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D E C I S I O N
of 14 October 1998

Case Number: T 0430/95 - 3.2.5

Application Number: 86307966.1

Publication Number: 0220874

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Language of the proceedings: EN

Title of invention:
Document wallet

Patentee:
Easi-Bind International Ltd.

Opponent:
Usiplast

Headword:
-

Relevant legal provisions:
EPC Art. 56

Keyword:
"Inventive step (yes after amendment)"

Decisions cited:
-

Catchword:
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Boards of Appeal

Chambres de recours

Case Number: T 0430/95 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 14 October 1998

Appellant:
(Opponent)

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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted 22 March
1995 concerning maintenance of European patent
No. 0 220 874 in amended form.

Composition of the Board:

Chairman: H. P. Ostertag
Members: C. G. F. Biggio
J. Van Moer

Summary of Facts and Submissions

I. The appeal concerns the interlocutory decision of the opposition division dated 22 March 1995, by which the European patent 220 874 was maintained in an amended form.

The following prior art documents were considered in the appealed decision.

D1: DE-A-2 258 250,

D2: FR-A-2 440 880,

D3: CH-A-402 721, and

D4: FR-A-2 502 066.

Claim 1, as maintained, reads as follows:

"A blank for a folder including a front wall (12) spaced from a rear wall (11) by a pair of side walls (14,16) and a bottom wall (18), the blank being formed from a single sheet of material which is cut and provided with fold lines to define a first wall panel (40,48) connected to a second wall panel (40,48) by an intermediate bottom wall panel (46), the first and second wall panels in the erected folder defining either the front and rear walls or the rear and front walls of the folder respectively, a pair of side wall panels (42,43) foldably connected to opposite sides of the second wall panel, and an attachment panel (53,54) foldably connected to each side wall panel, each attachment panel in the erected folder residing in face to face contact with the first wall panel and being connected thereto by co-operable latch means (56,57), the co-operable latch means for connecting each

attachment panel to the first wall panel comprising at least one tongue (65) engageable with a co-operating tongue accommodating opening (60), characterised in that each tongue (65) is integrally formed on the first wall panel and which, in the erected folder extends through a co-operating opening (60) in the attachment panel to project into the interior of the folder to underlie the attachment panel, the sheet material being resilient and being formed from either a plastics sheet or a card laminated on one or both sides with a plastics film and that the fold lines (FL) between the first wall panel (40,48), side wall panels (42,43) and attachment panels (53,54) are such that after folding along these lines, the side wall panels and attachment panels are biased to return toward their unfolded positions by the inherent resilience of the sheet material forming the blank so that, in the erected folder, each tongue (65) is urged into engagement with its co-operating tongue accommodating opening (60) to thereby maintain the folder in its erected condition".

In the suit, the above quoted claim will be referred to as: "Claim 1, according to the respondent's (patentee's) main request".

- II. On 19 May 1995, the appellant (opponent) lodged an appeal against the above decision, requesting that the latter be set aside and the patent revoked.
- III. With a letter dated 14 September 1998, the respondent (patentee) filed a newly drafted set of claims (SET C) and requested that the claims of said SET C be considered as his first auxiliary request.

Claim 1, according to the respondent's first auxiliary request (SET C), reads as follows:

"A blank for a folder including a front wall (12) spaced from a rear wall (11) by a pair of side walls (14,16) and a bottom wall (18), the blank being formed from a single sheet of material which is cut and provided with fold lines to define a first wall panel (40,48) connected to a second wall panel (40,48) by an intermediate bottom wall panel (46), the first and second wall panels in the erected folder defining either the front and rear walls or the rear and front walls of the folder respectively, a pair of side wall panels (42,43) foldably connected to opposite sides of the second wall panel, and an attachment panel (53,54) foldably connected to each side wall panel, each attachment panel in the erected folder residing in face to face contact with the first wall panel and being connected thereto by co-operable latch means (56,57), the co-operable latch means for connecting each attachment panel to the first wall panel comprising at least one tongue (65) engageable with a co-operating tongue accommodating opening (60), characterised in that in the erected folder the first wall panel overlies each attachment panel (53,54) to leave the upper portions thereof exposed so that the front wall (12) of the folder is defined by the first wall panel and the exposed upper portions of the attachment panels, the co-operable latch means (56,57) being located near to the upper edge of the first wall panel, and further characterised in that each tongue (65) is integrally formed on the first wall panel and which, in the erected folder extends through a co-operating opening (60) in the attachment panel to project into the interior of the folder to underlie the attachment panel, the sheet material being resilient and being formed from either a plastics sheet or a card laminated on one or both sides with a plastics film and that the

fold lines (FL) between the first wall panel (40,48), side wall panels (42,43) and attachment panels (53,54) are such that after folding along these lines, the side wall panels and attachment panels are biased to return toward their unfolded positions by the inherent resilience of the sheet material forming the blank so that, in the erected folder, each tongue (65) is urged into engagement with its co-operating tongue accommodating opening (60) to thereby maintain the folder in its erected condition".

IV. Oral proceedings were held on 14 October 1998.

V. At the oral proceedings, the respondent filed a further newly drafted set of claims (SET D) and requested that the claims of said SET D be considered as his second auxiliary request.

Claim 1, according to the respondent's second auxiliary request (SET D), reads as follows:

"A blank for a folder including a front wall (12) spaced from a rear wall (11) by a pair of side walls (14,16) and a bottom wall (18), the blank being formed from a single sheet of material which is cut and provided with fold lines to define a first wall panel (40,48) connected to a second wall panel (40,48) by an intermediate bottom wall panel (46), the first and second wall panels in the erected folder defining either the front and rear walls or the rear and front walls of the folder respectively, a pair of side wall panels (42,43) foldably connected to opposite sides of the second wall panel, and an attachment panel (53,54) foldably connected to each side wall panel, each attachment panel in the erected folder residing in face to face contact with the first wall panel and being connected thereto by co-operable latch means (56,57), the co-operable latch means for connecting each attachment panel to the first wall panel comprising at

least one tongue (65) engageable with a co-operating tongue accommodating opening (60), characterised in that in the erected folder the first wall panel overlies each attachment panel (53,54) to leave the upper portions thereof exposed so that the front wall (12) of the folder is defined by the first wall panel and the exposed upper portions of the attachment panels, the co-operable latch means (56,57) being located near to the upper edge of the first wall panel, and further characterised in that each tongue (65) is integrally formed on the first wall panel and which, in the erected folder extends through a co-operating opening (60) in the attachment panel to project into the interior of the folder to underlie the attachment panel, the sheet material being resilient and being formed from either a plastics sheet or a card laminated on one or both sides with a plastics film and that the fold lines (FL) between the first wall panel (40,48), side wall panels (42,43) and attachment panels (53,54) are such that after folding along these lines, the side wall panels and attachment panels are biased to return toward their unfolded positions by the inherent resilience of the sheet material forming the blank so that, in the erected folder, each tongue (65) is urged into engagement with its co-operating tongue accommodating opening (60) to thereby maintain the folder in its erected condition, each tongue accommodating opening (60) being in the form of a slit (60) formed in the attachment panel, the slit extending substantially parallel to the fold line between the attachment and the side wall panels".

The respondent further requested that, in the description of the patent as granted, the acknowledgement of prior art document D1: DE-2 258 250

(column 1, lines 22 to 47) be amended, because manifestly erroneous. The requested amendment concerned the last lines of said acknowledgement (see: column 1, lines 41 to 47), which should read:

"... comprising at least one tongue engageable with a co-operating tongue accommodating opening, the tongue being formed on the attachment panel and the co-operating opening being formed on the first wall panel respectively"

instead of:

"... comprising at least one tongue engageable with a co-operating tongue accommodating opening, the tongue being formed [either] on [the first wall panel or] the attachment panel and the co-operating opening being formed on the [attachment panel or the] first wall panel respectively".

VI. In writing and at the oral proceedings, the appellant argued essentially that the subject-matter of Claim 1, as according to the respondent's main and first auxiliary requests, did not involve an inventive step over the combined teachings from prior art documents D1 and D2. The following specific submissions were made.

Document D1 disclosed a blank for a storage folder showing all the features mentioned in the preamble of Claim 1, as according to the respondent's main and first auxiliary requests, so that:

- the blank for a folder claimed by Claim 1, as according to the respondent's main request, differed from the known one merely in that:

- (a) each tongue (65) is integrally formed on the first wall panel and, in the erected folder extends through a co-operating opening (60) in the attachment panel to project into the interior of the folder to underlie the attachment panel,
- (b) the sheet material of the blank is resilient and is formed from either a plastics sheet or a card laminated on one or both sides with a plastics film,
- (c) the fold lines (FL) between the first wall panel (40,48), side wall panels (42,43) and attachment panels (53,54) are such that after folding along these lines, the side wall panels and attachment panels are biased to return toward their unfolded positions by the inherent resilience of the sheet material forming the blank so that, in the erected folder, each tongue (65) is urged into engagement with its co-operating tongue accommodating opening (60) to thereby maintain the folder in its erected condition,

whereas

- the blank for a folder claimed by Claim 1, as according to the respondent's first auxiliary request, further differed from the known one merely in that:

- (d) in the erected folder the first wall panel overlies each attachment panel (53,54) to leave the upper portions thereof exposed so that the front wall (12) of the folder is

defined by the first wall panel and the exposed upper portions of the attachment panels, the co-operable latch means (56,57) being located near to the upper edge of the first wall panel.

According to the patent in suit (column 1, lines 48 to 51), the problem to be solved by the invention was to remedy the drawback shown by the storage folder according to document D1; said drawback being represented by the fact that said folder was not intended to be partially filled and so did not possess constructional features for this purpose. In other words, the problem to be solved was to provide a document folder intended to be only partially filled and showing suitable constructional features for this purpose; said constructional features - stability in the erected condition and long time solidity of the constituting material - being such that the document folder according to the patent in suit could be frequently handled and not uniquely intended for long time storage of documents, as the known one.

The person skilled in the art, faced with such a problem, would have immediately realised that a blank for a document folder meeting the above requirements should be made with a sheet material formed from either a plastics sheet or a card laminated on one or both sides with a plastics film. The person skilled in the art was, in fact, encouraged to replace the inherently unstable and non-durable strong paper or thin cartoon, disclosed by document D1, with a more stable, durable and strong plastics sheet or a card laminated on one or both sides with a plastics film, by the disclosure of document D2, where such materials were disclosed as being highly suitable for making blanks for stable and durable containers, intended to be handled frequently.

From the disclosure of document D2 (page 1, line 9 to page 2, line 27; Figure 1), the person skilled in the art would have also be taught that such a plastic material is also inherently resilient and, consequently, that in a blank made therewith, the fold lines between the wall panels, side wall panels and attachment panels would have been such that after folding along these lines, the side wall panels and attachment panels would have been biased to return toward their unfolded positions by the inherent resilience of the sheet material forming the blank so that, in the erected container, a tongue 9 would have been easily insertable into engagement with its co-operating tongue accommodating opening 10 and there maintained by the inherent resilience of the sheet material, thereby maintaining the resulting container in its erected condition.

Document D1 disclosed, at least implicitly, that the tongue intended to be engaged with the co-operating tongue accommodating opening could be formed either on the first wall panel or on the attachment panel and the co-operating opening could be formed either on the attachment panel or on the first wall panel respectively. Both these two implementation possibilities for the latching means were, accordingly, equivalent and open to the person skilled in the art, so that the choice of the one rather than of the other could not be regarded as involving an inventive step.

These two implementation possibilities for the latching means were, moreover, fully equivalent in order of providing the effect according to which "each tongue (65) is urged into engagement with its co-operating tongue accommodating opening (60) to thereby maintain the folder in its erected condition", as specified by Claim 1, as according to both the respondent's main and first auxiliary requests.

As to the further difference (see d) above) shown by the subject-matter of Claim 1 according to the respondent's first auxiliary request, it was submitted that such a difference was merely a choice open to the person skilled in the art and that such a difference was totally ineffective in order of providing the effect according to which "each tongue (65) is urged into engagement with its co-operating tongue accommodating opening (60) to thereby maintain the folder in its erected condition", as specified by Claim 1, as according to both the respondent's main and first auxiliary requests.

The appellant further argued that the subject-matter of Claim 1, as according to the respondent's main and first auxiliary requests, lacked an inventive step over the teaching from prior art documents FR-A-2 490 151 (D6) and FR-A-2 462 273 (D7) and requested that these two documents be considered by the Board pursuant to Article 114(1) EPC, since they were mentioned in the search report and, thus, already in the procedure from the very beginning.

In the respect of the subject-matter of Claim 1, as according to the respondent's second auxiliary request, the appellant stated that he would not oppose such a subject-matter.

VII. In writing and at the oral proceedings, the respondent made substantially the following submissions.

Documents D6 and D7, although mentioned in the search report, had to be considered as "late filed", since the appellant never relayed before on them, for supporting and substantiating his opposition. Moreover said

documents were less relevant than all the other prior art documents considered so far. It was, accordingly, requested that said documents be not considered by the Board, pursuant to Article 114(2) EPC.

Document D1 disclosed a storage folder intended to be totally filled and for long time storage of the therein stored documents, whereby the most important features that said storage folder should show were to be as cheap as possible, to request the minimum possible amount of material, but nevertheless such to ensure suitable long time storage performances. This document, accordingly, considered only strong paper or thin cartoon as suitable materials for the blank of such a storage folder.

Document D1, moreover, did not disclose, even implicitly, that the tongue intended to be engaged with the co-operating tongue accommodating opening could be formed either on the first wall panel or on the attachment panel and the co-operating opening could be formed either on the attachment panel or on the first wall panel respectively.

For this reason, the acknowledgement of document D1, as contained in the description of the patent in suit (column 1, lines 22 to 47) was manifestly erroneous and the appellant should be granted the right to correct such a manifest material error.

Admittedly, the two possible implementations for the latching means, as pointed out by the appellant, were open to the person skilled in the art. In the application as filed, the respondent himself mentioned said two possibilities which, at that time appeared to be equivalent. Nevertheless, the respondent decided to limit the scope of Claim 1 to one of these possibilities, i.e. that which provides that, in the

erected folder "each tongue (65) ... extends through a co-operating opening (60) in the attachment panel to project into the interior of the folder to underlie the attachment panel", since this implementation showed better performances and allowed, moreover, to avoid that the tongue be damaged, when extending to the exterior of the folder and overlying the attachment panel. The claimed implementation allowed, thus, to solve a problem which, though not explicitly mentioned in the application as filed, was nevertheless implicit in the general and broad statement of the problem to be solved by the invention, as mentioned in the application as filed.

Admittedly, document D2 disclosed the effects of a resilient plastic material and that, in a container whose blank was made therewith, a tongue 9 would have been easily insertable into engagement with its co-operating tongue accommodating opening 10 and there maintained by the inherent resilience of the sheet material, thereby maintaining the resulting container in its erected condition.

This document, nevertheless, taught to exploit said effects in a way which was totally different from that adopted in the invention according to the patent in suit and claimed by Claim 1, as according to every one of the respondent's requests.

As to the further difference (see (d), in Item VI above) shown by the subject-matter of Claim 1 according to the respondent's first auxiliary request, it was submitted that such a difference was not merely a choice open to the person skilled in the art, but on the contrary, that such a difference was highly effective in order of better providing the effect according to which "each tongue (65) is urged into engagement with its co-operating tongue accommodating

opening (60) to thereby maintain the folder in its erected condition", as specified by said claim. It was, moreover, submitted that none of the prior art documents considered -and even of the prior art documents on file- provide the slightest hint to the features represented by said difference.

It was, thus, concluded that none of the prior art documents considered -and even of the prior art documents on file- provide, alone or in combination, any teaching susceptible of rendering obvious the subject-matter of Claim 1, as according to the respondent's main and first auxiliary requests.

The subject-matter of Claim 1, according to the respondent's second auxiliary request, was a fortiori non-obvious; its patentability being admitted by the appellant himself.

VIII. The parties made the following final requests.

The appellant requested:

- that the appealed decision be set aside and that the patent be revoked, insofar as the subject-matter of Claim 1 is that according to the respondent's main and first auxiliary requests, and
- that the acknowledgement of document D1: DE-A-2 258 250 be maintained such as in the description (column 1, lines 22 to 47), as granted, of the patent in suit.

The respondent requested:

Main request:

that the appeal be dismissed and the decision of the opposition division be confirmed; the acknowledgement of document D1 in the description having been amended,

First auxiliary request:

that the appealed decision be set aside and the patent maintained on the basis of Claims 1 to 10, as filed with letter dated 14 September 1998,

Second auxiliary request:

that the appealed decision be set aside and the patent maintained on the basis of Claims 1 to 9, as filed at the oral proceedings.

- IX. At the oral proceedings, the respondent filed an amended description, comprising amended pages 2 and 3 of the granted patent and annex C.

Reasons for the Decision

1. *The closest prior art*
 - 1.1. In agreement with both appellant and respondent, the Board is of the opinion that document D1 represents the closest prior art on file. This document discloses, in fact, a blank for a storage folder showing all the features mentioned in the preamble of Claim 1, as according to any of the respondent's requests.
 - 1.2. The Board does not agree with the appellant's submission that document D1 discloses, at least implicitly, that the tongue intended to be engaged with the co-operating tongue accommodating opening might be

formed either on the first wall panel or on the attachment panel and the co-operating opening might be formed either on the attachment panel or on the first wall panel respectively. Such a disclosure is fully absent, even by implication, in document D1.

1.3. The Board, therefore, agrees with the respondent's submissions

- that the acknowledgement of said document, as contained in the description of the patent as granted (column 1, lines 22 to 47) is manifestly erroneous and
- that the lines 41 to 47 of said statement shall be corrected in such a way that they read as according to the amended description filed at the oral proceedings.

2. *Novelty*

With regard to the disclosure of document D1, the novelty of the subject-matter of Claim 1, as according to the respondent's main and first subsidiary requests, need not to be discussed at a long and in detail. .

The appellant himself admits (see Items VI) the novelty of said claims and states that:

- the novelty of the subject-matter of Claim 1, as according to the respondent's main request is represented by the following features:

- (a) each tongue (65) is integrally formed on the first wall panel and, in the erected folder extends through a co-operating opening (60) in the attachment panel to project into the interior of the folder to underlie the attachment panel,
- (b) the sheet material of the blank is resilient and is formed from either a plastics sheet or a card laminated on one or both sides with a plastics film,
- (c) the fold lines (FL) between the first wall panel (40,48), side wall panels (42,43) and attachment panels (53,54) are such that after folding along these lines, the side wall panels and attachment panels are biased to return toward their unfolded positions by the inherent resilience of the sheet material forming the blank so that, in the erected folder, each tongue (65) is urged into engagement with its co-operating tongue accommodating opening (60) to thereby maintain the folder in its erected condition; while

- the novelty of the subject-matter of Claim 1, as according to the respondent's first auxiliary request is further represented by the following additional feature:

- (d) in the erected folder the first wall panel overlies each attachment panel (53,54) to leave the upper portions thereof exposed so that the front wall (12) of the folder is

defined by the first wall panel and the exposed upper portions of the attachment panels, the co-operable latch means (56,57) being located near to the upper edge of the first wall panel.

The Board has no reasons for disputing the appellant's finding on novelty, which is, moreover agreed by the respondent himself.

3. *Documents D6 and D7*

Although documents D6 and D7 were indeed mentioned in the search report, the appellant did never rely on them for supporting and substantiating his opposition until his submissions filed with letter dated 8 October 1998.

Documents D6 and D7 have, consequently, to be considered as "late filed documents".

It is established jurisprudence of the Boards of Appeal that "late filed documents" should only be admitted into the procedure if, *prima facie*, they are more relevant than all the other prior art documents previously considered.

Documents D6 and D7 appear, *prima facie*, to be less relevant than all the other prior art documents, e.g. documents D1, D2 and D3, previously considered.

Neither document D6 nor D7 does either disclose or even hint at the feature (c) of the claimed folder (see previous point 2).

The Board decides, accordingly, not to introduce said documents D6 and D7 into the procedure, pursuant to Article 114(2) EPC.

4. *Problem and Solution*

The problem to be solved by the invention is clearly stated in the patent in suit (column 1, lines 48 to 51) and sums up to remedy the drawback shown by the storage folder according to document D1; said drawback being represented by the fact that said folder was not intended to be partially filled and so did not possess constructional features for this purpose. In other words, the problem to be solved was to provide a document folder intended to be only partially filled and showing suitable constructional features for this purpose; said constructional features - stability in the erected condition and long time solidity of the constituting material - being such that the document folder according to the patent in suit could be frequently handled, thus, not uniquely intended for long time storage of documents, as the known one.

Insofar as the solution of this problem is that claimed by Claim 1 as according to the respondent's main request, this problem is solved by the features (a), (b) and (c) (see previous point 2), mentioned in the characterising clause of said claim.

Insofar as the solution of this problem is that claimed by Claim 1 as according to the respondent's first auxiliary request, this problem is solved by the features (a), (b), (c) and (d) (see previous point 2), mentioned in the characterising clause of said claim.

5. *Inventive step*

5.1. *Main request*

The Board is of the opinion that the person skilled in the art, faced with the problem to be solved by the invention (see previous point 4), would have obviously considered that a blank for a document folder intended to be only partially filled and to be handled very frequently, i.e. meeting the requirements of stability, solidity and durability implied by the stated problem, had to be made with a sheet material formed from either a plastics sheet or a card laminated on one or both sides with a plastics film.

The Board is, in fact, of the opinion that the person skilled in the art was, indeed, encouraged to replace the inherently unstable and non-durable strong paper or thin cartoon, disclosed by document D1, with a more stable, durable and strong plastics sheet or a card laminated on one or both sides with a plastics film, by the disclosure of document D2, where such materials are disclosed as being highly suitable for making blanks for stable and durable containers, intended to be handled frequently.

The Board is, moreover, of the opinion, that from the disclosure of document D2 (page 1, line 9 to page 2, line 27; Figure 1), the person skilled in the art was also taught that such a plastic material shows an inherent resilience and, consequently, that in a blank made therewith, the fold lines between the wall panels, side wall panels and attachment panels would have been such that after folding along these lines, the side wall panels and attachment panels would have been biased to return toward their unfolded positions by the inherent resilience of the sheet material forming the

blank so that, in the erected container, the tongue 9 would have been easily insertable into engagement with its co-operating tongue accommodating opening 10 and there maintained by the inherent resilience of the sheet material, thereby maintaining the resulting container in its erected condition.

The Board is, accordingly, of the opinion that, once the person skilled in the art has made the first obvious step of choosing the plastic materials disclosed by D2, the effects due to the inherent resilience of said materials are automatically given to him and cannot, therefore, support inventiveness. The Board considers that the mere fact that document D2 implements its teaching in a way which is different from that adopted in the patent in suit was not susceptible of leading the person skilled in the art to discard said teaching, when he was looking for a solution of the problem to be solved by the invention. The person skilled in the art was, in fact, looking for a solution allowing the latching means according to document D1 to be maintained in their very simple implementation, i.e. the most simple tongue and therewith co-operating slit, but nevertheless be such that said tongue could be easily inserted into said slit, thereby providing for an easy and comfortable erection of the folder, while simultaneously, ensuring that, after erection, said tongue would have been firmly retained into said slit, thereby firmly and stably maintaining the resulting folder in its erected condition, and this without the need of any further retaining mechanical formations either on the tongue or in the slit.

As already said (see previous point 1.2), document D1 does not disclose, even by implication, that the tongue intended to be engaged with the co-operating tongue accommodating opening might be formed either on the first wall panel or on the attachment panel and the co-operating opening might be formed either on the attachment panel or on the first wall panel respectively.

The Board is, nevertheless, of the opinion that, at the priority date of the patent in suit, both these two implementation possibilities for the latching means were open to the person skilled in the art and that, at least prima facie, the person skilled in the art would have considered them as obviously equivalent and would have, at least, tried both said possible implementations. The Board notes that the obviousness of this prima facie equivalence is confirmed by the fact that both said possible implementations were contemplated by the application, as originally filed, and claimed by Claim 1 of the patent as granted.

The Board is, accordingly, of the opinion that at the priority date of the patent in suit the person skilled in the art would have considered these two implementation possibilities for the latching means as obviously and fully equivalent in order of providing the effect according to which "each tongue (65) is urged into engagement with its co-operating tongue accommodating opening (60) to thereby maintain the folder in its erected condition", as specified by Claim 1, as according to both the respondent's main and first auxiliary requests.

The Board cannot agree with the respondent's submission that an inventive step should be recognized in the feature: "each tongue (65) ... extends through a co-operating opening (60) in the attachment panel to project into the interior of the folder to underlie the attachment panel", on the grounds that this claimed implementation

- allows to avoid that the tongue be damaged, when extending to the exterior of the folder and overlying the attachment panel and, thus,
- allows to solve a problem which, though not explicitly mentioned in the originally filed application, was nevertheless implicit in the general and broad statement of the problem to be solved by the invention.

Said feature cannot establish inventiveness over the prior art since, although novel over D1, it is a mere mechanical equivalent of the corresponding feature in said document, i.e. it basically fulfills the same technical function as said corresponding feature in D1. Even if, subsequently, some advantages appear implied by said feature, these are irrelevant to inventive step, having regard to the obviousness of their cause.

Even admitting that the person skilled in the art would have recognized that the above problem of possible damages to the tongue was implicitly comprised in the general, broad statement of the problem to be solved by the invention, said person skilled in the art would have immediately realized that the tongue could be prevented from being damaged, merely by identifying and

suppressing the very origin of said potential damage, i.e. the mere fact that, in the erected folder according to document D1, the tongue projects **to the exterior** of the folder and **overlies** the attachment panel.

The Board is, accordingly, of the opinion that the claimed implementation, which provides that, in the erected folder, each tongue extends through its co-operating opening in the attachment panel to project **into the interior** of the folder and, thus, to **underlie** the attachment panel would have been the very first one that any person skilled in the art would have tried to put into effect.

Finally, the Board has found that the features (a), (b) and (c) of Claim 1, as according to the respondent's main request, do not cooperate in such a way as to provide any synergetic effect susceptible of increasing the stability of the folder, as aimed to by the invention.

The Board, thus, concludes the subject-matter of Claim 1, as according to the respondent's main request, does not involve an inventive step pursuant to Article 56 EPC and is, consequently, not patentable pursuant to Article 52(1) EPC.

5.2 First auxiliary request

Before appreciating the inventive step of the subject-matter of Claim 1, as according to the respondent's first auxiliary request, it is necessary to establish whether or not said subject-matter meets the requirements of Article 123(2 and 3) EPC.

Said subject-matter results from the addition of the features mentioned in Claim 6, as granted, to the subject-matter of Claim 1, as according to the respondent's main request. Since Claim 6, as granted, is supported by the originally filed application (page 4, lines 27 to 29), the requirements of Article 123(2) EPC are met.

The above indicated addition provides for a restriction of the scope of the claim. The requirements of Article 123(3) EPC are, thus, also met.

In order to decide whether or not the subject-matter of Claim 1, as according to the respondent's first auxiliary request, involves an inventive step and, thus, meets the requirements of Article 56 EPC, the Board has to investigate whether or not, at the priority date of the patent in suit and at the light of the state of the art, the subject-matter of said claim was non-obvious for the skilled person, due to the presence of the additional feature (d) (see previous point 2).

The Board finds that none of the relevant prior art documents considered -and even of the prior art documents on file- provide the slightest hint to said feature (d) (see previous point 2) and, accordingly, concludes that, in no way, a person skilled in the art would have been addressed and even less encouraged, by any of the teachings explicitly or implicitly disclosed by documents D1, D2, D3 and D4, to try and put into effect said additional feature (d).

The Board has, moreover, found that said feature (d) cooperates with (a), (b) and (c) to provide for a synergetic effect which contributes to increase the stability of the erected folder and which will be illustrated by the following considerations.

In comparison to the folder according to document D1, said feature (d) provides for an increased distance between the location - "near the upper edge of the first wall panel" - of the latching means - tongues 65 and slits 60 - and the fold line at the bottom edge of the same first wall panel 48, thereby providing, according to obvious mechanical considerations, for a reduction of the forces - due to the inherent resilience of the material used - which said first wall panel 48, biased to return toward its unfolded position, would apply to the latching means, in such a direction which would tend to disengage said latching means and, consequently, to render more instable the erected condition of the folder.

By this factual situation, the Board cannot agree with the appellant's submission that said feature (d) was merely a choice open to the person skilled in the art and was totally ineffective in order of providing the effect according to which "each tongue (65) is urged into engagement with its co-operating tongue accommodating opening (60) to thereby maintain the folder in its erected condition". Due to the synergetic effect illustrated above, said feature (d) is indeed effective to reduce the instability which would have resulted in the erected folder according to document D1, if the latter would have merely be realised with the plastic resilient materials disclosed by document D2.

The Board, thus, concludes that the subject-matter of Claim 1, as according to the respondent's first auxiliary request, does involve an inventive step pursuant to Article 56 EPC and is, consequently, patentable pursuant to Article 52(1) EPC.

Order**For these reasons it is decided that:**

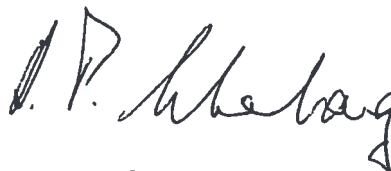
1. The decision under appeal is set aside.
2. The case is remitted to the first instance, with the order to maintain the patent with the following documents:
 - claims 1 to 10, filed with letter of 14 September 1998 (Set C or first auxiliary request),
 - description filed at the oral proceedings (pages 2 and 3 and annex C),
 - drawings as granted.

The Registrar:



A. Townend

The Chairman:



H. Ostertag

