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**Datasheet for the decision
of 19 July 2018**

Case Number: T 0446/15 - 3.2.08

Application Number: 03026418.8

Publication Number: 1400291

IPC: B21D51/26

Language of the proceedings: EN

Title of invention:

Deformation of thin walled bodies

Patent Proprietor:

Envases (UK) Limited

Opponents:

Mall + Herlan Italia Srl
Unilever PLC

Headword:

Relevant legal provisions:

EPC Art. 100(c), 76(1), 123(2)

Keyword:

Grounds for opposition - subject-matter extends beyond content
of earlier application (yes) - added subject-matter (yes)

Decisions cited:

Catchword:



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Case Number: T 0446/15 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 19 July 2018

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
12 December 2014 concerning maintenance of the
European Patent No. 1400291 in amended form.**

Composition of the Board:

Chairwoman	P. Acton
Members:	C. Herberhold
	P. Schmitz
	M. Foulger
	Y. Podbielski

Summary of Facts and Submissions

- I. By decision posted on 12 December 2014 the Opposition Division decided that European patent No. 1 400 291 as per the third request then on file, and the invention to which it related, met the requirements of the EPC.
- II. Appellant 1 (patent proprietor) and appellant 2 (opponent 1) lodged an appeal against that decision in the prescribed form and within the prescribed time limits.
- III. Oral proceedings were held before the Board on 19 July 2018.

As announced by letter dated 16 April 2018, the respondent (opponent 2) did not attend. In accordance with the provisions of Rule 115(2) EPC and Article 15(3) RPBA, the proceedings were continued without them.

At the end of the oral proceedings the requests of the parties were as follows:

Appellant 1 (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or one of auxiliary requests 1 to 6, all filed with letter of 14 June 2018, or auxiliary request 7 as filed during the oral proceedings before the Board.

Appellant 2 (opponent 1) requested that the decision under appeal be set aside and that the patent be revoked.

IV. Claim 3 of the main request reads as follows:

"Apparatus for deforming a cylindrical thin walled container (1), the apparatus including:

i) a vertically orientated multi station rotary holding table (3) operable to rotate about a horizontal axis in an indexed fashion to successively rotationally advanced locations respective holding stations spaced around the periphery of rotary holding table (3) comprising a respective clamp (4) for non rotatably clamping securely a respective container (1);

ii) a multi station tooling table (6) being positioned adjacent the holding table (3), the holding table (3) being rotationally indexable to bring the containers in succession to necking/shoulder forming tooling at respective tooling stations (7) for deformation, and the tooling table (6) being advanceable from a retracted position to an advanced position relative to the holding table; embossing tooling (10) at an embossing station (9)) of the tooling table (6) including an internal tooling part (11) and an external tooling part (13) arranged to engage within the interior, and on the exterior, of the container (1) respectively, together to deform the container at a predetermined wall zone on the container with reference to a pre-applied design on the wall of the container (1), whilst the container is clamped securely in the clamp (4) of a respective holding station;

iii) a determination and reorientation arrangement (60, 70) for determining the orientation of the container relative to a reference datum situation and permitting reorientation the container by rotating the container

automatically about a longitudinal axis of the container to accord with the datum situation."

V. Auxiliary requests 1-5 each comprise a device claim identical to claim 3 of the main request.

VI. Claim 1 of auxiliary request 6 reads as follows:

"A method of deforming a cylindrical thin walled container (1) to coordinate with a preprinted design on the wall of the container and in which one or more operations comprising necking of the container are carried out, the method including:

(i) holding the container securely in a clamp (4) of a holding station of a vertically orientated multi station rotary holding table (3) comprising a series of holding stations spaced around the periphery of the holding table (3), the table (3) being operated to rotate about a horizontal axis in an indexed fashion to successively rotationally advanced locations, the clamp (4) being arranged to clamp the respective container non rotatably;

(ii) advancing a vertically orientated multi station tooling table (6) carrying embossing tooling (10) at an embossing station (9), from a retracted position to an advanced position relative to the holding table (3) such that at embossing station (9), an internal tooling part (11) is inserted into the interior of the container and an external tooling part (13) is positioned externally of the container whilst the container is clamped securely at the holding station; and

(iii) operating the tooling (10) to engage with and deform the container at a predetermined wall zone, to coordinate with said pre-applied design on the wall of the container, whilst the container is gripped in a fixed orientation in the holding station;

wherein:

the tooling table (6) further carries necking/shoulder forming tooling at tooling stations (7); the holding table (3) is rotationally indexable to bring the containers in succession to the embossing station (9); and

the predetermined wall zone is co-aligned with the tooling by rotation of the container automatically about a longitudinal axis and then securing in the clamp (4) at the holding station in said fixed orientation for the coordinated deforming of the wall of the container (1)."

VII. Claim 1 of auxiliary request 7 comprises the following amendments with respect to claim 1 of auxiliary request 6:

"A method of deforming a cylindrical thin walled container (1) to coordinate with a preprinted design on the wall of the container and in which one or more operations comprising necking of the container are carried out, the method including:

(i) holding the container securely in a clamp (4) of a holding station of a vertically orientated multi station rotary holding table (3) comprising a series of holding stations spaced around the periphery of the holding table (3), the table (3) being operated to

rotate about a horizontal axis in an indexed fashion to successively rotationally advanced locations, the clamp (4) being arranged to clamp the respective container non rotatably;

(ii) advancing a vertically orientated multi station tooling table (6) carrying embossing tooling (10) at an embossing station (9), and necking/shoulder forming tooling at tooling stations (7) from a retracted position to an advanced position relative to the holding table (3) such that at embossing station (9), an internal tooling part (11) is inserted into the interior of the container and an external tooling part (13) is positioned externally of the container whilst the container is clamped securely at the holding station; and

(iii) operating the embossing tooling (10) to engage with and deform the container at a predetermined wall zone, to coordinate with said ~~pre-applied~~ pre-printed design on the wall of the container, whilst the container is gripped in a fixed orientation in the holding station;

(iv) retracting the tooling table (6) from the holding table (3) to withdraw the embossing tooling (10) from the container;

(v) rotationally indexing the holding table (3) to move the embossed container to be adjacent with the next tooling station (7) and bring a fresh container into alignment with the embossing tooling (10) at embossing station (9);

wherein:

~~the tooling table (6) further carries necking/shoulder forming tooling at tooling stations (7);~~ the holding table (3) is rotationally indexable to bring the containers in succession to the embossing station (9); and
the predetermined wall zone is co-aligned with the embossing tooling by rotation of the container automatically about a longitudinal axis and then securing in the clamp (4) at the holding station in said fixed orientation for the coordinated deforming of the wall of the container (1);
and the internal tooling parts 11 support non-deforming parts of the container wall during deformation at the predetermined wall zone."

VIII. The patent was granted on a divisional application (application number 03026418.8, hereinafter "the application"), derived from earlier application WO 01/58618, which entered the European phase under the application number 01904127.6 (hereinafter "the earlier application").

IX. The essential arguments of appellant 1 can be summarised as follows:

Main request, claim 3 - original disclosure

Claim 3 of the main request was directed to an apparatus for deforming a cylindrical thin walled container in which co-alignment between container and embossing tooling was achieved by what is described in the earlier application as the "alternative technique", i.e. by rotation of the container relative to the embossing tooling (see the paragraph bridging pages 19 and 20 and claim 49 of the earlier application). Although these disclosures were directed to a method,

it was clearly and unambiguously derivable for the skilled person that the "alternative technique" was to be carried out with an apparatus such as the one disclosed in detail for the first technique, with only the co-alignment functionality being adapted accordingly. Furthermore, the original disclosure comprised basis for abstraction, in particular claim 49 of the earlier application as filed for the "alternative technique", and page 2 ff and Figure 1 of the earlier application as filed for the apparatus of the "first technique".

With respect to the allegedly unallowable omission of the term "prior to" in item iii) of claim 3, although present in claim 49 and in the paragraph bridging page 19 and 20 of the earlier application as filed, this did not extend the subject-matter. Firstly, it was clear that the apparatus implemented the method of claim 1, in which the order was well defined. Secondly, the apparatus had all the elements necessary for performing the method. Thus, no definition of the order was required, nor was such a definition possible in a device claim. Thirdly, it was also inherent in the process that before embossing, the container had to be held in the holding station.

Consequently, the subject-matter of claim 3 did not extend beyond the content of the earlier application or the application as filed.

Auxiliary request 6, claim 1 - original disclosure

As discussed, there was original disclosure for the apparatus implementing the "first technique" with co-alignment means as disclosed for the "alternative technique". It was furthermore clearly and

unambiguously disclosed, see e.g. page 11, last paragraph, that in such an apparatus necking/shoulder forming tooling at stations 7 was present in addition to the embossing tooling at the embossing station. Nothing more was claimed in claim 1 of auxiliary request 6. As also acknowledged in the description, necking tooling such as described on page 11, first paragraph of the earlier application as filed was well known and used in the prior art. It was thus not necessary to further define the successive degrees of deformation performed by successive tooling stations on the container circumferential walls proximate their respective open ends. Neither was it necessary to indicate where on the tooling table the necking/shoulder forming tooling was provided and how it interacted with the other claimed integers. Indeed, only if one wilfully misunderstood the claim could it be assumed that the necking/shoulder forming tooling was possibly operating on the other side of the table independently from the rest of the claimed features.

The subject-matter claimed was thus clearly and unambiguously disclosed.

Auxiliary request 7 - admission into the proceedings

During oral proceedings before the Board the discussion had focused in particular on an alleged unallowable intermediate generalisation with respect to the tooling table further carrying necking/shoulder forming tools. Auxiliary request 7 was filed to address the issues which had developed during the discussion and which thus could not have been addressed earlier. The request should therefore be admitted into the proceedings.

Auxiliary request 7, claim 1 - original disclosure

In particular with respect to the necking/shoulder forming tooling, it was now more clearly visible that advancing and retracting the tooling table also brought the necking / shoulder forming tooling from a retracted position to an advanced position relative to the holding table. Furthermore, it was clarified that the "embossed container" moved to be adjacent with the next tooling station, i.e. adjacent with the necking/shoulder forming tooling at said tooling stations. In this way the operation of the necking/shoulder forming tooling and its interaction with the further claimed entities was well defined, such that the alleged unallowable intermediate generalisation was overcome. As also the further objections raised by appellant 2 had been taken care of, the subject-matter of claim 1 of auxiliary request 7 neither extended beyond the earlier application nor the application as filed.

- X. The essential arguments of appellant 2 can be summarized as follows:

Main request, claim 3 - original disclosure

Device claim 3 was directed to the "alternative technique", which was exclusively disclosed in the paragraph bridging pages 19 and 20 of the earlier application as filed, corresponding to paragraph [0058] of the published application as filed. Said disclosure was, however, only for a process not for an apparatus. It furthermore comprised numerous features which were not reflected in the present claim, which generalised the original disclosure in a non-allowable way even further. In particular, the disclosure did not provide a basis for the broadly defined "reorientation

arrangement...permitting reorientation the container by rotating the container automatically about a longitudinal axis of the container" because the original disclosure consistently required the rotational alignment to be performed prior to the body being gripped, a functionality which was not reflected in the wording of the claim.

The subject-matter of claim 3 of the main request thus extended beyond the content of the application and the earlier application as filed.

Auxiliary request 6, Claim 1 - original disclosure

Likewise, the subject-matter of claim 1 of auxiliary request 6 did not find a basis in the original disclosure. Firstly, there was no basis for combining the "alternative technique", i.e. co-alignment by rotation of the container, with the particular features of the "first technique" employing co-alignment by rotation of the tooling. Secondly, even in the context of the "first technique", there had been no such general disclosure of a method combining necking with embossing. Indeed, the specific disclosure of the "first technique" mentioned "necking and shoulder-forming tooling at tooling stations", however, it did so in the functional and structural context of those tooling stations performing specific operations, such as "successive degrees of deformation".

At least for this reason, the subject-matter extended beyond the content of the application and the earlier application as filed.

Auxiliary request 7 - admission into the proceedings

Auxiliary request 7 was filed at a very late stage of the proceedings, even though the objection of an intermediate generalisation had been already raised in the written proceedings. Auxiliary request 7 should thus not be admitted into the proceedings.

Auxiliary request 7, claim 1 - original disclosure

Auxiliary request 7 did not overcome the objection raised with respect to auxiliary request 6 in that the unallowable intermediated generalisation with respect to the necking/shoulder forming tooling was still present. The request was thus not allowable.

Reasons for the Decision

1. Article 100(c), 76(1), 123(2) EPC - Overview

The application on which the patent was granted and the earlier application relate to registered deformation of a thin walled body, in particular to registered embossing of thin walled bodies having pre-applied surface decoration.

Co-alignment between deformation tooling and thin walled body is effectuated either by rotation of the tooling relative to the thin walled body, with the body being gripped securely at a holding station ("first technique"), or by rotation of the body about an axis prior to securing at the holding station ("alternative technique").

In the earlier application, the "first technique" is the subject-matter of several method and device claims

(method claims 1-25; device claims 26-34). Furthermore, it underlies the detailed embodiment (page 10 - p. 19, line 22).

Conversely, the "alternative technique" is only the subject of method claim 49 of the earlier application, with further details of the technique being disclosed in the paragraph bridging pages 19 and 20. With respect to the "alternative technique", there is thus no originally disclosed device claim in the earlier application as filed. Furthermore, the respective part of the description is directed to a method, without mentioning any particular device features for the "alternative technique".

The divisional application as filed comprises a method claim (claim 1) and a device claim (claim 4), both directed to the "alternative technique" (see last paragraph of claim 1 as filed and item iv) of claim 4 as filed). The description of the application as filed and of the earlier application as filed are identical.

Likewise, the present main request and auxiliary requests 1-5 each define a method (claim 1) and a respective device (claim 3) for deforming a cylindrical thin walled container directed to the "alternative technique", see last paragraph of claim 1 and feature iii) of the respective independent device claim.

2. Main request, claim 3 - original disclosure

2.1 Independent device claim 3 defines an

"Apparatus for deforming a cylindrical thin walled container, the apparatus including:

...;

iii) a determination and reorientation arrangement (60, 70) for determining the orientation of the container relative to a reference datum situation and permitting reorientation the container by rotating the container automatically about a longitudinal axis of the container to accord with the datum situation".

2.2 However, claim 49 of the earlier application, claim 4 of the application as filed (see point iv) and paragraph [0058] of the description as filed (identical to page 19, 20 of the description of the earlier application) all specify that the rotation of the body is performed **prior to** it being gripped.

Thus, even if one assumes in favour of appellant 1 that the skilled person would clearly and unambiguously derive from the functional language of the respective passages in the description and from the method features of claim 49 that the "alternative technique" was to be performed by an apparatus, this amounts at best to a disclosure of such an apparatus having "means for" the specific functionality originally disclosed.

In particular, the person skilled in the art would derive from the disclosure that such an apparatus has means permitting reorientation of the container by rotating the container automatically about a longitudinal axis of the container **prior to securing at the holding station.**

The feature underlined above is, however, not part of independent device claim 3 of the main request.

2.3 Appellant 1 has argued that the device claimed was for execution of the method defined in claim 1 and had all features necessary therefor. Indeed, it was not

possible to define the particular order in which the steps were performed in a device claim, the respective time order being anyway inherent.

However, firstly, device claim 3 does not refer back to method claim 1. No order of the process can thus be derived therefrom. Secondly, an apparatus having "means permitting automatic reorientation" typically comprises, apart from structural means such as clamps, tooling or rotary tables, control means adapted to coordinate the operation of the structural means in a particular way. As the method originally disclosed has a specific mode of operation, i.e. co-alignment by rotation being performed **prior to** the container being clamped, a device claim having no such "means for rotation of the body ...**prior to** the body being gripped in a fixed orientation" cannot be clearly and unambiguously derived from the disclosed method. Lastly, rotation of the container prior to the container being clamped is present in claim 49 of the earlier application as filed, which is the most general level of abstraction disclosed and on which appellant 1 relies as a basis for all other generalisations over the detailed disclosure of the "alternative method". "Means of co-ordinated movement to reconfigure the body about an axis of the body to accord with the datum situation prior to the body being gripped at the holding station at a fixed orientation" are furthermore defined in the independent device claim of the divisional application as filed.

There is thus no clear and unambiguous basis for omitting such a prominently and consistently disclosed feature from the subject-matter of the claim.

Consequently, the subject-matter of claim 3 extends beyond the content of the application as filed as well as beyond the content of the earlier application as filed.

3. Auxiliary requests 1 to 5 - independent device claim

Auxiliary requests 1 to 5 each comprise an independent device claim identical to claim 3 of the main request. Therefore, these requests are likewise unallowable for the reasons discussed in point 2 above.

4. Auxiliary request 6, Claim 1 - original disclosure

4.1 Claim 1 of auxiliary request 6 defines:

"A method of deforming a cylindrical thin walled container (1) to coordinate with a preprinted design on the wall of the container and in which one or more operations comprising necking of the container are carried out, the method including:

...;

wherein:

the tooling table (6) further carries necking/shoulder forming tooling at tooling stations (7);

..."

The passages relating to "necking" have been underlined by the Board.

4.2 In the above claim wording, "necking" is claimed at a high level of abstraction. Apart from the tooling table carrying necking/shoulder forming tooling and from there being some sort of necking of the container comprised in the method, there are no further features in the claim as to where the necking/shoulder tooling

is located and if, how and to what effect it interacts with the other claim features.

- 4.3 There is, however, no support for such a high level of abstraction. The only disclosure of a "tooling table carrying necking/shoulder forming tooling" is on page 11, last paragraph, first sentence of the earlier application as filed. The tooling stations 7 mentioned in this paragraph are the tooling stations discussed in the first paragraph of page 11 (see also paragraphs [0032] and [0030] of the published application). According to the description in said paragraph, "following successive rotary index movements of rotary table 3 [i.e. of the holding table], table 6 [i.e. the tooling table] is advanced from a retracted position (figure 5) to an advanced position (figure 8). In moving to the advanced position the respective tools at tooling stations 7 perform forming operations on the container circumferential walls proximate their respective open ends 8. Successive tooling stations 7 perform successive degrees of deformation in the process."

Conversely, in the subject-matter of claim 1, most elements of the above cited functional and structural relationship of the "necking/shoulder forming tooling at tooling stations (7)" with the other claimed features as disclosed in the description have been omitted.

Whereas for the embossing tooling the claim defines that the "holding table is rotationally indexable to bring the containers in succession to the embossing station" to then perform the step of "operating the tooling (10) [i.e. the embossing tooling] to...deform the container at a predetermined wall zone, to

coordinate with said pre-applied design", there are no respective claim features regarding the functionality of the "necking/shoulder forming tooling". Indeed, the claim does not define that "in [the tooling table] moving to the advanced position the respective tools at tooling stations 7 perform forming operations on the container circumferential walls proximate their respective open ends", with "successive tooling stations perform[ing] successive degrees of deformation in the process" (page 11, first paragraph of the earlier application as filed). As illustrated at the oral proceedings, without these features the necking/shoulder forming tooling could be anywhere on the tooling table and carry out necking in whatever way (possibly even on the other side of the table). There is no clear and unambiguous basis - in particular in the present context of a method claim - for so separating the "tooling table further carry[ing] necking/shoulder forming tooling" from the functional interaction with the other features of the claim as explicitly originally disclosed. For compliance with the required standard of Articles 76(1) and 123(2) EPC, namely for a clear and unambiguous disclosure, it is not sufficient that the person skilled in the art might have a certain understanding of how necking/shoulder forming machines are usually set up.

The feature of the "tooling table carrying necking/shoulder forming tooling at tooling stations (7)" has thus been isolated from its specific functional and structural context, which amounts to an unallowable intermediate generalisation.

4.4 Thus, the subject-matter of claim 1 of auxiliary request 1 extends beyond the content of the application as filed and of the earlier application as filed.

5. Auxiliary request 7 - admission into the proceedings

Auxiliary request 7 was submitted during the oral proceedings in the appeal proceedings. Its admission is thus in the discretion of the Board (Art. 13 RPBA). While appellant 2 had objected in writing to an unallowable generalisation with respect to the necking/shoulder forming tooling, the fact that the claim did not specify the location of the tooling and its interaction with the other claim features had (although ultimately being a consequence of features being omitted upon generalisation of the subject-matter) not been so prominent before the oral proceedings. The Board thus found it appropriate to admit auxiliary request 7 in which appellant 1 aimed at overcoming these objections, into the proceedings.

6. Auxiliary request 7 - original disclosure

6.1 Claim 1 of auxiliary request 7 is more specific with respect to the necking/shoulder forming tooling in that in new item (v) it additionally specifies that the step of "rotationally indexing the holding table" is "to move the embossed container to be adjacent with the next tooling station".

However, claim 1 of auxiliary request 7 still does not define that these tooling stations "perform forming operations on the container circumferential walls proximate their respective open ends", with "successive tooling stations 7 perform[ing] successive degrees of deformation in the process" (page 11, first paragraph of the earlier application as filed and paragraphs [0032] and [0030] of the published application)).

6.2 Therefore, the subject-matter of claim 1 of auxiliary request 7 likewise extends beyond the content of the application as filed and of the earlier application as filed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairwoman:



C. Rodríguez Rodríguez

P. Acton

Decision electronically authenticated