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D E C I S I O N
of 2 February 1999

Case Number: T 1111/96 - 3.2.5

Application Number: 92850160.0

Publication Number: 0521841

IPC: B29C 49/08

Language of the proceedings: EN

Title of invention:

Method for making a container of plastic, and container made by means of the method

Patentee:

PLM AB

Opponent:

Schmalbach-Lubeca AG
Carlsberg A/S
Continental PET Technologies, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 54

Keyword:

"Novelty (yes)"
"Remittal to the first instance (yes)"

Decisions cited:

T 0204/83

Catchword:

-



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Chambres de recours

15.

Case Number: T 1111/96 - 3.2.5

D E C I S I O N
of the Technical Board of Appeal 3.2.5
of 2 February 1999

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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 6 November 1996 revoking European patent No. 0 521 841 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: A. Burkhardt
Members: C. G. F. Biggio
J. P. B. Seitz

Summary of Facts and Submissions

- I. The appellant (patentee) lodged an appeal against the decision of the opposition division revoking the European patent No. 521 841.

Oppositions were filed by three opponents against the patent as a whole and based on Article 100(a) EPC in conjunction with Article 54 and 56 EPC (lack of novelty and inventive step), and on Article 100(c) EPC (lack of an enabling disclosure).

The opposition division held that the grounds for opposition mentioned in Article 100(a) EPC prejudiced the maintenance of the patent as granted, since it found that the subject-matter of Claim 1, as granted, lacked novelty, having had regard to prior art document

D1": EP-A-247 566.

- II. Claim 1, as granted, reads as follows:

"A method for making a container (20), especially a bottle, by forming a blank or preform (10) of plastic, in particular substantially amorphous polyethylene terephthalate (PET), said blank (10) comprising a mouth portion (11), a substantially conical upper portion (12) extending from the mouth portion (11), and a substantially cylindrical portion (13) extending from said upper portion (12) towards the bottom of the blank (10), said container (20) comprising a mouth portion (21), a substantially cylindrical portion (23), and a shoulder (22) connecting the cylindrical portion (23) and the mouth portion (21), **characterised** in that when forming the blank (10) into the container (20), the shoulder (22) of the container (20) is formed substantially only of material which in the blank (10)

is located in the conical upper portion (12) of the blank while the cylindrical portion (23) of the container (20) is formed substantially only of material which in the blank (10) is located in the cylindrical portion (13) of the blank, and that during said forming the expansion of the material in the conical portion (12) of the blank (10) and of the material in the cylindrical portion (13) of the blank (10) is selectively controlled in such a manner that the material in the respective portion undergoes stretching in the axial direction of the blank, defined by the quotient of the axial length of the conical portion (12) of the blank (10) and the axial length of the cylindrical portion (13) of the blank (10) having values in the approximate range of 0.25-0.35, and by the quotient of the axial length of the shoulder (22) and the axial length of the cylindrical portion (23) of the container (20) having values in the approximative range of 0.60-0.80".

- III. The respondent (opponent O2) withdrew its opposition with its letter dated 24 April 1997 and, therefore, is no longer a party to these proceedings.
- IV. Oral proceedings before the Board of Appeal were held on 2 February 1999.

The appellant (patentee) requested, as main request:

- that the decision of the opposition division be set aside and
- that in case the Board finds that the claims of the patent in suit, as granted, have novelty, the case be remitted to the first instance for further prosecution, or, as auxiliary request:
- that, in case the Board finds that the claims as

granted are not novel, the claim filed with letter 14 March 1997 be considered as to novelty, and

- if this claim is found novel, the case be remitted to the first instance for further prosecution.

The respondents (opponents O1 and O3) requested that the appeal be dismissed; subsidiarily they requested that, if novelty were to be recognized, the case be not remitted to the first instance, for reasons of procedural economy (see Annexes 2 and 3 to the minutes of the oral proceedings).

V. The appellant argued essentially as follows.

The subject-matter of Claim 1 was novel over the disclosure of document D1", since this document did not disclose, either explicitly or implicitly, the features of Claim 1 of the patent in suit that the axial stretching of the respective portions of the blank "is defined by the quotient of the axial length of the conical portion of the blank and the axial length of the cylindrical portion of the blank having values in the approximate range of 0.25-0.35, and by the quotient of the axial length of the shoulder and the axial length of the cylindrical portion of the container having values in the approximative range of 0.60-0.80".

To be a novelty bar, a prior art document should disclose the relevant features clearly, unambiguously and fully derivably. This jurisprudence of the EPO was also applied to prior art drawings, as could be seen from the decision T 204/83 (OJ EPO, 1985, 310).

The figures 2 and 5 of D1" were not scale-true drawings and, therefore, did not disclose exact proportionality, allowing measurements to be made for novelty test, and the description of D1" was of no help to the skilled person to allow him to make such measurements. On the contrary, after having studied the whole disclosure, the skilled person would say that D1" was not concerned about length quotient dimensions of the preform (blank) and the bottle (container), and therefore the drawings were unreliably schematic or diagrammatic in the context of such length quotient dimensions. There was, in document D1", no whatsoever indication that said figures were engineering drawings, i.e. true-scale representations of the blank, respectively, the container disclosed. On the contrary, the few dimensions expressly and numerically indicated on said figures, i.e. the various thicknesses of the various portions of the container's walls, were such that the representation of the axial dimensions of both the blank and the container could in no way be considered either as being true-scale representations or engineering drawings.

The criteria established by decision T 204/83, for deciding whether or not it is allowable, for the skilled reader, to carry out dimensional measurements on drawings and read therewith, into the disclosure of a document numerical dimensions which are neither disclosed nor even hinted to in the associated description, were accordingly not met.

Rule 32(2)(f) EPC cited in the decision under appeal was no proof of true-scale representation in a drawing of an European patent application.

VI. The respondents essentially argued that the drawings of document D1" and of some others prior art documents on file should be considered as engineering drawings and thus these drawings did not fall within the ambit of decision T 204/83, so that it was allowable, for the skilled reader, to carry out dimensional measurements on said drawings and read therewith, into the disclosure of said document numerical dimensions, although they were not mentioned in the associated description.

Such dimensional measurements carried out on the drawings of document D1" -as well on those of documents D2 (EP-A-0 445 465) and D3 (EP-A-0 322 651)- revealed length proportions falling within the vaguely claimed ranges, as defined in the characterising clause of Claim 1 of the patent in suit. '

Since also all the other method steps of Claim 1 were clearly disclosed in these prior art documents, the method of Claim 1 was not novel.

(i) The respondent/opponent O1 argued essentially as follows.

The drawings of document D1" were read by a person skilled in the art who, using his normal technical knowledge, would have considered figures 2 and 5 as scale-true representations, on which he would have relied, in particular with respect to dimensions which were not expressis verbis mentioned either in the claims or in the description, as it was the case in document D1", when he was trying to carry out the invention disclosed by this document.

The invention according to D1" could not be properly carried out by the person skilled in the art, if the latter would be prevented from deriving, by measuring on the drawings of said document, geometrical figures concerning the respective lengths of both the blank and the container, which were not expressis verbis disclosed in the overall description of that invention.

(ii) The respondent/opponent O3 argued essentially as follows.

Figures 2 and 5 of D1", as well as figures 2 and 4 of D2 and figures 1 and 9 of D3, were to be considered as engineering drawings, as it was set out by Mr. Barrie in his statement of 9 September 1996.

The geometrical dimensions of both the blank and the container, as implied by the ratios mentioned in Claim 1 of the contested patent, were so vaguely defined that, at the most, they could be considered as falling within the broad ranges of classes of blanks and bottles disclosed by documents D1", D2 and D3.

Reasons for the Decision

- 1. The appeal is admissible.
- 2. *Novelty*
 - 2.1 Document D1" (see page 5, lines 15 to 26, figures 2 to 5 and the corresponding description) discloses a method for making a container, especially a bottle, by forming

a blank or preform of plastic, in particular substantially amorphous polyethylene terephthalate (PET), said blank comprising a mouth portion, a substantially conical upper portion extending from the mouth portion, and a substantially cylindrical portion extending from said upper portion towards the bottom of the blank, said container comprising a mouth portion, a substantially cylindrical central portion and a shoulder connecting the cylindrical portion and the mouth portion, wherein at forming the blank into the container, the shoulder of the container is formed substantially only of material which is located in the conical upper portion of the blank while the cylindrical portion of the container is formed substantially only of material which is located in the cylindrical portion of the blank, and wherein during said forming the expansion of the material in the conical portion of the blank and of the material in the cylindrical portion of the blank is selectively controlled in such a manner that the material in the respective portions undergoes stretching in the axial direction of the blank.

The appellant agrees that such a method - including the feature "the expansion of the material ... is selectively controlled ..." - is derivable from the disclosure of document D1" (see statement of the grounds of appeal, filed on 14 March 1997, page 2, last paragraph, and page 3, first paragraph).

- 2.2 It remains, therefore, to decide whether or not D1" also discloses the features of the characterising clause of Claim 1 of the granted patent that the axial stretching of the respective portions of the blank "is defined by the quotient of the axial length of the conical portion of the blank and the axial length of the cylindrical portion of the blank having values in the approximate range of 0.25-0.35, and by the quotient

of the axial length of the shoulder and the axial length of the cylindrical portion of the container having values in the approximative range of 0.60-0.80".

- 2.3 For the following reasons, the Board is of the opinion that the afore-mentioned features are not disclosed in document D1".

Document D1" is concerned with the forming of an improved base portion of both the preform (blank) and the final form (container) (see claims 12, 18, 19, 23 and 24; page 3, lines 1 to 3; page 4, lines 13 to 14).

Document D1" does not address or hint to the significance of the axial lengths of the respective conical and cylindrical portions of both the preform and the final form.

In fact D1" only discloses a single length value, this being the length of the preform (blank), below the neck finish (6.250 inches; page 5, lines 25 to 26). About the length of the tapered portion of the preform, it is only stated that it "was greatly increased" (page 5, line 27). Nothing is said about the length dimensions of the various parts of the container, while a lot of information is given about the thickness of various part of it (see figure 5). Instead of length dimensions, the thickness dimensions and other dimensions are discussed in the description of D1", e.g. contact diameter radius and inside blend radius of the container (page 4, lines 39 to 42) and the mid-diameter of the preform (page 5, line 26). In Claim 24, the ratio between the flute portion of the preform and the diameter of the resultant container body diameter is defined, and also the ratio between the thickness of the flute portion of the preform and the wall thickness of the preform body.

Thus, in D1" no attention is paid to the mutual length ratios of the portions of the preform and portions of the container corresponding to the portions of Claim 1 of the patent in suit, and the skilled person would consider the length of parts of the preform and container to be irrelevant and dispensable for the subject-matter disclosed in D1".

Accordingly, the description and the claims of document D1" do not guide the person skilled in the art to concentrate his interest on the axial length dimensions or proportions of the portions of both the preform and the final form, depicted in figures 2 and 5 as vertical sectional views, said figures being not associated with any numerical value of said axial length dimensions. The person skilled in the art is all the less motivated by the disclosure of document D1" to carry out on the figures 2 and 5 thereof any whatsoever length measurements and to correlate axial length dimension of both the preform and the final form, in a manner as indicated in Claim 1 of the patent in suit.

Figures 2 and 5 of document D1" could only be considered as a self-supporting clear source of information concerning axial length dimension obtained by measurements carried out thereon, if they were scale-true, i.e. engineering drawings.

The Board, however, does not find any indication in document D1" that figures 2 and 5 were intended to be scale-true drawings. The fact that the figures 2 and 5 are not expressis verbis designated as diagrammatic or schematic drawings may not lead the reader of document D1" to the conclusion that these figures were intended to be scale-true drawings. On the contrary, from figure 5 itself it can be rather concluded that this representation is merely diagrammatic or schematic, owing to the facts that

- the thickness of the mouth-wall portion immediately below the flange - indicated as 0.150" - is not proportionally related to that of the adjacent shoulder-wall - indicated as 0.035" -, and
- the wall-thickness and the diameter of the bottle according to figure 5 do not fulfil the requirements of Claim 7 of D1": "wall thickness is 0.7 to 0.9% of diameter".

Rule 32(2)(f) EPC, which was cited in the decision under appeal and which states that elements of the same figure should be in proportion to each other, cannot be taken as a proof that any figure, for the sole reason that it is shown in an European patent application - like D1" -, is effectively a proportional representation of a device, even less that it is a scale-true or engineering drawing.

For the reasons set out above, the Board does not agree with the opposition division's finding and with the respondents' view - including the statement of Mr. Barrie - that the figures 2 and 5 of document D1" were scale-true or engineering drawings.

On the contrary, the Board concludes that the figures 2 and 5 of document D1" have to be considered as "diagrammatical representations" of the kind referred to in the decision T 204/83, to which applies the case-law established by said decision, stating in its headnote: "Dimensions obtained merely by measuring a diagrammatic representation in a document do not form part of the disclosure".

The question, whether or not the ranges of the length ratios indicated in Claim 1 of the patent in suit are sufficiently clear to define the claimed method, is irrelevant when evaluating the novelty of the method according to said claim, in respect to that disclosed by document D1" which does neither disclose any length dimension nor any length ratio.

2.4 The same considerations, as set out above with respect to document D1", apply to the disclosure and the drawings of documents D2 and D3 which, also, do not disclose the features of the characterising clause of Claim 1, as quoted in previous item 2.2.

2.5 In conclusion, the Board states that the method of Claim 1 of the patent in suit is novel with respect to the methods disclosed by documents D1", D2 or D3, since none of these documents discloses the features of Claim 1 of the patent in suit that the axial stretching of the respective portions of the blank "is defined by the quotient of the axial length of the conical portion of the blank and the axial length of the cylindrical portion of the blank having values in the approximate range of 0.25-0.35, and by the quotient of the axial length of the shoulder and the axial length of the cylindrical portion of the container having values in the approximative range of 0.60-0.80".

3. *Remittal to the First Instance*

In the opposition file there is no indication that the opposition division pronounced itself on any aspect other than novelty.

In order not to deprive the parties of the opportunity to have the issue of inventive step examined by two instances, the Board exercises its discretion pursuant to Article 111(1) EPC to remit the case to the opposition division for further prosecution.

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 for further prosecution.

The Registrar:



A. Townend

The Chairman:



A. Burkhart



