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D E C I S I O N
of 11 January 2000

Case Number: T 0249/98 - 3.2.1

Application Number: 91202843.8

Publication Number: 0486085

IPC: B62J 3/00

Language of the proceedings: EN

Title of invention:
Bicycle bell

Patentee:
Spanninga Metaal B.V.

Opponent:
Widek Metaalwarenfabriek B.V.

Headword:
-

Relevant legal provisions:
EPC Art. 99
EPC R. 55(c), 67

Keyword:
"Admissibility of the opposition (yes)"
"Procedural violation (no)"
"Reimbursement of the appeal fee (no)"

Decisions cited:
T 0222/85, T 0538/89, T 0204/91

Catchword:

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Case Number: T 0249/98 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 11 January 2000

Appellant: Widek Metaalwarenfabriek B.V.
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Respondent: Spanninga Metaal B.V.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 15 January 1998
rejecting the opposition filed against European
patent No. 0 486 085 as inadmissible pursuant to
Rule 56(1) EPC.

Composition of the Board:

Chairman: F. A. Gumbel
Members: P. Alting van Geusau
J. H. P. Willems

Summary of Facts and Submissions

- I. The mention of the grant of European patent No. 0 486 085 in respect of European patent application No. 91 202 843.8, filed on 1 November 1991, was published on 20 July 1994.

Claim 1 of the patent reads as follows:

"1. A bicycle bell provided with a bracket (1) to be mounted on handlebars or the like, with a cap (3) mounted on said bracket and with at least one striking means (27, 27'), which can be set in motion by rotating and operating means (2) supported by said bracket and being rotatable about an axis of rotation, in such a manner that said striking means (27, 27') strikes the inner side of the cap so as to produce sound, characterised in that the striking means is mounted on an arm (23, 23') which extends at least substantially parallel to the axis of rotation and which can be set in motion against a spring force, said arm (23, 23') near its end remote from the striking means being coupled to the bracket, whilst a cam (28, 28') is secured to the arm, which cam operates with a tothing (32) provided on the inner circumference of the annular operating means."

- II. Notice of opposition was filed on the grounds of Article 100(a). In respect of an alleged lack of novelty and inventive step the following documents for substantiation of an alleged prior use were relied upon:

In relation to a bicycle bell denoted "TB 380":

- (a) Polaroid photograph entitled "TB 380"
- (b) Brochure entitled "Profile/TOKYO BELL in the Japanese language, comprising pictures of a bicycle bell with reference number "TB 380", 6 pages, undated
- (c) copy of a letter dated 2 August 1990 from the Yamaki Trading Co with an offer for delivery of the "TB-380" Rotary bell to the "Alkmaarse Groothandel Unie BV".

In relation to a bicycle bell named as "Draaibel":

- (d) Polaroid photograph entitled "DRAAIBELL"
- (e) Leaflet: Metaalwarenfabrik CV Widek comprising 11 pictures of bicycle bells of which one is named as Widek Draaibell, undated
- (f) 3 debit notes dated 25 March 1985, 20 May 1985 and 5 June 1985 for delivery of a quantity of the "Draaibel" bicycle bells by the company "Widek".

After the nine-month period of Article 99 EPC the appellant (opponent) filed further evidence in support of the alleged prior uses as well as a sample of the "Draaibel" and a copy of the Japanese Utility Model publication No. 3-49110 with a translation into the English language.

III. By a decision which was given at the end of oral

proceedings held on 17 November 1997 and posted on 15 January 1998 the Opposition Division rejected the opposition as inadmissible. The Opposition Division was of the opinion that the notice of opposition did not meet the requirements of Rule 55(c) EPC in that the alleged prior uses had not been sufficiently substantiated so as to enable the patentee to form a definite opinion on the ground of opposition raised by the opponent.

- V. On 25 February 1998 a notice of appeal was lodged against that decision together with payment of the appeal fee.

The statement of grounds of appeal was filed on 25 May 1998

The appellant requested that:

- the decision under appeal be set aside
- the case be remitted to the Opposition Division with the order to examine the opposition, including the late filed Japanese Utility Model, and
- the appeal fee be reimbursed as the appeal was at least partially necessitated by a substantial procedural violation on the part of the Opposition Division.

- V. In a communication dated 5 July 1998 the Board expressed the provisional opinion that the indications provided for in the notice of opposition appeared to be

sufficiently complete to meet the requirements of Rule 55(c) EPC, at least with respect to the "TB 380" bell.

In the Board's opinion no substantial procedural violation was committed on the part of the Opposition Division. Furthermore it appeared correct that the late cited evidence could not be taken into account for deciding the admissibility of the opposition.

VII. In support of its requests the appellant essentially relied upon the following submissions:

Not only did the Opposition Division fail to correctly interpret the requirements of Rule 55(c) EPC it further neither invited the appellant to remedy the alleged deficiencies in the notice of opposition nor did it correctly apply Article 114(1) EPC.

Rule 55(c) EPC required "an indication of the facts, evidence and arguments presented in support of the grounds on which the opposition was based" whereas the Opposition Division seemed to have examined whether the notice of opposition contained conclusive evidence for the prior use. As regards such "indication" in accordance with decision T 538/89 of 2 January 1991 this requirement merely had to be interpreted as meaning that the notice of opposition must indicate what attack was being mounted against the patent and what evidential support was being adduced for that attack. In this respect the notice of appeal clearly set out the reasons why the subject-matter of claim 1 was considered to lack novelty when having regard to the evidence submitted in connection with the "TB 380"

and "DRAAIBEL" bicycle bells.

The Guidelines stated that the formalities officer should notify the opponent of possible deficiencies in good time before the expiry of the time-limits within which it was still possible to remedy the deficiencies. The principle of good faith which governed the dealings between the parties and the EPO therefore would seem to dictate that the opponent should have been informed of the possible deficiency and the failure to do so would seem to constitute a substantial procedural violation which would warrant a reimbursement of the appeal fee in accordance with Rule 67 EPC.

When the notice of appeal was filed the opponent was convinced that the public prior use of both the TB 380 and the "Draaibel" bicycle bells were sufficiently substantiated to comply with the formal requirements of the EPC. This view was strengthened when the notice of opposition was communicated to the proprietor, indicating that the Opposition Division had preliminarily accepted the opposition. However, when it was later found that the Opposition Division considered the opposition to be inadmissible the opponent carried out a search for further substantiation of the opposition and found Japanese Utility Model No 3-49110 in the name of TOKYO BELL. This utility model concerned prior art very similar to the TB 380 bell. However, the Opposition Division refused to examine this document, even though it was clear that it completely anticipated the subject-matter of claim 1 of the patent. In so far the Opposition Division failed to comply with the established case law according to which Article 114(1) took precedence over Article 114(2) EPC in case of

apparent relevance of the late cited evidence.

VIII. The respondent requested rejection of the appeal. Its submissions are summarised as follows:

The opposition was based on the alleged public prior use of two bicycle bells, the bicycle bell "TB 380" produced by the Tokyo Bell Company and the bicycle bell "Draaibel" produced by the opponent. However, the appellant failed to submit any proof that these bicycle bells were known prior to the priority date of the patent in suit and also failed to submit a sufficient disclosure of the structure of the bells so that it was possible for the proprietor to check whether there could be eventually some resemblance between said bells and the structure claimed in the patent in suit and to give arguments for defending the claimed subject-matter. In so far as the Opposition Division correctly concluded that the notice of opposition did not meet Rule 55(c) EPC in respect of the requirement that the notice of opposition should contain a sufficient indication of the facts, evidence and arguments presented in support of the ground of opposition raised by the opponent.

In this respect attention was drawn to the decisions T 204/91 of 22 June 1992 and T 538/89, *supra*, according to which the term "indication" should be interpreted to mean that the notice of appeal should elaborate the relevant circumstances of the case to such an extent that the patentee and the Opposition division are able to form a definitive opinion on at least one ground of opposition raised, without the need to make further investigations.

With respect to the formal objections raised by the appellant reference was made also to the decision T 222/85 (OJ 1988, 128).

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility of the opposition*
 - 2.1 Since the requirements of Article 99, Rule 55(a) and(b) and Rule 1 are fulfilled the remaining question to be considered here is whether the requirements of Rule 55(c) are met, in particular whether at least one of the alleged prior uses relating to the "TB380" and the "Draaibel" bicycle bells was submitted in a manner so that a sufficiently clear "indication" of the facts, evidence and arguments presented in support of the ground of lack of novelty could be derived from the notice of opposition.

 - 2.2 The appellant was of the opinion that evidence filed later than the 9 month period mentioned in Article 99 EPC should have been taken into account by the opposition under Article 114(1) EPC.

However, substantive examination of the opposition can be started only if the opposition is formally admissible which means that for deciding the admissibility only those facts, evidence and arguments presented before the end of the opposition period can be taken into account for such decision. If later filed evidence was accepted for this purpose this clearly

would go against the limitation of the opposition period stipulated by Article 99 EPC.

- 2.3 Considering evidence based on an alleged prior use, in accordance with the case law of the Boards of appeal the notice of opposition must indicate all the facts which make it possible to determine the date of prior use, what has been used, and the circumstances relating to the prior use for allowing a conclusion whether or not the prior use was publicly available before the filing date of the patent in suit.

Furthermore, in relation to the concept of "indication" mentioned in Rule 55(c) EPC (see for example T 204/91, point 5) the scope and depth of substantiation of the prior use needs to be such as to enable the patentee and the Opposition Division to see clearly just what attack was being mounted against the patent, and what evidential support was being adduced for that attack. However, evidence mentioned in the notice of opposition could be submitted after expiry of the period for opposition (see T 538/89, point 2.6).

- 2.4 When considering the "indication" provided in the notice of opposition, the Board draws attention to the fact that the subject-matter claimed concerns a simple and generally well known technical item, i.e. a bicycle bell. Therefore, since the skilled person is well aware of the general mechanical construction of a bicycle bell, the evidence submitted by the appellant must be judged against such general background knowledge of the skilled engineer. In so far the Board follows the conclusion drawn in the decision T 538/89 (point 2.3, second paragraph) that the question whether the

opposition is sufficiently substantiated to conclude its admissibility is closely related to the technical particularities of the case concerned and may also depend on the difficulty of answering the decisive questions. This must be assessed on an objective basis, from the point of view of a reasonably skilled person in the art to which the opposed patent relates (see in this respect also T 222/85, supra, last lines of point 4 and point 5).

- 2.5 The appellant tried to establish the date of the alleged prior use of the "TB 380" bell by reference to the letter (c). In the Board's opinion, the content of the letter in connection with the leaflet (b) is basically suited to support the appellant's view that the rotary bell "TB 380" offered in that letter could be ordered and resold freely and was therefore made available to the Dutch market from 2 August 1990 on. In the leaflet the shape of the TB 380 bell is shown to be apparently the same as the one in the photograph (a) which follows from the specific shape of the TB 380 bell and also corresponds with the statement in the letter (c) that there is an outer ring which has to be turned to ring the bell.

The appellant further indicated that he had a limited number of those bells available which could be inspected at request and would be shown at the oral proceedings to be held.

This evidence is considered to be a sufficiently clear "indication" (but not necessarily sufficient proof) that the "TB 380" bells were considered to be freely available on the Dutch market before the priority date

of the patent in suit, thus answering the question where (in the Netherlands), when (in advance of the priority date of the patent in suit), how (by free ordering and selling) and by whom (the company Tokyo Bell) the alleged prior use took place.

2.6 Considering now the construction of the "TB 380" bell, although the photograph (a) is not very clear, at least a greater part of its components can be identified with the help of the description given in the notice of opposition and the letter to the "Alkmaarse Groothandel Unie" (c). The main components visible on the photo of this bell are:

- a frame and handlebar mounting means,
- a bell mounted to the frame,
- striking means
- a rotatable outer ring for actuating the striking means so that the bell is rung.

It was further explained in the notice of appeal by reference to the claim of the present patent which features of the claim were considered to be incorporated in the "TB 380" bell (features in bold letters) and which features were implied by the construction of the "TB 380" bell (features in normal letters).

Additionally the implied features were addressed one by one to make clear that the arm on which the striking means was mounted is formed by a helical spring.

Although such a spring is not identifiable in the further evidence (including the photograph) it is clear from the feature concerning the cam co-operating with a tothing provided on the inner circumference of the annular operating means - which can only refer to the rotatable outer ring mentioned in the evidence and which is recognisable in the photograph - together with the further explanation concerning the cams being formed by the striking means themselves, that spring support is provided for the striking means so as to allow the striking means to move and ring the bell when the outer ring is rotated.

Therefore, considered in relation to the explanations given in the notice of appeal, the Board cannot follow the respondent's opinion according to which the various parts visible on the photograph were neither identified as such, nor were they in any way identified vis-a-vis the features of claim 1 nor was the operation of the bell and the function of the various visible parts evident.

Additionally, the appellant offered further evidence by inspection of the TB 380 bells that were in its possession well before the expiry of the opposition period.

Therefore a sufficiently clear "indication" of **"what"** was allegedly used was also present in the notice of appeal and at any time this could be verified by inspection of the bells offered for inspection.

- 2.7 The respondent further argued that the notice of appeal did not contain sufficient information so as to allow

the Patentee and the Opposition Division to form a definite opinion on the ground of opposition raised without the need to make further investigation, and to indicate clearly to the proprietor the case he has to answer, as was the notion of "indication" identified in the decision T 204/91.

The Board is of the opinion that the respondent reads into decision T 204/91 a restrictive concept of "indication" which is neither supported by the content of this decision nor by the other decisions referred to.

In this respect attention is drawn to decision T 538/89 also referred to by the respondent, which sets out the difference between the requirements to be met when deciding the admissibility of the opposition and the probative value of the facts and evidence provided in support of the ground of opposition when examining the allowability of the opposition.

The arguments relied upon by the respondent essentially concern the question whether the evidence submitted in respect of the alleged prior use provides unequivocal proof of the alleged facts rather than the more general requirement following from the concept of "indication" as outlined above.

- 2.8 Summarising, as set out in points 2.4 to 2.5 above, the notice of opposition contains sufficient detail, at least as regards the TB-380 bell, to allow the patentee and the Opposition Division to understand the basis of the attack of lack of novelty of the subject-matter of claim 1 of the patent in suit. Therefore also the last

requirement of Rule 55(c) EPC is fulfilled and consequently the opposition is admissible.

- 2.9 Since the requirements for admissibility are fulfilled, at least in respect of the alleged public prior use supported by the TB 380 bicycle bell, there is no need to consider the admissibility of the opposition in respect of the alleged public prior use of the "Draaibel".

Once the opposition is found admissible the facts, evidence and arguments presented in support of the ground of opposition, thus also including the alleged public prior use in respect of the "Draaibel" are subject to the examination of the opposition which now has to be carried out by the Opposition Division.

In the examination of the opposition only the facts and evidence not submitted in due time underlie the provision of Article 114(2) EPC and the case law of the Boards of appeal in that respect. In so far it is up to the Opposition Division to decide whether or not the late filed Japanese Utility model No. 3-49110 should be considered in the opposition proceedings.

3. *Request for reimbursement of the appeal fee*

- 3.1 In support of its allegation that the Opposition Division committed a substantial procedural violation the appellant referred to the Guidelines for Examination Part D, Chapter IV, paragraph 1.2.2, according to which a deficiency under Rule 55(c) is checked by the Opposition Division and (paragraph 1.3.3) the formality officer should notify

the opponent in good time before the expiry of time limits within which it is still possible to remedy the deficiencies.

3.2 However, as regards the extent of the formalities officer's obligation to issue a communication to notify deficiencies under Rule 55(c) EPC it is also explicitly stated in the Guidelines that the opponent cannot seek legal remedy against failure to issue such a communication because this is to be regarded merely as a service afforded to the opponent by the EPO. The Board sees no reason to raise doubt in respect of the validity of such procedure under the requirements of the EPC or that the principle of good faith which governs the dealings with the parties and the EPO was infringed.

3.3 Furthermore, the mere fact that the Board has come to a different conclusion regarding the admissibility of the opposition does not in itself mean that the Opposition Division committed a substantial procedural violation. The issue involved when deciding upon the admissibility of the opposition was basically related to a question of judgment of the facts presented by the appellant rather than being of procedural nature (see also point 2.4 of this decision).

3.4 The appellant further argued that the late filed evidence, in particular the Japanese Utility model No. 3-49110 should have been taken into account by the opposition division. However, according to Article 101 EPC substantive examination of the opposition can be started only if the opposition is found formally admissible and therefore the provisions of

Article 114(1) and (2) EPC do not apply in a case where the opposition procedure was not started due to inadmissibility of the opposition.

- 3.5 For the above reasons the Board concludes that there was no substantial procedural violation on the part of the Opposition Division. Consequently there is no basis for reimbursement of the appeal fee (Rule 67 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 for further prosecution.
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:

S. Fabiani

F. Gumbel