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D E C I S I O N
of 24 May 2004

Case Number: T 0947/02 - 3.2.4

Application Number: 95203057.5

Publication Number: 0711501

IPC: A22C 17/14

Language of the proceedings: EN

Title of invention:
Method and device for separating at least one piece of visceral tissue from at least one organ connected thereto

Patentee:
STORK PMT B.V.

Opponent:
Meyn Food Processing Technology B.V.

Headword:
-

Relevant legal provisions:
EPC Art. 100(a), 100(b), 123(2) and (3), 84

Keyword:
"Sufficiency of disclosure (yes)"
"Added subject-matter (no)"
"Scope of protection extended (no)"
"Clarity (yes)"
"Novlty (yes)"
"Inventive step (yes)"

Decisions cited:
T 0068/85

Catchword:
-

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Case Number: T 0947/02 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 24 May 2004

Appellant: (Opponent)	Meyn Food Processing Technology B.V. Noordeinde 68 NL-1511 AE Oostzaan (NL)
Representative:	Van Breda, Jacobus Octrooibureau Los & Stigter B.V. Weteringschans 96 NL-1017 XS Amsterdam (NL)
Respondent: (Proprietor of the patent)	STORK PMT B.V. Handelstraat 3 NL-5831 AV Boxmeer (NL)
Representative:	Mertens, Hans Victor van Exter Polak & Charlouis B.V. P.O. Box 3241 NL-2280 GE Rijswijk (NL)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted 24 July 2002 rejecting the opposition filed against European patent No. 0711501 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
M. Aúz Castro

Summary of Facts and Submissions

I. By its decision dated 24 July 2002 the Opposition Division rejected the opposition. On 30 August 2002 the appellant (opponent) filed an appeal. The appeal fee was paid on 2 September 2002. The statement setting out the grounds of appeal was received on 19 November 2002.

II. The patent was opposed on the grounds for opposition based on Articles 100(a) EPC (54 and 56 EPC) and 100(b) EPC.

III. The following documents played a role in the appeal proceedings:

D1: US-A-4 815 166

D2: CA-A-1 134 571

D3: NL-A-7 811 019

D3': US-A-4 213 228 (member of the patent family of D3)

IV. With letter of 23 April 2004 the respondent filed a new set of claims, wherein solely independent claim 9 had been amended.

V. Independent claims 1 and 9 read as follows:

"1. Method for separating at least one piece of visceral tissue (10; 10b) from at least one organ (8; 8b) connected thereto, in which the at least one piece of visceral tissue (10; 10b) to be separated is smaller than said at least one organ (8; 8b), characterized in

that the cluster of at least one piece of visceral tissue (10; 10b) and the at least one organ (8; 8b) is moved relative to and over a surface (2; 2a; 2b; 26; 28; 30; 43; 48; 58) which is provided with holes (4; 4a; 4b; 4c; 30a; 41; 50; 60), which holes are effectively at least as large as the smallest cross-section of the at least one piece of visceral tissue(10; 10b) to be separated, while a piece of visceral tissue (10; 10b) to be separated which passes into a hole (4; 4a; 4b; 4c; 30a; 41; 50; 60) is retained in the hole."

"9. Device for separating at least one piece of visceral tissue (10; 10b) from at least one organ (8; 8b) connected thereto, in which the at least one piece of visceral tissue (10; 10b) to be separated is smaller than said at least one organ (8; 8b), characterized in that the device comprises:
a surface (2; 2a; 2b; 26; 28; 30; 43; 48; 58) provided with holes (4; 4a; 4b; 4c; 30a; 41; 50; 60) which are effectively at least as large as the smallest cross-section of the at least one piece of visceral tissue (10; 10b) to be separated, the holes being configured to retain a piece of visceral tissue (10; 10b) to be separated which passes into a hole, in the hole; and
means for making the cluster of at least one piece of visceral tissue (10; 10b) and at least one organ (8; 8b) move relative to and over the surface (2; 2a; 2b; 26; 28;30; 43; 48; 58)."

VI. Oral proceedings before the Board took place on 24 ay 2004.

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

The appellant mainly argued that the patent in suit did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC). He alleged that the patent specification did not indicate an upper limit for the size of the holes and that the lower limit for the size of the holes was defined with respect to the cluster of organs to be processed and therefore did not constitute an unambiguous teaching for a skilled person. Furthermore, the appellant put forward that amended claim 9 contravened the requirements of Articles 123(2) and 84 EPC, because none of the figures of the patent in suit referred to with respect to the device, nor the parts of the description of the patent in suit relating to the device, disclosed holes configured to retain a piece of visceral tissue that passes into it. Moreover, in his view not all of the essential features needed to define the invention were specified in the independent claims. Finally, the appellant argued that the subject-matter of the independent claims was not new with respect to D1 or did not involve an inventive step in comparison with D2.

The respondent (patentee) disputed the views of the appellant. He argued that the patent in suit provides clear instructions how to carry out the method for separating a piece of visceral tissue from an organ by moving it over a surface provided with holes, said information being sufficiently clear for a skilled person to reduce them to practice without undue burden,

if necessary with reasonable experiments. He further argued that although the claims were drafted in terms of functional features they were clear and did comprise all the essential features needed to define the invention. The respondent disputed that D1 discloses all the features of the independent claims and that D2 could render the invention obvious to a person skilled in the art.

The respondent requested that the appeal be dismissed with the proviso that the patent be maintained on the basis of claims 1 to 28 filed on 23 April 2004, columns 1, 2, 5 to 8 of the description as granted, columns 3 and 4 of the description as filed in oral proceedings and the figures as granted.

Reasons for the Decision

1. The appeal is admissible.

2. *Interpretation of the claims:*

When interpreting the claims of a patent a skilled person should rule out interpretations which are illogical or which do not make technical sense. He should try to arrive at an interpretation which is technically sensible and takes into account the whole of the disclosure of the patent.

In the characterizing portion of claim 1 it is indicated:

"the at least one organ (8; 8b) is moved relative to and over a surface (2; 2a; 2b; 26; 28; 30; 43; 48; 58) which is provided with holes", and
"while a piece of visceral tissue (10; 10b) to be separated which passes into a hole (4; 4a; 4b; 4c; 30a; 41; 50; 60) is retained in the hole."

Thus, a person skilled in the art is taught how separation is to be performed, i.e. in that the piece of visceral tissue is retained in the hole and torn away from the organ, since the organ continues its movement relative to the surface and the hole.

Furthermore, the invention addresses a method and a device for separating said piece of visceral tissue from the organ and is not concerned with what happens to the piece of visceral tissue after separation.

Thus, in the meaning of the patent in suit the term "retained" has to be interpreted as meaning "to hold back in order to obtain separation" and not as being indicative of what happens to the visceral tissue after separation, i.e. it does not imply that the visceral tissue is left behind in the hole after separation.

3. *Ground for opposition based on Article 100(b) EPC:*

3.1 Article 100(b) EPC reads as follows "the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art."

Thus, it is clearly indicated that it is the European patent, i.e. the whole patent specification including the description, the claims and the figures which shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art and not only the claims.

3.2 The appellant referred to a passage of claim 1 and stated that it does not establish the dimensions for a hole. Moreover the appellant argued that there is no indication of an upper limit for the dimension of the holes.

However, the description of the patent as granted clearly indicates, column 6, line 55 to column 7, line 4, the dimensions of the holes as well as the centre-to-centre distance of the holes for separating a spleen and fatty tissue from a liver of a slaughtered poultry. Therefore, a skilled person is given all the information which is necessary to calibrate the holes and thus to carry out the invention in at least one specific example where the organ to be processed is the liver of a slaughtered poultry.

Furthermore, since both the method and the device claim refer to the fact that the piece of visceral tissue to be separated has to be smaller than the organ to which it is connected, it is clear for a person skilled in the art that the upper limit for the dimension of the holes will be the dimension of the organ to be processed.

It is correct that the holes are defined in the independent claims in terms of functional features, since the size of the holes may vary in function of the organ to be processed. This is however not objectionable under Article 100(b) EPC as long as the patent provides instructions which are sufficiently clear for a skilled person to put them into practice without undue burden, if necessary with reasonable routine experiments (see T 68/85, OJ OEB, 1987, 228). In the present case there is no doubt that a skilled person can determine by reasonable experiments the adequate hole dimensions with respect to the type of organ to be processed, all the more because the dimensions and centre-to-centre distance of the holes for a specific application are defined in the patent specification, as indicated above.

3.3 Consequently, the ground for opposition based on Article 100(b) EPC does not prejudice the maintenance of the patent in suit.

4. *Independent claim 9 - Amendments:*

4.1 Article 123(2) and (3) EPC:

4.1.1 Claim 9 now on file differs from claim 9 as granted in that the following features have been added: "which are effectively at least as large as the smallest cross-section of the at least one piece of visceral tissue (10; 10b) to be separated, the holes being configured to retain a piece of visceral tissue (10; 10b) to be separated which passes into a hole, in the hole".

Claim 1 as originally filed already disclosed the following features " while a piece of visceral tissue (10; 10b) to be separated which passes into a hole (4; 4a; 4b; 4c; 30a; 41; 50; 60) is retained in the hole." Thus, from claim 1 it was clear for a person skilled in the art that the hole "must be configured to" retain a piece of visceral tissue which passes into said hole, since otherwise it would not be retained in the hole.

Therefore, the use of the term "being configured to" is not objectionable under Article 123(2) EPC.

4.1.2 The appellant argued that none of the figures of the patent in suit referred to with respect to the device, nor the parts of the description of the patent in suit relating to the device do disclose holes configured to retain a piece of visceral tissue that passes into it. However, the patent specification cannot be split into two separate parts, one relating exclusively to the method and the other relating exclusively to the device, since the device is suitable for carrying out the method and since Figures 1 to 5 (alleged to relate solely to the method) represent parts and hole configurations which clearly are intended to be used in a device.

4.1.3 Thus, there is a basis in the description as originally filed as well as in claim 1 as originally filed for the feature according to which the holes are effectively at least as large as the smallest cross-section of the at least one piece of visceral tissue to be separated, the holes being configured to retain a piece of visceral tissue to be separated which passes into a hole, in the hole.

Consequently, the requirements of Article 123(2) EPC are met.

4.1.4 Since the additional features introduce further limitations to the claim the protection conferred is not extended and the requirements of Article 123(3) EPC are also met.

4.2 Article 84 EPC - clarity:

The appellant argued that not all of the essential features needed to define the invention were specified in the independent claims. In his view, in order to be able to retain a piece of visceral tissue as indicated in paragraphs 16 and 26 of the patent specification, the holes must be provided with V-shaped notches or with suction openings. Consequently, in order to fulfil the requirements of Article 84 EPC, said features should have been specified in claim 9.

However, the patent specification indicates also another possible configuration of the holes in order to retain a piece of visceral tissue, see column 2, line 46 where it is indicated that the holes may be provided with a hooked edge. Thus, introduction of a feature according to which the holes are provided with V-shaped notches or with suction openings would unduly limit the claim to some specific embodiments.

Moreover, paragraph [0016] of the patent specification clearly refers to a "preferred embodiment" and does not present the notches as an essential feature, whereas paragraph [0026] of the patent specification relates to the description of Figure 4 which is one particular

embodiment. Thus, even if the presence of the V-shaped notches improves effectiveness, as indicated in paragraph [0026]: "… as a result of which there is a great certainty of a separation being obtained", there is no indication in the description which could lead to the conclusion that V-shaped notches or suction openings are essential for obtaining the expected separation.

The appellant put also forward that the patent specification does not disclose other means than suction means which would be able to retain pieces of visceral tissue after separation from the organ and that consequently, the suction means should be specified in claim 9. However, the invention addresses a method and a device for separating said piece of visceral tissue from the organ and is not concerned with what happens to the piece of visceral tissue after separation. The independent claims require that a piece of visceral tissue that passes into a hole is retained therein to be torn away from the organ; they do not require that the piece of visceral tissue will also be retained (kept) in the hole after separation.

Consequently, the subject-matter of amended claim 9 fulfils the requirements of clarity of Article 84 EPC.

5. *Novelty of the subject-matter of claims 1 and 9:*

5.1 The subject-matter of claim 1 of the patent in suit differs from that of D1 in that said holes are effectively at least as large as the smallest cross-section of the at least one piece of visceral tissue to be separated, while a piece of visceral tissue to be

separated which passes into a hole is retained in the hole.

5.2 The appellant argued that D1 also discloses said distinguishing features.

The appellant referred to Figure 27 of D1 and to the corresponding passage, column 8, lines 1 to 6 which reads as follows: "… the gizzards are moved around the interior of the defatter through contact with the rotating picker fingers 306 and the stationary fingers 298. Fat, gravel, grit and the like pass through perforations 312 formed in insert 296 under the combined action of the picker fingers and the water spray."

From this passage, a skilled person will deduce that the fat is removed from the gizzards by means of the rotating picker fingers, the stationary fingers and water spray and not because the fat is retained in the holes. Consequently, D1 does not disclose that the fat **to be removed** is retained in the holes. Although in D1 the fat passes through the perforations, this occurs only after removal of the fat from the organ.

The appellant further argued that it cannot be excluded that since the organs are moved over the surface, pieces of visceral tissue are caught in the perforations and retained therein.

However, there is no indication in D1 that removal of visceral tissue can be obtained in this way. Therefore such a statement is purely speculative, and based on an analysis which is only possible in awareness of the

invention and thus, clearly corresponds to an ex post facto approach.

Furthermore, claim 1 of the patent in suit requires that the holes are effectively at least as large as the smallest cross-section of the at least one piece of visceral tissue **to be separated** (emphasis added). Thus, in claim 1, the holes are defined with respect to the cross-section of a piece of visceral tissue **before** separation from the organ, whereas in D1 fat passes through the perforation **after** it has been torn away by the fingers, thus after separation. Consequently, no conclusion can be drawn from said passage of D1 with respect to the dimension of the holes compared to smallest cross-section of a piece of visceral tissue, not yet separated from the organ.

5.3 Neither D2, nor D3' (or D3) disclose all the features of the independent claims 1 or 9. This point has not been disputed.

5.4 Consequently, novelty of the subject-matter of claim 1 is given with respect to the documents cited by the appellant.

The same reasoning can be applied to the subject-matter of amended claim 9, which therefore is likewise novel with respect to the documents cited by the appellant.

6. *Inventive step of the subject-matter of claims 1 and 9:*

6.1 The appellant substantiated his objection under Article 56 EPC solely with respect to document D2.

D2 (Figures 2 and 3) discloses a method for removing the tongue of a fish. According to D2 the head of a fish to be processed is placed, tongue down over an aperture 22 provided in a supporting plate 24, the aperture being sufficiently large and of a configuration suitable to receive the tongue. The aperture is in communication with a conduit 20 wherein vacuum is applied. The tongue is separated from the fish by a rotary knife positioned for reciprocating movement (page 3, lines 3 to 19). Once separated from the fish, the tongue is drawn by vacuum into a tank 18.

6.2 The appellant argued as follows:

It is obvious for a person skilled in the art that D2 is suitable for separating a piece of visceral tissue from an organ. As confirmed by the patent in suit (column 1, line 48) such visceral tissue is weakly connected to the organ. Therefore, it would be obvious for a skilled person to omit the knife (since the tissue to be separated is only weakly connected to the organ to be processed). Moreover, because the knife has been removed, it would be obvious for a skilled person that the organ to be processed has to be moved over the surface in order to obtain an effective separation of the tissue and thereby, to arrive at a method as claimed in the patent in suit.

6.3 However, the Board cannot agree to this approach which represents an ex post facto analysis. The point is not whether a skilled person could have arrived at the invention by modifying the prior art, but rather whether, in expectation of the advantages actually achieved (in the light of the technical problem

addressed), he would have done so because of promptings in the prior art. What a skilled person would have done depends in large measure on the technical result he had set out to achieve. A skilled person does not act out of idle curiosity but with a specific technical purpose in mind.

Starting from D2, even if a person skilled in the art, knowing that the connection between the visceral tissue and the organ is weak, would have contemplated to remove the knife, there is no reason why he should have contemplated to move the organ relative to the supporting surface comprising the hole, since there is no disclosure or hint in the cited state of the art which could lead to the assumption that moving the organ could help in performing the separation of the visceral tissue. The normal behaviour of a skilled person would therefore have been to rely on the sole sucking action due to vacuum.

6.4 In fact, there is no disclosure or suggestion in the documents cited by the appellant of moving an organ over a surface provided with holes such that a piece of visceral tissue which passes into a hole is retained in the hole so that it is separated from the organ it was connected to.

Therefore, any possible combination of the teachings of documents cited by the appellant would likewise lack these features.

6.5 Consequently, the subject-matter of claim 1 involves an inventive step. The same applies to the subject-matter of claim 9, which therefore likewise involves an inventive step.

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 amended form on the basis of the following documents:

- Columns 1, 2, 5, 6, 7, 8 of the description as granted,
  columns 3 and 4 of the description filed in oral proceedings.

- Claims 1 to 28 filed with letter of 23 April 2004.

- Figures 1 to 11 as granted.

The Registrar: The Chairman:

G. Magouliotis M. Ceyte

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Case Number: T 0947/02 - 3.2.4

DECISION
of 2 August 2004
correcting errors in the decision
of the Technical Board of Appeal 3.2.4
of 24 May 2004

Appellant: (Opponent)	Meyn Food Processing Technology B.V. Noordeinde 68 NL-1511 AE Oostzaan (NL)
Representative:	Van Breda, Jacobus Octrooibureau Los & Stigter B.V. Weteringschans 96 NL-1017 XS Amsterdam (NL)
Respondent: (Proprietor of the patent)	STORK PMT B.V. Handelstraat 3 NL-5831 AV Boxmeer (NL)
Representative:	Mertens, Hans Victor van Exter Polak & Charlouis B.V. P.O. Box 3241 NL-2280 GE Rijswijk (NL)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted 24 July 2002 rejecting the opposition filed against European patent No. 0711501 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
M. Aúz Castro

Summary of Facts and Submissions

In application of Rule 89 EPC the decision given in case T 947/02 on 24 May 2004 is hereby corrected as follows:

In the order of the decision, the indication of the columns of the description as granted which read "columns 1, 2, 5, 6, 7, 8 of the description as granted" is replaced by "columns 1, 2, 5, 6, 7 of the description as granted".

The Registrar: The Chairman:

G. Magouliotis M. Ceyte