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**Datasheet for the decision  
of 27 October 2021**

**Case Number:** T 1863/19 - 3.2.01

**Application Number:** 13714018.2

**Publication Number:** 2830447

**IPC:** A24D3/02

**Language of the proceedings:** EN

**Title of invention:**

CLEANING SYSTEM FOR DRUM CONVEYOR OF APPARATUS FOR FEEDING  
FILTER SEGMENTS TO MULTI-SEGMENT FILTER MANUFACTURING APPARATUS  
AND METHOD OF CLEANING OF DRUM CONVEYOR

**Patent Proprietor:**

Philip Morris Products S.A.

**Opponent:**

Hauni Maschinenbau GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 54(2)

**Keyword:**

Novelty - main request (no) - public prior use (yes) -  
availability to the public - obligation to maintain secrecy  
(no) - implicit obligation to maintain secrecy (no)

**Decisions cited:**

G 0001/92

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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**Case Number: T 1863/19 - 3.2.01**

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 27 October 2021**

**Appellant:** Philip Morris Products S.A.  
(Patent Proprietor) Quai Jeanrenaud 3  
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**Representative:** Bohest AG  
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**Respondent:** Hauni Maschinenbau GmbH  
(Opponent) Kurt-A.-Körper-Chaussee 8-32  
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**Representative:** Seemann & Partner Patentanwälte mbB  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
30 April 2019 concerning maintenance of the  
European Patent No. 2830447 in amended form.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** A. Wagner  
A. Jimenez  
V. Vinci  
S. Fernández de Córdoba

## **Summary of Facts and Submissions**

- I. The appeal of the patent proprietor lies against the decision of the Opposition Division concerning the maintenance in amended form of the European patent 2830447.
- II. In its decision, the Opposition Division held among others that the public prior uses E1 and E2 were sufficiently proven and that they both took away novelty of the subject-matter of claim 1 and claim 5 of the main request.
- III. In order to come to these conclusions the opposition division considered, among others, the following documents:

For the public prior use E1 - MULFI-E:

E1-A: Betriebshandbuch MULFI-E, 02/2006

E1-C: Ersatzteilkatalog mit der Bezeichnung MEK.  
0000313734000050.0751 GCE.OO

E1-D: Auszug aus Ersatzteilkatalog (vgl. Anlage E1-C),  
Seite 153

For the public prior use E2 - PROTOS 80C:

E2-A: Service Manual PROTOS 80C, 01/2008

E2-F: Ersatzteilkatalog mit der Bezeichnung MEK.  
0000318072000010.0183MAX. 00

E2-G: Auszug aus Ersatzteilkatalog (vgl. Dokument E2-F), Seite 123

Additionally four witnesses (Christian Schmid, Manfred Folger, Alexander Gansewig, Peter Furrer) were heard.

IV. Oral proceedings were held before the Board on 27 October 2021.

V. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted, or in the alternative, that the patent be maintained in the form found allowable by the opposition division. Since the patent proprietor is the sole appellant, the patent as maintained by the opposition division cannot be challenged (*reformatio in peius*).

The respondent (opponent) requested that the appeal be dismissed or, in case the decision of the opposition division be set aside, that the case be remitted to the opposition division for further prosecution.

VI. Claim 1 and claim 5 of the main request (patent as granted) read as follows:

**Claim 1:**

A cleaning system of a drum conveyor of a filter segment feeding apparatus in the tobacco industry wherein a transport drum (3) comprises a plurality of discs (4) on the circumferential surface of which concavities (5) are formed, whereas the concavities of individual discs (4) are positioned relative to one another so that together they form receiving channels (6) for filter rods (1), where in the said channels (6) the filter rods (1) are

transported during cutting,  
whereas the peripheries of adjacent discs (4) do not  
contact one another and in this way they form  
circumferential grooves (9),  
characterized in that  
the discs (4) have passages (12) discharging the dirt,  
the circumferential grooves (9) have a connection with  
the passages (12) discharging the dirt, and in addition  
the system comprises a vacuum channel (15) receiving  
the dirt having a connection with the passages (12)  
discharging the dirt in the discs (4).

**Claim 5:**

A method of cleaning a drum conveyor of a filter  
segment feeding apparatus in the tobacco industry  
wherein a transport drum (3) comprises a plurality of  
discs (4) on the circumferential surface of which  
concavities (5) are formed  
whereas the concavities of the individual discs (4) are  
positioned relative to one another so that together  
they form channels (6) receiving the filter rods (1),  
where in the said receiving channels (6) the filter  
rods (1) are transported during cutting,  
whereas the borders of adjacent discs (4) do not  
contact one another and in this way they form  
circumferential grooves (9), characterized in that  
the dirt being formed during cutting of the filter rods  
(1) is discharged by vacuum to the circumferential  
grooves (9), next  
the dirt is discharged by vacuum to discharging  
passages (12) made in the discs (4), and then  
the dirt is discharged by vacuum to channels (15)  
receiving the dirt.

VII. The appellant's (patent proprietor's) arguments  
relevant to the present decision may be summarized as

follows:

*Public availability of E1 and E2*

The assumption made by the opposition division with respect to the lack of confidentiality in purchase contracts was without factual basis. The witnesses admitted that they did not have knowledge of sales contract details (Chr. Schmidt, S. 27/40, bottom, ff; H.-P. Furrer, S. 23/25). It was usual business practice in the tobacco industry to maintain secrecy and therefore at least a tacit confidentiality between the seller and the customer could be assumed. Witness testimony of an account manager of Philip Morris was offered to give evidence as to typical business practice and training of personnel in the tobacco industry.

The documents E1-A, E1-C, E2-A and E2-F included a confidentiality clause on the back side of their respective cover sheet reading: "Diese Unterlagen sind urheberrechtlich geschützt. Sie werden nur zur persönlichen Information überlassen und dürfen weder kopiert, noch vervielfältigt, noch Dritten ausgehändigt oder zugänglich gemacht werden..." and "Furthermore, the copying or reproduction of these documents, or any other form of provision whatsoever to third parties is not permitted". Even if these documents were not treated with confidentiality in practice, as appears from the statement of the witnesses (A. Gansewig, page 14/19, Chr. Schmidt, page 29/40), the manuals and spare part catalogues were very well under confidentiality obligation. Their content was thus only available for the customer - bound by a secrecy agreement - and not to third parties representing the public.

No detail on the inside mechanisms of the cutting drum of the sold machines MULFI-E and PROTOS 80C was available to third parties (the public), as these could only perform an outer inspection of the machine. The claimed features were hidden from view in the interior of the machines as confirmed by the witness (Chr. Schmidt, page 35/40) and therefore not publicly available.

As all evidence of the alleged prior uses lay with the opponent, the standard of proof had to be "beyond any reasonable doubt". In particular, there was at least reasonable doubt as to the public availability of the service manuals and spare part catalogues.

*Novelty*

When looking at the machines Mulfi-E and the Protos 80C from the outside, it might be deduced that the cutting drums thereof comprised a suction mechanism for holding the filter rods in the flutes. This mechanism was neither intended nor suitable for cleaning. Yet further, the suction to hold rods had to be well defined in strength and timing while the force needed for suction of dirt depended on an amount of dirt to be sucked. Therefore the skilled person would not jeopardize a good reliably working retention mechanism by combining it with suction of dirt.

- VIII. The respondent (opponent) referred to the reasons in the decision of the opposition division and added the following arguments with regard to public availability:

From the testimony of Chr. Schmidt (page 3/40) and H.-P. Furrer (page 7/25) it was clear that both machines, the Mulfi-E and the PROTOS 80C, were standard machines.



Chr. Schmidt explicitly stated that there was no secrecy agreement when he installed the MULFI-E (page 37/40). H.-P. Furrer stated the same for the sale of the PROTOS 80C (page 14/25). With the unconditional sale, the machines including the internal features thereof were made publicly available.

The passages in E1-A, E1-C, E2-A and E2-F referred to by the patent proprietor as being a confidentiality clause merely indicated that the documents were covered by copyright. According to T2056/13 (see also Case Law of the Board of Appeal of the EPO, I.C.3.4.3), a copyright notice normally does not imply an obligation to maintain secrecy.

## **Reasons for the Decision**

### **1. Public availability**

The Board judges that the machines MULFI-E and PROTOS 80C as disclosed in E1-A, E1-C, E2-A and E2-G were made publicly available before the priority date of the patent in suit.

#### **1.1 Unconditional sale**

1.1.1 The sale prior to the priority date of the contested patent of the machines MULFI-E and PROTOS 80C delivered together with the respective documents E1-A, E1-C, E2-A and E2-G is not contested. According to established case law, a single sale is sufficient to render an article sold available to the public within the meaning of Article 54(2) EPC provided the buyer is not bound by an obligation to maintain secrecy. The internal structure of the sold article also forms part of the

state of the art if it can be analysed and reproduced by the skilled person (see G1/92). Contrary to the appellant's (patent proprietor's) opinion, the Board does not see in the evidence on file (including the witnesses' testimonies) any indication that the sale of the MULFI-E or the PROTOS 80C machines have entailed an implicit or explicit confidentiality obligation. In this respect, the Board fully agrees with the reasons given in the impugned decision, chapters 14.1.5, 14.2.5. In particular, the Board shares the view of the Opposition Division that the fact that the sold machines were standard machines makes it unrealistic that a confidentiality clause was agreed upon.

- 1.1.2 Additionally both parties agreed that machines of different competitors were installed close to each other, that the service manuals were sold with the machines and that employees of all competitors usually had access to the machines at the customer's premises. If there had been a secrecy agreement, it would normally be expected that also the technicians of the machine manufacturers installing or maintaining the machines would have been made aware of the agreement. Accordingly, the technicians would normally not have free access to machines of other manufacturers and their respective service manuals.
- 1.1.3 Therefore the sale itself is evidence for public availability of the machines in question, including their internal structures.
- 1.1.4 With the statement of grounds of appeal, the appellant offered the witness testimony of an account manager of Philip Morris to give evidence as to typical business practice and training of personnel in the tobacco industry. This offer to take evidence cannot be taken

into consideration by the Board already in view of its lack of substantiation: the witness is not named, nor are her/his qualifications mentioned and exactly to what extent is it intended to prove the "usual business practice" in the tobacco industry to maintain secrecy. Moreover, offer is unrelated to the particular sale under discussion.

1.2 **Available information from the machine**

- 1.2.1 As the sale is found to be unconditional, the machine with its internal structure was made available to the customer representing the public.
- 1.2.2 The Board sees no undue burden for the skilled person, being e.g. a technician of the customer, to become aware of the internal structure of the machines. Indeed, in use, the transport drum with its plurality of discs needs to be cleaned regularly at the customer's premises. Therefore the plurality of discs may be disassembled whereby the internal structure relevant for the claimed subject-matter becomes visible (Chr. Schmidt, pages 32/40, 36/40).
- 1.2.3 The argument of the appellant (patent proprietor) that the public could gain information only by outer inspection and therefore the hidden interior of the machines was not made public is not convincing. The argument refers to the public as a third person besides the customer and the seller. As the customer already represents the public, it is irrelevant what kind of information a third person that can only carry out a visual inspection might gain.

**1.3 Manuals and spare part catalogues (E1-A, E1-C, E2-A, E2-F)**

1.3.1 As the sale of the machines is considered as an unconditional sale, the disputed public availability of the manuals and spare part catalogues E1-A, E1-C, E2-A, E2-F, would not be of relevance (see chapter 1.2 above). However, since the Opposition Division considered that these also were made available to the public and used these documents to establish the features of the sold machines, the following is noted by the Board.

1.3.2 Firstly, the manuals and spare part catalogues were sold together with the machine and therefore the information contained therein was also made available to the customer (being part of the public), even if these documents themselves could not be copied and/or given to third persons according to the clauses mentioned by the appellant (patent proprietor), which in the Board's view simply represent copyrights' statements.

1.3.3 Secondly, even if it were assumed that the manuals and spare part catalogues were not made public, they still can serve to determine the structure and features of the MULFI-E and the PROTOS 80C machines. The finding of the opposition division (chapter 14.1.2, 14.1.3, 14.2.2, 14.2.3) that the documents E1-A, E1-C, E2-A, E2-F correspond to the documents that were sent to the customer along with the machines MULFI-E and the PROTOS 80C was not disputed by the appellant.

## **2. Novelty**

- 2.1 The Board confirms the decision of the opposition division that the main request does not meet the requirements of Article 54 EPC.
- 2.2 During oral proceedings the appellant (patent proprietor) referred to the written submissions. Therefore the Board sees no reason to deviate from its preliminary opinion as set out in the communication annexed to the summons to oral proceedings, which is hereby confirmed and reads as follows:
- 2.3 The machine MULFI-E as well as the machine PROTOS 80C show all the features of claims 1 and 5 for the reasons given in the impugned decision, chapter 15. The structures and features of the machines can be determined from the manuals and spare part catalogues (E1-A, page 15-10, E1-D, E2-A, page 23-15, and E2-G).

The question if a skilled person would combine the cleaning function with the function of holding the rods by suction is irrelevant. The provided suction will automatically result in a certain amount of dirt being sucked, in accordance with the wording of claims 1 and 5, irrespective of the intended purpose in the sold machines of only providing suction for holding the rods.

## **Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated