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**Datasheet for the decision
of 22 June 2011**

Case Number: T 1194/08 - 3.2.07

Application Number: 01114029.0

Publication Number: 1167213

IPC: B65C 9/04

Language of the proceedings: EN

Title of invention:

Automatic rotating labelling machine

Patentee:

Simonazzi S.p.A.

Opponent:

KRONES AG

Headword:

-

Relevant legal provisions:

EPC Art. 56, 101(3), 123(2)

EPC R. 115(2)

RPBA Art. 15(3)

Keyword:

"Oral proceedings in the absence of a party (point 1)"

"Late-filed document already in the proceedings (point 2)"

"Amended claims filed without an amended description may lead to revocation (point 3)"

"Inventive step: no"

"Added subject-matter: yes"

Decisions cited:

-

Catchword:

-



Case Number: T 1194/08 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 22 June 2011

Appellant: KRONES AG
(Opponent) Boehmerwaldstrasse 5
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Representative: Grünecker, Kinkeldey
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Appellant: Simonazzi S.p.A.
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Representative: Leihkauf, Steffen Falk
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
14 April 2008 concerning maintenance of
European patent No. 1167213 in amended form.

Composition of the Board:

Chairman: H.-P. Felgenhauer
Members: P. O'Reilly
E. Dufrasne

Summary of Facts and Submissions

- I. Opposition was filed against European patent No. 1 167 213 as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step).

The opposition division decided that the patent could be maintained in amended form in accordance with the then first auxiliary request.

- II. The proprietor (hereinafter "appellant/proprietor") and the opponent (hereinafter "appellant/opponent") each filed an appeal against that decision.

- III. The appellant/proprietor requested that the appeal of the opponent be dismissed, that the decision under appeal be set aside and that the patent be maintained as granted or, in the alternative, as amended on the basis of one of the auxiliary requests 1 and 2 filed with letter of 13 May 2011.

The appellant/opponent requested that the appeal of the patent proprietor be dismissed, that the decision under appeal be set aside, and that the patent be revoked.

- IV. The parties were summoned to oral proceedings on 22 June 2011. With its letter of 13 May 2011 the appellant/proprietor indicated that it would not be present at the oral proceedings.

- V. Claim 1 of the **main request** (patent as granted) reads as follows:

"Automatic rotating labelling machine (1) comprising a rotatable support (3) carrying means (5) for gripping bottles or containers (6) to be labelled, said support (3) being operatively associated to at least one labelling unit (8, 9) that applies labels (19) to said bottles or containers (6), said rotatable support (3) being arranged at an upper end of said machine (1), and said gripping means (5) gripping said bottles or containers (6) at an open or upper portion thereof, and holds them below said support (3), characterised in that it comprises an upper platform (20) supported by columns (21) carrying at least a motor (4) and said rotatable support (3)."

Claim 1 of the **first auxiliary request** reads as follows (amendments when compared to claim 1 of the **main request** are depicted in bold or struck through by the Board):

"Automatic rotating labelling machine (1) comprising a rotatable support (3) carrying means (5) for gripping bottles or containers (6) to be labelled, said support (3) being operatively associated to at least one labelling unit (8, 9) that applies labels (19) to said bottles or containers (6), said rotatable support (3) being arranged at an upper end of said machine (1), and said gripping means (5) gripping said bottles or containers (6) at an open or upper portion thereof, and holds them below said support (3), characteris**ed** in that it comprises an upper platform (20) supported by columns (21) carrying at least a motor (4) and said rotatable support (3), **said rotatable support (3) being connected to motor (4) and hanging from platform (20)**

whereas the labeling (*sic*) unit (8, 9) is floor-supported."

Claim 1 of the **second auxiliary request** reads as follows (amendments when compared to claim 1 of the **first auxiliary request** are depicted in bold or struck through by the Board):

"Automatic rotating labelling machine (1) comprising a rotatable support (3) carrying means (5) for gripping bottles or containers (6) to be labelled, said support (3) being operatively associated to at least one labelling unit (8, 9) that applies labels (19) to said bottles or containers (6), said rotatable support (3) being arranged at an upper end of said machine (1), and said gripping means (5) gripping said bottles or containers (6) at an open or upper portion thereof, and holds them below said support (3), characterized in that it comprises an upper platform (20) supported by columns (21) carrying at least a motor (4) and said rotatable support (3), said rotatable support (3) being connected to motor (4) and hanging from platform (20) **whereas the labeling (*sic*) unit (8, 9) is carried by a floor-supported bench (24), wherein said machine (1) comprises an abutment member (23) comprising an (*sic*) non rotatable elongated member that extends from a central portion of the rotatable support (3) and ends with a base (25) to allow correct positioning of said bench (24) with respect to said rotatable support (3).**"

Claim 1 of the **patent as intended to be maintained according to the decision of the opposition division** reads as follows (amendments when compared to claim 1

of the **main request** are depicted in bold or struck through by the Board):

"Automatic rotating labelling machine (1) comprising a rotatable support (3) carrying means (5) for gripping bottles or containers (6) to be labelled, said support (3) being operatively associated to at least one labelling unit (8, 9) that applies labels (19) to said bottles or containers (6), said rotatable support (3) being arranged at an upper end of said machine (1), and said gripping means (5) gripping said bottles or containers (6) at an open or upper portion thereof, and holds them below said support (3), characterized in that it comprises an upper platform (20) supported by columns (21) carrying at least a motor (4) and said rotatable support (3), **wherein the labelling units (8, 9) are mounted on mobile platforms (17) with respect to the rotatable support (3).**"

VI. The documents cited in the present decision are the following:

E1: DE-C1-198 35 369

E4: DE-A-197 41 476

E15: FR-A-510 526

E16: DE-A-4 312 605

VII. The relevant written arguments of the appellant/proprietor may be summarised as follows:

(i) E15 and E16 should not be admitted into the proceedings.

In particular, E15 is late filed and not *prima facie* relevant to the novelty or inventive step of claim 1 on file. The document discloses a filling and crowning machine in which the bottles are supported from below, not from above.

(ii) The subject-matter of claim 1 of the main request involves an inventive step.

Starting from E1 the subject-matter of claim 1 as granted is distinguished from the disclosure of the document by the features whereby there is a labelling unit and the upper platform is supported by columns. In this respect the opposition division was wrong to consider that E1 implicitly discloses a labelling unit. The reference to labelling in column 1, line 9, is clearly erroneous and is not enabling. There is no known rotating labelling technique. Therefore the skilled person would not have considered the issue of labelling in E1 and hence would not have combined this with a column-supported platform.

(iii) There is a basis in the application as originally filed for the amendments made to claim 1 of the first auxiliary request.

A basis for the additional wording of claim 1 of this request can be found in claims 1 and 16 as originally filed, as well as the description as originally filed page 10, lines 2 to 7, and figures 1, 7, 8 and 9.

(iv) The subject-matter of claim 1 of the second auxiliary request involves an inventive step.

The extra features of the claim, compared to claim 1 of the main request, are not to be found in any prior art document. They solve the problem of saving space and at the same time providing a correct positioning of the bench with respect to the rotatable support. None of the prior art documents suggests hanging a rotatable support from a platform while floor-supporting a bench carrying a labelling unit and further providing a non-rotatable elongate abutment member to function as set out in the claim.

(v) The subject-matter of claim 1 of the patent in the form intended to be maintained in accordance with the decision of the opposition division involves an inventive step.

In particular the combination of E1 and E4 does not lead to the subject-matter of the claim. E1 requires that the aggregates are hanging whereas in the machine known from E4 they are floor mounted. Also, the plate 11 in E4 is not mobile but stationary. It is merely vertically and radially adjustable.

VIII. The relevant written and oral arguments of the appellant/opponent may be summarised as follows:

(i) E15 and E16 should be admitted into the proceedings.

In particular, E15 was *de facto* in the opposition proceedings and it is not understandable that the document should have been declared inadmissible only during the oral proceedings before the opposition

proceedings. Also, the document is relevant, at least with respect to the second auxiliary request.

(ii) The subject-matter of claim 1 of the main request lacks an inventive step.

Starting from E1 the opposition division correctly stated that all the features of claim 1 are known in combination from E1 with the exception of the feature of the columns which is known from E1 but not in combination with all the other features of claim 1. The appellant/proprietor argues that the reference in column 1, line 9, to a labelling aggregate was erroneous. This disclosure is, however, unambiguous and there is no basis to believe that it was made in error. A labelling unit must be present in the apparatus since it is mentioned in column 1, line 9, that apparatuses of that type have a labelling aggregate which implicitly must contain a labelling unit. It is clearly indicated in column 3, lines 27 to 32, that the ceiling 12 is held up by floor-based supports.

(iii) The amendments made to claim 1 of the first auxiliary request do not comply with Article 123(2) EPC.

The expression "floor-supported" is not to be found in the application as originally filed. It is only disclosed that the labelling unit can sit on a platform or bench 24.

(iv) The subject-matter of claim 1 of the second auxiliary request does not involve an inventive step.

In E15 rotatable supports 14 and 23 are disclosed. It is not inventive to provide them as non-rotatable. The claimed effect that the base allows correct positioning of the bench is not clear.

(v) The subject-matter of claim 1 of the patent in the form intended to be maintained according to the decision of the opposition division does not involve an inventive step.

The extra feature of the claim, compared to claim 1 as granted, according to which the labelling units are mounted on mobile platforms just means that the position of the unit is adjustable so as to be adapted to the bottles being labelled. It is however well known that such units, which may weigh several hundred kilos, are first roughly positioned and then must be more precisely positionable. Such a labelling unit is disclosed in E4 as being adjustable, see column 4, lines 10 to 13.

IX. Along with the summons to oral proceedings the Board expressed its provisional opinion regarding the appeals. The relevant parts of the opinion may be summarised as follows:

(i) The Board considers that E15 is already in the proceedings.

The opposition division admitted the document into the proceedings in its communication accompanying the summons to oral proceedings dated 31 October 2007. It was not entitled during the oral proceedings to reverse its admittance of the document.

(ii) The presence of an inventive step in the subject-matter of claim 1 of the patent as granted is in doubt.

Starting from E1 as the closest prior art document it appears that only the features of claim 1 of the labelling unit and the supporting columns may not be disclosed in E1 in combination with the other features of the claim. It appears, however, that the provision of these features may not involve an inventive step.

(iii) The presence of an inventive step in the subject-matter of claim 1 of the patent as intended to be maintained in accordance with the decision of the opposition division is in doubt.

The expression "mobile platforms" appears to have a general meaning that the platforms are movable in some undefined way. The lack of indication of the form of the mobility means that it may not be possible to identify any advantageous effect or problem solved by the feature. In E4 a mobile labelling machine is known (see column 5, lines 50 to 56).

(iv) If a request is filed which involves amendments then a correspondingly amended description and, if appropriate, amended dependent claims should be filed simultaneously.

Reasons for the Decision

1. *Absence of the appellant/proprietor at the oral proceedings before the Board*
 - 1.1 Although duly summoned the appellant/proprietor by its letter of 13 May 2011 indicated that it would not attend the oral proceedings.
 - 1.2 The Board decided nevertheless that pursuant to Article 115(2) EPC and Article 15(3) Rules of Procedure of the Boards of Appeal the proceedings would continue without that party.
2. *Admittance of late filed documents*
 - 2.1 E15 and E16 were late filed documents in the opposition proceedings. For the purpose of the present decision it is only necessary to consider the admittance of E15.
 - 2.2 E15 was filed by the appellant/opponent during the opposition proceedings with letter of 5 June 2007. The preceding communication of the opposition division dated 16 February 2007 had been favourable to the appellant/opponent. Nevertheless, the appellant/opponent considered that it wished to respond to one of the comments of the opposition division regarding a feature that the opposition division considered was not disclosed in the nearest prior art document. It responded by filing E15 (see point 3.3.2 of the communication and the second paragraph of the letter of the appellant/opponent).

- 2.3 With its letter also dated 5 June 2007 the appellant/proprietor filed three auxiliary requests. With its subsequent letter of 24 October 2007 the appellant/proprietor filed comments regarding E15 without objecting to its admittance into the proceedings.
- 2.4 In its provisional opinion accompanying the summons to oral proceedings dated 31 October 2007 the opposition division indicated that E15 was accepted as a belated submission. It further considered that the first auxiliary request was allowable taking into consideration E1 to E15.
- 2.5 In its letter dated 28 March 2008, i.e. five days before the oral proceedings, the appellant/proprietor objected for the first time to the admittance of E15 into the opposition proceedings. It repeated this objection at the start of the oral proceedings before the opposition division.
- 2.6 The opposition division decided to reject the document as having been late filed and because it considered that it was not more relevant than E1 or E4 (see point 2 of the decision grounds).
- 2.7 The appellant/opponent objected in its appeal grounds to the non-admittance of the document into the proceedings. Moreover, it also referred to the document in its response dated 19 December 2008 to the appeal of the patent proprietor with respect to the fourth auxiliary request of the appellant/proprietor (see section 5 of this response).

2.8 In the opinion of the Board the opposition division was not entitled during the oral proceedings to reverse its admittance of the document. The opponent was entitled to rely on the earlier decision of the opposition division to admit the document into the proceedings. Also, the request of the proprietor shortly before the oral proceedings, when beforehand it had dealt with the document, may itself be considered to have been made too late. This view of the Board was already set out in its provisional opinion accompanying the summons to oral proceedings.

2.9 The Board therefore considers that E15 is already in the proceedings so that there is no need to take a decision regarding its admittance into the appeal proceedings.

Main request

3. *Inventive step*

3.1 According to the reasoning of the decision under appeal the closest prior art document is E1. The appellant/opponent also started its argumentation from this document and it was not disputed by the appellant/proprietor that this is the closest prior art document.

3.2 With regard to the question of the distinguishing features of claim 1 the opposition division considered that the only distinguishing feature was that the upper platform is supported by columns (see point 3.2.1.8 of the decision reasoning). The appellant/proprietor argued that in addition to this feature also the

feature of the labelling unit is not disclosed in E1. The appellant/opponent disagreed with this argument of the appellant/proprietor.

- 3.3 It is not, however, necessary for the Board to decide whether or not the features of the labelling unit and/or the supporting columns are disclosed in E1 since even if it is considered that both of these are not disclosed in that document the subject-matter of the claim nevertheless lacks an inventive step.

In the open construction referred to in column 3, lines 27 to 30 of E1, it is indicated that there are supports for the roof. The selection of columns as the form for such supports cannot involve an inventive step. In the view of the Board columns are one of the most obvious ways of providing a support for a roof in an open construction.

Also, bottles are normally provided with labels. Nevertheless, the labelling does not always have to occur in the same apparatus and/or at the same location as the filling and sealing of the bottles. In the apparatus shown in the drawings of E1 the bottles leave the apparatus without having been labelled since no labelling unit is shown. The skilled person is, however, informed from column 1, line 9, that a labelling unit is one of the possible units which are provided for apparatus of this type. Therefore, the skilled person would, if required, provide a labelling unit for the apparatus shown in the drawings of E1. This would also apply to the option of an open construction as mentioned in column 3, lines 27 to 30.

Contrary to the argument of the appellant/proprietor the Board considers that there is no reason to believe that the indication in E1 of the possibility of providing a labelling unit is an error since there is no indication in this direction.

- 3.4 Consequently, the Board is not convinced by the arguments of the appellant/proprietor against the decision of the opposition division.
- 3.5 Therefore, the subject-matter of claim 1 of the main request does not involve an inventive step in the sense of Article 56 EPC.

First auxiliary request

4. *Added subject-matter - Article 123(2) EPC*

- 4.1 The appellant/proprietor stated that a basis for the additional wording of claim 1 of this request could be found in claims 1 and 16, the description page 10, lines 2 to 7, and figures 1, 7, 8 and 9, all as originally filed, though it actually referred to the corresponding parts of the A-publication of the application as originally filed.

Apart from simply making these references the appellant/proprietor supplied no supporting argumentation as to how these sources disclosed the amendments to the claim.

- 4.2 The cited passages all refer to the feature that the rotatable support is connected to a motor and hangs

from a platform. In particular, page 10, lines 6 and 7, provides a basis for this amendment.

- 4.3 With regard to the feature that the labelling unit is "floor-supported" the above cited references do not provide any basis and the appellant/proprietor did not indicate any basis specifically for this amendment.
- 4.4 With respect to the further amendments made to claim 1 of the first auxiliary request the appellant/proprietor also indicated a basis which included further passages of the application as originally filed. These further amendments comprise a more detailed definition of the feature in question. The Board has therefore also considered these further passages which are on page 11, lines 11 and 12, and page 10, lines 15 to 17 and 20 to 22, of the application as originally filed. These references indicate that there is a bench 24 which carries the labelling unit. This bench is visible in figures 7, 8 and 9, of the application as originally filed.

The feature of claim 1 of the first auxiliary request, however, is that the labelling unit is "floor-supported". This is a particular form of conceptual generalisation of the structural element of the bench. Other conceptual generalisations of the function of a bench are possible, e.g. to the function of its work surface. It cannot therefore be concluded that the skilled person understands that the term "bench" was intended to mean "floor-supported" in general, i.e. any form of floor support, even if the particular bench shown in the figures happens to be supported on the floor. The general concept of the labelling unit being

floor-supported, possibly by something other than a bench, has not been disclosed in the application as originally filed.

4.5 The Board in carrying out an *ex-officio* examination of the amendments has not been convinced by the references of the appellant/proprietor to parts of the description, claims and drawings of the application as originally filed. Also the appellant/opponent raised the same objection in its letter of 19 December 2008 against claim 1 of the then first auxiliary request which is identical to the present first auxiliary request (see letter of appellant/proprietor dated 13 May 2011, point 2, first paragraph).

4.6 The Board concludes therefore that the amendments made to claim 1 of the first auxiliary request do not comply with Article 123(2) EPC.

Second auxiliary request

5. *Requirements of the Convention other than novelty and inventive step*

5.1 The Board notes that the appellant/opponent raised a number of points of a so-called formal nature relating to alleged inconsistencies of the description and the depending claims with claim 1 of this request. Had the Board found that the subject-matter of the claim was patentable then it would have been necessary to examine these points before a decision could have been taken to allow the request.

5.2 In its communication accompanying the summons to oral proceedings the Board had explicitly indicated that new requests should be accompanied by a correspondingly amended description and, if appropriate, amended claims (see point 7.2 of the provisional opinion). Despite this indication the appellant/proprietor has not made any such amendments. Had the Board found that the subject-matter of claim 1 of the request involved an inventive step then it would have had to consider whether the amended patent also met the other requirements of the Convention, cf. Article 101(3)(a) EPC. A cursory assessment suggests that this is not the case, e.g. the embodiment of figure 9 is outside of the scope of the claims, so that even if the Board had found positively for the appellant/proprietor with respect to inventive step it would probably still have revoked the patent, cf. Article 101(3)(b) EPC.

6. *Inventive step*

6.1 Claim 1 of the second auxiliary request contains the extra feature (compared to claim 1 of the first auxiliary request) that the labelling unit is carried by a floor-supported bench, wherein said machine comprises an abutment member comprising a non rotatable elongated member that extends from a central portion of the rotatable support and ends with a base to allow correct positioning of said bench with respect to said rotatable support.

6.2 The appellant/proprietor argued (see letter dated 13 May 2011) that this feature solved the problem of saving space. It further argued that there is no indication in the prior art to provide a machine in

which a rotatable support hangs from a platform with the extra feature of the claim.

6.3 The appellant/opponent argued that the provision of the feature is suggested by E4 and E15 and that the reference to allowing "correct positioning" (see letter dated 19 December 2008 with respect to the then first and fourth auxiliary requests which are identical to the present first and second auxiliary requests) is not clear.

6.4 The Board agrees with the arguments of the appellant/opponent.

In E4 the labelling units are provided on a bench. In fact the term "bench" is broad and includes any form of support with a horizontal surface forming the support. The table plate 11 ("Tischplatte") clearly falls within the scope of the term "bench". It is supported by the floor as is visible in figure 2. The skilled person when providing a labelling unit would consider such a support. The fact that the rotatable support disclosed in E4 is not hanging from a platform does not mean that the skilled person would not consider using such a bench for a labelling unit in a machine which does have a hanging rotatable support, i.e. the machine of E1.

It is also known from E15 to provide a rotatable support with an elongated member extending from a central portion thereof. The support 14 is driven from above by a motor arm 5 (see page 1, lines 49 to 53). According to the claim the elongated abutment member allows correct positioning of the bench. However, it is not clear what is meant by "correct" positioning and

how the existence of an elongated abutment member can facilitate this.

Also the combination of these two additional elements does not provide any synergistic effect.

6.5 The Board notes that the appellant/proprietor when filing the second auxiliary request had available the argumentation that the appellant/opponent had brought against the previous fourth auxiliary request that was identical to the present second auxiliary request as stated by the appellant/proprietor (see first paragraph of point 2 of letter dated 13 May 2011). The appellant/proprietor was thus in a position to respond to the arguments of the appellant/opponent. Nevertheless it did not avail itself of this opportunity.

6.6 Therefore, the subject-matter of claim 1 of the second auxiliary request cannot be considered as involving an inventive step in the sense of Article 56 EPC.

Patent as intended to be maintained by the opposition division

7. *Inventive step*

7.1 Claim 1 of this request contains the extra feature, compared to claim 1 as granted whereby "the labelling units are mounted on mobile platforms with respect to the rotatable support".

7.2 As addressed by the Board in its provisional opinion (see point 4 thereof) the reference to mobile platforms

allows for two interpretations of the term "mobile", also in the light of the description of the patent.

In paragraph [0024] of the description of the patent it is indicated that the labelling units are "optionally mounted on extractable platforms so as to be quickly replaced" or they are "on mobile platforms with respect to the machine support, so as to easily adjust the position of the labelling unit". This latter definition of mobile platforms is presented in contrast to the large scale mobility of the former definition of "extractable platforms" so that it must be understood as covering fine adjustment of the position so as to be correctly positioned for labelling, e.g. for bottles of differing radii. In paragraph [0038] the labelling units are stated to be on "mobile platforms" so as to "adjust their position and have better access for maintenance and cleaning". This definition could be considered to refer to coarse adjustment. In the view of the Board the term "mobile" as used in the claim must be considered to cover both large-scale coarse adjustment of the position of the labelling unit, e.g. to facilitate access, as well as small-scale fine adjustment, e.g. to facilitate setting the position relative to the outer surface of the bottles for correct labelling action. The description of the patent does not consistently exclude either of these interpretations.

- 7.3 As discussed with respect to the main request the Board considers that it is an obvious step to provide a labelling unit in a machine as known from E1. The Board further considers that it is a necessity to provide an adjustment capability for the labelling unit at least

to take account of different bottle sizes. E4 in column 4, lines 10 to 13, indicates that the labelling unit should be vertically and radially adjustable relative to the rotatable support 1. Whether this is effected by being placed on an adjustable platform or by some other form of support is of no consequence.

- 7.4 The Board concludes therefore that the subject-matter of claim 1 of the patent as intended to be maintained according to the decision of the opposition division does not involve an inventive step.

Order

For these reasons it is decided that:

1. The appeal of the patent proprietor is dismissed.
2. The decision under appeal is set aside.
3. The patent is revoked.

The Registrar:

The Chairman:

G. Nachtigall

H.-P. Felgenhauer