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D E C I S I O N
of 25 June 2003

Case Number: T 1008/96 - 3.2.3

Application Number: 88830024.1

Publication Number: 0277098

IPC: F24C 15/02

Language of the proceedings: EN

Title of invention:

Improved gasket of elastomer material in the form of a closed or open frame for cooking oven doors

Patentee:

GIAT S.r.L.

Opponent:

TAMBURINI GI-EFFE S.r.l. // POSA S.p.a.
REHAU AG & Co.
BOSCH-SIEMENS HAUSGERÄTE GMBH, München

Headword:

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Relevant legal provisions:

EPC Art. 54, 55(1), 87(1), 89, 114(2)
EPC R. 55(c)

Keyword:

"Late-filed ground for opposition - exercise of discretion of the opposition division correct "
"Priority not valid because applicant is not entitled"
"Novelty - public prior use (yes)"

Decisions cited:

G 0009/91, G 0010/91, G 0003/98, G 0002/99, T 0640/91,
T 0986/93, J 0019/87

Catchword:

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Case Number: T 1008/96 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 25 June 2003

Appellant I:
(Opponent)

TAMBURINI GI-EFFE S.r.l.
Via Don Minzoni, 13/15
I-20020 MISINTO (MILANO) (IT)

and

POSA S.p.a.
Via Sormani, 40
I-20093 COLOGNO MONZESE (IT)

Representative:

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Viale San Michele del Carso, 4
I-20144 Milano (IT)

(Opponent)

REHAU AG & Co.
Rheniumhaus
D-95111 Rehau (DE)

Representative:

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Appellant II:
(Opponent)

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Patent- und Vertragswesen
Hochstrasse 17
Postfach 100250
D-80076 München (DE)

Representative:

-

Respondent: GIAT S.r.L.
(Proprietor of the patent) Via Tranquillo Cremona, 10
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Representative: Adorno, Silvano
c/o SOCIETA' ITALIANA BREVETTI S.p.A.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 7. October 1996
rejecting the opposition filed against
European patent No. 0277098 pursuant to
Article 102(2) EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: U. Krause
M. K. S. Aúz Castro
F. E. Brösamle
J. P. B. Seitz

Summary of Facts and Submissions

I. The appeals contest the decision of the Opposition Division, dated 9 July 1996 and posted on 7 October 1996, to reject the oppositions against the European patent No. 0 277 098 which claimed the priorities of Italian utility model applications IT-U-20563/87 dated 21 January 1987 and IT-U-21778/87 dated 11 June 1987. Independent claim 1 of the patent has the following wording:

"1. A frame-like gasket of elastomer material, particularly for cooking oven doors, formed of a tubular profile (1) with inner longitudinal cavity (2) and having a continuous, frontally protruding peripheral flange (4), with only one butt joint, if any, and metal coupling inserts (5,6,8) being provided for engagement under stretch in associated holes (12,13) on an abutment surface (14) of sheet iron, said coupling inserts being located at the inside of the tubular profile (1) from which they project outwardly, partially through slots or holes (11) with protruding portions (9,9'), characterized by the fact that said slots (11) are obtained by removal of material at the rear portion of profile (1) and their size in a plane orthogonal to the longitudinal axis of the tubular profile (1) is greater than the corresponding size of the protruding portion (9,9') of the metal insert therein, whereby at least one edge of said slot (11) is out of contact with said protruding portion."

II. The oppositions of Opponents I, II and III were based on the opposition grounds of lack of novelty and inventive step in view of a number of patent documents

and an alleged public prior use. A reference of Opponent II to problems of executing the invention, which could be subsumed under Article 100(b) EPC, was clarified in the oral proceedings before the first instance as relating to the grounds of Article 100(a) EPC (see page 6, fifth paragraph of the minutes). After expiry of the opposition period Opponent I raised an objection based on Article 123(2) EPC which was, however, not introduced into the proceedings by the Opposition Division as being *prima facie* not founded.

III. The notice of appeal was filed, concurrently with payment of the appeal fee, by Opponent I (hereinafter Appellant I) on 20 November 1996 and by Opponent III (hereinafter Appellant II) on 17 December 1996. The statement of the grounds of appeal was submitted by Appellant I on 5 February 1997 and by Appellant II on 17 February 1997.

Enclosed with its statement of the grounds of appeal and during the written appeal proceedings Appellant I submitted *inter alia* the following further documents relating to an alleged further public prior use and to the question of whether the patent was entitled to the claimed priorities:

AP4: Drawing Nos. 144000855.00, 144000856.00, 144000859, 144000860 and 144000863 of the firm Merloni Elettrodomestici and copies of invoices Nos. 678, 1057, 1124, 1128, 1141, 1152, 1180 and 1220 of TAMBURINI GI-EFFE s.p.a to MERLONI Elet.ci s.p.a

AP6: copy of the first page of a request pursuant to Article 81 R.D. 29 June 1939 (Italian Patent Law) in infringement proceedings against Appellant I, lodged on 11 October 1990 before the court of Monza, together with an English translation (AP6')

AP7: Title page and first description page of Italian patent No. 209842 referred to in AP6

AP13: Decision 1954/98 issued by the Court of Monza on 12 September 1998 in the case Calogera DI BILIO and GIAT s.r.l. vs. POSA s.p.a and TAMBURINI GI EFFE s.r.l., together with an English translation of page 22, lines 20 to 24 (AP13')

The Respondent submitted, with its response to the statement of the grounds of appeal of Appellant I, a declaration of Mrs DI BILIO and an English translation thereof ("Declaration").

The appeal proceedings were suspended as from 26 February 1999 on request of the Appellant I seeking a judgement before the civil court of Milan that he is entitled to the European patent under appeal, and were resumed on 1 July 2002.

Oral proceedings were held on 25 June 2003 in the absence of Appellant II, who had informed the Board that he would not attend, and Opponent II who did not make any submissions during the Appeal proceedings.

IV. Appellant I requests that the decision under appeal be set aside and that the patent be revoked. Its arguments can be summarized as follows:

The objection under Article 123(2) EPC was introduced within the opposition period by stating, on page 1 of the grounds of the notice of opposition, that the dimensional characteristic, ie the fact that the transverse dimension of the slot is greater than the corresponding dimension of the protruding part, "is not bound in any way to the scope set ... by the application as filed", meaning that this characteristic could not be derived from the application as filed. This feature was taken from the drawings which, however, lacked a clear disclosure in this respect because figures 1, 7 and 8 of the original application showed the protruding portions to be in contact with the edges of the slots. Since the dimensional relation was crucial for the assessment of novelty and inventive step, the objection should be admitted even if it was considered to be late-filed.

Regarding the issue of novelty emphasis was put on the further prior use having occurred within the priority interval. As proven by the various invoices included in evidence AP4, considerable numbers of gaskets according to the code numbers 144000855 and 144000856 were sold in the period from 9 July 1987 (invoice No. 678) to 18 December 1987 (invoice No. 1220) from Appellant I to MERLONI. The drawings having the above code numbers showed the complete gasket with inserts placed in the corners and included a table referring to detail drawings 140000863 and 140000862 for the metal inserts in the corners and to detail drawing 144000860 for the elastic gasket. A cut-out slot having a width of 4 mm was shown in the latter detail drawing, whereas it was derivable from the former two detail drawings that the

metal inserts had a protruding portion with a thickness of about 1mm. Thus, the slot width was greater than the corresponding dimension of the protruding portion such that at least one edge of the slot must be out of contact with the protruding portion when inserting the metal insert into the gasket. This prior use was acknowledged by the Respondent on page 7 of its letter dated 1 July 1997.

The prior use was novelty-destroying because the claimed priorities were invalid. Pursuant to Article 87(1) EPC a valid priority may only be claimed by the person who filed the priority application or by its successor in title, whereas the proprietor of the patent claiming the priority, GIAT s.r.l., was neither the person who filed the priority applications (Mrs DI BILIO) nor its successor in title. The declaration submitted by the Respondent was not a valid assignment of the priority rights to the Respondent, as in a transfer of an application, and was contradicted by evidence AP6 because Mrs DI BILIO could not be the owner of Italian patent No. 209842 derived from the priority application No. 20563 B/87, as stated in AP6, if she had assigned all rights to GIAT s.r.l. three years before. This missing link was also noted in the decision of the Law Court of Monza in 1998 (page 22, lines 20 to 24 of evidence AP13).

- V. Appellant II had argued, in writing, that the subject-matter of claim 1 was obvious in view of the patent documents. This argument need not be recorded in detail because, as will be evident from the reasons of the decision, it was not relevant for the decision.

VI. The Respondent requested that the appeals be dismissed and replied to the arguments of Appellant I essentially as follows:

Since the statement made by Appellant I on page 1 of its statement of the grounds of the notice of opposition would not be understood as referring to added subject-matter this objection was a fresh ground of opposition which could have been admitted into the proceedings only if it was *prima facie* evident that the dimensional characteristic was not derivable from the application as filed. The opposition division was correct in denying it because this characteristic was clearly disclosed, for the embodiment of figures 1 to 6, in the detailed figures 3 and 4 whereas the embodiment of figures 7 and 8 was deleted in the patent.

Concerning the further prior use the Appellant failed to provide a proof beyond any doubt because neither the dimensional relation between the slot width and the projecting portions, as claimed in claim 1, nor the manner of manufacturing the slots could be derived from the drawings referred to in the invoices of Appellant I. Furthermore, it gave rise to doubts that the drawings No. 144000859 and 144000860 for the profile dated 27/11/86 carry an earlier modification date of 8/10/86. The sales from Appellant I to MERLONI mentioned on page 7 of the letter dated 1 July 1997 did not necessarily concern the gasket shown in these drawings in combination with the inserts shown in drawings No. 144000861, 144000862 and 144000863. If this was true they occurred in breach of the confidentiality agreed between the parties, being due

to an evident abuse in relation to the Respondent, and could not, therefore, be taken into account as prior art pursuant to Article 55(1) EPC.

The EPC did not define any requirements for proving the succession in title for the priority rights; therefore a party applying for a European patent cannot be subjected to any burden in addition to those established in the Convention. According to Italian law a formal assignment of the priority right was not compulsory and an oral agreement would be equally valid. Thus, the declaration of Mrs DI BILIO was more than sufficient to prove the validity of the priorities. There was no conflict with the later request in the infringement proceedings (AP6) because the Italian law allowed Mrs DI BILIO to remain the registered owner even if she had actually assigned all rights to the Respondent, and only the registered owner was allowed to file the request pursuant to Article 81 of the Italian patent law. Moreover, a transfer of the priority rights could even be effected separately from the transfer of an application or patent.

Reasons for the Decision

1. The appeals meet the requirements of Rule 65(1) EPC and are, therefore, admissible.
2. *Objection of added subject-matter*
 - 2.1 With letter of 11 May 1994 Appellant I raised the objection that the feature of claim 1 defining the dimensional relation between the size of the slot in a

plane transversely to the longitudinal axis of the tubular profile and the corresponding size of the protruding portion of the metal insert therein had no basis in the application as filed, whereby the application contained subject-matter extending beyond the contents of the application as filed. Since the nine-month opposition period beginning with the date of publication of the grant of the patent, 29 April 1992, ended on 29 January 1993, this objection was made after expiry of the opposition period. The Opposition Division exercised its discretion given by Article 114(2) EPC to disregard this objection as being *prima facie* unfounded.

- 2.2 Appellant I argues that an objection under Article 123(2) EPC was introduced within the opposition period by alleging, on page 1 of the grounds for the notice of opposition, that the dimensional characteristic, i.e. the fact that the transverse dimension of the slot is greater than the corresponding dimension of the protruding part, "is not bound in any way to the scope set ... by the application as filed", meaning that this characteristic could not be derived from the application as filed. This argument is not convincing. In fact, it is not readily evident what is meant by saying that a feature "is bound ... to the scope..". Referring, therefore, to the context of this statement which concerns an allegedly missing technical effect and a definition of the invention in structural terms in a chapter headed "Contents of the opposed patent", one would conclude that this structural feature, having no technical effect, should be considered as irrelevant or superfluous. There is no room for any speculation as to what other meaning this

statement might have. In fact, the main object of the statement of the grounds of the notice of opposition according to Rule 55(c) EPC to define the legal and factual framework of the opposition (see G 9/91 and G 10/91, OJ 1993, 408 and 420) could not be achieved if it was left to the Proprietor of the patent and to the Opposition Division to guess or speculate what objections the Opponent might have had in mind.

- 2.3 Consequently, there was no indication that an objection relating to the opposition ground of added subject-matter (Article 100(c) EPC) was raised before the end of the opposition period, and it will therefore have to be determined whether the Opposition Division exercised its discretion according to the right principles when deciding not to admit this late-filed ground into the proceedings.

It follows from the substantial body of case law developed with regard to this question (see "Case Law", 4th edition, pages 327 to 332) that an essential condition to be met is whether the late submission was relevant or not. The Opposition Division considered this condition in points 5 and 5.1 of the decision under appeal, referring to the disclosure in original figures 1 to 8, and came to the conclusion that it was not met. Since the failure to meet an essential condition is sufficient to preclude admission of the late submission into the proceedings, the Board cannot see any incorrect application of the discretion.

- 2.4 Appellant I did not dispute these formal considerations but argued that the conclusion of the Opposition Division was based on an erroneous judgement on the

disclosure of the crucial dimensional relationship between the size of the slots and the corresponding size of the protruding portion in the figures of the original application, mainly because figures 1, 7 and 8 of the original application showed the protruding portions to be in contact with the edges of the slots. This argument must fail for the reason alone that it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the Opposition Division and to decide whether or not it would have exercised such discretion in the same way as the Opposition Division (see Decisions T 640/91 in OJ 1994, 918, section 6.3 of the reasons, and T 986/93 in OJ 1996, 215, sections 2.1 to 2.5 of the reasons). It is noted, however, that the dimensional relation as claimed in claim 1 seems to be clearly and unambiguously derivable from the enlarged views depicted in figures 3 and 4 of the application as filed, showing, at least on one side, a lateral spacing between the protruding portions of the insert and the longitudinally extending edges of the slot. The judgement of the Opposition Division in this respect was, therefore, not erroneous.

2.5 Hence, the ground of opposition under Article 100(c) EPC is not introduced into the proceedings.

3. *Priority*

3.1 Pursuant to Article 87(1) EPC a person who has duly filed in or for any state party to the Paris Convention for the Protection of Industrial Property, an application for a patent or for the representation of a utility model or..., or his successors in title, shall

enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.

From the wording of this provision it is clear that the right to claim priority belongs to the applicant or his successors in title.

3.2 In the case under consideration the European patent application resulting in the patent in suit and the two Italian utility model applications from which priority is claimed were filed by different persons as can be seen from the European patent application in suit and the priority documents. Hence the question of succession in title arises.

3.3 In contrast to what is alleged by the respondent the succession in title must be proven to the satisfaction of the board. It is a general principal of procedural law that any party claiming a right must be able to show that it is entitled to that right (see decision J 19/87). It is true that this question is to be answered in accordance with national law.

3.4 The respondent on the one hand alleged that the applicant of the two Italian utility model applications, Mrs DI BILIO, had assigned these applications in 1987 to the respondent and filed a declaration of Mrs DI BILIO dated 27 April 1988 made before a notary public in which she confirmed this allegation.

On the other hand it follows from document AP6, filed by Appellant I, that three years later the Court of Monza held Mrs DI BILIO to be the owner of the Italian patent No. 209842 which, according to document AP7, is based on the Italian utility model application No. 20563B/87, namely the first priority document.

So the board is confronted with two pieces of evidence which would appear to be mutually exclusive. The explanation of the respondent that, according to Italian law, Mrs DI BILIO would remain the registered owner even after assignment of all the rights is neither confirmed by document AP6 where the Court of Monza does not distinguish between "registered owner" and any other owner, nor by document AP13 (AP13') where the same court, in contrast to the respondent's allegation, points to the fact that there was not any evidence of the relationship which would link Mrs DI BILIO to the different owner of the European patent GIAT.

- 3.5 The documents AP6 together with AP7 and AP13 weigh too heavily to be left aside with regard to the declaration of Mrs DI BILIO. Therefore, the Board comes to the conclusion that the respondent has failed to prove that it is the successor in title of the two Italian utility model applications from which it claims priority and which were filed by Mrs DI BILIO. Consequently no priority rights exist for the patent in suit.

4. *Further prior use*

4.1 As a consequence of the lack of priority rights, the state of the art will comprise anything made available to the public before the filing date of 20 January 1988 (Articles 89 and 54(2) EPC).

4.2 Appellant I argues that an alleged prior use occurred before the filing date by its, Appellant's I, sale of gaskets to MERLONI, as proven by evidence AP4 including various invoices and the drawings mentioned therein.

4.3 According to these invoices "Guarn Sil Marr C 072 4" and "Guarn Sil Grigio C 072" were sold in quantities of 180 (invoice 678) to 2000 (invoice 1220) from Appellant I to MERLONI Elet.ci s.p.a. between 9 July 1987 (invoice 678) and 18 December 1987 (invoice 1220). Obviously, the description "Guarn" is an abbreviation for "guarnizione" which is the Italian word for gasket. This is confirmed by the reference, in the description of the gasket on the invoices, to "Cd 144000855" for a 4-sided gasket and "Cd 144000856" for a 3-sided gasket, the numbers being written in the field "Codice" as drawing numbers on corresponding drawings included in AP4 for 4-sided ("Nuova Guarnizione p.f. 4 Lati Completa") and 3-sided ("Nuova Guarnizione p.f. 3 Lati Completa") gaskets. On the basis of this evidence it can, therefore, be concluded that gaskets as shown in the drawings Nos. 144000855 and 144000856 have been sold by Appellant I to MERLONI before the filing date of the patent in suit.

4.4 The Respondent alleges that the details of the gasket, in particular the inserts, the slots in the profile and the relation of the size of the protruding portion of the inserts to the size of the slots in the profile, as claimed in claim 1 of the patent in suit, cannot be derived from the drawings. This argument does not take due account of the tables included at the bottom center of the drawings, the tables referring to positions 1, 2 and 3 marked in the drawing.

Position 1 marks the gasket itself, ie the elastic profile, and the tables contain the corresponding reference to "Nuova Guarnizione" having code or drawing Nos. 14400085901 and 14400086001. The corresponding drawings numbers 144000859 and 144000860 (the first modification expressed by the missing digits "01" is mentioned as "Modificate dimensioni..." in the text field of the drawings) included in AP4 show the elastic profiles having either two (for the 3-sided gasket" or three (for the 4-sided gasket) slots ("asola") where the material of the profile is removed, the slots having a length of 10 mm and a width of 4 mm (derivable from the radius of 2 mm for the rounded ends). The 4-sided gasket is formed of a single piece of the tubular profile shown in the cross-sectional view A-A of drawing No. 144000859 (it is evident that this drawing of the 4-sided gasket, rather than drawing 144000860 of the 3-sided gasket, is meant in the table of drawing 144000855 showing the 4-sided gasket), having an inner longitudinal cavity and a frontally protruding peripheral flange, by bending the profile at the corners (positions 2 and 3) and connecting the ends at the lower left corner of drawing 144000855 marked as joint ("Punto di giunzione della guarnizione").

Position 3 marks corners of the gaskets and the tables contain the corresponding reference to "Innesto Metal per Fis. Guarnizione" having code or drawing No. 14000086300. A metallic insert for mounting the gasket is shown on corresponding drawing No. 140000863.00. It is made of sheet metal having a thickness of 1 mm and the protruding portion is formed of a tongue of the insert which is bent to project 7 mm from the plane of the insert. The width of the protruding portion is 2 mm and its thickness corresponds to that of the sheet metal, ie 1 mm.

The Respondent has pointed out that the slots are not shown in the cross-section views A-A on figures 144000859 and 144000860 and that, therefore, their exact shape and position cannot be determined. It should, however, be borne in mind that the inserts are said to be, on drawings 144000855, 144000856 and 140000863, for mounting the gasket ("per fissaggio guarnizione") at the corner positions shown in drawings 144000859 and 144000860, wherefrom it can be concluded that the slots are formed in the rear portion of the gasket opposite to the front side having a projecting flange, and that the protruding portions of the insert extend through the corresponding slots for mounting the gasket when positioning the inserts as shown in figures 144000855 and 144000856. In this mounting position the size of the inserts in a plane transverse to the longitudinal axis of the tubular profile corresponds to its thickness, ie 1 mm, which is less than the corresponding size of the slot, which is the width of 4 mm, whereby at least one edge of the slot will be out

of contact with the protruding portions, as defined in claim 1 of the patent under appeal.

A further argument of the Respondent refers to an alleged inconsistency between the drawing date and the modification date on drawings 144000859 and 144000860. This argument is, however, not convincing because the modification date on these drawings is 27 November 1986 which is after the drawing date of 8 October 1986. The extension number "01" used in the tables of drawings 144000855 and 144000856 obviously refers to this first modification.

The Board has, therefore, no doubts that the sale of Appellant I to MERLONI concerned gaskets as defined in claim 1 of the patent in suit.

- 4.5 The invoices of Appellant I include, in addition to the description of the sold gaskets, the quantity ("quantità") and price ("prezzo") of each gasket sold as well as the total sum to be paid ("totale fattura"). Further, the date of delivery is noted in the field "bolla di consegna". For example, invoice No. 678 of 9 September 1987 refers to 80 4-sided gaskets for Lit 1.620 each and 100 3-sided gaskets for Lit 1.130 each, making a total amount of Lit 286.268 including tax ("imposta") to be paid, delivered on 7 July 1987. These indications make it clear that the delivery and sale was under commercial conditions, excluding any potential secrecy or confidentiality agreements which may have existed when developing the gaskets. Thus, the sales have to be considered as making the sold gaskets available to the public.

The Respondent argues that the sale of the gaskets according to the invoices occurred in breach of the confidentiality agreed between the parties, being due to an evident abuse in relation to the Respondent, and could not, therefore, be taken into account as prior art pursuant to Article 55(1) EPC. This argument must fail, irrespective of whether or not there was a corresponding agreement on confidentiality between the Respondent and either MERLONI or Appellant I which might have been broken by the sales, for the reason alone that part of the sales occurred outside of the time period allowed for in Article 55(1) EPC.

In fact, Article 55(1) EPC excludes from the prior art disclosures occurring due to an evident abuse in relation to the applicant or his legal predecessor no earlier than six months preceding the filing of the European patent application. In consolidated cases G 3/98 (OJ 2001, 62) and G 2/99 (OJ 2001, 83) the Enlarged Board ruled that for calculating this six-month period the relevant date is that of the actual filing of the European patent application, not the priority date. Thus, in the present case this period starts on 20 July 1987 which is six months before the filing date of 20 January 1988. The first sale of the gaskets, however, is established by the invoice 678 dated 9 July 1987 as having occurred on 7 July 1987 by delivery of 80 4-sided gaskets and 100 3-sided gaskets. Thus, this first sale occurred before the start of the six-month period defined in Article 55(1) EPC and cannot be excluded from consideration.

4.6 It is concluded that gaskets as claimed in claim 1 were part of the prior art to be considered when assessing novelty of the subject-matter of that claim and that claim 1 lacks novelty. The patent cannot, therefore, be maintained.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

A. Counillon

C. T. Wilson