

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N^o du recours : T 330/88 - 3.2.1

Anmeldenummer / Filing No / N^o de la demande : 82 850 107.2

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 066 561

Bezeichnung der Erfindung: File for paper or the like
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : B65D 1/22, B42F 7/02

ENTSCHEIDUNG / DECISION

vom / of / du 22 March 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Esselte Dymo AB

Einsprechender / Opponent / Opposant :

Bantex A/S

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Article 56, 104, 113

Schlagwort / Keyword / Mot clé :

"Inventive step (yes) - apportionment of
costs (no) - procedural violation (no)"

Leitsatz / Headnote / Sommaire



Case Number : T 330/88 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 22 March 1990

Appellant : Esselte Dymo AB
(Proprietor of the patent) Box 376
S-631 05 Eskilstuna (SE)

Representative : Lindblad, Sture
FAMTEC
Box 7574
S-103 93 Stockholm (SE)

Respondent : Bantex A/S
(Opponent) Solvang 14
DK-3450 Allerød (DK)

Representative : Körber, Wolfhart, Dr.
Mitscherlich & Partner
Steinsdorfstraße 10
D-8000 München 22 (DE)

Decision under appeal : Decision of Opposition Division of the European Patent
Office dated 30 May 1988 revoking European patent
No. 0 066 561 pursuant to Article 102(1) EPC.

Composition of the Board :

Chairman : F. Gumbel
Members : F. Brösamle
J-C. Saisset

Summary of Facts and Submissions

I. European patent No. 0 066 561 was granted with five claims on the basis of European patent application 82 850 107.2 on 11 July 1984.

II. The patent was opposed on 11 April 1985 by Bantex A/S. The Opponent (Respondent) requested revocation of the patent on the grounds of Articles 52 to 57 and 100(a) EPC in the light of

(D2) US-A-1 127 902,

and at the oral proceedings held on 11 and 12 November 1986

(D1) DE-U-7 622 389

was cited by the Respondent.

In the course of the proceedings before the Opposition Division following the oral proceedings, the patentee (Appellant) modified the set of claims several times, for instance with letters of 7 April 1987, of 23 September 1987 and of 23 December 1987. The Opposition Division on the other hand brought forward an objection under Article 83 EPC with its communication of 10 June 1987.

III. By its decision dated 30 May 1988 the Opposition Division revoked the European patent 0 066 561 for reasons of insufficient disclosure under Article 100(b) EPC.

IV. The Appellant appealed against this decision on 6 July 1988 and paid the appeal fee on the same day. The

Statement of Grounds of Appeal was filed on 23 September 1988 together with a claim version "D1" comprising Claims 1 to 5, which claim version should be considered by the Board, if the claim version underlying the impugned decision should not be accepted by the Board.

It was argued that the version "D1" discloses the invention in such a clear and complete manner that the skilled man can carry out the invention so that an objection under Article 100(b) EPC would no longer be applicable, in particular since the version "D1" refers to a "magazine file assembly" instead of a single "file".

- V. The Board commented on both claim versions in its communication dated 28 November 1989. Following the Board's communication the Appellant filed with letter of 20 February 1990 his comments on the Board's provisional view of the case together with new claims, version "D2" in the following, and a revised description. It was felt by the Appellant that the Opposition Division did not have the power to decide on the maintenance of the European patent except to the extent to which it was opposed, whereby reference was made to the decision T 9/87, OJ EPO 1989, 438. Hence, by revoking the patent solely on the ground of Article 100(b) EPC, the Opposition Division has in the Appellant's contention gone beyond its obligation and power and has thus violated the EPC provisions.

The Appellant furthermore argued in his letter of 20 February 1990 that the Opposition Division violated Article 113 EPC since his requests to adjourn the oral proceedings to give him the opportunity to consult the experts of the Appellant were waived by the Opposition Division. The position taken by the Opposition Division had in his contention delayed the proceedings considerably

and had caused costs on the other hand to the Appellant. Due to the late introduction of document D1 the Appellant requests for indemnity either from the Respondent, who in the opinion of the Appellant has agreed to take over Appellant's extra costs, or from the Opposition Division. Since minutes of the oral proceedings before the Opposition Division have been incomplete in these respects, the Appellant argued that he was obliged to clarify the actual course of the oral proceedings by filing an addendum to the minutes (Annex I of his letter of 7 April 1987).

- VI. In response to the Board's communication the Respondent requested the dismissal of the appeal for reasons of Article 100(b) EPC, since Claim 1 of the version "D1" would not give a complete teaching, and, in particular for reasons of Article 100(c) EPC, since Claim 1 of the version "D1" would contravene the requirements of Article 123(2) and (3) EPC and also for reasons of Article 100(a) EPC, since the subject-matter of Claim 1 of the version "D1" would be rendered obvious by the teaching of document D2 if taken alone or at least if combined with the teaching of document D1.
- VII. During oral proceedings held on 22 March 1990 the Appellant submitted slightly amended Claims 1 to 5 in respect of the "D2" version and an adapted description. Claim 1 now reads as follows:

"1. Magazine file assembly comprising two similar or identical files for paper or the like having planar walls at the front (11;31), at the sides (12,13; 32,33) and at the rear (14; 34) and a bottom (15; 35) as well as an opening opposite to the bottom,
c h a r a c t e r i z e d i n

that the assembly files (10; 30), when oriented with the openings of the files facing each other, and the walls (11-14; 31-34) in parallel, the two front walls (11; 31) in opposite directions, when displaced slightly perpendicularly to the side walls (12,13; 32,33) as well as to the front (11; 31) and rear (14; 34) walls in parallel with the plane of the bottoms (15; 35) and telescoped towards each other in parallel to the walls define two diametrically located intersectional points (at 19 and 38, fig. 3) between the walls, that at least one slit is formed in a file wall portion at said intersectional points, said at least one slit extending from the free top edge of a wall towards the bottom thereof and having a width adapted to receive a length of the wall of the other file, the total length of said at least one slit or coacting slits at each intersectional point being equal to the height of the shortest wall (14; 34), thereby allowing the files to be telescoped into each other until the top of a wall of one file abuts the bottom of the other file."

- VIII. The Appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of Claims 1 to 5 and the description as submitted during the oral proceedings, in combination with the drawings as granted. Furthermore he requested apportionment of costs.

The Respondent at the oral proceedings maintained his request to dismiss the appeal, since the subject-matter of the attacked patent in his contention extends beyond the content of the application as filed and in addition is not patentable within the terms of Articles 52 to 57 (grounds of opposition pursuant to Article 100(c) and (a) EPC), whereby reference was made particularly to document D2, page 1, lines 15 to 22 and lines 93 to 97. He derived

therefrom that the skilled person was sufficiently taught to nest identical parts such as lids or covers in the manner claimed in present Claim 1 in order to reduce the space needed to store or transport these parts, even if the drawings or the further text of D2 do not give further information how this has to be done in detail.

The Appellant contended that Respondent's view of D2 is based on inadmissible hindsight and not in conformity with the real teaching of D2. This document at least leaves some doubt how exactly the lids or covers have to be nested. This would be done by simply telescoping them with the openings facing each other, after having swung the side flaps about lines 13 into the plane of top member 10, rather than by using their slits in order to assemble them in the manner shown for the assembly of cover and box. Consequently the Appellant concludes that document D2 cannot question the novelty and inventiveness of the subject-matter of Claim 1.

Reasons for the Decision

1. The appeal is admissible.
2. Since the Respondent inter alia raised an objection under Article 100(c) EPC this issue should be dealt with first.
 - 2.1 Present Claim 1 relates to a "magazine file assembly".

From the original documents, see page 1, lines 20 to 22, page 2, line 14, page 3, lines 1 and 2, page 4, lines 7 to 10 as well as Fig. 2 and 3, it can be seen that not only a

"file" per se was originally disclosed, but also a "file assembly" consisting of two files which are telescoped one into the other.

The term "comprising two similar or identical files" of Claim 1 is clearly covered by the original page 1, line 21 and original Claim 1, respectively by Fig. 1 to 3 and the corresponding original description relating to these Figures.

- 2.2 For the skilled man it is immediately clear that two identical files can only be telescoped, if the slits concerning their location and their length vis-à-vis the height of the shortest wall (rear of the file) follow certain rules, which are for instance disclosed in the original Fig. 1 to 3, i.e. four slits per file are foreseen, whereby only two slits per file are active and the remaining two slits are passive. Since the slits of the two individual identical files necessarily coact, the length of the slits can be reduced, so that as a consequence the files are increased in their stability.
- 2.3 If on the other hand the two files are only similar, then it is again immediately clear for a skilled man that the files can only be similar as to their size and their overall configuration, but not as to the arrangement of the slits. These have to be so arranged that a "left" and that a "right" file are formed, since only then telescoping of these two files is possible.
- 2.4 The term "at least one slit is formed in a file wall portion at said intersectional points" of Claim 1 in its valid version to the Board's conviction covers both the alternatives discussed above under 2.2 and 2.3 (similar or identical files) and is clearly supported by the original

disclosure if the originally filed documents are interpreted by a skilled man.

The Board is therefore convinced that the subject-matter of present Claim 1 does not extend beyond the content of the application as filed, so that the Respondent's objection under Articles 100(c) and 123(2) EPC cannot be accepted.

3. From the foregoing considerations in the Board's view it follows that there is also no basis for an objection against Claim 1 on the ground of opposition pursuant to Article 100(b) EPC.

The Respondent argued in this context that in the case that the two files are only "similar" it would not be sufficient to prescribe that in each file "at least one slit is formed" since further prerequisites would have to be fulfilled.

Pursuant to Article 100(b) EPC the European patent has to disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

In this article reference is made to the patent as a whole and it is not prescribed that the claims per se must disclose the invention in such a manner. In the Board's finding the patent in suit seen in its entirety gives the skilled person in the art sufficient information for carrying out the invention. It is true that the invention is fully described and reproduced in the drawings only in the case of two identical files, which each have four slits, see Fig. 1 to 3 of the attacked patent. Considering the second alternative of the invention, where the files are only "similar", the attacked patent mentions literally

only two more embodiments, namely with two coacting slits in each file or with two slits in only one of the files (see column 3, lines 3 to 14). However, it is, in the Board's view, immediately apparent to a skilled person that further embodiments, e.g. the one with one slit in each file, would also meet the general requirement of Claim 1, according to which at least one slit must be present at each intersectional point.

4. The Respondent finally has based his opposition on grounds of Article 100(a) EPC. In this respect the following has to be observed:
 - 4.1 The document D1 which relates to a transportation box was filed after the time limit for giving notice of opposition, that is during the oral proceedings before the Opposition Division. This document did not play any role in the proceedings before the Board and its subject-matter does not prejudice the validity of Claim 1. The teaching of document D1 is characterised by four side walls which all have offset portions to allow nesting of a pair of boxes, without mutual sideways displacement of the boxes. In the middle area in which the side walls are offset a slit is foreseen in any of the side walls, see Claim 1 and Fig. 1, 4 and 5 of D1. This teaching of D1 differs fundamentally from the concept specified in the attacked patent, however, so that D1 in the Board's contention is irrelevant and can be disregarded in the following (Article 114(2) EPC).
 - 4.2 The sole document to be considered in the following is therefore D2, which document was the only document discussed in the oral proceedings before the Board.
 - 4.3 Document D2 does not disclose a magazine file assembly in the meaning of Claim 1, but a box construction comprising

the box and a top, cover or lid, so that the anticipation a priori does not deal with the problem how two identical or similar files can be nested, even if on page 1, lines 15 to 21 and lines 94 to 98 of D2 it is mentioned that lids/covers can be nested or packed in a very small space. The subject-matter of Claim 1 is therefore novel, Article 54 EPC.

- 4.4 For the following reasons the Board is convinced that Claim 1 also defines subject-matter which is based on an inventive step.

The basic idea of Claim 1 is that two similar or identical files should be nested in a manner that the storage space needed after nesting is roughly the same as the storage space of a single file. This is achieved by assembling the two files in an offset position with their openings facing each other and by providing slits at the intersectional points of the files to be assembled. As an additional feature the total length of each slit or of the coacting slits has to be equal to the height of the shortest wall of each file.

- 4.5 The main teaching of D2 is contradictory to the aforementioned teaching of Claim 1 primarily as far as two different parts, i.e. a box and a cover/top/lid, have to be assembled, see Fig. 1 to 7 of D2, whereby relatively complicated wall constructions are realised. This teaching thus does not lead a skilled person to the subject-matter of Claim 1.

- 4.6 It is true that D2 mentions on page 1, lines 15 to 21 and lines 94 to 98 to pack or nest identical parts in the form of covers or lids to reduce their storage space. How this has to be done in detail, however, cannot be derived directly from D2 in an unambiguous way, since the drawings

of D2 do not relate to this aspect and since nothing else in D2 gives additional information in this respect.

The Respondent argued that the covers/lids in D2 are packed or nested in the same way as in Claim 1 under discussion, whilst the Appellant argued that so packed, most probably the covers are firstly flattened in that the part "9" is swung around the hinge "13" and in that afterwards two thus deformed covers are telescoped like two U-profiles can be telescoped simply by assembling them along their longitudinal axes while being slightly offset and facing each other with their openings.

- 4.7 Given this situation, it cannot, in the Board's judgement, duly be argued that D2 clearly and unambiguously would point to the teaching of Claim 1, if D2 is seen by a skilled person not knowing the teaching of Claim 1. The interpretation of D2 brought forward by the Respondent is consequently not free from an ex-post facto analysis which, however, is inadmissible.
- 4.8 Consequently, the Board comes to the conclusion that the subject-matter of Claim 1 in its present version is based on an inventive step within the meaning of Article 56 EPC, so that the patent can be maintained on that basis in amended form.
5. As regards the Appellant's request for apportionment of costs (indemnity) which in his contention arose to him due to the late citation of document D1 during the oral proceedings before the Opposition Division, the following is observed:
- 5.1 As a general principle the EPC provides in this respect (see Article 104(1) EPC) that each party to the proceedings shall meet the costs he has incurred. In the

present case the late citation of D1 as such cannot duly be said to have violated Article 113(1) EPC or to have caused extra costs to the Appellant. Firstly, the Appellant's representative was given sufficient time during the oral proceedings taking place at two subsequent days to consider this document, simply consisting of seven pages including the claim page and two figure sheets. Since the representative was fully authorised, it could be expected at that stage of the proceedings that he was able to react on this new situation either by rejecting D1 as irrelevant or by filing amended claims. In fact, the representative has chosen the latter possibility as he has considered D1 to be a relevant document, which could have an influence on the validity of the patent as granted. The introduction of such a document, which is deemed to be relevant, is possible at any stage of the proceedings before the Opposition Division or the Board, since according to Article 114(1) EPC the European Patent Office shall examine the facts of its own motion.

5.2 The first instance followed this principle of the EPC and no contravention of Appellant's rights can therefore be seen by the Board, since the Appellant had sufficient time to react, be it during the oral proceedings before the Opposition Division or be it afterwards. In this context it is essential that these oral proceedings did not terminate the opposition procedure, since no decision was given but only an intention to maintain the patent in amended form was announced, see minutes of the oral proceedings dated 11 November 1986.

With the communication dated 14 January 1987 a time limit of four months was set by the Opposition Division to file amended claims and an amended introduction to the description, and subsequently four more communications setting out the Opposition Division's opinion on several

aspects were submitted to the parties. The Appellant thus clearly had at that stage again sufficient time to deal with the late filed document D1 and to present his comments. There is thus no basis for the argument that the Appellant had no opportunity to present his comments, Article 113(1) EPC.

- 5.3 Summarising, the Board comes to the conclusion that the late filed document D1 could be duly considered by the Appellant firstly during the oral proceedings before the Opposition Division - at that time the representative of the Appellant was in Munich anyway and no evidence was provided that extra costs have arisen because of the late filing of D1 at that stage - and secondly during the long time period following the oral proceedings, whereby it cannot be seen by the Board that the study of the document D1 can have caused any remarkable extra costs. Anyway under Article 104 EPC only costs incurred during oral proceedings or taking of evidence can be apportioned.
- 5.4 By applying the principles of Articles 104(1) and 114 EPC the request for apportionment of costs has to be rejected. Whether an arrangement in this respect has been reached between the parties concerning the taking over of costs during the oral proceedings before the Opposition Division is irrelevant to the Board's findings and outside its competence laid down in the EPC.

Order

For these reasons, it is decided that:

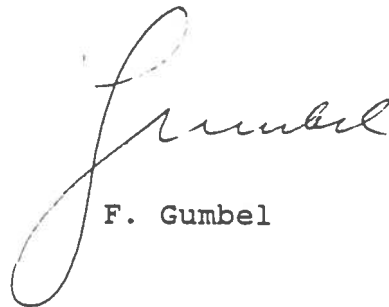
1. The decision under appeal is set aside.
2. The patent is maintained on the basis of the following documents:
 - (a) Claims 1 to 5 as handed over during the oral proceedings,
 - (b) description as handed over during the oral proceedings,
 - (c) drawing sheet "1/1" as granted.
3. The request for apportionment of costs is rejected.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel

26.4.90 Br.

01559

30.4.90 