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D E C I S I O N
of 15 June 2004

Case Number: T 0355/02 - 3.2.3

Application Number: 94830579.2

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Language of the proceedings: EN

Title of invention:

Anchoring element for metal fittings

Patentee:

ERRETI S.r.l.

Opponents:

SIEGENIA-AUBI KG.

GIESSE GRUPPO INDUSTRIALE S.p.A.

Headword:

-

Relevant legal provisions:

EPC Art. 56, 70(1), 104(1)

Keyword:

"Inventive step (main request: no; auxiliary request: yes)"

"Apportionment of costs (refused)"

Decisions cited:

-

Catchword:

-



Case Number: T 0355/02 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 15 June 2004

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Representative: -

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
20 March 2002 concerning maintenance of
European patent No. 0 659 967 in amended form.

Composition of the Board:

Chairman: C. T. Wilson
Members: J. Du Pouget de Nadaillac
M. K. S. Aúz Castro
U. Krause
M. J. Vogel

Summary of Facts and Submissions

I. The appeal is directed against the decision posted on 20 March 2002 of an opposition division of the European Patent Office which maintained in an amended form the European Patent EP-B-0 659 967. The amendments essentially concerned claims 2 and 4. In the decision under appeal, the opposition division held that the grounds of lack of novelty, of inventive step and of sufficient disclosure raised by the two opponents did not prejudice the maintenance of the patent as amended.

Opponent 02, hereinafter the appellant, lodged the appeal on 5 April 2002 and paid the appeal fee on the same day. In the statement of grounds which was received on 16 July 2002, lack of inventive step and insufficient disclosure of the invention under Article 100(a) and (b) EPC were still objected. New evidence relating to new prior uses was also filed.

II. Claim 1 of the patent as granted reads as follows:

"An anchoring element (1) for metal fittings, of the type used to attach an accessory or part (2) to a metal profile (30) on the fitting itself; said profile (30) has at least one seat (3) which extends lengthways and is formed by two parallel, opposing trims (31a, 31 b), with "L" or "T"-shaped profile, each having at east one tab (33a, 33b) which protrudes in the direction of the opposite tab (33b, 33a), so that the profile of said seat (3) is approximately "C"-shaped, with width (L) equivalent to the distance between the said trims (31a, 31b) and height (H) equivalent to the height of the trims themselves; said accessory or part (2) has a base

consisting of two sections (21, 22) which extend lengthways and form a concave section (C), the height (H21) of the first section (21) not exceeding the height (H) of said seat (3), said first section (21) having one edge (34) forming an oblique internal surface (SO); having screws (4) with which the element (1) is attached to the accessory (2) such that they are held loosely together; the length and configuration of the anchoring element (1) is largely cuneiform, with a first surface (9) designed to fit against the accessory (2) and a second surface or base (10) to be fitted against the section of profile which lies between the two trims (31a, 31b); said anchoring element (1) has a first tooth (11) which extends crosswise and lengthways along the element (1), with height (H11) not exceeding that of the profile (3); on the side opposite the first tooth (11), the anchoring element (1) has an angled surface (P1), designed to fit against the oblique surface (SO) of the accessory (2), the angle of the angled surface (P1) complementing that of the oblique surface;

characterized in that the angled surface (P1) of the anchoring element (1) has a broken line profile shaped to define a second tooth (12), designed to fit against the afore-mentioned oblique surface (SO) of the accessory (2) and, corresponding to the first tooth (11), the anchoring element (1) has a bevel (13) which extends along the length of the anchoring element (1), designed to allow insertion of the element (1), loosely attached to the accessory (2), in the seat (3), by inserting the first tooth (11) beneath the second tab (33b), then by inserting said first lower section (21) of the accessory (2) in the seat (3) beneath a first tab (33a),

that said element (1), on said first surface (9), corresponding to an edge (15) defining the top of the angled surface (P1), has a second bevel (14) which extends lengthways along the anchoring element (1), intended to allow said first surface (9) to be angled without interfering with the accessory (2), when the first tooth (11) is inserted beneath the second tab (33b)."

Claim 2, as amended during the proceedings before the first instance, reads as follows:

"An anchoring element (1) for metal fittings, of the type used to attach an accessory or part (2) to a metal profile (30) on the fitting itself; said profile (30) has at least one seat (3) which extends lengthwise and is formed by two parallel, opposing trims (31a, 31b), with "L" or "T"-shaped profile, each having at least one tab (33a, 33b) which protrudes in the direction of the opposite tab (33b, 33a) so that the profile of the seat (3) is approximately "C"-shaped, with width (L) equivalent to the distance between the said trims (31a, 31b) and height (H) equivalent to the height of the trims themselves; said accessory or part (2) has a base consisting of two sections (21, 22) which extend lengthwise and form a concave section (C), the height (H21) of the first section (21) not exceeding the height (H) of said seat (3), said first section (21) having one edge (34) forming an oblique internal surface (S0); having screws (4) with which the element (1) is attached to the accessory (2) such that they are held loosely together; the length and configuration of the

anchoring element (1) is largely cuneiform, with a first surface (9) designed to fit against the accessory (2) and a second surface or base (10) to be fitted against the section of profile which lies between the two trims (31a, 31b);

said anchoring element (1) has a first tooth (11) which extends crosswise and lengthwise along the element (1) with height (H11) no exceeding that of the profile (3); on the side opposite the first tooth (11), the anchoring element (1) has an angled surface (P1), designed to fit against the oblique surface (S0) of the accessory (2), the angle of the angled surface (P1) complementing that of the oblique surface, wherein said anchoring element (1) has at least one appendage or tab (16) which extends lengthwise on the external face of the element (1) itself, its length approximating to the distance (D) between the element (1) once positioning on the fitting and a portion (31) of the fitting (30) itself, said tab (16) designed to allow precise positioning by resting its free end on the portion (39) of the fitting,

characterised in that

corresponding to the first tooth (11), the anchoring element (1) has a bevel (13) which extends along the length of the anchoring element (1), designed to allow insertion of the element (1), loosely attached to the accessory (2), in the seat (3), by inserting the first tooth (11) beneath the second tab (33b), then by inserting said first lower section (21) of the accessory (2) in to the seat (3) beneath said first tab (33a)."

- III. Following a communication of the board of appeal for preparing the oral proceedings, opponent 01 announced by a fax received on 19 April 2004 that it did not intend to participate in the oral proceedings. The proprietor of the patent in suit, hereinafter the respondent, filed two new claims 2 on 17 May 2004 as auxiliary requests.
- IV. Oral proceedings took place on 15 June 2004. Although duly summoned, opponent 01, as announced, did not appear. Pursuant to Rule 71(2) EPC, the proceedings were continued without them. During these proceedings, the respondent filed a new set of five claims and new pages 1 to 4 of the description as single auxiliary request.
- V. The wording of claim 1 of this auxiliary request remains the same as that of claim 1 according to the main request.

Claim 2 reads as follows:

"An anchoring element (1) for metal fittings, of the type used to attach an accessory or part (2) to a metal profile (30) on the fitting itself; said profile (30) has at least one seat (3) which extends lengthways and is formed by two parallel, opposing trims (31a, 31b), with "L" or "T"-shaped profile, each having at least one tab (33a, 33b) which protrudes in the direction of the opposite tab (33b, 33a), so that the profile of said seat (3) is approximately "C"-shaped, with width (L) equivalent to the distance between the said trims (31a, 31b) and height (H) equivalent to the height of the trims themselves; said accessory or part (2) has a

base consisting of two sections (21, 22) which extend lengthways and form a concave section (C), the height (H21) of the first section (21) not exceeding the height (H) of said seat (3), said first section (21) having one edge (34) forming an oblique internal surface (S0); having screws (4) with which the element (1) is attached to the accessory (2) such that they are held loosely together; the length and configuration of the anchoring element (1) is largely cuneiform, with a first surface (9) designed to fit against the accessory (2) and a second surface or base (10) to be fitted against the section of profile which lies between the two trims (31a, 31b); said anchoring element (1) has a first tooth (11) which extends crosswise and lengthways along the element (1), with height (H11) not exceeding that of the profile (3); on the side opposite the first tooth (11), the anchoring element (1) has an angled surface (P1), designed to fit against the oblique surface (S0) of the accessory (2), the angle of the angled surface (P1) complementing that of the oblique surface; wherein said anchoring element (1) has at least one appendage or tab (16) which extends lengthways on the external face of the element (1) itself, its length approximating to the distance (D) between the element (1) once positioned on the fitting and a portion (39) of the fitting (30) itself, said tab (16) designed to allow precise positioning by resting its free end on the portion (39) of fitting, and, corresponding to the first tooth (11), the anchoring element (1) has a bevel (13) which extends along the length of the anchoring element (1), designed to allow insertion of the element (1), loosely attached to the accessory (2), in the seat (3), by inserting the first tooth (11) beneath the second tab (33b), then by

inserting said first lower section (21) of the accessory (2) in the seat (3) beneath a first tab (33a), wherein the angled surface (P1) of the anchoring element (1) has a broken line profile shaped to define a second tooth (12), designed to fit against the aforementioned oblique surface (S0) of the accessory (2)."

VI. The arguments of the parties can be summarized as follows:

(A) From the appellant:

Regarding the Figures 4 and 5 of the patent in suit it is not clear how it is possible to fit the element 2 in the manner shown in the Figure 5. Thus, the invention is not disclosed in a manner sufficiently clear for it to be carried out by a skilled person (Article 100(b) EPC).

There is no functional relationship between the bevel of the first tooth, the broken line and second tooth of the anchoring element and, last of all, the second bevel, namely the bevel on the top of this element. The technical effect provided by this second bevel is quite obscure or can be considered as being equivalent to that of the angled surface or second tooth of the anchoring element.

D10, which shows the marketed product of the device described in D2, discloses the bevel of the first tooth. See also D1.

The claimed broken line and second tooth of the anchoring element are the result of a mere inverted positioning of what is shown in D2, in which the broken line and recess are on the internal surface of the accessory. The underlying idea is the same, namely to provide a recess on the inclined surface of one of the cooperating elements, so that one element can be moved more substantially towards the other element than was the case in the prior art, limiting the width of these two elements assembled to each other and thus allowing the introduction of the hinge in the profile between the two tabs of the C-shaped seat. Then, by tightening the screws, the cam action provided by the cooperating inclined surfaces of the anchoring element and accessory results in the fixing of the hinge on the profile. This technical effect is disclosed in D2 for the same object, namely the use of an anchoring device on profiles of various sizes. The permanent contact shown in D2 between the inclined section 3c of the accessory and the oblique surface of the anchoring element may limit the angle of tilting of the accessory with respect to the anchoring element, but it does not however impede it. Although the method for inserting the hinge into the profile seat is different in D2, the hinge according to this prior art can also be mounted in the same way as disclosed in claim 1 of the patent in suit. Identical means are also disclosed in another prior art document, namely D8, see in particular Figure 11. For the same object, the anchoring plate shown in this figure has a tooth provided on a smooth inclined surface which cooperates with the internal inclined surface of the accessory.

Therefore, the subject-matter of claim 1 as granted does not imply an inventive step.

The same conclusion applies for claim 2, the subject-matter of which comprises the same features as in claim 1, apart from the bevel at the top of the anchoring element, and the additional feature relating to the presence of a long tab for a precise positioning of the anchoring element on the profile. This last feature with the same function is well known in the art as shown by documents D9 and D5. D9, column 5, lines 14 to 27 and 39 to 46, teaches the use of tabs for a precise vertical positioning of elements of a hinge, the free end of the tabs resting on a portion of the fitting.

The auxiliary request should not be admitted since it was filed too late. Moreover, as far as inventive step is concerned, the same reasons as for claim 1 apply.

(B) From the respondent:

By an appropriate choice of the height of the second tooth and of the space between the seat bottom and the first lower section of the accessory, resulting for example from the configuration of this section, see the upper part of Figure 8, it is possible, as soon as the unscrewing has begun, to insert said second tooth beneath the first lower section by tilting a bit the half-hinge and then to disengage said hinge from the profile. The mounting occurs in the reverse order: after insertion of the first tooth beneath the second tab, see Figure 5, the anchoring element being loosely attached to the accessory, the half-hinge with the

first lower section partly resting on the upper surface of the second tooth can be pivoted so as to insert said first lower section into the seat, and then the screws being tightened, the anchoring element is moved towards the top of the concave section C and it presses the first lower section beneath the corresponding seat tab due to the engagement of the outer surface of the second tooth with the oblique surface of the accessory. For a skilled person, this method of inserting and fixing the hinge can obviously be deduced from the figures and description of the patent in suit. It may be that certain figures as originally filed did not seem to comply with this method because of the presence of either a profil part which seems to impede the necessary angled position of the hinge part or an inappropriate configuration of the first lower section, but Figure 5 and the top part of Figure 8 at least provide enough information as to how the system works. It lies then within the normal capacity of a skilled person to determine without an undue burden the appropriate dimensions and/or configurations of the elements of the claimed device. Thus, the subject-matter of claim 1 can be carried out by the skilled person without needing inventive skill, so that Article 100(b) EPC is met.

The features of claim 1 are functionally linked together: it appears clearly in Figure 5 that, in some profiles, the first bevel reduces the space which is needed for pivoting the hinge and makes easier the insertion of the first tooth beneath the second seat tab, having the accessory in an inclined position. Figures 9 and 10 show that simultaneously, due to the presence of the second tooth, a close fit of the

anchoring element against the first lower section of the accessory is obtained, so that also place is thereby gained; the second tooth, moreover, when it contacts the oblique surface S0, which implies that the anchoring element and accessory are preliminary held in the seat, permits first a displacement of the hinge along the length of the profile seat and then, when the correct positioning of the hinge is reached, the fixing of said hinge. From Figure 6, it can be seen that the second bevel on the top of the anchoring element allows an angled positioning of the anchoring element with respect to the accessory and thus, here also, reduces the necessary space. Moreover, it helps to clamp the pieces together.

In the device according to D2, the inclined surface of the anchoring element is permanently fitted against the oblique section 3c of the accessory, so that in fact the recess 3b cannot be used as is the case with the step according to the present invention. The function of this recess cannot be compared to that of the second tooth of the present invention, since Figure 2 of D2 shows that this recess does not participate in the preliminary holding of the anchoring element and accessory in the seat.

The anchoring element of D1 indeed shows a first tooth with a kind of bevel, but this bevel has no function, since the element is vertically inserted into the seat, which implies an anchoring element corresponding to a given profile. Apparently, this bevel is only here for manufacturing reasons, and nothing more.

D8 also does not teach to use the same hinge for different profiles. Only a vertical positioning of the pieces is also disclosed and wanted, since the accessory must straddle simultaneously both seat tabs in order to avoid a spreading out of the seat trims. Moreover, the second tooth of D8 is not formed by a broken line profile of an angled surface. Its surface is rounded. The contacts between this tooth and the surface of the accessory are therefore linear and thus do not correspond to the surface contact of the present invention.

Claim 1 therefore complies with the provisions of Articles 52 and 56 EPC.

D9 does not teach to provide the anchoring element with a tag, as claimed in claim 2 of the patent in suit. Moreover, a combination of D2 with D5 is not obvious because of the different assembly methods of these two documents. The skilled person would also not use the positioning tab known from D5 in the device of D2, since the inclined position of the anchoring element would no longer be possible. Therefore, the subject-matter of claim 2 implies an inventive step.

The reason of the request for apportionment of costs is that a lot of work, such as the translations, their checking as well as the checking of the drawings against each other, the study of all late-filed documents, was involved and time-consuming, although it was finally found that these new documents did not bring anymore than the previously filed evidence. Unnecessary expense was therefore caused by the appellant.

VII. The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the appeal be dismissed, auxiliarily with the proviso that the patent be maintained on the basis of claims 1 to 5 and the adapted description, both filed in oral proceedings, as well as Figures 1 to 10 as granted. Further an apportionment of costs was requested.

Reasons for the decision

1. The appeal is admissible.
2. *Insufficiency of disclosure (Article 100(b) EPC)*

It may be that a skilled person, who focuses on certain figures of the patent in suit, for example Figure 4, wonders whether it is possible to mount or dismount the device shown in these figures and then has doubts about the sufficiency of disclosure of the invention. However, on the basis of other figures of the patent, in particular Figure 5, Figure 8 (upper part) and Figure 10, combined with the whole teaching of the description, it is apparent for the skilled person that a step is created on the angled surface of the anchoring element by the second tooth of this surface and that the first lower section of the accessory at the level of the edge (34) can be received on this step, at least partly, when the anchoring element in an intermediate stage of the mounting or dismounting method is loosely attached to the accessory, the length

of the screws being chosen accordingly (see Figure 5). By doing so, the whole width of the assembled parts of the device introduced into the seat is substantially reduced, allowing the use of profiles of different sizes. When mounting or dismounting the hinge, said intermediate stage must be reached.

Then, it is a mere question of choosing an appropriate thickness or height of the second tooth and an appropriate configuration of the first lower section - see Figure 8 for example -, so that, for example when dismounting, a certain space is made available between the seat bottom and the first lower section by moving up and inclining the accessory, as soon as the unscrewing has begun. The second tooth entering into this space, the above mentioned intermediate stage is reached and, the hinge being slightly moved towards the second tab, the first lower section is disengaged from its corresponding tab, reaching the situation illustrated in Figure 5. Since the above mentioned figures suggest such an intermediate stage and, as a consequence, a necessary correlation between the thickness of the second tooth and the space made available at the initial stage of unscrewing by moving the hinge, it is possible for the skilled person to carry out the invention without any inventive effort. It follows that the patent in suit complies with Article 100(b) EPC.

Main request (claims maintained by the impugned decision):

3. *Independent claim 2*

This independent claim is first dealt with, since it defines the invention in the broadest way.

3.1 It was agreed by the parties that the leaflet D10 shows the product of D2, which was put on the market. In addition to the structural features of this product which are known from D2, the first tooth of the anchoring element according to D10 is provided with a bevel in the same way as the present invention, so that it can fulfil the same function, that is given in claim 2. D10, therefore, preferably to D2, represents the prior art closest to the present invention.

3.2 The subject-matter of claim 2 differs from this prior art device in that the anchoring element has at least one tab which extends lengthwise on the external face of this element and is used for positioning the anchoring element on the metal profile.

The method features of claim 2, see the last lines of said claim, concern a precise sequence of insertion steps of the device. They are not disclosed in D2/D10, but there is no problem to apply the same sequence of steps to the device known from this prior art without any modification of this device. In particular, they have no effect on the new feature of claim 2. Claim 2 defining a product, these method features are unable to distinguish the claimed product from the anchoring system known from D2.

3.3 The problem underlying the invention, as defined in claim 2, can be seen in the provision of an anchoring device of the kind shown in D2/D10, which can be quickly mounted on the profile.

3.4 This problem is not new, as shown by D5, which also describes a hinge connecting a fixed frame to a mobile frame. Similar pieces to those in the present invention are disclosed, namely the hinge as accessory consisting of two sections forming a concave section (C) and an anchoring element, which is introduced into a C-shaped seat of a profile and by means of screws clamps the hinge on the profile. One object of this prior art is to overcome the need for the fitter to determine by measurements the precise position of the anchoring element on the profile.

This object is reached in that the longitudinal anchoring element is provided on one of its ends with a tab, which extends lengthways, its length corresponding to the distance between the anchoring element placed in the correct position on the profile and a section of the profile, on which the free end of the tab rests. This known solution corresponds to that given in claim 2.

The respondent has argued that, since the tab disclosed in D5 has the same section as the anchoring element itself, it would impede any angled position of the anchoring element and thus cannot be used in the device of D2/D10. This argument is not convincing, since in D5 the need to have the same section is not essential, being only a feature of a dependent claim, and further it is up to the skilled person, who wants to improve

the device of D2/D10, which is introduced into the seat by tilting, to determine a section which does not hinder such a tilting of the anchoring element, all the more as this tilting occurs in the direction transverse to the longitudinal direction of the tab, which itself is not subjected to any mechanical forces, so that its section can be reduced without disturbing its function. Therefore, even if the sequence of assembly steps are not the same in D2 and D5, this difference is irrelevant, as soon as D5 suggests to the skilled person the use of a tab for positioning the anchoring element.

- 3.5 It follows that the solution as given in claim 2 is obvious having regard to D5, so that the subject-matter of this claim does not involve an inventive step (Article 56 EPC). Thus, a request having to be considered as a whole, the main request of the respondent is to be rejected.

Auxiliary request:

4. *Admissibility*

Claim 2 of this request is a combination of the granted claims 2 and 4, corresponding to a combination of claim 1 and 3 as originally filed, the expression "has a pair of appendages or tabs" of this last claim being amended into "has at least one appendage or tab (16)". This amendment is supported by the lines 10 to 19 of page 10 of the description, as originally filed, which disclosed that "the anchoring element **can** be fitted with a pair of appendages or tabs...to allow precise

positioning by resting the free end of **one** of said tabs on the section of fitting".

In the description, apart from the amendment brought in column 2 which is a mere adaptation of the description to the new two independent claims, the other changes aim at clearly indicating the figures or features which no more entirely correspond to the invention as claimed. The appellant has objected that the expression "comparative examples" is not clear enough, at least in the Italian language. However, according to Article 70(1), it is the text of the European patent in the language of the proceedings - in the present case English - which is the authentic text and, in English, the above mentioned expression makes clear that these figures are not examples of the invention.

Since the two-part form of previous claim 2 was wrong having regard to D10 and a new two-part would have required substantial modifications of the claim, claim 2 is drafted in a one part form (Rule 29(1) EPC).

The new documents of the patent in suit are admissible (Article 123 EPC). The appellant has raised no objection against the admissibility of these amendments as such.

Although this request was filed at a late stage of the procedure, it is admissible, since the amended claim, namely claim 2, is a mere combination of the previous amended independent claim 2 with the dependent claim 4 and corresponds to the first auxiliary request filed in response to the communication of the board annexed to

the summons to oral proceedings. Thus, the appellant was not taken by surprise.

5. *Patentability*

For the same reason as above, see point 3, claim 2 is first examined.

5.1 D10 still represents the closest prior art. Compared to claim 2 of the main request, a new group of features has been introduced, concerning the second tooth provided on the angled surface of the anchoring element. Therefore, two groups of features are new vis-à-vis D10, namely the group relating to the second tooth and the group mentioning the tab for positioning the anchoring element.

5.2 According to the wording of the claim, the second tooth is a part of the angled surface P1, being designed to fit against the oblique surface S0 of the accessory as does the angled surface. It follows that the external surface of the second tooth is bevelled, its angle corresponding to the angle of the oblique and angled surfaces S0 and P1. This tooth creates a step into which the portion of the accessory which comprises the edge 34 can be placed during the first step of the assembly, as shown by Figure 5 of the patent in suit, the oblique internal surface S0 of the accessory at this time fitting against the portion of the angled surface P1 of the anchoring element which is located above the second tooth. After the second step, namely the insertion of the first section into the seat, the action of the screw which is tightened causes the bevelled surface of the second tooth to be fitted

against the oblique internal surface S0 of the accessory, moving the accessory sideways with respect to the seat. It follows that the sideways translation of the accessory is the result not only of the oblique and angled surfaces S0 and P1 sliding on each other, but also of the passage of the oblique internal surface S0 from one stepped portion of the angled surface P1 to its following stepped portion, due to the presence of the second tooth. The sideways displacement of the accessory according to the present invention compared to that of the accessory of D2 is therefore greater, so that the device of the present invention can be used with profiles having a greater variety of distances between the seat tabs, solving thereby the object of the present invention as given in column 2, lines 19 to 27 of the description of the patent in suit. The view of the appellant that the provision of a broken line profile with a tooth has no particular effect cannot be followed.

- 5.3 It is true that D2 shows an oblique internal surface of the accessory which also comprises two portions or sectors, namely an inclined upper sector and, following immediately below, a recess, as shown by Figure 2 of this prior art. However, all the figures of this document only disclose a sliding of the angled surface of the anchoring element onto the inclined upper sector, and nothing more. Figure 1 shows that the recess is only used to locate the lower corner tip of the angled surface of the anchoring element when, in the first step of insertion, the accessory being loosely attached to the anchoring element is tilted in order to insert its first lower section beneath the second seat tab. In this position, the anchoring element tends by gravity

to tilt in the opposite direction, that is to say towards the accessory, and it can be seen that there is, in such a case, no fit of a surface of the anchoring element against the internal surface of the accessory, but only a point of contact remaining between these surfaces appears. Thus, even if the upper sector 3b shown in D2 is assimilated to the step created by the second tooth in the present invention, it does not work in the same manner because of the permanent contact between this sector and the angled surface of the anchoring element. D2 does not show a "broken line profile (of the oblique surface of the accessory) shaped to define a tooth, designed to fit against the" angled surface of the anchoring element, so that contrary to the appellant's opinion there is more than an inverted exchange of surfaces of the accessory and anchoring element between the present invention and the teaching of D2. The group of features of claim 2, which concern the second tooth, cannot therefore be considered as means equivalent to those disclosed in D2, reaching a different technical effect. It follows that this group of features is not only new vis-à-vis D2, but also inventive.

- 5.4 It is not clear for which reason a person skilled in the art starting from the device shown in D2/D10 and faced with the problem of the present invention, namely to provide an anchoring element which can be fitted in metal profiles of various sizes, would turn his attention to the prior art document D8, since the problem envisaged in this prior art is to facilitate the mounting of an accessory designed for a given profile or, more precisely, designed to be fitted to

frames with channels of a given shape and given dimensions (D8, column 5, lines 50 to 51).

Moreover, the insertion of the accessory into the seat of the profile is made vertically in this prior art, since another object of this prior art is to avoid a spreading out of the profile seat sides, this problem being solved by providing the accessory with two ledges which each at the same time must encircle and clamp the top of a seat tab. It is also clearly indicated that a tilting or inclined position of the anchoring element is not wanted (column 5, lines 34 to 36). Thus, the insertion methods of D8 and D2/D10 are not only different, they are incompatible.

If the skilled person nevertheless were to consider this prior art, he would not receive any suggestion for the claimed solution, since it teaches that the accessory and the anchoring element in each position are always supported by each other along two lines of contact (column 5, lines 27 to 33, and Figure 10). This technical teaching does not correspond to the solution as claimed, which requires the sliding of surfaces on each other. The appellant itself has recognised that the solution as claimed comprises at least two oblique surfaces (the oblique surface of the accessory and the bevelled outer surface of the second tooth) which cooperate for the widening of the device, once introduced in the seat, and for the fixing of the accessory on the profile. In D8, this effect is achieved by two contact lines and not by surfaces, so that the solution is not the same. With the present invention, the use of the two cooperating oblique surfaces allows to have the anchoring element inclined

with respect to the accessory: this effect is not suggested by D8.

- 5.5 It follows that the subject-matter of claim 2 according to the auxiliary request implies an inventive step. Since claim 1 also contains the group of features concerning the second tooth, its subject-matter for the same reasons implies an inventive step. The dependent claims 3 to 5, since they relate to particular embodiments of the subject-matter of claim 1 and/or claim 2, can be maintained.

Apportionment of costs

6. The appellant in its statement of grounds drew attention to additional prior art in the form of two declarations in Italian and various technical drawings concerning an alleged own prior use. No translations of the declarations were provided. The same device as that shown in D10 was involved. Although the appellant referred to an own prior use, it did not explain why this alleged state of the art was cited so late and why this new evidence was important and more relevant than D2 or D10, or even the prior use already considered by the first instance. The respondent nevertheless examined these documents and filed more than two pages of arguments against them. In its annex to the summons to oral proceedings, the board announced to the parties that it did not intend to admit these documents into the proceedings. In a submission filed on 18 May 2004, the appellant contended that the documents were only filed to specify the disclosure already presented in D10. These documents were then not referred to again.

7. It is difficult to determine whether the late filing of the new documents was justified or not. On the one hand, the appellant being the losing party, has a right to try to improve its position by filing new evidence, especially as it was not quite clear from the impugned decision for which reason the amended claim 2, which did not mention a second tooth, was maintained by the first instance having regard to the alleged prior use cited in the decision. On the other hand, the appellant could have mentioned its own new prior use during the opposition period.

All the new filed drawings are quite simple and their examination, which takes only a few minutes, clearly shows that they all concern the same device as that shown in D10, so that, for the respondent, the weak relevance of these documents should have been obvious. The declarations are moreover short and understandable, even without translation. Hence, it does not seem that the respondent had to devote much time and energy on these documents. It is therefore doubtful whether costs higher than the costs usually supported by a party had been incurred, all the more as the appellant in the statement of grounds of appeal had essentially based its arguments on lack of inventive step with regard to other prior art documents, which were already considered by the first instance. The two pages of arguments filed by the respondent in response to the statements of grounds were indeed time-consuming, but in view of the poor relevance of the newly filed documents it was the responsibility of the respondent itself to decide whether it was necessary or not to provide counter-arguments. This work alone moreover does not seem to be sufficient to justify a different

apportionment of costs for reason of equity, as required by Article 104(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 in amended form on the basis of claims 1 to 5 and the adapted description, both filed in oral proceedings, as well as Figures 1 to 10 as granted.
3. The request for apportionment of costs is refused.

The Registrar:

The Chairman:

A. Counillon

C. T. Wilson