

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 2 October 2015**

Case Number: T 2585/11 - 3.2.04

Application Number: 04701640.7

Publication Number: 1587380

IPC: A24C5/00, B65B19/28

Language of the proceedings: EN

Title of invention:

A METHOD OF MANAGING A SYSTEM FOR THE MANUFACTURE OF TOBACCO PRODUCTS

Patent Proprietor:

G.D S.p.A.

Opponent:

Focke & Co. (GmbH & Co. KG)

Headword:

Relevant legal provisions:

EPC Art. 123(2), 123(3)
EPC R. 103(1)(a)

Keyword:

Amendments - added subject-matter
(yes) (main request, auxiliary requests 1,2,4,5) -
scope of protection extended (yes) (auxiliary request 3)
Reimbursement of appeal fee - (no)
Remittal to the department of first instance - (no)

Decisions cited:

G 0002/10

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2585/11 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 2 October 2015

Appellant:
(Patent Proprietor)

G.D S.p.A.
Via Battindarno, 91
40133 Bologna (IT)

Representative:

Bianciardi, Ezio
Bugnion S.p.A.
Via di Corticella, 87
40128 Bologna (IT)

Respondent:
(Opponent)

Focke & Co. (GmbH & Co. KG)
Siemensstrasse 10
27283 Verden (DE)

Representative:

Bolte, Erich
Meissner, Bolte & Partner GbR
Patentanwälte
Hollerallee 73
28209 Bremen (DE)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 25 October 2011
revoking European patent No. 1587380 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman A. de Vries
Members: J. Wright
C. Heath

Summary of Facts and Submissions

- I. The appellant (proprietor) lodged an appeal, received on 19 December 2011, against the opposition division's decision of 25 October 2011 revoking European patent no. EP-B-1587380. The appeal fee was paid at the same time. The statement setting out the grounds was received on 21 February 2012.

- II. Opposition was filed against the patent as a whole and based inter alia on the opposition ground mentioned in Article 100(c) together with 123(2) EPC (added subject matter). The opposition division held that this opposition ground prejudiced the maintenance of the patent as granted (decision grounds, point 3.1), and that claim 1 according to various auxiliary requests also added subject matter extending beyond the application as filed, contrary to Article 123(2) EPC (decision grounds, points 4 to 6).

- III. Oral proceedings were duly held before the Board on 2 October 2015 in the absence of the respondent who had been duly summoned and who had informed the Board in a letter received 16 September 2015 that they would not attend the oral proceedings.

- IV. The appellant requests that the decision under appeal be set aside and the patent maintained as granted as main request. Alternatively, they request that the decision under appeal be set aside and the patent be maintained in an amended form, according to the claims of auxiliary requests 1 to 5, all filed with the statement of grounds of appeal, in the alternative that the case be remitted to the first instance for further prosecution based on one of these requests. The

appellant additionally requests reimbursement of the appeal fee.

The respondent (opponent) requests that the appeal be dismissed.

V. The wording of claim 1 of the requests is as follows:

Main Request (as granted)

"A method of managing a system for the manufacture of tobacco products comprising a plurality of machines, typically cigarette makers, cigarette packers, cartoners, cellophaners, parcellers and the like, turning out products consisting respectively in cigarettes, packets, cartons, overwrapped packets or cartons, and packs or boxes, wherein the machines of the system can be supplied respectively with wrapping materials consisting typically in paper, metal foil, polypropylene and like, also with additional and/or auxiliary materials consisting typically in revenue stamps, coupons and the like, characterized in that it includes at least the steps of:

- programming a number (P_n) into a master control unit, representing a nominal production target for at least one predetermined product among those turned out by the machines of the system;
- programming a value (C_{max}) into the master control unit, representing the maximum output capacity of the system expressed as a quantity of the predetermined product;
- counting the number (P) of at least one of the products emerging from the relative machine of the system and relaying a corresponding item of data to the master control unit;

- running a first check on the actual quantity (C_1) of the predetermined product turned out by the system, at a moment (t_1) when the number (P) of emerging products equals a value (P_r) such as will result in a match ($P_n = P_r + C_{max}$) between the nominal production target (P_n) for the predetermined product and the sum of the number (P_r) of products turned out plus the value (C_{max}) indicating the maximum output capacity of the system, the actual quantity (C_1) expressing the real number of products in the making in the system, such number indicating the actual quantity (C_1) being obtained by controlling and/or counting one or more countable parameters necessary for carrying out the tobacco manufacturing;
- comparing the value of the actual quantity (C_1) registering at the first check with the value (C_{max}) indicating the maximum output capacity of the system, in order to establish what action should be applied to the system on the basis of the comparison"

Claim 1 of the *first auxiliary request* reads as that of the main request except that, after the wording "- programming a value (C_{max}) into the master control unit, representing the maximum output capacity of the system", the following wording is added: "in terms of the maximum quantity of products in process that the system can accommodate, the value (C_{max}) being" and in that the wording:

"the actual quantity (C_1) expressing the real number of products in the making in the system, such number indicating the actual quantity (C_1) being obtained by controlling and/or counting one or more countable parameters necessary for carrying out the tobacco manufacturing;" is replaced by the wording:

"the actual quantity (C1) expressing the actual output capacity of the system at the moment (t1), the actual quantity (C1) being obtained on the basis of input data received from counters (20, 21, 22, 23, 24, 25, 32) and/or sensors (8a, 26, 27, 28, 29, 30, 31) associated with each of the machines of the system;"

Claim 1 of the *second auxiliary request* reads as that of the first auxiliary request, except that the wording: "the actual quantity (C1) being obtained on the basis of input data received from counters (20, 21, 22, 23, 24, 25, 32) and/or sensors (8a, 26, 27, 28, 29, 30, 31) associated with each of the machines of the system;" is replaced by the wording:

"a control signal being relayed from a comparison block (39) indicating the step of verifying the condition ($P_n = P_r + C_{max}$) to a successive monitoring block (40) which is in receipt of input signals from counters (20, 21, 22, 23, 24, 25, 32) and sensors (8a, 26, 27, 28, 29, 30, 31), of which the outputs are connected to the master control unit (33), and capable of running the first check on the basis of the input data to verify the actual quantity C1;"

Claim 1 of the *third auxiliary request* is the same as the second auxiliary request, except that the wording: "the actual quantity (C1) expressing the actual output capacity of the system at the moment (t1)" is deleted.

Claim 1 of the *fourth auxiliary request* is the same as claim 1 of the main request, except that at the end of the claim the following wording is added:

"initiating a procedure for changeover to another brand of tobacco products in the event that the actual quantity (C1) of products registering at the moment of the first check is substantially equal to the value (Cmax) indicating the maximum output capacity of the system."

Claim 1 of the *fifth auxiliary request* is the same as claim 1 of the first auxiliary request with the following wording added at the end of the claim:

"initiating a procedure for changeover to another brand of tobacco products in the event that the actual quantity (C1) of products registering at the moment of the first check is substantially equal to the value (Cmax) indicating the maximum output capacity of the system."

VI. The appellant argued as follows:

"Products turned out by the system" mean those produced by the system. Here products mean not necessarily final products but can be intermediate products. However, the decision was wrong in considering that this means they have left the system. This is never stated in the definitions of C1 in the application as filed. Furthermore, such a definition would be the same as the definition of the parameter P which would make no sense. Furthermore this would mean that C1 would be greater than Cmax, which is not possible because C_{i-1} must always be less than C_i .

C1 and Cmax are related, because they use the same letter. Therefore C1, like Cmax defines products which are still in the system. Because the aim of the invention is to avoid that products remain in the

system at the end of a production cycle, C1 must mean the products still in the system at the time t1, because it is the only meaningful parameter which could be used to decide when to start a product changeover process when compared to Cmax.

Regarding auxiliary requests 1, 2 and 5 these replace the definition of C1 of the main request with an equivalent worded definition, more closely corresponding to the original definition of parameter Cmax.

Auxiliary request 3 removes the definition of C1 as the real number of products in the making, which the decision found to add subject matter.

Auxiliary request 4 combines granted claims 1 and 2 and does not add subject matter for the same reasons as apply to the main request.

The opposition division's decision to deal with added subject matter before lack of disclosure was a substantial procedural violation justifying reimbursement of the appeal fee.

VII. The respondent argued as follows:

Regarding the main request, the newly added definition of C1 as the real number of products in the making in the system adds subject matter beyond the application as filed. The original definition of C1 was the number of products turned out, that is produced by the system. Nothing in the description suggests otherwise. In the application as filed, C1 is consistently defined as the products turned out, not those still in the system as the added definition of C1 requires. The parameters C1

and Cmax are not said to be related in the application as filed. If this meaning had been intended it would have appeared in the original application. The application strictly distinguishes between what is turned out, meaning what has left the system and what remains in the system. This latter is never associated with the quantity C1 as the added feature now requires.

Auxiliary requests 1, 2 and 5 add subject matter beyond the application as filed because the additional definition of C1, which follows the wording of parameter Cmax, has no literal basis. Nor does the definition of Cmax imply such a basis, since C1 and Cmax are different parameters.

Auxiliary request 3 deletes the definition of C1 in granted claim 1 as the real number of products in the making in the system. Therefore the protection conferred by the claim is extended.

Auxiliary request 4 adds subject matter beyond the application as filed for the same reasons as apply to the main request.

Reasons for the Decision

1. The appeal is admissible.
2. Background

The patent concerns a method of managing a system for manufacturing tobacco products (specification, paragraph [0001]). Such systems generally comprise machines linked along a common production line that makes cigarettes in short production runs

(specification, paragraph [0005]). If the system is not optimally managed, materials may be wasted or overproduction occur at the changeover between different brands (specification, paragraph [0006]). The patent aims to solve this problem (specification, paragraph [0007]). The system is managed on the basis of a quantity C1, amongst other parameters, that is defined in all versions of Claim 1 (cf. specification, paragraphs [0022] to [0024]).

3. Main request, added subject matter

Claim 1 as originally filed, and indeed as granted, defines the quantity C1 as "the actual quantity (C1) of the predetermined product turned out by the system, at a moment (t1)".

Claim 1 of the main request (as granted) has been amended, *inter alia*, to add a further definition of C1 which reads as follows: "the actual quantity (C1) expressing the real number of products in the making in the system, such number indicating the actual quantity (C1) being obtained by controlling and/or counting one or more countable parameters necessary for carrying out the tobacco manufacturing". In the decision under appeal the opposition division held that this amendment added subject matter contrary to the requirements of Article 123(2) EPC.

3.1 All parties acknowledge that the added feature has no literal basis in the original documents as filed. The issue to be decided is whether the skilled person would derive the feature "directly and unambiguously using common general knowledge" from the whole of the documents filed, that is the description, claims and

drawings read as a whole (see e.g. G0002/10 OJ 2012, 376, reasons 4.3, first paragraph).

- 3.1.1 Considering first the original definition of C1, maintained in granted claim 1 (quantity of predetermined product turned out by the system...), and leaving aside for the moment the question as to whether the *quantity of product* is still in the system or not, it is common ground that here *turned out by the system* means produced by the system. Furthermore, the Board notes that the claim makes clear (lines 1-7) that the predetermined product is not necessarily the final product of the system, that is the boxes 15 emerging from the parceller 14, but can also include intermediate products such as the cigarettes 4 emerging from the cigarette maker 3 (cf. specification, paragraph [0032]).

It is also common ground that the definition of C1 added to claim 1, the real number of products in the making in the system, defines C1 as the number of products which have not yet emerged from the system, that is products which are still in the system.

- 3.1.2 The appellant has argued that the skilled person, reading the application as filed would have immediately understood C1 to have the above added definition (products in the making) since only this parameter, when compared with the maximum quantity C_{\max} of boxes the system was able to produce, gives a meaningful result for achieving the patent's stated aim of managing a tobacco product system to minimise waste. In particular, this is a result useful in deciding when to change over to manufacturing a different brand of cigarette (cf. specification, paragraphs [0006] and [0007]).

Bearing in mind the criteria for deciding on extension of subject matter (see point 3.1 above), the Board notes that it is not, per se, an issue for this decision whether or not comparing the actual quantity of products produced by the system and still in the system, to a parameter C_{\max} , would deliver a meaningful result for deciding when to change over production to a different brand. However plausible it may be that the real number of products in the making in the system would be a useful parameter to know in order to decide such a changeover, this sheds no light on whether or not the new definition of C1 was originally disclosed, that is directly and unambiguously derivable from the application as filed.

By the same token it is not relevant whether or not the skilled person might possibly interpret C1 to be the same as another parameter P or to exceed C_{\max} , if it did not have this new definition. At most such considerations might raise doubts in the skilled person's mind as to how the invention was to be carried out, but again could not demonstrate original filing of the newly added definition of C1.

Rather, to decide whether subject matter has been extended, the Board must put itself in the position of the skilled person reading the application as filed without knowledge of the new definition of C1 (quantity of products in the making), in order to determine whether or not it was directly and unambiguously disclosed there.

- 3.2 The Board does not believe that a skilled person, approaching the application for the very first time and without knowledge of the new definition of the

parameter C1, would be able to positively identify it, let alone derive it directly and unambiguously.

- 3.2.1 As explained above, original claim 1 furnishes the reader with a definition of C1 as the number of products turned out at a moment t1. Nothing in the wording of this definition gives any hint as to whether this number includes those products that are still in the system, those that have already left the system or a mixture of the two. The products have merely been produced.

Nor do the definitions of C1 in the description suggest anything different. C1 is first defined on page 8, lines 18 to 19. Here, consistent with the claim, C1 is *the actual quantity of products 15 turned out by the system 1*. Then again on page 9, lines 28-29 it is *the actual quantity of boxes 15 turned out by the system 1 at the predetermined moment t1*. Elsewhere C1 is mentioned as *the actual quantity of products* (page 10, line 7; page 14, line 5), or merely as a *value* (page 10, lines 12, 22 and 28, page 14, lines 7, 11, 17).

The literal definitions of C1 in the application as filed therefore give the skilled person a consistent picture of C1 as products turned out by the system, but it remains ambiguous as to whether or not these are still in the system.

- 3.2.2 Nor does the Board find any implicit disclosure that C1 should be only produced products that have not yet left the system as the new definition of C1 requires. If the skilled person were to look into how C1 is derived, they would not find this suggested (see page 9, lines 19-30, in conjunction with page 5, line 20, to page 6, line 23, and figures 1 and 2).

The monitoring block 40 of figure 2 represents the step of deriving parameter C1 on the basis of data input from counters 20-25, 32 and sensors 26-31 and 8a. The counters count products turned out by individual machines (page 5, lines 22-24), whereas the sensors 26-31 indicate materials 18, 19 consumed by the various machines (page 6, lines 5-10). Finally the sensor 8a monitors the number of cigarettes in a buffer 8 (page 6, lines 24-26).

All the counters tell the central control unit, not what is in the individual machines, but what they have produced. In other words what has left that particular machine. At best the counter 25, being at the end of the system, could count boxes 15 finally leaving the system. However, none of the counters could count products still in the system. For example the counter 20 can count the cigarettes 4 leaving the cigarette maker 3 but it cannot count whether those cigarettes are still in the system, for example in the cartoner 12, or have long left the system and are, for example, on a truck.

So too the sensors 26-31 monitor *consumption* of materials by the various machines, thus what has been used, not what is still available in the system (see application as filed, page 6, lines 7, 8, 13 and 18-20). Material consumption might indicate how many products the machines have produced, but, as with the counters, not whether those products are still in the system.

Only the sensor 8a provides information on how many cigarettes are in a particular part of the system, namely the buffer 8 (page 6, lines 24-27). However,

this still leaves the number of cigarettes in the rest of the system unknown, for example those on conveyor belts or in any of the various machines.

Therefore, at best the skilled person would realise that the system described in the application as filed and shown in the associated drawings was capable of providing a quantity for each predetermined product turned out by the system, as claim 1 and the description originally defined C1 to be. They might also realise that counted products could be products that are still in the system, that is in the making, or products that have left the system, or a mixture of both. This realisation would lead them to discount the idea that the quantity C1 was necessarily entirely composed of products which had left the system (cf. impugned decision, reasons 3.1.1). However, by the same token they would also discount the notion that the quantity C1 derived from the various counters could only be, that is unambiguously defined, the real number of produced products which are still in the system. In other words, even considering what the application implicitly discloses, there is no direct and unambiguous disclosure that the actual quantity C1 expresses the real number of products in the making in the system, as present claim 1 now requires.

3.2.3 Nor is the board convinced that because both C_{\max} and C1 use the letter C, their definitions should in some way correspond, let alone constitute a direct and unambiguous indication that the definition of C1 should be supplemented by an adapted definition of C_{\max} . As explained above, C1 is already defined in a consistent way in the application as filed, and the skilled person would not question this definition or interpret it in a narrower way, merely because a different parameter

shared a common letter, as indeed is often the case in patent literature. For example, in the present patent the letter P is common to parameters variously defined as a nominal target number of products P_n , the number of products turned out by a machine P and a system reference value P_r (specification, paragraphs [0020], [0022] and [0023]).

Furthermore, in the Board's opinion, the skilled person would not seek, let alone directly and unambiguously arrive at, the additional definition of C1 now claimed because the claim requires the two quantities C1 and C_{max} to be compared (claim 1 as filed and as granted, last feature). At most the skilled person might realise that since they are compared the units of the two parameters should be the same, for example boxes of cigarettes, but not that their definitions should be somehow analogous.

- 3.3 Thus, in the board's view, the skilled person is consistently presented with only one definition of C1 in the application as filed, namely that stated in original claim 1 (actual quantity of product turned out). By contrast, the additional information that C1 should be a quantity expressing the real number of products in the making in the system, as now claimed, is not directly and unambiguously derivable from the application as filed.

Therefore the amendment in granted claim 1 of the main request contains subject matter extending beyond the application as filed, so is contrary to the requirements of Article 123(2) EPC. For these reasons the main request must fail.

4. Auxiliary requests

4.1 Auxiliary requests 1, 2 and 5

Claim 1 of these requests all remove the following feature of granted claim 1: "the actual quantity (C1) expressing the real number of products in the making in the system," and replace it by the feature: "the actual quantity (C1) expressing the actual output capacity of the system at the moment (t1)".

It is common ground that there is no literal basis for the new (actual output capacity) feature in the application as filed.

As with the main request, the Board must therefore examine whether the skilled person would derive the feature directly and unambiguously using common general knowledge from the application documents as filed (see above, point 3.1).

The appellant has argued that the feature is derived from the definition of C_{\max} as indicating the maximum output capacity of the system 1 (application, page 7, lines 13 to 17).

As explained above (point 3.2.3) neither the fact that C1 and C_{\max} have the same reference letter, nor the fact that the original claim 1 requires them to be compared, means that they should have an analogous definition. Therefore the new definition of C1 (actual output capacity) is not directly and unambiguously derivable from the original definition of C_{\max} .

Just as for the main request, the application as filed presents the skilled person with a consistent literal definition of C1 as *the actual quantity of products 15*

turned out by the system 1, not as the actual output capacity of the system (see above, point 3.2.1).

Furthermore, as also explained above (see point 3.2.2), if the skilled person were to investigate how the parameter C1 is derived from the outputs of counters and sensors, they would also not find an implicit disclosure of the various counters and sensors in the system delivered a quantity expressing the real number of products being made *in* the system, that is having been produced but not having left the system. As the appellant has argued, it is this quantity that can be made into cigarettes, so it could be a measure of the capacity of the system at a given moment. Since, even considering what the application implicitly discloses, there is no original disclosure of the quantity by which the capacity could be measured, it follows that there is no direct and unambiguous disclosure of this new definition of C1 (actual output capacity at moment t1) in the application as filed.

Without prejudice to the question as to whether or not the amendments to claim 1 of these requests result in an extension in the protection conferred by the patent, Article 123(3) EPC, the Board concludes that the new definition of C1 (actual output capacity at moment t1) present in all versions of claim 1, adds subject matter extending beyond the application as filed. Therefore the subject matter of claim 1 of these requests does not meet the requirements of Article 123(2) EPC.

4.2 Auxiliary request 3

Claim 1 of this request has been amended with respect to claim 1 as granted, *inter alia*, by deleting without substitution, the feature additionally defining the

quantity (C1) as expressing the real number of products in the making in the system, and that it is obtained by controlling and/or counting one or more countable parameters necessary for carrying out tobacco manufacturing. In defining the subject-matter for which protection is sought in granted claim 1, the above additional definition of quantity C1 represents a limitation of the scope of protection conferred by the patent. By removing this limitation the protection conferred is extended. The Board concludes that this amendment is contrary to the requirements of Article 123(3) EPC.

4.3 Auxiliary request 4

Claim 1 of this request contains the same additional definition of C1 (the real number of products in the making) as granted claim 1. As explained above (section 3), this subject matter has no basis in the application as filed. Therefore for the same reasons as the main request, claim 1 of this request adds subject matter extending beyond the application as filed so does not meet the requirements of Article 123(2) EPC.

5. Since none of the requests on file are allowable, the Board confirms the opposition division's decision to revoke the patent.

6. Request for remittal & Reimbursement of Appeal Fee

6.1 As none of the requests is allowable the request for remittal must be rejected.

6.2 The appellant has requested reimbursement of the appeal fee by virtue of substantial procedural violations made by the division in its decision.

According to Rule 103(1)(a) EPC, reimbursement of the appeal fee can only be ordered if the Board deems the appeal to be allowable. Since this is not the case here, reimbursement of the appeal fee has to be refused.

- 6.3 The Board adds that it is unable to establish any serious procedural flaws that might have justified an immediate remittal and reimbursement. In particular it finds that the decision considers and counters all relevant arguments; that it does not rest on evidence - a dictionary definition of the term "verify" - which does not already represent common knowledge; that the differences between the two versions of auxiliary request 2 submitted in the first instance oral proceedings are immaterial to the reason for non-admission of this request; and finally, that the division is not bound to discuss the various opposition grounds in any particular order, but is free to do so in a manner that it believes best serves procedural economy.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated