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**Datasheet for the decision
of 21 May 2014**

Case Number: T 2182/10 - 3.2.07

Application Number: 04001634.7

Publication Number: 1447333

IPC: B65C9/18, B65C9/42, B65C9/46

Language of the proceedings: EN

Title of invention:
Labelling machine

Patent Proprietor:
Irplast S.p.A.

Opponent:
Domino Printing Sciences PLC

Headword:

Relevant legal provisions:
EPC Art. 56, 99(1)
EPC R. 76, 106
RPBA Art. 12(2), 12(4), 13(1), 13(3)

Keyword:

Admissibility of opposition - opposition substantiated (yes)
Late-filed documents - admitted (yes)
Late-filed translations of documents - admitted (yes)
Limitation of appeal to objections and arguments of opposition
(no)
Inventive step - main request (no)
Late-filed auxiliary request 1 - admitted (no)
Obligation to raise objections - objection dismissed
Late-filed auxiliary request 2 - admitted (yes)

Decisions cited:

G 0006/95, R 0001/13, T 0222/85, T 0453/87, T 0279/88,
T 1002/92, T 0557/94

Catchword:



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Case Number: T 2182/10 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 21 May 2014

Appellant: Domino Printing Sciences PLC
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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. 1447333 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman H.-P. Felgenhauer
Members: G. Patton
C. Brandt

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. 1 447 333.

The opposition was filed against the patent as a whole and was based on Article 100(a) EPC (lack of inventive step). The alleged ground based on Article 100(b) EPC (sufficiency of the disclosure) was not substantiated.

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

- II. The respondent (patent proprietor) replied to the appeal requesting that the appeal be dismissed on the basis that the opposition would be inadmissible or the appeal unfounded. It further requested to restrict the appeal to the objections and arguments of the opposition proceedings; if not, to remit the case to the department of first instance. It further requested to not admit D13(0) and D14.

- III. The Board provided the parties with its preliminary non-binding opinion annexed to the summons for oral proceedings that the opposition was regarded admissible and that the new objection(s) and/or argument(s) raised for the first time in appeal and based on admitted documents was not considered as constituting a procedural abuse; they could therefore be admitted in the proceedings. The Board did not see appropriate to remit the case to the department of first instance on the basis of these new objection(s) and/or argument(s) in view of keeping the procedure as short as possible.

The preliminary non-binding opinion of the Board was also that the subject-matter of independent claim 1 of the patent as granted did not involve inventive step starting from D14 and combined with the teaching of D7A and the general knowledge of the skilled person as illustrated by D5 or D8.

With respect to the documents relevant for the present decision, the Board's preliminary opinion was that:

- the *prima facie* relevance of late filed document D13(O) with respect to inventive step needed to be re-considered for the Board to decide in exercising its discretionary power to admit it or not in the proceedings; and
- no fault could be found in the Opposition Division's decision to admit late filed document D14 in the proceedings.

A copy of the documents D7A and a machine translation of D14 (=D14') was annexed to the preliminary opinion of the Board.

In view of the possible relevance of the Japanese documents D13(O) and D14, the Board invited the appellant to file proper translations, if in its possession.

In reaction to the Board's preliminary opinion the appellant electronically filed a certified translation of D14 (=D14") and a machine translation of D13(O) (=D13(O)') on 17 April 2014.

It further electronically filed a certified translation of D13(O) (=D13(O) ") on 16 May 2014.

IV. Oral proceedings took place on 21 May 2014 during which the followings aspects relevant for the present decision were discussed:

- the admissibility of the opposition;
- the admission in the proceedings of documents D13(0), D14, their machine and certified translations and D10b);
- the remittal to the first instance;
- the content and the subject-matter of claim 1 of the main request;
- the objection of lack of novelty regarding claim 1 of the main request;
- the objection of lack of inventive step starting from D14 as closest prior art in combination with D7A;
- the need of an interruption of the proceedings in order for the respondent to study the certified translation D13(0)" filed on 16 May 2014;
- the objection of lack of inventive step starting from D13(0) as closest prior art in combination with D7A;
- the admissibility of the first auxiliary request filed during the oral proceedings;
- the objection raised by the respondent under Rule 106 EPC;
- the admissibility of the second auxiliary request filed during the oral proceedings.

The present decision was announced at the end of the oral proceedings.

V. The appellant requests that the decision under appeal be set aside and that the European patent No. 1 447 333 be revoked.

VI. The respondent requests that the appeal be dismissed or, alternatively, that the auxiliary requests 1 and 2

filed during the oral proceedings on 21 May 2014 be admitted in the proceedings and that the case be remitted to the department of first instance for further prosecution on the basis of one of these auxiliary requests.

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

"A labelling for printing and applying machine labels on containers, comprising:

- an adhesive tape reel (1) from which the labels are formed;

- a reel unwinding system comprising at least an unwinding roll (8) and a tape tensioning device (9);

- optional photocell (4);

tape (5) adhesivized on the internal side of the reel;

- printing group (3), comprising a printing system wherein the contact between the print head (3b) and the adhesive tape to be printed (5) is carried out by a driving roll of anti-adherent material (3a), which cyclically inverts its rotation direction;

- cutting system (2) comprising:

- a cutting blade (2a) which moves perpendicularly to the direction of the tape to be cut, from which the labels are obtained; the cutting blade (2a) has an inclined cutting edge having an angle between 2° and 45°, preferably between 2° and 30° with respect to the tape (5) to be cut;

- a counterblade (2b); the blade and counterblade cutting surfaces are covered with solid anti-adhesives;

- applying pad (6);

the cutting system (2) being adjacent to the printing group (3)."

Claim 16 of the main request (patent as granted) reads as follows:

"A process for printing and applying the labels which uses the labelling machine of claims 1-10, wherein:

- the tape (5) is unwound from the reel (1) by the unwinding system comprising an unwinding roll (8) and a tape tensioning device (9), enters the printing group (3) for the label overprint;
- the tape (5) enters the cutting system (2) moving in a direction perpendicular to the cutting blade (2a); the blade (2a) cuts the tape maintaining a preferably constant inclination; the contact point between the blade (2a) and counter-blade (2b) during the cut moves transversally in a continuous way through the tape section (5);
- the printed label after the cut is immediately applied on the container by an applying pad (6);
- after the label application, the adhesive tape (5) is moved backward by the driving roll (3a), and the printing head (3b) starts printing near the upper edge of the label being formed;
- the tape (5) proceeds again into the cutting system (2) to form the next label."

Claim 1 of the first auxiliary request reads as follows (in bold the amendments with respect to claim 16 of the main request; emphasis added by the Board):

"A process for printing and applying the labels which uses ~~the labelling machine of claims 1-10~~, **a machine labelling for printing and applying labels on containers, wherein the machine comprises:**

- **an adhesive tape reel (1) from which the labels are formed;**

- a reel unwinding system comprising at least an unwinding roll (8) and a tape tensioning device (9);
- optional photocell (4);
- tape (5) adhesivized on the internal side of the reel;
- printing group (3), comprising a printing system wherein the contact between the print head (3b) and the adhesive tape to be printed (5) is carried out by a driving roll of anti-adherent material (3a), which cyclically inverts its rotation direction;
- cutting system (2) comprising:
 - a cutting blade (2a) which moves perpendicularly to the direction of the tape to be cut, from which the labels are obtained; the cutting blade (2a) has an inclined cutting edge having an angle between 2° and 45° preferably between 2° and 30° with respect to the tape (5) to be cut;
 - a counterblade (2b); the blade and counterblade cutting surfaces are covered with solid anti-adhesives;
 - applying pad (6);
- the cutting system (2) being adjacent to the printing group (3), wherein in the method:
 - the tape (5) is unwound from the reel (1) by the unwinding system comprising an unwinding roll (8) and a tape tensioning device (9 g), enters the printing group (3) for the label overprint;
 - the tape (5) enters the cutting system (2) moving in a direction perpendicular to the cutting blade (2a); the blade (2a) cuts the tape maintaining a preferably constant inclination; the contact point between the blade (2a) and counter-blade (2b) during the cut moves transversally in a continuous way through the tape section (5);
 - the printed label after the cut is immediately applied on the container by an applying pad (6);
 - after the label application, the adhesive tape (5) is moved backward by the driving roll (3a), and the

printing head (3b) starts printing near the upper edge of the label being formed;

- the tape (5) proceeds again into the cutting system (2) to form the next label."

Claim 1 of the second auxiliary request reads as follows (in bold the amendments with respect to claim 16 of the main request; emphasis added by the Board):

"A process for printing and applying the labels which uses ~~the labelling machine of claims 1-10~~, **a machine labelling for printing and applying labels on packages, wherein the machine comprises:**

- **an adhesive tape reel (1) from which the labels are formed;**

- **a reel unwinding system comprising at least an unwinding roll (8) and a tape tensioning device (9);**

- **optional photocell (4);**

tape (5) adhesivized on the internal side of the reel;

- **printing group (3), comprising a printing system wherein the contact between the print head (3b) and the adhesive tape to be printed (5) is carried out by a driving roll of anti-adherent material (3a), which cyclically inverts its rotation direction;**

- **cutting system (2) comprising:**

- **a cutting blade (2a) which moves perpendicularly to the direction of the tape to be cut, from which the labels are obtained; the cutting blade (2a) has an inclined cutting edge having an angle between 2° and 45° preferably between 2° and 30° with respect to the tape (5) to be cut;**

- **a counterblade (2b); the blade and counterblade cutting surfaces are covered with solid anti-adhesives;**

- **applying pad (6);**

the cutting system (2) being adjacent to the printing group (3) wherein in the method:

- the tape (5) is unwound from the reel (1) by the unwinding system comprising an unwinding roll (8) and a tape tensioning device (9 g), enters the printing group (3) for the label overprint;
 - the tape (5) enters the cutting system (2) moving in a direction perpendicular to the cutting blade (2a); the blade (2a) cuts the tape maintaining a preferably constant inclination; the contact point between the blade (2a) and counter-blade (2b) during the cut moves transversally in a continuous way through the tape section (5);
 - the printed label after the cut is immediately applied on the **container package** by an applying pad (6);
 - after the label application, the adhesive tape (5) is moved backward by the driving roll (3a), and the printing head (3b) starts printing near the upper edge of the label being formed;
 - the tape (5) proceeds again into the cutting system (2) to form the next label,
- wherein the sizes and the label text of the packaging line packages can be varied from one package to another even more times or in a continuous way, without interrupting the production cycle."**

VIII. The documents of the opposition and appeal proceedings mentioned in the present decision are the following:

- D1: US-A-4 784 714
- D2: US-A-4 276 112
- D3: US-A-6 145 423
- D4: US-A-3 861 303
- D5: US-A-5 531 853
- D6: US-A-5 487 807
- D7** : EP-B-1 106 514, published on 14 July 2004
- D7A: EP-A-1 106 514

- D8: US-A-5 813 772
D9: US-A-3 483 778
D10a: Drawing of METEC, model TT100-L, 1 page,
undated
D10b: Brochure, "Thermoscribe - The new
generation of thermoprinters", 6 pages,
undated
D11: EP-B-0 758 955
D12** : EP-B-1 050 566, published on 9 August 2006
D13(O)* : JP-A-4-152161 and English abstract from the
espacenet database
D13(O)' : Machine translation in English of the
Japanese application JP-A-4-152161, 5 pages
D13(O)" : Certified translation in English of the
Japanese application JP-A-4-152161, 10
pages
D14: JP-A-9-142431 and English abstract from the
espacenet database
D14' : Machine translation in English of the
Japanese application JP-A-9-142431, 7 pages
D14" : Certified translation in English of the
Japanese application JP-A-9-142431, 13
pages

* documents not admitted in the proceedings by the
Opposition Division (impugned decision, points 11-13)

** Patent documents published after the filing date of
the contested patent of 27 January 2004

IX. The appellant argued essentially as follows

Admissibility of opposition

The ground for opposition based on lack of inventive
step was sufficiently substantiated since the closest
prior art documents and their combination with other

pieces of prior art were indicated in the notice of opposition. The skilled person would recognize in the cited evidence the relevant features without extra burden.

Admission of late filed documents

D13(O) is *prima facie* relevant for assessing the inventive step of the claimed subject-matter in view of the English abstract and the figures. Rule 3(3) EPC, last two sentences, does not apply since the Board merely invited the appellant to file a translation if in its possession without setting a time limit.

A translation of a prior art document can be submitted at a stage later than the filing of the original document. A machine translation D13(O)', readily understandable by a skilled reader, was already available to the respondent more than one month before the oral proceedings, leaving enough time for it to study and discuss its content with its client. The later filed certified translation D13(O)" does not go beyond the technical information already available in D13(O)'. .

The technical information available in the English abstract and the figures of D14, especially figures 1, 4-7, is *prima facie* highly relevant in view of the claimed subject-matter. Rule 3(3) EPC, last two sentences, does not apply since the Board merely invited the appellant to file a translation if in its possession without setting a time limit.

A translation of a prior art document can be submitted at a stage later than the filing of the original document. A machine translation D14', readily

understandable by a skilled reader, was already available to the respondent provided with the preliminary opinion of the Board, i.e. three months before the oral proceedings. A certified translation D14", with no additional technical information with respect to D14', was also filed timely before the oral proceedings, i.e. around one month before, for the respondent to have enough time to study and discuss the translation with its client.

Documents D13(O), D13(O)', D13(O)", D14, D14' and D14" should therefore be admitted in the proceedings.

Restriction of appeal to the objections and arguments of the opposition proceedings - abuse of the procedure

Additional inventive step objections are justified since the appellant was not in a situation to present its complete case during the oral proceedings before the Opposition Division.

Since a machine translation of D13(O) was already available to the respondent one month before the oral proceedings the case should not be remitted to the department of first instance because of the admission of D13(O)" in the proceedings.

Main request

Starting from D14 as closest prior art, the only distinguishing feature of claim 1 is that the blade and counter-blade cutting surfaces are covered with solid anti-adhesives. This feature is however known and usual in the technical field concerned, even not essential according to the contested patent itself, so that it cannot support inventive step.

Starting from D13(O) as closest prior art, the only distinguishing features of claim 1 concern the cutting blade geometry, the blade and counter-blade cutting surfaces being covered with solid anti-adhesives and printing and applying labels from adhesive tape. Since cutting blades and counter-blades as defined by the first two distinguishing features are known from D7A and can easily be applied in the machine of D13(O), these features cannot support inventive step. The application of the labels from adhesive tape is further obvious for the skilled person applying his common general knowledge. As a result, starting from D13(O) the skilled person using the teaching of D7A together with his common general knowledge will arrive at the claimed subject-matter in an obvious manner.

First auxiliary request - Admission in the proceedings

It would be contrary to the efficiency of the procedure to admit a request which would *prima facie* not hold in view of the arguments given with respect to the subject-matter of claims of the main request.

The feature of claim 1 relating to the constant inclination of the blade can be seen as optional. Such an inclination of the blade is also disclosed by D7A. The alleged technical effects and/or advantages are further not obtained over the whole scope of claim 1.

Consequently, claim 1 of the first auxiliary request does not appear to *prima facie* overcome the objection of lack of inventive step raised against claim 1 of the main request and, hence, the first auxiliary request should not be admitted in the proceedings.

Second auxiliary request - Admission in the proceedings

The respondent had more than one month after having received the machine translation D13(O)' to react and file its auxiliary request. Consequently, such a late filed request should not be admitted in the proceedings.

X. The respondent argued essentially as follows

Admissibility of opposition

It was not in a position to form an opinion on the only reasoned ground of opposition based on lack of inventive step without the need to perform further investigations. It was unclear from the notice of opposition on which arguments and documents or passages of the cited documents the inventive step objections against claim 1 were based. Even the manner in which documents should be combined was not clear. The opposition should therefore not be considered as being admissible.

Admission of late filed documents

D13(O) is not *prima facie* relevant since it discloses a machine which prints a series of uncut labels. It is thus not related to the claimed machine for printing and applying labels. Its translation in an official language of the EPO should have been filed in due time (Rule 3(3) EPC).

A machine translation D13(O)' is not enough to understand an original document and the later filed certified translation D13(O)" should have been submitted in due time, i.e. earlier than two working

days before the oral proceedings. The time available was too short to consider the content of D13(O)" and to react appropriately.

The inversion of the rotation of the driving roll in D14 is not for the same purpose as in granted claim 1 of the contested patent. Further, D14 does not disclose a cutting system comprising the specific features of claim 1. Therefore, D14 is not *prima facie* relevant. Its translation in an official language of the EPO should have been filed in due time (Rule 3(3) EPC).

The translations of D14, more particularly D14", should have been filed far in advance, i.e. earlier than one month before oral proceedings. Due to the late filing, the respondent was not in a situation to comply with the general practice of the EPO of replying within the usual one month time limit before oral proceedings.

None of the documents D13(O), D13(O)', D13(O)", D14, D14' and D14" should be admitted in the proceedings for the reasons given above.

Restriction of appeal to the objections and arguments of the opposition proceedings - abuse of the procedure

The numerous new objections raised without any reason for the first time in the statement of grounds of appeal amounts to an abuse of the procedure. The appeal should be restricted to the objections and arguments of the opposition proceedings, if not, the case should be remitted to the department of first instance. The admission in the proceedings of the late filed certified translation D13(O)" would also be a reason for remittal.

Main request

When removing the cutting system of the machine of D14 taken as closest prior art to replace it by the one known from D7A, the skilled person will also remove the inverting mechanism of the driving roll of D14 since it is part of the cutting mechanism. Therefore, the result will be a machine falling outside the scope of claim 1.

D13(O) should not be considered for inventive step as it concerns the printing of forms of always the same format on continuous paper, while claim 1 on the contrary relates to printing "labels" of different formats and texts on adhesive tape to be applied on containers. In addition to the distinguishing features mentioned by the appellant, D13(O) does not disclose that the cutting system is adjacent to the printing group nor that the driving roll is of anti-adherent material. Instead of D7A, the skilled person will consider D5 for looking for a solution to the problem derived from the feature related to the cutting mechanism namely to increase the machine speed and avoid shut down. Inventive step should therefore be acknowledged.

First auxiliary request - Admission in the proceedings

Claim 1 of the first auxiliary request corresponds to claim 16 of the patent as granted, which has never been discussed exhaustively, neither in opposition nor in appeal proceedings. Hence, the first auxiliary request should be admitted.

Further, the first auxiliary request should be admitted in the proceedings since the translations of D13(O) and D14 were admitted.

Moreover none of the documents D13(0) and D7A discloses the features of claim 1 that: "the tape (5) enters the cutting system (2) moving in a direction perpendicular to the cutting blade (2a); the blade (2a) cuts the tape maintaining a preferably constant inclination; the contact point between the blade (2a) and counterblade (2b) during the cut moves transversally in a continuous way through the tape section (5)". Therefore, claim 1 of the first auxiliary request *prima facie* overcomes the objection of lack of inventive step raised against claim 1 of the main request. For the reasons given above the first auxiliary request should be admitted in the proceedings and the case remitted to the department of first instance for further prosecution on the basis of this request in order to preserve the respondent's right of two instances.

Objection under Rule 106 EPC

The proceedings were not fair since on one hand D13(0) and D14 were admitted in the proceedings, with their late filed certified translations (two days before the oral proceedings for D13(0)), while on the other hand the first auxiliary request restricted to the process claims of the patent as granted, i.e. claims in the proceedings from the very beginning, was not admitted in the proceedings. Furthermore, the right to be heard was violated since the respondent had not enough time for contacting and discussing the late filed certified translation D13(0)" with its client.

Second auxiliary request - Admission in the proceedings

The feature of claim 1 that "the sizes and the label text of the packaging line packages can be varied from

one package to another even more times or in a continuous way, without interrupting the production cycle" is not disclosed in D13(O) or D7A. Hence, the objection of lack of inventive step is *prima facie* overcome. The appellant could not have been surprised by a combination of features from claims of the patent as granted. Second auxiliary request should therefore be admitted in the proceedings and the case be remitted to the department of first instance.

Reasons for the Decision

1. Admissibility of the opposition

- 1.1 With its reply to the statement of grounds of appeal, the respondent contested the finding of the Opposition Division that the opposition is admissible (impugned decision, points 10, 10.1, 10.2 and 10.3).

It considered that it was unclear on which arguments and on which documents or passages of the cited documents the inventive step objections against claim 1 were based. Even the combinations of documents were not clear. In view of this, the respondent considered not to be in a position to form an opinion on this ground without the need to perform further investigations (T 222/85, published in OJ EPO 1988, 128; T 453/87 and T 279/88, not published in OJ EPO). Since this was the only reasoned ground, the opposition should not be admissible.

The respondent did not add any further arguments during the oral proceedings, stating that it relied upon its written submissions.

1.2 For the Board, however, the respondent's arguments were not convincing for the following reasons given in point 5 of the annex to the summons to oral proceedings (in the following: the annex).

As correctly put forward by the respondent, inventive step was the only substantiated ground in the notice of opposition. It was, however, clearly indicated the documents to consider (D1-D9, D10a, D10b, D11-D12), which of them to select as closest prior art (D7, D10a-D10b or D11) and with which of the other cited documents to combine. As correctly put forward by the respondent in its reply to the statement of grounds of appeal, the following inventive step objections (a), (b) and (c) were raised:

(a) D7 as closest prior art combined with D5 or D10 to show the tensioning device, with D1, D2, D4, D8 or D11 to show the printing group and with D1, D8 or D11 to show the cutting system adjacent to the printing group (points 9.1 to 9.5 of the notice of opposition);

(b) D10a-D10b as closest prior art combined with D7 (points 9.6 to 9.8 of the notice of opposition); and

(c) D11 as closest prior art combined with D7, D8 and D9 to show the cutting system and with D5, D9 and D10 to show the applying pad (points 9.9 to 9.11 of the notice of opposition).

For each of the inventive step objections, the distinguishing features of claim 1 over the corresponding closest prior art document (D7, D10a-D10b or D11) were explicitly given. Further, reference was also made to figures of relevant documents D7, D8, D9 and D10a-D10b (see points 9.2, 9.7, 9.11). As a result,

the Board could not see any difficulty for a person skilled in the art, i.e. used to reading technical drawings of such devices, to retrieve the relevant features from the cited figures.

Consequently, it was clear from the notice of opposition which documents, which combinations and which passages were considered for the inventive step objections, without a need to perform further investigations, as also stated by the appellant in its statement of grounds of appeal. The opposition was therefore substantiated.

In view of the above, the requirements according to Article 99(1) EPC and Rule 76 EPC were fulfilled as argued by the appellant and, hence, the Board considered the opposition as admissible.

2. Late filed documents

Documents D13(O) and D14 were filed during the opposition proceedings after the nine months opposition period. They were therefore regarded as late filed so that the Opposition Division applied the criteria of *prima facie* relevance for deciding on their admission in the proceedings, which was contested by the respondent.

The translations D13(O)', D13(O)" and D14" were filed by the appellant during the appeal proceedings so that they were subject to the discretionary power of the Board for their admission in the proceedings. D14' was introduced by the Board with the annex. The respondent contested their admission.

D7A was introduced by the Board to be used instead of D7. As a matter of fact, D7A is a prior art document according to Article 54(2) EPC and, hence, can be used for assessing inventive step of the claimed subject-matter, contrary to D7. The admission of D7A in the proceedings was not contested by the parties.

2.1 Admission of document D13(O)

The appellant contested the Opposition Division's decision to not admit D13(O) in the proceedings. The Opposition Division held that *prima facie* some of the features of claim 1 were not present or suggested in the document (impugned decision, points 11 and 11.1).

As put forward by the Board in the annex, point 6.1.1, it appears that the Opposition Division considered only novelty for assessing the *prima facie* relevance (see also point 5 of the minutes of the oral proceedings before the Opposition Division). However, inventive step is also one of the conditions in order to assess the *prima facie* relevance of a document. Since this had not been done, the Board informed the parties in the annex that the *prima facie* relevance of document D13(O) would have to be re-considered for the Board to decide when exercising its discretionary power to admit it or not in the proceedings. The Board also further emphasized that, contrary to the written respondent's allegation, it could not find any hint in the impugned decision that the Opposition Division considered the disclosure of D13(O) as not going beyond that of D1-D12.

During the oral proceedings before the Board, the respondent, referring to Rule 3(3) EPC, put forward that a document filed in a language other than an

official language of the EPO should be disregarded if a translation was not filed in due time. Since a translation of D13(O), especially the certified translation, was filed very late, i.e. only three working days before the oral proceedings, D13(O) should be disregarded and, hence, not admitted in the proceedings.

The Board could not share the respondent's view for the reason put forward by the appellant that **a translation was not required** for assessing that D13(O), in view of the English abstract and the figures, discloses the same solution as in the contested patent of reversing the feeding of the paper to be printed for exactly the same purpose of avoiding processing waste (D13(O), "Purpose" and last three lines of the abstract, figures 5 and 6; contested patent, [0034]). This disclosure of D13(O) was indeed relevant when assessing inventive step of the claimed subject-matter as can be derived from the following. Furthermore, regarding the filing of a translation, the Board merely invited the appellant to do so if in its possession without setting a time limit so that the conditions given in the last two sentences of Rule 3(3) EPC did not apply.

Therefore, the Board, applying its discretionary power, decided to admit D13(O) in the proceedings due to its *prima facie* relevance.

2.2 Translation documents D13(O)' and D13(O)"

In the annex to the summons to oral proceedings, the Board invited the appellant to provide, if in its possession, a proper translation of D13(O) in one of the official languages of the EPO.

In reaction, the appellant filed a machine translation in English (=D13(O)') with its letter dated 17 April 2014, i.e. around one month before the oral proceedings, and a certified translation in English (=D13(O)") with its letter dated 16 May 2014, i.e. three working days before the oral proceedings.

During the oral proceedings, the respondent contested their admission in the proceedings. It argued that a machine translation D13(O)' was not enough to properly and fully understand an original document and that the certified translation D13(O)" should have been filed earlier than three working days, i.e. *de facto* only two working days, before the oral proceedings. Because of this extremely short time available, it was not in a situation to consider and discuss the new document D13(O)" with its client and to react appropriately. Furthermore, no passage of the translations had been cited by the appellant so that it was left with studying the complete new documents D13(O)' and D13(O)" at a very late stage in the proceedings. The respondent further added that the certified translation D13(O)" should have been filed in due time, in particular in view of the fact that six years elapsed from the beginning of the opposition proceedings (Rule 3(3) EPC).

The Board could not share the respondent's view for the reasons put forward by the appellant during the oral proceedings. A translation of a prior art document in an official language of the EPO can be submitted at a stage later than the filing of the original document, as foreseen by Rule 3(3) EPC. Furthermore, the machine translation D13(O)' was already available to the respondent more than one month before the oral proceedings so that it had sufficient time to discuss

its complete content with its client and to react accordingly. The quality of the machine translated document was at such a high level that a skilled reader could readily understand its technical content without difficulty. This holds all the more true when considering also the figures, in particular figure 5, of D13. The possible linguistic errors in D13(O)' were no obstacle to the understanding of its disclosure. Finally, in view of the discussions during the oral proceedings, the later filed certified translation D13(O)" did not add any technical information with respect to D13(O)'.

Further, the Board could not accept the respondent's approach to simply ignore D13(O)' filed one month before the oral proceedings, since, as derivable from the invitation to file a translation in the annex, it was aware that it could not be excluded that the Board would admit a translation of D13(O) in the proceedings.

For the above reasons, the Board decided to admit the translation documents D13(O)' and D13(O)" in the proceedings.

2.3 Document D14

The respondent contested the Opposition Division's finding to admit D14 in the proceedings. The Opposition Division held that D14 appeared *prima facie* relevant (impugned decision, points 11 and 11.2). In a more detailed analysis of the document, the Opposition Division was then not convinced by the inventive step objections involving D14 (impugned decision, points 23.4 and 23.5).

The respondent (cf. point 3.2.2 of its reply to the statement of grounds of appeal) considered that the inversion of the rotation of the driving roll in D14 was not for the same purpose as in granted claim 1 of the contested patent, namely to enable cutting labels of different lengths. Consequently, it regarded D14 *prima facie* not relevant for that reason already. The respondent further added (point 4.5 of its reply), that D14 did not disclose a cutting system comprising the specific features of claim 1.

In the annex, the Board informed the parties that it could not share this view since the intended purpose was not in claim 1 of the granted patent, so that it could not be regarded as a distinguishing technical feature of claim 1 over D14, at least in a *prima facie* assessment. The Board further noted that a cutting system was provided in the device of D14 with a cutting blade and a counter-blade as shown in figures 1, 6 and 7 and described in [0011] and [0029] (reference was made to D14', a copy of which was annexed to the summons). Therefore, even if the subject-matter of claim 1 appeared *prima facie* novel over D14, inventive step could *prima facie* be an issue starting from this document.

During the oral proceedings, the respondent focused on arguing against the admission of the translations and did not present any specific arguments against the admission of D14 **as such**. Like for D13(O), it referred to Rule 3(3) EPC to argue that a document not filed in an official language of the EPO should be disregarded if the translation was not filed in due time. Since a translation of D14, especially a certified translation, was filed very late, i.e. only one month before the

oral proceedings, D14 should be disregarded and, hence, not admitted in the proceedings.

For the same reasons as those give above for D13(O), these arguments were not found convincing to the Board in view of the *prima facie* high relevance of the technical information readily available from the English abstract and the figures of D14, especially figures 1, 4-7. Furthermore, the Board merely invited the appellant to file a translation if in its possession without setting a time limit so that the conditions given in the last two sentences of Rule 3(3) EPC did not apply.

Therefore, the Board could not find fault in the Opposition Division's decision to admit D14 in the proceedings.

2.4 Translation documents D14' and D14"

In the annex, the Board introduced and used a machine translation of D14 (=D14') and further invited the appellant to provide, if in its possession, a proper translation in one of the official language.

In reaction, the appellant filed a certified translation in English of D14 (=D14") with its letter dated 17 April 2014, i.e. approximately one month before the oral proceedings.

During the oral proceedings the respondent contested the admission in the proceedings of the translations, more specifically D14". It put forward, like for D13(O)", that should the appellant wish to rely on the document and its translations, it should have provided them far in advance in accordance with Rule 3(3) EPC.

It also argued that it was not in a situation to reply within the usual one month time limit before oral proceedings in accordance with the EPO practice since the certified translation was filed too close to this time limit.

The Board could not share the respondent's view for the reasons put forward by the appellant during the oral proceedings. A translation in an official language of the EPO of a prior art document can be filed later, as foreseen by Rule 3(3) EPC. Furthermore, the machine translation D14' was already available to the respondent with the Board's preliminary opinion given in the annex, i.e. three months before the oral proceedings, so that it had sufficient time to discuss its complete content with its client and to react accordingly. The quality of the machine translated document was at such a high level that a skilled reader could readily understand its technical content without difficulty. Possible linguistic errors in D14' had no impact on understanding its content. Finally, the certified translation D14" was also filed timely before the oral proceedings, i.e. around one month before, so that even for the certified translation, the respondent had sufficient time to study and discuss it with its client in order to react appropriately. The certified translation D14" did not add any technical information with respect to D14' in view of the discussions during the oral proceedings.

The Board further could not follow the respondent's view regarding the time limit of one month before the oral proceedings for filing a reply. Indeed, no time limit was set with the summons. In the annex, point 10, the Board drew the attention of the parties that any amendment of a party's case would be subject to Article

114 EPC and the Rules of Procedure of the Boards of Appeal, i.e. with no reference to a time limit. The procedural conditions defined in Rule 116 EPC used by the first instance departments for setting a time limit do not apply to the Boards of Appeal (G 6/95, published in OJ EPO 1996, 649, point 5 of the reasons).

For the reasons given above, the Board decided to admit the translation documents D14' and D14" in the proceedings.

3. Restriction of appeal to the objections and arguments of the opposition proceedings - Abuse of the procedure

3.1 The respondent considered that the numerous new objections raised in the statement of grounds of appeal in comparison with the opposition proceedings amounts at an **abuse of the procedure**. It expressed the view that there is no valid reason for filing them for the first time in appeal. It requested therefore to restrict the appeal to the objections and arguments of the opposition proceedings, if not, to remit the case to the department of first instance. For the respondent, the appeal proceedings is not a mere continuation of the opposition proceedings but rather a review by the Board of the decision taken by the department of first instance. The additional objections lie therefore clearly outside the framework of the appeal proceedings.

The respondent referred to T 1002/92 (published in OJ EPO 1995, 605) in support of its arguments that the objections and arguments newly raised in the appeal proceedings should not be admitted.

3.2 The Board cannot share the respondent's view for the reasons already given in the annex that new objection(s) and/or argument(s) raised for the first time in appeal and based on admitted documents do not constitute a procedural abuse. Indeed, T 1002/92 (*supra*), headnote and point 3 of the reasons, states that in "*proceedings before the Opposition Divisions, late-filed facts, evidence and related arguments, which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to Rule 55(c) EPC in support of the grounds of opposition on which the opposition is based, should only exceptionally be admitted into the proceedings, if prima facie, there are clear reasons to suspect that such late-filed material would prejudice the maintenance of the European patent.*"

T 1002/92 (*supra*) explicitly refers to the arguments related to the **late-filed facts and evidence**, not to late-filed objection(s) and/or argument(s) on their own. If the late-filed facts and evidence, e.g. prior published patent applications, are already admitted in the proceedings, new objection(s) and/or argument(s) based on them can indeed validly be raised and admitted. This is all the more true for documents filed within the opposition period.

Since the requirements of the Rules of Procedures of the Boards of Appeal, in particular Article 12(2) and 12(4) RPBA, are fulfilled, the Board does not see any reason to not admit the new objection(s) and/or argument(s) in the proceedings.

The above finding is based on the understanding expressed in T 1002/92 (*supra*) and not on the appellant's allegations in its statement of grounds of

appeal, page 9, first complete paragraph, that it was not in a situation to present its complete case during the oral proceedings before the Opposition Division so that it would justify additional inventive step objections in appeal.

3.3 With respect to the respondent's request to remit the case to the department of first instance in case the newly raised objection(s) and/or argument(s) were to be admitted in the appeal proceedings, it needs to be taken into account that there is no absolute right to have an issue decided upon by two instances, as referred to by the Board in the annex. In accordance with Article 111(1) EPC the Board may indeed exercise any power within the competence of the department which was responsible for the decision appealed. Since the request for remittal relates to the admittance of new objection(s) and/or argument(s), the Board considers not appropriate to remit the case to the department of first instance in balance with the need to keep the procedure as short as possible (see Case Law of the Boards of Appeal, 7th Edition, 2013, IV.E, 7.1, 7.5 and 7.6).

3.4 During the oral proceedings, the respondent further argued that the case should be remitted in view of the admission of the certified translation D13(O)", which was filed only two working days before the oral proceedings.

The Board did not share the respondent's view for the reasons given by the appellant. As already pointed out under point 2.2 above when discussing the admission of D13(O)' and D13(O)" in the proceedings, a machine translation of D13(O) was already available to the respondent more than one month before the proceedings

in which all the necessary technical information was clearly and readily available to a skilled reader. D13(O)" did not include any additional technical information. The argument of only two working days leading to a lack of time for the respondent to revert and discuss the matter with the client could therefore not be followed. The appellant further cited T 557/94 (not published in OJ EPO, point 1.3 of the reasons) to support the fact that, even in case where documents are filed late in appeal, the Board can still decide to not remit the case to the department of the first instance.

In view of the above, the Board decided that the invoked reasons could not justify to remit the case to the department of first instance.

4. Main request (patent as granted)

4.1 Novelty (Article 54(1) EPC)

Contrary to its written submissions, the appellant stated during the oral proceedings that it did not dispute the novelty of the subject-matter of claim 1 any more. This view was shared by the Board since none of the available documents discloses in combination all of the features of claim 1.

Consequently, the subject-matter of claim 1 is novel (Article 54(1) EPC).

4.2 Inventive step (Article 56 EPC)

The appellant raised inventive step objections starting from either D14 or D13(O) as closest prior art.

4.2.1 Starting from D14

In the following, it is essentially referred to D14 (abstract and figures) and D14' since, as already indicated above when discussing admissibility of the documents, D14" does not add any technical information to what could be derived from D14'.

(a) Closest prior art D14

D14 can be selected as closest prior art document since it is directed to a similar purpose or effect as the contested patent, i.e. a labelling machine for printing and applying self-adhesive labels, the latter of a linerless type (no peeling station).

(b) Disclosure of D14

D14 discloses in the wording of claim 1 a labelling machine for printing and applying machine labels on containers, comprising:

- an adhesive tape reel (6) from which the labels (3A) are formed;
- a reel unwinding system comprising at least an unwinding roll (see tape reel 6 in figure 5);
- a tape (5) adhesivized on the internal side of the reel (6);
- a printing group (10), comprising a printing system wherein the contact between the print head (13) and the adhesive tape to be printed (6) is carried out by a driving roll (12, 24, 25) of anti-adherent material (see paragraph [0010], "silicon processing"), which cyclically inverts its rotation direction ("drawing back...in the direction opposite"; see also arrows in both directions on driving roll (12) in figure 1);
- a cutting system (11) comprising:

- a cutting blade (15) which rotates about an horizontal axis, i.e. moves at least locally perpendicularly to the surface of the tape to be cut and hence to its direction, from which the labels (3A) are obtained;

- a counter-blade (14);

the cutting system (11) being adjacent to the printing group (10) (D14, abstract and figures 1, 5-7; D14', [0006], [0010], [0011], [0019], [0029] and [0038]).

D14 does not explicitly disclose a tape tensioning device. However, as argued by the appellant, such a mechanism of this kind is necessarily present in such a machine for its functioning, i.e. to prevent uncontrolled unwinding and jamming of the tape. This has not been contested by the respondent.

The claimed optional photocell is also disclosed in D14 (detection sensors 34, 35).

(c) Distinguishing features

D14 does not disclose the following features of claim 1:

- (i) - the cutting blade has the cutting edge inclined of an angle comprised between 2° and 45°, preferably between 2° and 30° with respect to the tape to be cut;
- (ii) - the blade and counter-blade cutting surfaces are covered with solid anti-adhesives; and
- (iii) - the machine comprises an applying pad.

There is no explicit disclosure of feature (i) in D14. The appellant considered that this feature is implicitly disclosed due to the fact that the rotary blade (15) performs a **complete** rotation to cut the

label (D14', [0029], "...after one revolution..."). This complete rotation would necessarily imply that the rotary cutting blade of D14 is distributed around the shaft holding the rotary blade and, hence, said rotary blade would inevitably exhibit an angle, said angle being also inevitably within the range of up to 45°.

The Board did not share this view for the reasons given during the oral proceedings that the disclosure of a revolution of the rotary blade to cut the label does not necessarily imply that the blade is inclined with respect to the tape and/or arranged in an inclined manner around the rotary blade holding shaft. From paragraph [0029] of D14' it can only be concluded that, as stated therein, the cutting blade has to be brought back to its initial position ("...one revolution...") after the cutting operation in order to "not become trouble to a transfer of the pasteboard-less label 6 or the label piece 3A". Indeed, the cutting blade should not stay on the way of the label. No other meaning can be derived from this passage of D14'. As a matter of fact, if the cutting blade were to be constructed like the grass cutter shown in the drawing, page 3 of the appellant's letter dated 17 April 2014, it would indeed impede the transport of the label, which goes against the disclosure of D14'. The Board can therefore not follow the appellant's view that an angle of the cutting blade, corresponding to the one of feature (i), would be, at least implicitly, disclosed by D14.

With respect to feature (ii), the appellant referred in its written submissions to paragraph [0010] of D14' which, however, concerns solid anti-adhesives ("silicon processing") for the printing group, not for the cutting system as claimed. The fact that, as argued by the appellant, solid anti-adhesives would be common in

the present technical field or possibly not essential according to the contested patent itself, paragraph [0012], because of the term "preferably" does not relate to the disclosure of D14, but rather to inventive step. The appellant admitted during the oral proceedings that feature (ii) could be seen as a distinguishing feature of claim 1 over D14.

There is no explicit disclosure of feature (iii) in D14. Paragraph [0038] of D14' refers either to a "pasting roller" (not shown in the figures) or to a "manual sticking". This passage does not disclose a "pad", neither explicitly nor implicitly. The fact that an applying pad could be common in the field or that the description of the contested patent, [0046], may leave room for "various systems", as argued by the appellant, does not relate to the disclosure of D14. The Board can therefore not follow the appellant's view that feature (iii) would be disclosed by D14.

Features (i), (ii) and (iii) are thus considered as distinguishing features.

(d) Technical effects of the distinguishing features

Features (i) and (ii) may be seen as having the synergetic effect of avoiding "*any build-up of adhesive residues both on the blade and on the counter-blade, allowing a high speed of application of the closing device on the packs and avoiding machine shutdowns for cleaning*" as explicitly given in D7A which discloses a cutting system comprising a cutting blade and a counter-blade as defined by features (i) and (ii), [0010] to [0015], [0029], [0036], claims and figures 2.1 and 2.2 (see also contested patent, [0035]).

With respect to feature (iii), the technical effect appears to be to apply the label onto the product, i.e. the same effect as for the means provided in D14 (D14', [0038]; pasting roller or manual application).

Features (i) and (iii) on one side and feature (iii) on the other side appear therefore to have no synergetic effect so that they have to be dealt with separately in the examination of inventive step.

(e) Problems to be solved

The first partial problem to be solved in view of the effect(s) of features (i) and (ii) is seen as to provide the machine of D14 with a cutting system enabling to increase the machine speed and avoid shutdowns.

The second partial problem to be solved in view of the effect of feature (iii) can be seen as providing the machine of D14 with an alternative label application means.

(f) Obviousness

The Board is of the opinion, contrary to the respondent, that the skilled person, in view of the advantages of the cutting system disclosed in D7A, will certainly, in an attempt to solve the first problem, consider to implement this cutting system in the machine of D14. However, as argued by the respondent during the oral proceedings, the combination of D14 with D7A would not lead the skilled person to the claimed subject-matter. Indeed, in the device of D14 the adhesive tape is returned after the cutting in a direction opposite to the transport direction by

inverting the rotation of the driving roll (12) of the printing system (10) **in order to separate it from the cutting mechanism** (D14', [0012]), since it sticks to the stationary blade (14). Consequently, the skilled person implementing the solution of D7A in the device of D14 will realize that it is no longer required to invert the rotation of the driving roll any more since, due to the application of the solid anti-adhesive on the cutting blade and the counter-blade, the adhesive tape will already be prevented from sticking to the cutting mechanism. As a result, taking over the complete solution of D7A, i.e. the known cutting system comprising a blade and a counter-blade according to features (i) and (ii), the skilled person will, when replacing the rotary cutting mechanism of D14, also **remove the inverting mechanism which belongs de facto to the cutting mechanism of D14**. Consequently, by doing so, the skilled person will arrive at a machine which no longer comprises an inverting mechanism, i.e. a machine falling outside the claimed labelling machine. As a consequence, the skilled person would not arrive at the subject-matter of claim 1 in an obvious manner by the combination of the disclosures of D14 and D7A (Article 56 EPC).

For completeness' sake it shall be indicated that with respect to the second problem, the skilled person looking for an alternative to the pasting roller or the manual application of D14 (D14', [0038]), will immediately consider an applying pad since it is common in the technical field concerned as shown for instance by D5 ("applicator head" 16; figure 1) or D8 ("upper platen" 58; column 7, lines 28-61) for fixing labels onto products. The skilled person would see no difficulty to adapt any known and usual applying pads

to the device of D14. Therefore, feature (iii) does not support an inventive step.

4.2.2 Starting from D13(O)

In the following, it is essentially referred to D13(O) (abstract and figures) and D13(O)' since, as already indicated above when discussing admissibility of the documents, D13(O)" does not add any technical information to what could be derived from D13(O)'.

(a) Closest prior art D13(O)

D13(O) relates to labelling and printing machines on continuous paper, i.e. a neighbouring technical field to that of claim 1 of printing machines on adhesive tape, and intends as indicated in the following to solve the same problem of the contested patent (cf. paragraphs [0005] and [0034]), of avoiding processing waste. Therefore, the Board considers that D13(O) is, like D14, an appropriate starting point for assessing inventive step, contrary to the respondent's view.

As recalled by the Board in the annex, point 9.1, inventive step must be given **irrespective of which of the available documents** is selected as closest prior art, as long as it belongs to the relevant technical field. The respondent had therefore to expect that inventive step would be discussed at the oral proceedings in view of other documents than D14, at that time considered as being the best starting point, should it be concluded that the objection based on D14, preliminarily held valid by the Board, would not hold. This is all the more true since many other objections of lack of inventive step had been raised by the appellant. In particular, D13(O) had also been regarded

as a possible starting point for inventive step in the statement of grounds of appeal, point 5.3.8, and the Board further explicitly informed the parties that the non-admission of D13(O) in the proceedings by the Opposition Division would have to be re-considered in view of its possible relevance for inventive step (annex, point, 6.1.1). Consequently, the respondent could not be surprised that inventive step was also discussed at the oral proceedings on the basis of D13(O).

(b) Disclosure of D13(O)

D13(O) discloses in the wording of claim 1 a labelling machine for printing labels, comprising:

- a tape reel of continuous paper (2) from which the labels are formed;
- a reel unwinding system comprising at least an unwinding roll (see figure 6) and a continuous paper tensioning device (7);
- a printing group (4, 5), comprising a printing system wherein the contact between the print head (5) and the continuous paper to be printed (2) is carried out by a driving roll (4), which cyclically inverts the rotation direction by the action of a paper feed motor (3);
- a cutting system (6) comprising:
 - a cutting blade (6) which moves perpendicularly to the direction of the continuous paper to be cut, from which the labels are obtained;
 - a counter-blade (see figure 5);the cutting system (6) being adjacent to the printing group (4, 5) (D13(O), abstract and figures 5-6).

The translations D13(O)' and D13(O)" merely confirm the above recited disclosure of D13(O), i.e. the technical information available from the English abstract and

figures 5-6. During the oral proceedings, at the very start of the discussion on inventive step in view of D13(O), the respondent, asked by the Board, stated that it understood the technical content provided in the late filed translation D13(O)" so that it did not need time to study the document. It also added that it would request an interruption of the oral proceedings, in case it would consider necessary to be allocated more time to further study D13(O)", which it did not do.

(c) Distinguishing features

D13(O) does not disclose the following non-optional features of claim 1:

- (i) - the cutting blade has the cutting edge inclined of an angle comprised between 2° and 45°, preferably between 2° and 30° with respect to the tape to be cut;
- (ii) - the blade and counter-blade cutting surfaces are covered with solid anti-adhesives;
- (iii) - the machine comprises an applying pad;

and

- (iv) the machine is for printing and applying labels on containers;
- (v) an adhesive tape reel with a tape adhesivized on the internal side of the reel; and
- (vi) the driving roll is of anti-adherent material.

As argued during the oral proceedings, the respondent considers that D13(O) concerns the printing of forms having always the same format on continuous paper, while claim 1 on the contrary relates to printing "labels" of different formats and texts on adhesive tape to be applied on containers.

The Board, however, following the appellant's view, considers that these arguments do not disqualify D13(O) as an appropriate starting point for inventive step for the reasons given under point (a) above and, further, that the term "label" as such cannot be seen as leading to a distinguishing feature over D13(O) since it has a broad meaning and, hence, also encompasses the type of "label" disclosed by D13(O) (cf. abstract). The respondent's argument that the claimed machine aims at printing different label formats and/or texts cannot be regarded as concerning a distinguishing feature over D13(O), since, as referred to by the Board during the oral proceedings, a corresponding feature is not included in claim 1 of the main request.

The respondent is further of the opinion that, in addition to the above features, D13(O) does not disclose that the cutting system is adjacent to the printing group.

The Board cannot share the respondent's view for the reasons put forward by the appellant during the oral proceedings that "adjacent" does not mean "directly adjacent" in the sense that the cutting system and the printing group would be in contact or located within a specific distance from each other. The term "adjacent" has indeed a broad meaning and, hence, also encompasses the constructional design shown in figure 5 of D13(O), in which the cutting mechanism (6) is "adjacent" to the printing group (4, 5). This feature could therefore not be regarded as a distinguishing feature of the subject-matter of claim 1 over the machine known from D13(O).

(d) Technical effects of the distinguishing features

The technical effects of features (i), (ii) and (iii) are already discussed under point 4.2.1.(d) above. The technical effect of features (i) and (ii) is to avoid any build-up of adhesive residues both on the blade and on the counter-blade. The technical effect of feature (iii) is to apply the label onto the product.

As discussed during the oral proceedings the technical effect of features (iv), (v) and (vi) is regarded as to render the machine suitable for printing and applying labels of adhesive tape on containers.

(e) Problems to be solved

The first partial problem derived from the effect of features (i) and (ii) on one side and the second partial problem derived from the effect of feature (iii) on the other side are already given under point 4.2.1.(e) above.

With respect to features (iv), (v) and (iv), as put forward by the appellant during oral proceedings, the third partial problem to be solved is regarded as to render the machine of D14(0) suitable for using adhesive tape to be applied on containers.

(f) Obviousness

With respect to features (i) and (ii), the skilled person, when combining D7A with D13(0) will, contrary to the discussion under point 4.2.1.(f) above, keep this time the inverting mechanism of D13(0) since the latter is not linked to the cutting mechanism but rather intends to reversely feed the paper in order to bring the leading edge of the paper (2) back to the printing position for avoiding waste (D13(0), abstract,

"without cutting in the halfway"; confirmed by D13(O)', page 1, line 28 to page 2, line 15 and D13(O)", page 2, line 24 to page 3, line 25). The skilled person will find no technical difficulty to apply the solution known from D7A to the cutting mechanism of D13(O) so that features (i) and (ii) do not support an inventive step.

The respondent's argument that the skilled person would rather look in D5 for a solution to the problem derived from the cutting mechanism since, *inter alia*, D5 relates to a linerless label like D14, cannot be followed since this does not prevent the skilled person from contemplating the combination of D7A with D13(O).

For the same reasons as given under point 4.2.1.(f) above, feature (iii) cannot support an inventive step.

If, as discussed during the oral proceedings, the skilled person is, depending on circumstances, faced with the problem of adapting the machine of D13(O) for the use of adhesive tape corresponding to feature (v), he will use and apply his common general knowledge to prevent the tape from sticking to the contacting parts of the machine. By doing so he will implement the necessary constructional measures and come up with solutions according to features (iv) and (vi) in an obvious manner. As put forward by the appellant, when adapting the machine of D13(O), the skilled person will also immediately consider of inverting the reel shown in figure 6 of D13(O) in order to obtain the printing face of the tape in front of the printing head (5) within the framework of his common general knowledge. Therefore, features (iv), (v) and (vi) cannot support an inventive step.

In addition, as discussed during the oral proceedings, the machine of D13(O) is suitable for printing a single page/label. It is indeed computer-controlled and the number "N" of pages/labels to be printed can be set to "1", which is in fact the value by default. Printed single pages/labels are unambiguously applicable to containers (see D13(O)', page 2, line 46 to page 3, line 10 or D13(O)", page 4, last paragraph).

As a result of the above, the skilled person starting from D13(O) and using the teaching of D7A together with his common general knowledge will arrive at the claimed subject-matter in an obvious manner (Article 56 EPC).

5. First auxiliary request - Admissibility in the proceedings

5.1 The respondent filed the first auxiliary request at the very beginning of the oral proceedings.

As a result of the late filing, the admission of the first auxiliary request in the proceedings is subject to the discretionary power of the Board as set out in Article 13(1) RPBA.

5.2 Amendments (Articles 123(2) and (3) EPC)

Claim 1 of the first auxiliary request corresponds to independent process claim 16 of the patent as granted; dependent claims 2-9 of the first auxiliary request are based on dependent claims 17-24 of the patent as granted.

The requirements of Articles 123(2) and (3) EPC are therefore fulfilled. This was not contested by the appellant.

5.3 General arguments

5.3.1 The respondent argued that, since claim 1 of the first auxiliary request corresponds to claim 16 of the patent as granted, i.e. has been in the proceedings from the very beginning, and has never been discussed exhaustively, neither in opposition nor in appeal proceedings (see points 8.2 and 9.2 of the annex), the first auxiliary request should be admitted and the case be remitted to the department of first instance for further prosecution on the basis of this request in order to preserve the respondent's right of two instances.

It also added that first auxiliary request should be admitted in reaction to the admission of the late filed translations of D13(O) and D14 in the proceedings.

5.3.2 The Board, however, cannot find in the Rules of Procedure of the Boards of Appeal or the EPC, as apparently suggested by the respondent, a mechanism of automatism that would force the Board at the oral proceedings to admit any late filed request once a late filed document would have been admitted in the proceedings. In fact, for each late filed submission, be it a document or a request, the Board has to exercise its discretionary power based on applying criteria independently in order to ensure objective decisions. There is indeed no absolute right of admissibility of requests (R 1/13, not published in OJ EPO).

In fact, for the reasons already given under point 2 above, the late filed translations of D14 and D13(O), *a fortiori* the documents D14 and D13(O) themselves, could not be regarded as being new facts and/or evidence

coming as a surprise to the respondent at the oral proceedings before the Board which would justify to admit late filed auxiliary request(s).

As already put forward under point 3.3 above and again argued by the appellant during the proceedings, there is no absolute right for a party to have an issue decided by two instances.

In the present case, in relation to the requirement of procedural economy, the Board examined, as indicated to the parties during the oral proceedings, whether the new late filed request would be *prima facie* allowable in that it overcomes objection(s) regarded as validly raised against the main request and does not raise any new issues.

Consequently, during the oral proceedings, the discussion on admissibility of the late filed auxiliary request(s) focused on whether the objection of lack of inventive step starting from D13(O) raised against claim 1 of the main request appeared *prima facie* overcome or not.

5.4 *Prima facie* overcoming inventive step objection(s)

5.4.1 The respondent argued that the following feature of claim 1:

"the tape (5) enters the cutting system (2) moving in a direction perpendicular to the cutting blade (2a); the blade (2a) cuts the tape maintaining a preferably constant inclination; the contact point between the blade (2a) and counterblade (2b) during the cut moves transversally in a continuous way through the tape section (5)"

would enable *prima facie* to overcome the objection of lack of inventive step.

It considered that none of the documents D13(O) and D7A discloses a constant inclination of the blade as claimed. The contested patent, as shown in figure 2, more particularly the top view, clearly shows that the cutting blade (2a) is inclined with respect to the moving direction of the tape or to the counterblade (2b), the latter being in a plane perpendicular to the moving direction of the tape. This inclination of the cutting blade (2a) with respect to the moving direction of the tape has the technical effect to obtain a tape cut perpendicularly, while moving. It has the advantage of obtaining a perpendicular cut, i.e. a rectangular label, without having to stop the machine or to implement an additional cutting station.

- 5.4.2 The Board could not share the respondent's view for the following reasons put forward by the appellant during the oral proceedings.

The respondent's interpretation that the feature of claim 1 "preferably constant inclination" has the meaning that the blade is necessarily inclined but "preferably" at a constant angle over all its length cannot be followed. Indeed, due to the word "preferably" used, this feature can also be seen as optional, i.e. claim 1 also encompassing blades with no inclination. Such a feature, which can be considered as optional, cannot support inventive step.

Furthermore, the inclination shown in figure 2 of the contested patent, i.e. perpendicularly to the moving direction of the tape, is **not** included in claim 1. It

is in fact not specified in claim 1 how or about what the blade is to be inclined. D7A, figure 1, also discloses an inclined mobile blade (2a) about an axis perpendicular to the plane of the sheet so that this feature is also known from D7A. When implementing the solution of the cutting mechanism of D7A into the machine of D13(O), the skilled person will certainly envisage to incline the cutting blade accordingly, arriving at the claimed subject-matter in an obvious manner.

Finally, contrary to the respondent's view, although explicit from claim 1 that the tape is moving when entering the cutting mechanism, the claim is silent on whether the tape actually moves or not during the actual cutting process. Therefore, the alleged technical effects and/or advantages put forward by the respondent of obtaining a rectangular label without having to stop the machine or to implement an additional cutting station are not to be considered since not based on features defined in claim 1.

Consequently, as indicated during the oral proceedings, claim 1 of the first auxiliary request does not appear *prima facie* to overcome the objection of lack of inventive step raised against claim 1 of the main request. The Board thus decided to not admit the first auxiliary request in the proceedings (Article 13(1) RPBA).

As a result, the respondent's request to remit the case to the department of the first instance on the basis of this request cannot be granted either.

6. Objection under Rule 106 EPC

6.1 At the oral proceedings, after the Board informed the parties about the conclusion of its deliberation to not admit the first auxiliary request in the proceedings, the respondent raised an objection under Rule 106 EPC on the grounds that the proceedings was not fair since, on one hand D13(O) and D14 were admitted in the proceedings, with their late filed certified translations, two days before the oral proceedings for D13(O), while on the other hand the first auxiliary request restricted to the process claims of the patent as granted, i.e. claims already in the proceedings from the very beginning, was not admitted in the proceedings. Furthermore, its right to be heard was violated since it had not enough time for contacting and discussing the late filed certified translation of D13(O) with its client as two working days were certainly not sufficient.

6.2 However, the respondent did not add any further arguments with respect to those already discussed, on one hand, for the admission of the late filed documents D13(O), D14 and their translations D13(O)', D13(O)", D14' and D14" and, on the other hand, the admissibility of the first auxiliary request.

The respondent's unsubstantiated objection did not point to any procedural deficiency to be remedied. In view of this objection, the Board did **not see a reason to change its findings** on the substantive issues which had already been discussed.

As put forward above, the Board applied the appropriate criteria independently for exercising its discretionary power in deciding on the admission of, on one hand, the

late filed documents and, on the other hand, of the first auxiliary request. A fair treatment does not require that a party losing on one issue should win on the next one in order to obtain a balanced situation. In order to safeguard fairness, each issue subject to the Board's discretionary power has to be and has presently been decided by applying the appropriate criteria for each issue independently. This is exactly how the Board proceeded. Consequently, it could not find any lack of fairness to be remedied.

Concerning the alleged violation of the right to be heard, as already referred to above, the late filed certified translation of D13(O) (=D13(O)') did not add any technical information that the respondent could not have found and understood in the machine translation D13(O)' for it to revert and discuss with its client within one month before the oral proceedings. In the annex to the summons for oral proceedings, the Board explicitly mentioned D13(O) as potentially relevant for inventive step with even an invitation for filing a translation, so that the respondent could not simply ignore D13(O)' in its preparation for the oral proceedings. For the Board, the objection based on only two days having been available for the preparation for the oral proceedings could therefore not hold.

The respondent was made aware of the grounds which were intended to substantiate both issues - admission of late filed documents and their translations; inadmissibility of the first auxiliary request - and had obviously opportunities, at least during the oral proceedings, to take position on both issues. Its comments made in using these opportunities were carefully considered by the Board. Consequently, the respondent's right to be heard according to Article

113(1) EPC was safeguarded (see Case Law of the Boards of Appeal, 7th Edition 2013, III.B.1.1, 1.2, 2.1.1 b)).

As a result, the Board dismissed the objection.

7. Second auxiliary request - Admissibility in the proceedings

7.1 Like the first auxiliary request, the respondent filed the second auxiliary request at the very beginning of the oral proceedings.

As a result of the late filing, the admission of the second auxiliary request in the proceedings is subject to the discretionary power of the Board as set out in Article 13(1) RPBA.

7.2 Amendments (Articles 123(2) and (3) EPC)

Claim 1 of the second auxiliary request corresponds to the combination of independent process claim 16 and dependent claim 22 of the patent as granted; dependent claims 2-8 of the second auxiliary request are based on dependent claims 17-21, 23-24 of the patent as granted.

The replacement in claim 1 of "container" by "package" is disclosed for instance in the description of the application as originally filed, column 1, lines 3-7, or in original claim 22.

The requirements of Articles 123(2) and (3) EPC are therefore fulfilled. This was not contested by the appellant.

7.3 *Prima facie* allowability

7.3.1 For the same reasons as for the first auxiliary request, as a matter of procedural economy concern, the Board examined whether the new late filed request would enable *prima facie* to overcome the objection regarded as validly raised against the main request.

7.3.2 The respondent argued that the following feature of claim 1:

"the sizes and the label text of the packaging line packages can be varied from one package to another even more times or in a continuous way, without interrupting the production cycle."

would enable *prima facie* to overcome the objection of lack of inventive step.

It argued that none of the documents D13(O) and D7A discloses this feature. In particular, the machine of D13(O) explicitly continuously produces the **same** label, which is contrary to claim 1 (D13(O)', page 1, lines 4-6 or D13(O)", page 1, lines 24-25).

7.3.3 This was not contested by the appellant which put forward that the respondent had more than one month after having received the machine translation D13(O)' to react and file its auxiliary request. Consequently, such a late filed request should not be admitted in the proceedings.

7.3.4 The Board, however, shares the respondent's view that the appellant could not be surprised by a combination of features from claims of the patent as granted, especially when the features taken from the dependent

claim (claim 22 in present case) relate to the core of the discussion in opposition and appeal proceedings (see impugned decision, points 22 and 23.3; statement of grounds of appeal, point 5.2 iii)). Since, on one hand, the combination of D13(O) and D7A does not appear *prima facie* to lead the skilled person in an obvious manner to the subject-matter of claim 1 of the second auxiliary request and, on the other hand, the new set of claims does not appear to introduce new issue(s) which would have not been discussed so far in the proceedings, the Board does not see any reason to not admit the second auxiliary request in the proceedings.

- 7.3.5 The decision under appeal dealt exclusively with the machine claims of the patent as granted, which are no longer comprised in the second auxiliary request of the respondent. Therefore, taking into account that the set of process claims according to the second auxiliary request appears *prima facie* to overcome the lack of inventive step objections raised in the course of the appeal proceedings, the Board considers it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution on its basis.

Since "*prima facie*" merely sets a first hurdle by definition, the Opposition Division will have to consider in the course of the further prosecution, *inter alia*, whether the claims of the second auxiliary request actually comply with the requirements of Article 56 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the second auxiliary request (claims 1 to 8) filed during the oral proceedings on 21 May 2014.

The Registrar:

The Chairman:



G. Nachtigall

H. Felgenhauer

Decision electronically authenticated