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D E C I S I O N
of 17 May 2000

Case Number: T 0083/99 - 3.2.3
Application Number: 93908219.4
Publication Number: 0712460
IPC: E05B 73/00, E05B 47/00,
G11B 33/00, A47F 7/024

Language of the proceedings: EN

Title of invention:
Safety device for a box

Patentee:
MW TRADING APS

Opponent:
FORS FRANCE

Headword:
-

Relevant legal provisions:
EPC Art. 52, 54, 56, 104, 107, 116

Keyword:
"Novelty (yes)"
"Inventive step (yes)"
"Apportionment of costs (no)"

Decisions cited:
T 0461/88

Catchword:
-



Case Number: T 0083/99 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 17 May 2000

Appellant: FORS FRANCE
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Representative: Breese, Pierre
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Respondent: MW TRADING APS
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Representative: Ström Tore
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 24. November 1998
rejecting the opposition filed against European
patent No. 0 712 460 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: J. du Pouget de Nadaillac
M. K. S. Aúz Castro

Summary of Facts and Submissions

- I. The appeal is directed against the decision dated 24 November 1998 of an opposition division of the EPO, which rejected the opposition filed against the European Patent EP-B1-0 712 460 (based on the international patent application PCT/SE93/00241, i.e. WO 93/19268, and having the priority date of 24 March 1992).

Claim 1 of this patent reads as follows:

"Safety device to be mounted on a parallelepipedic box, comprising a frame (10) constructed to encircle the box and having an insert opening (11) for the box, and a blocking element (13) displaceably and pivotably mounted to the frame, said blocking element being adjustable between a blocking position and an off position to prevent in said blocking position the box inserted into the frame from being withdrawn from the frame, and a latch mechanism with a spring blade (22) retaining the blocking element in the blocking position thereof, which spring blade can be actuated by external means (37) in order to release the blocking element for adjustment to the off position by displacement and pivotal movement, thus allowing the box to be withdrawn from the frame through the insert opening,
characterised in that the spring blade (22) fixedly attached at one end thereof to the frame or the blocking element extends, in the blocking position in the displacement path of the blocking element (13) to engage at the other, free end thereof a shoulder (25) on the blocking element or the frame, respectively, positive engagement being established between the blocking element and the frame in the blocking position

of the blocking element to prevent pivotal movement of the blocking element."

Claims 2 to 6 of the patent are all dependent on at least Claim 1.

II. In the decision under appeal, the opposition division held that the grounds of lack of novelty and lack of inventive step invoked by the opponent against the subject-matter of Claim 1 were not well-founded having regard to the following documents filed during the opposition proceedings:

D1: EP-B-0 620 888 (WO-A-9208026), filed before the priority date of the patent in suit but published after this date and designating the same contracting states as said patent, therefore prior art only under the terms of Article 54(3) and (4) EPC.

D2: FR-A-2 678 907, published after the priority date.

D3: Single page of a copy of a notice of delivery of CD or MC Boxes, dated 17 March 1993, issued by the company "MICROPLAST" and addressed to the opponent.

III. The appeal was lodged on 21 January 1999 with, at the same time, the appeal fee being paid and the statement of grounds being received. In the statement of grounds, the appellant (opponent) filed a new document, namely:

D4: PCT/SE89/00733 of the same patent family as D1, and repeated the arguments put forward during opposition proceedings. Further facts, evidence

and grounds were announced (however, they were never received).

The arguments were the following:

Documents D1 and D4 disclose all the features of Claim 1, since they describe a frame constructed to encircle a parallelepipedic box and comprising a pivotable and displaceable blocking element and a latch mechanism having a blade which can be actuated by external means. This blade extends in the displacement path of the blocking element to engage a shoulder and a positive engagement is established to prevent pivotal movement of the blocking element.

Document D2 also discloses all these features. Indeed, this document was published after the priority date of the contested patent, but boxes according to this document were sold before said priority date, as shown by evidence D3.

- IV. The patentee (respondent) challenged the relevance of these arguments.

- V. In a communication dated 12 December 1999 accompanying the summons to oral proceedings, the board expressed its provisional opinion that the subject-matter of Claim 1 was new vis-a-vis D1 and D4 and, further, involved an inventive step starting from D4. As far as the alleged public prior use according to D2 and D3 was concerned, it did not seem that sufficient evidence had been provided to prove that prior use.

By fax sent on 16 May 2000, the appellant informed the board that, because of another more important

proceedings in France concerning a case in which he was designated to take over the business of a representative who had suddenly died, he would not attend the oral proceedings.

The respondent was immediately contacted by the board, but decided nevertheless to travel in order to participate in the oral proceedings, which took place on 17 May 2000.

VI. In these proceedings, the respondent endorsed the provisional assessment of the board in respect of novelty and inventive step of the subject-matter of the patent and argued with regard to the oral proceedings that his own request for the holding of oral proceedings was conditional. Had the appellant withdrawn his identical request or his appeal, then the oral proceedings could have been avoided. Therefore, an apportionment of costs in favour of the respondent is justified.

VII. The appellant had requested in writing that the decision under appeal be set aside and that the European patent No. 0 712 460 be revoked.

The respondent requested that the appeal be dismissed and that costs be apportioned.

Reasons for the Decision

1. The appeal is admissible.
2. Alleged prior use (evidence D3 in combination with D2).

D2, being published after the priority date and not being a European patent, is not a prior art document according to Article 54 EPC.

In D3, the notice of delivery dated 17 March 1992, that is to say seven days before the claimed priority date of the patent in suit, 300 MC boxes and 300 CD Boxes are merely mentioned without references or any kind of other designation. No prices are given in this notice. Therefore, D3 does not show either which product was really delivered nor for what purpose the delivery itself was made.

More important is the fact that no evidence has been provided by the appellant, showing that the delivered boxes mentioned in D3 correspond to the device disclosed in D2. It follows that the technical teaching of D2 cannot be considered as being part of the prior art according to Article 54(2) EPC by means of D3, as alleged by the appellant. Nothing else proves that the disclosure of D2 was made available to the public before the priority date of the contested patent. Thus, D2 and D3 must be disregarded.

3. *Novelty of the subject-matter of Claim 1*
(Articles 52 and 54 EPC)

3.1 Document D1

Being prior art under Article 54(3)(4) EPC, document D1 according to Article 56 EPC, second sentence, is to be taken into consideration with regard to the novelty of the subject-matter of Claim 1, however not with regard to the inventive step involved by this subject-matter.

At least two features distinguish the safety device according to D1 from the safety device defined by Claim 1 of the patent in suit: from the drawings of D1, it is clear that the spring blade is located above the blocking element, so that, contrary to the wording of said Claim 1, it does not "extend, in blocking position, in the displacement path of the blocking element". Moreover, the free end of this spring blade engages a shoulder of a rotary element, and not, as required by Claim 1, a shoulder on the blocking element, which is clearly distinguishable from the rotary bolt in this prior art.

3.2 Document D4

This document D4, like D1, belongs to the proprietor of the present invention. It is a prior art falling under the terms of Article 54(2) EPC since it was published in June 1990. It discloses a first attempt to provide a safety device for an anti-theft housing (or "frame") for CD cassettes or the like and was then followed by the invention of D1, which is a further improvement. In the safety device according to D4, a rotary bolt is fixed to the frame (or housing) and has a part which, in the blocking position, protrudes into the inside of said frame and engages an opening of a CD cassette inserted in said frame. In this blocking position, a spring blade forming the latch means engages a shoulder of the rotary bolt so that the cassette cannot be withdrawn. Only by means of magnetic forces can the spring blade be disengaged from the rotary bolt, allowing thereby its rotation and consequently the cassette to be withdrawn. In this prior art, the rotary bolt constitutes the blocking element. However, it is only rotatable and not displaceable. Thus, it does not

correspond to the safety device of Claim 1.

3.3 It follows that neither D1 nor D4 anticipates the device according to Claim 1, which is therefore new.

4. *Inventive step (Article 52 and 56 EPC)*

As far as the issue of inventive step is concerned, it also follows from the foregoing that the sole prior art document which can be taken into consideration is D4. As a consequence, it represents the prior art closest to the present invention. A main difference, as seen above, is that in this prior art the blocking element is a rotary bolt, whereas in the present invention, it is a pivotable and displaceable element, more precisely an elongate element formed at one end as a hook, which closes or at least obstructs one end of the insert opening of the frame. In the present invention, moreover, in the blocking position of this element a projection of the frame according to the present invention is received by a recess of the hook and, thus, a positive engagement is provided between the blocking element **and the frame** in order to prevent a pivotal movement of the blocking element. Therefore, the subject-matter of Claim 1 of the patent in suit differs from the prior art according to D4 as mainly described in Point 3.2 above in that:

- the blocking element is displaceably and pivotably mounted to the frame and can be released for adjustment to the off position by displacement and pivotal position,
- the spring blade extends in the blocking position in the displacement path of the blocking element,

and

- positive engagement (other than the engagement on the shoulder realised by the spring blade, known per se by D4) is established between the blocking element and the frame in the blocking position of the blocking element to prevent pivotal movement of the blocking element.

In the absence of any other prior art disclosure, it cannot be seen how a person skilled in the art starting from D4 and wishing to improve the safety device thereof would have reached the subject-matter of Claim 1 of the patent in suit, without any hint towards the new features, that is to say on the sole basis of his common knowledge.

Therefore, the board comes to the conclusion that the subject-matter of Claim 1 involves an inventive step having regard to the cited prior art. Since the dependent Claims 2 to 6 concern further embodiments of the safety device of Claim 1, their subject-matter as a consequence also involves an inventive step.

5. *Request of apportionment of costs*

Article 104(1) EPC states the principle that each party to the proceedings shall meet the costs he has incurred and that a different apportionment of costs incurred during taking of evidence or in oral proceedings can only be ordered for reasons of equity. There is no definition of equity in the EPC. To come to a conclusion in this respect all the details of a case have to be taken into account and evaluated. In general apportionment of costs is justified in cases where

costs arise in whole or in part as a result of the conduct of a party which is not in keeping with the care required in the exercise of its legal rights, or which stems from culpable actions or an irresponsible or even malicious nature (T 461/88, OJ EPO 1993, 295).

In the case under consideration the starting cause, why the appellant's representatives did not attend the oral proceedings, was the death of another representative whose case they were designated to take over. They informed the board and the respondent immediately about the situation and that because of their new engagement they would not attend the oral proceedings. In spite of these circumstances the respondent decided to participate in these proceedings, which the board considered expedient and would have held anyway as it told the respondent upon his telephone inquiry.

Thus, the respondent took the decision to participate in the oral proceedings in knowledge of all the relevant circumstances; the costs for these proceedings were therefore not incurred because of a wrong-doing of the appellant's representative.

The fact that he did not withdraw his request for oral proceedings cannot be held against him. Besides, such a withdrawal would not have altered the situation because the board would have held the oral proceedings anyhow. As is clear from the wording of Article 116(1) EPC a party has an unconditional right to oral proceedings. The effect of such oral proceedings is not only that a case is discussed orally but in the vast majority of cases that also a decision is given on that day, which can be a reason for not withdrawing the request.

Similar considerations apply with regard to the appeal. A party to the proceedings adversely affected by a decision has the right to appeal (Article 107 EPC) and to have its case reviewed by a second instance. If the appellant had withdrawn its appeal, no decision assessing its case would have been issued. Therefore, this also cannot be considered as conduct not in keeping with the care required in the exercise of legal rights.

Thus, the costs incurred in oral proceedings by the respondent were not the consequence of a wrong-doing of the appellant's representative. Therefore, no reason for deviating from the principle that each party to the proceedings shall meet the costs he has incurred, exists.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for apportionment of costs is refused.

The Registrar:

The Chairman:

A. Counillon

C. T. Wilson