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**Datasheet for the decision
of 19 June 2024**

Case Number: T 2252/21 - 3.2.05

Application Number: 11165243.4

Publication Number: 2522479

IPC: B29B11/14, B29C49/42,
B29C49/78, B65D1/02

Language of the proceedings: EN

Title of invention:

Plastic preform or container with a recessed orientation slot,
process of manufacturing a rigid container, process for
angularly orienting a preform and process of detecting the
orientation of a preform

Patent Proprietor:

Plastipak BAWT S.à.r.l.

Opponent:

Krones AG

Relevant legal provisions:

EPC Art. 54(1), 54(3), 123(2), 123(3), 83, 84, 100(a), 112(1)
(a)

EPC R. 80

RPBA 2020 Art. 13(2)

Keyword:

Grounds for opposition - lack of patentability (yes)
Novelty (main request and auxiliary requests 1 and 2: no;
auxiliary request 2A: yes)
Late-filed request - exceptional circumstances (yes)
Amendment occasioned by ground for opposition (yes)
Amendments - added subject-matter (no) - extension of
protection of the patent (no)
Sufficiency of disclosure (yes)
Claims - clarity (yes)
Referral to the Enlarged Board of Appeal (no)

Decisions cited:

G 0001/05, G 0003/14, G 0001/16, T 0094/82, T 0332/87,
T 0118/89



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 2252/21 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 19 June 2024

Appellant I: Plastipak BAWT S.à.r.l.
(Patent Proprietor) 24, Rue Héierchen
4940 Bascharage (LU)

Representative: V.O.
P.O. Box 87930
2508 DH Den Haag (NL)

Appellant II: Kronos AG
(Opponent) Böhmerwaldstraße 5
93073 Neutraubling (DE)

Representative: Bittner, Bernhard
Hannke Bittner & Partner
Patent- und Rechtsanwälte mbB
Prüfeninger Strasse 1
93049 Regensburg (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
13 October 2021 concerning maintenance of the
European Patent No. 2522479 in amended form.**

Composition of the Board:

Chairman P. Lanz
Members: T. Vermeulen
B. Burm-Herregodts

Summary of Facts and Submissions

- I. Both the patent proprietor and the opponent lodged an appeal against the interlocutory decision of the opposition division finding that European patent No. 2 522 479 as amended according to auxiliary request 4 met the requirements of the European Patent Convention.
- II. The opposition had been filed against the patent as a whole on the basis of the grounds for opposition under Article 100(a) together with Article 54(1) EPC (lack of novelty) and Article 56 EPC (lack of inventive step), under Article 100(b) EPC and under Article 100(c) EPC.
- III. In the decision under appeal, the opposition division came, *inter alia*, to the following conclusions:
- document D8 (EP 2 439 034 A2) is considered part of the prior art according to Article 54(3) EPC,
 - the subject-matter of claim 1 as granted and the subject-matter of claim 1 of auxiliary requests 1 and 2 lacks novelty over document D8,
 - the requirements of Rule 80, Article 84 and Article 123(2) and (3) EPC are fulfilled in view of the amendments to claim 1 of auxiliary requests 1 and 2.
- IV. With its reply to appellant II's (opponent's) statement of grounds of appeal, appellant I (the patent proprietor) filed eighteen sets of claims labelled 'Auxiliary claim request [1 to 17] Appeal' and 'Auxiliary claim request A appeal', respectively.
- V. On 23 May 2024, the board issued a communication pursuant to Article 15(1) of the Rules of Procedure of

the Boards of Appeal (RPBA) as in force since 1 January 2024 (see OJ EPO 2024, A15), in which the parties were informed of the board's provisional opinion on the issues of the case.

- VI. By letter dated 11 June 2024 the appellant filed two further auxiliary requests 2A and 2B, as well as four excerpts of different dictionaries as D13a, D13b, D13c and D13d.
- VII. Oral proceedings before the board were held on 19 June 2024. During the oral proceedings, appellant II submitted three questions to be referred to the Enlarged Board of Appeal.
- VIII. Appellant I (hereinafter: the patent proprietor) requested that:
- the decision under appeal be set aside and the patent be maintained as granted (main request),
 - or, alternatively, in amended form on the basis of the claims of one of auxiliary requests 1 to 2 filed as 'Auxiliary claim requests [1 to 2] Appeal' in reply to the opponent's statement of grounds of appeal,
 - or, further alternatively, in amended form on the basis of the claims of one of auxiliary requests 2A or 2B filed as 'Auxiliary claim requests [2A, 2B] Appeal' with letter dated 11 June 2024,
 - or, further alternatively, in amended form on the basis of the claims of auxiliary request 3 filed as 'Auxiliary claim request 3 Appeal' in reply to the opponent's statement of grounds of appeal,
 - or, further alternatively, that the opponent's appeal be dismissed and the patent be maintained in amended form on the basis of the claims of auxiliary request 4,

- or, further alternatively, that the patent be maintained in amended form on the basis of the claims of one of auxiliary requests 5 to 17 filed as 'Auxiliary claim requests [5 to 17] Appeal' in reply to the opponent's statement of grounds of appeal,
- or, further alternatively, on the basis of the claims of one of auxiliary requests 5A to 17A which can be obtained by carrying out the amendments of auxiliary request A filed as 'Auxiliary claim request A Appeal' in reply to the opponent's statement of grounds of appeal in each of auxiliary requests 5 to 17,
- the case be remitted to the opposition division for further prosecution.

Appellant II (hereinafter: the opponent) requested that the decision under appeal be set aside and that the patent be revoked. Further, the opponent requested not to admit auxiliary requests 2A, 2B, 3, 5 to 17 and 5A to 17A in the appeal proceedings. In addition, it requested to refer the following questions to the Enlarged Board of Appeal:

„1. Kann aus der Figur einer Patentanmeldung, welche ein bestimmtes Merkmal nicht zeigt allgemein darauf geschlossen werden, dass der in der Figur gezeigte Gegenstand frei von diesem Merkmal ist.

2. Falls 1. mit ja beantwortbar ist. Kann dieses Merkmal auch isoliert zur Einschränkung verwendet werden, wenn die Figurenbeschreibung zu dieser Figur ausschließlich weitere Merkmale offenbart, die in keinem unmittelbaren Zusammenhang mit diesem Merkmal steht.

3. Falls 1. mit ja beantwortet wird. Kann darauf geschlossen werden, dass dieses Merkmal eindeutig und unmittelbar offenbart ist."

(The board translates these questions into the language of the proceedings as follows:

"1. Can it generally be concluded from the figure of a patent application which does not show a certain feature that the subject-matter shown in the figure is free of this feature?

2. If 1. can be answered with yes. Can this feature also be used in isolation as a restriction if the figure description for this figure only discloses further features that are not directly related to this feature.

3. If 1. can be answered with yes. Can it be concluded that this feature is directly and unambiguously disclosed.")

IX. Independent claims 1, 8, 10 and 11 as granted have the following wording (the feature numbering used by the board for claim 1 appearing in square brackets):

"1. [1.1] A plastic preform (P) or plastic container (C) comprising [1.2] a neck finish (1), [1.3] a closed bottom end (3; 3') and [1.4] a main body (2 ; 2') extending between said closed bottom end and said neck finish, [1.5] said neck finish being terminated by an opening (11) and comprising a neck support ring (12), characterised in that [1.6] the bottom side (12a) of the neck support ring comprises a recessed orientation slot (S) [1.7] that extends radially from the neck support ring outer edge (12b) [1.8] and does not break

through the neck support ring and is thus not visible on a top view of the plastic preform."

"8. A process of manufacturing a rigid container, wherein a preform (P) according to any one of claims 1 to 7 is biaxially stretched in blowing mold in order to form a blow molded container (C)."

"10. A process of angularly orienting a preform (P) or container of any one of claims 1 to 6, wherein a movable cam (5) is inserted into the recessed orientation slot (S) of the preform or container."

"11. A process of detecting the orientation of a preform or a container of any one of claims 1 to 6, wherein the recessed orientation slot (S) of the preform or container is automatically detected by one or several sensors."

X. Claim 1 of auxiliary request 1 differs from claim 1 as granted in that the feature

"[1.6A] that is arranged for insertion of a movable cam (5) therein"

was added between features 1.6 and 1.7. The wording of the other claims remained unchanged.

XI. Compared to claim 1 of the patent as granted, claim 1 of auxiliary request 2 has the additional feature

"[1.5A] the neck support ring (12) is free of a slot that reaches the top side (12c) of the neck support ring and in that"

inserted between features 1.5 and 1.6. The wording of the other claims was not amended.

XII. The claims of auxiliary request 2A have identical wording to those of auxiliary request 2, except for the following change in feature 1.5A of claim 1:

"[1.5A'] the neck support ring (12) is free of a ~~slot~~ recess that reaches the top side (12c) of the neck support ring and in that".

XIII. The parties' arguments relevant for this decision can be summarised as follows.

Document D8 - prior art under Article 54(3) EPC

- *Patent proprietor*

The content of document D8 might only be considered prior art under Article 54(3) EPC insofar as it was entitled to priority. As the party relying on the priority date of this document, the onus was on the opponent to substantiate that the subject-matter benefited from the priority claimed. No such substantiation had been made in the notice of opposition nor afterwards. In fact, the opponent had not made the priority document - a patent application in the name of the opponent - part of the opposition proceedings and had thus chosen not to make its case. It was difficult and at the same time odd that the patent proprietor should have to look for the priority document in the electronic file. This was not the normal practice as established in Chapter F-VI, 2.1 of the Guidelines for Examination in the European Patent Office (hereinafter: 'the Guidelines'). Moreover, the opposition division was incorrect to conclude that the

patent proprietor failed to provide an argument about an alleged discrepancy. The opposition division's finding of its own in respect of the priority claim could not be accepted for lack of evidence. It appeared to have been limited to the content of the priority document, not to the entitlement to priority. The patent proprietor therefore requested not to consider document D8 as prior art.

- *Opponent*

The German priority application of document D8 was identical in wording to the European patent application that led to the publication D8. The question of an invalid priority claim could therefore not arise in the slightest. Apart therefrom, the opposition division formed its own opinion on the validity of the priority. This was fully in line with the established practice as set out in the Guidelines, which the patent proprietor cited out of context. Therefore, document D8 constituted state of the art according to Article 54(3) EPC.

Patent as granted - novelty over document D8

- *Patent proprietor*

The embodiment of Figures 3 and 4 of document D8 neither showed a body, nor an implicit opening, nor were these features disclosed in the figure description. The opposition division incorrectly relied on a combination of Figures 1 and 4 of document D8 to conclude that these features were disclosed. But it was clear from paragraphs [0038] and [0039] of document D8 and a comparison of the figures that these concerned a different subject-matter. An implicit presence of the

opening of Figure 1 could not be attributed to the disclosure of Figures 3 and 4. Paragraphs [0010], [0015], [0016], [0024] and [0028] of document D8 related to a different embodiment than paragraphs [0005] and [0009] and to yet a different embodiment than Figures 3 and 4. These passages could not be combined within the context of novelty. Nevertheless, paragraphs [0005], [0009] and [0010] of document D8 did not include the disclosure of feature 1.7 that the slot radially extended from the neck support ring outer edge. This was mentioned in paragraph [0028], but only in the context of a slot going through the ring. Furthermore, it followed from the description of the patent in paragraph [0034] that the orientation slot of claim 1 had to be adapted to cooperate with an orientation cam. The marking 10 of document D8, however, was not able to receive a cam, see paragraph [0011]. This was also reflected by the fact that, in Figure 4 of document D8, an orientation slot was shown in the 6 o'clock position, opposite the marking 10. The subject-matter of claim 1 as granted was thus novel over document D8.

- *Opponent*

A neck finish terminated by an opening in the sense of feature 1.5 was implicit from document D8. Moreover, in paragraph [0009] of document D8, it was emphasised that markings within the meaning of the prior art document were understood to mean in particular codes and/or recesses of any geometric shape. An orientation slot that did not break through the support ring had the configuration of a recess. The recess of document D8 was thus compatible with the subject-matter of claim 1 as granted. Paragraphs [0005], [0009], [0010], [0015], [0016], [0024] and [0028] of document D8 supported this

interpretation. In the opponent's view, feature 1.7 was disclosed by paragraphs [0010], [0015], [0016] and [0028] of document D8. These passages could certainly be combined to show that the document was prejudicial to novelty. Reference was made in this respect to decision T 332/87, from which it could be inferred that a combination of different passages of one document was possible provided that there were no reasons which would prevent a skilled person from such a combination. This was the case here. Also Figure 4 of document D8 showed features 1.7 and 1.8. It was clear that the recess 10 started radially from the outer edge of the neck support ring without breaking through the ring. In other words, it would not be visible from a top view. The recess was suitable for receiving a cam and orientating the plastic preform. Therefore, the subject-matter of claim 1 as granted was not new compared to document D8.

Auxiliary request 1 - novelty over document D8

- Patent proprietor

The added feature 1.6A was a positively claimed arrangement of the slot as one that was arranged for insertion of an orientation cam. Even if the recess 10 shown in the figures of document D8 could be held suitable for such an insertion, paragraph [0011] of document D8 specifically disclosed that it was not used in such a way; its purpose was optical detection only. The subject-matter of claim 1 of auxiliary request 1 was therefore novel over document D8.

- *Opponent*

The suitability of the slot 10 of document D8 for insertion of a cam was sufficient for anticipating also the additional feature 1.6A. The subject-matter of claim 1 of auxiliary request 1 therefore lacked novelty over document D8.

Auxiliary request 2 - novelty over document D8

- *Patent proprietor*

The additional feature 1.5A rendered claim 1 novel over document D8. The embodiment of Figure 4 of document D8 that was relied on for lack of novelty included an opening at the 6 o'clock position, which, unlike the opening 10 at the 12 o'clock position, did reach the top side of the orientation ring. Even if it was similar to what was called a groove G in the introductory portion of the patent in suit, the recess at the 6 o'clock position could be considered a slot. The opponent had actually admitted this in the oral proceedings before the opposition division, see point 6.2 of the minutes. The openings S and G referred to as 'slot' and 'groove' in the patent in suit both extended in circumferential, axial and radial directions of the ring, and functioned in the same way to orient the ring by accepting a cam. Naming them 'groove' and 'slot' did not provide for a differentiating technical feature. The different names were merely used to emphasise that one was prior art and the other was not. Furthermore, the first definition of the term 'slot' given in document D13a was a narrow opening. The circumferential openings G and S in Figures 1 and 7 of the patent in suit, and those at the 12 o'clock and 6 o'clock

positions in Figure 4 of document D8 were all narrow compared to the full circumference of the ring, and therefore also met this definition. But document D13a also defined the term slot as a 'groove' without any further dimensional qualifications. Whilst a groove could be narrow, it must not be. This was confirmed by documents D13b, D13c and the older document D13d. Based on these dictionary excerpts, the terms 'groove' and 'slot' were thus direct synonyms. The expression 'free of a slot that reaches the top side of the neck support ring' was then construed as 'free of a groove that reaches the top side of the neck support ring'. In consequence, feature 1.5A of claim 1 actually required the absence of a groove of the type shown in Figure 1 of the patent in suit. The embodiment of Figure 4 of document D8 did not meet this limitation of claim 1 of auxiliary request 2. As regards the description of document D8, it was noted that paragraphs [0005], [0009] and [0010] did not include the disclosure of the aspect of feature 1.7 that the slot radially extended from the neck support ring outer edge. In addition, paragraph [0010] of document D8 related to a different embodiment than paragraphs [0005] and [0009] and to yet a different embodiment than Figures 3 and 4. These paragraphs could thus not be combined within the context of novelty. Also paragraph [0024] did not include the aspect of feature 1.7 and pertained to yet another embodiment. The subject-matter of claim 1 of auxiliary request 2 was therefore novel over document D8.

- *Opponent*

There was no indication in document D8 that would lead to the interpretation that the opening shown at the bottom of Figure 4 was a slot. Rather, this element

could only be interpreted as a recess. It followed from paragraph [0028] of document D8 that the marking was a notch that did not break through the neck support ring in the normal case that the material of the preform was transparent. Only when particles were admixed that reduced the transparency, a notch or recess was used that pierced through the ring. Equating a slot with a groove was not correct, despite the excerpts of some free, online dictionaries. In contrast, a slot had a width dimension smaller than a length dimension. Consulting common general knowledge in the form of dictionaries was only necessary in case the patent itself did not teach the meaning of a term. Anyway, the board had an obligation to interpret the terms of a claim. The opponent concluded that the subject-matter of claim 1 of auxiliary request 2 lacked novelty over document D8.

Auxiliary request 2A

(a) Admittance

- Patent proprietor

The board's observation in point 19 of its communication under Article 15(1) RPBA was the first time in the appeal proceedings that a novelty objection was raised against auxiliary request 2 based on Figure 4 of document D8. In particular, it was argued for the first time in the communication that the recess at the 6 o'clock position would not be a slot based on a definition of a slot by reference to its dimensions. During the first-instance proceedings, the opponent had not raised this argument, but actually agreed with the opposition division that the recess was to be construed as a slot. In its statement of grounds of appeal and in

its reply to the patent proprietor's statement of grounds of appeal, the opponent did not provide any further arguments in this respect. Only in the context of auxiliary request 4 an argument on 'slot' was submitted, not in the context of auxiliary request 2. The patent proprietor was thus confronted with the above-mentioned objection for the first time when reading the preliminary opinion of the board. This represented exceptional circumstances in the sense of Article 13(2) RPBA that warranted the admittance of auxiliary request 2A. Moreover, it was a legitimate and timely response to the new objection, which prima facie solved the new issue by merely replacing the phrase 'free of a slot' in feature 1.5A 'free of a recess'. As the board had referred to two 'recesses' in Figure 4 of document D8, one of which reached the top side of the neck support ring, the amendment immediately overcame the supposed novelty objection. Furthermore, the amendment of auxiliary request 2A was not complex, it complied with Rule 80 EPC, did not extend the protection vis-à-vis the patent as granted under Article 123(3) EPC, and had basis in the application as filed, namely in Figures 6 to 13 and on page 8, lines 9 to 17. For these reasons, it was requested that auxiliary request 2A be admitted into the proceedings.

- *Opponent*

The discussion on the meaning of the terms 'slot' and 'groove' had already been part of proceedings before the opposition division. It was not raised for the first time by the board. But even if this were the case, it was not sufficient to invoke exceptional circumstances in the sense of Article 13(2) RPBA. Reference was made to page 13 of the opponent's reply to the patent proprietor's statement of grounds of

appeal, to page 6 of the patent proprietor's reply to the opponent's statement of grounds of appeal, and to pages 3 and 4 of the opponent's letter dated 6 April 2023. The amendment of auxiliary request 2A was not a serious attempt to overcome the novelty objection, since this depended on how the recess was defined. It raised further questions, such as clarity, but also added subject-matter, since relying on Figure 9 of the application as filed as basis for the amendment would mean that it effectively was an intermediate generalisation. Therefore, auxiliary request 2A should not be admitted into the proceedings.

(b) Objections under Rule 80 EPC, Article 123(2) and (3) EPC, Articles 83 and 84 EPC and Article 54(1) EPC

- *Patent proprietor*

Auxiliary Request 2A complied with Rule 80 EPC, as the amendment to claim 1 intended to overcome the novelty objection in view of document D8. Basis for the amendment of feature 1.5A' could be directly and unambiguously found in Figure 9 of the application as filed, a top view of the preform which clearly did not disclose any recess reaching the top side of the ring. It was not clear how this could result in an intermediate generalisation, particularly since page 8, lines 11 and 12 of the application as filed mentioned that the ledge was not necessary. Thus, the requirements of Article 123(2) EPC were fulfilled. Also the protection conferred by the patent was not extended by the limiting amendment, in line with Article 123(3) EPC. The opponent's objection of insufficient disclosure was actually a clarity objection against claim 1. By means of the amendment, any type of recess

was now excluded. A recess was a clear, general engineering term that corresponded to the German "Ausnehmung" used in document D8. Claim 1 was thus clear pursuant to Article 84 EPC. As regards novelty, feature 1.7 was only disclosed in the context of the embodiment of Figures 3 and 4 of document D8.

It was therefore not correct to depart from that embodiment and rely on paragraph [0028] of document D8, which mentioned very specific materials and failed to disclose the slot configuration 10 of the figures. As Figure 4 of document D8 showed an additional recess in the 6 o'clock position that reached the top side of the ring, feature 1.5A' was not disclosed so that the subject-matter of claim 1 of auxiliary request 2A was novel over document D8.

- *Opponent*

The amendment in claim 1 of auxiliary request 2A could not lead to success, so it was not occasioned by a ground for opposition. Furthermore, there was no basis for the amendment, contrary to the requirements of Article 123(2) EPC. The embodiment shown in Figure 9 of the application as filed encompassed further features. Isolating the absence of recesses reaching the top side of the ring from that figure amounted to an intermediate generalisation. This was clear also from the bottom paragraph of page 7 of the application as filed, in which the stop ledge 4 and an annular continuous seal were described. Also Article 123(3) EPC was not complied with, the reason being that the unclear meaning of the term 'recess' potentially shifted the scope of protection. Apart from the ambiguous term 'recess', the lack of definitions or information on the dimensions caused the expression 'free of a recess' to contradict with the expression

'recessed orientation slot' in claim 1, resulting in a violation of Article 83 EPC. As regards novelty, document D8 disclosed all features of claim 1 of auxiliary request 2A for the same reasons as set out in the context of auxiliary request 2. It did not make any difference if the ring was free of slots or free of recesses. Figure 4 of document D8 was only one embodiment. It followed from the description in paragraph [0008] of document D8 that the ring was uniform and, hence, its upper surface was smooth and uninterrupted, i.e. without recesses. In consequence, the subject-matter of claim 1 of auxiliary request 2A lacked novelty over document D8. There were no further objections against claim 1 or any of the other independent claims of auxiliary request 2A.

Referral to the Enlarged Board of Appeal

- *Patent proprietor*

The first question to be referred to the Enlarged Board of Appeal was a question of fact. In the case in hand, there was also another figure in the application as filed which showed the disclosed feature. Therefore, the question was too general for the present case. No divergence of case law was established by the opponent. This was clearly not a point of fundamental law. The request for referral should be refused.

- *Opponent*

The request for referring the questions to the Enlarged Board of Appeal was both to ensure uniform application of law and because they concerned a point of law of fundamental importance. By taking its decision in respect of the disclosure of a negative feature based

on a drawing, the board had deviated from the case law. It was necessary to solve this contradiction. Even if it was clear to the opponent that an Article 54(3) EPC document could be used to justify to disclaim a feature, question 1 was of fundamental importance. Questions 2 and 3 depended on the answer to the first question and also served to solve a contradiction in the case law.

Reasons for the Decision

Document D8 - prior art under Article 54(3) EPC

1. Document D8 is a European patent application filed and published after the filing date of the patent in suit (9 May 2011), but claiming priority of a German patent application (DE 102010047619) filed before the filing date of the patent in suit. Document D8 is therefore comprised in the state of the art under Article 54(3) EPC to the extent that the priority claim is valid.
2. It is well-established case law that each party bears the burden of proof for the facts it alleges ("Case Law of the Boards of Appeal of the European Patent Office", 10th edition 2022, III.G.5.1.1). In the present case, this means that it was incumbent on the patent proprietor, who challenged the priority claim of document D8, to demonstrate why the features the opponent relies on in document D8 for concluding lack of novelty do not benefit from the assumed priority right. The patent proprietor cannot be discharged from this burden of proof by the mere fact that the priority application of document D8, which is publicly available online via the European Patent Register, has not actually been submitted during the proceedings before

the opposition division or because it happens to be from the hand of the opponent.

3. The patent proprietor referred to the Guidelines, Chapter F-VI, 2.1 for proof of the normal practice of presenting priority documents in case the patentability depends on intermediate documents. However, this passage of the Guidelines (at least in the 'March 2021' version which was valid at the time of the impugned decision and the patent proprietor's statement of grounds of appeal) concerns the case where the substantive examination of a European patent application cannot be finalised with regard to intermediate documents or Article 54(3) documents because the priority document *of the application* was not yet filed by the applicant. It is therefore not pertinent to the present case.

4. It may be out of the ordinary that the opposition division examined *sua sponte* the content of the priority application of document D8 despite insisting on the rebuttable assumption that the priority was valid (cf. point 14.3 of the impugned decision). But the patent proprietor's failure to provide any element in support of its allegation that the features the opponent relied on in document D8 for concluding lack of novelty of the claimed subject-matter do not benefit from the assumed priority right leads the board to conclude that the priority claim is valid so that document D8 is comprised in the state of the art under Article 54(3) EPC.

Patent as granted - novelty over document D8

5. The patent proprietor's main request - to maintain the patent as granted - was disallowed by the opposition division on the ground that the subject-matter of claim 1 as granted was found to lack novelty over document D8.

6. Claims 1 and 2 of document D8 define a plastic container, in particular a plastic preform, having a main body 2, a threaded portion 4 and a ring-shaped portion 6 below the threaded portion, that extends radially outwards from the container. The side 6a of the ring directed away from the threaded portion comprises a recess ("Ausnehmung") 10. Figure 3 of document D8 is a partial representation of such a preform (see paragraph [0030] of document D8: "*eine Teildarstellung [...] des Kunststoffvorformlings*"). It shows a neck finish composed of a threaded portion 4 and a neck support ring in an upside down position, but without the body and the bottom end. The neck finish is similar to the ones of Figures 1 and 2, which are formed in one piece together with the body by stretch blow moulding and are, therefore, terminated by an opening at the free end of the threaded portion (see, for example, paragraphs [0001], [0005] and [0031] of document D8). In the embodiment of Figures 3 and 4 of document D8, the recess 10 is formed in the surface 6a of the ring directed away from the opening, i.e. at the bottom side of the ring. It does not break through the neck support ring and is thus not visible on a top view of the plastic preform. Moreover, paragraph [0039] of document D8 confirms that the recess 10 shown in plan view in Figure 4 extends radially from the outer edge of the ring.

7. The drawings of Figures 3 and 4 of document D8 present the recess 10 as an elongated depression with a relatively narrow v-shaped cross-section. It is therefore accurate to speak of a slot which, in the board's understanding, is an elongated narrow depression or perforation. This kind of marking can be used to establish the orientation of the plastic container around the longitudinal axis, be it by way of optical detection devices or by inserting a movable object therein, much alike to how this is done in the patent in suit (see paragraph [0034]). Therefore, the recess 10 is considered to fall under the expression "a recessed orientation slot". The patent proprietor's argument based on paragraph [0011] of document D8 is not convincing, as this passage addresses prior art solutions where the markings are arranged at the top side of the ring or in areas that are visually difficult to access. It does not exclude markings that interact with movable cams. Nor would this make any difference since claim 1 as granted fails to specify how, if at all, the recessed slot conveys information on an orientation of the plastic container.
8. The board concludes that the subject-matter of claim 1 lacks novelty over document D8. The ground for opposition under Article 100(a) together with Article 54(1) EPC therefore prejudices the maintenance of the patent as granted. The patent proprietor's main request is thus not allowable.

Auxiliary request 1 - novelty over document D8

9. The claims of auxiliary request 1 filed in reply to the opponent's statement of grounds of appeal are identical

to those of auxiliary request 1 underlying the impugned decision. In claim 1 of auxiliary request 1, the recessed orientation slot is further specified by requiring it to be arranged for insertion of a movable cam. In the board's view, the ability to receive a cam would very much depend on the size and shape of the cam. Given that such characteristics are not specified in claim 1 of auxiliary request 1, also the recessed orientation slot 10 illustrated in Figures 3 and 4 of document D8 would be suitable for insertion of a generally defined movable cam. Whether or not the actual use of the slot in document D8 requires a cam is irrelevant when assessing novelty of the product-type claim.

10. In view of the foregoing, the board arrives at the conclusion that the subject-matter of claim 1 of auxiliary request 1 lacks novelty over document D8 (Article 54(1) and (3) EPC). Auxiliary request 1 is thus not allowable.

Auxiliary request 2 - novelty over document D8

11. The claims of auxiliary request 2 filed in reply to the opponent's statement of grounds of appeal are identical to those of auxiliary request 2 underlying the impugned decision. In point 19.3 of the decision under appeal, the opposition division based its conclusion that document D8 anticipated all features of claim 1 of auxiliary request 2 on the disclosure in paragraph [0024] in combination with paragraphs [0005], [0009] and [0010] of document D8 "*without the figures 3 and 4 being needed*". The board cannot subscribe to this view for the following reasons. None of the paragraphs [0005], [0009], [0010] or [0024] of document D8

contains any information on how the "Markierung" (marking) or "Ausnehmung" (recess) extends with respect to the outer edge of the neck support ring. The requirement of feature 1.7 is thus not directly and unambiguously disclosed in the context of these passages. Also the reference in paragraph [0028] of the general description of document D8 to the radially outer edge ("*an dem radial äußeren Rand*") cannot lead to a negative assessment of novelty, since it applies to a particular recess that pierces the ring ("*eine derartige durchgehende Kerbe bzw. Ausnehmung*"), which is contrary to the requirement of feature 1.8.

12. It is only in the detailed embodiment of Figures 3 and 4 of document D8 that the requirement of feature 1.7 is disclosed. The recessed orientation slot 10 shown from the side in Figure 3 and from below in Figure 4 starts at the outer edge of the neck support ring and extends in radial direction towards the longitudinal axis of the plastic preform. This is confirmed in paragraph [0039] of document D8. In the context of auxiliary request 4 underlying the impugned decision, the opposition division expressed its view that the "*notch at the bottom (6 o'clock position) of the ring*" was also an orientation slot (see point 22.3 of the reasons). The so-called 'notch' is represented in Figure 4 of document D8 as a recess at the edge of the neck support ring that breaks through the ring and therefore reaches the top side of the ring. Unlike the recessed orientation slot 10, this recess is wide in the circumferential direction and has a limited extension in the radial direction, much in a similar way as the recess G illustrated in Figures 1 to 5 of the patent in suit, where it is referred to as a 'groove'. In the view of the matter taken by the board, this recess in Figure 4 of document D8 is not an

elongated narrow depression or perforation and can therefore not be regarded as a slot (see also point 7. above).

13. The patent proprietor argued by way of reference to four different documents D13a to D13d that 'slot' and 'groove' were direct synonyms so that what was considered to be a groove at the 6 o'clock position in Figure 4 of document D8 was in fact a slot that reached the top side of the neck support ring, against the requirement of feature 1.5A. The board concurs with the patent proprietor that, in the absence of any special definition given in the patent in suit, dictionaries may be used as an aid to the correct interpretation of terms used in a claim. Each of documents D13a to D13d is an excerpt from a different dictionary. The first excerpt D13a is taken from 'The Free Dictionary', an online dictionary based on various dictionary sources. The first meaning of the noun slot for each of those sources is given as follows:

"1. A narrow opening; a groove or slit: *a slot for coins in a vending machine; a mail slot*" (source: American Heritage® Dictionary of the English Language)

"1. an elongated aperture or groove, such as one in a vending machine for inserting a coin" (source: Collins English Dictionary)

"1. a slit or other narrow opening, esp. one for receiving something, as a coin or letter" (source: Random House Kernerman Webster's College Dictionary).

The second excerpt D13b is taken from the online Merriam-Webster dictionary, which defines a slot as follows:

"1 a : a narrow opening or groove: SLIT, NOTCH
a mail *slot* in a door".

The third excerpt D13c is taken from the digital platform 'Dictionary.com', according to which a slot is

"1 a narrow, elongated depression, groove, notch, slit, or aperture, especially a narrow opening for receiving or admitting something, as a coin or a letter".

The fourth excerpt D13d, finally, stems from an old Penguin English Dictionary. It defines a slot as

"slit; groove; narrow opening, esp one in which a coin is inserted".

The board observes that none of the above definitions is identical. By reference to different terms commonly used in the field of mechanics (slot, groove, notch, slit, aperture, opening, depression), they seem to capture slightly different nuances of the term's meaning. Whilst the aggregation of all these nuances tends to blur the distinction between the terms, one property of the slot is conspicuous: its limited extension in the width direction compared to the length direction. It is this property, expressed by the terms 'narrow', 'elongated' or 'slit', that makes a slot suitable for receiving an object such as a coin or a mail letter. The board can thus not see any reason to deviate from its understanding of the term 'slot' as an elongated narrow depression or perforation (see

points 7. and 12. above). The recess in the 6 o'clock position of Figure 4 of document D8 does not have this property. Quite the contrary, it is wide and short. Irrespective of whether it can be called a groove or a notch, the recess is not narrow or elongated and, hence, not a slot.

14. In view of the foregoing, it must be concluded that the plastic preform shown in the embodiment of Figures 3 and 4 of document D8 has a neck support ring that is free of a slot that reaches the top side of the neck support ring. The subject-matter of claim 1 of auxiliary request 2 therefore lacks novelty pursuant to Article 54(1) and (3) EPC.

Auxiliary request 2A

(a) Admittance

15. Article 13(2) RPBA provides that any amendment to a party's appeal case made after the expiry of a period specified by the Board in a communication under Rule 100, paragraph 2, EPC or, where such a communication is not issued, after notification of a communication under Article 15, paragraph 1, is, in principle, not taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
16. Auxiliary request 2A was filed with letter dated 11 June 2024 and thus formed an amendment of the patent proprietor's appeal case for which the provision of Article 13(2) RPBA applied.

17. The main reason put forward by the patent proprietor for taking into account auxiliary request 2A was that, for the first time when reading the board's communication under Article 15(1) RPBA, it had been confronted with a novelty objection against the subject-matter claimed in auxiliary request 2 based on Figure 4 of document D8. This argument is convincing. As set out in point 11. above, the opposition division decided on the novelty of the subject-matter claimed in auxiliary request 2 solely on the basis of some passages taken from the description of document D8. On page 23 of the its statement of grounds of appeal, the opponent agreed with this finding of the opposition division without presenting any further arguments. Even if it is correct that the meaning of the terms 'slot' and 'groove' had already been discussed in the proceedings before the opposition division, the question whether or not the neck support ring illustrated in Figure 4 of document D8 is free a slot that reaches the top side of the ring did not play any apparent role in the proceedings preceding the board's communication. In fact, the opponent's arguments presented on page 5 of its statement of grounds of appeal, as well as the patent proprietor's response thereto on page 6 of its reply to the opponent's statement of grounds of appeal, and the opponent's further observations on page 4 of its letter dated 6 April 2023 were all concerned with the feature "a single orientation slot" in claim 1 of auxiliary request 4 underlying the impugned decision. Feature 1.5A was not discussed there at all. The board concurs with the patent proprietor that it was not until the communication under Article 15(1) RPBA that feature 1.5A was assessed against the disclosure of Figure 4 of document D8.

18. This situation is considered as constituting exceptional circumstances within the meaning of Article 13(2) RPBA which, the board concludes, justify taking auxiliary request 2A into account.

(b) Rule 80 EPC

19. Compared to the claims of auxiliary request 2, the only amendment in auxiliary request 2A was the replacement of the word 'slot' in feature 1.5A by the word 'recess' in feature 1.5A'. This can be considered a serious attempt by the patent proprietor to overcome the board's objection of lack of novelty over the embodiment of Figures 3 and 4 of document D8. It is therefore occasioned by a ground for opposition under Article 100 EPC. Whether the amendment actually overcomes the novelty objection and thus gives way to an allowable subject-matter is a separate matter that needs to be settled subsequently; it does not fall under the ambit of Rule 80 EPC.

(c) Article 123(2) and (3) EPC

20. The board is satisfied that Figure 9 of the application as filed provides a direct and unambiguous disclosure of the additional feature 1.5A'. The top view of the plastic preform in Figure 9 conforms with the side view in Figure 6, the perspective in Figure 7 and the cross-section in Figure 8 of the application as filed in that the top surface of the neck support ring 12 is intact. Nothing else can be derived from the description and the claims of the application as filed. The ring is thus without depressions, cavities, pockets, indentations that reach the top side. The opponent did not dispute this conclusion, but argued that the embodiment of Figure 9 encompassed further features,

such as the ledge 4 and the annular seal 12d, so that the isolation of feature 1.5A' from the figure amounted to an intermediate generalisation. This may be the case, but it has to be taken into account that the ledge is described as optional on page 8, lines 11 and 12 of the application as filed. As to the seal 12d, it follows from the wording of page 7, lines 26 to 31 and claim 9 of the application as filed that it relates to a function attributed to the radially outer portion of the neck support ring 12 when used together with an unclaimed nozzle, rather than to a separate structural feature of the preform. The opponent has thus not convinced the board that the intermediary generalisation caused by the amendment of feature 1.5A' is not allowable and results in subject-matter which extends beyond the content of the application as filed. In conclusion, the requirements of Article 123(2) EPC are met.

21. The board is at a loss how the amendment from a neck support ring "free of a slot" to "free of a recess" can extend the protection conferred by the patent, considering that the dimensional constraints associated with a slot (see points 7., 12. and 13. above) do not apply to a recess. Article 123(3) EPC is thus found to be complied with.

(d) Articles 83 and 84 EPC

22. The patent proprietor has convincingly argued that the opponent's objection against Article 83 EPC is effectively a clarity objection. The skilled person would recognise sufficient information in the disclosure of Figures 6 to 13 and their description in the patent in suit that would allow them to reproduce

the plastic preform of claim 1 without any recess reaching the top side of the neck support ring.

23. The opponent has not established why the term 'recess' is ambiguous. As a matter of fact, it is a term frequently used in the field of mechanical engineering to depict a (general) space set back in a component, such as a depression, cavity, pocket or indentation. A ring with the requirement of feature 1.5A' can only have a space set back therein if it does not reach the top side of the ring. Also a contradiction between the wording "free of a recess" in feature 1.5A' and "recessed orientation slot" in feature 1.6 is not apparent. The former applies to the top side, the latter to the bottom side of the neck support ring. The board adds that any questions on the limitation the word "recessed" intends to convey onto the expression "orientation slot" cannot be examined under Article 84 EPC, since feature 1.6 was already part of claim 1 as granted (cf. G 3/14, OJ EPO 2015, 102). For these reasons, the requirements of Articles 83 and 84 EPC are met.

(e) Article 54(1) EPC

24. In the top view of Figure 4 of document D8, a recess is visible at the 6 o'clock position of the neck support ring. The recess manifestly breaks through the ring in the axial direction and reaches the top side. In view thereof, feature 1.5A' is not disclosed by this embodiment.
25. The opponent argued with reference to paragraph [0008] of document D8, that, in a further embodiment, the neck support ring had a smooth, uninterrupted top surface leading to the conclusion that the top side of the ring

was not reached by any recess. The board disagrees. As part of the general description of the invention, paragraph [0008] of document D8 gives some preferred ("Vorteilhaft") details of the neck support ring. The latter should preferably be a completely formed body, which is preferably uniform in the circumferential direction ("umlaufend einheitlich ausgebildet"), although it can also extend at a slight angle to the radial direction ("leicht schräg bezüglich der radialen Richtung"). This is understood to refer to the arrangement of the ring either in a radial or in a skewed manner. It is not clear, however, how any information on the texture or the finish of the (top) surface of the ring can be derived from that passage, let alone that it disclosed the absence of a recess that reaches the top side of the ring. Apart therefrom, the board maintains that nowhere in the general description of document D8 any information is provided on how the "Markierung" introduced in paragraph [0005] or the "Ausnehmung" mentioned for the first time in paragraph [0009] extends with respect to the outer edge of the neck support ring (see point 11. above). The requirement of feature 1.7 is only directly and unambiguously disclosed in the context of the embodiment of Figures 3 and 4 of document D8, which, as was concluded above, lacks feature 1.5A'.

26. It follows from the foregoing that the subject-matter of claim 1 of auxiliary request 2A is novel over document D8 in the sense of Article 54(1) and (3) EPC.
27. Because of the direct reference to "any one of claims 1 to 7" and "any one of claims 1 to 6" in the independent process claims 8, 10 and 11, respectively, of auxiliary request 2A, the board's conclusion on claim 1 extends to the subject-matter of these claims.

(f) Conclusion

28. The opponent did not have any further novelty objections against the subject-matter claimed in auxiliary request 2A. Nor were any objections of lack of inventive step raised. As the board does not see any reason to question the compliance of the subject-matter of any of claims 1 to 11 of auxiliary request 2A with the requirements of Article 54(1) or 56 EPC, it concludes that the patent can be maintained in amended form on the basis of the claims of auxiliary request 2A.

Referral to the Enlarged Board of Appeal

29. Under Article 112(1) (a) EPC, in order to ensure uniform application of the law, or if a point of law of fundamental importance arises during proceedings on a case, a board shall, either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision of the Enlarged Board is required. If the board rejects the request, it shall give the reasons in its final decision. It is established case law that only questions of law, not questions of fact may be referred to the Enlarged Board of Appeal (T 94/82, Reasons 15; T 118/89, Reasons 5). Moreover, the Enlarged Board of Appeal has set out in various decisions (cf. G 1/05, OJ EPO 2008, 271, Reasons 1; G 3/14, OJ EPO 2015, 102, Reasons A.1; G 1/16, OJ EPO 2018, 70, Reasons 5) that, in order for a referral to be admissible, the answers to the referred questions must be necessary for the referring board to be able to dispose of the appeal.

30. During the oral proceedings held before the board, the opponent requested that the board refer three questions to the Enlarged Board of Appeal both to ensure uniform application of law and because they concerned a point of law of fundamental importance. Question 1 (in English translation) is formulated as follows:

"1. Can it generally be concluded from the figure of a patent application which does not show a certain feature that the subject-matter shown in the figure is free of this feature?"

The original wording of the three questions and the board's translation can be found in point VIII. above.

31. Question 1 asks for a general conclusion on the subject-matter shown in the figure of a patent application. It is, however, unspecific as to the context in which the conclusion should be drawn. This could be novelty or inventive step, in which case the patent application would be a prior art document. Or it could refer to an objection under Article 123(2) or 76(1) EPC against a European patent (or patent application) under examination. Alternatively, the question may be directed to the examination of sufficiency of disclosure under Article 83 EPC in respect of a European patent application. Also possible is that it relates to the establishment of the validity of a priority right in respect of an earlier patent application.
32. Irrespective of the missing context, the answer to question 1 inevitably depends on the facts and circumstances of the individual case. Without any information on what is disclosed in the description,

the claims and the other figures of the application as filed, it is not possible to make a meaningful appraisal of the subject-matter shown in a single figure of a patent application as originally filed. Similarly, the technical disclosure of a prior art document must be considered as a whole, not on the basis of a figure bereft of any contextual information. Question 1 is thus not a question of law, let alone a point of law of fundamental importance, but a question of fact. As a *general* conclusion asked by question 1 is not possible without the facts, it can only be answered in the negative.

33. Despite the opponent's concern with ensuring a uniform application of law, it did not present any conflicting case law. Nor did it explain why the board deviated from the case law in any of the points set out hereinbefore. In view of the factual nature of question 1, it is difficult to understand how a deviation of the case law and, hence, a non-uniform application of the law would be possible.

34. The board wishes to add that, precisely because of the specific facts of the present case, it arrived at the conclusion in point 20. above that Figure 9 of the application as filed does not show a recess that reaches the top side of the neck support ring so that there is basis for the amendment 1.5A' of claim 1 of auxiliary request 2A. Likewise, the board considered the disclosure of document D8 as a whole in points 11. to 14. above before arriving at the conclusion that Figure 4 of document D8 does not show a slot that reaches the top side of the neck support ring so that feature 1.5A is disclosed by the specific embodiment of the prior art document. Insofar as the opponent intended question 1 to refer to one of these specific

situations, the answer would have already been given in the corresponding points above. A referral would have not been necessary for the board to be able to decide on the appeal.

35. With the negative answer to question 1, there is no need to answer the conditional questions 2 and 3.
36. As none of the questions proposed by the appellant meets the requirements for questions to be referred to the Enlarged Board of Appeal in accordance with Article 112(1)(a) EPC, the request for referral has to be refused.

Order

For these reasons it is decided that:

1. The opponent's request for referral of three questions to the Enlarged Board of Appeal is refused.
2. The decision under appeal is set aside.
3. The case is remitted to the opposition division with the order to grant a patent in amended form on the basis of:
 - Claims: 1 to 11 filed as auxiliary request 2A filed as 'Auxiliary claim request 2A Appeal' with letter dated 11 June 2024,
 - Description:
 - pages 2 and 4 of the patent specification
 - page 3 of the patent specification as filed during oral proceedings of 19 June 2024,
 - Drawings: Figures 1-13 of the patent specification.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated