BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [ ] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [X] To Chairmen
(D) [ ] No distribution

Datasheet for the decision of 22 January 2008

Case Number: T 0130/06 - 3.2.04

Application Number: 98946716.2

Publication Number: 1018890

IPC: A22C 21/06

Language of the proceedings: EN

Title of invention:
Method and device for making an incision in the skin of a slaughtered animal, and for performing a subcutaneous operation

Patentee:
STORK PMT B.V.

Opponent:
Meyn Food Processing Technology B.V.

Headword:
-

Relevant legal provisions:
EPC Art. 100(a), 100(b)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Main request - added subject-matter (no)"
"Novelty (yes)"
"Inventive step (yes)"

Decisions cited:
G 0010/91

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0130/06 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 22 January 2008

Appellant: (Opponent)
Meyn Food Processing Technology B.V.
Noordeinde 68
NL-1511 AE OOSTZAAN (NL)

Representative:
Van Breda, Jacobus
Octrooibureau Los en Stigter B.V.
Weteringschans 96
NL-1017 XS Amsterdam (NL)

Respondent: (Patent Proprietor)
STORK PMT B.V.
Handelstraat 3
NL-5831 AV Boxmeer (NL)

Representative:
Brookhuis, Hendrik Jan Arnold
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 2 December 2005 rejecting the opposition filed against European patent No. 1018890 pursuant to Article 102(2) EPC.

Composition of the Board:

Chairman: C. Scheibling
Members: A. de Vries
T. Bokor

Summary of Facts and Submissions

I. By its decision dated 2 December 2005 the Opposition Division rejected the opposition. On 27 January 2006 the Appellant (opponent) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 27 March 2006.

II. The patent was opposed on the grounds based on Articles 100(a) (lack of novelty and of inventive step) and 100(c) EPC. The ground of opposition based on Article 100(b) EPC was raised for the first time during oral proceedings in opposition but not admitted by the Opposition Division.

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

D1: US-A-2 795 815

D2: US-A-4 131 973

D3: EP-A-0 245 543

IV. Claims 1 and 21 according to the main request (as granted) read as follows:

"1. Method for making an incision in the skin (33) of a slaughtered animal (2), which incision has at least two ends, characterized by the following steps:

processing the skin (33) at the positions of the at least two ends of the incision, in order to prevent tearing of the skin (33) from said positions onwards; and

making an incision for connecting said positions substantially to each other."

"21. Device for making an incision in the skin (33) of a slaughtered animal (2), which incision has at least two ends, characterized by:
processing means for processing the skin (33) at the positions of the at least two ends of the incision, in order to prevent tearing of the skin (33) from said positions onwards; and
cutting means for making an incision which connects said positions substantially to each other."

V. Oral proceedings took place on 22 January 2008 before the Board of Appeal.

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

He mainly argued as follows:
Claim 2 as granted comprises the step of providing a slaughtered bird with a vent opening produced by cutting out the vent. According to claim 1 as granted the skin has to be processed at the two ends of the incision in order to prevent tearing. There is no indication in the contested patent how to cut out the vent such that tearing of the skin from said position onwards is prevented. Therefore, a skilled person would not be able to carry out the claimed invention.

Furthermore, according to claim 2 as filed the slaughtered bird was already provided with a vent opening and only the opposite end of the incision had to be processed. In claim 2 as granted, cutting out the vent is now presented as the processing operation to be carried out at one end of the incision. This is new

information which is not unambiguously derivable from the application as filed.

D1, D2 and D3 all disclose a device and a method comprising a blade having pointed teeth at each end, which process the skin before the incision is made.

Moreover, starting from D1, a skilled person would notice that the skin tearing problem never occurs at the end of the incision provided with the vent opening. He would therefore find it obvious to provide the other end of the incision with a similar opening in order to avoid tearing of the skin.

The Respondent (patentee) contested the arguments of the Appellant and submitted that there is no reason why on a prima facie basis a skilled person would be unable to carry out the invention.

Indeed, the whole of the description of the contested patent makes it clear for a skilled person that providing a vent opening is a way of processing the skin in the meaning of claim 1 as granted.

Claim 1 as granted requires that the skin be processed in order to prevent tearing of the skin. This implies that an operation that is different from making an incision is performed prior to making the incision. This is not taught by any of D1, D2 or D3.

In D1 a slaughtered bird is provided with a vent opening and an incision which ends at the region of the tip of the breast where the skin is under tensile stress and thus likely to tear. The vent region is under no stress,

so that a skilled person would not expect uncontrolled tearing of the skin in this region. Therefore, the skilled person would not even notice that no tearing occurs at the vent opening and thus, not be prompted to provide the other end of the incision with a similar opening.

The Respondent requested that the appeal be dismissed (main request), or in the alternative that the patent be maintained on the basis of one of the sets of claims according the first or second auxiliary requests, both filed with letter dated 20 December 2007.

Reasons for the Decision

1. The appeal is admissible.

2. *Insufficiency of disclosure:*

2.1 An objection based on Article 100(b) EPC was presented for the first time during the oral proceedings before the Opposition Division. According to the decision of the Enlarged Board of Appeal G 10/91 (OJ 1993, 420) exceptionally, the Opposition Division may in application of Article 114(1) EPC consider other grounds of opposition [than those submitted and substantiated in accordance with Article 99(1) EPC in conjunction with Rule 55(c) EPC 1973 (Rule 76 EPC 2000)], which prima facie, in whole or in part would seem to prejudice the maintenance of the European patent.

2.2 In the present case, the Appellant mainly argued that there is no indication in the contested patent how to

cut out the vent such that tearing of the skin from said position onwards is prevented.

However, the description as filed (WO-A-99/16321, page 15, lines 30 to 32) indicates that a cloaca cutter known per se can be used to provide a vent opening.

It follows that on a prima facie basis a skilled person is taught at least one manner to carry out the step of producing a vent opening and that such a vent opening is one possibility of processing the skin in the meaning of the claimed invention (see also point 3.3 below).

2.3 Therefore, the Board cannot see any reason why the Opposition Division would not have exercised its discretion correctly when deciding not to admit this new ground for opposition into the proceeding.

2.4 Additionally, G 10/91 (supra) states that fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee, which in the present case was not given.

3. *Main request - Added subject-matter:*

3.1 Claim 2 as originally filed comprises the step of "making an incision in the skin of the belly of a slaughtered bird which is provided with a vent opening produced by cutting out the vent".

Claim 2 of the main request (as granted) comprises the step of "providing a slaughtered bird (2) with a vent opening (14) produced by cutting out the vent".

Claim 2 as granted refers back to claim 1 as granted which requires to process the skin at the positions of the at least two ends of the incision.

3.2 The Appellant argued that claim 2 as granted relates to the active cutting out of the vent opening at the position of one end of the incision. When seen in conjunction with claim 1 as granted, cutting out the vent opening is thus a way of processing the skin in the meaning of the contested patent. However, there is no disclosure that producing a vent opening by cutting out the vent prevents tearing of the skin from the vent opening onwards.

3.3 The application as filed does in fact not explicitly state that providing a vent opening is one of the possible ways of processing the skin at the position of one of the ends of the incision.

However, throughout the application one of the ways of processing the skin to prevent tearing is to provide a hole at the end of the incision. Furthermore, claim 1 and claim 2 as filed relate to the same invention. Claim 1 as filed teaches to process each of the two ends of the incision, whereas claim 2 as filed teaches that when one end is already provided with a hole (the vent opening), only the other end of the incision has to be processed. Accordingly, a skilled person would derive from the whole of the application as filed that providing a vent opening produced by cutting out the vent is one way of processing the skin at the end of an incision in order to prevent tearing of the skin from this position onwards.

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

4. *Main request - novelty of claims 1 and 21:*

4.1 With respect to D1:

4.1.1 D1 (Figures 4 and 6) discloses a circular blade provided with teeth to cut out the vent of a slaughtered bird by providing a circular hole. Said circular blade further cooperates with a straight blade provided with a forward point to make an incision in the skin of the belly of the bird to be processed.

4.1.2 The circular blade alone does not present any end, accordingly it cannot realise an incision with at least two ends. Therefore already, the circular blade disclosed in D1 cannot alone be novelty destroying for the subject-matter of claims 1 and 21.

4.1.3 The hole produced by the circular blade according to D1 can be considered as a way of processing the skin at one of the ends of the incision in the meaning of the claimed invention. In D1 the incision is made by the straight blade.

4.1.4 The Appellant argued that at the opposite end of the incision with respect to the vent opening, the skin is processed by the tip of the straight blade which cuts a perforation in the skin before making the incision.

However, the tip of the straight blade is located in the middle of the extension of the blade, this means that the incision produced by the straight blade extends on both sides of the perforation. Accordingly, the

perforation produced by the straight blade is not located at the position of the end of the incision.

4.1.5 Consequently, the subject-matter of claims 1 and 21 of the main request is novel with respect to D1.

4.2 With respect to D2:

4.2.1 D2 (Figures 6a and 7) discloses a knife that is semicircular in cross-section and has three sharp points at its lower end. This knife produces a semicircular cut as shown in Figure 7.

4.2.2 The Appellant argued that the two sharp points at the ends of the knife of D2 each produce a hole and thus, process the skin at the positions of the two ends of the incision.

Figure 6a shows that the knife comprises three teeth. The tooth located in the middle of the knife presents a sharp point and two skewed flanks on both sides of the tip. Whether the two other teeth have the same profile cannot be derived from D2. Thus, it is unclear whether the sharp points of the other two teeth are located at the very ends of the teeth and of the semicircular knife and thus, would be able to provide a hole at the ends of the incision or whether they are located in the middle of the teeth between two skewed flanks. If these teeth are similar to the tooth located in the middle of the extension of the knife and comprise skewed flanks extending beyond the tip, the skin would not be perforated at the position of the ends of the incision made by the flanks of the teeth.

4.2.3 Thus, the knife of D2 does not unambiguously exhibit all the features of claims 1 and 21. Consequently, the subject-matter of claims 1 and 21 of the main request is novel with respect to D2.

4.3 With respect to D3:

4.3.1 D3 (figures 2 and 3) shows an L-shaped knife movable along an arc of a circle which comprises a foremost outermost protruding sharp point which is moved under the skin and cuts a perforation into the skin when the knife is rotated. During further rotation the trailing part of the knife completes the incision.

4.3.2 In claim 1 a distinction is made between processing the skin at the position of the ends of the incision and making the incision for connecting said positions substantially to each other, respectively in claim 21 the same distinction is made between the processing means and the cutting means. Therefore, it is clear for a skilled person that the skin processing means are distinct from the incision making means.

However, in D3 the sharp point of the knife is part of the blade which makes the incision, so that the same means are used to perforate the skin and to make the incision.

4.3.3 Furthermore, the problem of skin tearing is not addressed in D3. There is no indication whether the perforation of the skin produced by the sharp point of the knife can counteract tearing of the skin.

The Appellant argued that the statement of claim 1 "in order to prevent tearing of the skin (33) from said positions onwards" is not a technical feature and has no limiting effect.

Although being a functional feature, it defines what is meant by "processing the skin". It makes clear that processing the skin at the position of the end of the incision is an operation that counteracts or prevents tearing of the skin at the end of the incision (see also the last sentence of paragraph [0006] of the contested patent).

This implies that any skin operation that does not achieve this expected result is not a skin processing operation in the meaning of the claimed invention. However, D3 is silent regarding this point.

4.3.4 Consequently, D3 does not disclose all the features of claims 1 and 21 of the main request. Accordingly, the subject-matter of claims 1 and 21 is novel with respect to D3.

4.4 With respect to the other documents cited in opposition:

The Appellant did not challenge novelty on the basis of the other documents cited during opposition. The Board is satisfied that none of these documents discloses all the features of the independent claims of the main request.

5. *Main request - inventive step:*

5.1 The Board considers, in accordance with the parties, that D1 is the closest prior art.

5.2 As already stated above, the vent opening produced by the circular blade according to D1 can be considered as a way of processing the skin at one of the ends of the incision made by the straight blade in the meaning of the claimed invention.

5.3 The Appellant submitted that the problem to be solved by the invention with respect to D1 could be seen in preventing tearing of the skin at the end of the incision opposite to the vent opening. He further argued that a skilled person would notice that skin tearing problems never occur at the end of the incision provided with the vent opening and would therefore find it obvious to provide the other end of the incision with a similar opening in order to avoid tearing of the skin.

D1 indeed shows a slaughtered bird provided with a vent opening and an incision connecting the vent opening to the region of the tip of the breast.

Uncontrolled tearing of the skin at the end of an incision occurs in particular if the skin is under tensile stress. In the region of the tip of the breast the skin is under tensile stress and thus likely to tear (see paragraph [0003] of the contested patent). The vent region is under no stress, so that there is almost no risk of uncontrolled tearing of the skin in this region. Consequently, a skilled person does neither expect nor experience skin tearing in the vent region due to an

incision in the belly of the slaughtered bird. He has thus no reason to investigate why no skin tearing occurs, and accordingly to become aware that under other circumstances (i.e. if the skin were to be subjected to tensile stress) the presence of a vent opening could have prevented the skin from tearing. Therefore, he would not be prompted to provide the opposite end of the incision with a similar opening.

5.4 The Appellant also argued that providing a hole to stop a crack is a generally known concept in mechanics and quoted as an example repairing a crack in a windscreen by drilling a hole at the end of the crack and filling it with a resin.

However, a single example does not demonstrate that a concept is generally known. Moreover, a skilled person confronted with the problem of preventing tearing of the skin of a slaughtered animal would not take into consideration the remote technical field of repairing windscreens.

5.5 Accordingly, the subject-matter of claims 1 and 21 involves an inventive step when starting from D1 and taking into consideration the capability of a skilled person.

Order

For these reasons it is decided that:

The appeal is dismissed.

The registrar: The Chairman:

G. Magouliotis C. Scheibling