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**Datasheet for the decision
of 5 May 2023**

Case Number: T 0948/21 - 3.2.07

Application Number: 15767302.1

Publication Number: 3188986

IPC: B65D85/10

Language of the proceedings: EN

Title of invention:
PACKET OF SMOKE ARTICLES

Patent Proprietor:
G.D S.p.A.

Opponent:
Focke & Co. (GmbH & Co. KG)

Headword:

Relevant legal provisions:
EPC Art. 100(a), 54
EPC R. 139
RPBA 2020 Art. 11, 13(2)

Keyword:

Correction of error - immediately evident that nothing else
could have been intended (no)

Novelty - main request (no)

Remittal - special reasons (yes)

Decisions cited:

G 0011/91



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Case Number: T 0948/21 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 5 May 2023

Appellant: Focke & Co. (GmbH & Co. KG)
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 22 April 2021
rejecting the opposition filed against European
patent No. 3188986 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman B. Paul
Members: S. Watson
Y. Podbielski

Summary of Facts and Submissions

- I. An appeal was filed by the opponent against the decision of the opposition division rejecting the opposition against European patent No. 3 188 986.
- II. The opposition division found that none of the objections raised by the opponent prejudiced the maintenance of the patent as granted.
- III. In preparation for oral proceedings, the Board gave its preliminary opinion in a communication pursuant to Article 15(1) RPBA 2020, which took into account the opponent's statement of grounds of appeal, the patent proprietor's reply to the appeal and the opponent's rejoinder of 22 April 2022.
- IV. The patent proprietor responded to the Board's preliminary opinion with submissions of 3 May 2023.
- V. Oral proceedings before the Board took place on 5 May 2023. At the conclusion of the proceedings the decision was announced. Further details of the oral proceedings can be found in the minutes.
- VI. The final requests of the parties are as follows:

The opponent (appellant) requests
 - that the decision under appeal be set aside; and
 - that the patent be revoked
 - or alternatively that the case be remitted to the opposition division for further prosecution.

The patent proprietor (respondent) requests

- a correction of claim 1 and paragraph [0016] of the patent as granted under Rule 139 EPC,
- that the appeal be dismissed, i.e. the patent be maintained as granted, or
- that the case be remitted to the opposition division for further prosecution based on the first to seventh auxiliary requests filed with the reply to the statement setting out the grounds of appeal.

VII. The following document is referred to in this decision:

D1: DE 23 27 294 A1.

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

IX. Independent claim 1 of the patent as granted reads as follows (with the feature labelling used by the appellant):

1. Packet (1) of smoke articles, comprising:
 - 1.1 a container (2), which has a parallelepiped shape and has a front wall (9), a rear wall (10), a bottom wall (8) and two lateral walls (11);
 - 1.2 a parallelepiped-shape inner wrapper (3) that wraps a group of smoke articles, which is housed inside the container (2) and has a front wall (17), a rear wall (18), a top wall (15), a bottom wall (16) and two lateral walls (19);
and
 - 1.3 a separating element (20), which is arranged inside the inner wrapper (3) and divides the inner volume of the inner wrapper (3) so as to

form several partitions of the group of smoke articles;

1.4 wherein the separating element (20) comprises a separating wall (21) that separates the inner volume of the inner wrapper (3) into two chambers (22) each containing a respective partition of the group of smoke articles;

1.5 wherein the separating wall (21) comprises a longitudinal edge resting on and fixed to the front wall (17), or to the rear wall (18), of the inner wrapper (3),

the packet (1) of smoke articles is characterised in that

1.6 the separating element (20) is formed by a single separating wall (21) which constitutes the border between the two chambers (22).

X. In view of the decision taken, it is not necessary to reproduce the independent claims of the auxiliary requests here.

Reasons for the Decision

1. *Request for correction under Rule 139 EPC*

1.1 With its submissions of 3 May 2023 the respondent requested that claim 1 and paragraph [0016] of the patent as granted be corrected by replacing the word "formed" with the word "constituted" in the following phrase:

the separating element (20) is ~~formed~~ constituted by a single separating wall (21).

The respondent argued that there was an obvious error in the translation of the Italian phrase "*è costituito da*" as used in the application as filed. This had been translated as "is formed by", but the skilled person would recognise there was a translation error as "formed by" related only to groups of people (see respondent's submissions of 3 May 2023, page 6, point 1.3).

The skilled person would recognise that the term "is constituted by" expressed the meaning intended in the original Italian application (see respondent's submissions of 3 May 2023, point 1.1 and page 10, second and third complete paragraphs).

The respondent confirmed at the oral proceedings before the Board that it requested a correction under Rule 139 EPC and did not request that the translation be brought into conformity with the original application according to Article 14(2), second sentence, EPC.

- 1.2 In order for a correction to the description, claims or drawings to be allowable under Rule 139, second sentence, EPC, it must first be established that it is obvious that an error is present. If such an error is present it must then be established that the correction of the error is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction (see Case Law of the Boards of Appeal (CLB), 10th edition 2022, II.E.4.2).

It is not sufficient to contend that the correction to the description and claims expresses the true intention of the respondent; the skilled person must be in no doubt that the information is incorrect and must be in

no doubt that nothing else could have been intended than what is offered as the correction (G 11/91, reasons 5., final two sentences; reasons 6., final sentence).

- 1.2.1 In the present case, as argued by the appellant at the oral proceedings before the Board, there is, firstly, no obvious error in the phrase under consideration.

The skilled person, reading claim 1 and paragraph [0016], cannot immediately identify any error. They understand from the phrase under consideration that the separating element has a single separating wall. There is no indication for the skilled person that this information cannot be correct. The term "formed by" is regularly used in a technical context so that the skilled person would immediately understand the term as it is used in the contested patent with respect to the separating element.

- 1.2.2 Secondly, it is not evident what the correction should be. As brought forward by the appellant at the oral proceedings before the Board, the initial and corrected terms appear to be synonymous and the respondent mentioned a further, third possible translation of "consists of" (see respondent's submissions of 3 May 2023, page 8, penultimate paragraph to page 9, penultimate paragraph).

- 1.3 Therefore, in the absence of any obvious error in the description or claims, or an immediately evident correction, the request for correction cannot be allowed.

In light of the above findings, it is unnecessary to consider the appellant's request under Article 13(2)

RPBA 2020 to not admit the respondent's request for correction under Rule 139 EPC.

2. *Main request - Article 100(a) EPC - novelty - Article 54 EPC - claim 1*

2.1 In the decision under appeal, the opposition division found that claim 1 as granted was novel with respect to the disclosure of document D1, as this document did not unambiguously disclose part of the characterising portion of claim 1, namely that "the separating element (20) is formed by a single separating wall (21)" (feature 1.6).

The opposition division reasoned that this feature had to be understood as requiring that the separating element had no additional attachment panels at either side of the separating wall (see decision under appeal, point II.4.2.1).

2.2 The appellant argued in its statement of grounds of appeal (point 4.1, pages 5 to 7, together with point 3.) that the opposition division was incorrect in finding that feature 1.6 was not disclosed in document D1. According to the appellant, this feature should be interpreted broadly and did not exclude separating elements having a single separating wall with additional attachment panels as disclosed in the embodiments of document D1 (figures 1 to 3).

2.3 The patent proprietor argued that the "skilled person looking at the claimed invention and disclosed embodiment in the description and Figure 3 would have no doubt about the interpretation of the separating wall 21 as a single wall". The embodiment of figure 3

of the patent in suit does not show any panels attaching the separating wall to the inner wrapper.

2.4 Although the description and drawings may be consulted in order to clarify a term in a claim (see CLB, *supra*, II.A.6.3.3), it is established case law that limitations cannot be read into a claim on the basis of the description (see CLB, *supra*, II.A.6.3.4).

2.4.1 In the present case the interpretation used by the appellant follows the explicit wording of the claim and is not illogical or lacking in technical sense. It therefore appears that as there is no need for clarification, there is no reason to refer to the description and drawings in order to read further limitations into the claim.

2.4.2 In any case, as brought forward by the appellant at the oral proceedings before the Board, even if the description and drawings were consulted, no explicit, literal indication is given that feature 1.6 is to be interpreted as excluding any other components. The figures of the contested patent are schematic in nature and do not show every detail of the cigarette packet.

Indeed, paragraph [0067] of the description of the contested patent and claim 7 as granted both indicate that the separating element of claim 1 (and the embodiment shown in figures 3 to 6 of the contested patent) can comprise one or more projecting elements (24). Therefore, the skilled person understands that the separating element of claim 1 may have further components than the single separating wall.

2.4.3 The respondent argued at the oral proceedings before the Board that further elements of the separating wall,

such as the projecting elements, are not excluded, but such elements must be part of the separating wall and have a separating function, not an attachment function.

- 2.5 The Board, however, agrees with the appellant that the skilled person would interpret feature 1.6 more broadly than the opposition division and the respondent.

The separating element according to feature 1.6 of claim 1 as granted is formed by a single separating wall which constitutes the border between the two chambers, but it is not excluded that further panels for fixing this separating wall to the inner wrapper are present.

In other words, although the separating element can have only one, single, separating wall which is the border between the two chambers, attachment panels, which are not separating walls, are not precluded from forming part of the separating element. The Board cannot agree that the skilled person would understand feature 1.6 as including further projecting elements but excluding any attachment panels.

- 2.6 Therefore the appellant has shown the incorrectness of the decision on this point and that document D1 does disclose feature 1.6 of claim 1 as granted.

- 2.7 The respondent originally argued that feature 1.6 of claim 1 as granted was the single distinguishing feature with respect to the disclosure of document D1, as was found by the opposition division (see reply to the statement of grounds of appeal, point A.3).

- 2.7.1 However, with its submissions of 3 May 2023 (see point A.3) and at the oral proceedings before the Board, the

respondent also argued that the top wall, of feature 1.2, was not disclosed in document D1.

2.7.2 At the oral proceedings before the Board the appellant convincingly argued that a top wall is disclosed in document D1. Figure 2 shows a fold line at the top of the lateral and rear walls of the inner wrapper and, additionally, the skilled person is well aware from their common general knowledge that the purpose of the inner wrapper of the cigarette packet is to provide an environmental barrier to keep the tobacco fresh. If the inner wrapper did not enclose the group of cigarettes, it would be unable to fulfil its purpose.

2.7.3 Therefore, irrespective of the question of admittance of an amendment to the respondent's appeal case (Article 13(2) RPBA 2020), feature 1.2 is unambiguously disclosed in document D1 and cannot distinguish the claimed invention from the packet of document D1.

2.8 Therefore as both contested features (features 1.2 and 1.6) are disclosed in document D1, the subject-matter of claim 1 of the granted patent is not novel with respect to the disclosure of document D1 and the main request cannot be allowed.

3. *Remittal for further prosecution*

3.1 In its submissions of 22 April 2022 the appellant requested that if the main request was not allowable, that the case be remitted to the opposition division for further prosecution of the auxiliary requests as these were not considered in the decision under appeal (see submissions of 22 April 2022, paragraph bridging pages 5 and 6). This request was confirmed at the oral proceedings before the Board.

- 3.2 The respondent also requested remittal of the case (see submissions of 3 May 2023, page 11, seventh paragraph).
- 3.3 According to Article 11 RPBA 2020, a case should not be remitted for further prosecution unless special reasons present themselves for doing so. As argued by the appellant the primary object of appeal proceedings is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020). In the present case the opposition division did not consider the auxiliary requests of the respondent as the opposition was rejected. To consider these requests for the first time during appeal proceedings would present an undue burden on the parties and the Board, in particular due to the Board's differing interpretation of feature 1.6 (see CLB, *supra*, V.A.9.3.2 b), c) and d)).
- 3.4 Therefore, as special reasons are present, the case is to be remitted to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The request for correction under Rule 139 EPC is refused.
3. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



S. Lichtenvort

B. Paul

Decision electronically authenticated