

Candidate's Answer Paper

Legal points:

1. Claim 6 has been added claiming a process, the client suggesting that this process is implicitly contained in Claim 5. Although concerned with oppo. proceedings, G 2/88 ruled that such a change of claim category may be allowable under A 123, especially it was stated that this could be allowable when the claimed subject-matter did not produce a product. Concerning the present case, see arguments under A 100(c).
2. Client is interested in complete revocation of the patent, therefore, having regard to G 9/91, the whole extent of the patent, ie all claims, must be opposed. G 9/91 only allowed the possible exception that dependent claims of doubtful validity might be taken into consideration under A 114(1) by the Opp. Div.
3. The client refers to the possibility of "joint" opposition. A 99(1) states that any person may file a opposition, such a "person" may also be a "joint" legal person R 100(1) - indication of "multiple opponents" in Form 2300. However, having regard to the clear wording of A 100, it appears very unlikely that two sets of grounds can be filed or would be accepted by the EPO. However, in such a single opposition, having regard to R 100(1), third sentence, a common representative will have to be appointed, there being more than 1 prof. repr. representing the joint opponents.
4. It is clear from A 133(2) that parties using a prof. representative will have to use such one as defined in A 134(2), ie excluding the daughter. However, the daughter may wish to represent a client when accompanied by her father (prof. repr.) in oral proceedings.

Whether the above applies to a person not entitled under A 134(1) and (7) is pending under G 2/94.

5. With regard to the aesthetic effect, the Board ruled in T 686/90 that the relevant point as to patentability was an adequately identified technical feature (here: features of a fireplace); the fact that the technical solution does provide aesthetic effects is immaterial.
6. As to Annex 5, features have been added between filing and publishing of the patent. However, what is essential is when the public had access to this additional information. As Annex 5 was published a few days after the priority date of the patent in suit, the amendment must have been on file also before that date. As stated in the Guidelines C-III, 5.2 and D-V, 3.1.3, such information is public if a person could have gained knowledge of the information. As Annex 5 is a European patent, file inspection was possible under A 128 before grant.

Other points

The oppo. period runs until 05.09.96, ie there is suff. time for filing the opposition.

Address of opp. to be completed.

Facts and arguments

The English version of A1 is opposed.

Documents referred to: A1: Annex 1

A2:	-	2
A3:	-	3
A4:	-	4
A5:	-	5 (English)
A6:	-	6 (English)

Other evidence: Certified copies of the A5 EPO-file will be submitted.

Observations under A 100(c)

A1 contains matter not included in the application as filed, in that process Cl. 6 has been added. No basis for this new claim can be found, defining a method of collecting ashes through a removable closure plate. The description, penultimate paragraph [P. 21], clearly states that ashes is removed through the grate. In the last paragraph [P. 21] it is then disclosed that soot may be removed through the closure plate opening. To define that the latter procedure also applies to ashes is not supported by the description. Of course, the skilled man may have seen this possibility, but this clearly involves an amount of inventiveness, ie adding subject-matter.

Observations on Novelty and Inventive Step, A 100(a)

Claim 1: A3 is a valid EP-publication having a filing date of 5.9.95, ie prior to the effective filing date of A1 of 29.10.91, A 89. Therefore, A3 is relevant to novelty under A 54(3) for all commonly designated states (A 54(4), ie for all designated states of A1 except NL, SE. With regard to the other states Cl. 1 of A1 is not new over A3.

A3 discloses a fireplace incl. air inlet means (through the top of the wire mesh), an exhaust duct (11), a hollow base member (the room under ash tray (21)), a combustion chamber mounted on the base member (the room between the firebars and the wire mesh) having a peripheral wall including at least one transparent glass panel (see l. 4-5 [P. 37]), the hollow base member forming part of the exhaust duct (see 6th paragraph, l. 4-7 [P. 37]).

With regard to all states designated in A1, Cl. 1 lacks inventive step over A2 (cited in A1) in view of A4 published 9.6.81.

A2 discloses all the features of the preamble of Cl. 1. The additional features of Cl. 1 provides the solution to the problem stated in A1, ie to provide a fireplace with no exhaust pipe above the fireplace (3rd paragraph, 1st sentence [P. 21]).

However, exactly the same problem was addressed by A4, l. 5-10 [P. 40]. A4 solved the problem with the same means as defined in Cl. 1, ie by a hollow base member (16, 22), see Fig. 2, forming part of the exhaust duct.

Therefore, giving the clear teaching of A4 it would be obvious to the skilled man to solve the (known) problem by combining A2 and A4 reaching the solution as defined in present Cl. 1.

It is also submitted that starting from A4, the skilled man would contemplate the additional features of A2 (over A4), ie glass panels and add these whenever considered appropriate, clearly A2 in l. 1 [P. 34] teaches to use such glass panels to provide better draught and more safety.

Claim 2 (dependent upon Cl. 1) lacks inventive step over A2 in view of A4.

Cl. 2 adds the features that (a) the walls of the combustion chamber form a transparent pyramide and (b) the exhaust duct inlet is located in the top of the combustion chamber.

Of these features, (a) is also known from A2, see 4th paragraph, l. 1-4 [P. 34]. This passage disclose that the lateral sides of the chamber may be formed by "upwardly converging glass panels" this clearly defining a pyramid. That the glass panels are transparent is clear from Fig. 1.

With regard to feature (b) this feature is also known from A4, providing a specific solution to the object stated in A1, see for example Fig. 2. For the same reasons as given for Cl. 1 above, the skilled man would readily appreciate the solution offered by A4 and adopt this for the fireplace known from A2, thereby arising at the subject-matter as defined in Cl. 2.

It is also submitted that starting from A4, the skilled man would consider the form offered by A2 and, without overcoming any technical problems, adapt this form for the fireplace of A4.

Claim 3 (dependent upon Cl. 1) lacks inventive step over A2 in view of A4 and A5 as on file with the EPO before the priority of A1 (29.10.91), see above under "other evidence".

As stated above, the combination of A2 with A4 (in both directions) lacks inventive step. Cl. 3 adds the feature that an automatic fan for draught control is provided. This feature has no essential functional relationship with the features as defined in Cl. 1. A5 discloses fan means for increasing draught in a fireplace, this in order to improve burning (see lines 1-4 [P. 57]). This information is also to be found in A5 as filed and published on 13.09.89. Given this teaching (and common knowledge as to burning characteristics in fireplaces) the skilled person would certainly add a fan whenever considered appropriate. A2 discloses that the (natural) inlet draught is sufficient, however, only for the purpose of protecting the panels from smoke discoloration, see last paragraph, l. 3-4 [P. 34].

A5 finally adds that control means responding to fumes detection may be added, this also being relevant to the present invention. The latter feature is only disclosed in the file copy of A5 (see above) but is also considered that adding such control means comes within what the skilled person would consider during a normal design procedure.

For the commonly designated states, Cl. 3 is not new over A3, which also discloses an exhaust blower (26) controlled (automatically) by a thermostat (28), see last paragraph [P. 37].

Claim 4 (dependent upon Cl. 1) lacks inventive step over A2 in view of A4, Cl. 9 adding the feature that the air inlet means are adapted to keep the glass panels free of soot.

However, this feature is also known from A2, see last paragraph, l. 3-4 [P. 34]. Regarding the combination of A2 and A4, see above.

Claim 5 (dependent upon Cl. 1) lacks inventive step over A4 in view of A2. A4 discloses all of the additional features defined in Cl. 5, ie: an ash collection chamber (17) formed in the upper

surface of the hollow base member (16), a removable closure plate (32) provided in the upper surface of the hollow base member, a sweeping box (30, 31) being located below the hollow base member, the closure plate and the sweeping box both being provided for removing soot, see last paragraph [P. 40].

For the non-inventive combination of A2 and A4, see the arguments forwarded under Cl. 2 above. In the case that it should be argued that the arrangement (30, 31) of A4 is not a "box" in the sense of A1, it is submitted that the provision of such a "box" comes within what the skilled person would consider having regard to the actual teaching of A4. For example, in the case of large amounts of soot, he would simply enlarge the pipe (30) under the fireplace, thus providing a "box".

Claim 6 is a process claim dep. upon Cl. 5. This is considered to mean that a process is defined which can be used with a fireplace as defined in Cl. 5.

A6 is an advertisement published in August 1992 and as Claim 6 has been added after filing of A1 on 28.10.92, A6 is clearly prior art with regard to this claim.

Claim 6 lacks inventive step over A6, disclosing that ashes are removed from an ash box down into a sweeping box (or ash drawer) when a plate is opened, the only difference being that in A1 the closure plate is removed whereas in A6 a valve plate is rotated. The substitution of the more complicated valve with a simple plate is considered a mere design option as the advantages can be readily contemplated in advance.



Notice of Opposition to a European Patent

To the
European Patent Office

Tabulation marks		for EPO use only	
I. Patent opposed Patent No. Application No. Date of mention of the grant in the European Patent Bulletin (Art. 97(4), 99(1) EPC)		Opp. No. OPPO (1) 0 502 660 B1 92301700.8 5.7.1995	
Title of the invention: Fire place			
II. Proprietor of the Patent first named in the patent specification Fire Design			
Opponent's or representative's reference (max. 15 spaces)		OREF	
III. Opponent Name Address State of residence or of principal place of business Telephone/Telex/Fax Multiple opponents		OPPO (2) Pyrovision S.A.R.L. Wissembourg France France ☐ further opponents see additional sheet	
IV. Authorisation 1. Representative (Name only one representative to whom notification is to be made) Name Address of place of business Telephone/Telex/Fax Additional representative(s) 2. Employee(s) of the opponent authorised for these opposition proceedings under Art. 133(3) EPC Authorisation(s) To 1./2.		OPPO (9) Jacques Eurie 103, Place Kléber F - 67000 Strasbourg ☐ (on additional sheet/see authorisation) OPPO (5) Name(s): ☒ - not considered necessary ☐ has/have been registered under No. ☐ is/are enclosed	

V. Opposition is filed against

— the patent as a whole ☒

— claim(s) No(s).

VI. Grounds for opposition:

Opposition is based on the following grounds:

(a) the subject-matter of the European patent opposed is not patentable (Art. 100(a) EPC) because:

— it is not new (Art. 52(1); 54 EPC) ☒

— it does not involve an inventive step (Art. 52(1); 56 EPC) ☒

— patentability is excluded on other grounds, i. e.

Art.

(b) the patent opposed does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 100(b) EPC; see Art. 83 EPC). ☐

(c) the subject-matter of the patent opposed extends beyond the content of the application/ of the earlier application as filed (Art. 100(c) EPC, see Art. 123(2) EPC). ☒

VII. Facts and arguments

(Rule 55(c) EPC)

presented in support of the opposition are submitted herewith on a separate sheet (annex 1) ☒

VIII. Other requests:

If the request of the opponent cannot be allowed, oral proceedings are requested.

for EPO use only

X. Payment of the opposition fee is made

☒ as indicated in the enclosed voucher for payment of fees and costs (EPO Form 1010)

☐

XI. List of documents

Enclosure
No.

No. of copies

- | | | |
|----|--|---------------------------------------|
| 0 | ☒ Form for notice of opposition | <input type="text"/> (min. 2) |
| 1 | ☒ Facts and arguments (see VII.) | <input type="text"/> (min. 2) |
| 2 | Copies of documents presented as evidence (see IX.) | |
| 2a | ☒ — Publications | <input type="text"/> (min. 2 of each) |
| 2b | ☐ — Other documents | <input type="text"/> (min. 2 of each) |
| 3 | ☐ Signed authorisation(s) (see IV.) | <input type="text"/> |
| 4 | ☒ Voucher for payment of fees and costs (see X.) | <input type="text"/> |
| 5 | ☐ Cheque | <input type="text"/> |
| 6 | ☐ Additional sheet(s) | <input type="text"/> (min. 2 of each) |
| 7 | ☒ Other (please specify here): | <input type="text"/> |

Form for acknowledgement of receipt.

**XII. Signature
of opponent or representative**

Place Strasbourg

Date 29.3.96

X

Please type name under signature. In the case of legal persons, the position which the person signing holds within the company should also be typed.