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**Datasheet for the decision  
of 24 October 2013**

**Case Number:** T 0910/11 - 3.2.04

**Application Number:** 03750722.5

**Publication Number:** 1603417

**IPC:** A24C5/39

**Language of the proceedings:** EN

**Title of invention:**

CIGARETTE MANUFACTURING METHOD AND MACHINE

**Patent Proprietor:**

G.D SOCIETA' PER AZIONI

**Opponent:**

Hauni Maschinenbau AG

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(a), 100(b), 100(c), 123(2)

**Keyword:**

Fresh ground for opposition based on Art. 100(b) EPC - not admitted into the proceedings  
Main request - unallowable extension of the claimed subject-matter (yes)  
New line of attack - not admitted into the proceedings  
Auxiliary request 1 - novelty (yes) - inventive step (yes)

**Decisions cited:**

T 0570/91, T 0035/95

**Catchword:**



**Beschwerdekammern  
Boards of Appeal  
Chambres de recours**

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Case Number: T 0910/11 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 24 October 2013**

**Appellant:** Hauni Maschinenbau AG  
(Opponent) Kurt-A.-Körber-Chaussee 8 - 32  
21033 Hamburg (DE)

**Respondent:** G.D SOCIETA' PER AZIONI  
(Patent Proprietor) Via Battindarno 91  
Bologna (IT)

**Representative:** Bergadano, Mirko  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
23 February 2011 concerning maintenance of the  
European Patent No. 1603417 in amended form.

**Composition of the Board:**

**Chairman:** A. de Vries  
**Members:** C. Scheibling  
T. Bokor

## **Summary of Facts and Submissions**

- I. In its interlocutory decision posted 23 February 2011, the Opposition Division found that, taking into consideration the amendments made by the patent proprietor, the European patent and the invention to which it relates met the requirements of the EPC. On 14 April 2011 the Opponent (Appellant) filed an appeal; the appeal fee was paid on 8 April 2011. The statement setting out the grounds of appeal was received on 28 June 2011.
- II. The patent was opposed on the grounds of Articles 100(a) and (c) EPC. During the opposition proceedings the introduction of a new ground of opposition based on Article 100 b) EPC was not admitted.
- III. The following documents played a role in the present proceedings
- D1: US-A- 4 651 758
  - D2: DE-A-40 28 282
  - D4: EP-A-1 285 292
  - D6: US-A-3 441 131
  - D7: US-A-4 010 096
  - D10: DE-A-1 932 312
- IV. Oral proceedings before the Board took place on 24 October 2013.
- V. The Appellant (Opponent) requests that the decision under appeal be set aside and that the patent be revoked.
- VI. The Respondent (Proprietor) requests that the appeal be dismissed. In the alternative that the decision under appeal be set aside and that the patent be maintained

in the version according to one of the auxiliary requests 1 to 8 filed with letter dated 16 January 2012, auxiliary requests 6a or 7a filed with letter dated 28 March 2013 or auxiliary request 9 filed with letter dated 19 September 2013. Additionally that a question concerning the interpretation of the claims be referred to the Enlarged Board of Appeal in case the Board would not interpret claim 1 in the light of the description and that the case be remitted to the first instance in case D10 is introduced into the proceedings.

- VII. The Appellant mainly submitted that the expression "said given weight being regulated" is so unclear that the invention cannot be carried out. The subject-matter of claim 9 of the main request introduces subject-matter that extends beyond the content of the application as filed. Claim 9 of the main request has been modified with respect to claim 9 as granted; therefore this objection is admissible.
- Claim 4 of auxiliary request 1 is also objectionable under Article 123(2) EPC.
- D10 is prima facie relevant and should therefore be admitted into the proceedings.
- The subject-matter of claim 1 is not new with respect to D2 completed by D1 or at least does not involve an inventive step when taking into account the general knowledge of the skilled person or/and the teaching of D6 or D7. Starting from D4 it would be obvious for the skilled person to replace the cleaning tower of D4 by that of D6 or D7 in order to optimise the degree of separation of the particles and so to arrive at the claimed object.

VIII. The Respondent mainly argued that it is clear for the skilled person when reading the description what is meant by "said given weight being regulated". The objections based on Article 100(c) EPC would introduce a fresh line of attack with respect to the claims as granted and should not be admitted. D2/D1 fails at least to show an upflow channel comprising an adjustable section.

D10 does not have more features in common with the invention than D6 or D7 it is thus not more relevant than the prior art already on file. Furthermore, D10 is late filed and should therefore not be introduced into the proceedings.

D6 and D7 pertain to separators that have a different way of conducting the particles to be separated and a structure which is so different from that of D2, that the skilled person would be unable to combine one of D6 or D7 with D2. Since neither D4, nor D6, nor D7 disclose to conduct the particle stream by means of a first air stream, the combination of D4 with D6 or of D4 with D7 would likewise lack this feature.

IX. Claims 1 and 9 as held allowable by the first instance read as follows:

1. "A cigarette manufacturing method comprising the step of feeding a shredded tobacco stream (4), on a cigarette manufacturing machine (1) in a given flow direction (11) and along a channel (2) extending through at least one carding unit (49) and comprising at least one output portion (51) closed by a suction conveyor belt (7) to form a mat (6) of tobacco on said suction conveyor belt (7); and a cleaning step performed upstream from said output portion (51) in said flow direction (11) to clean said shredded tobacco stream (4) and remove from the shredded tobacco stream

(4) any relatively heavy parts, such as lumps of tobacco and/or woody tobacco parts and/or foreign bodies; said channel (2) comprises a hopper (42) connected to said output portion (51) via said carding unit (49); the method being characterized in that said cleaning step being performed on said shredded tobacco stream (4) upstream from said carding unit (49) in said flow direction (11) by conducting said shredded tobacco stream (4), by means of a first air stream (36), along an input portion (9, 10, 14) of said channel (2) located upstream from said hopper (42) and extending through a node (12) connecting an intermediate point of said input portion (9,10, 14) to the top of an upflow channel (22) of a cleaning tower (13), and by preventing parts present in said shredded tobacco stream (4) and below a given weight from falling along said upflow channel (22) by means of a second air stream (30a) fed upwards along said upflow channel (22); said given weight is regulated by adjusting a section of said upflow channel (22)."

"9. A cigarette manufacturing machine comprising a suction conveyor belt (7); a channel (2) for feeding a shredded tobacco stream (4) to said suction conveyor belt (7) to form a continuous mat (6) of shredded tobacco on the suction conveyor belt (7); at least one carding unit (45,49) located along said channel (2); and cleaning means (13) located along said channel (2) to remove relatively heavy parts, such as woody tobacco parts and any foreign bodies, from said shredded tobacco stream (4); said channel (2) comprising an output portion (51) closed by said suction conveyor belt (7) and located downstream from said cleaning means (13) in a flow direction (11) of said shredded tobacco stream (4) along said channel (2); said cleaning means (13) are located, along said channel

(2), upstream from said carding unit (45, 49) in said flow direction (11); said input unit (3) comprises an input portion (9, 10, 14) of said channel (2) extending through a node (12) connecting said channel (2) to said cleaning means (13); the machine further comprising suction means (15, 20) communicating with said input portion (9, 10, 14) downstream from said node (12) to generate, along the input portion (9,10, 14), a first air stream (36) for conducting said shredded tobacco stream (4) through said node (12); the machine being characterized in that said cleaning means (13) comprise an upflow channel (22) communicating at the top with said input portion (9, 10, 14) at said node (12); and supply means (30), which are connected to the bottom of said upflow channel (22) for supplying a second air stream (30a) preventing parts present in said shredded tobacco stream (4) and below a given weight from falling along said upflow channel (22); said upflow channel (22) being defined laterally by two facing walls (24, 25) movable to and from each other to vary a section of the upflow channel (22).

- X. Auxiliary request 1 differs from the main request in that claims 9 to 18 of the main request have been deleted.

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Objection based on Article 100(b) EPC*
  - 2.1 In the notice of opposition, the ground based on insufficiency of disclosure was not invoked.  
It was raised for the first time during the oral proceedings before the first instance, which did not



introduce it into the proceedings, because it was late filed and not prima facie relevant.

Thus, the Board can only overturn this decision if the first instance has not properly exercised its discretion.

- 2.2 In the first instance proceedings the Appellant objected that claims 8 as granted was unclear. He submits that from the written submissions concerning clarity it was evident that sufficiency of disclosure was being called into question.

However, in the passage of the notice of opposition relating to claim 8 (page 11 of the notice) it is merely stated that the feature "air from outside" is unclear and not further explained by the description, but the Board finds no indication, even less an explicit statement, that this lack of clarity renders the invention unworkable. The Board fails to see any reference to insufficiency of disclosure in this passage or how it might be understood that way. Thus the Opposition division correctly exercised its discretion when refusing to introduce a ground for opposition based on Article 100 (b) EPC and the Board has no reason to overturn this decision.

- 2.3 As regards the particular aspect of the claimed invention that the Appellant sees as insufficiently disclosed, the Board adds that it is satisfied that for the skilled person when reading claim 1 using normal reading skills and with a mind willing to understand it is sufficiently clear what is meant by the expression "said given weight is regulated". This formulation refers to the the part of the claim stating "preventing parts .... below a given weight from falling ... by means of a second air stream", where "given weight"

represents a threshold value. The objectionable phrase is thus read as merely meaning that this threshold is regulated or adjusted.

3. *Main request - Objection based on Article 123(2) EPC*

3.1 The Respondent argued that this would constitute a fresh ground for opposition, which could have been raised during the first instance proceedings.

3.2 However, claim 9 has been modified by including features of claims 4, 16, 19 and 27 as granted. Claim 19 as granted was dependent on granted claim 18, which in turn depended on granted claim 17. The features of these claims have however not been incorporated into amended claim 9.

Although introduced during the opposition proceedings, this new claim 9 is therefore not a straightforward combination of dependent claims. According to Article 101(3) (a) and (b) EPC the compliance of the patent as amended with the requirements of the Convention, and thus of these amendments with the provisions of Article 123(2) EPC should thus have been checked. This examination has to be done *ex officio* by the competent department of the EPO. Since it is not clear from the minutes and the decision of the first instance whether this has been duly done with respect to claim 9 as maintained, it is incumbent on the Board to consider whether this amendment meets the requirements of Article 123(2) EPC and this ground is thus introduced into the proceedings.

3.3 The technical information that claims 17 and 18 add to the claimed subject-matter can be summarised as

follows: the cleaning unit is located along said channel upstream from said hopper, the input is defined by said hopper and the cleaning means form part of said input unit.

Granted claims 17 and 18 thus indicated the position of the cleaning means with respect to the hopper. This position is characteristic of the specific embodiment now claimed and therefore a functional and structural relationship exists between these features and the features of claim 19 as granted defining the input unit.

Omitting these features which were disclosed in combination with the features of the input unit of claim 19 results therefore in an unallowable intermediate generalisation of the claimed embodiment. Thus claim 9 does not fulfil the requirements of Article 123(2) EPC. Consequently, the main request must fail.

4. *New objection against claim 4 of auxiliary request 1*

4.1 The set of claims of auxiliary request 1 corresponds to the set of claims of the main request with the difference that claims 9 to 18 have been deleted.

4.2 The Appellant raised a new line of attack under Article 123(2) EPC against claim 4 in his letter of 14 August 2013 (section 98). This constitutes an amendment to the Appellant's case in the sense of Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA).

According to Article 13(1) RPBA the Board is afforded discretion in admitting and considering amendments to a party's case. According to this article 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 exercising this discretion the Boards must also take into consideration the provisions of Article 12(4) 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". This will be the case if no sound reason exists for filing them at a later stage.

- 4.3 In the present case the auxiliary request 4 which was held to be allowable by the first instance already comprised claim 4 which is now attacked. An objection clearly could therefore have been raised before the first instance. Nor was any explanation offered as to why this objection had not been raised earlier. In view of the absence of justification of the late filing of this new attack, the complexity of the case (due to the many issues already raised and the various procedural questions - *inter alia* admissibility of new grounds and evidence - that needed to be addressed within the framework of the oral proceedings), the current state of the proceedings and the need for procedural economy (i.e. the need to come to a final decision without postponing the oral proceedings, see also Article 13(3) RPBA), the Board decided not to admit this new line of attack into the proceedings.

5. *Auxiliary request 1 - Novelty*

5.1 Interpretation of claim 1

- 5.2 According to the established case law of the Boards of Appeal, the skilled person should rule out interpretations which are illogical or which do not make technical sense. He should try to arrive at an interpretation which is technically sensible and takes

into account the whole of the disclosure of the patent (See Case Law, 7<sup>th</sup> edition 2013, II.A.6.1, first paragraph)

- 5.3 In the present case in the statement in claim 1: "by adjusting a section" the term "section" is to be understood as meaning "cross-section" and not "portion", since there would be little or no technical meaning in "adjusting a portion". Moreover, this reading is borne out by the description, in particular figure 2 and column 2, lines 45 to 54, where the adjustment is explained in more detail, as wall 24 being "adjustable to and from wall 25 to adjust the section of the upflow channel 22" (emphasis added).

Since the Board is in agreement with the Respondent's interpretation of claim 1 his request for referring a question to the Enlarged Board of Appeal concerning this point is moot.

- 5.4 Novelty has been challenged with respect to D2 completed by D1. D2 relates to a tobacco separator which is expressly described at column 2, lines 26 to 32 for use at the feed of a cigarette making machine as described in D1. That machine, see figure 1, operates to feed shredded tobacco into a hopper in a downwards direction via a channel formed of successive stations to a carding unit 44 and ultimately to an output at 47 on a suction conveyor belt. Prefeed separation upstream of the carder 44 involves the separators taught by D2, see figures 1a to 1c, where tobacco is conducted in a stream of air 4 through the top of a cleaning tower 3 with lighter tobacco particles borne out through opening 2b and heavier objects 6a, 6b being falling towards the bottom of the cylinder-shaped housing 3 of the separator, where they can be collected under the

action of a piston 17 to counter underpressure in the cylinder.

The presence of the piston 17 at the bottom of the cylindrical housing 3 does in no way suggest but rather preclude any adjustability of its cross-section. Thus, leaving aside the question as to whether the upflow of air generated by upward movement of the piston corresponds to the second air stream in claim 1, and taking into account the interpretation of claim 1 made above, there is no indication in D2 that the cross-section of the upflow channel as shown in the figures can be adjusted, nor is this fact contested by the Appellant.

Thus, D2 does not disclose that "said given weight is regulated by adjusting a section of said upflow channel (22)".

6. *Auxiliary request 1 - Inventive step*

6.1 Late filed document D10

6.1.1 D10 was filed with letter of 24 August 2014 well after filing of the grounds of appeal. It therefore constitutes a change of the Appellant's case in the sense of Article 13 RPBA. Under paragraph (1) of that Article its admission is at the discretion of the Board. Following established jurisprudence the Board weighs the factors such as special circumstances that might justify the belated submission and whether it appears to be especially relevant.

6.1.2 The Board does not agree with the Appellant when he states that this document is a reaction to the filing of the auxiliary requests. But for the replacement of

the term "transporting" by "conducting" the wording of claim 1 of the auxiliary request which was finally held to be allowable by the first instance is the same as that of claim 1 of the corresponding auxiliary request 4 filed before the one month time limit for filing submissions before oral proceedings set by the opposition division. Moreover the wording at issue - "adjusting a section of said upflow channel" - was added from granted claim 10 and thus the particular point new document D10 is said to address could and should have been addressed already during the first instance proceedings, at the latest in response to the filing of the fourth auxiliary request. The factual framework of the case has thus not changed and there is therefore no justification for the late filing of D10.

6.1.3 Regarding the relevance of D10 (see figure 1), the Board notes that it is not immediately apparent that the jet of air from nozzle 128 (figure 2) identified by the Appellant as the first air stream conducts tobacco *along an input portion of the channel* as required by claim 1. Furthermore, the nozzle is located below the actual input channel 56 in what might be identified as an upflow channel between perforated walls 14 and 16 through which upward air flow 51,52 (as second air stream) is generated. It is therefore also not immediately clear to the Board that in D10 the input is connected to the *top* of the upflow channel. Finally, in D10 according to arrows 57 the particles are projected onto the wall 14 in order to separate particles that have agglomerated (see D10, page 10, lines 16 to 30). Though wall 14 (and wall 16) are laterally movable to change the cross-section of the upflow channels, it is not immediately clear that this is meant to regulate the weight below which the parts present in the tobacco stream fall along the upflow channel. It is thus not

immediately clear to the Board why D10 would be more pertinent than D6 or D7 which do expressly disclose such a regulation.

Thus, the Board comes to the conclusion that there is no justification for the late filing of D10 and that this document is less relevant than D6 or D7 already on file. Therefore, the Board decided not to allow D10 into the proceedings.

## 6.2 Starting from D2/D1

6.2.1 As established above in section 5, the claimed method differs from that of D2/D1 at least in that: "said given weight is regulated by adjusting a section of said upflow channel".

6.2.2 The problem underlying the invention with respect to D2/D1 can be seen in optimising the degree of separation of the particles according to their weight.

6.2.3 D6 (figures 2, 10 and 11) and D7 (figure 2) disclose separators which separate particles according to their weight by using an air stream fed upwards into an upflow channel so that it prevents parts present in the particle stream and below a given weight from falling down along said upflow channel. The threshold weight is regulated by adjusting the cross-section of said upflow channel and thus the velocity of the air stream.

6.2.4 Applying the teaching of D6 or D7 would require modifying the upflow channel of D2, which has a circular cross-section, such as to exhibit a rectangular cross-section, so that at least one of its side walls can be displaced. This however is not possible since it would not be compatible with the



cylindrical piston (17 in figure 1) at the bottom of the upflow channel.

The Appellant submitted that the skilled person would replace the whole separator of D2 by a separator according to D6 or D7. However, in D2 the particle stream is conducted by means of a first air stream whereas in D6 or D7 the particles are fed via a mechanical transporter (rotary screw 62 and rotary member 60 in D6 and air lock feeder 32 in D7). Thus, they are of a different type. Therefore, if the skilled person were to consider replacing the D2 type separator in the D1 machine by a separator as in D6 or D7 he would arrive at a machine with a method of operation in which cleaning is affected as in D6 or D7, i.e. with tobacco conducted by a mechanical transporter, not by a first air stream. He thus would not arrive at the method as claimed.

Nor does the Board consider it to be within his routine skills to combine aspects of the two alternative types of separation to arrive at a hybrid third alternative. Although a person skilled in the art is completely free in choosing a starting point, he will of course be bound afterwards by that choice. If, for instance, for whatever reason it may be, a person skilled in the art prefers and decides to start from a specific cleaning tower where the particles are conducted by an air stream as in D2, he can further develop that cleaning tower but at the end of that development the normal result will still be a cleaning tower where the particles are conducted by an air stream and not a cleaning tower where the particles are fed via a mechanical transporter (similarly, see T 570/91, point 4.4). A conscious choice of a starting point, made in the knowledge of the respective benefits and drawbacks

of the various types concerned, not only determines the subject-matter serving as a starting point but also defines the framework for further development, i.e. development within this particular type. The assertion that a skilled person would consider a change of type during the further development of the consciously chosen type, to another type, which was previously known but had not been chosen, can then only be seen as an ex-post-facto analysis (T 0035/95, point 4.4).

Therefore the Board holds that it is not obvious for the skilled person starting from a cigarette making machine as in D1 and including a cleaning tower according to D2 to arrive in obvious manner at the machine that operates according to the method of claim 1 on the basis of a cleaning tower of a different type as those shown in D6 or D7.

6.2.5 Furthermore, even if it might be general knowledge that the velocity of an air flow can be adjusted by varying the cross-section of the conduit in which it flows, for the same reason given earlier the mere presence of the piston at the bottom of the cylindrical upflow channel in D2 means that it would not be straightforward, let alone obvious for the skilled person to modify this upflow channel so that its cross-section may be adjusted.

6.3 Starting from D4

6.3.1 According to claim 1 the shredded tobacco stream is conducted by means of a first air stream. In D4, see figure 1, the shredded tobacco stream is conducted by means of rotary drums 3 and 7 before being transported by intermediate zig-zag air separator 12 and an air-tobacco separator 16 to be output as a mat on suction

conveyor belt at 41. The separators 12 and 16 are located downstream of both the input hopper (below the air sluice 1) and a feed roll 7 which can be considered to represent a first carding unit. The separators 12 and 16 are upstream of another feed roll 32, which also can be considered as a carding unit.

6.3.2 The claimed method differs from that of D4 at least in that "said given weight is regulated by adjusting a section of said upflow channel" and by "conducting said shredded tobacco stream, by means of a first air stream".

6.3.3 Thus the problem underlying the invention with respect to D4 (figure 1) can be seen in optimising the degree of separation of the particles according to their weight and in conducting the shredded tobacco stream more efficiently.

6.3.4 The Appellant submitted that the skilled person would rely on D6 or D7 in order to solve that problem.

However, as already stated above in relation to the combination of D2 with D6 and D7, these documents both teach the use a mechanical transporter for conducting the particles to the cleaning tower. Thus the combination of D4 with D6 or of D4 with D7 would still lack a first air stream for conducting the particle stream, i.e. it would not lead to the claimed method. Moreover, it seems highly unlikely that the skilled person would consider using a continuous air stream for transporting the tobacco through the air sluice 1 of figure 1 of D4 (used for dosed pneumatic feed, see column 4, lines 26 to 28) as this would be likely to interfere with and be detrimental to the proper functioning of the air separator 16.

Consequently, the Board holds that starting from D4 the skilled person would not arrive at the claimed method even if he were to consider the teachings of D6 or D7.

6.3.5 The Board concludes that the subject-matter of claim 1 of the auxiliary request involves an inventive step over the cited prior art.

7. Taking into consideration the amendments made to the patent according to the first auxiliary request the Board finds that the patent and the invention to which it relates meet the requirements of the European Patent Convention, Article 101(3)(a) EPC. The opponent did not object to the amendments made to the description in the course of the oral proceedings. The patent can therefore be maintained as amended according to this request.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to maintain the patent with the following documents.

#### Description:

- columns 1 to 4 as filed during the oral proceedings before the Board
- column 5 of the patent specification

#### Claims:

- 1 to 8 of the first auxiliary request

#### Drawings:

- Figures 1 to 4 of the patent specification

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated