

Internal distribution code:

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

**Datasheet for the decision
of 23 August 2012**

Case Number: T 1138/11 - 3.2.07

Application Number: 00973063.1

Publication Number: 1313649

IPC: B65D 49/06

Language of the proceedings: EN

Title of invention:

Liquid container closure assembly

Patentee:

Guala Closures Patents B.V.

Opponents:

BERICAP Kapak San. Ltd. Sti
Bericap GmbH & Co. KG

Headword:

-

Relevant legal provisions:

EPC Art. 84, 100(a), 101(3), 123(2), 105(1)(b)
RPBA Art. 13(1)

Keyword:

"Intervention - inadmissible (point 1)"
"Features relating to use as defined in claim 1 - not
considered for novelty and inventive step (point 2.2.6); third
auxiliary request - not admitted (point 5.4)"

Decisions cited:

-

Catchword:

-



Case Number: T 1138/11 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 23 August 2012

Appellant 01: Guala Closures Patents B.V.
(Patent Proprietor) Prins Bernhardplein 200
NL-1097 JB Amsterdam (NL)

Representative: Perani, Aurelio
Perani & Partners
Piazza San Babila, 5
I-20122 Milano (IT)

Appellant 02: BERICAP Kapak San. Ltd. Sti
(Opponent 1) Osmangazi, Istasyon Cad. 97
Cayirova 41 410 Gebze/Kocaeli (TR)

Representative: Lieke, Winfried
WSL Patentanwälte
Kaiser-Friedrich-Ring 98
D-65185 Wiesbaden (DE)

Intervener Bericap GmbH & Co. KG
(Opponent 2) Kirchstrasse 5
D-55257 Budenheim (DE)

Representative: Lieke, Winfried
WSL Patentanwälte
Kaiser-Friedrich-Ring 98
D-65185 Wiesbaden (DE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
5 April 2011 concerning maintenance of European
patent No. 1313649 in amended form.

Composition of the Board:

Chairman: H. Meinders
Members: H.-P. Felgenhauer
I. Beckedorf

Summary of Facts and Submissions

- I. The patent proprietor (appellant 01) and the opponent (appellant 02) have filed an appeal against the decision of the opposition division maintaining European Patent No. 1 313 649 in amended form.

With intervention dated 10 August 2012 Bericap GmbH & Co KG, represented by the same professional representative as appellant 02, requested to be considered as intervening party. It paid the opposition as well as the appeal fee.

Appellant 01 requested that the decision under appeal be set aside and the patent be maintained as granted (main request), or, alternatively, in amended form on the basis of one of the sets of claims filed as first auxiliary request with letter dated 23 July 2012 and as third auxiliary request during the oral proceedings. In view of the appeal of appellant 02 it no longer defended the patent in the version maintained by the decision under appeal (essentially its original second auxiliary request) - but instead of requesting the dismissal of appellant 02's appeal - it only defended it on the basis of the further amended version according to the above-mentioned third auxiliary request.

It further requested that the intervention be rejected as inadmissible.

Appellant 02 and the intervener requested that the decision under appeal be set aside and the patent be revoked. Appellant 02 further requested that the appeal of appellant 01 be dismissed.

The intervener further requested that its intervention be deemed as admissible.

II. **Claim 1** according to the **main request** (claim 1 as granted) reads as follows:

"A closure assembly adapted to be applied to a mouth and neck portion (19) of a container for liquid, the closure assembly comprising:

a sleeve (20) adapted to lie substantially concentrically with respect to the mouth and provided with means for fixing the sleeve on the container; said means comprising a plurality of ribs (100) formed on the inner surface (70b) of said sleeve (20) which, in use coact with ridges on the outer surface of the neck portion (15), a cap (280) which is removable; an outer cap (330) associated with the cap (280) by means of a tight interference fit and comprising a closed wall (335) and an outer sleeve (310) said outer cap (330) being attached to said outer sleeve (310) and wherein, in use, the outer sleeve remains on the sleeve when the cap is removed, is a substantially tight fit with the sleeve but rotatable with respect thereto".

Claim 1 according to the **first auxiliary request** reads as follows, with features in addition to claim 1 according to the main request indicated in bold by the Board:

"A closure assembly adapted to be applied to a mouth and neck portion (19) of a container for liquid, the closure assembly comprising:

a sleeve (20) adapted to lie substantially concentrically with respect to the mouth and provided with means for fixing the sleeve on the container; said means comprising a plurality of ribs (100) formed on the inner surface (70b) of said sleeve (20) which, in use coact with ridges on the outer surface of the neck portion (15), a cap (280) which is removable; an outer cap (330) associated with the cap (280) by means of a tight interference fit and comprising a closed wall (335) and an outer sleeve (310) said outer cap (330) being attached to said outer sleeve (310) **by means of a frangible portion**, and wherein, in use, the outer sleeve remains on the sleeve when the cap is removed, is a substantially tight fit with the sleeve but rotatable with respect thereto, **wherein**

- **at least one projection means is provided on an inner wall of the sleeve to resiliently engage a lip portion of the container,**
- **the sleeve contains one or more circumferential apertures (40a, 40b, 40c) around the sleeve which are defined between axially extending portions (45) of the sleeve,**
- **the at least one projection means is provided adjacent to an edge of one of the apertures".**

Claim 1 according to the **third auxiliary request** reads as follows, with features in addition to claim 1 according to the main request indicated in bold by the Board:

"A closure assembly adapted to be applied to a mouth and neck portion (19) of a container for liquid, the closure assembly comprising:

a sleeve (20) adapted to lie substantially concentrically with respect to the mouth and provided with means for fixing the sleeve on the container; said means comprising a plurality of ribs (100) formed on the inner surface (70b) of said sleeve (20) which, in use coact with ridges on the outer surface of the neck portion (15), a cap (280) which is removable; an outer cap (330) associated with the cap (280) by means of a tight interference fit and comprising a closed wall (335) and an outer sleeve (310) said outer cap (330) being attached to said outer sleeve (310) and wherein, in use, the outer sleeve remains on the sleeve when the cap is removed, is a substantially tight fit with the sleeve but rotatable with respect thereto, **said closure further including valve means, wherein the valve means comprises a valve seat body (30) which is at least partially receivable within at least part of the mouth and neck portion of the container and wherein the valve seat body is at least partially surrounded by the sleeve, and the valve means further comprises a movable valve member (130),** wherein the outer sleeve fits with the sleeve by means of an interference fit between an outer surface of the sleeve and an inner surface of the outer sleeve, wherein the cap has thereon a threaded portion (290) which engages with a corresponding threaded portion (300) on the sleeve, wherein prior to initial opening the outer sleeve and outer cap are attached by a frangible portion (320), such that relative rotation of the outer sleeve and outer cap upon initial opening causes the portion to shear, wherein the outer sleeve and outer cap are made from metal foil,

wherein three projection means are provided on an inner wall of the sleeve said three projection means projecting inwardly of the sleeve and being movable radially of the sleeve to resiliently stiffly engage an outer lip portion of the container, wherein the sleeve contains three circumferential apertures (40a, 40b, 40c) spaced substantially equally around the sleeve, said circumferential apertures being defined between axially extending portions (45) of the sleeve, wherein each projection means is positioned on a lower circumferential edge (50a, 50b, 50c) respectively of the respective apertures".

III. The following document, considered in the decision under appeal, is referred to:

D6 EP-A-0 574 644

IV. Impugned decision

According to the impugned decision the subject-matter of claim 1 of the main request (claim 1 as granted) lacks novelty with respect to the disclosure of D6. The subject-matter of claim 1 according to the then third auxiliary request, which defines part of the subject-matter of claim 1 of the present third auxiliary request, was considered as involving inventive step starting from the closure assembly of D6 as closest prior art.

V. The essential submissions of appellant 01 can be summarized as follows:

- (a) The intervention of the assumed infringer should not be admitted, since the requirements of Article 105(1)(b) EPC are not fulfilled.

- (b) Claim 1 defines a closure assembly adapted to be applied to a mouth and neck portion of a container. The last features of this claim in the main request relate to a use where the closure assembly is (already) applied to a mouth and neck portion. This feature is as such present in the claims 1 of all requests. According to the use as defined by these claims the outer sleeve remains on the sleeve in a substantially tight fit with the sleeve but rotatable with respect thereto. This all happens when the cap, including an outer cap associated with the cap by means of a tight interference fit, is removed. In the following the "sleeve" will be designated "inner sleeve", for the sake of clarity.

- (c) These features define a use in which a cap and its associated outer cap are removed to open the container, at the same time leaving the outer sleeve on the sleeve in a substantially tight fit with the inner sleeve but rotatable with respect thereto. Prior to its removal the outer cap was attached to the outer sleeve.

- (d) The effects of the thus defined arrangement of the outer sleeve and the inner sleeve do not relate to a normal use but to a different, namely fraudulent, use of a container with the claimed closure assembly, namely when the latter is to be removed in its entirety. This is done so that it can e.g.

be fitted on a container filled with a liquid different to the one it is intended to be filled with, without the misuse of the closure assembly being noticeable. This means concerning the relationship between the outer sleeve and the inner sleeve as defined by the expression "substantially tight fit but rotatable thereto" that the inner sleeve in the original state of the closure assembly applied to a container is only accessible via the outer sleeve, but is rotatable. Thus forces applied to the outer sleeve in order to remove the entire closure assembly would require a deformation of the outer sleeve such that these forces can be transmitted to act on the inner sleeve. In this state the outer sleeve is no longer rotatable with respect to the inner sleeve, due to the deformation of the outer sleeve to bring portions of the outer sleeve and the inner sleeve into a contact with each other for this purpose. This deformation will lead to a visible mark remaining on the outer sleeve or to a breakage with respect to the closure assembly and / or the container. In either case there is a noticeable indication with respect to a fraudulent misuse of the closure assembly.

- (e) Seen in this context the definitions of the cooperation of the outer sleeve and the inner sleeve as "in a substantially tight fit but rotatable" are not in contradiction to each other and, in combination with the fraudulent type of use, clearly define the relationship between outer sleeve and inner sleeve within the closure assembly as defined by all claims 1.

- (f) Claim 1 according to the main request is in any case distinguished from the closure assembly of D6 by the feature that the inner sleeve is provided with means for fixing it on the container and by the feature that the outer cap is attached to the outer sleeve.

- (g) The amendments of claim 1 according to the first auxiliary request are based on the disclosure of the application as originally filed. The feature that the outer cap is attached to the outer sleeve by means of a frangible portion is e.g. disclosed by claim 24 as well as in the description originally filed. Since by means of this feature the structure is defined by which outer sleeve and outer cap are attached to each other there is no need to further define a possible effect resulting from this attachment. Introduction of the feature that at least one projection means is provided on an inner wall of the inner sleeve to resiliently engage a lip portion of the container is the result of the combination of claims 1 and 9 as granted. It is apparent that this projection also defines "means for fixing" but these are different from the plurality of ribs formed on the inner surface of the inner sleeve, so that it forms another part of the claimed "means for fixing the sleeve".

- (h) Claim 1 according to the third auxiliary request should be admitted into the proceedings since its combination of features, based essentially on a combination of claims as granted, cannot be

considered as coming as a surprise for the other party, nor as not fulfilling the requirements of Articles 84 and 123(2) and (3) EPC.

VI. The essential submissions of appellant 02 can be summarized as follows:

- (a) Claim 1 defines a closure assembly by means of structural features and a feature relating to a use of this closure assembly. According to the features relating to this use, the relationship between the outer sleeve and the inner sleeve is defined in a contradictory manner, in that on the one hand the outer sleeve is in a substantially tight fit with the inner sleeve but on the other hand is rotatable with respect thereto.
- (b) Since no effect can be attributed to the features defined in connection with this use they cannot be taken into account in the examination of novelty and inventive step. They also do not play any role concerning sufficiency of disclosure.
- (c) Claim 1 according to the main request lacks novelty over D6 taking due account of the broad definition of the structural features of the closure assembly of claim 1, namely that the sleeve is provided with means for fixing it on the container and the outer cap is attached to the outer sleeve.
- (d) The amendments of claim 1 according to the first auxiliary request lack a basis in the application as originally filed. The feature that the outer

cap is attached to the outer sleeve by means of a frangible portion is consistently disclosed in the application as originally filed only in combination with effects occurring during initial opening of the closure assembly, which however depend on the structural and functional limitations as defined by claim 6 as granted. The latter are not included in amended claim 1. This amendment therefore does not meet the requirement of Article 123(2) EPC.

(e) Claim 1 according to the first auxiliary request is furthermore unclear as a result of this amendment. The reason is that the features of claim 1 as granted which are directed at fixing the inner sleeve on the container (the plurality of ribs inside the inner sleeve) are now rendered unclear by the introduction of the features of claim 9 as granted, which relate to projection means also inside the inner sleeve.

(f) Claim 1 according to the third auxiliary request should not be admitted into the proceedings considering its late filing and since at first sight it does not meet the requirements of Article 123(2) EPC.

VII. The essential submissions of the intervener, supported by appellant 02, concerning the admissibility of its intervention can be summarized as follows:

Its intervention as an assumed infringer should be admitted, since the requirements of Article 105(1)(b) EPC are fulfilled.

By letter dated 31 July 2012 it had filed a law suit at the District Court of Düsseldorf ("Landgericht Düsseldorf") against appellant 01, seeking a declaration of non-infringement *i.a.* of the patent in suit.

It admitted that appellant 01 had not issued a "formal" written warning but, referring to the decision of the Enlarged Board of Appeal in case G 1/94 (OJ EPO 1994, 787) and of the German Federal Court of Justice ("Bundesgerichtshof", BGH) in case XII ZR 20/94, it considered that a prior warning was not obligatory for the admissibility of an intervention under Article 105 EPC because the behaviour of appellant 01 justified its legal interest both in the national and in the appeal proceedings. In this respect, it referred to the following circumstances:

- Its legally independent Turkish affiliate (opponent and appellant 02 in the present appeal proceedings) had been sued by appellant 01 in Turkey for an alleged infringement *i.a.* of the Turkish part of the patent in suit by its production and marketing of the "AV-3" closure assembly.
- The intervener itself intended to produce and/or sell the same AV-3-type of closure assembly in Germany.
- With regard to the litigation against its affiliate in Turkey it had requested appellant 01, by letters dated 26 June, 5 July and 19 July 2012 (annexes K2, K3, and K5 of the letter of intervention), to confirm that the latter would not commence proceedings against it for an alleged infringement of the German part of the same patent.

- Appellant 01 refused to issue the requested confirmation (annex K6 of the letter of intervention).
- There was no need for the intervener to await a formal warning letter from appellant 01 under German law prior to the institution of a law suit for a ruling that the intervener is not infringing the patent of appellant 01 (cf. BGH XII ZR 20/94). This exception to the general prerequisite was to be applied by the Board in the framework of Article 105(1)(b) EPC.

The pending service of the writ did not hinder the institution of legal action before the District Court of Düsseldorf because the German Code of Civil Procedure ("Zivilprozessordnung", ZPO) allowed a retroactive effect of the service of the writ back to the date of receipt of the corresponding application or declaration by the court provided that the service is made shortly afterwards. Since the service of the intervener's writ will be made in the near future the proceedings were to be deemed as instituted already by the filing of the writ. The pendency of the current appeal proceedings was equivalent to the deadline referred to in § 167 ZPO.

VIII. Appellant 01 essentially argued that the intervention did not fulfil the relevant legal requirements because it had never formally requested the intervener to cease an alleged infringement. With its letters the intervener merely confronted it with a hypothetical product insufficiently described. Thus, there was no need and no obligation for it to review and assess an abstract question of infringement raised by the intervener.

Article 105(1)(b) EPC explicitly required a request of the patent proprietor, any supposed exception to the general principle of such an obligatory prior warning letter permitted under German law was without relevance for the admissibility of the intervention under the EPC.

Apart from that, the mere filing of a negative declaratory action by the intervener against it before the District Court of Düsseldorf as such was not sufficient to institute proceedings according to the German Code of Civil Procedure. The obligatory translation into the Dutch language and the service of the intervener's writ were not proven.

- IX. In the annex to the summons to oral proceedings dated 7 May 2012 the Board indicated i.a. that according to its preliminary opinion the effect attributed to the features that in use the outer sleeve remains on the inner sleeve and is in a substantially tight fit with the inner sleeve but is also rotatable with respect thereto, namely that it is difficult to grip the assembly for an attempted removal, appears as not being proven (point 7.4.1).

Concerning the examination of novelty the Board gave its preliminary opinion that the above-mentioned feature of the use is to be considered as the only distinguishing feature over D6.

- X. In its communication of 23 August 2012 the Board informed the parties that the intervention did not appear to meet the requirements provided for in Article 105 EPC for two reasons.

First, there were no proceedings for infringement of the patent in suit instituted by appellant 01 against the intervener (Article 105(1)(a) EPC). Second, in respect of Article 105(1)(b) EPC, the appellant had not requested the intervener to cease alleged infringement before the intervener commenced the national proceedings against appellant 01 for a ruling that it is not infringing the patent.

XI. Oral proceedings before the Board were held 23 August 2012.

Reasons for the Decision

1. *Admissibility of the intervention of the assumed infringer*
- 1.1 With letters of 10 and 15 August 2012 Bericap GmbH&Co. KG filed an intervention referring to proceedings before the "Landgericht Düsseldorf" which it had initiated against appellant 01 for a ruling that it is not infringing the patent in suit (annex K 1 of the letter of 10 August 2012 and both annexes of its letter of 15 August 2012).
- 1.2 The intervener's submissions in respect of the patentability of the patent in suit and its claims need not be dealt with because the intervention has been found inadmissible by the Board for the following reasons.
- 1.3 The formal requirements for the filing of an intervention of the assumed infringer set out in

Rule 89 EPC, including the payment of the opposition fee, are fulfilled.

- 1.4 According to Article 105 EPC, any third party may, in accordance with the Implementing Regulations (Rule 89 EPC), intervene in opposition proceedings after the opposition period has expired, if the third party proves that
- (a) proceedings for infringement of the same patent have been instituted against him, or
 - (b) following a request of the proprietor of the patent to cease alleged infringement, the third party has instituted proceedings for a ruling that he is not infringing the patent.
- 1.5 As decided by the Enlarged Board of Appeal in case G 1/94 (*supra*), an assumed infringer of a European patent may also intervene in appeal proceedings and may base its intervention on any ground of opposition specified in Article 100 EPC.

However, this decision of the Enlarged Board of Appeal is silent in respect of the requirements of Article 105 EPC that need to be satisfied by the intervener.

- 1.6 Since appellant 01 has not instituted proceedings for infringement of the patent in suit against the intervener, the requirements set out in Article 105(1)(a) EPC are clearly not fulfilled.
- 1.7 For an intervention to be admissible according to Article 105(1)(b) EPC there need to be (national) proceedings instituted by the intervener against the

patent proprietor for a ruling that it is not infringing the patent.

- 1.7.1 As discussed with the parties at the oral proceedings, the intervener has not sufficiently submitted nor proven that the proceedings before the District Court of Düsseldorf have actually been formally instituted.

For the question of whether and when a law suit has been instituted, the national procedural rules apply (Benkard/Schäfers, EPC, 2nd edition 2012, Article 105, para. 15).

In this respect §§ 261(1) and 167 of the German Code of Civil Procedure are relevant:

§ 261(1) ZPO: Pending suit

By the complaint being brought, the dispute shall become pending.

§ 167 ZPO: Retroactive effect of the service

If service is made in order to comply with a deadline, or to have the period of limitations begin anew, or to have it extended pursuant to section 204 of the Civil Code (Bürgerliches Gesetzbuch, BGB), the receipt of the corresponding application or declaration by the court shall already have this effect provided service is made in the near future.

- 1.7.2 The intervener has only proven that it has filed a law suit according to § 261(1) ZPO for a ruling that it is not infringing the patent in suit and that the competent chamber of the District Court of Düsseldorf has ordered the service of the writ to appellant 01.

However, there is no evidence that the service has actually been executed.

- 1.7.3 The Board does not concur with the intervener on its interpretation of § 167 ZPO.

According to its clear wording, this provision is applicable to a case when a law suit is filed close to a deadline or a period of limitation. If the service of the writ is then executed after that deadline or period of limitation, it provides that - under certain conditions - the later service is given a retroactive effect (*ex tunc*) to the date of the filing of the law suit.

The intervener's argument that the pendency of the current appeal proceedings are to be deemed as a deadline according to § 167 ZPO is legally without substance. The intervener misconceives not just the wording of that provision but also its object.

First, § 167 ZPO serves a specific purpose in a particular stage of civil proceedings before German courts that cannot be "transferred" to the distinctive procedural situation before a Board of Appeal as an international court competent for a different jurisdiction.

Second, the condition for the retroactive effect, *i.e.* the actual service of the writ, has undisputedly not (yet) been fulfilled, as it is still pending. For reasons of pure logic, without the proven service of the writ there is no room for a retroactive effect of it.

1.8 Even if the proceedings before the District Court of Düsseldorf were to be considered as legally instituted proceedings, the further requirement provided for in Article 105(1)(b) EPC, *i.e.* that prior to the institution of these proceedings the patent proprietor has issued a request to the intervener to cease alleged patent infringement, is not met.

1.8.1 It is an undisputed fact that appellant 01 has not requested the intervener to cease alleged infringement before the intervener filed the above mentioned proceedings before the District Court of Düsseldorf.

1.8.2 The Board does not follow the intervener's argument that this requirement is to be determined according to the relevant national law, *i.e.* German law.

1.8.3 As discussed with the parties during the oral proceedings, this requirement is an essential legal feature in Article 105(1)(b) EPC itself with no explicit or implicit reference to the national laws of the EPC contracting states; Article 125 EPC is evidently of no relevance in the current context.

Since the laws in the contracting states vary to quite an extent from one to another, this requirement needs to be applied in a harmonized manner for all contracting states. Such a harmonization can only be secured by way of an autonomous interpretation of the provisions and legal terms of the EPC by the Board.

1.8.4 Even if there were circumstances recognized by the German civil law courts in which a prior written

warning ("Abmahnschreiben") could be dispensed with before commencing a law suit for a declaration of non-infringement of a patent, and even if the EPO and the Boards of Appeal might in their findings consider the practice of the national institution competent for a ruling that the intervener is not infringing the patent, it is for the EPO and the Boards of Appeal alone to decide whether or not a request referred to in Article 105(1)(b) EPC has actually been issued (cf. *Günzel* in *Singer/Stauder*, EPÜ, 5th edition 2010, Article 105, para. 3).

The cited decision of the German Federal Court of Justice (BGH XII ZR 20/94) speaks certainly not in favour of the intervener. It concerns the issue of the admissibility of a negative declaration for the defence of a claim for matrimonial maintenance issued for the past and therefore concerns quite a different area of law and a very particular procedural situation, both not comparable with the present case.

1.8.5 Apart from this, the following has to be taken into account.

An intervention of a third party is treated as an opposition and this party is thus granted the status of an opponent, as an exception to the 9-month time limit for filing a notice of opposition Article 99(1) EPC). It follows from this that Article 105 EPC is to be interpreted in a restrictive manner.

1.8.6 Consequently, it is an essential requirement for the admissibility of this intervention that appellant 01 as patent proprietor has requested the intervener to cease

alleged infringement before the intervener filed the above mentioned proceedings against appellant 01.

A mere warning letter from the patent proprietor, the threat of an infringement action or a warning addressed to a third party associated with the assumed infringer, or a letter addressed to the assumed infringer that the patent proprietor reserves its right to commence legal proceedings in the future cannot be qualified as the request required by Article 105(1)(b) EPC. It is rather for the intervener to establish that a request to cease an alleged infringement was addressed to him (see: T 392/97, Reasons 2.2 *et seq.*; T 887/04, Reasons 2.1 *et seq.*; Benkard/*Schäfers*, EPÜ, 2nd edition 2012, Article 105, para. 15; *Günzel* in Singer/Stauder, EPÜ, 5th edition 2010, Article 105, para. 3).

- 1.8.7 The intervener's letters to appellant 01 and the latter's replies (Annexes K2, K3, K5 and K6 of the intervener letter of intervention dated 10 August 2012) cannot be qualified as a surrogate alternative for such a request.

With its letters of 26 June 2012 (Annex K2) and of 5 July 2012 (Annex K3), the intervener had explicitly requested appellant 01 to confirm that it would not infringe the patent in suit "with regard to the import, sale, offer for sale and/or other forms of use of the Bericap AV3-closure in Germany" and that appellant 01 would refrain from initiating any legal actions based *i.a.* on the patent in suit against the intervener. This request can be understood as an enquiry that appellant 01 should otherwise state that it requested the intervener to cease such an infringement.

However, the decisive point in this context is that these letters were sent by the intervener to appellant 01 and not *vice versa* and, hence, cannot qualify as a request of a patent proprietor to an assumed infringer within the meaning of Article 105(1)(b) EPC. In its letter of 26 July 2012 (Annex K6), appellant 01 explicitly refused to issue any statement at all.

Even if one could presume an economic and also a legal interest of the intervener in having a clear legal situation in respect of the patent in suit before preparing the introduction of its product on the German market, this interest *eo ipso* is neither sufficient to replace the prescribed request to cease infringement, nor can it force appellant 01 to either issue such a request or to clear the product release intended by the intervener.

- 1.8.8 The Board to the contrary follows the argument of appellant 01 that it was under no legal obligation to react in whatever way. With its letters the intervener merely confronted appellant 01 with a hypothetical product.

There are simply no proceedings between appellant 01 and the intervener.

The patent dispute in Turkey about the so-called Bericap AV3-closure assembly is between appellant 01 and appellant 02, the latter being legally independent from the intervener according to its own submission. The proceedings in Turkey also do not have any effect on patent-related issues in Germany.

The intervener's indication that it intended to place *i.a.* that assembly on the German market, also cannot qualify as such.

As a consequence, there was no need nor obligation for appellant 01 to express itself on an abstract question of infringement and/or to issue a request to cease such a hypothetical infringement. Accordingly, the fact that appellant 01 did not comply with the intervener's request cannot be judged as a substitute for the request to cease infringement as required in Article 105(1)(b) EPC.

1.9 Therefore the intervention is to be rejected as inadmissible.

1.10 As far as the intervener has paid not just the opposition fee in accordance with Rule 89(2), 2nd sentence EPC but also an appeal fee, the latter was paid without legal basis (G 3/04, OJ EPO 2006, 118, Reasons 11). Consequently, the appeal fee is to be reimbursed *ex officio*.

Main request

2. *Subject-matter of claim 1 - understanding of the claimed subject-matter*

2.1 Claim 1 is directed to a closure assembly adapted to be applied to a mouth and neck portion of a container for liquid.

The closure assembly comprises a (inner) sleeve, a cap, an outer cap and an outer sleeve.

The inner sleeve is adapted to lie substantially concentrically with respect to the mouth and it is provided with means for fixing it on the container. These means comprise a plurality of ribs formed on the inner surface of the inner sleeve which, in use, coact with ridges on the outer surface of the neck portion.

2.2 The following features concerning the relationship of outer cap and cap, outer cap and outer sleeve and outer sleeve and inner sleeve are of particular importance for the understanding of the subject-matter of claim 1:

- (a) an outer cap is associated with the cap by means of a tight interference fit
- (b) said outer cap is attached to said outer sleeve
- (c) in the closure assembly, in use, the outer sleeve remains on the inner sleeve when the cap is removed,
- (d) is a substantially tight fit with the inner sleeve
- (e) but rotatable with respect thereto.

2.2.1 It is common ground that features (a), (b) and (d) and (e) are structural features which contribute to the definition of the closure assembly. It furthermore remained undisputed that feature (c) relates to a use of the closure assembly and that, concerning the definition of the structure of this closure assembly,

this use need only be taken into account to the extent that it contributes to the definition of that structure.

- 2.2.2 Concerning the **use as defined by feature (c)** it remained undisputed that this, as asserted by appellant 01, concerns a use with respect to a closure assembly applied to a mouth and neck portion of a container filled with liquid, i.e. a condition the closure assembly is adapted for according to the first feature of claim 1.

It remained further undisputed that this use is defined by reference to a particular state of the closure assembly, namely one in which the cap and with it the outer cap is removed in an opening operation (cf. paragraph [0077], due to the tight interference fit as defined by feature (a)).

This use is thus the regular use as referred to during the oral proceedings, namely when the cap is removed from the container in an opening operation.

- 2.2.3 As indicated above, feature (a) relates to the use according to feature (c) in that it allows removal of the outer cap together with the cap.

Feature (b) likewise relates to the use according to feature (c) in so far as the attachment of the outer cap to the outer sleeve comes to an end during the use according to feature (c), because the outer sleeve remains on the inner sleeve when the cap is removed.

- 2.2.4 The meaning of features (d) and (e) in the context with the remaining features of claim 1, in particular the

use according to feature (c), has been considered as essential for the **understanding** of the structure of the closure assembly of claim 1.

It is common ground that features (d) and (e) define, in combination with feature (c) the relationship between the outer sleeve and the inner sleeve. Feature (d) defines a geometric relationship, namely that the outer sleeve is in a substantially tight fit with the sleeve, whereas feature (e) defines a functional relationship closely linked to this geometric relationship by defining that the outer sleeve is also rotatable with respect to the inner sleeve.

With respect to the objection of appellant 02 that the different relationships as defined by features (d) and (e) contradict each other, appellant 01 finds it necessary to consider that, as can be derived from the description, these features relate to a use different from the one according to feature (c).

In the following this is referred to as the "second use".

The second use is not one in which only a part (cap and outer cap) of the closure assembly is to be removed, but one in which the entire closure assembly is to be removed from the container to allow its fraudulent re-use, possibly on a container with a less valuable content. According to appellant 01 it is the relationship between the outer sleeve and the inner sleeve as defined in features (d) and (e) which according to the invention enables such a second use to

be prevented, see the description, e.g. paragraphs [0004], [0007] and [0082].

- 2.2.5 The Board in this respect is of the opinion as stated during the oral proceedings that since claim 1 does not include or imply any reference to the second use such a use cannot be considered as contributing to the understanding of features (d) and (e).

Even if the second use would be taken into consideration this would, as argued by appellant 02, not resolve the contradiction between features (d) and (e), since even then it would remain open what is meant by the definition of the geometric relationship according to feature (d) in the context of the second use.

Concerning the understanding of these features, the description does not help either. According to paragraph [0070] the outer sleeve surrounds the inner sleeve in a tight interference fit, not a substantially tight fit. The geometric relationship between the outer sleeve and inner sleeve is thus described by the same terms used in connection with the definition of the geometric relationship between the outer cap and the cap (cf. feature (a), paragraph [0071]) for which an effect is referred to, namely that the outer cap is removed with the cap (cf. paragraph [0077]).

Although appellant 01 argued that the rotatability feature (e) should be viewed together with feature (d) as referred to in the description (the tight interference fit mentioned in paragraph [0070]), but that the geometric relationship defined by feature (d)

needs to be seen to differ from the one according to feature (a) (the tight interference fit between the outer cap and the cap), it could, having been questioned by the Board, cite no convincing support derivable from the description for this argument.

- 2.2.6 Under these circumstances the Board, taking into account that features (d) and (e) apparently do not relate to the normal use according to feature (c), even though according to their wording they do, as well as considering that they lead to contradictory relationships between the outer sleeve and the inner sleeve as indicated above, concludes, as indicated during the oral proceedings, that the features (d) and (e) cannot contribute to the understanding of the subject-matter of claim 1, nor can they be associated with a technical effect or effects and thus cannot be considered in the examination of novelty, inventive step and sufficiency of disclosure (Articles 100(a) and (b) EPC).

The issue of sufficiency of disclosure was originally raised by appellant 02 in that there was not enough information in the patent as to how a "tight interference" fit and/or a "substantially tight" fit, or both, in combination with the rotatability could be obtained. This issue needs no further consideration, as accepted by appellant 02 after the above result of the discussion with respect to the meaning of these features was announced during the oral proceedings.

- 2.2.7 The above conclusion differs from the one according to the impugned decision, according to which on the one hand features (d) and (e) have, in the context of the

examination of sufficiency of disclosure, not been considered as leading to contradictory properties (reasons, no. 2.2.1.2). On the other hand, with respect to the examination of novelty these features have been considered as disclosed for the closure assembly of D6, with the indication that with respect to the outer sleeve no anti-rotation means are provided between the outer sleeve and the inner sleeve, but that in case an appropriate torque is applied on the outer sleeve it can be rotated with respect to the inner sleeve (reasons, no. 2.2.2.3). The underlying assessment of the meaning of features (d) and (e), although it is different from the present one of the Board, at least indicates that the meaning of these features has been seen as non specific and very broad.

3. *Novelty*

- 3.1 It is undisputed that the closure assembly according to D6 is, corresponding to the one according to claim 1, adapted to be applied to a mouth and neck portion of a container for liquid.

It is further undisputed that, corresponding to the closure assembly according to claim 1, the one known from D6 comprises a sleeve 6, 10 adapted to lie substantially concentrically with respect to the mouth and provided with means ... comprising a plurality of ribs formed on the inner surface of said sleeve which, in use coact with ridges on the outer surface of the neck portion (cf. column 2, lines 45 - 49; figures 1 - 3: spline formations 27, 28), a cap 16 which is removable; an outer cap 29 associated with the cap by means of a tight interference fit and comprising a

closed wall (column 2, lines 13 - 17, 50 - 52; figures 1 - 3) and an outer sleeve 20 (column 2, lines 18 - 21; figures 1 - 3).

The features (c) - (e) according to which "in use, the outer sleeve remains on the sleeve when the cap is removed, is a substantially tight fit with the sleeve but rotatable with respect thereto" are, as indicated by the Board during the oral proceedings and as discussed above (cf. point 2.2.5), not to be considered.

- 3.2 According to appellant 01 the closure assembly of claim 1 is distinguished from the one of D6 two features:

the inner sleeve is provided with means for fixing the sleeve on the container, and

said outer cap is attached to said outer sleeve (feature (b)).

- 3.3 According to the impugned decision D6 also discloses the above mentioned two features.

- 3.3.1 For the first mentioned feature it concluded that the inner sleeve according to D6 is provided with means for fixing the sleeve on the container in the form of a splined connection between ribs 27 on the inside of the inner sleeve and cooperating ridges 28 on the outer surface of the neck portion (cf. column 2, lines 45 - 49). These means have been considered as corresponding to the "means for fixing the sleeve" of claim 1, which also comprise a plurality of ribs formed on the inner

surface of the inner sleeve which, in use coact with ridges on the outer surface of the neck portion.

Appellant 01 has objected to this conclusion arguing essentially that claim 1 defines "means for fixing the sleeve on the container; said means **comprising** a plurality of ribs formed on the inner surface on said sleeve ..." and that the wording of this claim, in particular since it contains the expression "comprising" requires that further means for fixing are provided on the sleeve.

The Board considers, however, the conclusion of the impugned decision to be correct taking into account that a use of the term "comprising", as long as no other features for fixing the inner sleeve are mentioned, does not exclude that the ribs referred to in claim 1 are the only means for fixing the inner sleeve on the container. Thus this feature does not distinguish the closure assembly according to claim 1 over the one of D6.

- 3.3.2 Appellant 01 further objected to the impugned decision where it considered the meaning of the term "attached" in feature (b) to be a very broad one (reasons, no. 2.2.2.3).

According to D6 the outer cap and outer sleeve only relate to each other in that these elements are only **in contact** with each other. This is different from the attachment according to feature (b). In its opinion one cannot speak of two points being **attached** to each other, if this is done via intermediate means, such as in D6 the outer cap 29 is connected to the cap 30, which in

turn is tightly fitted over the cap 16, which is connected to ring 17 via rupture weakening line 18, which ring 17 is connected to outer sleeve 20 via folded upper edge 21.

The Board concludes, contrary to the view expressed by appellant 01, that the relationship between outer cap 29 and outer sleeve 20 shown in figures 1 - 3 of D6 is such that these two elements are not only in contact with each other, but that this contact is maintained prior to the known closure assembly being fixed on the neck portion of a container by rolling the lower edge 22 of the band 20 against shoulder 5 of the neck portion (column 3, lines 17 - 22; figures 2, 3). This is achieved by connecting these two elements via the tamperproof ring 17 being part of cap 16 (column 2, lines 13 - 21; lines 50 - 52; figures 1, 2) as discussed above. This is the same as the outer cap being attached to the outer sleeve, as in feature b). When asked during the oral proceedings appellant 01 was unable to explain the exact difference between the expressions "being attached" and "being held in contact with each other by intermediate means" in the given context.

- 3.4 Consequently claim 1 lacks novelty over D6
(Article 100(a) EPC)

Claim 1 according to the first auxiliary request

4. Claim 1 of the first auxiliary request differs from claim 1 according to the main request in that the features have been added according to which

(i) said outer cap is attached to said outer sleeve by means of a frangible portion,

(ii) at least one projection means is provided on an inner wall of the sleeve to resiliently engage a lip portion of the container,

(iii) the sleeve contains one or more circumferential apertures around the sleeve which are defined between axially extending portions of the sleeve,

(iv) the at least one projection means is provided adjacent to an edge of one of the apertures.

4.1 Feature (i) is one of the features comprised in claim 6 as granted which reads "wherein prior to initial opening the outer sleeve and outer cap are attached to a frangible portion, such that relative rotation of the outer sleeve and outer cap upon initial opening causes the portion to shear".

4.1.1 Appellant 01 referred as basis for feature (i) in the application as originally filed to page 8, lines 18 and 19 of the description according to which the outer cap is associated with the outer sleeve by means of a frangible portion which means that when the outer cap is twisted away from the outer sleeve in a bottle opening operation, the frangible portion fails or breaks to separate the outer cap from the outer sleeve. It further indicated that this breaking of the frangible portion is a sign for subsequent users that the bottle has been opened; thus the combination of sleeve (more precisely: outer sleeve) and outer cap is a tamper evident device (page 17, lines 3 - 16).

4.1.2 According to appellant 02 this portion of the description has to be considered in its entirety such that the introduction of feature (i) into claim 1 without the effect or functionality as disclosed in connection with this attachment, be it in the rest of the description (page 8, lines 16 to 20) or in claim 6, infringes the requirement of Article 123(2) EPC.

4.1.3 The Board considers the opinion of appellant 02 to be correct in view of the disclosure of the application as originally filed. Therein the attachment according to feature (i) has consistently been referred to only in connection with the effect given in claim 6 as granted, or as discussed on page 18, lines 16 to 20, namely that relative motion of the outer sleeve and outer cap is required upon initial opening so as to cause the frangible portion between the two to fail or break.

This holds true also considering that, as pointed out by appellant 01, in the application as originally filed (cf. page 8, lines 18, 19; claim 24) the attachment of the outer cap and the outer sleeve is merely mentioned to be by means of the frangible portion, without any further reference of the effect of this frangible portion during the opening of the bottle. The reason is that no other effect than the one referred to above is originally disclosed with respect to the attachment via the frangible portion and that the use according to feature (c) in this respect is clear: it requires separation of the outer cap from the outer sleeve.

Consequently the introduction of feature (i) into claim 1 without also adding the feature relating to the

effect obtained by it does not meet the requirement of Article 123(2) EPC.

In the impugned decision it could be left open whether the addition of feature (i) infringes Article 123(2) EPC since for claim 1 then under examination other features were considered to violate Article 123(2) EPC (reasons, no. 2.3.3.1, 2.3.3.3).

- 4.2 As concerns feature (ii) the Board considers also the opinion of appellant 02 to be correct, that the addition of these features (of claim 9 as granted) into claim 1 leads to a lack of clarity for two reasons.

One reason follows from the fact that it remains undefined whether or not the at least one projection means forms part of the means for fixing the inner sleeve on the container, as referred to in claim 1 as granted.

The other reason follows from the fact that the definition of the at least one projection means according to feature (ii) is such that this means is not clearly distinguished from the means already defined in claim 1 as granted which comprise a plurality of ribs formed on the inner surface of the inner sleeve which, in use coact with ridges on the outer surface of the neck portion. The mere difference in wording (projection means versus ribs) does not suffice to distinguish the elements concerned, considering that for both elements it is defined that they are provided on the inner surface of the inner sleeve and that they coact with the neck portion or lip portion of the container.

- 4.3 Claim 1 according to the first auxiliary request thus violates the requirements of Articles 84 and 123(2) EPC and thus cannot be further considered.
- 4.4 For completeness' sake the Board indicates with respect to the above assessment of feature (ii) that the competence of the Board to examine whether amendments resulting from the combination of claims (concerning feature (ii) this is the combination of claims 1 and 9 as granted) fulfil the requirement of clarity, which examination has not been objected to during the oral proceedings, derives from the fact that the lack of clarity results from the combination of the features of both granted claims in their relationship to each other as indicated above (point 4.2).

Claim 1 according to the third auxiliary request

5. Claim 1 according to the third auxiliary request comprises in addition to the features of claim 1 as granted i.a. the following features
- (v) wherein the outer sleeve fits with the inner sleeve by means of an interference fit between an outer surface of the inner sleeve and an inner surface of the outer sleeve,
- (vi) three projection means are provided on an inner wall of the inner sleeve, said three projection means projecting inwardly of the inner sleeve and being movable radially of the inner sleeve,

(vii) to resiliently stiffly engage an outer lip portion of the container.

5.1 Feature (v) concerns the relationship between outer sleeve and inner sleeve already defined by features (c) to (e) as indicated above (cf. points 2.2.4 to 2.2.6 above). Contrary to the arguments of appellant 01 this feature does not contribute to resolving the contradiction between these features. Now that the relationship between the outer sleeve and the inner sleeve is additionally defined as an interference fit, it is even less likely to allow rotation of the outer sleeve with respect to the inner sleeve (feature e)) and it appears to be contradictory to the "substantially tight fit" of feature (d).

5.2 Portions of features (vi) and (vii) are taken from the description. Thus the amendments of claim 1 based on the addition of these features have to be examined with respect to the requirements of e.g. Articles 84 and 123(2) EPC.

According to feature (vi) three projection means are provided on an inner wall of the inner sleeve, said three projection means projecting inwardly of the inner sleeve and being movable radially of the inner sleeve.

According to feature (vii) this radial movement serves to resiliently stiffly engage an outer lip portion of the container.

As pointed out by the Board during the oral proceedings these features define a particular manner in which the three projection means engage an outer lip portion,

namely one resulting in a **resilient stiff engagement**. As likewise pointed out by the Board, according to the application as originally filed the material of the sleeve is, however, referred to as a **stiffly resilient plastics** material (page 18, line 26 - page 19, line 6). This material property, referred to by appellant 01 as original disclosure of feature (vii), cannot as a consequence be considered as disclosure for the resiliently stiffly engaging of the projection means with a lip portion of the container. The reason is that although the material properties of the projection means contribute to the manner in which these projection means engage an outer lip portion of the container, the material property disclosed in the application as originally filed is not the only decisive parameter in this respect. Features (vi) and (vii) thus define the nature of the engagement of the projection means with an outer lip portion for which there is no disclosure in this form in the application as originally filed.

5.3 From the above it has to be concluded that this claim 1 does not satisfy the requirement of Article 123(2) EPC. Given this situation there is no need to further examine whether or not claim 1 does not meet the requirements of the EPC for other, additional reasons, as argued by appellant 02.

5.4 The subject-matter of claim 1 is thus not *prima facie* allowable since at least one objection arises with respect to the amendments underlying this claim.

Considering also, as argued by appellant 02, the late stage in the proceedings at which this claim has been

filed, namely at the end of the oral proceedings, the Board decided not to admit the set of claims according to the third auxiliary request into the proceedings (Article 13(1) RPBA).

- 5.5 Since no set of amended claims is on file which meets the requirements of the EPC the patent has to be revoked (Article 101(3) EPC).

Order

For these reasons it is decided that:

1. The intervention is rejected as inadmissible.
2. The appeal of the appellant 01 is dismissed.
3. The decision under appeal is set aside.
4. The patent is revoked.
5. The appeal fee paid by the intervener is to be reimbursed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders