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**Datasheet for the decision
of 18 August 2009**

Case Number: T 1668/08 - 3.2.07

Application Number: 02716545.5

Publication Number: 1368162

IPC: B26D 3/26

Language of the proceedings: EN

Title of invention:

Cutting device for fruits and vegetables, preferably onion

Patentee:

EPU AG

Headword:

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Relevant legal provisions:

EPC Art. 54, 111(1),(2)

EPC R. 84(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Novelty: yes"

"Remittal: yes, also for consideration of continuing the proceedings after withdrawal of the opposition"

Decisions cited:

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Catchword:

see point 2



Case Number: T 1668/08 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 18 August 2009

Appellant: EPU AG
(Patent Proprietor) Schulhausstr. 9
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Representative: Müller, Frank Peter
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 13 June 2008
revoking European patent No. 1368162 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. O'Reilly
Members: K. Poalas
I. Beckedorf

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking the European patent No. 1 368 162.
- II. Opposition had been filed against the patent as a whole based on Article 100 (a) EPC on the grounds of lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC).
- III. The Opposition Division found that the subject-matter of claim 1 as granted is not novel over D7 (DE 44 69 41 C), the subject-matter of claim 1 according to the auxiliary request 1 does not involve an inventive step, and that claim 1 according to the auxiliary requests 2 to 5 does not meet the requirements of Article 123(2) EPC.
- IV. The respondent (opponent) withdrew its opposition with letter dated 30 October 2008 and is hence no longer party to these proceedings.
- V. During the oral proceedings which took place before the Board of Appeal on 18 August 2009 the appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, alternatively, that in setting aside the decision under appeal the patent be maintained in amended form on the basis of claim 1 filed with the first auxiliary request with letter of 21 October 2008 or on the basis of claim 1 of one of the new auxiliary requests 2, 2a and 3 filed with letter of 17 July 2009.

VI. Independent claim 1 as granted, i.e. according to main request, reads as follows:

"A device for cutting fruit and vegetables, particularly onions, comprising a cutting member (2) with intersecting knife blades (3,4), forming a grid, and a counter pad (5) against which the cutting member (2) can be pushed in the process of cutting the onion (6), said counter pad (5) being constituted by a cutting-board (8) and said cutting member (2) being pivotably connected by means of a joint in the shape of a hinge (7) to the cutting board (8) to allow its knife blade grid to carry out a swinging movement directed downwards to the cutting board (8) and towards an onion (6) placed there-on, the cutting board (8) having within the area essentially coinciding with the extent of the knife blades, a plurality of projections (9) supporting the onion (6), characterized in that the device consists of two main parts only, namely said counter pad (5) constituted by a cutting board (8) and said cutting member (2), being pivotably connected, and the knife blade grid has square openings or cavities (10) and the projections (9) protrude from the cutting board (8) at the same time as they form a supporting surface for the onion on the pad (5) constituting the cutting board (8), they form a pattern corresponding to that of the knife blades (3,4) on the cutting member (2) 11. by that they have a cross sectional shape substantially corresponding to the shape defined by the knife blades (3,4) in the cutting member (2), and that they are intended to completely penetrate the openings or cavities (10) in the knife blade grid when the cutting member (2) is in its fully down-tilted position over the cutting board (8) and having its knife blades

(3,4) penetrated into the grooves running between the projections (9) by means of one single pushing movement, said onion (6) resting on said cutting board (8) will be completely divided due to the knife blades (3,4) grid and corresponding pattern of the projections (9) and the height of the knife blades (3,4) being slightly less than that of the projections (9) so that, when the cutting member (2) is in its down-tilted position, a flat surface is obtained and a ready-cut onion (6) is present thereon".

VII. The appellant argued essentially as follows:

Claim 1 as granted: Novelty - Article 54 EPC

The Opposition Division concluded in its decision that the feature of claim 1 that the height of the knife blades is slightly less than that of the projections is implicitly disclosed in the device as described in D7 for tolerance reasons. The reasoning, made by the Opposition Division, is already part of the inventive step as achieved through the device in accordance with the invention. There is no disclosure whatsoever in document D7 which leads to the assumption (implicit disclosure) that the knife blades have a height which is slightly less than the height of the projections.

Document D7 clearly teaches in lines 34 - 38 of page 2 that figure 1 shows the cutting device in its fully down-tilted position ("... heruntergeklapptem Zustande"). If the knife blades of the device, as shown in document D7, were of less high than the projections h, figure 1 would not show the fully down-tilted position, but it would then be possible to further tilt

down levers c until frame f or levers c hit the ground of the projections, namely the surface of base part a. The knife blades e, g reach the base of the projections and thereby constitute a stop against the tilting movement of the lever (as shown in figure 1).

From the above, it is clear that the height of the knife blades must be equal to the height of the projections h.

Reasons for the Decision

1. *Claim 1 as granted: Novelty - Article 54 EPC*

It is undisputed that the feature that the height of the knife blades is slightly less than that of the projections is not explicitly mentioned in D7.

The question at stake is therefore to decide whether such feature is implicitly disclosed in D7.

The Board follows the appellant's argument that no conclusion can be drawn concerning the height of the blades from figure 1 of D7 because in this side view other elements may or may not hide the blades and it is unclear whether the vertical lines projecting underneath the lever c show only the projections h or if they also show some of the knife blades.

The height of the knife blades cannot be longer than that of the projections in D7 as the claim of D7 states that the projections fill out the space between the blades. The Board therefore understands that there are

the following possibilities remaining as far as it concerns the height of the knife blades in relationship with the height of the projections:

the first possibility is that the height of the knife blades is equal to the height of the projections and the second one is that the height of the knife blades is less or slightly less than the height of the projections.

According to the Board's persuasion it does not exist in D7 any clear indication for selecting one specific solution out of the two above mentioned possibilities. In fact given that figure 1 shows the tilted down position when the blades have reached the base of the projections and that the description states that the tops of the blades and projections are at the same level there exist in D7 if anything an implication towards the blades and the projections having essentially equal heights.

The Opposition Division stated under point 1.3 d) of the reasons for its decision that "although as a pure geometrical abstraction it could be conceivable that the height of all the knife blades of D7 be exactly equal to that of the projections, a skilled person, when realizing the device of D7, in order to keep the back of the blades flush with the upper part of the implement (h) and avoid the undesirable effect of food rests remaining stuck between the blades, would necessarily set the manufacturing tolerances for the blades such that the height of the knife blades is less than that of the projections. Since the term "slightly less" is vague, it is considered as equivalent to "less".

The Board cannot follow the above mentioned finding of the Opposition Division since it results from a desire to ameliorate the performance of the knife blades of the device known from D7 by "adjusting" the length of the knife blades with reference to the general knowledge of the skilled person and to thus "solve a non-mentioned problem" by reading into a document something which is not comprised therein. Such considerations are related to the evaluation of inventive step, and not of novelty. According to the jurisprudence of the Boards of Appeal, an "implicit prior description" of a feature cannot be based on the grounds that a person skilled in the art would have been aware of some disadvantages and of the lack of other forms of improvements related to said feature, this being a criterion for the evaluation of inventive step, see Case Law of the Boards of Appeal, 5th edition, 2006, I.C.2.3.

Thus, the feature concerning the height of the knife blades being slightly less than that of the projections is not derivable from D7 and the subject-matter of claim 1 as granted is novel over D7.

2. *Procedural matters*

The Board has found that the subject-matter of claim 1 as granted is novel over D7, and thus, that the decision under appeal is overturned by the Board of Appeal in this respect. Since the Opposition Division in its contested decision did not address any other ground of opposition, the Board, with the appellant's consent, exercise its discretion according to

Article 111(1) EPC not to examine these issues for the first time of its own motion during the appeal proceedings but to remit the case to that department for further prosecution. During that further prosecution, however, the Opposition Division will need first to decide according to the Rule 84(2) EPC whether or not to continue the opposition proceedings of its own motion in view of the withdrawal of the opposition. The Board's decision to remit should not be taken as indicative of the conclusion to be reached in this respect. In the case of a continuation of the opposition proceedings, the Opposition Division will be bound by the *ratio decidendi* of the Board's decision according to Article 111(2) EPC on novelty of claim 1 as granted over D7.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

G. Nachtigall

P. O'Reilly