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**Datasheet for the decision
of 28 March 2019**

Case Number: T 0907/12 - 3.5.01

Application Number: 08165904.7

Publication Number: 2172882

IPC: G06Q10/00

Language of the proceedings: EN

Title of invention:

Method of cigarette packaging and cigarette packaging system

Applicant:

JT International S.A.

Headword:

Cigarette packaging/Jt INTERNATIONAL S.A:

Relevant legal provisions:

EPC Art. 56

Keyword:

Inventive step - use of package code instead of carton code
(no - not technical and obvious)



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Case Number: T 0907/12 - 3.5.01

D E C I S I O N
of Technical Board of Appeal 3.5.01
of 28 March 2019

Appellant:
(Applicant)

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted on 14 November
2011 refusing European patent application No.
08165904.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman W. Chandler
Members: N. Glaser
P. Schmitz

Summary of Facts and Submissions

- I. This appeal is against the decision of the examining division refusing the European patent application 08165904.7 pursuant to Article 97(2) EPC on the ground of lack of inventive step (Article 56 EPC).

The examining division found that claim 1 and claim 7 of the main request, filed on 6 September 2011, did not involve an inventive step (Article 56 EPC) over WO02/073551 (D4) in combination with common general knowledge.

The respective independent claims of auxiliary requests I to VIII, all filed on 6 September 2011, were found to lack inventive step for the same reasons.

Auxiliary requests IX to XVI, all filed on 6 September 2011, were not admitted under Rule 137(3) EPC, because, prima facie, they did not bring anything new into the procedure. They were found to be identical to either the system or the method claims of the main request, or one of auxiliary requests IV, VII or VIII.

- II. In the statement setting out the grounds of appeal, dated 14 March 2012, the appellant requested that the decision of the examining division be set aside and that a patent be granted on the basis of the main request, or one of the auxiliary requests I to XVI underlying the appealed decision. Oral proceedings were requested on an auxiliary basis.
- III. In the annex to the summons to oral proceedings, the Board expressed its preliminary view that the refusal of the invention for a lack of inventive step over D4

in combination with common general knowledge was justified.

IV. The oral proceedings were held on 28 March 2019 in the absence of the appellant who had notified the Board on 21 March 2019 that he would not attend. At the end of the oral proceedings the Chairman announced the Board's decision.

V. Claim 1 of the main request reads as follows:

"1. A method of cigarette packaging, the method comprising the steps of:

Packing at least a first cigarette packet (52a) labeled with a first unique machine-readable code (12a) and a second cigarette packet (52b) labeled with a second unique machine-readable code (12b) into a first carton (10);

Detecting the first unique machine-readable code (12a) and the second unique machine-readable code (12b) in the first carton (10) after the packaging of the first cigarette packet (52a) and the second cigarette packet (52b) into the first carton (10);

Transferring the detected first unique machine-readable code (12a) and second unique machine-readable code (12b) to a database and recording an information (56) that at least the two cigarette packets (52a,52b) with the first unique machine-readable code (12a) and the second unique machine-readable code (12b) are packed into the same carton (10) in the database;

Packing the first carton (10) and at least a second carton (10) into a case (20), wherein at least a third

cigarette packet (52) labeled with a third unique machine-readable code (12) and a fourth cigarette packet (52) labeled with a fourth unique machine-readable code (12) are packed into the second carton (10);

Detecting the first unique machine-readable code (12a) in the case (20) by detecting the unique code of one cigarette packet of each carton (10) gathered in the case (20); and

Inputting the detected first unique machine-readable code (12a) into the database and reading from the database all the unique machine-readable codes (12b) of the cigarette packets (52b) that are packed into the same carton (10) as the detected first unique machine-readable code (12a)."

Claim 7 is a corresponding system claim.

VI. Claim 1 of auxiliary request I adds to second detecting feature the term "only" so that the feature reads "unique code of only one cigarette packet".

Claim 1 of auxiliary request II adds to the end of the second detecting feature of claim 1 of auxiliary request I the feature "wherein the unique codes (12a) are detected in the cartons (10) from the outside of the closed cartons 10".

Claim 1 of auxiliary request III inserts before the wherein clause of the second packing feature of claim 1 of the main request the feature "wherein the first carton (10) is packed into the case (20) in a way that the first cigarette packet (52a) is the closest to a detection side (24) of the case (20) of at least the first and the second cigarette packets (52a, 52b)

packed into the first carton", and adds after the word "by" in the second detection feature "scanning the detection side (24) of the case (20) and thus" and to the end of the same feature "that is the closest to the detection side (24)".

Claim 1 of auxiliary request IV is a combination of claims 1 of auxiliary requests II and III.

Claim 1 of auxiliary request V adds before the second detection feature of claim 1 of the main request the feature *"Closing the case (20) or sealing the case (20) with an adhesive"*.

Claim 1 of auxiliary request VI adds to the end of the first packing feature of claim 1 of the main request *"with windows (14) at the sides of the unique codes (12a, 12b) of the cigarette packets (52a, 52b) in the first carton (10)"*.

Claim 1 of auxiliary request VII adds to the two occurrences of *"machine-readable code (12a[b])"* of claim 1 of auxiliary request VI *"on at least two different sides of the first cigarette packet (52a[b])"*.

Claim 1 of auxiliary request VIII is a combination of claims 1 of auxiliary requests IV and VII.

Auxiliary request IX comprises claims 7 and 8 of the main request.

Auxiliary request X comprises claims 1 to 6 of the main request.

Auxiliary request XI comprises claims 6 and 7 of auxiliary request IV.

Auxiliary request XII comprises claims 1 to 5 of auxiliary request IV.

Auxiliary request XIII comprises claims 6 and 7 of auxiliary request VII.

Auxiliary request XIV comprises claims 1 to 5 of auxiliary request VII.

Auxiliary request XV comprises claims 5 and 6 of auxiliary request VIII.

Auxiliary request XVI comprises claims 1 to 4 of auxiliary request VIII.

Reasons for the Decision

1. Background

- 1.1 The invention concerns tracking individual cigarette packets from a factory to their first purchaser. This is done by providing a "unique code" on each cigarette packet and using it as a tracking code for tracking a sold packet to its purchaser, see page 4, of the description. A "unique code" is described in the application, page 4, third and fourth paragraphs, as a machine-readable code, which is provided on the cardboard, on the poly film of each cigarette packet, on a label, on a sticker or on a tax stamp (closure).
- 1.2 The application acknowledges, on page 1, third and fourth paragraphs, that it was known in the art that cartons with several cigarette packets can be tracked

to the first purchaser of a carton by labelling each carton with a unique carton code and each case, comprising several cartons, with a unique case code. The codes are stored in a database and used for tracking purposes. On page 2, the application further acknowledges that it was known in the art, for example from EP1134679 (D5), to label each cigarette packet and each carton with a unique code which were collected and stored in a real-time data collection server, see D5, paragraph [0016], column 4 to line 20 of column 5, *where individual packs of the product [e.g. cigarette packet] are applied with individual identifying indicia*. These codes were used for tracking purposes, see paragraphs [0011] and [0018], in particular by the tax authorities, see last four lines of paragraph [0023].

1.3 The invention, in a first embodiment, page 5, sixth and seventh paragraphs, claims that neither the unique codes of the cigarette packets nor a first unique carton code need to be printed on a carton, as done in the prior art. Instead the invention retrieves this information from a database. Specific properties of cartons are then given in a second and third embodiment. In a second embodiment, a carton is made of a naked poly wrap material or of a carton material which permits detection of the unique codes of the cigarette packets from the outside of a carton, page 6, fourth paragraph. In a third embodiment, a carton has windows at the sides of the unique codes of cigarette packets in the carton, page 8, fourth paragraph.

2. Main request - Article 56 EPC

2.1 The examining division took D4 as the closest prior art and the Board does not see a reason to disagree.

- 2.2 D4 discloses a method of packaging a plurality of articles where authentication is required to avoid falsification. As a specific example, D4 cites the packaging of cigarette packets (articles), page 5, lines 8 to 11. The number of articles packaged in a common container depends on the nature of the article and its distribution chain. A plurality of containers is placed in a common (super-)container. Each single article, container and super-container is marked with a label carrying a unique number which identifies the article, container and super-container. An article number may be encoded as a bar code, human readable letters or digits, or an RF tag or magnetic stripe, page 4, lines 18 to 24, the container number is printed directly on the container surface or on a suitable label; the super-container number is printed on a label.
- 2.3 Furthermore, D4 discloses a database which establishes a relation between article number, container number and super-container number, page 11, lines 25 to 29. This database stores all sorts of data for the purpose of article tracking, page 12, line 31, to page 13, line 6. Whenever an article is placed in a container, or a container in a super-container, its number is automatically scanned by a suitable scanning device and is recorded in the database, page 5, lines 16 to 29.
- 2.4 The Board agrees with the examining division's finding that claim 1 of the main request differed from D4 by the following features:
- (a) *"Detecting the first unique machine-readable code (12a) in the case (20) by detecting the unique code of one cigarette packet of each carton (10) gathered in the case (20)",*

(b) *"Inputting the detected first unique machine-readable code (12a) into the database and reading from the database all the unique machine-readable codes (12b) of the cigarette packets (52b) that are packed into the same carton (10) as the detected first unique machine-readable code (12a)."*

2.5 The Board considers that feature (b) is disclosed in D4 to the extent that D4 employs a *"carton code"* for the same purpose as the claimed *"detected first unique machine-readable code"*. D4, page 5, fourth and fifth paragraph, reads or scans an article number when it is packaged into a larger container. Each container is provided with a unique number which may be any numeric or alphanumeric string of suitable length, see page 4, lines 33 to 35. The number of all articles and, for each article, the number of the container it has been placed into, is stored in a database. D4, therefore identifies, as the present invention does, a group of items with a unique number, whereby one number can be used to retrieve the remaining numbers from the database, see page 6, lines 8 to 11.

2.6 Thus, the differences boil down to identifying a group of items, all uniquely labelled, by the number of one of its members. The Board considers that the concept of organising items one or the other way, labelling and identifying them, as presented in the application, to be an organisational concept within a business context and therefore of non-technical nature. Such a grouping concept is comparable to the use of a telephone book for the storage of telephone numbers of individual persons, grouped together based on different grouping concepts, for example, a city name or a street name. Providing the name of a person allows retrieval of

other persons, grouped together by the name of a street.

2.7 Even if the distinguishing concept could be considered to be technical, interpreting it in the light of page 8, fifth paragraph, of the application it might only have the technical effect that the printing of a code on a carton has become unnecessary. However, since claim 1 is very general and does not define how this effect is achieved, other than by using a *unique code of one cigarette packet as a first unique machine-readable code*, the Board considers that the problem can also be considered to be to provide an alternative way of identifying the container.

2.8 The Board agrees with the examining division's view at point 2.2.2.4 of the decision that the skilled person in the art would consider using the code of one of the cigarette packets - if this code can be easily detected - as an obvious alternative when designing a database query for retrieving from the database the list of all cigarette packets that are packaged into the same container. In particular, D4 discloses a database which already stores the necessary data, that is, a list of all individual cigarette packet numbers and the carton number in which they are packaged, see page 5, lines 18 to 29. It also discloses that the input of a single code (of a super-container) allows the database to identify and locate all containers and articles packaged into it, see page 6, lines 8 to 11, which technically implies formulating queries and retrieving data. Thus, the implementation of feature (a) does not require any particular skills other than common general knowledge about database querying and processing.

- 2.9 The appellant argued that D4 is limited to a system where the scanning of the labels is done prior to packaging. The Board does not consider that the wording "articles going into the container" in D4 at page 5, lines 23 to 24, necessarily implies that articles are not packed into the container during the detection of their article number. Such an interpretation would be contrary to the overall disclosure of D4, which describes *inter alia* that the number may be placed or printed outside of the object so that it can be inspected without opening it, page 9, last three lines.
- 2.10 The Board agrees with the examining division that the embodiment on page 13, lines 20ff., of D4 should not be interpreted as limiting the method of D4 to the packaging of cartons of cigarette packets as a single unit. D4 as a whole does not exclude that a single cigarette packet corresponds to an article, carrying each a different unique code, see for example, page 5, lines 7 to 12.
- 2.11 Furthermore, the Board cannot see that the packaging of cigarette packets with high-speed machines into cartons would prevent the use of the packaging method of D4, in particular when D4 explicitly discloses that it can be applied to the packaging of cigarette packets. Also, the invention does not require the use of specifically designed unique codes and of specifically designed scanners to cope with an alleged high production speed of cigarette packaging; it rather appears to rely on standard unique codes and standard scanners.
- 2.12 The verification of the authenticity of a container and its content requires the number of the container and of at least one article number, page 7, lines 20 to 22, to be sent to the database, which stores the association

of the unique codes of articles packed into a carton together with the unique code of the carton, see page 5, lines 16 to 32. D4 therefore discloses the same concept as the present invention, that is, to store article unique codes together with carton unique codes in a database, and to use only part of this data for verification purposes.

2.13 The Board therefore concludes that claims 1 and 7 of the main request lacks an inventive step over D4 and common general knowledge.

3. Auxiliary requests

3.1 The Board does not see any reason to deviate from the decision of the examining division that auxiliary requests I to VIII do not involve an inventive step over D4 in combination with common general knowledge.

3.2 Concerning auxiliary request I, the appellant argued that the feature that the unique machine-readable code of *"only one cigarette packet"* is detected would have the effect to more easily recognize a failure of the detection step. This claimed effect is in contradiction to the understanding of the person skilled in the art. In a situation when only a single unique machine-readable code is scanned for all items contained in a carton, the chance of failure would be much higher than if more than one unique machine-readable code would be scanned. It appears to be just an obvious matter of design choice, in particular a known trade-off, to scan only one item instead of a plurality.

3.3 Concerning auxiliary request II, the appellant argued that the feature that the *"unique codes are detected in the cartons from the outside of the closed cartons"*

would have the advantage of allowing detection of the codes of cigarette packets gathered/packed into a carton and does not require opening a carton. There is only a limited number of options for the verification of the content of a carton: either the carton is opened and the unique machine-readable codes of the items are checked, or the carton remains closed and the unique machine-readable codes are made visible to and readable from the outside. Depending on the nature of the machine-readable code and the type of packaging a limited number of obvious solutions is available: the person skilled in the art would for bar-codes, for example, provide openings in the form of windows in the carton, or use cartons made of transparent material.

3.4 Concerning auxiliary request III, the appellant argued that the feature that *"the first carton is packed into the case in a way that the first cigarette packet is the closest to a detection side of the case of at least the first and the second cigarette packets packed into the first carton"* and the feature of *"scanning the detection side of the case"* would have the effect of making sure that only one unique machine-readable code of all the cigarette packets packed into the same carton is detected. The Board considers the effect from a particular packaging of cigarette packets appears to be of non-technical nature. If any technical effect would be achieved, the Board considers it obvious for the person skilled in the art to pack cigarette packets in a carton in a way that the unique machine-readable codes are close to a detection side of the case, for being detectable from the outside.

3.5 The same reasons apply to auxiliary request IV as for auxiliary requests II and III.

- 3.6 Concerning auxiliary request V, the appellant further argued that the feature of *closing or sealing with an adhesive* would have the advantage that a case can be shifted and turned without content falling out from it. The Board considers it implicit in D4 or D5 to close a carton. It is standard practice in packaging items. The use of a seal with an adhesive is a well-known feature in the art of packaging.
- 3.7 Concerning auxiliary request VI, the Board considers the packaging of items into transparent cartons (e.g. naked poly wrap material) into cartons with windows or the use of RFID tags as obvious alternatives for the verification of packaged items in closed cartons, as the examining division did. All these features have in common the effect that unique machine-readable codes of items can be detected from the outside of a closed carton.
- 3.8 Concerning auxiliary request VII, the appellant argued that the feature that the unique machine-readable codes are provided *"on at least two different sides of the first cigarette packet"* would have the advantage of being able to scan the unique machine-readable codes of cigarette packets from two sides of a carton. The Board considers it obvious for the person skilled in the art to provide codes on two sides of cigarette packets for facilitating access to the codes and increasing readability.
- 3.9 The same reasons apply to auxiliary request VIII as for auxiliary requests IV and VII.
- 3.10 Accordingly, none of auxiliary requests I to VIII involves an inventive step over D4 in combination with common general knowledge.

3.11 Auxiliary requests IX to XVI were not admitted by the examining division. The Board agrees with the examining division's reasoning because each one of these requests is a subset of the claims of a higher-ranking request and thus these requests are also not allowable under Article 56 EPC for the same reasons.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



T. Buschek

W. Chandler

Decision electronically authenticated