

**Internal distribution code:**

- (A)  Publication in OJ
- (B)  To Chairmen and Members
- (C)  To Chairmen
- (D)  No distribution

**D E C I S I O N**  
**of 22 March 2005**

**Case Number:** T 0348/03 - 3.2.4

**Application Number:** 96105909.4

**Publication Number:** 0738478

**IPC:** A24C 5/35

**Language of the proceedings:** EN

**Title of invention:**

Variable-capacity store for elongated elements

**Patentee:**

G.D SOCIETA' PER AZIONI

**Opponent:**

Focke & Co. (GmbH & Co.)

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 84, 100(a), 111(1)

**Keyword:**

"Novelty (yes)"

"Remittal to the first instance for further prosecution"

**Decisions cited:**

G 0009/91

**Catchword:**

-



Case Number: T 0348/03 - 3.2.4

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.4  
of 22 March 2005

**Appellant:** G.D SOCIETA' PER AZIONI  
(Proprietor of the patent) Via Battindarno, 91  
I-40133 Bologna (BO) (IT)

**Representative:** Jorio, Paolo  
STUDIO TORTA S.r.l.  
Via Viotti, 9  
I-10121 Torino (IT)

**Respondent:** Focke & Co. (GmbH & Co.)  
(Opponent) Siemensstr. 10  
D-27283 Verden (DE)

**Representative:** Bolte, Erich, Dipl.-Ing.  
Meissner, Bolte & Partner  
Anwaltssozietät GbR  
Hollerallee 73  
D-28209 Bremen (DE)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 28 January 2003  
revoking European patent No. 0738478 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** M. Ceyte  
**Members:** P. Petti  
T. Bokor

## Summary of Facts and Submissions

- I. The European patent No. 738 478 was revoked by decision of the opposition division dispatched on 28 January 2003.

The opposition division found that the subject-matter of claim 1 according to the main request contravened Article 123(2) EPC and that the subject-matter of claim 1 according to the auxiliary request lacked novelty with respect to document EP-A-581 143 (D1).

- II. The patent proprietor (hereinafter appellant) lodged an appeal against this decision on 21 March 2003 and simultaneously paid the appeal fee.

- III. With the statement setting out the grounds of appeal received on 27 May 2003, the appellant filed an amended independent claim as subsidiary request.

- IV. Oral proceedings before the board were held on 22 March 2005.

- V. The appellant requested that the decision under appeal be set aside and that the patent be maintained

as main request, on the basis of claim 1 as filed during the oral proceedings before the opposition division as auxiliary request,

or as a subsidiary request, on the basis of Claim 1 filed with the statement setting out the grounds of appeal received on 27 May 2003 (pages 12 and 13).

The appellant further requested that the case be remitted to the opposition division for the question of inventive step, having regard to document GB-A-1 301 843 (D12).

The opponent (hereinafter respondent) requested that the appeal be dismissed.

VI. The independent claim 1 according to the main request reads as follows:

"1) A variable-capacity store (1; 47) for elongated elements (2), in particular tobacco products, the store (1; 47) comprising an input station (3) and an output station (4) located in series along a path (P) along which the elongated elements (2) are fed; and conveying means (8) for conveying said elongated elements (2); said conveying means (8) extending between the input and output stations (3, 4) and presenting a variable length; characterized in that said conveying means (8) comprise a continuous endless conveyor (8) defined by a transportation branch (9) for transporting said elongated elements (2), and by a return branch (10), said transportation branch (9) and said return branch (10) respectively presenting a first length (L1) and a second length (L2) complementary to each other; said transportation branch (9) extending from said input station (3) to said output station (4); said return branch (10) extending from said output station (4) to said input station (3); and varying means (11) being provided for varying said first and second lengths (L1, L2) in complementary manner; said varying means (11) comprising first transmission means (12) connected to the transportation branch (9) and adjustable to define,

along the transportation branch (9), a first spiral (26) of adjustable length; and second transmission means (13) connected to the return branch (10) and adjustable to define, along the return branch (10), a second spiral (27) presenting a length adjustable in complementary manner to the length of the first spiral (26); said first transmission means (12) comprising a first supporting device (33) for supporting said first spiral (26); and said second transmission means (13) comprising a second supporting device (34) for supporting said second spiral (27); said varying means (11) comprising actuating means (35) for expanding and contracting said first (33) and second (34) supporting devices to vary the lengths of said spirals (26, 27)."

VII. The appellant essentially argued that the subject-matter of claim 1 of main request is novel with respect to document D1.

The respondent contested the arguments of the appellant.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *The claimed subject-matter (main request)*
  - 2.1 The subject-matter of Claim 1 of the main request, which corresponds to the subject-matter of claim 3 of the patent as granted (i.e. to the combination of features specified in claims 1 to 3 as granted) defines a variable-capacity store having *inter alia* the following features:

- M) **varying means** (11) are provided for varying the lengths (L1, L2) [of the continuous endless conveyor (8)] in complementary manner,
- M1) said varying means (11) comprises **first transmission means** (12) connected to the transportation branch (9) [of the continuous endless conveyor (8)] and adjustable to define, along the transportation branch, a first spiral (26) of adjustable length (L1),
- M2) said varying means comprises **second transmission means** (13) connected to the return branch (10) [of the continuous endless conveyor (8)] and adjustable to define, along the return branch, a second spiral (27) presenting a length (L2) adjustable in complementary manner to the length (L1) of the first spiral (26),
- M12) said first transmission means (12) comprises a **first supporting device** (33) for supporting said first spiral (26),
- M21) said second transmission means comprises a **second supporting device** (34) for supporting said second spiral (27),
- M3) said varying means comprises **actuating means** (35) for expanding and contracting said first and second supporting devices to vary the lengths (L1, L2) of said spirals.

2.2 Claim 1 (see features M12, M21 and M3) refers to a **first** supporting device and to a **second** supporting device, that is to two distinct (or separated) supporting devices.

This is consistent with the description and the drawings of the patent which refers to "**two** transmission assemblies 12, 13, the **first** of which is associated with the transportation branch 9 ..., and the **second** of which is associated with the return branch 10 ..." (see column 2, lines 57 to 62; emphasis added) and comprising "respective supporting **devices** 33 and 34 for respectively supporting spiral 26 of transportation branch 9 and spiral 27 of return branch 10..." (column 3, lines 33 to 38; emphasis added).

2.3 It has to be understood that the term "device" indicates a "physical entity", i.e. a **physical structure** performing a function.

Thus, the first supporting device is a first structural unit associated to the transportation branch of the continuous endless conveyor performing the function of supporting the first spiral, while the second supporting device is a second structural unit associated to the return branch performing the function of supporting the second spiral.

Moreover, the terms "expanding" and "contracting" in feature M3 should be given their normal meaning, unless the description gives these terms a special meaning. Thus, according to feature M3 each of the supporting devices is expanded and contracted so that there is a

structural modification of the device which results in an increase (expansion) or in a reduction (contraction) of its overall size.

This is also consistent with the description and the drawings of the patent which refers to two supporting **devices** which are structurally expanded and contracted, wherein each supporting device can be constituted by a pair of cylindrical drums (see column 3, line 47 to column 4, line 17; Figure 1) or by a pair of drums presenting a hollow semicircular section (see column 5, lines 15 to 21; Figure 2) or by more than two drums forming a polygonal pattern (see column 5, lines 34 to 39).

3. *The prior art known from document D1*

This document discloses (see particularly Figures 1 to 3, 7 and 8) a variable-capacity store for elongated elements comprising an input station (21) and an output station (22) located in series along a path along which the elongated elements are fed. This variable-capacity store also comprises a continuous endless conveyor (18) for conveying the elongated elements which extends between the input and output stations. The continuous endless conveyor (18) has a transportation branch (19) for transporting the elongated elements and a return branch (23). The transportation branch (19), which extends from the input station (21) to the output station (22), presents a first length, while the return branch (23), which extends from the output station (22) to the input station (21), presents a second length, first and second lengths being complementary to each other.



The continuous endless conveyor is associated with a **conveyor supporting structure** constituted by an outer spiral-shaped guiding section ("Führungsbahnabschnitt" 2) consisting of a first guiding element ("Führungsschiene" 71), an inner spiral-shaped guiding section ("Führungsbahnabschnitt" 3) consisting of a second guiding element ("Führungsschiene" 72), a first S-shaped bridging element (9), a second S-shaped bridging element (11) and pulleys (24, 32, 31, 26, 34 and 36), wherein each of the S-shaped bridging elements (9 and 11) connects outer and inner spiral-shaped guiding sections (2 and 3) to each other.

Outer and inner spiral-shaped guiding sections (2 and 3) are associated with a **rigid frame** comprising a basement (6) and eight columns (68) provided with arms (69) which support the guiding elements (71 and 72) of first and second guiding sections (2 and 3). The S-shaped bridging elements (9 and 11) are mounted on a support ("Träger" 8) which can rotate around and move axially along a central column ("Säule" 7).

The transportation branch (19) of the continuous endless conveyor (18) is supported - from the input station pulley (24) to the output station pulley (26) - by a lower (ascending) portion of the outer spiral-shaped guiding section (2), the first S-shaped bridging element (9) and the lower (descending) portion of the inner spiral-shaped guiding section (3).

The return branch (23) of the continuous endless conveyor (18) is supported - from the output station pulley (26) to the input station pulley (24) - by the

pulleys (31 and 32), an upper (descending) portion of the inner spiral-shaped guiding section (3), the second S-shaped bridging element (11), an upper (ascending) portion of the outer spiral-shaped guiding section (2) and the pulleys (24 and 36).

When the support (8) carrying the bridging elements (9 and 11) is actuated by means of a motor (12) to move around and along the column (7), the position of both bridge elements (9 and 11) is changed with respect to outer and inner spiral-shaped guiding sections (2 and 3) so as to adjust the length of the transportation branch (19) in complementary manner to the length of the return branch (23).

It is clear that the variable-capacity store disclosed in document D1 is provided with a conveyor supporting structure which supports both transportation and return branches of the continuous endless conveyor (18). In other words, this conveyor supporting structure has to be considered as a single supporting device provided with different supporting elements (2, 3, 9, 11, in Figure 1; 73, 74, 83, 84 in Figures 7 and 8) defining a supporting and guiding surface for the conveyor.

#### 4. *Novelty*

- 4.1 According to features M12, M21 and M3, which define two separate supporting devices, the transportation branch of the conveyor is always supported by the first supporting device, while the return branch is always supported by the second supporting device. Moreover, each of the supporting devices can structurally be expanded or contracted to vary the lengths of

transportation and return branches in complementary manner to each other (see sections 2.2 and 2.3 above).

Having regard to the considerations in section 3 above, document D1 discloses a variable-capacity store having only one supporting device which is common to both transportation and return branches. Therefore, this known storage is not provided with two supporting devices which are expanded or contracted in order to vary the lengths of transportation and return branches.

4.2 According to the decision under appeal, in the variable-capacity store disclosed in document D1 "said first transmission means (9) comprises **a first supporting device (68, 69, fig.1)** for supporting said first spiral (2); and said second transmission means (11) comprise **a second supporting device (68, 69)** for supporting said second spiral (3); said varying means comprising actuating means (7, 8; fig.1) for expanding and contracting said first and second supporting devices to vary the length of the spirals (2,3; fig.1 i.e. varying the effective length of the spirals)" (see page 4 of the reasons, emphasis added).

4.2.1 The above reasoning is manifestly not correct: it is not possible to assert that in document D1 the upright columns (68) with their arms (69), which are part of the rigid support frame, could be expanded and contracted.

4.3 During the oral proceedings the respondent essentially argued as follows:

- (i) The expressions "first supporting device" and "second supporting device" are unclear and thus encompass any possible structure supporting the conveyor. The claim is not limited to separate first and second supporting devices. The "expanding and contracting" of the supporting devices as referred to in feature M3 has to be considered as defining a function.
  
- (ii) The variable-capacity store according to document D1 is provided with a "first supporting device", which is formed by a first portion of the outer spiral-shaped guiding section (2), the first S-shaped bridging element (9) and a first portion of the inner spiral-shaped guiding section (3), and with a "second supporting device", which is constituted by a second portion of the inner spiral-shaped guiding section (3), the second S-shaped bridging element (11) and a second portion of the outer spiral-shaped guiding section (2), wherein the first supporting device supports a first spiral, while the second supporting device supports a second spiral. Document D1 discloses a functional division of first and second supporting devices.

Moreover, due to the movement of the two S-shaped bridging elements, the effective lengths of the supporting devices are changed, so that it can be assumed that the variable-capacity store according to document D1 is provided with an actuating means as defined by feature M3.

4.3.1 The board cannot accept these arguments for the following reasons:

- (i) Since the subject-matter of claim 1 of the main request is identical with that of claim 3 of the patent as granted, claim 1 of the main request cannot be considered as being an amendment in the meaning of G 9/91, OJ EPO 1993, 408 (see section 19). Thus, the issue of whether the expressions "first supporting device" and "second supporting device" lack clarity has to be disregarded because Article 84 EPC is not a ground for opposition. These expressions have to be interpreted in order to identify their meanings.
- (ii) Having regard to the considerations in sections 2.2 and 2.3 above, it is clear that claim 1 defines a store provided with two separate supporting devices, wherein the first supporting device supports the spiral of the transportation branch, while the second one supports the spiral of the return branch. It is also clear that the supporting devices are two physical entities, each performing the function of supporting a spiral. The expansion and the contraction of a supporting device have to be seen as defining a structural modification of the device which result in an increase (expansion) or in a reduction (contraction) of its overall size.
- (iii) As already stated in section 3, the variable-capacity store according to document D1 is provided with only one physical structure, performs the function of supporting both branches

of the conveyor. The respondent, in his argumentation, considered a structure which is common to both (transportation and return) branches as being divided into two sub-structures, the first sub-structure being associated with the transportation branch, the second sub-structure being associated with the return branch. Indeed, the two sub-structures are not distinct from each other, in so far as a portion of the first sub-structure when the bridging elements (9 and 11) move into a different position becomes part of the second sub-structure (or vice versa).

4.4 Therefore, the subject-matter of claim 1 of the main request is novel with respect to document D1.

5. *Further proceedings*

With a previous communication, the board had informed the parties of its intention to remit the case to the opposition division for further prosecution, since the issue of whether the claimed subject-matter involves an inventive step had not been considered by the opposition division.

Therefore, the board, in exercising its discretion under Article 111(1) EPC, considers it appropriate to remit the case to the first instance for further prosecution.

Therefore, there is no need to deal with the subsidiary request of the appellant.

**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:

G. Magouliotis

M. Ceyte