) and on these documents since the the remaining documents were less relevant.

During Oral proceedings held on 16 May 2002 the Appellant raised the objection that claim 1 was incorrect with respect to the reference number (45) which, in claim 7 and in the description, was used for the carriage rather than for the element. The proprietor of the patent (hereinafter denoted Respondent) requested a correction of claim 1 by deleting this reference number. The Appellant further submitted a brochure "Slipform paver SP 500" of Wirtgen with imprint "No. 46-10 EN-10/99 by Wirtgen GmbH 1999 Printed in Germany" (D10) and a copy of a page referring to an international symposium on Infrastructure Construction Systems and Technologies held on Friday, 6 April 2001, within the framework of the trade fair "bauma 2001" (D11). It also argued that one day before the oral proceedings it became aware that a novelty-destroying public prior use had taken place on an exhibition at the priority date of the patent, and requested that this prior use be taken into consideration by questioning Mr. Moser of the Appellant as a witness. Any costs incurred by hearing the witness or by a potential postponement of the oral proceedings would be carried by the Appellant.

IV. The Appellant requests that the decision under appeal be set aside and that the patent be revoked. The

Respondent requests that the decision under appeal be set aside and that the patent be maintained with the amendment that the reference number "45" is deleted in claim 1 as granted (lines 35 and 40 of column 6).

V. The essential arguments of the Appellant concerning the issues of novelty and inventive step can be summarized as follows:

The machine shown at a fair starting at the priority date of the patent had all the features of claim 1. Since the claimed priority of the patent was invalid for claim 1, this exhibition was a prior disclosure of the subject-matter of claim 1 which should be taken into consideration as particularly relevant despite the late submission.

Moreover, the disclosure of D1 was not limited to an adjustment of the length of the guide by inserting extension attachments as disclosed in the preferred embodiments, since claim 38 of that document utilised the broader term "laterally expandable track assembly" which would include and even indicate a telescopic adjustment of the track. Thus, the concept of a telescopic adjustment was already derivable from D1 which, therefore, anticipated the subject-matter of claim 1. In any event, this broad term provided a pointer towards a telescopic adjustment of the guide, especially as the person skilled in the art, an engineer with a university diploma, would consider a telescopic adjustment as being one of the possibilities for expanding the guide for adjustment to a required width and indeed the same machine already included such a telescopic arrangement for adjusting the frame width. If according to column 2, lines 59 to 68 of D1 the

extension attachments described as "best practice" in that document, for example in column 36, lines 24 to 38, were proposed for economic reasons and for keeping the motive power and machine weight at a minimum, other solutions would be considered under different circumstances. A prejudice against the use of telescopically adjustable guides, as pointed out in the decision under appeal, did not exist because solutions for obstacle-free transitions between the guide parts were known e.g. from dish-washers and the tower cranes of D8 and D9, disclosing the general concept of providing respective guide rails in the telescoping parts for two sets of rollers of a trolley. The latter documents did not concern a remote technical field, as argued by the Opposition Division, because at least D9 was not limited to tower cranes and D10, see for example the photographs on pages 5,8,31,35,37 and 47, and D11 proved that such cranes were employed together with road buiding machinery in road works or exhibited at the same fairs, respectively. Moreover, the skilled person striving to improve the adjustment of the guide in D1 was aware of the similar problem encountered in tower cranes with extensible jibs and, therefore, would consult documents D8 and D9 teaching the translation of an element (the crab) along a telescopic guide (the jib) in an obstacle-free manner.

VI. The Respondent submits essentially the following counterarguments:

The alleged prior use should not be allowed into the proceedings as being irrelevant and unsubstantiated. No evidence was submitted other than a witness who was an employee of the appellant. Even if the exhibition proved to have taken place it was not before the valid

priority date of claim 1. The new submissions served only the purpose of delaying the decision on the validity of the patent.

The invention solved the problems encountered with the extension members of D1, for example the complex, labour and time intensive insertion of these members requiring the operation of the machine to be interrupted and a large number of members to be stored and transported. The claimed telescopic adjustment of the guide, providing an easy and variable adjustment of the working width of the guide whilst allowing a functionally reliable processing of the concrete with the working element, could not be derived from D1 because the entire disclosure of this document was directed to the use of adapters or extension members and not even the slightest suggestion for the use of telescopic guides could be found, especially as a skilled person would expect a rigid guide rail to be required for an accurate processing of the concrete by the element. The telescopic adjustment of the frame in D1 could not lead a skilled person to a similar adjustment of the guide because the frame did not have to guide an element therealong and the steps between the telescoping parts of the frame would prevent a smooth movement of the working element. Documents D8 and D9 were irrelevant as being directed exclusively to cranes or crane jibs on which a trolley or crab can move for conveying loads, a technology completely unrelated to concrete finishers with a reciprocating working element for processing the concrete surface, especially as the guide rail and trolley for the crab of a tower crane had a mere supporting function for the load on the crab, whereas the guide rail of a concrete finisher had to provide an exact guidance of the

working element for horizontally levelling the concrete. Thus, a skilled person would not search for solutions in the field of tower cranes any more than for example in the field of hammer or drilling machines used in road building for solutions to the technical problem underlying the patent.

Reasons for the Decision

1. The appeal meets the requirements of Articles 106 to 108 EPC and of Rules 1(1) and 64 EPC and is, therefore, admissible.

2. *Alleged prior use*

Pursuant to Article 114(2) EPC the European Patent Office may disregard facts or evidence which are not submitted in due time by the parties concerned. The discretionary power given by this Article to the departments of the EPO serves to ensure fair and swift conclusion of the proceedings in the interests of the parties, the general public and the EPO, and to forestall tactical abuse (see T 951/91, OJ 1995, 202). Thus, as a general rule any facts and evidence should be submitted as early and completely as possible. New evidence submitted at the oral proceedings of the appeal stage, i.e. towards the very end of the proceedings, could only be admitted in very exceptional cases if it is prima facie highly relevant in the sense that it is highly likely to prejudice maintenance of the patent, and it would not cause a major procedural complication and delay. This requires that it must be substantiated to an extent as to enable the Board to immediately determine whether this new submission is so

relevant that it cannot be disregarded and, if so, to examine the merits without further delay.

These requirements are not met. The Appellant merely alleged that a novelty-destroying public prior use had occurred by presenting a machine having the features of claim 1 at a trade fair, without submitting evidence on the subject-matter, date and circumstances of this use other than by referring to a potential witness. This witness, Mr. Moser, attended the oral proceedings before the first instance, without however referring to this prior use. The question therefore arises why the Appellant did not mention this prior use before, and the witness did not recall it until more than two years after that oral proceedings, if it was so relevant. No suitable explanation was presented for this behaviour. Thus, the circumstances of the alleged public prior use are so vague and doubtful that neither its relevance nor its merits can be determined without considerably delaying the proceedings. Thus, the Board refuses to admit this submission into the proceedings.

3. *Novelty*

Document D1 discloses a machine for levelling concrete comprising extensible strut members (48,52) for adjusting the width of the machine between the side members (42,44) and an adjustable frame track (552) for guiding an element, in this case a traveller (580) with a paddle (580) attached thereto, therealong in a continuous back-and-forth movement. The length of the frame track (552) is adjusted by inserting extension attachments between sections of a top track (560) and a bottom track (562). As compared with the description employing the expressions "extension" or "extensible"

for the insertion of attachments members, the term "laterally expandable track assembly" is mentioned in claim 38. This cannot, however, be seen as a disclosure of a telescopic arrangement for adjusting the frame track, as argued by the Appellant. In fact, the term "laterally expandable track assembly" may be so general as to include other solutions but such a general expression cannot in principle disclose a specific solution such as a telescopic arrangement. Furthermore, it is noted that the term "expandable" can be found in the description (col. 18, line 8) in connection with a similar adjustment of a subframe assembly by insertion of extension attachments. Thus, it is evident that the term "expandable" will be understood by the skilled reader as a synonym of "extensible" and that, therefore, D1 fails unambiguously to disclose an adjustment of the guide track other than by insertion of extension attachments.

Since the other documents are less relevant than D1 and do not disclose the features of claim 1 in combination either, the subject-matter of claim 1 is considered to be new.

4. *Inventive step*

4.1 Starting from document D1 which undisputedly represents the most pertinent prior art, it is found, based on the considerations set out with regard to novelty, that the subject-matter of claim 1 is distinguished in that the length of the guide can be telescopically adjusted, without the transition or transitions between the different telescopic guide parts being an obstacle for the movement of the element over the entire length of the guide. This functional definition is equivalent to

a definition of the guide as comprising telescopically adjustable guide parts which are designed to allow an obstacle-free movement of the movable element along the guide from one guide part to the other and vice versa. Whereas this free movement is a requirement which is also met by the construction disclosed in D1, allowing a free transition of the traveller (580) and paddle (588) along the full length of the frame track (552) with inserted attachments, the telescopic arrangement provides for a more flexible, faster and easier adaptation of the guide to the various predetermined widths of the frame because any width can be obtained without having to dismount the guide and to bolt or unbolt the extension attachments which have to be stored separately.

It will therefore have to be determined whether a skilled person faced with the problem of improving the width adjustment of the guide in D1 with respect to flexibility and expense of labour and time involved, without sacrificing the free movability along the full length of the guide, would consider a telescopic arrangement.

4.2 Considering first document D1 by itself, it turns out that this document neither includes a pointer towards the claimed solution, as argued by the Appellant, nor leads a skilled person away from this solution, as set out in the decision under appeal.

The Appellant relies on claim 38 of D1 as indicating a telescopic arrangement by the term "expandable", as compared with the term "extensible" used in connection with the insertion of the attachment members in the frame track. However, as set out above in connection

with the question of novelty, the term "expandable" will be understood by the skilled reader of the entire document D1 as a synonym of "extensible" so that no indication can be derived from D1 for an adjustment of the guide track other than by insertion of extension attachments. Likewise, the reference to a "best practice" in column 36, lines 24 to 38, of D1 is to a selection of extension attachments of different lengths so as to match any width of the frame whatsoever as being preferred over attachments of the same length, rather than to the extension attachments as being preferred over other possible solutions, thereby leaving room or providing a suggestion for contemplating other practical ways of adjusting the width, for example doing away with the extension attachments altogether. The object of minimizing the machine weight and the maintenance and operating expenses (column 2, lines 59 to 63), which could be a plausible reason for using the extension attachments, is only one of the objects, whereas this technical solution would be less preferable in view of other objects of higher priority (column 2, lines 49 to 58), i.e. coping with a variety of road dimensions and minimizing the set-up and tear down time. Thus, the objects to be solved cannot provide a pointer towards a telescopic arrangement either.

A telescopic arrangement is shown in D1 for the adjustment of the frame assembly (12) and comprises side members (42,44) attached to extending strut members (48,52) slidingly received in tubular members (26). This arrangement results in distinct steps at the transitions from the tubular members (26) to the strut members (48,52). Such steps can be accepted in the case of an adjustable frame having only the function of

supporting the side members. In a guide rail, however, these steps would be detrimental as forming an obstacle for the movement of a movable element and thereby preventing the element from being smoothly guided along the entire width of the guide rail. Thus, a skilled person would have no reason to adopt this solution for the guide rail. In fact, it can be seen as a confirmation of the opinion that the skilled person, knowing such typical telescopic arrangements, would not expect a telescopic guide to meet the requirements of smooth transition along the guide and of exact guidance. On the other hand, a "technical prejudice" against the telescopic adjustment of guides would mean that there was a generally accepted opinion in the art that guides should not be telescopic, which would have to be supported by statements to exactly this effect in suitable technical literature, for example standard works or textbooks (cf. the various decisions referred to in the Case Law book, 4th edition, pages 134 and 135).

In summary, the telescopic guide design cannot be considered as obvious in view of D1 alone.

4.3 Documents D8 and D9 relate to tower cranes having telescopically extensible jibs provided with runways allowing a continuous movement of a crab along the entire length of the jibs. The Appellant argues that a skilled person would derive from these documents the general idea of combining a telescopic arrangement with a guide for moving an element along its entire length, especially as tower cranes and road building machinery usually appear at the same sites, as shown by the recent documents D10 and D11. The Board cannot follow this argument. Tower cranes and road building machinery

may be both exhibited at trade fairs or employed in road works but there are usually so many different machines that no technical relation can be derived from this fact alone unless a skilled person expected the same technical problems to exist in both fields. This is, however, not the case because tower cranes typically have fixed rather than extensible jibs and the crab must be supported on the jib to carry a substantially vertical load, rather than guided to travel along an exact horizontal line as is the case with the traveller and paddle assembly of document D1. Consequently, the constructions shown in D8 and D9, comprising a crab having roller sets supported by runways (D8) or a runway in combination with an additional carriage (D9), are specific solutions for a tower crane, or for an extension arm for use in such a crane, rather than generally applicable concepts, and these specific solutions are not suitable for application to the slipform paving machine of D1, especially for horizontally guiding the paddle for evenly dispersing the concrete for a road surface or any other working element for processing the concrete surface. Thus, the skilled person knowing the different problems encountered in tower cranes and road building machinery would have no reason to search in the former field for solutions to a problem found in the latter one, and even if he incidentally became aware of documents D8 and D9 he would refrain from applying it to D1 as being unsuitable for guiding the paddle thereof.

The Appellant cannot be followed when he argues that document D9 is a general disclosure not restricted to cranes. It is correct that the first two lines of the description of D9 refer to a crane as an example, but

against this the reader of the whole document is presented with the title, the problem to be solved, the particular embodiments and all claims, clearly restricted to cranes.

4.4 The other documents are even less relevant and have not been referred to by the Appellant. The Board therefore concludes that the subject-matter of claim 1 is not rendered obvious by the available prior art.

5. Since the Respondent agreed to the maintenance of the patent only in the amended form whereby the reference sign "45" for the element, denoting a carriage in the remaining claims and in the description, is removed from claim 1 in lines 35 and 40 of column 6 of the patent, it follows from Article 113(2) EPC that the patent must be maintained in amended form including the requested modification.

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 with the following amendment: deletion of reference number "45" in lines 35 and 40 of the granted claim 1.

The Registrar: The Chairman:

A. Counillon C. T. Wilson