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D E C I S I O N
of 30 March 2000

Case Number: T 0151/97 - 3.2.4

Application Number: 90917334.6

Publication Number: 0500729

IPC: A47F 5/08

Language of the proceedings: EN

Title of invention:
A display or sales shelf for use in shelf systems

Patentee:
EXPEDIT A/S

Opponent:
Ingenieurbüro Lebling

Headword:
-

Relevant legal provisions:
EPC Art. 84, 123, 54, 56, 104(1)

Keyword:
"Main request (Introduction of a new dependent claim: refused)"
"Auxiliary request (novelty and inventive step: yes)"
"Apportionment of costs (refused)"

Decisions cited:
T 0295/87, T 0155/88, T 0829/93, T 0169/83, T 0523/88, T 0308/90, T 0372/90

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0151/97 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 30 March 2000

Appellant: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 6 December 1996 revoking European patent No. 0 500 729 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: C. A. J. Andries
Members: R. E. Gryc
M. Lewenton

Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal, received at the EPO on 5 February 1997, against the opposition division's decision revoking European patent No. 500 729 notified by post on 6 December 1996.

The appeal fee was paid simultaneously and the statement setting out the grounds of appeal was filed on 7 April 1997.

II. An opposition was filed requesting revocation of the patent as a whole on the basis of Article 100(a) EPC. The opposition division held that the subject-matter of Claim 1 as granted lacked an inventive step (Article 56 EPC) having regard to the combined teachings of documents:

D6: DE-A-2 311 069 and

D8: DE-U-76 31 838.

During the proceedings the following documents were also cited:

D1: SE-B-330 322

D4: US-A-3 993 002

D5: US-A-4 760 930 and

D9: US-A-2 891 678.

III. With the statement setting out the grounds of appeal, the appellant filed a new set of four claims comprising

an amended Claim 1 and a completely new Claim 4. The appellant acknowledged that, in so far as a single wire according to D8 is usable for holding a sign plate, already one such wire as in D6 at both the front and the rear wall member will be operable to receive the sign plate. He pointed however out that this was not taught in either of the documents.

He contended moreover that the citations have no bearing on the provision of specialized sign holder means both at the front and at the rear. In his opinion, the shelf according to the invention should be clearly designed to have a sign carrier also at the "rear wall" since, in order to display the signs in a presentable manner, the "rear wall" itself is shaped so that the relevant sign carrier portion is oriented otherwise than just perpendicularly to the shelf bottom.

With his reply, the respondent (opponent) filed a new document DE-A-2 728 477 (D11) and contended that still neither the structure of the holding means nor the structure of the plate members were specified in the new Claim 1 and that several features of said claim were either unclear or not supported by the description as originally filed. He argued also that all the features of Claim 1 were already known from D6 except for two characteristics (i.e. those according to which the edge portion should be "located so as to face forwardly and upwardly" and the strip shaped wall portion should be "bent out") which, according to him, can be learned from D11. In his opinion, a combination of the teachings of D6 and D11 makes the subject-matter of Claim 1 obvious.

IV. By a faxed communication dated 22 June 1998, the Board informed the appellant that Claim 4 of the set of claims filed with the statements of grounds was not allowable according to the established boards of appeal case law which refuses a new claim (i.e. new dependent Claim 4) whose subject-matter has not previously been claimed as such.

In reply, the appellant filed an auxiliary request but did not abandon the set of claims objected to which remained as the basis for the main request.

V. Oral proceedings took place on 26 June 1998.

Although duly summoned, the appellant did not appear. In accordance with the provisions of Rule 71(2) EPC the proceedings were continued without him.

The unallowability of the claims filed with the statement setting out the grounds of appeal was confirmed and the claims of the auxiliary request filed with appellant's letter of 23 June 1998 were examined and their patentability discussed.

During the discussion, the respondent brought additional and more precise arguments against clarity (Article 84 EPC) of some amendments made in auxiliary Claim 1 compared to Claim 1 as granted and he contended that such a lack of clarity resulted in lack of support in the application as originally filed, contravening thereof the requirements of Article 123(2) EPC.

The respondent acknowledged that the subject-matter of auxiliary Claim 1 was novel and he considered that the state of the art closest to the invention was disclosed

in D6. Starting from said closest state of the art, he contested however that the claimed solution could involve an inventive step in view of the teaching of D11 which, in his opinion, gave the skilled person several hints in direction to the invention. Furthermore, he contended that it was common general knowledge of the skilled person to orient the holding means and the price plates conveniently so that the prices were visible. According to him, it was thus obvious for the skilled person to arrange the back and the front of the shelf in a similar way and to prolong the vertical part of the upstanding wall with a generally inclined horizontally extending wall portion as suggested in D11.

After having closely examined and discussed the inventive step of the subject-matter of auxiliary Claim 1 compared to a possible combination of the teachings of D6 and D11, the Board was of the provisional opinion that the shelf as claimed could be patentable provided that some major objections as regards the requirements of Articles 84 and 123 EPC were removed. Exceptionally, the Board decided therefore to continue the proceedings in writing.

VI. In reply to several subsequent communications of the Board concerning in particular the interpretation to be given to the expression "corresponding to" of Claim 1 of the auxiliary request, the appellant acknowledged that he had nothing against the replacing expression "identical with" proposed by the respondent but that it was "just superfluous to reintroduce it" (see appellant's letter of 3 September 1999 , page 1, paragraphs 3 and 4). Finally, with his letter dated 26 October 1999, the appellant filed a new auxiliary

request comprising amended Claims 1 and 2, Claim 3 as granted and a modified description.

VII. The respondent replied that the claims of the auxiliary request still do not clarify the meaning of the disputed expression "corresponding to" and do not give a clear indication that the holding means (16) consist of two parallel wires as the other holding means of the shelf. Therefore, according to the respondent, due to the lack of clarity of the claims and to the statement of the last sentence of the description according to which the shelves may be shaped accordingly of a coherent plate material, the scope of protection of the patent was not clearly determined in contravention of Article 84 EPC.

He contended moreover that nowhere in the application as originally filed is it disclosed that the upstanding wall portion of the shelf "is shaped with a generally inclined, horizontally extending wall portion" as claimed in the new auxiliary Claim 1 so that the claims of the auxiliary request contravene Article 123(2) EPC.

The respondent also alleged that the costs involved by the continuation of the proceedings in writing which resulted from the non-appearance of the appellant at the oral proceedings were "incurred in oral proceedings" in the meaning of Article 104(1) EPC and he requested a different apportionment of said costs.

VIII. The following requests have been taken into consideration by the Board:

from the appellant: that the decision under appeal be set aside and the patent be maintained either on the

basis of Claims 1 to 4 submitted with the statement setting out the grounds of appeal (main request) or on the basis of Claims 1 to 3 filed with appellant's letter of 26 October 1999 (auxiliary request).

from the respondent: that the appeal be dismissed and an apportionment of costs be made in application of Article 104(1) EPC.

IX. Claim 1 of the auxiliary request filed with letter of 26 October 1999 reads as follows:

"A display or sales shelf for use in shelf systems of the type having carrier means for carrying the shelves optionally in a horizontal position or a forwardly and downwardly inclined position, the shelf having an upstanding wall portion (10) along one longitudinal edge thereof and being mountable on said carrier means with this wall portion forming a rear wall when the shelf is horizontal and a front wall when the shelf is mounted in its inclined position, said shelf, preferably a wire shelf, being of the type having along its opposite longitudinal edge a preferably obliquely bent-down or bent-up edge portion, which is provided with holding means for the holding of loose, exchangeable price or information plate members (12) and is located so as to face forwardly and upwardly, said holding means consisting of two inter-spaced, parallel wires (8), characterized in that the said upstanding wall portion (10), preferably along its upper edge area, is shaped with a generally inclined, horizontally extending wall portion having at its outer side holding means (16) corresponding to the said holding means consisting of two inter-spaced parallel wires (8), thus enabling the plate members to be

mounted facing forwardly and upwardly in either mounting position of the shelf."

Reasons for the Decision

1. *Admissibility*

The appeal is admissible.

2. *Main request*

As already stated in the Board's communication faxed to the parties on 22 June 1998, the addition to the granted claims of a new dependent Claim 4, the subject-matter of which has not previously been claimed as such, is considered in the light of the grounds submitted for the opposition to be neither appropriate nor necessary to the maintenance of the patent and is therefore not permitted even though the subject-matter of said additional claim has a counterpart in the application as originally filed.

Consequently, in line with the established boards of appeal case law (see in particular the published decision T 295/87 - OJ EPO 1990, 470 and also the unpublished decisions T 155/88 and T 829/93), the completely new dependent Claim 4 and thus the corresponding set of claims filed with the statement setting out the grounds of appeal are not allowable. Therefore, the main request which is based on said unallowable set of claims is refused.

3. *Auxiliary request (filed with letter of 26 October 1999)*

3.1 Amendments (Articles 84 and 123 EPC)

3.1.1 With respect to Claim 1 as granted (see the patent specification, column 3), the following amendments have been made:

- in line 19: the expression: "means for the holding of" has been replaced by: "holding means for the holding of" which does not change the content of the claim.

- in line 20, between the expressions: "plate members (12)" and "characterized in that", the following phrase has been inserted: "and is located so as to face forwardly and upwardly, said holding means consisting of two inter-spaced, parallel wires (8)"

It should be recalled that, in the course of opposition proceedings followed by an appeal, the subject-matter for which protection is sought can be further defined also by specific features disclosed only in the drawings of the opposed patent provided that these features are clearly derivable by a skilled person from said drawings (see for example decision T 169/83, OJ EPO 1985, 193 and unpublished decisions T 523/88, T 308/90 and T 372/90).

In the present case, it appears clearly from Figures 1 and 2 of the application as originally filed that, along its longitudinal edge opposite the upstanding wall portion (10), the shelf according to the invention has either a bent-down portion (Figures 1 and 2) or a bent-up portion (Figures 2 - dotted lines) facing forwardly and upwardly and provided with two parallel

wires (8) for the holding of plate members. Therefore, the above-mentioned insertion is supported by the drawings of the application as originally filed and restricts the protection of the claim (Articles 123(2) and (3) EPC).

- from line 21 to line 23, the following phrase:

  "the outside of said upstanding wall portion (10),..., is provided with holding means (16)" has been replaced by the following:

  "the said upstanding wall portion (10),..., is shaped with a generally inclined, horizontally extending wall portion having at its outer side holding means (16)"

These features are clearly represented on all the Figures 1 to 3 of the application as originally filed and their incorporation into Claim 1 also restricts the scope of the claim.

- from line 24 to line 26, the following phrase:

  "corresponding to the said plate member holding means (8) on the opposed edge portion of the shelf" has also been replaced by the following:

  "corresponding to the said holding means consisting of two inter-spaced parallel wires (8), thus enabling the plate members to be mounted facing forwardly and upwardly in either mounting position of the shelf."

It is clear, in particular from Figure 1 of the

application as originally filed, that "the plate member holding means (8)", which is defined in Claim 1 as granted as being located on the edge portion of the shelf opposed to the upstanding wall portion (10) (see line 25 of column 3 of the patent), is the same holding means as the one consisting of two inter-spaced parallel wires (8) recited in the preamble of Claim 1 of the auxiliary request. It is also clear from the figures that, with the structure claimed in Claim 1, the plate members can be mounted facing forwardly and upwardly in either mounting position of the shelf (see also the description of the patent, column 1, lines 49 to 51).

This modification, consisting merely in replacing a term by its own definition given in the description and in clarifying the result obtained by using such a structure, does not change the content of the claim. Since, moreover, to specify the structure of the holding means necessarily restricts the scope of the claim, the Board cannot agree with the argumentation of the opponent according to which such a modification would extend the protection conferred by the claim.

Therefore, the modifications made in Claim 1 of the auxiliary request fulfill the requirements of Articles 84 and 123(2) and (3) EPC and are allowable.

3.1.2 As regards the last paragraph of the description of the auxiliary request (which indicates that the shelves may be shaped of a coherent plate material), the deletion of which is requested by the respondent, it must be pointed out that the shelf according to Claim 1 is not limited to a wire shelf (in Claim 1, it is only stated: "preferably a wire shelf") and only each of its holding

means is described as consisting of two inter-spaced, parallel wires.

Therefore, the said last paragraph of the description is consistent with Claim 1 and no deletion is needed.

3.2 Interpretation of Claim 1

Clarity being not a ground for opposition, the proprietor of a patent cannot be forced to replace a general expression of a granted claim (such as the expression "corresponding to" of Claim 1 as granted - see column 3, line 24 of the patent) by a more precise and specific one. Moreover, to delete or to replace expressions of a granted claim always involves a risk of infringing the requirements of Article 123(3) EPC.

Therefore, in this specific case, the Board has decided that the general expression "corresponding to" in the granted Claim 1 need not be deleted but just interpreted in the light of the description (Article 69 EPC).

In Claim 1 of the opposed patent, both the means (8) and (16) were defined solely functionally as "holding means", without any specific structural feature being described.

In the description, the only passage (see column 2, lines 35 to 39) supporting the general expression "corresponding to" relates to identical holding structures, as clearly shown on Figures 1 to 3 , and no indication can be found according to which said holding structures could possibly be different from each other. Therefore, the said expression "corresponding to" can

solely be interpreted validly as signifying "identical with".

In this connection, it has to be emphasized that the appellant himself acknowledged and accepted this interpretation in his letters dated respectively 23 June 1998 (see page 1, last sentence) and 3 September 1999 (see page 1, paragraphs 2 and 3).

3.3 Novelty (Article 54 EPC)

The board is satisfied that none of the cited documents discloses a display or sales shelf incorporating in combination all the features described in Claim 1.

Since this has also been acknowledged by the respondent during the oral proceedings, there is no need for further detailed substantiation.

The subject-matter as set forth in Claim 1 is thus new within the meaning of Article 54 EPC.

3.4 The closest state of the art

In agreement with the respondent, the Board considers that the state of the art closest to the invention can be found in D6 which describes a shelving assembly of the type having carrier means for carrying the shelves optionally in a horizontal position or in a forwardly and downwardly inclined position, said shelves comprising most of the features of the pre-characterising portion of Claim 1 including the provision of parallel wires which can be used for the holding of loose, exchangeable information plate members located so as to face forwardly.

The subject-matter of Claim 1 differs from this closest state of the art in that:

- the bent-down edge portion is located so as to face not only forwardly but also upwardly,

- the upstanding wall portion opposite the bent-down edge portion is shaped with a generally inclined, horizontally extending wall portion having, at its outer side, holding means corresponding to (i.e. identical to - see section 3.2 above) the holding means provided on the bent-down edge portion of the shelf,

- the inclined horizontally extending wall portion and the bent-down edge portion allow the plate members to be mounted on said portions to face upwardly in either mounting position of the shelf.

3.5 Problem and solution

Starting from the aforementioned closest state of the art and taking into account the above-mentioned differences, the Board sees the problem as being to improve the shelf known from D6 so that the price or information markings may be arranged in the same systematic manner, whether the shelf be oriented one way or the other (see the patent specification: column 1, lines 49 to 51).

The Board is satisfied that the invention as claimed in Claim 1 brings effectively a solution to this problem.

3.6 Inventive step (Article 56 EPC)

3.6.1 D6 discloses a wire basket for shelving assemblies which can be carried optionally in a horizontal or an inclined position and turned all around from front to back (see D6: page 3, lines 32 to 36), however the use of information plate members is even not suggested, let alone the provision of means for the holding of such plate members both at the front and at the back of the basket and also the particular disposition of said holding means in relation with the mounting position of the basket.

Consequently the problem of having a shelf allowing the arrangement of the information markings in the same systematic manner, whether the shelf be oriented one way or the other, is not envisaged in D6 and the skilled person cannot expect to find therein a clue about a possible solution to such a problem.

It should be emphasized that, although the two inter-spaced parallel wires (12) of the basket of D6 could be used for holding information plates members as according to the wires (8) of the claimed shelf, the function of the wires (12) of D6 is to retain the separate front wall member (14) to the base member (1) and, since said wall member should normally be mounted perpendicular to the base member as according to the other closure walls of the basket, the skilled person has a priori no reason to incline the end portion of the transverse wires (11) so that the edge area of the bottom of the basket would be facing forwardly and upwardly.

Also, D6 neither suggests to shape the upper edge area of the wall portion (3) opposite to the edge area of the bottom so that said upper edge area faces forwardly

and upwardly when the shelf is turned all around from front to back, nor to provide the outer side of said upper edge area with holding means, let alone with holding means identical to those provided on the bent-down edge area of the bottom of the basket.

3.6.2 D11 discloses a display shelf of synthetic material having an upstanding wall portion (1a) along one longitudinal edge thereof and, along its opposite longitudinal edge, an obliquely bent-down edge portion located to face forwardly and upwardly. However, the shelf known from D11 cannot be carried optionally in a horizontal or an inclined position or turned all around from front to back and its rear upstanding wall portion (1a) is not shaped with a generally inclined, horizontally extending wall portion. Moreover, no holding means are provided at the outer side of said upstanding wall portion (1a) to enable any information means to face forwardly and upwardly in the reverse position of the shelf.

Therefore, at first, it seems doubtful that a skilled person searching to improve a reversible basket made of wires according to D6 would consult a document like D11 relating to a non-reversible shelf made of plastic. Assuming on the other hand that he were to do this, he would learn from D11 to display information or an advertisement in front of both the obliquely bent-down edge portion and the upstanding wall portion i.e. only on the front side of the shelf and not respectively on the front and the back side of the shelf as with the shelf according to the invention.

Therefore, even by combining the teachings of D6 and D11, the skilled person would not arrive at the basic

idea of the invention that consists in designing the outside of the opposite longitudinal edges of a reversible display or sales shelf such that it may receive identical sign plates arranged in the same systematic manner, whether the shelf be oriented one way or the other.

3.6.3 As regard the other documents cited during the proceedings, the following should be put forward:

- D1 and D8 do not concern shelves as such but loose, exchangeable price or information plate members provided with means holdingly engageable over the wires of a wire shelf. Therefore these documents do not suggest any of the features distinguishing the shelf claimed in Claim 1 from the shelf of D6.

- D4 and D5 do disclose display or sales shelves but the shelf of D4 is not conceived to be carried optionally in a horizontal or in an inclined position and none of these known shelves is designed for being optionally reversed from front to back, the idea that the shelves might eventually be reversed being even not envisaged anyway.

- D9 relates to a display shelf which can be changed as to its angle by reversing the position of the assembly, front to back, with respect with the upright foundation. Since no holding means for prices or information plate members are provided on this known shelf, a combination of the teaching of D9 with the teaching of D6 would not permit an improvement of the shelf of D6 as to the display

of information, and the skilled person would have a priori no reason and would not be inclined to modify the structure of the shelf of D6 so as to render it more complicated since the principal object of the teaching of D9 is in particular to provide a "relatively inexpensive" support assembly (see D9: column 1, lines 57 to 59) having a structure "ideally suitable for use in stores and the like where...economy is sought" (see D9: column 2, lines 13 to 17).

3.6.4 Therefore, the skilled person would not find in any of the above mentioned documents an indication or even a clue about the manner the shelf known from D6 could be modified in order to solve the problem described in section 3.5.

4. *Conclusion*

For the foregoing reasons, the Board considers that to improve the display shelf of D6 according to the teaching of Claim 1 of the auxiliary request filed with letter of 26 October 1999 does not follow plainly and logically from the cited prior art. Therefore, the reasons given by the respondent did not prejudice the maintenance of the patent in the version of the said auxiliary request.

5. *Apportionment of costs (Article 104(1) EPC)*

The "apportionment of costs" referred to in Article 104(1) EPC concerns in particular the costs incurred "in oral proceedings" i.e. the costs resulting from attending oral proceedings and not the costs generated by a decision taken during oral proceedings.

Moreover, the Board does not see any reason of equity to order a different apportionment of cost as usual (i.e. each party meets the costs he has incurred), all the more since the decision to continue the proceedings in writing was taken by the Board in order to overcome objections under Articles 84 and 123 EPC made by the respondent himself against the new set of claims. Consequently, the respondent's request of apportionment of costs must be refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance with the order to maintain the patent in the following version:

Claims: 1 to 3 filed with letter of 26 October 1999,

Description: pages 1 to 3 filed with letter of 26 October 1999, and

Figures: 1 to 3 of the drawings as granted.

3. The respondent's request for apportionment of costs is refused.

The Registrar The Chairman:

G. Magouliotis C. Andries