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**Datasheet for the decision
of 15 November 2024**

Case Number: T 0129/23 - 3.2.05

Application Number: 08870412.7

Publication Number: 2239144

IPC: B41J3/407, B23K26/08

Language of the proceedings: EN

Title of invention:

Method and arrangement for rotational marking

Patent Proprietor:

On-Laser Systems & Applications, S. L.

Opponent:

Patentree, Lda

Relevant legal provisions:

EPC Art. 54(1), 100(a)

EPC R. 99(2), 101(1)

RPBA 2020 Art. 12(2), 12(4), 12(6), 13(2)

Keyword:

Admissibility of appeal (yes)

Admittance of late-filed evidence

Grounds for opposition - lack of novelty (yes)

Late-filed auxiliary request - exceptional circumstances (no)
- admitted (no)

Decisions cited:

T 1311/21



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Case Number: T 0129/23 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 15 November 2024

Appellant: Patentree, Lda
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Representative: Patentree
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 October 2022
rejecting the opposition filed against European
patent No. 2239144 pursuant to
Article 101(2) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: M. Holz
F. Blumer
T. Vermeulen
M. Blasi

Summary of Facts and Submissions

I. The opponent (appellant) filed an appeal against the decision of the opposition division rejecting the opposition against European patent No. 2 239 144 (the patent).

With its statement of grounds of appeal, the appellant filed the following documents:

- D23: Orientalmotor, "RoHS-Compliant Speed Controller ES01/ES02", excerpt, April 2007
- D24: Orientalmotor, "RoHS-Compliant Speed Controller ES01/ES02", April 2007
- D25: The appellant's letter dated 15 October 2021
- D26: The appellant's letter entitled "Response to the communication under Art. 101(1) and R. 81(2) and (3) EPC" filed on 29 May 2017

On page 5 of its statement of grounds of appeal, the appellant also provided a link to a video file (video D27). The appellant sent the video file on a USB stick by letter dated 20 March 2023.

II. The patent proprietor (respondent) filed a reply to the appellant's statement of grounds of appeal.

On 11 October 2023, summons to oral proceedings before the board were issued as requested.

By letter dated 21 December 2023, the appellant filed submissions in response to the respondent's reply.

On 20 September 2024, the board issued a communication under Article 15(1) RPBA.

By letter dated 25 October 2024, the respondent filed submissions including annexes. With its letter, it filed, inter alia, the following document:

D30: Affidavit of Mr Oscar Vila Closas dated
24 October 2024

In this letter, it also requested that Mr Oscar Vila Closas be heard as a witness.

By letter dated 13 November 2024 (received on 14 November 2024), the appellant filed further submissions.

III. Oral proceedings before the board were held on 15 November 2024.

IV. The following documents filed during the opposition proceedings are referred to in this decision:

D1: WO 2006/066866 A1
D5: US 3,404,254
D8: CN 101007455 A
D17: Web page "Calendar", http://on-laser.com/decork/index_archivos/Page1056.htm, 22 July 2015
D22: Video "DSCN5142.MOV" referred to on page 6 of the respondent's letter dated 15 October 2021
D26a: Affidavit of Mr António Armindo Silva Oliveira dated 20 April 2017, filed by the appellant on 29 May 2017

Video D22 was sent to the appellant by email and shown during the oral proceedings before the opposition division.

On page 9 of its letter dated 15 October 2021, the appellant submitted a web link (<https://www.youtube.com/watch?v=BQD5H0Pmriw>) to a video (video D28).

V. The board had to decide on the following requests.

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The appellant further requested

- that video D22 not be admitted into the proceedings; and
- that the affidavit of Mr Oscar Vila Closas filed with the respondent's letter dated 25 October 2024, the request to hear Mr Vila Closas as a witness submitted with the same letter, the respondent's auxiliary request filed with the same letter as well as any new factual allegations submitted with said letter not be admitted.

In case the affidavit of Mr Vila Closas and/or the new witness testimony request be admitted, the appellant requested that the witnesses Mr Gomes and Mr Oliveira be heard again, that Professor Américo Azevedo be heard as a new witness and that a different apportionment of cost be ordered should a new witness hearing take place at a later date.

The respondent requested that the appeal be rejected as inadmissible or dismissed. The respondent further

requested, as an auxiliary request, that the decision under appeal be set aside and the patent be maintained as amended based on the claims of the auxiliary request filed with the respondent's letter dated 25 October 2024.

The respondent further requested

- that Mr Vila Closas be heard as a witness;
- that documents D23 to D26 not be admitted into the proceedings;
- that video D27 not be admitted into the proceedings;
- that the appellant's factual allegation that the variable rotational speed during laser marking of the cork stoppers had been orally disclosed to the attendees of the FEICOR 2008 fair not be taken into consideration;
- that the witness testimonies of Mr Gomes and Mr Oliveira not be admitted into the proceedings;
- that the submissions in points 8.11 to 8.22 of the statement of grounds of appeal not be admitted into the proceedings and
- that the submissions in the appellant's letter dated 13 November 2024 not be admitted into the proceedings.

VI. Claim 1 as granted reads:

"Method for marking or machining cylindrical elements rotating at a variable speed, preferably natural cork stoppers, agglomerated cork stoppers or synthetic materials used to close drinks like wine or similar, comprising the following steps:

A. arranging at least one cylindrical element in one or several systems of continuous or discontinuous rotary motion, located in the optical field of action for at

least a marking head or spatial modulator of a laser system;

B. rotating the at least one cylindrical element at a variable speed;

C. detecting the instant tangential speed at the surface of the cylindrical element located on the system of continuous or discontinuous rotary motion;

D. positioning the laser beam on the surface of the cylindrical element by means of spatial modulation of the laser beam in a synchronized manner with the instant tangential speed at the surface of the cylindrical element; and

E. applying a focused continuous or pulsed laser radiation on the surface of the cylindrical element to complete the marking of one or more dots or lines of a predetermined pattern."

Independent claim 7 as granted is directed to a device for rotary marking or machining of cylindrical materials suitable to perform the method described in claim 1.

VII. The parties submitted the following.

(a) Admissibility of the appeal

(i) Respondent

The appeal should be rejected as inadmissible under Rule 101(1) EPC since the appellant's statement of grounds of appeal did not meet the requirements of Rule 99(2) EPC. The statement of grounds of appeal lacked an appropriate discussion of the decision under appeal and did not address the arguments of the opposition division. It failed to explain why the opposition division had been wrong in considering the

claimed subject-matter to satisfy the requirements of the EPC.

(ii) Appellant

The appeal was admissible. The statement of grounds of appeal met the requirements of Rule 99(2) EPC since it, *inter alia*, explained that the feature of a variable rotational speed did not have a technical effect and should therefore not be considered when assessing inventive step (see point 8.1 of the statement of grounds of appeal).

(b) Admittance of the parties' late-filed submissions

(i) Appellant

The opposition division had incorrectly considered that the factual allegation that the feature of rotating the at least one cylindrical element at a variable speed had been disclosed orally at FEICOR 2008 had been presented for the first time during the oral proceedings before the opposition division. This factual allegation had already been submitted in the appellant's letter received on 29 May 2017. The opposition division's decision not to admit this factual allegation suffered from an error in the use of discretion and should be reversed.

The results of the witness hearings of Mr Gomes and Mr Oliveira were very relevant to the issues at hand and should not be disregarded.

Video D22 should not be admitted. This video had been filed late and by email, which was not a standard way to file evidence.

Documents D23 and D24 were identical to the documents filed during the oral proceedings before the opposition division on 16 December 2021 at 11.34 hrs. They were data sheets of speed controller ES02. The respondent had cited from these documents in its letters without indicating the source of the citations. The respondent alleged that the speed controller ES02 had been used at FEICOR 2008. To give a full picture of the speed controller's technical capability and to counter the respondent's arguments, documents D23 and D24 should be admitted for reasons of procedural efficiency and procedural fairness.

There was no reason for not taking documents D25 and D26 into account.

Video D27 should be admitted into the proceedings. It had been filed in reaction to the admittance of video D22 at the oral proceedings before the opposition division. Video D27 was relevant to the issue of what had been disclosed to the public at FEICOR 2008. The video was a slow-motion excerpt of video D28, which was part of the proceedings. Video D27 did not contain any more information than video D28.

The affidavit of Mr Oscar Vila Closas (document D30) and the request to hear him as a witness should not be admitted into the proceedings. There were no exceptional circumstances within the meaning of Article 13(2) RPBA. The request to admit the factual allegations of a public oral disclosure had been submitted in the statement of grounds of appeal. It had already been submitted in the letter received on 29 May 2017 that the presentation at FEICOR 2008 had involved an oral disclosure, i.e. the explanations by

Mr Vila Closas. Point 7.1.2 of the board's communication under Article 15(1) RPBA addressed the objection of lack of novelty in view of the public disclosure at FEICOR 2008 against claim 1 as granted. This objection had been raised in the opposition proceedings, was decided upon by the opposition division and was maintained in the statement of grounds of appeal.

Any new factual allegations included in the respondent's letter dated 25 October 2024 should not be admitted into the proceedings. This letter had been filed late, and no exceptional circumstances applied.

(ii) Respondent

The appellant had first submitted an alleged prior public use by oral disclosure for the device and the method, which corresponded to those claimed in the patent, in a letter of 29 May 2017 (see page 7 of the respondent's reply to the appellant's statement of grounds of appeal). This was a new fact submitted after the notice of opposition had been filed. The opposition division's decision not to admit it was correct. It was disputed that the factual allegation of an oral disclosure of the patented subject-matter had already been brought forth in the appellant's letter dated 29 May 2017 (see page 6, second paragraph of the respondent's letter dated 25 October 2024).

The results of the witness hearings of Mr Gomes and Mr Oliveira during the oral proceedings before the opposition division should not be admitted into the proceedings. The witnesses' statements were not credible.

The appellant's request not to admit video D22 had been filed late. This video should not be disregarded.

The opposition division's decision not to admit documents D23 and D24 should only be reversed if it suffered from an error in the use of discretion.

Documents D25 and D26 had been filed with the statement of grounds of appeal and should not be admitted into the proceedings.

Video D27 should not be admitted into the proceedings. It had been filed late, was not prior art and was not relevant to the issues at hand. Video D27 did not contain any more information than video D28.

The affidavit of Mr Oscar Vila Closas (document D30) and the request to hear him as a witness should be admitted into the proceedings. The circumstances were exceptional within the meaning of Article 13(2) RPBA for two reasons. The board had decided to admit the factual allegations of an alleged oral disclosure at FEICOR 2008 into the proceedings. Moreover, in point 7.1.2 of its communication under Article 15(1) RPBA, the board had been of the preliminary opinion that the witness testimonies proved that there had been a public disclosure of the subject-matter of claim 1 as granted. This was a new objection raised by the board.

The submissions in the appellant's letter dated 13 November 2024 should not be admitted into the proceedings. They had been filed late, and there had been too little time to study the letter in depth.

(c) Ground for opposition under Article 100(a) in conjunction with Article 54(1) EPC

(i) Appellant

The subject-matter of claim 1 as granted had been publicly disclosed at FEICOR 2008 and was thus not new. The witnesses Mr Gomes and Mr Oliveira stated in their witness testimonies that the rotational speed of the cork stopper increased in areas where nothing needed to be printed. Mr Gomes and Mr Oliveira had been members of the public at FEICOR 2008. The respondent did not convincingly demonstrate that they had been under an obligation of confidentiality. The witness hearings took place in the course of a videoconference. The witnesses could see the videos only through the Zoom link. The videos that the witnesses saw during their online hearings were jittery and full of artefacts. The witnesses had explained that the machine shown in video D22 was not the machine presented at FEICOR 2008. Mr Oliveira had declared that he had seen many cork stoppers being marked by Mr Vila Closas at FEICOR 2008, not only the personalised cork stopper. The photographs on file demonstrated that the public could see the machine's interior through the laser protection screens. As demonstrated by document D24, speed controller ES02 supported rotation at variable speed. According to page 23 of document D24, this controller had a cooling-off cycle that was compatible with the presentation at FEICOR 2008 and the estimated marking duration of 1.8 to 2.4 seconds per cork stopper. The witnesses had emphasised that the marking speed had been an important factor at the time of FEICOR 2008. It could thus be assumed that they paid particular attention to the rotational speed of the cork stoppers. The alleged prior use was under the control and charge

of the respondent. The balance of probabilities was thus the applicable standard of proof.

(ii) Respondent

Both witnesses had mentioned that the rotational speed of the cork stopper increased in areas where nothing needed to be printed (see page 30, last paragraph of the minutes of Mr Oliveira's hearing and page 14, fourth paragraph of the minutes of Mr Gomes' hearing). However, Mr Gomes had not been a member of the public. He had been an employee of the company Azevedos. The stand at which the public disclosure took place had been run by Azevedos. The machine presented at FEICOR 2008 had been the result of a joint venture of the respondent and Azevedos. According to Mr Oliveira's witness testimony, he thought at the time of his hearing that he had common interests with Azevedos. When being shown video D22 at their witness hearings, Mr Gomes and Mr Oliveira declared that they could see the cork stopper rotating at variable speed. However, video D22 only showed rotation at constant speed. The witnesses' statements that they could see a rotation at variable speed at FEICOR 2008 were thus not credible. Mr Oliveira had stated that a personalised cork stopper was printed for him (see photos in document D26a) and that while this cork stopper was printed, he could see the cork stopper speed up (see document D26a, page 1, fifth paragraph). There was an inconsistency in that text/image had to be printed on every part of the personalised cork stopper in the printing range, or the regions without text/image would be so small that an acceleration/deceleration would be impossible to observe. The marking of the cork stoppers at FEICOR 2008 took place behind laser protection screens. The laser protection screens had not been opaque. However,

little light could pass through. At FEICOR 2008, speed controller ES02 (see documents D23 and D24) had been used. This speed controller only supported stop-and-go motor operation; not a rotation at variable speed. The graph on the left of page 23 of document D24 showed the lowest possible acceleration time of about 0.5 seconds. The graph on the right showed the lowest possible deceleration time of about 2.5 seconds. This would already have exceeded the time it took to print the whole cork. The graphs on page 23 of document D24 referred to a rotational speed of 1000 rpm. The rotational speed of the motor at FEICOR 2008 was unknown and was estimated to be between 90 and 200 rpm based on a marking time per cork stopper of between 1.8 and 2.4 seconds. From document D24, it could not be derived how long the acceleration/deceleration time had been under the conditions used at FEICOR 2008. In the table below the graphs on page 23 of document D24, a minimum repetition cycle of 2 seconds was stated when the motor was operated in a low-power mode. This minimum cycle time would work when accelerating and decelerating the cork stopper had been done exactly one time during the marking of a single cork stopper, but not if it had been done multiple times during the marking. An acceleration/deceleration during the marking, in areas where nothing had to be printed, like the witnesses allegedly observed during FEICOR 2008, would not have been possible with the controller ES02. The purpose of the presentation at FEICOR 2008 was to demonstrate individual laser marking of cork stoppers and to give away personalised cork stoppers to visitors of the trade fair. The most important aspect had been that the cork stoppers had been marked on the fly, i.e. instantaneously, with a personalised image or text. The speed of the marking process had not been the focus. At the date of FEICOR 2008, the invention, in particular

the feature of rotating the at least one cylindrical element at a variable speed, had not been conceived. The opposite statement in the last two paragraphs on page 2 of the respondent's reply to the notice of opposition was based on a misunderstanding by the former representative. Mr Vila Closas therefore could not have orally disclosed at FEICOR 2008 that the cork stopper rotated at variable speed during the marking process. Mr Vila Closas had recorded video D22 at FEICOR 2008. The mode of operation visible in video D22 with a constant rotational speed of the marked cork stopper was the only mode of operation presented at FEICOR 2008. The burden of proof for an alleged public prior use was upon the appellant. The standard for such proof was "up to the hilt", in particular in a situation where the information for the alleged prior use was within the sphere of the appellant. Mr Gomes had been working for the company Azevedos, which had been involved in the construction of the setup used during FEICOR 2008. The appellant acted as a straw man for Azevedos.

(d) The respondent's auxiliary request

(i) Respondent

The auxiliary request would immediately resolve any issues of the appeal proceedings in a procedurally economical way and was thus prima facie relevant. The same exceptional circumstances as set out for the admittance of document D30 and the request to hear Mr Vila Closas as a witness applied to the auxiliary request.

(ii) Appellant

The respondent's auxiliary request should not be admitted into the proceedings. It had been filed very late. No exceptional circumstances applied.

Reasons for the Decision

1. Admissibility of the appeal
 - 1.1 The respondent refers to Rule 101(1) EPC and submits that the appeal should be rejected as inadmissible since the appellant's statement of grounds of appeal did not meet the requirements of Rule 99(2) EPC. The statement of grounds of appeal lacked an appropriate discussion of the decision under appeal and did not address the arguments of the opposition division. It failed to explain why the opposition division had been wrong in considering the claimed subject-matter to satisfy the requirements of the EPC.
 - 1.2 In its letter dated 21 December 2023, the appellant contests this view and submits that its statement of grounds of appeal met the requirements of Rule 99(2) EPC since it, inter alia, explained that the feature of a variable rotational speed did not have a technical effect and should therefore not be considered when assessing inventive step (see point 8.1 of the statement of grounds of appeal).
 - 1.3 Rule 99(2) EPC stipulates that in the statement of grounds of appeal, the appellant must indicate the reasons for setting aside the decision impugned, or the

extent to which it is to be amended, and the facts and evidence on which the appeal is based.

The appellant's statement of grounds of appeal meets the requirements of Rule 99(2) EPC. For example, in point 21.2.2 of the Reasons for the decision under appeal, the opposition division concluded that the subject-matter of claims 1 and 7 as granted involved an inventive step since none of the documents D1, D5 and D8 disclosed rotating the cylindrical element at a variable speed. If the board were to accept the appellant's view set out in point 8.1 of the statement of grounds of appeal that this feature should not be considered when assessing inventive step, the decision under appeal would have to be set aside.

Whether the requirements of Rule 99(2) EPC are met is furthermore independent of whether the board finds the appellant's submissions convincing.

The appeal is admissible.

2. Admittance of the parties' late submissions

2.1 Factual allegations of an oral disclosure at FEICOR 2008

According to point 21.2.1 of the Reasons for the decision under appeal, the allegation that the feature of rotating the at least one cylindrical element at a variable speed had been disclosed orally at FEICOR 2008 was considered by the opposition division a new factual allegation that had not been submitted by the opponent until the oral proceedings. The opposition division did not admit this factual allegation into the proceedings.

The appellant submits that the opposition division had incorrectly considered that the above factual allegation had been presented for the first time during the oral proceedings before the opposition division. It had already been submitted in the appellant's letter received on 29 May 2017 (see document D26).

On page 7 of its reply to the statement of grounds of appeal, the respondent stated that the appellant had first submitted an alleged prior public use by oral disclosure for the device and the method, which corresponded to those claimed in the patent, in a letter of 29 May 2017. On page 6, second paragraph of its letter dated 25 October 2024, the respondent disputed that the factual allegation of an oral disclosure of the patented subject-matter had already been brought forth in the appellant's letter dated 29 May 2017.

In accordance with Article 12(6), first sentence, RPBA, the board does not admit requests, facts, objections or evidence which were not admitted in the proceedings leading to the decision under appeal unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance.

At the top of the second page of its letter received on 29 May 2017, the appellant set out that Mr Oliveira stated in his affidavit (see document D26a) that the On-Laser technician had explained in detail the device operation mode and that On-Laser had emphasised the advantages of the device during the public fair, namely the speed of rotation of the cork when no marking was needed.

It was thus already submitted in this letter that the feature of rotating the at least one cylindrical element at a variable speed had been disclosed orally at FEICOR 2008. The opposition division's discretionary decision not to admit this factual allegation into the proceedings was thus based on an incorrect assumption.

The board has discretion under Article 12(6), first sentence, RPBA and exercised this discretion by admitting the factual allegations and evidence regarding a possible oral disclosure at FEICOR 2008 as submitted during the opposition proceedings into the appeal proceedings.

The board incidentally notes that it has not been contested that both parties could ask the witnesses Mr Gomes and Mr Oliveira questions on this oral disclosure (see, for example, page 55 of the minutes of the hearing of Mr Oliveira).

2.2 Testimonies by Mr Oliveira and Mr Gomes and video D22

The respondent requests that the results of the witness hearings during the oral proceedings before the opposition division (see minutes of these witness hearings) not be admitted into the proceedings.

During the oral proceedings, the opposition division decided, in addition to the order dated 17 May 2021 relating to Mr Oliveira, to also take evidence by hearing Mr Gomes as a witness (see point 19 of the Reasons for the decision under appeal and points 4 and 6 of the minutes of the oral proceedings), and the results of both witness hearings have furthermore been considered by the opposition division, as reflected in

the reasons for the decision under appeal (see, for example, point 21.2.1 of the Reasons). In this situation, the board sees no legal basis for disregarding the results of the witness hearings in the appeal proceedings.

The appellant requests that video D22 not be admitted into the proceedings.

The opposition division admitted video D22 into the proceedings (see point 17 of the Reasons for the decision under appeal). This video had been shown to the witnesses during their hearings. The reasons for the decision under appeal are, *inter alia*, based on this video. The board sees no legal basis for disregarding video D22 in the appeal proceedings.

The witness testimonies by Mr Gomes and Mr Oliveira and video D22 were thus taken into consideration by the board.

2.3 Documents D23 and D24

It is undisputed that documents D23 and D24 are identical to the documents filed during the oral proceedings before the opposition division on 16 December 2021 at 11.34 hrs.

The opposition division decided not to admit these documents. Article 12(6), first sentence, RPBA is pertinent. An error in the use of discretion is only one of the two alternatives addressed in that provision.

Since both parties referred to these documents for support of their (contrary) views, it was expedient in

terms of procedural efficiency and in view of procedural fairness that documents D23 and D24 be admitted. Exercising its discretion under Article 12(6), first sentence, RPBA, the board therefore decided to admit documents D23 and D24 into the appeal proceedings.

2.4 Documents D25 and D26

The respondent requests that documents D25 and D26 filed with the statement of grounds of appeal not be admitted into the proceedings.

Documents D25 and D26 are identical to the appellant's letters of 15 October 2021 and 29 May 2017 filed during the opposition proceedings. The board sees no legal basis for removing these letters from the proceedings as they form part of the file. Documents D25 and D26 cannot be disregarded by the board.

2.5 Video D27

The respondent requests that video D27 not be admitted into the appeal proceedings.

Articles 12(2) and (4) RPBA are pertinent. The parties agree that video D27 does not contain any more information than video D28. Admitting video D27 would thus not serve any purpose. Exercising its discretion under Article 12(4) RPBA, the board therefore decided not to admit video D27 into the appeal proceedings.

2.6 Document D30 and request to hear Mr Vila Closas as a witness

2.6.1 The affidavit by Mr Oscar Vila Closas (document D30) and the respondent's request to hear him as a witness were submitted by the respondent's letter dated 25 October 2024. It is undisputed that Article 13(2) RPBA applies.

The respondent submits that the circumstances were exceptional within the meaning of Article 13(2) RPBA in two aspects. The board had decided to admit the factual allegations of an oral disclosure at FEICOR 2008 into the proceedings. Moreover, in point 7.1.2 of the communication under Article 15(1) RPBA, the board had been of the preliminary opinion that the witness testimonies proved that there had been a public disclosure of the subject-matter of claim 1 as granted. This was a new objection raised by the board.

2.6.2 In point 5.2 of its statement of grounds of appeal, the appellant contested the opposition division's decision not to admit the factual allegations of an oral disclosure at FEICOR 2008. When admitting these factual allegations, the board acceded to the appellant's request submitted in its statement of grounds of appeal. This could not objectively have surprised the respondent and does not constitute exceptional circumstances within the meaning of Article 13(2) RPBA.

In point 7.1.2 of its communication under Article 15(1) RPBA, the board addressed the objection of lack of novelty in view of the public disclosure at FEICOR 2008 against claim 1 as granted. This objection was raised in the opposition proceedings, is addressed

in point 21.2.1 of the Reasons for the decision under appeal and has been maintained by the appellant in its statement of grounds of appeal. No new objection was raised in point 7.1.2 of the board's communication under Article 15(1) RPBA. Moreover, in that point of the communication, the board only addresses the evidence that had been filed in the opposition proceedings. The board's preliminary view after evaluating this evidence differing from the conclusion of the opposition division in the decision under appeal constitutes neither a new objection nor exceptional circumstances.

There are thus no exceptional circumstances justified with cogent reasons by the respondent. Exercising its discretion under Article 13(2) RPBA, the board therefore decided that the affidavit by Mr Vila Closas (document D30) and the respondent's request to hear Mr Vila Closas as a witness be not admitted into the appeal proceedings.

2.7 The appellant's submissions in points 8.11 to 8.22 of the statement of grounds of appeal

The respondent requests that the submissions in points 8.11 to 8.22 of the statement of grounds of appeal not be admitted into the proceedings. These submissions relate to objections of lack of inventive step. Since this decision is not based on these objections, the question of admittance of these sections of the statement of grounds of appeal can be left open.

- 2.8 The parties' submissions dated 25 October 2024 and 13 November 2024

The appellant requests that any new factual allegations included in the respondent's letter dated 25 October 2024 not be admitted in the appeal proceedings. The respondent requests that the submissions in the appellant's letter dated 13 November 2024 not be admitted into the appeal proceedings.

These letters contain refinements of the parties' previous submissions. At the oral proceedings, the board considered it appropriate to continue with the discussion on the substance, including these submissions. During the oral proceedings, the respondent took positions on the issues discussed, including those that had been addressed in the appellant's letter dated 13 November 2024. Moreover, the question of admittance can be left open, since this decision is not based on aspects that are only raised in the appellant's letter dated 13 November 2024. The submissions in the respondent's letter dated 25 October 2024 were taken into account in the appeal proceedings since this letter contains refinements of the party's previous submissions.

3. Ground for opposition under Article 100(a) in conjunction with Article 54(1) EPC
- 3.1 In point 21.1.1 of the Reasons for the decision under appeal, the opposition division concluded that the effective date for claims 1 and 7 as granted was the filing date of the application on which the contested

patent was granted, i.e. 31 December 2008. This conclusion has not been contested in the appeal proceedings, and the board sees no reason to come to a different view than the opposition division. Consequently, the alleged public prior use at FEICOR 2008 (see also document D17), if sufficiently proven, represents state of the art under Article 54(2) EPC.

In point 21.2.1 of the Reasons for the decision under appeal, the opposition division also concluded that a method and device for marking cork stoppers was shown in operation at the FEICOR fair between 30 May and 1 June 2008 in Santa Maria da Feira, Portugal (FEICOR 2008), including all features and steps contained in claim 1 as granted with one exception: the variable speed of rotation of the cork during the marking process.

- 3.2 The respondent has not contested this view in the appeal proceedings. The issue at hand therefore hinges only on whether the public disclosure at FEICOR 2008 involved rotating the cork stopper at a variable speed.
- 3.3 In accordance with the principle of the free evaluation of evidence, an assessment of whether the challenged facts are sufficiently established can only be made on a case-by-case basis (see also "Case Law of the Boards of Appeal of the European Patent Office", 10th edn., July 2022, III.G.4.1).
- 3.4 The parties disagree on the applicable standard of proof ("balance of probabilities" versus "beyond reasonable doubt" (or "up to the hilt")); see, for example, section 5.1.5 of the statement of grounds of appeal and paragraph V.7 of the reply to the statement of grounds of appeal). The board cannot accept the

respondent's argument that a stricter standard of proof should apply, the respondent arguing that the information for the alleged prior use was de facto within the sphere of the appellant. On the one hand, the allocation of the evidence is more complex than in cases where one party has full access and the other party has no access to the relevant evidence; here also the respondent was involved to some extent in the presentation of the machine at FEICOR 2008 and had access to information on the prior use. On the other hand, much of the relevant evidence was gathered from the public sphere (in particular, the witness statement and affidavit of Mr Oliveira). The board supports the position taken in decision T 1311/21 - a recent case where both parties to some extent had access to the evidence relating to the alleged prior use - that the binary approach to proof standards can turn out to be overly formalistic and simplistic. What matters is the deciding body's conviction of the occurrence of an alleged fact (see decision T 1311/21, Reasons 3.2.1).

3.5 As stated by the appellant, the witnesses Mr Gomes and Mr Oliveira mentioned in their witness testimonies that the rotational speed of the cork stopper increased in areas where nothing needed to be printed (see minutes of the witness hearing of Mr Oliveira, page 30 and minutes of the witness hearing of Mr Gomes, page 14). The result of the hearing of the two witnesses thus supports the view that the feature of rotating the at least one cylindrical element at a variable speed had been publicly disclosed at FEICOR 2008.

3.6 The respondent submits that Mr Gomes had not been a member of the public. This view is contested by the appellant.

Even assuming that Mr Gomes is not considered to be a member of the public, this would still leave the witness Mr Oliveira as a member of the public.

The respondent submits that according to Mr Oliveira's witness testimony, he thought at the time of his hearing that he had common interests with Azevedos.

However, even assuming that this was the case, this in itself does not imply that Mr Oliveira was under any obligation of confidentiality regarding what Mr Vila Closas publicly disclosed at FEICOR 2008 or that he could not be considered a member of the general public for the prior public disclosure.

- 3.7 The respondent submits that Mr Gomes and Mr Oliveira, in their witness hearings, declared that they could see the cork stopper rotating at variable speed in video D22. However, according to the respondent, this video only showed a rotation at constant speed. The witnesses' statements that they could see a rotation at variable speed at FEICOR 2008 were thus not credible.

As also pointed out by the appellant, the hearing of the witnesses took place by videoconference via Zoom. It is undisputed that connection problems occurred during the hearings. It is therefore not possible to be certain that video D22, when shown to the witnesses during their online hearings, was transmitted correctly and smoothly. The witnesses' impression that the rotational speed of the cork stopper varied may have been due to transmission artefacts.

- 3.8 Referring to document D26a, page 1, fifth paragraph, the respondent submits that Mr Oliveira said that a personalised cork stopper had been printed for him (see

photos in document D26a) and that, while this cork stopper was being printed, he could see the cork speed up. However, text/image had to be printed on every part of the personalised cork stopper in the printing range, or the regions without text/image would be so small that an acceleration/deceleration would be impossible to observe.

The board notes that document D26a has not been filed in an official language of the European Patent Office. There was, however, no disagreement on the relevant content of this document between the parties. It is uncontested that Mr Oliveira saw many cork stoppers being marked by Mr Vila Closas at FEICOR 2008, not only the personalised cork stopper. Even assuming that Mr Oliveira could not have observed this personalised cork stopper being rotated at variable speed during marking, this does not seriously put his testimony on the process used for marking other cork stoppers disclosed at FEICOR 2008 into question.

- 3.9 On page 13, second paragraph of the Reasons for Decision of the decision under appeal, the opposition division sets out that the fact that the variable rotational speed during marking may have been disclosed to the attendees at the fair could not be considered established. It could not be assumed with the required certainty that the naked eye would have clearly and unambiguously derived that information from the observation of the marking process. The surface of the cork stopper was rather small. Perceiving during the rotation of it any changes of speed between the marked and non-marked parts was something which could not be reasonably assumed. This difference could in addition be further blurred in the case of markings covering most of that surface.

The opposition division's considerations are hypothetical and do not convincingly demonstrate that the witness testimonies should have less weight when evaluating the available evidence. No evidence has been provided that seriously puts into question the witnesses' capability of observing that the cork stopper had been rotated at variable speed. Similarly, the opposition division's concern that speed changes might not have been observable by the witnesses do not seem to be supported by any evidence.

3.10 The respondent submits that the marking of the cork stoppers took place behind laser protection screens. However, it is undisputed that the laser protection screens were not opaque and that light could pass through. It is thus credible that the witnesses could see the marking process through the screens. As set out by the appellant, in the photos provided by the appellant, parts of the machine can be seen through the screens.

3.11 From the witness testimonies, it also follows that the marking speed was a very important factor at the time they attended FEICOR 2008. Even assuming that the possibility to provide a cork stopper with a personal image or text on the fly, i.e. instantaneously, was a remarkable feature of the machine presented by Mr Vila Closas, this does not imply that the witnesses or the general public would not have paid any attention to the speed of marking.

3.12 The respondent submits that video D22 was recorded at FEICOR 2008, that the recorded machine was the one presented and that the shown mode of operation was the only one that had been used during the fair.

Video D22 was shown to the witnesses during their hearing, and they declared that the machine visible in this video was not the same one that had been presented at FEICOR 2008.

However, even assuming that video D22 was recorded at FEICOR 2008, this video only shows the marking of a few cork stoppers during a short period of a few seconds. The video cannot prove that at other instances during FEICOR 2008, cork stoppers were marked while being rotated at variable speed.

It is uncontested that video D28 does not represent prior art. The witnesses declared that the machine visible in video D28 was not the same machine that had been presented at FEICOR 2008. The board sees no reason to assume that the video was filmed during this fair or that the marking process shown in the video was identical to the one shown at FEICOR 2008.

For the reasons set out below, the hardware used at the FEICOR 2008 could have been used to rotate the cork stopper at constant or at variable speed, depending on how the hardware was operated. Even if a video is provided using the same hardware that had been used at FEICOR 2008, this would not seem to imply that this hardware had been operated in the same way during the fair.

Videos D22 and D28 therefore seem less relevant to demonstrate what a member of the public could have observed at FEICOR 2008. Most importantly, they do not put into question the witnesses' testimonies.

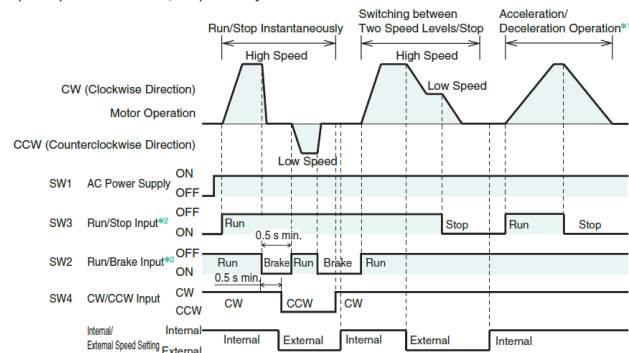
3.13 The respondent sets out that speed controller ES02 (see documents D23 and D24) had been used at FEICOR 2008 and that this speed controller only supported stop-and-go motor operation; not a rotation at variable speed.

However, the diagrams provided by the respondent on pages 10, 11 and 12 of its reply show an operational mode in which rotation is performed at variable speed.

This view is also supported by the diagram at the top of page 21 of document D24:

● Timing Chart

The timing chart below shows an example of switching between two speed levels when the high speed and low speed are selected via the internal and external speed potentiometers, respectively.



*1 Case where the acceleration and deceleration times are set longer by turning each potentiometer clockwise.
 *2 In case SW2 and SW3 are turned on at the same time, Brake Input (SW2) is given priority.

In the central part of this diagram (indicated as "Switching between Two Speed Levels/Stop"; see also the diagrams on pages 10, 11 and 12 of the respondent's reply which seem to show similar graphs), the speed level varies over time. First, it ramps up to a "High Speed" level where it remains constant for some time. Then it ramps down to a "Low Speed" level where it remains constant for some time. The term "variable speed" in claim 1 as granted does not exclude the possibility that the claimed method includes phases in which the speed remains constant.

This demonstrates that the speed controller ES02 can be used to implement a rotation at variable speed (such as a higher speed in a first phase when no marking is performed and a lower speed in a second phase when marking is performed). While the diagrams provided by the respondent (and documents D23 and D24) taken in isolation do not sufficiently prove that the speed controller ES02 was indeed operated in this way at FEICOR 2008, they do not contradict the witnesses' testimonies that they observed the rotational speed varying during the marking process. For the following reasons, the same holds true in view of the respondent's further references to document D24.

The respondent refers to the information below the headline "Repeated Operation/Braking Cycle" on page 23 of document D24, namely that, "[w]hen running/braking of the motor is repeated in short cycles, the motor temperature will increase and the continuous-operation time will be limited". In the table below this statement, a minimal repetition cycle of 2 seconds was given when running the motor in a low-power mode.

The table states repetition cycles of 2 seconds minimum (running 1 second, stopping 1 second) and 4 seconds minimum (running 2 seconds, stopping 2 seconds). The stated times are of the same order as the time it took to mark a single cork submitted by the respondent of 1.8 to 2.4 seconds. The table does not demonstrate that it was impossible to use speed controller ES02 to rotate the cork stopper at variable speed during marking and is thus not in contradiction to the witnesses' testimonies.

The respondent submits that the graph to the left of page 23 of document D24 showed that the lowest possible

acceleration time was about 0.5 seconds. The graph to the right showed the lowest possible deceleration time of about 2.5 seconds. According to the respondent, this would already exceed the time it took to print the whole cork, which was about 1.8 to 2.4 seconds.

The cited graphs refer to a rotational speed of the motor of 1000 rpm. Based on the respondent's estimations, it is not excluded that the speed of rotation of the motor when marking the cork stoppers at FEICOR 2008 was considerably lower. As accepted by the respondent, the graphs on page 23 of document D24 do not show or allow conclusions about acceleration/ deceleration times for the rotational speeds used at FEICOR 2008. These graphs therefore do not contradict the witnesses' testimonies.

- 3.14 Nor can it be concluded from the marking time per cork stopper estimated by the respondent that the rotational speed had been too high for an unarmed human eye to distinguish between rotation at constant or variable speed.
- 3.15 The witnesses furthermore declared in their testimonies that it had been explained to them at FEICOR 2008 that the cork stopper rotated at variable speed.

It has not been disputed by the respondent that Mr Vila Closas explained the machine and its operation at FEICOR 2008. However, the respondent submitted, for example, in its reply to the statement of grounds of appeal, that Mr Vila Closas could not have explained that the cork stopper rotated at variable speed at FEICOR 2008 because the invention involving this feature had not been made at that time. Previously, in the respondent's reply to the notice of opposition

(page 2, last two paragraphs), the respondent had acknowledged that a device and method for marking and machining cylindrical elements at variable speed had been made publicly available by the respondent at FEICOR 2008. During the oral proceedings before the board, the respondent submitted that this statement was incorrect and had been based on a misunderstanding by its former representative.

The respondent's contradictory submissions are not supported by any evidence and do not convincingly demonstrate that the witnesses' testimonies on the alleged public oral disclosure were wrong.

3.16 Freely evaluating the available evidence, the board is convinced that the feature of rotating the cork stopper at variable speed had been publicly disclosed at FEICOR 2008. Since this is the only feature of claim 1 as granted whose public disclosure at FEICOR 2008 was under dispute, the board concludes that the subject-matter of claim 1 as granted is not new in view of the public disclosure at FEICOR 2008.

3.17 Consequently, the ground for opposition under Article 100(a) in conjunction with Article 54(1) EPC prejudices the maintenance of the patent.

4. The respondent's auxiliary request

The respondent submitted the claim set of its auxiliary request with the letter dated 25 October 2024. It submits that the same exceptional circumstances as set out for the admittance of document D30 and the request to hear Mr Vila Closas as a witness applied.

For the reasons set out above, the board does not consider that the circumstances invoked by the respondent are exceptional under Article 13(2) RPBA. Whether this auxiliary request is prima facie adequate to overcome the objections raised against the patent as granted is less relevant.

Exercising its discretion under Article 13(2) RPBA, the board decided not to admit the respondent's auxiliary request into the appeal proceedings.

5. Conclusions

Since the appeal is admissible, the subject-matter of claim 1 as granted is not new and the board did not admit the respondent's auxiliary request into the appeal proceedings, the decision under appeal has to be set aside and the patent revoked.

Order

For these reasons it is decided that:

1. The appeal is admissible.
2. The decision under appeal is set aside.
3. The patent is revoked.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated