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**Datasheet for the decision  
of 14 November 2006**

**Case Number:** T 0986/04 - 3.2.07

**Application Number:** 92202361.9

**Publication Number:** 0526944

**IPC:** B65B 9/06

**Language of the proceedings:** EN

**Title of invention:**

Apparatus for applying adhesive onto a web of packaging material

**Patentee:**

SITMA S.p.A.

**Opponent:**

Buhrs Zaandam B.V.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 54, 56, 84, 100(c), 111(2), 123(2)  
RPBA Art. 10b(1)

**Keyword:**

"Ground asserted with appeal grounds - not admitted"  
"Remittal to hear witnesses - no"  
"Inventive step (second auxiliary request) - yes"  
"Clarity (second auxiliary request) - yes"  
"Slide presentation - allowed only for slides already shown in opposition proceedings"

**Decisions cited:**

T 1116/97, G 0009/91

**Catchword:**

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Case Number: T 0986/04 - 3.2.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.07  
of 14 November 2006

**Appellant:** SITMA S.p.A.  
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**Respondent:** Buhrs Zaandam B.V.  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
6 July 2004 concerning maintenance of European  
patent No. 0526944 in amended form.

**Composition of the Board:**

**Chairman:** H. Meinders  
**Members:** P. O'Reilly  
C. Holtz  
H.-P. Felgenhauer  
E. Lachacinski

## Summary of Facts and Submissions

- I. Opposition was filed against European patent No. 0 526 944 as a whole and based on Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(c) EPC (added subject-matter).

The opposition division held that the subject-matter of claim 1 of each of the main request and the first and second auxiliary requests was novel but did not involve an inventive step.

The opposition division decided to maintain the patent in accordance with the third auxiliary request then on file.

- II. The appellant (proprietor) filed an appeal against the decision of the opposition division.
- III. Oral proceedings were held before the Board on 14 November 2006.
- IV. The appellant requested that the decision under appeal be set aside and the patent be maintained either in accordance with the main request filed with letter of 5 November 2004 or with claim 1 according to the second auxiliary request filed on 14 November 2006 during the oral proceedings and claims 2 to 8 as granted, or on the basis of the third or fourth auxiliary requests filed with letter of 7 November 2006. The first auxiliary request was withdrawn during the oral proceedings before the Board.

The respondent requested that the appeal be dismissed.

V. The independent claim of the main request reads as follows:

"1. An apparatus for applying a pattern of adhesive (25, 30, 41) onto the sealing areas of a continuous web (17) of packaging material in a packaging machine for editorial graphic products (13), the apparatus comprising a frame (11), a first conveyor (16) mounted on said frame for conveying said continuous paper web (17), an unwinding unit (19) for unwinding said web from a roll (18), and with the front end of which there are associated, externally, a second conveyor (14) for feeding products (13) one after one onto said web, and, internally, means for folding said web (17) into a tubular configuration with overlapping longitudinal edges (20), an element (21) for transversally cutting individual sealed packages, a first adhesive application element (22, 40) in the region between said roll (18) and said folding means for dispensing adhesive material in a direction transverse to said web (17) to provide the transverse seals of the package, said first element (22, 40) being operated by sensor means (32) which senses the arrival of each product (13) fed by said second conveyor (14), at said front end there is also provided a second adhesive application element (34) for dispensing adhesive material onto the surface of at least one of said longitudinal edges (20) of said paper web (17) prior to being overlapped with the other longitudinal edge to provide the longitudinal seal of the package, wherein sensor means (35) for controlling the unwinding of the web of packaging material and for timing the dispensing of adhesive material are associated with said second dispensing element (34), and

wherein the element (21) for transversally cutting individual sealed packages is provided downstream of where the transversal seals and longitudinal seal are formed."

The independent claim of the second auxiliary request reads as follows (amendments when compared to claim 1 of the main request are depicted in bold):

"1. An apparatus for applying a pattern of adhesive (25, 30, 41) onto the sealing areas of a continuous web (17) of packaging material in a packaging machine for editorial graphic products (13), the apparatus comprising a frame (11), a first conveyor (16) mounted on said frame for conveying said continuous paper web (17), an unwinding unit (19) for unwinding said web from a roll (18), and with the front end of which there are associated, externally, a second conveyor (14) for feeding products (13) one after one onto said web, and, internally, means for folding said web (17) into a tubular configuration with overlapping longitudinal edges (20), an element (21) for transversally cutting individual sealed packages, a first adhesive application element (22, 40) in the region between said roll (18) and said folding means for dispensing adhesive material in a direction transverse to said web (17) to provide the transverse seals of the package, said first element (22, 40) being operated by sensor means (32) which senses the arrival of each product (13) fed by said second conveyor (14), at said front end, **downstream the feeding of the products (13)** there is also provided a second adhesive application element (34) for dispensing adhesive material onto the surface of at least one of said longitudinal edges (20) of said paper web (17)

prior to being overlapped with the other longitudinal edge to provide the longitudinal seal of the package, wherein sensor means (35) for controlling the unwinding of the web of packaging material and for timing the dispensing of adhesive material are associated with said second dispensing element (34), ~~and~~ wherein the element (21) for transversally cutting individual sealed packages is provided downstream of where the transversal seals and longitudinal seal are formed, **and wherein said first adhesive application element (22, 40) is provided down stream (*sic*) of said roll (18), upstream the feeding of the products (13) on the first conveyor (16); and wherein said first conveyor (16) and said second conveyor (14) move in the same direction, the delivery end of the conveyor (14) being frontally connected to the front end of the first conveyor (16).**"

VI. The documents cited in the present decision are the following:

D7: EP-A-0 018 041

D13: Invoice to Siber Hegner Machinery Ltd dated 24 February 1989.

D14: Invoice to Siber Hegner Machinery Ltd dated 19 April 1989.

D19: US-A-3 593 485

D20a: Translation into English of the testimonies of Messrs Bruinsma and Otten on 14 February 2001 before the District Court of The Hague.

D21a: Translation into English of testimonies of Messrs Endevelt and Tuijn on 28 March 2001 before the District Court of The Hague.

D22: Brochure for Polywrap from Buhrs-Zaandam with March 1990 inscription.

D23: Operators Manual for Polywrap from Buhrs-Zaandam with 3/91 inscription.

D27: Statement from Mr Tuijn, undated in the Dutch language, dated 21 September 2006 in its English translation.

D28: Slide presentation (PowerPoint®) filed by respondent with letter of 25 April 2005.

VII. The arguments of the appellant may be summarised as follows:

- (i) The ground under Article 100(c) EPC should not be admitted into the proceedings. The matter has already been finally decided by the previous Board 3.2.04 in its decision T 1116/99 concerning the same patent. The ground was not decided upon in the present decision under appeal and the appellant does not agree to its admittance into these appeal proceedings. The ground is also filed too late, on 16 October 2006. The respondent did not send a copy of its submission directly to the appellant so that the appellant only received its copy via the Board's communication of 18 October 2006, i.e. shortly before the oral proceedings. In order to defend itself against the ground the

appellant would not only have to find arguments but would also have to consider suitable auxiliary requests, which is not possible in the short time available between the receipt of the submission and the oral proceedings. The respondent has never questioned the part of the claim now objected to under this article and should not be allowed to do so at such a late stage.

- (ii) The subject-matter of claim 1 of the main request involves an inventive step. D19 is the nearest document of the documents which the appellant considers were available to the public before the priority date of the patent in suit. The apparatus of claim 1 is distinguished from the apparatus implicitly disclosed in this document in that the second conveyor feeds the first conveyor frontally, as well as by the provision of the sensor means for the arrival of each product and the sensor means for controlling the unwinding of the web of packaging material and their manner of controlling other parts of the apparatus as set out in the claim.

The problem to be solved is to provide a more reliable and faster packaging apparatus. It was not obvious to add the distinguishing features of claim 1 to the apparatus known from D19. The frontal feeding allows a faster feed because it is in the same direction as the movement of the conveyor. This is not possible in the apparatus according to D19 since in that apparatus the transverse adhesive lines are applied before the product is placed on the web. There is no



indication in the apparatus according to D19 of sensing the arrival of the product, nor would it make sense to do this in the apparatus of D19 since the arrival of the product is after the adhesive line has been applied so that it is no longer possible to influence this application.

In the apparatus according to D19 the longitudinal adhesive line is applied continuously so that there is no need to control this application. Also, in the apparatus according to D19 the longitudinal line is applied at the same place as the transverse line, i.e. before the product is placed on the web, so that it is already too late for the application of the longitudinal line to be influenced.

- (iii) The amendments made to claim 1 of the second auxiliary request conform to Article 123(2) EPC. The amendments are derived from the figures of the patent specification as originally filed.

The subject-matter of claim 1 of this request involves an inventive step over the undisputed prior art. The problem solved by the further distinguishing features of the claim is to increase the speed of the conveyors. The arrangement of the conveyors specified in the claim allows the products to be moved from one conveyor to the other without change of the direction of motion whilst allowing the application of adhesive at the desired position on the paper web.

- (iv) The matter should not be remitted to the department first instance. The witnesses have already been heard by the Dutch court, so that it is sufficient to consider that testimony. There are discrepancies between the testimony of Mr Tuijn before the Dutch District Court and his affidavit of 21 September 2006 (D27) so that a reliable conclusion regarding the events in 1991 cannot be reached. Since there is a clear testimony before the Court there is no need to rehear the witness and hence no need to remit the case.
- (v) The subject-matter of claim 1 of the second auxiliary request involves an inventive step over all the other prior art and testimonies admitted into the proceedings. Although each of the invoices D13 and D14 may indicate a sale of a Polywrap machine with a glue unit there is no indication as to how these were put together in the final constructed apparatus. The glue unit may have been used outside of the Polywrap machine.

D22 and D23 have not been proven to have been available to the public before the priority date of the patent in suit. Although they bear earlier inscriptions resembling dates, these may be printing dates and not distribution dates. In the case of D23 it has not been shown that a corresponding apparatus of the particular series was sold before the priority date of the patent in suit with which the operator's manual would have been supplied. The apparatus mentioned in D13 and D14 were from a different series. Even if D22 and

D23 were made available to the public it would not help since these show apparatus for use with plastics film wherein the film is transversely sealed as part of the cutting step after folding of the film. The skilled person receives no indication to use the apparatus for paper web and how to adapt it to this purpose. Also, there are no sensor means disclosed.

- (vi) There is no objection to showing the slides already shown during the opposition proceedings. However, new slides should not be allowed since the appellant will be shown their content for the first time during the oral proceedings and does not have the time to prepare a reaction.

VIII. The arguments of the respondent may be summarised as follows:

- (i) The ground under Article 100(c) EPC is already in the proceedings because it was a ground contained in the notice of opposition and has never been withdrawn. The previous Board 3.2.04 in their cited decision did not decide upon this ground. The previous Board only decided upon the amendments made to claim 1 during the appeal procedure. The decision of the previous Board is thus *res judicata* for those amendments but not for the ground itself.

It is correct that the ground was not argued further during the continued opposition proceedings. However, that does not mean that the ground is no longer in the proceedings.

It is unfortunate that the ground was not mentioned earlier in the appeal proceedings, however, it was only on receipt of the communication of the present Board accompanying the summons to oral proceedings that the respondent examined again the wording of the claim carefully and realised that some of the wording had not been disclosed in the application as originally filed. The objection based on this ground was filed with a submission one month before the oral proceedings. The matter is not complex so that the appellant has had time to prepare itself before the oral proceedings.

- (ii) The subject-matter of claim 1 of the main request lacks an inventive step in view of the undisputed documentary prior art. The nearest document from this prior art is D19, which describes a method of forming packages from a paper web. Since D19 describes various method steps applied to the web to form the packages the corresponding apparatus features are implicitly disclosed by this document. In this respect the front end of the first conveyor specified in the claim includes the region up to the folding means so that the supply of products at station E in the apparatus of D19 must implicitly be provided by a conveyor which is associated with this front end of the first conveyor. Claim 1 is distinguished from this implicitly disclosed apparatus by the features of the provision of the two sensors and the control functions which they carry out. The problem to be solved is to provide an apparatus to carry out

this method. The first sensor means, which detects the arrival of the product, operates the first adhesive application element which applies a transverse adhesive line. This, however, is an obvious measure for the skilled person since it is clear that there is no point in operating the adhesive applicator if there is no product to be packaged. The second sensor means controls the unwinding of the paper web and times the dispensing of adhesive by the second adhesive dispensing element which applies a longitudinal adhesive line. This feature is also obvious to the skilled person since the unwinding of the paper web has to be controlled and also the timing of the longitudinal adhesive line has to be controlled so that adhesive is not applied unnecessarily. There is, moreover, no indication in the claim of what is actually sensed by the second sensor.

- (iii) The amendments made to claim 1 of the second auxiliary request are not admissible since they are not clear, in particular with respect to the terms upstream and downstream.

The subject-matter of claim 1 of the second auxiliary request does not involve an inventive step over the undisputed prior art. The extra features of this request do not solve the problems of speed and reliability. There is no reason why a frontal feed should be faster. Moreover, the claim does not specify the speed attained. Since the claimed advantages are not attained there can be no inventive step.

- (iv) The case should be remitted to the department of first instance so that the circumstances regarding the alleged prior uses can be investigated further. There is ambiguity in the witness testimony of Mr Tuijn and his statement of 21 September 2006 (D27). In order that the truth of the matter be found out it is necessary that Mr Tuijn be heard by the department of first instance.

The matters discussed in the various meetings with manufacturers of glue applicators were not joint developments as they preceded possible sales of glue applicators by these manufacturers. For this reason they were also not confidential.

- (v) The subject-matter of claim 1 of the second auxiliary request does not involve an inventive step over the all the prior art and testimonies admitted into the proceedings.

From the witness testimonies as set out in D20a and D21a as well as the statement D27 by Mr Tuijn it is clear that an apparatus, that was a modified Polywrap machine, incorporating a glue gun in the position specified in claim 1 of this request, was constructed before the priority date of the patent in suit. As already argued with respect to the main request the provision of sensors operating in the manner set out in claim 1 was obvious to the skilled person.

Two Polywrap machines were sold before the priority date of the patent in suit as evidenced by the invoices D13 and D14. These invoices also show that in each case a hot melt glue unit with nozzles was sold along with each apparatus. When using such a glue unit it is clear that the glue should be applied where the paper is flat, i.e. before folding, which is before the products are placed and after unwinding, just as specified in the claim.

Also, when starting from D23 and wishing to use the apparatus for processing a paper web the skilled person would have to decide where to place the glue unit. It would be clear that it should be placed where the web is flat, i.e. before folding, which is before the products are placed and after unwinding.

As already argued with respect to the main request the provision of sensors operating in the manner set out in claim 1 is obvious to the skilled person.

- (vi) The new slides to be presented only show argumentation which is to be presented orally so that it should be possible to show them.

## **Reasons for the Decision**

### *Main request*

1. *Article 100(c) - admissibility of ground*

1.1 In its notice of opposition the opponent objected under Article 100(c) EPC to a number of amendments that had been made to claim 1 during the grant proceedings. The opposition division in a first decision revoking the patent decided that this objection was not justified, but that the subject-matter of claim 1 lacked novelty over D4 (a conflicting application pursuant to Article 54(3) EPC) and lacked inventive step over the teaching of D7 in combination with the teachings of D2, D5 or D6.

1.1.1 The subsequent appeal was dealt with by Board 3.2.04. During those appeal proceedings claim 1 was amended. The Board amongst other matters decided that the amendments made to the claim during the appeal proceedings complied with Article 123(2) and (3) EPC. The Board came to the conclusion that the decision of the opposition division on novelty and inventive step was not justified. The Board nevertheless remitted the case since it came to the conclusion that an alleged prior use, already brought forward in the opposition proceedings, could be more relevant than the document D7 on which the opposition division had partly relied in its decision. In its decision the Board, when explaining the reasons for the remittal (see section 6 of the reasons for the decision), referred only to the prior use.

1.1.2 In the subsequent continuation of the opposition proceedings the ground under Article 100(c) EPC was not mentioned by any party nor was it mentioned in the decision under appeal.



In its response to the appeal the respondent did not mention the ground.

1.1.3 The ground was first mentioned in the present appeal proceedings with the submission of the respondent dated 16 October 2006 (and received by fax on that date). This letter was not copied directly to the appellant by the respondent. According to the statement of the representative of the appellant in the oral proceedings before the present Board, the appellant received a copy of the submission from the Board on 26 October 2006.

1.1.4 In its submission the respondent argued that a part of claim 1, to which no objection had been made in the notice of opposition, was not disclosed in the application as originally filed.

This part of the claim had apparently also not been discussed during the first appeal proceedings as regards its disclosure in the application as originally filed.

1.1.5 The appellant argued that the ground in accordance with Article 100(c) EPC was *res judicata* in view of the preceding decision T 1116/97 and was a new ground in the appeal proceedings, with the introduction of which it did not agree. Moreover, appellant argued that it was filed too late in the appeal proceedings for it to react, in particular to formulate possible auxiliary requests.

1.2 In the opinion of the Board the ground can only be considered in the present appeal proceedings if it was already in the preceding opposition proceedings since the appellant does not agree with its introduction. In decision G 9/91 (OJ EPO 1993, 408) the Enlarged Board of

Appeal explained (see point 18 of the reasons) that the purpose of the appeal procedure is mainly to give the losing party the chance to challenge the decision on its merits. The decision of the opposition division presently under appeal does not deal with Article 100(c) EPC since the opponent has not relied upon this ground in the continued opposition proceedings. In the absence of a reassertion of this ground in the continued opposition proceedings and its consequent absence in the reasoning for the decision presently under appeal the ground cannot be considered to have been in the opposition proceedings leading to the present appeal proceedings and thus is a fresh ground for the present appeal.

1.3 In this respect the question of whether or not the ground was *res judicata* as a result of the decision T 1116/97 does not play a role since, if it was *res judicata* it could not have been considered in the continued opposition proceedings and if it was not *res judicata* then the failure of the opponent to reassert the ground during the continued opposition proceeding meant that the ground must be excluded from the present appeal proceedings unless the appellant permits its inclusion, which is not the case.

1.4 Since the ground is not part of the present appeal proceedings the question of the late filing of the ground does not have to be considered.

2. *Inventive step*

2.1 The parties both consider that D19 is the nearest documentary prior art and the Board agrees with this

view. The subject-matter of claim 1 is distinguished over the disclosure of this document by the features (using the identification letters used by the parties during the proceedings) that:

(i) said first element being operated by sensor means which senses the arrival of each product fed by said second conveyor, and

(k) sensor means for controlling the unwinding of the web of packaging material and for timing the dispensing of adhesive material are associated with said second dispensing element.

2.2 The appellant is of the opinion that also the feature whereby "with the front end of which there are associated, externally, a second conveyor (14) for feeding products (13) one after one onto said web" is not disclosed in D19.

2.2.1 The Board cannot agree with the appellant in this respect. The front end of the conveyor is defined in the claim as being associated with both the external conveyor and the internal folding means. The front end must therefore indicate a region starting at the front and ending at the folding means.

The appellant argued that with respect to the second conveyor a frontal direction was being defined. This argument, however, is inconsistent with the wording of the claim which indicates a region since the boundaries are defined for the front end. Since the front end is defined as a region it does not define a direction. In D19 the products arrive in some undisclosed manner at

the station E which is positioned before the folding means. The products therefore arrive at the front end of the first conveyor. The term "conveyor" is not restrictive to any particular type of conveyor but includes any arrangement which conveys. Such an arrangement must be implicitly present in the apparatus according to D19 in order that the products arrive on the conveyor so that the Board concludes that also this feature is disclosed in D19.

2.3 The appellant has argued that the problem to be solved is to provide a more reliable and faster packaging apparatus. However, the appellant has not convincingly demonstrated that the distinguishing features of claim 1 solve the problem of faster packaging. The appellant argued that feeding in the frontal direction allowed faster feeding, but as indicated above the Board does not agree with this interpretation of the claim.

2.4 For feature (i) the Board considers that it would be a normal measure for the skilled person, where adhesive is being applied in relationship to a product, to have a system to check that the product has actually arrived so as to avoid the unnecessary application of the adhesive. To provide a sensor to effect this check is a standard matter. A typical such sensor is a photoelectric cell together with an associated light source.

2.4.1 In the opinion of the Board also the provision of feature (k) in the apparatus known from D19 is obvious to the skilled person. As indicated by the appellant paper is less elastic than plastics film so that the unwinding of paper from a roll has to be controlled. A sensor for controlling the unwinding is a normal measure

for the skilled person. It is also known that with paper the presence of adhesive contacting a cutting knife is undesirable since the adhesive can adhere to the cutting knife which is detrimental to its cutting effect. It is clear to the skilled person that to avoid this contamination the application of the longitudinally applied adhesive must be interrupted in the area of the package which is to be cut. This requires a timer and a means of controlling the timer. A sensor is a standard means of effecting this, whereby the Board notes that this feature of the claim does not indicate what is being sensed or where it is sensed.

2.4.2 The features (i) and (k) may thus increase the reliability of the apparatus but nevertheless are obvious measures for the skilled person to achieve that goal. It is not apparent how these features can increase the processing speed of the apparatus.

2.5 Therefore, the subject-matter of claim 1 of the main request does not involve an inventive step in the sense of Article 56 EPC.

*Second auxiliary request*

3. *Admissibility of the amendments*

3.1 In accordance with a first amendment to claim 1 of this request the wording "downstream the feeding of the products" has been added to the definition of the position of the second adhesive element.

This feature may be derived from the drawings as originally filed and from the fact, as mentioned in

column 3, lines 1 to 4, of the patent specification (which has a counterpart in the application as filed), that the adhesive material must be kept hot and hence will be applied shortly before the folding takes place, which is downstream of the feeding of the products.

- 3.2 According to a second amendment to claim 1 of this request the following wording has been added: "said first adhesive application element (22, 40) is provided down stream (sic) of said roll (18), upstream the feeding of the products (13) on the first conveyor (16)".

This feature is based on figures 2 and 4 and the description in column 3, lines 13 to 15, of the patent specification (which have counterparts in the application as filed). In this part of the description it is indicated that the sealing apparatus is positioned between the roll and the folding means. In the figures there are shown two embodiments of the application elements which are each positioned upstream of the feeding of the products onto the first conveyor. The skilled person would thus understand that the first application element should preferably be provided downstream of the roll and upstream of the feeding of the products onto the first conveyor.

- 3.3 According to a third amendment to claim 1 of this request the following wording has been added: "said first conveyor (16) and said second conveyor (14) move in the same direction, the delivery end of the conveyor (14) being frontally connected to the front end of the first conveyor (16)".

Figures 1 and 2 of the drawings clearly show a pusher-type second conveyor 14 delivering products frontally to the belt-type first conveyor 16 with the two conveyors moving in the same direction. This is indeed what the skilled person would expect since this is the normal way of linking conveyors and passing products therebetween.

3.4 The Board therefore concludes that the amendments to claim 1 of this request satisfy the requirements of Article 123(2) and (3) EPC.

4. *Inventive step considering undisputed prior art*

4.1 Compared to claim 1 of the main request the extra features of claim 1 of this request whereby the first adhesive application element is provided downstream of the roll and upstream of the feeding of the products on the first conveyor, and the first conveyor and the second conveyor move in the same direction with the delivery end of the second conveyor being frontally connected to the front end of the first conveyor, solve the problem of increasing the speed of the adhesive applying apparatus.

In D19 the products to be placed on the web had to be placed either from above or from the side. This meant that there was a change in the direction of movement of the products which, because of their inertia, would limit the speeds that could be achieved by the conveyor. By arranging the delivery of the products from a conveyor delivering frontally and moving in the same direction an increase in the speed of the conveyors can be achieved as there is no change in the direction of

movement of the products and hence no problem with the inertia of the products.

This solution is not obvious to the person skilled in the art. In D19 the web is flat and the adhesive is applied first, transversely and longitudinally. This is followed by feeding the products between the strips of adhesive already applied. To provide a frontal feed would immediately produce a problem of how to apply the transverse adhesive lines such that the products can be placed between them. The skilled person would thus be prejudiced against this solution. The extra features of the claim not only mean that the products are fed frontally but also that the glue is applied before this point, i.e. below the first conveyor. There is nothing in the undisputed prior art to suggest this arrangement.

In the apparatus disclosed in D7 there is a frontal feed of products but that takes place with a plastics film. In this case the transverse seal is effected after folding together with the cutting step, wherein a hot sealing bar is applied to the cut ends of the plastics film. This document therefore gives no help to solving the problem for a paper web since its sealing method is different to that of the apparatus of D19 and it takes place at a different stage in the process.

- 4.2 The Board concludes therefore that the subject-matter of claim 1 of this request involves an inventive step in view of the undisputed prior art.



5. *Request for remittal to the department of first instance*

5.1 In the first opposition proceedings the opposition division did not hear the offered witnesses since it found that claim 1 of the then main request lacked both novelty and an inventive step in view of the prior art documents. On appeal, the previous Board ordered the remittal to the department of first instance since it considered that the prior art documents did not take away the novelty or inventive step of claim 1 of the main request before that Board, but that the alleged prior uses could be more relevant than the nearest prior art document which was then considered to be D7. During the continued opposition proceedings D19 was introduced into the proceedings and was considered by the opposition division to be more relevant than D7. In these continued proceedings the opposition division again did not hear the offered witnesses since it found that claim 1 of the then main request lacked an inventive step in view of the prior art documents, in particular taking account of D19.

In the course of the continued proceedings the respondent arranged for the witnesses to be heard by a Dutch court and filed the transcripts of this hearing. As part of its response to the appeal the respondent has requested that the case be remitted to the department of first instance to hear the witnesses. The request was reiterated in the oral proceedings before the Board after claim 1 of the second auxiliary request was found by the Board to involve an inventive step based on the undisputed prior art documents.

5.2 Before the Board remits a case, however, it must be satisfied that the alleged prior uses are more relevant than the prior art documents already in the proceedings since otherwise the remittal will simply waste time without changing the outcome of the proceedings. There are two particular matters which could affect the relevancy question in the present case. The first matter is whether or not the prior use is to be considered as confidential. The second matter is whether the content of the prior use is more relevant than the undisputed prior art documents.

In the view of the Board, even if the prior use were considered not to be confidential it still would not be more relevant.

5.3 It appears that during 1991 and before the priority date of the patent in suit, which is 5 August 1991, there was a desire expressed to the respondent for a packaging machine which could form paper packages for magazine mailings instead of the then standard plastics film packages. Attempts were therefore made by the respondent to modify its existing machine to work with a paper web.

The first witness heard by the Dutch District Court was Mr O. Bruinsma who was managing director of a company which was a customer of the respondent. Mr Bruinsma could remember little of the technical details of the discussions held at the time. Also, in his testimony (cf. D20a) there are parts which are nothing more than his views on what was needed to be done to modify the machine. Such considerations, however, do not form part of the actual object of the alleged prior use.

The next witness was Mr W. Otten (cf. D20a) who was an employee of Walcom which was a company which manufactured adhesive applicators. He mentions a meeting on 18 July 1991 with employees of the respondent at the premises of the respondent. According to him there was a discussion regarding the type and placing of the adhesive applicator. He referred also to a subsequent meeting with employees of the respondent on 1 August 1991 at the premises of his employer. He could not remember details of this meeting.

The next witness is Mr Endevelde (cf. D21a) who was an employee of a customer of the respondent. However, he could remember no technical details of tests at which he was present.

The last witness is Mr R. Tuijn (cf. D21a) who was an employee of the respondent. He was only able to remember a demonstration at Walcom on the morning of 1 August 1991. The demonstration was that of unwinding and winding paper and applying a glue pattern between these actions. The demonstration was a success. He indicated that a provisional construction was made but without indicating a date for this, and that the first prototype was shown in the autumn. He considered that the discussions were confidential.

- 5.4 In the view of the Board the witness testimonies show that even if the prior use was considered not to be confidential it still would not be relevant in view of its content. The witnesses did not indicate a specific apparatus which was constructed before the priority date and for which they could give constructional details. The Board concludes that the alleged prior uses would

not therefore be more relevant than the other documents on file.

5.5 The Board therefore decided not to remit the case to the department of first instance.

6. *Inventive step taking account of all prior art in the proceedings*

6.1 Although the Board decided not to remit the case to the department of first instance for the reasons explained above there exist in the proceedings documents, beyond the undisputed documents already dealt with above (see point 4), relating to the alleged prior uses, as well as brochures and the testimonies of the witnesses before the Dutch District Court. These documents and testimonies are in the proceedings and hence are available to the respondent to use in its argumentation. It must therefore be considered as to whether on the basis of all the documents and testimonies in the proceedings the subject-matter of claim 1 of this request involves an inventive step.

6.2 The respondent has particularly relied on D22 and D23 as well as the testimonies of the witnesses in D20a and D21a. The appellant disputes the public availability of D22 and D23. The availability to the public of these documents would have to be considered further if it were concluded that their content would affect the decision on inventive step.

6.3 Two particular demonstrations of apparatus have been discussed in the statements and testimonies of the witnesses. These, however, are imprecise regarding the

exact nature of the apparatus that were allegedly used. In this respect the witness testimonies/statements contain not only information about the actual apparatus but also information about how the witness thought that the apparatus should be.

First of all Mr Bruinsma explains that the machine called the Enveloper was a development of the Polywrap machine using a paper web and gluing, in place of a plastics film. In his explanation of the positioning of the gluing he makes references to the positioning of the glue applicators in a manner in which it is not clear if he is describing an actual apparatus. He uses in his testimony terminology such as "it was clear to me ..."; "I cannot recall if that was clear to Huub Endevelde at the time."; "On the top of the machine there was, to my mind, too little space."; "Timing in the Enveloper, I believe, ...". These statements, which are made on page 4 of D20a, third full paragraph, concern the situation before 5 August 1991, which is the priority date of the patent in suit. There is thus a clear doubt as to what exactly were the technical features of any apparatus then constructed.

In his testimony Mr Otten from Walcom states that in his agenda he can only locate tests held on 12 August 1991, but allows himself to be corrected to 1 August 1991 by Mr Hendriks, (see D20a, page 6, first five lines). He then states that the Walcom machines were presumably attached to the Buhrs machines in the weeks which followed. This would mean that there was no Buhrs machine, e.g. a Polywrap machine, having a Walcom glue applicator, before the priority date of the patent in suit.

Mr Endevelde can only remember seeing a machine running at Buhrs in the summer of 1991. He did not know any relevant technical details (cf. D21a page 3, first full paragraph). There was a demonstration at Walcom on the morning of 1 August 1991, just four days before the priority date of the patent in suit. This was apparently simply a gluing demonstration using a Walcom glue applicator (cf. D21a, testimony of Mr Tuijn, page 6 and D27, point 8).

According to the testimony of Mr Tuijn, in June 1991 there had been a test on a Polywrap machine with a paper web which had functioned giving rise to a need to investigate various problems including gluing. Mr Tuijn spoke to glue equipment manufacturers in July 1991. The first prototype of the "Enveloper" was shown at a fair in the autumn, i.e. after the priority date of the patent in suit. There is thus no indication of the constructional details of any apparatus which included glue applicators and which was constructed before the priority date of the patent in suite.

In the case of the later statement of Mr Tuijn dated 21 September 2006 (D27) the statement includes an indication by Mr Tuijn as to whether the features of claims of the main and auxiliary requests were present in a particular machine. Such a manner of making a statement is similar to putting inadmissible leading questions to a witness. Moreover, such a statement amounts to an interpretation of the scope of the claims by the witness making the statement. The purpose of a witness however, is to help to establish the facts not to interpret the claims. This manner of setting out the

statement leaves it uncertain as to what are the facts being witnessed and what are interpretations of the claim. The statement therefore has little value with regard to establishing the facts.

6.4 The respondent has also relied upon D13 and D14. These documents are invoices which are intended to show that a Polywrap mailing system was sold along with a side sealing kit including a hot melt glue unit. However, there is no indication of the constructional details of the finally installed apparatus. Only side sealing is mentioned and the positioning of this kit in the constructed apparatus is not indicated in the invoices. As argued by the appellant, the gluing kit could have been employed outside of the Polywrap apparatus. These documents cannot therefore prove the actual constructional features of the apparatus as finally constructed.

6.5 The respondent further argued that when adapting the Polywrap machine shown in D23 for use with paper it would be obvious to arrange for a glue applicator to apply the glue transversely to the paper web before the products are placed thereupon. There is, however, no support for this assertion. The skilled person knows that to adapt the Polywrap machine to a paper web it is necessary to apply glue. The skilled person does not, however, have any indication to apply the glue as specified in claim 1 of the request under discussion.

6.6 The Board concludes therefore that the subject-matter of claim 1 of this request involves an inventive step also in view of all the prior art and testimonies in the proceedings.

7. *Request to show a slide presentation (PowerPoint®)*

7.1 During the oral proceeding before the opposition division there had been a slide presentation. Copies of the slides shown in that presentation were filed by the appellant with its response to the appeal dated 25 April 2005. One day before the oral proceedings before the Board the respondent requested that a screen be present in the hearing room for a slide presentation, without indicating the content of the intended presentation.

Upon questioning by the Board at the beginning of the oral proceedings the respondent indicated that the presentation was more extensive than that already shown during the oral proceedings before the opposition division, including thirty four new slides containing argumentation.

7.2 In the view of the Board the showing of the new slides would give the respondent an unwarranted advantage since it would have available a visualisation of its arguments which was not available to the appellant. The Board therefore did not allow the presentation of these slides.

The slides (D28) shown before the opposition division and filed with the response to the appeal consist mainly of illustrating the wording of the claim by positioning it at the side of the relevant parts of the drawings of the nearest documentary prior art D19. The Board saw no objection to this content which indeed facilitates the discussion also for the appellant. The Board therefore allowed the showing of these slides, particularly taking account of the fact that they had been filed beforehand



so that the appellant was not taken by surprise with their content.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to maintain the patent with the following documents:

Claims: claim 1 filed in the oral proceedings on 14 November 2006, claims 2 - 8 as granted;

Description: columns 1 and 2 as filed on 3 February 2004 and columns 3 and 4 as granted;

Drawings figures 1 - 4 as granted.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders