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**Datasheet for the decision
of 1 August 2012**

Case Number: T 2133/10 - 3.2.04

Application Number: 03799567.7

Publication Number: 1575386

IPC: A24C 5/18

Language of the proceedings: EN

Title of invention:

Product change method for a cigarette manufacturing machine

Patentee:

G.D SOCIETÀ PER AZIONI

Opponent:

Hauni Maschinenbau aG

Headword:

-

Relevant legal provisions:

EPC Art. 14(2), 100a), 111(1), 112(1)a), 123(2)
EPC R. 6(3), 103

Keyword:

"Admissibility of the Patentee's appeal (yes)"
"Public availability - prior use (no) - A3 (yes)"
"Remittal (no)"
"Main request and auxiliary requests 1, 4-7, 12, 13 -
inventive step (no)"
"Auxiliary requests 2, 3 and 8-11 - extended subject-matter (yes)"
"Reimbursement of the appeal fee - question to the EBA - refused"

Decisions cited:

G 0006/91, T 0133/87, T 1067/97, T 0714/00, T 0713/02

Catchword:

-



Case Number: T 2133/10 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 1 August 2012

Appellant 2:
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Appellant 1:
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
16 August 2010 concerning maintenance of
European patent No. 1575386 in amended form.

Composition of the Board:

Chairman: A. de Vries
Members: C. Scheibling
C. Heath
P. Petti
T. Bokor

Summary of Facts and Submissions

- I. In its interlocutory decision posted 16 August 2010, 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 13 October 2010 the Opponent (Appellant 1) filed an appeal, having paid the appeal fee on 12 October 2010. On 18 October 2010 the Proprietor (Appellant 2) filed an appeal and paid the appeal fee simultaneously. The statements setting out the grounds of appeal were received on 17 December 2010 (Opponent) respectively on 24 December 2010 (Proprietor).
- II. The patent was opposed on the grounds of Articles 100(a) and (b) EPC.
- III. The following documents played a role in the present proceedings
- A3: "Verteiler VE 2 - Strangeinheit SE 2, Handbuch Bedienen und Einrichten, HBE.2545.00.2.d", edition 6/1994, selected pages
- Mr. Koepke's testimony:
- Minutes of the taking of evidence by the hearing of Mr. Koepke recorded during the oral proceedings before the Opposition division and the subsequent correction thereof
- IV. Oral proceedings before the Board took place on 21 June and 1 August 2012.
- V. The Appellant 1 (Opponent) requests that the decision under appeal be set aside, the patent be revoked.

Additionally that the appeal filed by the Patentee be rejected as inadmissible.

The Appellant 2 (Proprietor) requests that the decision under appeal be set aside and that the patent be maintained as granted, alternatively that the patent be maintained on the basis of one of the auxiliary requests 1 to 5 filed with the grounds of appeal or of one of the auxiliary requests 6 to 13 filed with letter dated 22 July 2011. He also requested that the appeal fee be reimbursed and that a question be referred to the Enlarged Board of Appeal.

VI. The Appellant-opponent mainly argued that according to the decision G 06/91, a fee reduction according to Rule 6(3) EPC is granted only if the essential item of the first act is filed in an official language of the State concerned and the necessary translation is supplied no earlier than simultaneously. This was presently not the case.

The testimony of the witness which was heard by the first instance is to be considered as a piece of prior art and reflects what common general knowledge was at the priority date of the patent in suit.

Document A3 is a handbook relating to a machine of the Protos 2 type and was delivered with each machine of this type. Since any member of the public could purchase such a machine, the handbook which belongs to it, was likewise available to the public. If A3 is admitted into the proceedings the case should be remitted to the first instance.

The subject-matter of claim 1 of the main and auxiliary requests 1, 4 and 5 lacks novelty over A3 or at least does not involve an inventive step when starting from

A3 and taking into account the normal capability of the skilled person. The auxiliary requests 6 to 13 filed after the statement of the grounds of appeal should not be admitted into the proceedings. The subject-matter of claim 1 of auxiliary requests 6, 7, 12 and 13 does not involve an inventive step when starting from A3 and taking into account the normal capability of the skilled person. Claim 1 of auxiliary requests 2, 3 and 8 to 11 infringes Article 123(2) EPC.

The Appellant-proprietor mainly submitted that:

All documents relating to the notice of appeal were filed together as one single fax, thus simultaneously in the meaning of G 06/91. The witness which was heard before the first instance, was an employee under contract and therefore not a member of the public. Consequently, what he could have seen was not publicly available.

A3 bears a statement forbidding the owner of the handbook to make its content accessible to third parties. Therefore it was to be kept secret and was thus not available to the public. If A3 is admitted, the case should not be remitted.

A3 does not indicate how to perform a product change, it does not disclose to form a waste stream to unload the first type of tobacco nor does it indicate that the second type of tobacco is fed to the machine only when the first type has been totally removed. Furthermore, there is no hint in A3 to combine the different steps disclosed therein so as to perform a product change. A3 does not disclose to stop the paper strip and the deflector of this machine would be unable to deflect a bead of tobacco that is not wrapped into paper.

The late filed documents A10 to A29 could have been filed during the opposition proceedings and should therefore not be admitted into the proceedings. Auxiliary requests 6 to 13 were filed with the response to the Opponent's appeal and are therefore admissible.

VII. Claim 1 as granted reads as follows:

"A product change method for a cigarette manufacturing machine, wherein an input hopper (2) receives a first type (3a) of shredded tobacco from a supply header (4), and feeds it to at least one channel (17) for forming a bead (19) of tobacco, which is released onto a paper strip (22) travelling along a forming table (20) for forming a continuous cigarette rod (21); the method comprising the steps of cutting off supply of said first type (3a) of tobacco to said manufacturing machine (1); unloading the first type (3a) of shredded tobacco from the manufacturing machine (1) to form a waste stream (30) of shredded tobacco of the first type (3a); and feeding a second type (3b) of shredded tobacco through the supply header (4) and the input hopper (2) until the manufacturing machine (1) is completely full."

Claim 1 of auxiliary request 1 adds to claim 1 as granted that the tobacco of the first type is unloaded "by means of the manufacturing machine (1) itself".

Claim 1 of auxiliary request 2 adds to claim 1 as granted the following wording "the method being carried out without stopping the machine and clearing the various compartments of the machine either by hand or using external suction devices".

Claim 1 of auxiliary request 3 adds to claim 1 as granted, the additional features of auxiliary requests 1 and 2.

Claim 1 of auxiliary request 4 adds to claim 1 as granted the following wording "the first type (3a) of tobacco being unloaded by deflecting said bead (19) of tobacco".

Claim 1 of auxiliary request 5 adds to claim 1 as granted the following wording "the first type (3a) of tobacco being unloaded by deflecting said bead (19) of tobacco into container means (31)".

Claim 1 of auxiliary request 6 (as considered allowable in opposition) adds claim 1 as granted, the features of claim 2 as granted, i.e. "wherein unloading the first type (3a) of tobacco comprises the step of arresting said paper strip (22)".

Claim 1 of auxiliary request 7 further adds to claim 1 of auxiliary request 6: "wherein the first type (3a) of tobacco being unloaded by deflecting said bead (19) of tobacco into container means (31)".

Claim 1 of auxiliary request 8 further adds to claim 1 of auxiliary request 6: "while leaving the rest of the manufacturing machine (1) running".

Claim 1 of auxiliary request 9 further adds to claim 1 of auxiliary request 6: "by stopping a feed line (23) of the paper strip (22) and simultaneously cutting paper strip (22) at a cutting station (24), while

leaving the rest of the manufacturing machine (1) running".

Claim 1 of auxiliary request 10 adds to claim 1 as granted that "said manufacturing machine (1) is switched over to a different type of cigarette by first closing a valve (12a) to cut off supply of shredded tobacco of the first type (3a), stopping a feed line (23) of the paper strip (22), and simultaneously cutting the paper strip (22) at a cutting station (24), while leaving the rest of manufacturing machine (1) running, so that all the remaining shredded tobacco of the first type (3a) is sucked into a box (5), which is then opened, under the control of level sensor (9), to unload the remaining shredded tobacco of the first type (3a) into input hopper (2) and so empty header (4) completely."

Claim 1 of auxiliary request 11 further adds to claim 1 of auxiliary request 10: "this operation continues until manufacturing machine (1) is cleared completely; at this point, with the machine in the same configuration described above, but with suction restored along suction conduit (10), valve (12b) is opened to feed shredded tobacco of a second type (3b) directly into input hopper (2) and afterwards only into box (5).

Claim 1 of auxiliary request 12 adds to claim 1 as granted, the features of claim 5 as granted, i.e. "the first type (3a) of tobacco being unloaded by deflecting said bead (19) of tobacco into container means (31) at an output end of said forming table (20)".

Claim 1 of auxiliary request 13 adds to claim 1 of auxiliary request 12 the features of claim 2, i.e. "unloading the first type (3a) of tobacco comprises the step of arresting said paper strip (22)".

Reasons for the Decision

1. *Admissibility of the appeals*

1.1 The appeals lodged by both parties meet the requirements of articles 106 to 108 EPC and are therefore admissible.

1.2 The Opponent (Appellant 1) considered that the requirements of Rule 6(3) EPC concerning the reduction of the appeal fee were not met, that the paid amount was not correct and that therefore, the appeal lodged by the Patentee was to be rejected as inadmissible. He referred to the decision of the Enlarged Board of Appeal G 06/91 (OJ EPO 1992, 491) which states that "the persons referred to in Article 14(2) EPC are entitled to a fee reduction if they file the essential item of the first act in filing, examination or appeal proceedings in an official language of the State concerned other than English, French or German, and supply the necessary translation no earlier than simultaneously". The Opponent noted that in the present case, the fax transmission of the English translation of the notice of appeal was completed before that of the original Italian notice of appeal and that therefore the English translation has been supplied earlier rather than together with regard to the Italian text.

Rule 2 EPC and Article 3 of the Decision of the President date 12 July 2007 concerning the filing of patent applications and other documents by facsimile (Special edition No.3, OJ EPO 2007, A. 3) read in conjunction with Rules 99(3) and Rule 50 EPC allow for the filing of the notice of appeal by facsimile. As set out in Article 5 of this decision documents filed by facsimile are accorded a single filing date. This is in particular to determine whether time limits, which are calculated in terms of days as smallest time unit, have been met. The implication of a single filing date is that a filing of documents by facsimile constitutes a single filing act, so that a facsimile filing for all intents and purposes can be considered equivalent to a filing by other means allowed under Rule 2(1). With one exception (a fax transmission extending beyond midnight), all documents received in a single fax transmission are thus considered to have been filed together on the same date and form part of a single filing.

Turning to G 6/91 (OJ EPO 1992, 491) cited by the Appellant-Opponent, this decision by the Enlarged Board considered the questions concerning inter alia filing requirements for fee reduction under Rule 6(3) arising in a specific case in which an appeal was filed in the form of a letter in Dutch accompanied by a translation into English, cf. summary, point II. The Enlarged Board weighed various considerations of such a filing of original and translation "at the same time" (cf. reasons 7 and 10), and held that, indeed, a party who wanted to benefit from a fee reduction under Rule 6(3) must file the translation "no earlier than

simultaneously" with the original, reasons 12. From a contextual reading of these separate parts the Board infers that the terms "at the same time" and "simultaneously" are used synonymously and are meant at least to cover the case at hand, i.e. where original and translation were filed together in a single filing on the same date. Thus, if original and translation are filed together fee reduction under Rule 6(3) should apply.

In the present case, as is clear from the transmission date recorded at the top and bottom of each page, all of the pages of the facsimile, including the Italian text and its English translation, were received in a single fax transmission on a single date recorded as 2010-10-18. This is also not changed by the fact that the exact time of reception of the individual pages of the fax transmission was also recorded on each page, thus showing a few seconds of delay between the pages. Consequently, both the notice of appeal in Italian and in its English translation were filed together in a single filing act of single filing date. This situation is thus analogous to that underlying G 06/91 but for the means of filing. As it can be inferred from the above decision of the President that filing by facsimile is legally equivalent to filing by any other means, it follows that the present case should therefore also benefit from a fee reduction under Rule 6(3). The Board adds that a narrower reading of G 01/91 which would differentiate between the different filing means would be alien to the broad principle of equity underlying that decision.

That the translation is not expressly identified as such in immaterial. Its nature and function are immediately clear from the express mention of Rule 6(3) EPC and Article 14(3) RFee and the corresponding 20% fee reduction. Thus, for example the Receiving Section had no problem in establishing that a fee reduction under Rule 6(3) was sought, and duly applied one.

The Board concludes that the requirements for a fee reduction of Rule 6(3) EPC were met and that therefore the correct fee has been paid. As otherwise all requirements of Article 108 and Rule 99 EPC have been met, the Board finds the proprietor's appeal to be admissible.

Nevertheless, the Board notes that the Patentee could have made things clearer by identifying the English version of the notice of appeal as being a translation.

2. *Testimony of the witness*

The fact that the witness has seen that different manufacturers at different geographic locations apply the same product change procedure, might be an indication that this procedure represented a standard procedure followed by a majority of companies. Nevertheless, as is evident from his testimony when he witnessed these product changes, he was present on the premises in the capacity of an employee under contract and thus not as a member of the public. That, as argued by the Opponent, the witness might have felt free to speak about this procedure because he was convinced that it belonged to the state of the art is of no relevance in this context, as, due to the contract, he will have been under an implicit obligation to maintain

secrecy. Furthermore, the witness did not observe a brand change in all the factories he went to and his testimony is not backed up as to whether everywhere product changes were carried out according to the same method.

Thus, the Board concludes that individual occasions of the change of product as described by the witness neither belongs to the prior art nor is it a conclusive proof of common general knowledge.

3. A3

3.1 A3 is a handbook relating to a Protos 2 machine ("Verteiler VE2" and "Strangeinheit SE2"), which was delivered together with the corresponding machine. The handbook on file bears the publication date 06/1994 and the Board has no reason to suspect that the witness was wrong when he stated that the first machine of this type was delivered in 1991 (see page 7/33, paragraph 4 of the testimony). That the handbook was publicly available is corroborated by the fact that other parts of this same handbook were filed on 11 January 2001 and 2 February 2001 in public proceedings concerning other patents (EP 0 755 635 and EP 0 755 636) and thus before the priority date of the patent in suit in the present proceedings.

It is true, as noted by the Patentee that page 2 of the document bears restrictions as to its use and more particularly that said document may not be copied or delivered to third parties. Such a statement merely asserts the author's copyrights ("urheberrechtlich"). It does contradict the fact that the handbook will have

been made available to the public - albeit under the limited terms of the copyright - by virtue of the fact that the machine together with the handbook could be freely purchased by any member of the public. No convincing evidence that machine and handbook were not sold together has been submitted. Thus the machine and the handbook have been made available to the public by having been marketed and sold.

- 3.2 The Opponent has requested that, if A3 is admitted into the proceedings, the case be remitted to the first instance in order to benefit from two levels of jurisdiction.

However, Article 111(1) EPC establishes no absolute right for parties to have all issues raised in appeal proceedings examined by two successive instances; on the contrary, it gives the Board of Appeal the discretion to decide in the light of the circumstances of the case, whether or not to remit it to the department of first instance, see inter alia T 0133/87, point 2 of the reasons.

In balancing the interests of the parties the Board decided that the Appellant-proprietor's interest in a speedy decision outweighed the Appellant-opponent's interest in a two-instance consideration. This was in particular so as A3 had been filed by the Appellant-opponent himself already in opposition and together with detailed submissions so that he was well aware of its content. Moreover, if the Board were to remit immediately without any consideration of the main request and simply with the instruction to also consider A3 it seems unlikely that the opposition

division would revise its negative finding regarding the main request based on evidence already on file. The Board could therefore only remit if it first reviewed the decision's findings in the light of that original evidence and then came to a different conclusion. The Board considered such a limited review neither feasible, having decided to admit A3 as prima facie prejudicial evidence, nor in the interest of overall procedural economy.

The Board decided therefore not to remit the case, as requested by the Appellant-opponent and to decide the case in the light of A3, according to Article 111(1) EPC.

4. *Main request and auxiliary request 1*

4.1 A3 discloses a cigarette manufacturing machine, shown in the figures on pages 92 and 94, wherein an input hopper receives a first type of shredded tobacco (top right of the figure) from a supply header, and feeds it to at least one channel for forming a bead of tobacco (centre left of the figure on page 94), which is released onto a paper strip travelling along a forming table, shown in detail in the figures on pages 200 and 202, for forming a continuous cigarette rod, see page 203, 5.15, first two lines.

In section 3.4 on page 69, A3 discloses a procedure for stopping production and shutting down the machine which includes cutting off supply of tobacco to said manufacturing machine followed by a run-out step in which the machine is emptied by running it without feed ("Tabakspeicher und Stauschacht werden ... leergefahren). This run-out necessarily implies the formation of a

waste stream of shredded tobacco as the tobacco is transported out of the machine by the suction conveyor ("Saugband", page 200), onto the conveyor of the forming table.

Sections 3.1 and 3.2 of pages 67 and 69 describe the start-up procedure of the machine comprising feeding of shredded tobacco through the supply header and the input hopper until the manufacturing machine is completely full.

Finally, page 79, section 4.2.3 indicates the possibility of performing a product change.

- 4.2 However, A3 is silent as to how to proceed in case of product change, nor does the Board believe that such information can be inferred directly and unambiguously from A3.

Consequently, those features in claim 1 that define in concrete terms how the changeover procedure takes place - cutting off supply and unloading *tobacco of a first type* followed by filling up the supply header with a *second type of tobacco* - represents differences of the claimed method over A3.

Accordingly the subject-matter of claim 1 of the main and auxiliary request 1 is novel with respect to A3.

It follows directly that the associated objective technical problem can be formulated as how to realise a product changeover in a manufacturing machine as in A3.

- 4.3 Considering that a product changeover necessarily implies stopping production of a product with a first type of tobacco in order to start production of another

product with a second type of tobacco, it is obvious for the skilled person to use the procedures for stopping respectively starting production already available in A3. He will thus as a matter of course realise a product changeover in a machine as in A3 by simply shutting down production for the first product and running the machine empty of the first tobacco type using the normal shut down procedure followed by restarting the machine with the second different type of tobacco in accordance with the normal start-up procedure. He will so arrive at the method of claim 1 as granted without an inventive step.

4.4 The Patentee argued that there is no indication in A3 how the remaining first type of tobacco is discharged. However as explained in section 5.1 above, since according to A3 unloading is done by the machine itself, there is no alternative to unloading it via the conveyors through the forming table and into the waste bin.

He further contended that A3 does not teach to add the second type of tobacco only when the machine is clear of the first type. However it is common general knowledge in the art that cigarette manufacturers due to strict requirements and perceptions of brand identity will want to exclude at all costs that tobaccos mix and that cigarettes containing a mix could be put on the market. Therefore a skilled person would never consider feeding a second type of tobacco into a cigarette maker which still contains amounts of tobacco of another type.

4.5 Consequently, the subject-matter of claim 1 of the main and the auxiliary request 1 does not involve an

inventive step having regard to A3 and the normal skills and abilities of the skilled person.

5. *Auxiliary requests 2 and 3*

5.1 Claim 1 of these requests comprises the following additional feature: "the method being carried out without stopping the machine and clearing the various compartments of the machine either by hand or using external suction devices".

5.2 The Patentee argued that this statement is derivable from the introductory part of the originally filed description relating to the prior art and the object of the invention, original description, page 1, lines 13 to 24. It is stated in this section that "On cigarette manufacturing machines, product changes are normally made by stopping the machine and clearing the various compartments of the machine either by hand or using external suction devices. Which operations obviously involve relatively long machine stoppages and the use of skilled labour". Furthermore, "It is an object of the present invention to provide a product change method for a cigarette manufacturing machine, designed to eliminate the aforementioned drawback."

5.3 From these passages it can only be inferred that "relatively long machine stoppages" should be avoided. This however does not necessarily imply that the machine is not stopped at all. It would still allow for relatively *short* machine stoppages.

5.4 Moreover, page 1, last sentence of the originally filed description states "substantially without stopping the

machine" and in fact, page 5, lines 19 to 24 states "Manufacturing machine 1 is switched over to a different type of cigarette by first closing valve 12a to cut off supply of shredded tobacco 3a, stopping feed line 23, and simultaneously cutting paper strip 22 at cutting station 24 (Figure 3), while leaving the rest of manufacturing machine 1 running ..." Thus in the detailed embodiment the machine is in fact partially shut down.

- 5.5 Thus there is no basis in the originally filed description for asserting that the method is carried out without stopping the machine.
- 5.6 Accordingly, the amendments carried out in claim 1 of auxiliary requests 2 and 3 do not meet the requirements of Article 123(2) EPC.
- 6. *Auxiliary requests 4 and 5*
 - 6.1 Claim 1 of auxiliary request 4 adds to claim 1 of the main request (as granted): "the first type (3a) of tobacco being unloaded by deflecting said bead (19) of tobacco" with claim 1 of auxiliary request 5 adding that: "the bead (19) of tobacco is deflected into container means (31)".
 - 6.2 The machined of A3 (see the figures on page 216 at 54) is equipped with a deflecting device ("Strangabschläger" on page 217) which deflects the bead of tobacco into a waste container ("Schußkasten," page 217, paragraph 5.15.2) when the tobacco rod does not exhibit the required quality. The deflector as indicated on page 217 operates in particular during the

shut-down and start-up of the cigarette maker. These additional features are thus already disclosed in A3.

6.3 The Patentee contended that it is not indicated in A3 that *all* tobacco to be discharged to waste is unloaded by deflecting the bead.

However, this is not required by claim 1. In any case, as already stated in section 5.4 above, there is no other way to discharge the tobacco by the machine itself disclosed in A3 and it would only be natural for the skilled person to use the deflector and container to unload and collect the waste tobacco during shut-down for the first product.

6.4 Accordingly, for the same reasons as mentioned with respect to the subject-matter of claim 1 of the main and auxiliary request 1, the subject-matter of claim 1 of the auxiliary requests 4 and 5 does not involve an inventive step.

7. *Admissibility of auxiliary requests 6 to 13*

The auxiliary requests 6 to 13 were filed with the response to the grounds of appeal of the Opponent. These requests could hardly have been filed before it was clear that the patent as maintained in amended form by the interlocutory decision of the Opposition division was effectively challenged by the Opponent by lodging an appeal.

The Board therefore decided to exercise its discretion in admitting these requests into the proceedings.

8. *Auxiliary requests 6 and 7*

- 8.1 Claim 1 of auxiliary request 6 adds to claim 1 of the main request (as granted) the features of claim 2 as granted, i.e. "wherein unloading the first type (3a) of tobacco comprises the step of arresting said paper strip (22)".

As indicated in A3 (figures on page 200; page 201, first sentence of the paragraph headed "Papiereinfädeln"; and page 205, the paragraph headed "Formatbänder") the paper strip is transported by the conveyor of the forming table once enough tobacco is deposited on the paper strip, that is, only then it does exert sufficient pressure on the underlying paper strip for it to be pulled along by the conveyor as explained by the Appellant-opponent.

Thus, when the machine according to A3 is unloaded by running it empty, at a certain point the amount of tobacco deposited on the paper strip will become insufficient for pulling the paper strip along with the conveyor belt and consequently the paper strip will stop.

From this it follows that, the run-out procedure as described in A3 will automatically result in the paper strip being arrested. It is common sense that the skilled person when noticing that the paper strip stands still, will at least at this moment, if not earlier, stop the paper feed line in order to avoid clogging the machine.

- 8.2 Claim 1 of auxiliary request 7 further adds to claim 1 of auxiliary request 6: "wherein the first type (3a) of

tobacco being unloaded by deflecting said bead (19) of tobacco into container means (31)".

This feature has already been discussed *per se* in section 7 above.

The Patentee argued that in conjunction with arresting the paper strip during unloading this additional feature reduces the amount of paper in the waste bin, so that especially at the end of the unloading operation only tobacco and no paper is deflected into the waste bin. The resultant waste would have a smaller or no paper content and would be easier to recycle leading to less wastage overall.

This alleged advantage is however not deducible from the specification of the patent under appeal. Moreover, since in the machine according to A3 the paper strip stops when, at the end of the unloading operation, the tobacco supply becomes irregular, in this prior art too, from a certain point paper will no longer be transported and deflected into the waste bin.

The Patentee also contended that the deflector shown on page 216 of A3 is too small to properly deflect a "naked" tobacco bead. This is however a purely speculative statement, all the more that, as explained above, at the end of the unloading operation of the machine of A3 the bead of tobacco exiting the forming table will be "naked" too.

Moreover, the Board is unable to see any combinative or synergetic effect between "arresting the paper strip" and "unloading the tobacco by deflecting the bead". The combination of these groups of features is thus nothing

more than the mere straightforward juxtaposition of features that are obvious *per se* and which therefore do not involve an inventive step.

- 8.3 Consequently, since the additional features as well as the subject-matter of claim 1 of the main request were found to lack an inventive step, the subject-matter of claim 1 of the auxiliary requests 6 and 7 lacks an inventive step, too.

9. *Auxiliary requests 8 to 11*

- 9.1 These requests comprise features taken from parts of the originally filed description that are identical to the patent specification, paragraphs [0017] to [0019].

According to the established case law of the Boards of Appeal, it is normally not admissible to extract an isolated feature from a set of features that have originally been disclosed in combination and to add it to the claimed subject-matter, if there is a structural or functional relationship between those features; see in particular T 1067/97 and T 0714/00.

- 9.2 In the present case, paragraphs [0017] to [0019] disclose the claimed product change method in a specified sequence of functionally interrelated steps. Auxiliary request 8 adds one, auxiliary request 9 adds some and auxiliary request 10 adds all the steps described in specification paragraph [0017], while auxiliary request 11 also adds the step set out in the first sentence of specification paragraph [0019].

All these requests at least omit the intermediate steps that appear in specification paragraph [0018] and the remaining part of specification paragraph [0019].

It is however not apparent to the Board that any of these steps can be omitted without effecting the outcome of the sequence, nor has the Appellant-proprietor provided any compelling evidence to the contrary.

9.3 Consequently, claim 1 of auxiliary request 8 to 11 comprises amendments which do not meet the requirements of Article 123(2) EPC.

10. *Auxiliary requests 12 and 13*

10.1 Claim 1 of auxiliary request 12 adds to claim 1 as granted, the features of claim 5 as granted, i.e. "the first type (3a) of tobacco is unloaded by deflecting said bead (19) of tobacco into container means (31) at an output end of said forming table (20)" and claim 1 of auxiliary request 13 adds the further features of claim 2 as granted, i.e. "wherein unloading the first type (3a) of tobacco comprises the step of arresting said paper strip (22)".

10.2 For the reasons already indicated in sections 9.1 and 9.2 above, each of the group of additional features quoted above is obviously derivable from A3 when taking into account the normal skills and abilities of the skilled person.

Furthermore, as stated in the last paragraph of section 9.2 above, these groups of features are not functionally interdependent, and their combination is

nothing more than the mere straightforward juxtaposition of obvious features.

Accordingly, for the reasons already indicated with respect to the subject-matter of claim 1 of auxiliary requests 6 and 7, the subject-matter of claim 1 of auxiliary requests 12 and 13 does also not involve an inventive step.

11. *Reimbursement of the appeal fee - referral of a question to the Enlarged Board of appeal*

11.1 It is a prerequisite of Rule 103 EPC that the appeal be allowed in order that reimbursement of the appeal fee can be ordered. Since in the present case none of the Appellant-proprietor's above requests are allowable and his appeal is therefore unsuccessful, already for this very reason the Appellant-proprietor's request for the reimbursement of the appeal fee must fail.

11.2 According to Article 112(1)(a) EPC a Board shall refer a question to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure uniform application of the law or if an important point of law arises. Although a question may involve an important point of law, it is only referred to the Enlarged Board of Appeal if the answer to it is necessary to decide the case under consideration (see T 0713/02, OJ EPO 2006, 267, point 5).
The question the Patentee would like to have referred relates to whether Article 69 EPC forms a basis for interpreting the significance and scope of a claim in view of the description. In the present case, this means that even if not explicitly mentioned in claim 1, the term "unloading" should be construed as meaning

that the step of unloading is carried out by the machine itself as disclosed in the patent specification.

However, in A3 which is cited against claim 1, unloading of the machine is also carried out by the machine itself. Hence, the question of interpretation of the claim did not arise during these proceedings, and this issue is immaterial in deciding the present case. Under these circumstances, the request to refer the question to the Enlarged Board of Appeal cannot be allowed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside
2. The patent is revoked.
3. The request for reimbursement of the appeal fee is refused.
4. The request to refer a question to the Enlarged Board of Appeal is refused.

The registrar:

The Chairman:

L. Fernández Gómez

A. de Vries