

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

D E C I S I O N
of 25 January 2005

Case Number: T 0983/01 - 3.2.6

Application Number: 95200776.3

Publication Number: 0674968

IPC: B23P 19/04

Language of the proceedings: EN

Title of invention:

Machine for applying runners to a drawer

Patentee:

Ferrari, Franco

Co-opponents:

Casati Macchine s.r.l. / Formenti & Giovenzana S.p.A.

Headword:

-

Relevant legal provisions:

EPC Art. 99, 54(2), 111(1)

Keyword:

"Admissibility of the opposition (yes)"

"Admissibility of amendments filed during oral proceedings
(yes)"

"Prior art made available by sale"

"Novelty (yes) - after amendment"

Decisions cited:

G 0003/99, G 0003/98, T 0132/92, T 0482/89, T 1022/99

Catchword:

-



Case Number: T 0983/01 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 25 January 2005

Appellant: Ferrari, Franco
(Proprietor of the patent) Frazione Deviscio, 2
I-22053 Lecco (Como) (IT)

Representative: Faraggiana, Vittorio, Dr. Ing.
Ingg. Guzzi & Ravizza S.r.l.
Via Vincenzo Monti 8
I-20123 Milano (IT)

Respondents: Casati Macchine S.r.l.
(Co-opponents) Via Bonvesin de la Riva, 6
I-20027 Rescaldina (MI) (IT)

and

Formenti & Giovenzana S.p.A.
Via Piave, 55
I-20050 Veduggio con Colzano (MI) (IT)

Representative: Perani, Aurelio
Perani Mezzanotte & Partners
Piazza San Babila 5
I-20122 Milano (IT)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 25 June 2001
revoking European patent No. 0674968 pursuant
to Article 102(1) EPC.**

Composition of the Board:

Chairman: P. Alting Van Geusau
Members: G. Pricolo
R. T. Menapace

Summary of Facts and Submissions

- I. The appeal is from the decision of the Opposition Division posted on 25 June 2001 to revoke European patent No. 0 674 968, granted in respect of European patent application No. 95 200 776.3.
- II. In the decision under appeal the Opposition Division considered that although amended claim 1 as filed with letter of 14 December 1999 met the requirements of Article 123(2) and (3) EPC, its subject-matter lacked novelty in the light of the prior art constituted by a machine "MAC 2/2 MODIFIED" which was made available to the public by means of a sale by Casati Macchine s.r.l. to Formenti & Giovanzana s.p.a. (the co-opponents) in February 1994, as was considered proven by the following evidence:
- D1: Affidavit of Mr Giorgio Casati dated 5 July 1999, together with a list of enclosures ("allegati") and enclosures 1 to 19; and
D1T: English translation of D1;
- D2: Affidavit of Mr Giancarlo Formenti dated 5 July 1999, together with a list of enclosures ("allegati") and enclosures 1 to 4; and
D2T: English translation of D2;
- D3: Affidavit of Mr Francesco Molteni Formenti dated 5 July 1999, together with a list of enclosures ("allegati") and enclosures 1 and 2; and
D3T: English translation of D3;

D4: Affidavit of Mr Stefano Pesenti dated 5 July 1999, together with a list of enclosures ("allegati") and enclosures 1 and 2; and

D4T: English translation of D4.

III. The appellant (patentee) lodged an appeal, received at the EPO on 24 August 2001, against this decision and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received at the EPO on 29 October 2001.

IV. In a communication accompanying the summons for oral proceedings pursuant to Article 11(1) Rules of Procedure of the Boards of Appeal the Board, having regard to the appellant's doubts on the admissibility of the opposition jointly filed by the two co-opponents, referred to the recent decision G 3/99 of the Enlarged Board of Appeal according to which an opposition could not be regarded as inadmissible on the mere ground that it was filed in common by two or more persons. The Board moreover expressed the preliminary opinion that it would appear that the amendments made to claim 1 during the opposition proceedings were contrary to the requirements of Article 123(2) EPC due to the introduction of the feature according to which the mechanical actuating means was arranged to "sequentially" operate the two clinching assemblies, and that the discussion during oral proceedings should focus on the issues concerning the credibility of the evidence D1T to D4T (together with their respective enclosures) in support of the prior use of the MAC 2/2 MODIFIED machine.

V. With letter dated 17 December 2004 the appellant submitted that the term "sequentially" was chosen to summarize the originally disclosed concept of the actuating means acting in two consecutive stages in order to avoid a simultaneous clinching of the two runners by the respective clinching assemblies and that the appellant was fully available to amend the relevant passage of claim 1 by using the exact wording of the application as filed.

VI. Oral proceedings, at the end of which the decision of the Board was announced, took place on 25 January 2005.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claim 1 as filed during the oral proceedings.

The respondents (co-opponents) requested that the appeal be dismissed.

Both parties further requested that the case be remitted to the department of first instance for continuation of the opposition proceedings if the appeal would not be dismissed.

VII. Claim 1 filed during the oral proceedings before the Board of Appeal reads as follows:

"1. Machine (10) for clinching runners on drawers, said runners comprising gripping tabs laterally disposed along a U-shaped groove in the runner which receives a lower edge of the side panel of the drawer, the machine comprising two clinching assemblies (20), each clinching assembly (20) having a channel (17) parallel

to the channel (17) of the other clinching assembly (20) for receiving the groove of one runner and the edge of the associated side panel disposed therein, each channel (17) being delimited on one side by hammer means (21) and on the other by anvil elements (22), mechanical actuating means (44) being arranged to operate in two consecutive stages the two clinching assemblies (20) by moving the respective anvil elements and hammer means reciprocally towards one another to grip the portion of the runner in the channel (17) between them and clamp the tabs against the side panel, whereby the hammer means are made of a plurality of hammer elements (25) secured to a movement head (28) pivotable about an axis (30) parallel to the channel (17) to be rotated around such axis by the actuating means, the two clinching assemblies (20) being connected for their operation to a control device (40) emitting respective activating signals with a pre-established reciprocal time delay upon operation of a clamping control device (42), so as to avoid the simultaneous clinching of the two runners."

VIII. In support of its requests the appellant relied essentially on the following submissions:

The alleged sale of a machine MAC 2/2 MODIFIED was already evaluated by an Italian Court during a civil lawsuit brought by the Ferrari Franco company (the patentee and appellant in the present proceedings) against Casati s.r.l and Formenti & Giovenzana s.p.a. (the two-co-opponents and respondents in the present proceedings). As stated in

Exhibit A: Decision of the 1st civil section of the Court of Milano (IT) dated 16 March 2000, filed together with

Exhibit A1: partial translation of Exhibit A;

the Court came to the conclusion that the alleged prior sale was an evident abuse committed by Casati in respect of the Ferrari Franco. However, apart from the violation of a secrecy agreement, the alleged sale of a machine by Casati to Formenti & Giovenzana could not be seen as a public disclosure but only as a confidential delivery because Formenti & Giovenzana was not a manufacturer of drawers but a manufacturer of runners and there was no apparent reason for the latter to purchase a machine for applying runners to a drawer. Furthermore, Casati and Formenti & Giovenzana were two companies clearly co-operating since long and now joined as co-opponents.

Anyway, the evidence put forward by the co-opponents was not such as to prove beyond any reasonable doubt that the prior use actually took place in the alleged manner. Firstly, all the affidavits filed by the opponents were signed by persons having direct interests in the matter. Secondly, a number of inconsistencies were present which justified a reasonable doubt:

The machine referred to in the delivery notes and invoices filed as enclosures to the affidavits D1, D2 and D3 had a weight of 120 kg which was about half the actual weight of a MAC 2/2 double-head machine as indicated for example in

Exhibit B: Declaration of Mr Agostino Ferrari dated
25 January 2001,

filed during the opposition proceedings.

Although it might happen that a manufacturer of runners such as Formenti & Giovanzana could use the allegedly prior used machine to show mounting of its runners onto drawers at public exhibitions and technical fairs, it was undisputable that a machine to be used for such purposes should always be in optimal conditions and would anyway appear practically brand-new even after many years because it would operate only a few days per year. Contrary thereto, the machine illustrated in the pictures filed as enclosures of D2 and D3 dated of only five years after the alleged sale, was clearly a wreck, which evidently had been operated to apply thousands of runners in a rough environment such as a drawer assembly plant. Furthermore, the machine shown in the pictures was lacking any logo, identification serial number, manufacturer's data, etc. Under these circumstances it was reasonable to assume that that the machine shown in the pictures was not the machine that was the subject-matter of the alleged sale in February 1994 but another machine to which, possibly, all identification elements had been removed.

The fact that the machine shown in the mentioned pictures and allegedly also in the drawing filed as enclosure 9 of D1 was not the "modified" version of the MAC 2/2 machine was apparent from the fact that in the pictures the hammer means were not provided with shafts, but were affixed with screws to the actuating means.

Furthermore, it was very doubtful that a storekeeper of Formenti & Giovenzana's could still remember in 1999, i.e. at the time of drafting the affidavit D3, that a machine delivered more than five years before was structurally identical to the machine shown in the pictures.

No documents proved the existence of offers and contacts, such as usual in practice, between Casati and Formenti & Giovenzana before the alleged sale of the machine. Moreover, it was not credible that a machine for manufacturing drawers was first offered and sold to a manufacturer of runners disregarding the manufacturers of drawers who were the normal customers for this kind of machines. In fact it was to be expected that evidence relating to commercialization of the allegedly prior used machine before the sale of Casati to Formenti & Giovenzana should be available. However such evidence, which was also relevant for the infringement proceedings before the Italian Court (see Exhibit A1) initiated in 1996 and for which retrieval the co-opponents thus had plenty of time, was not submitted.

Anyway, the allegedly prior used machine was not prejudicial to the novelty of the claimed subject-matter because it did not include the feature according to which the mechanical actuating means were arranged to operate the clinching assemblies in two consecutive stages for avoiding the simultaneous clinching of the runners. In fact, the respondents did not provide any convincing evidence in support of this feature.

IX. The arguments of the respondents can be summarized as follows.

Although not being of such nature to result in a substantial delay of the proceedings, the amendments made to claim 1 at various stages during the oral proceedings should be disregarded because they were not submitted in good time before oral proceedings.

Before the entry into force of the corresponding EU directive, there was no legal obligation in Italy to identify a specific machine with a plate including manufacturer's data and/or an identification serial number. A plate or logo (the latter being simply an adhesive which could be applied at any time), were applied only upon request by the client or in case of complex machines, to facilitate the identification of spare parts. The MAC 2/2 MODIFIED machine shown in the pictures annexed to D2 and D3 was not provided with a plate or logo because no request in that sense was made by the client (Formenti & Giovenzana) and because the machine was a very simple tool. In fact, the absence of a plate and/or a logo was not an unusual circumstance as proven by the fact that the machine was shown in commercial catalogues without any plates or logos. Furthermore, the machine delivered in February 1994 was the first machine of that kind to be sold to Formenti & Giovenzana. The purpose of this first delivery was to allow Formenti & Giovenzana to try and test the machine and thus evaluate whether it could pass it on to the clients that bought the runners to enable them to apply the runners to their drawers. As a matter of fact, it was usual practice for the manufacturer of runners to provide the clients not only with runners for their

drawers but also with the suitable machine for applying them. Furthermore, Formenti & Giovenzana was also a manufacturer of drawers since 1994, i.e. from the time at which it had acquired a company specialized in the manufacture of furniture and in particular of drawers, and therefore clearly had an own interest in the machine.

As stated in D2 and proved by the offer of Casati to Formenti & Giovenzana (enclosure 3 of D2) there had been several contacts between these two companies before the date of delivery of the machine MAC 2/2 MODIFIED.

It was not surprising that the storekeeper of Formenti & Giovenzana could remember the structure of the machine, because it was the first of that kind to be delivered. Furthermore, although his declaration D3 dated back to 1999, the relevant date at which he had to remember the machine was in 1996, i.e. at the time when the judicial action against Casati and Forment & Giovenzana (Exhibit A1) was initiated.

Although in the delivery notes annexed to the declaration D1, D2 and D3 the weight of the machine was wrongly indicated as being 120 kg, the indication of the weight in the delivery notes was not compulsory under Italian law. This was an information useful only for transportation but unnecessary for fiscal reasons.

The machine illustrated in the pictures enclosed to the declarations D2 and D3 showed signs of wear already in 1996, when it was inspected by order of the Italian Court during the infringement proceedings referred to

above, because it indeed worked very hard in the premises of Formenti & Giovenzana. In fact, it wasn't used for mere isolated test purposes but to evaluate its functioning in a real production line.

As regards the drawing of enclosure 9 annexed to declaration D1, it did not show all the constructional details, in particular all the details of the hammer means and of how they were affixed to the respective shafts, because these were already known from previous versions of the MAC 2/2 machine.

The MAC 2/2 machine which was thus made available to the public had all the features of claim 1 of the patent in suit. In particular, it directly followed from the declarations D1, D2 and

D7: Affidavit of Mr Rodolfo Forni dated 19 July 2000, together with a list of enclosures ("allegati") and enclosures 1 to 7; and

D7T: English translation of D7;

that the two clinching assemblies were operated with a reciprocal time delay. Furthermore it was evident from enclosure 7 of D7, which showed the pneumatic plan system for operating the clinching assemblies, that there were valves and pneumatic restrictions acting as a control device emitting respective activating signals with a pre-established reciprocal time for operating the two clinching assemblies in two consecutive stages. Accordingly, the subject-matter of claim 1 was not novel over the disclosure of a MAC 2/2 MODIFIED machine.

Reasons for the Decision

1. *Admissibility of the appeal.*

The appeal is admissible.

2. *Admissibility of the opposition*

In its statement of grounds of appeal, the appellant raised doubts on the admissibility of the opposition on the only ground that it was filed in common by Casati Macchine s.r.l. (hereinafter referred to simply as "Casati") and Formenti & Giovanzana s.p.a. (hereinafter referred to simply as "Formenti & Giovenzana").

In the communication accompanying the summons for oral proceedings the Board referred in this respect to decision G 3/99 of the Enlarged Board of Appeal according to which an opposition filed in common by two or more persons and which meets the requirements of Article 99 EPC and Rules 1 and 55 EPC is admissible on payment of only one opposition fee. Accordingly in the present case the opposition cannot be regarded as inadmissible for the mere fact that it has been filed in common by two co-opponents. The appellant's objection, which was however no longer relied upon during the oral proceedings before the Board of Appeal, must therefore be dismissed.

3. *Amendments*

- 3.1 During the oral proceedings before the Board of Appeal, claim 1 was amended over claim 1 of the set of claims filed with letter of 14 December 1999 on which the

decision of the Opposition Division was based by the inclusion of:

- (i) the features of claim 11 of said set of claims,
- (ii) the feature "in two consecutive stages", and
- (iii) the feature "so as to avoid the simultaneous clinching of the two runners".

Amendments (i) and (ii) were made in response to the objection under Article 123(2) EPC raised by the Board in its communication accompanying the summons for oral proceedings and in respect of which the appellant already indicated in the letter of 17 December 2004 its intention to amend claim 1 by using the wording of the application as filed referring to the operation of the clinching assemblies in two consecutive stages. Since the proposed amendments seek to overcome an objection raised by the Board, which was further discussed and explained during the oral proceedings, their filing during the oral proceedings cannot be regarded as not having been made in due time.

Amendment (iii) was made in response to the objection raised by the respondents during the oral proceedings according to which the feature that the mechanical actuating means was arranged to operate the two clinching assemblies "in two consecutive stages" contravened the teaching of the opposed patent of avoiding simultaneous clinching of the two runners, because it only implied that the two clinching assemblies did not start the operating movement at the same time but did not exclude the case that the second

clutching assembly was operated with a small delay resulting in simultaneous clutching of the two runners. Therefore, since this proposed amendment seeks to overcome an objection raised by the respondents in respect of the previous amendment made during oral proceedings, its filing during the oral proceedings cannot likewise be regarded as not having been made in due time.

Furthermore, the introduction of these amendments does not result in a substantial delay of the proceedings, as admitted by the respondents themselves. The claim submitted during the oral proceedings before the Board is, therefore, admissible and forms the basis of this decision (see e.g. T 132/92, points 2.2 and 2.3).

- 3.2 The basis for the definition of claim 1 is found in claims 1, 4, 10 and 12 and in page 8 of the description, lines 3 to 9, of the application as filed.

Claim 1 includes all the features of claim 1 of the patent as granted. Since it also includes further limiting features, in particular those of granted claims 9 and 12, it restricts the extent of protection conferred by the patent in suit.

Therefore, the amendments of claim 1 do not give rise to objections under Article 123(2) and (3) EPC.

4. *Prior use of a MAC 2/2 MODIFIED machine*

During the proceedings it was not disputed that a machine "MAC 2 versione doppia" (two heads) was effectively sold and delivered on 8 February 1994 to

Formenti & Giovenzana by Casati as results from the delivery note nr. 5861 of 8 February 1994 ("bolla", see enclosure 18 of D1 in which reference is made to the "vendita", i.e. the sale) and the invoice nr. 47 of 9 February 1994 ("fattura", see enclosure 17 of D1, which refers to the above-mentioned delivery note nr. 5861). In fact, the appellant essentially contested that the circumstances of the sale were such as to make the machine available to the public and that the machine effectively sold had all those features that the respondents pretended it had.

4.1 *The circumstances of the sale*

4.1.1 The fact that a "MAC 2 machine versione doppia" was effectively sold to Formenti & Giovenzana on 8 February 1994 is further confirmed by the decision of the Italian Court filed as Exhibit A (see page 2, last line, to page 3, first paragraph of the English translation filed as Exhibit A1). The Court (see page 4, last paragraph, of Exhibit A1) however comes to the conclusion that the sale is an abuse committed by Casati in view of the exclusive right restriction linking Casati and Ferrari Franco (the patentee and appellant in the present proceedings).

Even if the sale effectively was an abuse, it cannot be regarded as a non-prejudicial disclosure in the sense of Article 55(1)a EPC because it occurred earlier than six months preceding the filing (which according to G 3/98 means the filing date, i.e. 28 March 1995) of the European patent application, as correctly noted by the Opposition Division (point 5.1 of the decision under appeal). Nor would any such abuse of Casati in

relation to Ferrari imply an obligation to secrecy for a third party such as Formenti & Giovenzana to which the machine was sold by Casati.

In fact, a single sale of the machine as in the case at hand is sufficient to render the machine sold available to the public unless Formenti & Giovenzana was bound by an obligation to maintain secrecy in relation to Casati (see e.g. T 482/89, OJ 1992, 646 and T 1022/99).

- 4.1.2 The appellant argued that the sale was confidential, because Formenti & Giovenzana was not a manufacturer of drawers but of runners and because Casati and Formenti & Giovenzana were two closely co-operating companies.

In the Board's opinion there are actually good reasons for a manufacturer of runners to buy a machine for applying runners to drawers, such as for instance for testing the runners upon their application and in use after having been applied to a drawer. Furthermore, during the oral proceedings the respondent Formenti & Giovenzana explained that its commercial activity was not limited to manufacturing and selling runners for drawers, but included also the commercialization of the machines for applying the runners produced by Formenti & Giovenzana. In fact, this is confirmed by the statement in the decision of the Italian Court filed as Exhibit A, according to which (page 8) the Court "ascertained that Casati produces and Formenti & Giovenzana commercializes" machines for applying runners to drawers. Thus, there is no reason to doubt that Formenti & Giovenzana had an interest in unconditionally buying a MAC 2 machine for testing it under real production conditions, since its intention

was to pass on the machine to the clients that were buying the runners.

The further fact, submitted during the oral proceedings and undisputed by the appellant, according to which Formenti & Giovenzana acquired a furniture manufacturing company is an additional element showing the interest of Formenti & Giovenzana in unconditionally buying a MAC 2 machine.

As regards the co-operation between Casati and Formenti & Giovenzana, there is no element that supports the appellant's conclusion that the relationship between the two companies was such that the sale of the MAC 2 machine in February 1994 was confidential. In fact all facts and evidence, in particular those stated above, unambiguously confirm that the relationship between Casati and Formenti & Giovenzana was of purely commercial nature: Casati manufactured machines and put them on the market, and Formenti & Giovenzana bought them and either used them on its own or supplied them to its clients together with its own products (the runners). In such circumstances, an agreement on secrecy not only does not make sense, but would even have been detrimental to Formenti & Giovenzana who in such case could not pass on the machine or the relevant technical information in respect of how to apply the runners to its clients.

- 4.1.3 The appellant further argued that no documents proved offers or contacts between Casati and Formenti & Giovenzana resulting in the alleged sale of the machine and that it was not credible that a machine for

manufacturing drawers was first offered and sold to a manufacturer of runners.

As regards the latter argument, it has already been stated above that Formenti & Giovenzana was not merely a manufacturer of drawers and that it had an evident interest in acquiring a machine for applying runners to drawers. In fact, since Formenti & Giovenzana supplied its clients not only with runners but also with the necessary equipment for applying them to drawers, it would have been normal for Casati to first try to sell its machine to Formenti & Giovenzana rather than to the manufacturers of drawers.

Furthermore, evidence in support of offers and contacts between Casati and Formenti & Giovenzana in relation to machine for applying runners to drawers is found not only in enclosure 16 of D1 (offer of Casati to Formenti & Giovenzana dated 18 January 1994 referring to the same machine and price indicated in the enclosure 17 which is the above-mentioned invoice nr. 47), but also in the declaration D2T referring (see page 2) to several meetings which took place in 1993.

4.1.4 For the above reasons it is established that the sale in question was not confidential. Thus, the "MAC 2 versione doppia" machine sold on 8 February 1994 is to be considered to have been made available to the public within the meaning of Article 54(2) EPC on that date.

4.2 *The object of the sale*

4.2.1 According to the affidavit D1, the machine sold on 8 February 1994 was a so-called MAC 2/2 MODIFIED machine.

This denomination was also used in the decision under appeal to identify the MAC 2 machine which was the object of the sale in question. In order to identify the features of the MAC 2/2 MODIFIED machine, D1 refers to the drawing dated 10 March 1993 (thus dating back of about 11 months from the date of the sale) filed as enclosure 9 of D1. This drawing shows a MAC 2 double version identified as MAC 2/2 (page 3 of D1T, first full paragraph) from which the MAC 2/2 MODIFIED machine differs by the feature that the hammer elements have a striking slanting surface (see D1T, page 4, 2nd and 3rd paragraph). In D2T (pages 2 and 3) the features of the machine are described, and pictures 1 to 8 showing the machine are annexed as enclosure 2 of D2. The same pictures are annexed to the affidavits D3 and D4, and these declarations (see D3T and D4T) confirm that the machine delivered to Formenti & Giovenzana on 8 February 1994 is the one shown in the figures. Affidavit D4T further includes a description of some features of the machine.

- 4.2.2 It is true that affidavits D1 to D4 are signed by persons having direct interests in the matter: D1 and D2 are respectively signed by Mr Casati and Mr Formenti who are managers of the respondents and D3, D4 are signed by employees of the respondent Formenti & Giovenzana. However, the evidence given by means of the affidavits D1 to D4 is corroborated by further evidence, in particular the drawing enclosure 9 of D1, the pictures enclosed to D2-D4, the further affidavit D7 signed by Mr Forni who is not an employee of the co-opponent firms but the co-owner of a third company (Gamma Fluid s.r.l.). All that taken as a whole convincingly leads to the conclusion that the MAC 2/2

machine (hereinafter identified as "MAC 2/2 MODIFIED") sold and delivered on 8 February 1994 effectively corresponds to the descriptions made in the affidavits D1 to D4 and D7 and the relevant enclosures thereof.

- 4.2.3 The appellant referred to the inconsistency between the weight (120 kg) indicated in the delivery note (packing list) No. 5861 and the weight of 230 kg which, according to the respondents own admission, is the effective weight of a MAC 2/2 MODIFIED machine.

In this respect the Board agrees with the conclusion of the Opposition Division (point 5.5 of the decision) that the wrong indication of 120 kg in the delivery note (enclosure 18 of D1) and in the invoice (enclosure 17 of D1) was due to a general error in the Casati firm. This is confirmed by the fact that also in the brochure D20 of Casati filed during the oral proceedings before the Opposition Division the weight is wrongly indicated for the MAC 2 double headed version as being 120 kg with base. The fact that the indication of the weight in the delivery note and in the invoice was not required by the Italian regulations taken together with the fact that from a technical point of view the weight of the machine is of secondary importance is a reasonable explanation of such error and also of the absence of thorough checks in respect of a correct indication of the weight in the documents issued by Casati.

- 4.2.4 As regards the appellant's submission that the machine illustrated in the pictures filed as enclosures of D2 to D4 was clearly a wreck, it is noted that the machine shown in the pictures has clear signs of wear and rust

due to an intensive use and/or lack of proper maintenance. The respondents have however convincingly explained that the machine was used in production conditions. As it is quite normal for a machine of that kind to have signs of wear after an intensive use and after some years, this does not cast doubt on the fact that the pictures annexed to D2 to D4 effectively show the MAC 2/2 MODIFIED machine delivered on 8 February 1994.

4.2.5 Nor does the absence of a logo or an identification plate on the machine shown in the pictures justify such doubts. In fact, it was not contested by the appellant that at the time of the delivery no particular identification plate was required under Italian regulations. Furthermore, the absence of such a plate or a logo appears to correspond to normal practice in the case of a first delivery of a machine for testing it inside the customer's company. This aspect actually contributes to confirm, rather than to weaken, the respondents contention that the machine shown in the pictures was a first delivery.

4.2.6 As regards the argument of the appellant put forward during the oral proceedings that the machine shown in the pictures could have been another machine than the one effectively delivered on 8 February 1994 to which all identifications elements had been removed, the Board notes that without evidence to the contrary it has no reason to assume that all the cited affidavits were written in bad faith and that their signatories made statements without being certain that the machine delivered was the one shown in the pictures. In any event, the appellant could have requested to hear the

signatories of the affidavits as witnesses, if he had doubts in this respect. So there is nothing which would justify to put into question the correctness of the affidavits as to the identity of the machine shown in the pictures annexed to them.

- 4.2.7 The appellant further maintained that the statement of the storekeeper of Formenti & Giovenzana in the affidavit D3, according to which the machine received by him in 1994 was structurally identical to that shown in the enclosed pictures, was not credible.

It appears in fact rather unlikely for a storekeeper to remember all the structural details of a machine. But this is not what has been asserted by the storekeeper. In the specific circumstances of the case - it was the first delivery of a machine of that kind; it was used within the premises of the firm for test purposes; already about two years after delivery the machine was the subject of infringement proceedings including an in-situ inspection (as stated by the parties during the oral proceedings) - it is in the Board's view quite reasonable to expect from the storekeeper to reliably recognize what machine, from those present within the premises of his company, was the one delivered on 8 February 1994.

- 4.2.8 Finally, the Board cannot see any inconsistency between the drawing filed as enclosure 9 of D1 and the pictures, apart from the difference mentioned by the respondents that the machine shown in the pictures has hammer elements with striking slanting surface. Contrary to the appellant's criticism in this respect, the drawing shows clearly (see "sezione A-A") that the hammer

elements are rotatable between two positions about an axis (shaft) to which they are affixed.

4.2.9 Accordingly, having regard to the statements in the affidavits D1-D4 and D7, to the enclosure 9 of D1 and to the pictures enclosed to D2-D4 and D7, it is established that the MAC 2/2 MODIFIED machine delivered by Casati to Formenti & Giovenzana on 8 February 1994 was provided with the following features:

two clinching assemblies, each clinching assembly having a channel parallel to the channel of the other clinching assembly for receiving the groove of one runner and the edge of the associated side panel disposed therein, each channel being delimited on one side by hammer means and on the other by anvil elements, mechanical actuating means for operating the two clinching assemblies by moving the respective anvil elements and hammer means reciprocally towards one another to grip the portion of the runner in the channel between them and clamp the tabs against the side panel, whereby the hammer means are made of a plurality of hammer elements secured to a movement head pivotable about an axis parallel to the channel to be rotated around such axis by the actuating means.

In fact, the appellant did not contest that the machine shown in the above-mentioned drawing and enclosures effectively has these features.

Nor did the appellant contest that such machine also comprises the feature that the two clinching assemblies are connected for their operation to a control device emitting respective activating signals with a pre-

established reciprocal time delay upon operation of a clamping control device. This is confirmed by affidavits D1, D2, D4 and D7, all of which state that "the two clinching assemblies operation takes place with a reciprocal time delay" (see e.g. D1T, page 3).

- 4.2.10 The appellant however contested that in the MAC 2/2 MODIFIED machine the mechanical actuating means were arranged to operate the clinching assemblies in two consecutive stages, the time delay between the activating signals being such as to avoid the simultaneous clinching of the two runners.

The Board follows this view, for the following reasons. The above-mentioned statement in affidavit D1, D2, D4 and D7 that "the two clinching assemblies operation takes place with a reciprocal time delay" does not imply that the time delay is such as to avoid the simultaneous clinching of the two runners. In order to achieve this result it is necessary that the time delay be such that the clinching operation of the second clinching assembly starts after the clinching operation of the first clinching assembly is terminated, i.e. that the clinching stages are consecutive and do not overlap.

- 4.2.11 The pneumatic diagram filed as enclosure 7 of D7 shows that upon operation of a pedal a control device consisting of pneumatic valves and a variable fluid restriction emits pneumatic signals for controlling two further pneumatic valves that allow control fluid to flow in and out of respective cylinder and piston assemblies which actuate the clinching assemblies. The time delay between the operation of the two cylinder

and piston assemblies is pre-established by means of the variable fluid restriction which is disposed in the pneumatic line downwards of the valve for operating the first cylinder and piston assembly: due to this restriction, sufficient pressure to actuate the valve for operating the second cylinder and piston assembly is built up only after a pre-established delay from the actuation of the valve for operating the first cylinder and piston assembly. Thus, the clinching assemblies are operated consecutively (i.e. one after the other) by means of the two cylinder and piston assemblies. However, there is no disclosure in the drawing of the time delay being such that two consecutive clinching stages are defined so that the simultaneous clinching of the two runners is avoided.

In this respect also during the oral proceedings the respondents did not submit any facts beyond these stated in the affidavits or going further than the information directly derivable from the pneumatic diagram.

4.3 Therefore, the MAC 2/2 MODIFIED machine which became available to the public on 8 February 1994 by means of the above-mentioned unrestricted sale of Casati to Formenti & Giovenzana had the features as stated above (points 4.2.9 and 4.2.10).

5. *Novelty*

6. Accordingly, the subject-matter of claim 1 of the patent in suit is distinguished from the MAC 2/2 MODIFIED machine sold by Casati to Formenti & Giovenzana by the feature that the mechanical actuating

means are arranged to operate the clinching assemblies in two consecutive stages, the time delay between the activating signals being such as to avoid the simultaneous clinching of the two runners.

Therefore, the subject-matter of claim 1 is novel over the piece of prior art represented by said MAC 2/2 MODIFIED machine (Article 54(2) EPC).

7. *Remittal to the first instance*

Considering that the decision under appeal did not deal with inventive step, the respondents submitted further allegations of prior use during the opposition proceedings and both parties explicitly made a request to that end, the Board considers it appropriate to make use of its discretion pursuant to Article 111(1) EPC to remit the case to the first instance for further prosecution.

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.

The Registrar:

The Chairman:

U. Bultmann

P. Alting van Geusau