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**Datasheet for the decision
of 7 November 2014**

Case Number: T 0115/12 - 3.2.04

Application Number: 02380058.4

Publication Number: 1256297

IPC: A47F5/00, G09F3/20

Language of the proceedings: EN

Title of invention:
Product indicator for shelving.

Patent Proprietor:
Hijos de Francisco Camina, S.L.

Opponent:
PERIMEDIAS

Headword:

Relevant legal provisions:
EPC Art. 123(2), 54(1), 56, 101(3)
EPC R. 99(2)

Keyword:
Admissibility of appeal - (yes)
Amendments - allowable (yes)
Novelty - auxiliary request (yes)
Inventive step - auxiliary request (yes)

Decisions cited:

T 0373/12, G 0009/91, G 0001/91, T 0301/87, T 0478/09,
T 0589/09, T 1459/05, T 0459/09, T 0681/00, T 0409/10,
T 1324/09, T 0681/00

Catchword:



**Beschwerdekammern
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Chambres de recours**

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Case Number: T 0115/12 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 7 November 2014

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
14 November 2011 concerning maintenance of the
European Patent No. 1256297 in amended form.**

Composition of the Board:

Chairman A. de Vries
Members: J. Wright
C. Heath

Summary of Facts and Submissions

- I. The appellant-proprietor lodged an appeal, received 23 January 2012, against the interlocutory decision of the opposition division posted on 14 November 2011 on the amended form in which European patent no. 1256297 can be maintained and paid the appeal fee simultaneously. His statement setting out the grounds of appeal was filed on 16 March 2012.

The appellant-opponent also lodged an appeal, received 24 January 2012, against the above interlocutory decision and paid the appeal fee simultaneously. His statement setting out the grounds of appeal was filed on 26 March 2012.

- II. The opposition was filed against the patent as a whole and based *inter alia* on Article 100(a) together with Articles 52(1) and 56 EPC for lack of inventive step and on Article 100(c) with Article 123(2) EPC, extension of subject matter.

The opposition division decided to admit a late filed opposition ground under Article 100(a) EPC (novelty) based on late filed document D8. The division held, *inter alia*, that the patent as amended according to an auxiliary request met the requirements of Article 123(2) EPC, and that the grounds for opposition mentioned in Article 100(a) EPC did not prejudice maintenance of the patent as amended having regard to the following documents, amongst others:

D1: US 4 471 544

D2: US 4 161 074 and

D8: US 5 848 698

III. Summons to oral proceedings were issued on 16 July 2014 and rescheduled by communication of 28 July 2014. With a letter of 4 November 2014, the appellant-opponent informed the Board that he would not attend the oral proceedings scheduled for 7 November 2014. The oral proceeding before the Board were duly held as scheduled in his absence.

IV. The appellant-proprietor requests that the decision under appeal be set aside and that the patent be maintained in amended form according to the claims of auxiliary request 2 or in the alternative according to claims of one of auxiliary requests 3 to 6 ,6A, 6B, 6C, or 7 to 9 all filed on 19 March 2012. Previous main and first auxiliary requests were withdrawn during the oral proceedings before the Board.

The appellant-opponent requests that the decision under appeal be set aside and that the patent be revoked.

V. The wording of claim 1 of the requests that are relevant to this decision reads as follows:

Auxiliary Requests 2,3

"Indicator of products for shelving, particularly for shelving holding products in sales areas or shopping outlets, said indicator comprising a semi-rigid strip or band, said strip having three transversal folding lines, one central folding line (1) and two intermediate folding lines (2) that are symmetric with respect to said central folding line (1), these three folding lines (1, 2) defining two identical intermediate areas (3), which are situated back to back in full contact with each other after folding the strip along the transversal central folding line (1), and two

outer areas (4), which are situated in a coplanar position after being folded outwards at a right angle, along the respective intermediate folding lines (2), with respect to the adjacent intermediate area (3), and wherein each intermediate area (3) is separated from the adjacent outer area (4) by said intermediate folding line (2) and by a slot (2')."

Auxiliary requests 4, 5

Claim 1 reads as claim 1 of auxiliary request 2 but adds the following final feature:

", said slot extending upwards from a lower edge of said strip."

Auxiliary request 6

Claim 1 is as upheld by the decision and reads as claim 1 of auxiliary request 2 but adds the following final feature:

", said slot extending upwards from a lower edge of said strip until substantially at level with an upper edge of said outer area (4)."

VI. The appellant-proprietor mainly argued as follows:

Admissibility of the opponent's appeal:

The opponent's appeal is inadmissible because it does not argue why the impugned decision was wrong in respect to claim 1 as maintained by the division. All the opponent's arguments apply to higher ranking requests which were rejected by the opposition division. Therefore the opponent's arguments only deal

with those parts of the decision by which he was not adversely effected.

Admissibility of document D8

D8 should not have been admitted into the proceedings, the impugned decision did not say why D8 had been admitted but merely argued lack of novelty with respect to D8.

Extension of subject matter vis-à-vis the word *slot*:

The word slot in the patent is not an inadmissible extension of subject matter because in the context of the patent the Spanish word "ranura" means "slot" in the sense of a cut-out passing through the thickness of the indicator, rather than "groove".

Novelty of claim 1 of auxiliary requests 2 to 5

Claim 1 of these requests is novel with respect to D8, figures 4 and 5, because D8 does not disclose slots. All the cut-outs in figures 4 and 5 are notches that are shorter than slots.

Auxiliary request 6:

Dependent claim 4 does not constitute an unallowable extension of subject matter because slots are implicitly elongated. The opponent's objection that claim 4 is not clear should be rejected as inadmissible since it was present as a granted claim and lack of clarity is not a ground for opposition.

The subject matter of claim 1 is new with respect to D8 because, even if the notches starting at the bottom of the indicator in figures 4 and 5 are considered to be slots, they do not end substantially level with an upper edge of the outer areas. It would not be obvious to extend the slot as in D8 to this level since this would cut right through the strip. Starting from D1, D1

does not disclose slots starting at the lower edge of the indicator. D2 does not disclose a slot as defined in the claim, so the combined teachings of D1 and D2 would not lead the skilled person to the indicator claimed in an obvious manner.

- VII. The appellant-opponent mainly argued as follows:
The word "slot" extends the subject matter of the patent beyond the application as filed because the Spanish word "*ranura*" means *slot* or *groove*. It is therefore not unambiguously clear what may have been meant. The wording "elongated slot" in certain requests is a further extension of subject matter, since it was not originally disclosed and implies something more than merely a slot. Furthermore the expression is not clear. If a slot is not inherently elongate, it is unclear how an elongate slot differs from a slot.

Document D1 discloses an indicator having outer and intermediate areas as claimed separated by fold lines and small cut-outs at the upper edge. The skilled person understands that if a part of a fold line is replaced by a slot it is easier to fold. Slots are known from D2, so the skilled person would arrive at the subject matter of those independent claims having a slot without making an inventive step.

Reasons for the Decision

1. Admissibility
 - 1.1 Admissibility of the appellant-proprietor's appeal has not been contested, nor indeed is there any formal deficiency apparent that might warrant the rejection of the appeal as inadmissible under Rule 101 EPC.
 - 1.2 However the appellant proprietor contests admissibility of the opponent's appeal, as the appellant-opponent's grounds of appeal would not be sufficient to comply with Article 108 EPC, third sentence with Rule 99(2) EPC. In accordance with established jurisprudence of the Board's of appeal the grounds of appeal should set out the legal and factual reasons on which the case for setting aside the decision is based, see Case Law of the Boards of Appeal, 7th edition, 2013 (CLBA), IV.E. 2.6.3 a) and the decisions cited therein.
 - 1.3 It is true that in the present case the appellant-opponent's arguments do not specifically address the last feature of claim 1 as upheld by the opposition division, now auxiliary request 6. However, in section 2 of his reasoning headed "*Sur les requêtes auxiliaires no 2 à 6, 6a, 6b, 6c et 7 et la présence d'une fente (slot) dans la bande*" he sets out arguments as to why the term "slot" (grounds of appeal, pages 3/8 to 4/8, section 2), present in claim 1 of auxiliary request 4 and the term "elongated slot" (page 7/8, lines 7-9), present in dependent claim 4 of auxiliary request 4 offend against Article 123(2) EPC. Furthermore, in the same section, he addresses inventive step in the light of D1 with D2, (pages 4/8 and 5/8) particularly arguing

with respect to the feature of a slot. Thus he presents legal and factual arguments as to why the impugned decision should be set aside.

The fact that these arguments might likewise apply to higher ranking requests does not negate the fact that reasoned legal arguments, based on facts, have been presented against claims upheld.

From the above, the Board holds that the appellant-opponent's appeal is sufficiently reasoned to comply with Article 108 EPC with Rule 99(2) EPC.

1.4 The Board concludes that both appeals are therefore admissible.

2. Background of the invention

The patent is concerned with a three-dimensional product indicator for mounting on shelving that can be viewed from the front or the side, see specification paragraphs [0001] and [0002].

The invention's original idea was to make a simpler, cheaper indicator that could be easily and quickly fitted and removed by folding a single strip of semi-rigid material along transversal folding lines, see specification paragraphs [0005] and [0006].

A further idea was to facilitate folding and mounting of the indicator in retaining elements of the front of shelving, see specification in the version as upheld, paragraph [0013]. To this end, slots supplement the folding lines in all versions of claim 1 now requested by the appellant-proprietor in appeal.

3. Admissibility of D8

3.1 According to established jurisprudence of the Boards of appeal, see see Case Law of the Boards of Appeal, 7th edition, 2013 (CLBA), IV.C.1.3.3, late filed facts and evidence and supporting arguments should only exceptionally be admitted into the proceedings if, *prima facie*, there are reasons to suspect that such late-filed documents prejudice the maintenance of the European patent in suit. Furthermore, a board of appeal should only overrule the way in which a department of first instance has exercised its discretion when deciding on a particular case if it concludes that it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way, (T 640/91 OJ 1994, 918).

3.2 In the present case the opposition division admitted the late filed opposition ground of lack of novelty (Article 100a EPC), based on D8, into the proceedings.

It is true that the decision does not explicitly state that D8 is admitted into the proceedings, nor that D8 is *prima facie* relevant. However, since the lack of novelty ground is based solely on D8, consideration of the *prima facie* relevance of novelty is in this case inseparable from the *prima facie* relevance of D8. Furthermore admittance of this ground into the proceedings implies admittance of D8, since without D8 the ground fails. In effect therefore D8 was admitted into the proceedings by the opposition division together with the late filed ground of novelty.

The division held that, *prima facie*, admission of the novelty ground based on D8 would lead to a different outcome of the proceedings, in other words prejudiced

the maintenance of the patent in certain versions (decision reasons point 2). Furthermore the parties were heard on the issue (minutes of oral proceedings page 1, point 2). Thus the division appears to have exercised its discretion according to the correct principles and in a reasonable way. Therefore the Board has no reason to overrule the division's discretionary decision to admit D8.

4. Auxiliary requests 2 to 5 : novelty

4.1 Auxiliary requests 2,3

4.1.1 D8 (see in particular figures 1 to 5 and column 3, line 15 to column 4 line 15) discloses various product indicators for mounting on shelf pricing channels or shelf slat-walls (title and column 1, lines 33-41, figures 4 and 5). They are made of a semi-rigid strip (column 3, lines 15-17) having three transversal folding lines, namely a central 17 and two intermediate folding lines 18A, 18B (figures 1 and 2). When folded along the central line 17, identical intermediate areas 13A, 13B are back-to-back in full contact (column 3, lines 22-24). Folding the strip 90° outwards along the transversal lines 18A,B (column 3, lines 46-50, column 4, lines 5 to 7, figures 4 and 5) provides two coplanar outer areas 12A and 12B. D8 therefore indisputably discloses all features of claim 1 up to and including its penultimate feature.

4.1.2 The question of novelty vis-à-vis D8 thus hinges on whether D8 discloses the last feature of claim 1, namely that intermediate areas are separated from outer areas by slots.

- 4.1.3 Giving the term *slot* its normal meaning, the Board holds that the skilled person will understand it to mean a narrow aperture, in other words an opening longer than it is wide. Nothing in the patent suggests a different interpretation. According to paragraph [0013] slots form sections of the transversal folding lines, suggesting they are elongate, like a line. The figures of the only embodiment (figures 1, 2 and 3 with paragraph [0019]) show the slots 2' to be narrow openings in the strip.
- 4.1.4 The appellant-proprietor has argued that, in the context of the patent, *slot* is to be more narrowly interpreted as an opening shaped to fit over the front wall of two parallel wall retaining elements that form a narrow open-topped channel on a shelf front (a so called "V-shaped" channel). The Board disagrees. The patent does not mention V-shaped channels. The slots are said to facilitate the indicator's assembly in shelf retaining elements (paragraphs [0013] and [0021] of the description as upheld). However, the retaining elements are not defined, let alone how they interact with the slots. At best the skilled person might speculate about possible retaining elements, but he would not conclude that the slots claimed must have a particular shape to fit particular retaining elements.
- 4.1.5 Turning again to D8, figure 5 shows an indicator mounted on a slat wall. It is immediately apparent that the indicator has vertical openings along the boundaries between outer areas 12 and intermediate areas 13. These openings allow parts of the outer areas to be behind the slats whilst adjacent intermediate areas are in front of the slats. To fit around the slats, the width of these openings must at least equal the thickness of the slats. This is achieved by making

cuts between the exterior points where outer and intermediate areas meet and the holes 25A to D (cf. paragraph bridging columns 3 and 4 and figures 1 to 3). As can best be envisaged by comparison with figure 1, such cuts inevitably form narrow vertical apertures, running from the upper and lower edges of the indicator between respective areas 12 and 13, each ending at a respective hole 25 A to D. Such apertures are thus not merely notches but long narrow openings falling under the normal meaning of the word slot. Furthermore they separate adjacent intermediate and outer areas as claimed. Accordingly, D8 discloses all features of claim 1.

4.2 Auxiliary requests 4 and 5

Claim 1 of these requests adds that the slots extend upwards from a lower edge of the strip. In D8, the slots ending at holes 25A and 25C (cf figures 1 and 5) start from the bottom of the strip. Thus these slots likewise extend upwards from the lower edge of the strip as claimed. Accordingly, D8 discloses all features of claim 1.

4.3 The Board concludes that the subject-matter of claim 1 according to auxiliary requests 2 to 5 lacks novelty with respect to document D8, therefore the requirements of Article 52(1) with 54(2) EPC 1973 are not fulfilled and these requests fail.

5. Auxiliary request 6 (claims as upheld in first instance)

5.1 Added subject-matter

- 5.1.1 The application was originally filed in Spanish, which is therefore the authentic text, Article 70(2) EPC. It contained the term "ranura", originally translated as "groove", but then subsequently, in examination, changed to "slot". The new translation as *slot* in the present version of the patent has been challenged by the appellant-opponent as adding subject-matter. According to Article 14(2) EPC a translation of an application filed in a non-office language may be brought into conformity with the application as filed - the authentic text of Article 70 (2) - throughout the proceedings, Article 14(2) EPC. The subsequent correction of the translation thus cannot be an issue. The Board must therefore consider only whether or not the skilled person, using his general knowledge, would directly and unambiguously derive the term *slot* from the application as originally filed, i.e. as filed in Spanish.
- 5.1.2 It is common ground that the Spanish word *ranura* means a groove or slot, depending on its context. A *groove* is a narrow channel, in other words a furrow scooped out of but not completely passing through a surface, whereas a *slot* is a narrow aperture.
- 5.1.3 The skilled person reads *ranura* contextually, that is taking into account the description, claims and drawings. *Ranura* are mentioned in the original Spanish description (page 3, lines 16 to 21, page 4, lines 18-22) and claim 3 (cf. published application paragraphs [0012], [0018] and claim 3). Here they are presented as an alternative to *líneas de corte* - cutting lines - that play a role in assembling the indicator. Thus presented with *ranura* as an alternative to a linear cut, the skilled person would consider a *slot* - a slightly wider linear cut than a cutting line

- as a more appropriate translation of *ranura* than groove, which is no cut at all.

The figures of the sole embodiment confirm this interpretation. The feature 2' (figure 1), also seen in figures 2 and 3, is open at the lower edge of the indicator, so it must be an aperture cut completely through the indicator rather than merely scooped from its surface. In other words, read contextually, the skilled person would understand *ranura* in the original application to mean a slot, not a groove. Therefore the word slot in the patent does not extend the subject matter beyond the application as filed.

5.1.4 Claim 4 defines the slot of claim 1 as an *elongated* slot. Consistent with the skilled person's reading of slot (narrow aperture), a slot is always longer than it is wide and thus implicitly elongated. Consequently, the Board holds that claim 4 merely makes explicit an implicit feature of the slot of claim 1. Therefore no subject matter is added by the term elongated slot.

5.1.5 In the light of the above, the Board is satisfied that the version of claims according to auxiliary request 6 does not contain subject-matter extending beyond the content of the application as filed and therefore meets the requirements of Article 123(2) EPC.

5.2 Clarity

The appellant has argued that the feature "elongated slot" is unclear as such, and renders dependent claim 4 unclear, Article 84 EPC. Claim 4 is however unchanged (apart from its dependence) with respect to granted claim 5 on which it is based. The asserted lack of clarity in claim 4 is thus not the result of or linked

in any way to an amendment made to the granted patent. As clarity is not a ground of opposition, and can only be examined in opposition under Article 101(3) EPC if it arises from an amendment (irrespective of whether that amendment is substantial or not, see referral G3/14) the Board decided it did not have the power under Article 101(3) EPC to examine the issue.

5.3 Novelty

Claim 1 of this request adds to that of auxiliary request 4 the feature that the slots extend upwards from a lower edge of said strip *until substantially at [sic] level with an upper edge of said outer area* (added text emphasised by the Board). As explained above in section 4.1.5, in D8, figure 5, the slots which extend from a lower edge of the strip end at the holes 25A and 25C well below the middle of the outer areas 12A, 12B of the strip (cf. figures 1 and 5 and column 4, lines 1 to 15). Consequently D8 does not disclose that the slots extend until substantially level with an upper edge of the outer area. Similarly, considering D8, figure 4 as the impugned decision does, slots 12E and 12F are even shorter than in figure 5, they end far below the upper edge of the outer area. Therefore the Board confirms that decision's finding (reasons 9.5.1) that the subject matter of claim 1 is new vis-à-vis D8.

5.4 Inventive step

- 5.4.1 The appellant-opponent has argued that the subject matter of claim 1 lacks inventive step vis-à-vis D1 with D2.

5.4.2 However, neither document discloses the characterizing feature of slots extending upwards from the lower edge until substantially at level with upper edge of the outer area. D1 discloses (figures 6 to 10, column 3, line 65 to column 4, line 59) a product indicator 200 adapted for use with a pricing rail 216 with a channel of C-shaped cross section (figure 10) and made of a strip of semi-rigid material (sentence bridging columns 3 and 4) having intermediate areas 206, 208 separated by a central folding line 228 and outer areas 224, 210 separated by intermediate folding lines 226, 230. As is clear from figures 6 and 7 the D1 indicator has notches on the upper edge of the strip but none at its lower edge, let alone ones that extend all the way to the upper edge.

D2 also discloses a product indicator for a price rail 14 of C-shaped cross section (figure 3) also assembled from a flat strip but by looping through a vertical slit 18 rather than by folding (column 1, lines 38-47; column 2, lines 47-57, figures 1 and 3). Upper and lower notches 22,24,26 a and b (figures 1,2) assist insertion in the price rail; in the unassembled strip the main display area is further bordered at 10c by a further slot. Neither lower notches 22b,24b,26c, nor the slot at 10c extend all the way from lower to upper edge.

As neither document discloses the characterizing feature the combination of their teachings (whether that combination is obvious or not) would not result in the indicator as claimed.

5.4.3 Nor is it apparent to the Board that this feature might be obvious per se in the light of common general knowledge. It can be inferred from specification

paragraph [0021] considered in conjunction with figure 3 in particular that the slots 2' allow the outer portions 4 of the strip to be inserted downwardly in the securing element at the front of the shelving, which must have only an upward lip, i.e. forms a channel of V-shaped cross section. The differing feature thus represents a specific adaptation to a different system than that of D1 or D2 with C-shaped channels. The Board holds that such an adaptation goes beyond the routine skills of the skilled person in the present field of shelving display systems.

5.4.4 The same reasoning applies also to D8, the starting point chosen in the decision under appeal. That document also relates to shelving with C-shaped channel as in D1 and D2. The sole difference of the slot extending all the way from lower to upper edge again represents a specific adaptation to shelf display systems with a V-shaped channel, i.e. of different type, that is beyond the normal skills of the average skilled person. This conclusion holds irrespective of whether the figure 4 or the figure 5 embodiment of D8 is chosen as starting point.

5.4.5 In summary, the arguments presented by the appellant opponent fail to demonstrate a lack of inventive step of the subject matter of claim 1 upheld by the decision under appeal. The Board therefore confirms the decision's positive finding of inventive step, Article 100(a) with Articles 52(1) and 56 EPC.

Order

For these reasons it is decided that:

The appeals are dismissed.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated