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**D E C I S I O N**  
**of 26 April 1994**

**Case Number:** T 1051/92 - 3.2.1  
**Application Number:** 87300326.3  
**Publication Number:** 0278130  
**IPC:** B65D 81/20, B65D 30/08, B32B 15/08  
**Language of the proceedings:** EN

**Title of invention:**

Package of smooth appearance, method of making thereof and roll of web product for forming it

**Patentee:**

Fres-Co System USA, Inc.

**Opponent:**

Scheuch GmbH & Co. KG  
Wipf AG Verpackungen  
Rhône-Poulenc Multi-Techniques

**Headword:**

-

**Relevant legal norms:**

EPC Art. 54, 56, 113, 116  
EPC R. 67

**Keyword:**

"Novelty (yes)"  
"Inventive step (yes), substantial procedural violation (no)"  
"Reimbursement of the appeal fee (no)"

**Decisions cited:**

T 0004/83, T 0114/86, T 0125/89, T 0167/84

**Catchword:**

The right to oral proceedings is not restricted to the submission of "substantial new arguments" at such proceedings. However, the mere information provided by the Opposition Division in a communication that in case the Opponent did not submit new arguments at the oral proceedings he would run the risk of having to pay costs incurred by the Patentee, cannot be considered as constituting a substantial procedural violation.



Case Number: T 1051/92 - 3.2.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.1  
of 26 April 1994

**Appellant:**  
(Opponent 02)

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**Respondent:**  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office dated 21 September 1992  
rejecting the opposition filed against European  
patent No. 0 278 130 pursuant to Article 102(1)  
EPC.

**Composition of the Board:**

**Chairman:** F.A. Gumbel  
**Members:** P. Alting van Geusau  
J. Saisset

### Summary of Facts and Submissions

I. European patent No. 0 278 130 was granted with effect from 3 January 1990 on the basis of European patent application No. 87 300 326.3 filed on 15 January 1987.

II. With notice of opposition filed on 1 October 1990 the Appellant (Opponent 02) requested revocation of the patent in its entirety for the reason of non-compliance in particular with the provisions of Article 100(a) EPC.

Further oppositions based on an alleged non-compliance with the requirements of Article 100(a) were filed by the other parties on 26 September 1990 (Opponent 01) and 28 September 1990 (Opponent 03).

In respect of an alleged lack of novelty and inventive step the oppositions were supported by:

D1: FR-A-2 037 580

D2: DE-A-3 202 032

D3: GB-A-2 090 577

D4: DE-U-8 528 669

D5: An alleged prior use relating to a coffee bag with the printing: "TORREFAZIONE CAFFE' SAN MARCO" and a letter dated 14 February 1978 of the manufacturing company SILCES

D6: US-A-2 292 295

D7: EP-A-0 160 755

III. By decision dated 21 September 1992 the Opposition Division rejected the oppositions.

The Opposition Division held that the combination of features of the independent claims and in particular the characterising features relating essentially to:

- (a) securing the webs together by adhesive disposed along their longitudinal margins and
- (b) applying short portions of adhesive spaced apart across the webs,

were not suggested by the cited documents or alleged prior use so that the subject-matter of these claims should be considered to be based on an inventive step.

The objection against Claim 9 based on Article 100(b) EPC, in particular in respect of the feature defined in the last part of Claim 9 specifying that the roll is intended to be cut along a transverse cut line extending across the portions of a group was not considered to be well founded since, in the Opposition Division's opinion, it was immediately apparent from the description of the patent what was intended by this feature.

- IV. The Appellant (Opponent 02) lodged an appeal against this decision on 27 November 1992 and paid the appeal fee on the same day.

In his Statement of Grounds of Appeal, filed on 29 January 1993, in addition to his submissions with respect to patentability, the Appellant objected to the Opposition Division's warning in the communication dated 4 March 1992 that it might impose on him an apportionment of costs which led him to withdraw his request for oral proceedings.

- V. In a communication in preparation for oral proceedings auxiliarily requested by the Appellant the Board expressed the provisional opinion that in proceedings before the EPO the parties have an absolute right to be heard in accordance with Articles 113(1) and 116(1) EPC. Whether the Opposition Division's findings in the

communication dated 4 March 1992 amounted to a substantial procedural violation would be one of the issues to be discussed at the oral proceedings.

As regards the allowability of the appeal the Board expressed the view that the subject-matter of the patent was novel, since none of the cited documents showed the claimed arrangement of adhesive strips for joining together webs of different material intended for manufacturing of packages.

VI. Oral proceedings took place on 26 April 1993 at which the Respondent filed new Claims 1 to 7 and a revised description, columns 1 to 5.

The Respondent requested maintenance of the patent on the basis of the new claims and description, together with figures 1 to 5 as granted.

The independent Claims 1, 4 and 7 of the amended patent read as follows:

"1. A method of making a dual wall package (20) comprising an outer bag (26) and an inner bag (24) secured to the outer bag (26), the method comprising the steps of folding two superimposed webs (40, 42) of different materials to form lengths respectively of the outer bag (26) and the inner bag (24), cutting a length of the webs (40, 42) along a transverse cut line (45) and then sealing one end (30) of the inner bag (24) characterised by the preliminary step of securing the webs (40, 42) together by adhesive disposed along their longitudinal margins (44) and of applying short portions (46A...46F) of adhesive to extend longitudinally along the webs (40, 42), the portions being spaced apart across the webs (40, 42) and defining between them passageways (58) so that the portions (46A...46F) space

apart the webs (40, 42) in the formed package (20) and a gas space (28) is formed and can communicate with the atmosphere via the passageways (58) and that the length is cut along a cut line (45) which extends approximately across the longitudinal middle of the portions (46A...46F).

4. A filled package (20) containing contents (22) under vacuum and having a smooth external appearance, the package including an inner bag (24) and an outer bag (26), the inner bag (24) containing contents (22) and being vacuum sealed, the outer bag (26) extending about the inner bag (24) and being spaced from the inner bag (24) by a gas space (28), the outer bag (26) being formed of a sheet (42) of a flexible material different from the material (40) of which the inner bag (24) is formed so that the bags (24, 26) cannot be sealed together by a bonding energy used to seal the inner bag (24) characterised in that the outer bag (26) is secured to the inner bag (24) by adhesive disposed along their longitudinal margins (44) and by short portions (46A...46F) of adhesive extending longitudinally along the bags (24, 26), the short portions being spaced apart and bridging the air space (28) and define at least one passageway (58) in communication with both the ambient atmosphere and the gas space (28) and in that the portions (46A...46F) are present at each end (30, 32) of the package (20).

7. A roll of continuous length of web product for forming a succession of dual wall packages (20), each package comprising an outer bag (26) and an inner bag (24) which is secured to the outer bag (26), the bags (26, 24) being held apart so that an air space (28) is present in between, the web product comprising two superimposed webs (40, 42) of different materials to form lengths of the outer bag (26) and inner bag (24)

respectively, the inner bag being formed of a flexible sheet material which is strong, tough and substantially gas impervious, wherein the webs (40, 42), are secured together by adhesive along their longitudinal margins, and by groups of short portions of adhesive (46A..46F) which extend longitudinally along the webs (40, 42) the groups of portions (46A...46F) being spaced apart longitudinally along the webs (40, 42), the portions (46A...46F) of each group being spaced apart across the webs (40, 42) and defining between them passageways (58), the roll being intended to be cut along a transverse cut line (45) extending across the portions (46A...46F) of a group.

VII. In support of his requests for reimbursement of the appeal fee and revocation of the patent the Appellant submitted essentially the following arguments:

In its communication dated 4 March 1992 the Opposition Division announced that if the Opponents maintained their request for oral proceedings but failed to submit any substantial new argument during the oral proceedings, it would be considered whether an apportionment of costs pursuant to Article 104(1) EPC would be appropriate.

In view of the substantial costs potentially involved the Opposition Division's warning for an apportionment of costs in fact had induced the Appellant to withdraw his request for oral proceedings.

However, in accordance with the EPC an Opponent has an unconditional right to oral proceedings without any requirement that new arguments should be submitted at such proceedings and in this respect reference can be made to the decision T 125/89 (not published). Therefore the Opposition Division's warning should be considered



as a refusal of the absolute right to be heard under Article 113 EPC and consequently the Opposition Division's warning in their communication amounts to a substantial procedural violation justifying reimbursement of the appeal fee.

As regards the subject-matter of the patent, the sequence of manufacturing steps defined in Claim 1 is not in agreement with the sequence disclosed in column 3, lines 42 to 53 of the description. It is true that in column 4, lines 6 to 25 a sequence according to Claim 1 is disclosed, however in view of this discrepancy the sequence of manufacturing steps cannot be considered inventively significant.

Considering the subject-matter of Claim 4 the single difference left in respect of the prior art according to D2 is that the package of D2 is not a vacuum package. All the other features are known from D2 including the feature that the adhesive is disposed along both longitudinal margins because it is clearly stated in the description of the patent in suit in column 4, lines 58 and 59 that instead of a continuous adhesive area extending along the entire length, sections of adhesive areas can be used too, which definition applies to the portions 6 shown in Figure 2 of D2. Moreover, in view of the information contained in Claim 1 of D2 concerning the channels 23 to 26 to be open at least at one side of the package, it can be concluded that channels which are open at both sides are also envisaged, which would lead to a configuration of the adhesive strips essentially in accordance with that defined in Claim 4. The skilled person would need no inventive activity to use this known package for packing contents under vacuum because this requires only the use of a non-perforated inner sheet for the bag, which is already known from D1.

Also when starting from D1 the subject-matter of Claim 4 cannot be considered to be based on an inventive activity. D1 discloses a method of making a dual wall package which is evidently, when considering the information provided on page 2, lines 15 to 29 of D1, quite similar to one obtained with a conventional machine shown in Figure 1 of D6. The problem to be solved by the patent is not mentioned in the description but is apparently related to the provision of a better support of the inner bag, arranged in such a way that air can escape from the space between the two walls. This problem is solved by the arrangement disclosed in D2 and it would therefore be obvious to the skilled person to combine the teachings of D1 and D2.

Concerning the method of making a dual wall package claimed in Claim 1 of the patent in suit, D2 also implicitly discloses that the sheets shown in Figure 2 are cut from already adhesively connected webs, otherwise the term "Zuschnitt" on page 6, line 17 would make no sense and in respect of such disclosures considered to be implicit to the skilled person reference was made to the decisions T 4/83 (OJ EPO 1983, 498) and T 114/86 (OJ EPO 1987, 485).

When cutting from adhesively connected webs it would further be obvious to the skilled person to arrange the adhesive strips such that with each cut one cutting ("Zuschnitt") of the form shown in Figure 2 of D2 is obtained.

As regards the features of the granted Claim 2, now incorporated in the amended Claim 1, the Appellant should be given further time to carry out an additional search for the subject-matter now claimed. Anyhow, cutting along a cut line extending approximately across

the longitudinal middle of the portions at both ends of the sheets is considered to be an obvious measure to the skilled person.

The subject-matter of the independent Claim 7 lacks clarity and is for this reason alone not acceptable. Firstly it is not the roll itself that is cut but the web product. Moreover a feature merely relating to an intention of what will be done later with the roll, is not suitable for a clear definition of the roll itself.

It is also not considered acceptable to introduce the features from the description, Column 3, lines 15 to 17, in this independent Claim.

Even if Claim 7 were formally acceptable the claimed roll is not patentable for lack of inventive step. In view of the disclosure in D2 of a preformed web of two adhesively connected webs of material it would be obvious to the skilled person to manufacture in the same manner a roll of two adhesively connected webs in which the webs are not perforated, which is in essence the content of Claim 7.

VIII. In support of his request for maintenance of the patent in amended form the Respondent argued essentially as follows:

D1 is considered to represent the closest prior art. The main problem encountered with these known bags is that filling of the bags is difficult due to insufficient support of the inner bag by the outer bag so that filling material may enter the space between the inner and outer bag.

By the features of the independent claims the manufacture of double-walled bags is achieved in a simple effective manner and at the same time the inner bag is sufficiently supported to avoid the problems during filling without air being trapped between the walls of the bag.

Reference D1 explicitly deals with separate sheets from separate reels and there is no evidence of any incentive to combine D1 and D2.

There is also no suggestion in D2 that the cuttings shown in Figure 2 are cut from prejoined webs nor is there any disclosure or hint to arrange the adhesive strips and to arrange the cut line in the manner as claimed in either Claim 1 or Claim 4 of the amended patent.

As regards the roll of web product defined in Claim 7 it is noted that none of the cited documents discloses or hints to a roll of adhesively connected webs for the manufacture of double wall packages. Claim 7 also requires that the cut line extend across the short portions for forming passages at each end of the package, another feature having no antecedent in the cited prior art.

The Appellant's clarity objections against Claim 7 do not take into account the interpretation of the subject-matter of the Claim by the skilled person. Such person would not have any difficulty in understanding the content and scope of the amended Claim 7.

## Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is admissible.

### 2. *Amendments*

2.1 Claim 1 is a combination of the granted Claims 1 and 2. Claim 4 is a combination of the granted Claims 5 and 6. Claim 7 is based on the granted Claim 9 and now includes the features that the inner bag is formed of a wall of flexible sheet material which is strong, tough and substantially gas impervious as is disclosed in column 3, lines 15 to 17 of the granted description of the patent.

The subject-matter of the present independent Claims 1, 4 and 7 is based on the disclosures on pages 5, last paragraph to page 7, third paragraph of the application as it was originally filed.

The dependent Claims 2, 3, 5 and 6 are repetitions of the granted Claims 3, 4, 7 and 8.

The subject-matter of the present Claim 2 is disclosed on page 6, lines 6 to 10 and lines 16 to 21 and that of present Claim 3 on page 6, lines 13 to 15 of the originally filed description. Present Claim 5 and 6 are repetitions of the originally filed Claims 8 and 10.

In view of these assessments no objections arise against the present Claims in respect of Article 123(2) and (3) EPC.

2.2 The Appellant submitted that Claim 7 lacked clarity and objected also to the insertion of the features taken from column 3, lines 15 to 17 of the description into this claim.

In the Board's opinion Claim 7 is sufficiently clear to meet the requirements of Article 84 EPC. In this respect, considering the last feature of Claim 7, relating to the roll being intended to be cut along a transverse cut line extending across the portions of adhesive of a group, it is immediately clear to the skilled person that it can only be the web product of the roll that is cut. Furthermore, although related to a cutting step and not directly to the roll of web product claimed, this last feature implies in the context of the other features of the claim that the portions of adhesive should be arranged in such a manner that after cutting passageways are present between the short portions of adhesive in each of the cut lengths and as such indeed represents a constructional feature for defining the arrangement of adhesive strips between the two adhesively secured superimposed webs forming the roll.

In respect of the objection of insertion of features from the description the Appellant did not give any reasons why such insertion would contravene any of the requirements of the EPC. These further features clearly limit the material of the inner bag to be formed of the substantially gas impervious sheet material which is the material used in the embodiment disclosed in the description of the patent for a dual wall package suitable for containing contents under vacuum and as such is also disclosed in combination with the other features of the claim. In the absence of any reason for

non-compliance of Claim 7 with the formal requirements of the EPC, the Appellant's objections are considered not well founded in this respect.

- 2.3 The Appellant also objected to an alleged discrepancy of the sequence of method steps for forming a package with respect to the method defined in Claim 1 as contrasted to the method explained in column 3, lines 42 to 53 of the description. In this respect the Board notes that there is no lack of support under Article 84 EPC of the method of Claim 1 because the sequence of method steps claimed is supported by the description of the method of making a dual wall package in column 4, lines 6 to 25 of the patent.

The different sequence of method steps described in column 3, lines 42 to 53, in particular the exchange of the folding and cutting steps, although different from the sequence defined in Claim 1, need not necessarily be seen as contradicting the subject-matter claimed in the patent because the package defined in the independent Claim 4 is not limited to any particular sequence of folding and cutting steps and could well have been produced in accordance with the alternative method disclosed in the patent but not claimed as such.

- 2.4 The Appellant was also of the opinion that he should be given a further chance to carry out an additional search for the subject-matter of Claim 2 now incorporated in Claim 1.

In this respect the Board takes the view that the Appellant had sufficient opportunity to take position against the subject-matter of this claim and in fact already put forward objections on lack of inventive step in point 4 of his notice of opposition and cannot therefore be taken by surprise by the fact that the

granted Claim 1 was limited by introduction of the subject-matter of the granted Claim 2. There is thus no justification for granting the Appellant a further time-limit to search for further evidence at this point in time far outside the 9-month period stipulated in Article 99 EPC.

3. *Novelty*

3.1 Novelty of the subject-matter of the independent claims can be concluded for the reason that none of the cited prior art documents discloses superimposed webs or sheets of material adhesively secured together by means of adhesive disposed along both longitudinal margins of the webs or sheets and short portions of adhesive being spaced apart, bridging the air space between the superimposed webs or sheets and defining at least one passageway.

3.2 The Appellant was of the opinion that in view of the statement in column 4, lines 57 to 60 of the patent description, according to which passageways may also be provided by utilising sections of adhesive areas in lieu of continuous adhesive areas along the longitudinal margins, the arrangement of adhesive areas shown in Figure 2 of D2 which discloses at least two sections of adhesive at the left-hand longitudinal margins of the superimposed sheets, would anticipate this particular feature of the independent claims.

However, considering the text passage in column 4 of the patent referred to by the Appellant in its context, the information given to the skilled person is that sections can be used instead of continuous adhesive areas to form further air passageways. Clearly this function is thus additional to the securing function of the adhesive strips and as such the sections must be sufficiently



long and arranged over the whole length of the margins to give the required securing function of the margins of the superimposed webs. Considering now the arrangement of the adhesive strips in Figure 2 of D2 it is immediately clear to the skilled person that the part of the adhesive strip 18 of D2 extending merely along a small part of the longitudinal margin of the superimposed sheets constitutes a bottom adhesive strip only and is thus without any substantial securing function for the margins of the sheets. In view of these differences the skilled person would not have any conceivable reason to interpret the known bottom adhesive strip 18 of figure 2 of D2 as adhesive extending longitudinally along superimposed web or sheet margins.

Therefore the conclusions arrived at in the decisions T 4/83, point 4 (OJ EPO 1983, 498) and T 114/86, point 2 (OJ EPO 1987, 485) referred to by the Appellant to illustrate the interpretation of prior art documents to include also possible implicit disclosures, cannot be seen to contravene the above conclusions as to the disclosure of D2 arrived at in the present case.

4. *Inventive step*

- 4.1 The closest prior art to the subject-matter claimed in the amended patent is disclosed in D1.

This document discloses a dual wall package comprising an outer bag and an inner bag made by folding two superimposed webs of different materials, cutting a length of the webs along a transverse cut line and then sealing one end of the bag. The dual wall package is intended to be used for the packing of contents under vacuum which causes the inner bag to have a crinkled

appearance but due to the double wall arrangement the outer bag stays smooth for better appearance of the package and better visibility of printed information.

This prior art relates to the state of the art acknowledged in the precharacterising portions of the independent Claims 1 and 4 (see also column I, lines 30 to 45 of the description of the patent).

- 4.2 Considering the subject-matter claimed in the patent with respect to this prior art the underlying problem of the patent can be seen in the provision of a simple method of producing dual wall packages with improved filling characteristics and better aeration of the gas space between the package walls.

In this respect the selected arrangement of the adhesive strips defined in the independent claims provides for improved support of the inner and outer sheets for easy forming of the bags and, as was pointed out by the Respondent at the oral proceedings, to avoid that the content during filling gets into the space between the inner and outer bags, as well as to provide passageways at each end of the packages enabling air to pass therethrough, thereby enabling the front wall to be flexed outwardly to appear or remain smooth and aesthetically pleasing, notwithstanding the fact that the inner wall may be pebbled or unsmooth due to its tight adherence to the contents of the package. Providing short portions of adhesive spaced apart across the webs and longitudinally along the webs and cutting across the portions of a group results in a simple manufacture of such packages from a double-walled web.

- 4.3 Considering the cited documents and the alleged prior use, it cannot be seen that they provide sufficient suggestions for a skilled person to arrive at the

subject-matter of any of the independent claims in an obvious manner. In particular, none of the cited documents discloses or can be considered to give a lead to the selected particular arrangement of adhesive for securing webs or sheets of material for forming dual wall packages.

D2, which is considered to be particularly pertinent in this respect by the Appellant, discloses a cutting ("Zuschnitt") of two sheets of material connected by means of adhesive for forming a double wall package. The arrangement of adhesive is such that at least two channels are formed at least at one end of the package to allow surplus of air from the content of the package to escape through small holes in the inner package sheet and through these channels and additional short channels at the ends of the package into the outer atmosphere.

However, the known arrangement of adhesive is different from the claimed arrangement in that the adhesive is not disposed at both longitudinal margins of the package sheets, that at least some of the channels are formed from top to bottom of the sheets and in that the bottom side of the package is either closed by a band of adhesive or, by implication of the last feature of Claim 1 of D2, may indeed be open at both ends of each channel but thus does not form short portions in accordance with the definition in the independent Claims 1, 4 and 7. The known arrangement based on channels may be satisfactory for the intended use in D2, relying on a perforated inner bag, but, in the Board's opinion, is not really suitable for vacuum packages with a gas impervious inner bag in which sufficient aeration in a sideward direction between the inner and outer bag is also required.

Because of the significantly different use the skilled person would not be led to consider further adaptation of the known arrangement of adhesive in the direction of the now claimed arrangement in the amended patent, in particular because this would make it necessary to abandon the channel structure principally relied upon in D2.

- 4.4 In respect of the subject-matter of Claims 1 and 7, which relate to the use of webs for the manufacture of the packages, the Appellant placed great emphasis on an alleged implicit disclosure in D2 of presecured superimposed webs of different materials from which the cutting shown in Figure 2 of D2 would have been cut off.

In this context he also relied upon D6 which discloses in Figure 1 a conventional technique for forming double wall packages starting from webs of different material which are adhesively secured before forming of the package is carried out. In accordance with this known technique adhesive is applied at one longitudinal margin of a web and at longitudinal equidistant locations across a web and securing a second web to the first by means of the adhesive.

The Board notes that there is no direct disclosure in D2 as to how the cutting ("Zuschnitt") shown in Figure 2 is obtained. In the present case, the Appellant's interpretation is just one of several possible ways to arrive at the cutting shown in Figure 2 of D2 and therefore this specific interpretation cannot be regarded as belonging to the technical content disclosed in D2.

Even when presuming that the sheets are obtained by cutting from a dual sheet web, considering the different configuration of the adhesive strips at the bottom and

upper parts of the sheets, in the absence of any suggestion in either D1 or D2 in this respect the skilled person could not be led by D2 to rearrange the configuration of the adhesive at the margins and at the bottom and upper parts of the cutting so that by simply cutting the adhesively presecured webs across the short adhesive portions he would directly arrive at the provision of passageways at each end of the package and at both longitudinal margins.

4.5 There is no need to consider the further documents cited during opposition and not longer relied upon by the Appellant. It is apparent that they do not come any nearer to the subject-matter now claimed than the prior art disclosed in D1, D2 and D6.

4.6 Summarising, in the Board's judgment, the proposed solutions to the technical problem underlying the patent in suit defined in the independent Claims 1, 4 and 7 are inventive and therefore these claims as well as the claims dependent upon Claims 1 and 4 relating to particular embodiments of the invention in accordance with Rule 29(3) EPC, can form the basis for maintenance of the patent (Article 52(1) EPC).

5. The description and drawings are in agreement with the wording and scope of the current Claims. Hence these documents are also suitable for maintenance of the patent in amended form.

Thus taking into account the amendments made by the Respondent, the patent and the invention to which it relates meet the requirements of the EPC and the patent as amended may be maintained in this form (Article 102(3) EPC).

6. *Request for reimbursement of the appeal fee*

6.1 With reference to the decision T 125/89 of 10 January 1991 (not published), the Appellant submitted that the Opposition Division committed a substantial procedural violation when announcing in their communication dated 4 March 1992 that, "if the Opponents maintain their request for oral proceedings but fail to submit any substantial new arguments during the oral proceedings, the Opposition Division should consider whether an apportionment of costs pursuant to Article 104(1) EPC would be appropriate in the given circumstances" which announcement was the direct cause of the Appellant's withdrawal of the request for oral proceedings and, in his opinion, an infringement of the Appellant's rights in accordance with Articles 113 and 116 EPC.

6.2 The Board considers that the right to oral proceedings is clearly not restricted to submissions of "substantial new arguments" and that consequently the findings of the Opposition Division in their communication are not supported by the EPC.

However, the mere information provided by the Opposition Division in their communication, although giving the wrong impression that in case the Appellant did not submit new arguments at the oral proceedings he would, alone for this reason, run the risk of having to pay substantial costs incurred by the Respondent, can itself not be considered as an infringement of the Appellant's rights in accordance with Articles 113 and 116 EPC and cannot, consequently, be considered as a **substantial** procedural violation. Therefore there is no ground for a reimbursement of the appeal fee in accordance with Rule 67 EPC. Moreover, it should be considered that the Opposition Division's way of handling the case appears to be - at least formally - in agreement with the

decision T 167/84, point 11 (OJ EPO 1987, 369) which, however, deals with a very specific situation amounting to an abuse of oral proceedings.

Certainly, in the unpublished decision T 125/89 dated 10 January 1991 (see in particular point 7), which has been interpreted by the Appellant as implying that a warning of the form here in question should be considered as a substantial procedural violation requiring reimbursement of the appeal fee, the deciding Board took the view that parties have a right to repeat arguments or to stress arguments already put forward without contravening the provisions of Articles 113(1) and 116(1) EPC and that there is no legal basis for an apportionment of costs for the reason that no new arguments were presented at the oral proceedings. This legal position of the Board deciding in the case T 125/89 is fully supported by this Board. On the other hand, no reimbursement of the appeal fee was ordered in that case and in the absence of further considerations in this respect no unequivocal conclusion can be derived from the content of T 125/89 as to whether the Board deciding that case considered a mere warning of the form here in question in an Opposition Division's communication, to amount to a substantial procedural violation.

**Order**

**For these reasons, it is decided that:**

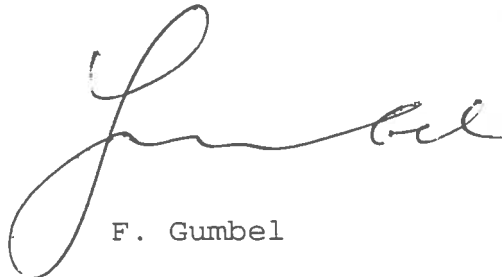
1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent with the Claims 1 to 7 and the description columns 1 to 5 presented at the oral proceedings together with the drawings as granted.
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel



