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D E C I S I O N
of 22 November 2001

Case Number: T 1043/93 - 3.2.4

Application Number: 86201700.1

Publication Number: 0220759

IPC: B65B 51/26

Language of the proceedings: EN

Title of invention:

Longitudinal welding equipment in a packer machine

Patentee:

SITMA S.p.A.

Opponent:

S.T.S. S.r.l. & C.M.C. S.r.l.

Intervener:

Soc. Alimentaire Brochures Industrie, A.B.I. Graphique SARL

Headword:

Welder/SITMA

Relevant legal provisions:

EPC Art. 54, 56, 100, 123, 117(1)(d)

Keyword:

"Main request: extension of subject-matter (missing feature)"
"Prior uses - burden of proof"
"Auxiliary request: inventive step (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 1043/93 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 22 November 2001

Appellant I:
(Opponent)

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Appellant II:
(Intervener)

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Respondent:
(Proprietor of the patent)

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Representative:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 13 October 1993
rejecting the opposition filed against European
patent No. 0 220 759 pursuant to Article 102 (2)
EPC.**

Composition of the Board:

Chairman: C. A. J. Andries
Members: P. Petti
J. P. B. Seitz

M. G. Hatherly
V. Di Cerbo

Summary of Facts and Submissions

- I. The European patent No. 220 759 results from European patent application No. 86 201 700.1 and claims the priority of the Italian utility model application IT 23205 filed on 24 September 1985.

An opposition as well as a notice of intervention according to Article 105(1) EPC were filed against this patent.

With its decision dispatched on 13 October 1993 the Opposition Division rejected the oppositions (according to Article 105(2) EPC, the intervention has been treated as an opposition).

Claim 1 of the patent as granted reads as follows:

"1. Longitudinal welding equipment in a machine for packaging products (14) fed on a conveyor belt (13) driven by a motor-variator (15, 17), wherein the products (14) are wrapped inside a continuous film (21) of plastic material having overlapping longitudinal edges, said equipment comprising a welder (44) having a circular welding surface lying in a longitudinal vertical plane and overlying said longitudinal side edges of the film (21) and at least one pressure belt (25) positioned atop said products (14) wrapped inside said film (21), **characterized in that** said welder (44) is pivotally mounted on a pivot axis (43), that means (45-48) to impart a reciprocatory rocking motion to said welder (44) about its pivot axis (43) and means (28-33) to drive said pressure belt (25) are operatively connected to said motor-variator (15, 17), and that said pivot axis (43) is shiftable by means of

a lifting and lowering device (38-42) between a lowered position when the packer machine is running, in which the welding surface of the welder (44) contacts said overlapping longitudinal side edges of the film (21), and a lifted position when the packer machine is stopped, in which the welding surface of the welder (44) is out of contact from said overlapping longitudinal side edges of the film (21)"

- II. An appeal against this decision was lodged on 8 December 1993 by the opponent (hereinafter Appellant I) who paid the appeal fee on 3 December 1993 and then filed on 10 February 1994 a statement setting out the grounds of appeal. Also the intervener (hereinafter Appellant II) lodged an appeal on 3 December 1993, and paid simultaneously the appeal fee. On 9 February 1994 the respective statement setting out the grounds of appeal was filed.
- III. In their statements setting out the grounds of appeal both Appellants alleged that machines of the type SITMA C80 made by SITMA SpA (proprietor of the patent, hereinafter Respondent) as well as machines of the type Ritmica H 30 made by C.M.C. di Ponti Giuseppe (previous firm name of C.M.C Srl, opponent) had been sold before the priority date of the patent in suit, that these machines had to be considered as being made available to the public by use (prior use) and that they prejudiced the maintenance of the patent in suit. In respect of these allegations, written evidence was filed and hearing of witnesses was requested.

With regard to these allegations of the Appellants, the Respondent also requested hearing of witnesses. During the subsequent phase of the appeal proceedings further

evidence concerning these issues was filed by Appellant I and by the Respondent.

IV. Furthermore in the statement setting the grounds of appeal, Appellant II argued:

- that the claimed subject-matter not only lacked novelty with respect to the prior use of the machines of the types SITMA C80 and RITMICA H 30 but also extended beyond the content of the application as filed, in so far as Claim 1 of the patent as granted did not specify a feature specified in Claim 1 of the application as filed, this feature concerning the temperature control of the longitudinal welding,
- that the subject-matter of Claim 1 of the patent as granted lacked inventive step having regard to the documents US-A-3 307 324, US-A-4 546 595 and US-A-4 004 400, and
- that, with reference to Article 100(b) EPC, Claim 1 of the patent as granted did not disclose the invention in a clear manner, particularly with regard to the technical problem to be solved.

V. In a communication dispatched on 12 October 1995, the Board expressed its provisional opinion that Claim 1 of the patent as granted contravened Article 100(c) EPC but that Article 100(b) EPC did not prejudice the maintenance of the patent.

With the letter dated 11 February 1997, the Respondent filed an auxiliary request based upon an amended Claim 1.

This claim reads as follows:

"1. Longitudinal welding equipment in a machine for packaging products (14) fed on a conveyor belt (13) driven by a motor-variator (15, 17), wherein the products (14) are wrapped inside a continuous film (21) of plastic material having overlapping longitudinal edges, said equipment comprising a welder (44) having a circular welding surface lying in a longitudinal vertical plane and overlying said longitudinal side edges of the film (21) and at least one pressure belt (25) positioned atop said products (14) wrapped inside said film (21), **characterized in that** said welder (44) is pivotally mounted on a pivot axis (43), that means (45-48) to impart a reciprocatory rocking motion to said welder (44) about its pivot axis (43) and means (28-33) to drive said pressure belt (25) are operatively connected to said motor-variator (15, 17), and that said pivot axis (43) is shiftable by means of a lifting and lowering device (38-42) between a lowered position when the packer machine is running, in which the welding surface of the welder (44) contacts said overlapping longitudinal side edges of the film (21), and a lifted position when the packer machine is stopped, in which the welding surface of the welder (44) is out of contact from said overlapping longitudinal side edges of the film (21), and the welding surface of the welder (44) is constituted by an electrically heated bar, means (50-56) being provided to control the temperature of said bar in dependence on the packaging speed."

VI. With a communication dispatched on 2 June 1999, the parties were informed that the Board did not consider it to be necessary to hear all the named witnesses.

- VII. On 1 August 2001 the Board dispatched a decision concerning taking evidence according to Rule 72 EPC. With this decision the Board decided that evidence had to be taken by hearing the witnesses Mr L. Bardelli, Mr R. Graziosi and Mr G. Manzini, named by the Respondent and Mr G. Marino, Mrs A. Negri, Mr M. Negri, Mr L. Pacini and Mr G. Ponti, named by the Appellants, the taking of evidence concerning
- (i) the allegation (this allegation will be referred to hereinafter as the "**first alleged public prior use**") that a machine of the type SITMA C80/305 was sold in January 1983 by "SITMA SpA" (hereinafter SITMA) to the firm "La Nuova AddressRoma di Marino Guglielmo & C." (hereinafter LNA),
 - (ii) the allegation (this allegation will be referred to hereinafter as the "**second alleged public prior use**") that a machine of the type SITMA C80/750 was sold on 16 May 1983 by SITMA to the firm Società Italiana Popolare per il Leasing ITALEASE SpA (hereinafter ITALEASE) and leased by ITALEASE to the firm Vittoria Indirizzi Conpit Srl (hereinafter CONPIT),
 - (iii) the allegation (this allegation will be referred to hereinafter as the "**third alleged public prior use**") that a machine of the type RITMICA H 30 was sold on 5 June 1985 by the firm C.M.C. di Ponti Giuseppe (hereinafter CMC) to LNA,
 - (iv) and the allegation (this allegation will be referred to hereinafter as the "**fourth alleged**

public prior use") that a machine of the type RITMICA H 30 was sold on the 1 March 1985 by CMC to the firm ELLEPI di Pacini Leopoldo (hereinafter ELLEPI).

Summons according to Rule 72(2) EPC were issued to each witness.

VIII. With respect to the public prior uses, the parties referred *inter alia* to the following documents:

(i) Documents filed by Appellant I with the Notice of Opposition:

NO-2 **Delivering note** ("Bolla di accompagnamento") No. 45810/84 (progressive No. 66), issued by CMC on 21 May 1985 to LNA

NO-3 Copy of an **invoice** No. 47 issued by CMC to LNA, dated 5 June 1985

NO-4 Copy of an **invoice No. 51** dated 25 January 1983 from SITMA to LNA

NO-5 **Declaration** of LNA, dated 31 January 1991

NO-6 Copy of the **Drawing** No. 4-1136 of SITMA, dated 1 April 1981 with the title "SALDATORE OSCILLANTE A 548"

NO-7 **Opinion ("Parere pro veritate")** of Mr Rastelli, Expert appointed by one of the parties of this proceedings during a judicial proceedings between SITMA and CMC before the Civil Court of

Milan

- NO-12 **Report** of Mr Pisanty, Expert appointed by the Civil Court of Milan during a judicial proceedings between SITMA, CMC and S.T.S. Srl
- (ii) Documents filed by Appellant I during the oral proceedings before the Opposition Division
- OP-1 Letter dated **27 January 1990** from C.S.A.-Centro Servizi Assistenza di **Graziosi Roberto** (herein after CSA) to SITMA
- OP-2 **Invoice** No. 288 of **13 February 1987** from SITMA to LNA
- OP-3 **Delivering note** ("Bolla di accompagnamento") No. 7743/86 dated **10 February 1987**, issued by SITMA to LN A
- OP-4 Copy of the **drawing** No. 4-715 of SITMA, provided with the date 30 May 1977 and with the title "SALDATORE ROTANTE A 548"
- OP-5 Copy of the **drawing** No. 4-715 of SITMA, provided with the date of 30 May 1977, with the updating date of 29 May(?) 1979 and with the title "SALDATORE ROTANTE A 548"
- OP-6 Copy of the **drawing** No-4-1136 of SITMA provided with the date of 1 April 1981 and with the title "SALDATORE OSCILLANTE" (this document corresponds to document NO-6)

- OP-7 Original **transparency** of the **drawing** No-4-1136 of SITMA provided with the date of **1 April 1981** and with the title "SALDATORE OSCILLANTE"
- (iii) Documents filed by the Appellants with the statements setting out the grounds of appeal:
- AD-8a Copy of the **invoice** No. 20 issued on 1 March 1985 by CMC to SOCIETA' ITALIANA LEASING (hereinafter SIL)
- AD-8b Copy of the **order** No. 1994 ("ordine di acquisto") issued by SIL on 19 February 1985 referring to a leasing contract with ELLEPI concerning a machine RITMICA H 30
- AD-8d **Minutes** of the mounting of a machine RITMICA H 30 in the premises of ELLEPI
- AD-8e Copy of a **delivering note** issued on 23 February 1985 by CMC to ELLEPI concerning a machine RITMICA H 30 and referring to the invoice No. 20 of 1 March 1985
- AD-9 **Declaration** of Mr Pacini (ELLEPI), dated 24 January 1994
- AD-10 **Declaration** of LNA dated 3 February 1989, sent to CMC
- AD-14 **Declaration** of LNA (without date)
- AD-15 **Offer** (80-43/298 D32) issued by SITMA to LNA on 13 September 1983 concerning a machine

SITMA-C80/750

- AD-17 **Declaration** of LNA, sent to CMC, dated
12 October 1988
- AD-19 **Letter** issued by LNA to CMC, dated 13 January
1988
- AD-20a **Declaration** of Mr Cavargini, dated 27 January
1994 concerning a drawing of CMC dated
13 January 1985 (see document AD-20d)
- AD-20c **Declaration** issued by LNA, dated 20 October 1988
- AD-20d **Drawing** of CMC dated 13 January 1985 attached to
the declaration AD-20c
- AD-22a **Declaration** of Mr Mario NEGRI, issued by CONPIT
(without date)
- AD-22b **Declaration** issued by CONPIT dated 8 November
1993
- AD-22c Copy of the **leasing contract** between CONPIT and
ITALEASE, dated 9 May 1983 and concerning a
machine SITMA C80/750
- (iv) Documents filed by the Respondent:
- RD-1 **Invoice** No. 011 issued by CSA to LNA, dated
9 October 1989
- RD-6a **Service note ("Bolla")** No. 80086 dated
18 October 1985, issued by SITMA and signed by

Mr Luciano BARDELLI, concerning a service intervention made on a machine SITMA C750 No. 325 Serie XIX at CONPIT

- RD-6b **Declaration** of Mr BARDELLI dated 10 May 1994 concerning the note RD-6a (on the rear side of the service note RD-6a)

- RD-12 **Declaration** made by Roberto Graziosi (CSA) before the Civil Court of Milan on 22 September 1987

- RD-14 Invoice No. 948 issued by SITMA to ITALEASE, dated 16 May 1983

- (v) Further documents filed by **Appellant I**

- AD-26a Copy of the **delivering note** No. 14830/83, issued by SITMA to CONPIT on 2 December 1983 (No. 2530)

- AD-26b Copy of the **invoice** No. 2368 issued by SITMA to CONPIT on 13 December 1983

- AD-27 **Declaration**, dated 13 September 1994, issued by the firm NUOVA ADDRESSROMA DUE Srl (new firm name of LNA) to CMC

- AD-41 Partial Photocopy of a **drawing** of SITMA

- AD-45 **Operating manual** ("Manuale di istruzione") of the machine SITMA-C80/305 (from series XVIII)

- AD-46 **Spare parts book** ("Catalogo parti di ricambio") of the machine C80/750-I, Serie XIX, N° 325

IX. The Respondent confirmed the presence of all witnesses named by him, namely Mr Bardelli, Mr Graziosi and Mr Manzini, and asserted that these witnesses wished to express themselves in Italian and indicated the names of two interpreters for the translation from Italian into English and vice versa.

The Appellants confirmed the presence of only three of the witnesses cited by them, namely of Mr Marino, Mr Pacini and Mr Ponti, and indicated the name of an interpreter for the translation from Italian into English and viceversa.

X. The taking of evidence and oral proceedings took place on 21 and 22 November 2001.

The witnesses Mrs Negri and Mr Negri, who were summoned by the Board, did not appear at the hearing. During the oral proceedings the Appellants filed two declarations in the Italian language (see sheets 437 to 440 of the appeal file), each declaration being signed by the respective witness before a public notary in Italy.

The witnesses Mr Bardelli, Mr Graziosi, Mr Marino, Mr Manzini, Mr Pacini and Mr Ponti were heard by the Board.

XI. During the oral proceedings the parties essentially argued as follows:

(i) With regard to Article 100(c) EPC, the Respondent argued that the feature concerning the temperature control of the welder was not an essential feature.

- (ii) With respect to the alleged public prior uses, the Appellants essentially argued that the depositions of the witnesses made it clear that packaging machines provided with an oscillating longitudinal welder as defined in Claim 1 of either the main or the auxiliary request were made available to the public before the priority date of the patent in suit.

In these respects, the Respondent argued that neither the evidence provided by the Appellants nor the depositions of the witnesses proved that the packaging machines to which the allegations of the Appellants referred (ie the machine according to the alleged public prior uses) were provided with an oscillating longitudinal welder.

- (iii) The Respondent asserted that the machines of SITMA to which the first and second alleged public prior uses referred were provided with a rotating longitudinal welder, whose circular welding surface was constituted by an electrically heated wire. In this respect, the Respondent admitted that machines of this type (ie machines of the type SITMA C80 provided with a rotating longitudinal welder) had been produced by SITMA and sold respectively to LNA and to CONPIT before the date of priority of the patent in suit and that the subject-matter of Claim 1 according to the main request differed from a machine of this type in that the claimed machine included **means to impart a reciprocatory rocking motion to the longitudinal welder, said means being operatively connected to the motor-**

variator.

(iv) With respect to inventive step the Appellants essentially argued that the use of an oscillating welder instead of a rotating one did not imply any inventive skill.

XII. The Appellants requested that the impugned decision be set aside and that the patent be revoked. Moreover, they requested the reimbursement of the appeal fee in the case of revocation of the patent.

Auxiliarily, the Appellants requested that the case be remitted to the first instance for further prosecution.

XIII. The Respondent requested that the appeals be dismissed (main request).

Auxiliarily, the Respondent requested that the decision under appeal be set aside and the patent be maintained on the basis of the following documents:

- claims 1 to 5 as well as columns 1 to 4 of the description filed as auxiliary request with letter dated 11 February 1997; and
- Figures 1 to 4 as granted.

Reasons for the decision

1. The appeals are admissible
2. *Concerning the claimed subject-matter*
 - 2.1 Claim 1 of the patent as granted as well as of the auxiliary request are directed to a "longitudinal welding equipment in a machine for packaging products...". This expression has to be understood as defining a **machine for packaging products** which is **provided with a longitudinal welding equipment**. During the oral proceedings on 21/22 November 2001, the Respondent agreed with this interpretation.
 - 2.2 According to Claim 1 (of either the main or the auxiliary request), the longitudinal welding equipment comprises a welder pivotally mounted on a pivot axis and means for imparting a reciprocatory rocking motion to the welder about its pivot axis. During one of two phases of its rocking or oscillating motion, the welder has to be in contact with the packaging film in order to produce the longitudinal seal of the package. A welder of this type has been referred to by the parties as an "oscillating longitudinal welder".
3. *Concerning the terminology*
 - 3.1 The term "oscillating longitudinal welder" will be used hereinafter as referring to a longitudinal welder as defined in Claim 1 of the patent as granted (see section 2.2 above).
 - 3.2 The term "rotating longitudinal welder" will be used

hereinafter as defining a longitudinal welder having a circular welding surface lying in a longitudinal vertical plane, the welder being mounted on an axis and being provided with means for imparting a **continuous** rotating motion to said axis, the longitudinal sealing being produced during the continuous rotating motion when the welding surface is in contact with the packaging film.

- 3.3 It has to be noted that both the oscillating and the rotating longitudinal welder are normally provided with a mechanism providing the up and down movement of the welder which has to be carried out for instance at start up and shut down. This up and down movement can be either a linear vertical movement or a rocking (or oscillating) movement about a further axis, this further rocking or oscillating movement being different from the rocking or oscillating movement providing the sealing function.

4. *The alleged public prior uses*

4.1 The first alleged public prior use

- 4.1.1 The parties agreed that a machine SITMA C80/305 of the Series XVIII, No. 315 was sold by SITMA to LNA in 1983 as resulting from document NO-4. The parties also agreed that this machine corresponds to the machine referred to in document NO-12 as "SITMA 525, n. 158, serie VIII, 'Costruzione 82'" (see document NO-12, Nota 3, page 1, 3rd paragraph) which was inspected on 8 June 1990 by Mr Pisanty in Roma at the firm LNA (see NO-12, page 5, 4th paragraph).

It can be understood from document NO-12 (see pages 31

and 32 and the diagrammatic drawing dated 8 June 1990 inserted between pages 31 and 32, in combination with the first paragraph on page 41) that this machine SITMA 525, ie SITMA C80/305, on 8 June 1990 was equipped with a longitudinal oscillating welder.

Document NO-4, however, refers in general terms to a longitudinal welder identified as "Saldatore Mod. 548, N. 238, Serie X".

In relation to this alleged public prior use Mr Marino, Mr Manzini and Mr Graziosi were heard as witnesses during the taking of evidence on 21 and 22 November 2001.

4.1.2 The Appellants alleged during the written phase of the proceedings that the machine SITMA C80-305 was already equipped with an oscillating longitudinal welder when it was sold to LNA in 1983. In support of this allegation, the Appellants referred *inter alia* to documents NO-4, NO-5, AD-10, AD-17, AD-19, AD-27, AD-41 and AD-45 and named Mr Marino as a witness.

(a) Documents NO-5, AD-10, AD-17, AD-19 and AD-27 are declarations or letters issued by LNA, attributed to Mr Marino, which refer to a machine of the type SITMA C80 installed at LNA in Rome. In particular, documents NO-5, AD-17 and AD-19 refer to the machine SITMA C80 as being provided with a longitudinal oscillating welder.

(a') During the taking of evidence on 21 November 2001 Mr Marino confirmed that these documents had been signed by him. Mr Marino stated that

the machine SITMA C80/305 was already equipped with a longitudinal oscillating welder when it was delivered to LNA and that no modification concerning this welder had been carried out (see Minutes of the taking of evidence of 21 to 22 November 2001 (hereinafter Minutes/TE), first hearing of Mr Marino: page 2 (appeal file sheet No. 464), 8th paragraph; page 7 (appeal file sheet No. 469), 2nd paragraph).

4.1.3 During the written phase of the proceedings the Respondent asserted that the machine C80/305 was equipped not with an oscillating but with a rotating longitudinal welder when it was sold to LNA and that the longitudinal oscillating welder referred to in document NO-12 had been mounted only after the priority date of the patent in suit. In support of this allegation, the Respondent referred *inter alia* to documents OP-4, OP-5, OP-6, OP-7, RD-1, RD-12 and named Mr Manzini and Mr Graziosi as witnesses.

(a) Documents OP-4 to OP-6 are copies of constructional drawings of the firm SITMA, while document OP-7 is a transparency corresponding to document OP-6, all these drawings concerning longitudinal welders. Documents OP-4 (dated 30 May 1977) and OP-5 (dated 30 May 1977, updated 29 May(?) 1979) clearly concern a rotating longitudinal welder, while documents OP-6 and OP-7 (both dated 1 April 1981) concern an oscillating one. With regard to these documents, the Respondent alleged that SITMA started the manufacturing of oscillating welders only in October 1985 and that therefore the machine sold to LNA in 1983 could not have been

equipped with an oscillating welder. The Respondent also alleged that the oscillating welder as shown in documents OP-6 and OP-7 had been designed later than the indicated date by modifying existing transparencies concerning a welder of the type shown in documents OP-4 or OP-5 and that document OP-7 was an old transparency having a date of 1 April 1981 but modified later without indication of the date of the modification.

(a') During the taking of evidence Mr Manzini confirmed these allegations (see Minutes/TE, first hearing of Mr Manzini: page 1 (appeal file sheet No. 446), last paragraph; page 6 (appeal file sheet No. 451), 2nd paragraph).

(a'') It can be derived from the transparency OP-7 - due to the presence of erasures - that modifications of a previous drawing were carried out. However, no erasures can be seen in the portions of the transparency in which the longitudinal welder is represented (particular in the upper part which represents the half-moon shaped support of the oscillating welder). In this respect Mr Manzini, during the taking of evidence, explained that the modifications concerning the upper part of the drawing were carried out on a different transparency which could not be found in the files of SITMA (see Minutes/TE, first hearing of Mr Manzini: page 10 (appeal file sheet No. 455), last paragraph to page 11 (appeal file sheet No. 456), first paragraph). The Board considers this explanation as being credible, having also regard to the

fact that this document was submitted by the Respondent itself.

(b) Document RD-1 is an invoice issued on 9 October 1989 by the firma CSA, whose owner was the witness Mr Graziosi and which refers to an intervention made by CSA at LNA in Rom, the intervention consisting in replacing and repairing a longitudinal welder identified by the reference number 548. Document RD-12 is the copy of the deposition made by Mr Graziosi before the Civil Court of Milan referring to the intervention made by him at LNA in Rom in 1989, in which it is stated that the intervention consisted in replacing a rotating longitudinal welder by an oscillating one. With regard to these documents the Respondent alleged that the machine SITMA C80/305 sold by SITMA to LNA in 1983 was originally provided with a rotating longitudinal welder and that therefore the oscillating longitudinal welder installed on the machine SITMA inspected by Mr Pisanty in 1990 (see document NO-12) had been mounted on that machine only in 1989.

(b') During the taking of evidence Mr Graziosi confirmed these allegations (see Minutes/TE, hearing of Mr Graziosi, page 3 (appeal file sheet 493), 2nd paragraph).

4.1.4 Having regard to the comments in sections 4.1.2 and 4.1.3 above, the statement of Mr Marino according to which the machine sold by SITMA to LNA in 1983 was already provided with an **oscillating** welder when it was delivered to LNA (ie the statement that the machine

described by Mr Pisanty in document NO-12 was the original one, without any changes having been introduced in the original welder existing on the machine) is inconsistent with the statements of Mr Graziosi and Mr Manzini in so far as Mr Manzini stated that SITMA did not produce oscillating welders before October 1985 and Mr Graziosi stated that he found a **rotary** welder mounted on this machine in October 1989 and, thus, confirmed his declaration made before the Court of Milan (document RD-12).

4.1.5 During the oral proceedings the Respondent highlighted the statement of Mr Marino "I'm not a technician" (see Minutes/TE, first hearing of Mr Marino, page 7 (appeal file sheet 469), 6th paragraph) and argued that the deposition of Mr Marino was not based upon information that he derived directly from the machine but upon information given to him by the people working on the machine. Moreover, the Respondent argued that the Appellants had not proved their allegation that the machine was provided with an oscillating welder.

4.1.6 The Appellants during the oral proceedings essentially argued as follows:

- (i) The report of Mr Pisanty (ie document NO-12), which describes the machine SITMA C80/305 installed at LNA (and inspected on 8 June 1990) as being provided with an oscillating longitudinal welder, was based upon the previous opinion of Mr Rastelli (ie document NO-7) and refers to this opinion (see NO-12, page 6). Document NO-7, particularly the passage on page 27, 2nd and 3rd paragraph (from "Questo dispositivo saldatore ..." to "... in rotazione

insieme ai citati rulli"), also describes the machine C80/305 sold by SITMA to LNA in 1983 inspected by Mr Rastelli on 23 December 1988 as being provided with an oscillating longitudinal welder. Therefore, the statement of Mr Graziosi that this machine was provided in 1989 with a rotary welder is inconsistent with document NO-7.

- (ii) Document NO-4 refers to the longitudinal welder as a "Saldatore Mod 548" of the series X. The spare part book, ie document AD-46, relates - in the section "Apparato B, Saldatore longitudinale SITMA A 548" (sheets B-1 to B-9) - to spare parts which can be attributed to an oscillating longitudinal welder and characterises these spare parts with the sign "IX ÷" (this would mean that they are spare parts suitable for welders from the series IX onwards). Thus, it can be derived from document AD-46 that the welder of the series X mounted on the machine SITMA C80/305 sold to LNA in 1983 was an oscillating longitudinal welder.

- (iii) According to the deposition of Mr Marino the drawing of SITMA corresponding to document AD-41 and showing an electrical plant was delivered together with the machine according to document NO-4 in 1983. This drawing indicates that the machine is provided with means for controlling the temperature of the electrical wire of the longitudinal welder and is very similar to the Figure 3 of the patent as granted.

4.1.7 The Board cannot accept the arguments of the Appellants

(see section 4.1.6 above, items (i) to (iii)) for the following reasons:

- (i) Document NO-7 is an opinion of an expert appointed by one of the firms which is an appealing party in this proceedings and which was a party in a judicial proceedings before the Court of Milan. Therefore, document NO-7 is not an Official Report.

Furthermore, document NO-7 - although it is referred to in document NO-12 (see page 6) - is not identical with document NO-12. It is true that document NO-12 (see Nota 3, page 3, last paragraph to page 4, first paragraph) contains a passage identical with the passage on page 27 (2nd and 3rd paragraph) of document No-7.

However, it cannot be derived unequivocally from this passage, which is common to both documents, that the longitudinal welder is an oscillating one. In particular, the fact that the first sentence of the second paragraph on page 27 of document NO-7 refers to a "rocking support axis of the longitudinal welder" (ie to a "perno di supporto oscillante") does not imply the disclosure of an oscillating movement of the welder in the meaning of section 2.2 above, because it clearly refers to the rocking movement providing the up and down movement of the welder (see section 3.3 above). Moreover, although the second sentence of the third paragraph on page 27 of document NO-7 refers to "a rocker mechanism, linked to an eccentric point of a crank-pinion assembly brought into rotation together with the said rollers " (ie to

a "meccanismo a bilancere [sic], collegato eccentrico ad un gruppo pignone-manovella che è azionato in rotazione insieme ai citati rulli"), this sentence - without any drawing showing the spatial relationship of the elements of mechanism - cannot be interpreted as unequivocally defining an oscillating motion of the welder in the meaning of section 2.2 above.

Besides, document NO-12 contains not only a passage (see Nota 3) which is identical with the above mentioned passage in document NO-7 but also a drawing and a further passage which make it clear that the machine on 8 June 1990 was provided with an oscillating welder (see the diagrammatic drawing dated 8 June 1990 inserted between pages 31 and 32 and page 41, first paragraph). What is disclosed in document NO-12 is that **on 8 June 1990** there was an oscillating longitudinal welder.

- (ii) The fact that pages B-1 to B-9 of document AD-46 refer to spare parts for a welder A 548 for the series IX does not imply that all welders developed after the series IX were of the oscillating type. Firstly, it has to be noted that document A-46 does not relate to the machine SITMA C80/305 sold by SITMA to LNA but to the machine SITMA C80/750-I, Series XIX, No. 325, which is the SITMA machine leased to CONPIT by ITALEASE in 1983 (ie the machine according to the second alleged public prior use). Secondly, it is not unequivocally clear that the isolated spare parts represented in pages B-1 to B-9 of document AD-46 relate to an

oscillating welder.

(iii) Even if it were to be accepted that document AD-41 discloses a temperature control of the welder, this would not imply that the machine sold by SITMA to LNA was provided with an oscillating longitudinal welder.

4.1.8 Having regard to comments in section 4.1.4 above, with respect to the issue of whether the machine sold by SITMA to LNA was provided with an oscillating longitudinal welder there is a conflict not only between the allegations of the Appellants and those of the Respondent but also between the depositions of the witness Marino and those of the witnesses Graziosi and Manzini. In the present case, having also regard to the whole content of the depositions of these witnesses (as far as they concern this alleged public prior use) and the further evidence concerning the first alleged public prior use, the Board is not satisfied that the allegations of the Appellants (that the above-mentioned machine was provided with an oscillating longitudinal welder before the priority date) are supported by sufficient proof.

Since the burden of proof to provide evidence of the alleged prior use rests on the Appellants, the Board decides that the first alleged public prior use (according to which an oscillating longitudinal welder was mounted on the machine SITMA C80/305 sold to LNA in 1983) cannot be considered as belonging to the prior art according to Article 54(2) EPC.

4.2 The second alleged public prior use

4.2.1 The parties agreed that a machine SITMA C80/750 of the Series XIX, No. 325 was sold by SITMA to ITALEASE on 16 May 1983 (as resulting from document RD-14) and leased by ITALEASE to CONPIT (as resulting from document AD-22c). According to document AD-22c, this machine was provided with a longitudinal welder Model 548 of the series XI, No. 243.

In relation to this alleged public prior use Mr Manzini and Mr Bardelli were heard as witnesses during the taking of evidence on 21 and 22 November 2001.

4.2.2 The Appellants, during the written phase of the proceedings, asserted that this machine was already equipped with an oscillating longitudinal welder when it was delivered to CONPIT in 1983. The Appellants referred *inter alia* to documents AD-22a, AD-22b, AD-26a and AD-26b, and named Mrs Negri and Mr Negri as witnesses.

(a) Document AD-22a is a declaration in which Mr Mario Negri (CONPIT) refers to a SITMA-machine C80/750 of the Series XIX, No. 325 manufactured in 1983 and to a longitudinal oscillating welder and states not only that the welder was mounted on the machine at the time of its delivery but also that it had never been modified since its delivery. Document AD-22b is a declaration issued by CONPIT and attributed by the Appellants to Mrs Angela Negri (CONPIT), in which it is stated that a SITMA-machine C80/750 of the Series XIX, No. 325 manufactured in 1983 is installed at CONPIT and is provided with a longitudinal oscillating welder. Documents AD-26a and AD-26b relate to the selling and

delivering of spare parts from SITMA to CONPIT, particularly of wires for a "basculating" welder ("fili per saldatore basculante"). During the written phase of the proceedings the Appellants argued that the word "basculating" should be interpreted as a synonym of "oscillating".

- (a') With respect to these allegations, Mrs Negri and Mr Negri were summoned by the Board. However, they did not appear at the taking of evidence. During the oral proceedings the Appellants justified their absence by referring to their age.

- (b) During the oral proceedings the Appellants filed two declarations ("dichiarazione sostitutiva di atto notorio"), signed respectively by Mrs Negri and Mr Negri before a public notary in Italy on 16 November 2001, and justified the late filing of these declarations by referring to the absence of the summoned witnesses.

- (b') The declarations filed during the oral proceedings are disregarded for the following reasons:

Firstly, they were filed only during the oral proceedings, ie at a very late stage of the appeal proceedings. In this respect, the Board cannot accept the justifications given by the Appellants, since the age of the witnesses must have been known to the Appellants when the witnesses were summoned. Moreover, the witnesses did not request to be heard by the competent court of their country of residence

(Rule 72(2)(c) EPC), although they were informed of this possibility in the summons to give evidence (see section 3 on page 1).

Secondly, these declarations are not written in an Official language of the EPO and no translation has been filed.

Thirdly, the information content of these declarations - as the Appellants themselves affirmed during the oral proceedings - does not extend beyond the content of the previous declarations AD-22a and AD-22b.

4.2.3 During the written phase of the proceedings, the Respondent asserted that the machine SITMA C80-750 was not equipped with an oscillating but with a rotating longitudinal welder when it was delivered to CONPIT. In support of this allegation, the Respondent referred *inter alia* to documents RD-6a, RD-6b and RD-14 and named Mr Manzini and Mr Bardelli as witnesses.

(a) Document RD-14 is the invoice issued by SITMA to ITALEASE concerning the machine C80/750 and refers to a longitudinal welder, Model 548, Number 243 of the Series XI. In this respect, the Respondent had argued that also the welder 548 of the Series XI was a rotating welder.

(a') Mr Manzini, during the taking of evidence, stated that the welder of the Series XI delivered to CONPIT in 1983 and that delivered to LNA (ie of the Series X) were of the same type with regard to the welding unit (see Minutes/TE, 1st hearing of Mr Manzini, page 4

(appeal file sheet 449), 3rd paragraph).
Furthermore, Mr Manzini confirmed the allegation of the Respondent that SITMA started the production of longitudinal oscillating welders only in October 1985 (see Minutes/TE, second hearing of Mr Manzini, page 1 (file sheet 459), 1st paragraph).

(b) Document RD-6a is a note of SITMA concerning a service intervention made by Mr Bardelli, employee of SITMA, on 18 October 1985 on the machine C80/750 (Series XIX) No. 325 installed at CONPIT. Document RD-6b is a declaration of Mr Bardelli in which it is stated that a welder 548 has been replaced by a new type welder. In this respect, the Respondent had argued that the original welder of the machine SITMA C80-750 installed at CONPIT was replaced by a longitudinal oscillating welder on 18 October 1985, ie after the priority date of the patent in suit.

(b') During the taking of evidence, Mr Bardelli confirmed this allegation of the Respondent in so far as he stated that the assistance office of SITMA gave him the order to replace the existing welder with an oscillating one (see Minutes/TE, Hearing of Mr Bardelli, page 2 (appeal file sheet 480), 3rd and 4th paragraphs).

4.2.4 Having regard to the comments in sections 4.2.2 and 4.2.3 there is a contradiction not only between the allegations of the Appellants and those of the Respondent but also between the declarations issued by

CONPIT (documents AD-22a and AD-22b) and the declaration of Mr Bardelli (document RD-6b).

4.2.5 During the oral proceedings the Appellants argued as follows:

- (i) In documents AD-26a and AD-26b, which refer *inter alia* to the delivery (in December 1983) of wires for the welder ("Fili per saldatore basculante"), the wires are defined by the code 0548193. On page B-6 of the spare parts book AD-46 a wire ("filo saldatore") having a semicircular rigid shape, ie suitable for the half-moon shaped support of an oscillating welder, is represented and is indicated by the same code. Since page B-6 of document AD-46 concerns an oscillating longitudinal welder, it is clear that the wires delivered in December 1983 by SITMA to CONPIT were suitable for an oscillating welder. Therefore, the SITMA machine installed at CONPIT was provided already in 1983 with an oscillating longitudinal welder.

- (ii) Document OP-2 refers to a "basculating welder" ("saldatore basculante"). On the basis of this document, which was submitted by the Respondent during the oral proceedings before the Opposition Division (see Minutes of the oral proceedings, page 3, 3rd paragraph), the Respondent alleged during said oral proceedings that an oscillating welder was mounted on the machine C80/305 only at the date of document OP-2, ie in 1987. It is clear from the minutes of the oral proceedings before the Opposition Division that the Respondent considered the term

"basculating" as meaning "oscillating".
Moreover, it is clear from page 17 (lines 2 to 4, 12 and 13) of a further report of Mr Pisanty (submitted as enclosure C96 of the Appellants' letter dated 12 March 1996) that the terms "oscillating" and "basculating" are synonyms because this further report refers to a "oscillating-basculating motion" of the welding bar. Therefore, the reference to a "basculating welder" in documents AD-26a and AD-26b indicates that an oscillating welder was already installed on the machine C80/750 of CONPIT in December 1983.

4.2.6 With regard to item (i) in section 4.2.5 above, the Respondent alleged during the oral proceedings that the electrical wires (as spare parts) for a rotating welder and for an oscillating welder were the same and that the wire can be deformed in order to adapt it to the shape of the support and cut in order to adjust its length. The Respondent also asserted that it was advantageous to keep the same part for both welders. In this respect, the Appellants alleged that the wires cannot be cut because of their rigidity and of the presence of connecting ends for ensuring the electrical contacts.

Furthermore, it was emphasized that Mr Bardelli updated the operating manual AD-46 after modifications of the machine involved were made, so that possible indications to spare parts for an oscillating welder were made available solely after Mr Bardelli's intervention, ie after 15 to 17 October 1985.

The Board finds that the allegations of the Respondent

are more convincing, particularly since it seems reasonable that a new development was made available to the public as soon as possible (ie on 15/17 October 1985) after the filing of the patent application (ie 24 September 1985) and free of charge in order to display it to other customers. Moreover, these allegations are supported by the deposition of Mr Manzini who stated that the wire for the rotating welder is longer than that for the oscillating one and that at the time of the assembly a part of it is cut off (see Minutes/TE, second hearing of Mr Manzini, page 4 (appeal file sheet 462)). Therefore, the Board cannot accept the Appellants' arguments referred to in section 4.2.5(i) above.

- 4.2.7 With regard to item (ii) in section 4.2.5 above, the Respondent argued that the invoice AD-26b was not drafted by a technician but by an employee of the commercial department of SITMA. Therefore, a precise technical meaning cannot be attributed to the term "basculating" in this invoice.

In these respects, the Board considers that it is in principle possible to use the word "basculating" to define an oscillating motion. However, without a clear indication of the axis of the motion, the word "basculating" - when it refers to a longitudinal welder - cannot unequivocally imply that the welder axis has an oscillating motion when it is performing the longitudinal seal, because it could also define the movement of the welder which has to be carried out when starting or shutting down.

Moreover, the fact that the meaning of "oscillating" may be given to the term "basculating", when it is used

in other documents, does not imply that the same meaning has to be given to this term when it is used in documents AD-26a and AD-26b.

Therefore, the Board cannot accept the Appellants' arguments referred to in section 4.2.5(ii) above.

- 4.2.8 Having regard to the above comments, with respect to the conflict between the allegations of the parties in relation to the issue of whether or not the machine delivered by SITMA to CONPIT was provided with an oscillating longitudinal welder, the Board finds that the allegations of the Appellants are less convincing than those of the Respondent.

Moreover, the allegations of the Respondent have been confirmed by the depositions of the witnesses Mr Manzini and Mr Bardelli, while in respect of the allegations of the Appellants the hearing of the witnesses Mrs Negri and Mr Negri did not take place.

It follows that the Board finds that it has not been proved that an oscillating longitudinal welder was mounted on the machine SITMA C80/705 delivered to CONPIT in 1983. Thus, the second alleged public prior use cannot be considered as belonging to the prior art according to Article 54(2) EPC.

- 4.3 The third alleged public prior use

- 4.3.1 It can be derived from documents NO-2 and NO-3 that a machine RITMICA H 30 was sold by CMC to LNA and delivered on 21 May 1985.

In relation to this alleged public prior use Mr Marino

and Mr Ponti were heard as witnesses during the taking of evidence on 21 and 22 November 2001.

4.3.2 During the written phase of the proceedings, the Appellants asserted that this machine RITMICA H 30 was already equipped with an oscillating longitudinal welder when it was sold and delivered to LNA in 1985. The Appellants referred *inter alia* to documents NO-2, NO-3, AD-17, AD-19, AD-20c and AD-20d, which are the most relevant documents cited in support of this allegation. The Appellants designated *inter alia* Mr Marino and Mr Ponti as witnesses.

(a) Document NO-3 is a copy of the invoice relating to the machine RITMICA H 30, while document NO-2 is the delivering note of that machine. Both documents refer to a "rotating longitudinal welder". With regard to the term "rotating", the Appellants argued that this term was used to refer to oscillating welders because any oscillating movement implies a rotation about an axis.

(a') During the taking of evidence Mr Ponti, who was the former owner of the firm "CMC di Ponti Giuseppe" and is now manager of "CMC Srl", confirmed that the word rotating was wrongly used to define an oscillating motion and stated that the machine RITMICA H 30 was actually delivered to LNA with an oscillating longitudinal welder (see Minutes/TE, hearing of Mr Ponti, page 2 (appeal file sheet 502), 3rd paragraph). Mr Ponti also stated that the machine delivered to LNA was one of the first machines of type RITMICA H 30 assembled by CMC

(see page 6 (appeal file sheet 506), 2nd paragraph) and that no manuals or catalogues concerning the machine were provided (see page 5 (appeal file sheet 505), 3rd paragraph). Moreover, Mr Ponti stated that no substantial modification on the machine installed at LNA, and particularly no modification concerning the transversal welding system, was made in the first period of time after the delivering.

- (b) Documents AD-17, AD-19 and AD-20c are declarations or letters issued by LNA and attributed to Mr Marino and which refer to a machine of the type RITMICA H 30 installed at LNA in Rome. In particular: In document AD-19, which is dated 13 January 1988, it is stated that the machine CMC in possession of LNA is provided with an oscillating longitudinal welder. In document AD-17, which is dated 12 October 1988 and refers to a machine bought by LNA with the invoice corresponding to document NO-3, it is stated that this machine was provided with "a longitudinal welder oscillating with a to-and-fro motion driven by a crank-lever similar to the one shown in the drawing No-4-1136 dated 1 April 1981 Mod.A-548 [ie document OP-6]". Document AD-20d is a drawing of CMC dated 13 January 1985 showing a longitudinal welder. It can be understood from this drawing that the welder represented there is of the oscillating type. In the declaration AD-20c, which is dated 20 October 1988, reference is made to the drawing AD-20d and it is stated that this drawing corresponds to the longitudinal welder mounted on the machine

RITMICA H 30 delivered by CMC.

(b') During the taking of evidence, Mr Marino stated that the machine RITMICA H 30 installed at LNA was provided with an oscillating longitudinal welder (see Minutes/TE, second hearing of Mr Marino, for instance page 3 (appeal file sheet No. 474), last paragraph to page 4 (appeal file sheet 475), first paragraph). Moreover, Mr Marino stated that no manuals were provided because the machine was one of the first machines or even a prototype produced by CMC (see second hearing, page 1 (appeal file sheet 472), last paragraph; page 2 (appeal file sheet No. 473), first paragraph; and page 3 (appeal file sheet 474), 3rd paragraph) and that modifications of the transversal welder were carried out (see second hearing, page 2, 3rd paragraph in conjunction with the comments of Mr Marino (see second hearing, page 4 (file sheet 475), 3rd and 4th paragraphs).

(b'') To the question of when he saw the drawing AD-20d for the first time, Mr Marino answered: "When the machine was delivered". However, when he was reminded that he had said before that the machine had been delivered without any document, he answered "After 15 years it is rather difficult to remember all the details" (see Minutes/TE, second hearing, page 6 (appeal file sheet No. 477), 2nd paragraph).

Asked by the Board why - in order to describe the longitudinal welder installed on the machine RITMICA H 30 - he made reference in the

declaration AD-20c to a CMC-drawing (ie to document AD-20d), whereas in the declaration AD-19, which was made eight days before the declaration AD-20c, he made reference to a SITMA-drawing (ie to document OP-6), Mr Marino answered "I'm unable to remember that. Too much time has gone by" (see Minutes/TE, second hearing, page 6 (appeal file sheet 477), last paragraph).

(b''') When he was asked by the Board to describe exactly the shape of the support for the electrical wires of the welder mounted on the machine RITMICA H 30, Mr Marino stated that the support had a half-moon shape (see Minutes/TE, second hearing, page 2, 5th and 6th paragraphs).

4.3.3 With respect to this public prior use the Appellants, during the oral proceedings, only pointed out that Mr Ponti stated during the taking of evidence that the machine RITMICA H 30 was provided with an oscillating longitudinal welder.

4.3.4 With respect to this prior use the following has to be noted:

(i) Neither catalogues nor manuals concerning the specific machine RITMICA H 30 sold by CMC to LNA and dated before the priority date of the patent in suit are available.

The most relevant written information sources containing a description of a machine of the type RITMICA H 30 are the CMC-drawing AD-20d and the official Report of Mr Pisanty, ie document

NO-12. Document AD-20d (which is an internal document of CMC) concerns a longitudinal welder for machines of the type RITMICA H 30 and, according to a declaration of Mr Cavargini (see document AD-20a), was drafted on 13 January 1985. Document NO-12 (which is dated after the priority date of the patent in suit) describes a machine of the type RITMICA H 30 inspected by Mr Pisanty in Madonna dell'Olmo (Cuneo, Italy) on 24 May 1990 (see Nota 2). However, none of documents AD-20a, AD-20d and NO-12 can be directly connected with the specific machine RITMICA H 30 delivered to LNA in May 1985. In this respect, it has to be considered that Mr Marino, although he referred to the drawing AD-20d in a previous declaration, gave no precise answer to the questions concerning the drawing AD-20d (see section 4.3.2(b'') above).

Each witness, in the decision concerning taking of evidence dated 20 July 2001 which was attached to the Summons to give evidence pursuant to Article 117(3)(a) and Rule 72(2) EPC dispatched on 10 September 2001, was requested to bring with him any written documents which have a connection with the topics of the taking of evidence (see section 5 of the above mentioned decision). However neither Mr Marino nor Mr Ponti brought any documents to the taking of evidence.

Therefore, in the present case, the information concerning the description of the machine relies exclusively upon the depositions of the witnesses, which cannot be based upon any

written record.

- (ii) Mr Ponti is now a manager of CMC but he was in 1985 the administrator of this firm.
- (iii) The deposition of Mr Marino contains not only unclear answers relating to the drawing AD-20d (see section 4.3.2(b'') above) but also an inconsistency relating to the shape of the support for the electrical wire of the welder in so far as he stated that the support of the longitudinal welder had a half-moon shape while the drawing AD-20d shows a disc-shaped support (see section 4.3.2(b''') above).
- (iv) The deposition of Mr Marino also conflicts with that of Mr Ponti in so far as these depositions refer to the transverse welder (see section 4.3.2(b') above).
- (v) The declaration that the involved machine RITMICA H 30 was one of the first machines (or even a prototype) produced by CMC with an oscillating longitudinal welder is weakened by the fact that about three months before the firm ELLEPI apparently had already bought such a machine (see fourth alleged public prior use).

Therefore, the Board finds that it is not proved that an oscillating longitudinal welder was mounted on the machine RITMICA H 30 delivered to LNA in 1985. Thus, the third alleged public prior use cannot be considered as belonging to the prior art according to Article 54(2) EPC.

4.4 The fourth alleged public prior use

4.4.1 It can be derived from documents AD-8a, AD-8b, AD-8d and AD-8e that a machine RITMICA H 30 was sold on 1 March 1985 (invoice date) by the firm CMC di Ponti Giuseppe to SIL, leased by SIL to ELLEPI and delivered to ELLEPI on 23 February 1985.

In relation to this alleged public prior use Mr Pacini and Mr Ponti were heard as witnesses during the taking of evidence on 21 and 22 November 2001.

4.4.2 During the written phase of the proceedings, the Appellants alleged that also this machine RITMICA H 30 was already equipped with an oscillating longitudinal welder when it was delivered to ELLEPI in 1985. The Appellants referred not only to documents AD-8a, AD-8b, AD-8d and AD-8e but also to document AD-9, these documents being the most relevant documents cited in support of this allegation, and cited Mr Pacini and Mr Ponti as witnesses.

(a) Document AD-8a refers to a machine RITMICA H 30 and indicates that the machine is provided with a longitudinal **rotating** welder. Document AD-8b also refers to a longitudinal **rotating** welder.

(a') Mr Ponti during the taking of evidence explained that the term "rotating" has to be understood as meaning "oscillating", as already mentioned in section 4.3.2(a') above.

(b) Document AD-9 is a declaration, dated 24 January 1994, signed by Mr Pacini (owner of ELLEPI), referring to document AD-8a and stating that

ELLEPI bought in 1985 the CMC machine mentioned in document AD-8a and that this machine was provided with an oscillating longitudinal welder.

(b') During the taking of evidence Mr Pacini confirmed this.

(b'') Mr Pacini also stated that the machine RITMICA H 30 bought in 1985 was traded in in 1990 and replaced by a new RITMICA H 30. For the first machine there was an instruction manual, this manual was given back with the machine when it was traded in in 1990 (see Minutes/TE, hearing of Mr Pacini, page 4 (appeal file sheet No. 487), 5th and 7th paragraphs; page 5 (appeal file sheet No. 488), 1st to 3rd paragraph).

(b''') Mr Pacini also stated that he had another wrapping machine using a **rotating** longitudinal welder which for technical reasons was never used (see page 2 (appeal file sheet 485), last paragraph), that he had knowledge of a problem arising with the rotating welder and that, when he ordered the first machine RITMICA H 30, he had been informed that the **oscillating** longitudinal welder solved that problem.

4.4.3 Having regard to the comments in sections 4.4.2(b'') and 4.3.2(a') above there is a conflict between the depositions of Mr Pacini and Mr Ponti with respect to the existence of an instruction manual for the machine RITMICA H 30.

4.4.4 During the oral proceedings the Appellants with regard

to the use of the term "rotating" referred to the deposition of Mr Ponti and argued analogously as in section 4.3.2(a) above.

With regard to the conflict concerning the instruction manual (see section 4.4.3 above), the Appellants essentially argued that Mr Pacini is a technician while Mr Ponti is a manager.

4.4.5 With respect to this prior use the following has to be noted:

- (i) Also for this alleged public prior use the information concerning the description of this machine RITMICA H 30 relies exclusively upon the depositions of the witnesses (see comments in section 4.3.4(i) above).
- (ii) The inconsistencies between the depositions of Mr Pacini and Mr Ponti concerning the instruction manual of the machine RITMICA H 30 give rise to doubts on the capacity of these witnesses to precisely remember the facts. The argument of the Appellants referred to in section 4.4.4 above is not relevant because the issue of whether an instruction manual was prepared for a machine has no technical character.
- (iii) The statement of Mr Pacini referred to in section 4.4.2(b''') is inconsistent with document AD-8b, the order of the machine RITMICA H 30 signed by Mr Pacini.

Namely, it is not convincing that Mr Pacini,

knowing that a problem concerning **rotating** longitudinal welders had been solved by developing an oscillating longitudinal welder, signed an order for a machine allegedly provided with an "oscillating" welder in which the welder is called "rotating welder".

Therefore, the Board finds that it is not proved that an oscillating longitudinal welder was mounted on the machine RITMICA H 30 delivered to ELLEPI in 1985. Thus, even the fourth alleged public prior use cannot be considered as belonging to the prior art according to Article 54(2) EPC.

- 4.5 Further evidence submitted by the Appellants and concerning machines of the types SITMA C80 and RITMICA H 30
 - 4.5.1 During the written phase of the proceedings the Appellants submitted further evidence concerning machines of the above mentioned types and, in respect of this evidence, had cited further witnesses (see section III above). The Board found that this further evidence was less relevant than the evidence referred to in sections 4.1 to 4.4 above and expressed in a communication its preliminary opinion that it was not necessary to hear the further witnesses (see section VI above). Since the Appellants did not submit any argument in reply to this preliminary opinion, the Board sees no reason to deviate from it.
 - 4.5.2 Document AD-15 is an offer issued by SITMA to LNA dated 13 September 1983 and concerning a machine SITMA C80/750.

In this respect, the Appellants pointed to the paragraph describing the longitudinal welder 548/A, in particular to the sentence according to which "the welding sector is driven with alternate motion on the same axis of the upper presser rollers and is connected with them as far as the height adjustments is concerned" (sheet No. 8 of AD-15), and argued that this sentence disclosed an oscillating longitudinal welder.

The Board finds that this sentence does not disclose in a clear and unequivocal way an oscillating welder, particularly since a rotating welder is mentioned in the paragraph headed "80/305 AVVOLGITRICE AUTOMATICA" (sheets No. 6 and 7 of AD-15). Furthermore, the reference to "the same axis of the upper presser roller" does not permit the Board to clearly establish that the alternate motion is an oscillating motion in the meaning of section 2.2 above.

4.6 Therefore, the evidence submitted by the Appellants does not prove that packaging machines either of the type SITMA C80 or of the type RITMICA H 30 were made available to the public in a version provided with an oscillating longitudinal welder as defined in section 2.2 above.

5. *Article 100(b) EPC*

Appellant II argued that Claim 1 of the patent as granted does not disclose the invention in a manner sufficiently clear for the skilled person to carry out the invention and requested that the patent be revoked for this reason.

The Board in the communication dated 12 October 1995

expressed its provisional opinion that the patent discloses the invention in a manner sufficiently clear and complete for it to be carried out by a skilled person.

Since none of the Appellants submitted further arguments in reply to this provisional opinion, the Board, after reconsideration of the objection, sees no reason to modify its provisional opinion in this respect.

Therefore, the ground for opposition according to Article 100(b) EPC does not prejudice the maintenance of the patent on the basis of either the main or the auxiliary request of the Respondent.

6. *The main request of the Respondent*

6.1 Claim 1 of the application as filed contains the feature "said welding means being equipped with temperature means for temperature controlling operatively connected to the packaging speed" whereas Claim 1 of the patent as granted no longer specifies this feature.

The Board in the communication dated 12 October 1995 expressed its provisional opinion that in the application as originally filed there was no basis for the omission of this feature. In particular, the Board considered that the description of the application as filed did not indicate that the omitted feature had no essential character but indicated that "a nearly continuously operating hot-bar longitudinal welding means 44 requires necessarily a suitable control of the welding temperature" (see page 5, lines 18 to 22).

6.2 In this respect, during the oral proceedings the Respondent argued that the omitted feature is not an essential feature since the packaging machine can also work at a constant speed.

6.2.1 The Board cannot accept this argument for the following reasons:

(i) Claim 1 of the patent as granted and Claim 1 of the application as filed specify the features that the conveyor belt on which the product are fed is "driven by a motor-variator (15, 17)" and that the means to impart a reciprocatory motion to the longitudinal welder "are operatively connected to said motor-variator". It is clear not only that the motor variator is suitable for varying speed of the feeding conveyor when there is a need to vary the speed but also that, when the packaging speed is varied, the time for performing the longitudinal seal changes. Thus, it is also clear that a change (particularly an increase) in the packaging speed would affect the quality of the longitudinal seal of the package if no counter-measure were undertaken. The only counter-measure disclosed in the application as filed is the temperature control of the longitudinal welder. Therefore, the suppression of the above mentioned feature would result in producing an imbalance in the functioning of the machine.

(ii) The presence of a motor-variator and of means for controlling the temperature of the welder does not necessarily imply either a continuous change in the packaging speed or a continuous

variation of the welding temperature but only the possibility to change the speed and to adapt the welding temperature correspondingly. This means that the motor-variator can be set so that the machine can work at a constant speed over a certain period of time without there being any need to change the temperature of the welder over this period of time. However, the means for controlling the temperature of the welder are present in order to adjust the welding temperature in dependance on the packaging speed **when** there is a need to vary the packaging speed.

6.3 Therefore, the main request of the Respondent which is based upon Claim 1 of the patent as granted has to be rejected because it contravenes Article 100(c) EPC.

7. *Amendments (auxiliary request)*

7.1 No objection with regard to Article 123(2) EPC was raised with respect to the auxiliary request.

7.1.1 Claim 1 of this request differs from Claim 1 of the patent as granted in that the feature that "the welding surface of the welder (44) is constituted by an electrically heated bar, means (50-56) being provided to control the temperature of said bar in dependance on the packaging speed" has been added.

The added feature, which was specified in Claim 2 of the patent as granted, can be derived from a passage in Claim 1 of the application as filed (lines 12 to 14) in conjunction with a passage of the description (page 4, line 23 to page 5, line 1, see particularly page 4,

lines 27 to 30).

7.1.2 The further amendments consist in the re-numbering of the dependent claims and in the adaptation of the description to the amended Claim 1.

7.2 The Board is satisfied that the amendments do not contravene Article 123(2) and (3) EPC.

8. *Novelty (auxiliary request)*

The subject-matter of Claim 1 is novel (Article 54 EPC). Novelty was not disputed.

9. *Inventive step (auxiliary request)*

9.1 During the written phase of the proceedings Appellant II argued that the claimed subject-matter lacks inventive step in view of documents US-A-3 307 324, US-A-4 546 595 and US-A-4 004 400.

The Board with the communication dispatched on 2 June 1999 drew the attention of the parties to the fact that document US-A-4 546 595 was published on 15 October 1985, ie after the claimed priority date of the patent in suit. Moreover, the Board expressed the provisional opinion that the patent in suit was entitled to the claimed priority date and that the above mentioned documents did not justify the revocation of the patent. This applies of course even more to a patent based on the auxiliary request.

The Appellants neither expressed comments in reply to the opinion of the Board in these respects nor referred to the above mentioned documents during the oral

proceedings.

Thus, the Board, after reconsideration of the objections, sees no reason to deviate from its preliminary opinion.

- 9.2 The closest prior art is a machine of the type SITMA C 80 provided with a **rotating** longitudinal welder (see section XI(iii) above).

It has to be noted that document AD-45 refers to a longitudinal welder provided with means for adjusting the temperature of the welder in so far as page 20 refers to a potentiometer 11 as shown in Figure 1 (page 5) for varying the temperature of the welder. Thus, it can be assumed that the machine according to the closest prior art was provided with means for manually controlling the temperature of the welding surface of the longitudinal welder.

- 9.2.1 The machine according to the prior art suffers from the disadvantage that the longitudinal seal of the package may present non-sealed portions because the electrically heated bar forming the circular welding surface of the welder is not arranged along the whole circular surface of the welder due to the presence of a gap between the connecting ends of the electrical wire.

- 9.2.2 Having regard to the comments in section 9.2 above, the subject-matter of Claim 1 of the auxiliary request not only differs from the closest prior in that

- (a) the machine includes **means to impart a reciprocatory rocking motion to the longitudinal welder, said means being operatively connected**

to the motor-variator,

but it can also be assumed that it differs therefrom also in that

(b) means (50-56) are provided to control the temperature of heated bar constituting the welding surface of the welder **in dependance on the packaging speed.**

9.2.3 The Board is satisfied that feature (a) permits the elimination of the drawback referred in section 9.2.1 above. Furthermore, it is clear that feature (b) allows an automatic adjustment of the welding temperature improving the quality of the seal.

The problem to be solved is therefore to provide a packaging machine capable of improving the quality and the reliability of the longitudinal seal of the package. Both features (a) and (b) co-operate to solve this problem.

9.2.4 No document is available which either describes an oscillating welder or indicates the advantages obtained by the use of a welder of this type. Thus, the skilled person would not find in the available prior art any indication suggesting to him to replace the rotating welder by an oscillating one in a machine according to the prior art.

It has however to be examined whether the skilled person would arrive at the claimed subject-matter on the basis of its general knowledge and of its skill.

In this respect, the Appellants argued during the oral

proceedings that the drawbacks of rotating longitudinal welders (see section 9.2.1 above) were well known, that the use of an oscillating welder was the only possible solution for eliminating these drawbacks and that, therefore, it would have been obvious for the skilled person to arrive at the claimed subject-matter.

The Board is not convinced that the use of an oscillating welder is the only possible solution. As the Respondent pointed out during the oral proceedings, it is possible to avoid the drawback referred to in section 9.2.1 above by performing the longitudinal seal by means of a fixed electrically heated welder or by using glue. Moreover, the skilled person trying to solve this problem could work on the position of the connecting ends of the heated bar relative to each other in order to minimize the gap existing between the ends. Therefore, the skilled person when confronted with the problem of eliminating the drawback of the closest prior art is not in a "one way street" situation leading him compulsorily to the claimed solution.

Therefore, the Board finds that the subject-matter of the independent Claim 1 is not obvious to a person skilled in the art, so that the subject-matter of the independent Claim 1 of the auxiliary request is considered as involving an inventive step as required by Article 56 EPC.

10. *The Appellants' request for remittal*

With respect to their request to remit the case to the first instance for further prosecution, no arguments were submitted by the Appellants.

Furthermore, the Board does not see any reason to remit the case to the first instance. Thus, this request cannot be allowed.

11. The patent can therefore be maintained on the basis of the auxiliary request of the Respondent.
12. *The request for reimbursement of the appeal fees*

According to Rule 67 EPC the reimbursement of the appeal fees shall be ordered where at least "the Board of Appeal deems the Appeal to be allowable". Since already this condition is not met in the present case, this request of the Appellants cannot be allowed.

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 in the following version:
 - claims 1 to 5 as well as columns 1 to 4 of the description filed as auxiliary request with letter dated 11 February 1997; and
 - Figures 1 to 4 as granted.

The Registrar:

The Chairman:

G. Magouliotis

C. Andries