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Datasheet for the decision of 8 October 2019

Case Number: T 0341/15 - 3.2.07

Application Number: 08750997.2

Publication Number: 2155568

IPC: B65D5/60, B65D85/10

Language of the proceedings: EN

Title of invention:
PACKAGE OF TOBACCO ARTICLES HAVING AN INNER PACKAGE WITH A COVER FLAP FIXED TO A HINGED LID

Patent Proprietor:
G.D Societa' per Azioni

Opponent:
Focke & Co. (GmbH & Co. KG)

Headword:

Relevant legal provisions:
EPC Art. 56, 99(1), 114(2)
RPBA Art. 12(4)

Keyword:
Discretionary decision of first instance to admit late-filed documents - overruled (no)
Late-filed auxiliary requests - admitted (no)
Inventive step - main request and auxiliary requests (no)

Decisions cited:
G 0009/91, G 0010/91, T 1705/07, T 1067/08, T 0618/14

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0341/15 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 8 October 2019

Appellant: (Patent Proprietor)	G.D Societa' per Azioni Via Battindarno 91 40133 Bologna (IT)
Representative:	Maccagnan, Matteo Studio Torta S.p.A. Via Viotti, 9 10121 Torino (IT)
Respondent: (Opponent)	Focke & Co. (GmbH & Co. KG) Siemensstrasse 10 27283 Verden (DE)
Representative:	Ellberg, Nils Meissner Bolte Patentanwälte Rechtsanwälte Partnerschaft mbB Hollerallee 73 28209 Bremen (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 12 January 2015 revoking European patent No. 2155568 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	I. Beckedorf
Members:	G. Patton
	A. Pieracci

Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal within the prescribed period and in the prescribed form against the decision of the Opposition Division to revoke European patent No. 2 155 568.

The opposition had been filed against the patent in its entirety and was based on Article 100(a) EPC (lack of inventive step only).

II. The Opposition Division admitted into the proceedings late-filed documents **D9**(=WO 98/22367 A) and **D14**(=DE 646 326 A) and held that claim 1 of the then main request (patent as granted) and of the then first to sixth auxiliary requests did not involve inventive step pursuant to Article 56 EPC starting from D9 as closest prior art in combination with the teaching of D14.

III. The Board provided the parties with its preliminary non-binding opinion on the sets of claims according to the main request (patent as granted), the first to seventh auxiliary requests filed with the statement setting out the grounds of appeal dated 22 May 2015 and the eighth to tenth auxiliary requests with letter dated 4 July 2017. For the details of the Board's preliminary opinion that the appeal was likely to be dismissed, reference is made to the communication pursuant to Article 15(1) RPBA dated 27 May 2019.

In reaction the appellant withdrew with letter dated 8 August 2019 the eighth to tenth auxiliary requests and filed further arguments regarding the admissibility of the second to fifth and seventh auxiliary requests.

IV. Oral proceedings took place on 8 October 2019. For further details about the course of the oral proceedings reference is made to the minutes. The order of the present decision was announced at the end of the oral proceedings.

V. The appellant requested

that the decision under appeal be set aside and
that the patent be maintained as granted (main request)
or, in the alternative,
that the patent be maintained in amended form according to one of the sets of claims filed as first to seventh auxiliary requests with the statement setting out the grounds of appeal dated 22 May 2015,
and
that documents D9 to D16 be not taken into account in the proceedings.

The respondent requested

that the appeal be dismissed
and
that documents D9 to D16 be taken into account
and
that the second to fifth and seventh auxiliary requests be not admitted into the proceedings.

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

"A package of tobacco articles, comprising:
a group of tobacco articles;

a cup-shaped outer container (2) having an open top end (6), and a cup-shaped lid (7) hinged to the outer container (2) along a hinge (8) to rotate, with respect to the outer container (2), between an open position and a closed position opening and closing the open top end (6) respectively; and
an inner package (3) which is housed inside the outer container (2), encloses the group of tobacco articles, and has a tobacco article extraction opening (4) closed by a cover flap (5);
wherein the cover flap (5) is fixed to the inner package (3) using non-dry, re-stick adhesive which is applied to the underside surface of the cover flap (5) and extends about the whole of the extraction opening (4), so the cover flap (5) can be repeatedly detached partly from the inner package (3) and then fixed back onto the inner package (3);
wherein the inner package (3) is formed by folding a sheet (19) of packing material, which is first cut to define the extraction opening (4), and then fitted with the cover flap (5) gummed on the underside with re-stick adhesive so that the underside surface of the cover flap (5) is coated with re-stick adhesive which, inside the extraction opening (4), glues the inner portion of the sheet (19) of packing material permanently to the cover flap (5), and, outside the extraction opening (4), glues the sheet (19) of packing material detachably to the cover flap (5);
the package (1) being characterized in that at least a portion of the cover flap (5) is connected permanently and non-removably to the lid (7), so that opening and closing the lid (7) simultaneously also opens and closes the cover flap (5)."

With respect to claim 1 of the main request, claim 1 of the **first auxiliary request** further comprises at the end of the claim:

"; and the cover flap (5) has a bottom tab (16) with no re-stick adhesive and glued permanently and non-removably to an inner surface of the lid (7)."

With respect to claim 1 of the main request, claim 1 of the **sixth auxiliary request** further comprises at the end of the claim:

"; the cover flap (5) has a bottom tab (16) with no re-stick adhesive and glued permanently and non-removably to an inner surface of the lid (7); and
the bottom tab (16) of the cover flap (5) is folded 180° onto the rest of the cover flap (5), and an inner surface of the bottom tab (16) of the cover flap (5) is glued by spots (17) of permanent glue to the inner surface of the lid (7)."

The wording of claims 1 of the second to fifth and seventh auxiliary requests is not necessary in view of the outcome of the present decision.

VII. The appellant argued essentially as follows (the arguments are discussed in more details in the reasons for the decision):

Admittance of late-filed documents D9 and D14

Because documents D9 and D14 were late-filed and *prima facie* not relevant for novelty the decision of the Opposition Division in this respect should be overruled.

Admittance of auxiliary requests in appeal proceedings

Since the patent was revoked by the Opposition Division the patent proprietor is entitled to file new requests in appeal proceedings and have them admitted into the proceedings.

Main request (patent as granted)

Inventive step of the claimed subject-matter is to be acknowledged. Document D9, taken as closest prior art, does not disclose the features of the characterising portion. The skilled person would not consider D14 since it concerns a shoulder box, i.e. a package type different from that of claim 1 and D9. Even when combining the teaching of D14 with the package of D9 the skilled person would not arrive at the claimed subject-matter.

First auxiliary request

Inventive step should be recognised for the subject-matter of claim 1 of the first auxiliary request. D14 does not disclose the features introduced in claim 1 of the first auxiliary request with respect to claim 1 of the main request.

The skilled person starting from D9 and thinking of connecting the cover flap permanently and non-removably to the lid, so that opening and closing the lid simultaneously also opens and closes the cover flap, would have no reason not to apply the re-stick adhesive ("tacky material") on the complete underside surface of the cover flap.

Sixth auxiliary request

Inventive step should be recognised for the subject-matter of claim 1 of the sixth auxiliary request. The skilled person would not consider the embodiment of page 4, lines 16-19, of D9 as a plausible closest prior art. For the appellant the skilled person would start from another embodiment of D9, such as the one of Figure 1.

VIII. The respondent argued essentially as follows (the arguments are discussed in more details in the reasons for the decision):

Admittance of late-filed documents D9 and D14

The Opposition Division exercised its discretion correctly when admitting D9 and D14, so that its decision should not be overruled in this respect.

Admittance of auxiliary requests in appeal proceedings

The revocation of the patent does not give specific rights to the patent proprietor for automaticity in admissibility of new requests in appeal proceedings. The second to fifth and seventh auxiliary requests should not be admitted into the proceedings.

Main request (patent as granted)

The claimed subject-matter is obvious for the skilled person starting from the teaching of D9 as the closest prior art and combining it with the teaching of D14.

First auxiliary request

The subject-matter of claim 1 of the first auxiliary request should be seen as lacking inventive step for the same reasons as those given for claim 1 of the main request.

Sixth auxiliary request

Inventive step should not be recognised for the subject-matter of claim 1 of the sixth auxiliary request because the features introduced in claim 1 of the sixth auxiliary request with respect to claim 1 of the first auxiliary request cannot justify inventive step.

Reasons for the Decision

1. *Documents*

Although the parties' requests referred to documents D9 to D16 of the opposition proceedings (see point V above), only documents **D9** and **D14** are relevant for the present decision.

1.1 Documents D9 and D14 were filed after the nine-months opposition period according to Article 99(1) EPC (impugned decision, points I.4, I.7 and I.9). Their admission into the proceedings was hence subject to the discretion of the Opposition Division, which decided to admit them into the proceedings (see impugned decision, point II.2; minutes of the oral proceedings, point 2).

1.2 The appellant considers that the late-filed documents D9 and D14 could have been retrieved and filed within

the time limit pursuant to Article 99(1) EPC, that their late-filing was done without any justification, and that they were *prima facie* not relevant, in particular not more relevant than the other documents filed within the nine-months opposition period. For these reasons, the appellant holds the view that they should not have been admitted into the proceedings similarly to other documents which had not been admitted by the Opposition Division (see impugned decisions, point II.2.3).

At the oral proceedings before the Board the appellant further added that D9 only concerns the preamble of claim 1 of the main request so that it would not be relevant to the invention. In addition, since it was filed at a very late stage of the opposition proceedings, although known to the respondent, it should have been admitted only if it would have been *prima facie* relevant for novelty, which was not the case. For these reasons, it should be concluded that the Opposition Division exercised its discretion wrongly and in an unfair manner against the appellant.

For the appellant, the same applies for D14 which had been filed even later during the opposition proceedings, i.e. after the summons had been sent by the Opposition Division.

1.3 The Board cannot share the appellant's view for the following reasons.

According to the established case law a Board of appeal should only overrule the way in which a department of first instance has exercised its discretion if it concludes that it has done so according to the wrong principles, or without taking into account the right

principles, or in an unreasonable way, and has thus exceeded the proper limits of its discretion. It is not the function of a Board to review all the facts and circumstances of the case as if it were in the place of the department of first instance in order to decide whether or not it would have exercised such discretion in the same way (Case Law of the Boards of Appeal, 9th edition 2019, IV.C.4.5.2 and V.A.3.5.1.b).

As put forward by the respondent at the oral proceedings before the Board, documents D9 and D14 were filed either before the summons for oral proceedings had been sent (D9) or at least within the time limit set pursuant to Rule 116 EPC (D14). Even though the documents were late-filed, the procedural rules were fulfilled and a hint of tactical behaviour from the respondent's side in this respect is not apparent, even in the allegedly absence of any justification for the late-filing.

When considering their admission into the proceedings, the Opposition Division applied the correct criterion of *prima facie* relevance. In this respect the Board follows the respondent's view that there is no legal basis or available case law according to which some circumstances would justify that only novelty, i.e. not inventive step, should be considered for the criterion of *prima facie* relevance (Case Law of the Boards of Appeal, 9th Edition 2019, IV.C.4.5.3).

Hence, the Board considers that, in the present case, the Opposition Division did not base its decision on the wrong principles, or without taking into account the right principles, or in an unreasonable way.

Consequently, the Board decides to not overrule the Opposition Division's decision as far as the admittance into the proceedings of documents D9 and D14 is concerned.

2. *Admittance of auxiliary requests in appeal proceedings*

2.1 The purpose of the inter partes appeal procedure is mainly to give the adversely affected party a possibility to challenge the decision of the Opposition Division on its merits and to obtain a judicial ruling on whether the decision of the opposition division is correct (G 9/91 and G 10/91, OJ EPO 1993, 408, 420). The appeal proceedings are not about bringing an entirely fresh case; rather, the decision of the Board will in principle be taken on the basis of the subject of the dispute in the first-instance proceedings. The appeal proceedings are thus largely determined by the factual and legal scope of the preceding opposition proceedings and the parties have only limited scope to amend the subject of the dispute in second-instance proceedings (see e.g. T 1705/07, point 8.4 of the reasons; T 1067/08, point 7 of the reasons, both not published in OJ EPO).

This means that parties to proceedings leading to the decision under appeal are not at liberty to bring about the shifting of their case to the second instance as they please, and so compel the Board either to give a first ruling on the critical issues or to remit the case to the department which issued the decision under appeal. Conceding such freedom to a party would run counter to orderly and efficient proceedings. In effect, it would allow a kind of "forum shopping" which would jeopardise the proper distribution of functions between the administrative departments and the Boards

of Appeal acting as the EPO's judicial instance, and would be absolutely unacceptable for procedural economy generally. In order to forestall such abusive conduct, Article 12(4) RPBA provides that the Board has the power to hold inadmissible any requests which could have been presented in the proceedings leading to the decision under appeal.

2.2 Since, in the present case, the second to fifth and seventh auxiliary requests were not presented during the opposition proceedings so that their respective claim 1 does not form part of the impugned decision, and because the appellant did not provide any convincing justification for their filing for the first time with the statement setting out the grounds of appeal, the Board does not admit these requests into the proceedings pursuant to Article 12(4) RPBA and Article 114(2) EPC.

2.3 At the oral proceedings before the Board, the appellant referring to its letter dated 8 August 2019 argued that, since the patent was revoked, it was entitled to file new requests in appeal proceedings and that such new requests should be admitted.

The appellant referred to the fact that, during the opposition proceedings, it had received only a positive opinion from the Opposition Division before the oral proceedings, that it applied a fair approach in filing new requests in due time, when necessary, and that this approach fulfilled the criterion of procedural economy in insuring an efficient procedure.

Finally the appellant argued that at least the second auxiliary request should be admitted into the proceedings since its claim 1 concerns the combination

of claims of the patent as granted and, hence, cannot be seen as a surprise by the respondent.

2.4 The Board cannot follow the appellant's view for the following reasons discussed at the oral proceedings.

As admitted by the appellant, no new issues such as new objections new reasoning, or new arguments, had come up during the oral proceedings before the Opposition Division which could have been a surprise. The objections raised on the basis of the disclosures of D9 and D14 were already known from the written procedure. Furthermore, the impugned decision does not include either any new facts and/or issues which could have justified the filing of new requests in the appeal proceedings. The mere fact that the final decision of the Opposition Division differs from its preliminary opinion provided in writing cannot justify the filing of new requests in appeal proceedings. As a matter of fact, preliminary opinions are by nature not final decisions since otherwise oral proceedings would be useless.

The revocation of the patent does not give to the patent proprietor the right of having any new requests **automatically** admitted in appeal proceedings. The case law of the Boards of Appeal does not provide such a right (Case Law of the Boards of Appeal, 9th Edition 2019, V.A.4.11.3.g)). As a matter of fact, none of the decisions cited by the appellant during the written phase of the appeal proceedings and referred to during the oral proceedings before the Board supports this view. There always exists conditions for admission of new requests filed for the first time in appeal proceedings, in particular that they have to be justified by the **normal development** of the proceedings

or have **under the circumstances** to be considered as a normal reaction of a losing party. As mentioned under point 2.1 above, providing such a right to the patent proprietor, even in case of revocation of the patent by the Opposition Division, would jeopardise the proper functioning and distribution of roles between the first instance and the Boards.

For instance T 618/14, not published in OJ EPO, point 4.2 of the reasons, which is the most recent decision of the above mentioned passage of the Case Law of the Boards of Appeal, *supra*, i.e. unambiguously applying the current Rules of Procedure of the Boards of Appeal, states for the admission of the new requests in appeal proceedings that it does not appear from the minutes of the oral proceedings that the patent proprietor deliberately chose not to file new requests. This, however, does not apply to the present case since as pointed out by the respondent it appears from the minutes, point 9, last paragraph, that the appellant deliberately chose not to file further requests.

Finally, the Board cannot see any distinction between the second auxiliary request and the third to fifth and seventh auxiliary requests for their admission into the proceedings in view of the above reasons.

3. *Main request (patent as granted)*

3.1 Since the Board considers that the subject-matter of claim 1 of the main request lacks inventive step (see below), there is no need to discuss in this decision any other objections which would have been raised by the respondent against this request.

3.2 Inventive step

3.2.1 The respondent contests that the subject-matter of claim 1 of the main request involves inventive step starting from D9 as closest prior art in combination with the teaching of D14 (see impugned decision, point II.4; minutes before the Opposition Division, point 3).

3.2.2 Disclosure of D9

Document D9 (page 11, line 16, to page 13, lines 19, Figure 1) discloses a package of tobacco articles such as cigarettes, comprising:

a group of tobacco articles ("batch of cigarettes" 3); a cup-shaped outer container ("pack" 1, "outer carton") having an open top end, and a cup-shaped lid (2) hinged to the outer container (1) along a hinge (see Figure 1) to rotate, with respect to the outer container (1), between an open position and a closed position opening and closing the open top end respectively; and an inner package ("barrier layer", "package") which is housed inside the outer container (1), encloses the group of tobacco articles such as cigarettes, and has a tobacco article extraction opening ("aperture") closed by a cover flap ("label" 7); wherein the cover flap (7) is fixed to the inner package ("barrier layer", "package") using non-dry, re-stick adhesive ("permanently tacky material") which is applied to the underside surface of the cover flap (7) and extends about the whole of the extraction opening ("aperture"), so the cover flap (7) can be repeatedly detached partly from the inner package ("barrier layer", "package") and then fixed back onto the inner package ("barrier layer", "package");

wherein the inner package ("barrier layer", "package") is formed by folding a sheet (25, see for instance Figure 4, page 14, lines 18 to page 16, line 18) of packing material, which is first cut ("slits" 30, 31) to define the extraction opening ("aperture"), and then fitted with the cover flap ("layer" 34, 7) gummed on the underside with re-stick adhesive ("permanently adhesive") so that the underside surface of the cover flap (7, 34) is coated with re-stick adhesive ("permanently adhesive") which, inside the extraction opening ("aperture"), glues the inner portion of the sheet (25) of packing material permanently to the cover flap (7, 34), and, outside the extraction opening ("aperture"), glues the sheet (25) of packing material detachably to the cover flap (7, 34). In this respect, the Board concurs with the finding of the impugned decision, point II.4, page 3, that since in D9 the label (7) is pulled to open the inner package, a permanent bond between the packing material of the inner package and the cover flap (7) within the meaning of claim 1 is inevitably present.

3.2.3 Distinguishing features over D9

In view of the above, the only distinguishing features of claim 1 over the disclosure of D9 are those of the characterising portion. This was agreed upon by both parties.

3.2.4 Technical effect - problem to be solved

As appearing from the contested patent, paragraph 20, the distinguishing features enable that the cover flap can be lifted and closed simultaneously with the lid.

The objective technical problem to be solved can then be formulated as to modify the package of tobacco of D9 such that the cover flap is lifted and closed simultaneously with the lid so as to provide an easier handling of the package (see impugned decision, point II.4, page 4, first paragraph).

At the oral proceedings, both parties agreed upon this definition of the problem to be solved.

3.2.5 The Board concurs with the respondent, see its reply, point 2.4, that the technical effects mentioned by the appellant that the cover flap peels-off the re-stick adhesive and avoids to tear away the cover flap from the inner package and that no wrinkles are formed due to the precise placement of the cover flap when closing are not related to the distinguishing features as such (see also appellant's letter dated 25 May 2016, point 4, in particular last paragraph). Hence the problem to be solved proposed by the appellant in the written procedure cannot be followed, see statement setting out the grounds, page 5, fifth paragraph. This view corresponds to the Board's preliminary opinion provided to the parties with the communication dated 27 May 2019, see point 6.2.5, which was not contested during the oral proceedings.

3.2.6 Inventiveness of the claimed solution

Contrary to the appellant's view, the Board is of the opinion that the skilled person would come across document D14 and consider it when looking for a solution to the above mentioned problem, since D14 lies within the same technical field as that of claim 1 and D9 of packages of tobacco. The fact that D14 may relate to a shoulder box type, i.e. a "*type of cigarette box*

much different from the type of cigarette of the claimed invention" as argued by the appellant, cannot remove this fact.

Contrary to the appellant's view, D14 clearly identifies the problem and discloses the claimed solution therefor (see for instance page 1, lines 37-43, "*Der an dem vorderen Ende des Aufreißstückes befestigte und auf der Innenseite des Deckels* ***festgeklebte*** *Fortsatz bewirkt beim Zurücklegen des Deckels* ***selbsttätig*** *die Aufreißung des Vollumschlages und das Heben des Päckchens*", emphasis added by the Board; see also page 1, lines 20-26, and page 2, lines 14-22).

The Board notes that a pre-weakened cut to define the extraction opening in the inner package like in D14 (see line b, Figures 1 to 3) is not excluded from claim 1, contrary to what seems to suggest the appellant.

Furthermore, contrary to the appellant's view, D14 explicitly mentions the reclosing of the lid for preserving the cigarettes, see for instance page 2, lines 32-44 ("für die Frischerhaltung der Zigaretten...wieder schließen...").

It is also referred to page 1, lines 1-8 of D14 where the prior art of D14 is discussed, disclosing also both the problem and the solution.

The Board cannot see, contrary to the appellant's view, why in view of the problem to be solved the skilled person would consider to replace the complete package of D9 by the inner wrapper of D14. When combining the teaching of D14 with the package of tobacco of D9 the skilled person would merely consider the disclosed

solution to the problem, i.e. gluing a portion ("Anfasser" d) of the cover flap ("Aufreißstück") to the lid ("Deckel").

As a consequence, the Board cannot find fault in the reasoning and the finding of the impugned decision, point II.4, that the subject-matter of claim 1 of the main request lacks inventive step starting from D9 as closest prior art in combination with the teaching of D14.

3.2.7 At the oral proceedings the appellant further argued that the skilled person when starting from D9 would not consider D14 since lifting of the inner package is mandatory in the disclosed package of D14, see page 1, lines 8 and 42 and page 2, lines 12 and 20 so as line 58 of claim 1, when opening the lid while it is not the case in the one of D9. Furthermore, the skilled person would have to separate the two features disclosed in combination in D14, namely the opening and the lifting. He would have no reason to do so, and no indication on how to do it.

3.2.8 The Board cannot follow the appellant's view since as already mentioned above the skilled person would consider D14 when looking for solution to the objective technical problem since D14 is in the technical field of packages of tobacco like D9 and claim 1 of the main request.

Furthermore, as put forward by the respondent, the lifting and opening correspond merely to two distinct functions, i.e. not to two distinct features, realised through the same feature of a portion of the cover flap being connected permanently and non-removably to the lid. In addition, as admitted by the appellant, lifting

is not excluded from the wording of claim 1. Hence, should there be any lifting of the inner package when implementing the solution of D14 into the package of D9, the resulting package would still fall within the scope of claim 1.

4. *First auxiliary request*

4.1 Since the Board considers that the subject-matter of claim 1 of the first auxiliary request lacks inventive step (see below), there is no need to discuss in this decision any other objections which would have been raised by the respondent against this request.

4.2 Inventive step

4.2.1 With regard to additional features in claim 1 of the first auxiliary request (see point VI above), the appellant considers that the entire grip in D14 is attached to the inner surface of the lid, so that above mentioned added features would not be disclosed in D14.

4.2.2 The Board cannot share the appellant's view taking into account the disclosure of D14 which refers to the "Anfasser" d being glued to the inner surface of the lid, i.e. not the entire grip ("Aufreißstück"), see page 2, lines 18-22 and Figure 1. The "Anfasser" d of D14 can then be regarded as the tab of claim 1.

Hence, said added features to claim 1 of the first auxiliary request are disclosed in D14 so that the Board cannot find fault in the reasoning and the finding of the impugned decision, point II.5, that the subject-matter of claim 1 of the first auxiliary request lacks inventive step starting from D9 as closest prior in combination with the teaching of D14.

4.2.3 At the oral proceedings the appellant additionally argued that, should the skilled person start from D9 and think of connecting the cover flap (7, 34) permanently and non-removably to the lid (2) so that opening and closing the lid (2) simultaneously also opens and closes the cover flap (7, 34), in accordance with the distinguishing feature mentioned under point 3.2.3 above, he would have no reason to apply the re-stick adhesive ("tacky material") only to a part of the underside surface of the cover flap (7, 34). For industrial reason and easiness of the method of production of the package he would apply the tacky material on the complete underside surface of the cover flap, i.e. also to the underside of the tab (10). By doing so he would not arrive at the claimed subject-matter in an obvious manner since it would be contrary to the feature added to claim 1 of the first auxiliary request (see point VI above). In D9, the reason for having no re-stick adhesive (tacky material) on the tab (10) is for the user to be able to easily grasp the tab and open the label (7) (see page 4, line 9-19 and page 12, lines 2-17). Since this would be done automatically by having the tab (10) permanently stuck to the lid (7) the skilled person would have no reason any longer to implement a complicated process step in manufacturing the package by masking the tab for avoiding the application of tacky material.

4.2.4 The Board cannot share this view but rather follows the respondent's one put forward at the oral proceedings that D9 discloses unambiguously the absence of re-stick material (tacky material) on the tab in accordance with the feature added to claim 1 of the first auxiliary request (see point VI above). The appellant's arguments that the skilled person would modify the disclosure of

D9 by gluing the tab (10) to the inner package (3) when having connected permanently the cover flap (7, 34) to the lid (2) in an obvious manner according to the main request, since he would no longer see the need for having such a free tab (10), is not convincing since it is not based on any available evidence. For the Board, the skilled person would have no reason to modify the disclosure of D9 before implementing the disclosed solution of D14. The skilled person would then arrive at the subject-matter of claim 1 of the first auxiliary request in an obvious manner for the same reasons as those given above for claim 1 of the main request.

5. *Sixth auxiliary request*

5.1 Since the Board considers that the subject-matter of claim 1 of the sixth auxiliary request lacks inventive step (see below), there is no need to discuss in this decision any other objections which would have been raised by the respondent against this request.

5.2 Inventive step

5.2.1 The claimed package covered by claim 1 of the sixth auxiliary request, which with respect to claim 1 of the first auxiliary request contains one additional feature (see point VI above), corresponds to the configuration according to the embodiment of the invention shown in Figures 9 and 10 (paragraph 19, cover flap forming a U-shaped fold).

5.2.2 The Board concurs with the finding of the impugned decision, point II.8, that the feature relating to 180° folding of the tab (discussion about the features of claim 5 of the patent as granted) is disclosed in D9,

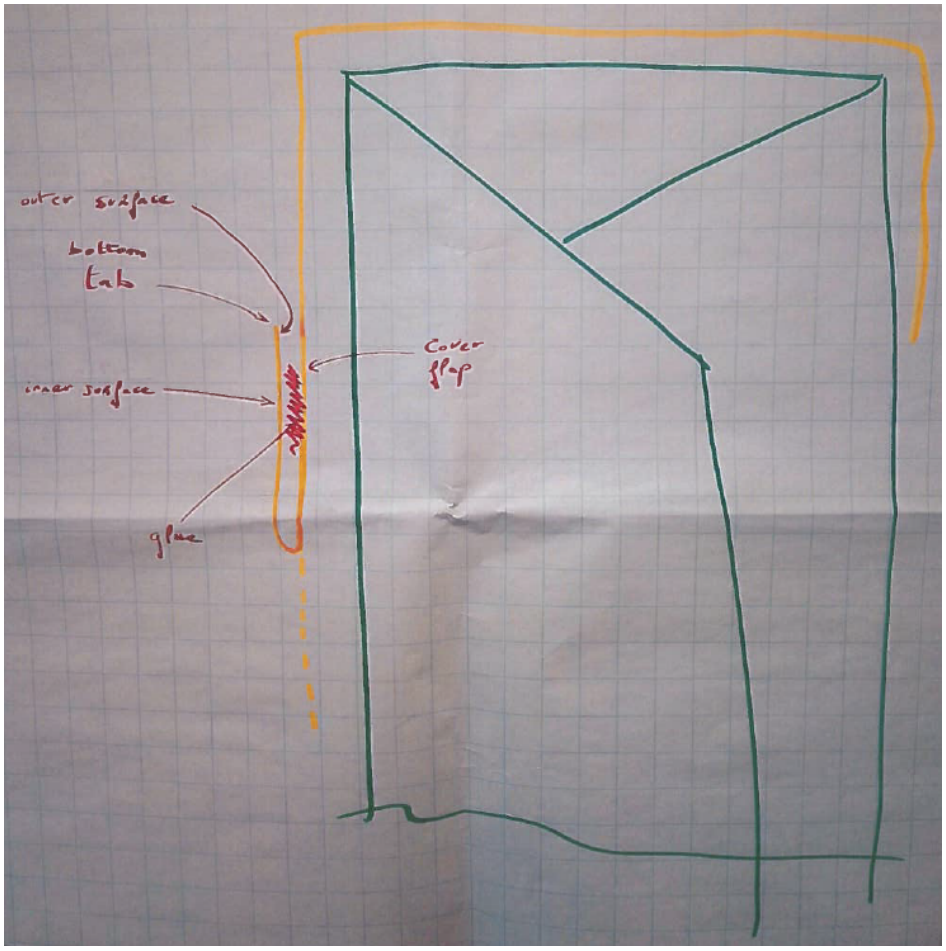
page 4, lines 16-19, in particular as the most preferred configuration.

Hence, the skilled person would unambiguously start from this configuration of D9 when combining with D14 and apply the solution disclosed in D14 to connect permanently the tab to the lid (see discussion with respect to the main request under point 3 above). By doing so, he would then inevitably glue the inner surface of the tab of D9 to the lid.

As mentioned in the impugned decision, point II.8, and uncontested by the parties, gluing by spot is usual in the present technical field.

Hence, the Board cannot find fault in the reasoning and the finding of the impugned decision, point II.9, so that the subject-matter of claim 1 of the sixth auxiliary request lacks inventive step starting from D9 as closest prior in combination with the teaching of D14.

5.2.3 At the oral proceedings the appellant argued that the skilled person would not start from the embodiment of page 4, lines 16-19 since this configuration comprises glue between the outer surface of the bottom tab and the cover flap as illustrated by the following sketch drawn by the appellant during the oral proceedings in which the Board added the names of the parts for facilitating the discussion.



Sketch drawn by the appellant

According to the appellant, such a glue applied between the outer surface of the bottom tab and the cover flap would discourage the skilled person to consider this embodiment as the closest prior art since two different opening counter-movements would be required: a first one of pulling the tab downwards as to take it off from the cover flap as required for tearing the glue and a second one of pulling the tab upwards for opening the package by the lid which would be permanently glued to the inner surface of the bottom tab. In view of these two counter-movements, the skilled person would consider that the embodiment would not work and, hence, would not be suitable as representing a plausible closest prior art with respect to claim 1 of the sixth

auxiliary request. Furthermore, the skilled person would realise that he would no longer need a folded tab since he would glue the lid directly to the unfolded cover flap. Such a long folded tab would be useless and not economical. For the appellant the skilled person would start from the embodiment shown in Figure 1 of D9.

5.2.4 The Board cannot follow the appellant's view for the following reasons discussed at the oral proceedings.

As put forward by the respondent the glue applied between the outer surface of the bottom tab and the cover flap in this embodiment of D9 (see sketch drawn by the appellant above) does not require two counter-movements for the opening of the package once the inner surface of the bottom tab of the cover flap is permanently glued to the inner surface of the lid. When opening or closing the lid the tab would automatically follow, whatever happens to the glue, i.e. torn off or not. Hence the reasons put forward by the appellant for disregarding the most preferred embodiment of D9 as a plausible closest prior art were not convincing. Finally, like for the first auxiliary request, in the absence of any evidence the Board is not convinced that the skilled person would modify the disclosure of the most preferred embodiment of D9, i.e. the tab therein, before implementing the solution of D14.

6. The Board therefore finds that the subject-matters of claim 1 of the patent as granted and of the first and sixth auxiliary requests do not involve an inventive step in view of the relevant state of the art and that auxiliary requests 2 to 5 and 7 are not admitted into the appeal proceedings. Hence, the appeal cannot be allowed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

G. Nachtigall I. Beckedorf

Decision electronically authenticated