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**Datasheet for the decision
of 23 November 2022**

Case Number: T 0758/20 - 3.2.01

Application Number: 13741981.8

Publication Number: 2884860

IPC: A24C5/32, A24D3/02

Language of the proceedings: EN

Title of invention:

ROTARY CONVEYOR DRUM FOR USE IN TOBACCO INDUSTRY MACHINES,
METHOD AND APPARATUS FOR TRANSPORTING ROD-LIKE ELEMENTS USING
SUCH DRUM AND MACHINE FOR MANUFACTURING MULTI-ELEMENT RODS

Patent Proprietor:

International Tobacco Machinery Poland Sp. z o.o.

Opponent:

G.D Società per Azioni

Headword:

Relevant legal provisions:

RPBA 2020 Art. 15a(1)

EPC Art. 123(2), 54, 56

Keyword:

Oral proceedings - before board of appeal - format by
videoconference

Amendments - allowable (no)

Novelty - auxiliary request (yes)

Inventive step - auxiliary request (yes)

Decisions cited:

G 0001/21, G 0003/98

Catchword:

Decision G 1/21 cannot be read as restricting the possibility of summoning for oral proceedings by videoconference contrary to the will of one of the parties only in the case of a general emergency. G 1/21 does not exclude that there are other circumstances specific to a case that justify the decision not to hold the oral proceedings in person.



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Case Number: T 0758/20 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 23 November 2022

Appellant: G.D Società per Azioni
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
13 March 2020 concerning maintenance of the
European Patent No. 2884860 in amended form.**

Composition of the Board:

Chairman G. Pricolo
Members: M. Geisenhofer
O. Loizou

Summary of Facts and Submissions

- I. The appeal was filed by the opponent (appellant) against the interlocutory decision of the opposition division according to which European patent No. 2 884 860, on the basis of auxiliary request 1 (then on file), met the requirements of the EPC.
- II. The opposition division decided that:
- the claimed subject-matter of auxiliary request 1 was novel and involved an inventive step over the cited prior art (Article 100(a) EPC in combination with Articles 54 and 56 EPC)
 - the patent disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC)
 - the subject-matter of the claims of this request did not extend beyond the disclosure of the application as originally filed (Article 100(c) EPC)
- III. Oral proceedings were held via videoconference before the board.
- (a) The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

With a letter dated 4 November 2022, the appellant also requested that the oral proceedings be held at the premises of the EPO, i.e. as an in-person hearing.

Furthermore, with a letter dated 14 November 2022, the appellant requested that the following question of law be submitted to the Enlarged Board of Appeal pursuant to Article 112(1)(a) EPC:

- "1) Is the discretion given to the Boards by Article 15a(1) RPBA to be exercised taking into account the findings of the Enlarged Board of Appeal under points 45-49 of the decision G 1/21, in particular by taking into consideration the reasons under which a party can be denied oral proceedings in person?
- 2) If the answer to question 1 is negative, which criteria should be applied by the Boards of Appeal when exercising the discretion according to Article 15a (1) RPBA, in particular in the case of a general emergency?
- 3) If the answer to question 1 is positive and a Board intends to hold oral proceedings in a format, such as a video conference, other than in person,
 - which criteria should be applied by the Boards, when exercising the discretion according to Article 15a (1) RPBA, for objectively assessing the question whether, in a concrete case, there are circumstances that relate to limitations and impairments affecting a party's ability to personally attend oral proceedings at the premises of the European Patent Office?
 - in particular in the case of a general emergency caused by an infectious disease, which objective criteria should be applied by the Boards to determine whether a state of pandemic exists and whether this specific state creates limitations and impairments affecting the parties' ability to attend oral proceedings in person at the premises of the European Patent Office?".

The appellant (opponent) clarified during oral proceedings that they requested that a new summons to oral proceedings in person be issued and if the Board did not concede to that then the question of law be submitted to the Enlarged Board of Appeal pursuant to Article 112(1)(a) EPC.

If the Board decided not to refer the question to the Enlarged Board of Appeal then the appellant requested that the case be discussed.

- (b) The respondent (patent proprietor) requested orally and in writing that the appeal be dismissed and that the patent be maintained in amended form based on auxiliary request 1 as upheld by the opposition division (main request), or in the alternative that the patent be maintained in amended form on the basis of one of auxiliary requests 2 - 25 filed with the reply to the appeal.

Conditionally they requested remittal to the first instance in case new facts, objections, arguments or evidence were to be admitted into the appeal proceedings.

- IV. The following documents (filed with the notice of opposition during opposition proceedings) are mentioned in the present decision:

D1 US 3 267 821 A
D3 FR 2 037 659

- V. Independent claim 1 according to the **main request** (patent as upheld by the opposition division) reads as follows:

"Rotary conveyor drum (19, 119, 219, 319, 419, 519, 59) for use in tobacco industry machines, for transferring a stream of rod-like elements (S), the drum having a first front base and a second front base and a lateral surface (20, 120, 220, 320, 420, 520, 50) onto which the rod-like elements (S) are delivered successively one by one, the lateral surface (20, 120, 220, 320, 420, 520, 50) being provided with spacer projections (22, 122, 222, 322, 422, 522, 52) forming channels therebetween in which the rod-like elements (S) are conveyed, the drum (19, 119, 219, 319, 419, 519, 59) being equipped with guiding means (21, 51) forcing the rod-like elements (S) to travel in a plane from the first front base to the second front base of the drum (19, 119, 219, 319, 419, 519, 59) during the rotation of the drum while the rod-like elements (S) are oriented substantially transversally to the spacer projections (22, 122, 222, 322, 422, 522, 52)."

Independent claim 1 of **auxiliary requests 2 and 3** is identical to claim 1 of the main request.

Independent claim 1 of **auxiliary request 4** reads as follows:

"Rotary conveyor drum (19, 119, 219, 319, 419, 519, 59) for use in tobacco industry machines, for transferring a stream of rod-like elements (S), the drum having a first front base and a second front base and a lateral surface (20, 120, 220, 320, 420, 520, 50) onto which the rod-like elements (S) are delivered successively one by one, the lateral surface (20, 120, 220, 320, 420, 520, 50) being provided with spacer projections (22, 122, 222, 322, 422, 522, 52) forming channels therebetween in which the rod-like elements (S) are conveyed, the drum (19, 119, 219, 319, 419, 519, 59) being equipped with guiding means (21, 51) forcing the

rod-like elements (S) to travel from the first front base to the second front base of the drum (19, 119, 219, 319, 419, 519, 59) during the rotation of the drum while the rod-like elements (S) are oriented substantially transversally to the spacer projections (22, 122, 222, 322, 422, 522, 52); wherein the thickness (w) of the spacer projections (22, 122, 222, 322, 422, 522, 52) decreases substantially to zero in the direction of the travel of the rod-like elements (S) in the channels (23, 123, 223, 323, 423, 523, 53)."

Independent claim 7 of auxiliary request 4 reads as follows:

"Apparatus (1, 1') for transporting a stream of rod-like elements (S) in tobacco industry machines, in which the rodlike elements (S) are transported successively one by one, the apparatus comprising at least two transfer wheels (9, 10) arranged so that the rod-like elements (S) are conveyed from one wheel (9, 10) to the other, the peripheries (9', 10') of the wheels (9, 10) being adapted to convey the rod-like elements (S) arranged one after another, characterized in that it comprises a rotary conveyor drum (19, 119, 219, 319, 419, 519, 59) having a first front base and a second front base and an axis of rotation (X) that is slanted in relation to the axis (Y) of rotation of the neighboring transfer wheel (10), and a lateral surface (20, 120, 220, 320, 420, 520, 50) provided with spacer projections (22, 122, 222, 322, 422, 522, 52) forming channels (23, 123, 223, 323, 423, 523, 53) of a constant width (D) therebetween for receiving the successive rod-like elements (S), the drum (19, 119, 219, 319, 419, 519, 59) being equipped with guiding means (21, 51) forcing the rod-like elements (S) to travel in the channels (23, 123, 223, 323, 423, 523, 53) during the rotation of the drum, the wheel (10) and

the drum (19, 119, 219, 319, 419, 519, 59) are arranged in such a way that during their rotation in opposite directions around their axes (X, Y), the drum (19, 119, 219, 319, 419, 519, 59) receives the successive rod-like elements (S) from the periphery (10') of the wheel (10) into the successive channels (23, 123, 223, 323, 423, 523, 53) of its lateral surface (20, 120, 220, 320, 420, 520, 50), the rod-like elements (S), oriented substantially transversally to the spacer projections (22, 122, 222, 322, 422, 522, 52) being conveyed along these channels (23, 123, 223, 323, 423, 523, 53) during the rotation of the drum, the thickness (w) of the spacer projections (22, 122, 222, 322, 422, 522, 52) varying along the channels (23, 123, 223, 323, 423, 523, 53)."

Independent claim 18 of auxiliary request 4 reads as follows:

"Method of transporting a stream of rod-like elements (S) in the tobacco industry machines, in which the rod-like elements (S) are transported successively one by one on the peripheries (9', 10') of at least two transfer wheels (9, 10), the rod-like elements (S) being arranged one after the other, characterized in that the successive rod-like elements (S) are subsequently transferred onto a rotary conveyor drum (19, 119, 219, 319, 419, 519, 59) having a first front base and a second front base and a lateral surface (20, 120, 220, 320, 420, 520, 50) provided with spacer projections (22, 122, 222, 322, 422, 522, 52) forming channels (23, 123, 223, 323, 423, 523, 53) for receiving the successive rod-like elements (S) that are conveyed one by one during the rotation of the drum (19, 119, 219, 319, 419, 519, 59), on the lateral surface (20, 120, 220, 320, 420, 520, 50) and along the channels (23, 123, 223, 323, 423, 523, 53), the rod-

like elements (S) travelling from the first front base to the second front base of the drum (19, 119, 219, 319, 419, 519, 59) during the rotation of the drum being oriented substantially transversally to the spacer projections (22, 122, 222, 322, 422, 522, 52) and in that the distances (d) between the successive rod-like elements (S) are changed during their travel on the lateral surface (20, 120, 220, 320, 420, 520, 50)."

- VI. The appellant put forward the following arguments on whether holding oral proceedings as a videoconference can be imposed on the parties without their consent.
- (a) Holding oral proceedings in person was the gold standard set out in G 1/21. The parties had a right to the gold standard and hence were not obliged to give reasons when requesting oral proceedings in person. Only when deviating from the gold standard did reasons need to be given.
 - (b) There was a "*tension*" between the discretionary power granted to the boards by Article 15a(1) RPBA 2021, which contained no indication of any limits to the exercise of that power, and the more limited discretion afforded to the boards by the decision G 1/21, leading to legal uncertainty for the parties.
 - (c) The criteria to be used when deciding on the form of the oral proceedings were defined by G 1/21 and were the following.
 - (i) A general emergency was required as a prerequisite to force the parties to accept oral proceedings by videoconference contrary to their will.

This prerequisite was no longer present since the COVID-19 pandemic ceased to prevail (decreasing number of infections, no travel restrictions in force and no quarantine obligation).

(ii) Furthermore, only reasons that effectively limited and impaired a party from appearing in person at the oral proceedings counted. The abstract possibility of an infection was not sufficient reason.

(d) The case was unsuitable to be dealt with by videoconference because a discussion on the disclosure of Figures 4, 5 and 6 of the originally filed application required pointing to these figures and providing free-hand sketches.

VII. The appellant supported its request to submit a question of law on whether oral proceedings could be held by videoconference pursuant to Article 15a(1) RPBA 2020 without consent of the parties to the Enlarged Board of Appeal with the following arguments.

(a) The board deviated from the conclusions of the Enlarged Board of Appeal in G 1/21 by deciding that although no travel restrictions were in place, oral proceedings by videoconference could be held without the appellant's consent to this format.

(b) There were diverging views in the evaluation by a number of different boards of comparable factual circumstances (e.g. the number of infections in Munich) when taking a decision on whether to hold oral proceedings by videoconference, and this led

to legal uncertainty. Furthermore, the principle of equal treatment and the right of parties to a fair trial obliged the boards to decide the individual cases pending before them according to uniformly applied criteria and not in an arbitrary manner.

- (c) This legal uncertainty required the Enlarged Board of Appeal's clarification on the criteria to be applied by the boards when exercising their discretion on the format of the oral proceedings.
- (d) Since the question of whether oral proceedings could be held by videoconference without the consent of a party concerned a large number of cases, this was a point of law of fundamental importance which justified submitting the question to the Enlarged Board of Appeal.

VIII. The appellant's arguments on the patentability of the patent in suit can be summarised as follows.

- (a) Claim 1 of the **main request** was unallowably amended since the originally filed application lacked a disclosure of the feature "*guiding means are forcing the rod-like elements to travel in a plane*".
- (b) **Auxiliary requests 2 and 3** comprised in claim 1 the same feature and hence were also unallowably amended.
- (c) The subject-matter of claim 1 of **auxiliary request 4** lacked an inventive step over D1.

Starting from D1 as closest prior art, the skilled person would have - due to their general

knowledge - inverted the spacer projections of the drum shown in Figure 7 of D1 such that their thickness decreased in the direction of travel of the rod-like elements when the intention was to eliminate any spaces between the rod-shaped elements.

- (d) The subject-matter of claim 7 of auxiliary request 4 lacked novelty over D3.

The claim required neither that both transfer wheels were provided upstream of the conveyor drum nor that the apparatus transported the rod-shaped element transversally to the spacer projections. The apparatus only needed to be suitable for transporting articles (with the articles themselves not forming part of the apparatus) in such an orientation.

- (e) The subject-matter of claim 18 of auxiliary request 4 was rendered obvious starting from D1.

The skilled person would have added an additional transfer wheel upstream of the drum to allow for quality check of the rod-shaped elements. This was part of the general knowledge of the skilled person not disputed by the respondent until oral proceedings before the board. This objection of the respondent should hence not be admitted.

- (f) This line of argument under inventive step was the logical continuation of the novelty attack raised in opposition proceedings and hence should be admitted.

- IX. The respondent gave its consent to the oral proceedings being held by videoconference with a letter dated 24 October 2022. It did not comment on the question of law to be submitted to the Enlarged Board of Appeal.
- X. The respondent's arguments on the patentability of the patent in suit can be summarised as follows.

(a) The feature "*guiding means are forcing the rod-like elements to travel in a plane*" in claim 1 of the **main request** could be derived from the figures taking into consideration the passages of the description on pages 11 - 15 on the path of the rod-like elements through the apparatus.

(b) The same applied to **auxiliary requests 2 and 3**.

(c) The subject-matter of claim 1 of **auxiliary request 4** was not rendered obvious by a combination of D1 with the general knowledge of the skilled person.

There was no motivation for the skilled person to eliminate spaces between the rod-shaped elements using the drum of Figure 7 since, as shown in Figure 6, this was achieved in D1 by the worm wheel 44 downstream of the drum. On the contrary, the drum was used to create a defined space between the rod-shaped elements C1 to introduce the components C2 in between them.

(d) The subject-matter of claim 7 was novel over D3.

The apparatus of D3 was neither intended nor suitable for conveying rod-shaped elements transversally to the spacer projections. Furthermore, claim 7 required that the at least two

transfer wheels be arranged in succession and before the drum.

- (e) The subject-matter of claim 18 was not rendered obvious by the combination of D1 with the general knowledge of the skilled person.

There was no reason to provide quality control before combining the components C1 and C2 in D1.

Furthermore, it was disputed that it was part of the general knowledge of the skilled person that a quality check required at least two transfer wheels. The appellant did not provide evidence of this allegation.

- (f) This line of argument should not be admitted since it had neither been dealt with in the appealed decision nor raised by the appellant in opposition or appeal proceedings.

Reasons for the Decision

Format of the oral proceedings

1. The board decided of its own motion to hold the oral proceedings by videoconference pursuant to Article 15a(1) RPBA 2020.
- 1.1 Article 15a(1) RPBA 2020 reads as follows:
"The board may decide to hold oral proceedings by videoconference if the board considers it appropriate to do so, either upon request by a party or of its own motion."

1.2 From the expression "if the board considers it appropriate", it is evident that the board has discretion to decide whether to hold oral proceedings by videoconference.

The provision does not set criteria to be applied when exercising this discretionary power. Nor does this provision require the consent of the parties.

1.3 The board considered it appropriate to hold the oral proceedings by videoconference.

1.3.1 To arrive at this conclusion when exercising its discretion, the board considered the following circumstances.

1.3.2 Before deciding the format of the oral proceedings, the board informed the parties that it intended to hold the oral proceedings by videoconference in view of the increasing number of COVID-19 infections and because the case appeared suitable for being dealt with in a videoconference (see communication dated 20 October 2022). At the same time, the board asked the parties whether they had any reasons why the oral proceedings should not be held by videoconference or why a hearing in person was required.

The respondent explicitly gave its consent to holding the oral proceedings by videoconference (see letter dated 24 October 2022).

The appellant disagreed. The reasons put forward by the appellant against holding oral proceedings by videoconference were, however, not convincing for the following reasons.

- (i) Contrary to the appellant's allegation, the COVID-19 pandemic was ongoing at the date of the oral proceedings before the board. On the day of the oral proceedings, there were still access restrictions in place for the premises of the boards in Haar (obligation to test prior to entering the premises and wear face masks within the premises) that could hinder a party or a member of the board from attending oral proceedings in person.

Holding oral proceedings by videoconference avoided the risk that a participant of the oral proceedings might, on quite short notice before the oral proceedings (or even on the very same day), be barred from attending them.

It is true that general travel restrictions being applied within the host country or the countries of the parties would be a clear indication that oral proceedings should be held by videoconference. However, the absence of such travel restrictions is not a clear indication that oral proceedings must therefore be held in person. The board still has the discretion to decide on the form of the oral proceedings.

A further aspect to be taken into account was the risk for the parties and the members of the board of being infected, irrespective of whether the probability of an infection was low or near to certainty.

The appellant argued that the absolute number of infections in the region of Munich but also the incidence of infections was low at the date of the oral proceedings.

The board takes the view that it is not possible to objectively define a threshold for the number of infections (or for any other parameter) below which it would be acceptable to expose the parties or the members of the board to the virus. The board is not empowered to force a participant to participate in oral proceedings in person against their will and contrary to their belief that they would be at risk of being infected during oral proceedings or while travelling to and from the board's premises.

- (ii) The current case required an examination of the objections raised regarding the disclosure of the application as originally filed, novelty and inventive step.

Proceedings before the EPO are mainly in writing and are complemented where necessary by oral proceedings as an opportunity for a party to present and argue its case (see Reasons 40 of G 1/21). Since all pieces of relevant prior art were printed documents available on the databases of the EPO and no particular difficulties were apparent, such as particular complexities or, for example,

models to be inspected during the oral proceedings, the board saw no reason why a videoconference was not suitable for dealing with this case.

- (iii) The appellant submitted that a discussion of the allegations of the opposition division in the impugned decision would require that three drawings, namely Figures 4, 5 and 6 of the application as filed, be examined in combination. The discussion would also require an examination of all possible paths that the rod-like elements could follow when moving across the machine of Figure 4 and in the cross-sections of Figures 5 and 6 to establish whether such paths all lied exclusively in one plane. The parties may thus need to illustrate and exemplify such paths by referring to the three drawings in combination, possibly with the aid of sketches. The software (Zoom) used for conducting oral proceedings by videoconference did not allow the simultaneous presentation of multiple figures of the patent. This would be necessary for discussing the opposition division's combined readings of Figures 4 to 6. Furthermore, the free-hand drawing of sketches on the "whiteboard" would be extremely awkward and impractical.

Firstly, the board notes that although it may be convenient for parties to present figures and to make free-hand sketches during oral proceedings, it would be more appropriate to provide such figures and

sketches in advance of the oral proceedings so that the board and the other party(ies) are informed in advance of the content of the presentation.

Moreover, the board cannot see why it would be possible to look at three different figures of the application as filed when oral proceedings are conducted in person but not when oral proceedings are conducted by videoconference. If the appellant's point was that during in-person oral proceedings the figures could be attached to a whiteboard and thus shown in combination, with free-hand sketches being drawn while looking at all of them simultaneously, the board still fails to see why this (i.e. the figures in combination and the sketches) - which in effect corresponds to a written rather than an oral presentation - could not be provided in writing in advance of the oral proceedings.

In any case, the Zoom software used for the videoconferences allows screen sharing with all participants. It is thus possible to display figures and even handmade sketches (which have to be scanned in advance) and share them with all participants of the oral proceedings.

Furthermore, it is possible to file these figures and sketches by email for them to be distributed by the board to the other participants of the oral proceedings.

The appellant actually used both options during oral proceedings and confirmed that it did not experience any technical problems when doing so.

When screen sharing, it is furthermore possible to point to details of the shared view using the mouse pointer.

- (iv) The appellant also observed that one of its lines of argument was based on a set of equations discussed in the statement of grounds of appeal with reference to two reference frames, illustrated in a drawing. According to the appellant, a discussion of that line of argument and the proprietor's counter arguments, some of which cast doubt on the geometrical accuracy of the reference frames chosen by the appellant, could only be meaningfully conducted if the parties were allowed to expound and develop their submissions with the help of the drawing presented in the grounds, possibly with the further aid of sketches made on that drawing.

The board is, however, not convinced as it is not apparent why a discussion on these mathematical equations could only be meaningfully carried out with the help of sketches and drawings being produced at the oral proceedings before the board, like a teacher explaining a mathematical equation to students, as the board has technical competence and knowledge of the case. A

reference to a sketch or scheme produced in writing is more than sufficient and, moreover, the videoconferencing software allows screen sharing, as explained above.

- 1.4 The appellant also referred to decision G 1/21 and submitted that in view of this decision, a party wishing to choose the in-person format for oral proceedings should not be obliged to provide any justification for this choice because, in accordance with that decision, oral proceedings in person should be the default option, i.e. the rule, and the party that requested oral proceedings - not the board - can choose the format.
- 1.4.1 Firstly, the current board does not interpret G 1/21 to mean that it is for the party that requested oral proceedings to choose the format of the oral proceedings. On the contrary, the format of the oral proceedings lies at the discretion of the board.
- 1.4.2 In decision G 1/21, points 47 to 50 of the Reasons, the Enlarged Board of Appeal stated:
- "47. As for the reasons that could justify denying a party its wish to have the oral proceedings held in person, the Enlarged Board makes the following observations.*
- 48. Firstly, there must be a suitable, even if not equivalent, alternative. As explained above, the Enlarged Board holds the view that a videoconference normally provides the basic conditions for an opportunity to be heard and to present a case. If in a particular case a videoconference is not suitable, the oral proceedings will need to be held in person. In the*

case underlying the referral, the Board expressed the view that the reasons brought forward why a videoconference would not be suitable for this particular case were not convincing. There was thus, in the Board's assessment, a suitable alternative which could be used to bring the appeal case to a conclusion.

49. Secondly, there must also be circumstances specific to the case that justify the decision not to hold the oral proceedings in person. These circumstances should relate to limitations and impairments affecting the parties' ability to attend oral proceedings in person at the premises of the EPO. In the case of a pandemic, such circumstances could be general travel restrictions or disruptions of travel possibilities, quarantine obligations, access restrictions at the EPO premises, and other health-related measures aimed at preventing the spread of the disease. This decision should not be influenced by administrative issues such as the availability of conference rooms and interpretation facilities or intended efficiency gains. It is the EPO's responsibility to make available the necessary resources for facilitating the conduct of proceedings provided for in the EPC.

50. Thirdly, the decision whether good reasons justify a deviation from the preference of a party to hold the oral proceedings in person must be a discretionary decision of the board of appeal summoning them to the oral proceedings."

- 1.4.3 Accordingly, in accordance with G 1/21, the decision on whether good reasons justify a deviation from the preference of a party to hold the oral proceedings in person is a discretionary decision of the board summoning it to the oral proceedings. It is not the

party, therefore, that chooses the format of the oral proceedings.

Although in point 46 of G1/21 it is stated that it *"makes sense that the choice of format for these oral proceedings can be made by the party who requested them and not by the board of appeal, especially as this concerns more than just an organisational matter"*, still this, in the Board's view, cannot be understood as implying that the choice is solely in the hands of the party, because otherwise the Board would have no discretion and this would be in contradiction with point 50 of G1/21. Moreover the Enlarged Board of Appeal although it used the wording "it makes sense" in point 46 did not specify that the choice of format for the oral proceedings shall be made only by the party.

- 1.4.4 Furthermore, the Enlarged Board of Appeal's order in G 1/21 reading: *"During a general emergency impairing the parties' possibilities to attend in-person oral proceedings at the EPO premises, the conduct of oral proceedings before the boards of appeal in the form of a videoconference is compatible with the EPC even if not all of the parties to the proceedings have given their consent to the conduct of oral proceedings in the form of a videoconference"*, cannot, in view of above-cited point 49 of the Reasons, be read as restricting the possibility of summoning for oral proceedings by videoconference contrary to the will of one party to only when there is a general emergency, as argued by the appellant-opponent. The order does not exclude that there are other circumstances specific to the case that justify the decision not to hold the oral proceedings in person.

1.4.5 As regards the circumstances that justify in the current case the decision not to hold the oral proceedings in person, these are explained above. In particular, access restrictions at the EPO premises in Haar were still in force.

1.4.6 Finally, it has also been explained above why a videoconference was suitable in the case at hand. Accordingly, the three criteria mentioned in points 47 to 50 of G 1/21 are met.

Hence, the board sees no conflict with G 1/21.

1.4.7 Irrespective of this, the board also considered whether in the current case holding oral proceedings by videoconference could be considered an equivalent alternative to holding oral proceedings in person, even having regard to G 1/21, in which in-person oral proceedings are stated to be the gold standard (see point 45 of the Reasons).

(a) Firstly, decision G 1/21 was taken after the Enlarged Board of Appeal limited the scope of the referral and reformulated the referred question:
"Is the conduct of oral proceedings in the form of a videoconference compatible with the right to oral proceedings as enshrined in Article 116(1) EPC if not all of the parties to the proceedings have given their consent to the conduct of oral proceedings in the form of a videoconference?"

to:

"During a general emergency impairing the parties' possibilities to attend in-person oral proceedings at the EPO premises, is the conduct of oral proceedings before the boards of appeal in the form of a videoconference compatible with the EPC if not

all of the parties have given their consent to the conduct of oral proceedings in the form of a videoconference?".

- (b) Furthermore, this decision was issued when the boards had had little experience with the software tools used for videoconferencing. As set out in G 1/21, point 46, *"at this point in time videoconferences do not provide the same level of communication possibilities as in-person oral proceedings"*.

Since then, the situation has changed, and the boards but also the parties have had extensive experience with videoconferences and the tools involved. The technical requirements were met on the board's side but also on the side of the representatives to allow for stable videoconferences with high-quality picture and sound such that holding oral proceedings by videoconference is no longer disadvantageous compared to the gold standard as it was when decision G 1/21 was taken.

On the contrary, in the board's view, nowadays oral proceedings held by videoconference are often equivalent to a hearing in person. This applies to the current case when using the available videoconference technology as the case involved no particular complexities and there were no limitations on the interaction between the parties and the board or on the opportunity for the parties to argue their cases.

Therefore, the board concludes that even in view of decision G 1/21, oral proceedings by

videoconference was in this case not only suitable but also represented an equivalent alternative to in-person oral proceedings.

- 1.4.8 Finally, the board notes that at the outcome of the oral proceedings, the appellant's representative confirmed that he had no objections based on the right to be heard and that the videoconferencing technology functioned properly.

Referral to the Enlarged Board of Appeal

2. Under Article 112(1)(a) EPC, a referral of questions to the Enlarged Board of Appeal is only admissible if a decision is required to ensure uniform application of the law or if an important point of law of fundamental importance arises. The answer to the referred question should not be merely of theoretical or general interest but has to be essential for reaching a decision on the appeal in question (see, for example, G 3/98 (OJ EPO 2001, 62), Reasons No. 1.2.3; see also Case Law of the Boards of Appeal, tenth edn., V.B.2.3.3).

Under Article 21 RPBA 2020, a question is to be referred to the Enlarged Board of Appeal if the referring board considers it necessary to deviate from an interpretation or explanation of the Convention contained in an earlier opinion or decision of the Enlarged Board of Appeal.

- 2.1 In light of the above reasoning, the request for referral must be refused. Firstly, the board does not see any deviation from decision G 1/21. Secondly, the board does not consider the question to be essential for the board to reach a decision in the current case.

Although it can be argued that important points of law are relevant to this appeal, the posed question does not warrant a referral to the Enlarged Board of Appeal since the board has no doubt, in particular taking into account G 1/21, that in the current circumstances it has discretion to decide to hold oral proceedings by videoconference, even without the consent of the appellant.

- 2.2 Finally, the appellant's desire to have clear criteria determined by the Enlarged Board of Appeal on how the boards should exercise their discretion is partly incompatible with the concept of judicial discretion itself.

Whenever a board is given judicial discretion by the law, it is up to the board to exercise its discretion based on its individualised evaluation, guided by the principles of law, of the case's circumstances rather than follow a rigid application of the law according to preset criteria. Clearly, discretionary decisions should not be arbitrary. They evolve over the years of practice of the boards and as a result of the development of case law. In any case, a list of criteria cannot be exhaustive as the circumstances of each case still determine the exercise of the discretion.

Patentability of the patent in suit

Main request

Amendments (Article 123(2) EPC)

3. The opposition division held that the amendments to claim 1 of the main request comply with the requirements of Article 123(2) EPC.

3.1 Claim 1 according to the main request is based on originally filed claim 1 where the expression:

"guiding means forcing the rod-like element to travel from the first front base to the second front base of the drum"

is amended to read:

"guiding means forcing the rod-like element to travel in a plane from the first front base to the second front base of the drum"

3.2 This amendment lacks disclosure in the application as originally filed, contrary to the decision of the opposition division.

3.2.1 The path of the rod-like elements is not specified in the originally filed description or the originally filed claims, in particular it is not specified that the path is *"in a plane"*.

3.2.2 Figures 5 and 6 are cuts through the conveyor drum but do not disclose the path of the rod-like elements on the drum either.

Figure 5 discloses a rod-like element (S) in a position where it is transferred from the conveyor drum to the collecting conveying device (31), which is referred to

as point D. Figure 6 discloses another element (S) being transferred from the transfer wheel (10) to the conveyor drum at point C. However, neither Figure 5 nor Figure 6 show the path of the elements on the drum since in both figures that path is on the hidden side of the drum.

3.2.3 Figure 4 in turn is a view of the drum and the transfer wheels representing the drum in perspective view. The path of rod-like elements is represented in this figure, but it is not possible to derive any information on the geometry of the path on the drum since the perspective view is distorted.

3.2.4 The passages cited by the respondent on pages 11 - 15 do not provide any information on the geometry of the path between point C and point D or the shape of the guiding means forcing the rod-like elements to follow this path. They only confirm the information that could be derived from Figures 5 and 6 as set out above.

3.3 Although it is plausible that the path shown in Figure 4 is in a plane with the conveyors (30, 31) and the transfer wheels (9, 10), it cannot be excluded that the path deviates from this plane defined by conveyors and transfer wheels.

A suitable basis for the feature "in a plane", however, requires that the technical information be clearly and unambiguously derivable from the originally filed application documents, and this cannot be acknowledged.

3.4 The main request, hence, does not comply with the requirements of Article 123(2) EPC. The opposition division's decision is therefore to be set aside.

Auxiliary requests 2 and 3

4. Claim 1 of auxiliary requests 2 and 3 is identical to claim 1 of the main request and therefore does not comply with the requirements of Article 123(2) EPC for the reasons set out for the main request.

Auxiliary request 4

Claim 1

5. The appellant alleged that the subject-matter of claim 1 lacked an inventive step over document D1 combined with the general knowledge of the skilled person (Article 56 EPC).
 - 5.1 It is undisputed between the parties that D1 discloses in Figure 7 a rotary conveyor drum with a first front base, a second front base and a lateral surface (61), the lateral surface being provided with spacer projections forming channels ("flutes") in which the rod-like elements are conveyed. The drum is further equipped with guiding means (casing 62 with internal rib 64) forcing the rod-like elements to travel from the first front base to the second front base of the drum during the rotation of the drum while the rod-like elements are oriented substantially transversally to the spacer projections (see column 7, starting in line 39).

As can be seen in Figure 7 and described in column 8, lines 1 and 2, the thickness of the spacer projections increases in the direction of the travel of the rod-like elements in the channels.

5.2 The subject-matter of claim 1 differs from this in that the thickness of the spacer projections decreases substantially to zero in the direction of travel. This is also undisputed by the parties.

5.2.1 Contrary to the appellant's argument, the board sees no reason why the skilled person should seek to push the rod-shaped element in D1 together using the drum of Figure 7. On the contrary, the drum of D1 provides in the apparatus shown in Figure 6 a controlled distance between subsequent rod-shaped elements C1 to allow for insertion of components C2 in between. The space between two rod-like elements C1 hence cannot be reduced to substantially zero but must correspond at least to the length of the component C2.

5.2.2 Furthermore, the apparatus of D1 uses a different means to push successive components together: as set out in column 6, lines 62 - 67, a worm wheel 44 is used to push components C1 and C2 together.

If the skilled person thus seeks a means to reduce the space between successive components, they would use a worm wheel but would not consider modifying the drum of Figure 7.

5.2.3 There is hence no identifiable motivation for inverting the spacer projections such that their thickness decreases substantially to zero in the direction of travel of the rod-like elements.

5.3 The subject-matter of claim 1 is hence not rendered obvious by a combination of document D1 with the general knowledge of the skilled person and therefore complies with Article 56 EPC.

Claim 7

6. The appellant alleged that the subject-matter of claim 7 lacked novelty over document D3 (Article 54 EPC).

6.1 It is undisputed between the parties that D3 in Figure 1 discloses an apparatus for transporting a stream of rod-like elements (Z1) successively one by one. The apparatus comprises at least two transfer wheels (1, 9) and a rotary conveyor drum (4) having a first front base, a second front base and an axis of rotation (7) slanted compared to the axis of rotation of the neighbouring transfer wheel, and a lateral surface provided with spacer projections forming channels (6) of a constant width between them for receiving the successive rod-like elements.

The drum is equipped with a guiding means (page 3, lines 34 - 39: using an air current) forcing the rod-like elements to travel in the channels during the rotation of the drum. The wheel and the drum are arranged in such a way that during their rotation in opposite directions around their axes, the drum receives the successive rod-like elements from the periphery of the wheel in the successive channels of its lateral surface, the rod-like elements being conveyed along these channels during the rotation of the drum, the thickness of the spacer projections varying along the channels (see Figure 1).

6.2 It is, however, disputed whether the transfer wheels are arranged so that the rod-like elements are conveyed from one wheel to the other, the peripheries of the wheels being adapted to convey the rod-like elements arranged one after another.

6.2.1 The appellant argues that the transfer wheels (1, 9), albeit separated by the conveyor drum (4), form part of the same transport line such that a rod-like element necessarily passes over both transfer wheels.

6.2.2 However, the rod-like elements are in the board's view not conveyed in D3 from one wheel to the other since the conveyor drum is arranged between the transfer wheels. The expression "*from one wheel to the other wheel*" implies in conjunction with the verb "*to convey*" that there is a direct transfer from one wheel to the other wheel.

The rod-like elements are conveyed in D3 from the transfer wheel (1) to the conveyor drum (4) and - in a consecutive, independent step - from the conveyor drum (4) to the second transfer wheel (9) but not (directly) from one transfer wheel to the other transfer wheel.

6.3 It is further disputed whether the rod-like elements are oriented substantially transversally to the spacer projections when being conveyed along the channels of the drum.

6.3.1 The appellant argues that claim 7 defines an apparatus where the feature in suit refers only to the suitability of the apparatus to convey the elements in transversal orientation. Since sufficiently small rod-like elements such as filter segments can be transported through the channels of the conveyor drum of D3 in a transversal orientation to the spacer projections, the apparatus of D3 would also fall under the wording of claim 7.

6.3.2 In the board's view, the channels of the conveyor drum are not suitable for use with rod-like elements having a length less than the width of the channels - this being necessary to allow transport in the transversal orientation. Such small elements conveyed by a stream of air as in D3 would tumble around within the channel, making it impossible to convey them in a controlled way at the end of the channel from the conveyor drum to the downstream transfer wheel.

6.4 The subject-matter of claim 7 is hence novel over D3 and therefore complies with the requirements of Article 54 EPC.

7. The appellant did not submit arguments on inventive step for claim 7 of auxiliary request 4.

Claim 18

8. The appellant alleged that the subject-matter of claim 18 lacked an inventive step over document D1 combined with the general knowledge of the skilled person (Article 56 EPC).

8.1 It is undisputed between the parties that D1 discloses a method of transporting a stream of rod-like elements in tobacco industry machines in which the rod-like elements are transported from a transfer wheel (60) to a rotary conveyor drum (61) as shown in Figure 6 of D1.

The rotary conveyor drum (shown in detail in Figure 7) has a first front base, a second front base and a lateral surface provided with spacer projections forming channels for receiving the successive rod-like elements that are conveyed one by one during the rotation of the drum on the lateral surface and along

the channels. The rod-like elements travelling from the first front base to the second front base of the drum during the rotation of the drum are oriented substantially transversally to the spacer projections.

It is also undisputed that the distances between the successive rod-like elements are varied during their travel on the lateral surface.

- 8.2 It is further undisputed by the parties that the subject-matter of claim 18 differs from the method known from D1 in that instead of the single transfer wheel (60) used in D1, two consecutive transfer wheels are used that allow the rod-like elements to be transported successively one by one on the peripheries of the two transfer wheels and then on the drum.
- 8.3 The appellant argues that the skilled person would add an additional transfer wheel before the existing transfer wheel (60) of D1 and after the cutter (58) to allow for quality check of the component C1 cut from the endless sling R1.
- 8.4 There is, however, no teaching available that would suggest to the skilled person to put a quality check point involving an additional transfer wheel between the cutter and the conveyor drum in D1. This does not belong to the general knowledge of the skilled person either, nor was evidence provided by the appellant for this.
- 8.4.1 On the contrary, it appears not expedient to provide quality check at that position since the delivering of the components C1 is synchronised with the stream of components C2. A quality check at the position suggested by the appellant hence would not encompass

components C2 such that additional quality check would be needed for components C2 before uniting both components.

- 8.4.2 Even if the skilled person added quality check after the cutter and before the conveyor drum in D1, there is still no reason to provide two transfer wheels for this quality check point instead of the existing one transfer wheel.

The appellant alleged that an additional transfer wheel would provide more time for deciding on the quality of the component before removing it from the production line.

However, the machines used in the tobacco industry work at high velocities such that an additional wheel to lengthen the path of the components is not necessary to provide time for deciding on the quality of the component.

- 8.4.3 The subject-matter of claim 18 is thus not rendered obvious and therefore complies with the requirements of Article 56 EPC.

- 8.5 It hence can remain undecided whether this line of argument can be admitted into the proceedings.

9. No further lines of argument for the claims of auxiliary request 4 were raised by the appellant.

10. The description was adapted to the wording of the claims of auxiliary request 4, with the appellant not raising any objection.

11. The patent can thus be maintained based on auxiliary request 4.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to maintain the patent in amended form on the basis of the following:

Description:

Columns 1-10 filed during oral proceedings by email at 15:16 (annex 5).

Claims:

No 1-24 of the auxiliary request 4, as filed with the reply to the statement of grounds of appeal, dated 27 October 2020.

Drawings:

Fig. 1 - 16b of the patent as granted.

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated