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**Datasheet for the decision
of 23 September 2010**

Case Number: T 1292/08 - 3.2.07

Application Number: 99116441.9

Publication Number: 0962391

IPC: B65B 61/18

Language of the proceedings: EN

Title of invention:

A method of applying fitments to containers and apparatus for use in the same

Patentee:

ELOPAK SYSTEMS AG

Opponent:

SIG Technology AG

Headword:

-

Relevant legal provisions:

EPC Art. 54, 104, 113(1), 123(2)

EPC R. 81(1), 84(2), 140

Relevant legal provisions (EPC 1973):

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Keyword:

"Corrected decision by Examining Division establishes the valid text of the patent"

"Added subject-matter: no"

"Novelty: no"

"Request for apportionment of costs: refused"

Decisions cited:

G 0009/91, G 0010/91

Catchword:

-



Case Number: T 1292/08 - 3.2.07

DECISION
of the Technical Board of Appeal 3.2.07
of 23 September 2010

Appellant: SIG Technology AG
(Opponent) Laufengasse 18
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Representative: Thielmann, Andreas
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Patent- und Rechtsanwälte
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Respondent: ELOPAK SYSTEMS AG
(Patent Proprietor) Cherstraße 4
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Representative: Burrows, Anthony Gregory
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 2 May 2008
rejecting the opposition filed against European
patent No. 0962391 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: H. Meinders
Members: P. O'Reilly
I. Beckedorf

Summary of Facts and Submissions

- I. Opposition was filed against European patent No. 0 962 391 as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(c) EPC (added subject-matter).

The opposition division decided to reject the opposition.

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

- III. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed and that an apportionment of costs be awarded in respect of the ground of opposition according to Article 100(c) EPC.

- IV. The independent claims of the **patent as corrected by the examining division after grant** read as follows (amendments when compared to claims 1 and 4 of the application as originally filed are respectively depicted in bold or struck through):

"1. Apparatus for use in applying fitments to containers, comprising an applicator (12) having at least two arms (32-38) distributed about an axis (58) and each having in a distal end zone thereof receiving means (50) to receive and carry a fitment (28), **including a sealing flange (54)**, ~~and~~ driving means (56) arranged to rotate said applicator (12) to cause one

arm (32) carrying one fitment (28) to align said one fitment (28) with one container (16B) while placing the receiving means of another arm (36) in position to receive another fitment (28) from an adjacent track (46), and also arranged to move the applicator (12) axially to apply said one fitment (28) to said one container (16B) and to bring the receiving means (50) of said other arm (36) to a **forward end** position (**Figure 2**), and placing means (40-44) for engaging said other fitment (28) and moving said other fitment (28) from said track (46) towards said other arm (36) characterized in that said forward end position (Figure 2) is at a predetermined spacing (d') from a **waiting position in said track (46) of the sealing flange (54) of said other fitment (28).**"

"4. A method of applying to containers fitment including respective sealing flanges, comprising turning an applicator (12) including a plurality of arms (32-38) distributed about an axis (58) and each having in a distal end zone thereof receiving means (50) to receive and carry a fitment (28), **including a sealing flange (54)**, and driving means (56) arranged to rotate said applicator (12) to cause one arm (32) carrying one fitment (28) to align said one fitment (28) with one container (16B) while placing the receiving means of another arm (36) in position to receive another fitment (28) from an adjacent track (46), and also arranged to move the applicator (12) axially to apply said one fitment (28) to said one container (16B) and to bring the receiving means (50) of said other arm (36) to a **forward end** position (**Figure 2**), and placing means (40-44) for engaging said other fitment (28) and moving said other fitment (28) from said track (46)

towards said other arm (36) characterized in that said forward end position (Figure 2) is at a predetermined spacing (d') from **a waiting position in said track (46) of the sealing flange (54) of said other fitment (28).**"

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

D1: WO-A-95/10408
D2: US-A-5 174 465
D3: US-A-5 249 695.

VI. The arguments of the appellant may be summarised as follows:

(i) The independent claims of the application as originally filed have been amended such that their content has been extended.

The position of the applicator 12 as shown in figure 2 of the patent in suit cannot be at its end position because at the end position the spigot 50 that is carrying the fitment to be welded should have moved the fitment into contact with the wall of the carton. It is clear, however, from the figure that there is still a gap. If this gap is closed by moving the applicator to the left the predetermined spacing (d') will disappear. Therefore figure 2 cannot provide a basis for this amendment. Also the spacing (d') that is shown in figure 2 in fact shows the distance between the spigot 50 and the track 46.

In moving to the characterising portion of the claim a feature which was not indicated to be particularly

relevant to the invention the nature of the invention has been changed. This feature is also not suitable for solving the problem to which the patent is addressed.

(ii) The subject-matter of claims 1 and 4 is not novel.

Considering claim 1 it is acknowledged by the respondent that the features of the preamble of the claim are known from D1. In the view of the appellant also the feature of the preamble is disclosed in this document. It is clearly indicated on page 3, lines 21 to 27 and page 12, lines 24 to 30, that the fitment is pushed onto the anvil and that the plug of the anvil enters the spout to engage the fitment as a result of the movement of the rod 107. This means that before this movement the anvil must have been at a predetermined distance from the fitment. Although there is a reference in D1 that the fitments known from D2 and D3 are suitable there is also a statement on page 9, line 17, that other fitments may be used. Furthermore some of the fitments disclosed in D3, see for example the embodiment of figure 12, are intended to be collapsed by the consumer so that they would not be collapsed on the machine. Therefore the arguments presented in the declarations of Messrs. Pape and Häbel which assume that the fitments are collapsible and are indeed collapsed on the apparatus are not valid. It is also not acceptable that a clearly stated function of the apparatus is considered to be wrong and that there is considered to be an unstated function in its place.

(iii) An apportionment of costs should not be awarded.

The ground under Article 100(c) EPC was only withdrawn during the oral proceedings before the opposition division after it was made clear by the opposition division to the appellant that the ground would not succeed. The appellant made the withdrawal in order to speed up the proceedings.

VII. The arguments of the respondent may be summarised as follows:

(i) The independent claims of the application as originally filed have not been amended such that their content has been extended.

It is clearly disclosed in column 4, lines 25 to 29 (for which there is a corresponding passage in the application as originally filed) that the receiving means stops at a predetermined spacing (d') from the fitment. It therefore also stops short of the flange of the fitment.

If the movement of a feature from the preamble to the characterizing portion of a claim was considered to be an addition of subject-matter then a large proportion of the granted European patents would be invalid.

(ii) The subject-matter of each of claims 1 and 4 is novel.

Considering claim 1 the characterising feature of this claim is not disclosed in D1. The anvil 99 does not stop at a predetermined spacing from the fitment 31.

The explanation of the functioning of D1 as given in the declarations of Messrs. Pape and Häbel shows that the purpose of the rod 107 was to collapse the fitment. This fitment is of the collapsible type because that is the type disclosed in D2 and D3 which are referred to in D1 as disclosing suitable fitments. Also in figure 10 of D1 the fitment is shown in a collapsed state so that it must have been collapsed to reach this state. Although the document indicates that the purpose of the movement of the rod 107 is to place the fitment on the anvil this description is wrong as is explained in the declarations of Messrs. Pape and Häbel. Since the purpose of the rod 107 is not as described in the document it is clear that the anvil would not be stopped at a predetermined spacing before the fitment.

(iii) An apportionment of costs should be awarded.

The appellant withdrew the ground under Article 100(c) EPC during the oral proceedings before the opposition division depriving the respondent of its right to an oral hearing on the matter. By reintroducing the ground in the appeal proceedings the matter is discussed at an oral hearing for the only time at the appeal stage. Since the ground has been re-admitted into the proceedings the costs of representative of the respondent in preparing and presenting its case with respect to this ground should be compensated by an award of these costs. The amount of these costs is not yet known.

Reasons for the Decision

1. *Patent documents on which this decision is based*

- 1.1 During the opposition proceedings the patent proprietor requested correction of the granted patent to remove some printing errors. A comparison between the text of the "Druckexemplar" and the printed text of the patent clearly shows the corrections to be transcription errors. Instead of correcting them as such (box 3.4 in Form 2051) the examining division agreed to the correction by correcting its decision to grant under Rule 140 EPC on 25 April 2008, 11 months after the request had been filed (18 May 2007). The corrected text although indicated as annexed to this decision is not available in the electronic file.

The examining division thus took its decision after the opposition division had announced its decision at the oral proceedings (on 15 April 2008), but before the written decision was sent to the parties on 2 May 2008. The internal decision of the examining division to correct was issued to the parties on 7 July 2008 by the opposition division, with an annexed version of the corrected patent. The content of the correction is not known as it is also not available in the electronic file. The publication department of the EPO published a B9 corrected patent specification on 15 October 2008.

- 1.2 In its communication annexed to the summons to the oral proceedings (see point 1 thereof) the Board indicated that the appeal proceedings would be based on the corrected version of the patent, i.e. the B9 publication, since that appears to be the valid version.

The Board considers that the issuing of the correction decision by the opposition division instead of the examining division was a minor procedural violation since the correct organ - the examining division (see Form 2051) - took the decision even though the incorrect organ - the opposition division (see Form 2052) - issued the decision. The other procedural errors in dealing with the request for correction have no influence on the substance of the patent, because as far as the executed corrections are concerned, these correspond to the "Druckexemplar" forming the basis of the decision to grant and with the corrections as requested by the patent proprietor with letter of 18 May 2007.

1.3 The corrected version was published after both the notice of appeal and the appeal grounds were filed. The Board considers that the appeal proceedings must be based on the corrected version of the patent since that is the valid version. The actual corrections - transcription errors by the printer - have had no effect on the proceedings.

2. *Article 100(c) EPC*

2.1 The appellant based its case in the appeal proceedings on two arguments. First of all that there had been a change in the definition of the predetermined spacing (d') in the independent claims as granted compared to the independent claims as originally filed. Secondly, that the movement of this feature from the preamble to become the sole characterising feature of the independent claims has changed the gist ("Witz") of the invention.

- 2.2 The first argument of the appellant is based on the alleged change in the definition of the predetermined spacing (d').

The appellant referred to figure 2 of the patent specification which does indeed show the predetermined spacing (d'). The appellant pointed out that the lower part of the applicator 12 had not reached the position in which the fitment's flange was in contact with the inner wall of the carton and that it would need to be moved more to the left to reach this position which only then corresponded with the forward end position. This leftwards movement would, according to the appellant, result in the spacing (d') disappearing. Moreover, the appellant considered that the spacing (d') shown in the drawing is the spacing between the spigot 50 and the track 46, not the flange 54 as specified in the claim.

As pointed out by the respondent, however, the description in column 4, lines 25 to 30 (for which there is a corresponding passage in the application as originally filed), clearly indicates that such a predetermined spacing (d') is present when the arms 32, 34 of the applicator have stopped. In column 3, lines 48 to 52, it is made clear that the spacing (d') is from the fitment 28 to the spigot 50.

The Board considers that the said passages in the description are quite clear and unequivocal that such a spacing exists in the terminal end position. The fact that the drawing may not depict perfectly the alignments in the vertical sense of parts of the

apparatus does not change the situation since the drawings in the present case are schematic. Also the apparent change in the definition of the predetermined spacing (d') from the spacing from the fitment to the spacing from a flange of the fitment does not change the matter. If the receiving means of an arm is a predetermined spacing from a fitment then it is also a predetermined spacing from a flange of that fitment. Indeed it is the spacing from the flange 54 that is being indicated in figure 2. Therefore the Board also does not accept the argument that the depicted spacing is between the track and the spigot since the flange 54 is also depicted in the drawing at the edge of the track. In any case an inaccurate depiction in the drawing does not change the clear disclosure in the description.

- 2.3 The appellant is correct in pointing out that the presence of the predetermined spacing (d') was not highlighted in the application as originally filed as being the inventive feature. In its argumentation the appellant has, however, misunderstood the meaning of the expression "characterized in that" in a claim. In accordance with Rule 43(1) EPC it is quite clear that on filing protection is sought for the combination of all the features in the claim and that the part situated before that expression merely sets out those features known from the prior art. The position of this expression in the independent claims of the application as filed will depend upon the prior art known to the applicant at the time of filing. The situation may change when, as in the present case, further prior art is found during the European search. This may lead to a rearrangement of the features of the claim with respect

to the preamble and characterising parts. Such a rearrangement can in principle lead to an extension of the content if the definitions of the relationships between the features is changed, but it does not necessarily result in this. In the present case these relationships have not changed, nor has movement of this feature from the characterising portion of claim 1 to its preamble resulted in a change in the content of the wording of the claim. In fact, the appellant failed completely to explain how the content had actually changed.

2.4 The Board concludes that the amendments made to the independent claims during the grant proceedings have not extended the content of the application as granted compared to the application as originally filed so that the ground under Article 100(c) EPC does not succeed.

3. *Novelty*

3.1 The appellant argued that D1 took away the novelty of the subject-matter of each of claims 1 and 4. For the purpose of this decision it is only necessary to consider claim 1 as will become clear below.

3.2 It was acknowledged by the respondent that the preamble of claim 1 is known from D1. The only question therefore to be decided is whether D1 also discloses the characterising feature of the claim according to which the forward end position of the receiving means is at a predetermined spacing (d') from a waiting position in the track of the sealing flange of the other fitment, i.e. the next one to be loaded onto the receiving means.

- 3.3 According to D1 there is a spider 96 mounted on a reciprocating shaft 81 (see page 11, lines 27 to 32 and page 12, lines 17 to 19). The spider provides a receiving means in the form of an anvil 99 for receiving a fitment 31 (see page 11, lines 20 to 24). A fitment is "loaded onto an anvil 99 while the previous fitment is being welded to a carton" (see page 11, lines 28 to 30). This means that the actions of loading a new fitment and welding the already loaded fitment to the carton take place when the spider is at the same position, which, as will be explained below, is a position where the spider has been moved away from a retracted position to an advanced position, corresponding to the claimed "forward end position". At this advanced position the already loaded fitment has been moved through a hole in the carton to bring the flange 33 of the fitment into contact with the inner wall of the carton ready for welding. With the spider in this advanced position the rod 107 of a cylinder 106 "pushes the lowermost fitment 31 at the delivery end onto the anvil so that the plug 101 enters spout 32 and engages the fitment by friction". The appellant argued that in order that the fitment may be pushed onto the anvil and that the plug may enter the spout as described it is necessary that the plug is not already in the spout, i.e. that it is spaced therefrom.
- 3.4 The respondent argued that the movement effected by the rod 107 did not serve to move the fitment onto the plug, but rather that it served to collapse the fitment. D1 refers on page 1, lines 17 to 21 and page 9, lines 15 to 17, to D2 and D3 as describing suitable fitments. The respondent argued further that the fitments

described therein are of the collapsible type as is the one shown in figure 10 of D1, i.e. the cap is pressed into the spout to collapse the fitment. According to the respondent and to the declarations of Messrs. Pape and Häbel these fitments must therefore have been collapsed on the apparatus disclosed in D1 and this collapsing must have been effected by the action of the rod 107. Mr. Häbel even went so far as to suggest that any pushing of the fitments on to the spigots was "merely co-incidental" (see section 6 of his declaration dated 20 August 2010).

- 3.5 D1 is concerned with welding a fitment to a carton. The document discloses a fitment in figure 10 and, as indicated by the respondent, it refers to the fitments of D2 and D3 as being suitable for use with the apparatus (see page 9, lines 15 to 17). However, as pointed out by the appellant it is stated on page 9, line 17, that other suitable fitments may be used, i.e. not just those disclosed in D2 and D3. In figure 5 of D1 at the top the outline of a fitment is shown at a position where it is to be applied to an anvil 99. The outline of the fitment is also shown at the bottom of figure 5 where the preceding fitment is in a position in alignment with the welding horn 111. The outline here is the same as at the top of the figure. In figure 6 the fitment is shown having been advanced into the welding horn so that welding can be effected. Again the outline here is the same as in both sections of figure 5. There does not appear to be any indication that if the fitment is considered to be of the collapsible type that it actually has been collapsed on the apparatus, i.e. when being pushed onto the spigot, or in any case before being welded onto the carton.

3.6 In the declarations of Messrs. Pape and Häbel it is argued that a collapsing of the fitment must have occurred, whereby they particularly refer to the fitments disclosed in D2. In D2 in column 3, lines 51 to 56, it is indicated that the collapsing of the fitment can be effected at the final moulding stage of the fitment or subsequently. In D3 with reference to the embodiment of figure 12 it is indicated that the consumer fractures the link between the cap and the spout, which means that this fitment cannot be "collapsed" during the process of fitting it to the carton. The Board concludes therefore that the argument that a collapsing of the fitment must have occurred during its collection on the spigot or during the fitting process is not supported by the disclosures of either D2 or D3, which clearly indicate that it could have occurred before this process or afterwards by the consumer. It is also possible that it could be effected by a further part of the apparatus which is not shown in D1 because D1 is concerned with an improvement in the way that the fitment is fitted to the carton not with collapsing the fitment.

3.7 The Board is therefore not convinced by the said declarations and cannot agree that where a device, here the rod 107 and piston 106, is described in a document to have a particular function that it can be concluded that it in fact does not perform this function but rather performs a completely different function which is not addressed anywhere in the document and leaving the disclosed function as "merely co-incidental".

To arrive at such a conclusion it would require that the described function is definitively excluded. In fact the declarations refer to functions that are "most likely" (see section 8 in each of the declarations of Mr. Pape dated 13 January 2005 and 23 August 2010) or "probably" (see section 5 in the declaration of Mr. Häbel dated 20 August 2010). In this respect the fact that figures 5 and 6 consistently show the shape of the fitment as being unchanged whereas the conclusions of the declarations would require it to change its shape casts further doubts on the conclusions drawn therein.

3.8 The Board therefore concludes that also the characterizing feature of claim 1 is unambiguously disclosed in D1.

3.9 Therefore, the subject-matter of claim 1 is not novel in the sense of Article 54 EPC.

4. *Request for the award of an apportionment of costs*

4.1 The respondent requested an apportionment of costs pursuant to Article 104(1) EPC. The arguments of the respondent are based on the alleged admittance of a new ground under Article 100(c) EPC into the appeal proceedings. This arguments rests on the premise that this ground was no longer in the proceedings.

The Board does not agree with that premise.

4.2 The notice of opposition contained a substantiated ground based on Article 100(c) EPC (see section III thereof). The patent proprietor in its submission dated

21 February 2007 refuted the ground. In the communication annexed to its summons to oral proceedings the opposition division gave its preliminary opinion that Article 123(2) EPC, i.e. the ground under Article 100(c) EPC, was complied with. The opponent in its written submission dated 14 March 2008, made after the receipt of the said communication, merely referred back to its notice of opposition regarding this ground.

According to the minutes of the oral proceedings (see point 2 thereof) the chairwoman indicated that the opposition division was still of the opinion that Article 123(2) EPC is complied with; whereupon the opponent "withdrew" this ground of opposition.

In its decision reasoning the opposition division explained why it considered that Article 123(2) EPC was complied with (see point 2 thereof) though it then noted that the ground had been withdrawn.

In its appeal grounds the appellant based its arguments in part on Article 100(c) EPC.

- 4.3 If the ground of opposition under Article 100(c) EPC is considered to still have been in the proceedings at the time that the appeal was filed then the question of its admissibility into the appeal proceedings would not arise. In which case the possibility of an apportionment of costs also would not arise since that request is based on the assumption that it is a new ground.

It must therefore be considered whether the ground was still in the proceedings at the time that the appeal was filed.

4.4 The ground was undisputedly in the opposition proceedings up to the start of the oral proceedings. The effect of the indication of the opponent during the oral proceedings that it "withdrew" the ground must therefore be considered.

4.4.1 According to Rule 81(1) EPC grounds of opposition not invoked by the opponent may be examined by the opposition division if they would prejudice the maintenance of the patent. On the basis of this rule the opposition division would not be limited by a withdrawal of a ground by an opponent, since it could itself in any case (re-)introduce the ground.

With respect to the reference in the rule to grounds which "would prejudice the maintenance of the European patent" this cannot be seen as limiting the consideration of a new ground to those which would inevitably lead to a revocation or limitation of the patent since that would imply that the opposition division would have to reach a conclusion that the ground "would prejudice" even before the counter-arguments of the proprietor had been heard. This wording must therefore be understood in the sense that if the possibility reasonably exists that the ground "would prejudice", even if after hearing the counter-arguments of the proprietor it may turn out that it would not, then the opposition division may introduce the ground.

4.4.2 Rule 84(2) EPC deals, amongst other matters, with the withdrawal of an opposition. It is indicated therein that the European Patent Office may of its own motion continue the opposition proceedings after such a withdrawal. The effect of a withdrawal of an opposition could be considered to be equivalent to the withdrawal of all the grounds of opposition. According to Rule 84(2) EPC, however, the opposition proceedings can be continued, which must mean that it can be continued at least on the basis of all the grounds already in the proceedings.

If the opposition division can continue with a ground when, in effect, all the grounds have been withdrawn then it must be entitled to continue with a ground when only that ground has been withdrawn by the opponent.

In the present case the opposition division must have considered that it was continuing with the ground since in its decision it gave reasons why the ground did not succeed. If the ground were no longer in the proceedings a decision thereon would not be necessary.

4.4.3 According to Enlarged Board of Appeal decisions G 9/91 and G 10/91 (OJ EPO 1993, 408 and 420 respectively) the purpose of appeal proceedings is mainly to give the losing party the possibility of challenging the decision of the opposition division on its merits (see point 18 thereof).

In the present case the opposition division clearly gave a decision with reasoning with respect to the ground under Article 100(c) EPC and the appellant is also challenging that part of the decision on its

merits, as well as challenging the findings on novelty and inventive step. There is therefore nothing in these decisions which would prevent the ground from being considered in appeal proceedings or would lead to a requirement that the patent proprietor must give its consent for the ground to be admitted. As already indicated the Board does not consider that the ground necessarily ever left the proceedings.

4.5 The Board concludes therefore that the ground was still in the proceedings at the time of the filing of the appeal so that the reference thereto in the appeal grounds cannot be equated to a (re-)introduction of the ground.

4.6 The respondent has argued that it was entitled to be heard on the matter at two instances in oral proceedings. Essentially this is an argument directed to its right to be heard under Article 113(1) EPC. The respondent has overlooked the fact that the finding in its favour by the opposition division means that its right to be heard has been respected. Even if the ground had not been withdrawn the opponent could have decided to make no oral presentation, relying on its written arguments. The respondent could not therefore assume that there would have been a two-way oral debate of which it had been deprived.

4.7 Since the ground was not being (re-)introduced, i.e. it was still in the proceedings, there is no basis for an apportionment of costs so that the request for such an apportionment must be refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for apportionment of costs is refused.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders