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**D E C I S I O N**  
**of 15 May 2001**

**Case Number:** T 0695/99 - 3.2.4

**Application Number:** 91830380.1

**Publication Number:** 0480882

**IPC:** B65B 25/14

**Language of the proceedings:**EN

**Title of invention:**

Machinery for wrapping books, magazines and the like with paper

**Patentee:**

C.M.C. S.r.L.

**Opponent:**

Buhrs-Zaandam B. V.

**Headword:**

Paper wrap machine/CMC

**Relevant legal provisions:**

EPC Art. 56, 123

**Keyword:**

"Oral submissions by a person accompanying the representative"  
"Late submitted prior uses"  
"Inventive steps (yes)"

**Decisions cited:**

G 0004/95, G 0001/99, G 0004/93, G 0010/91, T 0331/87

**Catchword:**

-



Case Number: T 0695/99 - 3.2.4

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.4**  
**of 15 May 2001**

**Appellant:** Buhrs-Zaandam B.V.  
(Opponent) Vredeweg 7  
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**Representative:** Smulders, Theodorus A.H.J., Ir  
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**Respondent:** C.M.C. S.r.l.  
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**Representative:** Dall'Olio, Giancarlo  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 12 May 1999  
rejecting the opposition filed against European  
patent No. 0 480 882 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** C. A. J. Andries  
**Members:** P. Petti  
H. Preglau

## Summary of Facts and Submissions

- I. An opposition, based upon Articles 100(a) and (c) EPC, was filed on 18 September 1997 against the European patent No. 480 882 which is based on the European patent application No. 91 830 380.1 filed on 18 September 1991 and claiming the Italian priority of 10 October 1990. By the decision of the opposition division dispatched on 12 May 1999, the opposition was rejected.
- II. In the course of the opposition proceedings, the appellant (opponent) had submitted evidence relating to an alleged public prior use concerning a machine called "CMC Ritmica vierzijdig papierbandeermachine" (CMC Ritmica four side paper wrap machine) and had argued that this public prior use prejudiced the novelty of the subject-matter of Claim 1 of the patent as granted.
- During the opposition proceedings, the appellant had also argued that the subject-matter of Claim 1 of the granted patent contained some features extending beyond the content of the application as originally filed (Article 100(c) EPC) and did not involve any inventive step having regard to document IT-A-1 196 631 (D4) which was considered as disclosing the closest prior art.
- III. In the appealed decision, the opposition division considered that the evidence concerning the alleged public prior use referred to in section II above (1<sup>st</sup> paragraph) did not unambiguously prove it, that the objections under Article 100(c) EPC could not lead to the revocation of the patent and that the subject-matter of Claim 1 involved an inventive step.

On the subject of inventive step, the opposition division did not agree with the view of the appellant that document D4 was the closest prior art but saw document GB-A-222 108 (D0), which is cited in the description of the patent, as the closest prior art.

In the decision, the opposition division also considered that the patent in suit was not entitled to the priority date of 10 October 1990.

IV. On 7 July 1999 the appellant filed an appeal against this decision and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received on 10 September 1999.

V. With the statement setting out the grounds of appeal, the appellant stated that the argumentation of lack of novelty based on the alleged public prior use referred to in section II above (1<sup>st</sup> paragraph) was no longer maintained.

With the statement setting out the grounds of appeal, the appellant also raised objections under Article 100(b) EPC and referred to this article as a new ground for opposition.

VI. With the letter dated 13 April 2001 the appellant filed the following new evidence:

D15: EP-A-526 944;

D16: US-A-4 520 615;

D17: Affidavit of Mr Brockdorff with the enclosures

- D17a: Copies of three pages of a leaflet of the firm SITMA SpA, "*Polymatic*",
- D17b: Copies of four pages of a leaflet of the firm BUHRS-ZAANDAM BV, "*Buhrs mailingsystems Zaandam-Polywrap*",
- D17c: GB-A-2 252 540 (published 12 August 1992);
- D18: Affidavit of Mr P. Antonissen, dated 9 April 2001;
- D19: Affidavit of Mr T. Eden, dated 24 March 2001 with Enclosure I;
- D20: GB-A-2 028 757;
- D21: Copy of the "*Operator's Manual Polywrap Station*", Series 37110 up 37170 (Buhrs-Zaandam B.V.), 3/91, 41 pages;
- D22: Copies of the minutes of the hearing ("Proces-verbaal") of the witnesses Mr O. Bruinsma and Mr W. C. Otten before the district Court in The Hague (eight pages) and translation thereof (D22a) as well as "Affidavits" dated 31 October 1996 of Mr O Bruinsma and Mr T. Bruinsma and a letter dated 6 November 1996 of Mr W. Otten;
- D23: Newsletter "*APO Flash*", 08.'91, offered and published by APO Web support center, Zaandam (46 pages);
- D24: Newsletter "*APO Flash*", 09.'91, offered and published by APO Web support center, Zaandam (35 pages);

D25: Video showing the mail cover produced by the machine called "Envelope" of the firm Buhrs-Zaandam.

On the basis of documents D17 to D25 the appellant alleged two further public prior uses.

VII. Oral proceedings were held on 15 May 2001.

Mr Dall'Olio, professional representative, was present on behalf of the proprietor of the patent (hereinafter respondent). He was accompanied by Mr Querze. At the beginning of the oral proceedings Mr Dall'Olio requested that Mr Querze be allowed to make oral submissions on specific technical issues on behalf of the respondent. This was accepted by the appellant and the board.

During the oral proceedings the respondent filed an amended independent Claim 1 which reads as follows:

"1. A machine for wrapping newspaper, magazines and similar articles, the said machine including an article drawing device (1) which takes the articles one by one from a pile, and a lateral unwinding device providing the paper wrapping material from rolls (8) and setting it under the articles, the machine including the combination of:

a small motorised presser belt (4) which keeps the articles at the right distance one from the other;

a hot melt glue spraying device (5) that applies a strip of glue between one article and the following one;

a further glue spraying device (7) that applies glue lengthwise over the edges of the wrapping sheet of paper folded towards the centre over the article;

two folding blades that gradually close the edges of the wrapping sheet over each other;

a pressing pad (9) and a pair of transverse rollers (15, 16), each provided with a protrusion extending along the whole length of the respective transverse roller, the rollers being respectively located above and underneath the wrapping sheet of paper such that the protrusions cooperate to press the glued strip of the wrapping sheet of paper between each pair of articles;

a cutting means (17, 18) which cuts the sheet of paper crosswise between each article and the following one;

an adequate press consisting of a moving apart belt (12), situated above the wrapped articles, that moves apart each wrapped article from the following one."

VIII. With regard to the ground for opposition according to Article 100(c) EPC, the appellant argued that the subject-matter of Claim 1 extended beyond the content of the application as filed.

With regard to the ground for opposition according to Article 100(a) EPC, the appellant argued that the subject-matter of Claim 1 did not involve an inventive step. In these respects, the appellant referred to document D4, which was considered as the closest prior art, to document D16 as well as to the following documents:

- D6: Agreement between the Kingdom of the Netherlands and the Dutch Association Packaging and Environment ("Stichting Verpakking en Milieu") "*Convenant Verpakkingen*";
- D6a: Translation of the relevant passages of document D6;
- D7: Copy of the Information sheet "*Mikroprozessor Steuerung IK11*" of the firm Robatech BV (two pages);
- D8: Article "*Klebstoff-Auftragsanlagen für das Jahr 2000*", in "*Neue Verpackung*", 4/83, pages 400 and 403;
- D9: Information sheet 12/88 "*H200 series Modular Hot Melt Guns*" of the firm Nordson Corporation;
- D10: Leaflet 306-18-687 "*Series 6000 Applicators*" of the firm Nordson Corporation, issued 5/90;
- D11: Leaflet 306-18-869 "*Series 3500 Applicators*" of the firm Nordson Corporation, issued 8/89;
- D12: Leaflet 306-18-858 "*Nordson System 3000*" of the firm Nordson Corporation, issued 1/90.

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

The respondent requested that the decision under appeal be set aside and the patent be granted in the following version:



- Claims 1 to 5, as filed during the oral proceedings;
- Description, columns 1 to 4, as filed during the oral proceedings;
- Figures 1 to 4, as granted.

### Reasons for the Decision

1. The appeal is admissible.
2. *Procedural matter*

According to the decision G 4/95, OJ EPO 1996, 412 (see Order), a person accompanying the professional representative of a party may be allowed to make oral submissions only with the permission of and under the discretion of the board, provided that the professional representative requests permission for such oral submissions to be made. It is also stated in this decision that "a request which is made shortly before or at the oral proceedings **should** in absence of exceptional circumstances **be refused, unless each opposing party agrees** to the making of the oral submissions requested" (see Order 3.b.iii); emphasis added).

In the present case, Mr Dall'Olio, professional representative, requested at the beginning of the oral proceedings that Mr Querze, who is not a professional representative, be allowed to make oral submissions on behalf of the respondent (see section VII above).

The appellant agreed to the making of these oral submissions.

Since the board was satisfied that the oral submissions by Mr Querze were made under the continuing responsibility and control of the professional representative (see G 4/95, Order 3.b.iv), the request of the respondent was accepted.

3. *The claimed subject-matter*

3.1 Claim 1 is directed to

(A) **a machine for paper wrapping newspapers, magazines and similar articles**, the machine having the following features:

(B) the machine includes an article drawing device (1),

(B1) the article drawing device (1) takes the articles one by one from a pile,

(C) the machine includes a lateral unwinding device,

(C1) the lateral unwinding device provides the paper wrapping material from rolls (8),

(C2) the unwinding device sets the paper wrapping material under the articles,

(E) the machine includes a small motorised presser belt (4),

(E1) the small motorised presser belt (4) keeps the

articles at the right distance one from the other,

- (F) the machine includes a hot melt glue spraying device (5),
- (F1) the hot melt glue spraying device (5) applies a strip of glue between one article and the following one,
- (G) the machine includes a further glue spraying device (7),
- (G1) the further glue spraying device (7) applies glue lengthwise over the edges of the wrapping sheet of paper folded towards the centre over the article,
- (H) the machine includes two folding blades,
- (H1) the folding blades gradually close the edges of the wrapping sheet over each other,
- (J) the machine includes a pressing pad (9),
- (K) the machine includes a pair of transverse rollers (15, 16),
- (K1) each transverse roller is provided with a protrusion extending along the whole length of the respective transverse roller,
- (K2) the rollers are respectively located above and underneath the wrapping sheet of paper such that the protrusions cooperate to press the glued strip of the wrapping sheet of paper between each pair of articles,

(L) the machine includes a cutting means (17, 18),

(L1) the cutting means (17, 18) cuts the sheet of paper cross-wise between each article and the following one,

(M) the machine includes an adequate press consisting of a moving apart belt (12) situated above the wrapped article,

(M1) the moving apart belt moves apart each wrapped article from the following one.

3.2 Claim 1 refers to the function of the transverse rollers 15 and 16 (see feature K2) but does not explicitly indicate the function of the pressing pad 9 (see feature J). However, it is clear from the description (see column 3, lines 40 to 47) that the transverse pad 9 and the rollers 15 and 16 apply pressure to the previously glued layers of papers so that they stick together and form seals. It is clear that the rollers 15 and 16 contribute to form the transverse seals (due to the presence of strips of glue which are put cross-wise onto the paper) and that the pressing pad 9 contributes to form the longitudinal seal (due to the presence of glue applied lengthwise over the edges of the wrapping sheet of paper folded towards the centre over the article).

3.3 Features L and L1 refer to a cutting means. It has to be understood that this cutting means is distinguished from and is arranged downstream of the means to form the transverse seals, i.e. it is distinguished from the hot melt glue spraying device 5 and the rollers 15 and 16 (see Figures 1 to 3 of the patent as granted).

4. *Article 100(b) EPC*

During the written phase of the appeal proceedings the appellant had raised objections under Article 100(b) EPC. However, the opposition ground according to Article 100(b) EPC was neither invoked by the appellant in the notice of opposition nor considered by the opposition division in the course of the previous proceedings. According to the opinion G 10/91, OJ EPO 1993, 420 (see section 3), fresh grounds for opposition may be considered by the board of appeal during the appeal proceedings only with the agreement of the proprietor of the patent. Since the respondent during the oral proceedings expressed its disagreement with respect to the objections under Article 100(b) EPC, the board will not consider them.

5. *Articles 123 and 100(c) EPC*

5.1 The present Claim 1 differs from Claim 1 of the patent as granted in that

- (i) the expression "**lateral** unwinding device" (emphasis added) has replaced the expression "unwinding device";
- (ii) the expression "**small** motorised presser belt" (emphasis added) has replaced the expression "motorised presser belt";
- (iii) features K, K1 and K2 have replaced the feature that the machine includes "a transverse strip presser roller means (15, 16)";
- (iv) feature M has replaced the feature that the

machine includes "a moving apart belt";

- (v) feature F1 has replaced the feature that "the hot melt glue spraying device (5) applies a strip of glue **cross-wise onto the paper** between one article and the following one" (emphasis added).

5.1.1 According to the respondent - as clearly expressed during the oral proceedings - Claim 1 as granted was amended in order to meet at least the requirements of Article 100(c) EPC.

5.1.2 Having regard to nature of the above amendments, the present Claim 1 contains - apart from the amendment according to item v) - all the features specified in Claim 1 of the patent as granted.

The amendment according to item v) results in the deletion of the term "cross-wise onto the paper". However, it is clear from the content of Claim 1 that the strip of glue is applied transversely onto the paper, because the strip of glue applied between one article and the following one by the hot-melt glue spraying device (as defined by feature F1) is pressed in order to form a transverse seal due to the cooperation of the protrusions of the transverse rollers which extend along the whole length of the respective roller, i.e. transversely (as defined by features K, K1 and K2).

Therefore, the above amendments do not extend the scope of the claim with respect to the patent as granted and do not contravene the requirements of Article 123(3) EPC.

5.1.2 The amendments according to items i) to iv) above can be unambiguously derived from the application as filed, namely:

from Claims 1 and 2 and from the description, page 2, 2<sup>nd</sup> paragraph (items i) and ii));

from Figure 3 (item iii));

from Claim 3 (in particular page 9, lines 1 to 3), from the description, page 6, lines 2 to 4 and from Figure 1 (item iv).

Therefore, these amendments do not contravene the requirements of Article 123(2) EPC.

5.1.3 It has to be noted that these amendments represent a reaction of the respondent to objections under Article 100(c) EPC raised by the appellant and by the board during the appeal proceedings. Thus, they are clearly intended to remove deficiencies in respect of the requirements of Article 100(c) EPC. Therefore, these amendments are appropriate and necessary in the sense of the decision G 4/93 (OJ EPO 1994, 875). Moreover, these amendments are to be allowed according to the decision G 1/99 of 2 April 2001 (OJ EPO 2001, 381) because they do not put the appellant in a worse situation with respect to the appealed decision in so far as they introduce features which do not broaden the scope of the patent as maintained (see G 1/99, section 14).

5.2 On the subject of the objection under Article 100(c) EPC the following has to be noted.

5.2.1 With respect to the expression "small motorised presser **belt** (4)" (see features E and E1; emphasis added), the appellant argued as follows:

The claims (see Claim 2) and the description (page 5, 3<sup>rd</sup> paragraph, 1<sup>st</sup> sentence) of the application as filed do not mention this expression but the expression "small motorised press (4)". The term "motorised press" embraces not only a "motorised presser belt" (as defined in the present Claim 1) which is continuously driven in phase but also a "motorised pressing pad" which is alternatively driven such that it follows an article on its travel and jumps back towards the next article. Thus, the skilled person when confronted with the term "motorised press" would not unambiguously interpret this term as defining a "motorised presser belt".

The board cannot accept this argument for the following reasons:

The skilled person who knows that a "motorised press" covers not only a "motorised presser belt" but also an "alternatively driven pressing pad" would interpret this term on the basis of the drawings. In the present case, Figures 1 and 2 of the application as filed clearly show a belt and give no basis for an "alternatively driven pressing pad".

5.2.2 Claim 1 of the application as filed specifies the features that the machine comprises "an opening device (2), which opens the first page of each magazine" and "one or more feeders (3), which may introduce an insert inside the opened magazine", these features being no longer specified in the present Claim 1.



In these respects the appellant argued as follows:

The respondent when filing the original application has chosen to present the "opening device" and the "feeders" as essential features. Therefore, Claim 1 contravenes the requirements of Article 100(c) EPC, because it does not specify essential features. In other words, the application as filed does not disclose a machine which provided neither with an opening device nor with one or more feeders.

The board cannot accept this argument for the following reasons:

- (a) In the application as filed, the features concerning the "opening device" and the "feeders" were not explained as essential. The fact that the description on page 2 contains a paragraph beginning with the terms "First of all ..." and referring to a "device which opens the first page of each magazine" and to "one or more feeders [which] may introduce an insert..." does not mean that these features are presented as essential. Moreover, the problem to be solved as defined in the application as filed relates to the use of paper as wrapping material and particularly to the way of glueing the edges of the wrapping material. Neither the opening device nor the feeders are indispensable for the solution of this problem. Furthermore, the removal of these features does not require modification of other features to compensate for the change. Therefore, these features have to be considered as non-essential features (see in this respect the decision T 331/87, OJ EPO 1991, 22, section 6).

(b) According to the description of the application as filed "Fig. 1 shows a front view of the machine" while "Fig. 2 shows a view of the machine from the top" (see page 4), these Figures relating to a first embodiment of the invention. It has to be noted that the opening device 2 and the feeders 3 are represented only in Figure 1. Moreover, in the application as filed only Claim 1 refers to these features while Claims 2 to 4, which also relate to the first embodiment, neither include the features of Claim 1 nor contain a reference to Claim 1. Thus, each of these claims can be considered as an independent claim. Therefore, the skilled person reading the application would immediately realize that a machine lacking the features concerning the "opening device" and the "feeders" is implicitly disclosed.

5.3 Having regard to the above comments, the board is satisfied that the subject-matter of Claim 1 does not extend beyond the content of the application as filed (Article 100(c) EPC).

6. *Novelty*

The subject-matter of Claim 1 is novel. Novelty was not disputed.

7. *The closest prior art and the problem to be solved*

7.1 The parties consider document IT-A-1 196 631 (D4) as the closest prior art. This document is referred to in the description of the patent of the patent and in that of the application as filed.

This document D4 discloses a machine for packaging books, magazines and similar articles *in a plastic film*, the machine having the following features:

- the machine includes an article drawing device 1,
- the article drawing device 1 takes the articles one by one from a pile,
- the machine includes an unwinding device,
- the unwinding device provides the paper wrapping material from rolls,
- material under the articles,
- the machine includes a means for providing transverse seals,
- the means for providing transverse seals comprises a *transverse welder 17*,
- *the transverse welder 17 performs a seal cross-wise onto the plastic film* between one article and the following one,
- the machine includes a means for providing a longitudinal seal,
- the means for providing a longitudinal seal comprises a *further welder 13*,
- *the further welder 13 performs a seal lengthwise over the edges of the wrapping plastic film* folded towards the centre over the article,

- the machine includes a pressing *belt* 16,
- *the transverse welder 17 being also suitable for cutting the plastic film cross-wise between each article and the following one,*
- the machine includes a moving apart belt 18,
- the moving apart belt moves apart each wrapped article from the following one.

Moreover, it can be understood from the drawing of document D4 that the machine includes a motorised presser belt located at the beginning of the wrapping part of the machine and keeping the articles at the right distance one from the other.

Furthermore, it can be assumed that this machine includes two folding blades which gradually close the edges of the wrapping plastic film over each other.

7.2 The subject-matter of Claim 1 substantially differs therefrom in that

- (A') the machine is **suitable for paper wrapping** the articles,
- (C') the unwinding device is a **lateral** one,
- (F) the machine includes (i.e. the means for providing the transverse seals comprises) **a hot melt glue spraying device (5),**
- (F1) the hot melt glue spraying device (5) **applies a**

**strip of glue between one article and the following one,**

- (G) the machine includes (i.e. the means for providing the longitudinal seal comprises) **a further glue spraying device (7),**
- (G1) the further glue spraying device (7) **applies glue lengthwise over the edges of the wrapping sheet of papers folded towards the centre over the article,**
- (K) the machine includes **a pair of transverse rollers (15, 16),**
- (K1) **each transverse roller is provided with a protrusion extending along the whole length of the respective transverse roller,**
- (K2) the rollers are respectively located above and underneath the wrapping sheet of paper such that the protrusions cooperate to press the glued strip of the wrapping sheet of paper between each pair of articles,
- (L) the machine includes a cutting means (ie a cutting means which is distinguished from the means providing the transverse seals).

7.3 The machine according to document D4 uses a plastic film, namely a PVC film (see page 7, 2<sup>nd</sup> paragraph), as wrapping material. The use of plastic materials, such as PVC, is a disadvantage of the known machine since these materials, not being biodegradable, are

considered to be dangerous pollutants.

Thus, the technical problem to be solved consists in eliminating this disadvantage.

The board is satisfied that the combination of the features specified in Claim 1 solves this problem.

In particular, it has to be noted that feature A' results in avoiding the use of a wrapping material which is not biodegradable and that features G and G1 - in co-operation with feature J - result in the arrangement of a means for providing a longitudinal seal which is adapted to paper, while features F, F1, K, K1 and K2 result in the arrangement of a means for providing transverse seals which is adapted to paper.

- 7.3.1 On the subject of features K, K1 and K2 the respondent stated that the use of two rollers cooperating with each other is important because it allows the paper webs to be accompanied for the period of time necessary for ensuring that the two layers of paper stick together.

8. *Inventive step*

- 8.1 On the subject of inventive step, the appellant essentially argued as follows:

Before the priority date of the patent in suit there was an interest in developing a different package, ie. a package reducing the packaging waste to be dumped and delivered to the ecosystem. This can be derived not only from document D6a (page 2, § 2.1, Article 3) but also from a statement made by the respondent in the

letter dated 27 March 2000, according to which the manufacturers of wrapping machines "were indeed confronted with the problem of packing articles in paper rather than [sic] in PVC" (see page 8, lines 21 and 22).

The differences between the claimed subject-matter and the machine according to document D4 essentially concern the application of glue. It would be obvious for the skilled person to replace the heat welders of the machine according to document D4 with a glue applying device when a PVC film is replaced by a paper band. This was also stated by the respondent itself in the letter dated 20 April 1998 (see page 8: "Obviously, if a PVC band is replaced by a paper band, the heat welders must be replaced with glue applicators ..."). Moreover, glue applicators are well known from documents D7 to D12.

With respect to features K, K1, K2 and L, the skilled person would turn to document D16. This document, which relates to an "apparatus for making a packaging tube from a web of paper or film" (see Claim 1), refers to a two-stage cutter and sealer (see column 3, lines 11 to 17) and shows in Figure 1 a sealing roll located above the paper web or film and a cutter provided with a cutting element, the sealing roll being provided with a protrusion.

Feature C' only defines the arrangement of the rolls with respect to the longitudinal axis of the machine. This feature has no influence on the package and therefore has to be neglected.

Therefore, starting from a machine according to

document D4, the skilled person would arrive at the claimed subject-matter without exercising any inventive skill.

8.1.1 The board cannot accept this argument of the appellant for the following reasons:

- (i) Document D6a is the translation of an Agreement between the Kingdom of the Netherlands and the Dutch Association Packaging and Environment which only expresses the general aim of reducing waste stream of packaging in order to reduce the impact on the environment. This document does not indicate the use of paper as wrapping material.
- (ii) The assertion of the respondent in its letter dated 27 March 2000 has to be read in the context of the arguments developed on page 8, lines 13 to 16 of this letter, according to which Claim 1 is not related to the idea of packaging articles with paper rather than with PVC but to a machine using a **continuous paper web** for packaging the articles.

In this respect, it has to be noted that the skilled person starting from a machine according to document D4 and confronted with the general problem of reducing packaging waste - in order to arrive at the subject-matter of Claim 1 - has firstly to arrive at the idea of using paper instead of plastics, then he has to realize that a continuous web of paper can be used in a packaging machine which was conceived for using a plastic film and finally he has to modify the machine so as to adapt it to the use of a paper



web.

- (iii) Even if it were to be assumed that the ideas of replacing plastics by paper and of using a continuous paper web are obvious, it should be considered that a plurality of further steps are necessary to arrive at a machine adapted to process a paper web as defined in Claim 1.

Firstly, the skilled person has to arrive at the idea of using glue applicators and particularly of using hot-melt glue applicators for the transverse seals. This choice is not the sole possibility the skilled person has in order to close the transverse edges of the package. Indeed, it is possible to close the transverse edges of the package either by punching, as pointed out by the respondent during the oral proceedings, or by using a web of paper having adhesive strips.

- (iv) The description of document D16 refers to a "transverse sealer and cutter indicated diagrammatically at 60" (see column 3, lines 11 to 15) in Figure 1. Figure 1, which is defined as "a diagrammatic side elevation of the tube-forming machine" shows - on the left-hand side of the reference sign 60 - a first circle provided with a rectangular extension having its lower side in contact with the upper paper web and a second circle provided with a rectilinear extension intersecting the paper web. Thus, it can be understood that the first circle represents the transverse sealer and the second circle the cutter. Document D16 neither refers to

glue applying devices nor discloses how the transverse sealer works. In other words, document D16 does not disclose the transverse sealer as a device for applying pressure to the paper web so as to ensure that the two layers of paper stick together.

If it were assumed that transverse edges of the paper forming the package are previously glued, then it could be assumed that the first circle shown in Figure 1 represents a roll provided with a protrusion by means of which the necessary pressure can be exerted so as to ensure that the previously glued edges stick together. With this assumption, it has to be understood that the protrusion cooperates with a fixed surface located underneath the sheet of paper.

As was argued by the respondent during the oral proceedings, a roll cooperating with a fixed surface to press a continuously moving paper web could damage the paper. Besides, the arrangement of a pair of rolls as defined by features K, K1 and K2 reduces the risk of damaging the paper in so far as the paper web is accompanied by the two rotating protrusions while pressure is exerted on the glued area of the paper web.

Therefore, document D16 neither suggests the use of **a pair of rolls** arranged as defined by feature K2 nor indicates the technical advantages which are obtained by using a pair of rolls instead of a single roll.

Thus, even if it were to be assumed that on the basis of the information derivable from documents D7 to D12 it would be obvious to replace the heat sealers with glue applicators, it still would not be obvious to arrive at a machine having feature K2.

- 8.2 The opposition division held in the decision under appeal that the document D0 (GB-A-222 108) cited in the description of the patent had to be seen as the closest prior art and considered that the way of wrapping the objects as disclosed in this document was so different from the claimed subject-matter that the ground for opposition under Article 100(a) EPC did not prejudice the maintenance of the patent.

These findings of the opposition division were not challenged by the appellant. The board sees no reasons to disagree with these findings.

- 8.3 Having regard to the above comments, the skilled person would not arrive in an obvious way at the claimed solution on the basis of the information content of the above mentioned documents.

9. *The documents filed with the letter of 13 April 2001*

- 9.1 Document D15 is an European Patent Application claiming the date of priority of 5 August 1991. During the written phase of the proceedings, the appellant referred to the finding of the opposition division that the patent in suit was not entitled to the claimed priority of 10 October 1990 but had to be considered as being filed on 18 September 1991 and therefore based on document D15 an objection of lack of novelty under

Article 54(3) EPC. However, this objection was no longer maintained by the appellant during the oral proceedings.

In any case the board does not consider this document as relevant.

- 9.2 The appellant referred during the oral proceedings to document D16, which was mentioned in the Search Report of the application from which the patent in suit derives, in order to indicate that the use of pressure rolls as transverse sealers was known. Therefore, this document has been considered by the board (see section 8.1.1 above).
- 9.3 Document D20 relates to a method for making stuffed envelopes from a continuous web of paper in which glue is firstly applied transversely on the web to provide glue strips, a stuffer is fed transversely of the paper web between the transverse glue strips, the transverse glue strips are closed and a longitudinal strip of glue is applied. Thus, this document concerns a different concept with respect to the claimed subject-matter according to which the objects are wrapped by the paper web.

In any case, this document does not disclose the arrangement of a pair of rolls as defined by feature K2. Therefore, this document is not considered as being more relevant than the documents referred to in the above sections 7 and 8.

10. *The public prior use alleged by the appellant during the previous opposition proceedings*

With the statement setting out the grounds of appeal, the appellant stated that the argumentation of lack of novelty based on the alleged public prior use referred in the above section II (1<sup>st</sup> paragraph) was no longer maintained. Therefore, the board has no reason to consider this alleged public prior use.

11. *The public prior uses alleged by the appellant with the letter of 13 April 2001*

11.1 With the letter dated 13 April 2001, ie nineteen months after the filing of the statement setting out the grounds of appeal and about one month before the oral proceedings, the appellant also filed documents D17 to D19 and D21 to D25 and on the basis of these documents alleged two further public prior uses.

11.2 Documents D17 to D19 and D21 refer to a first alleged public prior use.

In particular, documents D17 and D18 refer to tests conducted by Mr Brockdorff in order to develop a continuous paper wrap machine. These tests were conducted on a machine SITMA C-80 of the type described in the brochure D17a as well as on a Polywrap-machine of the firm Buhrs-Zaandam of the type described in the brochure D17b and in the manual D21. According to the appellant these machines were very similar to the device disclosed in document D4. According to the documents D17 and D18, for this development Mr Brockdorff filed on 30 April 1990 the patent application GB-A-2 252 540 (document D17c) which was published on 12 August 1992.

According to documents D17 and D19 the technology

described in the patent application D17c was disclosed by Mr Brockdorff before the publication date of document D17c and before the filing date of the patent in suit.

- 11.2.1 Therefore, the content of document D17c is decisive in order to determine what could have been disclosed.

This document concerns a machine for forming paper around a pre-collated sets of loose inserts for mailing so as to enclose them at high speed on a continuous basis. More particularly, this document discloses a machine for making envelopes from a continuous web of paper in which a pattern of hot melt glue is on the paper web, inserts are fed transversely of the paper web, an envelope flap is formed and is glued by a plough turn and finder wheel mechanism. Thus also this document - analogously to document D20 - concerns a different concept with respect to the claimed subject-matter according to which the objects are wrapped by the paper web. Moreover, this document does not disclose the arrangement of a pair of rolls as defined by feature K2.

- 11.2.2 Therefore, the alleged public prior use based on documents D17 to D19 and D21 is disregarded (Article 114(2) EPC), since it is not relevant.

- 11.3 Documents D22 to D25 relate to the second alleged public prior use which concerns a machine called "Envelope". According to the appellant, the "Envelope", which was suitable for processing paper as packaging material, was made publicly available from 2 July 1991, ie before the filing date of the patent in suit.

The "Enveloper" is a machine developed by the appellant's firm (Buhrs-Zaandam). In this respect, it has to be noted that document D22 (D22a) contains the minutes of the hearing of the witnesses O. Bruinsma and W. Otten before the Dutch Court in The Hague on 14 February 2001 in a civil court proceedings between Buhrs-Zaandam BV and another firm. Two declarations of the witnesses are attached to the minutes, the declaration of Mr Bruinsma being dated 31 October 1996, that of Mr Otten being dated 6 November 1996. Thus, it has to be assumed that the appellant was aware of this public prior use before the date of filing of the opposition notice (18 September 1997). However, this public prior use was only alleged with the letter of 13 April 2001.

11.3.1 During the oral proceedings the appellant justified the late filing of this prior use essentially by arguing as follows:

- (i) It was preferred to rely on "external" evidence.
- (ii) It was not realized that this public prior use could be important because the patent in suit claimed a priority date preceding the date on which the "Enveloper" was made available to the public.

According to the board, argument i) cannot justify a late filing. Argument ii) cannot be accepted because the appellant argued already with its notice of opposition dated 18 September 1997 that the patent in suit was not entitled to the claimed priority date. Therefore, the evidence concerning this alleged public prior use as well as a request of taking of evidence by

hearing the above mentioned witnesses could have been filed earlier, for instance either with the notice of opposition or at least with the statement setting out the grounds of appeal.

11.3.2 Moreover, on the subject of documents D23 to D25 the following has to be noted:

- (i) The appellant did not refer to document D23 as relating to the "Enveloper". According to the appellant this document "refers to the Buhrs-Zaandam Polywrap machine and indicates that it offers all the choices: amongst others filmwrapping **and/or** paperwrapping, combined or independent" (see letter dated 13 April 2001, page 11). Thus, this document is not relevant.
- (ii) During the oral proceedings the appellant stated that neither document D24 nor the video D25 was made available to the public before the priority date of the patent in suit.

Therefore these documents are to be disregarded (Article 114(2) EPC).

11.3.3 Having regard to the insufficiency of the reasons the appellant gave for the filing of the evidence relating to this alleged public prior use at this late stage of the proceedings as well as to the content of this evidence, the board is not persuaded that it is proper to introduce it into the proceedings. Therefore, also the second alleged public prior use is disregarded (Article 114(2) EPC).

12. Therefore, the patent can be maintained on the basis of



the respondent's request.

**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 filed during the oral proceedings;

Description, columns 1 to 4, as filed during the oral proceedings;

Figures 1 to 4, as granted.

The Registrar:

The Chairman:

G. Magouliotis

C. Andries