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**Datasheet for the decision  
of 17 September 2015**

**Case Number:** T 1254/11 - 3.4.02

**Application Number:** 02000191.3

**Publication Number:** 1225430

**IPC:** G01G19/393

**Language of the proceedings:** EN

**Title of invention:**  
Combination weighing apparatus

**Patent Proprietor:**  
ISHIDA CO., Ltd.

**Opponent:**  
Multipond Wägetechnik GmbH

**Headword:**

**Relevant legal provisions:**  
EPC 1973 Art. 19(2), 54, 112(1)(a)  
RPBA Art. 11, 13(1), 13(3)

**Keyword:**

Remittal to the department of first instance -  
special reasons for not remitting the case  
Referral to the Enlarged Board of Appeal - (no)  
Novelty - main request (no) -  
first and second auxiliary requests (no)  
Admissibility - third auxiliary request (no)  
Different apportionment of costs (no)

**Decisions cited:**

G 0005/91, R 0001/13, J 0005/81, T 0515/05, T 0990/06,  
T 0160/09

**Catchword:**

1. An opposition division enlarged to four members pursuant to Article 19(2) EPC 1973 can in principle be reduced again to three members. It is for the four-person panel to decide on the reduction. In this respect the board concurs with T 990/06. In deciding on the reduction, the opposition division consisting of four members must properly exercise its discretion. (See point 1.4)
2. The board assumes *arguendo* that the fact that no decision to enlarge nor a decision to reduce the opposition division was added to the publicly available file and the fact that the appointment of the new chairman could only be traced from the internal register of the EPO both constitute fundamental deficiencies of the proceedings before the opposition division.

However, different from the situation in T 990/06, it is possible to determine from the file that the division was lawfully enlarged and, at a later stage, lawfully reduced again. (See points 1.6 and 1.7)

The board considers that these circumstances constitute special reasons for not remitting the case within the meaning of Article 11 RPBA. The aforementioned fundamental deficiencies assumed *arguendo* are of a formal nature. They would, in the board's view, not justify substantially delaying the proceedings. (See point 1.9)



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Case Number: T 1254/11 - 3.4.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.02**  
**of 17 September 2015**

**Appellant:** ISHIDA CO., Ltd.  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 31 March 2011  
revoking European patent No. 1225430 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** B. Müller  
**Members:** A. Hornung  
F. Maaswinkel

## Summary of Facts and Submissions

I. The patentee appealed against the decision of the opposition division revoking European patent No. 1225430.

Opposition had been filed against the patent as a whole and based on the grounds of Article 100(a), together with Articles 54(1) and 56 EPC.

The opposition division held that the ground for opposition mentioned in Article 100(a) EPC, together with Article 54(1) EPC, prejudiced maintenance of the patent as granted. The patentee had not submitted any auxiliary claim request.

II. Oral proceedings before the board were held on 17 September 2015.

III. The patentee requested

1) to set aside the decision of the Opposition Division dated March 31, 2011 to revoke European patent EP 1 225 430 ("*the Patent*") and to remit the case to the Opposition Division by reason of fundamental deficiencies apparent in the first instance proceedings (Article 11 RPBA) ("*Primary Request*");

2) in case the request in item 1) is not granted, to refer the following questions to the Enlarged Board of Appeal ("*Alternate Request*"):

- i) May the composition of an Opposition Division be reduced again during pending opposition proceedings once it had been enlarged by a legally qualified examiner in accordance with Article 19(2) EPC?

ii) If the answer to question (i) is yes, who shall take a decision to set aside any preceding decision for enlarging an Opposition Division in accordance with Article 19(2) EPC?

iii) What kind of evidence is required to show that such a decision was taken properly?

iv) Is there any discretion of the Boards of Appeal, if doubts can be raised against the lawful composition of an Opposition Division, to remit the case to the Opposition Division or must the case be remitted in such cases?

3) in case the requests in items 1) or 2) are not granted, to set aside the aforementioned decision and to maintain the Patent as granted ("*Main request*");

4) if neither of the foregoing requests is granted, to set aside the aforementioned decision and

- to maintain the Patent on the basis of claims 1 to 12 as filed as an auxiliary request with the statement of grounds of appeal dated August 5, 2011 ("*Auxiliary Request I*"), or

- to maintain the Patent on the basis of claims 1 to 12 as enclosed to this letter ("*Auxiliary Request II*"), or

- to maintain the Patent on the basis of claims 1 to 12 as submitted during the oral proceedings ("*Auxiliary Request III*") (in this order).

5) to reject the request for apportionment of costs.

The respondent (opponent) requested

- to dismiss the appeal of the patentee,
- to order that the patentee bear the costs of the second-instance appeal proceedings,
- as a precaution, to remit the case to the department of first instance for hearing the witnesses.

IV. Independent claim 1 according to the patentee's main request reads as follows (labelling of features (a) to (f) added by the board and identical with the labelling in the decision under appeal):

"A combination weighing apparatus for combining and discharging articles, said combination weighing apparatus comprising:

- (a) a plurality of hoppers (4, 104; 5, 105) that hold the articles;
- (b) memory means (23) that stores said plurality of hoppers (4, 104; 5, 105) dividing them into a first group (104, 105) and a second group (4, 5);
- (c) specification means (31) for specifying a discharge from at least one hopper (105) in said first group based upon a predetermined criterion;
- (d) weighing means (10, 110) for weighing articles held in said hoppers (5, 105), said weighing means (10) being provided at least in said hoppers (5) in said second group;
- (e) selection means (32) for conducting a combination calculation using the weights of said hoppers of only said second group (4, 5) obtained by said weighing means (10), and selecting hoppers (5) based on the combination calculation such that a total weight of

said selected hoppers is within a predetermined weight range; and

- (f) discharge means (33, 6) for collecting and discharging the articles held in said hoppers (5) selected by said selection means (32) and the articles held in said at least one hopper (105) specified by said specification means (31)."

In the following, Auxiliary Request I, II and III are also referred to as first, second and third auxiliary request, respectively.

Claim 1 of patentee's first auxiliary request is identical to that of the main request except for feature (c) of the claim which reads:

- (c) specification means (31) for specifying a discharge from at least one hopper (105) in said first group based upon a predetermined criterion stored in said memory (23) and based on one of a random number signal, periodic conditions and ratio conditions.

Claim 1 of patentee's second auxiliary request is identical to that of the main request except for feature (c) of the claim which reads:

- (c) specification means (31) for specifying a discharge from at least one hopper (105) in said first group based upon a predetermined criterion stored in said memory (23) and based on periodic conditions.

Claim 1 of patentee's third auxiliary request is identical to that of the second auxiliary request except for a feature added at the end of the claim which reads:

wherein the periodic conditions assign the number of times that the at least one hopper (105) in said first group is discharged while the hoppers (5) in said second group are discharged a fixed number of times.

V. The following patent documents will be referred to in the present decision:

D1: US 4,678,046

D7: US 4,466,500 .

VI. In the decision under appeal it was considered that all the features of granted claim 1 were disclosed by document D1.

With the statement of grounds of appeal, the patentee filed new claims 1 to 12 of an auxiliary request (now labelled "Auxiliary Request I" or "first auxiliary request"). The patentee requested that the decision under appeal be set aside and the patent be maintained as granted, this being the main request, or maintained on the basis of the claims of the auxiliary request.

The patentee essentially argued that both features (c) and (e) of claim 1 of the main request as provided in the feature analysis of the decision under appeal were not disclosed in D1. Therefore, the finding of lack of novelty of the subject-matter of claim 1 over D1 was not justified. As to the auxiliary request, the "predetermined criterion" of feature (c) was expressly spelled out.

In its reply, the opponent requested that the appeal be dismissed. It contested the patentee's discussion of features (c) and (e) of claim 1 of the main request considering that both were disclosed in D1, reason why the subject-matter of claim 1 of the main request was not new. The subject-matter of claim 1 was also not new in relation to prior uses V1, V2



and V3, all relating to a certain combination weighing apparatus. As a precaution, the opponent asserted that the subject-matter of claim 1 did not involve an inventive step in relation to a combination of user manual V1 and D1 if, unexpectedly, the specification of a fractional target weight and the following comparison made in D1 were not considered to constitute a predetermined criterion.

In respect of claim 1 of the first auxiliary request, its subject-matter was not new because all of its features were disclosed in user manual V1. In addition, the subject-matter of claim 1 was not inventive in view of a combination of D1 and newly submitted patent document D7.

The opponent also introduced further prior use V4, being a combination weighing apparatus, together with user manual D8, and proposed a witness to be heard as to the circumstances surrounding the delivery and installation of the weighing apparatus and on its technical features.

VII. The board issued a communication accompanying the summons to oral proceedings. The preliminary opinion of the board indicated that it tended to share the opposition division's opinion. In relation to the first auxiliary request, the board raised doubts as to its admissibility under Article 12(4) of the Rules of Procedure of the Boards of Appeal ("RPBA", OJ EPO 2007, 536). The board noted that the appellant had made no attempt to avoid revocation of the patent in the first-instance proceedings. It should have filed the amended set of claims during those proceedings.

Apart from that, the claimed subject-matter appeared to still lack novelty in respect of D1. In addition, if the first auxiliary request were admitted, then the relevance of the prior uses relied on before the opposition division would have to be assessed by the board for the first time and

additional evidence filed by the opponent before the board, i.e. D7 and a fourth prior use V4 might have to be admitted, too.

VIII. With a letter of reply of 14 August 2015, the opponent requested that the appeal be dismissed because the main request was unfounded and the first auxiliary request was not admissible. In addition, it requested that the board order the patentee to bear the costs of the appeal proceedings. It argued that filing the first auxiliary request only at the appeal stage amounted to an abuse of procedure. As a precaution, the opponent requested oral proceedings and, as a further precaution, that the case be remitted to the opposition division to hear witness testimony.

IX. For its part, with a letter of reply of 12 August 2015, the patentee asserted that the decision under appeal was tainted by a substantial breach of procedural provisions of the EPC.

If the board did not concur with this view, then it was requested to refer certain related questions to the Enlarged Board of Appeal to ensure uniform application of the law under Art. 112(1)(a) EPC. These questions are set out above, under point III. 2), questions i) to iii).

If the board did not allow any of these requests, then the patentee maintained that the patent as granted met the requirements of novelty and inventive step. As a precaution, it was requested to admit the first auxiliary request on file into the proceedings and maintain the patent on that basis. The patentee also submitted claims of a second auxiliary request being a narrower version of the claim set according to the first auxiliary request. This request was filed in response to and taking into account the comments made in the board's communication. It should thus be admissible.

In the course of the oral proceedings before the board, the patentee added question iv) to the questions requested to be referred to the Enlarged Board of Appeal (see above, at point III.2). Late in the afternoon of the date on which oral proceedings were held, the patentee also filed claims of a third auxiliary request.

## **Reasons for the Decision**

1. Primary request: remittal under Article 11 RPBA

1.1 *The request*

In its reply of 12 August 2015 to the board's communication attached to the summons for oral proceedings (hereinafter referred to as "the reply"), the patentee for the first time in the present appeal proceedings asserted that the decision under appeal was tainted by a substantial breach of procedural provisions of the EPC. More specifically, the patentee was of the opinion that the lawful composition of the opposition division as required by Article 19(2) EPC was not ensured during the opposition proceedings which led to the decision under appeal. As a consequence, pursuant to Article 11 RPBA and following the findings in the decision in case T 990/06, in particular at points 2.4 and 3.2 of the Reasons, the case had to be remitted to the opposition division.

Article 11 RPBA reads as follows:

A Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

1.2 *The parties' submissions*

- The patentee

The patentee bases its request for remittal pursuant to Article 11 RPBA on the following facts (see point 2 of the reply):

A summons to attend oral proceedings before the opposition division to be held on 5 April 2011 was issued on 23 September 2010. The summons showed the names of a "1<sup>st</sup> Examiner", "2<sup>nd</sup> Examiner", "Chairman" and "Legally qualified member". The communication accompanying the summons stated at the beginning that "[t]he opposition division ... has been enlarged by a legally qualified examiner (Article 19(2) EPC)". The communication set forth that witnesses (whose testimony was) offered by the opponent would be heard in accordance with the enclosed order to take evidence. It appeared that the order was also signed by the aforementioned individuals. After the patentee, with a letter of 3 March 2011, had given notice that it would not attend the oral proceedings, the parties were informed with a fax of 24 March 2011 that the summons to attend oral proceedings was cancelled and the procedure would be continued in writing. The file contained a corresponding document referring to said faxed decision which showed the signatures of three examiners only. The signature of the legally qualified member was missing, and the signatures suggested that the chairman had been replaced.

With the decision of 31 March 2011 the parties were informed that the opposition division had decided to revoke the patent. The decision showed only the names of a chairman and a first and second examiner. The corresponding decision document (EPO Form 2339 (Sheet 1)) on file of 25 March 2011

appeared to have been signed by the same individuals as those who issued the decision to cancel the oral proceedings.

The decision under appeal indicated on page 1, at point 8 of the part "Facts and Submissions" that "[t]he enlargement of the division by a legally qualified examiner has been set aside on 22.03.2011 since no witness need to be heard anymore".

The file did not contain any document representing a decision to enlarge the opposition division with a legally qualified examiner. Moreover, the file neither contained any document representing a decision to reverse the enlargement. Nor did the file contain any document explaining the change of the chairman.

Therefore, the file did not allow verifying the lawful composition of the opposition division at any substantial point in time. Firstly, at the time of the summons, neither one of the summons, the communication accompanying the summons or the order to take evidence revealed any details on the composition of the opposition division going beyond the mentioning that the division had been enlarged. In particular, from these documents, and any other documents available at that time, it was not clear or verifiable when any decision to enlarge the opposition division had been taken and, if so, who had taken that decision.

Secondly, at some time after the summons had been issued, the opposition division apparently changed its composition in two regards, namely by replacing the chairman and by removing the legally qualified examiner. Again, there was no document on file which showed when this had happened and who had taken the corresponding decision. In particular, it remained a mystery who decided on setting aside the decision to enlarge

the opposition division if such reversal decision was admissible at all.

Lastly and most strikingly, if one were not to require a formal decision on the enlargement or the setting aside of the enlargement in the meaning of T 990/06, it remained impossible to verify whether the legally qualified examiner's removal had been lawful. At point 8 of the "Facts and Submissions" of the decision under appeal it was stated that the enlargement of the opposition division had been set aside on 22 March 2011 "since no witness need[ed] to be heard anymore". However, the decision under appeal had been signed by three examiners only. The patentee concludes therefrom: "Thus, the decision was apparently also taken by said three examiners only". Therefore, there was no evidence on file that on 22 March 2011 a panel comprising the four examiners forming the opposition division at that time had decided to set aside the enlargement. To the contrary, all documents in the file, which the EPO issued after the patentee had informed the opposition division on 3 March 2011 that it would not attend the oral proceedings showed at best the names of three technically qualified examiners. This made it doubtful whether the legally qualified examiner had been involved in the proceedings at all after the patentee's letter of 3 March 2011.

In the oral proceedings before the board the patentee added that the opposition division must have taken a decision on the merits on 22 March 2011, i.e. the date mentioned in the decision under appeal (at point 8 of the "Facts and Submissions") when the enlargement of the division was set aside "since no witness need[ed] to be heard anymore" (see *idem*). This means that the opposition division must have agreed that D1 sufficed as a basis for revocation of the patent, even though, in the summons to the hearing before the division, the division also invited witnesses, i.e. they were

not sure whether D1 would suffice. That meant that there was a discrepancy between the opinion of the four-person panel that took the decision to hear witnesses and the opinion of the three-person panel that cancelled the oral proceedings on 24 March 2011 and thereafter gave the decision of the opposition division, first on 25 March 2011, and then, with reasons mentioning the reduction of the opposition division, on 31 March 2011. This would add weight to the assumption that the decision of 22 March 2011 to reduce the opposition division was also taken only by three and not - as required - by four examiners including the legally qualified one. It was only on 25 March 2011 that it became clear that no witnesses should be heard, but the legally qualified examiner had been removed from the opposition division before that date. It was not clear for the patentee and the public who took the decision of 22 March 2011, whether the division was composed of the correct members or whether there was bias for some reason leading to the decision having been taken by three members only.

- The opponent

The opponent objected to a remittal. It argued, in particular, that it was lawful to reduce an enlarged opposition division once the purpose for enlargement had ceased to exist. This was due the efficiency rule ("economic principle"). If it had been forgotten to add a document to the European Patent Register, then this was a non-substantial procedural deficiency. But even if it were substantial, then there would be special reasons (within the meaning of Article 11 RPBA) not to remit the case to the department of first instance, i.e. the fact that remittal would lead to a substantial delay of the proceedings even though their outcome was clear. The rights of licensees who would be affected by a remittal should also be taken into account. In this context, the opponent relied on the decision in case T

515/05 where the board decided not to remit the case, because the arguments of the patentee had been taken into consideration by the opposition division, the patentee had expanded its line of reasoning before the board, and the patentee had given no specific reason why the case should be remitted, such as an intention to produce further evidence.

The replacement of a chairman did not have to be made by a decision in the respective case, and the reasons therefor did not need to be mentioned in the online register. The replacement, rather, was made in the framework of the "business distribution scheme".

The patentee, in not attending the oral proceedings before the opposition division, showed its lack of interest in the details of the composition of the division. The announcement that it would not attend the oral proceedings triggered their cancellation. Furthermore, the patentee, in its statement of grounds of appeal, raised no objections to the composition of the division. As a consequence, it was barred from objecting to the various compositions of the opposition division (the opponent, in this context, referred to the term "rügeloses Einlassen"). The patentee had raised the objection only after having received the unfavourable opinion of the board.

1.3 *Whether the patentee's objection relating to the composition of the opposition division can be dealt with in the present appeal proceedings*

The patentee maintains that this is a question to be examined *ex officio* and therefore can be brought up at any time during the proceedings.

The board, in principle, agrees with the patentee on this point. In European patent procedure there is no such legal concept as "rügeloses Einlassen", a term known in German



civil procedure and referring, in principle, to the loss of the right to a certain objection by participating in the debate, especially in a hearing, without raising that objection. The opponent has not provided facts and evidence according to which such a concept could be relied on under Article 125 EPC 1973. What is acknowledged in European patent procedure is the concept of abandonment. However, the mere fact that the patentee did not raise the objection relating to the composition of the opposition division before its submission of 12 August 2015, i.e. roughly one month before the oral proceedings before the board, cannot be considered to amount to the abandonment thereof.

Nevertheless, the board holds that Article 13(1) RPBA does apply to submissions made after the filing of the statement of grounds relating to matters that need to be examined *ex officio* given that such submissions are covered by the term "amendment to a party's case".

In the present case, the board admits the objection relating to the composition of the opposition division pursuant to Article 13(1) RPBA. The point having been raised about one month before oral proceedings the board considers that there was enough time both for the opponent and the board to deal with it, and the opponent in fact did make substantial submissions on the topic.

1.4 *Whether an enlarged opposition division can in principle be reduced again*

As can be seen from the summons for oral proceedings of 23 September 2010 and the enclosed order to take evidence, the opposition division originally composed of three technical examiners (chairman, primary and second examiner) was, as a matter of fact, enlarged by a legally qualified member. It is also clear that the decision to cancel the oral proceedings

of 24 March 2011 and the decision to revoke the patent (i.e. both the decision document of 25 March 2010 and the reasoned decision of 31 March 2010) were adopted by only three examiners, i.e. without the legally qualified member. It follows that the enlargement, as a matter of fact, must have been undone in between.

The patentee argued that there was no legal basis for reducing the four-examiner panel to three. Only the opposite case, i.e. the enlargement, was dealt with in the EPC, i.e. in its Article 19(2), fourth sentence.

The opponent said reduction was possible due to the efficiency rule ("economic principle").

The board, in the hearing, drew the patentee's attention to T 990/06 on which the patentee heavily relied in general, and in which the possibility of a reduction was taken for granted (see points 2.1 *in fine* and 2.4, first paragraph). The patentee answered that it did not rely on this particular point of the decision. The board also informed the parties about two decisions handed down by the General Court of the European Union (formerly referred to as Court of First Instance) in cases T-251/00 of 20 November 2002 and T-488/09 of 12 May 2011. In T-251/00, affirmed by T-488/09 (see point 106), it was held that

in accordance with a general principle of law that, in principle, a body which has power to adopt a particular legal measure also has power to abrogate or amend it by adopting an *actus contrarius*, unless such power is expressly conferred upon another body. (See point 130.)

In T-392/04 of 14 December 2006 the Court concluded from this principle that a decision could only be validly corrected by all members of a board of appeal (of OHIM) and not by the rapporteur alone (see point 53).

The patentee would prefer the Enlarged Board of Appeal to give an opinion on whether the principle also applied in European patent law.

The board considers that the answer is plain and that therefore no opinion of the Enlarged Board is required (see, in greater detail, below, at point 2.4). The board holds that the principle enunciated by the General Court in case T-251/00, also applies in European patent law, i.e. an opposition division enlarged to four members pursuant to Article 19(2) EPC 1973 can be reduced again to three members and it is for the four-person panel to decide on the reduction. In this respect the board concurs with T 990/06 (see points 2.1 *in fine* and 2.4, first paragraph). In deciding on the reduction, the opposition division consisting of four members must properly exercise its discretion. The reasons for these findings are as follows:

**First**, to the General Court, the principle quite obviously is basic so that it did not need to further explain it. The board concurs and considers that it is also a principle of procedural law generally recognised in the Contracting States to the EPC pursuant to Article 125 EPC 1973.

**Second**, the principle is required by the need for procedural efficiency following from various provisions of the EPC, notably Article 114(2). Procedural efficiency requires that, once the reason for enlargement, e.g., as in the case at hand, the hearing of witnesses, is considered to have ceased to exist, then no need is apparent for maintaining the enlargement based on this reason. The opponent was right to make this point. It should be added that where a four-person division delivered the decision, then a five-member appeal board needs to hear the case, instead of a board composed of three members; see Article 21(3)(b). This provision lends added weight to the efficiency criterion.

**Third,** the opposition division, in deciding on whether to reduce, has discretion and must use it properly.

It may be true that there may be situations in which the (sole) original reason for enlargement may have ceased to exist, but where, in the deliberations of the four members of the division made in the course of the proceedings, other reasons for enlargement may have arisen. In such a situation the division would need to maintain its enlarged composition.

Furthermore, as the patentee pointed out, there may be situations in which the division may not have been unanimous in its assessment of the issues surrounding the case. The legal examiner may have sided with the chairman, and thus a specific approach may have been followed which was in contrast to the view of the other two technical examiners. Where such is the case, one might consider that the four-person composition should also be upheld in order to avoid a situation in which the stance would arbitrarily be upended. However, the danger that such a decision to reduce would be taken in the four-person composition is unlikely, as the chairman and the legal member have the majority. This follows from the last sentence of Article 19(2) EPC 1973 according to which "[i]n the event of parity of votes, the vote of the Chairman of the [Opposition] Division shall be decisive".

1.5 *Whether the discretion to reduce the enlarged opposition division was properly exercised in the present case*

In the present case, different from what the patentee asserts, there is no indication of an improper exercise of discretion. The patentee's two theories developed in this respect are not persuasive:

- Re change of opinion of the opposition division

There is no indication on file of any change of position of the opposition division since issuance of the communication annexed to the summons for oral proceedings of 23 September 2010. In that communication, document D1 was already found to be novelty-destroying, that finding having been affirmed later in the decision under appeal. See point 1.2 of the communication where it was said that "[t]his feature [disclosed in D1] suffices to take away the novelty of claim 1...". It was again a measure of procedural efficiency to summon the witnesses in case that that view could not be maintained on the basis of any submissions made by the patentee in those proceedings or in any written submissions filed in preparation thereof.

The patentee, with the letter of 3 March 2011, had made additional submissions countering the division's position regarding the novelty-destroying character of D1. It had however also informed the division that it would not attend the oral proceedings. Thus it could not bring about a change of the position of the division in relation to novelty during the oral proceedings, their position having obviously been left unaffected by the submissions made in the aforementioned letter. Consequently, there was no need to hear the witnesses, and the oral proceedings could be cancelled.

In other words: the very patentee's conduct did away with the need to hear the witnesses. The corresponding decision by the division to cancel oral proceedings was therefore consistent with the division's previously expressed opinions. As no change of position of the division has become apparent, the patentee's surmise about such a change because of possibly divergent views within the enlarged division that might have led to the exclusion of the legal member has no basis in the facts, but, rather, turns things upside down.

● Re role of the chairman

The same conclusion applies to the patentee's theory regarding the decisive vote of the chairman in an enlarged opposition division. In the patentee's view, it might have happened that the decision to reduce was not taken by all four members, but only by three of them, and the two members outvoted the chairman. This might have had an influence on the outcome of the case, because, in a four-member opposition division, in case of parity, the chairman's vote tipped the balance.

The board considers such a scenario to be highly implausible. If the chairman had taken a view different from that of the two technical examiners, but in line with that of the legally qualified member, then the chairman and the legally qualified member would in all likelihood not have agreed to reduce the division.

1.6 *Whether the right body took the decision to reduce the opposition division from four to three examiners*

As found above, at point 1.4, an enlarged opposition division consisting of four members can be reduced again, and it must be the four-person panel that decides on the reduction.

The board is satisfied that this principle was complied with in the present case, more specifically that the opposition division was reduced on 22 March 2011, as stated at point 8 of the part "Facts and Submissions" of the decision under appeal. Point 8 literally reads as follows:

The enlargement of the division by a legally qualified examiner has been set aside on 22.03.2011 since no witness need to be heard anymore.

Point 8 does not indicate who took the decision, but absent any indication to the contrary, it must be assumed that the decision was adopted in a lawful manner, i.e. that the whole of the panel comprising four persons took it.

The members of the division are officials entitled to grant or refuse European patent applications, or to maintain or revoke European patents. It must therefore be considered to be within their capacity to also confirm specifics of the patent proceedings, such as the reduction of an opposition division from four to three members.

As long as there are no hints to the contrary, as in the present case, the division must be presumed to have acted lawfully. The patentee confirmed in the hearing that there were no such hints, but that it wanted to verify the decision to reduce in question. Whether the patentee has such a right will be discussed in the following section below.

1.7 *Whether the decisions pertaining to the composition of an opposition division need to be added to the public file at any essential point of the proceedings*

To support its request for remittal due to a fundamental deficiency of the proceedings before the opposition division pursuant to Article 11 RPBA, the patentee heavily relied on the decision in case T 990/06 (with the exception of the fact that the board took the legal possibility of a reduction of an enlarged division for granted; see point 2.1 *in fine*.)

At point 2.1 of this decision, the board indeed held that

Article 19(2) EPC [1973] contains clear instructions on how an opposition division, as a rule, has to be composed. Thus the parties know which decision-making body conducts, and takes the decision in a set of oral proceedings on the case. This makes it possible for the parties to scrutinise compliance with the provisions of Article 19(2) EPC [1973] as well as the impartiality of the members of this decision-making body pursuant to G 5/91 (OJ EPO 1992, 617). For this

reason it is *indispensable* that the *composition* of the opposition division is *clear and verifiable at any essential point in time* in the course of the opposition proceedings. For this reason it is furthermore indispensable that the procedure to enlarge the opposition division by a legally qualified member pursuant to Article 19(2) EPC [1973] has to be subject to scrutiny. The same applies as a matter of course to the possible retirement of a member from the division if the reason for his or her participation has *ceased to exist*. (Translation made by the board; emphasis added.)

The board in T 990/06 also held (at point 2.4) that where an opposition division was enlarged by a legally qualified member, the file would have to include a respective decision signed by the three members of the opposition division. If the enlargement had subsequently been set aside, then the file would need to also include the respective decision, signed by all four members. Furthermore, if there were doubts as to the lawful composition of the opposition division, then doubts would also arise as to the legality of the decision that it adopted (see point 2.5 of T 990/06).

In this respect, the present board would first like to point out that, in the cited decision in case G 5/91, the Enlarged Board held (at point 5) that no separate appeal lay in principle from a decision regarding the composition of the opposition division:

There is no legal basis under the EPC for any separate appeal against an order of a director of a department of the first instance such as an Opposition Division rejecting an objection to a member of the division on the ground of suspected partiality. However, the composition of the Opposition Division may be challenged on such a ground on appeal against the final decision of the division or against any interlocutory decision under Article 106(3) EPC [1973] allowing separate appeal. If not all the members of an Opposition Division should have fulfilled the requirement of impartiality, there has occurred a procedural violation as to the composition of the Opposition Division, normally rendering the decision void. It lies clearly within the competence of the Boards of Appeal to consider and decide on whether the requirements concerning the composition of an Opposition Division have been fulfilled.



If no separate appeal lies in principle from a decision regarding the composition of the opposition division, then questions arise in relation to the view expressed in T 990/06 that "it is indispensable that the composition of the opposition division is clear and verifiable *at any essential point in time* in the course of the opposition proceedings" (emphasis added). If necessary, the correctness of the composition has to be assessed once the proceedings before the opposition division have come to an end by virtue of the adoption of a final decision, i.e. by a board of appeal in the context of the examination of that decision under appeal.

To show a more general contrast to T 990/06, the board, during the oral proceedings, handed over a copy of the decision in case T 160/09 to the parties. In point 12.5 of that decision it is said:

The board therefore concludes that the patentee has *failed to establish a transparency principle which would, according to Article 125 EPC 1973, require the EPO to publish the appointment procedure of examiners*. The board also finds that the patentee has not established that the replacement of the second examiner in the present case infringed on its right to be heard or constituted a fundamental procedural defect for other reasons. (Emphasis added.)

For the sake of completeness, the board adds that the facts underlying the decision in case T 990/06 differ significantly from those in the case at hand. In that case there was, in particular, a discrepancy between internal documents and those sent to the parties.

Against the backdrop of the above case-law, the board, in the present case, considers it appropriate to leave the question of whether the decisions pertaining to the composition of an opposition division need to be added to the public file at any essential point of the proceedings undecided. This is because, in the present case, the board has no doubt that

both the decision to enlarge the opposition division and to reduce it again at a later stage were each indeed lawfully adopted at proper points in time. This finding will prove to be sufficient for the board's decision on whether or not to remit the case under Article 11 RPBA. See below, at point 1.9.

As to the enlargement of the division preceding the summons to oral proceedings before the opposition division, there was not much debate during the oral proceedings before the board, with the patentee focusing on the reduction of the division. The board, in respect of the enlargement, relies on the correctness of the statement made at the beginning of the communication (dated 21 September 2010) accompanying the summons of 23 September 2010 that "[t]he opposition division ... has been enlarged by a legally qualified examiner (Article 19(2) EPC)" (as quoted by the patentee; see above, at point 2.1, second paragraph). This statement was later affirmed in point 5 of the part "Facts and Submissions" of the decision under appeal reading in pertinent part:

Oral proceedings are appointed and scheduled for April 5 and 6, 2011. The opposition division is enlarged by a legally qualified examiner as witnesses need to be heard in order to prove the alleged prior uses (V1, V3).

In line with the statement in the communication just quoted, as correctly mentioned by the patentee (see above, at point 1.2), both the summons for oral proceedings before the opposition division of 23 September 2010 and the accompanying order to take evidence were signed by four members of the opposition division.

As to the core of the debate, i.e. the reduction of the enlarged opposition division, the board is convinced of the veracity of point 8 of the part "Facts and Submissions" of the decision under appeal affirming that the decision to

reduce the division was indeed lawfully taken. See already above, at point 1.6.

1.8 *The replacement of the chairman*

The patentee also criticised the fact that the file contained no document explaining the change of the chairman. But the patentee did not cast doubt in principle on the possibility to replace a chairman. The board considers that this is possible and refers in this respect to the decision in case T 160/09 (at point 11) dealing with the replacement of members of an examining or opposition division, including the chairman:

The appointment and possible replacement of members of the examining (and opposition) divisions are amongst the "necessary steps" which by Article 10(2)(a) EPC 1973 the president is empowered to take to ensure the functioning of the European patent office. The president may delegate these powers under Article 10(2)(i) EPC 1973. In this respect, Rule 12(1) EPC 1973 provides that examining divisions are grouped together administratively so as to form directorates. In the board's view this implies that the president delegates decisions about administrative matters regarding the examining divisions, including the appointment and replacement of members, to the directorates.

In the present board's opinion, the latter implication, by analogy, applies to opposition divisions.

As to the question of who acted as chairman at the essential points in time, the board notes the following: it ensues from the file that the new chairman acted on 24 March 2011 when the oral proceedings were cancelled, the signature (without the name in block letters) corresponding with the signature on the decision document of 25 March 2011 to which the name was added in block letters. The same new chairman was also mentioned in the reasoned decision of 31 March 2011. The new chairman was appointed on 23 February 2011. The rapporteur informed the parties during the oral proceedings that this information was found in the internal EPO register. The board

deduces therefrom that the new chairman also took part in the decision to reduce the enlarged opposition division on 22 March 2011, i.e. two days before the oral proceedings were cancelled.

In the light of the foregoing the board has no doubt as to the correctness of the replacement of the chairman. After the information on the date of replacement had been provided by the board during the oral proceedings, the patentee did not make additional submissions on this point.

- 1.9 *The consequence: whether to remit or whether special reasons present themselves for not remitting the case to the opposition division*

Pursuant to Article 11 RPBA, already quoted above, a "board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise".

In case T 990/06, the board, having found it to be impossible to determine the composition of the opposition division at any essential point in time, remitted the case. In doing so, it considered, but rejected the other party's objection that remittal would substantially delay the proceedings. The fundamental deficiency prevented it from continuing the proceedings. (See point 3.2. of T 990/06)

Conversely, pursuant to T 515/05, cited by the opponent, even though a fundamental deficiency had become apparent, the board still exercised its discretion in not remitting the case. The board (at point 4.4) held that denying the opponent (appellant) the opportunity during the oral proceedings to comment on a ground of opposition (Article 100(b) EPC), albeit brought into the case by the Opposition Division

itself, constituted a substantial procedural violation (Article 113(1) EPC). The reasons for still not remitting the case were as follows:

5.2 Although according to Article 10 of the RPBoA [now Article 11] a Board should usually remit a case to the Division at first instance if a fundamental deficiency arises, remittal is not an automatic consequence and if special circumstances exist the Board may decide otherwise.

In the present case, the Board considers that remittal is not appropriate, essentially because (i) the arguments of the Appellant concerning Article 100(b) EPC... were taken into account in the decision under appeal ... by the Opposition Division on [sic] its own motion (these arguments de facto being those produced by the Opposition Division itself when introducing this new ground ...), (ii) the Appellant in the meantime has had the opportunity, and indeed availed itself of it, to expand its argumentation in this respect before the Board, and (iii) no concrete reason was given by the Appellant for the necessity for remittal (e.g. no intention was declared for the production of further evidence which would need more time for preparation). In the circumstances a remittal to the Opposition Division would only unnecessarily delay the proceedings.

The board leaves the question open whether T 515/05, whose conditions might be met in the present case, should be followed.

The board assumes *arguendo*, and favourably for the patentee, that the fact that no decision to enlarge nor a decision to reduce the opposition division was added to the publicly available file and the fact that the appointment of the new chairman could only be traced from the internal register of the EPO both constitute fundamental deficiencies of the proceedings before the opposition division.

However, different from the situation in T 990/06, it is possible to determine from the file that the division was lawfully enlarged and, at a later stage, lawfully reduced again. This follows especially from points 5 and 8 of the part "Facts and Submissions" of the decision under appeal, as explained above, at points 1.6 and 1.7.

The board considers that, independent of the considerations in T 515/05 just mentioned, these circumstances constitute special reasons for not remitting the case within the meaning of Article 11 RPBA. The aforementioned fundamental deficiencies assumed *arguendo* in favour of the patentee are of a formal nature. They would, in the board's view, not justify substantially delaying the already lengthy proceedings (the filing date of the patent application is 10 January 2002, and the date of publication and mention of the grant of the patent is 30 May 2007).

2. Alternate request

2.1 If the board did not concur with the patentee's view regarding remittal under Article 11 RPBA, then it was requested to refer certain related questions to the Enlarged Board of Appeal to ensure uniform application of the law and also to deal with a point of law of fundamental importance pursuant to Article 112(1)(a) EPC. For the sake of convenience, these questions are repeated below:

*(i) May the composition of an Opposition Division be reduced again during pending opposition proceedings once it had been enlarged by a legally qualified examiner in accordance with Article 19(2) EPC?*

(ii) If the answer to question (i) is yes, who shall take a decision to set aside any preceding decision for enlarging an Opposition Division in accordance with Article 19(2) EPC?

(iii) What kind of evidence is required to show that such a decision was taken properly?

(iv) Is there any discretion of the Boards of Appeal, if doubts can be raised against the lawful composition of an Opposition Division, to remit the case to the Opposition Division or must the case be remitted in such cases?

2.2 According to Article 112(1) (a) EPC 1973, a board of appeal shall refer any question to the Enlarged Board of Appeal if it considers that a decision is required to ensure uniform

application of the law or if a point of law of fundamental importance arises.

2.3 In the present case the board does not consider that, for the purposes of deciding on the present case, a decision is required on any of the above questions either to ensure uniform application of the law or because a point of law of fundamental importance has arisen.

2.4 A question involving an important point of law need not be referred to the Enlarged Board of Appeal if the board of appeal hearing the case considers itself able to answer it beyond any doubt; see J 5/81 (OJ EPO 1982, 155), headnote 2).

As the board considers this to be the case in relation to questions i) to iii), an answer by the Enlarged Board of Appeal to these questions is not required.

Question (i) was answered in the affirmative (see above, at point 1.4), question (ii) was answered in the sense that the opposition division consisting of four members must adopt the decision (see *idem*). The patentee has not submitted that there was divergent case-law on questions i) to iii). On the contrary, the board in the decision in case T 990/06 on which the patentee heavily relied arrived at the same conclusion regarding questions i) and ii) as the board deciding on the present case.

As to question (iii), no general answer as to the evidence required is necessary, because it is clear to the board that in the present case the statement in point 8 of the part "Facts and Submissions" of the decision under appeal is credible. The board is satisfied that the decision to reduce the opposition division was taken properly as to substance. The question of whether, for purposes of transparency, decisions on enlargement and reduction of an opposition

division would have to be added to the public file at any essential point in time is being left open. In the light of the foregoing, no referral is required on the question of evidence necessary in general to show that a decision to reduce an opposition division was taken properly .

The board adds *obiter* that it sees no legal obstacles for the EPO to systematically add decisions on enlargement of opposition divisions by legally qualified members to the public file. The same would apply if subsequently an opposition division were reduced to a composition of three members.

2.5 Question (iv) is not relevant, and consequently a decision by the Enlarged Board is not required, because no doubts could successfully be raised in the case at hand; see the answer to point (iii). As a consequence, the more general question of whether a specific category of situations could at all arise in which the discretion afforded by Article 11 RPBA would exceptionally be limited to one sole correct decision, i.e. the decision to remit, and if so, whether the category mentioned by the patentee, i.e. the presence of doubts as to the lawful composition of an opposition division, would qualify, is moot.

3. Main (claim) request - Novelty

The subject-matter of claim 1 is anticipated by the device of D1 (Article 54(1) and (2) EPC 1973).

3.1 D1 discloses, with reference to figures 1 and 3, a combination weighing apparatus [4] comprising

(a) a plurality of hoppers [*scales 17a, 17b; storage hoppers 22a, 22b*] that hold articles [*products A, B*],



- (b) memory means *[computer 19]* that stores said plurality of hoppers dividing them into a first group *[scales 17b, hoppers 22b - which, in D1, are referred to as the second group and contain product B; see D1, column 3, lines 17 to 19]* and a second group *[scales 17a, hoppers 17a - which, in D1, are referred to as the first group and contain product A],*
- (c) specification means *[computer 19]* for specifying a discharge from at least one hopper in the first group *[hopper 22b]* based upon a predetermined criterion *[fractional target weight for product B],*
- (d) weighing means *[scales 17a]* provided at least in the hoppers of the second group *[hoppers 22a],*
- (e) selection means *[computer 19]* for conducting a combination calculation using the weights of the hoppers of only the second group *[hoppers 22a],* and selecting hoppers *[hoppers 22a]* such that a total weight of the selected hoppers *[hoppers 22a]* is within a predetermined weight range,
- (f) discharge means *[common discharge chute 8]* for collecting and discharging the articles held in the hoppers *[hoppers 22a]* selected by the selection means and the articles hold in the at least one hopper *[hopper 22b]* specified by the specification means.

Concerning the specification means of feature (c), it is to be noted that in D1, hoppers 22b are selected by the computer according to the criterion that their weight is equal to or greater than the fractional target weight for product B (see D1, column 4, lines 57 to 62). This criterion is predetermined since the target weight for

product B is based upon data entered by an operator at the beginning of the process (see D1, column 4, lines 25 to 31 and lines 53 to 57).

Concerning the selection means of feature (e), it is to be noted that, in D1, scales 17a and the corresponding hoppers 22a are selected which contain a combined quantity of product A nearest the fractional target weight for the product A (see D1, column 4, lines 35 to 38), such that the combined quantity is within a corresponding tolerance range (see D1, column 4, lines 45 to 48). The weight range is predetermined in the sense that it is defined by the fractional target weight for the product A, entered into the computer by an operator at the beginning of the process (see D1, column 4, lines 25 to 31), in combination with a corresponding tolerance range. In other words, the hoppers 22a in D1, as in claim 1, are selected such that their total weight is within a predetermined weight range.

Furthermore, concerning the selection means of feature (e), it is to be noted that D1, column 4, lines 35 to 38, discloses that "the computer searches for a combination of the scales of the first group 17a", which means that weights of the hoppers of the second group 17b are not used in the calculation of the best combination of the scales of the first group 17a. In other words, the calculation combination in D1, as in claim 1, uses the weights of hoppers of only the first group 17a (the designations "first" and "second" group in D1 are reversed with respect to claim 1).

It follows that D1 discloses all the features of claim 1.

*Counter-arguments from the patentee*

3.2 In the patentee's view, D1 does not disclose features (c) and (e).

3.2.1 The patentee states that D1 and claim 1 define two completely different devices having completely different aims and that, therefore, the apparatus of D1 cannot anticipate the claimed subject-matter. For instance, D1 would not infringe the patent in a fictitious infringement case. More particularly, in D1, two products A and B are always mixed together in the same package, the criterion being that the total weight of the package containing the two products fulfils a total weight target. In claim 1, however, the focus is on one single, main product whose weight must fulfil a weight target, a second product being merely added as a bonus item (or "special article") to this main product on the basis of a predetermined, weight-independent criterion. The aim of the invention is to avoid a separate automatic loader which is used in the prior art for adding the bonus item, as described in paragraphs [0003] and [0004] of the patent. This aim is clearly defined in claim 1. Features (c) and (e) of claim 1 ensure that this aim is obtained since two clearly different terms, i.e. "specification means" and "selection means", are used to define features (c) and (e), respectively, wherein only the "selection means" of feature (e) conducts a combination calculation using weights of only one product.

The board, however, agrees with the opponent that feature (c) of claim 1 is not limited to a predetermined criterion which would exclude weight dependent aspects. Therefore, the criterion in D1, i.e. the fractional target weight for the product B, falls under the wording of claim 1. The board also agrees with the opponent that feature (e) does not exclude that, in addition to the hoppers 22a containing product A being selected through combination weighing, the hoppers 22b containing product B may also be selected through subsequent combination weighing. Whether the description of the patent

as a whole defines a device which differs from that of D1 is not relevant for deciding on novelty of the claimed subject-matter, as long as the device of D1 falls under the wording of present claim 1.

- 3.2.2 Concerning feature (c), the patentee is of the view that "the predetermined criterion" must be independent of any previously measured weight value. Otherwise its interpretation would be "disproportionally based on a philological understanding of the words of the claim and not take into account the technical sense of the whole disclosure of the patent", contrary to the requirement of Article 69(1) EPC which provides that the description and drawings shall be used to interpret the claims. According to paragraph [0050] and dependent claims 6 to 8 of the patent, "predetermined criterion" means that the discharge is based on either "periodic, random or ratio conditions". The continuous discharge criterion is not covered by the expression "predetermined criterion" (see paragraphs [0029] and [0030]).

The board cannot agree with this view since the claimed subject-matter is clearly defined by the wording of claim 1 defining, on the one hand, the existence of a predetermined criterion but, on the other hand, leaving open the precise nature of the criterion. The additional information disclosed in the patent as a whole defines further limitations of the claimed feature (c) which are not automatically present in claim 1. The description also allows for a broader interpretation of the expression "predetermined criterion" than meaning exclusively "periodic, random or ratio conditions": see paragraphs [0061] and [0065] disclosing the additional "continuous discharge" mode and paragraph [0066] disclosing that "the discharge conditions for the two types of large candy balls, periodic conditions, random conditions, ratio conditions *and the like* can also be established". Paragraphs [0029] to [0030] disclose a further embodiment

comprising switching means that switches between the predetermined criteria and the continuous discharge criteria.

- 3.2.3 Concerning feature (e), the patentee objects that D1 did not disclose a "predetermined weight range" within which the total weight of the selected hoppers must fall. In D1, it would be sufficient that the total weight for product A were "nearest" to the fractional target weight for the product A (column 4, lines 35 to 38). Any deviation from the target weight for product A would be compensated by the weight of product B. In the patent, however, such a compensation by the bonus item was not possible, this fact implying that the combined weight of the selected hoppers in claim 1 had to be within a predetermined weight range.

Even though it is correct that D1 discloses that the measured weight for product A should be nearest to the target weight, the patentee's argument is not found convincing by the board because D1 further discloses that the search process for the adequate hoppers containing product A may be carried out by using a large tolerance. This large tolerance surrounds the target weight in the sense of a "predetermined weight range" (see D1, column 4, lines 38 to 48).

- 3.2.4 In conclusion, the patentee's arguments in favour of novelty of the claimed subject-matter are not found to be convincing by the board.

#### 4. First and second auxiliary (claim) requests

##### 4.1 Admissibility

There is no need to decide on the question whether the first and second auxiliary requests are admissible under Articles 12(4), 13(1) and 13(3) RPBA, since the claimed subject-matter of these two requests is found to be not novel by the board.

## 4.2 Novelty

The subject-matter of claim 1 of the first and second auxiliary requests is anticipated by the device of D1 (Article 54(1) and (2) EPC 1973).

Claim 1 of the first auxiliary request defines three alternative apparatuses wherein the predetermined criterion is based on one of a random number signal, periodic conditions and ratio conditions, respectively. Claim 1 of the second auxiliary request defines an apparatus which is identical to one of the alternative apparatuses defined in claim 1 of the first auxiliary request, namely, wherein the predetermined criterion is based on periodic conditions. In the following, it will be shown that D1 discloses at least the apparatus of claim 1 of the first auxiliary request corresponding to the alternative wherein the predetermined criterion is based on periodic conditions and, thus, also anticipates the subject-matter of claim 1 of the second auxiliary request.

- 4.2.1 D1 discloses a combination weighing apparatus [4] comprising all the features of claim 1 of the main request (see point 3.1 above).

In addition, the specification means of D1 use a predetermined criterion which is stored in the memory and which is based on periodic conditions [*discharge from hoppers 22b occurs at approximately 0.33 second intervals; see D1, column 6, lines 63 to 65*].

Further to the arguments given in point 3.1 above, the board notes that the "predetermined criterion" in D1 is stored in the computer memory in the sense that it results from a calculation step carried out by the computer, the calculation

results necessarily being stored in the computer during the calculation steps (see D1, column 4, lines 53 to 57). According to an embodiment of D1 (column 6, lines 15 to 21 and column 8, lines 6 to 53), hoppers 22b, having been specified on the basis of a "predetermined criterion", are periodically discharged at 0.33 second interval (see D1, column 8, lines 30 to 32; see also the timing chart of figure 6 showing the periodic "release time of product B" 1b, 2b, 3b, 4b). In view of the vague expressions "based upon" and "based on", used in claim 1, the question of how the "predetermined criterion" and the "periodic conditions" are exactly to be used in the specification process of the hoppers is left open.

It follows that D1 discloses the subject-matter of both the first and the second auxiliary request.

*Counter-arguments from the patentee*

4.2.2 The patentee argues that the timing chart shown in figure 6 of D1 deals with spreading out the discharge of articles A and B from the hoppers in order to avoid clogging of the nozzle portion. The clogging may only appear after the hoppers have been specified by the specification means. The periodic conditions, i.e. the 0.33 second interval, disclosed in D1 relate to the discharge means and not to the specification means. In contrast thereto, claim 1 comprises specification means defined by feature (c) of claim 1 which are distinct from the discharge means defined by feature (f) of claim 1. Feature (c) specifies if a hopper will be discharged or not, whereas feature (f) defines that articles are collected and discharged from the hoppers. The periodic conditions in claim 1 relate only to the specification means and not to the discharge means, which is contrary to the disclosure of D1.

The board is not convinced by this argument. Even though in D1 the hoppers 22b to be discharged are identified in a process step preceding their discharge, specifying the timing sequence at which the identified hoppers 22b will be effectively discharged forms an integral part of the tasks of the specification means as defined in claim 1. The wording used in claim 1 for defining the specification means, for instance the expression "based upon/on", does not exclude that the periodic conditions may apply to the dump timing of the hoppers.

- 4.2.3 The patentee further argued that claim 1 defines a periodic discharge of *one* hopper in the sense that the same hopper is periodically discharged, whereas D1 defines a periodic discharge of *several* hoppers in the sense that a periodic time interval occurs between the discharge of one hopper (e.g. hopper 1b) and the discharge of the next hopper (e.g. hopper 2b).

The board is also not convinced by this argument since the wording of claim 1 does not limit the claimed subject-matter to periodic conditions applying only to the same hopper. Indeed, feature (c) defines "a discharge from at least one hopper", which covers more than a single hopper, and uses the expressions "based upon a predetermined criterion" and "based on periodic conditions" which leave open how the periodic conditions are effectively used in defining the discharge of the hoppers. Feature (f) defines "discharge means for collecting and discharging [...] articles held in said at least one hopper specified by said specification means", thereby covering the discharge of more than hopper.

5. Third auxiliary (claim) request - Admissibility

- 5.1 Following the opponent's request not to admit the third auxiliary request into the proceedings and taking into



account the arguments of both parties, the board decided not to admit this request into the proceedings under Articles 13(1) and (3) RPBA for the following reasons:

5.1.1 One of the well established criteria for assessing the admittance of amended claims during appeal proceedings is whether the amendments are *prima facie* clearly allowable (see, for instance, the decisions cited in the Case Law of the Boards of Appeal, chapter IV.E.4.4.2). The present amendment does not fulfil this criterion since it appears to infringe the requirements of at least Articles 123(2) and 84 EPC 1973 (see points 5.1.2 and 5.1.3 below).

5.1.2 Article 123(2) EPC

It would appear that claim 1 contains subject-matter which extends beyond the content of the application as filed, contrary to the requirement of Article 123(2) EPC.

According to the patentee, the amendment is based on the two following passages in the application as originally filed, either in combination or taken individually: page 5, lines 17 to 18; page 10, lines 6 to 8.

(a) The board agrees with the opponent that there appears to be no basis on page 10, lines 6 to 8, nor elsewhere in the application as filed, for the first portion of the amended feature, i.e. "periodic conditions assign the number of times that the at least one hopper (105) in said first group is discharged", since page 10, lines 6 to 8 as originally filed reads "periodic conditions that assign the number of times that each article is discharged by the discharge routine". It is obscure where the basis is in the application as originally filed for the replacement of the expression "each article" by the expression "the at least one

hopper in said first group". The patentee did not indicate a passage in the application as originally filed showing that the two expressions are equivalent, nor did the board find evidence for such an interpretation of the two expressions.

- (b) The final portion of the amended feature, i.e. "while the hoppers (5) in said second group are discharged a fixed number of times", is originally disclosed on page 5, lines 17 to 18 in combination with the feature that hoppers are specified based upon "periodic conditions such as a fixed interval of space, a fixed interval of time, and the like" (page 5, lines 18 to 20). Since the amended feature in claim 1 comprises only a portion of the general teaching disclosed in the application as filed, it would appear that the amended feature of claim 1 represents an unallowable intermediate generalization. Moreover, claim 1 refers to "the at least one hopper in said first group [being] discharged", whereas, on page 5, lines 17 to 22, reference is made to "the hoppers in the first group". No clear basis can be seen for the generalized feature in claim 1 including the case of one single hopper. It is to be noted that the disclosure of the specific numerical example on page 5, lines 20 to 21 does also not seem to represent a sufficient basis for the generalized feature of claim 1.

### 5.1.3 Article 84 EPC 1973

According to the amended feature, the periodic conditions assign the number of times that the at least one hopper (105) in said first group is discharged. It seems to be unclear from the wording whether the number provided by the periodic conditions is the number of times that each single hopper is

discharged or the number of times that a plurality of hoppers is discharged (Article 84 EPC).

5.1.4 The third auxiliary request was filed at a very late stage of the proceedings, namely on the day of the oral proceedings before the board and close to its end.

5.1.5 The new feature of claim 1 was completely taken from the description. Such type of an amendment is potentially complex since (i) it may open, as it did in the present case, the debate about the compliance of the amendment with respect to the basic requirements of Article 123(2) EPC and Article 84 EPC 1973 and (ii) it defines subject-matter which was not previously claimed and, therefore, may require an additional search and substantive examination to be restarted.

5.1.6 In the case of a new request with amended claims, one well-established criterion for deciding on its admissibility under Article 13(1) RPBA is whether the claims are likely to overcome the objection or objections in response to which the request has been filed [see R 1/13, reasons 16.2]. Even though in the present case no final decision on novelty had to be taken by the board, the board notes that, during the debate about novelty which took place during the oral proceedings before the board, at least the opponent was of the view that amended claim 1 of the third auxiliary request still lacked novelty with respect to at least D1, but also with respect to the prior-use documents filed during the first instance opposition proceedings. Therefore, this criterion is not suitable to support admittance of the third auxiliary request into the proceedings.

5.1.7 If the third auxiliary request were admitted into the proceedings, and if it were novel over D1, remittal for further prosecution, including the hearing of witnesses in relationship with the allegedly relevant prior uses filed by

the opponent during the first instance proceedings, might become necessary. The remittal would substantially increase the length of the opposition proceedings and go against procedural economy. This is not desirable in view of the current state of the proceedings and also not in view of the patentee's course of action during the first instance opposition proceedings to neither file amendments to overcome the novelty objection with respect to D1 already then at stake, nor to attend the oral proceedings to orally defend its patent.

- 5.1.8 For the above reasons, the board decided not to admit the third auxiliary request into the proceedings.

*Counter-arguments from the patentee*

- 5.2 The patentee argued in favour of admitting the third auxiliary request as follows:

- 5.2.1 The board drew the parties' attention to figure 6 of D1 only late in the afternoon of the date on which oral proceedings were held. Filing the third auxiliary request is a direct response to the subsequent novelty objection raised by the opponent.

The board acknowledges that the novelty objection based on figure 6 of D1 arose only late in the afternoon of the oral proceedings and that, therefore, there appears to be a sound reason to file an amended claim with a view to overcoming the newly raised objection. Actually, that is what the patentee did after having received the time it requested to study the new situation and to prepare a new request. However, the fact alone that the new novelty objection arose only at the end of oral proceedings does not outweigh the reasons given above for not admitting third auxiliary request, whereby the board follows the view given in the decision R 1/13, reasons 13.3.

Moreover, the board notes that document D1 was well known to the patentee since D1 was considered throughout the whole opposition proceedings as being a highly, if not the most, relevant document, the patent being revoked by the opposition division on the grounds of lack of novelty with respect to the disclosure of D1.

- 5.2.2 The patentee submitted that the two passages of the patent application as originally filed, cited above, either in combination or taken separately, represented a clear basis for the amendment of claim 1. It was clear from the application as a whole that each hopper contained articles and that, therefore, the expression "each article" on page 10, line 7 could be replaced by the expression "the at least one hopper in said first group". It was also clear from the disclosure as a whole or from the wording of claim 1 as originally filed that the first group of hoppers may be either a single hopper or a plurality of hoppers.

The board cannot follow this argument (see also point 5.1.2 above). In the passage on page 5, lines 17 to 24, there is no disclosure of a general teaching according to which the "periodic conditions assign the number of times that the hoppers in the first group are discharged". In contrast, this paragraph actually teaches periodic conditions being fixed numbers of a very specific nature, such as an interval of space or an interval of time. In the passage on page 10, lines 5 to 12, only the expression "each article" is mentioned in connection with "a number of times" and no link is made with a hopper or a plurality of hoppers belonging to a certain group.

- 5.3 In the light of the foregoing, the board decided not to admit the third auxiliary request into the proceedings.

6. The opponent's request that the patentee bear the costs of the appeal proceedings

6.1 The facts

In its reply to the board's communication attached to the summons for oral proceedings, the opponent requested that the patentee bear the costs of the appeal proceedings. The patentee had filed Auxiliary Request 1 together with the statement of grounds of appeal only. But it had filed no auxiliary request at all in the proceedings before the opposition division even though the communication attached to the summons for the oral proceedings before the opposition division was unfavourable as to the main and sole request and would thus have suggested filing an auxiliary request. Furthermore, the patentee did not attend those oral proceedings.

The opponent was of the opinion that the late filing of Auxiliary Request 1 did not comply with the principle of fairness and amounted to an abuse of the procedure in the present case, because in respect of Auxiliary Request I witnesses would have to be summoned once more and the opponent would in addition lose one instance for dealing with the pertinent issues. Had the patentee made its defence in a procedurally efficient way before the department of first instance, then the relevant questions could have been answered at that stage.

In the oral proceedings the patentee objected to the request for apportionment of costs. It argued that the opponent's submissions regarding the chances of success of the main request before the opposition division were not true. Furthermore, the principle of fairness was not infringed because claim 1 of Auxiliary Request 1 comprised a combination of features of certain granted claims. Finally,

in relation to a possible award of costs, the fact should be considered that the opponent was accompanied by witnesses even though they were not summoned.

## 6.2 Analysis

Pursuant to Article 104(1) EPC, "[e]ach party to the opposition proceedings shall bear the costs it has incurred, unless the Opposition Division, for reasons of equity, orders ... a different apportionment of costs." According to Article 16(1) RPBA, the board may, subject to Article 104(1) EPC, "on request order a party to pay some or all of another party's costs which shall, without limiting the Board's discretion, include those incurred by any (a) amendment pursuant to Article 13 [RPBA] to a party's case as filed pursuant to Article 12, paragraph 1".

The wording of Article 104(1) EPC makes it clear that, as a rule, each party bears its own costs. In the present case, the board has found no reasons of equity suggesting a departure from this rule. It might have been expedient to file the first auxiliary request before the opposition division for the reasons mentioned by the opponent. However, the board was in a position to deal with the substance of this request, whose admittance it left open, during the oral proceedings. No witnesses needed to be heard. This also applies to the second auxiliary request. The third auxiliary request was not admitted. Finally, the oral proceedings could be brought to an end by a decision on the date appointed for those proceedings. The patentee could in any case not have been criticised for defending its main request in oral proceedings before the board. It is furthermore not uncommon that a patentee files an auxiliary request even during oral proceedings, as in the case at hand, in reaction to the development of those proceedings, and this request may or may not be admitted under the provisions of Articles 13(1) and

(3) RPBA. Even in case of non-admittance, as in relation to the third auxiliary request in the case at hand, a discussion on admittance must take place.

All things considered, there was no causal connection between the patentee's conduct, in particular before the opposition division, and the need for the oral proceedings the way they were held. The patentee's conduct therefore cannot be considered to infringe the principle of fairness or even amount to an abuse of procedure. As a consequence, the board does not consider it to be appropriate to order a different apportionment of costs for reasons of equity.

## **Order**

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

1. The request to remit the case to the department of first instance pursuant to Article 11 RPBA is refused.
2. The request for referral to the Enlarged Board of Appeal is refused.
3. The appeal is also dismissed for the remainder.
4. The request for apportionment of costs is refused.



The Registrar:

The Chairman:



M. Kiehl

B. Müller

Decision electronically authenticated