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**D E C I S I O N**  
**of 4 October 2001**

**Case Number:** T 0033/99 - 3.2.4

**Application Number:** 92202436.9

**Publication Number:** 0526950

**IPC:** B65B 7/28

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for closing a packing

**Patentee:**

METALTECH V.O.F

**Opponent:**

Alcan Deutschland GmbH

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 55(1)(a), 54, 111(1)

**Keyword:**

"Evident abuse - no"

"Public prior use - yes"

"Novelty - first auxiliary request - yes"

"Remittal to first instance"

**Decisions cited:**

G 0003/98, G 0002/99, T 0472/92

**Catchword:**

-



**Case Number:** T 0033/99 - 3.2.4

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.4**  
**of 4 October 2001**

**Appellant:** METALTECH V.O.F  
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**Respondent:** Alcan Deutschland GmbH  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 27 October 1998  
revoking European patent No. 0 526 950 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** C. A. J. Andries  
**Members:** M. G. Hatherly  
C. Holtz  
R. E. Gryc  
H. Preglau

## Summary of Facts and Submissions

I. The opposition division's decision to revoke European patent No. 0 526 950 (resulting from European patent application number 92 202 436.9 filed on 6 August 1992 with a priority date of 7 August 1991) was posted on 27 October 1998.

On 6 January 1999 the patentee filed an appeal against this decision and paid the appeal fee, filing the statement of grounds on 8 March 1999.

II. The documents that played a role in the appeal proceedings

D2: EP-A-0 209 890

D6: Brochure "OHLER® Packaging machines - Hand closing machine Type D", Alcan Deutschland GmbH, marked "9/88" (filed by the respondent as annex HEP 6 to the notice of opposition)

D7: Instruction sheet "OHLER® Handverschließgerät Type D3", Alcan Deutschland GmbH, no date (filed by the respondent as annex HEP 7)

D8: Bill from Meinerzhagener Druck und Verlagshaus to Alcan Deutschland GmbH dated 27.12.90 for printing 550 copies of D7 (submitted by respondent as annex HEP 8)

D9: Brochure "OHLER® Verpackungs-Anlagen - Handverschließgerät Type D", Alcan Deutschland GmbH, marked "Stand: 9/88"

D10: Brochure "OHLER® Verpackungs-Anlagen -  
Handverschließgerät Type D 5.2", Alcan Deutschland  
GmbH, not prior art

III. The opposition division revoked the patent after finding an allegation of public prior use proven, namely that in April 1991 on the CEBAL stand at the MACROPAK 91 packaging fair at Utrecht in the Netherlands, Mr Herber showed Mr Heitkamp an apparatus as shown in the patent without obliging Mr Heitkamp to secrecy.

The appellant (patentee) maintained that if a visitor to the fair had tried to use the apparatus or if Mr Herber had demonstrated it, then this would have been an evident abuse in relation to the patentee and should not be taken into account since the patent's priority date of 7 August 1991 was less than six months after the packaging fair (Article 55(1)(a) EPC).

The opposition division considered that the period of six months referred to in Article 55(1) EPC applied to the actual filing date not the priority date and that, since the filing date of 6 August 1992 was more than six months after the packaging fair, Article 55(1)(a) EPC could not be applicable.

While this was disputed by the appellant in the statement of grounds of appeal, the board pointed out in its communication of 29 June 2001 that the Enlarged Board of Appeal decisions G 3/98 (OJ EPO, 2001, 062) and G 2/99 (OJ EPO, 2001, 083) had found that the relevant date was indeed the date of the actual filing of the European patent application and not the date of priority. The board thus considered that evident abuse

could not be a defence in the present case.

On 4 October 2001 oral proceedings took place before the board during which the appellant stated that it would not present any further arguments on evident abuse.

- IV. During these oral proceedings the appellant withdrew its previous requests that the witness Mr Heitkamp be heard on oath by a competent German court and that oral evidence relied upon in the appeal proceedings be considered only to the extent given under oath.
  
- V. A main request and four auxiliary requests from the appellant were on file at the start of the oral proceedings on 4 October 2001.

The **main request** was for the patent as granted, the main claims of which read:

"1. Method for closing a packing (4) consisting of an upper part (3) having a downward hanging edge (16) and a lower part (2) having a protruding flange (15), by placing the upper part (3) on the lower part (2), placing the assembled packing (4) in a closing apparatus (1) having a base (5) with holding means (6) and a closing part (7) moveably arranged with respect thereto, said closing part (7) comprising a pressure plate (8) and a plurality of moveable ring segments (9), and moving the closing part (7) and the base (5) of the closing apparatus towards each other, thus causing the ring segments (9) to move towards each other and fold the downward hanging edge (16) of the upper part (3) around the protruding flange (15) of the lower part (2), **characterized in that** said ring

segments (9) are only moved towards each other after the pressure plate (8) and the base (5) have reached their fully closed, abutting position, in which position the upper part of the packing (4) just makes contact with the pressure plate (8)."

"2. Apparatus (1) for performing the method of claim 1, comprising a base (5) carrying means (6) for holding the packing (4) in a closing position and a closing part (7) moveably arranged with respect thereto, said closing part (7) comprising a pressure plate (8) and a ring (14) consisting of a plurality of ring segments (9) moveable in radial direction substantially parallel to said pressure plate (8) between a release position in which the dimensions in peripheral direction of the ring (14) are greater than those of the packing (4) and a first closing position in which the dimensions in peripheral direction of the ring (14) are smaller than those of the packing (4), and moveable in a direction substantially transversely of said pressure plate (8) between said first closing position and a second closing position in which said packing (4) is pressed close between said ring segments (9) and said pressure plate (8), **characterized in that** the ring segments (9) are arranged on said closing part (7) such, that they are moveable in said directions when said pressure plate (8) and said base (5) are in their fully closed, abutting position, in which position the upper part of the packing (4) just makes contact with the pressure plate (8)."

VI. The first auxiliary request at the start of the oral proceedings on 4 October 2001 was the auxiliary request of 14 August 1998 based on apparatus claims 1 and 2 filed with the letter of 14 August 1998.

The apparatus of Claim 2 as granted specifies that the apparatus is "for performing the method of claim 1" (i.e. as granted) and so the apparatus has to be such that the ring segments are **only** moved towards each other after the pressure plate and the base have reached their fully closed, abutting position (see claim 1 as granted, column 5, lines 23 to 26).

In the oral proceedings the board objected that the apparatus claim 1 of this first auxiliary request did not contain the word "only" so that the apparatus was not restricted to providing ring segment movement **only** after the pressure plate and the base had reached their fully closed, abutting position, and that therefore the scope of protection was extended, contrary to Article 123(3) EPC.

Thereupon the appellant withdrew this first auxiliary request and renumbered the remaining auxiliary requests.

VII. The sole independent claim of the resulting **first auxiliary request** (the first auxiliary request as submitted in the oral proceedings before the opposition division) reads:

"1. Apparatus (1) for closing a packing (4) consisting of an upper part (3) having a downward hanging edge (16) and a lower part (2) having a protruding flange (15), said closing apparatus (1) comprising a base (5) carrying means (6) for holding the packing (4) in a closing position and a closing part (7) moveably arranged with respect thereto, said closing part (7) comprising a pressure plate (8) and a ring (14) consisting of a plurality of ring segments (9) moveable

in radial direction substantially parallel to said pressure plate (8) between a release position in which the dimensions in peripheral direction of the ring (14) are greater than those of the packing (4) and a first closing position in which the dimensions in peripheral direction of the ring (14) are smaller than those of the packing (4), and moveable in a direction substantially transversely of the pressure plate (8) between the first closing position and a second closing position in which said packing (4) is pressed close between said ring segments (9) and said pressure plate (8), said ring segments (9) being arranged on said closing part (7) such that they are moveable in said directions only when said pressure plate (8) and said base (5) are in their fully closed abutting position, in which position the upper part of the packing (4) just makes contact with the pressure plate (8), **characterised in that** each ring segment (9) is slideably mounted in the pressure plate (8), a spacer member (23) is arranged between each segment (9) and the pressure plate (8), and in that the pressure plate (8) has a plurality of receiving spaces (24) for said spacer members (23), which are arranged such that in the first closing position each spacer member (23) is aligned with a receiving space (24) and is received therein during a movement of its associated ring segment (9) to the second closing position."

VIII. The sole independent claim 1 of the present **second auxiliary request** (which was the second auxiliary request as submitted in the oral proceedings before the opposition division) specifies *inter alia* a bridge piece pivotally connected to the lever and to pivot arms.



During the oral proceedings on 4 October 2001 the respondent (opponent) accepted that to see the bridge piece of the apparatus brought to these oral proceedings it would be necessary to remove the cover and that this would have applied also to the apparatus at the MACROPAK 91 packaging fair. However the respondent maintained that a structure similar to this bridge piece was already shown in Figure 2 of D2.

- IX. The present **third auxiliary request** corresponds to auxiliary request E filed with the letter of 4 September 2001 except that the appellant deleted claim 2 thereof. The board had objected that this claim contained previously unclaimed features but, being a dependent claim, could never overcome objections made in the opposition or appeal proceedings against the independent claims and was therefore inappropriate. The board also objected to claim 1 of the request for lack of clarity (Article 84 EPC) and extension of subject-matter (Article 123(2) EPC).
- X. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of one of the following:
- main request: The patent as granted;
  - first auxiliary request: The first auxiliary request as submitted in the oral proceedings before the opposition division;
  - second auxiliary request: The second auxiliary request as submitted in the oral proceedings before the opposition division;

- third auxiliary request: Claims 1 to 5 as submitted on 4 September 2001 and amended in the oral proceedings before the board of appeal.

The respondent requested the dismissal of the appeal.

## **Reasons for the Decision**

1. The appeal is admissible.

2. *The alleged public prior use*

2.1 Allegedly, in April 1991 on the CEBAL stand at the MACROPAK 91 packaging fair at Utrecht in the Netherlands, Mr Herber showed Mr Heitkamp an apparatus as shown in the patent without obliging Mr Heitkamp to secrecy.

2.2 Evident abuse

The board sees no reason to change its provisional opinion given in the communication of 29 June 2001 concerning evident abuse (see the above section III) and therefore finds that evident abuse cannot be a defence in the present case.

2.3 The appellant doubted the statement of Mr Heitkamp saying he was not neutral and that the only part of testimony that was verifiable by physical evidence was that Mr Heitkamp visited the fair. The appellant objected that the witness first of all maintained before the opposition division that he had no financial interest in the outcome of the opposition (see the minutes of the taking of evidence before the opposition

division, page 1, penultimate paragraph) but subsequently admitted that part of his salary was dependent on sales of this hand closing apparatus (see the top of page 7 of said minutes).

2.4 The board points out that it is well established that an employee of one of the parties can be heard as a witness and, even if his evidence might be biased, this does not make his evidence inadmissible but would be a matter to be taken into account when the board considered the evidence (see Case Law of the Boards of Appeal of the EPO, 3rd edition 1998, page 328 of the English edition).

2.5 Concerning the financial interest, the respondent explained that the closing apparatuses were provided merely to help sell the packings which were its main interest. Moreover Mr Heitkamp explained that his salary was not wholly dependent on the sale of the closing apparatus (see the top of page 7 of the minutes of the taking of evidence).

2.6 Despite allegedly realising the importance of this apparatus and discussing it with his colleagues (e.g. Mr de Graaf, Mr Vogt and Mr Pawelec) and in various departments of Alcan, Mr Heitkamp did not receive a technical brochure about the apparatus, he took no notes about what he saw and he took no pictures (see the last paragraph of page 7 of the minutes of the taking of evidence). D6 to D10 either concern a different apparatus or are not prior art, so that all that is in effect present as evidence of prior use is Mr Heitkamp's statement.

2.7 However the appellant accepted that an apparatus was

present at this fair, and according to the middle of page 1 of the minutes of the oral proceedings before the opposition division "The Patentee admitted that the machine shown at the MACROPAK exhibition is the machine of the patent in question". Moreover, according to the middle of page 2 of said minutes, "The Patentee admitted that the features of independent claims 1 and 2 of the main request are disclosed by the prior public use apparatus."

- 2.8 Thus it is agreed that the apparatus was at the fair and the board considers that it was there to be looked at and examined, at least to some extent, this being the normal reason for items being at exhibitions. This is furthermore supported by the statement of Mr Heitkamp.
- 2.9 The appellant, while agreeing that the apparatus was at the fair to be looked at, stated that it was not important how it worked but only what result it achieved. The appellant maintained that Mr Herber showed the immobile apparatus and the closed packing along the lines of "This is our apparatus and this is the quality of the closure". The appellant also stated that the apparatus shown at the fair was only a prototype.
- 2.10 However, Mr Heitkamp's testimony is part accepted by the appellant and the board sees no particular reason to disbelieve the remainder, in particular since the appellant has not offered any evidence to the contrary.
- 2.11 Even taking into account that Mr Heitkamp was an employee of the respondent, the board therefore comes to the conclusion that an apparatus in accordance with

the granted claim 2 was not only present at the Macropak 91 packaging fair in Utrecht but could also have been seen and handled in its assembled state by a member of the public present at the fair. The respondent has not claimed, nor has Mr Heitkamp testified that the apparatus was dismantled. The board must therefore assume that the apparatus at the fair could only be looked at and worked in a manner showing a visitor its ease of handling and the resulting package. The board therefore only considers those features to have been available to the public which could be seen or detected by a skilled person looking at and handling the apparatus.

3. *Main request - novelty*

3.1 The apparatus presented to the board at the oral proceedings was the same apparatus as that presented to the opposition division but it is not disputed that it was not the actual apparatus that was exhibited at the fair in 1991. However the apparatus seen by the board helped it to decide what Mr Heitkamp would have been able to see at the fair. It is noted that, at the oral proceedings, the appellant could not point out any differences between, on the one hand, the apparatus presented to the board and, on the other hand, the so-called prototype allegedly present at the fair.

3.2 Mr Heitkamp said in the taking of evidence before the opposition division

- that the stand at the fair was surrounded by a counter on which the apparatus stood (see the second paragraph of page 2 of the minutes of the taking of evidence),

- that he could look at the apparatus from all sides (paragraph 3 of page 3 of said minutes),
- that Mr Herber showed him how the apparatus closed (paragraph 3 of page 3 of said minutes),
- that he himself operated the apparatus by hand to see how it closed (paragraph 3 of page 7 of said minutes), and
- that although he saw a closed packing he could not remember whether a packing was actually closed in this demonstration (lines 3 to 5 on page 5 of said minutes).

3.3 One must remember that Mr Heitkamp was familiar with the prior art "OHLER® Type D hand closing machine" marketed by his company and shown in D6 (the same apparatus is also shown in the undated D7 and in D9).

D6 shows a lid (upper part) having a downward hanging edge placed on a container (lower part) having a full curl rim (protruding flange). The lidded container is placed in the apparatus on a base with angle pieces (holding means) below a closing frame. After having pushed down the frame, the crank handle is rotated to close the container by pressing the lid rim around the full curl and the shoulder of the container.

3.4 Thus when Mr Heitkamp saw the new apparatus at the MACROPAK 91 packaging fair, he would have had a good idea of what it was supposed to do and a rough idea of how it would work.

3.5 The board considers that Mr Heitkamp would have seen

the lever of the apparatus being pushed down and how, once the closing part had come to a halt by having abutted the base, the ring segments moved inward. Although it is not clear whether a packing was actually closed in this demonstration or even whether an already closed packing was placed in the apparatus, he would still have realised that the apparatus worked according to the steps set out in the pre-characterising portion of claim 1 as granted. These steps were known to him from the method of using the similar D6 apparatus (except that in the latter apparatus the frame performed a diagonal closing movement as opposed to the substantially transverse movement of the ring segments between the first and second closing positions in the present invention). Moreover he would have realised that the ring segments did not move inwards immediately the lever started moving but only after the closing part had come to a halt by having abutted the base. He would have known that this position (as in the D6 apparatus) was the position where the pressure plate contacted the lid of the packing (otherwise the lid would bulge upwardly during closure and this he knew from looking at the closed packing did not happen).

3.6 Accordingly the board finds that even the most basic demonstration of the apparatus at the fair to Mr Heitkamp would have disclosed to him the method of claim 1 of the main request.

3.7 This claim is therefore unallowable and the main request must be refused.

3.8 For essentially the same reasons as those given in sections 3.1 to 3.5 above, the board finds that also the features of the apparatus of claim 2 of the main

request were disclosed to Mr Heitkamp at the fair.

4. *First auxiliary request - amendments*

- 4.1 The apparatus claim 1 of the first auxiliary request comprises all of the apparatus claim 2 as granted except that the wording has been deleted that it must be suitable "for performing the method of claim 1" i.e. the method claim 1 as granted. The board's objections under Article 123(3) EPC expressed in the third paragraph of the above section VI, have been taken care of by the introduction of said word "only".

The wording "for closing a packing (4) consisting of an upper part (3) having a downward hanging edge (16) and a lower part (2) having a protruding flange (15)" taken from claim 1 as granted is however present in claim 1 of the first auxiliary request. The rest of the subject-matter of claim 1 as granted is also present in claim 1 of the first auxiliary request, sometimes with slightly amended but equivalent wording and sometimes implicitly.

The characterising portion of claim 1 of the first auxiliary request consists of claim 3 as granted.

Thus the amendments made to arrive at claim 1 of the first auxiliary request are unobjectionable under Article 123(2) EPC and, since they do not broaden the scope of the granted claim 2, they are unobjectionable under Article 123(3) EPC as well.

- 4.2 The characterising portion of claim 2 of the first auxiliary request consists of claims 4 and 5 as granted and a description that bridge piece movement results in



each ring segment being moved from its release position to its first closing position and subsequently to its second closing position. This can be seen on the Figures and from page 5, line 36 to page 6, line 16 of the originally filed description (column 4, lines 17 to 37 of the description as granted).

4.3 Claims 3 to 5 of the first auxiliary request correspond to claims 6 to 8 as granted.

4.4 The description and drawings for the first auxiliary request are the same as those granted.

4.5 Thus there is no objection under Article 123 EPC to the version of the patent for the first auxiliary request.

5. *First auxiliary request - novelty*

5.1 The board found in section 3.8 of this decision that the features of claim 2 of the main request were disclosed at the fair to Mr Heitkamp who is a member of the public. The pre-characterising portion of claim 1 of the first auxiliary request contains these features while the characterising portion contains the features of the granted claim 3. So the board must now decide whether also these added features were disclosed to Mr Heitkamp at the fair.

5.2 First of all it must be remembered that there is a difference between, on the one hand, selling the apparatus and, on the other hand, merely exhibiting and demonstrating it.

5.3 In the former case the apparatus could have been examined carefully and even dismantled to find out

every detail of how it was constructed and how it worked. If it had corresponded exactly to the apparatus depicted and described in the subsequent patent application, then the conclusion of the opposition division in section 6 on page 7 of its decision would have been correct that "all claims which can only be based on the disclosure of the application lack novelty".

5.4 There was however no sale. The apparatus was only exhibited and, the board has decided, demonstrated. However the apparatus remained the responsibility of Mr Herber and so the opportunity Mr Heitkamp had to inspect it was limited. Thus what Mr Heitkamp could learn about the apparatus was limited. In particular even the respondent accepted that to see the bridge piece of the apparatus it would be necessary to remove the cover, see section VIII of this decision, whereas it has never been suggested that the cover was in fact removed or that Mr Herber would have allowed it to be removed. Accordingly at least this bridge piece was not available to the public and the blanket conclusion of the opposition division cited in the above paragraph is wrong.

5.5 This bridge piece is however not specified in the independent claim of the first auxiliary request so the allowability of this request still needs to be considered in more detail.

5.6 Referring to the characterising portion of claim 1 of the first auxiliary request, the board considers that Mr Heitkamp would have seen that each ring segment was slideably mounted in the pressure plate.

5.7 In the apparatus brought to the oral proceedings before the board, it was possible, if one looked carefully, to see four small, rounded components, one at each corner, between the respective ring segment and the pressure plate. It can be derived from Figures 4 to 7 and column 4, lines 25 to 42 of the patent specification that these rounded components are the spacer members 23 specified in claim 1 of the first auxiliary request.

5.8 However the patent specification and the preceding patent application were not available to Mr Heitkamp, he did not mention these components during the taking of evidence and he and Mr Herber did not discuss technical details (see the last paragraph on page 7 of the minutes of the taking of evidence). So it seems that he took no notice of the components. The board does not consider that Mr Heitkamp, assuming he saw them at the fair, learned what these rounded components were or what they did i.e. with what they cooperated.

It must be borne in mind that there is no prior art example on file of a spacer member performing a similar function to that in the present patent and that there is no equivalent spacer member in the prior art apparatus of D6. Moreover the sequential movements of the ring segments differed from the composite (diagonal) movement of the frame of the D6 apparatus. Thus Mr Heitkamp, when looking at the apparatus at the fair, could not have been expected to know (from the prior art) or deduce the function of the spacer members (bearing in mind that at that time he could not have had the patent specification or application to help him).

5.9 The claim explains that the pressure plate has a

receiving space 24 for each spacer member 23, each spacer member being aligned with its receiving space in the first closing position 24 and received therein during a movement of its associated ring segment 9 to the second closing position.

In the apparatus brought to the oral proceedings before the board, it was possible, again if one looked carefully, to see depressions at the corners of the pressure plate. It is the board's opinion that only with knowledge of the patent specification or application would one know that the spacer members enter these depressions and under what conditions of the apparatus, since there is no unambiguous disclosure of these claimed features. Any other evaluation of that what could have been seen is speculative and certainly not founded on unambiguously disclosed features.

5.10 It is pointed out that it has not been proven that the apparatus brought to the oral proceedings was identical with that at the fair.

5.11 Thus the board concludes that it has not been proven with reasonable certainty that Mr Heitkamp learned all of the subject-matter of claim 1 of the first auxiliary request at the fair. It follows from the second paragraph on page 2 and the last paragraph on page 4 of the minutes of the taking of evidence that also colleagues of Mr Heitkamp saw the apparatus at the fair. However statements from these colleagues are not on file and there is no evidence that they saw anything more or realised the significance of what they saw any more than Mr Heitkamp.

5.12 An invention is made available to the public even if no

skilled person actually inspected it. It suffices that a skilled person had had the possibility of doing so. Presuming that other visitors at the fair would have been allowed to handle the apparatus, the board has to consider whether such visitors - being skilled persons - would have been able to observe the above details and draw correct conclusions about their functioning without access to the patent application or specification. The board must answer this in the negative, since a sufficient understanding of the apparatus would have required its dismantling.

- 5.13 Accordingly the board finds that the subject-matter of claim 1 of the first auxiliary request is novel over the disclosure at the MACROPAK 91 packaging fair. No other source of information has been alleged to be novelty destroying and so the subject-matter of this claim is novel within the meaning of Article 54 EPC.
6. The board has limited the prior art discussion to novelty regarding the alleged public prior use at the MACROPAK 91 packaging fair and is therefore now remitting the case to the opposition division for further prosecution (Article 111(1) EPC) on the basis of the first auxiliary request. Accordingly no comments are needed on the second and third auxiliary requests (beyond what is contained in sections VIII, IX and 5.4).

**Order**

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

1. The decision under appeal is set aside.
2. The main request of the appellant is refused.
3. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

G. Magouliotis

C. Andries