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**Datasheet for the decision
of 14 September 2018**

Case Number: T 0525/15 - 3.2.05

Application Number: 08862603.1

Publication Number: 2222452

IPC: B29C49/02, B29C49/48

Language of the proceedings: EN

Title of invention:

A preform and a mold stack for producing the preform

Patent Proprietor:

Husky Injection Molding Systems Ltd.

Opponents:

MHT Mold & Hotrunner Technology AG
Mold-Masters (2007) Limited

Relevant legal provisions:

EPC Art. 54(2)
EPC R. 116(2)
RPBA Art. 12(4)

Keyword:

Exercise of discretion by the opposition division (not overruled)

Late-filed document - admitted (yes)

Novelty - main request (no) - auxiliary request (no)

Decisions cited:

G 0007/93, T 0971/11



Beschwerdekammern

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Case Number: T 0525/15 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 14 September 2018

Appellant I: MHT Mold & Hotrunner Technology AG
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
5 January 2015 concerning maintenance of the
European Patent No. 2222452 in amended form.**

Composition of the Board:

Chairman M. Poock
Members: P. Lanz
 J. Geschwind

Summary of Facts and Submissions

- I. The appeals by both opponents are against the interlocutory decision of the opposition division on the version in which European patent EP-B-2 222 452 met the requirements of the European Patent Convention.
- II. During the opposition proceedings, the opponents had raised the grounds for opposition according to Articles 100(a) (lack of novelty and lack of inventive step), 100(b) and 100(c) EPC.
- III. Oral proceedings were held before the board of appeal on 14 September 2018.
- IV. Both appellants I and II (opponents 1 and 2) requested that the decision under appeal be set aside and that the European patent be revoked.
- V. The respondent (patent proprietor) requested that the appeals be dismissed or, as an auxiliary measure, that the patent be maintained on the basis of the claims according to the auxiliary request filed under cover of a letter dated 9 August 2018.
- VI. The documents referred to during the appeal proceedings include the following:

E1: US 4,243,620;

E13: Extracts from "Technology of Plastics Packaging for the Consumer Market" edited by Geoff A. Giles and David R. Bain, first published in 2001, Sheffield Academic Press, pages 76 to 81 and 119 to 123.

VII. Claim 1 as considered allowable by the opposition division (main request) is worded as follows (using appellant I's feature analysis in square brackets):

"A mold stack (600) for producing a preform (300) consisting of a neck portion (302), a gate portion (306) and a body portion (304) extending between the neck portion (302) and the gate portion (306), the mold stack comprising **[feature 1]**:

a core insert (602) for defining the internal surface of the preform (300) **[feature 2]**, the core insert (602) comprising a first cavity defining portion (603) configured to define a portion of a mold cavity (609), and an attachment portion (601) configured for attachment to a core plate **[feature 2.1]**, wherein the first cavity defining portion (603) comprises a gate defining portion (610) having a conical shape **[feature 2.2]**;

a cavity insert (606) for defining the external surface of the body portion (304) of the preform (300) **[feature 3]**;

a gate insert (608) for defining the external surface of the gate portion (306) of the preform (300) **[feature 4]**, the gate insert (608) comprising a second cavity defining portion (612) configured to define, in use, a portion of the external surface of the gate portion (306) of the preform (300) **[feature 4.1]**, the second cavity defining portion (612) being associated with an inverted conical shape terminating in an extremity (802) substantially corresponding in diameter to an orifice of a nozzle receptacle (804) of the gate insert (608) configured to receive, in use, a hot runner nozzle **[feature 4.2]**;

the core insert (602) and the gate insert (608) being configured to cooperate, in use, to define the gate

portion (306) of the preform (300) having a substantially conical shape **[feature 5]**, the mold stack further comprising a split mold insert pair (604) for defining the external surface of the neck portion (302) of the preform (300) **[feature 6]**, wherein, in use, the core insert (602), the split mold insert pair (604), the cavity insert (606) and the gate insert (608) define the molding cavity (609) into which molding material can be injected to form the preform (300) **[feature 6.1]**, characterized in that the gate portion (306) of the preform (300) is associated with a substantially uniform wall thickness ("W") **[feature 7]**, the substantially conical shape of the gate portion (306) terminates directly in a vestige portion (308) having a size that substantially corresponds to an orifice of the hot runner nozzle received, in use, in the nozzle receptacle (804) of the gate insert (608) **[feature 7.1]**, and is associated with an angle (" α ") defined between an imaginary central line (310), the imaginary central line (310) passing through a longitudinal axis of the preform (300), and the internal surface of the conical shape of the gate portion (306) **[feature 7.2]."**

VIII. Compared with the main request, claim 1 of the auxiliary request is amended as follows (additions are underlined and deletions struck through by the board):

"... a core insert (602) for defining the internal surface of the preform (300) **[feature 2]**, the core insert (602) comprising a first cavity defining portion (603) configured to define a portion of a mold cavity (609), and an attachment portion (601) configured for attachment to a core plate **[feature 2.1]**, wherein the first cavity defining portion (603) comprises a gate

defining portion (610) having a substantially conical shape **[feature 2.2']**; ..."

"... characterized in that the gate portion (306) of the preform (300) is associated with a substantially uniform wall thickness ("W") **[feature 7]**, the substantially conical shape of the gate portion (306) terminates directly in a vestige portion (308) having a size that substantially corresponds to an orifice of the hot runner nozzle received, in use, in the nozzle receptacle (804) of the gate insert ~~(608)~~ (806) **[feature 7.1']**, and is associated with an angle (" α ") defined between an imaginary central line (310), the imaginary central line (310) passing through a longitudinal axis of the preform (300), and the internal surface of the conical shape of the gate portion (306) **[feature 7.2']**."

IX. The arguments of the appellants in the written and oral proceedings can be summarised as follows:

Admissibility of the main request

During the oral proceedings before the opposition division, the respondent-proprietor at first withdrew its (then) main request and replaced it with the first auxiliary request filed on 29 September 2014, prior to any substantial discussion of the main request. Thus, it was obvious that the intention of the respondent was not to defend the patent on the basis of the (then) main request, but on the basis of the scope of the lower ranking requests. The respondent's course of action led to a surprising situation and an unfair improvement of the respondent's position during the first-instance oral proceedings. This had to be rejected.

Admissibility of document E13

The opposition division should have admitted handbook excerpt E13 into the opposition proceedings. The filing of document E13 was a legitimate reaction to the inclusion of the feature of the uniform wall thickness into claim 1 of the main request. Hence, the document should have been admitted even if it was filed after the final date set in accordance with Rule 116(1) EPC.

Alternatively, document E13 should be admitted into the appeal proceedings.

Novelty

The subject-matter of claim 1 of the main request and of the auxiliary request lacked novelty in view of document E1. In particular, the wording "*having a conical shape*" in feature 2.2 relating to the gate defining portion of the core insert was anticipated by the shape of the gate forming portion of the core of document E1 (see Figure 11, reference sign 4). Angle α of feature 7.2 did not imply that the conical shape had to be "truly" conical, since an angle as defined in the claim could be established irrespective of whether the cone was truncated or not. In that respect, reference was additionally made to an excerpt of "*Meyers Lexikon der Technik und der exakten Naturwissenschaften*" in order to prove that the German term "Konus" covered a truncated cone. Moreover, the terminology used in the contested patent for the conical shapes of the preform, the core and the gate insert was consistent with this general understanding of the term "cone" (see e.g. paragraphs [0020], [0026], [0029] and [0040] of the patent).

Moreover, Figure 11 of document E1 (see right side of the drawing) clearly showed a substantially uniform wall thickness and thereby anticipated feature 7 without measuring. Even without this disclosure, the need for having a uniform wall thickness was implicitly clear to the person skilled in the field of blow moulding (cf. handbook excerpt E13, middle of page 77).

Figure 11 of document E1 also showed that the diameter of the gate defining portion corresponded to the diameter of the orifice of the hot runner nozzle (cf. features 4.2 and 7.1).

Consequently, document E1 disclosed all features of claim 1 in combination. The subject-matter of claim 1 of the main request and the auxiliary request lacked novelty.

- X. The respondent's arguments during in the written and oral proceedings were essentially as follows:

Admissibility of the main request

The opposition division's exercise of discretion regarding the admission of the main request into the opposition proceedings was correct for the reasons set out in the decision under appeal.

Admissibility of document E13

The opposition division properly exercised its discretion under Article 114(2) EPC and correctly decided not admit document E13 into the opposition proceedings. For similar reasons, the document could not be introduced into the appeal proceedings.

Novelty

Due to the claim wording "*having a conical shape*", the internal surface of the gate portion of the preform had to have the shape of a (true) cone and not that of a truncated cone. The appellants used embodiments of the patent not any longer falling under the claims for broadly interpreting the term "*having a conical shape*". This was not permissible. In fact, only if the internal surface of the gate portion of the preform had the shape of a true cone, an angle α could be defined between the internal surface of the gate portion and an imaginary central line passing through a longitudinal axis of the preform, as defined in feature 7.2 of claim 1. Since the cone shown in Figure 11 of document E1 was truncated, this document could not anticipate the true cone according to features 2.2 and 7.2 of present claim 1.

Moreover, the drawings of document E1, in particular Figure 11, were schematic; they could not directly and unambiguously anticipate feature 7 relating to the substantially uniform wall thickness of the gate portion of the preform. According to decisions T 857/91 and T 272/92, dimensions, which could only be obtained by measurement of schematic drawings, did not constitute a direct and unambiguous disclosure. The corresponding passage in column 7, lines 53 to 57 of document E1 even mentioned a varying wall thickness, which was contrary to feature 7 of claim 1. Page 77 of handbook excerpt E13 did not relate to the gate portion of the preform and was therefore not relevant for the present case.

Finally, document E1 did not disclose that the extremity of the second gate defining portion corresponded in diameter to an orifice of the nozzle receptacle, as defined in feature 4.2. That document E1 (see column 3, lines 46 to 50) stated that the nozzle duct of the hot runner nozzle was concentric with the inlet orifice did not mean that they had corresponding diameters. The same reasoning applied to feature 7.1.

In view of the above, the subject-matter of claim 1 of the main request differed from document E1 in features 2.2, 4.2, 7, 7.1 and 7.2. It was therefore novel. These reasons were, in substance, also valid for claim 1 of the auxiliary request.

Reasons for the Decision

1. *Admissibility of the main request*
- 1.1 Appellant II challenges the opposition division's exercise of discretion regarding the admission of what is now the main request. The request had been filed as first auxiliary request about five weeks before the date of the oral proceedings before the opposition division. During the oral proceedings it became the respondent-proprietor's main request, which, after a further amendment, was considered allowable by the opposition division. Appellant II puts particular emphasis on the fact that, prior to any substantial discussion during the first-instance oral proceedings, the respondent-proprietor had at first withdrawn its (previous) main request and replaced it with the first auxiliary request.
- 1.2 The discretionary power conferred by Article 114(2) and Rule 116(2) EPC necessarily implies that the EPO

department of first instance has a certain degree of freedom in exercising its power (cf. G 7/93, OJ EPO 1994, 775). A board of appeal should only overrule the way in which a department of first instance has exercised its discretion when deciding on a particular case 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. This rule also applies with respect to the opposition division's decisions on the admission of late-filed requests. It is generally not the function of a board of appeal 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 (cf. cases cited in Case Law of the Boards of Appeal of the European Patent Office, 8th edition, 2016, IV.C. 1.2.2 a)).

- 1.3 In the case in hand, the opposition division decided to admit the present main request into the proceedings, after having heard the parties (cf. minutes of the oral proceedings before the opposition division, points 2 and 3.8 to 3.11). It considered that this request was intended to overcome objections by the opponents and the opposition division's previous conclusions on added subject-matter. Moreover, according to the decision under appeal, the amended claim did not introduce any new elements and its content was known to the opponents (cf. contested decision, Reasons 5.1). It is thus not apparent that the opposition division exercised its discretion according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (cf. G 7/93, *supra*). Consequently, the opposition division's exercise of discretion under Rule 116(2) EPC regarding the admission of the main

request into the opposition proceedings is not objectionable.

The board additionally observes that the framework of the European Patent Convention does not provide a legal basis for excluding, at the appeal stage, a request which was correctly admitted into the first-instance proceedings.

For these reasons, the main request considered allowable by the opposition division forms part of the present appeal proceedings.

2. *Admissibility of document E13*

2.1 The appellants contest the opposition division's decision not to admit handbook excerpt E13 into the opposition proceedings. In their view, the filing of document E13 was a legitimate reaction to the inclusion of the feature of the uniform wall thickness into claim 1 of the main request.

2.2 Under Article 114(2) EPC it is at the opposition division's discretion not to admit facts and evidence not submitted in due time. It is well established practice that in deciding whether or not to admit such late-filed facts and evidence, the criteria to be considered by the opposition division include the state of the procedure, the reasons for the belated submission and its prima facie relevance (cf. Guidelines for Examination in the European Patent Office, November 2017, E-VI, 2). As already stated above, the discretionary power conferred by Article 114(2) EPC necessarily implies that the EPO department of first instance has a certain degree of freedom in exercising its power (cf. G 7/93, *supra*). The principle

that 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, also applies with respect to the opposition division's discretion on the admission of late-filed evidence. It is generally not the function of a board of appeal 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 (cf. cases cited in Case Law of the Boards of Appeal of the European Patent Office, 8th edition, 2016, IV.C.1.2.2 a)).

2.3 Turning to the present case, it is noted that appellant II filed handbook excerpt E13 at a late stage of the oral proceedings before the opposition division and justified its late submission with the recent addition of the feature of the uniform wall thickness into claim 1. The opposition division decided not to admit document E13 into the proceedings. In particular, it was of the opinion that the feature of the even wall thickness was already subject of claim 3 as granted and, hence, not a new issue. Moreover, it could not contribute anything beyond what was known from the prior art already on file (cf. contested decision, Reasons 5.5).

2.4 It appears from the minutes of the oral proceedings (cf. point 7) that the opposition division heard the parties before deciding on the admissibility of document E13. Moreover, it based its discretionary decision not to admit document E13 on well-established principles and it is not apparent that it acted in an

unreasonable way. Under these circumstances, the board has no reasons to overrule the way in which the department of first instance exercised its discretion under Article 114(2) EPC.

2.5 Together with its statement setting out the grounds of appeal, appellant II re-submitted document E13 in order to support its allegation that the feature relating to the uniform thickness of the conical gate portion, which the opposition division had considered an inventive contribution, was obvious.

2.6 The admission or not of document E13 into the appeal proceedings is governed by Article 12(4) RPBA. Following this provision, the non-admission of facts and evidence, which were not admitted in the first instance proceedings, into the appeal proceedings is at the discretion of the board. In fact, the wording of Article 12(4) RPBA puts facts and evidence that could have been submitted before the department of first instance but were not and facts and evidence that were submitted but were not admitted on an equal footing. Consequently, facts and evidence, which would have been admitted into appeal proceedings if they had been filed for the first time at the outset of those proceedings, should not be held inadmissible for the sole reason that they were already filed before the department of first instance and not admitted then by a correct discretionary decision. Rather, the board has to exercise its discretion under Article 12(4) RPBA independently, giving due consideration to the appellant's additional submissions filed at appeal stage (cf. T 971/11, Reasons 1.2 and 1.3).

2.7 According to the established case law, the filing of new facts and evidence before the board of appeal is

normally considered to be in due time, if it is occasioned by an argument or a point raised by another party and could not have been filed before under the circumstances of the case; a late filing can be justifiable if it is an appropriate and immediate reaction to developments in the previous proceedings. Hence, an appellant who has lost the opposition proceedings should be given the opportunity to fill the gaps in its arguments by presenting further evidence in this regard (cf. cases cited in Case Law of the Boards of Appeal of the European Patent Office, 8th edition, 2016, IV.C.1.3.6 a)).

- 2.8 Applying these principles to the case at hand, it is noted that the feature of the uniform thickness of the conical gate portion, which the opposition finally considered decisive for the question of inventive step, did not form part of the apparatus claims as granted. Rather, it was inserted into the independent apparatus claim about one month before the date of the oral proceedings, i.e. at an advanced stage of the opposition proceedings. Under these circumstances, the filing of document E13 at an early stage of the appeal proceedings could be considered a legitimate reaction to these developments in the last phase of the opposition proceedings and to the impugned decision. The fact that appellant II already submitted document E13 during the oral proceedings before the opposition division, so that this document could possibly be considered by the department of first instance, instead of holding it back in order to submit it only at the appeal stage, was neither detrimental to procedural economy nor a disadvantage to the respondent (or the board) and is thus not to be held against the appellant under Article 12(4) RPBA.

2.9 For these reasons, the board admitted document E13 into the appeal proceedings under Article 12(4) RPBA.

3. *Novelty*

3.1 On the issue of novelty, the parties' views essentially differ on whether the wording "*having a conical shape*" in claim 1 of the main request requires the gate defining portion to have the shape of a "true" cone or whether this wording encompasses the possibility of it having the shape of a truncated cone, as depicted in Figure 11 of document E1.

According to established case law (see Case Law of the Boards of Appeal of the European Patent Office, 8th edition 2016, II.A.6.3.3.), terms in patent documents should be given their normal meaning, unless the description gives them a special meaning.

In that respect, the dictionary excerpt of "*Meyers Lexikon der Technik und der exakten Naturwissenschaften*" filed by appellant I indicates that, at least in German, the term "Konus" covers both a true cone and a truncated cone. Additionally, it is noted that the terminology used in the contested patent and the underlying original application for the various (inverted) conical shapes of the preform, the core and the gate insert is consistent with this general understanding of the term "cone". Reference is made for example to gate portion (306), which, due to the vestige portion (308), has the shape of a truncated cone (see also Figure 3 of the opposed patent) and is referred to as having a substantially conical shape in feature 7.1 of present claim 1.

It is added that the angle α of feature 7.2 does not imply that the conical shape has to be "truly" conical. In fact, angle α as defined in the claim can be established irrespective of whether the conical shape is truncated or not.

In view of the above, there is neither any evidence on file that the skilled person would generally understand the term "*having a conical shape*" as excluding the shape of a truncated cone nor does the patent specification support such a restricted interpretation. The board therefore understands the term "*having a conical shape*" according to feature 2.2 as encompassing the possibility of it having the shape of a truncated cone. Based on this understanding, the terminal part of core (4) in Figure 11 of document E1 anticipates the core insert with a gate defining portion having a conical shape as defined in features 2.2 and 7.2 of present claim 1.

- 3.2 Regarding the further disputed issues of whether features 4.2, 7 and 7.1 can be directly deduced from the right side of Figure 11 of document E1, reference is made to the case law of the boards of appeal (see Case Law of the Boards of Appeal of the European Patent Office, 8th edition 2016, chapter I.C.4.6. citing, *inter alia*, the decisions referred to by the respondent), according to which features shown solely in a drawing of a prior art document form part of the state of the art when a person skilled in that art is able, in the absence of any other description, to derive a technical teaching from them. Dimensions obtained merely by measuring a diagrammatic representation in a document do not, however, form part of the disclosure.

Applying these principles to the present case, the board observes that features 4.2 ("*substantially corresponding diameter*") and 7.1 ("*size that substantially corresponds to an orifice of the hot runner nozzle*") are not directed to specific dimensions of the mould in terms of numerical values but are of more general nature. Turning now to feature 4.2, it is directly derivable for a skilled person from Figure 11 of document E1 that the extremity of the inverted conically shaped gate portion substantially corresponds in diameter to the orifice of the hot runner nozzle. By the same token, it can be deduced that the vestige portion of the preform has a size which substantially corresponds to the orifice of the hot runner nozzle, as defined in feature 7.1. In the judgement of the board, the skilled person will arrive at these conclusions at first sight without measuring any dimensions. Figure 11 of document E1 thus clearly and unambiguously anticipates features 4.2 and 7.1 of contested claim 1.

This reasoning is also valid for feature 7 of claim 1 ("*substantially uniform wall thickness*"), which does not define specific dimensions of the preform either. For a skilled person, this feature is directly derivable from Figure 11 of document E1 without having to measure specific dimensions. The possibility of varying the thickness of the plastic material between the time of its injection (left side of Figure 11) and its final shape (right side of Figure 11) due the conical shape of the core (see E1, column 7, lines 53 to 57) does not alter the fact that, in its final shape shown on the right side of Figure 11, the gate portion of the preform has a substantially uniform wall thickness.

3.3 For these reasons, document E1 discloses all features of claim 1 in combination. Consequently, the subject-matter of claim 1 of the main request lacks novelty.

3.4 The claims of the auxiliary request do not differ in substance from those of the main request. The above conclusion on the main request therefore applies to claim 1 of the auxiliary request, the subject-matter of which is equally not new, Article 54(1) and (2) EPC.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



N. Schneider

M. Poock

Decision electronically authenticated