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

Case Number: T 1168/18 - 3.2.01

Application Number: 12175918.7

Publication Number: 2545791

IPC: A24C5/47

Language of the proceedings: EN

Title of invention:

Filter-tipped cigarette rolling device and method

Patent Proprietor:

G.D S.p.A.

Opponent:

Hauni Maschinenbau GmbH

Headword:

Relevant legal provisions:

EPC Art. 100(a), 100(b), 54, 56, 84
RPBA Art. 12(4)

Keyword:

Novelty - main request (no)

Not substantiated auxiliary request - not to be taken into account

Inventive step - auxiliary request 5 (yes)

Late-filed facts - submitted with the statement of grounds of appeal

Claims - lack of support by the description no ground for opposition

Decisions cited:

G 0003/14, T 1890/09, T 0217/10, T 0089/16

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 1168/18 - 3.2.01

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

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

Representative: Seemann & Partner Patentanwälte mbB
Raboisen 6
20095 Hamburg (DE)

Respondent: G.D S.p.A.
(Patent Proprietor) Via Battindarno, 91
40133 Bologna (IT)

Representative: Bianciardi, Ezio
Bugnion S.p.A.
Via di Corticella, 87
40128 Bologna (IT)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 27 March 2018
rejecting the opposition filed against European
patent No. 2545791 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: J. J. de Acha González
P. Guntz
M. Geisenhofer
O. Loizou

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. 2 545 791.

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

E7: JP 2002-176965;

E7T: English Translation of E7; and

E9: DE 197 18 322 A1.

The Opposition Division found among others that the ground for opposition under Article 100(b) EPC did not prejudice the maintenance of the granted patent and that the subject-matter of granted claims 1 and 13 was novel over E9 and involved an inventive step starting from E7 and E9 as the closest prior art.

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

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

The respondent (patent proprietor) requested to dismiss the appeal, or, in the alternative, to maintain the patent according to any one of the auxiliary requests 3 and 5 filed with the reply to the statement of grounds of appeal.

IV. Granted claim 1 reads as follows (in bold the passages as in the B1 specification):

A filter-tipped cigarette rolling device comprising a rolling channel (30) where paper patches (10) are rolled round respective groups (4), each defined by two cigarette sticks (6) axially aligned with each other, and a double filter plug (8) interposed between the two cigarette sticks (6); the channel (30) having an infeed station (I) where the groups (4) and the respective patches (10) are fed in, and being defined by a first surface (38) and a second surface (40) mutually opposed and movable relative to each other;

to fix each patch (10) to the cigarette sticks (6) and to the filter plug (8), the patch (10) has glue previously applied to it by a gluing device (12);

the patches (10) having glue spread on them according to a predetermined application pattern (32);

the glue application pattern (32) comprising glued areas, that is, areas with glue uniformly spread on them, and unglued areas, that is, without any glue on them;

*the device being **characterized in that** at least one of the surfaces (38,40) has first zones (56) which are recessed relative to second zones (58), the latter being distributed according to a pattern reflecting the predetermined glue application pattern (32); the first zones (56) and the second zones (58) defining in the rolling channel (30) differentiated compression sections by which the patches (10) are pressed on the respective groups (4) to different degrees; **the first zones (56) defining the compression of the zones of the patch (10) without any glue on them.***

Granted claim 13 reads as follows (in bold the passages as in the B1 specification):

A method for rolling filter-tipped cigarettes comprising the steps of:

partly superposing groups (4), each consisting of two axially aligned cigarette sticks (6) and a double filter plug (8) interposed between the two cigarette sticks (6), with a respective patch (10) by which each cigarette stick (6) is connected to the filter plug (8) and which has glue spread on it according to a predetermined pattern (32);

the glue application pattern (32) comprising glued areas, that is, areas with glue uniformly spread on them, and unglued areas, that is, without any glue on them feeding the groups (4) and the patches (10) to a rolling channel (30) for rolling the groups (4) onto the patches (10) and defined by a first surface (38) and a second surface (40) mutually opposed and movable relative to each other;

the method being characterized in that:

rolling the groups (4) in the patches (10) and causing each group (4) to be compressed by the action of first zones (56) which are recessed relative to second zones (58), these being distributed according to a pattern that reflects the glue application pattern (32); **the first zones (56) defining the compression of the zones of the patch (10) without any glue on them;**

applying, during the rolling step, a different compression on the zones of the patch (10) provided with glue according to the predetermined application pattern (32).

Claim 1 of auxiliary request 3 differs from granted claim 1 in that it further includes the features of granted claim 2, namely:

the second zones (58) are defined by a first compression rolling portion (94) for a front portion (60) of the patch (10), extending along a direction transversal to the direction of travel (D) of the channel (30); a second (96), third (98) and fourth (100) rolling portions allowing compression, respectively, of a first lateral portion (64), a longitudinal central portion (68) and a second lateral portion (66) of the patch (10); the second (96), third (98) and fourth (100) portions extending parallel to and spaced from each other; a fifth rolling portion (102) parallel to the first (94) and located between the second portion (96) and the fourth (100), allowing compression of a transversal central portion (70) of the patch (10).

Claim 12 of auxiliary request 3 as well as the sole claim of auxiliary request 5 are identical to claim 13 as granted.

Reasons for the Decision

1. *Main request - Novelty over E9*
- 1.1 The subject-matter of granted claim 1 is not new over the disclosure of E9 (Article 100(a) and 54 EPC).
- 1.2 *Claim interpretation*

- 1.2.1 Claim 1 is directed to a filter-tipped cigarette rolling device comprising a rolling channel having an infeed station wherein the groups (two axially aligned cigarette sticks and a double filter therebetween) and respective paper patches are fed. The channel is defined by first and second surfaces mutually opposed and movable relative to each other.
- The claimed device is defined by reference to the groups and their respective paper patches which have glue previously applied to them according to a pattern which comprises glued and unglued areas. The groups and the patches with the glue pattern are indeed entities not forming part of the device of claim 1. However - contrary to the appellant's assertions - the characterising part of the claim limits its scope in that the device has a rolling channel that functions the way claimed, i.e. by providing at least one of the surfaces with first zones which are recessed relative to second zones, the latter being distributed according to a pattern capable of reflecting a predetermined glue application pattern on a patch; the first zones and the second zones defining in the rolling channel differentiated compression sections by which the patches are pressed on the respective groups to different degrees; the first zones defining the compression of the zones of the patch without any glue on them. According to these functional features the machine allows to press the paper patches on the groups with different pressures on the first and second zones.
- 1.2.2 The appellant argued that the claim wording did not exclude that the compression of the first or second zones was zero and accordingly a non-contact between the patch and the first or second zones was included in the subject-matter claimed.

1.2.3 The characterising part of claim 1 stipulates however that both the first and second zones compress the patch on the respective group - a positive pressure is applied by the first and second zones of the rolling channel. The compression applied is merely different on the zones of the patch with glue and on those without glue. The compression is not defined in the claim as a mathematical function which could include a zero value or even a negative one (i.e. a traction or suction) applied by the corresponding zone but is only specified as a compression of the groups. This is also the case for granted method claim 13.

Consequently, a contact and the application of a positive pressure in both first and second zones of the surface of the rolling channel to the corresponding paper and group is provided by the device when rolling the groups in the rolling channel. Furthermore, the first and second zones are such that they press the zones of the patch without and with glue respectively when the corresponding patch is used in the device. Also, in line with the respondent's submissions, the filter-tipped cigarette rolling device according to granted claim 1 is such that when a corresponding and suitable patch together with the group is rolled in the device, the filter tipped cigarette is properly rolled. This was not contested by the appellant.

1.3 *E9 disclosure*

1.3.1 Bearing in mind the interpretation above, E9 discloses two zones on the rolling surface 9 of the rolling hand 7. One zone includes the protrusions 24 and 26 and the other corresponds to the rest of the rolling face of the hand. The groups and corresponding paper patches roll over the whole surface 9 and when passing the protruded area the groups together with their

respective patch are pressed with greater pressure than in the rest of the rolling surface in order to ensure gluing of the cigarette paper and paper patch 17 (see col. 1 l. 60-65; and col 2 l. 42-50). The protrusions apply more pressure clearly where the patch 17 has glue on it (see col. 2, l. 20 to 22). Therefore, the device of E9 is novelty destroying since a patch having glue applied on it that corresponds to the pattern of the the protrusions 24 and 26 when rolled in the rolling channel 11 of the rolling device of E9 would be rolled according to the invention of the patent in suit.

- 1.3.2 The Opposition Division considered that the dimensions of the protrusions in E9 are such that there is no contact with the rest of the rolling surface once the group is in contact with the protrusion. However, this does not derive directly and unambiguously from the disclosure of E9 but the opposite is true, as pointed out further up.
- 1.3.3 The respondent alleged that E9 was silent on the protrusions matching a corresponding gluing pattern on the paper patch.
As mentioned above and pointed out by the appellant, the patches are not part of the subject-matter claimed and it suffices that it is possible to form a patch with a gluing pattern on it that corresponds to the protrusion pattern of roll hand of E9 for the device of E9 to be novelty destroying for the subject-matter of claim 1. This is clearly the case in E9.
- 1.3.4 The respondent further argued that even if a patch could be formed with a gluing pattern matching that of the protrusions of the rolling hand, such a patch which would result in glue applied only along its perimeter would not achieve the needed reliable connection of the

filter plug with the two cigarette sticks. Nearly the entire surface of the patch would not have glue on it and in the middle of the plug no circumferential glue would be present such that after cutting the double filter plug, the part along the cutting edge would not be properly fixed. The result would be a poor connection which was not suitable for such rolled filter-tipped cigarettes. E9 taught merely that an extra compression at specific key zones was desired. However, glue had to be present also outside of said zones to provide the needed connection for achieving high quality cigarettes that did not break, fail or could be easily damaged.

This reasoning is not persuasive since - as correctly pointed out by the appellant - the skilled person is aware that a cigarette stick with its filter can be rolled with a cigarette paper including only glue along its outer longitudinal edge whilst providing an adequate, stable and reliable connection of the cigarette stick and filter. Consequently, a patch with glue applied thereon in order to reflect the pattern of the protrusions of the rolling hand of E9 would provide securely rolled filter-tipped cigarette using the device of E9.

2. *Auxiliary request 3 - unsubstantiated*

2.1 Auxiliary request 3 was not taken into account in the appeal proceedings under Article 12(4) RPBA 2007 (Rules of Procedure of the Boards of Appeal OJ EPO 2007, 536) which applies to the present appeal pursuant to Article 25(2) RPBA 2020 (Rules of Procedure of the Boards of Appeal OJ EPO 2019, A63).

- 2.2 Auxiliary request 3 filed with the reply to the statement of grounds of appeal of the opponent corresponds to auxiliary request 8 underlying the contested decision, upon which the Opposition Division did not decide. Apparatus claim 1 is a combination of granted claims 1 and 2, and method claim 12 is identical to granted claim 13. The appellant objected in the statement of grounds of appeal to the inventive step of the subject-matter of granted claim 2 (see point X of the statement of grounds of appeal). The respondent did not address this argumentation of the appellant in its reply and merely submitted the basis in the granted patent for the new claim 1 of the request thereby failing to substantially address it in view in particular of the requirements of inventive step.
- 2.3 Under Article 12(4) RPBA 2007 everything presented by the parties under Article 12(1) RPBA 2007 shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA 2007. Article 12(2) RPBA 2007 stipulates that the statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on.
- 2.4 According to the Case Law of the Boards of Appeal, auxiliary requests which were not substantiated by the respondent in the reply, in the sense that arguments were put forward as to why the amended sets of claims overcome the objections raised by the appellant against

the main request in the statement of grounds of appeal, do not meet the requirements stipulated in Article 12(2) RPBA (see Case Law of the Boards of Appeal, 9th edition 2019, V.A.4.12.5, and in particular T 1890/09, reasons 4, T 217/10, reasons 5, and T 89/16, reasons 2).

2.5 In the present case, the auxiliary request 3 submitted by the respondent does not meet the above mentioned criteria and consequently was not taken into account.

3. *Auxiliary request 5*

3.1 *Inventive step - Article 56 EPC*

3.1.1 The subject-matter of claim 1 is not rendered obvious by E7 or E9 in combination with common general knowledge of the skilled person.

3.1.2 Claim 1 of auxiliary request 5, which is identical to granted claim 13, claims the method for rolling filter-tipped cigarettes according to the invention of the patent in suit. Therefore, this method claim, in contrast to the device of granted claim 1, is limited to the patches having glue spread on them according to a predetermined pattern that is reflected in the distribution of the second zones. This exclusive correspondence between the non-recessed areas of the second zones with a gluing pattern on the patch such that the first zones compress the zones of the patch without any glue on them and the second zones compress those with glue is not rendered obvious by the appellant's inventive step objections for the following reasons.

- 3.1.3 The inventive step objection of the appellant starting from E7 as the closest prior art cannot succeed because it is based on the incorrect assumption that E7 discloses two zones applying different pressures to the groups with the respective patches. However, the method for rolling filter-tipped cigarettes disclosed in E7 only applies a compression to the patch C with the surface 28 of the rolling guide 18. The surfaces 30 and the slots 32 do not apply any compression to the patch C (see figure 2 of E7).
- 3.1.4 When starting from E9 the appellant argued that the subject-matter of claim 13 differed from the method disclosed in E9 on account of a glue pattern on the patches and its correspondence with the pattern of the second zones of the rolling channel since E9 was silent on how the glue was applied on the patches. However, the skilled person, being aware - as specified in paragraph [0015] of the contested patent - that applying a higher compressive force in rolling in order to improve gluing efficacy has the effect of reducing the degree of ventilation in the perforated windows of the skip tipped patch, would match the protruding zones of the rolling hand of E9 with a glue application pattern on the patch in order to customize and optimize the rolling of filter-tipped cigarettes.
- 3.1.5 The reasoning of the appellant is based on hindsight. The difference between the method of claim 1 and the method of E9 is indeed the glue pattern on the patches and its correspondence with the pattern of the second zones of the rolling channel. With such exclusive correspondence the invention allows to provide filter-tipped cigarettes rolled with high degree of ventilation while properly and securely glued (see paragraphs [0015] and [0016] of the patent). The

skilled person finds however no hint or motivation in its common general knowledge to apply such a specific pattern of glue on the patches of E9 with its correspondence of the glue areas with the protrusions of the hand. The purpose of the protrusions in E9 is to guarantee a smooth bonding of cigarette paper and connecting patches even with reduced tobacco storage or tobacco compaction at the inner end of the cigarette by producing a greater pressure in the critical parts of the joint between cigarettes and filter components. Further, as submitted by the patent proprietor, paragraph [0015] of the patent in suit does not reflect common general knowledge of the skilled person but conclusions drawn from the inventor of the patent in suit by carrying out experiments. Evidence proving that such experiments belong to common general knowledge or were available to the public was not provided by the appellant. Consequently, the skilled person could provide such a patch with a glue pattern corresponding to the protrusions of the rolling hand in the method of E9 but a pointer is missing that would indeed motivate him to do so.

3.2 *Sufficiency of disclosure - admissibility*

3.2.1 The new objection on insufficiency of disclosure for the invention according to claim 1, which is identical to granted claim 13, raised in the statement of grounds of appeal was not admitted into the appeal proceedings (Article 12(4) RPBA 2007).

3.2.2 The appellant maintained in the statement of grounds of appeal the ground for opposition under Article 100(b) EPC also for the subject-matter of granted claim 13. However, the appellant did not pursue in this regard its line of attack presented during the opposition

proceedings (see point II.2 of the notice of opposition) and upon which the Opposition Division decided (see point 13 of the decision). According to that line of attack the appellant considered that the possibility to provide one whole side of the paper patch with glue and the back side without any glue fell under the glue pattern of claim 13.

In contrast, the new line of attack presented is directed to the patent failing to disclose the special compressibility requirement that the filter plugs must fulfil, and which were needed in order to carry out the invention according to granted claim 13 (i.e. claim 1 of auxiliary request 5).

- 3.2.3 Under Article 12(4) RPBA 2007 the Board has the power to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings.
- 3.2.4 The new line of attack on insufficiency of disclosure of the invention according to granted claim 13 is based on a new alleged fact and accordingly the Board has the discretion to hold it inadmissible.

Since the subject under discussion remains the granted patent, in particular the invention according to the granted method, the appellant could and should have raised this objection already in its notice of opposition. Furthermore, the appellant did not put forward any reason arising from the opposition proceedings that justified the submission of the new objection at such a late stage. The Board did not identify any either.

Under these circumstances the Board exercised its discretionary power and did not admit the objection.

3.3 *Adaptation of the description*

3.3.1 The sole claim is supported by the description of the auxiliary request 5 filed during the oral proceedings before the Board (Article 84 EPC) as it was accordingly adapted to it.

3.3.2 The appellant held that the amended patent did not fulfill the requirements of Article 84 EPC since the description was not correctly adapted. In particular, it did not include any embodiment disclosing the claimed method according to the invention. The embodiment referred only to a known method for rolling filter-tipped cigarettes. Deleting the references in the description as granted to the filter-tipped cigarette rolling device as being the invention resulted in a lack of support by the description of the claimed method.

Further, the paragraphs [0022] and [0088] did not recite all the features of the method according to claim 1 and specific reference signs (94, 96, 100, 102, 106, 104a, 104b) were present in the description but not found in the corresponding figures of the amended patent.

3.3.3 According to the decision of the Enlarged Board of Appeal G 3/14 the claims of the patent as amended may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC.

Article 84 EPC stipulates that the claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.

3.3.4 In the present case, the sole claim is identical to claim 13 as granted. Further, the amendments made to the description are only directed to the deletion of statements indicating that the invention relates to a device, which was the case for granted claims 1 to 12. Consequently, the alleged lack of support of the method claim by the description, if any, was already present in the granted patent. Accordingly, the alleged non-compliance has not been introduced by the amendment. Therefore, the lack of support of claim 1 of the auxiliary request 5 by the description is not open for examination under Article 84 EPC in view of G 3/14.

4. It follows from the above that the documents as filed during oral proceedings before the Board according to auxiliary request 5 meet the requirements of the EPC.

5. Correction of the minutes dated 8 April 2022

The Board noted that said minutes contained an obvious mistake and pursuant to Rule 140 EPC corrected ex officio the minutes accordingly.

The amended description as filed did not include page 1 but page 2 of the patent specification.

Thus, the respective parts in the minutes now read: "Documents presented: Adapted description pages 2 to 6" and "description pages 2 to 6" instead of "description pages 1 to 6" (see also corrected minutes).

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 on the basis of the:
 - sole claim of the 5th auxiliary request as submitted with the reply to the statement of grounds of appeal,
 - description pages **2** to 6 as submitted during the oral proceedings and
 - figures 1 to 4 as granted.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated