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Datasheet for the decision of 10 December 2018

Case Number: T 0408/14 - 3.2.07

Application Number: 06725264.3

Publication Number: 1866209

IPC: B65B19/22, B65B53/02, B65B51/32

Language of the proceedings: EN

Title of invention:
METHOD AND DEVICE FOR FINISHING PACKETS HAVING RESPECTIVE OVERWRAPPINGS OF HEAT-SHRINK MATERIAL

Patent Proprietor:
G.D Societa' per Azioni

Opponent:
Focke & Co. (GmbH & Co. KG)

Headword:

Relevant legal provisions:
EPC Art. 54(1), 56, 111(1), 112(1)(a), 113(1)
RPBA Art. 12(4)

Keyword:
Right to be heard - violation (no)
Referral to the Enlarged Board of Appeal - (no)
Main request and auxiliary requests 1-3 - novelty and/or inventive step (no)
Auxiliary requests 4-7 - admission and remittal to the opposition division (yes)

Decisions cited:

Catchword:

Europäisches Patentamt
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Case Number: T 0408/14 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 10 December 2018

Appellant: (Patent Proprietor)	G.D Societa' per Azioni Via Battindarno 91 40133 Bologna (IT)
Representative:	Bergadano, Mirko Studio Torta S.p.A. Via Viotti, 9 10121 Torino (IT)
Respondent: (Opponent)	Focke & Co. (GmbH & Co. KG) Siemensstrasse 10 27283 Verden (DE)
Representative:	Ellberg, Nils Meissner Bolte Patentanwälte Rechtsanwälte Partnerschaft mbB Hollerallee 73 28209 Bremen (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 20 December 2013 revoking European patent No. 1866209 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	I. Beckedorf
Members:	G. Patton
	K. Poalas

Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal within the prescribed time limit and in the prescribed form against the decision of the Opposition Division to revoke European patent No. 1 866 209.

The opposition had been filed against the patent as a whole and was based on Article 100(a) EPC (lack of novelty and lack of inventive step). In Form 2300, the box relating to Article 100(b) EPC (insufficiency of disclosure) was ticked. This latter ground for opposition was, however, not substantiated in the notice of opposition so it does not form part of the legal frame of the opposition appeal proceedings.

The Opposition Division held that:

- the subject-matter of claims 1 and 18 of the then main request (patent as granted) was novel but did not involve an inventive step starting from D4 in combination with the skilled person's common general knowledge as illustrated by D2, D10 or D8;
- the same applied to the claimed subject-matters of the then auxiliary requests 1 to 6 and 15; and
- the then auxiliary requests 7-14 were not admitted into the proceedings.

II. The following documents of the opposition proceedings are relevant for the present decision:

D1: EP-A-1 103 465;
D2: GB-A-1 234 731;
D3: US-A-5 058 361;
D4: US-A-6 511 405, cited in paragraph 4 of the contested patent;
D5: DE-A-38 24 924;

D7: US-A-2004/0151481;
D8: EP-B-0 268 151; and
D10: DE-B-1 761 523.

III. With the statement setting out the grounds of appeal, the appellant requested

that the impugned decision be set aside and
that the patent be maintained as granted (main request),
or, alternatively,
that the patent be maintained in amended form according to one of the sets of claims filed with the statement setting out the grounds and referred as main request (A), main request (B), auxiliary requests 1, 1(A), 1(B), 2, 2(A), 2(B), 3, 3(A), 3(B), 4, 4(A), 4(B), 5, 5(A), 5(B), 6 and 7.

For each of the main request and auxiliary requests 1-5:
- auxiliary requests **A** corresponded to the device claims of the respective requests (method claims deleted);
- auxiliary requests **B** corresponded to the method claims of the respective requests (device claims deleted).

The appellant requested incidentally

that the appeal fee be reimbursed under Rule 103(1) EPC, and/or
that the case be remitted to the Opposition Division with a different composition, due to a violation of its right to be heard.

The appellant further requested

that the question of law formulated on page 4 of the statement setting out the grounds (see item (4)) be referred to the Enlarged Board of Appeal.

With its reply, the opponent (respondent) requested

that the appeal be dismissed.

IV. The Board provided the parties with its preliminary non-binding opinion in a communication dated 18 October 2018 pursuant to Article 15(1) RPBA, according to which:
- the subject-matters of the independent claims of the main request, main request (A), main request (B), and auxiliary requests 1, 1(A) and 1(B) seemed to be lacking novelty over D4;
- the subject-matters of the independent claims of auxiliary requests 2, 2(A), 2(B), 3, 3(A) and 3(B) seemed to be lacking inventive step starting from D4 as closest prior art in view of the teaching of D10; and
- the appellant's requests for reimbursement of the appeal fee and/or for (immediate) remittal of the case to the Opposition Division and also for referring a question of law to the Enlarged Board of Appeal would not be granted.

In reaction, the appellant filed with its letter dated 6 November 2018 additional arguments concerning, *inter alia,* the device disclosed in D4 together with a paper copy of the auxiliary requests A and B already on file. It also filed a definition of the word "embed":

PA1: Internet extract, url: https://dictionary.cambridge.org/dictionary/english/

embed, EMBED|meaning in the Cambridge English Dictionary, undated, 5 pages

The respondent also reacted to the Board's preliminary opinion by filing arguments against auxiliary requests 4-7 on the basis of the following new documents:

D12: DE 35 14 714 A;
D13: DE 1 234 505 A; and
D14: EP 1 369 362 A.

V. Oral proceedings took place on 10 December 2018, during which the appellant withdrew its request for reimbursement of the appeal fee.

For more details about the course of the oral proceedings reference is made to the minutes.

The order of the present decision was announced at the end of the oral proceedings.

VI. The appellant requested

that the decision under appeal be set aside
and
that the case be remitted to the Opposition Division due to an alleged procedural violation,
or
that the patent be maintained as granted (main request),
or, in the alternative,
that the patent be maintained in amended form on the basis of one of the sets of claims filed by letter dated 30 April 2014 as main requests A and B and as auxiliary requests 1, 1(A), 1(B), 2, 2(A),

2(B), 3, 3(A), 3(B), 4, 4(A), 4(B), 5, 5(A), 5(B), 6 and 7,
where the A- and B-versions of the main requests and of auxiliary requests 1 to 5 were re-filed with a letter dated 6 November 2018,
and further
that the following question of law be referred to the Enlarged Board of Appeal:
"Is a small number of patent documents (e.g. two or three) enough evidence of common general knowledge in the absence of any other element in that regard?"

VII. The respondent requested

that the appeal be dismissed.

VIII. Claims 1 of the main request (patent as granted) and main request (A) read as follows:

"A device for finishing packets having respective overwrappings of heat-shrink material, the device (1) comprising feed means (4) for feeding at least a first and at least a second packet (2a, 2b), each of which has a respective lateral surface (18a, 18b), along a first and second feed path (P1, P2), respectively, to a work station (11) through a sealing station (7) and a heat-shrink station (9); a sealing unit (8) located at the sealing station (7) to seal the overwrappings (3) about respective packets (2, 2a, 2b); a heat-shrink unit (10) located at the heat-shrink station (9) to heat the overwrappings (3), so that the overwrappings (3) shrink and adapt to the configuration of the packets (2, 2a, 2b); in the area of the work station (11), in use, the first and second packet (2a, 2b) are brought together so that the lateral surfaces (18a,

18b) of the first and second packet (2a, 2b) are brought into contact with each other, the heat-shrink unit (10) comprising at least one heating member (24) for shrinking the overwrapping (3) of the first packet (2a) by heating at least the lateral surface (18a) of the first packet (2a); the device being characterized by comprising a cooling unit (12) located downstream from the heat-shrink station (9) to cool the overwrappings (3); the cooling unit (12) being located downstream from the heating member (24) to cool at least the lateral surface (18a) of the first packet (2a) before the lateral surfaces (18a, 18b) of the first and second packets (2a, 2b) are brought into contact with each other."

Claim 18 of the main request (patent as granted) and claim 1 of main request (B) read as follows:

"Method of finishing packets having respective overwrappings of heat-shrink material, the method comprising a sealing step to seal the overwrappings (3), and a heat-shrink step to heat the overwrappings (3) so that the overwrappings (3) adapt to the configuration of the packets (2, 2a, 2b); the heat-shrink step being performed after the sealing step; a feed step to feed at least a first and a second packet (2a, 2b), each of which has a respective lateral surface (18a, 18b), in a traveling direction along a first and a second feed path (P1, P2), respectively, to a work station (11) where the first and second packet (2a, 2b) are brought together so that the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other; at the heat-shrink step, a heating member (24) heats at least the lateral surface (18a) of the first packet (2a) to shrink the overwrapping (3) of the first packet (2a);

and the method being characterized by comprising a cooling step, wherein a cooling unit (12) cools the overwrappings (3); the cooling step being performed after the heat-shrink step and before the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other."

Claims 1 of auxiliary requests 1 and 1(A) read as follows (amendments with respect to claim 1 of the main request are in bold; emphasis added by the Board):

"A device for finishing packets having respective overwrappings of heat-shrink material, the device (1) comprising feed means (4) for feeding at least a first and at least a second packet (2a, 2b), each of which has a respective lateral surface (18a, 18b), along a first and second feed path (P1, P2), respectively, to a work station (11) through a sealing station (7) and a heat-shrink station (9); a sealing unit (8) located at the sealing station (7) to seal the overwrappings (3) about respective packets (2, 2a, 2b); a heat-shrink unit (10) located at the heat-shrink station (9) to heat the overwrappings (3), so that the overwrappings (3) shrink and adapt to the configuration of the packets (2, 2a, 2b); in the area of the work station (11), in use, the first and second packet (2a, 2b) are brought together so that the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other, the heat-shrink unit (10) comprising at least one heating member (24) for shrinking the overwrapping (3) of the first packet (2a) by heating at least the lateral surface (18a) of the first packet (2a); the device being characterized by comprising a cooling unit (12) located downstream from the heat-shrink station (9) to cool the overwrappings (3); **and at least two feed channels (13)**

for respectively directing the first and the second packet (2a, 2b), along the first and the second feed path (P1, P2), respectively; the cooling unit (12) being located downstream from the heating member (24) to cool at least the lateral surface (18a) of the first packet (2a) before the lateral surfaces (18a, 18b) of the first and second packets (2a, 2b) are brought into contact with each other; **the cooling unit (12) being located at the work-station, at the end of the two feed channels (13).**"

Claim 16 of auxiliary request 1 and claim 1 of auxiliary request 1(B) read as follows (amendments with respect to claim 18 of the main request are in bold; emphasis added by the Board).

"Method of finishing packets having respective overwrappings of heat-shrink material, the method comprising a sealing step to seal the overwrappings (3), and a heat-shrink step to heat the overwrappings (3) so that the overwrappings (3) adapt to the configuration of the packets (2, 2a, 2b); the heat-shrink step being performed after the sealing step; a feed step to feed at least a first and a second packet (2a, 2b), each of which has a respective lateral surface (18a, 18b), in a traveling direction along a first and a second feed path (P1, P2), respectively, to a work station (11) where the first and second packet (2a, 2b) are brought together so that the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other; at the heat-shrink step, a heating member (24) heats at least the lateral surface (18a) of the first packet (2a) to shrink the overwrapping (3) of the first packet (2a); and the method being characterized by comprising a cooling step, wherein a cooling unit (12) cools the

overwrappings (3); the cooling step being performed after the heat-shrink step and before the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other; **at least two feed channels (13) for respectively directing the first and the second packet (2a, 2b), along the first and the second feed path (P1, P2), respectively, being provided; the cooling unit (12) being located at the work-station, at the end of the two feed channels (13).**"

Claims 1 of auxiliary request 2 and 2(A) read as follows (amendments with respect to claim 1 of auxiliary request 1 are in bold; emphasis added by the Board):

"A device for finishing packets having respective overwrappings of heat-shrink material, the device (1) comprising feed means (4) for feeding at least a first and at least a second packet (2a, 2b), each of which has a respective lateral surface (18a, 18b), along a first and second feed path (P1, P2), respectively, to a work station (11) through a sealing station (7) and a heat-shrink station (9); a sealing unit (8) located at the sealing station (7) to seal the overwrappings (3) about respective packets (2, 2a, 2b); a heat-shrink unit (10) located at the heat-shrink station (9) to heat the overwrappings (3), so that the overwrappings (3) shrink and adapt to the configuration of the packets (2, 2a, 2b); in the area of the work station (11), in use, the first and second packet (2a, 2b) are brought together so that the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other, the heat-shrink unit (10) comprising at least one heating member (24) for shrinking the overwrapping (3) of the first packet

(2a) by heating at least the lateral surface (18a) of the first packet (2a); the device being characterized by comprising a cooling unit (12) located downstream from the heat-shrink station (9) to cool the overwrappings (3); and at least two feed channels (13) for respectively directing the first and the second packet (2a, 2b), along the first and the second feed path (P1, P2), respectively; the cooling unit (12) being located downstream from the heating member (24) to cool at least the lateral surface (18a) of the first packet (2a) before the lateral surfaces (18a, 18b) of the first and second packets (2a, 2b) are brought into contact with each other; the cooling unit (12) being located at the work-station, at the end of the two feed channels (13) **and comprising at least one outlet nozzle (26; 33, 34, 35) to emit at least one air jet onto the lateral surface (18a, 18b) of the first and/or second packet (2a, 2b).**"

Claim 15 of auxiliary request 2 and claim 1 of auxiliary request 2(B) read as follows (amendments with respect to claim 16 of auxiliary request 1 are in bold; emphasis added by the Board).

"Method of finishing packets having respective overwrappings of heat-shrink material, the method comprising a sealing step to seal the overwrappings (3), and a heat-shrink step to heat the overwrappings (3) so that the overwrappings (3) adapt to the configuration of the packets (2, 2a, 2b); the heat-shrink step being performed after the sealing step; a feed step to feed at least a first and a second packet (2a, 2b), each of which has a respective lateral surface (18a, 18b), in a traveling direction along a first and a second feed path (P1, P2), respectively, to a work station (11) where the first and second packet

(2a, 2b) are brought together so that the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other; at the heat-shrink step, a heating member (24) heats at least the lateral surface (18a) of the first packet (2a) to shrink the overwrapping (3) of the first packet (2a); and the method being characterized by comprising a cooling step, wherein a cooling unit (12) cools the overwrappings (3); the cooling step being performed after the heat-shrink step and before the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other; at least two feed channels (13) for respectively directing the first and the second packet (2a, 2b), along the first and the second feed path (P1, P2), respectively, being provided; the cooling unit (12) being located at the work-station, at the end of the two feed channels (13); **at the cooling step, at least one air jet is directed onto the lateral surface (18a, 18b) of the first and/or second packet (2a, 2b).**"

Claims 1 of auxiliary request 3 and 3(A) read as follows (amendments with respect to claim 1 of auxiliary request 2 are in bold; emphasis added by the Board):

"A device for finishing packets having respective overwrappings of heat-shrink material, the device (1) comprising feed means (4) for feeding at least a first and at least a second packet (2a, 2b), each of which has a respective lateral surface (18a, 18b), along a first and second feed path (P1, P2), respectively, to a work station (11) through a sealing station (7) and a heat-shrink station (9); a sealing unit (8) located at the sealing station (7) to seal the overwrappings (3) about respective packets (2, 2a, 2b); a heat-shrink

unit (10) located at the heat-shrink station (9) to heat the overwrappings (3), so that the overwrappings (3) shrink and adapt to the configuration of the packets (2, 2a, 2b); in the area of the work station (11), in use, the first and second packet (2a, 2b) are brought together so that the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other, the heat-shrink unit (10) comprising at least one heating member (24) for shrinking the overwrapping (3) of the first packet (2a) by heating at least the lateral surface (18a) of the first packet (2a); the device being characterized by comprising a cooling unit (12) located downstream from the heat-shrink station (9) to cool the overwrappings (3); and at least two feed channels (13) for respectively directing the first and the second packet (2a, 2b), along the first and the second feed path (P1, P2), respectively; the cooling unit (12) being located downstream from the heating member (24) to cool at least the lateral surface (18a) of the first packet (2a) before the lateral surfaces (18a, 18b) of the first and second packets (2a, 2b) are brought into contact with each other; the cooling unit (12) being located at the work-station, at the end of the two feed channels (13); **the heating member (24) is interposed between the first and the second feed path (P1, P2) to shrink the overwrappings (3) of the first and second packet (2a, 2b) heating the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b); the cooling unit (12) being located downstream from the heating member (24) to cool the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) before the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other; the cooling unit comprises** ~~and comprising~~ at least one outlet nozzle (26; 33, 34, 35) to emit at least one air

jet onto the lateral surface (18a, 18b) of the first and/or second packet (2a, 2b)."

Claim 14 of auxiliary request 3 and claim 1 of auxiliary request 3(B) reads as follows (in bold the amendments with respect to claim 15 of auxiliary request 2; emphasis added by the Board).

"Method of finishing packets having respective overwrappings of heat-shrink material, the method comprising a sealing step to seal the overwrappings (3), and a heat-shrink step to heat the overwrappings (3) so that the overwrappings (3) adapt to the configuration of the packets (2, 2a, 2b); the heat-shrink step being performed after the sealing step; a feed step to feed at least a first and a second packet (2a, 2b), each of which has a respective lateral surface (18a, 18b), in a traveling direction along a first and a second feed path (P1, P2), respectively, to a work station (11) where the first and second packet (2a, 2b) are brought together so that the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other; at the heat-shrink step, a heating member (24) heats at least the lateral surface (18a) of the first packet (2a) to shrink the overwrapping (3) of the first packet (2a); and the method being characterized by comprising a cooling step, wherein a cooling unit (12) cools the overwrappings (3); the cooling step being performed after the heat-shrink step and before the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other; at least two feed channels (13) for respectively directing the first and the second packet (2a, 2b), along the first and the second feed path (P1, P2), respectively, being provided; the cooling unit (12) being located at the work-station, at the end of the two

feed channels (13); **the heating member (24) is interposed between the first and second feed path (P1, P2) and shrinks the overwrap pings (3) of the first and second packet (2a, 2b) heating the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b); the cooling unit (12) is located downstream from the heating member (24) and cools the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) before the lateral surfaces (18a, 18b) of the first and second packet (2a, 2b) are brought into contact with each other;** at the cooling step, at least one air jet is directed onto the lateral surface (18a, 18b) of the first and/or second packet (2a, 2b)."

In view of the outcome of the present decision there is no need to give the wording of the independent claims of auxiliary requests 4 to 7.

IX. The appellant argued essentially as follows (the arguments are discussed in more details in the reasons for the decision):

Remittal - referral to the Enlarged Board of Appeal

The impugned decision was based on a line of argument which had not been properly discussed by the parties during the oral proceedings before the Opposition Division. Hence, the appellant's right to be heard had been violated and the case should be remitted to the Opposition Division with a different composition.

According to the case law, the skilled person's common general knowledge is established by handbooks and textbooks, i.e. not by patent documents as was the case with the Opposition Division. Hence, a question relating to whether a small number of patent documents

(e.g. two or three) would be enough evidence of common general knowledge in the absence of any other element should be referred to the Enlarged Board of Appeal.

Main request (patent as granted) - main requests (A) and (B)

The device disclosed in document D4 does not comprise **a cooling unit**. Hence, novelty should be acknowledged for the subject-matters of independent claims 1 and 18 of the main request on this basis (feature (a)).

In view of the technical effect associated with this distinguishing feature, the problem to be solved can be seen as to prevent the packets sticking to each other when they are brought together after shrinkage so as to decrease the risk of damaging them.

Since none of the available prior art documents discloses or suggests the solution, nor addresses said problem, inventive step should be acknowledged for the claimed subject-matters.

In addition, the skilled person faced with said problem would have many solutions at their disposal so that the claimed solution cannot then be seen as a one-way-street solution. The skilled person could select the claimed solution, but there is no reason why they would do so.

The same applies to claims 1 of main requests (A) and (B).

Auxiliary requests 1, 1(A), 1(B)

The following feature of independent claims 1 and 16 of auxiliary request 1:

(b) the cooling unit being located at the work station

is not disclosed in D4 and renders the claimed subject-matters novel and inventive over the available prior art documents.

The same applies to claims 1 of auxiliary requests 1(A) and 1(B).

Auxiliary requests 2, 2(A), 2(B)

Document D4 does not disclose:

(c) an outlet nozzle to emit at least one air jet

so that novelty is to be acknowledged for the subject-matter of independent claims 1 and 15 of auxiliary request 2.

In the claims, it is unambiguous that the lateral surface of the first and/or second packet onto which the air jet is directed is/are the lateral surface(s) which is/are to be brought into contact with each other. The claimed solution in this configuration is not disclosed or suggested in D10, nor is it in the available prior art documents. No evidence is provided for the skilled person's common general knowledge in this respect. Inventive step of the claimed subject-matters should then be acknowledged.

The same applies to claims 1 of auxiliary requests 2(A) and 2(B).

Auxiliary requests 3, 3(A), 3(B)

The closest prior art D4 does not disclose that:

> (d) the heating member is interposed between the first and the second feed path to shrink the overwrappings of the first and second packet.

Feature (d) is then an additional distinguishing feature of independent claims 1 and 14 over D4. It does not contribute to the solution of the problem associated with the cooling of the overwrappings linked with distinguishing features (a) and (c). However, contrary to the respondent's view, the claimed solution is not disclosed in D1 nor in the other available prior art documents. Hence, inventive step should be acknowledged for the claimed subject-matters.

The same applies to claims 1 of auxiliary requests 3(A) and 3(B).

Auxiliary requests 4 to 7

Due to the repeated misleading indications provided by the Opposition Division during the oral proceedings, the appellant could not react by filing appropriate auxiliary requests. It could only do so once it had received the impugned decision with the statement setting out the grounds of appeal. For this reason, auxiliary requests 4 to 7 should be admitted into the proceedings.

There is no objection to remit the case to the Opposition Division for further prosecution on the basis of auxiliary requests 4 to 7.

X. The respondent argued essentially as follows (the arguments are discussed in more details in the reasons for the decision):

Remittal - referral to the Enlarged Board of Appeal

The respondent did not provide any arguments on these issues.

Main request (patent as granted) - main requests (A) and (B)

Document D4 discloses all the features of independent claims 1 and 18 of the main request, including a cooling unit since the end surface 48 of the carrying plate 35 of the heating plate 33 is suitable for cooling the overwrappings 13. Hence, the claimed subject-matters should be regarded as lacking novelty.

Should document D4 be considered as not disclosing **a cooling unit**, the problem to be solved starting from D4 as closest prior art would be to prevent the packets sticking to each other when they are brought together after shrinkage so as to decrease the risk of damaging them.

The skilled person faced with this problem would realise that the obvious solution is to remove the heat, i.e. reduce the temperature. This common general knowledge is illustrated, for instance, by D10. The fact that other possible solutions exist does not render the obvious solution inventive.

Hence, starting from D4, the skilled person using their common general knowledge would arrive at the claimed subject-matters in an obvious manner.

The same applies to claims 1 of main requests (A) and (B).

Auxiliary requests 1, 1(A), 1(B)

Document D4 discloses the features added to independent claims 1 and 16 of auxiliary request 1 with respect to claims 1 and 18 of the main request. Hence, the same reasons as those given for the main request still apply. In particular, their subject-matters lack inventive step.

The same applies to claims 1 of auxiliary requests 1(A) and 1(B).

Auxiliary requests 2, 2(A), 2(B)

It is not clearly specified in independent claims 1 and 15 of auxiliary request 2 that the lateral surfaces which are brought into contact with each other are those onto which the air is directed.

The closest prior art document D4 does not disclose

(c) an outlet nozzle to emit at least one air jet.

This distinguishing feature (c) has a synergetic effect with the distinguishing feature relating to the cooling unit discussed for the main request, leading to the same problem to be solved, namely to prevent the packets sticking to each other when they are brought

together after shrinkage so as to decrease the risk of damaging them.

Cooling by air jet belongs to the skilled person's common general knowledge, as illustrated, for instance, by D10.

As a consequence, starting from D4, the skilled person using their common general knowledge as illustrated by D10 would arrive at the claimed subject-matters in an obvious manner.

The same applies to claims 1 of auxiliary requests 2(A) and 2(B).

Auxiliary requests 3, 3(A), 3(B)

D4 does not disclose the feature of independent claims 1 and 14 of auxiliary request 3 that the heating member shrinks the overwrappings of the first and second packets, i.e. including the ones located in the top row.

The technical effect associated with this feature relates to the heating step which has no synergy with the technical effect of the other distinguishing features (a) and (c). Its contribution to inventive step for the claimed subject-matters can then be assessed independently from the other distinguishing features.

The partial problem to be solved in view of this distinguishing feature can be seen as to improve the efficiency of the heating step.

The claimed solution is known from D1, and the skilled person would have no difficulties to implement this known solution into the device of D4.

As a consequence, starting from D4, the skilled person using their common general knowledge and the teaching of D1 would arrive at the claimed subject-matters in an obvious manner.

The same applies to claims 1 of auxiliary requests 3(A) and 3(B).

Auxiliary requests 4 to 7

Auxiliary requests 4, 4(a), 4(B), 5, 5(A), 5(B), 6 and 7 should not be admitted into the proceedings since they could have been presented during the opposition proceedings.

The case should not be remitted to the Opposition Division. A second oral proceedings before the Board should instead be arranged in order to avoid lengthy proceedings before a final decision can be reached.

Reasons for the Decision

1. *Remittal - referral to the Enlarged Board of Appeal*

1.1 In order to support its request for immediate remittal to the Opposition Division (with a different composition), the appellant argues that its right to be heard was violated pursuant to Article 113(1) EPC. In its view, the impugned decision was based on a line of argument, i.e. combination of the teaching of D4 with the skilled person's common general knowledge, which had not been properly discussed by the parties during the oral proceedings. The Opposition Division provided "*indications not in the right directions*". These misleading statements were repeated several times by the Opposition Division during the oral proceedings (statement setting out the grounds, pages 3-4, point 1.1, items(1)-(5) and pages 16-17, point 1.10; appellant's letter dated 6 November 2018, point 5).

1.2 The Board cannot share the appellant's view for the following reasons.

1.2.1 With its letter dated 10 September 2012, i.e. before the oral proceedings before the Opposition Division, the respondent had made clear in point III.1 that the skilled person, in view of the disclosure of D4, would find the claimed solution ("cooling unit") an obvious measure, i.e. on the basis of their common general knowledge. In the oral proceedings, the respondent provided its line of argument on a similar basis (see point 5 of the minutes), to which the appellant reacted (point 6 of the minutes). The appellant was then aware of such an objection and, hence, had to be pro-reactive, i.e. not merely wait for "indications" from the Opposition Division in order to take position on

and provide counter arguments against an objection which had already been formulated. At the oral proceedings the fact that the Opposition Division provided orally a different statement with respect to its finding in the impugned decision does not invalidate the fact that the appellant had the opportunity to take position on the objection relating to the combination of the disclosure of D4 with the common general knowledge as illustrated by any one of documents D10, D2 and D8. The appellant's right to be heard was hence not violated (Article 113(1) EPC).

1.2.2 The considerations brought forward by the appellant in the statement setting out the grounds, point 1.1, item (3), relate to whether the Opposition Division assessed inventive step in a correct manner, in particular whether it applied the problem/solution approach properly, e.g. without hindsight. This concerns the substantive evaluation of the case at hand by the Opposition Division and, hence, cannot be seen as amounting to a substantial procedural violation. The same applies to items (4) and (5) of point 1.1 of the statement setting out the grounds.

1.2.3 Regarding said item (4), the Board further emphasises that, when taking its decision, the Opposition Division is entitled, depending on the case and arguments of the parties, to determine by itself what does or does not belong to the skilled person's common general knowledge, and not always with supporting evidence. Patent documents, whatever their numbers, could then, depending on their disclosure, be cited in order to illustrate this skilled person's common general knowledge. This assessment by the Opposition Division of the skilled person's common general knowledge can be disputed by the parties in appeal proceedings but

cannot be seen as amounting to a substantial procedural violation. This corresponds to the present case in view of the impugned decision, point 2.2.2, ("...*D4 with the general technical knowledge (e.g. the teachings of D10, D2 or D8)*...".

In view of this, the question of law proposed by the appellant for referral to the Enlarged Board of Appeal is not relevant for the decision, i.e. the decision on the case at hand does not require an answer to said question by the Enlarged Board pursuant to Article 112(1)(a) EPC.

1.3 The above was the preliminary opinion of the Board provided to the parties in the communication dated 18 October 2018, point 13. At the oral proceedings the appellant relied upon its written submissions.

After taking into account and re-assessing all the arguments, including the appellant's letter dated 6 November 2018, point 5, as also discussed above, the Board considers that the appellant's requests for (immediately) remitting the case to the Opposition Division and for referring a question to the Enlarged Board of Appeal cannot be granted.

2. *Main request (patent as granted)*

2.1 Novelty

The respondent contests that the subject-matter of claim 1 of the main request is novel over the disclosure of D4 (impugned decision, point 2.2.1).

2.1.1 Disclosure of D4

Document D4 (column 1, line 6 to column 3, line 67; figures; claims) discloses a device ("packaging machine", "apparatus for producing packs") for finishing packets ("packs for cigarettes" 10) having respective overwrappings ("outer wrapper" 13) of heat-shrink material, the device comprising feed means ("pusher" 24) for feeding at least a first and at least a second packet 10, each of which has a respective lateral surface ("large-surface-area sides", "front side", "rear side"), along a first and second feed path ("two pack rows" 22, 23), respectively, to a work station through a sealing station ("sealing station" 25) and a heat-shrink station ("shrinking station" 26); a sealing unit ("lateral sealing jaws" 30, 31) located at the sealing station 25 to seal the overwrappings 13 about respective packets 10; a heat-shrink unit ("top heating plate" 32; "bottom heating plate" 33) located at the heat-shrink station 26 to heat the overwrappings 13, so that the overwrappings 13 shrink and adapt to the configuration of the packets 10; in the area of the work station, in use, the first and second packet 10 are brought together so that the lateral surfaces (upward-facing front side of bottom pack row 23; downward-facing rear side of the top pack row 22) of the first and second packet 10 are brought into contact with each other; the heat-shrink unit 26 comprising at least one heating member ("heating members" 32, 33; "heating elements" 36, 37) for shrinking the overwrapping 13 of the first packet 10 by heating at least the lateral surface (upward-facing front sides of pack rows 22, 23) of the first packet 10.

The device of D4 further comprises a **cooling unit** ("end surface" 48 of "heating plate" 33) located downstream

from the heat-shrink station 26 suitable for cooling the overwrappings 13. As a matter of fact, the **cooling unit** 48 is located downstream from the heating members 32, 33, 36, 37 and is considered to be suitable for cooling at least the lateral surface of the first packet (upward-facing front side of bottom pack row 23; downward-facing rear side of top pack row 22) before the lateral surfaces of the first and second packets (upward-facing front side of bottom pack row 23; downward-facing rear side of the top pack row 22) are brought into contact with each other.

In view of the above, D4 discloses all the features of claim 1 of the main request so that its subject-matter is not novel over D4 (Article 54(1) EPC).

2.1.2 The appellant contests that D4 discloses the features of the characterising part of claim 1, more specifically that the device of D4 comprises **a cooling unit** (see impugned decision, point 2.2.1; statement setting out the grounds, point 1.2, pages 4-6).

The Board does, however, share the respondent's view that the cooling unit of the device of claim 1, in the absence of any specific structural features, consists merely of a unit which has a cooling function. It has hence only to be suitable for cooling the lateral surfaces of (at least) the first packet.

As put forward by the respondent, even though not explicitly disclosed in D4, the end surface 48 of the carrying plate 35 of the heating plate 33 will **inevitably be suitable for providing such function** before the packets 10 are brought into contact with each other (respondent's reply, point I).

In this respect, it is referred to column 5, lines 29-39 of D4, which discloses that the carrying plates 34, 35 have a recess in which the heating elements 36, 37 are positioned so that said heating elements 36, 37 act in a downward direction on the packets positioned beneath the heating element 36, 37, 71 (Figures 7 and 8). In column 1, lines 40-45, and column 3, lines 15-17, it is further specified that heat for shrinking is applied merely to the upwardly directed front sides of the packets 10. Hence, for the skilled person, it is immediately and unambiguously derivable that the temperature of the carrying plates 34, 35 is inevitably lower than the one provided by the heating elements 36, 37, i.e. it is lower than the temperature required for the overwrappings 13 to shrink. Consequently, for the skilled person, a cooling effect is provided by the end surface 48 of the carrying plate 35 to the overwrappings 13 when they reach said end surface 48, contrary to the finding of the impugned decision, point 2.2.1. As also put forward by the respondent it is not specified in claim 1 of the contested patent how high the cooling effect has to be.

2.1.3 The appellant argues that the end surface 48 is disclosed in D4 as **being part of the heating plate 33** in the heat-shrink station 26 so that the end surface 48 cannot act or be seen as a cooling unit. For the appellant, the function of the end surface 48 **is even to heat** since the heat is transmitted through the heating plates 32, 33.

For the appellant, this is all the more true since the text of D4 does not specify that the end surface 48 is part of the carrying plate 35. The text of D4, which is completely **silent on the cooling effect of the end surface 48**, is then contrary to schematic Figure 1.

For the appellant, even though it were to be admitted, which is not, that the end surface 48 was disclosed in D4 as being part of the carrying plate 35, it is clear in view of Figures 7 and 8 that the quality of the **thermal insulation** between the carrying plate 35 and the sheet-like heating element 71 embedded therein **is poor** since said carrying plate 35 and said sheet-like heating element 71 are in direct contact with each other due to the lack of the silicon element 79 on the sides of the sheet-like heating element 71 (see in particular Figure 8 and also column 6, lines 6-8). The term "embedding" used in D4 only means fixed therein (see PA1, page 1). That the end surface 48 would reach a high temperature cannot therefore be excluded.

Still according to the appellant, in view of the high production speed of such devices, around six packets per second, **the time** the packet stays at the heat-shrink station **is short** (column 6, lines 20-25). Hence, in so little time for transmitting the heat, the temperature of the heating element 37 is to be significantly higher than the one reached by the overwrappings 13.

Furthermore, before being moved forward towards the end surface 48 in D4 (stepwise process), **the overwrappings 13 can cool** first in the heat-shrink station 26 while the heating plates 32, 33 are raised. Hence, due to this stationary cooling and the time required to reach and come into contact with the end surface 48, the temperature of the overwrappings 13 would decrease by an unknown amount so as to become lower than the temperature of the end surface 48.

It would then appear that an unambiguous disclosure is lacking in D4 regarding the temperature reached by the overwrappings 13 and the temperature reached by the end surface 48. For this reason, it would not be possible to derive the temperature of the overwrappings 13 or that of the end surface 48 when they come into contact with each other. There is no indication in D4 that the end surface 48 has a temperature sufficient for cooling the overwrappings 13.

As a consequence, it is not directly and unambiguously disclosed in D4 that the end surface 48 would act as a cooling unit.

2.1.4 The Board cannot share the appellant's view for the following reasons discussed in the oral proceedings.

The expression "heating plate" used in D4 is generic since each heating plate 32, 33 comprises a carrying plate 34, 35 and a sheet-like heating element 36, 37, see column 3, lines 22-24. The fact that the carrying plate 35 and the sheet-like heating element 37 are two distinct parts of the heating plate 33 is also clear from column 5, lines 29-39, and Figures 7 and 8.

In D4, it is explicitly disclosed that **only the upwardly directed front sides** of the packets 10 are heated, see column 1, lines 43-45, column 3, lines 10-13 and column 5, lines 29-39. This unambiguously means for the Board that the carrying plate 35 does not provide heat for shrinking the overwrapprings 13 of the packet 10 of the top row 22. The temperature of the carrying plate 35 is therefore lower than that of the overwrappings 13 when shrinking. The carrying plate 35 therefore has to be seen as thermally insulated, at

least to some extent, from the sheet-like heating element 37.

Furthermore, as put forward by the appellant, D4 explicitly discloses that the end surface 48 belongs to the heating plate 33 (column 3, lines 65-66). However, as discussed above, the expression "heating plate" is meant to comprise a carrying plate. Figure 1, which unambiguously discloses that the end surface 48 is part of the carrying plate 35, is therefore not in contradiction with the passage of D4. As a consequence, since the carrying plate 35 has a temperature lower than that of the overwrappings 13 when shrinking, the same inevitably applies for the end surface 48.

Regarding the appellant's arguments with respect to the time for transmitting the heat, and the fact that the temperature of the overwrappings 13 would have decreased before reaching the end surface 48, the Board considers that they relate to **the method of operating the device of D4**. In this respect, the Board agrees with the appellant that D4 does not disclose what are, in use, the temperatures of the end surface 48 and of the overwrappings 13 when they come into contact with each other. The Board also agrees with the appellant in that there could possibly be parameters for operating the device of D4 with which, in use, the temperature of the end surface 48 would not be lower than that of the overwrappings 13 when they come into contact with each other so as the overwrappings 13 would not be cooled.

However, considering on the one hand the appellant's arguments of a high production speed in D4 and, hence, that the time for the packets 10 to reach the end surface 48 after the heat-shrink station 26 is short, and on the other hand, as discussed above, the

intention of D4 of having the carrying plate 35 to be thermally insulated from the heating element 37, at least to some extent, it cannot be excluded that under some operating parameters, in use, the temperature of the carrying plate 35 and hence of the end surface 48, would be lower than that of the overwrappings 13 when they come into contact with each other.

The Board is therefore not convinced that the method of operating the device of D4 described by the appellant in which the end surface 48 would have a temperature higher that that of the overwrappings 13 when they come into contact with each other would be the only possible one in view of the many parameters to be varied when operating the device of D4, including also, *inter alia*, the choice of the material of the overwrappings 13 or the temperature of the heating element 37 as discussed in the oral proceedings.

As a result of the above, the Board finds that the end surface 48 of the carrying plate 35 of the device of D4 is suitable for cooling the overwrappings 13.

3. *Main request (A)*

Since claim 1 of main request (A) is identical to claim 1 of the main request, the same reasoning and conclusion as under point 2 above apply. Hence, the subject-matter of claim 1 of main request (A) also lacks novelty over the disclosure of D4 (Article 54(1) EPC).

4. *Main request (B)*

4.1 Novelty

For the method of claim 1 of main request 1(B) (=claim 18 of the main request), the parties put forward the same arguments as the ones against the device in accordance with claim 1 of the main request.

As discussed under point 2.1.4 above, the Board agrees with the appellant that D4 does not disclose what are, **in use**, the temperatures of the end surface 48 and the overwrappings 13 when they come into contact with each other. Parameters have indeed to be selected in order to operate the device of D4 the way it is specified in the claimed method, i.e. that the end surface 48 actually cools down the overwrappings 13 (see impugned decision, point 2.2.1 of the reasons, page 5).

As a consequence, D4 does not disclose the following feature of the method of claim 1 of main request (B) that:

> (a) a cooling unit cools the overwrappings; the cooling step being performed after the heat-shrink step and before the lateral surfaces of the first and second packet are brought into contact with each other.

Therefore, the subject-matter of claim 1 of main request (B) is novel (Article 54(1) EPC).

4.2 Inventive step

Both parties as well as the Board agree with document D4 being selected as the closest prior art, since D4,

like claim 1 of main request (B), relates to a method of finishing packets having respective overwrappings of heat-shrink material (see for instance claim 1).

The Board notes that the respondent also referred to document D1 as a plausible alternative closest prior art.

4.2.1 Technical effect - problem to be solved

The above-mentioned distinguishing feature (a) has the technical effect of preventing the packets sticking to each other when they are brought together after shrinkage (see contested patent, paragraphs 5 and 6).

As agreed by both parties in the oral proceedings, the problem to be solved can then be seen as to obtain this effect so as to decrease the risk of damaging the packets.

4.2.2 For the appellant, none of the available documents, in particular D10, D7, D3 and D2, discloses or suggests the solution, nor addresses said problem, meaning that inventive step should be acknowledged for the claimed subject-matter.

In D10, the packets do not come into contact with each other and they are put on a roll conveyor so that they do not stay still and cannot stick to anything else.

In D7 and D3, the cooling step is associated with the sealing step, not with the heat-shrink step as claimed.

In D2, cooling is performed after shrinking only in order to be able to retain the shape of the packages

made up of loose material, i.e. wrapping piles of newspaper or magazines, so as to be able to stack them.

In addition, still according to the appellant, the skilled person faced with the above-mentioned technical problem would have many solutions at their disposal, such as implementing vibrating conveyors, provide the packets with transversal movements with respect to one another (see for instance D5, Figure 5 or D8, Figure 9), change the material of the overwrappings, or lower the temperature applied for shrinking. The claimed solution cannot then be seen as a one-way-street solution for the skilled person. The skilled person could select the claimed solution, but there is no reason why they would do so.

4.2.3 The Board cannot share this view for the following reasons discussed in the oral proceedings.

The skilled person faced with the above-mentioned problem would immediately realise that the problem is due to the application of heat. The obvious solution which would first come to skilled person's mind would be to remove, i.e. reduce, this heat by cooling the overwapprings 13. As a matter of fact, cooling after having applied heat in order to avoid the possible problems associated therewith belongs to the skilled person's common general knowledge, whatever the intention for applying the heat, i.e. for sealing or shrinking the overwrappings.

This common general knowledge is illustrated for instance by D10 (see column 1, line 64, to column 2, line 45, Figure 1), which discloses to implement a cooling unit ("Kühlstation" 6) comprising an outlet nozzle ("Ventilatoren" 18, "Luftleitkanälen" 19) to

emit at least one air jet so as to cool the packets after a heat-shrink station (""Schrumpftunnel" 5"). As far as the appellant objected to allowing a small number of patent documents as evidence of the common general knowledge, in respect of which it requested that a question of law be referred to the Enlarged Board, the Board, in agreement with the Opposition Division, finds that the respondent sufficiently, and to the Board's conviction, demonstrated the skilled person's common general technical knowledge, thus making the requested referral unnecessary (see also points 1.2.3 and 1.3 above).

The fact that other solutions may be known to the skilled person, as put forward by the appellant with reference to D5 and D8, does not render the obvious solution of cooling after heating inventive.

Finally, for the same reasons as those given under point 2.1.4 above, the Board is of the opinion that the skilled person would be able to select the appropriate parameters for operating the device of D4 so as to cool the overwrappings 13 by the end surface 48.

As a consequence, starting from D4 the skilled person using their common general knowledge would arrive at the subject-matter of claim 1 of main request (B) (=claim 18 of the main request) in an obvious manner (Article 56 EPC).

5. *Auxiliary request 1*

5.1 With respect to independent claims 1 and 18 of the main request, independent claims 1 and 16 of auxiliary request 1 further comprise the features of dependent claims 3 and 5 of the patent as granted.

Auxiliary request 1 corresponds to auxiliary request 5 underlying the impugned decision, point 6.

5.2 Regarding auxiliary request 1, the appellant considers that the following feature of claims 1 and 16:

> (b) the cooling unit being located at the work station

renders the claimed subject-matter novel and inventive over the available prior art documents.

For the appellant, the work station is defined as the area where the first and second packets are brought together. According to claims 1 and 16, the cooling unit would then be part of the work station as also illustrated in Figure 1 of the contested patent, i.e. located where the first and second packets are brought together.

Since in D4 the end surface 48, which is the cooling unit, is not part of the work station in accordance with claims 1 and 16, feature (b) should be seen as a distinguishing feature over D4.

5.3 The Board cannot share this view for the following reasons discussed in the oral proceedings.

The device of D4 comprises at least two feed channels for respectively directing the first and the second packet 10, along the first and the second feed path ("pack rows" 22, 23), respectively (see also impugned decision, point 4; minutes, point 12).

Furthermore, the cooling unit 48 in D4 is unambiguously located at the work station, at the end of the two feed channels, similarly to Figure 3 of the contested patent. In this respect, the Board shares the respondent's view that the expression "work station" used in claims 1 and 16 encompasses a broad meaning. As a matter of fact, in said claims, it is only specified that the work station includes the area where the first and the second packets are brought together. There is, however, no clear indication where the work station starts and where it finishes, such that the end surface 48 of the device of D4 can also be seen as belonging to such a work station.

As a consequence, feature (b) cannot be seen as a distinguishing feature over D4 so that claims 1 and 16 of auxiliary request 1 are not allowable for the same reasons as those given against claim 1 of the main request and claim 1 of main request (B) respectively (see points 2 and 4.2 above).

In this respect, it is noted that in the oral proceedings the respondent only raised objections of lack of inventive step against the claimed subject-matters of auxiliary request 1 (Article 56 EPC). Hence, in view of the above discussion, it appears that the subject-matter of claim 1 of auxiliary request 1 lacks inventive step over D4 with no identifiable distinguishing feature (see also respondent's reply, points I and III).

6. *Auxiliary requests 1(A) and 1(B)*

Since claim 1 of auxiliary request 1(A) and claim 1 of auxiliary request 1(B) are identical to claims 1 and 16 of auxiliary request 1, respectively, the same

reasoning and conclusion as under point 5 above apply. Hence, the subject-matters of claims 1 of auxiliary requests 1(A) and 1(B) do not involve an inventive step (Article 56 EPC).

7. *Auxiliary request 2*

7.1 With respect to independent claims 1 and 16 of auxiliary request 1, independent claims 1 and 15 of auxiliary request 2 further comprise the features of dependent claims 7 and 21 respectively of the patent as granted.

7.2 Disclosure of D4

7.2.1 Since document D4 does not disclose:

(c) an outlet nozzle to emit at least one air jet

for the cooling unit, novelty can be acknowledged for the subject-matter of claims 1 and 15. Hence, as admitted by the respondent, this represents a distinguishing feature of claims 1 and 15 over the disclosure of D4.

7.2.2 At the oral proceedings the appellant argued that it would be clearly specified in the claims that the lateral surface of the first and/or second packet onto which the air jet is directed is/are the lateral surface(s) which is/are to be brought into contact with each other. This would be clear from the use of the definite article "the" each time the lateral surfaces are mentioned after they have been defined once ("...*each of which has a respective lateral surface (18a, 18b)*..."). This would also be clear from the use of the same reference numbers 18a and 18b throughout

claims 1 and 15. Finally, Figure 1 of the contested patent makes it clear what is meant in the claims by said lateral surfaces.

7.2.3 The Board cannot share this view since, as mentioned by the respondent, a packet has six lateral surfaces and it is not apparent, when referring merely to "the" lateral surface(s), which one of the six is actually meant therewith. In any case, it cannot be ascertained whether the lateral surfaces which are brought into contact with each other are those onto which the air is directed. Contrary to the appellant's view, the use of the definite article in this particular case does not equate to the use of "said" lateral surface(s). Furthermore, it is established case law that reference signs do not limit the scope of the claims of a granted patent, nor specific features or figures of embodiments.

7.2.4 Taking into consideration the synergetic effect between distinguishing feature (a) (for method claim 15, see point 4.1 above) and distinguishing feature (c), both parties based their arguments in the oral proceedings on the same technical problem for both independent claims 1 and 15 of modifying the device or the method of D4 in order to prevent the packets sticking to each other when they are brought together after shrinkage so as to decrease the risk of damaging them (see also point 4.2.1 above).

7.2.5 The Board agrees with the respondent in that cooling by air jet belongs to the skilled person's common general knowledge, as illustrated for instance by D10 (see also point 4.2.3 above; impugned decision, point 9; minutes, points 22-25). D10 (column 1, line 64 to column 2, line 45, Figure 1), like D4 and the contested patent,

concerns a device for finishing packets having respective overwappings ("Folie") of heat-shrink material. As already mentioned above, D10 discloses to implement a cooling unit ("Kühlstation" 6) comprising an outlet nozzle ("Ventilatoren" 18, "Luftleitkanälen" 19) to emit at least one air jet so as to cool the packets, after a heat-shrink station ("Schrumpftunnel" 5"). The skilled person would encounter no technical difficulties in implementing in the device of D4 air jets on the lateral side between the end surface 48 and the heating member 33. By doing so, such air jets would inevitably be directed and come onto lateral surfaces of the packets (see point 7.2.3 above).

Hence, starting from D4, the skilled person faced with the above problem and using their common general knowledge, as illustrated e.g. by D10, would arrive at the subject-matter of claims 1 and 15 of auxiliary request 2 in an obvious manner (Article 56 EPC).

8. Auxiliary requests 2(A) and 2(B)

Since claim 1 of auxiliary request 2(A) and claim 1 of auxiliary request 2(B) are identical to claims 1 and 15 of auxiliary request 2, respectively, the same reasoning and conclusion as under point 7 above apply. Hence, the subject-matters of claims 1 of auxiliary requests 2(A) and 2(B) do not involve an inventive step either (Article 56 EPC).

9. *Auxiliary request 3*

9.1 With respect to independent claims 1 and 15 of auxiliary request 2, independent claims 1 and 14 of auxiliary request 3 further comprise the features of

dependent claims 2 and 19 respectively of the patent as granted.

Auxiliary request 3 corresponds to auxiliary request 15 underlying the impugned decision.

9.2 The Board accepts the appellant's view put forward in the oral proceedings that D4 does not disclose that:

> (d) the heating member is interposed between the first and the second feed path to shrink the overwrappings of the first and second packet.

Feature (d) is then a distinguishing feature of claims 1 and 14 over D4.

9.3 The appellant could not, however, provide any specific technical effect associated with the distinguishing feature (d) and admitted at the oral proceedings that it does not contribute to the solution of the problem defined under point 7.2.4 associated with the cooling of the overwrappings.

9.4 Hence, the Board agrees with the respondent's view that the contribution of feature (d) for assessing the inventive step of the subject-matter of claims 1 and 14 of auxiliary request 3 can be assessed independently from the other distinguishing features (a) and (c). As already discussed for auxiliary request 2 under point 7.2.5 above, features (a) and (c) cannot justify inventive step.

The partial problem associated with distinguishing feature (d) in view of its technical effect, as argued by the respondent, can then be seen as to improve the efficiency of the heating step in the device of D4.

Contrary to the appellant's unfounded allegation, the claimed solution is known from D1 (see column 6, lines 3-9, and Figure 6, heating elements 57, 58 and 59). The skilled person would have no difficulties to implement this known solution into the device of D4 since they would simply have to remove the carrying plate 35 among other minor structural adaptions so as to have the heating element 37 to heat-shrink simultaneously the packets of the upper and lower pack rows 22, 23.

As a consequence, starting from D4, the skilled person using their common general knowledge and the teaching of D1 would arrive at the subject-matter of claims 1 and 14 of auxiliary request 3 in an obvious manner (Article 56 EPC).

10. Auxiliary requests 3(A) and 3(B)

Since claim 1 of auxiliary request 3(A) and claim 1 of auxiliary request 3(B) are identical to claims 1 and 14 of auxiliary request 3 respectively, the same reasoning and conclusion as under point 9 above apply. Hence, the subject-matters of claims 1 of auxiliary requests 3(A) and 3(B) do not involve an inventive step either (Article 56 EPC).

11. *Auxiliary requests 4 to 7*

11.1 Admission in the proceedings

11.1.1 Auxiliary requests 4, 4(A), 4(B), 5, 5(A), 5(B), 6 and 7 were filed for the first time by the appellant with the statement setting out the grounds of appeal together with a respective substantiation concerning their patentability in accordance with Article 12(2) RPBA.

11.1.2 The respondent did not raise any objection to the admissibility of these requests in its written submissions (see respondent's reply, point III.3). Even in its last letter dated 12 November 2018, such an objection is not mentioned (see also the Board's communication dated 18 October 2018, point 12). As a consequence, the Board cannot see any reasons why for the first time in the appeal proceedings, which have lasted for nearly four years, their admission would become an issue at the very latest stage of the proceedings, i.e. in the oral proceedings before the Board. Consequently, the Board decided to admit auxiliary request 4, 4(A), 4(B), 5, 5(A), 5(B), 6 and 7 into the appeal proceedings pursuant to Article 12(4) RPBA.

11.2 Remittal

11.2.1 The respondent argued against the patentability of the subject-matter of auxiliary requests 4 to 7 for the very first time in its letter dated 12 November 2018, i.e. only one month before the oral proceedings before the Board, and at the same time filed three new documents D12, D13 and D14. In the oral proceedings, the respondent requested that the case not be remitted to the Opposition Division and that a second oral proceedings before the Board should be held instead, in order to avoid the prospect of lengthy proceedings before a final decision can be reached.

The appellant, on its side, saw no objections to remitting the case to the Opposition Division.

11.2.2 The role of the appeal proceedings is to review the decision under appeal, i.e. not to be a mere

continuation of the opposition proceedings. Hence, in view of the fact that the Board is confronted with new sets of claims and completely new late-filed objections, it considers it appropriate, contrary to the respondent's request, to remit the case to the Opposition Division for further prosecution on the basis of auxiliary requests 4 to 7 pursuant to Article 111(1) EPC. Since the Board does not consider that a substantial procedural violation occurred in the opposition proceedings (see point 1 above), it does not see any need to order a change in the composition of the Opposition Division.

Order

For these reasons it is decided that:

1. The request for referral of a question of law to the Enlarged Board of Appeal is rejected.

2. The decision under appeal is set aside.

3. The case is remitted to the Opposition Division for further prosecution on the basis of auxiliary requests 4 to 7 filed with letter dated 30 April 2014.

The Registrar: The Chairman:

G. Nachtigall I. Beckedorf

Decision electronically authenticated