

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 16 January 2013**

Case Number: T 0007/11 - 3.2.04

Application Number: 04818833.8

Publication Number: 1703811

IPC: A24C 5/28

Language of the proceedings: EN

Title of invention:

Cutting unit for cutting continuous cigarette rods

Patentee:

G.D SOCIETÀ PER AZIONI

Opponent:

Hauni Maschinenbau AG

Headword:

-

Relevant legal provisions:

EPC Art. 100a), 114(2)

RPBA Art. 13(3)

Keyword:

"Inventive step - main request (no)"

"Auxiliary requests - admissibility (no) (Reasons 4)"

Decisions cited:

-

Catchword:

-



Case Number: T 0007/11 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 16 January 2013

Appellant: Hauni Maschinenbau AG
(Opponent) Kurt-A.-Körper-Chaussee 8 - 32
D-21033 Hamburg (DE)

Representative: Schulze, Udo
Patentanwälte Wenzel & Kalkoff
Postfach 73 04 66
D-22124 Hamburg (DE)

Respondent: G.D SOCIETÀ PER AZIONI
(Patent Proprietor) Via Battindarno, 91
I-40133 Bologna (IT)

Representative: Jorio, Paolo
Studio Torta S.p.A.
Via Viotti, 9
I-10121 Torino (IT)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
5 November 2010 concerning maintenance of
European patent No. 1703811 in amended form.

Composition of the Board:

Chairman: A. de Vries
Members: C. Scheibling
C. Heath

Summary of Facts and Submissions

- I. In its interlocutory decision posted on 5 November 2010, the Opposition Division found that, taking into consideration the amendments made by the patent proprietor, the European patent no. 1 703 811 and the invention to which it relates met the requirements of the EPC. On 30 December 2010 the Appellant (opponent) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 4 March 2011.
- II. The patent was opposed on the grounds of Articles 100(a) EPC.
- III. The following documents played a role in the present proceedings
- E1: DE-C-33 08 380
 - E4: DE-A-31 40 769
 - E11: "HBE.2545.00.2.d", "Verteiler VE2 Strangeinheit SE2, Handbuch Bedienen und Einrichten", Hauni, edition 06/1994
- IV. Oral proceedings before the Board took place on 16 January 2013.
- V. The Appellant (Opponent) requests that the decision under appeal be set aside and that the patent be revoked.

The Respondent (Proprietor) requests that the appeal be dismissed, in the alternative that the decision under appeal be set aside and the patent be maintained on the basis of one of the sets of claims of auxiliary

requests 1 and 2 filed as auxiliary requests 2 and 3 respectively with letter dated 24 December 2012. Auxiliary request 1 was withdrawn during the oral proceedings before the Board.

VI. Claim 1 of the main request reads as follows:

"A cutting unit for cutting continuous cigarette rods fed in a given travelling direction (6) [feature M1], the cutting unit (1) comprising:

a supporting body (9) [feature M2];

a cutting head (12) fitted to the supporting body (9) to rotate about a first axis (20) [feature M3], the cutting head (12) comprising a cutting drum (15), which rotates about a second axis (16) forming a given angle with said travelling direction (6), and has at least one radial blade (8) [feature M31]; and

actuating means (27, 31, 32) interposed between the supporting body (9) and the cutting head (12) to rotate the cutting head (12) about said first axis (20) to vary said angle [feature M6]; and

the cutting unit (1) is characterized in that it comprises:

locking means (24), which are different from the actuating means (27, 31, 32) [feature M7];

the locking means (24) being designed for angularly locking the cutting head (12) in position on said supporting body (9) [feature M5], and comprising automatic [feature M51] release means (48) for releasing the cutting head (12) with respect to the supporting body (9) [features M52];

a counter-cutting device (4), which is engaged by at least one said continuous cigarette rod (3), and

through which said first axis (20) extends [feature M4]; and

sensor means (23) for determining said angle and for negative-feedback-controlling said actuating means (27, 31, 32) [feature M8]."

Claim 1 of auxiliary request 1 adds to claim 1 of the main request the features of claims 8 and 10 as granted.

Claim 1 of auxiliary request 2 adds in essence to claim 1 of auxiliary request 1 the features of claims 11 and 12 as granted.

VII. The Appellant mainly argued that starting from E1 or E4 as closest prior art, the problem underlying the invention can be seen in automating the cutting angle setting procedure. However, the mere automation of functions previously performed by hand is a general trend in technology which cannot involve inventiveness. The auxiliary requests are late filed and change the framework of the case, so that they should not be admitted into the proceedings.

VIII. The Respondent mainly submitted that starting from E1 and considering the teaching of E4, the skilled person would not arrive at the claimed invention without inventive skill, even if taking into account its normal capability. Starting from E4 and taking into account the teaching of E1 the skilled person would realise that it would be difficult to provide release means for the locking means disclosed in E4, that the motor of the actuating means of E1 would be sufficient for angularly locking the cutting head and therefore remove

the locking means disclosed in E4. Therefore a combination of E4 with E1 even if taking into account the general knowledge of the skilled person would not lead to the claimed invention in an obvious manner. The auxiliary requests were filed in response to the fact that E11 could possibly be admitted into the proceedings. This became only clear when the Appellant filed evidence relating to the public availability of E11. The auxiliary requests add the features of granted dependent claims to claim 1 of the main request. These dependent claims were already attacked in opposition so that the Appellant has not been taken by surprise. Therefore, these requests should be admitted into the proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Inventive step*
 - 2.1 The Board considers E4 to disclose the closest prior art. It is one of a number of possible starting points which serves the same purpose and aim as the present claimed invention and has a large number of features in common with it.

Thus, it is undisputed that E4 discloses a cutting unit which includes the features M1, M2, M3, M31, M4 and M5 of claim 1; see page 8, ultimate paragraph to page 9, penultimate line; page 12, lines 3 to 10; Figures 1, 2. These show a cutting unit with a drum shaped cutting head 29 bearing a radial blade 13 and which is mounted in a support body 14 to rotate via drive train 8 and 9

(see figure 1). The rotating drum is slightly tilted with respect to the direction of travel of the cigarette rods 3, 4 through counter cutting devices 50 to 55. The tilt angle can be adjusted by rotating a mounting part 20 with slots 24 within arcuate section 16 on the support body 14 as shown in figure 2. The drum and mount is locked into place by tightening bolts 23 protruding from the arcuate section 16 through the slots 24.

The Appellant considers that the slots 24 forming the guide means (see figure 2 of E4) are actuating means (feature M6). This point of view cannot be shared. In fact in E4 the angle is set manually by the operator and thus there are no actuating means in the proper sense of the term as used in claim 1 and throughout the patent. Moreover, even if release means must be present in some way, they are not part of the locking means and therefore feature M51 is not disclosed by E4 either. However, since the actuating is performed by the operator and the locking is performed by the bolts 23, E4 clearly discloses features M7.

2.2 Thus the cutting unit of claim 1 differs from that of E4 in that it further comprises:

- actuating means being interposed between the supporting body and the cutting head to rotate the cutting head about said first axis to vary said angle (feature M6);
- locking means comprising automatic release means for releasing the cutting head with respect to the supporting body (features M51 and 52);

- sensor means for determining said angle and for negative-feedback-controlling said actuating means (feature M8).

2.3 It is common ground that these differences allow the tilt angle to be adjusted automatically and precisely, without the need for an operator. In E4 the entire adjustment procedure must be effected by the operator, who must unfasten bolts 24, rotate the head by the required tilt angle and then tighten the bolts again.

The Board agrees with both parties that when starting from E4 as closest prior art, the problem underlying the claimed invention can be seen in fully automating the cutting angle setting procedure in a cutting unit as in E4.

2.4 However, the automation of functions previously performed by hand is a general trend in technology which cannot be considered inventive per se. Thus, formulating the problem does not itself involve an inventive step.

2.5 To set the cutting angle of the cutting unit of E4, the operator must carry out the following sequence of steps as stated:

- unlock bolts 23 as locking means,
- precisely adjust the angular position of the cutting head, and
- tighten bolts 23.

The most obvious way of fully automating the cutting angle setting procedure is to automate each individual step by appropriate means.

To automatically unlock bolt 23 the skilled person will obviously provide appropriate means that serve that function that is means that automatically unlock the bolts and so release the cutting head from its locked position with respect to the supporting body. Such means correspond to the automatic release means of claim 1. It is noted in this context that claim 1 gives only a functional definition of the means. Such a definition is not concerned with the particular mode of realisation but is rather intended to cover the general idea of automating unlocking or release. As stated, that idea follows obviously from the fact that the skilled person will recognise immediately that he must automate each individual step by appropriate automatic means if he wants to automate cutting head angle adjustment.

For this reason the skilled person will also as a matter of obviousness provide separate means for carrying out the adjustment, without the intervention of an operator.

As in the prior art it is the operator who moves the cutting unit to its new adjusted position, automating this step necessarily requires his replacement by appropriate moving and actuating means, which must naturally be interposed in some manner between the support body and the cutting head which is to be moved with respect to the support body. Again the purely functional definition means that there is no limitation to any specific realisation of the means that perform this function. It is rather the general idea of automating the movement of the cutting head which is to be moved with respect to the support body that is meant

to be covered. This idea, divorced of any concrete manner of realisation, is itself obvious.

Given that the cutting head tilt must be set precisely, see page 5, lines 22 to 27 and page 12, lines 6 to 19 of E4, any automation of the tilt adjustment must also be so as to produce precise tilt angle. In automation control, the field in which the skilled person, a mechanical engineer tasked to automate operation of the cutting unit, will be knowledgeable, there are basically two alternative approaches to achieve this, open loop and closed loop control. The latter option, which offers the higher accuracy, uses a sensor providing a measure of the output to provide a negative-feedback-signal to the control. This is the option that the skilled person, faced with the task of automation of the accurate adjustment procedure, would choose as a matter of obviousness. The use of a sensor for sensing the head angle for negative feedback controlling the actuating means as claimed then applies this closed loop approach in an entirely standard way that is devoid of inventive insight.

Thus, the features which distinguish the cutting unit of claim 1 from that of E4 correspond to the measures that a skilled person would take naturally and without inventive skill in order to automate the cutting unit of E4.

- 2.6 The Respondent argues that although it might be obvious for the skilled person to provide actuating means to automate the angle setting procedure, since actuating means comprise a motor as in E1 and owing to the fact that it would be difficult to provide release means for

the locking means disclosed in E4, the skilled person would realise that the motor of the actuating means could be used for locking the actuating means and thus the cutting head and therefore, suppress the locking means disclosed in E4.

This point of view cannot be shared. It has first to be noted that E1 does not indicate that the actuating means disclosed therein are powered by a motor. That the motor of the actuating means could in addition perform the locking in position of the actuating means is purely speculative and even if this possibility were envisaged by the skilled person (which would not be obvious), it would be doubtful whether the actuating means could then provide the necessary steadiness to the cutting head when operating the machine. If anything, the skilled person would be much more likely to reject the idea of removing the locking means that are foreseen in E4.

The Respondent also refers to the fact that the prior art does not disclose any form of release means for locking means. However, claim 1 does not itself specify the release means in any way, but simply states that such release means are to be provided, i.e. simply defines the result to be achieved without any further indication. As stated above the mere idea of an automated release means is an obvious aspect of obvious automation of the tilt angle adjustment.

2.7 Accordingly, the subject-matter of claim 1 of the main request does not involve an inventive step when starting from E4 and when taking into consideration the normal capability of the skilled person.

3. *Auxiliary requests*

3.1 Auxiliary requests were filed with letter dated 24 December 2012. On this day the EPO was closed and remained closed until the 2 January 2013, when a copy of the Respondent's letter was sent to the Appellant.

3.2 The auxiliary requests were thus filed after filing the response to the grounds of appeal. Consequently, they constitute amendments to the Respondent's case in the sense of Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA). Under that article the Board is afforded discretion in admitting and considering such amendments. The article further stipulates that this discretion "shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy".

An approach frequently adopted by the Boards when exercising their discretion in admitting amendments filed shortly before oral proceedings can be summarized as follows: the late filing of new amendments is justifiable if its filing is occasioned by an argument or a point first raised in the course of the appeal proceedings.

3.3 The Board first notes that these auxiliary requests could and should have been submitted before but were filed well after the deadline set in its communication dated 28 September 2012.

The Respondent argues that these requests were filed in response to the fact that E11 might possibly be admitted into the proceedings. This became only clear when the Appellant filed evidence relating to the

public availability of E11. However, E11 was filed with the grounds of appeal and even if its admissibility was contested, it could not be excluded that this document might nevertheless be admitted into the proceedings. E11 should therefore have been addressed with the response to the grounds of appeal. The submission of these new auxiliary requests at this late stage is thus not a response to a new line of attack in the Appellant's final submission before the oral proceedings. Furthermore, as the main request has fallen on the basis of the prior art already on file, there was no need to consider admission of E11 into the proceedings and the document has played no further role.

Therefore, there is thus no need to better distinguish the claimed subject-matter from the disclosure of E11. Consequently, the Board concludes that the amendments proposed in the two auxiliary requests are not occasioned either by developments during the proceedings or by a new argument or point raised by the other party, and that there are thus no sound reasons which could justify their late filing.

3.4 Moreover, the Respondent has provided no explanation why the subject-matter of the independent claim of the auxiliary requests should involve an inventive step. Whereas the accompanying letter does indicate the basis of the amendments for the auxiliary requests, it is entirely silent as to how they address the central issue of inventive step identified in the annex to the summons.

This would have been necessary in particular when considering that the added features are those of granted dependent claims 8, 10, 11 and 12, which were

attacked in the statement of opposition, see sections 6.1, 6.3, 6.4 and 6.5 on the basis of documents E5 and E6. These documents however, had not played a role in the appeal proceedings thus far.

If the auxiliary requests were to be admitted into the proceedings, in view of these previous attacks, these documents would need to be considered for a proper assessment of inventive step.

However, given the progressed stage of the proceedings at which this became apparent - during the afternoon of the oral proceedings - it is clear that such a proper consideration would not be feasible without adjourning the oral proceedings for this purpose (as indeed suggested by the Respondent). However, according to Article 13 (3) RPBA "Amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings".

- 3.5 The Board concludes that not only does no clear justification exist for the late filing of the auxiliary requests, but that their admission would necessitate an adjournment of the oral proceedings. Pursuant to Article 13(3) RPBA the Board decides not to admit the late filed auxiliary requests into the proceedings.

Order

For these reasons it is decided that:

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

The registrar:

The Chairman:

G. Magouliotis

A. de Vries