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**Datasheet for the decision
of 20 March 2009**

Case Number: T 0276/07 - 3.2.07

Application Number: 00954410.7

Publication Number: 1183183

IPC: B65B 1/00

Language of the proceedings: EN

Title of invention:

Method and apparatus for packaging articles by means of an envelope made of a thermoplastic film

Patentee:

MATEC S.p.A.

Opponent:

CORTESE S.p.A.

Headword:

-

Relevant legal provisions:

EPC Art. 54, 56, 83, 123(2)

EPC R. 3(3)

Keyword:

"Added subject-matter - no"

"Late filed ground of insufficiency - not admitted"

"Prior use - not proven"

"Novelty - yes"

"Inventive step - yes"

Decisions cited:

G 0009/91

Catchword:

-



Case Number: T 0276/07 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 20 March 2009

Appellant:
(Opponent)

CORTESE S.p.A.
Via del Faggiolo 1/11
I-40135 Bologna (IT)

Representative:

di Francia, Vincenzo
Manzella & Associati
Via Nosadella 9
I-40123 Bologna (IT)

Respondent:
(Patent Proprietor)

MATEC S.p.A.
Via delle Nazioni Unite 1
I-50018 Scandicci (Firenze) (IT)

Representative:

Celestino, Marco
AB, Agenzia Brevetti & Marchi
Viale Giovanni Pisano, 31
I-56123 Pisa (IT)

Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
7 December 2006 concerning maintenance of
European patent No. 1183183 in amended form.

Composition of the Board:

Chairman: H. Meinders
Members: P. O'Reilly
I. Beckedorf

Summary of Facts and Submissions

- I. Opposition was filed against European patent No. 1 183 183 as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step).

The opposition division decided to maintain the patent in amended form. It held that the subject-matter of claims 1 and 5 of the second auxiliary request was novel and involved an inventive step.

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

- III. The appellant in written proceedings requested that the decision under appeal be set aside and that the patent be revoked.

It objected to the late filing of the submissions and requests with letter of 12 March 2009 by the respondent.

The respondent (patent proprietor) requested that the appeal be dismissed or, alternatively, in setting aside the decision under appeal the patent be maintained in amended form on the basis of either set of claims filed as third and fourth auxiliary requests with letter of 12 March 2009.

- IV. Oral proceedings were held before the Board on 20 March 2009. The appellant did not appear in accordance with the corresponding indication in its submission dated 19 February 2009.

In the annex to its summons to oral proceedings the Board expressed its provisional opinion regarding the case. The Board indicated that the objection raised by the appellant under Article 123(2) EPC against the amendments carried out on the patent did not appear to be relevant and that the introduction of the ground of opposition under Article 100(b) EPC would need the agreement of the respondent. In its opinion the Board indicated that it considered the subject-matter of claim 1 to be novel over E4 (DE-A-2 317 257). The Board questioned the introduction of an alleged prior use into the appeal proceedings when it had not been argued in the oral proceedings before the opposition division. In any case the Board indicated that there was a serious doubt regarding the veracity of the alleged dates of sale and delivery of the packaging machine with serial number 5497.

V. The independent claims of the patent as maintained read as follows:

"1. A method for packaging articles coming from production lines by means of an envelope made of film fed continuously that can be welded thermoplastically comprising the steps of:

- in a feeding direction arranging at least a web (30) of continuous film that can be welded thermoplastically according to two continuous wings (31, 32) overlapping each other in order to present a continuous longitudinal closed edge (33), said folded web having a front end (38) transversally to its feeding direction closed in a previous step;
- arranging thermoplastic cutting and welding means (50, 52) transversally to the feeding direction of said web;

- opening apart from each other said wings and introducing between them an article (10) being packaged opposite to said closed longitudinal continuous edge at an opening station located upstream of said thermoplastic cutting and welding means (50, 52), said article being introduced on a support tray (23) between said wings;
- carrying said article on said tray (23) with a relative movement through said web (30) up to reaching or overcoming said thermoplastic cutting and welding means (50, 52) until a front edge of said article is at said front closed end (38), which has been brought further forward by said tray beyond the thermoplastic cutting and welding means together with the article;
- drawing back said tray upstream of said thermoplastic cutting and welding means towards said loading station, leaving said article at said front closed end;
- at said thermoplastic cutting and welding means, transversal to the feeding direction of the web pinching said folded web by means of a gripper (53) transversal to the feeding direction of the web, leaving said web free of sliding through said gripper;
- pulling said web upstream of said gripper transversal to the feeding direction of the web and drawing back said web that slides through said gripper until a front edge of said article contacts said front closed end;
- further drawing back said web until a rear edge of said article contacts said gripper;
- transversal to its feeding direct cutting and welding said web next to said gripper whereby an envelope (36) is formed closed at three sides about said article;
- dragging away said envelope, further packaging the articles and feeding said cut web, said transversal

cutting and welding creating another front closed end for said web."

"5. An apparatus for packaging articles coming from production lines by means of an envelope made of film fed continuously that can be welded thermoplastically comprising the steps of:

- means (40) for feeding and drawing back in a feeding direction at least a web (30) of continuous film that can be welded thermoplastically having two continuous overlapped wings;
- thermoplastic cutting and welding means (50, 52) arranged transversally to the feeding direction of said web;
- means (21) for opening apart said wings;
- wherein said means (21) for opening apart said wings (31, 32) are arranged between said means (40) for feeding and drawing back and the thermoplastic cutting and welding means (50, 52), the following being furthermore provided:
 - support means (23) of said article (10) at the level of said means for opening apart the wings, said support means being located between the wings of said web (30);
 - means for moving said support means along said web between said means for opening apart the wings and a position downstream of said thermoplastic cutting and welding means and viceversa, sliding through said wings;
 - a gripper (53) transversal to the feeding direction of the web provided at the level of said thermoplastic cutting and welding means;
 - means (55, 56a, 57) for closing said gripper on said web leaving it free of sliding if pulled back from said means for drawing back;

- means (46) for dragging away an envelope, formed downstream said thermoplastic cutting and welding means about said article after two consecutive cuts transversal to the feeding direction of the web."

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

- E31: Report in Italian by the expert of the Court of Bologna dated 21 February 2003 describing the packaging machine with the serial number 5497 with English translation;
- E32: Brochure for the Cortese machine model 850;
- E33: Invoice of Cortese S.p.a. to Levante S.p.a. dated 18 February 1999 concerning a model 850 machine;
- E34: Two invoices of Cortese S.p.a. to Tintoria Elledue S.r.l. dated 30 June 1999 and 16 July 1999 concerning a model 850 machine;
- E35: Delivery note AB1/12 dated 4 February 1999;
- E36: Invoices from SPM to Cortese S.p.a. relating to parts or work done for a model 850 machine;
- E37: Brochure for the Cortese machine model 750;
- E4: DE-A-2 317 257;
- E5: Report in Italian by an expert appointed by the Court of Bologna dated 28 November 2005;
- E6: AT-B-252 819;
- E7: Decision of the Court of Bologna of 7 January 2009;
- E8: Translation into English of E7.

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

- (i) The amendments to the description of the patent offend Article 123(2) EPC since the way in which the prior art has been acknowledged puts the invention in a different light to that when granted. This also applies to the amendments to the independent claims wherein the two-part form of claim has been replaced by a one-part form.

The amended independent claims also offend Article 100(b) EPC since the description does not explain how a relative movement of the tray through the web, as specified in these claims, may be achieved.

- (ii) The subject-matter of each of independent claims 1 and 5 was disclosed via the prior use as evidenced by E31 - E36. A Cortese model 850 packaging machine was ordered by Levante S.p.a. on 17 July 1998 and the machine with serial number 5497 was delivered thereto at the premises of Tintoria Elledue S.r.l. on 4 February 1999 as evidenced by delivery note E35. The machine was designed by Cortese S.p.a. in 1998 as evidenced by the invoices E36 issued by SPM Progettazioni Costruzioni Meccaniche. The machine with number 5497 had all the features of claims 1 and 5 as described by the court expert in E31.

- (iii) The disclosure of E4 takes away the novelty of the subject-matter of each of claims 1 and 5. The opposition division considered that there were three features (a) to (c) which conferred novelty on the claims:

(a) the opening station is located upstream of the cutting and welding means,
(b) the article is carried on the support tray with a relative movement through said web up to reaching or overcoming the cutting and welding means, until a front edge of the article is at the front closed end, which has been brought further forward by said tray beyond the cutting and welding means together with the article,
(c) drawing back said tray upstream of the cutting and welding means towards the loading station, leaving the article at said front close end.

Contrary to the view of the opposition division these features are in fact disclosed in E4.

Feature (a) can be deduced from figure 7 in combination with figures 8 and 9.

Feature (b) is disclosed in figure 9 which shows a drive member 919 which is capable of moving the half-tube 2 from an upstream position to a downstream position.

Feature (c) is disclosed in figure 2 and from the fact that the drive member 919 moves up and down along the half-tube 2 leaving the article close to the closed front end as illustrated in the figure.

(iv) Even if it is novel the subject-matter of claims 1 and 5 lacks an inventive step.

Starting from E4 the problem to be solved is to improve the efficiency of the respective method

and apparatus. The features (a) to (c) are disclosed in E6. The skilled person would apply the teaching of E6 to the apparatus of E4 and hence arrive at the respective method and apparatus specified in claims 1 and 5.

The Court of Bologna has found in its decision E7 that the subject-matter of claims 1 and 5 lacks an inventive step. The expert's opinion to which the court refers also applies in the present proceedings.

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

(i) The amendments to the patent comply with Article 123(2) EPC and the ground under Article 100(b) EPC is late filed and should not be admitted into the proceedings.

(ii) The evidence filed does not prove the prior use. Moreover, the machine inspected by the court expert had been modified since its delivery in 1999.

(iii) Claim 1 is novel over the disclosure of E4 since it does not disclose features (a) to (c) as well as the following feature of claim 1:

(d) further drawing back said web until a rear edge of the article contacts the gripper.

The opposition division has already explained why features (a) to (c) are not disclosed in E4. With

respect to feature (d) in E4 there is a staircase arrangement at the entrance to the gripper means and it is clear from the drawings, e.g. figures 2 and 3, that the rear edge of the article does not reach the gripper because of the effect of the staircase arrangement.

- (iv) The subject-matter of claims 1 and 5 involves an inventive step.

Starting from E4 as the nearest prior art the features (a) to (c) solve the problem of stretching the film around the package contents without using an extra element and increasing the production rate. It would not be obvious to apply the teachings of E6 since the apparatus disclosed in this document does not have a tray that can be withdrawn longitudinally from under the article but needs to be withdrawn transversely.

The Court of Bologna has failed to understand the matter properly since the court expert did not understand E4 properly. In any case the respondent is appealing the decision of the court.

Reasons for the Decision

Main request

1. *Added subject-matter*

- 1.1 The appellant argued that the amendment to the description to add an acknowledgement of the prior art

in the form of E4 and the deletion of the words "characterised in that it comprises the further steps of" from claim 1 and "characterised in that it further comprises" from claim 5, constituted added subject-matter.

1.2 With regard to the amendment to the description this was limited to a summary of the content of the relevant prior art document and did not change the description of the invention. Even if the description of the prior art could be considered to put the invention under a different light this is normal since the prior art cited in the opposition proceedings was considered closer to the claimed invention than the prior art cited during the examination proceedings. This amendment, however, does not bring any new content to the disclosure of the invention.

1.3 The deletion of the words which show the two-part form of the claim has no effect on the scope of the claimed subject-matter and therefore cannot add subject-matter.

1.4 The amendments therefore comply with Article 123(2) EPC.

2. *Insufficiency*

2.1 The appellant raised the ground of insufficiency under Article 100(b) EPC for the first time in the appeal proceedings. The respondent did not give permission for the introduction of this ground as is required in accordance with G 9/91 (OJ EPO 1993, 408).

2.2 The ground was therefore not admitted into the appeal proceedings.

3. *Prior use*

3.1 The appellant in its appeal grounds alleged a prior use of a packaging machine sold unconditionally to Levante S.p.A. The prior use is based on a description of the machine and its functioning by an expert appointed by the Court of Bologna (E31) and documents (E32 - E36) purporting to show its date of sale and delivery.

3.2 This allegation was raised during the opposition proceedings. In its communication dated 28 June 2005 the opposition division expressed the view that the prior use would not lead to lack of novelty or to lack of inventive step in the subject-matter of the independent claims of the patent as granted. During the oral proceedings before the opposition division the appellant did not pursue the prior use issue in respect of the patent as finally maintained. The question arises as to whether the actions of the appellant in not presenting arguments during the oral proceedings before the opposition division against the claims presently under discussion but nevertheless presenting such arguments in the appeal proceedings constitutes an abuse of the proceedings. The Board need not pursue this point further since it is clear that based on the facts, evidence and arguments on file the alleged prior use cannot be considered proven so that also its alleged content need not be discussed.

3.3 The machine was inspected by the court expert on 21 January 2003 at the premises of Tintoria Elledue S.r.l. His report and the photographs of the machine form part of E31. His photographs include one of a plate

indicating the serial number of an enveloping machine with model number 850 and its date of construction. The serial number of the machine is shown as 5497 and its construction date as 1999. The priority date of the patent in suit is 21 May 1999 so it is important to know the exact date on which this packaging machine in question was delivered. To this end the appellant supplied during the opposition proceedings a number of documents.

E32 is a brochure for a model 850 machine which is the model in question. Little information about the structure and functioning of the machine can be gleaned from the brochure.

E33 is an invoice to the company Levante S.p.A. for an enveloping machine model 850 which is dated 18 February 1999. The invoice was apparently originally for a machine number 5427 but this number has been crossed out and replaced by number 5497 in a different font. No explication has been offered for this change. It remains unknown as to when and by whom this change was made.

E34 is two invoices to Tintoria Elledue S.r.l. for a model 850 machine number 5921, i.e. a different serial number to the inspected machine. The first invoice is dated 30 June 1999 and the second is dated 16 July 1999, i.e. both dates are after the priority date.

E35 is a delivery document for a model 850 machine which indicates Tintoria Elledue S.r.l. as the destination and Levante S.p.A. as the legal recipient ("cessionario") of the machine. The document is dated 4 February 1999. The document has the machine indicated as serial number 5427

but again this number has been crossed out and replaced by serial number 5497 in a different font. Again no explanation has been offered regarding the circumstances leading to the correction of the document.

E36 is an invoice directed to Cortese S.p.A for parts or work done for an 850 model machine. The invoice is dated 31 July 1998 but no indication of a serial number of a particular machine is given.

E37 is a brochure for a model 750 machine which is not the model in question.

- 3.4 It is quite clear from the above considerations of the documents that the only documents which could lend support to the sale and delivery of a model 850 enveloping machine with serial number 5497 have been altered by changing the serial number of the machine in question. This puts the validity of these documents in doubt and no verifiable explanation has been supplied for these changes.
- 3.5 The lack of verifiable proof of the actual date of delivery of the enveloping machine model 850 with the serial number 5497 as described in E31 means that the prior use must be considered to be non-proven. How this machine was actually constructed and how it functioned as delivered, even supposing that was as described in E31 established on 21 January 2003 (i.e. a considerable time after the priority date), is in that case of no consequence.

4. *Novelty*

4.1 The appellant alleged lack of novelty of the subject-matter of claims 1 and 5 in view of E4, though it supplied no specific argumentation with respect to claim 5.

4.2 The respondent argued that claim 1 is distinguished over the disclosure of E4 by the following features:

(a) the opening station is located upstream of the cutting and welding means,

(b) the article is carried on the support tray with a relative movement through said web up to reaching or overcoming the cutting and welding means, until a front edge of the article is at the front closed end, which has been brought further forward by said tray beyond the cutting and welding means together with the article,

(c) drawing back said tray upstream of the cutting and welding means towards the loading station, leaving the article at said front close end, and

(d) further drawing back said web until a rear edge of the article contacts the gripper.

4.3 The opposition division had considered that only features (a) to (c) were novel and that feature (d) was disclosed in E4.

The Board agrees with the assessment of the opposition division.

4.4 From E4 it is not entirely clear how the disclosed machine works. What is clear is that the movement of the film is effected by the "Einweisblech 816", which

functions as opening means, as indicated by the fact that the attached drive member 919 is provided for movement in the machine direction so that this movement may be effected (see page 12, lines 1 to 5).

The description of E4 is consistent with the insertion station being positioned **downstream** of the gripping and welding means 28 which are not shown in any figure that allows their position relative to the insertion station to be seen.

It is, however, derivable that the opening means 816 would be initially (at the time that the gripping and welding means operate) positioned upstream of the gripping and welding means. The opening means would then be moved by the drive member 919 in the machine direction through the gripping and welding means to a position opposite the insertion means 815. This movement also moves the welded front edge 2b of the film along with the opening means. The article 1a is then inserted into the opened film between the opening means as shown in figure 7 and the opening means are then moved back against the machine direction through the gripping and welding means to their upstream starting position. Then the film is partly drawn back through the nearly closed gripping means as shown in figure 2 whereby inserter 26 of the insertion means 815 remains in place during this action. Thereafter, the inserter must be removed, so that the remaining open side of the package may be closed as shown in figures 4 to 6. The package is then moved further downstream as illustrated in figure 7.

If the insertion means 815 were to be positioned **upstream** of the gripping and welding means 28 (as

claimed in claim 1) then after insertion of the article the opening means as well as inserter 26 of the insertion means would have to move together with the film and the article downstream through the gripping and welding means. However, no such mechanism is disclosed for moving the inserter in the machine direction downstream through the gripping and welding means. Further, after the film has been drawn back through the already nearly closed gripping means and has been welded the inserter would have to be removed and somehow brought back upstream of the gripping and welding means to its starting position. Also for this action no mechanism is disclosed. The inserter 26 of E4 cannot carry out this function by remaining permanently on the downstream side of the gripping and welding means since the description on page 8, lines 1 to 4 clearly shows that the inserter 26 is part of the insertion means which remain in the package during the film drawing back operation, i.e. it must be positioned at the insertion point.

The Board concludes therefore that an upstream positioning of the insertion means relative to the gripping and welding means requires the existence of mechanisms which are not disclosed or hinted at in E4 whereas a downstream positioning of the insertion means is consistent with its disclosure.

- 4.5 Since the Board considers that the insertion means in E4 is positioned downstream of the gripping and welding means and does not move in the longitudinal direction of the film this means that none of features (a) to (c) can be established as disclosed in the document.

4.6 The Board cannot agree with the respondent that feature (d) is not disclosed in E4. It argued that figures 2 and 3 appear to show a space between the gripper and the rear edge of the article leading to the film being angled at the staircase like abutment 28e. However, in the description on page 8, last lines of the first paragraph, it is explicitly stated that the article and its supporting carton are pulled against and abut the side 28d of the gripper 28. When considering the drawings it must be remembered that these are diagrammatic and that gaps depicted in drawings are commonly exaggerated in their width to allow a clear and understandable drawing. The Board is convinced that the skilled person considering the drawing and the explicit statement in the description will understand that feature (d) is disclosed in E4.

4.7 The apparatus claim 5 contains features corresponding to the features which are established by the Board as not disclosed in E4.

4.8 Therefore, the subject-matter of claims 1 and 5 is novel in the sense of Article 54 EPC.

5. *Inventive step*

5.1 The closest prior art is represented by E4 which discloses a method and apparatus comprising the features of claims 1 and 5, except for those already identified as novel in the above assessment of novelty.

5.2 According to the respondent the problem to be solved is to increase the production rate and avoid having elements within the package during its tightening around

the article and its sealing process by the gripping and welding means. The Board can agree with this assessment.

- 5.3 When considering the solution proposed by the features (a) to (c) the essential point to be considered is whether it was obvious for the skilled person to move the support tray together with the article to be packaged in the machine direction through the welding and cutting means as the way of moving the film therethrough and then to move only the tray back against the machine direction through these gripping and welding means to the upstream position where another article may be placed thereon, later to be inserted between the opened wings of the film.

If the skilled person had turned to E6 then he would have received the information that the insertion means which placed the article between the film wings should first be moved downstream through the welding and cutting means, then withdrawn and moved back upstream in some unspecified manner. The teaching of E6 even if applied to the method known from E4 would not have resulted in a method in accordance with claim 1. To arrive at this method it would require the skilled person to modify the apparatus from the form disclosed in E6. In this respect the Board notes that the form of the insertion device 5 used in the apparatus according to E6 makes it unsuitable to leave the article at the closed end of the film and to be moved back through the welding and cutting means since its shape is such that it would move the article back with it. Its shape and functioning together with a means 16 for retaining the article requires it to be withdrawn transversely before

being moved back against the machine direction to its insertion position.

- 5.4 The Board also notes that the difference between the invention as claimed and a combination of the teachings of E4 and E6 is not just that of an alternative solution but brings positive benefits. In particular, the arrangement of E6 requires that mechanisms are provided for transverse movement of the inserter at two longitudinally separated positions, i.e. one upstream and one downstream of the welding and cutting means. According to the method of claim 1 transverse movement only takes place at the upstream position which means that the corresponding equipment need only be provided once or need not be provided in the longitudinally moving carriage for the inserter.

Therefore even if the skilled person considered applying the teaching of E6 to the machine known from E4 he still would not arrive in an obvious manner at the method set out in claim 1 or the apparatus set out in claim 5. For this reason it not necessary to even consider whether he would apply the teaching of E6 to the machine known from E4.

- 5.5 The appellant made reference to court proceedings in Bologna. In the course of these proceedings a court expert came to the conclusion that claims 1 to 6 and 10 lacked an inventive step and that claims 7, 8 and 9 lacked novelty as indicated in the decision of the court (E7). The appellant supplied a translation E8 of this decision. The Board does not consider these findings to be relevant since the detailed reasons for them are not given in the decision. The court refers to some of the

argumentation in the expert opinion but not to enough as to allow it to be evaluated.

5.6 A copy of the complete expert opinion was filed during the opposition proceedings as E5. The opinion is given in the Italian language. The Board in the annex to its summons to oral proceedings pointed out that documents on which a party wished to rely had to be translated into an official language within the set time limit. The appellant did not supply such a translation so that this document was not taken into consideration (Rule 3(3) EPC).

5.7 Therefore, the subject-matter of claims 1 and 5 of the main request involves an inventive step in the sense of Article 56 EPC.

Auxiliary requests

6.1 The respondent responded neither to the notice of appeal nor to its statement of grounds.

In the annex to its summons the Board indicated a last date of submissions of one month before the oral proceedings, i.e. 19 February 2009.

On 19 February 2009 the appellant filed a submission.

On 12 March 2009, i.e. one week before the oral proceedings, the respondent filed a submission which contained arguments in support of its main request and two auxiliary requests with no explanation as to the reasons for the late filing.

With letter of 17 March 2009 the appellant objected to the late filing of the observations as well as the auxiliary requests pointing to the previous lack of action by the respondent.

- 6.2 The Board granted the main request of the respondent, i.e. dismissal of the appeal, so that it is not necessary to consider the admissibility of the late filed auxiliary requests of the respondent.

As arguments in support of a request can even be put forward as late as the oral proceedings itself, the Board did not see any legal basis for not admitting the respondent's observations in support of its main request.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders