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**Datasheet for the decision
of 3 July 2023**

Case Number: T 0719/22 - 3.2.07

Application Number: 12710114.5

Publication Number: 2668104

IPC: B65B19/22, B65B57/12

Language of the proceedings: EN

Title of invention:

COMMAND AND CONTROL APPARATUS TO CONTROL AND COMMAND OPERATING
UNITS OF A PACKING MACHINE AND CORRESPONDING METHOD

Patent Proprietor:

I.M.A. Industria Macchine Automatiche S.p.A.

Opponent:

Focke & Co. (GmbH & Co. KG)

Headword:

Relevant legal provisions:

EPC Art. 112(1)(a), 123(2)
RPBA 2020 Art. 13(2)

Keyword:

Amendments - extension beyond the content of the application
as filed (yes) - main request

Amendment after summons - exceptional circumstances (no) -
taken into account (no)

Referral to the Enlarged Board of Appeal - (no)

Decisions cited:

G 0002/10, G 0001/12, J 0014/19, T 0879/09, T 1791/12,
T 0172/17, T 0574/17, T 2787/17, T 1776/18, T 0463/19,
T 0450/20, T 0487/20

Catchword:



Beschwerdekammern

Boards of Appeal

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Case Number: T 0719/22 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 3 July 2023

Appellant: Focke & Co. (GmbH & Co. KG)
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
11 January 2022 concerning maintenance of the
European Patent No. 2668104 in amended form.**

Composition of the Board:

Chairman G. Patton
Members: S. Watson
N. Obrovski

Summary of Facts and Submissions

- I. An appeal was filed by the opponent against the decision of the opposition division maintaining European patent No. 2 668 104 in amended form with the set of claims according to then auxiliary request 1.
- II. The opposition division found that the subject-matter of claim 1 of then auxiliary request 1 did not contain subject-matter which extended beyond the content of the application as originally filed (Article 123(2) EPC), was clear (Article 84 EPC) and the subject-matter was inventive (Article 56 EPC)
- 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 appellant's grounds of appeal and the opponent's reply to the appeal.
- IV. The patent proprietor responded to the board's preliminary opinion with submissions of 31 May 2023, including the submitting of auxiliary requests 1 to 18 and the opponent responded to the patent proprietor's communication with submissions of 19 June 2023.
- V. Oral proceedings before the board took place on 3 July 2023.
- VI. During the oral proceedings the respondent withdrew auxiliary requests 1 to 17 and requested referral of a question to the Enlarged Board of Appeal.

At the conclusion of the proceedings the decision was announced. Further details of the oral proceedings can be found in the minutes.

VII. The final requests of the parties are as follows:

for the opponent (appellant):

- that the decision under appeal be set aside; and
- that the patent be revoked;

for the patent proprietor (respondent):

- that the appeal be dismissed and the patent be maintained as considered allowable by the opposition division (main request) or,
- as an auxiliary measure, that the patent be maintained in amended form on the basis of auxiliary request 18 submitted in the appeal proceedings with the letter dated 31 May 2023, and
- that the following question be referred to the Enlarged Board of Appeal:

"Is an amendment to a party's case filed in reaction to the preliminary opinion of the Board, that is filed before the hearing and that resolves all the issues raised by another party in an appeal procedure not to be admitted into the proceedings by the Board using its discretionary power only for the reason that it is not in conformity with Art. 13(2) RPBA 2020?"

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 main request reads as follows (with the feature labelling as used by the parties):

- a)** "Control method to control the operations performed by two or more operating units (22, 25, 26, 27, 34, 37) of a packing machine (1) for finished packets of smoking articles, extending along a single substantially vertical plane, which provides to wrap at least partly, by means of a central wrapping wheel (13), at least one organized group of smoking articles, previously wrapped by a corresponding first internal wrapping sheet (4) in a respective collar (6) and in a respective second external wrapping sheet (8);
- b)** and which provides at least one or more of the following operations performed by said operating units (22, 25, 26, 27, 34, 37):
 - b1)** - feeding by a movement unit (9) driven by an electric motor said at least one organized group of smoking articles along a substantially horizontal direction of movement (M) parallel to an axis of rotation (R) of said wrapping wheel (13);
 - b2)** - positioning the collar (6), moving it in a radial direction to said wrapping wheel (13) by means of a positioning operating unit (25), sequentially in peripheral drawers (14) of said wrapping wheel (13);
 - b3)** - transferring, in a radial direction to said wrapping wheel (13), a group of smoking articles already wrapped by the internal wrapping sheet (4), taking it from said movement unit (9), by means of a first transfer unit (22);
 - b4)** - delivering in a radial direction to said

wrapping wheel (13) the second external wrapping sheet (8) by means of a second transfer unit (27);

- b5)** - packaging and wrapping, by means of a wheel type final packaging and wrapping unit (34), the material received radially on each occasion from said central wrapping wheel (13) so as to form the packets (3);

characterized in that

- c)** it also provides to use both a first step-wise servomotor (71A) in order to drive said wrapping wheel (13) and at least two second step-wise servomotors (71B) each associated with one of said operating units (22, 25, 26, 27, 34, 37), wherein each of said step-wise servomotors (71A, 71B) is provided with a position transducer, and also to subordinate the functioning of said step-wise servomotors (71A, 71B) to a central command and control unit (100) of the programmable type associated to an electronic memory containing a programmable data and times base (101) which contains information relating to one or more work cycles to be carried out, said method also providing, for the purposes of control and command:

- c1)** - to combine, in a bidirectional and independent manner, said first stepwise servomotor (71A) of said wrapping wheel (13) with at least one of said second step-wise servomotors (71B) of said operating units (22, 25, 26, 27, 34, 37) controlled by said central unit (100);
- c2)** - to determine, by means of said central unit (100), for each pair (A-B1; A-B2; A-B3; A-B4; A-Bn) of step-wise servomotors (71A, 71B), combined with each other, a univocal and bidirectional dialog, on the basis of the

data and times memorized in said electronic memory containing the programmable data and times base (101) and the information provided by the position transducers of the step-wise servomotors (71A, 71B) concerned, so that the information supplied by said transducers and associated to said dialog are compared by the said central unit (100) with the information contained in said electronic memory containing the programmable data and times base (101) in order to verify their conformity with the corresponding work cycle to be carried out;

c3) - to introduce possible corrections to said step-wise servomotors (71A, 71B) when said central unit (100) finds any possible anomaly;

d) wherein said method provides to effect, by means of said central unit (100) and presence sensor means, for each of said pairs (A-B1; A-B2; A-B3; A-B4, A-Bn) of step-wise servomotors,

d1) a first verification of

d11) • the presence of a determinate material selected from among one or the other of said organized group of smoking articles, first (4) and second (8) wrapping sheet and collar (6) on a first component (A) of the pair of step-wise servomotors and/or

d12) • the presence or absence of a specific operating part of one of said operating units (22, 25, 26, 27, 34, 37) and/or said central wrapping wheel (13) and,

d2) if positive, a second verification of

d21) • the presence of a coordinated material selected from one or the other of said

organized group of smoking articles, first (4) and second (8) wrapping sheet and collar (6) on a second step-wise servomotor (B1, B2, B3, B4, Bn) of the pair and/or

d22) • the presence or absence of a specific operating part of one of said operating units (22, 25, 26, 27, 34, 37) and/or said central wrapping wheel (13)

d3) and in a further positive case to start the work cycle, whereas in a negative case for the first or the second verification to repeat the control cycle from the start."

X. Independent claim 7 of the main request reads as follows:

"Command and control apparatus to control a packing machine (1) of finished packets (3) of smoking articles, extending along a single substantially vertical plane and having a central wrapping wheel (13) and at least two of the following operating units (22, 25, 26, 27, 34, 37):

- a movement unit (9) driven by an electric motor and suitable to feed said smoking articles toward said wrapping wheel (13) along a substantially horizontal direction of movement (M) parallel to an axis of rotation (R) of said wrapping wheel (13);
- a positioning unit (25) suitable to position sequentially a plurality of small collars (6) moving them in a radial direction with respect to said wrapping wheel (13) toward peripheral drawers (14) of said wrapping wheel (13);
- a first transfer unit (22) suitable to transfer in a radial direction with respect to said wrapping wheel (13) said smoking articles already wrapped by

an internal wrapping sheet (4), taking it from said movement unit (9);

- a second transfer unit (27) suitable to deliver an external wrapping sheet (8) in a radial direction into said peripheral drawers (14) of said wrapping wheel (13);

- a wheel type final packaging and wrapping unit (34) suitable to receive radially from said wrapping wheel (13) the material introduced therein on each occasion so as to form said packets (3); wherein said command and control apparatus comprises a central command and control unit (100) of the programmable type associated to an electronic memory containing a programmable data and times base (101) which contains information relating at least to one or more work cycles to be carried out,

characterized in that it also comprises a first step-wise servomotor (71A) associated with said wrapping wheel (13) and at least two second step-wise servomotors (71B) each associated to one of said at least two operating units (22, 25, 26, 27, 34, 37), wherein each of said first and second step-wise servomotors (71A, 71B) is provided with a position transducer and is controlled by said central command and control unit (100) of the programmable type, so that said first stepwise servomotor (71A) associated with said wrapping wheel (13) is combined for the purposes of the control and command in a bidirectional and independent manner with at least one of said two second step-wise servomotors (71B) of said operating units (22, 25, 26, 27, 34, 37), said central unit (100) being configured to determine, for each pair (A-B1; A-B2; A-B3; A-B4; A-Bn) that is created between said first step-wise servomotor

(71A) and one of said second step-wise servomotors (71B), a univocal and bidirectional dialog, which is assisted by said central unit (100), on the basis of the data and times memorized in said electronic memory containing the programmable data and times base (101) and the information supplied by the position transducers of the step-wise servomotors (71A, 71B) involved, so that the information supplied by said transducers and associated to said dialog are compared by said central unit (100) with the information contained in said electronic memory containing the programmable data and times base (101) in order to verify their conformity with the corresponding work cycle to be carried out, wherein said operating units (22, 25, 26, 27, 34, 37) comprise one or more presence sensors suitable to detect the presence of material in one or more of said operating units (22, 25, 26, 27, 34, 37) and/or the presence or absence of a specific operating part of one of the operating units (22, 25, 26, 27, 34, 37) and/or of said central wrapping wheel (13), said presence sensor means being associated with said central unit (100), wherein said central command and control unit (100) is configured to effect, by means of said presence sensors, for each of said pairs (A-B1; A-B2; A-B3; A-B4, A-Bn) of step-wise servomotors, a first verification of the presence of a determinate material selected from among one or the other of said organized group of smoking articles, first (4) and second (8) wrapping sheet and collar (6) on a first component (A) of the pair of step-wise servomotors and/or the presence or absence of a specific operating part of one of said operating units (22, 25, 26, 27, 34, 37) and/or said central

wrapping wheel (13) and, if positive, a second verification of the presence of a coordinated material selected from one or the other of said organized group of smoking articles, first (4) and second (8) wrapping sheet and collar (6) on a second step-wise servomotor (B1, B2, B3, B4, Bn) of the pair and/or the presence or absence of a specific operating part of one of said operating units (22, 25, 26, 27, 34, 37) and/or said central wrapping wheel (13) and in a further positive case to start the work cycle, whereas in a negative case for the first or the second verification to repeat the control cycle from the start.

XI. In independent claim 1 of auxiliary request 18 feature b1) is amended, with respect to claim 1 of the main request, as follows (additions are shown underlined, deletions are struckthrough):

~~"feeding by a movement unit (9) driven by an electric motor~~ said at least one organized group of smoking articles, through a movement unit (9) driven by an electric motor, in order to move the group of smoking articles at least partly wrapped by said corresponding first internal wrapping sheet (4) along a substantially horizontal direction of movement (M) parallel to an axis of rotation (R) of said wrapping wheel (13), wherein said movement unit (9) comprises an endless belt (10) closed in a ring around two pulleys rotating around respective horizontal axes, and advancing with varied motion along said direction of movement (M) and wherein said movement unit (9) comprises a plurality of abutment elements (11), attached to said endless belt (10) and which extend transversely with respect to said direction of movement (M), disposed to abut on a smaller side of the group of smoking

articles wrapped in corresponding first internal wrapping sheets (4) so as to move the latter along said direction of movement (M)".

XII. In independent claim 7 of auxiliary request 18 the corresponding feature is amended, with respect to claim 7 of the main request, as follows (additions are shown underlined):

"a movement unit (9) driven by an electric motor and suitable to feed said smoking articles at least partly wrapped by a corresponding first internal wrapping sheet (4) toward said wrapping wheel (13) along a substantially horizontal direction of movement (M) parallel to an axis of rotation (R) of said wrapping wheel (13), wherein said movement unit (9) comprises an endless belt (10) closed in a ring around two pulleys rotating around respective horizontal axes, and configured to advance with varied motion along said direction of movement (M) and wherein said movement unit (9) comprises a plurality of abutment elements (11), attached to said endless belt (10) and which extend transversely with respect to said direction of movement (M), disposed to abut on a smaller side of the group of smoking articles wrapped in corresponding first internal wrapping sheets (4) so as to move the latter along said direction of movement (M)".

Reasons for the Decision

1. *Claims 1 and 7 - main request - Article 123(2) EPC*

1.1 The contested amendments relate to feature b1) of independent claim 1 of the main request, which reads as

follows (additions with respect to claim 5 as originally filed are shown underlined, deletions are struckthrough):

"feeding by a movement unit (9) driven by an electric motor said at least one organized group of smoking articles ~~(2)~~ along a substantially horizontal direction of movement (M) parallel to an axis of rotation (R) of said wrapping wheel (13)"

Independent claim 7 of the main request was correspondingly amended as follows (additions with respect to claim 1 as originally filed are shown underlined):

"a movement unit (9) driven by an electric motor and suitable to feed said smoking articles toward said wrapping wheel (13) along a substantially horizontal direction of movement (M) parallel to an axis of rotation (R) of said wrapping wheel (13)"

- 1.2 The opposition division found that the amendments fulfilled the requirements of Article 123(2) EPC as figures 1 and 2 together with the description on page 9, lines 16 to 28, of the application as originally filed, provided the basis for independent claims 1 and 7 as amended.

The cited passage of the description reads as follows:

"The packing machine 1 also includes movement means 9 (fig. 2) driven by an electric motor 71, advantageously a step motor of the brushless type, in order to move the groups of wrapped cigarettes, at least partly, in their corresponding internal wrapping sheets 4, along a substantially horizontal direction of movement M. In this case, the movement

means 9 comprise an endless belt 10 closed in a ring around two pulleys, not shown, rotating around respective horizontal axes, and advancing with varied motion along the direction of movement M. In the solution shown, the movement means 9 also comprise a plurality of abutment elements 11, attached to the endless belt 10 and which extend transversely with respect to the direction of movement M, disposed to abut on a smaller side of the group of cigarettes wrapped in the corresponding internal wrapping sheets 4 so as to move the latter along the direction of movement M."

The opposition division reasoned that the further features, which the appellant had argued should be included in the claim, showed only possible examples that were not inextricably linked to the movement means.

- 1.3 In its statement of grounds of appeal, the appellant argued that the opposition division's findings were incorrect as the additional features found in the cited passage of page 9 of the application as originally filed and not included in the claims, formed part of the same embodiment and were structurally and functionally related to the introduced features.
- 1.4 According to established case law, it is not normally allowable to base an amended claim on the extraction of isolated features from a set of features originally disclosed only in combination, unless the skilled person can recognise that there is no clearly recognisable functional or structural relationship among the features of the specific combination (Case Law of the Boards of Appeal (CLB), 10th edition 2022, II.E.1.9.1).

- 1.5 The respondent argued that from the wording of the cited passage alone, the person skilled in the art clearly understood that the first sentence referred to the movement means in a general manner and was not linked to the specific disclosure of the movement means in the second and third sentences of this paragraph.
- 1.5.1 The respondent followed the reasoning given by the opposition division, that the phrase "[i]n this case" as used on page 9, line 20, of the application as originally filed, indicated that the features following this phrase referred only to a possible example of the movement means.
- 1.6 The board disagrees. The skilled person understands the cited passage on page 9, lines 16 to 28, as a whole. It refers to a specific embodiment of movement means for feeding an organized group of smoking articles along a substantially horizontal direction of movement.
- 1.7 The opposition division had cited the passage on page 10, lines 9 to 10 of the application as originally filed in support of its understanding of the phrase "in this case".
- 1.7.1 The passage on page 10, lines 9 to 10 of the application as originally filed, reads:
"transfer means, in this case a transfer wheel 27, although they could be linear, like conveyor belts,...".

Here, the phrase "in this case" can be understood as referring to one of a number of possibilities, as further examples are also given.

1.7.2 The passage on page 9, lines 20 to 28, however, reads differently, namely "*In this case, the movement means 9 comprise an endless belt...*". The skilled person understands this to refer back to the movement means 9 as shown in figure 2 ("this case") such that the passage provides further details of these specific movement means, rather than disclosing optional exemplary features. This is further emphasised by the use of "In the solution shown..." on page 9, line 23, indicating further features, all relating to the same embodiment. This cannot be understood as referring to features which are merely possible examples of the movement means 9.

1.7.3 The respondent argued that although "fig 2" was present in the first sentence of the paragraph, it did not refer to a particular embodiment but merely indicated where the movement means 9 could be seen in the figures.

The respondent argued further that the originally filed documents showed more than one single embodiment with a movement unit feeding groups of cigarettes in a substantially horizontal direction of movement parallel to an axis of rotation of a wrapping wheel. According to the respondent the embodiment of figures 8 and 9 showed different abutment elements to the embodiment of figure 2.

The board disagrees. The skilled person understands figures 8 and 9 as showing the apparatus of figures 1 and 2 in particular operational situations. On page 8, lines 25 to 26 of the application as originally filed it is stated that to "facilitate comprehension, the same reference numbers have been used, where possible to identify identical common elements in the drawings".

The same reference numerals are used in figures 2, 8 and 9 and the drawings, which are in any case sketches, not technical drawings, show the same components. As argued by the appellant, the difference between figures 2, 8 and 9 is in the viewing angle, not the operating units.

There is therefore only one embodiment showing a movement unit or means to feed groups of cigarettes in a substantially horizontal direction of movement parallel to an axis of rotation of the wrapping wheel. The omitted features of this embodiment described on page 9, lines 20 to 28 are functionally related to the included features as it is the omitted features, namely the endless belt and abutment elements attached to the belt, which cause the movement of the organized group of smoking articles along a substantially horizontal direction of movement parallel to an axis of rotation of the wrapping wheel.

- 1.8 The respondent also argued that the skilled person, using their common general knowledge, was aware of many alternative means of providing horizontal movement, not limited to the examples given in the cited passage of page 9, lines 20 to 28.
- 1.8.1 The board notes, however, that when determining whether a claim contains subject-matter extending beyond the content of the application as filed, it must be assessed what the skilled person directly and unambiguously understands from the original disclosure, not what may have been rendered obvious to them (CLB, *supra*, II.E.1.3.4 a)).
- 1.8.2 In the present case, the existence of other, equally feasible, ways in which the movement means could be put

into practice may be obvious to the skilled person, but this does not represent a direct and unambiguous disclosure of those possibilities in the application as filed.

1.9 A further argument of the respondent is that the features of the direction of movement and axis of rotation are not mentioned anywhere else in claim 1, so they are not inextricably linked to the other claimed features and the omission of the further features therefore has no consequences for other claimed features.

1.9.1 However, when assessing the allowability of an intermediate generalisation, it does not generally have to be considered whether the features which have been introduced into the claim are inextricably linked to the original features of the claim or not, but rather whether the omitted features of the embodiment are inextricably linked (or functionally or structurally related) to the features which were introduced into the claim.

In other words, whether the skilled person could directly and unambiguously derive from the application documents that some features of an embodiment could be isolated and extracted from other features and used in a more general context.

1.10 The respondent's further argument that the omitted features were not inextricably linked to the newly introduced features since they were not relevant to solving the technical problem solved by the invention, is also not persuasive.

1.10.1 The respondent cited decision T 879/09 in support of its contention. This decision however, although indeed mentioning that a particular feature was not related to solving the problem addressed by the invention, uses this criteria as a test to aid in deciding whether the combination of claimed features was directly and unambiguously derivable from the application as originally filed, i.e. the "gold standard" as confirmed by the Enlarged Board of Appeal in G 2/10, Reasons 4.3 (see T 879/09, Reasons 2.1.3, 2.1.5, 2.2.1).

It is established case law, however, that tests developed for different cases of amendments are only meant to provide assistance in determining the allowability of an amendment but do not take the place of the "gold standard" (see CLB, *supra*, II.E.1.3.1, fifth paragraph; T 1791/12, Reasons 2.1.2).

1.11 The skilled person cannot directly and unambiguously derive from the application documents as a whole a movement unit or means driven by an electric motor which feeds organized groups of smoking articles along a substantially horizontal direction of movement (M) parallel to an axis of rotation (R) of said wrapping wheel (13) but does not include the further features disclosed in the passage of page 9, lines 20 to 28. There is no indication in the application documents as originally filed that only the features of the first sentence of that paragraph can be used in isolation from the further features.

1.12 The requirements of Article 123(2) EPC are therefore not fulfilled for claims 1 and 7 of the main request.

*Auxiliary request 18 - admittance into the appeal proceedings -
Article 13(2) RPBA 2020*

2. Auxiliary request 18 was filed with the respondent's submissions of 31 May 2023, i.e. after the summons to oral proceedings had been issued.
 - 2.1 The appellant requested that the newly filed request not be considered in the appeal proceedings as no exceptional circumstances were present as required by Article 13(2) RPBA 2020.
 - 2.2 According to Article 13(2) RPBA any amendment to a party's appeal case filed after the notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified by cogent reasons by the party concerned.
 - 2.3 With respect to auxiliary request 18, the respondent argued that although this request was a new request, it was filed in direct response to a new objection raised by the board in its preliminary opinion, which constituted exceptional circumstances.
 - 2.4 The board, however, agrees with the appellant that no new objection was raised by the board in its preliminary opinion. The board followed the objection raised by the appellant in its statement of grounds of appeal, which had also formed part of the opposition proceedings and was dealt with in the decision under appeal.
 - 2.4.1 The respondent argued that it was only with the preliminary opinion of the board that it became apparent that the further features of the passage on

page 9, lines 20 to 28 of the application as originally filed might be required to be introduced into claims 1 and 7 in order to overcome the objection under Article 123(2) EPC.

- 2.4.2 The board notes that on page 6, second paragraph, and page 7, second and third paragraphs, of the appellant's statement of grounds of appeal it was stated that the features introduced into claims 1 and 7 during examination and opposition proceedings were isolated from the cited passage which described more structurally and functionally related features.

This objection was also raised and discussed during the opposition proceedings as can be seen from the minutes of the oral proceedings before the opposition division, which mention that the opponent expressed the view that the added features were only disclosed together with the features in the sentences starting on page 9, lines 20 and 23, and page 10, line 1 (see minutes, paragraph bridging pages 1 and 2).

- 2.4.3 In its preliminary opinion, the board did not go beyond the objection raised by the appellant (see the board's communication pursuant to Article 15(1) RPBA 2020, point 7.8).

- 2.5 The respondent argued that the appellant had not clearly set out the objection in its statement of grounds of appeal, so that it became clear only with the board's preliminary opinion.

- 2.5.1 In the board's view, the objection was set out sufficiently clearly in the statement of grounds of appeal. In any case, the board follows the decision in case T 450/20 that the refining of an objection,

whether by the board or another party, does not automatically constitute an amendment which could be regarded as an exceptional circumstance justifying the filing of a new set of claims (see T 450/20, Reasons 4.6).

2.6 Therefore, no new objection was raised by the board which could be regarded as providing an exceptional circumstance justifying the filing of auxiliary request 18 after the summons to oral proceedings.

3. The respondent also brought forward an alternative line of argument, citing a number of cases where boards of appeal had determined that exceptional circumstances could also exist when a request did not compromise procedural economy and did not adversely effect other parties. As the claims of auxiliary request 18 overcame the objection raised and did not give rise to any new objections, it should be admitted into the appeal proceedings for this reason alone.

3.1 The appellant argued on this point that auxiliary request 18 was not *prima facie* allowable as the subject-matter of claims 1 and 7 did not fulfil the requirements of Articles 84 or 123(2) EPC. The appellant also requested remittal of the case to the opposition division should auxiliary request 18 be admitted into the proceedings, in order to have further objections relating to patentability considered.

3.2 The board considers that, although there is no obligation to assess the *prima facie* allowability of a new claim request in order to conclude that there are no exceptional circumstances under Article 13(2) RPBA 2020 justifying its admittance into the appeal proceedings (see T 2787/17, Reasons 4.1.3 and T 574/17,

Reasons 2.3.3), a board may also rely on criteria as set out in Article 13(1) RPBA 2020 when exercising its discretion under Article 13(2) RPBA 2020 (see T 172/17, Reasons 5.4, T 574/17, Reasons 2.3.1, T 487/20, Reasons 2.2; as to documents see also T 463/19, Reasons 3.3.3). These criteria include whether the amendments overcome the issues raised and do not give rise to new objections.

- 3.3 As set out by the appellant, at least claim 7 does not *prima facie* fulfil the requirements of Article 84 EPC. The feature "said smoking articles at least partly wrapped by a corresponding first internal wrapping sheet" has been introduced into the claim. The claim further mentions "the group of smoking articles" without previously defining a group so that it is unclear how the first mentioned "smoking articles" are related to "the group of smoking articles". Therefore, although the amendments to claims 1 and 7 of auxiliary request 18 appear to overcome the objection under Article 123(2) EPC, they give rise to new objections.
4. Hence, for the reasons set out in points 2 and 3 above, the board does not admit auxiliary request 18 into the appeal proceedings.
5. *Respondent's request for referral of a question to the Enlarged Board of Appeal*
- 5.1 The respondent requested that the following question be referred to the Enlarged Board of Appeal:

"Is an amendment to a party's case filed in reaction to the preliminary opinion of the Board, that is filed before the hearing and that resolves all the issues raised by another party in an appeal

procedure not to be admitted into the proceedings by the Board using its discretionary power only for the reason that it is not in conformity with Art. 13(2) RPBA 2020?"

- 5.2 Under Article 112(1)(a) EPC a board of appeal refers a question to the Enlarged Board of Appeal if it considers an answer to the question necessary to either ensure a uniform application of the law or if a point of law of fundamental importance arises.

The issue of whether or not to refer a question is a discretionary decision by the board (see CLB, *supra*, V.B.2.3.2). In order for a referral to be admissible, the referred question must be relevant for deciding the case in question (see CLB, *supra*, V.B. 2.3.3).

For the following reasons, the board refuses the respondent's request for referral.

- 5.3 Firstly, the question suggested by the respondent is not relevant for deciding the case as it is based on the erroneous assumption that the "amendment to a party's case" underlying the suggested question, i.e. auxiliary request 18, resolved "all the issues raised". As set out in point 3.3 above, this request rather gave rise to new objections which the board considered *prima facie* convincing.

- 5.4 Secondly, auxiliary request 18 was only in terms of chronological order "filed in reaction to the preliminary opinion of the Board". Legally speaking it was, as set out in point 2.5.1 above, filed in reaction to an existing objection of the appellant, not in reaction to a new objection raised in the preliminary opinion of the board (see point 2. above). Hence, the

question suggested by the respondent is also in this regard based on an erroneous assumption.

5.5 Thirdly, the question essentially asks whether a late-filed claim request constituting an amendment under Article 13(2) RPBA 2020 should not be admitted in the appeal proceedings "only for the reason that it is not in conformity with Art. 13(2) RPBA 2020". The Board considers that, for appeal proceedings, the RPBA 2020 implement Article 114(2) EPC in a manner which in principle is binding (T 1776/18, Reasons 4.6.3). This part of the question can be answered by the Board itself without doubt.

5.6 Fourthly, Article 13(2) RPBA 2020 confers a certain degree of discretion on the board. This is also reflected in the question suggested by the respondent, which speaks about "the Board using its discretionary power". Discretion means that there are, in principle, multiple legally correct options available to a board (J 14/19, Reasons 8.3). Moreover, the exercise of discretion is usually highly dependent on the specific circumstances of the case.

The differences in outcomes in the cases cited by the appellant result in the board's view from the inherent multitude of possible, legally correct decisions when exercising discretion, as well as from differences in the factual circumstances of the individual cases. To the extent that the answer to the question suggested by the respondent depends on the individual circumstances of a case, the question does not concern a "point of law of fundamental importance" within the meaning of Article 112(1) EPC, which would be "relevant to a large number of similar cases" (G 1/12, Reasons 10).

6. In conclusion, the main request is not allowable so that the decision under appeal must be set aside and the sole auxiliary request is not admitted into the proceedings. Therefore in the absence of an allowable and admissible request, the patent must be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for referral of a question to the Enlarged Board of Appeal is refused.

The Registrar:

The Chairman:



G. Nachtigall

G. Patton

Decision electronically authenticated