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Datasheet for the decision of 25 July 2006

Case Number: T 0736/04 - 3.2.04

Application Number: 96830505.2

Publication Number: 0766928

IPC: A24C 5/47

Language of the proceedings: EN

Title of invention:
Method and device for the production of filter tip bands for ventilated cigarettes

Patentee:
G.D S.p.A.

Opponent:
Hauni Maschinenbau AG

Headword:
-

Relevant legal provisions:
EPC Art. 100(a)

Keyword:
"Admissibility of an auxiliary request filed during oral proceedings (no)"
"Novelty - claim 1 as granted (no) - claim 1 according to the set of claims M1 (no)"
"Inventive step of claim 1 according to the set of claims M2 (no)"

Decisions cited:
-

Catchword:
-

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Case Number: T 0736/04 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 25 July 2006

Appellant: (Opponent)
Hauni Maschinenbau AG
Kurt-A.-Körber-Chaussee 8-32
D-21033 Hamburg (DE)

Representative:
Meier, Frank
Eisenführ, Speiser & Partner
Zippelhaus 5
D-20457 Hamburg (DE)

Respondent: (Patent Proprietor)
G.D S.p.A.
Via Pomponia 10
I-40133 Bologna (IT)

Representative:
Ghioni, Carlo Raoul Maria
Bugnion S.p.A.
Via Goito, 18
I-40126 Bologna (IT)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 3 May 2004 rejecting the opposition filed against European patent No. 0766928 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
H. Preglau

Summary of Facts and Submissions

I. By its decision dated 3 May 2004 the Opposition Division rejected the opposition. On 10 June 2004 the Appellant (opponent) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 31 August 2004.

II. The patent was opposed on the grounds based on Articles 100 (a) (54 and 56) and 100 (b) EPC.

III. The following documents played a role in the present proceedings:

D5: DE-A-1 805 075
D6: GB-A-602 736
D14: US-A-4 452 172

IV. With letter dated 23 June 2006 the Respondent (patentee) filed new auxiliary requests based on several sets of claims numbered M1, M2, D1, D2 and D3.

V. Oral proceedings before the Board took place on 25 July 2006. At the beginning of these proceedings the Respondent presented an additional auxiliary request.

The Appellant (opponent) requested that the auxiliary requests filed with letter of 23 June 2006 and the auxiliary request filed during the oral proceedings be not admitted into the proceedings, that the decision under appeal be set aside and that the patent be revoked.

He mainly argued as follows:
The number and the content of the auxiliary requests presented by letter dated 23 June 2006 are not defined since they are based on either one of the sets of claims M1, M2, D1, D2 and D3 or combinations of these sets of claims. Consequently, no proper preparation of the oral proceedings was possible. Therefore, these requests should not be admitted into the proceedings.
Furthermore, the additional auxiliary request submitted at the beginning of the oral proceedings should be rejected as being late filed.
The subject-matter of claim 1 as granted and of claim 1 according to the set of claims M1 lacks novelty over D14. Even if the subject-matter of claim 1 of M1 were found to be novel, it would not involve an inventive step with respect to D14 in combination with D5.
The subject-matter of claim 1 according to the set of claims M2 does not involve an inventive step when considering D14 in combination with D6 and taking into account the common knowledge of a skilled person.

The Respondent (patentee) countered the Appellant's arguments and mainly argued as follows:
The letter of 23 June 2006 clearly indicates that the auxiliary requests are formed by combining successively each of the sets of claims M1 and M2 with one of the sets of claims D1 to D3. Auxiliary request 1 submitted at the oral proceedings is to be considered as a response to the objections raised by the Appellant.
Therefore all auxiliary requests are admissible.
Claim 1 as granted and claims 1 according to M1 or M2 all refer to the timing between the gumming means and the cutting means. A "timing between" is the time that elapses between two events and is expressed in seconds.

None of the cited documents teaches to control, compare and correct time values. D14 and D6 compare positions, whereas D5 compares a sequence of events, thus these systems are different from the invention. Therefore, novelty of the subject-matter of claim 1 as granted and of claims 1 according to M1 or M2 is given. Furthermore, the system used to control the synchronisation of gumming means and cutting means in D14 is so different from the systems used in D5 and D6 that a skilled person would never consider using the control and correction means of D5 or of D6 in the system of D14. Therefore, the subject-matter of the independent claims according to all requests also involves an inventive step.

The Respondent requested that the appeal be dismissed (main request) or that the patent be maintained on the basis of the set of claims according to auxiliary request 1 submitted at the oral proceedings, or according to one of the following auxiliary requests 2 to 7 defined at the oral proceedings and containing the sets of claims M1, M2, D1, D2 and D3 submitted by letter of 23 June 2006:

- auxiliary request 2 comprising the sets of claims M1 and D1,
- auxiliary request 3 comprising the sets of claims M1 and D2,
- auxiliary request 4 comprising the sets of claims M1 and D3,
- auxiliary request 5 comprising the sets of claims M2 and D1,
- auxiliary request 6 comprising the sets of claims M2 and D2,

- auxiliary request 7 comprising the sets of claims M2 and D3.

VI. Claim 1 as granted read as follows:

"1. A method for the production of filter tip bands (2) for ventilated cigarettes, including the phases of feeding a continuous strip (4) along a pre-set feed path (41);
cutting the strip (4) using cutting means (8) along transversal lines (2a) at pre-set intervals to produce the bands (2);
controlling, using control means (9, 10 and 11) a timing (S1); and
comparing the said timing (S1) with a pre-set value (S) and correcting it, using correction means (12, 13 and 14) in order to eliminate any variation with respect to the pre-set value (S);
characterized in that it includes the phase of applying an adhesive substance to the strip (4) using a gumming device (3), defining on the strip (4) itself a periodic succession of gummed areas (36) alternated with non-gummed areas (35), said transversal lines (2a) at pre-set intervals being defined by the gummed areas (36); and in that said Timing is the timing (S1) between the said gumming means (3) and the said cutting means (8)."

Claim 1 according to the set of claims M1 reads as follows:
"1. A method for the production of filter tip bands (2) for ventilated cigarettes, including the phases of feeding a continuous strip (4) along a pre-set feed path (41);

cutting the strip (4) using cutting means (8) along transversal lines (2a) at pre-set intervals to produce the bands;
applying an adhesive substance on the strip (4) using a gumming device (3), defining on the strip (4) itself a periodic succession of gummed areas (36) alternated with non-gummed areas (35), said transversal lines (2a) at pre-set intervals being defined by the gummed areas (36);
characterized in that it includes the phases of:
controlling, using control means (9, 10 and 11) a timing (S1) between the said gumming means (3) and the said cutting means (8); and
comparing the said timing (S1) with a pre-set value (S) and correcting it, using correction means (12, 13 and 14) in order to eliminate any variation with respect to the pre-set value (S);
the said timing (S1) being controlled by comparing a first signal (S9), indicating the timing of said gumming means, with a second signal (S10), indicating the timing of the said cutting means."

Claim 1 according to the set of claims M2 reads as follows:
"1. A method for the production of filter tip bands (2) for ventilated cigarettes, including the phases of feeding a continuous strip (4) along a pre-set feed path (41);
cutting the strip (4) using cutting means (8) along transversal lines (2a) at pre-set intervals to produce the bands;
applying an adhesive substance on the strip (4) using a gumming device (3) including a gumming roller (32) driven by a motor (12) and designed to transfer the

adhesive substance to the surface of the strip (4), defining on the strip (4) itself a periodic succession of gummed areas (36) alternated with non-gummed areas (35), said transversal lines (2a) at pre-set intervals being defined by the gummed areas (36);
characterized in that it includes the phases of:
controlling, using control means (9, 10 and 11) a timing (S1) between the said gumming means (3) and the said cutting means (8); and
comparing the said timing (S1) with a pre-set value (S) and correcting it, using correction means (12, 13 and 14) in order to eliminate any variation with respect to the pre-set value (S);
said correction means (12) correct said timing (S1) by modifying the timing of the gumming roller (32) by operating on the motor (12) to change, temporarily, the speed of said gumming roller (32)."

Reasons for the Decision

1. The appeal is admissible.

2. *Auxiliary requests:*

2.1 Auxiliary requests submitted by letter of 23 June 2006:

Although the number and the content of the auxiliary requests might not have been clearly defined, it is clear that all requests are based on the sets of claims M1, M2, D1, D2, and D3. Thus, if the Appellant has considered, according to his own statement, all these sets of claims individually, he should have been prepared to present his arguments with respect to any

combination of these sets. Therefore, the Board considers that the possible lack of a clear definition of the auxiliary requests did not hinder the Appellant from properly preparing himself for the oral proceedings. Furthermore, these sets of claims were filed within the time limit fixed by the Board in its communication, hence, the Board in exercising its discretion under Article 10b (1) RPBA admits the requests filed by letter of 23 June 2006 and defined during the oral proceedings.

2.2 Auxiliary request 1 submitted at the oral proceedings:

According to Article 10a (2) of the Rules of Procedure of the Boards of Appeal (RPBA) "the statement of grounds of appeal and the reply shall contain a party's complete case". According to Article 10b (1) RPBA "Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy."
In the present case the Respondent had already introduced at least six new auxiliary requests with letter of 23 June 2006 which were not substantiated by argument. It is also observed that auxiliary request 1 was filed at the oral proceedings without any proper justification for such late filing. The Respondent by filing a further auxiliary request 1 at the oral proceedings entirely ignored the Board's express invitation in its communication pursuant to

Article 11(1) RPBA to file amended claims at least one month before the date fixed for the oral proceedings. Owing to the number of auxiliary requests already on file and the state of the proceedings, the Board in exercising its discretion inter alia under Article 10b (1) RPBA decided during the oral proceedings to reject auxiliary request 1 as inadmissible.

3. *Interpretation of the term "timing":*

Paragraph [0035] of the description of the patent in suit reads "In use, the unit 11 constantly compares the signal S1 corresponding to the timing between the signals S9 and S10 with a reference signal S which corresponds to a pre-set value."

From this, it is clear that in the disclosed embodiment "timing S1 between the gumming means and the cutting means" is a signal which is representative of whether or not a transversal line defined by the gummed areas is detected at the right moment with respect to the detection of a cutting blade.

However, there is no indication in the patent specification which could lead to the assumption that the signal S1 is a "time" that is measured in seconds.

4. *Claim 1 as granted:*

4.1 Novelty has been disputed with respect to D14. D14 discloses a method for the production of filter tip bands for ventilated cigarettes (column 5, lines 12

to 15), including the phases of feeding a continuous strip (80) along a pre-set feed path (Figure 7), applying an adhesive substance on the strip (80) using a gumming device (Figure 7), defining on the strip (80) itself a periodic succession of gummed areas alternated with non-gummed areas (83), transversal lines (84) at pre-set intervals being defined by the gummed areas (Figure 8),
cutting the strip (80) using cutting means (85) along said transversal lines (84) at pre-set intervals to produce the bands,
controlling, using control means (pulsed beam of light 89 and viewer) a timing; said timing being the timing between the said gumming means and the said cutting means (85) and
comparing the said timing with a pre-set value (virtual line joining the two marks 90 on the guide) and correcting it, using correction means (column 5, lines 39 to 44) in order to eliminate any variation with respect to the pre-set value.

4.2 The Respondent argued that D14 does not show:
-a- a timing between the gumming means and the cutting means,
-b- the steps of controlling, said timing using control means and of comparing said timing with a pre-set value,
-c- the step of correcting by means of correcting means said "timing between" to eliminate any variation with respect to the pre-set value.

4.3 This point of view cannot be shared for the following reasons:

-a- D14 indicates column 2, lines 60, 61 and 64 to 68 with respect to Figures 1 to 4 that "The rollers 10 and 12 are driven with the same peripheral speed via intermeshing gears 22 on the shafts 20 and 21" and "The gear on the shaft 20 receives the drive for the gummer via an input shaft 24 which has a flange 25 carrying a pin engaging in a hole in the gear 22 whereby the roller 12 is driven and is timed with respect to the web cutting device." These passages disclose timing between the roller and the cutting device.

Column 4, lines 51 to 53 indicate that "FIGS. 7 and 8 show a different example. In this example, the gummer is substantially the same as that shown in FIGS. 1 to 4."

Furthermore, in column 5, lines 34 to 37 it is stated that: "If the timing of the ungummed areas 83 is incorrect, so that the transverse cuts are not made substantially midway between areas 84 then faulty cigarettes may be produced. Adjustment of that timing can be effected …" This passage refers to an incorrect timing between the gumming means and the cutting means (thus, a "timing between" in the sense of the patent in suit) and makes clear that this timing has to be monitored and eventually to be adjusted.

-b- In column 5 lines 45 to 58 it is indicated that "In order to allow easy determination of the position of the dry patches 83 while the machine is running … there is a light emitting device 89 which is arranged to emit

a pulsed beam of light downward on to the web, the pulses being at the frequency at which successive dry patches 83 pass beneath the device 89. The timing of the pulses is such that, if the dry patches 83 are in their correct positions, they will appear to a viewer, owing to the stroboscopic effect, to be stationary … at positions such that two marks 90 on the guide lie on a line passing through the middle of one of the areas 84."

It is implicit from the above cited passages, that the dry patches are in the "correct position" when the "timing between" the dry patches and the cutting means is correct; i.e. when due to the stroboscopic effect the virtual line joining the marks 90 on the guide passes through the middle of the apparent position of the transversal areas 84.
Furthermore, it is also clear that the shift between the virtual line joining the two marks 90 on the guide and the apparent position of the areas 84 is a visual signal which is representative of the "timing between" the gumming means and the cutting means. In this system, the viewer and the pulsed beam of light constitute the control means used to check whether or not the timing between the gumming means and the cutting means is correct. This is done by monitoring the shift of the areas 84 with respect to reference marks 90 on the guide. It is implicit that the pre-set value to which the actual shift is compared is the shift which can be tolerated without activating the correction means.

-c- In column 5, lines 58 to 65 it is stated "If the areas 84 appear to have moved relative to that line

then the plate 75 carrying the gummer is rotated slightly in the appropriate direction to restore the proper timing of the areas 83." Furthermore, column 5, lines 42 to 44 it is indicated that the adjustment of the timing "may be controlled by a servo device which may respond automatically to an automatic detection system."

Thus, D14 not only discloses manual correction means (screw) but also automatic detection and correction means (servo device) to adjust the "timing between" so as to eliminate any variation with respect to the pre-set value, i.e. to restore coincidence between the apparent position of the areas 84 and the marks 90 on the guide.

The Respondent argued that D14 does not disclose an automatic detection system as claimed in claim 1 and that although there is an indication that the checking and adjusting operations may be carried out automatically, D14 does not provide an enabling disclosure.

This cannot be accepted. Although claim 1 comprises the step of "controlling using control means" there is no indication that this control means are "automatic". Furthermore, the expression "using control means" does not set any structural or functional limits to said control means which could distinguish them from the detection and correcting means disclosed in D14.

4.4 Thus, the subject-matter of claim 1 as granted is not novel with respect to D14.

5. *Claim 1 according to the set of claims M1:*

5.1 With respect to claim 1 as granted, claim 1 according to the set of claims M1 comprises the following additional features:
- the said timing (S1) being controlled by comparing a first signal (S9), indicating the timing of said gumming means, with a second signal (S10), indicating the timing of the said cutting means.

5.2 The Respondent argued that D14 does neither disclose a signal indicating timing, nor control timings by comparing them.

This point of view cannot be shared.
In D14 the light emitting device 89 pulses at the frequency at which the successive dry patches pass beneath the device 89 (col. 5, lines 51 to 53). Thus, the line drawn by the areas 84 which appears due the stroboscopic effect is a signal indicative of the timing of the gumming means. The virtual line which can be drawn between the marks 90 that appear in the light of device 89 is a signal indicative of the timing of the cutting means (col. 5, lines 53-58). This can be derived from the fact that the timing between the gumming means and the cutting means is correct when the two marks 90 lie on an line passing through the middle of areas 84 (column 5, lines 53 - 58) and that the timing is incorrect when the transverse cuts are not made substantially midway between the areas 84 (column 5, lines 34 to 36). If the timing is incorrect, correcting means are operated to eliminate any variation and to restore proper timing (col. 5, lines 58-62). This implies that the timing between the two

signals is controlled. In D14 this is done by comparing visually or automatically the relative position of the areas 84 with respect to the virtual line defined by the marks 90, i.e. by controlling how much the one is shifted with respect to the other.

5.3 Consequently, the additional features are likewise disclosed in D14 and therefore, the subject-matter of claim 1 according to the set of claims M1 is not new either.

6. *Claim 1 according to the set of claims M2:*

6.1 This claim comprises the following additional features with respect to claim 1 as granted:
-a- "including a gumming roller (32) driven by a motor (12) ",
-b- "said correction means (12) correct said timing (S1) by modifying the timing of the gumming roller (32) by operating on the motor (12) to change, temporarily, the speed of said gumming roller (32)".

6.2 In D14 the gumming roller is driven via a gear and thus, implicitly by a motor (see Figure 7).

Thus, the method of claim 1 according to the set of claims M2 differs from that of D14 in that:
- correction means correct said timing by modifying the timing of the gumming roller by operating on the motor to change, temporarily, the speed of said gumming roller.

6.3 These distinguishing features define how the correction means operate. In D14 the correction means operate by extending or shortening the feeding path of the strip.

Thus, the problem to be solved by the claimed invention can be seen in defining correction means which operate in a different manner from those disclosed in D14.

6.4 From D6, there is known an automatic control of the colour mechanism of a cigarette making machine, so that the mechanism will locate the coloured areas on the web in such positions that the severing device will successively cut the rod along accurately located lines irrespective of any creeping or lagging of the wetted web between the colour applying mechanism and the cigarette forming machine (page 1, lines 84 to 94). This machine comprising means operatively controlled by variations in a prefixed spacing of the adjacent ends of the coloured areas relative to said path at the instant of actuation of the severing device for rotatably adjusting the printer roll relative to the web to insure the timing of the severing device to server the web between succeeding coloured areas (page 2, lines 27 to 35).

Thus, D6 discloses correction means for correcting the timing between a colour applying roller and cutting means.

In D6 (page 3, line 36 to page 7, line 3, Figure 3) the colour is applied by a printing roller 20 that is driven by a shaft 30 connected to an input shaft and therefore, implicitly to a motor, via a planetary type differential mechanism 31 comprising a ring gear 38

meshing with a worm 40 driven by a further motor 42. By actuating this further motor 42 to rotate the ring gear in one direction or the other, the speed of the output shaft 30 is increased or decreased with respect to the input shaft. This results in the roller being advanced or retarded with respect to the web.

Thus, D6 teaches to correct the timing between a roller and cutting means by operating on the driving means to change temporarily the speed of the roller.

However, since D6 teaches how to realise correction means for the same purpose (correcting the timing between the roller and the cutting means), it is obvious to the skilled person, namely when the same result is to be achieved by an alternative embodiment, to apply the teaching of D6 to the method according to D14.

6.5 The Respondent objected that D6 does not disclose to act on the motor which drives the roller, but on a differential mechanism, which is so complicated that it would not have been taken into consideration by a skilled person.
It is true that in D6 the correction means act on the differential mechanism and not on the driving motor, but it has to be noted that D6 was filed in 1945 and that at this time it was usual to drive all units of a machine by one single motor. However, at the filing date of the patent in suit, it was usual to provide each unit with its own motor, therefore a skilled person would not have used a complicated and expensive differential mechanism to vary temporarily the speed of the roller, in order to implement the teaching of D6,

but in accordance with the common knowledge, he would have provided each unit with its own motor and varied the speed of the roller by operating on the driving motor itself.

6.6 The Respondent also objected that D6 does disclose neither to detect a time, nor to measure a "time between", nor to correct a time.
However, as already stated before, claim 1 according to the set of claims M2 does not require to detect, measure and correct a time. It refers to the "timing S1" which is a timing between two events (detection of gummed areas, detection of the cutting blade) and which is a signal that is representative of the ability to select the precise moment for doing something (to perform a cut) for optimum effect (along the transversal line defined by the gummed areas).

6.7 Consequently, the subject-matter of claim 1 according to the set of claims M2 does not involve an inventive step.

7. *Patentability of the requests on file:*

7.1 All requests on file comprise either claim 1 as granted, or claim 1 according to the set of claims M1, or claim 1 according to the set of claims M2. Since none of these claims is patentable, all of these requests must fail.

7.2 Since none of the requests on file is patentable, it is not necessary to examine the further objections and grounds for opposition raised by the Appellant.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The registrar: The Chairman:

G. Magouliotis M. Ceyte