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**Datasheet for the decision  
of 1 October 2020**

**Case Number:** T 0481/16 - 3.2.07

**Application Number:** 09744697.5

**Publication Number:** 2358595

**IPC:** B65B1/22, B65B5/06, B65D77/00

**Language of the proceedings:** EN

**Title of invention:**  
PROCESS FOR PACKAGING POTATO CRISPS, AS WELL AS THE PACKAGE  
OBTAINED

**Patent Proprietor:**  
Elias, Michael Joseph

**Opponent:**  
Tyrrells Potato Crisps Limited

**Headword:**

**Relevant legal provisions:**  
EPC Art. 56, 100(a), 113(1), 116(1)  
RPBA 2020 Art. 12(8), 15(1)

**Keyword:**  
Inventive step - (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
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Case Number: T 0481/16 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 1 October 2020**

**Appellant:** Elias, Michael Joseph  
(Patent Proprietor) Suite 4  
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**Representative:** Tomkins & Co  
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**Respondent:** Tyrrells Potato Crisps Limited  
(Opponent) Tyrrells Court  
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**Representative:** Forresters IP LLP  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
21 December 2015 concerning maintenance of the  
European Patent No. 2358595 in amended form.**

**Composition of the Board:**

**Chairman**            I. Beckedorf  
**Members:**            A. Beckman  
                          A. Pieracci

## **Summary of Facts and Submissions**

- I. The patent proprietor lodged an appeal in the prescribed form and within the prescribed time limit against the interlocutory decision of the opposition division maintaining European patent No. EP 2 358 595 in amended form. As far as the opponent had appealed against that decision as well, this appeal was subsequently withdrawn with letter dated 10 March 2016.
- II. Opposition had been filed against the patent as a whole based on Article 100(a) and (b) EPC (lack of novelty and of inventive step, insufficiency of disclosure).
- III. The opposition division held
- that the grounds for opposition concerning lack of novelty and insufficiency of disclosure did not hold against the patent as granted, but
  - that the ground for opposition concerning lack of inventive step prejudiced the maintenance of the patent as granted, since
    - the subject-matter of independent claim 1 as granted did not involve an inventive step starting from either D19 (= EP 1 270 416 A1) or D16 (= EP 1 767 465 A1) as closest prior art in combination with the common general technical knowledge of the skilled person in the art, as exemplified in D1 (= US 4 351 141 A), and
    - the subject-matter of independent claim 13 as granted did not involve an inventive step starting from D19 as closest prior art in combination with the common general technical knowledge of the person skilled in the art, and
  - that auxiliary request 1 submitted during the oral proceedings fulfilled the requirements of the EPC.

IV. With the statement setting out the grounds of appeal the patent proprietor (appellant) requested

that the decision under appeal be set aside and 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 auxiliary requests 1 to 3 filed with the statement setting out the grounds of appeal.

The patent proprietor subsidiarily requested the right to be heard in accordance with Article 116 EPC.

The opponent (respondent) did not submit any request or reply to the patent proprietor's appeal.

V. In a communication pursuant to Article 15(1) RPBA 2020 dated 20 February 2020 the Board provided its preliminary opinion that the patent proprietor had failed to convincingly demonstrate the incorrectness of the finding of the opposition division on lack of inventive step of the claimed subject-matter of the independent product claim of the patent as granted (point 2 of said communication) but that the set of claims of auxiliary request 2 directed to the independent process claim of the patent as granted seemed to be allowable (point 3 of said communication). The Board further noted that, in the event that the patent proprietor wished to defend the patent only on the basis of auxiliary request 2, a decision of the Board could be issued in writing without holding oral proceedings on 19 October 2020 to which the parties were summoned (point 4 of said communication).

VI. In its response dated 1 September 2020 to the aforementioned communication of the Board, the patent proprietor explicitly "choose" to defend the appeal on the basis of auxiliary request 2 and requested that a decision allowing auxiliary request 2 be issued in writing without oral proceedings.

Hence the Board understands the patent proprietor's final request as follows

that the decision under appeal be set aside and that the patent be maintained on the basis of auxiliary request 2 filed with the statement setting out the grounds of appeal.

VII. The patent proprietor's arguments contesting the decision under appeal are dealt with in detail in the reasons for the decision.

VIII. Independent claim 1 of auxiliary request 2, corresponding to claim 1 of the patent as granted, reads as follows:

"A process for packing potato crisps (5) into a box (12) with a base and side-walls, the process comprising the steps of:

- (i) dispensing potato crisps into the box;
- (ii) shaking the box to settle the potato crisps in the box; and
- (iii) foil-wrapping the box."

## **Reasons for the Decision**

### *1. Decision in written procedure*

Given the findings and the order of the decision, the patent proprietor's earlier request for oral proceedings is subsidiarily to its auxiliary request 2 that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the auxiliary request 2 (see the patent proprietor's letter of 1 September 2020). Because the opponent withdrew its appeal, its request for oral proceedings submitted in the notice of appeal became obsolete.

The case is ready for decision on the basis of the patent proprietor's written submissions and the decision under appeal (Article 12(8) RPBA 2020). For this reason, the issuing of the decision in written procedure without oral proceedings, which had originally been arranged for 19 October 2020 and which are cancelled, is in compliance with Articles 113(1) and 116(1) EPC.

### *2. Auxiliary request 2*

The claims of auxiliary request 2 are the same as the claims of the patent as granted except for the deletion of the product claims 13 and 14, as confirmed by the patent proprietor.

#### *2.1 Claim 1 - Inventive step (Articles 100(a) and 56 EPC)*

##### *2.1.1 D19 as closest prior art*

The patent proprietor contests the finding under points II.2.3 and 6.1 of the reasons of the impugned decision



that the subject-matter of independent claim 1 does not involve an inventive step starting from D19 as closest prior art in combination with the common general technical knowledge of the skilled person in the art, as exemplified in D1.

The Board concurs with the patent proprietor's argumentation as follows.

Contrary to the reasoning in the impugned decision, the Board disagrees that D19 is a plausible closest prior art and starting point for assessing inventive step. As a matter of fact, D19 fails to disclose a process for packing potato crisps into a box with a base and side-walls, and fails to disclose any of the claimed steps of such a process according to claim 1. Thus, D19 cannot be regarded as a feasible starting point for assessing inventive step.

Following the patent proprietor's view, the opposition division has merely asserted that "it would be trivial and obvious for the skilled person to also consider packaging (dispensing) potato crisps into a tray". However, there is no teaching in D19 to lead the skilled person to replace cookies or crackers (paragraph [0002] of D19), *i.e.* biscuits, with potato crisps. Thus, it is not evident for the skilled person to assume that the tray referred to in D19 is in any way foreseen for packaging potato crisps. Any such assumption is based on hindsight.

Even if D19 would be regarded as a feasible starting point for assessing inventive step, as argued in the impugned decision, then, starting from D19, the objective technical problem to be solved by the distinguishing process steps features, as identified in

the impugned decision (point II.2.2 of the reasons), can be seen in providing more efficient packaging of potato crisps, while protecting the crisps from potential damage during storage and shipping (for example by crushing) and also protecting the crisps from spoiling e.g. oxidation, as argued by the patent proprietor.

The opposition division found that to achieve a uniform filling, the skilled person would know from common general knowledge of the packaging field to vibrate or shake a box filled with potato crisps to solve a problem of increasing packaging efficiency.

The Board disagrees as the opposition division did not indicate in a persuasive manner that anywhere in the cited prior art there was filling of a box with potato crisps, where there was any need to shake the box, or indeed that any such shaking is conventional. Accordingly, starting from D19 and addressing the objective technical problem and looking to common general knowledge there is no solution to the objective technical problem in common general knowledge. The only piece of prior art relied upon as evidence of the problem of "increasing packaging efficiency" is the passage of D1, column 1, lines 42 to 44, which discusses packaging of potato strips. However, D1 refers only to jackstrawing of potato strips and describes vibratory action for alignment (reducing jackstrawing) to prevent subsequent breakage. Neither D1 nor D19 address the problem of achieving packaging efficiency for potato crisps. Thus, the skilled person has no motivation to combine the teaching of D19 with D1 when seeking a solution to the assumed objective technical problem. Even if one takes the position that the tray of D19 is a box of the present invention, then

D19 does not dispense potato crisps into the tray, it does not shake the tray, and in particular there is no indication that the tray is of a type that when shaken would allow one to settle the potato crisps in the tray, and furthermore there is no indication in D19 that the wrapping step or the resulting package would be sufficient to protect the crisps e.g. from oxidation or that more efficient packaging is achieved.

Hence, even if the skilled person would combine D19 and the common general technical knowledge or the teaching of D1, it must be recognised that it would not arrive at the subject-matter of claim 1 in an obvious manner.

#### *2.1.2 D16 as closest prior art*

The patent proprietor contests the finding under points II.2.3 and 6.1 of the reasons of the impugned decision that the subject-matter of independent claim 1 does not involve an inventive step starting from D16 as closest prior art in combination with the common general technical knowledge of the skilled person in the art, as exemplified in D1.

Following the patent proprietor's view, there is no teaching in D16 that indicates that the trays or the bags disclosed are suitable for packaging potato crisps and, more particularly, there is nothing in D16 that indicates that the trays or the bags of D16 are suitable for use with the process of claim 1. D16 also fails to disclose the claimed step of foil wrapping a box into which potato crisps have been dispensed and which has been shaken to settle the potato crisps.

As D16 does not relate to a process for packing potato crisps and fails to disclose any of the claimed steps

process steps of claim 1, D16 cannot be regarded as a plausible starting point for assessing inventive step.

Since D16 cannot be regarded as a plausible closest prior art as D19, the reasons set out under point 2.1.1 above with regard to D19 apply to D16 *mutatis mutandis*.

Hence, even if the skilled person would combine D16 and the common general technical knowledge or the teaching of D1, it would not arrive at the subject-matter of claim 1 in an obvious manner.

2.2 Dependent claims 2 to 12 of auxiliary request 2 relate to further embodiments of the process claim 1 and, therefore, likewise involve an inventive step.

3. *Conclusion*

Hence, the Board finds the patent proprietor's appeal allowable on the basis of the auxiliary request 2.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended form with claims 1 to 12 filed as auxiliary request 2 with the statement setting out the grounds of appeal dated 29 April 2016 and a description to be adapted thereto.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated