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**Datasheet for the decision  
of 20 November 2013**

**Case Number:** T 1937/10 - 3.2.07

**Application Number:** 99942671.1

**Publication Number:** 1175360

**IPC:** B65G47/14, B65G25/08

**Language of the proceedings:** EN

**Title of invention:**

ARTICLE TRANSFER DEVICE

**Patent Proprietor:**

Comact Equipment Inc.

**Opponent:**

Nordautomation Oy

**Headword:**

**Relevant legal provisions:**

EPC R. 76(2) (c)

**Keyword:**

Admissibility of opposition - opposition substantiated (yes)

**Decisions cited:**

T 0522/94, T 0328/87, T 0597/07, T 1022/99

**Catchword:**



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Case Number: T 1937/10 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 20 November 2013**

**Appellant:** Nordautomation Oy  
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**Decision under appeal:** **Decision of the Opposition Division of the European Patent Office posted on 12 July 2010 concerning the inadmissibility of the opposition filed against the European patent No. 1 175 360 pursuant to Rule 77 EPC.**

**Composition of the Board:**

**Chairman:** H. Meinders  
**Members:** G. Patton  
E. Kossonakou

## **Summary of Facts and Submissions**

- I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division to reject the opposition against the European patent No. 1 175 360 as inadmissible.

The opposition was filed against the patent as a whole and was based on Article 100(a) EPC (lack of novelty and lack of inventive step).

- II. The respondent (patent proprietor) replied to the appeal and requested that it be dismissed as inadmissible or as unfounded. In the alternative that the decision under appeal is set aside, it requested that the case be remitted to the department of first instance for a decision on the patentability of the subject-matter of the patent. Subsidiarily it also requested that the patent be maintained on the basis of a first or second auxiliary request.

The Board provided the parties with its preliminary non-binding opinion annexed to the summons for oral proceedings that the appeal and the opposition could be regarded as admissible.

With its letter dated 24 October 2013 the respondent withdrew its objection as to the inadmissibility of the appeal.

- III. Oral proceedings took place on 20 November 2013 at the beginning of which the respondent confirmed that it no longer contested the admissibility of the appeal. Thus, the discussion concentrated specifically on the admissibility of the opposition.

The present decision was announced at the end of the oral proceedings.

- IV. The appellant requests that the decision under appeal be set aside and confirms that it agrees to remittal of the case to the department of first instance for further prosecution, if the Board decides that the opposition is admissible.
- V. The respondent requests that the appeal be dismissed. Should the decision under appeal be set aside, the respondent requests that the case be remitted to the department of first instance for further prosecution.
- VI. The documents of the opposition proceedings which are of relevance for the present decision are the following:

- D1 FI-94743
- D1a English translation of D1, 6 pages
- D2 Seminar, Nordautomation Oy, "Puukaupan Mittaukset Ja Laadutus Pohjolassa Uudet Menetelmät - Virkesmätning Och Kvalifikation I Norden Nya Metoder", Kemi, Finland, 23-24 March 1995, programme and page "AQS300 Mittaus- Ja Laadutusasema"
- D3 Pictures, 2 pages, undated
- D4 Jari Marjomaa and Kimmo Uurtamo, "Kuitupuun Automaattinen Mittaus- Ja Laadutusasema", Metsäteho, Katsaus, October 1995, pages 1-3
- D4a English translation of first paragraph of D4, 1 page
- D5 FI-78882

- VII. The appellant argued essentially as follows:

Documents D1 to D5 were cited in the notice of opposition. D1 and D2 refer to the same device which was disclosed in a public seminar held in Kemi, Finland on 23-34 March 1995. D4 is an article on that same device, which was published before the priority date. D3 presents photos of this device. These public prior disclosures, evidenced by D1 to D4, comprised all the features of claim 1 and, hence, its subject-matter is not novel.

The evidence D1 to D4 is easily understandable and the interrelation between these documents is explained in the notice of opposition. Whether the statements made in the notice of opposition are true or not, such as whether D1 to D4 are truly interrelated or whether D2 and D3 are actually prior art documents, does not relate to the admissibility of the opposition but rather to its substantive merit.

VIII. The respondent argued essentially as follows:

The opposition is insufficiently substantiated with regard to the question of **what** has been actually disclosed. The nature of the evidence is not explained in the notice of opposition as it is not unambiguously established that D2 is one complete document and that D3 actually discloses the same device as D2 or D4. Further, the statement that D1 to D4 refer to the same device is a mere allegation. Further investigations would be needed to clarify and understand the nature of this evidence.

IX. The impugned decision found that it is not clear whether a machine related to D1 had actually been disclosed in the seminar of D2. The link between documents D2 and D4 has not been proven, nor the

interrelation of D3 with D1, D2 and D4. It has not been proven either that the machine of D1 is of the same nature as the machines of D2, D3 or D4. Even features of claim 1 which would be considered as not disclosed by D1 are not clearly derivable from D2 or D4. Consequently, the prior use has not been sufficiently substantiated, in particular with regard to the question of what has been disclosed.

### **Reasons for the Decision**

1. Admissibility of the opposition
  - 1.1 The notice of opposition is founded on the sole objection of lack of novelty against claim 1 of the contested patent, relying only on an alleged public prior use (D1 to D3) and a prior disclosure of that same device (D1, D3, D4). The inadmissibility of the opposition is based on the ground of insufficient substantiation, in particular with regard to the question of **what** has been actually disclosed (point 2.4 of the impugned decision).
  - 1.2 The relevant requirements concerning substantiation of the opposition are set out in Rule 76(2)(c) EPC, according to which the notice of opposition shall contain a statement of the **extent** to which the European patent is opposed and of the **grounds** on which the opposition is based, as well as an indication of the **facts and evidence** presented in support of these grounds.
  - 1.3 It is clear from the EPO Form 2300 dated 28 November 2007 filed by the appellant that the opposition was filed against the patent as a whole (extent) and based on the grounds of Article 100(a) EPC, namely lack of

novelty and lack of inventive step (grounds). This is further confirmed by the notice of opposition itself. The first two conditions of Rule 76(2)(c) EPC are therefore clearly fulfilled.

- 1.4 With respect to the last condition (facts and evidence), according to the established case law the notice of opposition must indicate the "when", "what" and under "what circumstances", in particular "to whom", the alleged public prior use was made available (T 522/94, OJ EPO 1998, 421, Headnote IV, points 10, 12, 20 to 25 of the reasons; T 328/87, not published in OJ EPO, point 3.3 of the reasons).
- 1.5 In the present case, the appellant cited documents D1 to D5 with its notice of opposition. D5 was merely cited for dependent claims, it is therefore not relevant for this decision. It indicated that a relevant device, as in D1, was made public to the attendees of a public seminar, i.e. to members of the public not bound by secrecy, held in Kemi, Finland on 23-34 March 1995 (**circumstances** and **when**). It filed D2 in this respect, constituted of a cover page, a programme page and a one page description of an AQS300 device with a picture and a drawing of this device.

The appellant argued in its notice of opposition that D1 discloses all the features of claim 1 except the features of the characterising portion. The latter features are alleged to be comprised in the device shown at the said seminar (**what**). D2 and D3 were filed as evidence to support this fact.

The same device was the subject of a prior disclosure in the article D4, showing the same picture as in D2.

The photos D3 were filed as supporting evidence for this device as well.

In the light of these "what", "when" and "what circumstances", the appellant concluded that novelty of the subject-matter of claim 1 was not given.

- 1.6 As indicated in T 597/07 (not published in OJ EPO), point 2.5 of the reasons, according to the established case law, *"it is not required for an opposition to be admissible that the arguments brought in support are **conclusive** or that the opponent's statements are **true**. What is required is that the patentee and the opposition division are put in a position of understanding clearly the nature of the objections and the evidence and arguments in support"*.

It is further referred, for instance, to T 1022/99 (not published in OJ EPO), point 2.2 of the reasons, indicating that the facts - what, when, what circumstances of the alleged public prior use - must be indicated within the opposition period, while the evidence can be brought later in the proceedings as long as it is indicated.

- 1.7 Therefore, a distinction must be made between examining admissibility of the opposition and its substantive merit (see Case Law of the Boards of Appeal of the European Patent Office, 7th edition 2013, chapter IV.D. 3.3.3).

This distinction, contrary to the respondent's opinion, was not made in the impugned decision which appears to be focused only on assessing whether the appellant's case of alleged prior use was conclusive and convincing.



1.8 The respondent holds the view that T 597/07 (*supra*) requires that the **nature of the evidence** is clearly understandable at the time when the opposition is filed and considers this element to be missing in the present case.

It argues that it is not unambiguously established that D2 and D3 are prior art documents. In particular, it is not clear whether page 3 of D2 actually belongs to D2 itself as there is no direct link between said page 3 and the first two pages (cover and programme of the seminar). With respect to D3, the pictures might have been taken on any device at any time and their link to the other documents D1, D2 or D4 merely relies on appellant's allegations.

Even though the pictures look similar, the link between D2 and D4 is also missing and cannot be unambiguously established. Similarly, the link between D1 and D4 is unclear as there is no mention in D1 of the machine AQS300 of D4.

In fact, the notice of opposition merely alleges that D1 to D4 refer to the same device, without giving any evidence, however, how these documents are actually interrelated. The opposition relies on allegations without even indicating how these allegations could be proven.

Consequently, further investigations would be needed for the respondent or the opposition division to clarify and understand the nature of evidence. That makes the opposition inadmissible.

1.9 The Board cannot share the respondent's view for the reasons given during the oral proceedings and recited below.

The decision T 597/07 (*supra*) does not refer to the "nature of evidence" but rather to the evidence as such. The sentence quoted under point 1.6 above is to be understood as that *the patentee and the opposition division are put in a position of understanding clearly:*

- *the nature of the objections and*
- *the evidence and*
- *arguments*

*in support*, i.e. meaning that the "nature" only relates to the objections, not to the evidence itself as argued by the respondent.

Furthermore, D1 (its translation D1a), D2, D3 and D4 (for its introductory part that has been translated and its pictures) are understandable documents, D1 and D4 being indisputable prior art documents as admitted by the respondent. What the evidence is alleged to be proving is explained by the appellant in the notice of opposition (see also point 1.5 above), in particular with respect to the sole alleged distinguishing feature of the characterising part of claim 1 over D1. This characterising part reads as follows:

"at least some of said upper log-receiving surfaces (16) or of said leading edge regions (18) comprise a plurality of projections projecting therefrom, said projections comprising an outermost contact region for contacting logs being transferred between said spaced locations, said contact regions being configured as a peak"

In the notice of opposition the appellant argued that this feature could be seen in the picture contained in D2, which was further alleged to be clarified by the photos of D3, alleged to have been taken on the same device as shown in D2. The same argument was brought forward regarding the identical picture in D4, relating to the allegedly same installation as discussed at the seminar (D2). The relationship between these documents is therefore sufficiently discussed.

When reading the notice of opposition, the nature of the objections (lack of novelty), the evidence (D1 to D4) and the arguments (interrelation between D1-D4) in support, i.e. the case the opponent tries to make, is therefore clearly understandable for the Board.

Whether the device of D1 was actually the same as presented at the seminar (D2) or was actually the same as discussed in D4, i.e. whether the appellant's statements in the notice of opposition are proven or not, does not relate to the admissibility of the opposition but rather to its substantive merit. The same applies to the question whether D2 is the complete document and whether the photos of D3 relate to the device of D2 or D4 as it was alleged.

An opposition can indeed be found admissible on the basis of the statements, documents or copies thereof indicated in/filed with the notice of opposition which, later in the opposition proceedings, may eventually be considered incomplete, insufficient or simply wrong.

This, however, does not put the admissibility of the opposition into question. It only relates to the strength of the case.

Doubting whether documents cited in the notice of opposition are actually what they are alleged to be, as in the present case by the respondent and the impugned decision, is an issue of merit of the opponent's case, not of its admissibility.

1.10 In view of the above, the Board considers that the notice of opposition meets the requirements of Rule 76(2)(c) EPC. Consequently, the opposition is admissible.

### **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

H. Meinders

Decision electronically authenticated