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**Datasheet for the decision  
of 9 July 2018**

**Case Number:** T 1093/17 - 3.2.07

**Application Number:** 02748973.1

**Publication Number:** 1409344

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

**Language of the proceedings:** EN

**Title of invention:**

METHOD OF LOADING A SPOOL FOR A WASTE STORAGE DEVICE

**Patent Proprietor:**

Sangenic International Limited

**Opponent:**

Lamico ApS

**Headword:**

**Relevant legal provisions:**

EPC Art. 83, 84, 101(1), 104(1), 107, 108, 111(1), 113(1),  
123(2), 123(3)

**Keyword:**

Admissibility of appeal - (yes)

Sufficiency of disclosure - support by the description (yes)

Claims - support in the description (yes)

Apportionment of costs - (no)

**Decisions cited:**

T 0128/13

**Catchword:**



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Case Number: T 1093/17 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 9 July 2018**

**Appellant:** Lamico ApS  
(Opponent) Ellemosevej 3  
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**Representative:** Budde Schou A/S  
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**Respondent:** Sangenic International Limited  
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**Representative:** HGF Limited  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
28 February 2017 concerning maintenance of  
European patent No. 1409344 in amended form**

**Composition of the Board:**

**Chairman** I. Beckedorf  
**Members:** G. Patton  
W. Marx

## Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal within the prescribed period and in the prescribed form against the interlocutory decision of the Opposition Division maintaining European patent No. 1 409 344 in amended form.

The appeal follows a previous appeal in the present case on which decision T 128/13 dated 8 December 2015 has already been taken, with the order "*to maintain the patent with claims 1 and 2 of the first auxiliary request filed with letter dated 6 November 2015 and a description, and if need be, the drawings to be adapted thereto*". The order and the *ratio decidendi* of T 128/13 are *res judicata* for the present decision, which accordingly deals only with adapting the description and, if need be, the drawings to the claims already allowed.

- II. In response to a reasoned request from the appellant for accelerated processing, the Board decided to treat this appeal case with priority.
- III. The Board provided a preliminary non-binding opinion pursuant to Article 15(1) RPBA (hereinafter: the Board's preliminary opinion), according to which the description of the respondent's main request seemed to contravene the requirements of Articles 83, 84 and 123(2) and (3) EPC.

In reaction, the respondent withdrew its main request with its letter dated 4 July 2018, re-filing its former auxiliary requests 1 and 2, which had been filed with the reply to the appellant's statement of grounds of appeal, as its new main and auxiliary requests,

respectively. Against these requests no written objections had been specifically raised by the appellant (see the Board's preliminary opinion, point 6).

- IV. Oral proceedings were held on 9 July 2018, during which the following issues were discussed:
- admissibility of the appeal;
  - compliance of the main request with the requirements of Article 123(2) and (3) EPC;
  - compliance of the main request with the requirements of Articles 83 and 84 EPC;
  - requests for apportionment of costs.

For further details of 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.

In view of the outcome, the respondent's auxiliary request does not need to be discussed.

- V. The appellant requested:
- that the decision under appeal be set aside;
  - that European patent No. 1 409 344 be revoked; and
  - that a different apportionment of costs be ordered.
- VI. The respondent requested:
- that the appeal be rejected as inadmissible; or
  - that, in setting the decision under appeal aside, the patent be maintained in amended form on the basis of either the main request or, in the alternative, the auxiliary request, both as filed with the letter dated 4 July 2018; and
  - that a different apportionment of costs be ordered.

VII. Document D6 (= GB 2 232 951 A) cited in the opposition proceedings is of relevance in the present decision, as it also was in T 128/13.

VIII. The appellant argued in substance essentially as follows:

*Admissibility of the appeal*

The appellant had not presented any arguments on this issue.

*Main request*

The description did not comprise any embodiment according to the invention as defined by the allowed claims. Even the prior art D6 cited in the description did not give the skilled person any information on how to perform the claimed method, in particular on how the compression ring worked.

When acknowledging an inventive step in previous appeal T 128/13, only parts of the disclosure of D6 had been considered. Now, in order to justify that the requirements of Article 83 EPC were fulfilled, the full disclosure of D6 was referred to. Hence, there was a conflict between how inventive step had been acknowledged and how the requirements of Article 83 EPC were now assessed.

In view of the above, the skilled person would not be able to carry out the method as defined by the allowed claims, contrary to the requirements of Article 83 EPC.

Due to the lack of any embodiment in accordance with the invention in the description, the claims were left unsupported, so the requirements of Article 84 EPC were also not met.

*Apportionment of costs*

The late filing of an adapted description in the oral proceedings on 8 December 2015 before the competent Board in the first appeal proceedings and the resulting remittal of the case to the Opposition Division had led to second proceedings before the Opposition Division and the present Board. This had entailed unnecessary additional costs for the appellant, caused exclusively by the patent proprietor's neglect of the usual and accepted procedures before the EPO, not to be excused by the size of the specification and/or the complexity of the claims, but rather resulting from deliberate obstruction. This amounted to an abuse of procedure by the patent proprietor, and so all costs involved in the second opposition proceedings and the present appeal proceedings should be borne by the respondent.

- IX. The respondent argued in substance essentially as follows:

*Admissibility of the appeal*

In its statement setting out the grounds the appellant had merely repeated the arguments presented before the Opposition Division without any reference to the impugned decision or as to why the impugned decision should be considered incorrect. The appeal should therefore be regarded as inadmissible.

*Main request*

The amendments to the description according to the main request were merely made to bring the description into line with the allowed claims. The issues relating to Article 83 EPC had already been taken into consideration by the competent Board in the first appeal proceedings in T 128/13 and so should be regarded as *res judicata*.

This also applied to the alleged conflict in assessing the requirements of Articles 56 and 83 EPC.

In any case the requirements of Article 83 EPC should be regarded as fulfilled, since the skilled person would find enough technical information in the description of the main request. This was particularly true in view of D6, which was explicitly cited in the description, see page 1, lines 19-22, and also page 5, lines 24-27, where its disclosure was also mentioned and incorporated by reference, giving clear technical information to the skilled person about the compression ring of claim 1 of the allowed claims (as found in T 128/13, point 1.6).

The above applied *mutatis mutandis* to the requirements of Article 84 EPC.

*Apportionment of costs*

In accordance with the Boards' standard practice, the competent Board in T 128/13 had decided to remit the case to the Opposition Division for adaptation of the description to the allowed claims. The appellant had used the second opposition proceedings and the present appeal proceedings as opportunities to unduly delay the



issuance of the patent by persistently raising irrelevant objections against the proposed adapted description. This amounted to an abuse of procedure, and so all costs involved in the second opposition proceedings and the present appeal proceedings should be borne by the appellant.

### **Reasons for the Decision**

#### 1. Admissibility of the appeal

1.1 The respondent contests the admissibility of the appeal, arguing that the statement setting out the grounds does not contain any specific reference to the impugned decision or as to why the impugned decision should be considered incorrect. For the respondent, the appellant had merely repeated the arguments presented before the Opposition Division, whatever the objection raised pursuant to Articles 123(2), 123(3), 83 and/or 84 EPC.

1.2 The Board cannot follow the respondent's view, since the appellant in the section "Article 123(2) EPC and Article 123(3) EPC", pages 1 and 2, of its statement setting out the grounds argues against the finding of the impugned decision, point 2.4, that the "annular disc" is the "compression ring".

As a result, the appeal is admissible (Article 108 EPC).

The above was the Board's preliminary opinion provided to the parties, point 4. It has not been subsequently commented on or contested by the respondent, either in writing or orally at the oral proceedings.

2. Main request

2.1 Articles 123(2) and (3) EPC

At the oral proceedings, the appellant conceded that the main request fulfilled the requirements of Articles 123(2) and (3) EPC, as the expression "annular disc" or "disc" was no longer substituted by the expression "compression ring" in the description. The Board also concurs with this view.

2.2 Articles 83 and 84 EPC

2.2.1 At the oral proceedings, the appellant for the first time argued against the main request as follows:

The description according to the main request did not comprise any disclosure of an embodiment according to the invention as defined in the claims allowed by T 128/13. None of the examples depicted in the figures showed the claimed method, as they explicitly no longer concerned the invention due to the substitution of the term "invention" by "example". Hence, the skilled person had no information at his disposal in the description according to the main request as to how to perform the claimed method. In particular, the kind of ring to be used for the compression ring of claim 1 was not described, for instance with respect to its shape, whether it was an annular disc or not. The way it was applied was also not described, for instance whether it was a slight or heavy compression. Potential infringers of the allowed claims were left in the dark as to whether they were working within the claimed scope or not.

Even the prior art D6 cited in the description did not give the skilled person information on how to perform the claimed method, as it was silent on how the compression ring worked, for instance the level of compression applied by the compression ring.

The technical effect of the compression ring was not derivable from the description of the main request. In that respect there was a conflict between the way inventive step of the claimed subject-matter was acknowledged in view of D6 and the way fulfilment of the requirements of Article 83 EPC was now assessed, still in view of D6. For inventive step only parts of the disclosure of D6 had been considered in T 128/13 to conclude that the claimed subject-matter involved an inventive step, while now for the requirements of Article 83 EPC the skilled person should consider the complete disclosure of D6 in order to be able to perform the invention. The same standard should be applied for assessing inventive step or sufficiency of disclosure.

In view of the above, the skilled person would not be able to carry out the method as defined in the claims allowed in T 128/13, contrary to Article 83 EPC.

The same arguments presented in relation to Article 83 applied to the requirements of Article 84 EPC. Given that the description according to the main request failed to describe or mention any embodiment according to the claimed method, the claims allowed in T 128/13 were left unsupported, contrary to the requirements of Article 84 EPC.

2.2.2 The Board cannot follow the appellant's view for the following reasons given by the respondent at the oral proceedings:

The amendments to the description according to the main request merely bring the description into line with the allowed claims.

The appellant has failed to convincingly show in what respect the amendments to the description according to the main request, allegedly rendering the skilled person unable to perform the invention as defined by the allowed claims, would relate to technical information that the then Board would not have considered when deciding in T 128/13 on the allowability of the claims.

In fact, the issues relating to Article 83 EPC as far as these amendments are concerned were already taken into consideration by the then Board, irrespective of whether the term "(embodiment of the) invention" or "example" is recited in the description. This appears from the minutes of the oral proceedings before the then Board, page 3, first paragraph, and also from T 128/13, points 1.6 and 1.8, where it is clear that the then Board considered that the skilled person would rely on the disclosure of D6 with respect to the compression ring. It is noted that the features of claim 10 mentioned in said passages of T 128/13 are incorporated into claim 1 allowed in T 128/13.

As a consequence, the present Board considers that the issues at stake raised by the appellant with respect to Article 83 EPC are *res judicata*.

This also applies to the alleged conflict in the assessment of fulfillment of the requirements of Articles 56 and 83 EPC in view of D6.

As a consequence, the requirements of Article 83 EPC are fulfilled.

The above applies *mutatis mutandis* to the requirements of Article 84 EPC.

3. Apportionment of costs

3.1 Both parties request apportionment of costs pursuant to Article 104(1) EPC, arguing an abuse of procedure by the other party.

3.2 The Board cannot follow either of the parties' view for the following reasons:

Regarding the late filing of an adapted description by the respondent in the oral proceedings before the Board on 8 December 2015, the present Board notes that the then Board explicitly stated that the Board "*will not outright refuse that an amended description be submitted*" (see minutes, page 3, penultimate paragraph). In decision T 128/13, when exercising its discretionary power pursuant to Article 111(1) EPC to remit the case to the Opposition Division for further prosecution, the then Board explicitly ordered that the description be adapted to the allowable set of claims. Hence, the Board in the proceedings for T 128/13 did not see any procedural abuse in the late filing of an adapted description, and neither does the present Board.

In arguing against a proposed adapted description in the subsequent opposition proceedings, the appellant is within its rights pursuant to Articles 101(1) and 113(1) EPC. It was obviously adversely affected by the impugned decision posted on 28 February 2017, and so it is within its rights to lodge an appeal against said decision pursuant to Article 107 EPC.

3.3 Hence, the Board considers that neither of the requests for apportionment of costs is justified.

The above was the Board's preliminary opinion provided to the parties, point 7. It has not been subsequently commented on or contested by the parties, either in writing or orally at the oral proceedings.

