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**Datasheet for the decision
of 5 August 2010**

Case Number: T 1002/08 - 3.2.07

Application Number: 99830164.2

Publication Number: 0952085

IPC: B65B 61/20

Language of the proceedings: EN

Title of invention:

Method and equipment for fashioning packets of cigarettes

Patentee:

G.D SOCIETÀ PER AZIONI

Opponent:

Focke & Co. (GmbH & Co. KG)

Headword:

-

Relevant legal provisions:

EPC Art. 56

Relevant legal provisions (EPC 1973):

-

Keyword:

"Alleged effect - not to be considered (point 2.2.5)"
"selection of closest prior art (point 4.4)"
"Technical problem - provision of method for producing a
product with particular specifications (point 7)"
"Inventive step - no (main and first auxiliary request)
(points 10.4.1, 11)"
"Admissibility - no (second auxiliary request)"

Decisions cited:

-

Catchword:

-



Case Number: T 1002/08 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 5 August 2010

Appellant: Focke & Co. (GmbH & Co. KG)
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 14 March 2008
rejecting the opposition filed against European
patent No. 0952085 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: H. Meinders
Members: H.-P. Felgenhauer
I. Beckedorf

Summary of Facts and Submissions

I. This appeal is against the decision of the opposition division rejecting the opposition against European patent No. 0 952 085.

II. The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked.

The respondent (proprietor) requested that the appeal be dismissed or, alternatively, in setting aside the decision under appeal that the patent be maintained in amended form on the basis of one of the sets of claims filed as first and second auxiliary requests during the oral proceedings.

III. Claims 1 according to the main request and the auxiliary requests are (with subdivisions added by the Board) as follows:

Claim 1 according to the main request (as granted):

- (a) A method for fashioning sealed packets of cigarettes
- (b) furnished with respective revenue stamps (3) and
- (c) respective coupons (4),
- (d) comprising the steps of
- (e) assembling packets (2a) of cigarettes in a packaging machine (5),

- (f) each packet presenting an outer surface (10) afforded by an opaque wrapping material;
- (g) transferring the packets (2a) of cigarettes directly from the packaging machine (5) to a cellophaner (6);
- (h) overwrapping the opaque wrapping material of each packet (2a) with a transparent material (15) and
- (i) securing the transparent material to fashion a sealed packet (2; 72) of cigarettes;
- (j) applying a revenue stamp (3)
- (k) to the outer surface (10) of each packet (2a)
- (l) during the transfer of step,

characterised in that

- (m) the method comprises the step of
- (n) applying a coupon (4)
- (o) to the outer surface of each packet (2a)
- (p) during the transfer step,
- (q) the coupon (4) covering at least in part the revenue stamp (3).

Claim 1 according to the first auxiliary request (with amendments marked in bold):

- (a) A method for fashioning sealed packets of cigarettes
- (b) furnished with respective revenue stamps (3) and
- (c) respective coupons (4),
- (d) comprising the steps of
- (e) assembling packets (2a) of cigarettes in a packaging machine (5),
- (f) each packet presenting an outer surface (10) afforded by an opaque wrapping material;
- (g) transferring the packets (2a) of cigarettes directly from the packaging machine (5) to a cellophaner (6);
- (h) overwrapping the opaque wrapping material of each packet (2a) with a transparent material (15) and
- (i) securing the transparent material to fashion a sealed packet (2; 72) of cigarettes;
- (j) applying a revenue stamp (3) **by affixing**
- (k) to the outer surface (10) of each packet (2a)
- (l) during the transfer of step,

characterised in that

- (m) the method comprises the step of
- (n) applying a coupon (4) **by affixing**
- (o) to the outer surface of each packet (2a)
- (p) during the transfer step,
- (q) the coupon (4) covering at least in part the revenue stamp (3).

Claim 1 according to the second auxiliary request (with amendments over claim 1 as granted marked in bold):

- (a) A method for fashioning sealed packets of cigarettes
- (b) furnished with respective revenue stamps (3) and
- (c) respective coupons (4),
- (d) comprising the steps of
- (e) assembling packets (2a) of cigarettes in a packaging machine (5),
- (f) each packet presenting an outer surface (10) afforded by an opaque wrapping material;
- (g) transferring the packets (2a) of cigarettes directly from the packaging machine (5) to a cellophaner (6);

- (h) overwrapping the opaque wrapping material of each packet (2a) with a transparent material (15) and
- (i) securing the transparent material to fashion a sealed packet (2; 72) of cigarettes;
- (j) applying a revenue stamp (3) **by affixing**
- (k) to the outer surface (10) of each packet (2a)
- (l) during the transfer of step,

characterised in that

- (m) the method comprises the step of
- (n) applying a coupon (4) by affixing in the same manner as the stamp (3)
- (o) to the outer surface (10) of each packet (2a)
- (p) during the transfer step,
- (q) the coupon (4) covering at least in part the revenue stamp (3),
- (r) **wherein the outer surface (10) comprises two parallel and opposite larger faces (11), two parallel and opposite flank faces (12) and two parallel and opposite end faces (13), and the coupon (4) is applied to a first of the two larger faces (11), and**

(s) wherein the coupon (4) being essentially rectangular, with dimensions smaller than those of the larger face (11), and applied to the same face as that occupied by the stamp (3) in such a way that the stamp (3) is covered in part.

IV. In the present decision the following documents already referred to in the decision under appeal are considered:

D1: GB-A-2 157 260

D8: EP-A-0 709 306.

V. According to the impugned decision the method according to claim 1 involves an inventive step considering the method of D1 as closest prior art in connection with the packet and the method disclosed in D8.

VI. The facts, evidence and arguments essentially relied upon by the appellant can, as far as they are relevant to the present decision, be summarised as follows:

- (a) The features of claim 1 according to the main request defining that a coupon is applied to the outer surface of each packet cannot be considered as defining that the outer coupon is fixed to the outer surface.
- (b) Although it is defined in claim 1 according to the first auxiliary request that a coupon is applied by affixing to the outer surface of each packet, it cannot be derived from this feature that it is the portion of the coupon covering the revenue stamp

which is affixed to it. The reason is that claim 1 does not further define how the coupon is affixed to the outer surface of each packet, which consequently applies also to the manner in which the coupon covers at least in part the revenue stamp.

- (c) Concerning claim 1 according to the main request and the first auxiliary request it thus follows that, since it remains undefined in which manner the coupon covers at least in part the revenue stamp, no technical effect, like the one referred to by the respondent, according to which by this arrangement access to the revenue stamp is made more difficult, can be associated with this feature. Such an effect, moreover, is also not referred to in the remainder of the patent in suit, nor derivable from the structural features disclosed therein.
- (d) Claim 1 according to the second auxiliary request is late filed and since the features introduced into this claim, which partially have been taken from the description, lack a clear basis in the application as originally filed, new issues would arise in case this claim would be admitted, namely concerning clarity of the amended features and the question whether they lead to an extension of subject matter. This claim thus should not be admitted at this late stage of the appeal proceedings.
- (e) Concerning the examination of inventive step of the method of claim 1 according to the main request D1

can be considered as closest prior art. Moreover, for a claim to be considered as involving an inventive step it must have this quality irrespective of which of the feasible prior art documents in the technical field in question is chosen as closest prior art.

- (f) Document D1 discloses a method of applying a revenue stamp as defined in this claim 1. It comes within regular design practice that in case a further item, like a coupon, has to be applied, the existing method steps by which the revenue stamp is applied will be simply duplicated downstream to apply the other item, e.g. a coupon. Concerning the fact that the packet according to claim 1 is now also furnished with a coupon it is evident that such a packet is simply the result of requirements resulting from customer specifications for a particular package. An example that a package satisfying such specifications is well known is given by the packet disclosed in D8, which has a revenue stamp, covered at least in part by a coupon.
- (g) The method according to claim 1 of the main request thus does not involve an inventive step, since it is obvious to manufacture a packet as defined by this claim, which as such is known from D8, by the method as defined in claim 1 which is obvious in view of the method disclosed in D1.
- (h) The reasons given with respect to claim 1 according to the main request apply correspondingly to the method according to claim 1 of the first auxiliary request, since the amendment of this claim

according to which the coupon is, like the revenue stamp, applied by affixing does not lead to a technical effect to be considered in the examination of inventive step. The reason is that although it is now defined that the coupon is applied by affixing, still no definition is given with respect to the manner in which the portion of the coupon covering the revenue stamp covers the latter, more particularly whether it is fixed to it or not.

VII. The facts, evidence and arguments essentially relied upon by the respondent can, as far as they are relevant to the present decision, be summarised as follows:

- (a) With respect to the subject-matter of claim 1 it needs to be taken into account that it is apparent that the features of claim 1 according to the main request defining that a coupon is applied to the outer surface of each packet have, in context with the features of this claim defining that a revenue stamp, for which it is known that it has to be fixedly attached to the outer surface of the packet, is applied, to be considered as defining that the coupon is likewise fixedly applied to that surface. Since it is further defined that the coupon covers at least in part the revenue stamp it is evident that the application of the coupon in the defined manner needs to be seen as having the technical effect of making access to the revenue stamp and thus tampering by fraudulent removal of this revenue stamp more difficult.

- (b) This applies even more with respect to claim 1 according to the first auxiliary request in which it is expressly stated that the coupon, like the revenue stamp, is applied by affixing. Since the coupon covering the revenue stamp is affixed to the packet, it must also be fixed to that stamp and it is evident that the coupon thus prohibits easy access to the revenue stamp. This applies likewise with respect to claim 1 according to the second auxiliary request.
- (c) Since it is clearly derivable from the claims 1 according to all requests that the feature, according to which the coupon is applied or affixed such that it covers at least in part the revenue stamp, has a technical effect which needs to be considered in the examination of inventive step. This holds true irrespective of the fact that this effect is neither defined in claim 1 nor disclosed as such in the patent in suit. In this respect the generally accepted principle should be taken into account that such effects can be relied upon in the examination of inventive step even if they are not originally disclosed. Concerning the assessment of inventive step it needs to be taken into account that such an effect is not referred to in the available prior art documents.
- (d) Due to the similarities of the packet of cigarettes according to D8 with the packet being sealed by the method according to the claims 1 according to all requests, this document needs to be chosen as closest prior art. Since according to this document the coupon is applied together with an opaque

wrapping film in the cellophaner, this document fails to give an indication towards the method of claims 1 according to all requests providing for the coupon to be applied, like the revenue stamp, during the upstream transfer step.

- (e) D1 on the contrary is not suited as closest prior art document and thus as starting point for the examination of inventive step since it does not concern, nor does it give any indication to a package of cigarettes as referred to in claim 1 according to all requests, which is provided, in addition to the revenue stamp, with a coupon.
- (f) Even if, despite the solution existing already as disclosed in D8, the person skilled in the art would consider D1 in the attempt to provide a packet with a revenue stamp as well as a coupon as referred to in claim 1 according to all requests there is no indication for the coupon being applied as defined in claim 1.
- (g) Claim 1 according to the second auxiliary request has been filed taking account of the objections raised during the oral proceedings in the discussion of inventive step with respect to claim 1 according to the main request and to the first auxiliary request. This claim, which moreover has a basis in the application as filed, should render the structural feature defining the relative position of the coupon with respect to the revenue stamp and the manner in which the coupon is affixed even more clear. It thus does not give rise to any new issues and, due to the fact that the features

concerning the relationship between the application of the coupon with that of the revenue stamp are made even more clear, it is readily apparent that the method this claim defines involves an inventive step. Claim 1 according to the second auxiliary request should thus be admitted into the appeal proceedings.

VIII. In the annex to the summons to oral proceedings dated 10 May 2010 the Board gave its preliminary opinion with respect to the method defined by claim 1 according to the main request that the features referring to the application of the revenue stamp and of the coupon leave it open whether or not the revenue stamp and/or the coupon are also fixed or attached to the outer surface of the packet (cf. point 8.3).

The Board further indicated that in this respect it needs to be taken into account that there appears to be no essential difference between the **manner** in which the revenue stamp is applied on the one hand and the manner in which the coupon is applied on the other hand. Thus it was concluded that the only difference between the application of the revenue stamp and the application of the coupon appears to reside in their **relative position**, defined in that the coupon covers at least in part the revenue stamp (cf. point 8.4).

IX. Oral proceedings before the Board were held on 5 August 2010.

Reasons for the decision

1. *Admittance of the second auxiliary request*

- 1.1 Claim 1 according to the second auxiliary request (cf. point III above) differs from claim 1 according to the main request in that feature (j) "applying a revenue stamp (3) by affixing" comprises the added expression "by affixing" and that feature (n) "applying a coupon (4) by affixing in the same manner as the stamp (3)" comprises the added expression "by affixing in the same manner as the stamp (3)".

This claim 1 further comprises added features (r) and (s) defining "wherein the outer surface (10) comprises two parallel and opposite larger faces (11), two parallel and opposite flank faces (12) and two parallel and opposite end faces (13), and the coupon (4) is applied to a first of the two larger faces (11)" and "wherein the coupon (4) being essentially rectangular, with dimensions smaller than those of the larger face (11), and applied to the same face as that occupied by the stamp (3) in such a way that the stamp (3) is covered in part", respectively.

These features concern the definition of the faces constituting the outer surface of the packet, the definition of the particular face of the packet to which the revenue stamp is applied, the definition of the shape of the coupon and of its dimensions as compared to those of a larger face of the packet and they repeat essentially the positional relationship between the revenue stamp and the coupon as already defined by feature (q).

1.2 Claim 1 according to the second auxiliary request has been filed after hearing the conclusions of the Board with respect to claims 1 according to the main request and the first auxiliary request, namely that the particular arrangement of a coupon and the corresponding revenue stamp as defined by feature (q) cannot be considered as leading to the technical effect alleged by the respondent (cf. points 2.2.5 and 3.4 below).

1.3 The amendments of claim 1 according to the second auxiliary request evidently cannot lead to a different conclusion concerning this issue.

The amendments of features (j) and (n) correspond essentially to the amendments of these features according to the first auxiliary request. As concluded with respect to claim 1 according to the first auxiliary request (cf. section 3.4 below) these amendments cannot be considered as leading to a technical effect which can be attributed to feature (q).

Concerning the addition of features (r) and (s) it is not apparent how, as also argued by the appellant and discussed during the oral proceedings, these features defining the faces of the packet and of the particular face to which the revenue stamp and the coupon are applied, the shape of the coupon and its dimensions relative to a larger face of the packet can lead to a technical effect which should be considered in the examination of inventive step.

- 1.4 Concerning the amendments it is also evident that further issues may need to be dealt with, in respect of clarity (Article 84 EPC), e.g. due to a redundancy caused by features (q) and (s) relating to the positional relationship of the coupon and the associated revenue stamp, and with respect to the question of whether the amendments lead to an extension of subject matter (Article 123(2) EPC). The latter concerns the definition of the shape of the coupon and its relative dimensions according to feature (s) for which, since these definitions have been taken from the description, it is necessary to examine whether they are originally disclosed in this isolated and general form in the application as filed.

- 1.5 For the reasons given above the Board decided not to admit the second auxiliary request into the proceedings.

2. *Subject-matter of claim 1 according to the main request*

- 2.1 The Board finds it important that, as indicated at the oral proceedings, it is taken into consideration that claim 1 according to all requests comprises two groups of features, one group defining packets of cigarettes and the other defining the method for fashioning these packets.

- 2.1.1 The first group of features, essentially comprising features (b), (c), (f), (n), (o) and (q) of claim 1 concerns the packets which are furnished with revenue stamps and coupons (features (b), (c)) and are overwrapped with a transparent material (feature (h)).

Concerning the relative arrangement of the revenue stamps and the coupons it is further defined that the coupon covers at least in part the revenue stamp (feature (q)).

- 2.1.2 The second group of features of claim 1 concerns the method according to which the revenue stamp and the coupon are applied to the outer surface of a packet (features (j), (k) and (n), (o)).

Concerning this method it is further defined that both items are applied during the transfer step (features (l), (p)).

- 2.2 The parties are of different opinion concerning the meaning of features (j) and (n), i.e. concerning the manner in which the revenue stamp and the coupon are applied.

- 2.2.1 Claim 1 refers in this connection to "applying a revenue stamp" and correspondingly to "applying a coupon".

- 2.2.2 The respondent bases its argument on two aspects.

The first aspect concerns the manner in which revenue stamps are applied. In this respect according to the respondent it is apparent for the skilled person that by its very nature and purpose a revenue stamp has to be fixedly applied to a packet. In connection with the revenue stamp the expression "applying" in feature (j) thus needs to be understood as meaning "fixedly applied" or "applying by affixing" as defined in claim 1 according to the first auxiliary request.

This understanding of the manner in which the revenue stamp is applied and thus of the meaning of feature (j) has not been objected to by the appellant.

The Board is of the opinion that the expression "applying" in feature (j) (i.e. relating to the revenue stamp) can be understood as "applying by affixing" within the meaning that, in line with its purpose, the whole revenue stamp is - after its application - fixedly attached to the outer surface. To try and remove the stamp would result in damage to the stamp and/or the package surface, such that tampering is immediately evident.

In this respect the Board has also taken into account that it is stated in the description of the patent in suit that a device is provided for dispensing and affixing the revenue stamps (column 2, lines 39 - 44; column 3, lines 48 - 51).

- 2.2.3 The second aspect focuses on the same expression, namely "applying", now being used for the application of a coupon onto the packet.

The respondent is of the opinion that in the present case use of the same expression in features concerning the application of revenue stamps and the application of coupons has the consequence that, irrespective of the feature and item to be applied, the expression "applying" needs to be understood as having the same meaning in either case.

The appellant objects to the expression "applying" in feature (n) having the meaning of leading to a fixed attachment arguing essentially that such a meaning cannot be directly and unambiguously arrived at, that coupons serve an entirely different purpose as it is the case for the revenue stamps. As it is a coupon with its own purpose (advertisement, collectable item) it may even be advantageous to leave the coupon unattached for easy removal from a packet.

- 2.2.4 The Board is of the opinion that it is doubtful that in the present case the use in the description of the same expression for the application of both the stamp and the coupon necessarily leads to the understanding that both items are also applied in an identical way, i.e. that the coupon is also fixedly attached to the packet.

Concerning the expression "applying" used in claim 1 the Board is of the opinion that this expression is of a general nature and as such not clearly defining the manner in which the coupon is arranged on the packet. Thus even if this expression is, in connection with a revenue stamp, to be understood as having the meaning of leading to a fixed connection (cf. section 2.2.2 above), this does not necessarily need to hold true for the application of coupons. The Board in this respect finds the view expressed by the appellant, that it may in general be advantageous to leave coupons unattached for easy removal from a packet, as more convincing.

In this context the respondent also referred to the fact that the description states that the coupons are affixed "in like manner" as the stamps (c.f. column 4, lines 10, 11 of the patent in suit). The Board is not

convinced by this, mainly because the function of coupons (they have to be detachable) is different from the function of stamps. Further, in "like manner" means more "in a similar way" i.e. not exactly identical or not as complete.

Feature (n) thus cannot be understood as defining that the coupon is fixedly attached to the packet, let alone to the stamp.

- 2.2.5 Consequently the technical effect attributed to this feature by the respondent, namely that by the coupon being attached to the packet according to feature (q), easy access to the revenue stamp and in particular to the portion covered by the coupon is prevented such that fraudulent manipulation of the stamp is at least made more difficult, cannot be considered, since a structural feature, to which this effect can be attributed, is lacking.

The Board wishes to add in this respect that such an effect is also not referred to in the patent in suit.

Feature (q) thus cannot be considered as leading to this technical effect; what remains is the simple covering, to an undefined extent, of the stamp by the coupon.

- 2.2.6 The above also holds true considering the argument of the respondent according to which in principle such a technical effect can be relied upon in the examination of inventive step even if it is not disclosed in the patent in suit.

The Board is of the opinion that, although this principle might be applicable in certain cases, in the present case the technical effect concerned cannot be taken into account since it is not supported by the facts because, as indicated above, a structural feature causing the alleged technical effect is missing.

3. *Subject-matter of claim 1 according to the first auxiliary request*

3.1 For the reasons as given above with respect to claim 1 according to the main request, the amended features (j) and (n) of claim 1 according to the first auxiliary request can likewise not be considered as leading to the alleged technical effect being attributable to the relative arrangement of the revenue stamp and the coupon on the packet, as defined by feature (q).

3.2 Claim 1 according to the first auxiliary request differs from claim 1 according to the main request in that features (j) and (n) reading "applying a revenue stamp (3) by affixing" and "applying a coupon (4) by affixing" now comprise the expression "by affixing".

3.3 The Board is of the opinion that the view expressed by the respondent, according to which feature (n), by reference to the expression "applying a coupon by affixing", defines that the coupon is fixedly attached to the packet, can be followed. The appellant did not object to this understanding of feature (n).

3.4 As indicated at the oral proceedings the question whether the part of the coupon covering the revenue

stamp according to feature (q) is fixedly attached to the revenue stamp or not is of particular importance.

Only in case features (n) and (q) would definitely define this, the technical effect referred to by the respondent could be attributed to feature (q).

As indicated in the oral proceedings the extent to which the coupon covers the stamp is not defined in the claim and therefore the mere overlying arrangement of the coupon defined by feature (q) cannot be considered as leading to the effect of making the revenue stamp less accessible (cf. point 2.2.5 above), if the portion of the coupon covering the revenue stamp is not fixedly attached to the revenue stamp underlying it.

The Board is, as argued by the appellant, however of the opinion that feature (n) leaves open the manner and the extent to which the coupon is fixedly attached to the packet. Nothing is said about affixing it to the revenue stamp.

The Board concludes therefore that features (n) and (q) cannot be considered as giving a definition in this respect.

Thus, the alleged technical effect attributed to feature (q) can, since it is not supported by this feature, not be considered (cf. also point 2.2.5).

4. *Selection of the closest prior art*

4.1 According to the respondent due to the packet of cigarettes according to D8 comprising the features of

the packet resulting from the method according to claims 1 according to all requests, this document needs to be chosen as the closest prior art following the problem solution approach in the examination of inventive step.

D1 on the contrary is not suited to be chosen as closest prior art since it gives no indication at all with respect to a package of cigarettes as referred to in the claims concerned which is provided, in addition to the revenue stamp, with a coupon.

- 4.2 The appellant expressed in general the opinion, which is considered as being correct by the Board, that in order to be inventive, the subject-matter of a claim must involve an inventive step irrespective of which document is chosen from a number of suitable documents qualifying as closest prior art.

Concerning the present case the appellant is of the opinion that D1 should be considered as closest prior art.

- 4.3 The respondent, who in its submissions in writing also relied upon D1 as closest prior art, did not object to D1 being a document the person skilled in the art takes into account in connection with a method such as the one defined by the claims concerned.

- 4.4 Concerning a document which can be considered as an appropriate starting point in the examination of inventive step the Board came, as indicated at the oral proceedings, to the conclusion that D1 could well serve this purpose.

To arrive at this result the Board considered that of the two groups of features comprised by the claims 1 concerned, namely those relating to a packet and those relating to a method for fashioning such a packet (cf. points 2.1, 2.1.1 and 2.1.2 above), the group defining the method for fashioning sealed packets of cigarettes should be considered the most important one for determining which prior art document is the appropriate starting point.

In this respect the Board considered the category of the claims 1 concerned, both being method claims, as well as the number and the importance of the method features comprised in these claims as compared to their packet features.

Considering the method the Board furthermore is of the opinion that in order to improve the subject matter of one of these claims, the person skilled in the art would focus on the method, obviously taking due account of the features of the packet to be produced.

Concerning the packet, the Board, following an argument of the appellant, is of the opinion that its features result from requirements given by customer specifications. Consequently the packet itself (like e.g. the one according to D1) cannot be considered as being the object of improvement in the present context.

With respect to D1 the Board considers, as can be derived from the following, that D1 discloses to a large extent the method features defined by the

claims 1 according to the main request and the first auxiliary request.

5. *Disclosure of D1 - main request*

D1 discloses, as compared to the method of claim 1 according to the main request, a method for fashioning sealed packets of cigarettes (feature (a)), furnished with respective revenue stamps (feature (b)) and comprising the steps of assembling packets of cigarettes in a packaging machine (feature (e)), each packet presenting an outer surface afforded by an opaque wrapping material (feature (f)), transferring the packets of cigarettes directly from the packaging machine to a cellophaner (feature (g)), overwrapping the opaque wrapping material of each packet (with a transparent material (feature (h)) and securing the transparent material to fashion a sealed packet of cigarettes (feature (i)) and applying a revenue stamp (feature (j)) to the outer surface of each packet (feature (k)) during the transfer step (feature (l)).

D1 is silent with respect to the application of a further item, like a coupon, on the packet.

6. *Distinguishing features and effect derivable therefrom*

- 6.1 The method according to claim 1 differs from the one disclosed in D1 (cf. point 5 above) with respect to the packets fashioned in that the sealed packets of cigarettes are further furnished with respective coupons (feature (c)), the coupon covering at least in part the revenue stamp (feature (q)).

- 6.1.1 The effect of these distinguishing features can, as discussed during the oral proceedings, be seen in merely complying with a given product specification, thus satisfying a particular customer requirement (cf. point 4.4).

The technical effect referred to by the respondent, according to which the arrangement of a coupon with respect to an associated revenue stamp according to feature (q) leads to the revenue stamp being prevented from being easily accessible and thus less or not susceptible to fraudulent manipulation, cannot be considered, as indicated in point 2.2.5 above.

- 6.2 The method according to claim 1 furthermore differs from the one known from D1 with respect to the method steps in that it comprises the step of applying a coupon (feature (n)) to the outer surface of each packet (feature (o)) during the transfer step (feature (p)).

The effect of these features can be seen as leading to the known method now producing packets which comply with product specifications different to the ones given for the packet disclosed in D1.

7. *Problem to be solved*

The technical problem to be considered based on the effect of the distinguishing features concerning the method steps (cf. point 6.2 above) can, corresponding to the problem referred to in the impugned decision (reasons, point 3.3) be formulated as providing that the known method can produce products which meet a

further product specification, namely the one known from D8 (cf. point 9 below).

8. *Solution*

It is common ground that the problem underlying the method of claim 1 is solved by the method defined by this claim.

9. *Disclosure of D8*

It is undisputed that D8 discloses, as it is the case for D1 (cf. point 5 above), a packet which is fashioned and, at least in part, a method defining the manner in which such a package is fashioned.

Concerning the packet disclosed in D8 it is further common ground that figure 1 of D8 (cf. also column 3, lines 43 - 51) shows a packet as defined by claim 1, i.e. one being furnished on its outer surface with a revenue stamp and a coupon, the coupon covering at least in part the revenue stamp.

Concerning the method disclosed in D8 it is also undisputed that D8 discloses that the coupon is applied together with the transparent wrapping in the cellophaner (cf. D8, column 5, lines 1 - 17).

10. *Obviousness*

10.1 The reasoning of the impugned decision taking D1 as starting point for the examination of inventive step (cf. reasons, point 3.3) considers as distinguishing features only features relating to the method

(cf. point 2.3 above), remaining silent on the distinguishing features concerning the fashioned packet (cf. point 2.4 above).

10.1.1 Based on these distinguishing features the problem has been seen in providing a method of furnishing packets with both a revenue stamp and a coupon.

10.1.2 To solve this problem, according to the impugned decision, the person skilled in the art would consider the teaching of D8, since this document discloses packets of cigarettes being furnished with a revenue stamp and a coupon covering at least in part the revenue stamp.

The impugned decision then refers to the method disclosed in D8 stating that starting from the method of D1 and considering D8, the person skilled in the art would replace the cellophaner used in the method of D1 by the one of D8, which integrates the application of the coupon with that of the transparent wrapping film.

This approach is considered in the impugned decision as not directly leading to the subject-matter of claim 1, which claims the application of the coupon during the transfer step.

10.2 According to the respondent the person skilled in the art, starting from the method of D1, would have no reason to furnish the packets with a coupon besides revenue stamp.

Being required to furnish the packages with a revenue stamp and a coupon as known from D8 (and as defined by

claim 1) the person skilled in the art would have no reason to deviate from the method disclosed in D8. It thus would apply the coupon together with the transparent wrapping in the cellophaner.

Consequently D8 fails to give an indication towards the method of claim 1.

This holds true also with respect to a combined consideration of the teachings of D1 and D8.

In this respect it also needs to be considered that even if, despite the method already disclosed in D8, the person skilled in the art would consider D1 in an attempt to provide a packet as referred to in claim 1, there is no indication for the coupon to be positioned relative to the revenue stamp as resulting from the method as defined in claim 1.

10.3 According to the appellant document D8, as can be derived from its claims, primarily focuses on the provision of sealed packets of cigarettes which are furnished with a coupon. These packets can be considered as corresponding to a particular product specification satisfying customers' demands.

In contrast thereto the disclosure of D8, with respect to the manner in which the coupon is applied, serves clearly only as an example.

Starting from the method according to D1 in order to solve the problem concerning the fashioning of packets furnished with revenue stamps as well as coupons as they are known from D8, the skilled person would

attempt to adapt the method of D1 so that such packets would result.

It then would, considering the manner in which already the revenue stamps are applied according to D1, namely via an applicator wheel during the transfer of the packets from the packaging machine to the cellophaner, immediately consider to duplicate this step for the application of the coupons, also during this transfer.

- 10.4 The Board, considering the impugned decision as well as the arguments of both parties concludes that starting from the method according to D1, in an attempt to solve the problem of assuring that this known method fashions packets fulfilling the product requirement as known from D8 (cf. point 7 above), would, in this respect corresponding to the impugned decision (cf. point 10.1.2 above), adapt the method according to D1 such that packets satisfying the mentioned product specification would result.

According to a first approach in this respect, relied upon by the opposition division (cf. point 10.1.2 above) as well as essentially the respondent, which both consider it as not being obvious, the method according to D1 would be adapted to comply with the product specification as given by D8 in that, following the method of D8, the complete cellophaner would be replaced with one having the double function of applying the coupon together with the wrapping material (D8, column 5, lines 1 - 17).

According to a second approach, relied upon by the appellant, the method according to D1 would be adapted

by simply duplicating the method step according to which the revenue stamp is applied during the transfer step (D1, page 4, lines 10 - 23; figure 1) to provide for the application of coupons in the same manner as it is the case for the revenue stamps.

- 10.4.1 The Board is of the opinion that the second approach is feasible and leads in an obvious manner to the method according to claim 1. The question of whether this also holds true for the first approach thus need not be further examined.

Concerning the second approach the Board is, as indicated during the oral proceedings, of the opinion that the person skilled in the art starting from the method according to D1 knows from the teaching of this document that revenue stamps can be applied to packets of cigarettes during the transfer step in which the packets are directly transferred to a cellophaner (cf. D1, page 4, line 10 - page 5, line 1; figure 1).

In case the person skilled in the art is confronted, e.g. due to customer requirements concerning package specifications, with the problem to adapt the known method such that a package as known from D8 (figure 1) is produced it realizes immediately that the coupon can be applied by simply duplicating the known manner according to which the revenue stamps are applied. It has neither been alleged nor is it otherwise apparent that following the second approach, besides duplicating the manner in which revenue stamps are applied such that likewise coupons are applied, any further modifications of the method known from D1 are required,

which lie outside adaptations coming within regular design practice.

In any case, as argued by the appellant, the duplication of the revenue stamp applicator with its folding of the revenue stamp over one of the longitudinal edges of the packet allows for the coupon to be folded over that edge, as is a product requirement of D8, see in this respect the "folder" 27 in the method of D1 and column 5, lines 23 and 24 of D8.

The method according to claim 1 according to the main request thus does not involve an inventive step (Article 56 EPC).

11. *Claim 1 according to the first auxiliary request*

11.1 The above considerations apply likewise with respect to claim 1 according to the first auxiliary request. As indicated above (cf. point 3.2), this claim differs from claim 1 according to the main request in that to features (j) and (n) reading "of applying a revenue stamp (3) by affixing" and "of applying a coupon (4) by affixing", respectively, the expression "by affixing" has been added.

11.2 This amendment does not lead, as indicated in point 3.4 above, to the alleged technical effect being attributable to feature (q) referring to "the coupon (4) covering at least in part the revenue stamp (3)". This alleged effect therefore need not be considered for this request either.

11.3 This distinguishing feature can thus merely be seen as a further product requirement, in the sense of "make sure the coupon stays in the right place when wrapped", or "make sure the coupon does not get lost when wrapping the packet".

11.4 Since it is known from D1 to affix revenue stamps by gluing (cf. e.g. page 4, lines 15 - 23; figure 1) duplication of the manner in which revenue stamps are applied for the application of coupons automatically leads to the coupons likewise being "affixed" to the packet. This is in any case also a necessary requirement in the method of D1, as otherwise coupons might be lost further downstream in the transfer step, before the transparent wrapper is applied.

The method according to claim 1 of the first auxiliary request thus does not involve an inventive step (Article 56 EPC).

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. Nachtigall

H. Meinders