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**Datasheet for the decision
of 9 November 2006**

Case Number: T 1074/04 - 3.2.07

Application Number: 97302783.2

Publication Number: 0803442

IPC: B65D 1/02

Language of the proceedings: EN

Title of invention:

Hermetically sealed container with closure insert

Patentee:

AUTOMATIC LIQUID PACKAGING, INC.

Opponent:

kocher-plastik Maschinen GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 123(3)

EPC R. 57a

RPBA Art. 10b(3)

Keyword:

"Extension of protection - yes"

"Added subject-matter - yes"

"Requests filed during oral proceedings requiring adjournement

- not admitted"

Decisions cited:

-

Catchword:

-



Case Number: T 1074/04 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 9 November 2006

Appellant: AUTOMATIC LIQUID PACKAGING, INC.
(Patent Proprietor) 2200 West Lake Shore Drive
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Representative: Hepworth, John Malcolm
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Respondent: kocher-plastik Maschinenbau GmbH
(Opponent) Talstraße 22-30
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Representative: Bartels, Martin Erich Arthur
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 1 June 2004
revoking European patent No. 0803442 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: P. O'Reilly
E. Lachacinski

Summary of Facts and Submissions

I. Opposition was filed against European patent No. 0 803 442 as a whole and based on Article 100(a) EPC (lack of novelty and lack of inventive step).

The opposition division decided to revoke the patent. The opposition division held that the subject-matter of claim 1 of the main request was novel but did not involve an inventive step.

II. The appellant (proprietor) filed an appeal against that decision.

The respondent (opponent) requested that the appeal be dismissed.

III. In its provisional opinion which accompanied the summons to oral proceedings the Board, amongst other matters, indicated that the amendments to claim 1 of the only request then on file (the present main request) might not comply with Article 123(3) EPC and furthermore that the appellant should be in a position to justify all the amendments which had been made to the claim for compliance with Articles 84 and 123(2)(3) EPC. The Board further provisionally indicated that the grounds of the appeal did not seem to have shown that the impugned decision was wrong.

IV. At the start of the oral proceedings held on 9 November 2006 before the Board the appellant withdrew the five auxiliary requests which had been filed with its submission dated 9 October 2006 and replaced them with two new auxiliary requests.

At the oral proceedings, with regard to the main request, the Board, as part of its *ex-officio* examination of the amendments to claim 1, indicated that Article 123(2) and (3) EPC as well as Rule 57a EPC did not appear to be complied with.

At the end of the oral proceedings the final requests of the appellant were that the decision under appeal be set aside and the patent be maintained according to the main request filed with letter of 30 October 2003 or, alternatively, in accordance with the first or second auxiliary requests filed during the oral proceedings before the Board.

V. The independent claim of the main request reads as follows (amendments when compared to claim 1 of the patent as granted are depicted in bold or struck through):

"1. A hermitically sealed container (10) of a thermoplastic material and comprising:
(a) a body portion (12);
(b) a socket (32) unitary with said body portion;
(c) a preformed closure insert (44) within said socket and defining an axial access passageway (46) into said body portion, said closure insert including a skirt (50) with a scabrous outer perimeter band (56) and an outwardly extending peripheral flange (62), said skirt being immobilized within said socket, ~~said flange together with said scabrous outer perimeter band providing a permanent seal for container contents;~~ and

(d) a removable closure shroud (34) unitary with said socket and delineated therefrom by a peripheral frangible web (36) circumscribing said closure insert:

characterised in that said outwardly extending peripheral flange **is positioned at the top of the skirt and** extends radially outwardly beyond said scabrous outer perimeter band; and wherein **the flange comprises two circumferential and radially outwardly extending top and bottom sealing surfaces (64, 66) spaced apart from one another and an end annular sealing surface (68) and wherein** the thermoplastic material forming the socket (32) of the container is in intimate contact with ~~said flange (62) and provides~~ **the total contact area of the top and bottom sealing surfaces, the end annular sealing surface and the scabrous outer perimeter band continuously without interruption to provide a permanent seal for the closure insert within the socket of the container** ~~container contents.~~"

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

"1. A hermitically sealed container (10) of a thermoplastic material and comprising:
(a) a body portion (12);
(b) a socket (32) unitary with said body portion;
(c) a preformed closure insert (44) within said socket and defining an axial access passageway (46) into said body portion, said closure insert including a skirt (50) with a scabrous outer perimeter band (56) and an outwardly extending peripheral flange (62), said skirt being immobilized within said socket; and

(d) a removable closure shroud (34) unitary with said socket and delineated therefrom by a peripheral frangible web (36) circumscribing said closure insert:

characterised in that **said closure insert has an** outwardly extending peripheral flange is positioned at the top of the skirt and **extending** ~~extends~~ radially outwardly beyond said scabrous outer perimeter band; and wherein the flange comprises two circumferential and radially outwardly extending top and bottom sealing surfaces (64, 66) spaced apart from one another and an end annular sealing surface (68), **in that** ~~and wherein~~ the thermoplastic material forming the socket (32) of the container **is formed to provide an external flange surrounding said flange of the closure insert by being** ~~is~~ in intimate contact with the total contact area of the top and bottom sealing surfaces **and** the end annular sealing surface **and is in intimate contact with** the scabrous outer perimeter band continuously without interruption provides a permanent seal **between** ~~for~~ the closure insert **and within** the socket of the container, **and in that the external flange extends outwardly beyond the thermoplastic material which is in intimate contact with the scabrous outer perimeter band.**"

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

- "1. A hermitically sealed container (10) of a thermoplastic material and comprising:
- (a) a body portion (12);
 - (b) a socket (32) unitary with said body portion;

(c) a preformed closure insert (44) within said socket and defining an axial access passageway (46) into said body portion, said closure insert including a skirt (50) with a scabrous outer perimeter band (56) and an outwardly extending peripheral flange (62), said skirt being immobilized within said socket; and

(d) a removable closure shroud (34) unitary with said socket and delineated therefrom by a peripheral frangible web (36) circumscribing said closure insert:

characterised in that said closure insert has an outwardly extending peripheral flange is positioned at the top of the skirt and extending radially outwardly beyond said scabrous outer perimeter band; and wherein the flange comprises two circumferential and radially outwardly extending top and bottom sealing surfaces (64, 66) spaced apart from one another and an end annular sealing surface (68), in that the thermoplastic material forming the socket (32) of the container is formed to provide an external flange surrounding said flange of the closure insert by being in intimate contact with the total contact area of the top and bottom sealing surfaces and the end annular sealing surface and is in intimate contact with the scabrous outer perimeter band continuously without interruption provides a permanent seal between the closure insert **within and** the socket of the container, **and** in that the external flange extends outwardly beyond the thermoplastic material which is in intimate contact with the scabrous outer perimeter band **and in that said thermoplastic material forming the socket (32) of the container is welded to said flange of the closure insert."**

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

- (i) The amendments to claim 1 of the main request comply with Articles 123(2) and (3) EPC and Rule 57a EPC.

It is clear from the drawings of the patent and the application as originally filed that the thermoplastic material forming the socket of the container is in intimate contact with the total contact area of the top and bottom sealing surfaces and the end annular sealing surface; is in intimate contact with the scabrous outer perimeter band; and continuously without interruption provides a permanent seal between the closure insert and the socket of the container. The drawings of the patent specification show that the contact is continuous without interruption.

Although the wording of claim 1 as granted which relates to providing a permanent seal for container contents has been deleted from the claim, equivalent wording has been added so that there is no extension of the scope of protection. The equivalent wording is the permanent seal for the closure insert within the socket of the container.

- (ii) The auxiliary requests filed at the oral proceedings before the Board should be admitted into the proceedings. They are filed at a late stage because of difficulties in contacting the inventor, who has left the appellant company, and in obtaining further technical information. The

amendments contained in the independent claims of the requests contribute to better distinguishing their subject-matter from the prior art.

(iii) The subject-matter of the independent claims of each of the requests is novel and involves an inventive step.

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

(i) The amendments made to claim 1 of the main request contravene Article 123(2) and (3) EPC. There is no disclosure in the application as originally filed of a seal that is continuous without interruption. Also, the deletion of the reference to sealing the container contents extends the scope of protection.

(ii) The auxiliary requests filed at the oral proceedings before the Board should not be allowed at this stage of the proceedings. There have already been seven auxiliary requests in total in the proceedings so that further requests should not be admitted. Since the requests include features which come from the description and have not previously been included in claims there has been no opportunity to carry out a search for these features.

(iii) The subject-matter of the independent claims of each of the requests does not involve an inventive step.

Reasons for the Decision

Main request

1. *Amendments to claim 1*

1.1 In the following discussion for convenience reference is made to parts of the granted patent specification whereby these parts have counterparts in the application as originally filed.

1.2 Already in its provisional opinion the Board expressed the view that the deletion from independent claim 1 as granted of the feature that there was a permanent seal "for container contents" might not be in accordance with Article 123(3) EPC. The appellant argued that this feature found its expression in the amended claim 1 in the feature that there is a permanent seal "for the closure insert within the socket of the container".

The Board cannot agree with the appellant in this respect. The claim as granted quite clearly indicated a limitation with respect to the contents of the container, i.e. that they should be permanently sealed in the container. There were indeed two such references in the claim and both have been deleted. The situation of the contents of the container, i.e. whether or not they are permanently sealed therein, no longer forms part of the claim so that there has been an extension in the scope of protection in contravention of Article 123(3) EPC.

1.3 Even if it could have been shown that the amendment to claim 1 did not contravene Article 123(3) EPC there still would remain the question of whether the amendment was occasioned a ground of opposition as required by Rule 57a EPC. The appellant was unable to show how this amendment could contribute to meeting such a ground. This amendment therefore also contravenes Rule 57a EPC.

1.4.1 According to the amended claim "the total contact area of the top and bottom sealing surfaces, the end annular sealing surface and the scabrous outer perimeter band **continuously without interruption** to provide a permanent seal for the closure insert" (bold added by Board).

1.4.2 The description of the patent in column 4, lines 46 to 50 indicates that the thermoplastic material of the container socket **substantially** fills the interstices or channels between adjacent ribs (of the insert) and immobilises the insert by forming a permanent seal between the closure insert and the socket during molding. This section therefore only deals with the scabrous surface and only indicates the formation of a permanent seal without indicating that there is a continuous permanent seal. The fact that the thermoplastic material only "substantially" fills the interstices between the ribs speaks against a continuous permanent seal.

1.4.3 The description of the patent in column 5, lines 15 to 22 indicates that the thermoplastic material of the container socket is disposed in intimate contact with the total actual surface area of the top and bottom sealing surfaces (of the flange) and with the annular

end sealing surface, so as to provide an enlarged, permanent sealing surface for container contents. This part of the description therefore deals only with the flange and not with any other part of the insert.

1.4.4 There is no indication of the situation with regard to the sealing of the part of the surface positioned between the flange and the scabrous surface. According to the appellant the basis for this amendment is to be found in the drawings, e.g. figure 2. However, figure 2 and the other drawings which show the extent of the thermoplastic material are axial cross-sectional drawings which by their nature can only show the part through which the cross-section is taken. These drawings by their nature cannot show if the contact of the thermoplastic material is continuous without interruption.

1.4.5 This feature is therefore not unambiguously disclosed in the application as originally filed.

The main request cannot therefore be allowed.

Auxiliary requests

2. *Admissibility of the auxiliary requests filed at the oral proceedings*

2.1 In the communication of the Board accompanying the summons to oral proceedings the provisional opinion was expressed that the appeal grounds did not appear to show that the appealed decision was wrong. The appellant was thus aware well before the oral proceedings that the filing of auxiliary requests might

be appropriate. The appellant indeed filed five such auxiliary requests one month before the oral proceedings, which shows that it was clearly aware of the problem. The respondent made no substantive submission after the issue of the summons to oral proceedings so that no new matters arose which could cause the appellant to change its requests.

At the start of the oral proceedings before the Board the five auxiliary requests then on file were withdrawn and two new auxiliary requests were filed.

- 2.2 With regard to the timing of filing the appellant explained difficulties in contacting the inventor, who no longer worked for the appellant, and the need to reconsider the technical effects of the features of the claimed device.

The Board has difficulties in accepting this argument. The patent had been revoked by the opposition division and the provisional opinion of the Board was unfavourable to the appellant. The appellant had sufficient opportunity after receipt of the provisional opinion to reconsider the situation, to make consultations, and to file suitable auxiliary requests.

During the period from the receipt of the provisional opinion through to the start of the oral proceedings it has not be shown by the appellant that there was any unforeseeable event which could give rise to a need to file further auxiliary requests at such a late stage of the proceedings.

2.3.1 With regard to the content of the requests, both requests include a feature, i.e. the container "is formed to provide an external flange surrounding said flange of the closure insert", which according to the appellant was derivable from the description and/or drawings.

This feature was not in the claims as originally filed nor was it included in the granted claims. It also did not figure in the claims presented as part of requests made during the opposition proceedings and the appeal proceedings prior to the oral proceedings before the Board. This feature thus became a claimed feature for the first time with these requests filed during the oral proceedings.

The application as filed does not mention this feature anywhere in its description and in particular neither its function nor its importance. It is therefore clear that the feature would not have been the subject of the European search (see Guidelines for Examination B-III, 3.2) and could not have been the subject of a search by the respondent. The feature is not a trivial feature since according to the appellant the feature is introduced specifically to distinguish the claimed invention from the documents cited in the opposition proceedings. The Board cannot, however, allow requests to be filed at oral proceedings containing features to which the respondent is not in a position to respond since in such a case the respondent would be put at a disadvantage for reasons for which it was not responsible.

- 2.3.2 The requests contain several amendments compared to requests previously on file and include extensive new wording requiring careful consideration for compliance with the Convention if the patent were to be maintained in accordance with Article 102(3) EPC. Such examination must be undertaken not only by the respondent, but also *ex-officio* by the Board. It is not the purpose of oral proceedings, which by their nature are of limited duration, to perform extensive examination when there is no apparent reason why the amendments could not have been filed in time well before the oral proceedings.
- 2.4 Because of the content of these requests the oral proceedings would have to be adjourned in order to allow the respondent to carry out a search in order to prepare his position satisfactorily and for the Board to examine carefully the amendments for compliance with the Convention. The admittance of the requests would therefore not be in accordance with Article 10b(3) of the Rules of Procedure of the Board of Appeal.
- 2.5 The Board, exercising its discretion concludes therefore that in view of the content of the auxiliary requests and their timing they cannot be admitted into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders