

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 8 February 2022**

Case Number: T 2558/17 - 3.2.01

Application Number: 13157883.3

Publication Number: 2636321

IPC: A24D3/02

Language of the proceedings: EN

Title of invention:

Method and machine for producing paperless filter rods for smoking articles

Patent Proprietor:

MONTRADE S.p.A.

Opponent:

Hauni Maschinenbau GmbH

Headword:

Relevant legal provisions:

EPC Art. 100(b), 100(a), 54(2), 56
RPBA Art. 12(4)

Keyword:

Grounds for opposition - insufficiency of disclosure (no)

Late-filed facts - admitted (no)

Novelty (yes) - public prior use - availability to the public
(no)

Inventive step - (yes)

Decisions cited:

G 0007/93, G 0003/97, G 0001/12, T 0472/92, T 2451/13,

T 0093/99, T 0538/89, T 0392/16

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 2558/17 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 8 February 2022

Appellant: Hauni Maschinenbau GmbH
(Opponent) Kurt-A.-Körber-Chaussee 8-32
21033 Hamburg (DE)

Representative: Sollmann, Michael
Hauni Maschinenbau AG
Kurt-A.-Körber-Chaussee 8-32
21033 Hamburg (DE)

Respondent: MONTRADE S.p.A.
(Patent Proprietor) Via Armando Sarti 6
40132 Bologna (IT)

Representative: Crippa, Paolo Ernesto
Jacobacci & Partners S.p.A.
Via Stezzano 87
24126 Bergamo (IT)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 29 September
2017 rejecting the opposition filed against
European patent No. 2636321 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: J. J. de Acha González
S. Fernández de Córdoba
S. Mangin
A. Jimenez

Summary of Facts and Submissions

I. The appeal of the opponent lies against the decision of the Opposition Division to reject the opposition filed against European patent No. 2636321.

II. The following documents are inter alia cited in the decision:

- A1: affidavit of Mr Hoffmann;
- A2: affidavit of Mr Lembke;
- A3: travel report 11 - 12 May 2011 dated 7 October 2014;
- A4: Filtrona NWA Process Manual (1988);
- A5: drawings by Elmont (2006);
- A6: document "Herstellung van NWA Filtern";
- A7: document "Intermach Limited Genuine Spare Parts";
- A8: set of 76 photos (not dated) of a NWA machine;
- A9: documents and notes concerning duty travel of Mr Lembke and Mr Hoffmann, "Reiseanweisung";
- A10: affidavit of Mr Dietrich;
- A12: US3377220A;
- A15: US5911224A;
- A16: US3455766A;
- A19: NWA - Current status, 19 February 1980;
- A32: GB1092354A;
- A37: document "NWA filters for improved ventilated cigarettes", June 1978;
- A39: RJR - NWA Trip Report to Eastman, 3 December 1979;
- A41: letter from Hauni to MonTrade, 24 March 2015;
- A42: letter from MonTrade to Hauni, 21 April 2015;
- A43: EP1069222A;
- A45: US4312698;

- A46: WO2016016862A1;
- H01: NWA Licence, 18 January 1978;
- H02: 2015 - Filter and cigarette process development, Filter development annual report, 5 September 1980 ;
- H04: NWA Manual 1978; and
- H07: Cigarette filter processing effects - Filtrona NWA Process (Berger et al) vs. P.M. Microwave process, 21 October 1980;

The Opposition Division found that:

- the ground for opposition under Article 100(b) EPC did not prejudice the maintenance of the granted patent;
- the subject-matter of granted claims 1 and 8 was novel over A15 (together with A16) and A12;
- the subject-matter of granted claims 1 and 8 involved an inventive step in view of the following combinations of prior art:
 - (i) A12 with A19 and A39;
 - (ii) A19 with A43 ;
 - (iii) A19 with A12 and A43;
 - (iv) A39 with common general knowledge and A43; and
 - (v) A32 with common general knowledge.

As regards the evidence submitted during the opposition proceedings and the alleged public prior uses the Opposition Division decided among others that:

- late filed documents A44, A45, A46, H01, H02, H04 and H07 were not admitted as not being *prima facie* relevant;
- alleged public prior uses of a machine within the factory premises of JTI Austria Tabak in Hainburg in 2004 and in 2011 together with documents A4 to

- A9 were not made available to the public due to an implied confidentiality; and
- alleged knowledge of alleged public prior use JTI Austria Tabak by the patent proprietor (A41, A42) was not properly substantiated and there was no need to summon the witnesses (Giannini and Monzoni).

III. Oral proceedings were held before the Board on 8 February 2022 by videoconference.

The patent proprietor was not present in the oral proceedings as announced with letters dated 3 January 2022 and 21 January 2022 and was treated as relying only on its written case in accordance with Article 15(3) RPBA 2020 (Rules of Procedure of the Boards of Appeal OJ EPO 2019, A63).

The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested in writing that the appeal be dismissed, or, in the alternative, that the patent be maintained according to any of the auxiliary requests 1 to 9 filed with the reply to the statement of grounds of appeal.

IV. Granted claim 1 reads as follows:

A method for producing paperless filter rods for smoking articles, comprising:

- *feeding a tow band (11) of hardening-material-impregnated filtering material, onto porous conveying means (22) extending along a forming channel (36) of a forming beam (12) comprising a*

stabilizing first portion (29) and a drying second portion (30);

- *advancing the conveyor means (22) and the tow band (11) along the forming channel (36);*
- *blowing steam through the conveyor means (22) and the tow band (11) as they advance along the first portion (29) to cause the hardening material to react;*
- *blowing air through the conveyor means (22) and the tow band (11) as they advance along the second portion (30) to dry the tow band (11) previously moistened by the steam to obtain a continuous paperless rigid rod filter (5); and*
- *feeding the continuous rod (5) coming out from the forming beam (12) to a cutting means (6) to cut the rod (5) crosswise into filter segments of a predetermined length;*

*the method being **characterized in that:***

- *steam blowing is performed at a number of stabilization stations (45) arranged in series along the first portion (29); and in that:*
- *at each stabilization station (45), the steam is fed into an accumulation chamber (46 + 47) surrounding the forming channel (36) and communicating therewith through an annular nozzle (61 + 62) extending on a transverse plane to the forming channel (36) and having a constant width, measured along an axis (A) of the forming channel (36), of 0.3 to 0.9 mm.*

Granted claim 8 reads as follows:

Machine for producing paperless filters for smoking articles, the machine comprising a forming beam (12) comprising stabilizing first portion (29) and a drying second portion (30) and having a forming channel (36)

extending along an axis (A) between and input (35) and an output (39); porous conveying means (22) extending along the forming channel (36) and driven to move along the forming channel (36) in a determined direction (7) parallel to said axis (A); feeding means (10) to feed a hardening-material-impregnated filtering material tow band (11) onto the conveying means (22) and upstream from said inlet (35); stabilizing means (45) arranged along the first portion (29) for injecting steam through the conveying means (22) and the tow band (11) for causing the hardening material to react; drying means (65) arranged along the second portion (30) for blowing air through the conveyor means (22) and the tow band (11) for drying the tow band (11) previously moistened by the steam and to obtain a continuous paperless rigid filter rod (5); and a cutting device (6) disposed downstream from said outlet (39) in the feed direction (7) to cut the continuous rod (5) crosswise into filter segments of a determined length; the machine (1) being **characterized in that** the stabilizing means (45) comprise at least two stabilization stations (45) arranged in series along the first portion (29); and in that each stabilization station (45) comprises an accumulation chamber (46 + 47) surrounding the forming channel (36); feeding means (10) to feed steam to the accumulation chamber (46 + 47); and an annular nozzle (61 + 62) to put the accumulation chamber (46 + 47) into communication with the forming channel (36); the annular nozzle (61 + 62) being arranged on a plane extending crosswise to the forming channel (36) and having a constant width, measured along said axis (A), of 0.3 to 0.9 mm.

Reasons for the Decision

1. Evidence

1.1 To documents A45, A46, H01, H02, H04 and H07

1.1.1 The Opposition Division did not admit late filed documents A46 and H07 for purposes of sufficiency of disclosure, and A45, H01, H02 and H04 for purposes of inventive step. The appellant contested the inadmissibility.

1.1.2 According to established case law of the Boards of Appeal the discretionary power of the Opposition Division should only be overruled by the Board if the Opposition Division applied its discretion in an unreasonable way or by using the wrong principles (see G7/93).

1.1.3 The Board considers that the Opposition Division correctly applied its discretion when deciding on the admissibility of the above late filed documents by assessing their *prima facie* relevance.

1.1.4 The appellant alleged that A46 proved that the invention according to the patent did not solve the problem posed, namely a significant reduction of the amount of water used in the steam stabilizing portion. The invention of A46 started from the invention of the impugned patent and confirmed that a post-drying was required, therefore implying that the produced filter rods according to the patent in suit were wet.

However, A46 is directed to the improvement of the second part of the process as such, i.e. the drying of the towed filtering material after the steam application in order to be able to further reduce humidity contained in the tow band. This by no means implies that the amount of water in the blowing station has not been reduced compared to other machines and methods but merely that the remaining humidity in the tow band can be removed in a more efficient manner as proposed by the invention of A46.

As regards H07, the document does not add anything further but only reinforces the allegations of the appellant about the lack of data for parameters that the patent specification should disclose for enabling the skilled person to carry out the NWA (non wrapped acetate) filter producing method and machine according to the invention of the contested patent. The appellant merely repeated the arguments already considered by the Opposition Division. The Board concurs with the respondent that the *prima facie* assessment of the Opposition Division is free of any error in its reasoning.

As for A45, the appellant considered that the Opposition Division erred in its analysis in that A45 disclosed annular nozzles in the form of plurality of radially spaced holes 72 along a ring. The Board concurs with the Opposition Division that the passageways 72 in figure 6 are not *prima facie* annular nozzles in the sense of the contested patent (see figure 4 of the patent and the reasoning further below under novelty) and the document is also silent on their dimensions. These features were seen as the differences with respect to the closest prior art in order to assess inventive step.

The same as for A45 applies for H04 together with H01 and H02 (also in view of A4, A6, A7 and A37). The appellant fails to indicate where the *prima facie* analysis of the Opposition Division is erred according to which the annular nozzles with the specific claimed dimensions for each steam blowing station are not disclosed in H04. The appellant further alleged for the first time in the statement of grounds of appeal that H04 shows extensive similarities with A4, A6, A7 and A37. These allegations are, however, irrelevant for questioning the Opposition Division's exercise of discretion.

1.1.5 Accordingly, the Opposition Division's exercise of discretion as regards the above mentioned documents is free of any unreasonable assessment and carried out according to the right principles. The Board has accordingly no reason to overrule it.

1.2 *Alleged public prior uses*

1.2.1 The appellant pursued in the appeal proceedings three of the four public prior uses alleged during the opposition proceedings.

These three alleged public prior uses relate to the same machine which was in operation in the production plant of JTI Hainburg. According to two of the public prior uses the machine was inspected by three persons which were heard as witnesses during the oral proceedings in front of the Opposition Division:

- 1) in April 2004 by Mr Dietrich (evidenced by its testimony and A10);
- 2) in May 2011 by Mr Lembke and Mr Hoffmann (evidenced by their testimony and A1-A9).

The machine in question was a modified machine of JTI, i.e. not a series production machine, which was installed at the time by employees of ITM. All three witnesses were employees of Universelle at the time of the visits of the plant in Hainburg. Universelle is a company owned at 100% by the opponent.

The third of the alleged public prior uses relates to the patent proprietor's knowledge of the machine in the above mentioned JTI plant.

- 1.2.2 Regarding the two first alleged public prior uses the public character of the visits was contested by the patent proprietor. The Opposition Division evaluated the evidence available after hearing the witnesses by applying the standard of proof "beyond any reasonable doubt" and decided that the witnesses could not be considered as members of the public since they were implicitly bound by confidentiality. The prior use was thus found not to have been made available to the public.
- 1.2.3 The appellant argued that the standard of proof to be applied to the two first alleged public prior uses was that of balance of probabilities. In this respect the decision of the Boards of Appeal referred to by the Opposition Division (T 472/92 and T 2451/13) concerned facts that were not comparable to those of the present case. In contrast thereto the prior uses in 2004 and 2011 took place in the Hainburg plant of JTI, which was neither affiliated with the employer of Mr Dietrich, Mr Lembke and Mr Hoffmann (Universelle) or with the opponent itself, nor part of any joint venture between the JTI Hainburg plant and Universelle or the opponent. Furthermore, according to the evidence produced by hearing the witnesses and their affidavits (A10, A1 and

A2) there were no confidentiality obligations, nor was there any research and development work in cooperation between the JTI Hainburg plant, the witnesses' employer or the opponent. The visits had clearly public character. In particular, the conclusions of the Opposition Division that an implied duty of confidentiality was present was flawed since the machine in question related to a modification and refitting of a common filter producing machine with a commercially available modification kit by the third party supplier ITM. The circumstances of the visits clearly pointed towards the contrary.

- 1.2.4 Bearing in mind the principle of free evaluation of evidence which pertains to established case law of the Boards of Appeal (see Case Law of the Boards of Appeal of the EPO, 9th Edition, III.G.4.1) and applies before the European Patent Office (see also G 3/97, reasons point 5, G 1/12 reasons point 31), the Board cannot identify any error in the application of the law carried out by the Opposition Division because the evaluation done is free of any contradiction when assessing the evidence of the two first alleged public prior uses, for the following reasons.
- Firstly, the stricter standard of proof selected - beyond any reasonable doubt - is correct. It is true that the machine in question belonged to JTI and not to the opponent or to its 100% subsidiary, Universelle. However, the proof of its public availability is carried out by the appellant by means of evidence produced by statements of employees of its owned subsidiary when visiting the factory premises of JTI in Hainburg where the machine was located. Accordingly, irrespective of the non-existence of any joint venture or cooperation between JTI and Universelle (or the appellant itself), that evidence lies within the power

and knowledge of the appellant and consequently the established stricter criterion must be applied. This is correctly pointed out by the Opposition Division in its decision when referring to T 472/92 and T 2451/13. The appellant did not seek, or succeed, to prove the alleged public prior uses with evidence obtained from JTI itself or even from ITM, which would then not lie within its power and knowledge.

Secondly, it is well recognised that processes and equipments installed and located within factory premises are not made available to the public since a factory is normally not open to the public.

Accordingly, a visit to a factory premise implies in general a duty of confidentiality, which does not thus necessarily need to be specified in a written agreement. The burden to prove beyond any reasonable doubt that this was not the case for the visits in April 2004 by Mr Dietrich and in May 2011 by Mr Lembke and Mr Hoffmann lies within the appellant. Even if the non-existence of a fact, in this case of an agreement of confidentiality, cannot, as a rule, be positively proven, the appellant in the present case has not shown with the required level of certainty that the circumstances of the visits excluded that they were confidential. On the contrary, even though the visit of Mr Dietrich was not specifically directed to the machine in question, the later visit of Mr Lembke and Mr Hoffmann was purposively carried out in order to inspect and assess whether the technology employed in the machine was suitable for developing NWA filter producing machines at Universelle. Consequently, this type of cooperation between JTI and Universelle points clearly to a mutual interest in keeping confidential the technology for producing filters for smoking articles included in the machine. Accordingly, it is reasonable to conclude, as the Opposition Division did,

that the visit was implicitly bound by confidentiality. Put in other words, it cannot either be excluded beyond any reasonable doubt that such a tacit confidentiality existed bearing in mind the circumstances of the visits.

Consequently, there is no reason to overturn the evaluation of the evidence made by the Opposition Division in its decision in this respect. The first two alleged public prior uses are therefore not prior art under Article 54 EPC.

- 1.2.5 Regarding the patent proprietor's knowledge of the machine at JTI in Hainburg by its employees Ms Giannini and Mr Monzoni, the appellant argued that it derived from A42 that the respondent was aware of the allegedly new and inventive combination of features before the priority date of the patent in suit. These features were shown in the photographs of the machine in the plant of JTI in Hainburg included in A41 and posted to the patent proprietor. The patent proprietor accordingly knew about the existence of the machine in Hainburg and the Opposition Division should have carried out the taking of evidence by hearing Ms Giannini and Mr Monzoni in order to confirm the circumstances in which the patent proprietor became aware of the existence of the machine. Even if one were to follow the view of the Opposition Division that A41 did lack a connection with the machine in the Hainburg plant, the Opposition Division disregarded the fact that the only possible explanation for the knowledge of the patent proprietor about the individual features and their combination was that the inventors were also informed elsewhere or in another way about them - independently of the Hainburg plant.

The appellant in its reasoning fails however to address the lack of substantiation raised by the Opposition Division in the impugned decision relating to the patent proprietor's knowledge of the machine of JTI in Hainburg. The circumstances of this alleged public prior use, in particular, when, how and who (see e.g. T 93/99, T 538/89), are still incomplete and the Opposition Division correctly decided not to hear Ms Giannini and Mr Monzoni, since it was not clear which facts the witnesses were supposed to confirm. The submission from the appellant that A42 presumably represented evidence that the NWA technology of the machine in Hainburg was not only visible in the Hainburg plant but obviously also in other places since the respondent was aware of its existence, is an assumption irrelevant for assessing the substantiation of this public prior use.

Accordingly, the third alleged public prior use does not either form part of the state of the art under Article 54(2) EPC.

- 1.2.6 The appellant further contested that A5, A6, A8 and A9 were not state of the art. Regarding A6, however, its availability was defended by referring to handing it over to Mr Hoffmann and Mr Lembke during the visit to JTI (see page 37 of the notice of opposition). As concluded above the visit lacked public character. Accordingly, A6 does not form part of the prior art. As for A5, A8 and A9 the appellant is silent in the appeal on their specific stand-alone public availability. The Board has thus no reason to deviate from the conclusions of the Opposition Division in the decision.

2. *Sufficiency of disclosure - Article 100(b) EPC*

2.1 The European patent discloses the invention according to claims 1 and 8 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

2.2 The appellant contested the reasoning of the Opposition Division in the decision under appeal in this regard as follows. Claim 1 was not merely directed to a method for applying steam at one or more steam stations, but to a method for producing paperless filter rods for smoking articles. Accordingly, it was not correct to reduce the method of granted claim 1 and the machine of granted claim 8 to an improvement of a partial aspect thereof, and to expect that only disclosed details of this improvement suffice for a clear and complete disclosure of the invention. Therefore, the skilled person would rightly expect information on parameters, with which the method claimed was feasible and the stated advantages (significant reduction of the amount of water in the steam flow and significant increase of the production speed without negative impact on the quality of the product) occurred. These parameters involved at least temperatures, steam saturation/overheat, pressure level, steam flow rate and dwell times. Since the patent in suit was completely mute in this respect and did not even mention a starting point, the person skilled in the art was confronted with an unreasonable effort consisting in carrying out numerous tests, without the help of common general knowledge. Documents A39 and A15 supported this view. The disclosure of the invention in the patent was consequently such that it did not enable the skilled person to carry it out.

The Board disagrees. NWA machines and methodology, as also put forward by the appellant in the introductory part of the statement of grounds of appeal, are common general knowledge. The invention according to the patent is indeed directed to the improvement of the first portion (stabilization portion responsible for applying steam to the hardening-material-impregnated filtering material) in the manufacturing of NWA cigarette filters with a specific technical purpose which is explained in para. 35 to 39 of the patent. The setting and tuning of the different parameters when carrying out a specific method and machine as claimed in claims 1 and 8, respectively, merely involve design parameters that fall under customary practice of the skilled person. The patent specification is not an instruction manual and the different parameters appear to depend on the specific machine used (size, composition of the filter, tow band parameters, etc...). This is confirmed by the reference to A15 and A39 done by the appellant itself (see col. 15, l. 34 ff. of A15 and page 3 under general comments of A39). Clearly the setting and tuning of the parameters is machine and method specific.

Furthermore, it is to be noted that it is well-established case law of the Boards of Appeal, that an objection of insufficient disclosure cannot legitimately be based on an argument that the patent does not enable a skilled person to achieve a technical effect (here the advantages under para. 35 to 39 of the patent) which is not defined in the claim. Such arguments are rather to be considered for the purpose of inventive step.

- 2.3 The appellant further objected that the witnesses Mr Dietrich and Mr Hoffmann were not heard for the issue of sufficiency of disclosure. The Board cannot follow

this objection since their testimony was not requested for that purpose and the appellant did not substantiate such an objection in view of the witnesses in its notice of opposition (see p. 13 and 14 of the notice of opposition). Furthermore, no trace in the opposition proceedings is found of any objections under Article 100(b) EPC raised by the appellant and based on the content of the affidavits of these witnesses (A1 and A10). The request for hearing these witnesses was conditional on whether the affidavits were contested or doubted upon and on the public prior use "Hainburg" (see p.12 to 14 of the notice of opposition). The hearing of technical experts was never requested. Consequently, the Board judges that the Opposition Division correctly did not hear Mr Dietrich and Mr Hoffmann as witnesses or as technical experts for purposes of sufficiency of disclosure of the contested patent.

3. *Novelty - Article 100(a) and 54 EPC*

3.1 The subject-matter of granted claims 1 and 8 is new over the prior art at hand.

3.2 The appellant maintained the novelty objections as in the impugned decision that the subject-matter of claims 1 and 8 was not new over A15 (together with A16) and A12. Further, the appellant added that A4 and A7 as stand alone state of the art anticipated as well the subject-matter of the independent granted claims. These latter attacks were raised in the notice of opposition and the Opposition Division decided that the appellant was not able to prove that A4 and A7 together with the second above-mentioned alleged public prior use had become publicly available. Lastly, the appellant raised for the first time with the appeal a novelty objection

over the prior art incorporated by Mr Dietrich himself and evidenced by the minutes of hearing Mr Dietrich as a witness carried out by the Opposition Division and by the affidavit A10 with respect to its previous work at Filtrona.

- 3.3 As regards A15 (A16) and A12 the appellant repeated the arguments duly considered by the Opposition Division in its decision (see point 15 of the contested decision). In particular, the appellant argued that under the claimed "annular nozzle" fell a series of radial bores extending on a traverse plane to the forming channel and disposed in an annular form. Accordingly, the plurality of radial apertures 96 of the steam part (stabilization portion) of the filter rods producing machine and method in figure 7 of A16 and the plurality of radially spaced passage ways 72 in figure 4 of A12 disclosed such an annular nozzle. A plurality of stabilization stations arranged in series along a first portion of the forming channel was implicit from claim 49 of A15, since a single application of superheated steam could not raise the tow moisture in the intended manner, and also disclosed in claim 32 of A12.

Since the Board finds the reasoning of the Opposition Division to be correct, it adopts it as its own. Specifically, the claimed annular nozzle is a single nozzle having an annular shape and not a plurality of nozzles arranged in an annular form. Further, even considering that a single application of steam would not be enough to provide the required result in the towed material, the application of steam along the first portion of the forming channel at different locations does not necessarily mean that a plurality of stabilization stations are needed. Providing steam nozzles at different points of the forming channel but

within a single station would also be possible. Consequently, A15(A16) and A12 fail to disclose directly and unambiguously a plurality of stabilization stations arranged in series along the first portion of the forming channel and each having an annular nozzle.

- 3.4 As regards the novelty objections in view of A4 and A7 as stand alone prior art, the appellant made reference to the notice of opposition (pages 38 to 42 for A4 and pages 29 to 36 for A7). In particular, the appellant argued that figure 2 of A4 and figure 4 of A7 showed that each steam station had a toroidal-shaped annular accumulation chamber, which was formed in the top and bottom steam blocks. Each semicircular torus surrounded the forming channel in its assembling position.

However, the figures referred to in A4 and A7 do not show the specific shape and structure of the interior part of the top and bottom steam blocks. Accordingly, it is not directly and unambiguously derivable from the disclosures of A4 and A7 that the depicted holes at the side ends of the annular nozzles run in a toroidal form within the top and bottom steam blocks. As put forward by the respondent, it cannot be derived from the figures how the holes at the ends of the annular nozzles look like and extend into the inner part of the top and bottom steam blocks. Consequently, neither A4 nor A7 disclose directly and unambiguously an accumulation chamber surrounding the forming channel at each stabilization station.

Since A4 and A7 do not anticipate the subject-matter of granted claims 1 and 8, the issue of their public availability can therefore be left aside.

3.5 The appellant further considered that Mr Dietrich himself represented a source of prior art regarding its knowledge of NWA technology as a result to its previous work at Filtrona. The appellant pointed it out during the oral proceedings before the Opposition Division (see corrected version of the minutes point 2.1). This prior art was allegedly novelty destroying for the subject-matter of granted claims 1 and 8.

However, there is no trace of such an objection in the opposition file or during the oral proceedings. The contested decision does not either deal with that issue under novelty.

Consequently, the novelty objection represents a new alleged fact raised for the first time in the appeal proceedings (see e.g. T 392/16 of the same Board but in different composition).

Under Article 12(4) RPBA 2007 (Rules of Procedure of the Boards of Appeal OJ EPO 2007, 536; this article applies to the current appeal under Article 25(2) RPBA 2020) the Board has the power to hold inadmissible facts which could have been presented in the first instance proceedings.

The Board finds no reason in the opposition proceedings that justifies raising the objection at such a late stage. The object contested still remains the granted patent and the appellant should have put forward the objection already in the notice of opposition or at the latest during the oral proceedings before the Opposition Division after the taking of evidence by hearing Mr Dietrich. However, the appellant chose not to do so and nothing else during the opposition proceedings justifies submitting the objection for the first time with the grounds of appeal. Moreover, the

only purpose of hearing Mr Dietrich as a witness was to prove the public availability of the machine at JTI in Hainburg and not as himself being a source of prior art.

Under these circumstances, the Board exercised its discretionary power under Article 12(4) RPBA 2007 and held this late filed novelty attack inadmissible.

4. *Inventive step - Article 100(a) and 56 EPC*

4.1 The subject-matter of granted claims 1 and 8 is not rendered obvious by the available prior art.

4.2 The appellant maintained the following inventive step objections raised during the opposition proceedings:

- A12 in combination with A19 and A39;
- A19 with A43;
- A19 with A12 and A43;
- A39 with A43; and
- A32 with common knowledge.

4.3 The appellant essentially reiterated the lines of argument as regards the above inventive step objections which are duly considered by the Opposition Division in the impugned decision.

Since the Board considers that the reasoning of the Opposition Division is correct, it adopts it as its own.

4.4 The appellant notably argued that even though A19 did not disclose an annular nozzle, the skilled person would also implicitly recognize an annular structure of a steam inlet nozzle because the steam garniture 13 illustrated on the last page of A19 usually had a

channel with a circular cross-section, in which the porous band was guided and wrapped around the filter tow.

Further, A43 (see para. 17) gave the skilled person a hint that substituting several nozzle holes for a wide slit nozzle represented a known alternative. Since A43 pertained also to the field of thermal stabilisation of fibers by blowing steam and the shape of the forming channel was already prescribed by the pieces of prior art (A19, A12 or A39) used as starting point for assessing inventive step in the objections raised, the fact that A43 was not directed to a tow band advancing through a circular forming channel for forming filter rods was irrelevant. The difference of granted claims 1 and 8 lied merely on the form of the nozzle and using several holes or a slit instead was an obvious alternative as hinted in A43.

Lastly, starting from A32 as the closest prior art the annular nozzle of granted claims 1 and 8 was specifically disclosed in claim 2 of A32 by reference to a tubular nozzle.

4.5 The Board disagrees. None of the pieces of prior art above discloses nor renders obvious the feature of providing an annular nozzle having a constant width, measured along an axis of the forming channel, of 0.3 to 0.9 mm in each of the plurality of steam blowing stations, the specific accumulation chamber communicating through said nozzle with the forming channel.

In particular, the skilled person cannot implicitly derive the specific form of the ports in the steam manifold of the steam garniture 13 of A19 solely by the feature that the forming channel has a circular cross section. Any method or machine producing filter rods

for smoking articles needs to have at some point a circular cross section for the forming of the rods. However, in view only of the prior art available, it is clear that the ports for the steam station are not imperatively configured as an annular nozzle as discussed above under novelty.

Further, the reasoning that the skilled person would immediately recognise that an annular nozzle is an obvious alternative to several nozzles arranged as an annular array of bores when confronted with the disclosure of A43 is tainted of hindsight. As correctly pointed out by the Opposition Division, A43 is not directed to the production of filter rods but generally to the stabilization of fibers through the application of steam for the production of binder-free, lightweight and absorbent non-wovens. A43 uses the same principle for treating fibers and stabilize them as in the invention of the contested patent. However, A43 does not address the production of rods but rather that of fabrics. Consequently, the nozzles used therein are, at least as regards their structural disposition, different to those used in a NWA filter producing method and machine. The alternative selection of a series of holes or a slit as nozzles is taken by the appellant from A43 in isolation from other aspects disclosed therein, such as the nozzle bar. The skilled person finds no hint or motivation in A43 to proceed as argued by the appellant because A43 does not disclose any annular application of steam to a forming channel nor any isolated teaching on obvious structural configurations for nozzles in such applications. Consequently, the reasoning of the appellant is based on hindsight.

The appellant's objection starting from A32 lies on the assumption that claim 2 of A32 discloses an annular nozzle through which steam is fed. However, the tubular nozzle in claim 2 of A32 represents the tubular part of the channel through which the sliver (tow band) passes. Claim 2 further stipulates that the steam is injected through the wall of the nozzle. The shape and form of the injection ports is however unspecified. Consequently, this inventive step objection also fails since A32 does not disclose the annular nozzle of claims 1 and 8 as granted.

5. It follows from the above that the appeal is not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated