

Internal distribution code:

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

**Datasheet for the decision
of 18 November 2008**

Case Number: T 0826/08 - 3.2.07

Application Number: 02802678.9

Publication Number: 1436200

IPC: B65B 9/08

Language of the proceedings: EN

Title of invention:

Method for filling packages manufactured from a vertical,
longitudinally folded web

Applicant:

Aroma System SRL

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 109, 111(1)

EPC R. 103(1)(a)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Remittal due to extensively amended claims - yes"

"Reimbursement of appeal fee - refused"

Decisions cited:

T 0139/87

Catchword:

Reasons, point 2.2



Case Number: T 0826/08 - 3.2.07

DECISION
of the Technical Board of Appeal 3.2.07
of 18 November 2008

Appellant: Aroma System SRL
Via Battirame, 6
I-40138 Bologna (IT)

Representative: Beszédes, Stephan G.
Patentanwalt
Münchener Strasse 80a
D-85221 Dachau (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 25 October 2007
refusing European application No. 02802678.9
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: P. O'Reilly
E. Dufrasne

Summary of Facts and Submissions

I. European application No. 02 802 678 was refused by the examining division for lack of inventive step.

II. The appellant (applicant) filed an appeal against that decision.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 5 filed with its appeal grounds dated 25 February 2008. Oral proceedings were also requested.

III. In a communication of the Board dated 6 August 2008 the Board indicated its provisional opinion. It considered that the claims according to the request of the appellant had been so extensively amended compared to those on which the examining division had taken its decision that the grounds for the decision under appeal no longer applied. The Board indicated its intention to remit the case to the department of first instance for further prosecution.

IV. In its response dated 16 September 2008 the appellant agreed to the remittal and withdrew its request for oral proceedings. With this response the appellant requested the reimbursement of the appeal fee.

V. With respect to its request for reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC the appellant argued that the examining division had committed a substantial procedural violation in not rectifying its decision pursuant to Article 109(1) EPC which would have avoided the appeal. The appellant referred in this

respect to T 139/87 (OJ EPO 1990, 68) as supporting its arguments.

VI. The independent claim of the application on which the examining division took its decision reads as follows:

"1. Method to package envelopes comprising the steps of: starting from a roll of flat ribbon, folding and flattening the ribbon upon a vertically orientated surface, sealing the vertically folded ribbon with the horizontal operations of transversal sealing jaws, building a set of juxtaposed envelopes placed with horizontal sides and the vertical mouth frontally open, characterized by rotating the sealed envelopes sideways, placing them on a horizontal plane and cutting them into separate single envelopes for picking up each of the single envelopes and for vertically straightening it with the mouth thereof directed upwards, to simplify a subsequent packing operation."

VII. The independent claim of the set of claims filed with the appeal reads as follows:

1. Method for packing envelopes [I-XIII] in cycles, wherein a cycle starts when a cutting equipment (7) is in a closed state [Fig.5], wherein the cutting equipment (7) subsequently moves into an open state [Fig. 6], and ends when the cutting equipment (7) is back in the closed state [Fig. 7], the cutting equipment (7) being formed of only two transversally extending and oppositely arranged cutting jaws (7) which are moveable towards each other [dark arrows in Figs. 3, 5, 7, and 8] for being closed and away from each other [light arrows

in Figs. 4, 6, and 9] for being opened, comprising the steps of:

- operating the cutting jaws (7) and sealing jaws (2) such that the jaws (2, 7) are simultaneously in the closed state [Figs. 3, 5 and 7] or in the open state [Figs. 4, 6 and 8];
- during the closed state of the jaws (2, 7) [Figs. 1, 3, 5, 7, and 8] performing the following steps:
 - transversally sealing the ribbon (1) in a thermostealing phase during which the ribbon is still [p. 1, 1.24-25] in order to form juxtaposed [original claim 1] envelopes [I-XII] separated by sealing zones (3), each envelope [I-XII] having a mouth (5) opened in a vertical direction [p.1, 1.21-22],
 - wherein the juxtaposed envelopes (I-XII) of the ribbon (1) are cut when the cutting jaws (7) are being closed, in order to provide an individually separated first envelope (V), wherein the first envelope (V) is then provided into a horizontal plane;
- during the open state of the jaws (2, 7) [Figs. 4, 6 and 8; p.2, 1.7] performing the following steps:
 - intermittently [p.3, 1.4] providing a flattened ribbon (1) in a vertical plane [p.2, 1.2], the ribbon (1) being folded longitudinally in order to form respective bottoms (4) of the envelopes [p.1, 1.21], by moving the ribbon (1) vertically downwards [p.2, 1.1-2] such that one single [p.2, 1.4; p.3, 1.8; original claims 2 and 3] envelope of the ribbon (1) passes through the opened jaws (2,7) before the jaws (2,7) are being closed again;
 - catching the cut first envelope [V] with a first prehensile equipment (9), before the ribbon (1) is intermittently moved [Fig. 6, arrow 8; p.2, 1.15-17], such that the cut first envelope [V] is rotated from the horizontal plane into the vertical plane where the mouth

(5) of the first envelope [V] is then orientated upwards [p.2, l.13];

opening a mouth (5) of a second envelope [IV] which is arranged one position further downstream relative to the first envelope [V], particularly by moving a second prehensile equipment (9), assigned to the second envelope [IV], towards each other, wherein the opening process is particularly assisted by an air stream (10) [p.2, l. 18];

filling a third envelope [III], which is held by a third prehensile equipment (9) and is arranged one position further downstream relative to the second envelope [IV], from above [p.3, l.15];

conditioning [p.3, l. 16] a fourth envelope [II], which is held by a fourth prehensile equipment (9) and is arranged one position further downstream relative to the third envelope [III];

final sealing [p.3, l.17] a fifth envelope [I], which is held by a fifth prehensile equipment (9) and is arranged one position further downstream relative to the fourth envelope [II], and releasing the final-sealed fifth envelope, when final sealing step is completed [logical consequence of Figs. 6 and 7]; and

after the fifth envelope is released, moving each prehensile equipment (9) one position further downstream.

Reasons for the Decision

1. *Remittal to the department of first instance*

1.1 The claims filed with the appeal grounds have been amended extensively compared to those on which the examining division took its decision. According to the

appellant the amendments are in part based on features taken from the description and/or the drawings of the application.

1.2 In its reasoned statement the appellant did not seek to explain why the impugned decision was wrong but concentrated on demonstrating why it considered that the subject-matter of the set of claims as amended was novel and involved an inventive step.

1.3 In the view of the board it is not the purpose of appeal proceedings to examine claims which bear little resemblance to those upon which the impugned decision was taken. In such cases the Board itself would have to take on the role of the examining division in all its aspects so that it would be acting as a first instance as opposed to an appeal instance. Moreover, in the present case the nature of the amendments is such that a further search could be necessary before a patent could be granted. Further, compliance with Article 123(2) EPC would need to be examined.

1.4 In accordance with Article 111(1) EPC, the Board therefore considers it appropriate to remit the case to the department of first instance so as to give the appellant the possibility to argue its case before two instances.

2. *Reimbursement of the appeal fee*

2.1 The appellant argues that the examining division committed a procedural violation in not granting interlocutory revision and thus avoiding the appeal.

This argumentation of the appellant is clearly in error since it is only by filing the appeal that the appellant was able to have the possibility of interlocutory revision. An appeal could not have been avoided if the appellant wished to save its application after the decision to refuse. The main effect of the examining division granting interlocutory revision would have been that examination would continue and the Board would not have had to deal with matter.

- 2.2 The Board agrees with the appellant that the examining division should have granted interlocutory revision. In the view of the Board the case clearly falls under category (iii) as set out in the Guidelines for Examination, E-XI, 7.1, which refers to T 139/87 (*supra*). Whilst the amended claims may or may not fulfil all the requirements of the Convention even a cursory reading shows that they clearly make the grounds for the impugned decision no longer relevant.

The Board notes, however, that the alleged procedural violation did not result in an unnecessary appeal. Indeed the appellant itself did not even seek to demonstrate that the impugned decision was incorrect. A reimbursement of the appeal fee would therefore be inappropriate. In this respect the appellant referred to T 139/87 (*supra*). However, that decision merely gave an opinion on the circumstances in which interlocutory revision should have been applied and the deciding Board made no comment and gave no order regarding any procedural violation or reimbursement of the appeal fee.

- 2.3 The decision of the examining division not to grant interlocutory revision is presumably based on its

assessment of the content of the appeal grounds. A possibly incorrect conclusion in this case is thus one of content and not one of defective procedure.

In this respect in accordance with Article 109(2) EPC the examining division is not allowed to indicate its reasons for not granting interlocutory revision so that the Board is prevented from reviewing the reasons for the action of the examining division.

- 2.4 The Board therefore refuses the request for the reimbursement of the appeal fee.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders