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D E C I S I O N
of 10 May 2004

Case Number: T 0692/03 - 3.2.7

Application Number: 98937688.4

Publication Number: 1001909

IPC: B65H 54/76

Language of the proceedings: EN

Title of invention:
Packaging method and apparatus

Patentee:
Adcock, Paul Richard, et al

Opponent:
Black & Decker

Headword:
-

Relevant legal provisions:
EPC Art. 111(1), 123(2), 123(3)

Keyword:
"Extension of subject-matter (no, after amendment); remittal to first instance for further prosecution"

Decisions cited:
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Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0692/03 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 10 May 2004

Appellant: (Proprietor of the patent)	Adcock, Paul Richard 378 Alwoodley Lane Leeds, West Yorkshire LS17 7DN (GB)
Representative:	Watson, Anthony Stephen Anthony Watson & Co. 9 Hawthorn Croft Tadcaster North Yorkshire LS24 9UB (GB)
Respondent: (Opponent)	Black & Decker 210 Bath Road Slough, Berks SL1 3YD (GB)
Representative:	Cavalier, Marcus Alexander Mawson Black & Decker Europe, 210 Bath Road Slough, Berks SL1 3YD (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted 22 May 2003 revoking European patent No. 1001909 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: A. Burkhart
Members: H. E. Hahn
E. Lachacinski

Summary of Facts and Submissions

I. The appellant (patentee) lodged an appeal against the decision of the Opposition Division to revoke the European patent No. 1 001 909.

II. An opposition had been filed against the patent as a whole and was based on Article 100(a) EPC (lack of novelty and lack of inventive step), Article 100(b) EPC (that the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art) and Article 100(c) EPC (extension of the subject-matter of the patent beyond the content of the application as filed).

The Opposition Division held that the invention was sufficiently disclosed but that the subject-matter of the independent claims 1 and 10 extended beyond the content of the application as filed.

III. The respondent (opponent) submitted with a letter dated 10 February 2004 that it would no longer challenge the patent in the event of it being reinstated.

IV. With a communication dated 24 March 2004 the Board expressed its opinion that the claims 1 and 10 as granted did not appear to meet the requirements of Article 123(2) EPC due to the combination of the features "feed means" with "feed pipes or needles" which has no basis in the originally filed application. Considering the statement of the respondent (compare point III above) the Board invited the appellant to submit an amended main request which should contain the

feature "pinch wheels" instead of the said generalisation "feed means" in the claims 1 and 10 in order to meet the requirements of Article 123(2) EPC. The Board further stated that, provided that the appellant were to do so, it would be inclined to remit the case to the Opposition Division for further examination of the remaining objections under Article 100(a) EPC.

V. With letter dated 20 April 2004 the appellant submitted an amended set of claims 1 to 10 and accordingly adapted description pages 3 to 4.

VI. The independent claims 1 and 10 under consideration as filed with letter of 20 April 2004 read as follows:

"1. Apparatus for the packaging of trimmer line comprising **pinch wheels** (24,26) to feed a length of trimmer line (2) from a supply source (4)into guide means (22,28) and thence into a closed container or package(10) through a hole or aperture (10A) in said container or package, means (30) being provided to sever the trimmer line (2) when a predetermined length has been fed into said container or package (10), said guide means comprising feed pipes or needles (22,28) located one above and one below said **pinch wheels** (24,26), the trimmer line being sequentially fed into the upper pipe or needle (22) and then into the lower pipe or needle (28) from which it is fed through the hole or aperture (10A) into the closed container or package (10), characterised in that said lower pipe or needle (28) is movable axially and towards and away from said upper pipe or needle (22), said **pinch wheels** (24,26) and said closed container or package (10) so as

to enable the distance between a lower end of said lower pipe or needle (28) and said **pinch wheels** (24,26) and said container or package (10) to be varied."

"10. A method for the packaging of trimmer line including the steps of positioning a closed container or package (10) beneath a line filling station, lowering a lower pipe or needle (28) to the required position relative to said container or package (10) and to **pinch wheels** (24,26) for the line, feeding a required length of line (2) through an upper feed pipe or needle (22) and thence through said lower feed pipe or needle (28) into said closed container or package (10) through a hole or aperture (10A) therein, retracting said lower feed pipe or needle (28), severing the trimmer line (2) so as to leave a portion of said trimmer line (2) projecting from said container or package (10), and thereafter moving the filled container or package (10) away from said filling station and simultaneously positioning a further closed container or package (10) beneath said filling station."

VII. The appellant requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the claims 1 to 10 as filed with letter of 20 April 2004.

The respondent did not submit any request (compare point III above).

VIII. The appellant argued essentially as follows:

In the originally filed application (i.e. the published WO-A-99/07630) there is no reference whatsoever to the upper pipe or needle (22) being movable in its axial direction or any other direction, nor is there any reference whatsoever to the feed means (24, 26) being movable in the axial direction of the pipes or needles (22, 28). Similarly, there is no reference to the container or package (10) being movable in the axial direction of the pipes or needles (22, 28). With the above in mind it is clear that if the lower pipe or needle (28) is movable axially towards and away from the closed container or package (10), and the upper pipe or needle (22) and the feed means (24, 26) are fixed - as regards any axial movement towards and away from the closed container or package (10) - then inherently and unequivocally the lower pipe or needle (28) must move relative to the upper pipe or needle (22) and the feed means (24, 26) and thus vary the distance between a lower end of the lower pipe or needle (28) and the upper pipe or needle (22) and the feed means (24, 26) as well as to the closed container or package (10). If there would have been a requirement for the upper pipe or needle (22) or the feed means (24, 26) to be movable towards the closed container or package (10), this would have been stated in the application as originally filed. Thus the Opposition Division is wrong in its allegation of paragraphs 10.2 and 10.3 of the decision. The Opposition Division cannot read into a document something that is neither stated or implied. Since the original application is silent with respect to any movement of said items the Opposition Division is incorrect in stating that these items are movable. The same arguments fully apply to process claim 10.

Consequently, claims 1 and 10 meet the requirements of Article 123(2) and (3) EPC.

Reasons for the Decision

1. *Admissibility of amendments (Article 123(2) and (3) EPC)*

1.1 The specific embodiment of pinch wheels in combination with feed pipes or needles has a basis in the originally filed application (cf. WO-A-99/07630, page 4, lines 7 to 11; and claims 6 to 7 and 9).

1.2 The Board concurs with the appellant that the feature "… said lower pipe or needle (28) is movable axially and **towards and away from said upper pipe or needle (22), said pinch wheels (24,26)** and said closed container or package (10) **so as to enable the distance between a lower end of said lower pipe or needle (28) and said pinch wheels (24,26)** and said container or package (10) to be varied" of claim 1 can be derived directly and unambiguously from the originally filed application. The same applies likewise to the feature "… **lowering a lower pipe or needle (28) to the required position relative** to said container or package (10) and **to pinch wheels (24,26)** …" of claim 10.

1.2.1 The originally filed application explicitly only discloses that "the lower of said piper or needles will preferably be movable axially so as to enable the distance of the end of said pipe or needle to be varied relative to the container or package" (cf. page 4, lines 13 to 15; and claims 6 and 10).

The application as originally filed is totally silent as to whether the said upper pipe or needle (22) and the pinch wheels (24, 26) are to be movable or whether they are fixed (cf. Figures 1 to 3), respectively. There is also no reference that the container or package (10) should be movable in said axial direction.

1.2.2 Considering that no movements of the upper pipe or needle (22) and the pinch wheels (24,26) have been stated in the application as filed, there is no ambiguity for the skilled person regarding the movement of the lower pipe or needle (28).
Therefore, the Board shares the appellant's view that the skilled person would interpret the said wording "the lower of said piper or needles will preferably be movable axially …" as meaning that **only** said "lower pipes or needles" are movable while the upper pipe or needle (22) and the pinch wheels (24,26) are fixed.

This inherently and unequivocally implies that the lower pipe or needle (28) must move relative to the upper pipe or needle (22) and the pinch wheels (24,26) and thereby vary the distance between a lower end of the lower pipe or needle (28) and the upper pipe or needle (22) and the pinch wheels (24,26) as well as to the closed container or package (10) when the lower pipe or needle is moved axially towards and away from the closed container or package (10).

1.2.3 Consequently, the skilled person can derive this embodiment from the originally filed application in a clear and unmistakeable manner.

1.2.4 The conclusions of paragraphs 1.2.1 to 1.2.3 above apply likewise to independent process claim 10 which comprises the said wording "…lowering a lower pipe or needle (28)…".

1.3 The Board therefore concludes that the subject-matter of claims 1 and 10 of the single request dated 20 April 2004 meets the requirements of Articles 123(2) EPC and, since the claims 1 and 10 have been limited compared with the claims 1 and 10 as granted, also of Article 123(3) EPC.

2. *Remittal to the first instance*

The amendments made in claims 1 and 10 have the effect that the reasons given for revoking the patent no longer apply. However, as is evident from the file the Opposition Division has not dealt with the objections raised under Article 100(a) EPC yet.

Under these circumstances the Board considers it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution, i.e. to examine whether the amended claims meet the requirements of novelty and inventive step.

Thus, the appellant has the opportunity to have its case considered without loss of an instance.

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:

A. Wolinski A. Burkhart