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**Datasheet for the decision
of 15 June 2021**

Case Number: T 0107/18 - 3.2.08

Application Number: 09802199.1

Publication Number: 2347078

IPC: E05G1/12, E05G1/14

Language of the proceedings: EN

Title of invention:

A SECURITY APPARATUS AND METHOD FOR STORING OR TRANSPORTING
VALUABLES

Patent Proprietor:

Spinnaker International Limited

Opponents:

Oberthur Cash Protection
Cennox AB

Headword:

Relevant legal provisions:

EPC Art. 54, 56, 83
RPBA Art. 13(3)

Keyword:

Novelty - main request (no)

Inventive step - auxiliary requests 1 - 3 (no) - auxiliary request 4A (yes)

Sufficiency of disclosure - (yes)

Late-filed request - adjournment of oral proceedings would have been required (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0107/18 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 15 June 2021

Appellant:
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Decision under appeal:
Decision of the Opposition Division of the
European Patent Office posted on 3 January 2018
revoking European patent No. 2347078 pursuant to
Article 101(3) (b) EPC.

Composition of the Board:

Chairwoman P. Acton

Members: M. Foulger

 Y. Podbielski

Summary of Facts and Submissions

- I. With the decision posted on 3 January 2018, the opposition division revoked the European patent No. 2 347 078.
- II. The opposition division found that the subject-matter of claim 1 of the main request and the then valid second auxiliary request was not new with regard to D18 (EP 1 653 037 A1). The then valid first auxiliary request was found not to meet the requirements of Article 123(2) EPC. The subject-matter of claim 1 of the then valid third auxiliary request was found to lack an inventive step in view of the combination of the teachings of D10 (FR 2 888 604 A) with those of D18.
- III. The patent proprietor filed an appeal against this decision.
- IV. Oral proceedings took place before the Board by video-conference on 15 June 2021.
- V. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted, or that the patent be maintained on the basis of one of auxiliary requests 1 - 3 filed with the statement setting out the grounds of appeal or on the basis of one of auxiliary requests 4A and 5A filed with letter dated 9 March 2020.
- VI. The respondents requested that the appeal be dismissed.
- VII. The following documents are relevant for this decision:

D3: FR2822880 A1

D10: FR2888604 A1

D18: EP 1 653 037 A1

E1: "Report for Spinnaker Patent EP1653037A1", Prof.
Akhavan, 13 December 2019

VIII. a) Main request

Claim 1 reads as follows:

"Apparatus (10) for storing or transporting a valuable item, the apparatus (10) comprising a compartment (18) for receiving an item to be stored or transported, a detection system (26) which is operative to detect interference with the apparatus (10) and a dispensing mechanism (60) comprising first and second dispensing means (74, 76), **characterised in that** the dispensing mechanism (60) is operative, on detection of interference with the apparatus (10), to dispense a first part of a degrading agent through one of the dispensing means (74, 76) onto the item and to dispense a second part of the degrading agent through the other of the dispensing means (76, 74) onto the item such that the first and second parts of the degrading agent mix with each other on the item and render the item unusable."

b) First auxiliary request

Claim 1 reads as follows:

"Apparatus (10) for storing or transporting a valuable item, the apparatus (10) comprising:
a compartment (18) for receiving the item to be stored or transported,
a detection system (26) which is operative to detect

interference with the apparatus (10);
a first reservoir (62) containing a priming agent of a degrading agent;
a second reservoir (64) containing an activation agent of the degrading agent;
wherein the degrading agent is ineffective until the priming agent and the activation agent are mixed together;
a dispensing mechanism (60) comprising first and second dispensing means (74,76), characterised in that the dispensing mechanism (60) is operative, on detection of interference with the apparatus (10), to dispense the priming agent through one of the dispensing means (74,76) into the compartment (18) and to dispense the activation agent through the other of the dispensing means (76, 74) into the compartment (18) such that priming agent and the activation agent mix in the compartment (18) in a manner such that the priming agent and the activation agent would mix on the item contained in the compartment (18) and render the item unusable."

c) Second auxiliary request

The following feature is added to 1st auxiliary request:

"wherein the dispensing mechanism is arranged to dispense the priming agent and the activation agent separately."

d) Third auxiliary request

The following feature is added to the 1st auxiliary request:

"wherein the item comprises bank notes."

e) Auxiliary request 4A

Claim 1 reads as follows:

"Apparatus (10) for storing or transporting a valuable item, the apparatus (10) comprising:

a compartment (18) for receiving the item to be stored or transported;

a detection system (26) which is operative to detect interference with the apparatus (10);

(1) a first reservoir (62) containing a priming agent of a degrading agent;

(2) a second reservoir (64) containing an activation agent of the degrading agent;

wherein the degrading agent is ineffective until the priming agent and the activation agent are mixed together; and

(3) a dispensing mechanism (60) comprising respective first and second pressure valves (66,68) wherein the first and second reservoirs (62,64) each communicate with a respective one of the respective first and second pressure valves (62,64), wherein the first and second pressure valves (66,68) each communicate with a respective conduit (70,72), and wherein each respective conduit (70,72) terminates in a spray head (74,76),

characterised in that

the dispensing mechanism (60) is operative, on detection of interference with the apparatus (10), to dispense the priming agent through one of the spray heads (74, 76) into the compartment (18) and to dispense the activation agent through the other of the spray heads (76, 74) into compartment (18) such that the priming agent and the activation agent mix in the compartment (18) in a manner such that the priming

agent and the activation agent would mix on the item contained in the compartment (18) and render the item unusable."

The feature numbering was added in bold by the Board.

IX. The appellant argued essentially as follows:

a) Main request - Novelty

The claim had to be read with "synthetical propensity" and with a mind willing to understand. D18 did not disclose first and second parts which mixed on the item. In particular, the arrows 7 in Fig. 2 show that the products in the reservoirs are projected directly on the valuable item. The arrows 5 between indicate that there is a gas flow which separates the two flows of the degrading agent. Thus, there was no mixing on the valuable item. Moreover, taking into account the overall disclosure of the patent, the first and second parts of the degrading agent had to be different agents, which was not the case in D18.

b) First auxiliary request

i) Novelty

D18 did not disclose what the reservoirs contained. Thus, at least for this reason, the subject-matter of claim 1 was new.

ii) Inventive step

D18 was not directed towards achieving a mixing of the reagents on the valuable items. Thus, the skilled person would have no reason to consider putting a

priming agent in one reservoir and an activation agent in the other reservoir. Moreover, the expert opinion E1 showed that such a mixing was unlikely.

Thus, the subject-matter of claim 1 also involved an inventive step.

c) Second and third auxiliary requests

As for the first auxiliary request, the subject-matter of claim 1 of these requests was also new and inventive.

d) Auxiliary request 4A

i) Admittance

This request was submitted in response to the Board's communication. It was dealt with in the impugned decision. Moreover, it had been filed well in advance of the oral proceedings. Thus, it did not raise any issues that would require postponement of the oral proceedings.

ii) Inventive step

D10 did not disclose the feature relating to the arrangement of the dispensing mechanism (feature 3). The valve in D10 was arranged between the pressure and the reservoirs. Moreover, the contents of the reservoirs (features 1 and 2) was not disclosed in D10.

None of the cited documents disclosed such a dispensing mechanism. In particular, D3 and D18 used pyrotechnic devices in which it would not be obvious to use valves. Consequently there was no hint that would enable the

skilled person to arrive at the subject-matter of claim 1.

iii) Sufficiency of disclosure

One embodiment of the invention was shown in Figure 5 of the patent. In order to ensure that the degrading agents mixed on the valuable items the skilled person would direct the spray heads appropriately, if necessary using a certain amount of trial and error.

Thus, the patent disclosed the invention in a manner sufficiently clear and complete for the skilled person to carry it out.

X. The respondents argued essentially the following:

a) Main request - Novelty

The subject-matter of claim 1 was not new. D18 disclosed an apparatus for storing or transporting a valuable item (9), the apparatus comprising a compartment (8) for receiving an item to be stored or transported, a detection system (11) which is operative to detect interference with the apparatus and a dispensing mechanism comprising first and second dispensing means (the two reservoirs 2). Upon detection of interference with the apparatus, the pyrotechnic devices were set off which forced the products in the reservoirs through the grill. Given the turbulence that would be expected to occur due to the pyrotechnics, it was certain that the contents of the two reservoirs would mix on the valuable items.

Hence, all features of claim 1 were known from D18.

b) First auxiliary request

i) Novelty

D18 disclosed in paragraph [0030] that the reagents react with each other. This meant that there was one degrading agent which may be regarded as a priming agent and the other which may be regarded as an activation agent.

ii) Inventive step

Even if D18 did not specifically disclose which reagent was contained in which reservoir, this was a simple and obvious design choice for the skilled person.

The skilled person would thus have arrived at the subject-matter of claim 1 without the exercise of inventive activity.

c) Second and third auxiliary requests

The further features of these requests were disclosed in D18, see Fig. 1B and paragraph [0027]. The subject-matter of claim 1 of these requests thus also lacked an inventive step.

d) Auxiliary request 4A

i) Admittance

This request was filed after the reply to the appeal. It was thus an amendment to the appellant's case and should not be admitted.

ii) Inventive step

D10 was regarded as the closest prior art and disclosed:

an apparatus (10) for storing or transporting a valuable item (14), the apparatus comprising a compartment (12) for receiving the item to be stored or transported;

a detection system which is operative to detect interference with the apparatus (10);

a first reservoir (18)

a second reservoir (20);

wherein the degrading agent is ineffective until the priming agent and the activation agent are mixed together; and

a dispensing mechanism (see Fig. 1) comprising respective first and second pressure valves ("moyens commandés du type électrovanne" - see p. 5, l. 5 - 6) wherein the first and second reservoirs each communicate with a respective one of the respective first and second pressure valves, wherein the first and second pressure valves each communicate with a respective conduit (24) and wherein each respective conduit terminates in a spray head (16), wherein

the dispensing mechanism is operative, on detection of interference with the apparatus, to dispense the priming agent through one of the spray heads into the compartment and to dispense the activation agent through the other of the spray heads onto the item such that the priming agent and the activation agent would mix with each other on the item contained in the compartment and render the item unusable.

The subject-matter of claim 1 merely differed in that the first reservoir contained a priming agent of a degrading agent

and that the second reservoir contained an activation agent of the degrading agent.

The claim merely required that the valves were connected to the reservoir, this requirement was clearly fulfilled in the arrangement shown in D10. The valve could be regarded as being connected to the conduit terminating in a spray head because there was a fluid connection between them.

If it were to be considered that the claim required a certain arrangement of the valve, reservoir and spray head, then the skilled person would change the location of the valve shown in D10 so that a valve was positioned in each conduit between the reservoir and the spray head as a simple design choice.

Moreover, both D18 and D3 disclosed that different agents could be stored in the respective reservoirs so that for the skilled person this would be a simple design choice.

Thus, the skilled person would thereby arrive at the subject-matter of claim 1 without the exercise of inventive skill.

iii) Sufficiency of disclosure

The patent did not disclose how the invention should be carried out, in particular it was not disclosed how the reagents were directed so that they mixed on the valuable items.

Reasons for the Decision

1.

Main request - Novelty

It is common ground that D18 discloses an apparatus for transporting a valuable item, in particular:

An apparatus for storing or transporting a valuable item (9), the apparatus comprising a compartment (8) for receiving an item to be stored or transported, a detection system (11) which is operative to detect interference with the apparatus and a dispensing mechanism comprising first and second dispensing means (the two reservoirs 2 with associated pyrotechnics).

The appellant argues however that D18 disclosed neither different first and second parts nor that they mixed on the item. In particular, the arrows 7 in Fig. 2 show that the products in the reservoirs are projected directly on the valuable item. The arrows 5 between the arrows 7 indicate that there is a gas flow which separates the two flows of the degrading agent.

Furthermore, the appellant argues that the claims should be interpreted with "synthetical propensity" to arrive at a sensible interpretation of the claim. The Board would like to stress that it is, however, important to consider which elements are included in the scope of the claim because according to Article 84 EPC it is the claims that "define the matter for which protection is sought". Hence, "synthetical propensity" should not be used to include elements in the claim which are not actually claimed and appear solely in the description and figures.

It is to be noted that the valuable item is not actually part of the claimed apparatus but rather that the apparatus should merely be suitable for the stated purpose. Hence, whether a mixing actually takes place depends very much on the volume and shape of the valuable item. Furthermore, in paragraph [0030] of D18, it is clearly disclosed that the degrading agents react with each other to render the valuable goods unusable. Moreover, due to the use of pyrotechnics there will be considerable turbulence within the compartment such that degrading agents from each of the reservoirs would mix on the valuable items.

The argument that the claimed apparatus dispensed first and second parts of different composition of the degrading agent is similarly unpersuasive. The claim only provides for a dispensing mechanism which can dispense a first and second part of the degrading agent onto the item. The claim does not specify that the first and second parts must be different compositions.

Moreover, D18 also discloses that:
the dispensing mechanism is operative, on detection of interference with the apparatus, to dispense a first part of a degrading agent through one of the dispensing means onto the item and to dispense a second part of the degrading agent through the other of the dispensing means (it may be seen from Fig. 2 that the product from each reservoir passes separately through the grill 3 onto the items in the compartment) onto the item such that the first and second parts of the degrading agent mix with each other on the item and render the item unusable.

Hence, all features of claim 1 are known from D18.

2. First auxiliary request

2.1 Novelty

This request further specifies that the first reservoir contains a priming agent of the degrading agent and that the second reservoir contains an activation agent of the degrading agent, wherein the degrading agent is ineffective until the priming agent and the activation agent are mixed together.

D18 discloses in paragraph [0030] that the reagents react with each other, but not however what the reagents actually are. Thus, there is no specific disclosure of a priming agent and an activation agent. The fact that two different reagents are present does not directly and unambiguously disclose that one is a priming agent and the other is an activation agent.

Hence, the subject-matter of claim 1 is new.

2.2 Inventive step

D18 is the closest prior art from which the subject-matter of claim 1 differs in that the first reservoir contains a priming agent and the second reservoir contains an activation agent, wherein the degrading agent is ineffective until the priming agent and the activation agent are mixed together.

The technical effect of these features is to improve the reliability of the apparatus by reducing the possibility that the valuable item is rendered unusable by one of the agents being accidentally dispensed.

The use of a priming agent and an activation agent is common in the art. The skilled person faced with the problem of improving the reliability of the apparatus would consider this possibility and apply it to solve the above problem.

Although D18 does not address the issue of the contents of the two reservoirs mixing on the valuable item, this cannot contribute to the existence of an inventive step because as discussed above for the main request whether mixing actually takes place depends on the shape and form of the valuable item which is not specified in the claim. The expert opinion also does not address the influence of these factors. Thus, the argument that the skilled person would not use priming and activation agents because the products of D18 did not mix is not persuasive.

Therefore, the subject-matter of claim 1 does not involve an inventive step.

3. Second and third auxiliary requests

The further feature of claim 1 of these requests are also known from D18. From Fig. 1B of D18 it can be seen that the two reservoirs dispense their contents onto the valuable items separately (extra feature of auxiliary request 2). Moreover, D18 discloses the use of bank notes as the valuable item - see paragraph [0025] (extra feature of auxiliary request 3).

Hence the above conclusion also applies to these requests.

4. Auxiliary request 4A

4.1 Admittance

The summons to oral proceedings was sent on 5 November 2019, i.e. before the entry into force of the RPBA 2020. Thus, according to Article 25(3) RPBA 2020, Article 13(2) RPBA 2020 shall not apply, instead Article 13 RPBA 2007 applies to the current case. As the amendment to the appellant's case was made after oral proceedings had been arranged Article 13(3) RPBA 2007 is applicable.

The amendments to the appellant's case, i.e. auxiliary requests 4A and 5A, were filed on 9 March 2020. Thus, there is no doubt that the respondents had time to prepare to discuss them. Moreover, auxiliary request 4A is identical to auxiliary request 3 on which the opposition division decided upon in their decision. Therefore, no issues were raised by this request which the respondents could not be expected to deal with without adjournment of the proceedings.

This auxiliary request was thus admitted into the proceedings.

4.2 Inventive step

D18 cannot be regarded as closest prior art for this request because D18 concerns an apparatus which functions with pyrotechnics in which it would not be obvious to introduce valves as claimed. Nor was this argued by the respondents.

It is common ground that D10 represents the closest prior art and discloses:

An apparatus (10) for storing or transporting a

valuable item, the apparatus (10) comprising
a compartment (12) for receiving the item to be stored
or transported,
a detection system (p. 4, l. 25 - 30) which is
operative to detect interference with the apparatus
(10).

D10 discloses first and second reservoirs but does not
disclose what they contain. Furthermore, D10 discloses
a valve between the pressure source and the reservoirs.
The claim however requires that the valve communicates
with the conduit which terminates in a spray head. By
contrast, in the arrangement of D10, the reservoir
communicates directly with the conduit which terminates
in a spray head without any intermediate valve.

In this respect, the argumentation of the respondents
whereby "communicate" could also encompass the meaning
of being connected to via the reservoir is not
persuasive. Taking the normal reading of "communicate"
i.e. opening into each other or to be connected by a
channel excludes this sense. Thus, the feature 3 of
claim 1 whereby the dispensing mechanism comprises
respective first and second pressure valves wherein the
first and second reservoirs each communicate with a
respective one of the respective first and second
pressure valves, wherein the first and second pressure
valves each communicate with a respective conduit and
wherein each respective conduit terminates in a spray
head, is not known from D10.

The problem solved by having separate pressure valves
is to provide an apparatus wherein the probability of
the valuable items accidentally being rendered unusable
is reduced.

According to the respondents, the skilled person would change the location of the valve shown in D10 so that a valve was positioned in each conduit between the reservoir and the spray head. This would be a simple choice for the skilled person who would thereby arrive at the subject-matter of claim 1 without the exercise of inventive skill.

This is not convincing because there is no hint in the prior art that would motivate the skilled person to alter the apparatus of D10 in this manner, in particular D3 and D18 disclose pyrotechnic devices which do not use valves and thus offer no suggestion that would enable the skilled person to arrive at the claimed solution.

Thus, the subject-matter of claim 1 involves an inventive step.

4.3 Sufficiency of disclosure

The patent gives one example in the embodiment of Fig. 5 of how to carry out the invention. In order to ensure that the degrading agents mixed on the valuable items as claimed it may be that the skilled person would need to use some trial and error. This is however part of the skilled person's abilities which does not require inventive activity. The skilled person would thus be able to put the invention into practice and the requirements of Art. 83 EPC are fulfilled.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended form with the following claims and a description to be adapted thereto:
Claims 1-16 of auxiliary request 4A filed with letter dated 9 March 2020.

The Registrar:

The Chairwoman:



D. Magliano

P. Acton

Decision electronically authenticated