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**D E C I S I O N**  
**of 13 October 2003**

**Case Number:** T 0608/02 - 3.2.7

**Application Number:** 98945517.5

**Publication Number:** 1017599

**IPC:** B65D 81/05

**Language of the proceedings:** EN

**Title of invention:**

System and method for packing and transporting sheet materials

**Applicant:**

Eyal, Moshe

**Opponent:**

-

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 54, 111(1)

**Keyword:**

"Novelty - yes, after amendment"

"Remittal for further prosecution"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0608/02 - 3.2.7

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.7  
of 13 October 2003

**Appellant:**

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**Representative:**

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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 30 November 2001  
refusing European application No. 98945517.5  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. Burkhardt  
**Members:** P. A. O'Reilly  
E. Lachacinski

## Summary of Facts and Submissions

I. The appellant (applicant) filed an appeal against the decision of the Examining Division to refuse the European application No. 98 945 517.5.

II. The application was refused by the Examining Division for lack of novelty and lack of inventive step.

The most relevant prior art documents for the present decision are:

D1: GB-A-2 311 278

D2: EP-A-0 570 614

D3: US-A-4 101 109

D4: US-A-4 201 138

III. The appellant requested that the decision under appeal be set aside. The claims of the valid request are claims 1 to 13 filed with letter of 23 May 2003, whereby the further claims 14 and 15 filed with that letter were deleted in accordance with letter of 18 September 2003. The appellant understood that claims 1 to 13 would be remitted to the first instance for further examination.

IV. The independent claim of the main request reads as follows:

"1. Sheet material protecting unit (12) for protecting corners of a stack of vertically aligned sheet material (10), comprising:

- two protecting elements (30a, 30b), each engaging front and back surfaces about a corner of the stack of vertically aligned sheet material (10); and
- at least one coupling element (32) for coupling said two protecting elements (30a, 30b) across the corner edge of the stack, characterized in that each of said protecting elements (30a, 30b) is substantially planar and has at least one projection (14, 16) along at least one side thereof, and the coupling element (32) is a rigid hollow element having bores (34, 38) for engaging the projections (15, 16) of the complementary protecting elements and that said coupling element (32) may be shortened by cutting to adjust the desired spacing between the complementary protecting elements so as to fit stacks (10) of varying thickness."

V. In their decision the Examining Division argued essentially as follows:

(i) The subject-matter of independent device claims 1 and 14 is not novel over either of documents D1 or D2.

(ii) The subject-matter of claim 15 is rendered obvious by document D3.

(iii) The subject-matter of independent method claim 18 is rendered obvious by document D4.

VI. The appellant argued essentially as follows:

- (i) Claim 1 as amended is now limited to the embodiments of Figures 1 to 3 and 5 to 10. The embodiment of Figure 4 is no longer pursued.
- (ii) The prior art devices of documents D1 and D2 have a limited application as they cannot be used with stacks of sheets above a maximum thickness. This is possible with the invention as presently claimed. The device of document D4 solves a different problem to that of the invention. Also, claim 1 now contains features which structurally distinguish the invention from the teaching of document D4.

## **Reasons for the Decision**

1. *Admissibility of the amendments*

1.1 Claim 1 essentially differs from claim 1 as filed in that:

- (a) the field of the invention has been changed from protecting units "for use in packing, storing and transporting sheet material" to "for protecting corners of a stack of vertically aligned sheet material".

(b) the protecting elements are defined to each have at least one projection along at least one side; and

(c) the coupling element is defined to be a rigid hollow element having bores for engaging the projections of the complementary protecting elements.

1.2 With regards to feature (a) the change amounts to a limitation of the field of application of the claim. A support for the limitation may be found on page 3, lines 9 to 11 and page 5, lines 14 to 16 of the application as filed.

1.3 With regards to feature (b) the Board notes that claim 2 as filed only specified a plurality of projections along at least one side so that the claim as amended now includes the option of just one projection. Claim 1 as filed was silent about the presence of projections. Claim 1 as filed however specified at least one coupling element. In the opinion of the Board the skilled person would realise that since there may be only one coupling element this single coupling element could be coupled to a single projection and does not need to be coupled to a plurality of projections. Dependent claim 13 as filed, which was dependent indirectly on claim 1, specified that the coupling element includes at least one bore. If a coupling element has only one bore then the corresponding protecting elements would need only one projection to enter the single bore. Moreover, in the application as filed it was indicated on page 7, line 25 to page 8, line 1 that the number of

projections is changeable and depends upon the weight. Thus, the Board is satisfied that the skilled person reading the application as filed would realise that there could be only one projection on each protecting element, or a plurality of projections.

1.4 With regards to feature (c) the Board notes that claim 13 as filed specified that the protecting elements each include at least one through bore. Furthermore on page 8, lines 19 to 21 reference is made to the coupling element being hollow and having bores. The application does not contain an explicit reference to the coupling element being rigid. However, the bore 36 of the coupling element may contain reinforcing ribs or be replaced by a solid wall, see page 8, line 26 to page 9, line 1. The skilled person would understand such reinforcing is provided in order to make the coupling element rigid.

1.5 The Board is therefore satisfied that claim 1 of the valid request meets the requirements of Article 123(2) EPC.

## 2. *Novelty*

2.1 The nearest prior art is represented either by document D1 or by document D2. Neither of these documents discloses a protecting unit comprising two protecting elements and at least one coupling element for coupling the protecting elements. In each of these documents there is disclosed two protecting elements coupled directly together without any coupling element. Hence, at least the feature of claim 1 of a coupling element is lacking in the disclosure of each of these documents.

2.2 Document D3 discloses a protecting unit comprising two protecting elements and a coupling element. The coupling element is not however a rigid hollow element as required by claim 1 but rather a flexible loop. Hence, at least this feature of claim 1 is lacking in the disclosure of this document.

2.3 Document D4 discloses a protecting unit comprising two protecting elements and a coupling element. The coupling element is not however a hollow element as required by claim 1 but rather a solid cornerboard. Hence, at least this feature of claim 1 is lacking in the disclosure of this document.

2.4 Therefore, the subject-matter of claim 1 is novel in the sense of Article 54 EPC.

### 3. *Inventive step*

3.1 Claim 1 of the valid request contains features which were not present in any of the independent claims considered by the Examining Division in their decision. As the Board intends to remit the case to the first instance for further prosecution the Board considers that it would be inappropriate to express an opinion with regards to an inventive step in the subject-matter of this claim.

### 4. *Remittal to the First Instance*

4.1 Claim 1 now contains features which have not been the subject of detailed examination by the first instance. In accordance with Article 111(1) EPC, the Board



therefore considers it appropriate to remit the case to the first instance so as to give the appellant the possibility to argue his case before two instances.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

D. Spigarelli

A. Burkhart