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**Datasheet for the decision
of 2 April 2009**

Case Number: T 0776/07 - 3.2.04

Application Number: 96105909.4

Publication Number: 0738478

IPC: A24C 5/35

Language of the proceedings: EN

Title of invention:

Variable-capacity store for elongated elements

Patentee:

G.D. SOCIETÀ PER AZIONI

Opponent:

Focke & Co. (GmbH & Co.)

Headword:

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Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 100(a)

Keyword:

"Claim 1 of all requests - novelty (yes) - inventive step (no)"

Decisions cited:

G 0002/88, T 0651/91, T 0848/93

Catchword:

-



Case Number: T 0776/07 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 2 April 2009

Appellant: Focke & Co. (GmbH & Co.)
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
27 March 2007 concerning maintenance of
European patent No. 0738478 in amended form.

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
T. Bokor

Summary of Facts and Submissions

I. In its interlocutory decision posted 27 March 2007, the Opposition Division found that, taking into consideration the amendments made by the patent proprietor, the European patent and the invention to which it relates met the requirements of the EPC. On 10 May 2007 the Appellant (opponent) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 20 July 2007.

II. The patent was opposed on the grounds based on Article 100(a), (b) and (c) EPC. During the first oral proceedings before the Opposition division the Opponent withdrew the ground for opposition under Article 100(b) EPC.

III. The following documents played a role in the present proceedings:

D12: GB-A-1 301 843

D13: WO-A-94/24026

D14: US-A-4 565 284

IV. Oral proceedings took place on 2 April 2009 before the Board of Appeal.

The Appellant requested that the decision under appeal be set aside and that the patent be revoked.

He mainly argued as follows:

In accordance with the decision of the Enlarged Board of Appeal G 02/88 a claim directed to a new use of a

known device and which contains no technical feature which reflects such new use is invalid under Article 54(1) and (2) EPC. Therefore, the subject-matter of Claim 1 of the main, first and second auxiliary requests lack novelty. D12 discloses a method and a device for storing cigarettes in a variable capacity store comprising a transportation branch exhibiting all the features of that claimed in the contested patent as well as a return branch. D12 does not describe how the return branch is configured. A skilled person would therefore be prompted to design the return branch like the transportation branch, all the more because D13 shows a variable capacity store comprising identical transportation and return branches. That the products are "randomly arranged in a continuous stream" does not add any technical feature with respect to D12. Furthermore, in D12 the supporting device comprises columns which have the same technical effect as the claimed drums. Therefore, using drums instead of columns does not involve inventiveness.

The Respondent (patentee) contested the arguments of the Appellant and submitted that:

A claim directed to a method for storing tobacco product elongated elements comprises the functional feature concerning the storing of tobacco product elongated elements, and is thus limited to the storage of such elements and novel with respect to methods for storing any kind of items.

D12 does not show how the return branch may be designed. A skilled person is aware that a variable capacity store for tobacco product elongated elements must be of huge capacity, but may not become too bulky. Therefore, he would not have realised the return branch

like the transportation branch but would have tried to find a less bulky construction. Since D12 does not give any hint how to carry out the return branch, a skilled person would have looked at other variable capacity stores for cigarettes of the prior art, without taking into consideration stores for other kinds of items like in D13 for example.

That the products are "randomly arranged in a continuous stream" distinguishes from stores where each item is placed in a separate tray. Finally, none of the cited documents shows a supporting device comprising drums.

The Respondent requested that the appeal be dismissed, i.e. that the patent be maintained on the basis of the claims held allowable by the Opposition Division (main request) or alternatively that the decision under appeal be set aside and that the patent be maintained on the basis of one of the first to third auxiliary requests filed with letter of 27 November 2007.

V. Claim 1 held allowable by the Opposition Division reads as follows:

"1. A method for storing tobacco product elongated elements in a variable-capacity store (1; 47); the store (1; 47) comprising an input station (3) and an output station (4) located in series along a path (P) along which the elongated elements (2) are fed; and conveying means (8) for conveying said elongated elements (2), said conveying means (8) extending between the input and output stations (3, 4) and presenting a variable length; said conveying means (8) comprise a continuous endless conveyor (8) defined by a

transportation branch (9) for transporting said elongated elements (2), and by a return branch (10), said transportation branch (9) and said return branch (10) respectively presenting a first length (L1) and a second length (L2) complementary to each other; said transportation branch (9) extending from said input station (3) to said output station (4); said return branch (10) extending from said output station (4) to said input station (3); and varying means (11) being provided for varying said lengths (L1, L2) in complementary manner; said varying means (11) comprising first transmission means (12) connected to the transportation branch (9) and adjustable to define, along the transportation branch (9), a first spiral (26) of adjustable length (L1); and second transmission means (13) connected to the return branch (10) and adjustable to define, along the return branch (10), a second spiral (27) presenting a length (L2) adjustable in complementary manner to the length (L1) of the first spiral (26); said first transmission means (12) comprising a first supporting device (33) for supporting said first spiral (26); and said second transmission means (13) comprise a second supporting device (34) for supporting said second spiral (27); said varying means (11) comprising actuating means (35), the method comprising the step of expanding and contracting said first (33) and second (34) supporting devices to vary the lengths (L1, L2) of said spirals (26, 27) by said actuating means (35)."

Claim 1 of the first auxiliary request:

This claim differs from claim 1 of the main request in that "randomly arranged in a continuous stream (6)" has

been introduced after "A method for storing tobacco product elongated elements".

Claim 1 of the second auxiliary request:

This claim differs from claim 1 of the first auxiliary request by the addition of the features of claim 2 as maintained (claim 4 as granted).

Claim 1 of the third auxiliary request:

This claim is a combination of claims 1 to 4 as granted.

Reasons for the Decision

1. The appeal is admissible.
2. *Novelty:*
 - 2.1 Novelty of the subject-matter of claims 1 of the main, first and second auxiliary requests has been contested with respect to D13 and D14. Novelty of claim 1 of the third auxiliary request has not been challenged by the Appellant and the Board is satisfied that novelty of the subject-matter of this claim is given.
 - 2.2 Claim 1 of the main, first and second auxiliary requests relates to "A method for storing tobacco product elongated elements in a variable-capacity store". According to the Guidelines for Examination in the EPO, C-III, 4.13 and decision T 848/93 (not published) the intended use in a method claim does

limit the claim. Thus claim 1 is limited to a method for storing tobacco product elongated elements and not merely to a method that would be suitable for storing tobacco product elongated elements.

The Appellant argued that the generic disclosure "any kind of items" also includes "tobacco product elongated elements" and thus deprives this specific feature of novelty.

This cannot be accepted. It is established case law that a specific disclosure takes away novelty of a generic feature in a claim but that a generic disclosure does not take away novelty of a specific feature (see T 651/91 point 4.3 and Guidelines for Examination in the EPO, C-IV, 9.5, December 07 version).

Consequently, D13 and D14 which relate to a method for storing any kind of items and more especially ice-cream, respectively cakes of soap do not take away novelty of a method for storing tobacco product elongated elements.

- 2.3 The Appellant further quoted a passage of the decision of the Enlarged Board of Appeal G 02/88 (OJ EPO 1990, 093) which reads "a claim to a new use of a known compound (the new purpose of such use being the only potentially novel feature), if on its proper construction the claim contains no technical feature which reflects such new use, and the wording of the claim which refers to such new use is merely mental in nature and does not define a technical feature, then the claim contains no novel technical feature and is invalid under Article 54(1) and (2) EPC (because the

only technical features in the claim are known)". The Appellant then concluded that according to this passage, the subject-matter of the claimed method which adds no technical feature which respect to the corresponding former device claims is deprived of novelty.

This point of view cannot be shared by the Board. The decision G 02/88 relates to a "new use of a known compound" and thus to claims which seek protection for a new, i.e. a "second" different use of a known compound, and which therefore must distinguish the claimed subject-matter from the first genuine use of this compound by a technical feature reflecting such a new use. In the present case, the claimed subject-matter is a method for storing tobacco product elongated elements and not a new use of a known device for the intended purpose of storing tobacco product elongated elements. Accordingly, the above cited decision does not apply to the present case.

2.4 Thus, novelty of the subject-matter of claim 1 of the main and first to third auxiliary requests is given with respect to D13 and D14.

3. *Inventive step:*

3.1 Main request:

D12 is considered to be the closest prior art since it relates to the same technical field as the contested patent and presents the most features in common with the claimed invention.

D12 (figures) discloses a variable-capacity store and implicitly a method for storing cigarettes (page 1,

lines 11 and 12); the store (13) comprises an input station and an output station (junction between the conveyor 10 and 14, respectively 14 and 12) located in series along a path along which the cigarettes are fed; and conveying means (14) for conveying said cigarettes, said conveying means extending between the input and output stations and presenting a variable length; said conveying means comprise a continuous endless conveyor (14) defined by a transportation branch (17 to 19) for transporting said cigarettes, and by a return branch (inside container 21), said transportation branch and said return branch respectively presenting a first length and a second length complementary to each other; said transportation branch extending from said input station to said output station; said return branch (10) extending from said output station to said input station; and varying means being provided for varying said lengths (page 1, lines 20 to 36; 15, 16) in complementary manner; said varying means comprising first transmission means (15, 16) connected to the transportation branch and adjustable to define, along the transportation branch, a first spiral (17, 19) of adjustable length; and second transmission means connected to the return branch presenting a length adjustable in complementary manner to the length of the first spiral (page 1, lines 27 to 29); said first transmission means comprising a first supporting device (15, 16) for supporting said first spiral; said varying means comprising actuating means (implicit), the method comprising the step of expanding and contracting said first and second supporting devices to vary the lengths of said conveyor branches by said actuating means (page 1, lines 40 to 54).

Thus the method according to claim 1 of the main request differs from that disclosed in D12 in that: the second transmission means are adjustable to define, along the return branch, a second spiral, and the second transmission means comprise a second supporting device for supporting said second spiral.

D12 does not show how the conveyor material reservoir, i.e. the return branch may be designed.

Thus starting from D12 as closest prior art, the objective technical problem underlying the present invention may be seen in providing a device of the kind disclosed in D12 with a suitable return branch construction.

A skilled person seeking to design the return branch would normally first try to implement the easiest solution which is to merely replicate the transportation branch configuration and thus arrive at the claimed method, all the more because such a configuration (identical transportation and return branches) is already suggested by D13. This could also improve the interchangeability of the elements of the return branch with those of the transportation branch and thus the modularity of the store design.

The Respondent argued that a skilled person is aware that a variable capacity store for tobacco product elongated elements must be of huge capacity, but may not become too bulky. Therefore, there would be a prejudice against realising the return branch as bulky as the transportation branch.

However the Respondent did not file any evidence in support of this alleged prejudice. On the contrary D13 shows a variable capacity store in which the design of the return branch is in essence the same as that of the transportation branch.

The Board does not dispute that the skilled person may well have concerns about the volume of the construction in certain circumstances. However, in other circumstances this may be of marginal importance only, and concerns of accessibility of the construction, for example for ease of repair, and the desire for the modular construction, for example for a smaller spare parts reserve, may be more important. Therefore, the skilled person would reasonably contemplate the duplication in the transportation branch.

Accordingly, the subject-matter of claim 1 of the main request does not involve an inventive step.

3.2 First auxiliary request:

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that "randomly arranged in a continuous stream (6)" has been introduced after "A method for storing tobacco product elongated elements". This additional feature too is already known from the closest prior art document D12, see page 1, lines 70 to 74.

Consequently, for the same reasons already mentioned, the subject-matter of claim 1 of the first auxiliary request does not involve an inventive step either.

3.3 Second auxiliary request:

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request by the addition of the features of claim 2 as maintained (claim 4 as granted). These additional features specify in essence that each of the first and second supporting devices comprise at least two drums.

According to Figure 2 of the contested patent the two first (external) drums are configured as two semi-cylindrical shells and the two second drums (inside the first ones) are configured as two semi-columns.

D12 (Figure 1) shows a supporting device comprising two columns 15 and 16 at a distance from a chain dotted centre line figuring the path of the conveyor. The two columns are said to form a guide assembly (page 1, lines 86 to 93). On page 2, lines 30 to 32 it is indicated although with respect to an alternative embodiment "... conveyor ... to be capable of carrying the cigarette stack through the necessary semi-circular path." Thus, the path is necessary semi-circular.

The Respondent argued that although D12 refers to columns, the Figures are schematic and do not show how the supporting means are configured between the columns and the conveyor.

However, since in the embodiment of Figure 2 of the patent under appeal the second drums are depicted as columns, columns are to be construed as drums in the meaning of the patent under appeal. Likewise in the same Figure the first drums are depicted as semi-cylindrical shells, thus the columns in D12 are to be

construed as drums because they also define a semi-circular path.

Consequently, the subject-matter of claim 1 of the second auxiliary request does not involve an inventive step either.

3.4 Third auxiliary request:

Claim 1 of the third auxiliary request is a combination of claims 1 to 4 as granted.

Thus, although it relates to a device (a variable capacity store) this claim comprises in essence the same technical features as claim 1 of the second auxiliary request.

Therefore, the line of argument brought forward with respect to the subject-matter of claim 1 of the second auxiliary request applies mutatis mutandis to the subject-matter of claim 1 of the third auxiliary request. Accordingly the subject-matter of claim 1 of the third auxiliary request does not involve an inventive step either.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The European patent is revoked.

The registrar:

The Chairman:

M. Schalow

M. Ceyte