

**Internal distribution code:**

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

**Datasheet for the decision  
of 1 October 2019**

**Case Number:** T 1487/14 - 3.2.07

**Application Number:** 05101238.3

**Publication Number:** 1568632

**IPC:** B65G47/51, A24C5/31, B65B19/30

**Language of the proceedings:** EN

**Title of invention:**  
Variable-capacity FIFO store with an expulsion station

**Patent Proprietor:**  
G.D SOCIETÀ PER AZIONI

**Opponent:**  
Hauni Maschinenbau GmbH

**Headword:**

**Relevant legal provisions:**  
EPC Art. 52, 54, 56, 83  
RPBA Art. 12(4)

**Keyword:**

Late-filed evidence - admitted (no)

Sufficiency of disclosure - (yes)

Novelty - (yes)

Inventive step - (yes)

**Decisions cited:**

T 0032/84

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 1487/14 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 1 October 2019**

**Respondent:** G.D SOCIETÀ PER AZIONI  
(Patent Proprietor) Via Battindarno, 91  
40133 Bologna (IT)

**Representative:** Bergadano, Mirko  
Studio Torta S.p.A.  
Via Viotti, 9  
10121 Torino (IT)

**Appellant:** Hauni Maschinenbau GmbH  
(Opponent) Kurt-A.-Körber-Chaussee 8-32  
21033 Hamburg (DE)

**Representative:** Stork Bamberger Patentanwälte PartmbB  
Meiendorfer Strasse 89  
22145 Hamburg (DE)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
15 May 2014 concerning maintenance of the  
European Patent No. 1568632 in amended form.**

**Composition of the Board:**

**Chairman** I. Beckedorf  
**Members:** K. Poalas  
V. Bevilacqua  
A. Pieracci  
O. Loizou

## Summary of Facts and Submissions

- I. The opponent lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division concerning European patent No. 1 568 632.
- II. The patent proprietor had also lodged an appeal, whereby this appeal was withdrawn at the end of the oral proceedings before the Board.
- III. Opposition had been filed against the patent as a whole based on Articles 100(a) EPC (lack of novelty and inventive step) and 100(b) EPC (insufficient disclosure). The opposition division found that the patent as amended according to the patent proprietor's second auxiliary request met the requirements of the EPC.
- IV. To prepare the oral proceedings, the Board informed the parties of its preliminary assessment of the case by means of a communication pursuant to Article 15(1) RPBA. The Board considered therein, *inter alia*,  
  
that the ground for opposition according to Article 100(b) EPC does not hold against the patent as granted (point 5 of said communication);  
that K24 and K30 would not be admitted into the proceedings (point 6 of said communication);  
that the new lines of argument submitted by the opponent for the first time in the appeal proceedings to support its objections to novelty and inventive step would not be admitted in to the appeal proceedings (point 10 of said communication);  
that the subject-matter of claim 1 of the second

auxiliary request is novel (point 11 of said communication);  
that the subject-matter of claim 1 of the second auxiliary request involves an inventive step (point 12 of said communication).

V. No written comments were submitted by the opponent in respect to the aforementioned communication.

VI. Oral proceedings before the Board took place on 1 October 2019.

The opponent requested

that the appealed decision be set aside  
and  
that the patent be revoked.

The patent proprietor requested

that the opponent's appeal be dismissed.

For further details on the course of the oral proceedings, in particular the matters discussed with the parties, reference is made to the minutes thereof.

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

VII. Independent claim 1 according to the second auxiliary request, i.e. as maintained by the opposition division (hereinafter without further reference to the request), reads as follows:

"A variable-capacity FIFO store comprising:  
an input station (8) located at an input conveyor (5);

an output station (9) located at an output conveyor (7);

a powered endless conveyor belt (10) defining a conveying branch (13) for transferring a mass of articles (6) from the input station (8) to the output station (9), and a return branch (16) extending from the output station (9) to the input station (8);

an adjusting assembly (17) for adjusting the lengths of the conveying and return branches (13, 16) in complementary manner, so as to adjust the storage capacity of the store (4); and

an expulsion station (32) located along the output conveyor (7), downstream from the output station (9), to expel a given mass of articles (6) from the output conveyor (7);

the store (4) being characterized by comprising a control unit (33) for identifying the location of a mass of articles (6) in the store (4), and for activating the expulsion station (32) when the previously identified mass of articles (6) travels through the expulsion station (32);

wherein the conveying branch (13) is divided into a number of sections (41), each identified by respective coordinates (42, 43) to enable an operator to communicate to the control unit (33) identification and subsequent expulsion of all the articles (6) within a given section (41); and

wherein the coordinates (42, 43) are indicated in a fixed position on the store (4), so as to be visible by an operator".

VIII. In the present decision reference is made to the following evidences:

K1 : WO 2005/049235 A1;

K2 : PL 186270;

K4 : DE 199 03 777 A1;  
K9 : DE 102 16 069 A1;  
K23: Video in CD form as evidence of prior use  
"FiFo-store Varios";  
K24: Video in CD form as evidence of prior use  
"ITM FiFo-store Capricorn";  
K26: Tobacco Journal 1/2004, p. 1 to 7 and 48 to 51;  
K27: Tobacco Journal 3/2003, pages 73 to 74;  
K29: DE 2 113 841 A1;  
K30: US 3 867 283 A.

IX. The lines of argument of the parties are substantially as follows and they are dealt with in detail in the reasons for the decision.

During the oral proceedings the opponent confirmed and submitted arguments that its objections concerned an alleged insufficiency of disclosure (Article 83 EPC) and an alleged lack of novelty of the subject-matter of claim 1 over the disclosure of document K1 in view of also the disclosures of K2 and K26. For its alleged lack of inventive step of the subject-matter of claim 1, the opponent referred to its written submissions, in which it had argued to this end starting from the teaching of any of documents K2, K26 and K27, chosen as closest prior art, in combination with the teaching of any of documents K4, K23, K24, K26, K27 and K29, or in combination with the common general technical knowledge of the person skilled in the art.

The patent proprietor defended the patent in the version held by the opposition division to meet the requirements of the EPC and, in particular, argued against the opponent's objections.

## Reasons for the Decision

1. After the withdrawal of the patent proprietor's appeal the decision was taken on the opponent's appeal.

2. *Admittance into the proceedings of K24 and K30*

2.1 Under point 6 of its communication dated 28 May 2019 the Board stated the following:

*"6. As far as it concerns the admittance into the proceedings of K24, K26, K27 and K30 the Board comments as follows:*

*6.1 The opponent criticised the way in which the opposition division exercised its discretion not to admit the video K24 into the proceedings, and the patent proprietor criticised the way in which the opposition division exercised its discretion to admit documents K26 and K27 into the proceedings.*

*6.2 It is not the function of a Board of Appeal to review all the facts and circumstances of the case as if it was in the place of the department of first instance, and to decide whether or not it would have exercised such discretion in the same way as the department of first instance.*

*6.3 A Board should only overrule the way in which a department of first instance has exercised its discretion if the Board concludes it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (see the Case Law of the Boards of Appeal IV.E.3.6).*



*6.4 This is here not the case, since the opposition division decided not to admit the video K24 but to admit documents K26 and K27 by applying the correct criterion, namely by assessing the prima facie relevance of aforementioned pieces of prior art (see points II.4.6 to II.4.12 of the opposition division's communication dated 17 September 2013 and point II.3.3 of the impugned decision).*

*6.5 As a consequence of that the Board sees no reason to overrule the admittance into the proceedings of K26 and K27 and the non-admittance into the proceedings of K24 during the opposition proceedings.*

*6.6 Given that K30 was filed by the opponent for the first time with their statement setting out the grounds of appeal, but that this document does not add anything to what was already disclosed in K29 that had been admitted by the opposition division (see the corresponding patent proprietor's arguments under point 2 of its reply to the opponent's appeal), the Board sees no reason to admit K30 into the proceedings in accordance with Article 12(4) RPBA." .*

2.2 The above-mentioned preliminary findings of the Board have not been commented on nor they have been contested by the opponent during the appeal proceedings, see points V and IX above.

2.3 Under these circumstances, the Board - having once again taken into consideration all the relevant aspects concerning said issue - sees no reason to deviate from its above-mentioned findings.

2.4 As a consequence, K24 and K30 are not admitted into the proceedings.

3. *Sufficiency of disclosure; Article 83 EPC*

3.1 The opponent argues that the requirements of Article 83 EPC are not met for the following reasons.

3.2 For the first, semi-automatic embodiment of the invention it is almost impossible for the operator acting as mentioned in paragraphs 24 and 29 of the description to recognise the exact point of brand changing between two masses of cigarettes within the variable capacity FIFO store, since the feeding velocity of the mass of cigarettes within the variable capacity FIFO store is very high and the position of the operator in front of the conveyor belt does not allow him to optically recognise the exact brand changing point.

3.3 Furthermore, the patent in suit refers in addition to the control unit 33 also to a control station (see paragraph 30 and claim 6), by means of which the quality of the cigarettes upstream of the expulsion station 32 is to be controlled (fully automatically). Paragraph 30 explicitly mentions that this is an alternative embodiment, however also a combination of said two embodiments is covered by the wording of claim 6.

The opponent puts forward that it is not disclosed in the patent in suit where in such a "combination embodiment" the control station is supposed to detect defective objects, especially since no coordinates are required for the second, fully automatic embodiment. This is a disclosure gap preventing the invention from

being carried out by the person skilled in the art.

- 3.4 The patent proprietor's counter-arguments, which are fully endorsed by the Board, are summarised as follows.
- 3.5 During the changing of the brand of the cigarettes a variable capacity FIFO store runs at a reduced velocity and/or in a stop-and-go modus. Furthermore, the variable capacity FIFO store according to the present invention has raised walkways as described in paragraph 29 of the description. These two measures allow the operator to easily recognise the cigarette brand changing area, contrary to the corresponding allegation of the opponent.
- 3.6 In view of the information disclosed in the description (see especially paragraphs 24 to 30) and in the figures of the patent in suit the person skilled in the art, who interprets this information in the light of the common general knowledge in the technical field concerned, is aware of how such a control unit, a control station and an expulsion station are constructed, positioned and connected to each other and this for all three possible embodiments (half-automatic, fully-automatic and a combination thereof). The fact that in the fully-automatic embodiment the control station does not need any correlation to the respective coordinates has nothing to do with the sufficiency of the disclosure of the present invention.
- 3.7 The Board notes in this respect that as it was pointed out in T 32/84 (OJ EPO 1986, 9), the fact that certain elements of an invention essential to its operation were not referred to explicitly either in the claims, or in the relevant portion of the description nor shown in the drawing of the invention as claimed does not

necessarily mean that the application does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

3.8 Furthermore, a successful objection of lack of sufficiency of disclosure presupposes that there are serious doubts, substantiated by verifiable facts. In order to establish insufficiency of disclosure in inter partes proceedings, the burden of proof is upon the opponent (appellant) to establish that a skilled person reading the patent, using his common general knowledge, would be unable to carry out the invention. Otherwise the benefit of the doubt is normally to be given to the patent proprietor (see Case Law of the Boards of Appeal, 9th edition 2019, II.C.9).

3.9 In the present case the opponent described a number of possible difficulties that the skilled person might encounter, but did not raise any serious doubts concerning lack of sufficiency of disclosure substantiated by verifiable facts. In the absence of such verifiable facts, the Board could not find the opponent's objection of lack of sufficient disclosure persuasive.

4. *Novelty; Articles 52 and 54 EPC*

4.1 The patent proprietor puts forward that none of the available pieces of prior art discloses the features of claim 1 according to which

"the conveying branch (13) is divided into a number of sections (41), each identified by respective coordinates (42, 43) to enable an operator to communicate to the control unit (33) identification and

subsequent expulsion of all the articles (6) within a given section (41); and wherein the coordinates (42, 43) are indicated in a fixed position on the store (4), so as to be visible by an operator".

- 4.2 The opponent argues that the subject-matter of claim 1 is not novel over the content of the disclosure of K1 for the following reasons.
- 4.3 The variable-capacity FIFO store known from K1 has implicitly a conveying branch similar to the one depicted in figure 1 of K2 or to the one depicted in the picture of page 2 of K26, whereby said branch is divided into a number of sections (the horizontal planes/conveyors depicted in said figure and in said picture), each one of said sections being automatically identified by respective coordinates to enable an operator to communicate to the control unit identification and subsequent expulsion of all the articles within a given section/plane. Said coordinates are thereby indicated in a fixed position on the store, so as to be visible by an operator. It is therefore further implicitly disclosed in K1, that the skilled person would have configured its control unit so that it would be suitable for receiving the above indicated communication from the operator in order to activate the expulsion station.
- 4.4 The Board cannot share the opponent's view for the following reasons.
- 4.5 The Board considers that the floors, pillars, conveyors or planes depicted in figure 1 of K2 and in the picture of page 2 of K26 cannot be considered as creating a coordinate system as claimed in claim 1. There is no

hint in K1, K2 or K26 in this direction and the skilled person does not conceive through its general technical knowledge these structural parts as being a coordinate system used for identification of articles as claimed in claim 1.

4.6 But even if accepting, for the sake of argument, that the conveying branch of the store of K1 could have been built according to figure 1 of K2 or according to the picture of page 2 of K26 and could therefore be seen by a skilled person as being divided into sections, and that coordinates for each section could also be identified by the skilled person, there is no indication, i.e. no explicit or implicit disclosure to be found in K1 that these coordinates would also be suitable to enable the operator to communicate to the control unit of the store identification and subsequent expulsion of the articles present within a specific section, whereby said coordinates are indicated in a fixed position on the store, so as to be visible by an operator.

Furthermore, it is not directly and unambiguously derivable from K1 that the control unit of its variable capacity FIFO-store is suitable for receiving the above indicated communication data, i.e. information from the operator.

4.7 From the above-mentioned reason the Board concludes that the subject-matter of claim 1 is novel.

5. *Inventive step; Articles 52 and 56 EPC*

5.1 Under points 10 and 12 of its communication dated 28 May 2019 the Board stated the following:

*"10. The Board makes the following general remarks*

concerning the opponent's lack of novelty and lack of inventive step attacks claim 1 of the **second auxiliary request**.

10.1 Claim 1 of the second auxiliary request corresponds to claim 6 (in combination with claims 1 and 5) of the patent as granted.

10.2 During the opposition proceedings the opponent based its lack of **novelty** attack against said claim on **K1** (see submission dated 11 February 2014, pages 37 and 38, and page 3, eighth paragraph of the minutes of the oral proceedings) and its lack of **inventive step** attack on the combination of the teachings of **K2 + K4, K2 + K9 and K2 + K27** (see submission dated 11 February 2014, pages 38 and 39, and page 4 of the minutes of the oral proceedings).

10.3 With its statement setting out the grounds of appeal the opponent based its lack of **novelty** attack in addition to K1 also on several additional documents and evidences (K23, K24, K26, K27; see page 18, first paragraph and page 22, lines 1 to 3). It based further its lack of **inventive step** attacks not only on the above-mentioned combinations of the teachings of K2 + K4 or K2 + K27 but also on several new combinations of teachings (K2 + general technical knowledge, K26 + general technical knowledge, K27 + general technical knowledge, K2 + K26, K2 + K23, K2 + K24, K2 + K29, K26 + general technical knowledge, K27 + general technical knowledge; see pages 18 to 24).

10.4 Given that claim 1 of the second auxiliary request corresponds to claim 6 of the patent as granted, the Board sees no reason why said attacks have not been presented during the opposition proceedings, so that

*the opposition division could have given its ruling about said attacks. For this reason the Board intends to not admit the new lack of novelty and lack of inventive step attacks argued for the first time in the opponent's statement setting out the grounds of appeal into the proceedings in accordance with Article 12(4) RPBA."*

*"12. As far as it concerns the inventive step of the subject-matter of claim 1 of the **second auxiliary request**, the Board comments as follows:*

*12.1 Starting from K2 as representing the closest prior art and due to the fact that none of the prior art documents and evidences in the file discloses the differentiating features mentioned under point 10.1 above and that the Board considers that said differentiating features do not belong to the general technical knowledge of the person skilled in the art, the Board concludes that due to lack of any hint towards said differentiating features the skilled person would not arrive at the subject-matter of claim 1 without the exercise of an inventive activity."*

- 5.2 The above-mentioned preliminary findings of the Board have not been commented on nor have they been contested by the opponent during the appeal proceedings, see points V and IX above.
- 5.3 Under these circumstances, the Board - having once again taken into consideration all the relevant aspects concerning said issue - sees no reason to deviate from its above-mentioned findings.



5.4 As a consequence, the subject-matter of claim 1 of the second auxiliary request involves an inventive step.

6. Since the opponent confirmed at the oral proceedings that there were no other objections to the amended version of the patent held by the opposition division to meet the requirements of the EPC, the Board finds that the opponent has failed to demonstrate and to convince the Board of the incorrectness of the decision under appeal. Hence, the appeal cannot be allowed.

## Order

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

The appeal of appellant 2 (opponent) is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated