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D E C I S I O N
of 13 October 2005

Case Number: T 0374/02 - 3.2.07

Application Number: 93905228.8

Publication Number: 0637353

IPC: D21J 5/00

Language of the proceedings: EN

Title of invention:

Equipment for making articles from pulp material

Patentee:

Brodrene Hartmann A/S

Opponent:

Leopack B.V.

Headword:

-

Relevant legal provisions:

EPC Art. 54, 117(1)(d)

Keyword:

"Novelty (yes)"

"Witnesses - not proposed by the appellant"

Decisions cited:

-

Catchword:

-



Case Number: T 0374/02 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 13 October 2005

Appellant: Leopack B.V.
(Opponent) Zuidelijke Industrieweg 3 - 7, P.O. Box 5
NL-8800 AA Franeker (NL)

Representative: de Vries, Erik Eduard
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Respondent: Brodrene Hartmann A/S
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Representative: Roerboel, Leif
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 27 November 2001
rejecting the opposition filed against European
patent No. 0637353 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: H. Meinders
Members: K. Poalas
C. Holtz
P. A. O'Reilly
E. Lachacinski

Summary of Facts and Submissions

I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division rejecting the opposition against the European patent No. 0 637 353.

The opposition was filed against the patent as a whole and was based on Article 100(a) EPC (lack of novelty and lack of inventive step).

The Opposition Division held that the grounds for opposition mentioned in Article 100(a) EPC did not prejudice the maintenance of the patent as granted.

The Opposition Division took into consideration inter alia the following means of evidence:

- D2: Order from Grundig to Leopack dated 11 July 1991
- D3: Fax from Mr. Pauler of Grundig to Mr. Guichard of Leopack dated 24 October 1991
- D4: Order from Cartonneries de Muno to Hiatus dated 11 December 1991
- D5: Drawing No. 25834-986.00 dated 5 July 1991
- D6: Debit note dated 13 December 1991
- D7: Minutes of a visit by employees of Grundig at Leopack on 29 August 1991
- D8: Minutes of a visit by employees of Grundig at Cartonneries de Muno on 18/19 September 1991
- D9: DE-A-40 39 572
- D10-D14: Photographs of a suction mould, numbered A to E

- D15: Photograph of a counter mould, numbered F
- D16: Declaration from Ms. K. Veldman, employee of Leopack from 1 October 1991 to 31 January 1993, dated 17 February 1998
- D17: Declaration from Mr J. Arnold, employee of Grundig
- D18: Photograph of a suction mould, numbered G
- D19: Fax from Mr Arnold of Grundig to Mr. Guichard of Leopack dated 14 June 1991
- D20: Further declaration from Ms. K. Veldman, dated 10 September 2001
- D21: Internal Note concerning a visit by employees of Grundig at Cartonneries de Muno on 29 October 1991
- D22: Declaration from Mr. B. Lecomte, employee of Cartonneries de Muno in 1991
- D23: Declaration from Mr. W. van der Gang, managing director of Hiatus in 1991 and 1992.

It found that it was not proven that the equipment shown in photographs D10 - D15 and D18 and presented during the oral proceedings to the Opposition Division was made available to the public before the priority date of the patent in suit. The opponent had not been able to prove that the mould allegedly seen by Mr. Arnold on 29 October 1991, i.e. before the priority date of the patent in suit, had the same features as the mould shown in these photographs.

- II. On appeal, the appellant requested that the decision under appeal be set aside and the patent revoked. As an auxiliary measure, oral proceedings were requested.

The following additional documents were filed by the appellant during the appeal procedure:

- A1: Statement of Mr Willem van der Gang dated 22 March 2002,
- A2: Debit note dated 6 October 1991,
- A3: Reminder for payment dated 2 December 1991,
- A4: Minutes of a visit by employees of Grundig at Leopack on 25/26 March 1992,
- A5: Fax von Grundig an Leopack dated 14 January 1992,
- A6: Minutes of a visit by employees of Leopack at Grundig on 8 April 1992,
- A7: Fax von Grundig an Leopack dated 22 May 1992,
- A8: Fax von Grundig an Leopack dated 25 June 1992,
- A9: Fax von Fr. Veldman an Grundig dated 29 June 1992 together with a drawing dated 26 June 1992,
- A10: Fax von Grundig an Leopack dated 14 July 1992,
- A11: Declaration of Mr Arnold dated 2 May 2002.

III. The respondent (patent proprietor) requested that the appeal be dismissed and the patent be maintained as granted. As an auxiliary measure, oral proceedings were requested.

IV. The Board sent a summons to attend oral proceedings dated 9 March 2005 and informed the parties in an annex that the discussion during the oral proceedings would mainly be focused on the question of which alleged prior use was made available to the public before the priority date of the patent in suit and that the Board did not intend to hear any witness in the present case.

V. With its letter dated 4 May 2005 the appellant informed the Board that he would not be "present/represented"

during the scheduled oral proceedings, because witnesses could not be heard. With the same letter the appellant asked for a decision based on the documents on file.

VI. With its notification dated 12 May 2005 the Board informed the parties of the cancellation of the scheduled oral proceedings.

VII. Independent claim 1 as granted reads as follows:

"Equipment for making a thin-walled papier-mâché product from pulp material and comprising a suction mould (1) with flushing edges (3) and a shaping surface having projections (8) and covered with wire gauze (6,10), said projections having a suitable taper permitting problem-free liberation of the moulded product from the suction mould, wherein

a) the suction mould (1) comprises a base surface (2) provided with perforations (5) and covered by wire gauze, and wherein

b) the projections (8) are releasably secured (12) to the plate (2) above suitable openings (7) in the latter and in the wire gauze (6) and consist of perforated hollow members (9) covered on the outside with wire gauze (10), characterized in that said base surface is a plane plate (2) and that said projections (8) are selected from a first building-set system comprising a relatively small number of types of pre-fabricated projections (8) with different dimensions and shapes."

VIII. The appellant argued essentially as follows:

The mould as shown in the photographs D10 - D15 and D18 and as presented during the oral proceedings before the Opposition Division is the original tool seen by Mr. Arnold on 29 October 1991, i.e. before the priority date of the contested patent. The modifications made to this mould are of minor importance and with no relevance to the features of the claims of the opposed patent. Therefore, a mould having all the features of the equipment according to claim 1 as granted has been publicly available before the priority date of the contested patent and is thus novelty-destroying for the subject-matter of that claim.

IX. The respondent argued essentially as follows:

The equipment shown during the oral proceedings before the Opposition Division and in the photographs D10 - D15 and D18 is not identical with the equipment shown to Mr. Arnold, which was lost. The declarations filed do not point out in any detail in which way the original mould has been modified and therefore it remains uncertain how it was originally constructed. In fact, the evidence shows that nothing more than a 3-dimensional mould for making pulp articles and consisting of interconnected mould pieces has been made available to the public before the priority date of the patent in suit.

Reasons for the Decision

1. *Procedural matters*

- 1.1 In its letter dated 8 April 2002 the appellant informed the Board that in the requested oral proceedings Mr. Van der Gang and Mr. Arnold "will be present" at the oral proceedings and that Ms. Veldman "could attend oral proceedings". In the same letter the appellant asked for the Board's opinion about the presence of the above mentioned persons in the oral proceedings. In its letter of 19 August 2002 it stated that Mr. Arnold "will be present if possible". In its letter of 8 October 2002 it mentioned that in the oral proceedings Mr. Arnold "can make a further statement". None of these persons was explicitly offered as witness to be heard in the oral proceedings. The subject and the contents of the intended further statements were not given either.

In the absence of a clear request, the Board stated in the annex to the summons to attend oral proceedings that it did not intend to hear any witness.

In its reply dated 4 May 2005 the appellant stated that it would not be present at the scheduled oral proceedings "because witnesses cannot be heard".

- 1.2 It must be observed that no hearing of witnesses had been explicitly requested before the Opposition Division either, nor was any decision to that effect taken by this Division, although it was extended shortly before the oral proceedings with a legally qualified examiner. Instead, the Opposition Division

limited itself to examine written declarations from three persons involved in developing the mould contended to represent a public prior use.

- 1.3 The EPC requires clear requests with regard to testimonies a party wishes witnesses to give, since the responsible department of the EPO must issue a decision regarding the taking of oral evidence (see Article 117(1)(d) and Rule 72(1) EPC). The party must indicate the factual details that it wants to be proven by the oral evidence requested.

Even if the mention of the above mentioned persons could have been considered an implicit offer of witnesses, the Board is of the opinion that it did not need to hear them, because this "implicit offer of witnesses" did not specify what should be able to persuade the Board to evaluate differently the evidence already existing in the file and because witnesses are meant to corroborate the facts for which they are expected to be heard, not to fill in gaps in the facts and arguments brought forward by the party in support of its case. The lack of an indication of the facts which were to be proven by testimonies of the three persons mentioned means that the necessary conditions for the hearing of witnesses do not exist in the present case.

2. *Novelty (Article 54(2) EPC)*

- 2.1 According to the appellant the company Hiatus was asked in September 1991 to produce a mould for a package made from fiber pulp material for Grundig satellite receivers. On 29 October 1991 Mr. Arnold and

Mr. Büttcher from Grundig saw a mould at Leopack/Cartonneries de Muno, used at that time for the production of the Grundig packages, and requested further modifications of the mould. The mould seen on 29 October 1991 had according to the appellant all the features of the equipment according to claim 1 of the patent in suit and was, apart from minor - not relevant - modifications the same as shown in photographs D10 - D15 and D18.

2.2 Assuming that Mr. Arnold and Mr. Büttcher saw on 29 October 1991 the mould used at that time at Leopack/Cartonneries de Muno and that they both were part of the public, not being under an obligation to maintain secrecy, the main issue to be examined is **what** exactly was made available to them on that date. Only then can it be determined whether this prior disclosure involved all the features of the equipment of claim 1 of the patent in suit.

2.3 D17 and A11 are the only two declarations of Mr. Arnold in the file. No reference to the structural features of the mould seen on 29 October 1991 is made in D17. In A11 (see fourth paragraph) Mr. Arnold declares that on that date he saw a plastic tool for the production of packages made of fiber pulp material, said tool having perforated plastic segments, said segments being mounted onto a perforated mounting plate, whereby a gauze was attached by adhesive onto the plastic segments (or the cores).

Mr. Arnold does not mention the following features:

- a wire gauze covering the base plate, the gauze having openings,
- a releasable securing of the plastic segments to the base plate above suitable openings in the latter and above those in the gauze,
- a base plate being a plane plate, and
- any flying edges of the mould,

which as such are claimed in claim 1 of the patent in suit.

Thus, on the basis of this declaration alone, the novelty of the subject-matter of claim 1 of the patent in suit is not at stake.

It therefore has to be examined whether the further evidence submitted by the appellant proves that the mould seen by Mr. Arnold also possessed the above mentioned distinguishing features.

- 2.4 The appellant argued that the mould shown in photographs D10 - D15 and D18 was the one seen by Mr. Arnold on 29 October 1991. Since then, this mould had undergone only minor modifications, not relevant for the subject-matter of claim 1 of the patent in suit. Therefore, this mould was novelty destroying for this claim. Also the Opposition Division in its decision stated that the mould shown in these photographs possessed all the features of the equipment of claim 1.

The respondent argued that the original mould had been lost. Therefore, the mould of the photographs D10 - D15

and D18 and the one seen by Mr. Arnold were not the same.

In the opposition proceedings, however, the appellant filed in this respect document D16, a declaration of Ms. Veldman stating that the original mould still existed and that the photographs filed showed that mould.

This has not been refuted by the respondent.

For the present decision, therefore, the Board assumes that the photographs D10 - D15 and D18 show the mould as seen by Mr. Arnold on 29 October 1991 after having undergone later modifications.

- 2.4.1 For the following reasons, however, the Board cannot follow the appellant's argument that those modifications are not relevant in the present case:

Firstly, no constructional drawings of the mould showing its original design or the subsequent modifications have been filed. The Board can hardly imagine that the mould in question has been produced without such drawings. In fact, Ms Veldman mentions such a drawing in D20; the same is done by Mr. Lecomte in D22.

Secondly, Ms. Veldman from Leopack declares in D16 that the mould shown in photographs D10 - D15 and D18 underwent only a single modification since seen by Mr. Arnold on 29 October 1991, consisting (according to D16) in a modified diameter of the perforations in the

projections. According to her declaration D20, however, "modifications" (in the plural) were carried out.

Thirdly, according to Mr. Lecomte of Cartonneries de Muno (see D22) some minor modifications ("modifications mineures") had to be carried out in respect of the mould seen by Mr. Arnold on 29 October 1991, since the mould was not according to the "drawing". No details of these modifications were given.

Fourthly, Mr. van der Gang of Hiatus declares in D23 that some small details of the mould were corrected. No details of these modifications are given in D23. In A1 on the other hand, he states that after the visit of the Grundig representatives to Leopack/Cartonneries de Muno "very limited" modifications in the form of height and radius adjustments of the plastic parts of the mould were carried out.

Fifthly, according to documents A4 to A9 the mould had to undergo further modifications after the priority date of the patent in suit to produce the required packages. No details of these modifications are given.

Sixthly, the appellant itself states in its statement of grounds of appeal (see page 2, 8th and 9th paragraph) that the mould as seen by Mr. Arnold on 29 October 1991 underwent several modifications before it developed its final form as shown in photographs D10 - D15 and D18.

- 2.4.2 Even accepting that the modifications mentioned in D16 (perforation diameter) and A1 (height and radius) were made to the mould seen by Mr. Arnold on 29 October 1991

the presented information is partially contradictory (only one modification according to D16 and more than one modifications according to D20, D22 as a consequence of the visit of Mr. Arnold) and partially not specified (see D20, D22, D23 and A4 - A9).

The Board is therefore not put in the position to deduce all modifications that resulted in the final mould shown in photographs D10 - D15 and D18. It cannot therefore determine the exact configuration of the mould as seen by Mr. Arnold on 29 October 1991.

2.4.3 The appellant's argument that only minor modifications have been made to the mould with no influence on the structural features of the mould itself, remains therefore an allegation without conclusive evidence (see above).

2.5 Therefore, the Board concludes that since the mould as described in A11 by Mr. Arnold does not involve a wire gauze covering the base plate, the gauze having openings, a releasable securing of the plastic segments to the base plate above suitable openings in the latter and above those in the gauze, a base plate being a plane plate, and flying edges of the mould as claimed in claim 1 of the patent in suit and since the mould shown in photographs D10 - D15 and D18 in combination with the evidence D16, D20, D22, D23, A1 and A4 - A9 cannot shed light on the exact configuration of the mould as seen by Mr. Arnold on 29 October 1991 in this respect, the novelty of the subject-matter of claim 1 is given and the requirements of Article 54 EPC are fulfilled.

3. *Inventive step (Article 56 EPC)*

Inventive step was not an issue in the appeal procedure and the Board sees no reason to deal with this point.

4. In view of the above reasons in favour of the respondent's request for dismissal of the appeal, its auxiliary request for oral proceedings becomes redundant.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders