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**Datasheet for the decision  
of 10 October 2013**

**Case Number:** T 2509/11 - 3.2.07

**Application Number:** 06734280.8

**Publication Number:** 1851132

**IPC:** B65D 71/00

**Language of the proceedings:** EN

**Title of invention:**  
Gusseted carton

**Applicant:**  
Graphic Packaging International, Inc.

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 10(2)(a)(i), 111(1)  
EPC R. 103(1)(a)  
RPBA Art. 11

**Keyword:**  
"Decision on the state of the file: sufficiently reasoned  
(no)"  
"Substantial procedural violation: (yes)"  
"Reimbursement of appeal fee: (yes)"

**Decisions cited:**  
T 0278/00, T 0963/02, T 1309/05, T 1356/05, T 1997/08,  
T 0071/99

**Catchword:**  
-



Case Number: T 2509/11 - 3.2.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.07  
of 10 October 2013

**Appellant:**  
(Applicant)

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**Decision under appeal:**

**Decision of the Examining Division of the  
European Patent Office posted on 14 July 2011  
refusing European patent application  
No. 06734280.8 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman:** H. Meinders  
**Members:** K. Poalas  
I. Beckedorf

## Summary of Facts and Submissions

I. The appeal lies against the decision of the examining division refusing European patent application 06 734 280.8 published as international publication WO-A-2006/084120.

II. In a **first** communication, dated 27 February 2008, the examining division raised objections as to lack of novelty of the subject-matters of the revised independent claims 1 and 12 filed on 28 August 2007 on entry into the European phase.

Under point 3 of said communication is stated:

*"The present application does not meet the requirements of Article 52(1) EPC, because the subject-matter of claim 1 is not new.*

*Document US-A-2 594 376, regarded as the closest prior art to the subject-matter of claim 1, discloses a carton having all the features of claim 1 (see in particular Fig. 1; bottom panel 12, end wall panel 16, gusset panels 23, side end panels 21, bottom formed as seen in Fig. 6).*

*The features of claim 1 are disclosed also by documents CA-C-2 160 145 (see in particular Fig. 2; bottom panel 32, gusset panels 46, 48), US-A-4 216 861 (Fig. 1; Fig. 1, bottom wall 1).*

*A similar reasoning applies to the claim 12";*

and under point 4 of the same communication is further stated:

*"The features of claims 6, 7, referring to the presence of **diamond corner panels**, appear to involve an*

**inventive step**" (emphasis added by the Board).

III. With its response, dated 25 August 2008, the applicant filed amended claims, *inter alia* introducing into the independent claims 1 and 11 the additional features of originally filed claim 4 and the last feature of originally filed claim 28. It provided also reasons as to why it considered the new claims to involve inventive step. As a precautionary measure oral proceedings were requested.

Both independent claims comprised the following "gusset panel features":

"a first pair of gusset panels (130, 140), one gusset panel (130) of the pair being foldably connected to one side of the first bottom end panel (32), and the other gusset panel (140) of the pair being connected to the other side of the first bottom end panel (32); and a first pair of side end panels (22, 42), one side end panel (22) of the pair being foldably connected to one of the gusset panels (130), and the other side end panel (42) of the pair being foldably connected to other gusset panel (140)".

IV. In a **second** communication, dated 10 September 2008, the examining division switched to document DE-U-202 06 426 (D2) and raised objections as to lack of inventive step as follows:

"[s]hould document D2 be regarded as being the closest prior art to the subject-matter of claim 1 (or 11), this document shows all the features thereof except for the gusset panels (see Fig. 1; bottom 2, top 1 6, side panels between lines A-D and D-D left of bottom panel 2, and side panels between lines C-D and D-A right of same

*bottom panel 2; lower and upper end side panels above the line 4 and below the line 5 in continuation of the abovementioned side panels).*

*Should the problem to be solved be to provide a liquid-tight bottom to the carton of D2, it is deemed obvious for the skilled person to take a look at the bottom of the carton of D2 and realise that liquid can flow through the space created, for instance, between the lower side end panels 9 and panel 3 or, in other words, at the corners of the bottom panel 2.*

*It is further regarded as obvious for the skilled person to form these corner portions with gussets in order to avoid the presence of separate panels which would allow liquid to flow. The formation of a bottom with corner gussets is deemed as well-known in the art".*

- V. The applicant responded thereto by commenting in its letter dated 19 January 2009 on the objections raised as being based on hindsight, since it introduced the solution (providing a liquid-tight bottom) in the definition of the problem. It filed a new set of amended claims, whereby *inter alia* the additional features of the originally filed claim 6 concerning the presence of "diamond corner panels" were introduced into the independent claims 1 and 10.

In the following these will be called the "diamond corner panels feature"; they are the following:  
*"a first pair of diamond corner panels, one diamond corner panel of the pair being respectively foldably connected to the first upper side panel at an oblique fold line, to one of the upper side end panels, and to*

*one of the lower side end panels, and the other diamond corner panel of the pair being respectively foldably connected to the second upper side panel at an oblique fold line, to the other upper side end panel, and to the other lower side end panel".*

It requested again as a precautionary measure oral proceedings.

VI. In a **third** communication, dated 10 March 2009, the examining division objected to the "diamond corner panels feature" that

*"However, such a solution is well-known in the art (see document US-A-6 227 367; Fig. 1, triangles 102, 122, 106, 126, etc., and position of said diamonds on the walls in Figs. 2, 3) and obvious for the skilled person wishing to provide better contact between the container walls and the bottles.*

*The applicant's argumentation regarding the alleged use of hindsight by the examiner is refuted, since the problem of providing a liquid-tight bottom is the objective problem in view of the prior art considered (document D2). The applicant cannot simply ignore this problem and claim that it does not exist".*

It concluded that the subject-matters of the independent claims 1 and 10 of the then valid request do not involve an inventive step.

It informed further the applicant that "[i]f the next set of claims will not comprise inventive independent claims oral proceedings will be called", see point 2,

last sentence of said third communication.

VII. With its response of 7 July 2009 the applicant filed a main request with independent claims 1 and 9 being identical with the independent claims 1 and 10 of the request dated 19 January 2009 and an auxiliary request with independent claims 1 and 8, which are further limited as far as it concerns the "gusset panel feature" in that there is a second pair of such panels. The liquid-tight bottom receptacle is further limited in that it *"is formed from a continuous section of a folded material of a blank and comprises a portion of the carton (160) having an upper border below which no glued seams are formed"*. It argued that the "gusset panels feature", "diamond corner panels feature" and the liquid-tight bottom together provided a combinatory effect and should not be seen as a mere aggregation of independent features. It requested again as precautionary measure oral proceedings.

VIII. In a **fourth** communication, dated 28 July 2009, the examining division stated under point 1 referring to applicant's main request that *"the arguments provided by the first examiner in the previous communication remain further valid"*.

It stated further that the subject-matter of claim 1 of the auxiliary request does not involve an inventive step when starting from D2 as closest prior art, as follows:

*"[s]hould the problem to be solved be the provision of a fluid-tight bottom having the bottom 2 of D2 as a base, it would be obvious for the skilled person to introduce gusset panels in the bottom areas where there*

*is space between the panels, i.e., between the panels 3 and 9 (see Fig. 1 of D2).*

*The use of gusset panels for providing fluid-tightness is well known in the art and needs no further documentation".*

Furthermore, the following was stated in the last sentence of point 3 of said communication:

*"The applicant has the choice of a decision according to the state of the file as an alternative to **oral proceedings**, which are deemed to be **time consuming** on both sides while **not leading to grant**" (emphasis added by the Board).*

IX. In its response dated 3 December 2009, the applicant stated under point I:

*"Given that there is not to be seen a **comprehensive assessment** of the overall teaching of the restricted claims filed under the auxiliary request and in consideration of the fruitless discussion of the instant invention in the examination proceedings up to now, it is refrained from filing anew a written statement dealing with the relevant aspects to be considered. Rather, it is requested to set a date for oral proceedings under Art. 116 EPC" (emphasis added by the Board).*

Referring back to the last sentence of the examining division's fourth communication, the applicant presumed **prejudice** by the primary examiner with regard to any kind of arguments to be put forward by the applicant during the oral proceedings and requested his **exclusion**



from the further proceedings including the oral proceedings.

- X. In a **fifth** communication, dated 26 July 2010, the examining division informed the applicant as follows:

*"While acknowledging that the wording of the previous communication could have been improved, its meaning, as explained by the first examiner, was nothing else than a statement to the fact that the subject-matter of the claims on file was not deemed to be inventive. Should the applicant combine features from the description there is, of course, the possibility that a consequently amended claim may lead to a patent.*

*There is absolutely no bias on the first examiner's side, especially since the applicant's patent attorney has had several files dealt with by the first examiner and even followed his suggestions in order to speed up the grant.*

*Consequently, the first examiner will be part of the proceedings".*

Finally, "[t]he objections raised in the previous communication of July 28 remain valid. The oral proceedings can be avoided if the applicant filed a set of claims with an independent claim **distinguished from the prior art**". (emphasis added by the Board).

XI. With its fax of 8 November 2010 the applicant withdrew its auxiliary request for oral proceedings and requested an appealable decision according to the state of the file.

XII. The decision to refuse the application was issued on EPO Form 2061 and posted on 14 July 2011. The decision refers to the second, third and fourth communications of the examining division. The full text of the grounds for the decision reads as follows:

*"In the communication(s) dated 10.09.2008, 10.03.2009, 28.07.2009 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.  
The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on .(sic)  
The application must therefore be refused."*

XIII. In the statement with its grounds of appeal the appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the main request or on the basis of the first auxiliary request, both requests as filed with the letter of 7 July 2009 and refused in the impugned decision, or on the basis of the second auxiliary request filed together with the appeal. Auxiliarily oral proceedings are requested.

XIV. During a telephone conversation on 10 September 2013 with the rapporteur the appellant was informed that the Board considers that a procedural violation has occurred during the examination proceedings and that it intends to remit the case to the examining division for further prosecution.

The appellant stated that under these circumstances it withdraws its auxiliary request for oral proceedings.

XV. The Board was then in position to decide the present case in written proceedings.

### **Reasons for the decision**

1. Pursuant to Article 106(1) EPC an appeal shall lie from decisions of *inter alia* the examining divisions. According to Rule 111(2) EPC the decisions of the European Patent Office open to appeal shall be reasoned.
2. The function of appeal proceedings is to give a judicial decision upon the correctness of an earlier decision taken by a first instance department. A reasoned decision meeting the requirements of Rule 111(2) EPC is accordingly a prerequisite for the examination of the appeal.
3. It is established jurisprudence of the Boards of Appeal that for a decision to be reasoned it must contain a logical sequence of arguments and that all facts, evidence and arguments essential to the decision must be discussed in detail (see for instance T 278/00, OJ EPO 2003, 546, points 2 - 4; T 1997/08, not published

in OJ EPO, point 4 of the reasons).

4. The Boards of Appeal have consistently decided further that a request for a decision based on the current state of the file does not mean that the party gives up its right to a reasoned decision (see T 1356/05, point 15 of the reasons; T 1309/05, point 3.7 of the reasons, both not published in OJ EPO). It simply means that the party does not wish to further comment on the case.
  
5. It follows from the above that, if a decision is to be reasoned by reference to one or more previous communications, the requirement of Rule 111(2) EPC is only met if the referenced communications themselves fulfil the above mentioned requirements. The decisive reasons for refusal must be clear to the appellant and to the Board of Appeal from the reference. This applies, in particular, if reference is made to more than one preceding communication, dealing with different issues and/or having as basis different sets of claims. A complete chain of reasoning has to be directly derivable from the referenced communications and it must not be left to the Board and the appellant to speculate as to which part of an incomplete reasoning given in preceding communications might be essential to the decision to refuse the application (see T 963/02, not published in OJ EPO, point 2.1).
  
6. With its fax of 8 November 2010 the applicant withdrew its auxiliary request for oral proceedings and requested an appealable decision according to the state of the file, see point XI above.

The decision to refuse the application is of a standard form and as such neither specifies the grounds upon which it is based, nor contains any facts, evidence or arguments that justify the refusal of the application. It contains solely a reference to three communications, namely those of 10 September 2008, 10 March 2009 and 28 July 2009 issued in the course of the examination of the application, each of these communications having as basis different sets of claims, see points II to VIII above.

7. The above has the consequence that, in order for the Board to be in the position of reviewing the decision under appeal, it would have to examine each of the cited communications for the facts, evidence and arguments that might support the refusal of the application and would have to piece the relevant parts together to arrive at the reasoning applicable to the present main and first auxiliary requests.
  
8. As far as it concerns independent claims 1 and 9 according to the **main request** refused by the examining division the Board finds as follows.
  - 8.1 According to the second and third communication (see points IV to VIII above) the subject-matters of independent claims 1 and 9 according to the main request distinguish themselves from the carton disclosed in D2 by the "gusset panel feature" and the "diamond corner panel feature". The fourth communication merely confirms the previous two communications. Neither communication clearly sets out what feature it actually considers distinguishing as the "gusset panel feature", nor which features

constitute the "diamond corner panels feature" that is distinguishing.

- 8.2 The Board notes that the Guidelines for Examination in the EPO applicable at that time (versions December 2007 and April 2009), see C-IV, 11.7, first paragraph state that *"in order to assess inventive step in an objective and predictable manner, **the examiner should normally apply the so-called "problem-and-solution approach"**".*

In this approach it is required to establish the closest prior art, the difference(s) of the claimed invention over this closest prior art and the objective problem to be solved. The latter means the aim and the task of modifying or adapting the closest prior art to provide the technical effects that this (these) difference(s) provide(s) over the closest prior art. When several distinct differentiating features dealing eventually with different technical problems are recognised it has to be assessed whether a synergistic effect exists between said differentiating features. If this is not the case also that aspect should be reasoned.

- 8.3 No such "problem-and-solution-approach" can be deduced from these two communications. They do not properly cite the distinguishing features, nor the effects obtained thereby.
- Further, as regards the "gusset panel feature" the examining division does not provide any (documentary) basis for its allegation that the skilled person would obviously provide them for obtaining a liquid-tight bottom, nor does it refute the hindsight-argument of the appellant. As regards the "diamond corner panels

feature" it only provides the information and the statement that the skilled person would provide such for a better contact between the container walls and the bottles. None of the communications discusses the possible relationship between these two features, none deals with the appellant's argument that there is a combinatory (synergistic) effect of these two features.

8.4 As a result the Board can only establish that what it can "piece together" from the communications falls definitely short of a proper reasoning on lack of inventive step where two distinguishing technical features are concerned.

9. As far as it concerns the independent claims 1 and 8 according to the **auxiliary request** refused by the examining division the Board finds as follows.

9.1 Again, the distinguishing features are not properly defined, in particular the further feature that the "liquid-tight bottom receptacle is formed from a continuous section of folded material of a blank and comprises a portion of the carton having an upper border below which no glued seams are formed" is nowhere mentioned.

9.2 Again, no "problem-and-solution-approach" is presented. This counts in particular for the additional feature of the absence of glued seams below an upper border in the liquid-tight bottom of the carton.

9.3 As a result, also this falls short of a proper reasoning on lack of inventive step where two (or even

three) distinguishing features are established.

10. The impugned decision is therefore at odds with the well established principle that, for a decision to be reasoned within the meaning of Rule 111(2) EPC, it must be self-contained, i.e. it must include all and each of the facts, evidence and arguments that are essential to the decision, and provide a chain of reasoning that is complete.
11. In the Board's judgment, this *de facto* absence of reasoning in the appealed decision amounts to a substantial procedural violation. Such a procedural violation requires that the decision under appeal be set aside and the case remitted to the department of first instance in application of Article 111(1) EPC and Article 11 RPBA.
12. Although the appellant has not requested reimbursement of the appeal fee, the Board considers it in the present case to be equitable that the appeal fee be reimbursed, Rule 103(1) (a) EPC.
13. *Further prosecution*
  - 13.1 The Board takes note of the appellant's argument that the statement in the last sentence of the examining division's fourth communication that oral proceedings are deemed to be time consuming while not leading to grant "*makes the responsible examiner appear prejudiced with regard to arguments to be discussed during the hearing and thus suspected of partiality*".



13.2 In the last sentence of its fifth communication the examining division invites the applicant to file independent claims "*with an independent claim distinguished from the prior art*".

This invitation does not appear to be helpful in view of the fact that the appellant, by then, had filed independent claims which - as acknowledged by the examining division - were already distinguished from the prior art by two, if not three, different features.

13.3 In view of the above and with respect to the applicant's request dated 3 December 2009 to exclude the primary examiner from the further proceedings the Board wishes to make reference to decision T 71/99, not published in OJ EPO. In point 4 of the reasons it is observed that it follows from Article 10(2) (a) and (i) EPC that the organisation of the (examining and opposition) divisions is under the responsibility of the President of the office, who in practice delegates this power to the director via the responsible vice-president and principal director. Therefore, it is the responsible director who should consider whether the appellant's request for a change in composition may be justified in view of the procedural history of the present case and the remarks made in the communications with respect to the chances of success for the application when holding oral proceedings: "*The applicant has the choice of a decision according to the state of the file as an alternative to oral proceedings, which are deemed to be time consuming on both sides while not leading to grant*".

**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 for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders