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**Datasheet for the decision
of 21 June 2016**

Case Number: T 2067/12 - 3.3.09

Application Number: 06100727.4

Publication Number: 1683423

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A23L3/3589

Language of the proceedings: EN

Title of invention:
Brine device

Patent Proprietor:
CFS Bakel B.V.

Opponent:
Inject Star Pökemaschinen Gesellschaft m.b.H

Headword:

Relevant legal provisions:
EPC Art. 84

Keyword:
Claims - functional features (no)

Decisions cited:

T 0068/85

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2067/12 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 21 June 2016

Appellant: Inject Star Pökemaschinen Gesellschaft m.b.H
(Opponent) Industriestrasse 18
2201 Hagenbrunn (AT)

Representative: Wildhack & Jellinek
Patentanwälte
Landstraßer Hauptstraße 50
1030 Wien (AT)

Respondent: CFS Bakel B.V.
(Patent Proprietor) Beekakker 11
5761 EN Bakel (NL)

Representative: Wolff, Felix
Kutzenberger Wolff & Partner
Theodor-Heuss-Ring 23
50668 Köln (DE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
10 July 2012 maintaining European patent
No. 1683423 in amended form.

Composition of the Board:

Chairman W. Sieber
Members: J. Jardón Álvarez
F. Blumer
M. O. Müller
E. Kossonakou

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the opponent against the interlocutory decision of the opposition division that European patent No. 1 683 423 as amended met the requirements of the EPC.
- II. The opponent had requested revocation of the patent in its entirety (Article 100(a) EPC), relying *inter alia* on an alleged prior use that had occurred with the sale of brining device MBI-135-C No. 420 to the company Wiesbauer Österreichische Wurstspezialitäten GmbH (D6).
- III. The opposition division maintained the patent in amended form on the basis of the set of claims filed as auxiliary request 1 during the oral proceedings on 25 October 2011. This request included 14 claims, claim 1 reading as follows:

"1. Device for introducing a liquid, such as brine, into an animal product (2), such as meat, ham and the like, comprising a mounting member (1) on which the product (2) can be arranged, a holder (3) at some distance from the mounting member (1), which holder (3) bears a multiplicity of hollow needles (4) oriented transversely with respect to the mounting member (1) and which holder (3) can move to and fro transversely to the mounting member (1) for inserting the needles (4) into the product (2) or, alternatively, for extracting the needles (4) from the product, which needles (4) have at least one discharge orifice (12) near their free end and one feed orifice (11) at some distance from said free end, which needles (4) are accommodated in the holder (3) such that they can be displaced in the longitudinal direction between a position projecting relatively far out of the

holder (3), in which the feed orifices (11) are blocked, and a position projecting relatively less far out of the holder (3), in which the feed orifices (11) have a flow connection to a liquid supply (10), characterized in that locking means (15) are provided for locking the needles (4) in their position projecting relatively less far out of the holder (3) **and only the needles that have been inserted into the product deliver liquid**" (amendments over granted claim 1 in bold).

Claims 2 to 14 were dependent claims.

IV. The opposition division's decision can be summarised as follows:

- the prior use based on D6 had been sufficiently proven. D6 was thus considered to be state of the art within the meaning of Article 54(2) EPC and was found to be novelty-destroying for the subject-matter of claim 1 of the main request (granted claims);
- the subject-matter of the claims of auxiliary request 1 fulfilled the requirements of Article 123(2) EPC, because the amendment "and only the needles that have been inserted into the product deliver liquid" was literally disclosed in the application as filed. The amendment was clear (Article 84 EPC), and limited the device to the effect that only the needles introduced into the product deliver liquid; and
- the bringing device from D6 was no longer novelty-destroying to the subject-matter of the amended claims of auxiliary request 1.

- Lastly, no inventive-step objection had been raised during the oral proceedings.

V. On 10 September 2012 the opponent (in the following: the appellant) lodged an appeal. The statement setting out the grounds of appeal was filed on 2 November 2012. The appellant requested that the decision under appeal be set aside and that the patent be revoked in its entirety, because the amendment in claim 1 as upheld by the opposition division did not meet the requirements of Articles 123(2) and 84 EPC, and the claimed subject-matter was not novel over the alleged prior use (brining device MBI-135-C).

VI. In its reply dated 17 July 2013, the patent proprietor (in the following: the respondent) requested that the appeal be dismissed, and stated that it did not intend to file any substantive reply to the grounds of appeal.

VII. In a communication dated 18 January 2016, the board indicated the points to be discussed during the oral proceedings, which were held on 21 June 2016 in the absence of both parties as announced in their respective letters.

VIII. The relevant arguments of the appellant may be summarised as follows:

- The amendment to claim 1 as upheld by the opposition division was not clear. It related to a subjective advantage of the claimed device and was merely a desideratum. The claim gave no technical measure of how such advantage could be obtained. Moreover, the feature related to an "external"

property of the device, namely when it was being used, and could not clearly limit the device.

- IX. The respondent did not file any substantive submissions during the appeal proceedings.
- X. The appellant requested that the decision under appeal be set aside and that European patent No. 1 683 423 be revoked in its entirety.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. *Amendments*

- 1.1 Claim 1 of the sole request differs from claim 1 as granted in that the device is further defined by indicating at the end of the claim that

"and only the needles that have been inserted into the product deliver liquid".

This feature is based on page 2, lines 5 to 6 of the application as filed (see also paragraph [0006] of the patent specification).

- 1.2 The amendment was made during the opposition proceedings in order to establish novelty over a public prior use involving device MBI-135-C No. 420 (D6). The opposition division had denied novelty of granted claim 1 because this known device disclosed both the features of the preamble of claim 1 and the characterising part, namely that locking means were

provided for locking the needles in their position projecting relatively less far out of the holder.

1.3 The amendment amounts to the introduction of a functional feature into the claim, in the sense that it now defines the device by a technical result to be achieved, that is to say the locking means (15) of the device are to be constructed in such a way that they ensure that "only the needles that have been inserted into the product deliver liquid" (and, by implication, that those not inserted do not deliver liquid).

1.4 As the claim has been amended by introducing a feature taken from the description, it is first necessary to examine whether it fulfils the clarity requirements of Article 84 EPC.

1.4.1 In accordance with established case law of the boards of appeal, functional features defining a technical result are permissible in a claim if (i) from an objective viewpoint they could not otherwise be defined more precisely without restricting the scope of the invention, and (ii) if they provide instructions that are sufficiently clear for a skilled person to be able to reduce them to practice without undue burden, if necessary with reasonable experiments (see decision T 68/85, OJ 1987, 228, headnote). In other words, the functional feature must not only be such that the skilled person can understand it, but he must also be able to implement it in accordance with the requirements of Article 84 EPC.

1.4.2 Concerning the first criterion it is noted that the patent specification in paragraphs [0007] to [0009] describes technical features of a locking system that ensure that only the needles that have been inserted

into the product deliver liquid and that they do this both when they are being pushed into the product and when they are being extracted from it.

1.4.3 Whether or not the introduction of these specific technical features would unduly restrict the scope of the invention can be left unanswered because the functional feature does not in any case fulfil the second criterion, namely it does not provide clear instructions of how to put it into practice. This is the case for the following reasons:

- Firstly, the functional feature defines an advantage of the device in its functioning state, as can be seen from paragraph [0006] of the patent specification. Thus, the functional feature amounts to a mere desideratum. It is not apparent how such a broadly defined desideratum could provide the skilled person with instructions which are sufficiently clear to enable him to reduce them to practice (see in this context point 8.4.3 of T 68/85). It is, for example, not clear whether and how the added functional feature is interrelated with the locking means (15), whether the control of the delivery of liquid occurs automatically or via the locking means (15), or which other means are envisaged.
- Moreover, this lack of clarity is aggravated by the fact that the use of the device includes a first descending step of inserting the needles into the product and a second ascending step of extracting them. Although it is mentioned in paragraph [0006] of the patent specification that the needles deliver liquid both when they are being pushed into the product and when they are being extracted from

it, this is not clear from the wording of the claim itself, which is open on this issue.

- 1.5 In summary, the functional definition present in claim 1 cannot be accepted and the claim does not fulfil the requirements of Article 84 EPC.
2. Consequently, the respondent's request is not allowable.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated