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**Datasheet for the decision
of 22 January 2008**

Case Number: T 0431/05 - 3.2.04

Application Number: 99906582.4

Publication Number: 1059853

IPC: A24C 5/35

Language of the proceedings: EN

Title of invention:

Variable-capacity buffer store for rod-shaped articles

Patentee:

International Tobacco Machinery Poland Ltd

Opponent:

Hauni Maschinenbau AG

Headword:

Buffer Store/ITMP

Relevant legal provisions (EPC 1973):

EPC Art. 100(b), 111(1)

Keyword:

"Sufficiency of disclosure (yes)"
"Remittal to the opposition division"

Decisions cited:

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Catchword:

-



Case Number: T 0431/05 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 22 January 2008

Appellant:
(Opponent)

Hauni Maschinenbau AG
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Representative:

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Respondent:
(Patent Proprietor)

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Representative:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 4 February 2005
rejecting the opposition filed against European
patent No. 1059853 pursuant to Article 102(2)
EPC.**

Composition of the Board:

Chairman: M. Ceyte
Members: P. Petti
A. Pignatelli

Summary of Facts and Submissions

- I. The opposition filed against the European patent No. 1 059 853 was rejected by decision dated 4 February 2005.

The opposition division found that the grounds of opposition mentioned in Articles 100(a) and (b) EPC did not prejudice the maintenance of the patent as granted. In particular, the opposition division held that the subject matter of claim 1 of the patent as granted was novel over document EP-A-738 478 (D1A) and involved an inventive step over this document, taking account *inter alia* of documents US-A-5 362 888 (D2), DE-A-4 224 609 (D4) and US-A-4 641 024 (D7).

Claim 1 of the patent as granted reads as follows:

- "1. A variable-capacity buffer store for rod-shaped articles working in the system, first in, first out, comprising an input station (16) connectable to a production machine and an output station (17) connectable to a receiving machine, and both the input station (16) and the output station (17) cooperate with a continuous endless conveyor (8), carrying rod-shaped articles from the input station (16) to the output station (17), the first part of which is situated in a transport sector (11) and the second part of which is situated in a return sector (9), and length of the conveyor (8) in both of the sectors (9, 11) compensate each other **characterised in that**, at the inlet of the transport sector(11) is situated a first drive means (21) of the conveyor (8) which is controlled

by and connected to a fullness sensor (22) assembled in the input station (16) via a control unit, and at the exit of the transport sector (11) is situated a second drive means (23) of the conveyor (8) which is controlled by and connected to a fullness sensor (24) assembled in the output station (17) via a control unit, and the transport sector (11) consists of two, active and passive, identical support guide means (10, 15) of the conveyor (8) that consist of independent disc modules (6) rotary assembled on the axes (5, 14), the return sector (9) consists of two, active and passive, identical support guide means (7, 13) of the conveyor (8) that consist of independent disc modules (6) rotary assembled on the axes (4, 12), the axis (5) of the active support guide means (10) in the transport sector (11) is fixed to the axis (4) of the active support guide means (7) in the return sector (9) by a carriage (3) moveable assembled on a horizontal guide bar (2) on a frame (1) of the store in a plane perpendicular to the axes (5, 4)."

- II. On 1 April 2005 the opponent (hereinafter appellant) lodged an appeal against this decision and simultaneously paid the appeal fee. A statement setting out the grounds of appeal was received on 31 May 2005.

- III. With the statement setting out the grounds of appeal the appellant filed documents DE-B-1 292 069 (D8) and US-A-4 513 858 (D9).

By letter dated 12 October 2007, the appellant filed documents EP-A-557 933 (D10), JP-A-58-60982 (D11), WO-A-94/24026 (D12) and WO-A-96/11862 (D13).

- IV. Oral proceedings before the board were held on 22 January 2008.
- V. The appellant requested that the decision under appeal be set aside and the patent be revoked.

The patent proprietor (hereinafter respondent) requested that the appeal be dismissed (main request) or, in alternative, that the decision under appeal be set aside and the patent be maintained in amended form on the basis of one of the sets of claims according to the auxiliary requests 1, 2, 2A, 3, 3A, 4 and 4A, all filed with letter dated 19 November 2007. The respondent also requested that the case be remitted to the department of first instance, if the board intended to introduce documents D10 to D13 into the proceedings.

- VI. The appellant essentially argued as follows:
 - i) Claim 1 also covers variable-capacity buffer stores in which transport and return sectors are located side-by-side or one inside the other. Such buffer stores are not supported by the description which only discloses a buffer store in which the transport and return sectors are arranged one under the other. In particular, these undisclosed buffer stores require an arrangement of the carriage linking the axes of the active support guide means and of the drive means which differs from the arrangement disclosed in relation to

Figure 1. Thus, having regard to the examples and the information given in the patent specification, the invention cannot be performed in the whole area claimed by a person skilled in the art using common general knowledge without undue burden. Moreover, since it is impossible for the appellant to establish insufficiency for embodiments which are not disclosed or do not exist, the burden of proof that the invention can be carried out within the whole area claimed should shift to the respondent.

- ii) Documents D10 to D13 were submitted in response to the board's communication dated 25 July 2007 and are thus not late filed.

VII. The respondent essentially contested the appellant's arguments. In particular he argued that documents D10 to D13 should not be admitted into the proceedings since they are no more relevant than the previously filed documents.

Reasons for the Decision

As a preliminary remark, the board draws the attention of the parties to the fact that, since the European patent was already granted at the time of the entry into force of the EPC 2000 on 13 December 2007, the transitional provisions according to Article 7 of the Act revising the EPC of 29 November 2000 and the Decisions of the Administrative Council of 28 June 2001 and of 7 December 2006, Article 2, have been applied.

When Articles or Rules of the version of the EPC 1973 are cited, the year is indicated.

1. The appeal is admissible.
2. *Article 100(b) EPC (1973)*
 - 2.1 Claim 1 as granted refers to the support guide means (7, 10, 13 and 15) of the endless conveyor without indicating how transport and return sectors are spatially arranged with respect to each other. According to dependent claim 3 the support guide means of the transport and return sectors are arranged one under or above the other, in so far as the axes are defined as being "situated in the one vertical plane". According to dependent claim 4 the support guide means of the transport and return sectors are arranged side-by-side, in so far as the axes (4, 12) of the support guide means (7, 13) of the return sector are defined as being situated in a vertical plane which is parallel to the vertical plane in which the axes (5, 14) of the support guide means (10, 15) of the transport sector are situated.

In the patent specification one way of carrying out the invention is described in relation to Figure 1 which concerns a variable-capacity buffer store provided with an endless conveyor (8) which is supported and guided by means of four support guide means (7, 10, 13 and 15), wherein the axes (4, 5, 12 and 14) of all the support guide means (7, 10, 13 and 15) are situated in the same vertical plane, such that the support guide means (7, 13) of the return sector of the endless

conveyor are arranged over the support guide means (10, 15) of the transport sector of the endless conveyor.

Thus, the board is satisfied that at least one way is clearly indicated enabling the skilled person to carry out the invention.

- 2.2 It is upon the appellant (opponent) to substantiate the allegation that a skilled reader using his common general knowledge would be unable to carry out the invention within the whole area that is claimed, that is also for those undisclosed embodiments which the appellant was able to identify (i.e. where transport and return sectors are located side-by-side or one inside the other). The appellant's argument that the carriage and the drive means of these two undisclosed embodiments have to be arranged other than as described in the patent specification is clearly not sufficient to substantiate insufficiency of disclosure in the absence of further submissions in support of such a ground.

Thus, the appellant's submission is insufficient to discharge himself of the onus to substantiate insufficiency of disclosure.

- 2.3 Therefore, the ground for opposition under Article 100(b) EPC (1973) does not prejudice the maintenance of the patent.

3. *Documents D10 to D13*

- 3.1 Documents D10 to D13 are admitted into the proceedings because the board considers that they have been filed

as an appropriate reaction to the communication of the board dated 25 July 2007. By this communication, the board expressed its preliminary view that none of documents D2, D4 and D7 suggested the idea upon which the claimed invention is based, that is using the differences in the speed between a first drive means associated with the input station of the buffer store and a second drive means associated with the output station to force linear movement of a carriage linking the axis of two active support guide means of the conveyor of the buffer store. In this communication, the board expressed the view that documents D8 and D9 were relevant in so far as they suggested this idea. However, it could be understood from the board's analysis that none of documents D8 and D9 discloses a variable-capacity buffer store provided with support guide means consisting of disc modules rotary-assembled on a common axis, and that document D9 did not refer to fullness sensors.

The filing of documents D10 to D13 clearly represents an appropriate reaction hereto since

- i) document D10 refers to fullness sensors and
- ii) documents D12 and D13 disclose not only the above mentioned idea upon which the claimed invention is based but also a conveyor provided with support guide means consisting of disc modules which are rotary assembled on a common axis (in this respect, they are *prima facie* more relevant than documents D8 and D9).

3.2 The respondent requested that the case be remitted to the first instance in order to be given the opportunity of appealing a written decision revoking the patent on the basis of the newly-introduced documents.

During oral proceedings the appellant did not raise any objection against this request. Accordingly, the board in exercising its discretion under Article 111(1) EPC (1973), considers it appropriate to remit the case to the opposition division for further prosecution.

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 for further prosecution.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte