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D E C I S I O N
of 16 March 2006

Case Number: T 0442/04 - 3.2.07

Application Number: 93201252.9

Publication Number: 0569089

IPC: B65D 5/42

Language of the proceedings: EN

Title of invention:

Folded box with suspension means

Patent Proprietor:

Aarts, Mathieu

Opponents:

Cosack GmbH & Co. KG Druck und Verpackung
Werner Freiburg GmbH & Co. KG

Headword:

-

Relevant legal provisions:

EPÜ Art. 54, 56, 114

Keyword:

"Late filed documents - admitted"

"Alleged prior uses - not proven up to the hilt"

"Novelty (yes)"

"Inventive step (yes)"

Decisions cited:

T 0219/83, T 0472/92, T 0097/94, T 0750/94, T 1070/98

Catchword:

-



Case Number: T 0442/04 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 16 March 2006

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 3 February 2004
rejecting the opposition filed against European
patent No. 0569089 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. O'Reilly
Members: H. Hahn
C. Holtz
K. Poalas
E. Lachacinski

Summary of Facts and Submissions

- I. Opponents I and II lodged appeals against the decision of the Opposition Division to reject the oppositions and to maintain European patent No. 0 569 089 in unamended form. The case had previously been remitted to the Opposition Division by Board of Appeal 3.2.1 in accordance with decision T 1070/98.
- II. Two oppositions were filed against the patent as a whole, based on Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(b) EPC (that the patent 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).

The Opposition Division held that the alleged prior uses of both opponents had not been proven up to the hilt. The box of claim 1 differed from the box according to the closest prior art D15 (box I of Briloner Leuchten) by two features, namely it represented a cover integrally formed with one side wall at the upper edge of said side wall; and one of the side walls at its upper edge had been provided with an extension which was folded against the inner sides at two opposite side walls and another part which extended between said two opposite side walls beneath the level of the passages. The available written prior art, particularly E4, neither disclosed nor suggested such an arrangement.

- III. Together with the grounds of appeal dated 23 June 2003 appellant I (opponent I) filed the new documents D32 (Letter of R. Fricke dated 04.05.92 to the firm

Paul Neuhaus), D33 (Offer of Freiburg to Paul Neuhaus GmbH through sales representative Fricke dated 22.04.92) and D34 (Note of R. Fricke to the firm Paul Neuhaus dated 12.05.92) and argued with respect to a prior use of the firm "Neuhaus".

IV. With a communication dated 19 December 2005 and annexed to the summons to oral proceedings the Board presented its preliminary opinion based on claim 1 of the patent as granted.

V. Oral Proceedings before the Board were held on 16 March 2006. The following requests were made by the parties:

- (a) Appellant I and appellant II (opponent II) requested that the decision under appeal be set aside and the patent be revoked.
- (b) The respondent requested that the appeals be dismissed and the patent be maintained unamended.

VI. The following documents were considered in this decision:

D1 = Jobcard W3599, construction date 17.01.1992

D2 = Delivery note No. 54405 referring to W03599 dated 25.02.1992

D3 = Invoice No. 58994 referring to W03599 dated 25.02.1992

D7 = Report of meeting written by B. Vente dated 16.04.1992

D8 = Jobcard A230492 (23.04.1992)

D9 = Delivery note No. 1576 dated 04.05.1992
(versions with handwritten remarks made by Mr. B. Vente
and Mr. Rauterkus)

D12 = "Eidesstattliche Versicherung" of Mr. Rauterkus
dated 04.11.1997

D13 = "Eidesstattliche Versicherung" of Mr. B. Vente
dated 04.11.1997

D14 = Additional "Eidesstattliche Versicherung" of
Mr. B. Vente dated 23.07.1998 comprising a printout of
a back-up disc for April 1992

D15 = Drawing and model of Briloner box D1 (box I)

D20 = Drawings of Mr. Maat from TNO Institute of
Industrial Technology, 24 July 1998

D21 = Drawings of Mr. Müller from Fraunhofer Institut
für Materialfluß und Logistik, 14 July 1998

D25a = Offer of firm Freiburg dated 06.05.1992 sent to
firm Wortmann & Filz GmbH

D25b = Report of visit made by Mr. Rauterkus dated
13.05.1992

D27 = Confirmation of order No. 36072 sent to
Wortmann & Filz GmbH dated 04.06.1992

D27a = Confirmation of order No. 36072 obtained by
Wortmann & Filz GmbH dated 04.06.1992

D28 = "Eidesstattliche Versicherung" of
Mrs. Dr. A. Freiburg dated 08.12.2003

D29 = Drawing sheet of Mr. Fricke comprising dates of
04.05.1992 and 23.05.1997

D30 = "Eidesstattliche Versicherung" of
Mr. V. Wortmann dated 03.07.2000

D31 = Hearing of evidence of Mr. V. Wortmann dated
11.05.2001

B5 = Jobcard D290492L (W3278) dated 29.04.1992

B6 = Jobcard B 22 04 92 dated 22.04.1992

B7 = Jobcard G270492, construction date 27.04.1992

B8 = Jobcard D270492, construction date 27.04.1992

T2 = Expert opinion ("Abschlußbericht der
Durchsuchung") of Univ.Prof. Dr.Ing. R. Lohe dated
30.10.2000 with printout of back-up discs of April 92,
May 92 and June 92

T3 = Printout of back-up discs of April 92, May 92
and June 92

T8 = Supplement to the expert opinion of Univ.Prof.
Dr.Ing. R. Lohe of 30.10.2000 dated 03.06.2002

"Eidesstattliche Versicherung" of Mr. R. Fricke dated 05.11.1997

ECMA Codes, Den Haag, March 1993, Ed. 1.0, pages 10-16, 41-45, and 49-58

The written recordings of the testimonies given by the witnesses before the Opposition Division on 3 February 2003; Mr. B. Vente, Mr. V. Wortmann, Mr. H. Wortmann and Mr. R. Fricke, pages 1 to 25 and by Mr. H. Becker before the Opposition Division on 8 December 2003, pages 1 to 12

E2 = FR-A-2 576 288

VII. Independent claim 1 as granted reads as follows:

"1. A storage box folded from a blank, said storage box being provided with a bottom (12,13), upright side walls (1, 4, 5, 6) and a cover (19) integrally formed with one of the side walls (1) at the upper edge (18) of said side walls (1), whereby aligned passages (33, 34) are provided near the upper edges of two opposite side walls (1, 6), the aligned passages (33, 34) being located below the level of the cover (19), characterised in that one of the side walls (6) at its upper edge has been provided with an extension (27, 29, 31) which has parts (27, 31) which are folded against the inner sides at two opposite side walls (1, 6) and another part (29) which extends between said two opposite side walls (1, 6) beneath the level of the passages (33, 34)."

VIII. Appellant I has argued essentially as follows:

The prior use "Briloner Leuchten" is undisputed (see D1 to D3 and D15). From the descriptions given in D1 to D3 alone it is not possible to derive the exact form of the blank according to D15 used for making the boxes "Briloner I" which were sold. It is, however, clear that the boxes produced correspond to the jobcard D1 and the drawing D15. Thus the jobcard D8 having the reference number A230492 has to be seen in the context of these descriptions in D1 to D3 and in the context of the box described in the report D7 of the meeting of 16 April 1992. The delivery note D9 specifying said reference number A230492 at the first position gives a further description of the boxes delivered to Wortmann & Filz GmbH (hereinafter "WOFI") which is consistent with the drawing according to D8. It was Mr. Rauterkus who delivered the sample boxes according to construction number A230492 which corresponds to jobcard D8 (see D12). Subsequently, the offer D25a was made on 06.05.1992 in which position 1 corresponds to that of position 2 in D9. The offer D25a comprises a further description of the boxes. According to the report of meeting D25b dated 13.05.1992 all dimensions except that of position 1 were amended. The order confirmation D27 refers to the order of 22.05.1992 so that it is clear that the jobcards referenced to in D9 were produced on 23.04.1992, 27.04.1992 and 29.04.1992, respectively, and that they have not been amended (see T3). The file a230492 corresponding to the jobcard D8 has never been amended and would be sufficient to prove a prior use. The entry in the column "last date of work" according to T3 is made by the computer and cannot be amended by the user. Furthermore, all back-up

discs were collected by the police. The inconsistencies therein are caused by typing errors of Mr. Vente and presumably because he copied files without correcting all designations therein (such as the description "Rondell"). Although it is true that some files are missing, when considering that the file names on one day should start with an "a" and that a file with a first letter "m" can be found for 29.05.1992 in T3 without all consecutive files, this can easily be explained. Files with other letters than "m" were not finished and have not been saved since the person began a new file and gave it a name with a new letter. Another explanation would be that there were 3 CAD-stations so that Mr. Vente could have created jobcard files on one machine and then continued the construction on another machine. Furthermore, the persons working on the CAD-stations changed. The drawings shown by the respondent in the oral proceedings are speculative and do not prove that such boxes were actually made by the opponent. The descriptions given in D7, D9, D25a or D27 are clear, particularly when considering the ECMA Code, e.g. the code 2120 shows a box with tuck-in flaps on the main panel corresponding to "beiderseitig versetzt" (see ECMA Code, pages 45 and 53). The hand written remark on the external part of D27 submitted by the respondent, i.e. D27a, could have been made much later. The letter "L" was added to the file number when the corresponding tool was ordered and included the addition of the waste knives (see hearing of witnesses, B. Vente, page 12). The file of jobcard D290492L (B5) is not comprised in the print-out of the back-up discs of April 1992 but only in the June one. The number of figures mentioned in the file lists corresponds to the number of blocks

in a drawing and based on the type of graphic elements chosen may differ substantially for one and the same drawing (see hearing of witnesses, B. Vente, page 7, sixth paragraph; and T2, page 4, line 8). It is evident from the hearing of the witnesses that there existed no secrecy agreement (see D30, page 3, second paragraph; hearing of witnesses, B. Vente, page 8, fifth paragraph; "Eidesstattliche Versicherung" of H. Wortmann dated 31.05.2000; D12).

D15 represents the closest undisputed prior art which differs from the box according to claim 1 in that the aligned passages in parts 6, 8 are not below the level of the cover and in that the extension (i.e. parts 8, 9) is folded against an inner side of the sidewall (claim 1 requires extension parts that are folded). However, if the upper edge is interpreted as a cover then the condition that the aligned passages are below the cover would be met. The problem as defined in the patent in suit (see patent, column 1, lines 15 to 18) is already solved by D15. Taking account of the described advantages (see patent, column 1, lines 35 to 46) and of the statements in D7 the remaining problem can be defined as the provision of a more aesthetic product which is closed. The skilled person would have a look to E2 which reveals a closed box having a cover 4 (see E2, figure 1). Thus the skilled person would combine the teachings of D15 and E2 and thereby derive the subject-matter of claim 1. The advantages mentioned by the proprietor are not mentioned in the specification of the patent in suit so that this problem is not derivable. Therefore claim 1 lacks an inventive step.

IX. Appellant II has argued essentially as follows:

1992 represented the beginning of the electronic data processing which has to be considered under this aspect, which means that things were not always done in as well an organised manner as today. The description according to D7 was made for an insider only; for example Mr. Becker stated that he was not interested in this but only in the product (see hearing of the witness H. Becker, page 11, sixth paragraph). According to D7 all the samples were promised to be ready for 27 April 1992 but it was implicitly also acknowledged that there might be time problems. Sample 1 of D9, i.e. the box according to D8, was not accepted for some reason; however, the other samples were accepted. It is admitted that appellant II cannot know exactly what the delivered sample boxes looked like. On his delivery note D9, Mr. Rauterkus remarked that alternatives of the samples having a reinforced bottom part should also be offered to "WOFI". These alternatives are then mentioned in the offer D25a but were not followed up while the dimensions of positions 2, 3 and 4 of D9 were amended according to D25b. The whole proceeding was an ordinary business affair wherein the samples were presented two days before the priority date of the patent in suit. It is clear that the samples, particularly the one according to D8, were delivered to "WOFI" (see D12 and D13). All five samples had the same type of construction and differed only in their dimensions. As can be derived from D27 a tool having the number W3728, which corresponds to the tool number given on B5 having the dimensions mentioned therein was ordered. The statements made by Mr. V. Wortmann in documents D30, D31 and during the hearing of the

witnesses on 3 February 2003 are inconsistent and not credible. He was in need of justification after having made his first statement.

According to Prof. Lohe the meaning of the letter "L" is not clearly defined but pointed largely towards the ready condition of a drawing (see T8, page 5, second paragraph). The file d290492 always remained the same and the corresponding jobcard B5 comprises the tool number W3728. The jobcards B6 to B8 do not mention any tool number. The remark concerning all rights on D9 does not imply any secrecy agreement and, as proven by D25b, Mr. Rauterkus noted the prices of competitors for said boxes, which could either be based on a mere allegation or that actually prices were obtained from a third party. It was standard practice to get prices from competitors to reduce the price of the offer. This, however, implies that the competitor has seen the boxes. Claim 1 thus lacks novelty with respect to the public prior use "WOFI".

Claim 1 lacks an inventive step in view of a combination of D15 combined with E2 since the skilled person would close the balcony of D15 to provide a more aesthetic box than the Briloner box. The advantages of the patent in suit are as obvious as is the invention.

X. The respondent has argued essentially as follows:

The first meeting between firm Freiburg and the new client "WOFI" took place on 16 April 1992 (see D7). As the first drawing A230492 allegedly did not change, i.e. the concept had not changed, why did Vente not make the other drawings for the other dimensions before Monday

27 April 1992? There may have been problems in arriving at the solution. Normally there is a step by step development to reach the final design of a box. This view is confirmed by the two witnesses Mr. Becker and Mr. V. Wortmann who stated that there were several meetings to reach the construction of the box by a trial and error method. In the meeting of D7 nothing was said about the upper side reinforcement parts and the top lid (see D7). Both witnesses stated that the box was developed after 4 May 1992. Therefore it is unlikely that the box according to jobcard D8 was ready on 23 April 1992. Since the Briloner box represented the starting point the terms in the description thereof should have the same meaning (see D3) as for D7. There exist several possibilities for what could have been understood from the different descriptions of boxes given in documents D9, D25a and D27. This is also proven by the drawings made according to several different descriptions (see D20 and D21). It is unlikely that a "Verschluß" part is simply designated as "gerillte anhängende Lasche". Furthermore, D25a and D27 refer to a glued bottom part, the latter referring to "eins. Einsteckverschluß" whereas D27a, obtained from "WOFI" refers to a "doppeltem Einsteckverschluß", which indicates some changes of the construction (compare D27 and D27a). The box according to offer D25a was more like the Briloner box than the one according to the order confirmation D27. The basic questions to be answered for a prior use are: when and how was what and by whom disclosed? On 16 April 1992 no boxes covered by claim 1 were disclosed. Furthermore, since two firms started working together for the first time such a meeting will not be considered to be public but confidential. The same applies to the meeting of

4 May 1992. Only after the sale of these boxes is there no more confidentiality. There exists an implicit interest that third parties do not get to know the kind of boxes before they are put on the market (compare also D9). No evidence has been provided that boxes covered by claim 1 were available before 6 May 1992. It is also not necessary to show boxes to competitors to get an offer it is sufficient to specify the dimensions of the cardboard. It is curious that Mr. B. Vente stated that he needs several days for finishing a drawing while jobcard A230492 was finished on the same day (see hearing of witnesses, B. Vente, page 6, sixth paragraph). Thus the drawing of D8 does not reflect the design of the box in question. Furthermore, there does not exist a jobcard of a file a2304921. Mr. V. Wortmann was a witness of appellant II so he cannot now be considered by them to be a liar. Likewise Mr. B. Vente stated that Mr. Fricke would have been present at the meeting which was not correct (see D7) but he is nevertheless considered reliable by both appellants. It is very normal to forget dates except if something exceptional such as a birth or death occurred. Mr. Becker supports the case of a step by step development (see hearing of the witness Mr. H. Becker, pages 4 and 7 to 9). Neither document D12 nor D13 describes the box but these documents refer only to the delivery note D9. It is not certain what Mr. Vente and Mr. Rauterkus had seen according to their "Eidesstattliche Versicherung". Mrs. Freiburg did not show up as witness but stated that the developments of the boxes were made in May 1992 (see D28). Prof. Lohe stated that "kein Fachmann wird die hier zur Diskussion stehenden Massenspeicher als Fälschungssicher bezeichnen" (see T8, page 5). There exist no files in

the May/June print-out of the back-up discs supporting the allegation. The CAD-system provides one letter after the other so that the system cannot provide e.g. the letter "d" twice on a day such as d270492 or d270592. Therefore there existed presumably the corresponding "l"-files such as d270492l. Furthermore, there exist many files created or amended on a Saturday or a Sunday in June. As stated by Prof. Lohe the dates attributed by the computer to the back-up of the files are not reliable (see T8, page 3) and the filenames, dates and the content of the files could easily be manipulated. The "l" of the files has no clear meaning and could also be used for sending the file to the plotter (see T8, pages 4 to 5, page bridging paragraph). If the waste knives are added to the drawing of a jobcard then the number of figures should increase which is not the case for d290492l, made on 13 June 1992 (i.e. after the priority date) according to B5, which comprises less figures than the file d290592 allegedly made on 29 April 1992 and also less figures than the file d290492 made in June 1992 (compare D14 and T3). According to D25b "Einlagen" were needed for supporting the lamp within the box. It is unlikely to have a jobcard for both the box and the "Einlage". The print-out of the back-up discs does not disclose any file relating to such an "Einlage" and "WOFI". However, there exists a file m250592 made on 29 May 1992 relating to an "Einlage" but to a different firm "Sanitop" (see T3). Consequently, the appellants have not proven their case up to the hilt as required by decision T 750/94, OJ EPO 1998, 32.

Starting from D15 the problem is to provide an improved box which is stackable since the cover according to D15

can be easily pressed into the inner space and the open box collects dust. The box according to claim 1 is more stable and additionally allows the storage of further parts in the second compartment created between the balcony and the cover. In order to arrive at this solution there are two steps necessary:

- a) to replace the one lid 6 according to D15 by providing an extension part 27, 29, 31 having parts 27, 31 which are folded against the inner sides at two opposite side walls; and
- b) to add a flap on the lid 9 according to D15 at the other side to form the cover.

There are more amendments necessary than just adding a cover so that a combination of D15 with E2 does not result in a box according to claim 1. Furthermore, the object of E2 is a reel and this is the reason why the holes for the suspending means are placed in the corners of the box where the reel cannot interfere with the pin-shaped suspending means at a rack. According to the solution provided by the patent in suit the product cannot interfere with the suspending means since the product is in a different chamber (see column 3, lines 53 to 58). All the advantages are derivable for the skilled person and D15 was not known at the time when the application of the patent in suit had been drafted. Thus, the subject-matter of claim 1 involves an inventive step.

Reasons for the Decision

1. *Admissibility of late filed documents D27a and D32 to D34 and a copy of a "Verpackungsmuster"-Internal note of Werner Freiburg*

None of the parties objected to the late filing of these documents and the respondent actually appreciated the submissions made by appellant I since it had asked for these documents several times. The Board therefore exercised its discretion and allowed the introduction of D27a, D32 to D34 as well as the copy of a "Verpackungsmuster"-Internal note of Werner Freiburg into the procedure.

2. *Novelty (Article 54 EPC)*

In the present case all the asserted public prior uses took place within the premises of or at least within the environment of the two appellant/opponents, particularly that of appellant/opponent II.

- 2.1 According to the established jurisprudence of the EPO public prior uses have to be proven beyond any reasonable doubt in cases where practically all the evidence in support of an alleged public prior use lies within the power and knowledge of the opponent, so that the patent proprietor seldom has any access to it at all. In such cases the patent proprietor can in practice only challenge that evidence by pointing out any inconsistencies contained in it or by drawing the attention to any gaps in the chain of commercial transactions which needed to be established by the opponent in order to succeed on his ground. In these

cases an opponent has to prove his case up to the hilt (see Case Law of the Boards of Appeal of the European Patent Office", 4th Edition 2001, section VI.J.5(b); see particularly decision T 472/92, OJ EPO, 1998, 161, points 3.1 and 3.2; and decision T 97/94, OJ EPO, 1998, 467, point 5.1).

Prior use "Wortmann & Filz"

2.2 It is undisputed by all parties that two meetings took place on 16 April and on 4 May 1992 respectively between the firm Freiburg and the firm "WOFI" which was a new client of Freiburg and that the Briloner box I represented the starting point for the discussions of the new box to be developed (compare T 1070/98, not published, point 2 of the reasons).

2.2.1 These are the only facts which are undisputed by the parties. It is not clear what the boxes looked like which were delivered to "WOFI" on 4 May 1992. Although D7 includes a keyword-style description of the planned design of the storage box it does not allow the safe conclusion that these boxes had the form required by claim 1. On the contrary it is evident that the description in D7 is not consistent with said sample storage boxes delivered to "WOFI" on 4 May 1992. According to D7 both the top and bottom of the box had double tuck-in flaps ("beiders. doppelter Einsteckverschluß") while the boxes delivered according to D9 had double tuck-in flaps at the bottom and a single tuck-in flap at the top (compare D7 and D9). Additionally, there is no clear correlation between the "anhängende gerillte Lasche" at the top of the box, as mentioned in both D7 and D9, and the extension part

specified in claim 1 of the patent in suit which has parts folded against two opposite side walls of the box and another part extending therebetween beneath the level of the aligned passages. Furthermore, D7 is silent with respect to the upper reinforcement parts and the top cover.

2.2.2 The further descriptions of boxes given in the offer D25a and in the order confirmations D27 and/or D27a, which boxes are alleged to be identical with those of the sample storage boxes delivered on 4 May 1992, deviate from those given in D7 and D9. Hence these further descriptions do not remove the aforementioned inconsistencies but strengthen the same. The offered ECMA codes cannot remove these inconsistencies since the written descriptions which were used by Mr. B. Vente in the several documents are not in full agreement therewith. The respondent convincingly demonstrated during the oral proceedings before the Board that - based on each of these descriptions - boxes can be constructed which do not meet the requirements of claim 1. The same conclusion can also be drawn from the drawings made by two different skilled persons which were made on the basis of several different descriptions resulting in different boxes (see D20 and D21) which were not covered by claim 1. Thus, as admitted by both appellants, the written description given in documents D7, D9, D25a, D27 and/or D27a does not allow to conclusively derive what the boxes delivered on 4 May 1992 looked like.

In this context it is remarked that appellant II during the oral proceedings before the Board admitted that it

did not know exactly what the delivered sample boxes looked like.

With respect to the differing descriptions of the boxes in the several documents, which were explained by the appellants as Mr. Vente's attempt to improve the agreement of the descriptions with the ECMA codes, it appears to be more credible that the boxes actually were modified step-by-step as confirmed by the statements of the witnesses Mr. Becker and Mr. V. Wortmann (see point 2.2.6 below).

- 2.2.3 In this context the Board has also considered the statement of Mr. Rauterkus in his written affidavit about having personally delivered box samples (A 230 492) to "WOFI". Mr. Rauterkus stated that the sample *corresponded to or was analogous to* annex 12 of the grounds of opposition dated 22 May 1996 (see D12, second paragraph). Thus, the Board notes that Mr. Rauterkus did not state that the sample was identical to the box of annex 12.

Since document D12 does not contain a copy of annex 12 which was presented to Mr. Rauterkus, the respondent raised further doubts as to whether or not the content of this annex 12 was identical with document D8. Mr. Rauterkus might have shed some further light onto these issues but unfortunately he could not appear as a witness.

- 2.2.4 Both appellants argued that - taking account of the five box sample numbers quoted in delivery note D9, such as for example A230492 and D290492 - it was clear that the delivered five boxes met all the requirements

of claim 1 of the patent in suit since their submitted jobcards showed an identical type of construction of boxes only differing in their dimensions.

In this context, both appellants argued that the sample D290492 always remained the same since its dimensions were not amended and that the corresponding jobcard B5 comprises the tool number W3728 (compare D9, D25a, D27 and B5). They also admitted that the jobcards B6 to B8 do not mention any tool number. According to Mr. B. Vente said number D290492 corresponded to the file d290592 which was listed in the print-out of the back-up disc of April 92 (see D14 and T3; and hearing of the witnesses, B. Vente, page 7, third paragraph).

All these arguments cannot be accepted by the Board for the following reasons:

First of all, the Board considers that if it were true that jobcard D290492 (B8) remained unamended then the corresponding file for the jobcard made for the cutting tool W3728 should either read d2905921 or there should exist a file d290492 in the print-out of the back-up discs of May 92 or June 92 having the same content as the file d290592 contained in the list of April 92. One of these two files should then be found when considering that Mr. B. Vente at least in May 1992 would have realized that the numbering was incorrect. However, a file d2905921 could not be found on said print-outs. Only a file d290492 having a date of 13 June 1992 was found in the list of June 92 (see B10 and T3). Surprisingly, this file d290492 specifies **64** figures which number deviates from the figure number of 72 given for the file d290592 in the April list

(compare D14, B10 and T3) although it was alleged by both appellants that this file remained unamended. Hence this allegation is not credible.

Furthermore, if waste knives are added to the drawing of a jobcard then the number of figures is expected to increase and not to decrease. However, this is not the case for file d2904921 according to B5, allegedly made on 13 June 1992 (i.e. a Saturday and well after the priority date). The file d2904921 comprises only **13** figures and thus less than said file d290592, allegedly made on 29 April 1992, and fewer figures than the file d290492 likewise created on 13 June 1992 (compare D14, B10 and T3). The argument of appellant I that the number of figures mentioned in the file lists corresponds to the number of blocks in a drawing and, based on the type of graphic elements chosen, may differ substantially for one and the same drawing (see witness Vente, page 7, sixth paragraph; and T2, page 4, line 8) is not particularly relevant if the drawing as such remained unamended. Hence there exists another inconsistency of the electronic files in question, which could not be explained adequately by the appellants.

The Board concurs with the Opposition Division's view that the list of files should in principle follow a chronological progression in dates after each letter. However, it is not the case in the list of April 92, for example for the references under the positions 44, 73, 75, 76 and 89 (see D14 in combination with T3). Furthermore, these numerous anomalies appear to exist only in combination with the client "WOFI".

Appellant I offered several explanations for these anomalies. First of all, it stated that the inconsistencies in the lists are caused by typing errors of Mr. Vente, presumably because he copied files without correcting all designations therein, such as the description "Rondell". Secondly, it admitted that some files are missing, when considering that the file names on one day should start with an "a" and that a file with a first letter "m" can be found for 25.05.92 in T3 without all preceding consecutively numbered files. It further argued that the missing files can be simply explained by the fact that files with other letters than "m" were not finished and have not been saved since the person began a new file and gave it a name with a new letter. Another explanation would be that there were 3 CAD-stations so that Mr. Vente created jobcard files on one machine and then continued the construction on another machine. Furthermore, the persons working on the CAD-stations were changing.

Therefore, although the explanations offered to the existing inconsistencies may be possible explanations the Board remarks that they are not the **only** possible ones which exclude any other explanation.

In this light the statements of Prof. Lohe concerning the reliability of the dates attributed to the files on the back-up discs and concerning a falsification of the back-up disc (see T8, page 3, second paragraph; page 5, penultimate paragraph) has to be considered. Prof. Lohe came to the conclusion with respect to a possible falsification that there exist neither indications nor any proof that the hard-disc storage or the back-up discs have been tampered with although there exist

anomalies (see T2, page 5, paragraph "conclusion"; and T8, page 6, first to third paragraph). Prof. Lohe's expert opinion thus cannot support the appellants' case. What must have been required is an unequivocal proof that nobody could have falsified said storage means. Such evidence, however, has neither been submitted nor would it be credible, since it is common general knowledge that such electronic files, e.g. their content or their dates, easily can be amended at the will of the user.

In this context the Board notes that - differing to the statement of Mr. B. Vente - there were 3 CAD stations (see hearing of the witnesses, Mr. B. Vente, page 14, first paragraph) - Prof. Lohe specified only 2 CAD stations (see T2, page 3, point 1 "Rechnerkonfiguration").

2.2.5 As a consequence of the above considerations the Board comes to the conclusion that the submitted jobcards D8, B5, B6, B7 and B8 based on their corresponding electronic files cannot be considered as a reliable evidence of what type of boxes have been delivered to "WOFI" on 4 May 1992.

2.2.6 Furthermore, it has to be considered that the identity between the design of the sample boxes allegedly delivered to "WOFI" according to D9 and the blanks shown on the associated jobcards D8 and B5 to B8 is additionally called into question by the witnesses Mr. Becker and Mr. V. Wortmann who stated that there were several meetings to reach the construction of the box by applying the - usual - trial and error method (see hearing of witnesses, V. Wortmann, page 16, first

paragraph to page 17, third paragraph; and hearing of the witness Mr. Becker, page 4, fourth paragraph to page 5, fourth paragraph; page 9, eighth paragraph) which implies that the boxes delivered on 4 May 1992 did not meet the requirements of claim 1 of the patent in suit.

Since both witnesses, Mr. Becker and Mr. V. Wortmann, stated that the boxes were not like those according to D8 and that the reinforcements in any case were missing their statements differ diametrically from those of Mr. B. Vente who stated that the storage box samples were developed in April 1992, that they were ready on 4 May 1992 and corresponded to the jobcards specified in D9 (see hearing of witnesses, B. Vente, page 5, fifth paragraph to page 7, first paragraph; and page 8, third paragraph).

The aforementioned statement of Mr. B. Vente is also called into question by Mrs. Freiburg who stated in her "Eidesstattliche Versicherung" that these boxes were developed in May 1992 (see D28, page 2, second paragraph).

In this context the Board notes that all the witnesses were employees or clients of only the appellants. Mr. V. Wortmann, for example, was a witness offered by appellant II. Although there exist some inconsistencies in the different statements made by him as a witness and according to documents D30 and D31, he cannot be considered as being totally unreliable, particularly since his statement is confirmed by Mr. H. Becker. Furthermore, if the existence of any such inconsistencies in different statements would result in

the conclusion that a person making such inconsistent statements cannot be considered to be totally reliable, then the same conclusion should likewise apply to Mr. B. Vente. He stated as a witness, for example, that Mr. Fricke would have been present at the meeting with "WOFI" - which apparently was not correct (see D7) - and likewise declared that he needed several days for finishing the construction of one drawing according to a jobcard - which is inconsistent with, for example, the jobcards of files a230492 and d290492 since they were finished on the same day (see T3 and B10). Consequently, the arguments of both appellants that Mr. V. Wortmann may not be considered to be reliable, cannot be accepted by the Board.

2.2.7 Furthermore, both appellants argued that according to D7 it was implicitly acknowledged that there might have been time problems as to why the construction of the five samples could not be finished before the deadline of 27 April 1992 (as promised at least for the "1er und 2er Spot"; see D7).

However, taking account of the fact that the jobcard D8 - which allegedly existed on 23 April 1992 according to the back-up discs of April (see D14 and T3) - already contained the final construction of the storage box, and that the file b220492 corresponding to the "2er spot" and to position 3 of delivery note D9 allegedly had been started to work with on 22 April 1992, the explanation given by the appellants is not considered to be convincing by the Board.

This is because if the jobcard D8 actually existed on 23 April 1992 this would have implied that for the

other samples only the dimensions of the boxes had to be adapted, i.e. a less time consuming work which should have been done in a shorter period than the development of a new box design, particularly since file b220492 - which according to the jobcard B6 eventually contained the same construction as the file a230492 - had been created one day before the creation of D8. Furthermore, taking account of the facts that a) "WOFI" represented a new client and that b) these boxes were urgently needed by "WOFI", any firm would have tried everything to meet this promised deadline in order to satisfy the client. Therefore it is considered to be surprising that the firm Freiburg failed to meet this deadline. In this context the Board notes that Mr. B. Vente did not offer any particular explanation, such as exceptional circumstances, which hindered him to meet this deadline, particularly since he seemed to remember many other details concerning this offer to "WOFI".

2.2.8 Since it could not be established beyond any reasonable doubt what was available in the meeting on 4 May 1992 the Board sees no need to further deal with and to decide the issue of whether or not said prior use was public, i.e. non-confidential.

Prior use "Fricke"

2.3 Mr. Fricke stated in his "Eidesstattliche Versicherung" that the idea of closing the balcony at the top of the Briloner box with a cover was made by himself in December 1991 and that he had presented such a box to several potential clients including "WOFI" in

March/April 1992 (see "Eidesstattliche Versicherung" of Mr. R. Fricke dated 5 November 1997, pages 1 to 4).

- 2.3.1 In his hearing as a witness Mr. Fricke further stated that he had presented this Briloner box having a cover also to Mr. V. Wortmann either on 4 May 1992 or the last working day before the weekend, i.e. the Friday (see hearing of the witnesses, Mr. Fricke, pages 22-23). In this context the Board remarks that the last working day of the weekend before 4 May 1992 (i.e. a Monday) was, however, a Thursday since Friday was 1 May 1992, i.e. a public holiday.

Furthermore, Mr. V. Wortmann stated in the same hearing that he cannot remember such a meeting and that it is not probable that he had meetings with Mr. Fricke and with Mr. Rauterkus on the same day. He would remember these two meetings if the same packaging box would have been offered by Mr. Fricke and Mr. Rauterkus on the same day.

The Board is convinced that Mr. V. Wortmann would have remembered such a coincidence of receiving identical sample boxes or drawings from two different persons on 4 May 1992.

- 2.3.2 Mr. V. Wortmann further stated during the hearing in front of Mr. Fricke that he has never seen the drawings according to document D29 (see hearing of the witnesses before the Opposition Division on 3 February 2003, pages 23-25) which two hand drawings were stated to have been made by Mr. Fricke himself (see D29).

2.3.3 Document D29 as such does not prove anything since although carrying hand written dates of 04.05.92 and 23.05.97 it does not allow a deduction as to when it was produced and, as no further evidence was submitted, that it was actually sent or shown to someone and when this had occurred.

The same applies to Mr. Fricke's assertions concerning said Briloner type box having a cover which he allegedly presented in meetings and offered to potential clients for which also no pieces of evidence have been submitted.

2.3.4 The burden of proof invariably lies with the party claiming that the information in question was made available to the public before the relevant date (see "Case Law of the Boards of Appeal of the European Patent Office", 4th Edition 2001, section I.C.1.7.2). If the parties to the proceedings make contrary assertions and the European patent office is unable to establish the facts with sufficient certainty, it is the party having the burden of proof, i.e. whose arguments rest on the alleged facts who loses thereby (see decision T 219/83, OJ EPO 1986, 211, point 12).

2.3.5 Consequently, the Board considers that the alleged prior use "Fricke" has not been proven.

Prior use "Neuhaus"

2.4 Together with the grounds of appeal appellant I alleged another prior use through the delivery of boxes to company Neuhaus based on the job card A050592L.

2.4.1 First of all, the job card A050592L has never been submitted by either of the two opponents. Thus it has **not** been proven that the box according to this job card would have been in accordance with claim 1. Secondly, said job card has a construction date of 22.05.92 and **not** of 05.05.92 as alleged by appellant I (see T3, list of May 92, second line). Thus the construction of a box in accordance with this job card - the type of which is not known - is considered to have been made well **after** the priority date of the patent in suit.

2.4.2 The Board in exercising its discretion under Article 114(2) EPC therefore decided not to consider this alleged public prior use - which was presented for the first time in the present second appeal procedure - for not being *prima facie* relevant.

2.5 All other cited documents, particularly the ordinary written prior art including E2, are even less relevant to novelty than the boxes according to the alleged prior use "WOFI".

2.6 The Board therefore concludes that the subject-matter of claim 1 is novel with respect to the submitted documents and alleged prior disclosures.

3. *Inventive step*

3.1 *Closest prior art*

It was not contested that the Briloner box I according to D15 represents the closest undisputed prior art. This box comprises a first extension (i.e. a lid) 6 at the upper edge of a side wall and a second extension

comprising parts (lids) 8 and 9 at the upper edge of the opposite side wall (see D15). Each of said extension parts 6 and 8 comprises two Euro holes (see D15). When folded said extension part 9 forms the upper cover of the box. This upper cover part 9 has three rectangular extensions which, when folded, are inserted into corresponding holes provided in the two extension parts 7 and said first extension part 6 whereby a balcony at the top of the box is formed.

The storage box according to claim 1 of the patent in suit differs from said Briloner box I in that:

- a) the box has a cover integrally formed with one of the side walls at the upper edge of said side wall; and
- b) one of the side walls at its upper edge is provided with an extension having parts, which are folded against the inner sides at two opposite side walls and another part which extends between said two opposite side walls beneath the level of the passages (i.e. the Euro holes).

3.2 *Problem to be solved*

The Board concurs with the respondent that the problem to be solved is to provide an improved storage box which is stackable and which can be suspended from a rack or the like (see patent, column 1, lines 15 to 18; figure 2).

3.3 *Solution to the problem*

The problem is solved by a storage box as defined in claim 1.

It is credible that the claimed measures provide an effective solution to the technical problem. The storage box according to claim 1 is stackable and it is more stable than the Brilloner box I.

3.4 The Board considers that the subject-matter of claim 1 is not obvious for the person skilled in the art for the following reasons:

3.4.1 Appellant I argued that the problem as defined in the patent in suit (see patent, column 1, lines 15 to 18) is already solved by D15 and defined the objective problem taking account of the described advantages (see patent, column 1, lines 35 to 46) and of the statements in D7 as the provision of a more aesthetic product which is closed. Likewise appellant II defined the problem as being the provision of a more aesthetic box. These definitions of a different problem were, however, based on an interpretation of the box according to D15 which is unacceptable from the Board's point of view. According to this interpretation the upper edge of the box of D15 was considered as forming the cover whereby the condition of the aligned passages being below the cover would be met so that the two distinguishing features were - incorrectly - reduced to just one. Consequently, these arguments cannot be accepted. During the oral proceedings appellant I actually had admitted that the box according to D15 differs from that according to claim 1 in that a) the aligned passages contained in parts 6, 8 are **not** below the level of the cover, and b) in that the extension (i.e. parts 8, 9) is folded against an inner side of the

sidewall while claim 1 of the patent in suit requires extension parts which **are** folded.

3.4.2 Both appellants argued that the skilled person in order to provide a more aesthetic box would have a look at E2 which reveals a closed box having a cover 4 (see E2, figure 1). Thus the skilled person would combine the teachings of the Briloner box I - being represented by D15 - and E2 and thereby derive the subject-matter of claim 1.

These arguments cannot be accepted since in order to arrive at the claimed solution there are two steps necessary:

a) to replace the one extension part (lid) 6 according to D15 by providing an extension part 27, 29, 31 having two additional parts 27, 31 which are folded against the inner sides at two opposite side walls and which contain passages 36 and 37 (i.e. two Euro holes); and
b) to redesign the extension parts 8 (which forms a reinforcing part containing the passages or Euro holes) and 9 (which forms the cover) according to D15 at the opposite side of the box by providing a rectangular cover part 19 having a lip 21 containing a passage 35 (i.e. one Euro hole) to form the cover according to claim 1.

Thus, there are more changes necessary than just adding a cover to the box of D15. A mere combination of D15 with E2 does not result in a box according to claim 1. It has also to be considered that the object to be packed in the box of E2 is a reel. This is also the reason why the holes for the suspending means are

placed in the corners of the box, where the reel cannot interfere with the pin-shaped suspending means of a rack (see page 1, lines 1 to 3; page 2, lines 26 to 39; figure 1). Contrary to that, the holes according to the storage box of D15, which is intended to contain lamps, contains two holes, one in the middle and one at the corner of the upper part of the sidewalls of the box **but above** the chamber of the box. Thereby the suspending means are also prevented from interfering with the packed lamps. This fact, however, is considered to prevent the skilled person from combining the differing teachings of D15 and E2. It is also considered that the box according to D15 contains two holes because it is designated to store a lamp whose weight, particularly the weight of the transformer for the halogen lamps, is not evenly distributed with respect to its dimensions and that the box normally contains only one hole in the middle of said upper part if the weight of the lamp is evenly distributed. Furthermore, both documents D15 and E2 teach the skilled person to provide one cover but neither gives any hint to nor suggests replacing this one cover by two covers to thereby create a second chamber.

According to the solution provided by the patent in suit the product to be packed cannot interfere with the suspending means since the product is in a different chamber (see patent, column 3, lines 53 to 58).

- 3.4.3 Furthermore, the appellants argued that the advantages mentioned by the respondent are not mentioned in the specification of the patent in suit so that the problem as defined in point 3.2 above is not derivable.

These arguments cannot be accepted since the advantageous stackability and the higher stability of the boxes according to claim 1 is derivable for the skilled person from the drawing of figure 2 while the possibility of storing further parts in the second chamber is self-evident.

3.4.4 The subject-matter of claim 1 thus involves an inventive step within the meaning of Article 56 EPC.

Order

For these reasons it is decided that:

The appeals are dismissed.

The Registrar:

The Chairman:

G. Nachtigall

P. O'Reilly