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D E C I S I O N
of 22 November 2005

Case Number: T 0640/03 - 3.5.02

Application Number: 95903035.4

Publication Number: 0734561

IPC: G08B 13/24

Language of the proceedings: EN

Title of invention:
Transponder for a detection system

Patentee:
Dutch A&A Trading B.V.

Opponent:
Meto International GmbH

Headword:

-

Relevant legal provisions:
EPC Art. 54, 56, 113(1), 114(2)

Keyword:
"Fresh prior art cited on appeal - highly relevant"
"Patent proprietor not represented at oral proceedings"
"Novelty (yes)"
"Inventive step (no)"

Decisions cited:

-

Catchword:

-



Case Number: T 0640/03 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 22 November 2005

Appellant: Meto International GmbH
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Representative: Menges, Rolf
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Respondent: Dutch A&A Trading B.V.
(Proprietor of the patent) Galvanistraat 24
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Representative: van Westenbrugge, Andries
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
21 March 2003 concerning maintenance of
European patent No. 0734561 in amended form.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: J.-M. Cannard
P. Mühlens

Summary of Facts and Submissions

- I. The opponent appealed against the decision of the opposition division concerning the maintenance of European patent No. 0 734 561 in amended form in accordance with the proprietor's auxiliary request filed on 11 February 2003 during the oral proceedings before the opposition division.
- II. During the appeal, the appellant referred *inter alia* to the following prior art documents:
- D1: US-A-4 910 625, considered during the proceedings before the opposition division, and
- D7: EP-A-0 319 248, and
- D8: EP-A-0 260 830,
- which were filed for the first time with the opponent's statement of grounds of appeal.
- III. Claim 1 as maintained by the opposition division reads as follows:
- "Transponder for a detection system, comprising a transmitter, for the production of a magnetic alternating field having a predetermined frequency, and a receiver, the transponder comprising a signal element made of soft magnetic material and the receiver being provided with a detector which detects higher harmonics of the frequency of the alternating field, which harmonics are generated by placing the transponder in the magnetic alternating field, in which the signal

element has the shape of a closed or open circular ring, **characterised in that**, at least one straight sub-element made of soft magnetic material extends from a point on the circular ring."

Claims 2 to 9 are dependent on claim 1.

- IV. In the statement of grounds of appeal and in a letter of response to the proprietor dated 8 March 2004, the appellant opponent argued, *inter alia*, that claim 1 as maintained by the opposition division lacked novelty, or lacked an inventive step, having regard to document D7. He requested oral proceedings.
- V. In a communication accompanying summons to oral proceedings, the Board observed that D7 did not disclose explicitly a circular ring and that the question "whether or not the disclosure of D7 makes it obvious to make a circular transponder with a straight portion extending from a point on the circular ring" could be discussed at the oral proceedings.
- VI. As announced in a letter dated 14 November 2005, the proprietor did not attend the oral proceedings which were held on 22 November 2005.
- VII. In the oral proceedings, the appellant opponent argued, *inter alia*, that the subject-matter of claim 1 did not involve an inventive step having regard to the combination of documents D1 and D7.

The transponder according to claim 1 differed from the transponder according to document D1, which had the shape of a circular ring, only by the feature "at least

one straight sub-element made of soft magnetic material extends from a point on the circular ring". Starting from D1, the technical problem consisted in reducing the sensitivity of the transponder to its orientation. Document D7 solved a similar problem in a polygonal transponder by arranging the strips forming the sides of the polygon so that they extended beyond their intersections. The transponder of claim 1 resulted from the obvious application of the technical measures known from D7 to the circular transponder of D1.

VIII. The written arguments of the respondent proprietor can be summarised as follows:

Document D7 did not disclose the combination of a closed circular ring and a straight sub-element which was made of soft magnetic material and extended from a point on the ring. If the number of pairs of strips used according to D7 was increased, the transponder would ultimately have formed a circular ring, because the length of the strip overlaps would have decreased with that of the strips and eventually be smaller than the width of the strips.

The transponder of claim 1 involved an inventive step. It was distinguished over the transponder of D7, which ultimately had the form of a circular ring, by at least a straight sub-element extending from a point on the ring. Such an additional sub-element provided the solution for obtaining a true omni-directional characteristic, as opposed to the multi-directional characteristic of the transponder of D7. Nowhere in documents D7 or D8 was there any indication to form a

transponder comprising a straight sub-element which extended from a point on a circular ring.

An apportionment of costs was requested because the proprietor had been compelled by the appellant to incur expenses for preparing for oral proceedings although the prior art documents submitted at the appeal stage were *prima facie* not relevant.

- IX. The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked.
- X. The respondent (patentee) requested that the appeal be dismissed. The patentee also requested an apportionment of costs.

Reasons for the Decision

- 1. The appeal is admissible.

Procedural matters

- 2. The present version of claim 1 of the patent was filed during oral proceedings before the opposition division. Document D7, which was cited for the first time with the opponent's statement of grounds of appeal, is *prima facie* highly relevant (see *infra* points 4 to 4.3) and clearly responsive to the reasons given in the contested decision, which, erroneously in the Board's view, placed emphasis on the claimed transponder being a two dimensional marker. Therefore, the Board admitted D7 into the proceedings.

3. According to Article 113(1) EPC, the decision "may only be based **on grounds or evidence** on which the parties concerned have had an opportunity to present their comments" (emphasis added by the Board). In the present case, the Board was able to take a decision at the end of the oral proceedings before the Board, as provided for by Article 11(3) and (6) of the Rules of procedure of the Boards of Appeal, since the requirements of Article 113(1) EPC are satisfied, as outlined below.

3.1 There was agreement between the parties during the opposition proceedings that D1 had to be considered as the closest prior art. This is apparent from the impugned decision and the acknowledgement of D1 in the amended description of the patent in suit.

3.2 In the statement of grounds of appeal, the opponent submitted that the subject-matter of claim 1 was not new, or at least lacked an inventive step, in view of the teaching of D7. In the communication annexed to the summons to attend oral proceedings, the Board made it clear that the question of whether or not the disclosure of D7 made it obvious to make a circular transponder with a straight portion extending from a point on the circular ring could be discussed at the oral proceedings.

3.3 Accordingly, the proprietor was aware of the ground and all the relevant facts and evidence on which the decision is based when he chose not to appear at the oral proceedings.

Inventive step

4. Claim 1, which has been amended during the opposition proceedings, has to be fully examined as to its compatibility with the requirements of the EPC. The subject-matter of claim 1 as approved by the opposition division is not to be considered as involving an inventive step within the meaning of Article 56 EPC in view of documents D1 and D7 taken in combination.
- 4.1 Document D1, which discloses a transponder for a detection system, in which the signal element has the shape of a closed circular ring (figures 1, 2 and 4; column 4, lines 2 to 24) is considered as the closest prior art (*supra* point 3.1). The transponder of claim 1 differs from the transponder described in D1 only in the characterising feature: "at least one straight sub-element made of soft magnetic material extends from a point on the circular ring".
- 4.2 Since a transponder having the shape of a circular ring already has a relatively good direction-insensitive response (as acknowledged in the patent application as filed (W095/16981), page 1, lines 31 to 33 and in the granted patent, page 2, lines 18 to 20), the technical effect provided by the invention appears to be an improved signal response, i.e. an improved pattern of the frequency spectrum for a minimum length of the transponder (patent specification, page 2, lines 34 to 43; page 3, line 48). The objective problem addressed by the invention thus could be seen as improving further the response signal produced by the transponder.

4.3 D7 (figures 1 and 2; page 3, line 48 to page 4, line 12; page 5, lines 31 to 39 and lines 53 to 55; page 6, lines 3 to 12 and lines 49 to 56, Table I and claim 1) discloses a transponder made of pairs of short strips which are arranged parallel to each other to form a closed planar shape, such as a square. When the ends of each strip are positioned to just overlap with the outside edge of an intersecting strip, or the strips are inset thus forming a "tic-tac-toe" configuration as in figures 1 and 2, the strips of one pair act as flux collectors to concentrate flux in the strips of the other pair, so that an improved high order harmonic, high sensitivity, multi-directional response is obtained for a minimum length of the transponder. The skilled man would understand from the teaching of D7 that straight sub-elements extending from the corners of a square transponder improved the response of the transponder compared with that of a circular ring transponder. By analogy, the skilled person would consider it worthwhile to try adding such straight sub-elements extending from points on the circular ring transponder of D1 to improve the response of this transponder. Such a modified circular ring transponder falls within the terms of claim 1 of the patent in suit.

5. The Board concludes therefore that the subject-matter of claim 1 does not involve an inventive step within the meaning of Article 56 EPC, so that the ground for opposition mentioned in Article 100a EPC prejudices the maintenance of the patent.

Apportionment of costs

6. The request for a different apportionment of costs in accordance with Article 104 EPC relates to the additional costs incurred by the respondent during the appeal proceedings because of the citation of fresh documents D7 and D8 in the statement of grounds of appeal, this being long after the nine-month period for filing an opposition. The request is refused because there is no reason to depart from the normal rule that each party meets its own costs according to Article 104(1) EPC, for the following reasons:

6.1 The present claim 1 results from amendments made in the course of the oral proceedings held by the opposition division. The introduction of fresh prior art, in particular D7, in support of the grounds of appeal appears to be a logical reaction to the reasons given in the decision under appeal, as explained above in paragraph 2. No provision of the EPC expressly forbids a losing opponent to file with the grounds of appeal new pieces of prior art. Such prior art may be disregarded in application of Article 114(2) EPC, or admitted into the proceedings if the Board judges it to be highly relevant and responsive to the reasons given in the appealed decision. Moreover, according to Article 10a(2) RPBA, the statement of grounds shall contain the appellant's complete case. The filing of D7 and D8 is thus not regarded by the Board as a late filing or an abuse of proceedings.

6.2 The documents D7 and D8 are both easily understandable and the statement of grounds of appeal indicates clearly why these new cited documents were thought to

be responsive to the reasons given in the contested decision. The introduction of D7 and D8 does not appear to have caused an unreasonable amount of work for the respondent during the appeal proceedings, since it is normal for a respondent to have to reply to a statement of grounds of appeal and to be summoned to oral proceedings in the course of an appeal.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for apportionment of costs is refused.

The Registrar:

The Chairman:

U. Bultmann

W. J. L. Wheeler