

**Internal distribution code:**

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

**Datasheet for the decision  
of 4 March 2020**

**Case Number:** T 3247/19 - 3.2.07

**Application Number:** 16190898.3

**Publication Number:** 3284687

**IPC:** B65D5/355, B65B57/10,  
B65B61/00, B65B5/02, B65D5/28

**Language of the proceedings:** EN

**Title of invention:**  
SYSTEM AND METHOD FOR AUTOMATICALLY PACKAGING ITEMS VARYING IN  
SIZE AND NUMBER FOR SHIPMENT

**Applicant:**  
Neopost Technologies

**Headword:**

**Relevant legal provisions:**  
EPC Art. 83, 111(1)  
RPBA 2020 Art. 11, 25(1)

**Keyword:**  
Sufficiency of disclosure - (yes)  
Appeal decision - remittal to the department of first instance  
(yes)

**Decisions cited:**

**Catchword:**

Special reasons within the meaning of Article 11, 1st sentence RPBA 2020 for remitting a case to the department whose decision was appealed for further prosecution (see points 8 to 12 of the Reasons)



**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 3247/19 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 4 March 2020**

**Appellant:** Neopost Technologies  
(Applicant) 42-46 Avenue Aristide Briand  
92220 Bagneux (FR)

**Representative:** CBDL Patentanwälte  
Königstraße 57  
47051 Duisburg (DE)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 26 July 2019  
refusing European patent application No.  
16190898.3 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

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

## **Summary of Facts and Submissions**

I. The appellant (applicant) filed an appeal against the decision of the examining division refusing application No. 16 190 898.3 due to the invention not being disclosed in a manner sufficiently clear and complete for it to be carried out by the skilled person as required by Article 83 EPC.

II. The appellant requested that

the appealed decision be set aside and that the case be remitted to the examining division either with an order to grant a European patent on the basis of one of the main or auxiliary requests I to V and a description to be adapted, or for further examination.

The main request and auxiliary requests I to III correspond to the requests of the contested decision, auxiliary requests IV and V were filed with the notice of appeal.

III. Independent claims 1 and 9 of the main request, filed on 6 June 2019, read:

1. A system for automatically packaging items (26, 28, 30, 32, 34) that vary in size and number for shipment, comprising

- a packaging station for holding a pre-folded cardboard box (10) to receive one or more item(s) (26, 28, 30, 32, 34) to be packaged, said pre-folded cardboard box (10) having a bottom panel (12), two side panels (14, 16) and a first end panel (24), the first end panel (24) being joined to each of said side panels (14, 16), the side

panels (14, 16) and the end panel (24) being erected from the bottom panel (12) to form a box (10) having an open top and an open side, the bottom panel (12) having an end portion intended to form a second end panel (46), each side panel (14, 16) having an end portion intended to form a corner panel (42, 44),

- at least one cutting unit for adjustably shortening the end portions of the side panels (14, 16) and the end portion of the bottom panel (12) of the pre-folded box (10),

- at least one folding unit for folding the corner panels (42, 44) and the second end panel (46) to close said open side of the box (10).

9. A method for automatically packaging items (26, 28, 30, 32, 34) that vary in size and number for shipment, comprising the following steps:

- arranging one or more more item(s) (26, 28, 30, 32, 34) to be packaged in a pre-folded cardboard box (10), said pre-folded cardboard box (10) having a bottom panel (12), two side panels (14, 16) and a first end panel (24), the first end panel (24) being joined to each of said side panels (14, 16), the side panels (14, 16) and the end panel (24) being erected from the bottom panel (12) to form a box (10) having an open top and an open side, the bottom panel (12) having an end portion intended to form a second end panel (46), each side panel (14, 16) having an end portion intended to form a corner panel (42, 44),

- depending on the dimensions of the arrangement of the one or more item(s) (26, 28, 30, 32, 34), shortening as needed the end portions of the side panels (14, 16) and the end portion of the bottom panel (12) of the pre-folded box (10),

- folding the corner panels (42, 44) and the second end panel (46) to close said open side of the box (10).

Since the present decision is taken on the basis of the main request, there is no need to reproduce the auxiliary requests.

IV. In the present decision reference is made to the following documents from the examination proceedings:

D8: EP 2 951 098 A1;  
D9: EP 2 951 011 A2;  
D10: EP 3 003 658 A1;  
D11: EP 1 827 983 A1;  
D12: EP 2 684 802 A1;  
D13: EP 1 832 413 A1;  
D14: US 2012/100976 A1;  
D15: FR 2 721 281 A1;  
D16: US 2008/020916 A1;  
D17: EP 2 812 180, the contested decision gives D17 as being EP 2 812 190, however, from the minutes to oral proceedings before the examining division, it is clear that D17, as filed, is EP 2 812 180.

The appellant filed two further documents with the statement setting out the grounds of appeal:

D18: "CO2 laser robots" from [www.kuka.com](http://www.kuka.com);  
D19: WO 2017/153825 A1.

V. The appellant argued that the skilled person, using their common general knowledge, was able to carry out the claimed invention. They provided documents D8 to D19 to substantiate their arguments which are dealt with in detail in the Reasons.

## **Reasons for the Decision**

### **Review of the decision under appeal - sufficiency of disclosure**

1. In the contested decision, the examining division decided that the application did not disclose the claimed invention in a manner sufficiently clear and complete for the person skilled in the art to carry it out.
  
2. The examining division found that there was no disclosure of a system for automatically packaging items as the application does not disclose any detailed embodiment of a system/machine. Specifically (point 1.1.1 of the Grounds for the Decision), the examining division objected to the application having insufficient information regarding the cutting unit for adjustably shortening the end portions of the side and bottom panels of the pre-folded (already erected) box. The examining division further held that the mere mention of a laser cutting unit as a possible cutting unit was not sufficient to enable the skilled person to build a system which shortens the end portions of the side and bottom panels of the open side of a pre-folded box.
  
3. The appellant argued (statement of grounds of appeal, point II.2.1) that in the penultimate paragraph of page 6 of the description, laser cutting units are given as an example of a possible cutting unit. They further argued that laser cutting of cardboard was very well known to the skilled person at the date of filing of the application, as shown by the prior art section of document D19, and that a robot laser cutter (such as shown in document D18) could, without undue effort, be

set up by the skilled person to cut the side and bottom panels of a pre-folded box.

4. According to the established case law of the boards of appeal a finding of lack of sufficiency of disclosure should be based on serious doubts, substantiated by verifiable facts (Case Law of the Boards of Appeal, 9<sup>th</sup> edition 2019, II.C.9).
  
5. The decision under appeal is essentially based on the following two findings of the examining division, *i.e.* that
  - i) a detailed embodiment was necessary for a cutting unit for a system for automatically packaging, which disclosed the invention in sufficient detail, such as how to set-up the cutting unit, how to support the pre-folded box during shortening, and how to perform an adjustable shortening of the side and bottom panels of the unstable open side of the box;
  - ii) the systems shown in documents D8 to D17 provided by the appellant were not suitable, without adaptation, for carrying out the invention.
  
- 5.1 With respect to the first point, the level of detail required is always dependent on the facts of the particular case, in particular the character of the technical field. The current application relates to a method and system for automatically packaging items by placing items in a pre-folded box having an open top and an open side, cutting the open side panels and bottom panel of the box to size and folding the side and bottom panels to close the open side of the box. From the application the skilled person can clearly understand where folds and cuts must be made in the box in order to carry out the invention. One example of a cutting unit (laser cutting) for use in a system for



automatically packaging items is given, albeit in broad terms. It is however not necessary to give further details of how to cut the box if it is clear for the skilled person in the light of common general knowledge how the cutting can be achieved.

- 5.2 With respect to the second point, according to established case law the specific teaching of a patent document is generally not regarded as forming part of the common general knowledge of the skilled person (Case Law of the Boards of Appeal, *supra*, II.C.4.1), unless the field of research is very new. In the present case the Board concludes that the field of research is not so new as to need to rely on patent documents to show common general knowledge and therefore it is not relevant whether documents D8 to D17 and D19 show systems capable of carrying out the invention or not, as they do not represent common general knowledge.

It is not known when document D18 was made available to the public and it is therefore unclear whether it can be used to show that an exemplary, commonly known laser robot existed at the effective date of the application.

6. However, in the view of the Board the common general knowledge of the skilled person regarding the cutting of cardboard boxes required for carrying out the present invention does not require substantiation through documentary evidence.

The Board considers that, in the present application, it is within the bounds of the common general knowledge of the skilled person to provide an automatic cutting unit capable of cutting cardboard in two directions. In the application the use of a laser cutting unit is suggested, however the skilled person is also generally

aware of other types of cutting units having fixed or rotary blades and suitable for cutting cardboard. Cutting units using laser cutters, fixed or rotating blades and operating transversely, longitudinally or vertically are known to the skilled person, whether they are moved via simple or complicated guide systems or carried by a manipulator such as a robot.

The setting up of a such a cutting unit and the provision of a support for a workpiece during cutting are regarded as being achievable steps for the skilled person using their common general knowledge, without needing undue experimentation.

There is no requirement that in order to carry out the invention claimed, the system is a single integrated machine with a packaging station, cutting unit and folding unit.

The skilled person on the filing date of the application therefore had sufficient information, together with their common general knowledge, to build a system and carry out a method which can automatically package items according to the claimed invention.

7. Therefore, in reviewing the decision under appeal, the Board finds that the ground for refusing the application does not hold against the main request as the appellant has convincingly demonstrated the incorrectness of the contested decision on the issue of sufficiency of disclosure.

In view of this finding, the present case is in a position to be decided on with regard to the question of insufficiency of disclosure according to Article 83 EPC, which was the sole ground for refusal mentioned in the contested decision.

**Remittal of the case to the examining division**

8. The Board notes
  - that no further requirements for patentability were mentioned or examined in the contested decision;
  - that the appellant has not presented any arguments, beyond a cursory reference to submissions made during the examination proceedings (see statement of grounds of appeal, point VIII), relating to the further requirements for patentability; and
  - that the appellant explicitly requested that the case be remitted to the examining division (see point II. above).
  
9. As there are no substantive arguments present in the appeal proceedings relating to any patentability issues other than Article 83 EPC, the Board cannot come to a decision regarding further patentability requirements on the basis of the current appeal case alone.
  
10. The Board is aware that, according to Article 11, first sentence, RPBA 2020, a remittal for further prosecution should only be undertaken, exceptionally, when special reasons apply.
  
11. Against this background, after considering all the relevant circumstances of the case at hand, the Board comes to the conclusion that the issues relevant to patentability in the present case, including but not limited to, the examination of novelty, inventive step and clarity, could not be decided upon without undue burden (cf. explanatory notes to Article 11 RPBA 2020, Supplementary publication 2 - OJ EPO 2020, 46, 54).

12. Consequently, the Board is convinced that there are special reasons within the meaning of Article 11, first sentence, RPBA 2020 that apply, and that it is appropriate to remit the present case to the examining division for further prosecution and examination of the further patentability requirements, in accordance with Article 111 (1) EPC.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated