

Internal distribution code:

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

**Datasheet for the decision
of 16 September 2022**

Case Number: T 3240/19 - 3.2.07

Application Number: 14163123.4

Publication Number: 2792599

IPC: B65B9/13, B65B59/00

Language of the proceedings: EN

Title of invention:

A machine for packaging pallets

Patent Proprietor:

Officina Bocedi S.R.L.

Opponent:

MSK-Verpackungs-Systeme GmbH

Headword:

Relevant legal provisions:

EPC Art. 123(2)

RPBA 2020 Art. 12(2), 12(4), 12(6), 13(2), 15(1)

Keyword:

Amendments - added subject-matter - main request (yes) -
auxiliary request (no)
Amendment to case after summons - taken into account (no)

Decisions cited:

G 0003/89, G 0002/10

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 3240/19 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 16 September 2022

Appellant: MSK-Verpackungs-Systeme GmbH
(Opponent) Benzstrasse
47533 Kleve (DE)

Representative: Dr. Stark & Partner Patentanwälte mbB
Moerser Straße 140
47803 Krefeld (DE)

Respondent: Officina Bocedi S.R.L.
(Patent Proprietor) Via Bosco 31/B Frazione Pratissolo
42019 Scandiano (Reggio Emilia) (IT)

Representative: Casadei, Giovanni
Bugnion S.p.A.
Via Vellani Marchi, 20
41124 Modena (IT)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
16 October 2019 concerning maintenance of the
European Patent No. 2792599 in amended form.**

Composition of the Board:

Chairman I. Beckedorf
Members: S. Watson
A. Pieracci

Summary of Facts and Submissions

- I. An appeal was filed by the opponent in the prescribed form and within the prescribed time limit against the decision of the opposition division maintaining European patent No. 2 792 599 in amended form according to the then main request.
- II. The opposition division found that the subject-matter of the set of claims of the then main request fulfilled the requirements of Articles 56, 84 and 123(2) EPC.
- III. In preparation for oral proceedings the Board communicated its preliminary assessment of the case in a communication pursuant to Article 15(1) RPBA 2020 to which both parties responded substantively.
- IV. Oral proceedings before the Board took place on 16 September 2022. At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes.
- V. The following documents are mentioned in this decision:
D1: WO 2008/031449 A1;
D2: EP 2 336 034 A1;
D3: DE 36 00 589 C1.
- VI. The final requests of the parties are as follows:
for the opponent (appellant):

that the decision under appeal be set aside and
that the patent be revoked in its entirety,

for the patent proprietor (respondent):

that the appeal be dismissed and the patent be maintained in the amended form found to be allowable by the opposition division (main request);

or in the alternative, when setting aside the decision under appeal,

that the patent be maintained in amended form on the basis of one of the sets of claims of the first or second auxiliary requests filed with the reply to the statement setting out the grounds of appeal.

VII. The arguments of the parties are dealt with in detail in the reasons for the decision.

VIII. Independent claim 1 of the main request reads as follows:

"A machine for packaging pallets, comprising:

a frame (2);

a supply device (3), predisposed to remove a section of tubular film from a store (M);

a cutting and welding device (4), predisposed to cut and weld at a determined section of the tubular film;

a positioning device (5), vertically mobile, which comprises four gripping units (51), arranged at the vertices of a quadrilateral and predisposed to grip the section of tubular film at one end and to collect the section of tubular film in a sleeve around hooking elements (52) and to fit the section of film onto a pile of articles;

wherein the cutting and welding device (4) is vertically mobile, while the supply device (3) is arranged in a fixed position in an upper zone of the

frame (2), above the cutting and welding device (4) and the positioning device (5);
wherein the cutting and welding device (4) is maintained fixed in a specific vertical position with respect to the frame (2), during normal functioning of the machine;
wherein the cutting and welding device (4) may be lowered, by means of dedicated sliding means or by sliding of the positioning device (5), down to a level accessible from the ground for operators, on occasion of maintenance operations;
and wherein during normal functioning of the machine, the gripping units (51) are lowered, fitting the tubular film (F) onto the pile of articles;
wherein once arrangement of the tubular film (F) on the pile of articles is completed, said pile is evacuated and replaced by a new pile of articles to be covered and the gripping units (51) return to the initial position."

IX. Independent claim 1 of the first auxiliary request reads as follows (additions and deletions with respect to claim 1 of the main request are shown underlined and struck-through, respectively):

"A machine for packaging pallets, comprising:
a frame (2);
a supply device (3), predisposed to remove a section of tubular film from a store(M);
a cutting and welding device (4), predisposed to cut and weld at a determined section of the tubular film;
a positioning device (5), vertically mobile, which comprises four gripping units (51), arranged at the vertices of a quadrilateral and predisposed to grip the section of tubular film at one end and to collect the section of tubular film in a sleeve around hooking

elements (52) and to fit the section of film onto a pile of articles, each of which is mobile on a horizontal plane along two perpendicular axis (X,Y); wherein the cutting and welding device (4) is vertically mobile, while the supply device (3) is arranged in a fixed position in an upper zone of the frame (2), above the cutting and welding device (4) and the positioning device (5); wherein the cutting and welding device (4) is maintained fixed in a specific vertical position with respect to the frame (2), during normal functioning of the machine; wherein the cutting and welding device (4) may be lowered, by means of dedicated sliding means ~~or by sliding of the positioning device (5)~~, down to a level accessible from the ground for operators, on occasion of maintenance operations; and wherein during normal functioning of the machine, the gripping units (51) are lowered, fitting the tubular film (F) onto the pile of articles; wherein once arrangement of the tubular film (F) on the pile of articles is completed, said pile is evacuated and replaced by a new pile of articles to be covered and the gripping units (51) return to the initial position."

Independent claim 2 of the first auxiliary request reads as follows (additions and deletions with respect to claim 1 of the main request are shown underlined and struck-through, respectively):

"A machine for packaging pallets, comprising:
a frame (2);
a supply device (3), predisposed to remove a section of tubular film from a store (M);

a cutting and welding device (4), predisposed to cut and weld at a determined section of the tubular film; a positioning device (5), vertically mobile, which comprises four gripping units (51), arranged at the vertices of a quadrilateral and predisposed to grip the section of tubular film at one end and to collect the section of tubular film in a sleeve around hooking elements (52) and to fit the section of film onto a pile of articles, each of which is mobile on a horizontal plane along two perpendicular axis (X,Y); wherein the cutting and welding device (4) is vertically mobile, while the supply device (3) is arranged in a fixed position in an upper zone of the frame (2), above the cutting and welding device (4) and the positioning device (5); wherein the cutting and welding device (4) is maintained fixed in a specific vertical position with respect to the frame (2), during normal functioning of the machine; wherein the cutting and welding device (4) may be lowered, ~~by means of dedicated sliding means or by~~ sliding of the positioning device (5), down to a level accessible from the ground for operators, on occasion of maintenance operations; wherein blocking means are provided to maintain the cutting and welding device (4) fixed in a specific vertical position with respect to the frame (2) during normal functioning of the machine; and wherein during normal functioning of the machine, the gripping units (51) are lowered, fitting the tubular film (F) onto the pile of articles; wherein once arrangement of the tubular film (F) on the pile of articles is completed, said pile is evacuated and replaced by a new pile of articles to be covered and the gripping units (51) return to the initial position."

- X. As the second auxiliary request does not form part of this decision, it is unnecessary to reproduce its independent claim here.

Reasons for the Decision

1. *Main request - claim 1 - Article 123(2) EPC*

In the decision under appeal, the opposition division found that claim 1, in amended form, fulfilled the requirements of Article 123(2) EPC (see points II.13.1 to II.13.3).

- 1.1 The appellant argued, that the opposition division was incorrect in its findings, *inter alia*, that the omission from feature M4 of claim 1 of the feature "each of which is mobile on a horizontal plane along two perpendicular axes (X,Y)" did not give rise to an unallowable intermediate generalisation.

- 1.2 Feature M4 of claim 1 of the main request reads as follows (additions with respect to claim 1 as originally filed are underlined and deletions are struck-through; additions with respect to claim 1 as granted are shown in bold):

"a positioning device (5), vertically mobile, which comprises four gripping units (51), arranged at the vertices of a quadrilateral and is predisposed to grip the section of tubular film at one end and to collect the section of tubular film in a sleeve around hooking elements (52) and to fit the section of film onto a pile of articles".

The opposition division found a basis for the amendments made during the opposition proceedings in dependent claim 4 as originally filed which reads as follows:

"The machine according to claim 1, wherein the positioning device (5) comprises four gripping units (51), arranged substantially at the vertices of a quadrilateral, each of which is mobile on a horizontal plane along two perpendicular axes (X,Y)."

The opposition division reasoned that it was allowable to introduce only the number of gripping units and their position without introducing the feature that each gripping unit was mobile along two perpendicular axes in a horizontal plane because the omitted feature solved the problem of stretching the lower edge of the tubular film, whereas the introduced features solved the problem of evenly pulling the lower edge of the film. The opposition division considered that the omitted feature was a "stand-alone" feature which was "not indispensable for the function of the invention in the light of the problem of evenly pulling the lower edge of the tubular film" and no modifications were necessary to compensate for the omission of the feature (see decision under appeal, point II.13.1.1, final paragraph).

- 1.3 The Board notes that any amendment to a claim can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge from the documents as filed, *i.e.* the "gold standard" (G 3/89, G 2/10). It is also established case law that an intermediate generalisation fulfils the requirements of Article 123(2) EPC only in the absence of a clear

functional or structural relationship between the features (see Case Law of the Boards of Appeal (CLB), 10th edition 2022, II.E.1.9).

- 1.4 The Board agrees with the appellant's arguments raised in its statement of grounds of appeal that the omitted feature was clearly functionally and structurally linked to the other features found in claim 4 as originally filed. The combination of movement by the gripping units along two perpendicular axes in a horizontal plane together with the provision of four units arranged at the vertices of a quadrilateral allowed the units to carry out the claimed functions of gripping the section of tube at one end, collecting the section of tubular film in a sleeve around hooking elements and fitting the section of film onto a pile of articles (see statement of grounds of appeal, point II.2.).

- 1.5 The Board cannot see a direct and unambiguous disclosure in claim 4 as originally filed for a positioning device having four gripping units, arranged at the vertices of a quadrilateral without the gripping units also being mobile on a horizontal plane along two perpendicular axes. The mere presence of different features in one dependent claim does not necessarily mean that such features have a structural or functional relationship (see CLB, *supra*, II.E.1.9.2, second paragraph). However, in the present case, the skilled person is given no indication that the second feature of claim 4 is optional for a positioning device having four gripping units arranged at the vertices of a quadrilateral. The features are clearly structurally related as they all refer to the gripping units, and functionally related as the claimed functions of the

positioning device are carried out by the combination of the structural features.

- 1.6 The respondent's argument that paragraphs [0006], [0016] and [0018] of the application as published demonstrate that the features in claim 4 as originally filed are unrelated, cannot be followed. According to the respondent, the functions fulfilled by the two features are different and unconnected as the number and position of the gripping units relates to gripping the tubular film and fitting it onto the pile of articles, whereas the horizontal mobility of the gripping units is necessary to stretch the lower edge of the film (see reply to the statement of grounds of appeal, page 2, first to seventh paragraphs, and submissions of 16 May 2022, page 2, first to third paragraphs).

However, the Board cannot see any disclosure that the features and functions are independent of one another.

Paragraph [0006] relates only to the positioning device as a whole and does not mention the gripping units.

Paragraph [0016] refers to a preferred embodiment in which the vertically mobile positioning device has four gripping units, arranged at the vertices of a quadrilateral and mobile on a horizontal plane along two perpendicular axes. Paragraph [0016] includes a number of further features disclosing that the horizontal movement of the four grippers is achieved through a specific arrangement of crossbars and side members. Therefore paragraph [0016] not only indicates that the contested features are structurally and functionally linked, but also discloses further related features.

Paragraph [0018] describes how the gripping units are used in the first stages of gripping and collecting the tubular film, prior to fitting the film onto a pile of articles. There is nothing in this paragraph which would lead the skilled person to directly and unambiguously derive that the horizontal mobility of the gripping units and the number and position of said gripping units are not linked in the disclosed embodiment.

The respondent argued that the skilled person would be aware of other means which could be provided for enlarging the tubular film before it is gripped by the positioning device, but there is no disclosure in the application as originally filed of any other means for achieving this enlargement other than the gripping units.

1.7 Therefore the appellant has convincingly demonstrated that the decision under appeal was incorrect in finding that claim 1 of the main request fulfilled the requirements of Article 123(2) EPC and the main request is not allowable.

2. *First auxiliary request - admittance -
Article 12 RPBA 2020*

2.1 The first auxiliary request was filed by the respondent with its reply to the statement of grounds of appeal and therefore did not form part of the decision under appeal.

The appellant argued, in agreement with the Board's preliminary opinion, that the first auxiliary request

should not be admitted into the appeal proceedings as, pursuant to Article 12(6), second sentence, RPBA 2020, it should have been filed during the opposition proceedings in response to the appellant's objections made in its submissions of 11 July 2019, prior to oral proceedings before the opposition division (see appellant's submissions of 15 August 2022, point II.).

- 2.2 The Board, however, is of the view that the circumstances of the present appeal case are such that the first auxiliary request can be admitted into the appeal proceedings using the Board's discretion under Article 12(4) RPBA 2020.
 - 2.2.1 In the notice of opposition, the appellant raised an objection under Article 123(2) EPC regarding the omission of the exact number of gripping units from claim 1 as granted (see notice of opposition, page 5, point 2.a)). The respondent filed a new set of claims as its main request with its reply to the notice of opposition on 19 September 2018 in which the feature objected to by the appellant was amended by the introduction of the feature of four gripping units, arranged at the vertices of a quadrilateral.
 - 2.2.2 The opposition division gave its preliminary opinion on 24 January 2019, together with the invitation to oral proceedings, that claim 1 as amended, according to the main request, overcame the appellant's objection and met the requirements of Article 123(2) EPC (see summons to oral proceedings before the opposition division, page 3, first paragraph).
 - 2.2.3 On 11 July 2019, the final date for making written submissions in accordance with Rule 116 EPC, the appellant raised objections under Article 123(2) EPC

against claim 1 of the main request, including an objection to the omission of further features from feature M4.

- 2.2.4 During oral proceedings before the opposition division, on 11 September 2019, this objection was discussed for the first time by the parties. The opposition division decided that the requirements of Article 123(2) EPC were fulfilled (see minutes of the oral proceedings, page 1, lines 18 to 37). There was therefore no requirement for the respondent to file any requests overcoming this objection during the oral proceedings before the opposition division.

Indeed, if the opposition division had found that the requirements of Article 123(2) EPC were not fulfilled it appears likely that a new request, filed in response to the new objection, would have to have been admitted (see CLB, *supra*, IV.C.5.1.4 b)).

However, as the opposition division found that the new objection did not prejudice maintenance of the patent in amended form according to the main request, the Board shares the view of the respondent that the first auxiliary request was filed at the first opportunity at which it should have been filed, namely with the respondent's reply to the appellant's statement of grounds of appeal (see respondent's submissions of 16 May 2022, page 3, final paragraph) and therefore that Article 12(6), second sentence, RPBA 2020 does not apply.

- 2.3 According to Article 12(4) RPBA 2020 in conjunction with Article 12(2) RPBA 2020, requests which were not admissibly raised and maintained in the proceedings leading to the decision under appeal are to be regarded

as amendments of a party's case and may only be admitted at the discretion of the Board.

In the present case as the first auxiliary request *prima facie* addresses the objections raised by the appellant to the main request and does not appear to give rise to new objections, the Board used its discretion and admitted the first auxiliary request into the appeal proceedings.

3. *First auxiliary request - Article 123(2) EPC - claim 1*

3.1 With the agreement of the respondent, a further objection to feature M4 which had been raised by the appellant in its statement of grounds of appeal with respect to the main request, was considered during the oral proceedings before the Board.

3.1.1 Feature M4 of both the main request and first auxiliary request contains features introduced from claim 4 as originally filed with the deletion of the word "substantially" as follows:
"four gripping units (51), arranged ~~substantially~~ at the vertices of a quadrilateral".

The opposition division found that the omission of the word "substantially" did not contravene the requirements of Article 123(2) EPC because the skilled person, when reading the application as originally filed, would understand the technical features as being the same "within the tolerances or imprecisions of the method used to manufacture the machine" (see the decision under appeal, point II.13.1.2, final paragraph).

The appellant argued during the oral proceedings before the Board that the term "substantially arranged at the vertices" explicitly did not include the teaching that the gripping units were "arranged at the vertices" and that therefore the subject-matter of claim 1 extended beyond the content of the application as originally filed (see also the appellant's statement of grounds of appeal, points II.3. and II.4.).

The Board however does not find this argument convincing as the skilled person understands the term "substantially at the vertices" in the technical context of the present case to mean that the gripping units are essentially at the vertices. That the word "substantially" may, in different contexts, take on different meanings is not relevant for the decision at hand, as the Board is convinced that the skilled person would not understand "substantially arranged at the vertices" as precluding that the gripping units are in fact arranged at the vertices.

The Board therefore follows the reasoning of the opposition division, that the skilled person, when reading the application as a whole, would understand the term "arranged at the vertices" in the same manner as "substantially arranged at the vertices", leading to no extension of the subject-matter of claim 1 beyond the content of the application as originally filed.

4. *First auxiliary request - admittance of further objections - Article 13(2) RPBA 2020*

- 4.1 During oral proceedings before the Board the appellant raised objections for the first time to claim 1 of the first auxiliary request under Articles 56, 84 and 123(2) EPC.

4.2 The respondent requested that the objections not be admitted into the appeal proceedings as they were late-filed. The appellant had not raised any objections to the set of claims according to the first auxiliary request during the written proceedings, although the request had been filed together with the respondent's reply to the statement of grounds of appeal.

4.3 According to Article 13(2) RPBA 2020 any amendment to a party's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

Therefore it has to be established whether, firstly, the appellant's appeal case has been amended and, secondly, whether exceptional circumstances justified by cogent reasons exist (see CLB, *supra*, V.A.4.5).

4.4 The appellant argued at the oral proceedings before the Board that there was no amendment to its appeal case as the objections it raised against the first auxiliary request had been raised in its statement of grounds of appeal, albeit with respect to the main request, but applying equally to the first auxiliary request.

The respondent argued that neither of independent claims 1 and 2 of the first auxiliary request was identical to claim 1 of the main request, so that it was not immediately apparent without further explanation how the same objections should apply. According to the respondent, the objections under Articles 84 and 123(2) EPC raised against feature M6.2 of the main request had been overcome by the filing of two independent claims and the introduction of a new

feature into claim 2. The inventive step objections raised in the main request, using a combination of either document D1 or D2 together with common general knowledge or document D3, clearly could not take into account the features introduced into claims 1 and 2 of the first auxiliary request. Therefore the objections constituted an amendment to the appellant's appeal case.

- 4.5 The Board notes that the first auxiliary request was filed with the respondent's reply to the statement of grounds of appeal on 6 July 2020. In the Board's communication pursuant to Article 15(1) RPBA 2020 of 18 February 2022, the Board noted that the appellant had made no submissions regarding the first auxiliary request (see point 10, last paragraph). With its submissions of 15 August 2022 the appellant raised objections relating to the admittance of the first auxiliary request into the appeal proceedings but did not raise any objections relating to the substance of the claims of the request.

The Board therefore agrees with the respondent that the appellant made no objections to the claims of the first auxiliary request during the written proceedings.

- 4.6 The Board also agrees with the respondent that it is not immediately apparent that the objections raised in the appellant's statement of grounds of appeal with respect to claim 1 of the main request can be directly applied to amended claims 1 or 2 of the first auxiliary request.

The appellant raised objections under Articles 84 and 123(2) EPC to feature M6.2 of claim 1 of the main request (statement of grounds of appeal, pages 8 and 9), which reads:

"wherein the cutting and welding device (4) may be lowered, by means of dedicated sliding means or by sliding of the positioning device (5), down to a level accessible from the ground for operators, on occasion of maintenance operations".

Both new independent claims according to the first auxiliary request contain an amended feature M6.2 so that whether the appellant's objections to the main request would also apply could not be immediately recognised without further consideration.

The appellant further argued that its objections to a lack of inventive step of the subject-matter of claim 1 of the main request were recognisably applicable to the subject-matter of claim 1 of the first auxiliary request as the newly introduced feature was described in the statement of grounds of appeal as being disclosed in document D1 (statement of grounds of appeal, page 12, first paragraph).

The Board however agrees with the appellant that it is not apparent from the statement of grounds of appeal that the newly introduced feature was known from document D1 as this feature did not form part of feature M4 according to claim 1 of the main request and was consequently not mentioned in relation to the disclosure of document D1.

4.7 Therefore the objections under Articles 56, 84 and 123(2) EPC to the claims of the first auxiliary request were raised for the first time at the oral proceedings and form an amendment to the appellant's appeal case.

The Board cannot see that any exceptional circumstances, justified by cogent reasons, are present

and the appellant did not submit any such justification.

The revised Rules of Procedure of the Boards of Appeal 2020 set out, in the interests of procedural economy while maintaining a fair procedure for all parties, a converging approach to admittance of amendments as an appeal case progresses. It is therefore not the case that objections can be raised at any stage of the appeal proceedings as argued by the appellant at the oral proceedings before the Board (see CLB, *supra*, V.A. 4.5.11 a)).

In the present case, the respondent and the Board would have had to consider the objections to the amended claims for the first time at the oral proceedings, the latest stage of the appeal proceedings, although the request objected to was submitted at the earliest stage of the appeal proceedings with the reply to the statement of grounds of appeal.

Therefore the Board decided not to admit the new objections (Article 13(2) RPBA 2020).

5. In conclusion, the decision under appeal is to be set aside as the appellant has convincingly demonstrated that the decision under appeal was incorrect and that the subject-matter of claim 1 of the main request does not fulfil the requirements of Article 123(2) EPC.

In the absence of any allowable or admissible objections to the set of claims according to the first auxiliary request, the patent is to be maintained in this amended form while setting aside the decision under appeal.

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 as amended in the following version:

Claims

Nos. 1 to 7 filed as first auxiliary request
on 6 July 2020 with the reply
to the statement setting out the
grounds of appeal.

Description

Columns 1 and 2 filed at the oral proceedings
on 16 September 2022
Columns 3 to 5 of the patent specification

Drawings

Figures 1 to 5 of the patent specification

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated