

**Internal distribution code:**

- (A)  Publication in OJ  
(B)  To Chairmen and Members  
(C)  To Chairmen  
(D)  No distribution

**Datasheet for the decision  
of 16 October 2012**

**Case Number:** T 2359/09 - 3.2.04

**Application Number:** 02786238.2

**Publication Number:** 1455566

**IPC:** A01G 9/10, B66F 9/19

**Language of the proceedings:** EN

**Title of invention:**

Apparatus and method for moving or positioning wider or narrower objects

**Patentee:**

Visser 's-Gravendeel Holding B.V.

**Opponent:**

HETO B.V.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 100(c)

RPBA Art. 13(3)

**Keyword:**

"Added subject-matter - yes (main request)"

"Late filed requests - not admitted - not clearly allowable"

**Decisions cited:**

T 0404/03, T 1067/97, T 0025/03, T 1408/04, T 0191/93

**Catchword:**

-



Case Number: T 2359/09 - 3.2.04

**DECISION**  
of the Technical Board of Appeal 3.2.04  
of 16 October 2012

**Appellant:** HETO B.V.  
(Opponent) Plantage 4  
NL-2377 AH Ouda Wetering (NL)

**Representative:** Jessen, L.J.J.  
Vereenigde  
Johan de Wittlaan 7  
NL-2517 JR Den Haag (NL)

**Respondent:** Visser 's-Gravendeel Holding B.V.  
(Patent Proprietor) Mijlweg 18  
NL-3295 KH 's-Gravendeel (NL)

**Representative:** Grootscholten, J.A.M.  
Arnold & Siedsma  
Sweelinckplein 1  
NL-2517 GK The Hague (NL)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 12 October 2009  
rejecting the opposition filed against European  
patent No. 1455566 pursuant to Article 101(2)  
EPC.

**Composition of the Board:**

**Chairman:** T. Bokor  
**Members:** A. de Vries  
P. Petti

## Summary of Facts and Submissions

I. The Appellant (Opponent) lodged an appeal, received 3 December 2009, against the decision of the Opposition Division posted 12 October 2009 to reject the opposition against European patent No. 1 455 566 and simultaneously paid the appeal fee. The statement of the grounds of appeal was received 22 February 2010.

II. The opposition had been filed against the patent as a whole based on Article 100(a) in combination with Articles 54 and 56 EPC for lack of novelty and inventive step, on Article 100(b) for insufficiency of disclosure and on Article 100(c) for added subject-matter.

The Opposition Division held that none of the raised grounds prejudiced the patent as granted.

III. Oral proceedings were duly held before the Board on 16 October 2012.

IV. The Appellant requests that the decision under appeal be set aside and the patent be revoked in its entirety.

The Respondent (Proprietor) requests that the appeal be dismissed, alternatively that the patent be maintained in amended form based on one of auxiliary requests 1 to 5 filed during the oral proceedings before the Board.

V. The wording of independent claim 1 of the requests is as follows:

*Main Request*

"Apparatus for displacing objects (10) which can be picked up, comprising:

- a fork-like member (2) provided with mutually adjacent teeth (3) and only one flexible carrier (4) arranged on each tooth (3), said flexible carriers (4) being drivable in longitudinal direction of the teeth (3) and being adapted for picking up the objects between the teeth (3),
- transporting means connected to the fork-like member (2),
- moving means for moving the fork-like member (2) vertically, and
- control means for controlling the transporting and moving means,

**characterized in that** the fork-like member (2) comprises at least three teeth (3) each having the flexible carrier (4) arranged on a horizontal side thereof."

*First Auxiliary Request*

With respect to claim 1 of the main request the characterizing part has been amended as follows, where deleted text is indicated by ~~striketrough~~ and added text is underlined:

**"characterized in that** the fork-like member (2) comprises ~~at least three~~ more mutually adjacent teeth (3) than one pair of mutually adjacent teeth (3), each having the flexible carrier (4) arranged on a ~~horizontal~~ side thereof, that is horizontal during simultaneous pick-up of the objects, the carrier (4) is

arranged on the horizontal side of tooth (3) and around tooth (3) by means of a drive wheel (5) and guide wheels (7,8,9).

*Second to Fifth Auxiliary Request*

Claim 1 is identical for these requests. It adds at the end of claim 1 of the first auxiliary request the following wording:

"wherein each two mutually adjacent teeth (3) are adapted to support objects (10) there between on the flexible carrier (4) of each tooth (3) of the two mutually adjacent teeth (3)".

VI. The Appellant argued as follows:

The amendments generally have no literal basis anywhere in the original disclosure. They cannot be inferred from various figures considered together as the figures are not interrelated. In as far as they are added from the figures, e.g. figure 2, they are added in isolation from other features and represent an unallowable intermediate generalization. There is no indication that these features would be essential.

Particularly, there is no disclosure of a "*horizontal side*" on a tooth, which are only described in terms of a longitudinal direction but without any indication of a reference system. Figure 3 shows the carrier extending around the entire L-shaped tooth, including around its vertical part, not just what might be horizontal. There moreover top and bottom surfaces are

inclined and it is not clear which one might be horizontal.

The figures might show 8, 6 or 3 teeth, but there is no disclosure of "at least" three teeth, nor why this feature is significant. As formulated these teeth need not be adjacent, while the formulation further allows for other teeth without a carrier, or a carrier not on a horizontal side.

The added feature that the carrier "*is adapted for picking up objects between the teeth*" is much broader than the only specific disclosure in figure 2 of how it is adapted. This formulation implies something special about the carrier. In figure 2 and page 5, lines 19 to 22 the pot edge is supported on the carrier which extends over the full width of the tooth.

The new auxiliary requests are late filed and should not be admitted as not clearly allowable.

Thus the amendments to claim 1 of the first auxiliary request do not address all points and raise new ones. The apparatus is defined in terms of a method, while there is contradiction in the claim's wording. The added features again have no verbatim support. They try to generalize figure 3, while they include some, but not all of its features. These objections apply also to claim 1 of the auxiliary requests 3 to 5.

The further addition to claim 1 of the second auxiliary request merely compounds the problem as it introduces a further contradiction and again represents an intermediate generalization.

VII. The Respondent argued as follows:

The figures could refer to several embodiments but it is clear, e.g. from the common reference signs, that they are closely related. When he considers these figures together and in combination with the description the skilled person immediately recognizes the basic idea of the invention, which is portrayed in figure 2. That figure shows the "basic minimum unit" embodying the invention, with two pairs of teeth sharing a common middle tooth, allowing two rows of pots to be picked up simultaneously. It also shows the top side of the teeth as being horizontal, and the carrier on this top side supporting the pots. The horizontal orientation is also clear from the other figures. Claim 1 as granted incorporates all the essential features of this idea. This should be allowed according to T 404/03.

The at least three teeth must be adjacent for the invention to work. This feature is indeed implicit in a meaningful reading of claim 1

Similarly, the top side of the teeth must be horizontal to pick up all pots in a row simultaneously.

The new requests address points which have only become clear at the oral proceedings and they could only be formulated once the Board's position had become clear on these points. In this regard some guidance would be useful. The amendments of both first and second auxiliary requests incorporate further essential feature from the context. Thus, e.g. for the purpose of

picking up it is clear that the L-shape of the teeth is not important.

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Main Request : added subject-matter*
  - 2.1 The patent is concerned with lifting objects, in particular pots, to then put them down with a different spacing, see specification paragraph [0003]. This is achieved basically using a fork-lift with a fork-like member that has a flexible carrier such as a belt or a chain on each tooth and driven along its length. The application as filed included claims to the apparatus and its method of operation.

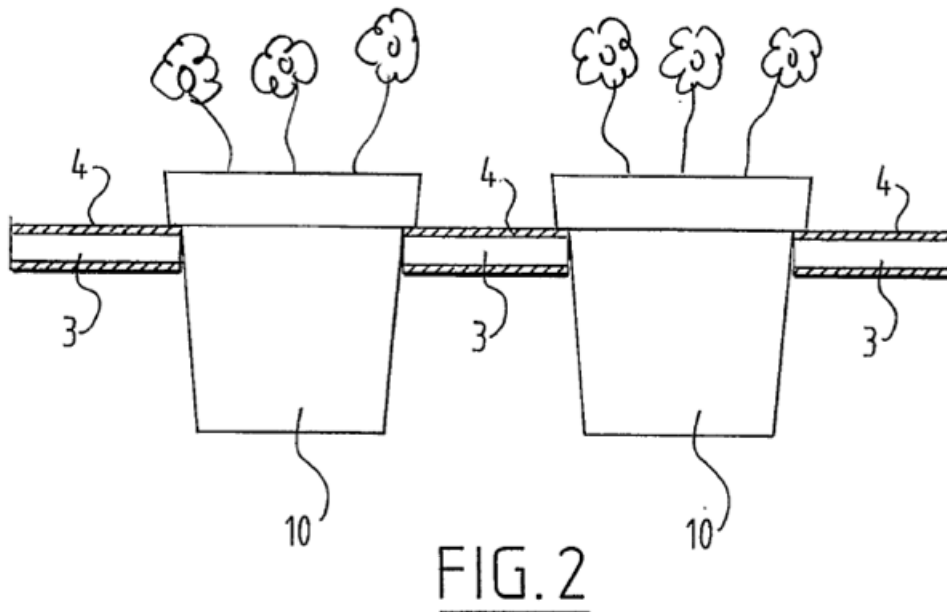
Original claim 1 identified the fork-like member, means for moving it vertically and transporting means both under control of a control means. The characterizing part of the claim stated that "at least one pair of mutually adjacent teeth of the fork-like member is equipped with one flexible carrier arranged on each tooth and drivable in longitudinal direction of the tooth".

In the proceedings leading up to grant claim 1 was amended to include the new requirement of the carriers "*being adapted for picking up the objects between the teeth*". The characterizing part further includes new requirements that the fork-like member comprises "at



least three teeth", "each having the flexible carrier arranged on a horizontal side thereof".

2.2 These features have no literal basis in the application as filed as acknowledged by the Respondent-Proprietor. Rather, they are said to derive from figure 2 of the application as filed. This figure would show the "basic minimum unit" embodying the invention. Figure 2 is shown below.



According to as filed description page 2, lines 24 to 26, this figure is a "cross-section of three teeth". Further page 5, lines 19 to 22, states: "objects for moving are for instance flower pots 10 with the edge 11 which can be picked up between teeth 3, wherein the edges 11 support on carriers 4 as shown in figure 2". The Board notes there is no reference sign 11 in figure 2, but it easily infers that these "edges 11" refer to the edges of the rims of the pots 10, by which they are shown resting on the carrier 4.

Figure 2 considered in conjunction with the accompanying text is seen to show 3 adjacent teeth with two pots between each pair of adjacent teeth. The carrier 4, shown hatched, extends *across the full width of the top and bottom* of the cross-section of each of the three teeth 3. The rims of the pots rest on the edges of the carrier 4 *on the top of the teeth* and are supported thereby.

2.3 When the Board compares the features said to be added to claim 1 from figure 2 with what is actually shown in figure 2 considered in conjunction with the corresponding passages it notes that not all features shown have been included in claim 1, and if they have been they are phrased in much broader terms. Thus, claim 1 does not require the teeth to be *adjacent*. Rather than stating that the carrier runs over *top and bottom* of the tooth it is "arranged on a horizontal side", while the fact that the carrier *on the top of the tooth extends over its entire width of the tooth* so as to support the pot by its rim is replaced by the carrier "being adapted for picking up objects between the teeth". Additionally, that there should be *at least three teeth*, where figure 2 shows *exactly three* can have no basis in the figure itself.

2.4 The Board is unable to find a basis in the application as filed for these omissions and generalizations of features of figure 2, nor for the added requirement of *at least three teeth*.

2.4.1 It is well-established in jurisprudence that the inclusion in a claim of some but not all features from a given context is only justified in the absence of any

clearly recognizable functional or structural relationship among the features, see e.g. Case Law of the Boards of Appeal of the EPO, 6th edition, 2010, section III.A.2, and decisions T 1067/97, T 0025/03, T 1408/04 cited therein. This applies not only to features isolated from a given context in the description but also when taken from figures, see T 191/93.

2.4.2 Applying this approach to the present case the Board finds that in figure 2 the fact that the three teeth are adjacent is clearly functionally important in that it allows the pots to be picked up between them. Similarly, the carriers in figure 2 are only seen to fulfil their function of carrying the pots if they extend across the width of the individual teeth so that the pot rims can rest on them. Finally, if the Board reads figure 2 in conjunction with figure 1 as would the skilled person, it finds that the carrier's longitudinal movement is due to the fact that it runs around the tooth over its top and bottom surfaces as shown by the hatched areas on the top and bottom of the cross-section of the tooth 3 in figure 2. The Board concludes that these various features are closely linked together in terms of function and structure. The features are thus taught together, in close combination. Introducing only selected ones but not others represents a new teaching which encompasses new embodiments that the skilled person would not have considered when reading the original disclosure. These include, for example, fork-like members with the three teeth separated by teeth without a carrier, or a with a carrier not on its horizontal side; members with teeth bearing carriers that do not extend across the width of

the tooth; or members with teeth that have carriers arranged only on the top or the bottom on the tooth.

2.4.3 It is not enough to state, as does granted claim 1, that the carrier is on a "horizontal side" of the tooth, or that it is "adapted for picking up objects between the teeth". Leaving aside what is exactly meant by "horizontal" in this context, the former formulation allows for the carrier to be arranged on only one side, which can be either top or bottom of the tooth, while the latter does not limit in any way the particular features of the carrier that allow it to support the objects. Both formulations are much broader than is justified by figure 2 alone. Nor is there any basis for such a broad formulation in any other part of the original disclosure. Figures 1 and 3 show the carrier in belt form running around the length of the teeth, on top and bottom and matching its width. Figure 4 illustrates in cross-section a single tooth with chain-like carrier again extending both on top and bottom. How the objects are supported is unclear.

2.4.4 Finally, the original application teaches "at least one pair" of teeth, see claim 1, and gives specific examples of eight, six and three teeth (figures 1, 5A and 2 respectively). There is no indication anywhere that three would represent a technically significant minimum for the number of teeth, either in relation to the application's original idea or in any other context. The original idea was to have on each tooth one carrier drivable along it, which would allow variation of the distance between pots adjusting the speed of the carrier, see the bridging paragraph of as filed description pages 1 and 2. Apart from the requirement

that there should be a minimum of two teeth to be able to pick up a pot, whether there are three, six or eight teeth plays no role. By specifying three as a minimum in granted claim 1 that number acquires a significance it did not have in the original teaching, thus also adding information.

- 2.5 The Respondent-Proprietor relying on T 404/03 has argued that claim 1 incorporates only the essential features of the "basic minimum unit" which the skilled person will recognize in figure 2.
- 2.5.1 T 404/03, see reasons 10 and 11, considers the broader application of the essentiality test, developed in T 331/87 (OJ 1991, 22) for assessing the omission of a feature from an independent claim, to the generalization or isolation of a feature disclosed in a specific context in dependent claims or description. This three point test is concerned with what the skilled person perceives as essential and what not in a claimed constellation of features. This is the main criterion proposed there for deciding whether omission of a feature does not add subject-matter.
- 2.5.2 The above argument based on the essentiality test presumes first and foremost that the skilled person perceives figure 2 in the totality of the original disclosure as embodying the essence of the invention. The Board is however unable to find any indication in the application as filed that figure 2 might be special in any way over and above the other figures. Its sole purpose is to illustrate one aspect among others of the application's teaching, namely how pots, the particular objects of interest, can be supported on the carrier

via their rims. Page 4, lines 24 to 26, identifies the figure as nothing more than a "cross-section .... of an embodiment" of the invention. That invention is stated in claim 1 as filed and is also outlined in the paragraph bridging pages 1 and 2 as the idea of having one carrier arranged on each tooth and drivable along the tooth, which would allow the distance between objects to be varied in response to variation of the carrier speed, see also as filed claim 12. It differs markedly from the one given in granted claim 1 which gives the number of teeth and the horizontal placement of the carrier centre stage.

2.5.3 Even assuming that the skilled person had read figure 2 as special, the Board is unconvinced that he would have been able to distinguish between features that are and ones that are not essential. All the features shown therein appear to contribute equally to the way the pots are picked up, and no one feature is given greater significance over any other. Nor is this evident anywhere in the text of the description or when considering figure 2 together with the other figures.

2.6 In the light of the above the Board concludes that claim 1 as granted extends beyond the content of the application as filed, contrary to Article 100(c) EPC.

3. *Admissibility of the auxiliary requests 1 to 5*

3.1 The requests 1 to 5 have all been filed during the oral proceedings before the Board and are thus subject to discretion afforded the Board under Article 13 of the Rules of Procedure of the Boards of Appeal. That discretion is to be exercised "in view of inter alia

the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy", Article 13(3) of the Rules of Procedure of the Boards of Appeal. According to established case law that discretion is exercised as follows: Unless an amendment is *justified* by developments in the appeal proceedings it will be admitted only if it does *not extend the scope or framework of discussion* as determined by the decision under appeal and the statement of the grounds of appeal, and is moreover *clearly allowable*, see the Case Law of the Boards of Appeal 6th edition, 2010 (or CLBA), VII.E.16.1.1 and the case law cited therein, in particular T 0397/01, reasons 1. Amended claims are *clearly allowable* if the Board can quickly ascertain that they overcome all outstanding issues without raising new ones, see CLBA, VII.E.16.4.1 and the case law cited therein.

- 3.2 No clear justification exists for the late filing of auxiliary requests 1 to 5. They are said to address points raised during the oral proceedings before the Board, but these points were in fact discussed in some detail in the Appellant's statement of grounds, see e.g. pages 4 to 16. Point 2 of the annexe to the summons also clearly identifies the issue of isolation and broad formulation of features.

In this regard the Respondent cannot expect to be able to rely on the Board's position, much less on specific guidance, on the various points at issue before it submits amendments. Apart from the fact that this manner of proceeding does not comply with Article 12(2) RPBA, it is irreconcilable with the nature of an

opposition appeal as an impartial judicial review in contentious inter partes proceedings, as it would favour one party over another. It is thus incumbent on a respondent to formulate its response to an appeal in a timely and appropriate manner without assistance from the Board.

3.3 Leaving aside the question of whether they extend the scope of discussion, the Board therefore considers whether these amendments are clearly allowable.

3.3.1 The first and 2nd auxiliary request add to claim 1 that the relevant teeth with carrier are adjacent, while rephrasing the requirement of "at least three" teeth. Furthermore, the term "horizontal" is redefined, while features are added defining how the carrier is arranged around the tooth. The 2nd auxiliary request adds a further feature that each of the mutually adjacent teeth is adapted to support objects between them on the carrier on their teeth.

3.3.2 It is immediately clear that neither version specifically includes the omitted feature of the *width* of the carrier shown in figure 2 and instrumental in supporting the object. Moreover, apart from specifying adjacency the new formulation of "more mutually adjacent teeth than one pair of mutually adjacent teeth" appears to simply restate in different terms the objectionable feature of "at least three teeth" as in granted claim 1. Thus, these features do not convincingly address the issues under Article 123(2) discussed above.



- 3.3.3 The first two added features also, as before, have no literal basis in the application as filed. They must be inferred from either figures or from disparate passages that should be read together. Consequently their basis in the original disclosure, on the face of it, appears problematic, and is certainly not straightforward. Similarly, the further added feature of the arrangement of the carrier around the tooth draws on figure 3 and the corresponding text on page 5, lines 11 to 13. However, various features from that figure appear again to have been omitted, e.g. the number of guide wheels, their location, the general shape of the tooth, to name but a few. These features all appear structurally and functionally related, so that this particular amendment results in a further unallowable intermediate generalization. Consequently, these amendments raise new issues under Article 123(2) EPC.
- 3.3.4 The redefinition of what is a horizontal, namely during pick-up of the objects, defines the apparatus in reference to the way it is to be used, which seems ill-suited to define the relevant structural features intended. Moreover, the original formulation that the carrier is arranged on the horizontal side is retained further on in the claim, leading to an apparent contradiction. The final feature of claim 1 of the 2nd auxiliary request that the teeth are adapted to support objects seems to contradict the preamble's requirement that it is the carriers that are adapted to this end. These amendments raise issues of clarity, Article 84 EPC.
- 3.3.5 Claim 1 of the 3rd, 4th and 5th auxiliary requests is identical to that of the first auxiliary request. The

comments made in respect of that request apply also to these requests.

- 3.4 The Board concludes that the amendments to the auxiliary requests 1 to 5 fail to fully address the issues of added subject-matter raised under Article 100(c) EPC against granted claim 1, while they add new issues of added subject-matter, Article 123(2) EPC, and clarity, Article 84 EPC. They are thus not clearly allowable, and for this reason the Board decided not to admit them into the proceedings pursuant to Article 13(3) RPBA.
4. As the opposition ground raised under Article 100(c) EPC prejudices the maintenance of the patent as granted requested as main request, and the Board does not admit the late filed auxiliary requests 1 to 5 into the proceedings, it must therefore revoke the patent pursuant to Article 101(2) and (3)(b) EPC.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar

The Chairman

L. Fernández Gómez

T. Bokor