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**Datasheet for the decision  
of 8 December 2015**

**Case Number:** T 0128/13 - 3.2.07

**Application Number:** 02748973.1

**Publication Number:** 1409344

**IPC:** B65B9/15, B65B67/12

**Language of the proceedings:** EN

**Title of invention:**  
SPOOL FOR A WASTE STORAGE DEVICE

**Patent Proprietor:**  
Sangenic International Limited

**Opponent:**  
Lamico ApS

**Headword:**

**Relevant legal provisions:**  
EPC Art. 84, 123(2), 56, 100(c), 111(1)  
RPBA Art. 13(1)

**Keyword:**

Amendments (claim 1 of the main request) - added subject-matter (yes)

Fresh ground for opposition -  
not introduced into the appeal proceedings in the absence of the patentee's approval

Late-filed argument (inventive step) -  
admitted (new set of claims)

Inventive step - claim 1 of the first auxiliary request (yes)

Remittal to the opposition division (yes)

**Decisions cited:**

G 0010/91, G 0003/14

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0128/13 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 8 December 2015**

**Appellant:** Lamico ApS  
(Opponent) Ellemosevej 3  
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**Representative:** Budde Schou A/S  
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**Respondent:** Sangenic International Limited  
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**Representative:** Roberts, Gwilym Vaughan  
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**Decision under appeal:** **Interlocutory decision of the Opposition**  
**Division of the European Patent Office posted on**  
**9 November 2012 concerning maintenance of the**  
**European Patent No. 1409344 in amended form.**

**Composition of the Board:**

**Chairman** H. Meinders  
**Members:** K. Poalas  
C. Brandt

## **Summary of Facts and Submissions**

- I. The appellant (opponent) lodged an appeal against the interlocutory decision maintaining European patent No. 1 409 344 in amended form.
- II. Opposition had been filed against the patent as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step), Article 100(b) EPC (insufficient disclosure) and on Article 100(c) EPC (unallowable amendments).
- III. The opposition division found that the subject-matter of claims 1 to 8 filed during the oral proceedings as then new second auxiliary request meets the requirements of the EPC.
- IV. Oral proceedings took place before the Board on 8 December 2015.
  - a) The appellant requested that the decision under appeal be set aside and that the patent be revoked in its entirety.
  - b) The respondent (patent proprietor) requested that the appeal be dismissed and the patent be maintained as upheld by the Opposition Division (main request), or, alternatively that, in setting aside the decision under appeal, the patent be maintained on the basis of any of the first to fifth auxiliary requests as filed with letter dated 6 November 2015.
- V. The following documents of the opposition proceedings are referred to in the present decision:

D0: WO 02/100723 A1 (corresponding to the originally  
filed application of the patent in suit),

D6: GB 2 232 951 A,

D8b: US 5 782 061 A.

VI. The independent claims 1 and 7 according to the **main request**, i.e. as upheld by the opposition division read as follows (substantive amendments with respect to claims 1 and 8 of the patent as granted are in bold):

"1. A waste storage device spool (10) for storing tubular film, the spool (10) having one flared end (16) and an opposing film loading end arranged to receive film loaded in a direction towards the flared end (16), **the spool further comprising tubular film (30) loaded thereon and a compression ring (32) loaded against the loaded film**".

"7. A method of loading tubular film (48) onto a waste storage device spool (10) having a flared end (16) and a film loading end, the method characterised in that it comprises the steps of mounting the spool (10) with the film loading end disposed towards a film dispenser, and loading the film (48) from the film dispenser onto the spool, in the direction towards the flared end (16), the flared end (16) being opposite the film loading end **and further comprising the steps of loading a compression ring (32) against the loaded film (30)**".

Claim 1 of the **first auxiliary request** is identical to claim 7 of the main request.

In view of the Board's decision, see points 5 and 6 below, the wording of the second to fifth auxiliary requests is not of relevance for the present decision.

VII. The arguments of the appellant can be summarised as follows:

*Claim 1 of the main request - amendments, Article 123(2) EPC*

A "compression ring" and an "annular ring" are two different and distinct entities.

The compression ring finds mention in D0 (the original application) only in connection with the method of loading tubular film into a cassette, as mentioned in claim 10 as originally filed and which is the starting point for the method of the patent in suit. In that method the compression ring is part of the apparatus for loading the film, and it is certainly not left on the cassette, no longer forming part of the loading apparatus. This constitutes new information and is as such a violation of the requirements of Article 123(2) EPC.

The same applies to the use of reference number 32 for the "compression ring", which is not the original disclosure, in which this reference number 32 related to the annular disk, which did remain on the spool.

*Claim 7 according to the main request - admission of the appellant's objections based on Articles 84, 123(2) and 100(c) EPC raised for the first time during the oral proceedings*

Given that the "annular disc 32" and the "compression ring" are two different entities, see the argumentation above in respect of claim 1, the assignment in claim 7 of the reference sign 32 to the compression ring constitutes an unallowable amendment and renders claim

7 unclear.

Claim 7 is equivalent to the first alternative of claim 10 of the patent as granted, i.e. equivalent to a granted claim and therefore it can be objected to on the basis of the ground for opposition of Article 100(c) EPC. An objection according to Article 100(c) EPC was already raised with the notice of opposition against the method claim 8, on which claim 10 depends. This means that the objection could be now extended to the inadmissible assignment of the reference sign 32 to the compression ring. This objection, even raised during the oral proceedings before the Board, is not to be seen as a fresh ground for opposition.

Alternatively, claim 7 can be considered as resulting from an amendment of independent method claim 8 of the patent as granted by the insertion into said claim of the first alternative of the dependent method claim 10. Accordingly, such an amended claim is open to examination for compliance with the requirements of Articles 84 and 123(2) EPC.

*Claim 1 according to the first auxiliary request - admission of the appellant's objections based on Articles 84, 123(2) and 100(c) EPC raised for the first time during the oral proceedings*

Given that claim 1 of the first auxiliary request is identical with claim 7 of the main request the same arguments and submissions put forward in respect with claim 7 of the main request are valid for this claim 1.

*Claim 1 according to the first auxiliary request - admission of the appellant's objections based on Article 56 EPC raised for the first time during the*

*oral proceedings*

It was only due to the filing of the first auxiliary request with letter dated 6 November 2015, i.e. only one month before the oral proceedings, said request consisting now only of method claims, that the discussion concerning the patentability of the present invention has been focused only on the method claims.

Given that on the one hand the appellant was for the first time confronted with a new set of claims focused only on the claimed method, and on the other hand that the arguments on lack of inventive step in respect of claim 1 of the main request are *mutatis mutandis* applicable to this set of claims of the first auxiliary request, the respondent could not be taken by surprise when confronted with these arguments. In such a case the Board should admit the appellant's lack of inventive step objection against claim 1 of the main request.

*Claim 1 according to the first auxiliary request -  
inventive step, Articles 52(1) and 56 EPC*

The specific paper tape or ties mentioned in D8b only constitute two of several possible solutions to the technical problem of keeping the pleated film material together and the general statement for this "by suitable means", in column 2, lines 36 to 39, indicates to the person skilled in the art that alternative solutions are to be considered. The person skilled in the art seeking an alternative solution to the problem of holding the coil of pleated foil material on the spool known from D8b would apply the teaching of D6 and instead of the tape or ties would use the compression ring 56 known from D6 and would then arrive at the



subject-matter of claim 1 without the exercise of an inventive activity.

VIII. The arguments of the respondent can be summarised as follows:

*Claim 1 of the main request - amendments, Article 123(2) EPC*

Claim 10 of D0 provides basis for the feature of a compression ring loaded against the film loaded onto the spool. That no reference sign is presented in this claim 10 is irrelevant.

It is further clear from several passages in D0 that compression of the film loaded onto the spool 10 is also a function of the annular disc 32, see page 3, lines 16 to 20 and page 5, lines 17 to 19, and that due to its presence on the spool the annular cap 60 which was needed in the spool of D6 is no longer needed.

Given that compression of the film loaded onto the spool is also a function of the compression ring mentioned in claim 10 of D0 it follows that the terms "compression ring" and "annular ring 32" are two alternative names for the same entity.

The compression ring is thus identical with the annular ring 32 and its insertion into claim 1, in combination with the reference sign 32, does not violate the requirements of Article 123(2) EPC.

*Claim 7 according to the main request - admission of the appellant's objections based on Articles 84, 123(2) and 100(c) EPC raised for the first time during the oral proceedings*

The respondent expressly opposes the introduction into the appeal proceedings of this fresh ground for opposition according to Article 100(c) EPC.

The appellant's objections based on Article 84 EPC (lack of clarity) and Article 123(2) EPC (unallowable amendment) against the presence of the feature "compression ring (32)" in claim 7, said feature being also present in one of the two alternatives of claim 10 as granted, cannot be examined in view of the decision G 3/14 (from 24 March 2015, not yet published in OJ EPO), see point 62 of the reasons.

*Claim 1 according to the first auxiliary request - admission of the appellant's objections based on Articles 84, 123(2) and 100(c) EPC raised for the first time during the oral proceedings*

Given that claim 1 of the first auxiliary request is identical with claim 7 of the main request the same arguments and submissions put forward in respect of claim 7 of the main request are valid also for claim 1 of the first auxiliary request.

*Claim 1 according to the first auxiliary request - admission of the appellant's objections based on Article 56 EPC raised for the first time during the oral proceedings*

In its statement setting out the grounds of appeal the appellant presented lack of inventive step arguments only in respect of the product claim 1 of the main request.

It was only during the oral proceedings that the

appellant presented lack of inventive step arguments in respect of the method claim.

For this reason the Board should exercise its discretion against the appellant and not admit these late submitted objections.

*Claim 1 according to the first auxiliary request - inventive step, Articles 52(1) and 56 EPC*

When the pleated film material 23 of D8b is placed onto the coil holder 24, there is no need for it to be retained in place by a compression ring, as it is prevented from moving in a downward direction by the "enlarged lower end 28" of the coil holder, and is prevented from moving in an upward direction by the conical shape of the "transition piece 17" in the embodiment shown in figures 1 to 3 of D8b and the conical shape of the "hopper 11" in the embodiment of figure 4 of D8b. Therefore, it is clear from D8b that once the pleated film material is placed on the coil holder neither retention nor compression of the pleated film material is necessary.

In column 2, lines 53 to 54 of D8b is disclosed that "the lower end 28 of the coil holder is enlarged to retain the coil on the coil holder". This disclosure makes it clear that gravity would clearly affect the pleated film material, and it would be clear to the skilled person that no compression is required in order to make easier pulling down of the pleated film material possible.

The skilled person would therefore see no reason to add a compression ring 56, 58 as known from D6 to the coil

holder 24 of D8b. Furthermore, the compression ring 56, 58 of D6 is incompatible with the structure of D8b.

### **Reasons for the Decision**

1. Claim 1 of the main request - amendments, Article 123(2) EPC
- 1.1 In the general description part of D0, see page 1, lines 19 to 22, reference is made to D6, said last relating to an **apparatus** for fitting a flexible tubing into a cassette via a **compression ring** and a floating **annular cap**.
- 1.2 In the part of the description of D0 relating to the **spool 10** depicted in figure 2 reference is made to a simple **annular disc 32**, see page 3, lines 15 to 18.
- 1.3 In the first part of the paragraph bridging pages 4 and 5 of D0 it is stated that the floating **annular cap** is no longer required, said cap being obviously the one known from D6. Further, **the annular disc 32**, obviously the one referred to on page 3, lines 15 to 18 of D0, can be of light-weight cheap material and is simply formed, or can be dispensed with altogether. In the last part of the same paragraph of D0 it is again stated that a complex **annular cap** is not needed any more, referring obviously again to the cap known from D6.
- 1.4 The last complete paragraph of page 5 of D0 refers to figure 7, said last showing a second stage in the loading process. According to said paragraph the **annular disc 32** being loaded via reciprocating plunger 72 onto the **spool 10** compresses the loaded film appropriately and remains in place due to a retaining

annular bead 74. Furthermore, it mentions that the rotary station and feeding arrangement for the film can be the one known from D6, the disclosure of said last document being "incorporated herein by reference" into D0.

- 1.5 A specific step of the **method for loading tubular film onto a spool** according to claim 8 of D0 is further defined in claim 10 in the form of "loading a **compression ring** against the loaded film".
  
- 1.6 For the person skilled in the art reading the above-mentioned parts of D0 it is clear that the compression ring and the annular cap referred to on page 1, line 19 to 22 are the compression ring 56, 58 and the annular cap 60 mentioned on page 5, line 21 to page 6, line 36 of D6, the starting point of the invention of D0. Given that the last complete paragraph on page 5 of D0 referring to a second stage of the loading process states that the disclosure of D6 "is incorporated herein by reference", it is further clear to the person skilled in the art that the compression ring mentioned in claim 10 is, i.e. corresponds to the compression ring 56, 58 of D6 used in the process of loading the film and in doing so, forcing the pleated film into its loaded state.
  
- 1.7 From the above-mentioned paragraph bridging pages 4 and 5 and also from the last complete paragraph on page 5 of D0 it is further clear for the person skilled in the art that the annular cap 60 of D6 is no longer required for the spool 10 of D0, since the annular disc 32 takes over the cap's function of keeping the loaded film on the spool.

1.8 From the above follows that the compression ring disclosed in D0 corresponds to the compression ring 56, 58 of the **apparatus** for producing axially compacted film tubing of D6, see page 1, lines 19 to 22 of D0 and as used in the **process** of loading the film onto the spool. There is no indication or teaching in D0 that this compression **ring** is identical with the annular **disc** 32 remaining on the spool and thus being a structural part of the spool.

1.9 The respondent argues that given that compression of the film loaded on the spool is a function of both the "compression ring" and the "annular ring 32", said terms are two different but alternative names of the same entity, i.e. the compression ring is identical with the annular disc 32.

1.10 This cannot be followed by the Board for the following reasons.

Firstly, according to the teaching of D0 the compressing ring acting in a sense similar to the function of compression rings 56, 58 of D6 compresses in a first step the film loaded on the spool and retracts in the second step from the compressed film in order to allow in a further step the cap 60, according to D6, or the annular disc 32, according to D0, to be loaded against the upper face of the compressed film and to become part of the spool. The compression ring does **not** remain on the spool.

Secondly, a ring and an annular disc are not necessarily identical objects. A ring is generic whereas an annular disc is more specific. An annular disc is also a ring, but not every ring is an annular disc. A ring can have a cross-section which is not

necessarily plane and thin. Even if accepting, for the sake of argument, that the **annular disc** 32 which may apply compression to the film loaded on the spool can be seen as an annular **compression disc**, redefining it as a **compression ring** generates new information, which is not as such directly and unambiguously derivable from D0.

- 1.11 For the above-mentioned reasons claim 1 violates the requirements of Article 123(2) EPC.
  
2. *Claim 7 according to the main request - admission of the appellant's objections raised for the first time during the oral proceedings based on Articles 84, 123(2) and 100(c) EPC*
  
- 2.1 In a first line of argument the appellant considered claim 7 being equivalent to the first alternative of claim 10 of the patent as granted, i.e. equivalent to a granted claim and therefore open to the objection according to Article 100(c) EPC it had already raised with the notice of opposition against the method claim 8, on which claim 10 depended. The objections raised during the oral proceedings against claim 7, i.e. against the first alternative of claim 10 of the patent as granted should therefore not be considered as a fresh ground for opposition.
  
- 2.2 In the first complete paragraph on page 2 of annex 1 of its notice of opposition the appellant substantiated an objection according to Article 100(c) EPC against the presence of the expression "waste storage device spool" in independent method claim 8 as granted. No objection according to Article 100(c) EPC was raised at any time during the opposition proceedings against the then

dependent method claim 10, certainly not against the "compression ring (32)".

Also, the opposition division's decision, point 3.2.2 of the reasons mentions that no objections under Article 100(c) EPC have been raised with regard to claim 7 of the main request. Further, neither in the statement setting out the grounds of appeal nor later in the written appeal proceedings was such an objection raised. Raising it only during the oral proceedings before the Board certainly makes it a new ground of opposition, due to the fact that the presence of the compression ring has no connection with the issue of the "waste storage spool".

2.3 According to G 10/91, see OJ EPO 1993, 420, headnote 3, a fresh ground for opposition may be considered in appeal proceedings only with the approval of the patent proprietor. This means for the present case that this objection may not be dealt with in substance by the Board, given that the respondent expressly opposed the introduction of said fresh ground for opposition into the appeal proceedings.

2.4 In a second line of argument the appellant considered claim 7 as resulting from the independent method claim 8 from the patent as granted being amended through the insertion into said claim of the first alternative of dependent method claim 10. Accordingly, such an amended claim should be open to examination according to the requirements of Article 84 EPC and Article 123(2) EPC.

2.5 The Board follows the appellant in that claim 7 results from the introduction of the first alternative of dependent claim 10 as granted into independent claim 8 as granted. This alternative has the reference sign 32



in combination with the compression ring. Accordingly, the **amendment** of claim 8 as granted consists in the literal insertion of said first alternative of dependent claim 10 as granted into said independent claim.

2.6 According to the conclusion of the Enlarged Board of Appeal under point 62 of G 3/14 (*supra*) it is not the object and purpose of Article 101(3) EPC, on an **amendment of a granted claim**, "to open up the **patent to complete re-examination**, whether for **clarity or the other requirements of EPC**. Rather, the indication is that what is relevant is **the amendment itself** and its effect as regards the ground for opposition which is intended to overcome, rather than whether other parts of the patent also meet the requirements of the EPC" (emphasis added by the Board).

2.7 Given that the **amendment** of claim 8 as granted consists only of the literal insertion of the first alternative of dependent claim 10 as granted into said independent claim, see point 2.5 above, the objections based on the requirements of the EPC according to Article 84 EPC (lack of clarity) and Article 123(2) EPC (unallowable amendment) raised by the appellant against the feature "compression ring (32)" of claim 7 cannot be examined by the Board in view of the above-mentioned conclusions under point 62 of G 3/14 (*supra*).

3. *Claim 1 according to the first auxiliary request - admission of the appellant's objections based on Articles 84, 123(2) and 100(c) EPC raised for the first time during the oral proceedings*

Given that claim 1 of the first auxiliary request is identical with claim 7 of the main request the Board's

finding under point 2 above is also applicable to claim 1 of the first auxiliary request.

4. *Claim 1 according to the first auxiliary request - admission of the appellant's objections based on Article 56 EPC raised for the first time during the oral proceedings*
- 4.1 Under point 3.6.2 of its decision the opposition division found that its considerations in respect of inventive step concerning the product claim 1 of the main request are *mutatis mutandis* applicable to the method claim 7 of the main request, i.e. to the present method claim 1. For that reason the subject-matter of this claim was considered to involve inventive step.
- 4.2 In its statement setting out the grounds of appeal the appellant presented lack of inventive step arguments only in respect of the product claim 1 of the main request.
- 4.3 On the other hand, it was only due to the filing of the first auxiliary request with letter dated 6 November 2015, i.e. only one month before the oral proceedings, said request having only method claims, that the discussion concerning the patentability of the present invention has been focused exclusively on the method.
- 4.4 This means that the appellant was for the first time confronted with a new set of claims, exclusively focused on the method. In addition, the Board follows the appellant arguing that the same arguments presented to the inventive step issue in respect of claim 1 of the main request are in any case *mutatis mutandis* applicable to the method claim 7 of that request, i.e. to the method claim 1 of the present first auxiliary

request, as it was also recognised in the impugned decision. The respondent could therefore not be taken by surprise when confronted with these arguments.

4.5 Considering the above, the Board exercises its discretion according to Article 13(1) RPBA to admit these appellant's objections.

5. *Claim 1 according to the first auxiliary request - inventive step, Articles 52(1) and 56 EPC*

5.1 It is undisputed that at least the method step of claim 1, of loading a compression ring against the loaded film, is not known from the method of loading a tubular film onto a spool as known from D8b.

5.2 The effect of this step is the compression of the loaded film.

5.3 The problem to be solved is therefore to be seen in the provision of means for compressing the film on the spool.

5.4 According to the method known from D8b the pleated film material (flexible plastic tubing 23) "is folded and gathered in an axial direction to form a coil which is held together by **suitable means** such as paper tape or ties 26 until it is mounted on the coil holder" (emphasis added by the Board), see column 2, lines 36 to 39.

5.5 The appellant argues that in D8b the paper tape or ties only constitute two of several possible solutions to the technical problem of compressing the pleated film on the spool and the statement "by suitable means" indicates to the person skilled in the art that

alternative solutions are in any case to be considered. The person skilled in the art seeking to find an alternative to the paper tape or ties would apply the teaching of D6 and instead of the tape or ties he would use the compression ring 56 known from D6 and would thus arrive at the subject-matter of claim 1 without the exercise of an inventive activity.

5.6 The Board cannot follow the above-mentioned arguments of the appellant for the following reasons.

5.6.1 D6 discloses a method for producing an axially compacted film material (tubing) 22 via the steps of first compressing said film material by a compressing ring 58 into an annular container body 20 holding the shirred tubing and subsequently closing the upper part of the container via a separate annular cap 60, providing thereby a complete cassette.

5.6.2 According to the claim, the film is loaded from the film dispenser onto the spool. That results in "loaded film", against which a compression ring is subsequently loaded. If the skilled person would consider using the cassette of D6 he would first have to secure the film material in its compressed state, take said film material out of the cassette and load it onto the spool 24 of D8b. He would then have to take away said securing means and at the same time have provided a compression ring as the one shown in figures 9 and 10 of D6 on the spool 24, to keep the film compressed towards the flared end. This means he has to go to an inordinate amount of trouble, not in the least go against the teaching of D6, namely to apply compression to the film material via a compression ring **after** said film material has been taken out of the cassette and not **before**, according to the teaching of D6, it has

been compacted and loaded into the cassette, see page 5, line 21 to page 7, line 1 of D6.

- 5.6.3 This cannot be seen as obvious steps for the person skilled in the art and therefore the subject-matter of claim 1 involves an inventive step (Article 56 EPC).

6. *Procedural matters*

In view of the Board's finding under point 1 above the impugned decision has to be set aside. Furthermore, in view of the Board's finding under point 5 above the patent now relates exclusively to a method for loading tubular film onto a spool. A description appropriately adapted to the method claims of the first auxiliary request will require more extensive examination, more than can be examined in the framework of oral proceedings. Due to the important change in the course of these proceedings, the parties should have the opportunity to argue their case before two instances. The Board therefore considers it appropriate to make use of its power under Article 111(1) EPC to remit the case to the opposition division for further prosecution.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent with claims 1 and 2 of the first auxiliary request filed with letter dated 6 November 2015 and a description, and if need be, the drawings to be adapted thereto.

The Registrar:

The Chairman:



G. Nachtigall

H. Meinders

Decision electronically authenticated