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**Datasheet for the decision
of 12 December 2022**

Case Number: T 0931/21 - 3.2.07

Application Number: 16152509.2

Publication Number: 3053837

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Language of the proceedings: EN

Title of invention:
PACKAGING SYSTEM

Patent Proprietor:
Ishida Co., Ltd.

Opponents:
MULTIVAC Sepp Haggemüller SE & Co. KG
GEA Food Solutions Weert B.V.
Bizerba SE & Co. KG

Headword:

Relevant legal provisions:

EPC Art. 100(a), 54, 56, 111(1)

RPBA 2020 Art. 11

Keyword:

Novelty - main request (no) - auxiliary requests 1 and 2 (no)

Inventive step - auxiliary requests 3 and 4 (no)

Remittal - (yes) - special reasons for remittal

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0931/21 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 12 December 2022

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
15 April 2021 concerning maintenance of the
European Patent No. 3053837 in amended form.

Composition of the Board:

Chairman I. Beckedorf
Members: A. Cano Palmero
S. Watson

Summary of Facts and Submissions

- I. The patent proprietor and opponent 1 (appellants) lodged appeals within the prescribed period and in the prescribed form against the decision of the opposition division to maintain European patent No. 3 053 837 in amended form on the basis of the then auxiliary request 3.
- II. Three oppositions were filed, which were directed against the patent in its entirety and based on all grounds for opposition pursuant to Article 100 EPC.
- III. In preparation for oral proceedings, the Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA 2020.
- IV. In response to the communication under Article 15(1) RPBA 2020, the patent proprietor and opponent 1 submitted arguments with letters dated 12 October 2022 and 26 October 2022 respectively. The patent proprietor further submitted extracts from the Oxford Dictionary of English and the Oxford Advanced Learner's Dictionary in support of its arguments.
- V. Oral proceedings before the Board took place on 12 December 2022.

At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes thereof.

VI. The final requests of the parties are as follows,

for the patent proprietor

that the decision under appeal be set aside

and

that the patent be maintained as granted (**main request**),

or, in the alternative,

if the Board finds the main request to be novel,

that the case be remitted to the opposition

division for further prosecution,

or, in the alternative,

that the patent be maintained in amended form

according to the set of claims filed as **auxiliary**

request 1, filed during oral proceedings before the

opposition division proceedings as auxiliary

request "A" and re-filed with the patent

proprietor's statement of grounds of appeal,

or, in the alternative,

that the patent be maintained in amended form

according to the set of claims filed as **auxiliary**

request 2, filed during opposition proceedings as

auxiliary request 1 with letter of 3 December 2020

and re-filed with the patent proprietor's statement

of grounds of appeal,

whereby the main request and auxiliary requests 1

and 2 were decided upon in the decision under

appeal,

or, in the alternative,

that the appeal of opponent 1 be dismissed, *i.e.*

that the patent be maintained in the amended form

found by the opposition division to meet the

requirements of the EPC (**auxiliary request 3**, filed as auxiliary request 2 with letter of 3 December 2020),

or in the alternative,
in the event that auxiliary requests 1 to 3 were found not to be allowable, that the case be remitted to the opposition division for further prosecution of **auxiliary requests 4 to 10** filed during opposition proceedings as auxiliary requests 2a, 3, 3a, 4, 4a, 5 and 5a with letter of 3 December 2020 and re-filed with the patent proprietor's statement of grounds of appeal;

or, if the case not be remitted to the opposition division for further prosecution,
that the patent be maintained in amended form according to one of the sets of claims filed as **auxiliary requests 4 to 10**.

for opponent 1
that the decision under appeal be set aside
and
that the patent be revoked;

for opponents 2 and 3 (respondents)
that the patent proprietor's appeal be dismissed.

VII. The lines of argument of the parties relevant for the present decision are dealt with in detail in the reasons for the decision and address the following issues:

- novelty of the subject-matter of claim 1 of the main request, as well as auxiliary requests 1 and 2 in view of document E1 (**US 8,393,133 B2**),

- inventive step of the subject-matter of claim 1 of auxiliary requests 3 and 4 in view of E1 alone or in combination with common general knowledge,
- remittal of the case to the opposition division for further prosecution based on auxiliary requests 5 to 10.

VIII. Claim 1 of the main request (*i.e.* according to the patent as granted) reads as follows:

"A method of packaging an article to be packaged in an optimal state by connecting an external server (SV) to a plurality of packaging apparatuses (1) via a network, wherein each packaging apparatus of the plurality of packaging apparatuses includes a communication unit configured to communicate with the external server and download the control parameters, a storage unit configured to store the control parameters downloaded by the communication unit, and a control unit configured to control a packaging operation on the basis of the control parameters stored in the storage unit, the method comprising the steps of:

storing, by the external server (SV), control parameters for the packaging apparatuses to package an article to be packaged in an optimal state;
communicating, by a communication unit (90) of a packaging apparatus (1) of the plurality of packaging apparatuses (1), with the external server (SV) and downloading, by said communication unit (90), the control parameters;
storing, by a storage unit (9b) of the packaging apparatus (1), the control parameters downloaded by the communication unit (90); and
controlling, by a control unit (9c) of the packaging apparatus (90), a packaging operation on

the basis of the control parameters stored in the storage unit (9b); **characterised in that** the method further comprises the steps of:

when control parameters for packaging by using a new commodity, a new tray, or a new film are newly set and registered in any packaging apparatus (1) among the plurality of packaging apparatuses (1), uploading, by the communication unit (90) of the corresponding packaging apparatus (1), information regarding the article to be packaged and the control parameters to the external server (SV); and sharing the control parameters which are uploaded by the plurality of packaging apparatuses (1)."

IX. Claim 1 of auxiliary request 1 reads as follows (additions with respect to claim 1 of the patent as granted being underlined by the Board):

"A method of packaging an article to be packaged in an optimal state by connecting an external server (SV) to a plurality of packaging apparatuses (1) provided in stores, via a network, wherein each packaging apparatus of the plurality of packaging apparatuses includes a communication unit configured to communicate with the external server and download the control parameters, a storage unit configured to store the control parameters downloaded by the communication unit, and a control unit configured to control a packaging operation on the basis of the control parameters stored in the storage unit, the method comprising the steps of:

storing, by the external server (SV), control parameters for the packaging apparatuses to package an article to be packaged in an optimal state;

communicating, by a communication unit (90) of a packaging apparatus (1) of the plurality of packaging apparatuses (1), with the external server (SV) and

downloading, by said communication unit (90), the control parameters;

storing, by a storage unit (9b) of the packaging apparatus (1), the control parameters downloaded by the communication unit (90); and

controlling, by a control unit (9c) of the packaging apparatus (90), a packaging operation on the basis of the control parameters stored in the storage unit (9b); characterised in that the method further comprises the steps of:

when control parameters for packaging by using a new commodity, a new tray, or a new film are newly set and registered in any packaging apparatus (1) among the plurality of packaging apparatuses (1) provided in stores, uploading, by the communication unit (90) of the corresponding packaging apparatus (1), information regarding the article to be packaged and the control parameters to the external server (SV); and sharing the control parameters which are uploaded by the plurality of packaging apparatuses (1)."

- X. Claim 1 of auxiliary request 2 reads as follows (additions with respect to claim 1 of the patent as granted being underlined by the Board):

"A method of packaging an article to be packaged in an optimal state by connecting an external server (SV) to a plurality of packaging apparatuses (1) via a network, wherein each packaging apparatus of the plurality of packaging apparatuses includes a communication unit configured to communicate with the external server and download the control parameters, a storage unit configured to store the control parameters downloaded by the communication unit, and a control unit configured to control a packaging operation on the basis of the control parameters stored in the storage

unit, the method comprising the steps of:

storing, by the external server (SV), control parameters for the packaging apparatuses to package an article to be packaged in an optimal state;

communicating, by a communication unit (90) of a packaging apparatus (1) of the plurality of packaging apparatuses (1), with the external server (SV) and downloading, by said communication unit (90), the control parameters;

storing, by a storage unit (9b) of the packaging apparatus (1), the control parameters downloaded by the communication unit (90); and

controlling, by a control unit (9c) of the packaging apparatus (~~90~~1), a packaging operation on the basis of the control parameters stored in the storage unit (9b); characterised in that the method further comprises the steps of:

when new control parameters for packaging by using a new commodity, a new tray, or a new film are newly set and registered in any packaging apparatus (1) among the plurality of packaging apparatuses (1), uploading, by the communication unit (90) of the corresponding packaging apparatus (1), information regarding the article to be packaged and the new control parameters to the external server (SV); and sharing the new control parameters which are uploaded by the plurality of packaging apparatuses (1)."

XI. Claim 1 of auxiliary request 3, *i.e.* according to the version found by the opposition division to meet the requirements of the EPC, reads as follows (additions with respect to claim 1 of the patent as granted being underlined by the Board):

"A method of packaging an article to be packaged in an optimal state by connecting an external server (SV) to

a plurality of packaging apparatuses (1) via a network, wherein each packaging apparatus of the plurality of packaging apparatuses includes a communication unit configured to communicate with the external server and download the control parameters, a storage unit configured to store the control parameters downloaded by the communication unit, and a control unit configured to control a packaging operation on the basis of the control parameters stored in the storage unit, the method comprising the steps of:

storing, by the external server (SV), control parameters for the packaging apparatuses to package an article to be packaged in an optimal state;

communicating, by a communication unit (90) of a packaging apparatus (1) of the plurality of packaging apparatuses (1), with the external server (SV) and downloading, by said communication unit (90), the control parameters;

storing, by a storage unit (9b) of the packaging apparatus (1), the control parameters downloaded by the communication unit (90); and

controlling, by a control unit (9c) of the packaging apparatus (~~90~~1), a packaging operation on the basis of the control parameters stored in the storage unit (9b); characterised in that the method further comprises the steps of:

when control parameters for packaging by using a new commodity, a new tray, or a new film are newly set and registered in any packaging apparatus (1) among the plurality of packaging apparatuses (1), uploading, by the communication unit (90) of the corresponding packaging apparatus (1), information regarding the article to be packaged and the control parameters to the external server (SV); and sharing the control parameters which are uploaded by the plurality of packaging apparatuses (1), wherein the communication

unit of each of the plurality of packaging apparatuses (1) communicates with the external server (SV) regularly or each time when the apparatus (1) is started up in order to download the new control parameters."

XII. Claim 1 of auxiliary request 4 reads as follows (additions with respect to claim 1 of the patent as granted being underlined by the Board):

"A method of packaging an article to be packaged in an optimal state by connecting an external server (SV) to a plurality of packaging apparatuses (1) via a network, wherein each packaging apparatus of the plurality of packaging apparatuses includes a communication unit configured to communicate with the external server and download the control parameters, a storage unit configured to store the control parameters downloaded by the communication unit, and a control unit configured to control a packaging operation on the basis of the control parameters stored in the storage unit, the method comprising the steps of:

storing, by the external server (SV), control parameters for the packaging apparatuses to package an article to be packaged in an optimal state;

communicating, by a communication unit (90) of a packaging apparatus (1) of the plurality of packaging apparatuses (1), with the external server (SV) and downloading, by said communication unit (90), the control parameters;

storing, by a storage unit (9b) of the packaging apparatus (1), the control parameters downloaded by the communication unit (90); and

controlling, by a control unit (9c) of the packaging apparatus (901), a packaging operation on the

basis of the control parameters stored in the storage unit (9b); characterised in that the method further comprises the steps of:

when new control parameters for packaging by using a new commodity, a new tray, or a new film are newly set and registered in any packaging apparatus (1) among the plurality of packaging apparatuses (1), uploading, by the communication unit (90) of the corresponding packaging apparatus (1), information regarding the article to be packaged and the new control parameters to the external server (SV); and sharing the new control parameters which are uploaded by the plurality of packaging apparatuses (1), wherein the communication unit of each of the plurality of packaging apparatuses (1) communicates with the external server (SV) regularly or each time when the apparatus (1) is started up in order to download the new control parameters."

Reasons for the Decision

Patent proprietor's appeal

1. *Patent as granted (main request) - novelty, Articles 100(a) and 54 EPC*
- 1.1 The patent proprietor objected in point B.2 of its statement of grounds of appeal to the findings of the opposition division of point 2.3.2 of the reasons for the decision under appeal that claim 1 according to the patent as granted lacked novelty in view of document E1 (**US 8,393,133 B2**). In particular, the patent proprietor argued that E1 fails to disclose features

1L, 1M and 1N (see statement of grounds of appeal of the patent proprietor, point B.2.1.4).

1.2 With regard to feature 1L, which reads

"when control parameters for packaging by using a new commodity, a new tray, or a new film are newly set and registered in any packaging apparatus among the plurality of packaging apparatuses"

the patent proprietor argued in point B.2.1.1 of its statement of grounds of appeal that E1 does not disclose that control parameters are **newly** set by using a **new** commodity, a **new** tray or a **new** film, as required by claim 1 as granted.

1.2.1 In particular, the patent proprietor argued that an **"initial set-up"** or set of predefined wrap parameters as defined in E1 as "wrapbox" does not fall within the meaning of **"newly set parameters"** according to claim 1 as granted, so that the findings of the opposition division with respect to the patent as granted are incorrect. Additionally, the patent proprietor concurred with the conclusion reached by the opposition division in point 3.4.2 of the reasons of the decision under appeal with respect to the then auxiliary request 1 (in combination with the feature "in a store"), that an **"editing"** of wrap parameters as described in E1, column 2, lines 47 to 62 cannot be considered as equivalent to the claimed control parameters being **"newly set"** for a new commodity, new film or a new tray (see point B.2.1.3, page 8 and page 9, fourth paragraph of the patent proprietor's statement of grounds of appeal). In particular, the patent proprietor indicated that it is apparent for the skilled person from paragraphs [0015] and [0066] to

[0070] of the patent in suit, that the term "newly set" for control parameters is to be understood in the sense of a "creation" of these parameters. The mere calibration of a previously installed parameter, as might be the case in E1, does not anticipate the subject-matter of claim 1 as granted.

- 1.2.2 The Board is not convinced by the patent proprietor's arguments and rather agrees with the opponents (see reply of opponent 1, page 6, first full paragraph and reply of opponent 3, page 6, second paragraph) that an editing of the wrap parameters as described in column 2, lines 47 to 59 of E1 falls within the meaning of the control parameters being newly set as claimed.

Indeed, the Board is convinced that the term "editing" (as in E1) is a particular case of newly "setting" (as in the patent as granted), so that the feature that control parameters are newly set is anticipated by the controller configured to permit wrap parameters to be edited as in E1.

- 1.3 The patent proprietor further argued that even in the case that E1 disclosed that the control parameters are newly set, E1 does not provide any information on how this is done. In particular E1 fails to anticipate that setting takes place in any wrapping apparatus, as required by the subject-matter of claim 1 as granted.

- 1.3.1 The Board disagrees. As correctly argued by opponent 1, document E1 specifies in column 1, lines 48 to 50, that the appropriate set of wrapping parameters are determined with the use of one wrapping machine. Furthermore, column 2, lines 53 to 54, specifies that the editing is done via the user interfaces which are part of the wrapping machines as indicated in column 2,

lines 38 to 41, of E1. The Board has thus no doubts that E1 anticipates that the newly setting and registering of the control parameters takes place in the wrapping machines.

1.4 With respect to features 1M and 1N, which concern the uploading and sharing of the control parameters defined in feature 1L, the patent proprietor indicated in point B.2.1.2 of its statement of grounds of appeal that these features are also inherently missing from E1 since E1 fails to disclose feature 1L.

1.4.1 The patent proprietor also argued on page 9, paragraph 7, to page 10, paragraph 3, of its statement of grounds of appeal that the disclosure of the so-called "exception wrapboxes" in column 2, lines 12 to 29, of E1 forms a different embodiment/aspect of E1 to the transfer of edited wrapping parameters described in column 2, lines 47 to 59, so that there is no direct and unambiguous disclosure in E1 that exception wrapboxes are edited or newly set according to feature 1L, or uploaded to an external server, as required by feature 1M or that uploaded exception wrapboxes are shared, as required by feature 1N of claim 1 as granted. In addition, in column 2, lines 47 to 59, of E1, only wrap parameters are referred to, but no information is given regarding the article to be wrapped as required by feature 1M.

1.4.2 The Board is not persuaded by the arguments of the patent proprietor and rather follows the view of the opponents that the opposition division based its findings on the whole disclosure of E1. Indeed, E1 firstly makes a general definition of the "wrapboxes" as a set of wrap parameters to be stored in the wrapping machines for each tray size and other tray

characteristics (see E1, column 1, lines 32 to 35). E1 also foresees so-called "exception wrapboxes", which contain information on the article to be wrapped and are generated when a specific item needs to be wrapped differently than other items using the same tray size, *i.e.* by using a new commodity in the sense of claim 1 according to the patent as granted (see E1, column 2, lines 12 to 29, and column 4, lines 61 to 63).

1.4.3 The skilled reader does not have any indication from the disclosure of E1, that the particular case of "exception wrapboxes" is to be treated differently than the general "wrapboxes" and therefore be excluded from being edited, communicated and uploaded to other machines as foreseen in column 2, lines 53 to 62, of E1. On the contrary, the skilled person derives from column 1, lines 48 to 50, of E1 that once the appropriate set of wrapping parameters (which applies to any kind of wrapboxes) have been determined, these are desirably transferred to other machines.

1.5 The Board thus concludes that opponents 1 and 3 have provided convincing arguments that E1 discloses all features of claim 1 as granted including features 1L, 1M and 1N, so that the subject-matter of claim 1 lacks novelty.

2. *Auxiliary request 1 - novelty, Article 54 EPC*

2.1 Claim 1 of auxiliary request 1 corresponds to claim 1 of the patent as granted with the additional requirement that the plurality of packaging apparatuses are "provided in stores".

2.2 The opposition division found in point 3.4.2 of the reasons for the decision under appeal that the subject-

matter of claim 1 of auxiliary request 1 was new, since "there is no clear teaching in E1 that the production site has a store. A fabrication site, where potential customers may view a prototype apparatus is not considered to be a store." Furthermore, the opposition division did not find a teaching in E1 of wrapboxes being newly set in an apparatus in a store, but rather only the possibility of "editing" control parameters in a store.

2.3 The patent proprietor substantially agreed with the reasoned findings of the opposition division. In addition, the patent proprietor indicated that the skilled person commonly understands that a "shop" is meant by the term "store". This interpretation is also supported by paragraph [0020] of the patent in suit. The patent proprietor further argued that E1 does not only fail to disclose "store" at all, but also fails to disclose that the creation of control parameters takes place in such a store.

2.4 The Board does not agree with the finding of the opposition division and is of the view, in line with the view of the opponents, that E1 anticipates the subject-matter of claim 1 of auxiliary request 1.

2.4.1 The Board has doubts as to the limiting character of the term "store", which is so broad that it encompasses many kinds of location. In this sense, as correctly indicated by the opponents, E1 already foresees in column 7, lines 9 to 16, "e.g., multiple wrapping machines at the same or different locations ... for transferring the settings data from one machine to another". In addition, column 1, lines 40 to 43, explicitly discloses that the machines are located "within a given store and/or store chain", so that the

newly added feature that the packaging apparatuses are provided in stores is anticipated by E1. As already discussed in point 1.3.1 above for claim 1 of the patent as granted, the step of newly setting the control parameters in E1 takes place in the wrapping machines. Since such machines are in a given store, the Board concurs with the opponents that not only the sharing, but also the new setting of control parameters takes place in such given stores in accordance with the subject-matter of claim 1 of auxiliary request 1.

2.5 It follows that the opponents have convincingly demonstrated that E1 anticipates the subject-matter of claim 1 according to auxiliary request 1.

3. *Auxiliary request 2 - novelty, Article 54 EPC*

3.1 Claim 1 of auxiliary request 2 corresponds to claim 1 of the patent as granted whereby the control parameters in the characterising portion of the claim have been amended to be "new" control parameters.

3.2 The opposition division concluded in point 4.1 of the reasons for the decision under appeal that the amendments did "not change the subject-matter of claim 1 with respect to the subject-matter of claim 1 as granted. As such, the amendments made are purely of clarifying character and fail to overcome any ground of opposition as required by Rule 80 EPC". The opposition division thus did not admit auxiliary request 2 into the proceedings.

3.3 The patent proprietor contests this finding and is of the view in point D. of its statement of grounds of appeal that by restricting the control parameters to "new" control parameters, these are explicitly

distinguished from pre-existing default control parameters and from edited wrap parameters as disclosed in E1, column 2, lines 47 to 62 which are not "created from scratch" as claimed but instead are modified versions of pre-existing parameters.

3.4 The Board is not persuaded by the view of the patent proprietor and concurs with the opponents that the control parameters edited via the user interface or forming part of exception wrapboxes according to E1 are to be considered as new control parameters, since they differ from the standard control parameters. It follows that the additional feature does not render the subject-matter of claim 1 according to auxiliary request 2 new in view of E1, so that the requirements of Article 54 EPC are not met.

3.5 In view of this conclusion of the Board, it is not necessary to consider the admittance of this request under Article 12(6), first sentence, RPBA 2020, nor to review the exercise of discretion of the opposition division to not admit auxiliary request 2 into the proceedings based on Rule 80 EPC nor the question of convergence raised by opponent 3 in point 7 of its reply to the patent proprietor's appeal.

4. As a consequence of the above, the patent proprietor's appeal is to be dismissed.

Appeal of opponent 1

5. *Patent as maintained by the opposition division (auxiliary request 3) - inventive step, Article 56 EPC*

5.1 Claim 1 in the form held by the opposition division to meet the requirements of the EPC corresponds to claim 1

of the patent as granted, whereby the following feature has been added at the end of the claim:

"...wherein the communication unit of each of the plurality of packaging apparatuses (1) communicates with the external server (SV) regularly or each time when the apparatus (1) is started up in order to download the new control parameters."

5.2 With its statement of grounds of appeal (see point 4), opponent 1 argued that the subject-matter of claim 1 is not novel over E1, or not inventive in view of E1 as closest prior art in combination with the common general knowledge or in combination with the teaching of E2/E2a (**EP 1 880 820 B1/US 7,299,103 B1**).

5.3 The opposition division found in point 5.2.2 of the reasons for the decision under appeal that the term "regularly" was to be understood as "periodically" and it was clear for the skilled person that the communication happens at "set intervals". In point 5.3.2.1, the opposition division held that the subject-matter of claim 1 according to the then auxiliary request 3 differs from document E1 "in the underlying idea of downloading data at pre-defined points of time", solving the objective technical problem of providing a more reliable update of the packaging apparatuses of E1. Starting from E1 and in view of the objective technical problem, the opposition division considered that E1 gave no hint to the skilled person to arrive at the solution of claim 1, so that its subject-matter was not obvious in view of E1 alone (see point 5.3.2.1.1 of the reasons). Furthermore, even in combination with E2/E2a, there is no hint for the

skilled person of a communication made "periodically" as required by the claim under the opposition division's interpretation of "regularly" (see point 5.3.2.1.2 of the reasons).

- 5.4 The patent proprietor, making reference to the dictionary extracts filed with letter of 12 October 2022, argued in addition that the term "regularly" requires that the downloading of data takes place repeatedly, *i.e.* at least more than once. This cannot be derived from the teaching of E1 specially because if no editing takes place, then no communication takes place either.
- 5.5 Furthermore, the patent proprietor indicated that in contrast to document E1, where the information is "pushed" *ad hoc* from the server to the packaging apparatuses, in auxiliary request 3 it is the communication unit of each of the packaging apparatuses which is "pulling" the information from the server.
- 5.6 These distinguishing features result in a more efficient and reliable sharing of information, since all new parameters can be automatically downloaded in batches. The skilled person, starting from E1 as closest prior art which shares the information in a rather sporadic and not regular way, would only arrive at the subject-matter of claim of auxiliary request 3 exercising inventive skills.
- 5.7 The Board disagrees with these reasoned findings of the opposition division and with the view of the patent proprietor for the following reasons.
- 5.7.1 Firstly, the Board finds the interpretation made by the opposition division of the term "regularly" (*i.e.* to be

understood as "periodically" or "at pre-defined points of time") quite restrictive and not duly justified. As has been indicated by the patent proprietor in point D. 2.2 of its reply to the statement of grounds of appeal of opponent 1, the text of the patent does not support any departure from the standard meaning of the term "regularly" in English.

The Board agrees with opponent 1 that this term does not necessarily require a certain constant time interval between consecutive communication steps. This is also confirmed by the dictionary extracts provided by the patent proprietor with its letter of 12 October 2022, which also provides the meaning of "regularly" as being merely "often".

5.7.2 Secondly, E1 discloses in column 1, lines 48 to 50, that it is desirable to transfer the list of wrapboxes to other machines once the appropriate set of wrapping parameters has been determined with the use of one machine. Column 2, lines 52 to 58, discloses that a sharing of wrap parameters can be carried out when a new set of parameters is edited. In view of this, the Board is convinced, in line with the arguments presented by opponent 1 in pages 5 and 6 of its statement of grounds of appeal, that it would be illogical and contrary to the purpose and teaching of E1 that in the event that a new set of wrapping parameters is edited for a particular configuration, these parameters are not shared promptly with the other wrapping machines.

5.7.3 In addition, the Board cannot share the view of the patent proprietor that this sharing of the new parameters in E1 could occur only once, so that it does not happen "regularly". As discussed above, the skilled

person derives from E1 that wrap parameters are shared every time that a new set of parameters is edited. The Board is of the view that the skilled person, in view of the whole technical teaching of E1, cannot understand this sharing as being a single one-time occurrence.

- 5.7.4 Furthermore, contrary to the view of the patent proprietor, claim 1 of auxiliary request 3 does not require that the communication unit of each of the packaging apparatuses "pulls" the data from the external server, but merely that a communication is established between the communication units and the external server, which covers a communication in both directions and definitely the sharing of new edited parameters as disclosed in document E1.
- 5.7.5 In view of this, the Board is of the view that a communication between the communication unit of each of the plurality of the packaging apparatuses and the external server which takes place "regularly" is, if not implicitly disclosed, at least obvious in view of E1 alone so that the subject-matter of claim 1 according to auxiliary request 3 does not meet the requirements of at least Article 56 EPC.
- 5.8 In view of this conclusion of the Board, it is not necessary to address the rest of the objections raised by opponent 1 in its statement of grounds of appeal regarding lack of clarity, added subject-matter and lack of inventive step in view of the teachings of E1 in combination with E2/E2a. As for the question of convergence raised by opponent 3 in point 7 of its reply, the Board notes that this objection cannot be taken into account considering that this request corresponds to the set of claims which in the impugned

decision was held to meet the requirements of the EPC and opponent 3 did not file an appeal, *i.e.* it did not formally challenge this request.

5.9 It follows that opponent 1 has provided convincing arguments that demonstrate the incorrectness of the reasoned findings of the opposition division as regards inventive step of auxiliary request 3, so that **the decision under appeal is to be set aside.**

6. *Auxiliary request 4 - inventive step, Article 56 EPC*

6.1 The following findings on auxiliary request 4 correspond to the view of the Board which was communicated to the parties with the communication pursuant to Article 15(1) RPBA 2020 (see point 13 thereof). The parties did not comment on this preliminary opinion, neither in writing nor at the oral proceedings. After having reconsidered all relevant legal and factual aspects of the case, the Board does not see any reason to deviate from its preliminary opinion and concludes that the subject-matter of claim 1 of auxiliary request 4.

6.2 The amendments carried out in auxiliary request 4 are a combination of the amendments of auxiliary requests 2 and 3. The Board, in its communication pursuant to Article 15(1) RPBA 2020 (see point 13 thereof) substantially followed the position of opponent 1 in point 6 of its reply to the patent proprietor's statement of grounds of appeal, that the subject-matter of claim 1 according to auxiliary request 4 lacked inventive step in view of E1 alone, for the same reasons as for auxiliary requests 2 and 3, see points 3 and 4 above. This conclusion has been reached taking into account the submissions of all parties in appeal

proceedings, so that there are no special reasons that could justify a remittal of the case to the opposition division based on this request, as requested by the patent proprietor.

6.3 In view of this conclusion of the Board, it is not necessary to address the fulfilment of Rule 80 EPC of this request, as raised by opponent 1. The question of convergence raised by opponent 3 in point 7 of its reply cannot be taken into account as this request was filed and maintained in the proceedings leading to the impugned decision and opponent 3 did not file an appeal against the decision.

7. *Auxiliary requests 5 to 10 - Remittal of the case to the opposition division for further prosecution, Articles 111(1) EPC and 11 RPBA*

7.1 The Board is aware that, according to Article 11 RPBA 2020, a remittal for further prosecution should only be undertaken, exceptionally, when special reasons apply.

7.2 In the present case, opponent 1 contested the admittance of auxiliary requests 5 to 10 into the appeal proceedings and additionally raised substantive objections specific to these requests based on at least Articles 84 and 123(2) EPC (see points 7 to 12 its reply to the patent proprietor's statement of grounds of appeal). The patent proprietor did not react to these specific objections.

7.3 The patent proprietor however submitted arguments relating to novelty and inventive step of the subject-matter of claims of auxiliary requests 5 to 10 (see points F.2 to F.7 of the patent proprietor's statement of grounds of appeal), and opponent 1 did not provide

any counter-arguments on these points. The objections raised against novelty and inventive step for the higher-ranking requests do not *prima facie* appear to apply to the subject-matter of the claims according to auxiliary requests 5 to 10.

- 7.4 Therefore neither the patent proprietor nor opponent 1 have addressed the submissions and/or objections presented by the other party relating specifically to auxiliary requests 5 to 10.

Since in addition the decision under appeal did not deal with these requests, the Board cannot come to a decision regarding further patentability requirements such as, but not limited to, clarity, added subject-matter, novelty and inventive step of auxiliary requests 5 to 10 on the basis of the current appeal case alone.

- 7.5 Against this background, after considering all the relevant circumstances of the case at hand, the Board comes to the conclusion that the relevant issues in the present case for auxiliary requests 5 to 10 could not be decided upon without undue burden (cf. explanatory notes to Article 11 RPBA 2020, Supplementary publication 2 - OJ EPO 2020, 46, 54).

- 7.6 Consequently, the Board is convinced that there are special reasons within the meaning of Article 11, first sentence, RPBA 2020 that apply. Moreover, since all parties agreed at the oral proceedings before the Board that the case be remitted under these circumstances, the Board finds it appropriate to remit the present case to the opposition division for further prosecution of the auxiliary requests 5 to 10, in accordance with Article 111(1) EPC.

Order

For these reasons it is decided that:

1. The appeal of the patent proprietor is dismissed.
2. The decision under appeal is set aside.
3. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated