

Internal distribution code:

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

**Datasheet for the decision
of 22 October 2015**

Case Number: T 0113/12 - 3.2.04

Application Number: 04425296.3

Publication Number: 1472936

IPC: A24C5/39

Language of the proceedings: EN

Title of invention:

A cigarette maker

Patent Proprietor:

G.D S.p.A.

Opponent:

Hauni Maschinenbau AG

Headword:

Relevant legal provisions:

RPBA Art. 12(4)

EPC Art. 56

Keyword:

Late-filed document - admitted (yes) - justification for late filing (yes)

Remittal to the department of first instance - (no)

Adjournment of proceedings - (no)

Inventive step - (no)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0113/12 - 3.2.04

**D E C I S I O N
of Technical Board of Appeal 3.2.04
of 22 October 2015**

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

Representative: Seemann, Ralph
Patentanwälte
Seemann & Partner
Raboisen 6
20095 Hamburg (DE)

Respondent: G.D S.p.A.
(Patent Proprietor) Via Battindarno, 91
40133 Bologna (IT)

Representative: Bianciardi, Ezio
Bugnion S.p.A.
Via di Corticella, 87
40128 Bologna (IT)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
29 November 2011 concerning maintenance of the
European Patent No. 1472936 in amended form.**

Composition of the Board:

Chairman A. de Vries
Members: J. Wright
C. Heath

Summary of Facts and Submissions

- I. The appellant-opponent lodged an appeal, received 18 January 2012, against the interlocutory decision of the opposition division of 29 November 2011 on the amended form in which European patent no. 1472936 could be maintained and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was filed on 27 March 2012
- II. The opposition was filed against the patent as a whole and based inter alia on Article 100(a) EPC together with Articles 52(1) and 56 EPC for lack of inventive step.

The division held, inter alia, that the opposition ground of inventive step mentioned in Article 100(a) EPC did not prejudice maintenance of the patent as amended according to an auxiliary request, having regard to the following documents, amongst others:

D2 : DE 2357132 C3

D6 : EP 0202874 B1

D11: DE 1219837

The appellant filed the following document, amongst others, with their grounds of appeal:

D17: US 1183618.

- III. Oral proceedings before the Board were duly held on 22 October 2015.
- IV. The appellant 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 case be remitted to the first instance should, amongst others, document D17 in relation to Art. 100(a) EPC be admitted into the proceedings, further in the alternative that the case be postponed (adjourned) in such case.

V. The wording of claim 1 of the main request (as upheld by the opposition division) is as follows:

A cigarette maker comprising: a descent channel (16); a carding unit (13) by which shredded tobacco (9) is fed into the descent channel (16), also conveyor means (36) by which reclaimed tobacco (24) is fed into the selfsame channel (16); a toothed unit (25) by which the shredded tobacco (9) and the reclaimed tobacco (24) are taken up and are directed toward an ascent channel (29) through which the tobacco is carried as a flow of distinct particles; an aspirating belt (31) positioned at the outlet of the ascent channel (29), on which the flow of particles is formed into a stream (32) and advanced toward a trimming station (33), thence to the entry point (35) of a station at which the stream is formed into a continuous cigarette rod, characterized

in that the descent channel (16) is divided internally into a first portion (21) and a second portion (22) by a partition wall (23), the first and the second portion (21,22) being distinct one from the other and serving respectively to admit shredded tobacco (9) and reclaimed tobacco (24),

in that the toothed unit (25) comprises a first section (39) and a second section (40) by which the shredded tobacco (9) and the reclaimed tobacco (24) are taken up

from the respective outlet ends of the first and second portions (21, 22) of the descent channel; and in that the first and second sections (39,40) of the toothed take-up unit (25) are independent of one another.

VI. The appellant argued as follows:

Admissibility of document D17

D17 was filed at the earliest possibility in response to the respondent's new request filed in the oral proceedings before the opposition division. It should be admitted because it relates to the feature added to the claim in that request. Either remitting the case or adjourning the proceedings would cause unnecessary delay.

Inventive step

D2 discloses a cigarette maker. Its reference to D11, which discloses an ascent channel and aspirating belt as claimed, implies that the feature is if not already known, then obvious from D2. D2 discloses a separate, distinct portions in the descent channel for the recycled and shredded tobacco as is evident from their different widths and separate monitoring of column height in the two sections.

The problem to be solved by the partition wall feature, if not already known from D2, is to better separate tobacco in the descent channel. From the skilled person's general knowledge it is already obvious to use a partition wall to separate. Even if the front wall of the descent channel in D2 is vibrating, the skilled person knows how to make a partition wall between fixed and moving front and back walls. Therefore from D2 with

general knowledge, the skilled person would arrive at the subject matter of claim 1 in an obvious manner.

Furthermore, such a wall is known from D17 where it is used for the same purpose of separating different tobaccos in a common hopper. D6, figure 6 also teaches separating different kinds of tobacco in descent channels. A common channel can alternatively be used with baffles in between, which are partition walls. From D2, to solve the problem of tobacco separation, the skilled person would apply the partition wall feature from D17 or D6 leading to a descent channel as claimed. Therefore claim 1 lacks inventive step.

VII. The respondent argued as follows:

Admissibility of document D17

Document D17 is late filed and should not be admitted. The claim as amended in opposition merely clarifies a feature implicitly present in granted claim 1, so it is not fair to admit new prior art in appeal. Furthermore D17 is not more relevant than for example D6, already on file.

If D17 is admitted, not only the document itself but also an argument based on D2 and D17 is new to the proceedings, such an argument not having been made in the written proceedings. Presenting such an argument now in the oral proceedings is unfair to the respondent who then would have no time to respond. Furthermore, the issue should be discussed before two instances. Therefore the case should be remitted or at least the proceedings adjourned.

Inventive step

Document D2 is the closest prior art. D2 discloses a cigarette maker but it has no ascent channel and aspirating belt with trimming station. It has a descent channel but not one having portions that are distinct from one another, nor with a partition wall.

Whereas it is acknowledged that it would be obvious to incorporate an ascent channel and aspirating belt as a known alternative, the aspect of the descent channel with distinct portions separated by a partition wall is not obvious. In the descent channel of D2 tobacco can freely mix. Furthermore, in the descent channel of D2 freshly shredded tobacco shorts are separated and mixed with reclaimed tobacco, so there is no real separation of the tobaccos as claimed. Starting from D2, the problem to be solved by the partition wall feature is to better separate tobacco in the descent channel. In D2, because the front wall of the channel is vibrating and the rear wall is fixed it would not be possible to build a partition wall between the two. Although D2's descent channel must have side walls, these could be provided with a simple seal whereas an intermediate partition wall would require a complex seal where moving and stationary parts meet, so the modification would not be obvious from the skilled person's general knowledge, nor is any such seal disclosed in the prior art. D17 is not relevant to the separation problem because it contains no reclaimed tobacco, only different sizes of shredded tobaccos. D6 is also not relevant: in the embodiment of figure 6 there are separate descent channels, not one common channel. Although an alternative arrangement has baffles to make different descent paths in one channel, there is never a separation of reclaimed and shredded tobaccos, they are always mixed together. The arrangement of D6, which has non vibrating vertical hoppers, is also not

compatible with the arrangement of D2 with its vibrating wall. Therefore, starting from D2, neither common general knowledge, nor the teaching of D17 or D6 would lead the skilled person to the partition wall feature claimed in an obvious manner.

Reasons for the Decision

1. The appeal is admissible.
2. Background

The patent concerns a cigarette maker (specification, paragraph [0001]). It is known for cigarette makers to have a descent channel receiving shredded, in other words fresh, tobacco from a carding unit (specification, paragraph [0002]), followed by an ascent channel, aspirating belt and trimming station to form the continuous tobacco rod used to make cigarettes (specification, paragraphs [0003] to [0005]).

It is also known to return reclaimed tobacco to the descent channel. Reclaimed and shredded tobacco differ in particle size and moisture content (specification, paragraphs [0007] and [0008]). If they are not uniformly distributed in the continuous tobacco rod from which cigarettes are finally made, the cigarettes will vary in quality. The invention aims to overcome this drawback (specification, paragraphs [0009] and [0010]).

This is achieved, inter alia, by making reclaimed and shredded tobacco follow separate paths, including in the descent channel, in the manufacturing stages prior

to production of the tobacco rod (specification paragraphs [0037] to [0040]).

3. Admissibility of document D17, request for remittal or adjournment

- 3.1 Document D17 was filed with the grounds of appeal and thus outside the opposition period. It is therefore late filed and subject to the discretion afforded by Article 114(2) EPC and Article 12(4) RPBA. In exercising their discretion the Boards consider, among other factors, whether or not filing is justified by developments in the procedure, and relevance cf. Case Law of the Boards of Appeal, 7th edition, 2013 (CLBA), IV.C.1.4.5 b) and the decisions cited therein.

In the present case D17 is said by the appellant to be cited in response to a claim amendment that was made at the oral proceedings before the opposition division. The amendment is based on subject matter from the description.

Given that prior to those oral proceedings the appellant (opponent) was not aware of the present request, they had no opportunity to provide evidence addressing the particular amendment at that stage. Now in appeal proceedings, the earliest that the appellant could possibly have been expected to respond to this procedural development was with the grounds of appeal. Indeed they have done just that by filing, inter alia, document D17.

Whether or not it was fair of the opposition division to have admitted such a new request incorporating into claim 1 material from the description during the oral proceedings, the Board does not consider it equitable

not to allow the appellant to respond to such an unforeseeable new situation with a new document. Such a course of action would effectively tie the hands of the appellant in appeal to only base their arguments on previously cited documents, having first given the respondent a free hand to amend the claim based on the description at the last moment in opposition proceedings.

Nor was the amendment a mere clarification rendering explicit a feature that was previously implicit. It introduces a partition wall into the claim for the first time. That portions of a descent channel are distinct from one another, as they were claimed in granted claim 1, does not necessarily mean that they are separated by a partition wall. Furthermore, the appellant uses D17 to address obviousness of exactly the partition wall feature (grounds of appeal, paragraph bridging pages 27 and 28). Indeed a cursory inspection of D17 reveals it to disclose a tobacco hopper with a partition 13 and partition-extension 23. Therefore, whether or not D6 also discloses a partition wall, D17 at least prima facie appears to be relevant to the case in hand (D17, page 1, lines 71-91).

3.2 For these reasons, the Board exercised its discretion under Rule 12(4) RPBA to admit document D17 into the proceedings.

3.3 Furthermore, the Board sees no justification for remitting the case to the first instance. In the Board's view the arguments based on D17 do not constitute a "fresh case" which might justify a remittal. D17 does not fundamentally change the appellant's line of reasoning starting from D2, in that it merely provides further proof of the allegation that

partition walls for separating tobacco are well known. The appellant states as much in the paragraph bridging pages 27 and 28 of the statement of the grounds of appeal, where D17 is first introduced. Even if not expressly mentioned in combination with D2, its relevance in that context and with regard to feature of the partition wall will be apparent.

Furthermore, remitting the case to the first instance would not be compatible with the need for overall procedural economy. In this regard the Board notes that the opposition division has already considered which features of claim 1 according to the respondent's sole request are known from D2, an important consideration for inventive step (decision grounds inter alia point 9.3). Nor does it appear necessary to have the opposition division examine whether D17 discloses a partition wall since it is common ground that it does (respondent's reply to appeal, 2 August 2012, page 5, section titled "Document D17", second paragraph). In the light of the limited investigations required, and in the interest of overall procedural economy, the Board decided not to remit the case, as requested by the respondent but to decide the case, including consideration of D2 with D17, according to Article 111(1) EPC.

- 3.3.1 Lastly, the respondent has been aware of D17 and its relevance to the partition wall since the appellant's statement of the grounds of appeal, i.e. some three years, and indeed has discussed the document in their submissions. The Board therefore sees no compelling reason to further delay the present proceedings, other than the brief interruption allowed the respondent, at his request, in the oral proceedings.

Therefore the Board decided not to postpone or adjourn the oral proceedings.

4. Inventive step

4.1 As explained above, D2 can be considered to be the closest prior art.

D2 (see figures 1 and 2 and column 3, line 7, to column 6, line 19) discloses a cigarette maker in which shredded tobacco 4 is fed via a carding unit 20 into a descent channel 25. Excess tobacco (in German: "überschüssiger Tabak") is fed from a chute 44 via conveyor wheel 48 down a sloping vibrating plate 50 and then enters the left side of the same descent channel 25 (see figure 2). In this document excess tobacco means reclaimed tobacco. It is collected from the tobacco stream at a trimming station (column 1, lines 49-52 and column 2, lines 15-19).

4.1.1 Furthermore, in the Board's opinion, the channel 25 has first and second portions that are distinct from one another. The first portion admits shredded tobacco via sloping plate 26A, whilst the second portion admits reclaimed tobacco via sloping plate 50. Thus the portions are distinguished by their different entrances. Furthermore the second portion of the channel 25 can have a narrower width (column 4, lines 39-42). Thus, far from merely being distinguished by their contents, the first and second portions are also distinct from each other in their physical arrangement and their dimensions. This also follows from the fact that the level of the tobacco columns in the two sections is monitored and controlled separately, see column 5, lines 5 to 29. Thus these two sections of the

descent channel 25 will be perceived by the skilled person to be distinct and separate.

- 4.1.2 Two toothed rollers ("Stachelwalze") 30 and 30A constitute first section and second section respectively of a toothed take-up unit at the end of the channel 25 (figure 2, column 4, lines 3-19). The first section 30, with its width W2 and second section 30A (shown in figure 2 across the remaining part of the total overall width W1) take up shredded and reclaimed tobacco respectively from respective outlet ends of the first and second portions of the descent channel.

In this context the Board sees the descent channel 25 as having only one exit, namely at the lower end of the plate 26, best seen in figure 1. Elsewhere the channel is bounded by front plate 26, back-plate 28 and side walls (figure 2, shown hatched at left and right sides of the portion between carder 20 and conveyor roller 48 at the upper end and take up roll 30 at the lower end). Thus, tobacco that enters the descent channel, the shredded tobacco on the right, under carding roller 20 and the reclaimed tobacco on the left under plate 50, leave it at the bottom and are taken up by respective sections of the roller 30, 30A.

Furthermore, shredded tobacco "shorts" may be added, via a slit 62, to the reclaimed tobacco that has left the descent channel (figure 1, column 5, lines 39-64). and are thus possibly processed by the roller 30A. However, this does not change the fact that all the shredded tobacco from the outlet end of the the descent channel's first portion is taken up by the first roller section 30 and all the reclaimed tobacco from the channel's second outlet end is taken up by the second roller section 30A.

- 4.1.3 Lastly, each of the toothed roller sections 30, 30A rotates independently of the other (figure 2, column 4, lines 16-18).
- 4.1.4 Once the tobacco leaves the take-up unit, it arrives on a plate 34 from where it may be showered into a shower channel or onto a suction drum (column 3, lines 54-59).
- 4.2 Consequently, in the Board's opinion and in agreement with the decision under appeal, D2 is seen to disclose all the features of claim 1 except firstly an ascent channel and an aspirating belt as claimed; and secondly, that the first and second portions of the descent channel is divided internally into the first and second portions by a partition wall.

With regards to the first point, D2's mere reference to D11 (column 1, lines 46-49) does not imply that the ascent channel/aspirating belt features as known from D11, are therefore likewise known in combination from D2. Regarding the second point, D2 does not mention a partition wall, nor can one be seen in the figures. At best the different widths of the first and second portions might imply an intermediate external wall where the portions meet, but not their being divided by an interior partition wall.

- 4.3 The partition wall feature is first described in the specification paragraph [0018]. Paragraph [0038] goes on to explain that the partition wall prevents mixing of trimmed and shredded tobacco inside the descent channel, in other words separates the two tobacco types in the channel.

The features of an ascent channel and aspirating belt on the other hand represents an alternative way of forming the tobacco stream and are unrelated to those of the partition wall. Inventive step of the two sets of differences can therefore be assessed separately.

4.4 Starting with the ascent channel and aspirating belt, these features are known from D11. In view of the fact that D2's teaching is not specific to shower or suction drum tobacco string formation and its express reference to D11 the Board concludes that it would be obvious to adopt that document's alternative tobacco string formation mechanism in a tobacco maker such as known from D2. The respondent indeed agrees that inventive step does not reside in these features, but rather focuses on that of the partition wall.

4.5 Turning now to the feature of the partition wall and its associated effect of preventing mixing of shredded and reclaimed tobacco the Board notes that D2 already goes some way in achieving this effect. The toothed wheel 20 only delivers shredded tobacco into the right hand part of the descent path of width W2, whereas the reclaimed tobacco enters over the remaining width via the plate 50 (figure 2). Although, it is conceivable that there might be some mixing of the two types of tobacco in the descent channel, it is clear from the fact that the shredded and reclaimed tobacco is fed from separate feeds and that the shredded tobacco is then processed by the toothed wheel section 30 while the reclaimed tobacco is processed by the wheel section 30A (column 4, lines 14-19), that the two tobacco streams are meant to remain separate. Consequently, the tobacco descends the channel 25 largely in two separate parallel columns, a column of reclaimed and a column of shredded tobacco. As noted previously, the level of the

tobacco in the two columns is also monitored and controlled separately, which further reinforces this conclusion.

Thus, in the the light of D2, the objective technical problem associated with this second effect can be formulated as how to improve separation of shredded and reclaimed tobacco columns in the descent path of D2.

- 4.6 Tasked with the above separation problem the Board holds that, by applying their general knowledge, the skilled person would as a matter of obviousness modify the descent channel of D2 by providing a partition wall.

In the Board's opinion, the skilled person, a mechanical engineer working in the cigarette machine industry, knows from common general knowledge that to reliably keep different materials separate, in other words to avoid them mixing, a physical barrier must be put between them. The simplest form and most straightforward to realize that the skilled person knows from their general knowledge is a partition wall.

- 4.6.1 This is all the more so in view of the fact, as is common ground, that the descent channel 25 of D2 already has lateral side walls at its edges (figure 2). These guide the tobacco, keeping the tobacco in the channel, that is preventing it from falling out of the sides of the channel. The skilled person knows that a partition wall functions in just the same way. It acts as a guide, keeping things left and right of it separate. Given the task of improving separation of the columns of tobacco in the distinct portions of the descent channel 25 of D2, the skilled person would

therefore, as a matter of obviousness, separate the two portions by means of a partition wall.

- 4.6.2 The Board is not persuaded by the respondent's argument that the skilled person would reject this idea because the front wall 26 is a vibrating wall whilst the rear wall 28 is fixed (figure 1, column 3, lines 38-45, cf. decision grounds, point 9.6). As explained above, the descent channel 25 already has left and right side walls which do not appear to interfere with vibration of wall 26. Irrespective of whether these side walls are attached to the vibrating front wall 26 or fixed to back wall 28, and whether or not seals are provided to interface vibrating and fixed parts, they also extend between a vibrating and a fixed wall. This would apply in equal measure for a partition wall, i.e. such a wall would be realized in analogous manner. Therefore in that D2 already teaches side walls it will be immediately clear to the skilled person that vibration of the front (or back) walls need not be a hindrance for providing a partition wall to better separate the two columns.

In any case, far from a partition wall requiring a complicated seal interfacing vibrating and stationary front and back walls, the claim does not require that the partition wall must extend laterally all the way between the front and back walls or be attached to both, let alone sealed to them. Nor is this inherent in the feature of a partition wall or necessary for it to provide better separation.

- 4.6.3 The Board concludes that, starting from D2 and applying their common general knowledge to solve the problem in hand (better separation), the skilled person would

arrive at the partition wall feature as claimed, without making an inventive step.

4.7 Alternatively, starting from D2 and tasked with the problem of improving separation of shredded and reclaimed tobacco, the skilled person will look to ways of improving separation of tobacco in cigarette making machines such as known to him from D17 or D6.

4.7.1 He will find one such way in D17 (page 1, lines 22-78, figures 1-3). In D17 a partition wall 13 and its extension 23 separate long and short tobacco in a hopper 4 (page 1, lines 27-37 and lines 71-91). Therefore the skilled person would immediately see that a partition wall is a suitable means of keeping different types of tobacco separate in a tobacco processing receptacle. In improving tobacco separation in D2 they would thus, as a matter of obviousness, use a partition wall to separate the two distinct sections of the channel 25 in D2.

For the reasons explained above, the Board does not consider that the skilled person will dismiss using a partition wall known from D17 in the descent channel 25 of D2 because it has a vibrating front wall 26 and fixed back wall 28. In this context, the Board also notes that in D17 the partition wall 13 and its extension 23 divide the hopper 4, yet neither touch the rotating carding drums 6, 7. In the same way it would be obvious for the skilled person to make a partition wall that internally divided the channel 25 of D2 and that was attached to either the vibrating or fixed wall but not to both.

Nor does the Board believe that the skilled person would ignore the teaching of D17 because the partition

wall separates long and short tobacco, rather than shredded and reclaimed tobacco (column 1, lines 23-31). The partition wall, being solid, is a barrier that will separate tobaccos of any kind. The skilled person, with his eye focused on the problem of better separation, not what types of tobacco should constitute the tobacco rod, will immediately recognise that the idea of the partition wall in D17, can equally be applied to improve separation of reclaimed and shredded tobaccos.

Thus the combination of D2 and D17 would lead the skilled person to a descent channel with a partition wall as claimed without having made an inventive step.

- 4.7.2 By the same token, the Board considers that a combination of D2 and document D6 would likewise lead the skilled person to a descent channel with a partition wall as claimed in an obvious manner.

In particular the last embodiment of D6 (column 16, line 30-column 17, line 53, with figure 6) discloses (see figure 6) discrete descent channels 412, 416 and 414 for keeping different types of tobacco separate (column 16, lines 30-51). In an alternative of this arrangement (column 17, lines 43-53), a single reservoir divided into separate chambers by internal baffles is proposed. In other words a single descent channel divided internally into distinct portions by a partition wall (baffle). Starting from D2 and wishing to improve separation of the shredded and reclaimed tobacco descending side-by-side in the common channel 25, the teaching of D6 would prompt the skilled person to use baffles, i.e. partition walls, as in D6, in the channel 25.

Again, the skilled person will be focused on the problem of separation, not the different kinds of tobacco to be separated, nor whether or not the descent channel of D6 has vibrating parts. Thus they will immediately see from D6 that a partition wall will improve separation, that is prevent mixing, of the different types of tobacco descending in the channel 25 of D2. To solve the objective problem (improved separation) they will therefore include a partition wall in the channel 25 of D2 and thus arrive at the claimed partition wall feature in an obvious manner.

4.8 Summarising, the Board holds that the skilled person would, as a matter of obviousness, use an ascent channel and aspiring belt, known from D11, as an alternative way of building the tobacco stream in the cigarette maker of D2. Furthermore the skilled person would, in the light of their common general knowledge, or D17 or D6, internally divide the descent channel 25 of D2 by means of a partition wall as a matter of obviousness. In so doing the skilled person would arrive at the subject matter of claim 1 without making an inventive step. The Board concludes that the subject matter of claim 1 of the sole request lacks inventive step, Article 52(1) with 56 EPC.

5. The Board concludes that for this reason alone the patent as amended according to the main and sole request on file does not meet the requirements of the EPC. Pursuant to Article 101(3)(b) EPC the patent must therefore be revoked. The further questions as to whether or not the subject-matter of claim 1 of the sole request is novel or is amended to include added subject matter ; whether as amended it is unclear, and whether the claimed invention is sufficiently disclosed can remain unanswered.

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

Decision electronically authenticated