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**Datasheet for the decision
of 11 May 2010**

Case Number: T 1287/07 - 3.2.08

Application Number: 02006357.4

Publication Number: 1236849

IPC: E05B 19/00

Language of the proceedings: EN

Title of invention:

Key for a cylinder lock

Patentee:

Mottura Serrature di Sicurezza S.p.A.

Opponent:

ALBAN GIACOMO S.p.A.

Headword:

-

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

EPC Art. 56, 84, 100, 102, 114(2)

Keyword:

"Late-filed documents (not admitted)"

"Re-filing of divisional application (no ground for revocation)"

"Amendments-added subject-matter (no)"

"Art. 84 objection (not admissible)"

"Inventive step (yes)"

Decisions cited:

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Catchword:

See points V and VI, re-filing of a divisional application,
and point 3.



Case Number: T 1287/07 - 3.2.08

D E C I S I O N
of the Technical Board of Appeal 3.2.08
of 11 May 2010

Appellant: ALBAN GIACOMO S.p.A.
(Opponent) Via A. De Gasperi, 75
I-36060 Romano d'Ezzelino VI (IT)

Representative: Josif, Albert
Modiano & Associati SpA
Via Meravigli, 16
I-20123 Milano (IT)

Respondent: Mottura Serrature di Sicurezza S.p.A.
(Patent Proprietor) Strade Antica di Francia, 34
I-10057 Sant'Ambrogio (Torino) (IT)

Representative: Notaro, Giancarlo
Buzzi, Notaro & Antonielli d'Oulx
Via Maria Vittoria 18
I-10123 Torino (IT)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 June 2007
rejecting the opposition filed against European
patent No. 1236849 pursuant to Article 102(2)
EPC (1973).

Composition of the Board:

Chairman: T. Kriner
Members: M. Alvazzi Delfrate
U. Tronser

Summary of Facts and Submissions

I. The opponent filed an appeal on 2 August 2007 against the decision of the opposition division, posted on 20 June 2007, to reject the opposition against the European patent No. 1 236 849. The appeal fee was paid on the same day and the statement setting out the grounds for appeal was filed on 24 October 2007.

II. The following documents have been cited in the appeal proceedings:

A1: US -A- 4 377 082;

A2: IT -B- 1 235 586 as well as its family member

A2-1: EP -A- 416 500;

A3: FR -A- 2 762 345;

A4: FR -A- 2 759 406;

A5: FR -A- 2 522 053;

A6: FR -A- 2 708 657; and

A7: FR -A- 2 619 149.

III. Oral proceedings before the board of appeal were held on 11 May 2010.

The appellant requested that the decision under appeal be set aside and that the European patent No. 1 236 849 be revoked.

The respondent requested that the appeal be dismissed as far as the patent is maintained on the basis of the main request as submitted during oral proceedings.

IV. The independent claim of this request reads as follows:

"A key which is to be used in a cylinder lock comprising a lock body or stator (8), a cylinder or rotor (10), rotatably mounted within the body (8) and having a passage for introduction of a key (3), and a plurality of locking tumblers (11) mounted within the cylinder (19) and having their axes arranged radially and provided for being engaged by a key having a predetermined profile in order to be arranged in a position in which they enable the free rotation of the cylinder (10) within the body (8), the above mentioned key having a body on which there is mounted a ring (30), characterized in that the above-mentioned ring (30) is mounted with the possibility of moving with its axis relative to the body of the key, said ring being able to assume at least one position in which the ring projects from one face of the body of the key and in that the ring (30) is mounted with clearance over a transverse pin carried by the body of the key, and in that the ring (30) is mounted within a longitudinal slot (29) at the end of the body of the key."

V. The appellant's arguments in support of its request can be essentially summarised as follows:

Admissibility of documents A1 to A5 and A7

Documents A1 to A5 and A7 were filed late in the proceedings due to a change of the representative in charge of the case. They were highly relevant, in particular A3 which was prima facie novelty destroying.

Therefore, these documents should be introduced into the proceedings.

Re-filing of a divisional application

The patent in suit was based on divisional application No. 02006357.4, which was filed with a text identical to that of the earlier divisional application No. 01117094.1, which had been withdrawn and converted into an Italian utility model. Since the conversion into a national right was intended as a compensation for an application which had been withdrawn, the re-filing of the same subject-matter was an abuse of procedure, which, albeit not explicitly contravening any provision of the EPC, justified the revocation of the patent in suit.

Further legal points

In the statement setting out the grounds for appeal the appellant further argued that the patent in suit could not benefit from the priority right from the parent application, and should therefore be revoked, since its content was published previous to its date of filing by way of said parent application. This argument was not maintained during the oral proceedings.

Moreover, in the statement setting out the grounds for appeal the appellant formulated also two points of law, questions relating to the re-filing of divisional applications, and requested the board to decide whether to answer those questions by itself or refer them to Enlarged Board of Appeal. This request was not maintained either.

Art. 123(2) EPC

Claim 1 had been amended to stipulate that the ring was mounted within a longitudinal slot at the end of the body of the key. From the application as filed it was clear that this longitudinal slot had to extend through the body of the key, as could be seen from the drawings, or at least be deep enough to allow the interaction of the ring with the abutment pin of the lock, which was essential to the functioning of the key. Therefore, a longitudinal slot of unspecified depth, as recited by the amended claim 1, was not disclosed in the application as filed. Accordingly, this amendment was contrary to Art. 123(2) EPC.

Art. 84 EPC (1973)

The feature that the longitudinal slot was at the end of the body of the key had been taken from the description and introduced in claim 1. However, this amendment failed to define the depth of the slot. Since it was crucial to the functioning of the key that the slot was deep enough to allow interaction with the abutment pin of the lock, the claim lacked an essential feature. Therefore, the amendment resulted in the claims contravening the requirements of Art. 84 EPC (1973).

Inventive step

A6 which, like the patent in suit, was concerned with a key with a security element could be seen as representing the most relevant state of the art. The

subject-matter of claim 1 was distinguished from the key shown in A6 solely by the choice of a ring as a security element, said ring being mounted with clearance over a transverse pin with the possibility of moving with its axis relative to the body of the key to assume at least one position in which the ring projects from one face of the body of the key.

Since the movement of the ring according to claim 1 was kinematically equivalent to the rotation of the triangular element of the key shown in A6, it would have been obvious to replace said triangular element with a ring in order to develop an alternative to the known key. Accordingly, the subject-matter of claim 1 did not involve an inventive step.

VI. The arguments presented by the respondent can be essentially summarised as follows:

Admissibility of documents A1 to A5 and A7

Since documents A1 to A5 and A7 were known to the appellant before filing the appeal, there was no excuse for mentioning them for the first time shortly in advance of the oral proceedings. Moreover, none of these documents was prima facie highly relevant, and A3 and A4, which were published after the priority date of the patent in suit, were not even prior art. Accordingly, documents A1 to A5 and A7 should not be admitted into the proceedings.

Re-filing of a divisional application

There was no provision in the EPC sanctioning the re-filing of a divisional application as in the present case. Furthermore, such re-filing could not be assessed as an abuse of procedure. Therefore, the patent in suit could not be revoked on this basis.

Art. 123(2) EPC

The application as filed did not disclose the longitudinal slot in connection with a particular depth. The person skilled in the art would rather have freely chosen this depth in accordance with the circumstances. Therefore, the amendment to claim 1, which did not define the depth of the longitudinal slot, complied with Art. 123(2) EPC.

Art. 84 EPC (1973)

Present claim 1 comprised the features of granted claims 1 and 3. Since these claims did not comprise a feature concerning the depth of the longitudinal slot of the key it was not understandable why the introduction of the wording "at the end of" the body of the key should require the addition of such a feature. Accordingly, the objection under Art. 84 EPC (1973) raised by the appellant was not linked to the amendments to the claims and, as a consequence, not admissible.

Inventive step

The key claimed in the patent in suit was distinguished from the one disclosed in A6 in that the security element was a ring mounted with clearance over the transverse pin with the possibility of moving with its axis relative to the body of the key to assume at least one position in which the ring projects from one face of the body of the key.

The ring according to claim 1 could be manufactured more easily than the chamfered triangular element shown in figures 3 and 4 of A6. Moreover, thanks to its possibility of moving with its axis relative to the body of the key, it could not be replaced by a soldered or otherwise fixed element, resulting in increased safety of the key. Since it was not obvious to replace the triangular element of the key disclosed in A6 with the ring according to patent in suit to achieve these advantages, the subject-matter of claim 1 involved an inventive step.

Reasons for the Decision

1. The appeal is admissible.

2. Documents A1 to A5 and A7 were mentioned for the first time in the appeal proceedings in the letter dated 19 March 2010.

According to Art. 114(2) EPC (1973) the Board may disregard facts or evidence which are not submitted in due time by the parties concerned.

In the present case documents A1 to A5 and A7 were already known to the appellant from the opposition proceedings and the only explanation given by the appellant for their late submission, i.e. the fact that the appellant's representative took over the case only recently, cannot be accepted as a justification. Moreover, documents A3 and A4, having been published after the priority date of the patent in suit, do not belong to the prior art and documents A1 to A2, A5 and A7 are not prima facie more relevant than A6, which was filed together with the statement setting out the grounds of appeal.

Under these circumstances documents A1 to A5 and A7 are not admitted into the proceedings.

3. The appellant submitted that re-filing the same subject-matter comprised in an earlier divisional application which had been withdrawn and converted in a national right was an abuse of procedure.

However, as acknowledged by the appellant itself, this re-filing does not fall under the grounds for opposition listed in Art. 100 EPC (1973), which may lead to revocation of the patent in opposition proceedings according to Art. 102(1) EPC (1973). Since the list of grounds for opposition of Art. 100 EPC is exhaustive, there is no legal basis for revoking the patent in suit on this basis. Therefore, the alleged re-filing of the same subject-matter cannot result in the revocation of the patent in suit.

4. Claim 1 has been amended to recite that the ring is mounted within a longitudinal slot at the end of the body of the key.

It is true that, as pointed out by the appellant, the longitudinal slot shown in the drawings of the application (see in particular Figure 14) extends through the whole thickness of the key body. However, the content of the application as filed comprises also the description and the claims, which disclose the longitudinal slot in a general way, i.e. without specifying its depth (see paragraph [0017] as well as claim 4). The need to interact with the abutment pin does also not impose any requirement on the depth of the longitudinal slot, since the length of the abutment pin is not defined. Accordingly, a longitudinal slot of unspecified depth as recited by claim 1 of the patent in suit is directly and unambiguously derivable from the application as originally filed.

Therefore, the patent has not been amended in a way that it contains subject-matter extending beyond the content of the application as filed, and the requirements of Art. 123(2) EPC are met.

5. The appellant argued that, since amended claim 1 did not define the depth of the longitudinal slot, it lacked an essential feature and contravened the requirements of Art. 84 EPC (1973).

Failure to comply with the requirements of Art. 84 EPC (1973) is not a ground of opposition. Nevertheless, according to the established case law of the Boards of Appeal Art. 102 EPC (1973) allows objections against

the amended patent to be based upon Art. 84 EPC (1973), provided that they arise out of the amendments made (see Case law of the Boards of Appeal of the European Patent Office, 5th edition 2006, VII. C.6.2).

In the present case claim 1 according to the respondent's request comprises all the features of claims 1 and 3 as granted and the additional feature according to which the slot is "at the end" of the body of the key. Therefore, the alleged lack of an essential feature would equally apply to the claims as granted, since they already refer to a longitudinal slot without defining its depth (see claim 3 of the granted patent). Therefore, the purported deficiency cannot be caused by the introduction of the feature that the longitudinal slot is positioned "at the end of" the body of the key. In other words, the objection raised by the appellant under Art. 84 EPC (1973) does not concern the amendments that led to the present claims but the claims of the patent as granted. As a consequence, this objection must be considered inadmissible, and cannot result in a revocation of the patent.

6. The most relevant state of the art is undisputedly represented by A6, relating to a key whose safety is improved by means of a rotatable security element.

A6 (see in particular Figures 1-5) discloses a key which is to be used in a cylinder lock comprising a lock body or stator, a cylinder or rotor (9), rotatably mounted within the body (13) and having a passage for introduction of a key, and a plurality of locking tumblers mounted within the cylinder and having their axes arranged radially and provided for being engaged

by a key having a predetermined profile in order to be arranged in a position in which they enable the free rotation of the cylinder within the body (see page 2, line 27-30). The key disclosed in A6 has a body on which there is mounted an element (4), said element being able to assume at least one position in which the element projects from one face of the body of the key (page 1, lines 33-43). A6 further discloses that the element is mounted over a transverse pin (1) carried by the body of the key and within a longitudinal slot at the end of the body of the key (see page 1, lines 50-54).

Starting from the key disclosed in A6 the object underlying the claimed invention can be seen in providing a key ensuring a high degree of safety (see patent in suit paragraph [0002]).

According to claim 1 this object is achieved in that said element is a ring mounted with the possibility of moving with its axis relative to the body of the key, said ring being able to assume at least one position in which the ring projects from one face of the body of the key and in that the ring is mounted with clearance over said transverse pin.

Since the ring according to claim 1 of the patent in suit can move with its axis relative to the body of the key, it cannot, contrary to the element of the key of A6 (see page 2, lines 16-21), be replaced by an element fixed to the body of the key. This fact results in a high degree of safety of the key.

Even if A6 discloses other shapes of the security element in addition to the triangular shape (see page 2, lines 1-5), none of them is a ring and, most important, their movement is a rotation, a feature which is presented as essential in A6 (see page 2, lines 21-22). Accordingly, A6 as such does not render obvious the use of a ring which has the possibility of moving with its axis relative to the body of the key.

The common general knowledge of person skilled in the art did not give a hint of how to achieve the object above according to claim 1 either, since the movement of the ring of the patent in suit, which involves a translation, cannot be considered kinematically equivalent to the rotation of the element of A6.

Therefore, the subject-matter of claim 1 involves an inventive step.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the Opposition Division with the order to maintain the patent on the basis of the claims 1 and 2 and column 1 of the description according to the main request submitted during the oral proceedings and columns 2 to 7 and Figures 1 to 25 as granted.

The Registrar:

The Chairman:

V. Commare

T. Kriner