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**Datasheet for the decision
of 11 December 2013**

Case Number: T 2165/10 - 3.2.07

Application Number: 06112759.3

Publication Number: 1714878

IPC: B65B19/22

Language of the proceedings: EN

Title of invention:

Overwrapping machine for packets of cigarettes

Patent Proprietor:

G.D SOCIETÀ PER AZIONI

Opponent:

Focke & Co. (GmbH & Co. KG)

Headword:

Relevant legal provisions:

EPC Art. 54(1), 56, 114(2)

RPBA Art. 12(2)

Keyword:

Late submitted material - correct exercise of discretion (yes)
Novelty (yes) and inventive step (yes) - argument missing as
to why and to which extent the impugned decision is wrong
Statement of grounds of appeal - party's complete case

Decisions cited:

G 0007/93, T 0001/81, T 0039/92, T 0142/84, T 0332/90,
T 0485/91, T 0025/97, T 0165/00

Catchword:



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Chambres de recours**

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Case Number: T 2165/10 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 11 December 2013

Appellant: Focke & Co. (GmbH & Co. KG)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 20 August 2010 rejecting the opposition filed against European patent No. 1714878 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman: H. Meinders
Members: G. Patton
I. Beckedorf

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division to reject the opposition against the European patent No. 1 714 878.

The opposition had been filed against the patent as a whole and was based on Article 100(a) EPC (lack of novelty and lack of inventive step).

The Opposition Division held that these grounds for opposition did not prejudice the maintenance of the patent as granted.

- II. The respondent (patent proprietor) replied to the appeal and filed an auxiliary request with a letter dated 28 March 2011.

The Board provided the parties with its preliminary non-binding opinion annexed to the summons for oral proceedings that the Opposition Division appeared to have exercised its discretionary power correctly in not admitting the late filed alleged public prior use (E1-E10), that the Board could not find any reason for admitting it in the appeal proceedings and, hence, did not consider necessary to hear a witness on that matter.

With its preliminary non-binding opinion the parties were also informed that the Board did not see any reason for deviating from the finding of the impugned decision that the claimed subject-matter was novel and presented inventive step over the prior art on file (D1-D4) since the appellant had not provided any argument as to why and to which extent the conclusions of the impugned decision should be considered as wrong.

In reaction the appellant withdrew its request for oral proceedings with its fax received on 7 November 2013.

- III. The appellant requests that the decision under appeal be set aside and that the patent be revoked.

- IV. The respondent requests that the appeal be dismissed or, in the alternative that the decision under appeal be set aside, that the patent be maintained on the basis of the auxiliary request filed with the letter dated 28 March 2011. Oral proceedings are auxiliarily requested if the patent is not maintained as granted.

- V. Claim 1 of the main request (patent as granted) reads as follows:

"An overwrapping machine for packets of cigarettes, the machine (1) comprising a first feed line (5) for feeding the packets (3) of cigarettes successively along a first path (8); a second feed line (6) for feeding sheets (4) of transparent packing material successively along a second path (9), the first path (8) intersecting the second path (9) at a cross station (7) to pair each packet (3) with a respective sheet (4) of packing material; and a guide (12), for the packets (3), located upstream from the cross station (7), and having an output end (14), for the packets (3), facing the cross station (7); the machine (1) being characterized in that the guide (12) is movable to and from a forward operating position, in which the guide (12) forms part of the first path (8), and said output end (14) is positioned substantially contacting the second path (9)."

VI. The documents of the opposition and appeal proceedings which are of relevance for the present decision are the following:

- D1: EP-A-0 143 961
- D2: DE-A-35 38 264
- D3: DE-A-29 06 204

Documents relating to an alleged public prior use, not admitted in the proceedings by the Opposition Division:

- E1: Order confirmation dated 13 August 1990 of supplier Focke & Co to buyer Philip Morris Holland B.V., order N° 4346-4349 and 4351-4355, machine model 750/07, 6 pages
- E2: Invoice dated 28 May 1991 of supplier Focke & Co to buyer Philip Morris Holland B.V., order N° 4346-4349, machine model 750/07, 2 pages
- E3: Delivery note dated 30 May 1991 of supplier Focke & Co to buyer Philip Morris Holland B.V., order N° 4346-4349, machine model 750/07, 1 page
- E4: Shipping document of S.A.F.E Shipping GmbH dated 30 May 1991 from supplier Focke & Co to buyer Philip Morris Holland B.V., order and machine N° 4346-4349, model 750/07, 1 page
- E5: Invoices dated 16 August 1991 for installation with respect to order N° 4346-4350, supplier Focke & Co, buyer Philip Morris Holland B.V., 3 pages
- E6: Parts list dated 12 April 1990 for the order N° 4348, machine type 750, 4 pages
- E7: Drawing "Mundstück u. Unterfalter", of Focke and Co, N° 750.09.02, 3 pages
- E8: Drawing "Folienapparat", of Focke and Co, N° 750.32.05, 3 pages
- E9: Drawing "Gerade Einlaufstation", of Focke and Co, N° 750.00.03, 1 page

E10: Affidavit of Mr Martin Stiller dated 26 March 2010,
2 pages

The following document, cited in the patent ([0003]),
was used by the Opposition Division in the impugned
decision as the closest prior art:

D4: US-A-5 782 063

VII. The appellant argued essentially as follows

*Admission of alleged public prior use E1-E10 and
hearing of witnesses*

The alleged public prior use took place more than 20
years ago in a foreign country and many of the relevant
documents were no longer available. This implied a huge
burden for retrieving them, resulting in that the
opposition time limit could not be met. The documents
in the appellant's possession before expiry of the
opposition time limit were not sufficient to establish
a complete chain of evidence. The appellant did not
want to provide the Opposition Division with an
incomplete submission.

The alleged prior use is *prima facie* relevant for
inventive step as it could also be regarded as the
closest prior art for the claimed subject-matter. It is
admitted that the guide in the alleged public prior use
is located downstream from the cross station, contrary
to what is claimed in claim 1. However, this is not a
"substantial" difference which could justify an
inventive step.

Main request

With respect to the documents on file (D1-D4), reference is merely made to the notice of opposition in which D1 and D2 are discussed.

VIII. The respondent argued essentially as follows

Admission of alleged public prior use E1-E10 and hearing of witnesses

There is no good reason for the late filing of the alleged public prior use and the appellant should at least have indicated it in its notice of opposition and have filed all evidence in its possession at the time. Further necessary evidence could have been indicated to be filed later.

The alleged public prior use does not anticipate the claimed subject-matter, nor does it qualify as the closest prior art. It is *prima facie* not relevant.

Main request

With respect to the documents on file (D1-D4), reference is made to the arguments given in the opposition proceedings.

Reasons for the Decision

1. Alleged public prior use E1-E10 and hearing of witnesses
 - 1.1 The documents E1-E10, which relate to an alleged public prior use, were filed by the appellant with its letter of 8 April 2010, well after expiry of the nine month

opposition period ending 5 December 2008. By applying the criteria of *prima facie* relevance, they were not admitted in the proceedings by the Opposition Division (point 16 of the impugned decision).

1.2 The Board shares the Opposition Division's conclusion that E1-E10 were filed late without any good reason for doing so. There was indeed no change in the file during the opposition proceedings, such as a patent proprietor's new request, which could have justified the late filing. Furthermore, the Board considers that the Opposition Division applied the principle of *prima facie* relevance correctly in a reasonable manner when exercising its discretionary power (G 7/93, OJ EPO 1994, 775, point 2.6 of the reasons). Consequently, the Board does not see any reason to overturn that decision.

1.3 The reasons mentioned by the appellant for the late submission of E1-E10 are that the public prior use took place **more than 20 years ago in a foreign country**. Since the legal time limit for keeping documents had long elapsed, many of the relevant **documents had been destroyed**. This made it a huge burden to retrieve the necessary pieces of evidence, so that the appellant could only file them as complete as possible after the opposition time limit. With respect to its letter dated 24 April 2008 sent to the respondent, in which it refers to the public prior use, the appellant argues that the documents in its possession at that time were considered **not enough to constitute a complete chain of evidence**, so that it did not wish to provide it in that incomplete form to the Opposition Division.

The Board, however, shares the respondent's view that the appellant should have included an indication of the alleged public prior use in its notice of opposition

and indicated/filed all evidence in its possession at that time, i.e. the drawings and pictures as annexed to its letter to the respondent dated 24 April 2008. Any further evidence, like the commercial documentation, could have been indicated to be filed later, indicating the difficulties in retrieving such documents in the archives, abroad and/or with third parties.

- 1.4 The Board is of the opinion that the *prima facie* relevance test was also exercised correctly in that the Opposition Division considered that the evidence E1-E10 does not disclose a number of the claimed features (novelty) and does not deal with the problem of the contested patent of avoiding jamming of the overwrapping machine **when pairing the packets with the respective sheets of packing material** (impugned decision, point 16, paragraphs 4 and 5). Since there is a document (D4) that does relate to this problem, the Board can also not find fault in the Opposition Division's reasoning to find the prior use less relevant as starting point. It also dealt with the relevance of the prior use as a teaching which could possibly lead the skilled person to the invention (impugned decision, point 16, paragraph 6) and found it also insufficient in that respect.

Thus, the Opposition Division dealt with all aspects of relevance of the prior use when not admitting it. It is, therefore, not part of the opposition proceedings and, as a consequence, not as such part of the appeal proceedings (Article 114(2) EPC).

- 1.5 The late filing of the evidence relating to the alleged public prior use could have been "repaired" on appeal if the Opposition Division had not applied its

discretion correctly. This is, however, not the case here as discussed above.

- 1.6 The appellant accepts in the appeal proceedings that the guide in the alleged public prior use is located **downstream**, i.e. not upstream, from the cross station and now argues that this is not a "substantial" difference which could justify an inventive step. The skilled person using his common general knowledge would immediately think of positioning the guide on the other side if needed. It cites T 1/81 (OJ EPO 1981, 439), which establishes that inverting process steps cannot support inventive step and implies that a geometrical inversion can neither justify this. Similarly, it cites T 39/82 (OJ EPO 1982, 419), T 142/84 (OJ EPO 1987, 112), T 332/90, T 485/91 and T 25/97 (all not published in OJ EPO) for supporting that a new application of a known measure cannot lead to an inventive step if the problem does not change.

The above cannot lead to the Board to exceptionally admit the evidence relating to the alleged public prior use of its own motion in the appeal proceedings.

In assessing whether it qualifies as closest prior art, also the function of the guide has to be taken into account. In the alleged public prior use machine it has no function whatsoever with respect to the transparent packing material nor to guide the cigarette packs to that packing material. It guides the wrapped packs to the revolver 08.01, which is a different problem. Even if the above mentioned case law would establish the principles attributed to it by the appellant, the present alleged public prior use would *prima facie* **not** fulfil them.

The evidence related to the alleged public prior use is therefore not admitted in the appeal proceedings.

A witness hearing on this matter is thus also not necessary.

2. Main request (patent as granted)

With respect to the documents on file (D1-D4), the appellant has only referred to its notice of opposition dated 4 November 2008 in which it presents its view on the disclosures of D1 and D2.

It is established case law (see the case law reviewed in T 165/00 (not published in OJ EPO)) that an appeal solely based on a simple reference to submissions made in the first instance proceedings is inadmissible, as it does not state the legal and factual reasons why the impugned decision is not correct. As the appeal is already admissible for the fact that it deals with the impugned decision by its references to the alleged public prior use, this simple reference does not affect the general admissibility of the appeal.

According to Article 12(2) RPBA the statement setting out the grounds of appeal shall contain the appellant's complete case, set out clearly and concisely the reasons why it is requested that the impugned decision is to be reversed and should specify expressly all the facts, evidence and arguments relied on. In this respect the appellant has, however, not provided any single argument as to why and to which extent the conclusions in points 14 and 15 of the impugned decision should be considered as wrong. The Board can neither find *ex officio* in this respect anything wrong in the impugned decision's reasoning.

Consequently, the Board does not see any reason to deviate from the finding of the impugned decision that the claimed subject-matter is novel and involves inventive step over the cited prior art (Articles 54(1) and 56 EPC).

The above points 1 and 2 correspond to the preliminary opinion of the Board provided to the parties in the annex to the summons for oral proceedings.

3. Auxiliary request

In view of the above, there is no need to deal with the respondent's auxiliary request.

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar:

The Chairman:



G. Nachtigall

H. Meinders

Decision electronically authenticated