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Aktenzeichen / Case Number / N^o du recours : T 101/87-3.2.1

Anmeldenummer / Filing No / N^o de la demande : 81 401 174.8

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 045 249

Bezeichnung der Erfindung: A device for removing vehicle windscreens

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : B 60S 5/00, B25D 17/02

ENTSCHEIDUNG / DECISION

vom / of / du 25 January 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Lock, T.S.

Einsprechender / Opponent / Opposant :

C. & E. Fein GmbH & Co.

Stichwort / Headword / Référence : Costs/Lock

EPÜ / EPC / CBE Articles 104, 114, 117(1) EPC; Rule 63 EPC

Schlagwort / Keyword / Mot clé : "Apportionment of costs"

Leitsatz / Headnote / Sommaire



Case Number : T 101/87 - 3.2.1

Europäisches Patentamt · Erhardtstraße 27 · D-8000 München 2

D E C I S I O N
of the Technical Board of Appeal - 3.2.1
of 25 January 1990

Erhardtstraße 27
D-8000 München 2

Telephon (0 89) 23 99-0
Telex 5 23 656 epmu d

Appellant :
(Opponent)

C. & E. Fein GmbH & Co.
Leuschnerstr. 41-47
7000 Stuttgart 1 (DE)

Zeichen
Reference
Référence

Datum
Date
Date

Representative :

Hoeger, Stellrecht & Partner
Uhlandstrasse 14 c
D-7000 Stuttgart 1 (DE)

Respondent :
(Proprietor of the patent)

Lock, Trevor Stanley
16 Bailey Street
Eaglehawk, Victoria 3556 (AU)

Representative :

Picard, Jean-Claude Georges
Cabinet Plasseraud
84, rue d'Amsterdam
F-75009 Paris (FR)

Decision under appeal :

Decision of Opposition Division of the European
Patent Office dated 10 February 1987 rejecting
the opposition filed against European patent
No. 0 045 249 pursuant to Article 102(2) EPC.

Composition of the Board :

Chairman : P.E.M. Delbecque
Members : C.T. Wilson
F. Benussi

Summary of Facts and Submissions

- I. European patent No. 0 045 249 was granted on 30 January 1985 with five claims on the basis of European patent application No. 81 401 174.8. Claim 1 is worded as follows:

"A device for removing from a vehicle a glass panel (10) secured in the vehicle by an elastomeric sealing strip (11), said device comprising an elongated flexible blade (1) having a sharpened edge (4) at one end (3) and means (2, 6, 8; 15) at the other end to allow the blade to be manually gripped or operably gripped by a reciprocating power tool (18), characterized in that said sharpened edge (4) extends along a short length of at least one longitudinal edge of said blade from said one end, said sharpened edge (4) being located in the plane of one face (16) of the flexible blade (1)."

- II. The patent was opposed on 24 October 1985. The Opponent requested ~~revocation of the patent on grounds of lack of novelty and of inventive step.~~ The following documents were cited in support of the opposition:

(D1) Page 60 of the Catalogue "Elektrowerkzeuge" of AEG Company, dated 1979

(D2) Drawing No. 6350303300 of C. & E. Fein GmbH & Co, dated 1972.

- III. The Opposition Division rejected the opposition in a decision dated 10 February 1987. According to the decision, the subject-matter of Claim 1 was novel since the photographic reproduction of the knife blade of (D1) did not allow the precise location and extent of the cutting

edge to be established. Moreover, since the documents cited during the examination procedure do not suggest the solution to the problem posed in column 1, lines 49 to 54 of the opposed patent, as defined in Claim 1, the subject-matter of the claim also involves an inventive step. (Since document D2 was not cited against Claim 1 this was left out of consideration).

- IV. The Appellant (Opponent) filed an appeal against this decision on 14 March 1987 with the payment of the appropriate fee, and submitted a Statement of Grounds on 6 June 1987. He requests revocation of the patent since all features of all the claims are either known or are obvious in the light of the prior art as reflected in four new documents and in alleged public prior use of the devices disclosed in these documents.

The four documents are as follows:

1. (Anlage 1), Prospectus "Zeitsparende Spezialwerkzeuge für Karosserie-Reparaturen" (Deprag)
2. (Anlage 2), Prospectus "Druckluft-Niet-und Meißelhämmer" (Fein, Druckluft-Werkzeuge)
3. (Anlage 3), Prospectus "Zeitsparende Spezialwerkzeuge für Karosseriereparaturen"
4. (Anlage 4), Prospectus "Druckluft-Niet-und Meißelhämmer" (Fein, 5000).

A witness, Herr Wilhelm Fritz Lösch, is named for both the alleged prior use and for the availability of the documents constituting Anlage 1, 2 and 3 to the public before the priority date of the contested patent.

The document constituting Anlage 4, although not available before the priority date, is merely cited since the quality of reproduction of a photo identical to one shown in the document of Anlage 2, is better.

- V. The Respondent (Patentee) did not file any observations on the Statement of Grounds.
- VI. In a communication of the Board of Appeal pursuant to Article 110(2) EPC and dated 16 January 1989, the Board expressed its intention not to take into account the new late documents cited in the Grounds for Appeal, since they appeared no more relevant than the previously cited documents, none of which appeared to give any indication to the man skilled in the art that the characterising features of Claim 1 would solve the problem set in the present patent. Moreover, the Board would also consider apportionment of any costs incurred by the Representative of the Respondent, and charged to the Respondent, as a result of this appeal, in the light of the fact that the appeal was only based on completely new evidence, comprising the four new documents and the alleged prior use. The Board also referred to previous decision T 117/86 - 3.3.1 dated 1 August 1988, (to be published), in this respect.
- VII. In a reply from the Respondent received 27 February 1989, he expressed his agreement with the opinion of the Board, requesting that the additional prior art not be taken into account, that the Appeal be dismissed and the patent maintained unamended, and that the Respondent be awarded his costs from 10 October 1985, i.e. the date of the Opponent's letter containing the Notice of Opposition.
- VIII. In a reply received 27 April 1989 the Appellant argued essentially that the new documents were not to be

considered as late-filed. Further, an enlargement of a picture of the tool 806 077 from Document Anlage 1 was filed and should now show clearly the characterising features of Claim 1. Finally, the Appellant contests the apportionment of costs, and requests that the patent be revoked.

Reasons for the Decision

1. The appeal is admissible.
2. All four new documents, and the new ground of prior use, have been referred to in the opposition proceedings for the first time in the Grounds of Appeal, namely 6 June 1987 or approximately, two and a half years after grant of the patent. They have clearly therefore been filed outside the opposition period and, since they are not more relevant than any of the earlier documents cited, are not admitted into the procedure under Article 114(2) EPC.

The Appellant is of the opinion that the documents are not to be considered as late-filed, and refers in this respect to decision T 156/84 (OJ 10/88, p. 372), according to which documents are not to be considered as late-filed just because they are filed outside the opposition period. However, the Board has in the present case not only considered this but has also considered their relevance. The documents were according to the Appellant filed in response to the decision of the Opposition Division who based their decision essentially on the fact that it was not explicitly clear from the cited state of the art that the knives were suitable for cutting the elastomeric materials used for retaining windshields. It was first made clear in the decision that the Opposition Division was only prepared to consider documents as relevant if they were directed closely to this use.

This argument is not however convincing. This is a typical case of an Opponent filing an opposition and, when the Opposition Division decides that the cited prior art is not such as to require amendment of the patent, attempting to find more relevant prior art and effectively prolonging the period of opposition. This sort of procedure is clearly to be distinguished from the Opponent who makes a further search in response to substantial amendments of a claim, for example, or to comments from the Opposition Division to a "missing link" in a chain of argument. These documents are therefore regarded as late-filed.

3 Whilst the Board is not required to give reasons for not admitting this new evidence, it would make the following points:

3.1 All four new documents 1-4 relate to power tools (namely a reciprocating hammer) and their associated tool bits specially adapted for effecting repairs to car body works (other specific applications are referred to in document 2).

3.2 In document 1, on page 3, a tool bit is shown and described, namely No. 806 077, for operating on grooves containing rubber seals. These could clearly also contain windscreens. This document could therefore be considered to disclose a tool bit corresponding to the precharacterising part of Claim 1. However, the blade No. 806 077, as shown in document 1 differs from the subject-matter of Claim 1 by the characterising features of the claim.

Moreover, contrary to the opinion of the Appellant, it is not clear to the Board from the enlargement filed with the Appellant's reply, that the tool 806 077 also has the characterising features of Claim 1. It really cannot be

seen from this enlargement, for example, that the sharpened edge is "located in the plane of one face of the flexible blade", as called for in Claim 1.

Moreover, the Board does not agree that the man skilled in the art would ignore the fact that the different tools are designed for different purposes, as also argued by the Appellant, simply because they are sold as a set to be driven by a common pneumatic tool.

As well as the blade No. 806 077, many other blades are described for other purposes, e.g. for straight cuts in metal (806 055), for round cuts (806 060), for cutting off the roof of a car (806 066), for cutting off the exhaust pipe (806 253), for separating welded joints (e.g. spot welds (806 057)). The Board cannot follow the Appellant when he states that the man skilled in the art would appreciate from document 1 that all of these tool bits are suitable for removing rubber seals. In fact, only one of the tool bits is stated to be so suitable. The man skilled in the art would apparently rather assume that any differences between the tool bits are special adaptations for the special purposes for which the tool bits are intended to be used. For example, the rounded end of the cutting blade of the tool bit No. 806 064, whilst providing a cutting edge extending along a longitudinal edge of the blade (see Claim 1), is provided on a tool bit for separating light spot welds between thin metal sheets. There is no clear indication that this would be particularly suitable for solving the problem posed in the present patent (see column 1, lines 49-54). Similarly, the off-centre cutting blade of tool bit No. 806 063 is also described for a tool bit for separating spot welds. Even if, therefore, this tool could be considered as having a sharpened edge located in the plane of one face of the flexible blade (Claim 1), there appears to be no indication

that this would be a particularly useful feature for a blade for removing windscreens.

- 3.3 The other documents also, whilst possibly showing chisels or blades with cutting edges having one or other of the features of the characterising part of Claim 1, do not appear to contain any suggestion that these features would be at all advantageous for a device for removing windscreens from vehicles.
4. Clearly, since according to the above analysis, the disclosure of the documents does not render the subject-matter of Claim 1 obvious, the alleged prior use of the devices described in these documents can also not provide grounds for revoking the patent for lack of inventive step.
5. Further, none of the documents cited in the examination proceedings or earlier in the opposition proceedings appears to give any indication to the man skilled in the art that the characterising features of Claim 1 would solve the problem set in the present patent. Since this has not been contested by the Appellant in the present appeal, no further justification is necessary.
6. The Grounds of Appeal make no criticism of the reasons for the decision of the Opposition Division, but rely only on documents submitted approximately 20 months after the period of lodging an opposition provided by Article 99(1) EPC. A Board of Appeal has stated in Decisions T 117/86 (OJ EPO 10/89, 401) and T 416/87 of 29 June 1989 (to be published), that Article 99(1) and Rule 55(c) EPC considered together clearly require that an Opponent's case against an opposed patent should be set out fully and completely in the notice of opposition and should not be presented and developed piece-meal.

In the present case, the fact that the Appellant relies in the Statement of Grounds of Appeal on four new documents exclusively is regarded by the Board as an abuse of the opposition procedure. By introducing arguments and documents which bear little relation to those filed in the original opposition, the Appellant has produced virtually a new opposition at the appeal stage. This cannot be, by definition, the purpose of an appeal.

The late filing of documents (1) to (4) must have considerably increased the costs incurred by the Respondent, in comparison with the situation if all facts and evidence had been filed within the nine month period. The present abuse of procedure therefore justifies, in the Board's view, the apportionment of costs incurred during taking of evidence. As provided in Rule 63(1) EPC, such costs include the remuneration of the representatives of the parties (see Decision T 117/86 "Costs", No. 7 of the Grounds).

The Appellant argues the since there has been no oral proceedings nor taking of evidence (Article 104(1)), no cost apportionment is possible.

However, he is clearly confusing "taking of evidence" with "hearing of witness" (Article 117(1)), and he requests that the question be sent to the Enlarged Board if the Board intends to award costs. He is clearly unaware of the decisions T 117/86 and T 416/87 which render such submission unnecessary.

The request of the Respondent for his costs in the opposition procedure before the appeal stage must clearly be refused. The apportionment of costs is only considered

to be equitable in respect of the abuse of the opposition procedure at the appeal stage.

Having carefully considered all the relevant circumstances of the case, the Board has decided for reasons of equity to order an apportionment of costs by which the Appellant shall pay to the Respondent fifty per cent of the costs which were incurred by the Respondent's representative and charged to the Respondent in the present appeal, i.e. from 14 March 1987.

Order

For these reasons, it is decided that:

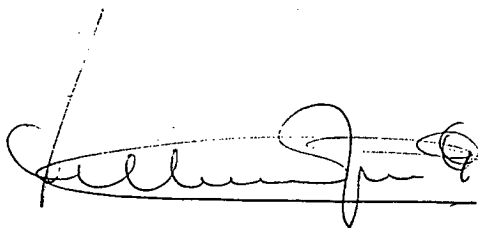
1. The appeal is dismissed.
2. The costs in the appeal procedure shall be apportioned so that the Appellant shall pay to the Respondent fifty per cent of the costs which were incurred by the Respondent's representative and charged to the Respondent in the present appeal.

The Registrar:



S. Fabiani

The Chairman:



P.E.M. Delbecque

