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D E C I S I O N
of 4 July 2000

Case Number: T 1070/98 - 3.2.1
Application Number: 93201252.9
Publication Number: 0569089
IPC: B65D 5/42, B65D 75/56

Language of the proceedings: EN

Title of invention:
Folded box with suspension means

Patentee:
Aarts, Mathieu

Opponent:
(OI) Cosack GmbH & Co. KG Druck und Verpackung
(OII) Werner Freiburg GmbH & Co. KG

Headword:
-

Relevant legal provisions:
EPC Art. 54(2), 111(2), 117

Keyword:
"Alleged prior use - not sufficiently substantiated"
"Remittal for further prosecution"
"Taking of evidence"

Decisions cited:
-

Catchword:
-



Case Number: T 1070/98 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 4 July 2000

Appellant: Aarts, Mathieu
(Proprietor of the patent) Chrysantenstraat 15
NL-6214 SX Maastricht (NL)

Representative: Vollebregt, Cornelis Jacobus, Ir.
Algemeen Octrooibureau
World Trade Center
P.O. Box 645
NL-5600 AP Eindhoven (NL)

Respondents: Cosack GmbH & Co. KG Druck und Verpackung
(Opponent OI) von-Siemens-Str. 14
D-59757 Arnsberg (DE)

Representative: Fritz, Edmund Lothar, Dipl.-Chem.
Patentanwaltskanzlei Fritz
Ostentor 9
D-59757 Arnsberg-Herdringen (DE)

(Opponent OII) Werner, Freiburg GmbH & Co. KG
Blumenstr. 31-33
D-57413 Finnentrop (DE)

Representative: Ostriga, Harald, Dipl.-Ing.
Patentanwälte Ostriga & Sonnet
Postfach 20 16 53
D-42216 Wuppertal (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 10 September 1998
revoking European patent No. 0 569 089 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: F. A. Gumbel
Members: S. Crane
J. H. van Moer

Summary of Facts and Submissions

- I. European patent No. 0 569 089 was granted on 23 August 1995 on the basis of European patent application No. 93 201 252.9. This application claims a priority date of 6 May 1992.

Claim 1 of the granted patent reads as follows:

"A storage box folded from a blank, said storage box being provided with a bottom (12, 13), upright side walls (1, 4, 5, 6) and a cover (19) integrally formed with one of the side walls (1) at the upper edge (18) of said side walls (1), whereby aligned passages (33, 34) are provided near the upper edges of two opposite side walls (1, 6), the aligned passages (33, 34) being located below the level of the cover (19), characterised in that one of the side walls (6) at its upper edge has been provided with an extension (27, 29, 31) which has parts (27, 31) which are folded against the inner sides at two opposite side walls (1, 6) and another part (29) which extends between said two opposite side walls (1, 6) beneath the level of the passages (33, 34)"

Dependent claims 2 to 6 relate to preferred embodiments of the storage box according to claim 1, claim 7 to a blank for folding into a storage box according to any one of claims 1 to 6.

- II. The granted patent was opposed by the present respondents (opponents OI and OII) on the ground that its subject-matter lacked novelty and/or inventive step (Article 100(a) EPC).

In their notice of opposition opponents OI relied **inter alia** on the public prior use of storage boxes designated "VK 050", "VK 060" and "VK 070" allegedly supplied by opponents OII to the company Briloner Leuchten before the priority date of the contested patent. They supplied samples of the storage boxes allegedly involved.

Opponents OII, in addition to the supply by themselves of storage boxes to the company Briloner Leuchten, also relied **inter alia** on the public prior use of five different sample storage boxes supplied by themselves to the company Wortmann & Filz ("WOFI") on 4 May 1992. Amongst the pieces of evidence filed by them in the course of the opposition proceedings to support their allegation of prior use were the following documents: a report of a meeting on 16 April 1992 between representatives of opponents OII and WOFI at which a design for a storage box was discussed (henceforth designated document D7); jobcard A230492 (document D8); delivery note 1576 dated 4 May 1992 (document D9); and unsworn solemn declarations ("eidesstattliche Versicherungen") of two employees of opponents OII, Messrs Josef Rauterkus and Burkhard Vente (documents D12, D13 and D14).

III. With its decision posted on 10 September 1998 the Opposition Division revoked the patent. In the reasons given for the decision it was held that the available evidence convincingly proved that the sample storage box No. A230492 delivered to WOFI on 4 May 1992 was made up from a blank as shown in the corresponding jobcard (ie document D8) and consequently exhibited all of the features of granted claim 1; furthermore this storage box was handed over to WOFI without there being

either an explicit or implicit agreement of confidentiality, so that the storage box had become part of the state of the art by public prior use; accordingly the subject-matter of granted claim 1 lacked novelty.

IV. An appeal against this decision was filed on 6 November 1998 and the fee for appeal paid at the same time. The statement of grounds of appeal, together with extensive annexes and models of various forms of storage box was filed on 8 January 1999.

V. With a counterstatement received on 19 July 1999 Opponents OII also submitted a number of new documents including jobcards Nos. D290492L, B220492, G270492 and D270492 (documents B5 to B8) which allegedly showed the blanks from which the other four types of sample storage box delivered to WOF1 on 4 May 1992 were constructed.

With a further letter received on 3 June 2000 they submitted an unsworn solemn declaration of Mr Hubert Wortmann, the managing director of WOFI, concerning the sample storage boxes delivered to his company on 4 May 1992.

VI. Oral proceedings before the Board were held on 4 July 2000.

The main request of the appellant (proprietor of the patent) was that the decision under appeal be set aside and the patent maintained as granted. In the alternative he requested that the case be remitted to the Opposition Division for further prosecution, in particular to enable the witnesses to be heard (first

auxiliary request) or that the Board request the competent German court to hear the witnesses under oath (second auxiliary request).

The respondents requested that the appeal be dismissed and the decision to revoke the patent confirmed.

VII. The main line of argument of the appellant was that, on the assumption that sample storage boxes listed in document D9 had in fact been delivered on 4 May 1992, then these were not made up from blanks as shown in the corresponding jobcards D7 and B5 to B8. What those jobcards in fact showed were subsequent developments of the blanks involved which were not made until after the priority date of the contested patent. It had to be remembered in this respect that the jobcards presented as evidence were merely subsequently made print-outs of computer files and it lay in the very nature of such files that they could be modified at will. As could readily be seen from the print-outs of the contents of the April 1992 and June 1992 diskettes of the CAD-system of opponents OII, there was no clear correlation between the numbers indicated on the jobcards and the dates on which the corresponding files were last modified. It could therefore not be safely assumed that the blank shown in document D7 (jobcard "A230492") had actually been designed in this form on 23 April 1992.

The second line of argument was that any storage boxes delivered to WOFI on 4 May 1992 did not in any case belong to the state of the art according to Article 54(2) EPC. WOFI were bound by an implicit agreement of confidentiality, would have had no commercial interest in making a premature disclosure of the new storage boxes to third parties and would not in

fact have been capable of doing so since the storage boxes had actually been immediately returned to opponents OII.

In support of both of the above contentions the appellant submitted at the oral proceedings a facsimile copy of an unsworn solemn declaration of Mr Volker Wortmann, a former employee of WOFI, dated 3 July 2000. The original version of this declaration would be filed subsequently.

The only appropriate way of resolving the inconsistencies and contradictions in the written evidence was to hear the witnesses concerned.

VIII. The respondents disputed that there could be any genuine doubt about the sequence of events in late April and early May 1992. The declarations of Messrs Vente, Rauterkus and Hubert Wortmann were entirely consistent with each other and were corroborated by the documentary evidence. The alleged inconsistencies referred to by the appellant could all be readily explained when proper account was taken of the circumstances involved. In view of the clear evidence on the file it appeared unnecessary to hear the witnesses in person, but if the Board decided that this was the appropriate course of action to take then the respondents would welcome the opportunity to clarify any remaining doubts. Although the Opposition Division had concentrated on the actual delivery of the storage boxes on 4 May 1992, the form of these boxes had however already been established, at least verbally, at the meeting between members of Opponents OII and WOFI on 16 April 1992. Since the latter were not bound by any obligation of

confidentiality then the form of these boxes belonged to the state of the art, by means of oral description, already from that date.

Reasons for the Decision

1. The appeal complies with the formal requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is therefore admissible.

2. It is not in dispute between the parties that a meeting took place on 16 April 1992 at which various representatives of opponents OII and WOFI were present and where the development of a storage box to be supplied to the latter for packaging lamps was discussed. Document D7 is a brief record of the meeting made the same day by Mr Vente.

The appellant has invested considerable effort in trying to demonstrate that the known type of storage box, already being supplied by opponents OII to the company Briloner Leuchten, which formed the starting point for discussions at this meeting was of the form which came to be known during the course of the appeal proceedings as "Box II" (as illustrated in document D18). Opponents OII deny that this was the case and say that the storage box involved was of the type known as "Box I" (also as illustrated in document D18). The main plank in the arguments put forward by the appellant in this context is the fact that opponents OI, in their notice of opposition, supplied samples of storage boxes of the "Box II" type and stated that these had been supplied by opponents OII to Briloner Leuchten in early 1992. This

was subsequently confirmed in an unsworn solemn statement of Mr Peter Braun, an employee of the latter company. Furthermore, Mrs Andrea Freiburg, the managing director of opponents OII had made an equivalent statement in a letter dated 23 September 1994, filed as a third party intervention under Article 115 EPC before the grant of the contested patent. The reason that the appellant sees this issue as being of such crucial importance is that if "Box II" and not "Box I" was the starting point then the actual storage box developed during the meeting was in his view most probably "Box I" itself and not, as alleged, a storage box according to the claimed invention.

On the basis of the available evidence, in particular the documents submitted by opponents OII on 19 July 1999, the Board has no hesitation in concluding that the starting point for the discussions on 16 April 1992 could not have been a "Box II" type storage box since this had not in fact been produced by that date and was a subsequent development of the "Box I" type storage box. The confusion in the mind of the witness of opponents OI undoubtedly arose because both types of storage box were sold to Briloner Leuchten under the same designation namely "VK 050", "VK 060" and "VK 070" and, although the form of the blanks differed, the two types of boxes were virtually visually identical in their assembled state. In this context it is also to be noted that the witness involved was not a packaging expert, but a lamp designer. Similar explanations can be adduced to explain the mistaken assertion in the letter of Mrs Freiburg dated 23 September 1994. What can perhaps be derived from this state of affairs is that it is difficult for someone not intensively involved with the design of cardboard packages to draw

conclusions about the form of the blank from the package in its assembled state. This could be of relevance with respect to the declarations of Messrs Rauterkus and Hubert Wortmann.

3. Although for the reasons discussed above the Board is satisfied as to what constituted the starting point of the deliberations at the meeting of 16 April 1992, the same cannot be said with respect to the end result. Document D7 does indeed include a keyword-style description of the planned design of the new storage box, but this description is not such as to allow the safe conclusion that this box took the form required by present claim 1. In one particular aspect it is however clear that the description contained in document D7 is not consistent with the sample storage boxes allegedly delivered to WOFI on 4 May 1992, namely the statement that both the top and bottom of the box has double tuck-in flaps ("beiders.doppelter Einsteckverschluss"); the boxes allegedly delivered had double tuck-in flaps at the bottom and a single tuck-in flap at the top, cf the delivery note, document D9. Furthermore, there is no clear correlation between the "anhängende gerillte Lasche" at the top of the box, as mentioned in both documents D7 and D9, and the extension referred to in granted claim 1 which has parts folded against two opposite side walls of the box and another part extending therebetween beneath the level of the passages.

Thus for these reasons alone, leaving aside any consideration of whether the participants of WOFI at the meeting on 16 April 1992 would have been implicitly bound to confidentiality or would in any case have had a commercial interest in maintaining secrecy about what

was discussed there, the Board cannot accept the argument of the respondents that by virtue of oral disclosure at this meeting a storage box having all the features specified in granted claim 1 entered the state of the art in accordance with Article 54(2) EPC.

4. On the basis of the arguments presented to it and the available evidence the Opposition Division came to the conclusion that it had been reliably proven that a sample storage box No. A230492, made up from a blank as shown in document D8 (jobcard No. A230492), had been delivered to WOFI on 4 May 1992 and that the delivery was free of any obligation of confidentiality. Such a box exhibited all of the features specified in granted claim 1 (that as such is not in dispute), so that the subject-matter of the claim lacked novelty.

In the course of the appeal proceedings the appellant has however by the introduction of further arguments and evidence succeeded in casting some doubt on the conclusiveness of what was relied upon on the Opposition Division. It has in particular become clear that the numerical part of the jobcard file name, i.e. in the case for example of document D8 "230492", can be freely chosen by the operator of the associated CAD-system and is not necessarily indicative of the fact that the associated design was produced on 23 April 1992. That this is the case became apparent from a consideration of the computer print out of the contents of the April 1992 diskette, attached to the second declaration of Mr Vente (document D14). Here can be found file names "b220592", "d270592", "d290592" and "g270592" all associated with a preparation date of 29 April 1992. Having regard to the similarity of these file names to the designations of the other sample

boxes mentioned in document D9 in addition to A230492, namely "B220492", "D270492", "D290492" and "G270492", there is clearly something here which needs to be adequately explained.

The identity between the form of the sample boxes delivered to WOFI according to document D9 and the blanks shown on the associated jobcards submitted by opponents OII (documents D8 and B5 to B8) has also been called into question by the appellant on the basis of the declaration of Mr Volker Wortmann, who was also present at the meeting of 16 April 1992. According to this declaration a first delivery of sample boxes was made by Mr Rauterkus of opponents OII, these boxes being found however to be unsuitable. It was only after a redesign that suitable sample boxes were delivered. The declaration does not include any precise dates so that in principle at least the second delivery could be that referred to in document D9; in these circumstances it might however have been expected that the two separate deliveries would have been mentioned by Messrs Vente and Rauterkus.

The declaration of Mr Volker Wortmann is also of interest in that it states that the sample boxes of the second delivery, after approval by the representatives of WOFI, were taken away again by Mr Rauterkus. This could have some bearing on the question as to whether the boxes involved should be considered as belonging to the state of the art in accordance with Article 54(2) EPC.

5. Having regard to the above the Board is of the opinion that the proper way to investigate the various questions which have been raised and to resolve the

apparent contradictions in the declarations of the principal witnesses is for those witnesses (Messrs Vente, Rauterkus, Hubert Wortmann and Volker Wortmann) to be heard. In the circumstances it is appropriate that this be done by the Opposition Division rather than the Board itself. Not only will this enable the issues involved to be aired fully before two instances, but it will in addition give the Opposition Division the opportunity, if this should prove necessary, of completing its investigations into the other alleged prior use activities, especially those of Mr Fricke, and in the event that the subject-matter of the patent be held to be novel, of making an evaluation of inventive step.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

S. Fabiani

F. Gumbel