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**Datasheet for the decision
of 17 October 2013**

Case Number: T 0576/11 - 3.2.04

Application Number: 04798893.6

Publication Number: 1694145

IPC: A24C 5/34

Language of the proceedings: EN

Title of invention:

A system for monitoring and controlling machines used in the manufacture of tobacco products

Patent Proprietor:

G.D S.p.A.

Opponents:

Focke & Co. (GmbH & Co. KG)
Hauni Maschinenbau AG

Headword:

-

Relevant legal provisions:

EPC Art. 100, 108
EPC R. 115(2)

Relevant legal provisions (EPC 1973):

EPC R. 55(c)

Keyword:

"Late-filed document - admissibility into the proceedings (no)"
"Admissibility of a fresh ground for opposition and new line of attack (no)"
"Novelty and inventive step (yes)"

Decisions cited:

G 0010/91

Catchword:

-



Case Number: T 0576/11 - 3.2.04

DECISION
of the Technical Board of Appeal 3.2.04
of 17 October 2013

Appellant: Hauni Maschinenbau AG
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Respondent: G.D S.p.A.
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Party as of right: Focke & Co. (GmbH & Co. KG)
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 18 Januar 2011
rejecting the opposition filed against European
patent No. 1694145 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman: A. de Vries
Members: C. Scheibling
C. Heath

Summary of Facts and Submissions

I. By its decision dated 18 January 2011 the Opposition Division rejected the opposition. On 11 March 2011 the Appellant (opponent 2) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 13 May 2011.

The patent was opposed on the grounds based on Article 100(a) EPC (lack of novelty and inventive step).

II. Oral proceedings took place on 17 October 2013 before the Board of Appeal.

Although duly summoned, the Opponent 1 who is a party to the proceedings as of right did not appear.

According to the provisions of Rule 115(2) EPC the proceedings were continued without him.

The following documents played a role in the appeal proceedings

D1: US-A-5 284 164

D11: EP-A-0 409 443

D19: "Tobacco Engineer", pages 40 and 41

D20: WO-A-00/16647

D21: DE-A-199 25 968

D22: Page 38 of the magazine "Tobacco Engineer"

D23: M.D. Austin "Automatic calibration of Q.C. instrumentation" Lecture held at the "CORESTA" fair, Vienna, 1995

D24: "Tobacco Engineer", November 1985

D25: "Tabellenbuch Elektronik", Verlag Europalehrmittel, 2001, selected pages

- D26: "Automatisierungstechnik", Walter Jacobi, Springer Verlag, 1996, selected parts
- D27: Magazine "TR Tobacco Reporter", Volume 116, Number 10, October 1986, selected pages
- D28: "Filter Facts", "Eastman IFMAC system advances filter technology", April 1986

- III. The Appellant requests that the decision under appeal be set aside, that the patent be revoked, auxiliarily, to refer a question concerning the admission in appeal of a fresh ground for opposition to the Enlarged Board of Appeal.
- IV. The Respondent (patentee) requests that the appeal be dismissed and that the patent be maintained as granted. Further, if one the late filed documents D19 to D28 is introduced into the proceedings and the main request is rejected, it is requested to remit the case to the first instance. If the Board decides to introduce one of the documents D25 to D28 or the arguments filed therewith, it is requested to postpone the oral proceedings.
- V. Claim 1 of the main request (as granted) reads as follows:

"A system for monitoring and controlling a line (1) manufacturing tobacco products (2), comprising a plurality of production devices and units connected by way of a common interface network (48) to a respective master control unit (82,83) and/or to visual display means (84), an auxiliary inspection unit (45) associated with the manufacturing line (1), connected to the network (48) and serving to verify at least one

characteristic of tobacco products (2) taken as test samples, by which signals indicative of the at least one characteristic of the tobacco products (2) are transmitted to the network (48) **characterized in that** it comprises a processing and control unit (81) associated with each production device and unit, wherein the signal indicative of the characteristic is relayed by the auxiliary inspection unit (45) to the processing and control units (81) as a prompt for corrective action, in such a way that the auxiliary inspection unit (45) forms a part of at least one feedback control loop".

VI. The Appellant mainly argued as follows:

As regards D19 the opposition division exercised its discretion incorrectly as there was no proper assessment of its prima facie relevance. D20 should be considered as a reaction to the reasons provided with the attacked decision. D21 to D28 are cited to illustrate how given terms should be interpreted and what was part of the general knowledge at the priority date of the patent in suit.

The new novelty attacks based on D1, D7, D8 or D12 are a reaction to the Board's communication. The documents have, in any case, been extensively discussed during the opposition proceedings so that they are well known and cannot take the Respondent by surprise.

By the mere indication that the patent in suit is not patentable according to Article 100 EPC all grounds for opposition are implicitly introduced. Thus feasibility and added subject-matter EPC cannot be considered as fresh grounds for opposition, all the more claim 1 has been interpreted in a very specific way by the first

instance which justifies the introduction of new objections.

D11 is clearly novelty destroying because claim 1 is very broad in scope and should not be interpreted in a restrictive manner.

The difference (if any) between the claimed subject-matter and D11 could only be the presence of a "common interface network". Such a network is however well known and part of the general knowledge of the skilled person and thus cannot provide the basis for an inventive step.

With respect to D1 the problem would be to automate the system and to improve and simplify communication.

However, automating systems is a general trend in the technical field of machines for manufacturing tobacco products and the use of a common interface network is standard for the skilled person.

Moreover the features of claim 1 which possibly distinguish the subject-matter of claim 1 from the system of D1 are known from D11 and vice versa.

VII. The Respondent (patentee) argued as follows:

D19 has been properly considered and not admitted by the opposition division. Documents D20 to D28 should and could have been filed earlier and that there are no circumstances that could justify their late filing. According to G 010/91 fresh grounds of opposition cannot be introduced at the stage of the appeal proceedings without consent of the patentee which is not given.

D11 does not show all features of claim 1 and especially not a "common interface network".

It is not obvious for the skilled person to provide D11 with a "common interface network" since this would imply huge modifications of the system.

D1 neither discloses processing and control units associated with each production device and unit, nor a "common interface network". Thus the combination of D11 with D1 or D1 with D11 would not lead to a system comprising all features of claim 1.

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility of D19 to D28*

2.1 D19 was filed during the opposition proceedings and was not admitted into the proceedings because the opposition division considered it late filed and not more relevant than the documents already on file, reason 2 of the decision under appeal.

According to accepted jurisprudence, the Board can only consider whether the Opposition division has correctly exercised its discretion. The Board notes that the late filing of D19 was not contested. Reason 2 of the decision clearly indicates that the division assessed the prima facie relevance of D19, as is apparent from the minutes of the first instance proceedings, which indicate that the technical content of D19 has been discussed (see section 12).

As prima facie relevance is the decisive criterion in the exercise of discretion in first instance, and the division demonstrably considered D19's prima facie

relevance, the Board comes to the conclusion that the Opposition division correctly exercised its discretion.

- 2.2 The Appellant argued that D20 filed with the grounds of appeal has been cited as a response to the decision under appeal in order to show a "common interface network", a feature that was considered to be missing in the prior art by the attacked decision. However, already in the communication annexed to the summons for the oral proceedings in opposition it was indicated that neither D7 (see section 2.1.2) nor D11 (see section 2.2.2) appear to comprise a "common interface network". Thus if D20 was intended to refute this argument, it should have already been filed at this stage in response to the division's communication. As there has been no factual change in the case since, there is no justification for this late filing (see Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA) which refers to the "power of the Board to hold inadmissible facts, evidence or requests which could have been presented ... in the first instance"). Moreover, rather than supplementing the evidence used in an existing attack, D20 is cited as evidence in a completely new, independent attack on novelty. Finally, the cited passages do not appear to disclose the inspection unit as forming part of a feedback control loop, a central feature of the invention, and thus on the face of it does not appear to call into question patentability. For these reasons the Board decided to exercise its discretion not to admit D20 into the proceedings.

- 2.3 The Appellant has not referred to documents D21 to D28 which were filed with the grounds of appeal or

subsequently in the course of the appeal proceedings for assessing novelty and inventive step. Thus, they are not meant to directly call into question the validity of the patent. The Appellant mainly argued that these documents relate to the general knowledge of the skilled person. Given their diverse nature and content, the Board is unconvinced that these documents are prima facie suitable as evidence for the common knowledge of the skilled person.

Finally, the Board believes that the late admission into the proceedings of this number of documents, many of which have only been filed subsequent to the statement of the grounds of appeal or after the summons to oral proceedings before the Board, would compromise procedural economy (cf. Article 13(1), (3) RPBA). For these reasons, the Board decided to exercise its discretion not to admit D21 to D28 into the proceedings.

2.4 Since none of the late filed documents D19 to D28 has been admitted into the proceedings, the request of the Respondent for postponement or remittal to the first instance is moot.

3. *Arguments and documents not mentioned in the ground of appeal and Fresh grounds for opposition*

3.1 The appeal procedure is an independent procedure with respect to the opposition procedure. This means that the facts and arguments which have been presented before the Opposition division are not automatically part of the appeal proceedings. For the purpose of compliance with Article 108 EPC, third sentence, an appellant is obliged to state the legal and factual

grounds which constitute the basis of his challenge to the validity of the decision. It is thus not sufficient merely to indicate that the arguments presented during the opposition division are maintained to have them incorporated into the appeal proceedings.

With letter dated 6 September 2013, the Appellant presented new lines of attack based on D1, D7, D8 and D12 which have not been presented with the grounds of appeal. They therefore constitute amendments to the appellant's case in the sense of Article 13(1) RPBA. Under that article the Board is afforded discretion in admitting and considering such amendments. The article further stipulates that this discretion "shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy". In the present case, admitting these new lines of attack would amount to creating a fresh case and thus would be contrary to the need for procedural economy, all the more as this could possibly lead to a postponement of the oral proceedings. Therefore, the Board decided to exercise its discretion not to admit these lines of attack into the proceedings.

3.2 According to point 1 of the order of the decision of the Enlarged Board of Appeal G 10/91 (OJ 1993; 420) new grounds for opposition which are not covered by the statement under Rule 55(c) EPC 1973 cannot be introduced into the appeal proceeding without consent of the patentee.

The fact that the other opposing party Opponent 1 indicated in the grounds for opposition that the patent "is not patentable" according to Article 100 EPC does not mean that the opposition automatically includes all

possible grounds listed in this Article. On the contrary, only those grounds that are properly substantiated are to be considered during the proceedings. In the present case, Opponent 1 did not mention or argue in any level of detail insufficiency of disclosure or extended subject-matter in his submissions, nor indeed had he crossed the corresponding boxes in the opposition form. Such grounds were thus not raised and not substantiated. Thus, no ground for opposition based on Article 100 (b) or 100 (c) EPC was part of the opposition proceedings and therefore these grounds are fresh grounds for opposition which can only be introduced into the proceedings with the consent of the patentee. This consent has expressly been withheld.

3.3 The Board is not aware of any diverging decision with respect to "fresh grounds for opposition" so that it sees no reason to refer a question concerning the admissibility of such grounds to the Enlarged Board of Appeal.

4. *Interpretation of claim 1 of the main request*

Claim 1 refers inter alia to "a common interface network" and it is stated that a "plurality of production devices and units" as well as "an auxiliary inspection unit" are connected to this network. Furthermore, "by [the auxiliary inspection unit] signals indicative of the at least one characteristic ... are transmitted to the network". Finally, it is stated that "the signal ... is relayed by the auxiliary inspection unit (45) to the processing and control units (81) as a prompt for corrective action, in such a

way that the auxiliary inspection unit (45) forms a part of at least one feedback control loop". The inference is that the signals relayed to the processing and control units are feedback control signals and are transmitted via the common interface network. These statements define a particular control hierarchy in the system in which the auxiliary inspection unit is directly linked to the control unit via the common interface network. The signal is thus not transmitted via a central computer or distribution device. It follows from a meaningful reading of the claim's terms and their context that the "common interface network" is a network whose main function is to allow direct transmission from the auxiliary inspection unit to every control unit and vice versa.

5. *Novelty of claim 1 of the main request*

5.1 Novelty has been challenged with respect to D11. Leaving apart the question whether D11 concerns a "tobacco product" in the meaning of the patent in suit, no clear and unambiguous disclosure of a common interface network in the sense of claim 1 can be found in this document.

5.2 The Appellant submitted that the various connections shown in figure 2 of D11 and linking the different components make up a common interface network. This cannot be accepted. According to figure 2 the auxiliary inspection unit (28) delivers its signal to the system controller (36) which may or may not forward it to a regulation device (38) that issues corrective action commands to the production devices and units (22, 24).

In this hierarchy the system controller plays a central role in the communication between the inspection unit (28) and the production devices and units (22, 24); i.e. in the feedback control loop. However there is no network which allows direct connection between the units connected to said network.

6. *Inventive step of claim 1 of the main request*

6.1 Starting from D11

6.1.1 As assessed in section 5.1 above, the system of claim 1 differs from that of D11 at least in that it comprises a "common interface network".

6.1.2 The Appellant sees the problem underlying the invention in simplifying and improving the communication. A common interface network which is known per se would then be an obvious alternative for the skilled person.

6.1.3 The Board does not share this point of view. Replacing the communication lines in D11 by a common interface network would require extensive modification of the system hierarchy in D11. Indeed providing a direct feedback communication link between the inspection unit and individual process and control units obviates a central system controller resulting in a radically different hierarchy. Such a different hierarchy is not apparent from any of the cited prior art, nor does the Board hold that it is part of the skilled person's common knowledge. In the Board's view such a modification lies beyond his routine skills and abilities.

6.2 Starting from D1

6.2.1 The subject-matter of claim 1 differs from the system of D1 not only in that D1 does not disclose an automatic system but also in that it does not show a common interface network in the meaning of the invention.

6.2.2 The problem to be solved by the invention with respect to D1 can be seen in automating the system and simplifying and improving the communication.

6.2.3 In D1, figure 3, the whole system relies on a central computer 10. Thus the hierarchical system is comparable to that of D11.

Therefore, even if automating a system might be considered as a standard trend in the technical field of tobacco products manufacturing lines, the use of a common interface network would not be an obvious alternative for the skilled person for the reasons already mentioned in section 6.1.3 above.

6.3 Starting from D11 and combining it with D1 or starting from D1 and combining it with D11

Since neither D11 nor D1 discloses a system comprising a common interface network in the meaning of the invention, the combination of D11 with D1 or D1 with D11 cannot possibly result in a system including this feature and thus does not lead to the claimed subject-matter in an obvious manner.

6.4 In conclusion the Board finds that the cited prior art and common general knowledge do not render the subject-matter of the granted claim 1 obvious.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Magouliotis

A. de Vries