

**Internal distribution code:**

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

**Datasheet for the decision  
of 21 February 2014**

**Case Number:** T 0029/13 - 3.2.05

**Application Number:** 99202615.3

**Publication Number:** 979723

**IPC:** B29C65/02

**Language of the proceedings:** EN

**Title of invention:**  
Heat-sealing apparatus

**Patent Proprietor:**  
Shikoku Kakoki Co., Ltd.

**Opponent:**  
AB Tetra Pak

**Relevant legal provisions:**  
RPBA Art. 13(1)  
EPC 1973 Art. 54

**Keyword:**  
Admissibility of late filed requests - main request (yes) -  
auxiliary requests 1 and 2 (no)  
Novelty - main request (no)  
Objection in accordance with Rule 106 - dismissed



**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 0029/13 - 3.2.05

**D E C I S I O N  
of Technical Board of Appeal 3.2.05  
of 21 February 2014**

**Appellant II:** Shikoku Kakoki Co., Ltd.  
(Patent Proprietor) 10-1, Aza-Nishinokawa,  
Tarohachisu,  
Kitajima-cho  
Itano-gun,  
Tokushima-ken 771-0202 (JP)

**Representative:** Charles Thomas Harding  
D Young & Co LLP  
120 Holborn  
London  
EC1N 2DY (GB)

**Appellant I:** AB Tetra Pak  
(Opponent) Ruben Rausings Gata  
SE-221 86 Lund (SE)

**Representative:** Müller Schupfner & Partner  
Bavariaring 11  
80336 München (DE)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
16 November 2012 concerning maintenance of the  
European Patent No. 979723 in amended form.**

**Composition of the Board:**

**Chairman:** M. Poock  
**Members:** S. Bridge  
M. J. Vogel

## **Summary of Facts and Submissions**

- I. Two appeals were lodged against the interlocutory decision of the opposition division aiming to maintain the European patent No. 0 979 723 in amended form according to auxiliary request 4.

The opposition was filed against the patent as a whole based on Article 100(a) EPC (lack of novelty, Article 54 EPC and lack of inventive step, Article 56 EPC 1973), Article 100(b) EPC (the invention is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, Article 83 EPC 1973) and Article 100(c) EPC (added subject-matter extends beyond the content of the application as filed, Article 123(2) EPC).

- II. Oral proceedings were held before the board of appeal on 21 February 2014.

Appellant I (opponent) requested that the decision under appeal be set aside and that the European patent be revoked.

Appellant II (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request, filed with letter of 20 January 2014, or on the basis of any of the auxiliary requests 1 and 2, submitted during the oral proceedings.

- III. Claim 1 according to the main request reads as follows (the feature numbering was added by the board in accordance with the one advanced by appellant I):

1.1 "1. A *heat-sealing apparatus*

- 1.2 *for forming a packing material made of a laminate including a synthetic resin layer into a tubular-shape, and*
  - 1.3 *transversely heat-sealing the tubular packing material by using a pair of open-and-closable pressing members having a heating mechanism,*
  - 1.4 *wherein a groove is disposed on at least one action face of the pressing members, capable of forming a synthetic resin bulge,*
  - 1.5 *wherein the packing material is heated with a fluid and*
  - 1.6 *the resin bulge is adjacent to the outer side of a zone to be sealed on a container's interior side;*
  - 1.7 *wherein the phrase "packing material is heated with a fluid" means heating the packing material filled with fluid."*
- IV. Claim 1 according to auxiliary request 1 differs from claim 1 according to the main request in that the following additional text is introduced at the end of the claim (the feature numbering was added by the board in continuation of the one used in claim 1 according to the main request):
- 1.8 *"wherein the apparatus comprises the pair of open-and-closed pressing members;*
  - 1.9 *wherein the laminate further has an aluminum foil layer, and the pair of open-and-closable pressing members having a heating mechanism includes a sealing jaw provided with a high-frequency coil having a flat action face and a jaw opposing to the sealing jaw; and*
  - 1.10 *wherein the groove is formed adjacent to the outer side of a high-frequency coil having a flat action face on a container's interior side;*
  - 1.11 *and wherein the resin flows out of the sealed zone into the groove to form the synthetic resin bulge, and*

1.12 *wherein the action face of the pressing members corresponding to the sealed zone is the zone to be sealed."*

- V. Claim 1 according to auxiliary request 2 differs from claim 1 according to auxiliary request 1 in that the following additional feature is inserted between features 1.10 and 1.11:

*"and the groove is formed on the outer side of the zone to be sealed;"*

- VI. The following documents are referred to in the present decision:

D1: JP-A-08 230 834 including its English translation as filed on 28 December 2007 by the patent proprietor  
D4: US-4,241,560

- VII. The arguments of appellant I in the written and oral proceedings can be summarised as follows:

Claim 1 according to the main request returns to the subject-matter as granted which was already considered by the opposition division to lack novelty with respect to the document D4. Forming a packing material into a tubular-shape is implicitly disclosed in document D4 which starts from cut boxboard stock which must be prefabricated, i.e. formed, into cartons with open tops (abstract; column 1, lines 6 to 15).

Furthermore, the apparatus of claim 1 according to the main request is defined in terms of process steps such as features 1.2 and 1.3. *"Thus, neither the packing material itself nor the step of transversely heat-*

*sealing the packing material limit the scope of protection, so that any prior art heat-sealing apparatus, which is able to process such packing material, would render the claimed heat-sealing apparatus not novel anymore. Furthermore, claim 1 also leaves it open on whether the pressing members using a heating mechanism are subject of the claimed heat-sealing apparatus or not. Thus, the following discussion is based on the auxiliary assumption that the pressing members using a heating mechanism are subject of the claimed heat sealing apparatus"* (Grounds of appeal, section II.1, last three paragraphs).

In addition, the main request could have been filed earlier. For all these reasons, the main request should not be admitted into the procedure at this late stage.

According to paragraph [0022] of the patent in suit the resin bulge does "*... not contribute to the sealing properties so much...*" as a consequence of transporting resin from one area (corresponding to the action face) and collecting it at another area (corresponding to the bulge) and thereby concentrating and mixing impurities present on the surface of the resin. This effect does not result from constructional features of the claimed heat-sealing apparatus and in particular not from an effect associated with any unclear interpretation of where a "*sealed zone*" or "*zone to be sealed*" begins and ends. The bulge of document D1 will consequently provide the same set of sealing properties as the bulge of the patent in suit, regardless of what is designated as a "*sealing part*" in document D1 and a "*sealed zone*" or "*zone to be sealed*" in the opposed patent. In consequence, properties of the bulge cannot be used for differentiating between document D1 and the opposed

patent, neither can any specific wording when such wording is based on different interpretations.

Thus, even if the pressing members are considered to be part of the subject-matter of claim 1 according to the main request, figure 11 of document D1 discloses that the resin bulge is adjacent to the outer side of "a zone to be sealed" on a container's interior side. Therefore, the subject-matter of claim 1 according to the main request is not new with respect to document D1.

Claims 1 respectively according to auxiliary requests 1 and 2 include features 1.11 and 1.12 which are taken from the description and render the subject-matter complex and unclear. Furthermore, the features added from dependent claims 2 and 3 do not establish novelty with respect to document D1 which also discloses the groove adjacent to the outer side of the high-frequency coil 31 (figure 11). There is no reason to admit these requests at this late stage of the procedure, because the issues concerning the pressing members and the problematic definition of the "zone to be sealed" leading to the lack of novelty with respect to document D1 were already known before the oral proceedings. Therefore, and for reasons of procedure economy, auxiliary requests 1 and 2 should not be admitted into the proceedings.

VIII. The arguments of appellant II in the written and oral proceedings can be summarised as follows:

The main request was filed in response to the provisional opinion of the board expressed in the annex to the summons to oral proceedings.

Document D4 does not directly and unambiguously disclose an apparatus which is suitable for forming a packing material into a tubular-shape in accordance with feature 1.2 of claim 1 according to the main request. The subject-matter of claim 1 according to the main request is therefore prima facie new with respect to document D4.

The position of the resin bulge constitutes an apparatus feature since it defines the position of the groove, because the resin bulge is formed in the groove. The claimed pressing members with a groove are a limiting feature of the claimed apparatus since a device not having these pressing members would not be suitable for "*heat-sealing the tubular packing material by using a pair of open-and-closable pressing members...*". Clearly, only devices having the pressing members can be suitable for heat-sealing using the pressing members.

When the board queried, by analogy with machine tools, which remain suitable for machining *by using a tool* even though the tool does not form part of the machine, whether the pressing members really are necessarily part of the subject-matter of claim 1, the answer was that taking into account the patent as a whole and considering a mind willing to understand, the pressing members are necessarily part of the subject-matter of claim 1.

Even if the subject-matter of claim 1 according to the main request constitutes a return to the subject-matter of claim 1 as granted, this cannot constitute a surprise for the opponent. The main request should be admitted into the procedure.



The pressing members are considered part of the subject-matter of claim 1. Document D1 provides an explicit definition of the region where the sealing actually occurs. Paragraph [0038] of the English translation states that *"only the part corresponding to the region AR3 contributes to the heat sealing, and the region AR3 becomes the sealing part S"* so that the region AR3 or S is the "zone to be sealed". Figure 5 of document D1 shows that the grooves 73 and 75 are entirely within the zone to be sealed AR3. This is consistent with paragraphs 18 and 43 of the English translation of document D1 which state that the resin does not run out from the area of the sealing part S - i.e. the grooves must be within the zone to be sealed. As according to document D1 the groove lies within the zone to be sealed, the resin bulge is formed in the groove, and the resin does not run out from the sealing part S, then in document D1 the resin bulge is within the zone to be sealed. Hence, in document D1, the resin bulge is adjacent to the inner side of the zone to be sealed, not adjacent to the outer side of the zone to be sealed on the container's interior side.

Therefore, the subject-matter of claim 1 according to the main request is new with respect to document D1.

Claim 1 according to auxiliary requests 1 and 2 only includes subject-matter from granted dependent claims 2 and 3 as well as clarifying statements from the description which serve to establish novelty with respect to document D1. Auxiliary requests 1 and 2 should be admitted into the proceedings.

## **Reasons for the Decision**

1. The appeal is admissible.
2. Admissibility of the main request, filed with letter of 20 January 2014
  - 2.1 According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion. The criteria for exercise of discretion include inter alia whether or not there are good reasons for the late filing and whether or not the amendments and submissions are suitable attempts for resolving the issues to be discussed at the oral proceedings.

Appellant II argued that this request is a response to the provisional opinion of the board in that a feature which was objected to under Article 100(c) EPC in claim 1 according to the previous main request has been deleted.

In consequence, claim 1 according to the present main request corresponds to the subject-matter as granted which was already considered by the opposition division to lack novelty with respect to the document D4. Thus, the question of prima facie novelty with respect to document D4 must be considered.

- 2.2 Prima facie novelty with respect to document D4

Although claim 1 according to the main request refers to the claimed apparatus as a "*heat-sealing apparatus*" this apparatus must nevertheless also be suitable "*for forming a packing material made of a laminate including*

*a synthetic resin layer into a tubular-shape"*  
(feature 1.2 of claim 1 according to the main request).

The invention according to document D4 (column 1, lines 6 to 15) "*relates to an apparatus for folding and closing the tops of folding cartons which are prefabricated from cut boxboard stock*" which implies that a step "*for forming a packing material made of a laminate including a synthetic resin layer into a tubular-shape*" must take place to convert the "*cut boxboard stock*" into the prefabricated folding cartons with open tops. However, such a step could, for example, be carried out in a separate apparatus situated upstream of the carton conveying belt 1. As document D4 is silent on where this "*forming*" step is carried out, it does not directly and unambiguously disclose that it is the "*apparatus for folding and closing the tops of folding cartons*" which also forms "*a packing material made of a laminate including a synthetic resin layer into a tubular-shape*".

For this reason, the subject-matter of claim 1 according to the main request is *prima facie* new with respect to document D4 (Article 54 EPC 1973).

- 2.3 As the request is a response to the provisional opinion of the board, there is *prima facie* novelty with respect to document D4 and no issues liable to surprise the opponent have been introduced, the board exercised its discretion under Article 13(1) Rules of procedure of the boards of appeal (RPBA) to admit the main request into the procedure.
3. Understanding feature 1.3 of claim 1 according to the main request: "*transversely heat-sealing the tubular*

*packing material by using a pair of open-and-closable pressing members having a heating mechanism"*

Appellant I argued already in section II of its grounds of appeal that functional features 1.2 and 1.3 of claim 1 need interpretation to determine the claimed subject-matter. In particular, functional feature 1.3 "*transversely heat-sealing the tubular packing material*" is subject to an additional constraint, in that this must occur "*by using a pair of open-and-closable pressing members having a heating mechanism*", which leads appellant I to conclude that claim 1 leaves open whether such pressing members are part of the claimed subject-matter or not (Section II, page 5, lines 11 to 13).

During the oral proceedings, this point was illustrated in greater detail by reference to machine tools which remain suitable for machining by using one of several possible tools even though a given tool does not necessarily belong to, i.e. form part, of the machine tool itself. Similarly, an apparatus whose pressing members have been removed (e.g. for maintenance) still remains suitable "*for transversely heat-sealing the tubular packing material by using a pair of open-and-closable pressing members having a heating mechanism*" as the "*by using*" constraint only implies that pressing members are present while carrying out the heat-sealing operation without requiring them to be a necessary part of the claimed apparatus as such.

Appellant II's argument "*a device not having these pressing members would not be suitable for 'heat-sealing the tubular packing material by using a pair of open-and-closable pressing members...'*" (reply to appeal of 5 July 2013, page 1, penultimate paragraph) does not

address what occurs when the claimed apparatus is not in use, i.e. in a state which apparatus claim 1 according to the main request also covers.

Appellant II's further argument, that taking into account the patent as a whole and considering a mind willing to understand, the pressing members must necessarily be part of the subject-matter of claim 1 cannot be accepted, because "*the claims shall define the matter for which protection is sought*" (Article 84 EPC 1973, first sentence) and the subject-matter of the claim is thus not defined by the description and figures as a whole when considered by a mind willing to understand.

The board thus cannot share appellant II's conclusion that "*only devices having the pressing members can be suitable for heat-sealing using the pressing members*" (reply to appeal of 5 July 2013, page 1, penultimate paragraph): Claim 1 is an apparatus claim and thus concerns an apparatus as such characterised in terms of apparatus features and is not limited to the apparatus when being used in a particular manner.

As claim 1 does not explicitly state that particular pressing members are part of the claimed apparatus, these pressing members are not necessarily part of the subject-matter of claim 1. Thus the pressing members only constitute an optional feature of the subject-matter of claim 1 according to the main request.

4. Novelty of the subject-matter of claim 1 according to the main request with respect to document D1

Document D1 discloses a heat-sealing apparatus (English translation, title and paragraph [0001]) suitable for:

- forming a packing material made of a laminate including a synthetic resin layer (English translation, paragraph [0020]) into a tubular-shape, wherein the packing material is heated, i.e. heat-sealed, while filled with fluid (English translation, paragraph [0021]), and
- and transversely heat-sealing the tubular packing material by using a pair of open-and-closable pressing members having a heating mechanism (English translation, paragraphs [0010], [0014] and figure 7 showing pressing members 14a and 14b).

Thus, features 1.1 to 1.3, 1.5 and 1.7 of claim 1 according to the main request are disclosed in combination in document D1.

As the pressing members are only optional, corresponding features 1.4 (*"wherein a groove is disposed on at least one action face of the pressing members, capable of forming a synthetic resin bulge"*) and 1.6 (*"the resin bulge is adjacent to the outer side of a zone to be sealed on a container's interior side"*) of the pressing members cannot provide novelty.

Therefore, the subject-matter of claim 1 lacks novelty with respect to document D1 (Article 54(2) EPC 1973).

5. As remarked by the representative of Appellant II during the oral proceedings, the finding that the pressing members are only optional features of the subject-matter of claim 1 would appear to carry over to all remaining auxiliary requests then on file. In order to reconsider his requests with a view to procedural efficiency, further information concerning any other

factors contributing to the lack of novelty was requested from the board during the oral proceedings.

Thus, although the pressing members are only optional features of the subject-matter of claim 1, features 1.4 and 1.6 were also discussed with respect to document D1 and, to quote the words of appellant I, "*the following discussion is [thus] based on the auxiliary assumption that the pressing members using a heating mechanism are subject of the claimed heat sealing apparatus*" (Grounds of appeal of Appellant I, page 5, last paragraph of section II.1).

- 5.1 Feature 1.4 "*a groove is disposed on at least one action face of the pressing members, capable of forming a synthetic resin bulge*"

Document D1 further discloses a groove 75 disposed on at least one action face of the pressing members 14b, capable of forming a synthetic resin bulge (figure 5 shows a groove 75 and figure 11 shows the synthetic resin bulge next to groove 75). Feature 1.4 is thus disclosed in document D1.

- 5.2 Feature 1.6 "*the resin bulge is adjacent to the outer side of a zone to be sealed on a container's interior side*"

The meaning, in particular, of the terms "*adjacent*" and "*a zone to be sealed*" was disputed by the parties.

- 5.2.1 The board considers the English definition of "*adjacent*" from the Oxford English dictionary to be appropriate and no arguments to the contrary were advanced by the parties:

**adjacent, adj.**

**A.** adj.

1. Next to or very near something else; neighbouring; bordering, contiguous; adjoining.
2. Of non-material things: closely related; connected.

This definition is thus broader than the American one from the Merriam Webster American Dictionary used in the decision of the opposition division.

5.2.2 It was advanced on behalf of appellant II, that a technically meaningful interpretation of "a zone to be sealed" which also forms an identifiable feature is the location where the sealing actually occurs: For a given apparatus and packing material this can be determined simply by operating the apparatus with the particular packing material and analysing the resulting seal.

However, the extent of sealing provided by the heat sealing apparatus of claim 1 according to the main request is necessarily dependent on the constitution and nature of the packing material, since it is the synthetic resin layer of the packing material which, when heated and pressed, fuses to form the seal. However, as already pointed out by appellant I (grounds of appeal of 15 March 2013, page 5, second full paragraph) the packing material is not part of the claimed subject-matter.

Furthermore, the expression "a zone to be sealed" only denotes an intention of sealing associated with a particular "zone". Such an intention and thus the extent of the "zone" can be (re)defined arbitrarily without making any physical changes to the corresponding apparatus. Thus, the expression "a zone to be sealed" does not state where any sealing will effectively occur with respect to the intended zone: it



could be that all of the zone is sealed or just some of it. It also does not rule out that the intention may not be fulfilled or that sealing may (also) occur elsewhere.

Therefore, "*a zone to be sealed*" does not constitute an objective technical feature of the claimed apparatus as such.

According to paragraphs [0022] and [0023] of the patent in suit, the resin layer having no foreign substances provides the required sealing in the "*sealing zone*". Appellant II agreed with this view and indicated that the terms "*a zone to be sealed*" and "*sealing zone*" are thus linked in paragraph [0022], column 5, lines 55 to 58 of the patent in suit as published.

Conversely, the last sentence of paragraph [0023] of the patent in suit, discloses that although the synthetic resin bulge does not contribute much to the sealing, it can nevertheless be said to enhance the sealing strength. Thus, the decision of whether the synthetic resin bulge forms part of, or is excluded from, a region where the sealing actually occurs in a particular packing material is a matter of arbitrary definition.

Feature 1.6 refers to the "*resin bulge*" (and thus indirectly relates to the groove) as adjacent the region described as "*the outer side of a zone to be sealed on a container's interior side*". The text "*on a container's interior side*" identifies one of the two "*outer sides*" of the zone to be sealed - the one facing the cutting mechanism 6 (when present) or the one facing the interior of the container.

Thus, the "zone to be sealed" arbitrarily defines a region adjacent to the resin bulge facing away from the container's interior and where sealing actually occurs.

### 5.2.3 Disclosure of feature 1.6 in document D1

Document D1 discloses that "*only the part corresponding to the region AR3 contributes to the heat sealing, and the region AR3 becomes the sealing part S*" (English translation, paragraph [0038]) and figure 5 shows that the groove 75 is entirely within the zone AR3.

Paragraphs [0018] and [0043] discuss the formation of the synthetic resin bulge and figure 11 discloses the synthetic resin bulge next to the groove 75.

It was argued on behalf of appellant II that the zone AR3 of document D1 is to be compared directly to the "zone to be sealed" of feature 1.6. and that therefore the resin bulge of document D1 is within the "zone to be sealed", i.e. that, in document D1, the resin bulge is adjacent to the inner side of the zone to be sealed and not adjacent to the outer side of the zone to be sealed on the container's interior side.

However, this approach ignores that the term "*a zone to be sealed*", as used in feature 1.6 of claim 1 according to the main request, is not an objective technical feature of the sealing apparatus, but merely an arbitrary definition as already clarified in point 5.2.2 above. For the prior art to be comparable to the subject-matter of claim 1 according to the main request, the same definition as the one used in feature 1.6 of claim 1 according to the main request must be applied to document D1.

As advanced on behalf of appellant I, the process by which any foreign substances will be flushed away by some of the molten resin to end up in the synthetic resin bulge caused by a groove necessarily also occurs in prior art devices such as the one disclosed in document D1 (grounds of appeal of 15 March 2013, page 18, line 10 onwards). Thus, the synthetic resin bulges of document D1 and the present invention are comparable.

The "*zone to be sealed*" (as used in feature 1.6 of claim 1) thus identifies the region between the synthetic resin bulges as shown in figure 11 of document D1. Paragraphs [0018], [0037] and [0038] of document D1 confirm that sealing does take place in that zone as it overlaps the region AR3 of the "*sealing part*" as shown in figure 5. Thus, document D1 also discloses a region adjacent to the resin bulge facing away from the container's interior and where sealing actually occurs.

Thus, when the same definition of "*a zone to be sealed*" is applied to the device disclosed in document D1, then feature 1.6 is already identically disclosed therein and feature 1.6 of claim 1 according to the main request does not provide the claimed invention with any additional technical feature which is not already known from document D1.

Furthermore, feature 1.6 of claim 1 does not exclude that sealing may also occur outside the "*a zone to be sealed*" and indeed according to the last sentence of paragraph [0023] of the patent in suit, although the synthetic resin bulge does not contribute much to the sealing, it can nevertheless be said to enhance the sealing strength. Thus, document D1, which is at

liberty to provide its own definitions, is technically justified in using an alternative definition for its "*sealing part*", in which the lesser amount of sealing provided by the bulges is nevertheless deemed to contribute to, and be part of, the "*sealing part*" as defined therein in terms of the zone AR3 shown in figure 5. Therefore, the alleged difference advanced by appellant II is only due to different definitions being used in the patent in suit and in the prior art and is not a difference founded on technical features. In both cases there is a region adjacent to the resin bulge facing away from the container's interior and where sealing actually occurs so that the "*resin bulge is adjacent to the outer side of a zone to be sealed on a container's interior side*".

Appellant II further cited decision T 0357/08 in which the definition used by document D1 is referred to in point 4.5 of that decision. However, as set out above, in the present case the particular definition of "*a zone to be sealed*" of claim 1 according to the main request has to be used when comparing the prior art to the claimed subject-matter.

An apparent difference which is only the result of different definitions being used in the patent in suit and in the prior art cannot be used to establish novelty with respect to document D1.

Even supposing that the pressing members using a heating mechanism were explicitly part of the claimed heat-sealing apparatus according to claim 1 (main request), document D1 (including its English translation) discloses the thus augmented subject-matter of claim 1 according to the main request. In particular, groove 75 (figures 1a, 1b and 5) is

disposed on at least one "action face" of the pressing member 19 and capable of forming a "synthetic resin bulge adjacent to the outer side of a zone to be sealed on a container's interior side" (figure 11).

6. Admissibility of auxiliary requests 1 and 2

6.1 The additional technical features of claim 1 according to auxiliary request 1 are disclosed in document D1. The heat-sealing apparatus of document D1 comprises the pair of open-and-closed pressing members 14a, 14b, 19, 91 (English translation, paragraph [0021], figures 7 and 11 - cf. feature 1.8) and is suitable for use with a laminate packing material comprising an aluminum foil layer (English translation, paragraph [0020], last sentence). The pair of open-and-closable pressing members 14a, 14b, 19, 91 having a heating mechanism includes a sealing jaw 14b, 19 provided with a high-frequency coil 31 having a flat action face and a jaw 14a, 91 opposing to the sealing jaw (English translation, paragraphs [0021] [0035], figures 1, 5, 7 and 11 - cf. feature 1.9). The groove 75 is formed adjacent to the outer side of a high-frequency coil 31 having a flat action face on a container's interior side (figure 11- cf. feature 1.10).

Feature 1.11 "*the resin flows out of the sealed zone into the groove to form the synthetic resin bulge*" of claim 1 according to auxiliary request 1 only concerns a method step and is disclosed in paragraph [0043] of the English translation of document D1.

Feature 1.12 of claim 1 according to auxiliary request 1 only defines an equivalence between "*the sealed zone*", "*the zone to be sealed*" and (part of) the action face of the pressing members and thus does not

go beyond the mere introduction of more vocabulary. In document D1, sealing also occurs at the action face of the pressing members 14b, 19 (English translation, paragraphs [0042] and [0043], figure 11).

Thus, the subject-matter of claim 1 according to auxiliary request 1 does not prima facie establish novelty over document D1.

6.2 The additional feature "*and the groove is formed on the outer side of the zone to be sealed*" of claim 1 according to auxiliary request 2, with respect to claim 1 according to auxiliary request 1, merely restates explicitly the position of the "*zone to be sealed*" in relation to the groove with respect to what is already implicit from feature 1.6. The above arguments concerning claim 1 according to auxiliary request 1 thus carry over to claim 1 according to auxiliary request 2. Thus, the subject-matter of claim 1 according to auxiliary request 2 does not prima facie establish novelty over document D1.

6.3 Furthermore, insofar that feature 1.12 "*the action face of the pressing members corresponding to the sealed zone is the zone to be sealed*" (of claim 1 respectively according to auxiliary requests 1 and 2) implies that the whole of the "*action face of the pressing members*" is identical to the "*sealed zone*" i.e. "*zone to be sealed*", there is a contradiction within claim 1 concerning the position of the groove: feature 1.12 indicates that the action face of the pressing members - where the groove is located according to feature 1.4 ("*groove is disposed on at least one action face of the pressing members*") - corresponds to the "*sealed zone*" and the "*zone to be sealed*" whereas features 1.6 and 1.11 imply that the groove is outside "*a zone to be*

*sealed* , i.e. outside a *"sealed zone"*. Since, claims 1 respectively according to auxiliary requests 1 and 2 are not explicitly limited to only some part of the *"action face of the pressing members corresponding to the sealed zone [being] the zone to be sealed"* (as was advanced by appellant II), the amendments make the claims *prima facie* unclear (Article 84 EPC 1973).

6.4 The issue concerning the pressing members was already raised in the grounds of appeal of 15 March 2013 of appellant I (page 5, penultimate paragraph of section II.1) as were the issues surrounding the definition of the *"zone to be sealed"* (last paragraph on page 18) and the lack of novelty with respect to document D1 (page 14, first paragraph of section IV.1). The issues surrounding the definition of the *"zone to be sealed"* were also taken up in the board's annex to the summons to oral proceedings in point 9.4. So contrary to what was advanced by appellant II, these issues were not raised for the first time during the oral proceedings and thus there are no good reasons for the late filing of auxiliary requests 1 and 2.

6.5 Since, there are no good reasons for the late filing, the amendments may require further discussion with respect to clarity and do not *prima facie* overcome the novelty issues already discussed with respect to document D1, the board used its discretion under Article 13(1) RPBA not to admit auxiliary requests 1 and 2 into the procedure.

7. Objection by appellant II in view of Rule 106 EPC concerning alleged procedural defects

The alleged procedural defects raised by appellant II consists of two points as follows.

7.1 "Point 1

*Fundamental violation of Art 113 (Art 112a(c))*

*We were denied any opportunity to respond effectively to an interpretation/point regarding the claim that was fundamental to the rejection and wherein said interpretation/point had not been raised before the oral proceedings."*

The board notes that:

- *"point 1" is not specific concerning what "interpretation/point regarding the claim" is being referred to; and*
- *that, nevertheless, all the issues leading to the rejection of the main request had already been raised by appellant I in his grounds of appeal (see section 6.4 above). Appellant II thus had had and had used the opportunities to respond to these issues.*

The board thus considers the objection under *"point 1"* not to be justified.

7.2 "Point 2

*Interplay of Art 112a(d) and Rule 104(b)*

*By not following my request in toto - namely "replacing AR1 and AR2 for Auxiliary requests 1-16 already on file" - hence, by not then allowing AR1 and AR2 into the proceedings and then also not considering Auxiliary Claim Requests 1-16 means that a fundamental procedural defect occurred (Art 112a)."*



According to Article 15(4) RPBA, "*the chairman presides over the oral proceedings and ensures their fair, orderly and efficient conduct*". In this capacity, the chairman explained to appellant II that conditional requests are not acceptable. With a thus constructed request, starting a discussion concerning the admissibility of the new auxiliary requests would be tantamount to pre-empting the outcome of that discussion and subsequent deliberation of the board in favour of the requester, contrary to the principle of a fair and open hearing and fair and free decision making of the board based on arguments yet to be presented in such a discussion. There is also no legal basis on which a board could thus deprive the other party of its rights. A request construction which thus aims to circumvent the legal process by imposing an outcome in favour of one of the parties to the detriment of another is necessarily inadmissible. To clarify the state of the requests, the chairman asked the representative of appellant II directly and unambiguously whether auxiliary requests 1 to 16 are withdrawn and the answer was "yes". The representative of appellant II then filed new auxiliary requests 1 and 2 ("AR1", "AR2").

The objection under "*point 2*" thus errs in that it assumes that a party may determine the conduct of the oral proceedings by a request construction which imposes an admissibility decision of the board in its favour. Furthermore, appellant II could have decided not to withdraw auxiliary requests 1 to 16, then on file, when asked directly by the chairman.

The board thus considers the objection under "*point 2*" not to be justified.

7.3 Since neither the objection under "*point 1*" nor that under "*point 2*" is justified, the board dismissed the objection concerning an alleged procedural defect as raised during the appeal proceedings by appellant II.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside and the patent is revoked.
2. The appeal of appellant II is dismissed.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated