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**Datasheet for the decision  
of 20 July 2018**

**Case Number:** T 1278/16 - 3.2.08

**Application Number:** 05013807.2

**Publication Number:** 1595616

**IPC:** B21D51/26, B21D17/02

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for deforming thin walled bodies

**Patent Proprietor:**

Envases (UK) Limited

**Opponents:**

Mall + Herlan Schweiz AG  
UNILEVER PLC / UNILEVER NV

**Headword:**

**Relevant legal provisions:**

EPC Art. 100 (c), 76(1)

**Keyword:**

Divisional application - added subject-matter (yes)

**Decisions cited:**

G 0001/06

**Catchword:**



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Case Number: T 1278/16 - 3.2.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.08**  
**of 20 July 2018**

**Appellant:** Envases (UK) Limited  
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**Decision under appeal:** **Interlocutory decision of the Opposition**  
**Division of the European Patent Office posted on**  
**19 April 2016 concerning maintenance of the**  
**European Patent No. 1595616 in amended form.**

**Composition of the Board:**

**Chairwoman** P. Acton  
**Members:** C. Herberhold  
Y. Podbielski

## **Summary of Facts and Submissions**

- I. By decision posted on 19 April 2016 the Opposition Division decided that European patent No. 1595616 as per the 6th auxiliary request then on file, and the invention to which it related, met the requirements of the EPC.
- II. Appellant 1 (patent proprietor) and appellant 2 (opponent) lodged an appeal against that decision in the prescribed form and within the prescribed time limit.
- III. Oral proceedings before the Board were held on 20 July 2018.

At the end of the oral proceedings the requests of the parties were as follows:

Appellant 1 requested that the decision under appeal be set aside and a patent be maintained on the basis of one of auxiliary requests 1-4, auxiliary requests 6-7, the main request or auxiliary request 5, all filed with letter dated 25 August 2016 (for the order of requests see letter dated 14 June 2018).

Appellant 2 requested that the decision under appeal be set aside and the patent be revoked.

- IV. Independent claim 1 of auxiliary request 1 reads as follows:

"A method of deforming a cylindrical thin walled container (1) to coordinate with a printed design on a

circumferential wall of the container, the method comprising:

(i) holding the container gripped securely in a holding station (4) being one of a series of holding stations (4) spaced around the periphery of a vertically orientated rotary holding table (3) of a multi-station necking machine (2), the holding table being operable to rotate about a horizontal axis in an indexed fashion to successively rotationally advanced locations;

(ii) advancing a multi-station tooling table (6) of the necking machine (2) from a retracted position to an advanced position relative to the holding table (3) whilst the container (1) is gripped in the holding station (4) and in the advanced position engaging embossing tooling (10) at an embossing station (9), provided at one of the tooling stations of the tooling table, to deform the circumferential wall of the container at a predetermined wall zone to coordinate with a printed design on the circumferential wall of the container, the embossing station (9) being adjacent the holding station (4) during deformation;

wherein the predetermined wall zone is co-aligned with the embossing tooling (10) by rotation of the container about its longitudinal axis prior to (Feature A) securing at the holding station.

Dependent claim 3 (as far as relevant for the present decision) reads as follows:

"...; wherein the predetermined wall zone is co-aligned with the embossing tooling (10) by rotation of the container (1) about the longitudinal axis prior to (Feature A') securing at the holding station (4) in

said fixed orientation for deforming of the wall of the container."

Feature identifiers A, A' added by the Board.

V. Auxiliary requests 2-4, auxiliary requests 6-7, the main request, and auxiliary request 5 all comprise an independent claim and a dependent claim having a difference in wording analogous to the one present between **features A** and **A'**, i.e. the dependent claim defining in a fixed orientation whereas the independent claim is not so restricted.

VI. The following document has played a role in the present decision:

D1: US 3,628,451

VII. The application (EP-A-1 595 616) on which the present patent (EP-A-1 595 616) was granted is a divisional application (hereinafter "the application"). The parent is EP-A-1 400 291 (hereinafter "the parent application"), the grandparent is EP-A-1 216 112, filed as WO-A-01/58618 (hereinafter "the grandparent application").

VIII. The essential arguments of appellant 1 can be summarised as follows:

*Disclosure in the earlier applications as filed*

Generally, the disclosure of an application was not limited to specific embodiments, but its entire content including the claims had to be considered. Thus, while paragraph [0058] of the parent application as filed as well as the paragraph bridging pages 19 and 20 of the

grandparent application as filed, disclosed a particular embodiment of co-alignment between an embossing tooling and a container by rotation of the container prior to it being placed in a chuck, claim 49 of the grandparent and claim 1 of the parent provided more generalised definitions of said invention.

With respect to the securement being defined as "non-rotatably" or "in a fixed orientation" in claim 48 and claim 1 of the grandparent and parent application respectively, this corresponded exactly to what was defined in **feature A** of claim 1. The skilled person would thus consider the wording of claim 1 equivalent to "securing in a fixed orientation". Indeed, it was inherent in the process of registered co-alignment between the tooling and the container, that there could not be rotation of the container relative to the tooling. In particular in the context of the disclosed necking/embossing machines, which ran at a speed of 200 containers per minute thereby causing considerable vibration, such securement was paramount.

The difference in wording between **feature A and A'** in claims 1 and 3 amounted at most to an unclarity, which could however not change the skilled person's understanding of the feature in view of the technical requirements.

Consequently, claim 1 defined the invention with an appropriate level of generalisation and the omission of "non-rotatably" or "in a fixed orientation" did not add subject-matter.

Thus, Article 100(c) EPC did not prejudice the maintenance of the patent according to auxiliary request 1.

The argumentation with respect to the objected omission of "non-rotatably" / "in a fixed orientation" applied *mutatis mutandis* to all further pending requests.

IX. The essential arguments of appellant 2 can be summarised as follows:

*No disclosure in the earlier applications as filed*

The parent and grandparent application disclosed two distinct embodiments: one in which co-alignment was reached by the embossing tooling being rotated relative to the container, and the other in which co-alignment was effectuated by the container being rotated relative to the tooling.

The only disclosure for the latter embodiment was in paragraph [0058] of the parent application as filed (identical to the paragraph bridging pages 19 and 20 of the grandparent application as filed). However, this disclosure was in the context of further specific, functionally and structurally interlinked features, which were missing in the definition of independent claim 1 of auxiliary request 1. The co-alignment disclosed in this passage had furthermore not been disclosed in combination with the particular features belonging to the first embodiment, let alone in combination with the multiple generalisations additionally introduced in this respect e.g. regarding the embossing tooling.

With respect to the second embodiment, the only possibly disclosed generalisation was in claim 49 and claim 1 of the grandparent and parent respectively. These defined both the securement to be "non-



rotatably" / "in a fixed orientation" as an essential element, which could not be omitted.

Consequently, the subject-matter of claim 1 had to be considered an unallowable intermediate generalisation over the original disclosure.

## **Reasons for the Decision**

### 1. Auxiliary request 1

1.1 Whereas the descriptions of the application, the parent application and the grandparent application are identical, each family member comprises its own set of claims. The claim set of the earlier application(s) is not present in the respective child application(s).

According to G 1/06 (HN), in the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, it is a necessary and sufficient condition for a divisional application of that sequence to comply with Article 76(1), second sentence, EPC that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in each of the preceding applications as filed.

1.2 Claim 1 of auxiliary request 1 defines a method of deforming a cylindrical thin walled container to coordinate with a (pre-) printed design on the circumferential wall of the container.

The application as filed describes essentially two "techniques" with respect to aligning the predetermined wall zone with the deforming tooling: either by

rotation of the deforming tooling relative to the container (see paragraphs [0048] - [0057]), or by rotation of the container relative to the deforming tooling (paragraph [0058] of the application and the parent application, which correspond to the paragraph bridging pages 19 and 20 of the grandparent application, WO 01/58618, as filed).

By claiming that "the predetermined wall zone is co-aligned with the embossing tooling by rotation of the container about its longitudinal axis prior to securing at the holding station", claim 1 is directed to the second technique.

- 1.3 The second technique furthermore forms the subject-matter of claim 49 of the grandparent application and of claim 1 of the parent application, which are abstractions from the detailed subject-matter disclosed in paragraph [0058] of the application as filed (and the corresponding passages of the earlier applications as filed).

Appellant 1 relies on these abstractions as a basis for independent device claim 1.

- 1.4 Claim 49 of the grandparent application and claim 1 of the parent application both define the body to be "gripped **in a fixed orientation**" (claim 1 of the parent)/ "gripped securely (**non-rotatably**)" (claim 49 of the grandparent) following co-alignment by rotation.

Even if the bracketed expression "non-rotatably" in claim 49 of the grandparent was considered non-limiting, claim 1 of the parent unambiguously defines the body to be gripped "in a fixed orientation".

Thus, the subject-matter directly and unambiguously derivable from said claims in each of the preceding applications as filed is that the container is gripped **in a fixed orientation / non-rotatably**.

Also the description (see paragraph [0058] of the application as filed and the corresponding passages in parent and grandparent application) discloses that, after co-ordination of the position of the tooling and of the circumferential position of the printed-design on the container wall, there is no requirement to adjust the relative position of the container and tooling. In other words, the container securely clamped in the clamp of the holding station remains in a fixed orientation.

1.5 Appellant 1 has argued that the person skilled in the art would consider the wording of claim 1 of auxiliary request 1 equivalent to "securing in a fixed orientation". In the context of high speed necking machines nothing else was conceivable.

However, the wording of the claims of auxiliary request 1 clearly differentiates between "securing at the holding station" (**feature A**, claim 1) and "securing in the holding station **in [a] fixed orientation**", **feature A'**, dependent claim 3.

It thus has to be concluded that these definition are distinct, i.e. that **feature A** (contrary to **feature A'**) comprises securing in the holding station without being in a fixed orientation.

Appellant 1 was of the opinion that the different wording of **features A** and **A'** in claims 1 and 3 was at most a clarity problem which had already been present

upon grant and which was thus not objectionable in opposition appeal proceedings. Indeed, both definitions, **A** and **A'** were equivalent.

However, the different wording of definitions **A** and **A'** suggests a different meaning. Even if this resulted only from a now un-objectionable lack of clarity in the feature definition, appellant 1 - who as the patent proprietor was responsible for drafting the claims - has to bear the consequences of the unclarity, i.e. the subject-matter of claim 1 covering clamping securely **without the container being held in a fixed orientation.**

- 1.6 As pointed out in the summons (point 3.3.3) clamping securely without the container being in a fixed orientation is technically conceivable and applied e.g. in prior art document D1, see e.g. D1, Figure 16, where compression spring 101 may be overridden to allow rotation of a can which is still securely held in the vacuum clamp 85 (column 6, line 9-23). The broader interpretation of claim 1 would thus not be rejected by the skilled person for technical reasons.
- 1.7 To conclude, the subject-matter claimed in claim 1 of auxiliary request 1, which includes - after the predetermined wall zone being co-aligned with the embossing tooling by rotation - the container being secured without being in a fixed orientation, extends beyond the application as filed and the earlier application as filed.
2. Auxiliary requests 2-4, auxiliary requests 6-7, main request and auxiliary request 5

As accepted by both parties, all the above requests comprise an independent device claim and a dependent claim with a difference in wording analogous to the one between **feature A** and **feature A'**.

Hence, in all these requests, securing at the holding station without the body/container being held in a fixed orientation forms part of the subject-matter of the independent device claim, whose subject-matter thus extends beyond the content of the parent and grandparent applications as filed.

## Order

### For these reasons it is decided that:

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

The Registrar:

The Chairwoman:



I. Aperribay

P. Acton

Decision electronically authenticated