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**Datasheet for the decision
of 3 December 2013**

Case Number: T 0493/11 - 3.2.07

Application Number: 02003001.1

Publication Number: 1232949

IPC: B65B 57/08, G05B 19/4067

Language of the proceedings: EN

Title of invention:
Automatic machine for processing cigarettes

Patent Proprietor:
G.D. SOCIETÀ PER AZIONI

Opponent:
Hauni Maschinenbau AG

Headword:
-

Relevant legal provisions:
EPC Art. 104, 123(2)

Keyword:
"Amendments - allowability of amended claims 1 - no (all requests)"
"Apportionment of costs (yes) - equitable (point 3)"

Decisions cited:
-

Catchword:
-



Case Number: T 0493/11 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 3 December 2013

Appellant: G.D SOCIETÀ PER AZIONI
(Patent Proprietor) Via Battindarno, 91
I-40133 Bologna (IT)

Representative: Bergadano, Mirko
Studio Torta S.p.A.
Via Viotti, 9
I-10121 Torino (IT)

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

Representative: Stork Bamberger
Patentanwälte
Postfach 73 04 66
D-22124 Hamburg (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 4 January 2011
revoking European patent No. 1232949 pursuant
to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: H. Meinders
Members: H.-P. Felgenhauer
E. Kossonakou
G. Patton
I. Beckedorf

Summary of Facts and Submissions

- I. The proprietor (appellant) filed an appeal against the decision of the opposition division revoking European patent No. 1 232 949.

The appellant requested that the decision under appeal be set aside and the patent maintained in amended form according to the main request filed with its submissions dated 15 February 2011 or according to one of the first to eighth auxiliary requests filed at various stages throughout the proceedings, namely with its submissions dated 15 February 2011 (first to fifth auxiliary requests), 19 September 2013 (sixth and seventh auxiliary requests) and at the oral proceedings (eighth auxiliary request). Should one of these requests be found to fulfil the requirements of Article 123(2) EPC, the appellant requested that the case be remitted to the department of first instance for further prosecution. The appellant finally requested a different apportionment of costs due to the postponement of the oral proceedings before the opposition division.

The opponent (respondent) requested that the appeal be dismissed. Should one of the appellant's requests be found to fulfil the requirements of Article 123(2) EPC, the respondent requested that the case be remitted to the department of first instance for further prosecution.

- II. Claim 1 according to the main request, which is identical to claim 1 according to the main request underlying the impugned decision, reads as follows:

"An automatic machine for processing cigarettes (2), the automatic machine (1) comprising:
a wrapping wheel (6), a belt conveyor (7), a drying conveyor (8);
a number of electric motors (14a), solenoid valves (14b) and electronic sensors (14c) interacting with the wrapping wheel (6), the belt conveyor (7) and the drying conveyor (8); and
first control means (16) for setting the automatic machine (1) to an operating condition wherein the electric motors (14a), the solenoid valves (14b) and the electronic sensors (14c) are activated coordinately to process the cigarettes (2), or to a machine stop condition wherein substantially each electric motors (14a), solenoid valves (14b) and electronic sensors (14c) is deactivated in a respective rest condition;
the machine (1) is characterized by comprising second test control means (17) for testing the automatic machine (1), when the automatic machine (1) is in the machine stop condition, by selecting at least one said electric motor (14a), solenoid valve (14b) or electronic sensor (14c) to be tested and by activating said electric motor (14a), solenoid valve (14b) or electronic sensor (14c) to be tested as of the respective rest condition and independently of the other electric motors (14a), solenoid valves (14b) and electronic sensors (14c)."

Each of the claims 1 according to the first to eighth auxiliary requests comprises the feature of claim 1 according to the main request: "the machine (1) is characterized by comprising second test control means (17) for testing the automatic machine (1)."

III. Impugned decision

The subject-matter of claim 1 according to the then and present main request has been considered as contravening Article 123(2) EPC in that the term "electronic sensor" as compared to "sensor" was considered not originally disclosed. None of the requests underlying the decision under appeal has been considered allowable in view of Articles 100(c) and 123(2) and (3) EPC.

The request of the appellant for a different apportionment of costs, as incurred due to the postponement of the oral proceedings before the opposition division has been rejected.

IV. The submissions of the appellant relevant for the present decision can be summarised as follows:

- (a) The amendment of the feature of claim 1 of the main request: "the machine (1) is characterized by comprising second test control means (17) for testing the automatic machine (1)", which is also present in the claims 1 of all auxiliary requests, does not lead to the requirement of Article 123(2) EPC being infringed.
- (b) It was the conduct of the respondent (then opponent) during the opposition proceedings which made the postponement of the oral proceedings before the opposition division necessary. It follows that for reasons of equity the respondent should bear the costs incurred due to the

postponement of the oral proceedings, namely those incurred by the then necessary cancellation of the flight and hotel bookings.

V. The submissions of the respondent relevant for the present decision can be summarised as follows:

(a) The amendment of the feature of the claims 1 of all requests: "the machine (1) is characterized by comprising second test control means (17) for testing the automatic machine (1)" leads to subject-matter extending beyond the content of the application as originally filed such that the requirement of Article 123(2) EPC is infringed.

(b) The postponement of the oral proceedings before the opposition division shortly before the appointed date was mainly due to the tardy reaction of the opposition division itself, which should and could have postponed the oral proceedings at a much earlier date. Consequently, it is the conduct of the opposition division and not of the respondent which led to extra costs due to the flight and hotel bookings having to be cancelled. It would thus run counter to the principle of procedural fairness to deviate from the general principle that each party in opposition proceedings shall bear the costs it has incurred.

VI. Oral proceedings before the Board were held on 3 December 2013, at the end of which the present decision was announced.

Reasons for the Decision

1. *Allowability of claims 1 of all requests (Article 123(2) EPC)*

1.1 One amendment objected to by the respondent as leading to subject-matter extending beyond the content of the application as originally filed concerns the following feature common to claims 1 of all requests:

"the machine (1) is characterized by comprising **second test control means (17) for testing** the automatic machine (1)" (emphasis, here and in the following, added by the Board).

1.2 To the advantage of the appellant this feature (in the following: the amended feature) is considered as reading:

"the machine (1) is characterized by comprising **second control means (17) for testing** the automatic machine (1)",

since the appellant has indicated during the oral proceedings that it would be prepared to change the expression "second test control means" into "second control means" by deleting the term "test".

1.3 The corresponding feature of claim 1 as granted reads as follows:

"the machine (1) is characterized by comprising **second control means (17) for activating** at least one said electric motor (14a), electric actuator (14b) or electric sensor (14c) **to be tested ...**"

- 1.4 The corresponding feature of claim 1 of the application as originally filed reads as follows:

"the machine (1) being characterized by comprising **second control means (17) for activating** at least one said operating member (14) **to be tested ...**".

- 1.5 Since the feature concerned has substantially the same wording for claim 1 as granted and claim 1 of the application as originally filed (the only difference concerns the expressions: "the machine (1) **is** characterized" / "the machine (1) **being** characterized"), in the following the version of the feature according to claim 1 as granted will be referred to as the "original feature".

- 1.6 It is evident that, as referred to by the respondent, the meaning of the amended feature as compared to the original feature has changed. While the amended feature refers to second **control means for testing** the automatic machine, the original feature referred to second **control means for activating** the automatic machine.

- 1.6.1 Thus, the amended feature relates to **control means having a different function** than it is the case for the original feature. For the amended feature the **function defined is testing**, whereas for the original feature the **function is activation**.

- 1.6.2 Moreover, according to the respondent the difference concerning the function also reflects on the means by which that function is obtained for each case.
- 1.7 Thus, in order to comply with the requirement of Article 123(2) EPC the amendment of the original feature must have a basis in the application as originally filed. According to the established case law of the boards of appeal this basis must be such that the amended feature is derivable, explicitly or implicitly, "directly and unambiguously" from the application as originally filed.
- 1.8 Questioned by the Board during the oral proceedings for such a basis the appellant referred to the disclosure of the original application as addressed in the following, in which reference to the published application (A-publication) is made.
- 1.8.1 According to paragraph [0011] the machine comprises a control unit 9. In paragraph [0013] it is stated "Control unit 9 comprises a program 15 for controlling automatic machine 1 and implementing a main application program 16 for controlling normal operation of automatic machine 1, and a test application program 17 for testing automatic machine 1." It is further indicated "As of a machine stop condition in which each operating member 14 is deactivated in a respective rest position, the operator can select, by means of interface device 10, whether to perform main application program 16 or test application program 17. Main application program 16 activates operating members 14 in substantially coordinated manner to overwrap

packets 2, while test application program 17 activates one test operating member 14 substantially independently of the other operating members 14."

Paragraph [0014] refers to a condition which must be fulfilled if the test application program is to be started: "For the operator to launch test application program 17, automatic machine 1 must be set to the machine stop condition, wherein each operating member 14 is in a respective rest condition". Paragraph [0015] refers to what happens if the test application is actually started: "When test application program 17 is launched, screen 13 shows an introductory display 18 (Figure 2) showing a synoptic image 19 (shown schematically) of automatic machine 1, and three push-buttons 20 by which the operator selects the type of operating member 14 for testing. More specifically, the push-button 20 indicated M selects electric motors 14a, the push-button 20 indicated E selects solenoid valves 14b, and the push-button 20 indicated S selects sensors 14c."

These disclosures are followed by those of paragraphs [0016] to [0019] relating to selections enabled via selection display 21 in case the push-button 20 indicated M, E or S is selected.

Paragraph [0020], likewise referred to by the appellant, states "Whether an electric motor, solenoid valve or sensor is selected, before allowing access to activation display 24, test application program 17 memorizes the rest condition of each operating member 14 in a known memory (not shown) of computer 11, so that, at the end of the test stage conducted by the

operator using activation display 24, each operating member 14 activated at the test stage can be restored to the respective rest condition by test application program."

1.9 It is true that, as asserted by the appellant, the portions of the description referred to above disclose that the control unit of the machine comprises a test application program, in which condition of the automatic machine this program can be started, how the type of operating member to be tested by this program can be selected and what happens at the end of a test stage.

1.9.1 Contrary to the view expressed by the appellant these disclosures, however, do not concern the actual testing of the machine.

This applies also if, as referred to by the appellant, the disclosure given by the figures is also taken into account, since no disclosure concerning the function of testing the automatic machine is derivable therefrom.

The above applies furthermore if the remainder of the disclosure of the application as originally filed is taken into account. It neither has been argued nor is it apparent for the Board that this disclosure, considered by itself or in combination with the disclosure of the paragraphs referred to above, gives any (further) information concerning the function of testing the automatic machine.

1.9.2 Consequently, the function of testing the automatic machine as referred to in the amended feature is not

derivable directly and unambiguously from the application as originally filed.

For that reason the claims 1 of all requests, which all comprise the same amended feature, do not fulfil the requirement of Article 123(2) EPC.

- 1.9.3 Moreover, this lack of original disclosure leads, as referred to by the respondent, to a further infringement of the requirement of Article 123(2) EPC.

Since the function of testing the automatic machine lacks a direct and unambiguous disclosure in the original application, this applies likewise for the element causing this function, which according to the amended feature is the **second test control means**. As a result of the lack of disclosure concerning the function as indicated above, such a means, which is mainly defined via its function, lacks likewise a direct and unambiguous disclosure in the application as originally filed.

- 1.9.4 Finally, the lack of original disclosure of the amended feature can also be seen as leading to an unwarranted advantage, as it gives technical information not disclosed in the application as originally filed.

2. As a consequence, it has to be concluded that none of the requests can be allowed.

Concerning this issue the appeal thus has to be dismissed.

3. Apportionment of costs

3.1 According to Article 104 EPC, in opposition proceedings each party shall bear the costs it has incurred, unless for reasons of equity a different apportionment of costs is ordered.

3.2 The appellant had already during the opposition proceedings requested a different apportionment of costs, namely those incurred due to the postponement of the oral proceedings before the opposition division. However, this request was rejected in the decision under appeal.

3.3 As to the events preceding the postponement of the oral proceedings:

3.3.1 The opposition division summoned to oral proceedings for 3 March 2010 and set the "final date for making written submissions and/or amendments" at 4 January 2010. Attached to the summons was a communication outlining the opposition division's preliminary opinion *inter alia* in respect of the public prior use ("Folieneinschlagmaschine TF2") alleged by the respondent, stating that, although of relevance, it could not be considered as proven, and concerning the issue of inventive step of the subject-matter of claim 1 according to each of the appellant's then three requests.

3.3.2 In replying to said communication, the appellant filed on 4 January 2010, the final date set in the aforementioned summons, amended sets of claims which

were replaced on 10 February 2010 by an even further amended main request and five auxiliary requests. The respondent filed, also on 4 January 2010, four new documents and requested the hearing of a witness for the alleged public prior use in question, without however indicating its name or address for service.

- 3.3.3 When cancelling the oral proceedings by communication of 22 February 2010, the opposition division in substance referred only to the respondent's last submissions and invited the respondent to indicate the name(s) and address(es) of the witness(es).

It is already evident from the above that the purpose of the cancellation of the oral proceedings was to follow the respondent's submissions and its request for the taking of evidence concerning the alleged public prior use in question and to give the respondent the opportunity to provide the information necessary to enable witnesses to be correctly summoned. It was only then that the respondent filed the names and addresses of two witnesses leading the opposition division to issue the order to take evidence by hearing those two witnesses.

Consequently, the fact as referred to by the respondent, that the appellant itself had submitted new requests quite late in the appeal proceedings, *i.e.* on the same day as the respondent had submitted its (incomplete) offer of evidence, obviously was not the decisive factor for the opposition division when cancelling the oral proceedings.

3.4 As established in the case law of the boards of appeal, the submission of facts and evidence at a late stage in the proceedings which causes the incurring of additional costs by the other party, may lead to a different apportionment of the costs for reasons of equity (see Case Law of the Boards of Appeal, 7th edition 2013, chapter IV.C.7.2.1, page 852 *et seq.*).

3.4.1 Thus, a decision on a different apportionment of costs according to Article 104(1) EPC, being an exception to the norm that all parties bear their own costs, only arises if the particular circumstances of the case call for it. In the Board's view, costs should be awarded against a party to proceedings if it can be held to have caused unnecessary expenses which could well have been avoided if normal care had been exercised.

3.4.2 These criteria are met in the present case since the respondent introduced important evidence, *i.e.* a request for a witness hearing on the relevant alleged public prior use, at a late stage of the proceedings, namely only two months before the date of the scheduled oral proceedings, without cogent reasons for the delay and in particular without submitting all necessary information, *i.e.* the name(s) and address(es) of the witness(es) in question. The latter was only done after a further delay of one month.

Since the prior use in question was raised and the offer of witnesses was already made with the opposition, the respondent could have come forward with the above-mentioned supporting submissions and the specific mention of witnesses for the alleged public prior use already at an earlier stage of the opposition

proceedings or, at least, directly after receiving the opposition division's summons and communication. The latter was clear on the issue of the relevance of that prior use for novelty and inventive step.

If it had submitted this material at such a point in time that the two months' time limit of Rule 118(2) EPC could have been complied with in respect of the date originally set for the oral proceedings, no postponement would have been necessary and the appellant's costs would not have been incurred unnecessarily.

Instead, the respondent waited until the final date of 4 January 2010 as set by the opposition division before submitting a "first" portion of its request pursuant to Article 117(1)(d) EPC which caused the opposition division's further communication of 22 February 2010 leading to the submission of the "second" portion with the names and addresses of the witnesses as late as on 20 April 2010.

The respondent's argument that it was faced with difficulties in locating the two witnesses, who had changed employment, cannot hold as it had sufficient time between the filing of the opposition and mention of the prior use in July 2006 and the issuance of the summons to oral proceedings in September 2009 to find both persons who were active at that time for Topack GmbH, a company within the same conglomerate as the opponent, up to the end of 2003. Further, it does not take away the **procedural** fact that the responsibility for stating its complete case, including all necessary evidence, and the risk for any failure in doing so lie

exclusively within the respondent's own sphere. As a consequence, any delay causing the incurring of additional costs by the other party remains within the respondent's sphere and liability.

3.5 It, therefore, is equitable to order that the respondent meet part of the additional costs incurred by the appellant, *i.e.* those costs caused by the cancellation of the flight and hotel bookings due to the postponement of the oral proceedings foreseen for 3 March 2010.

Order

For these reasons it is decided that:

The appeal is dismissed.

The respondent shall bear the costs incurred by the appellant due to the postponement of the oral proceedings of 3 March 2010, namely those caused by the cancellation of the flight and hotel bookings.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders