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**Datasheet for the decision
of 13 November 2017**

Case Number: T 1746/15 - 3.2.07

Application Number: 09168562.8

Publication Number: 2159174

IPC: B65G47/84

Language of the proceedings: EN

Title of invention:

An apparatus for transport and controlled discharge of products

Patent Proprietor:

Eurosort B.V.

Opponents:

Optimus Sorter Holding B.V.
SDI Group Material Handling Solutions GmbH

Headword:

Relevant legal provisions:

EPC Art. 54(1), 105(1)(a), 105(2), 114(2)
RPBA Art. 12(2), 12(4), 13(1), 13(3)
ZPO §§ 485, 487, 491, 493, 494a
PatG § 140c

Keyword:

Selbstständiges Beweisverfahren - proceedings for infringement (no)

Intervention of assumed infringer - admissible (no)

Novelty - main request and first auxiliary request (no)

Late-filed second to seventh auxiliary requests - admitted (no)

Decisions cited:

T 1713/11, T 0305/08, T 0188/97

Catchword:

Independent evidentiary proceedings under § 485 of the German Code of Civil Procedure ("selbstständiges Beweisverfahren", also known under "Beweissicherungsverfahren" or "Düsseldorfer Verfahren") do not qualify as proceedings for infringement under Article 105(1)(a) EPC (see reasons, point 1).



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 1746/15 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 13 November 2017

Appellant: Eurosort B.V.
(Patent Proprietor) Flevolaan 9a
1382 JX Weesp (NL)

Representative: Zonneveld, Hendrik Jan
De Vries & Metman
Overschiestraat 180
1062 XK Amsterdam (NL)

Respondent I: Optimus Sorter Holding B.V.
(Opponent I) Bijsterhuizen 24-36
6604 LL Wijchen (NL)

Representative: V.O.
P.O. Box 87930
2508 DH Den Haag (NL)

Respondent II: SDI Group Material Handling Solutions GmbH
(Opponent II) Schelpmilserweg 14 b
33609 Bielefeld (DE)

Representative: Dantz, Jan Henning
Loesenbeck - Specht - Dantz
Patent- und Rechtsanwälte
Am Zwinger 2
33602 Bielefeld (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 3 July 2015
revoking European patent No. 2159174 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman	I. Beckedorf
Members:	G. Patton
	V. Bevilacqua
	K. Poalas
	C. Brandt

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal in the prescribed form and within the prescribed period against the decision of the opposition division to revoke European patent No. 2 159 174.

The opposition of opponent/respondent I had been filed against the patent as a whole and was based on the grounds of Article 100(a) EPC (lack of novelty and lack of inventive step), Article 100(b) EPC (insufficiency of disclosure) and Article 100(c) EPC (unallowable amendments).

The intervention of opponent/respondent II pursuant to Article 105(1)(a) EPC had been filed against the patent as a whole and was based on the grounds of Article 100(a) EPC (lack of novelty and lack of inventive step).

The opposition division held that the intervention of opponent/respondent II was admissible and that the subject-matter of claim 1 of the patent as granted lacked novelty over D1(=DE 199 59 843 A). The opposition division found the auxiliary request filed during the oral proceedings to be *prima facie* not allowable and did not admit it into the proceedings.

- II. With letter dated 13 October 2017, the appellant reacted to the Board's preliminary non-binding opinion annexed to the summons for oral proceedings by filing new first to seventh auxiliary requests to replace the former first to seventh auxiliary requests.
- III. Oral proceedings took place on 13 November 2017, at the end of which the present decision was announced. For

the course of the oral proceedings, the issues discussed with the parties and the parties' initial and final requests, reference is made to the minutes of the proceedings.

- IV. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request (patent as granted) or on the basis of any of the first to seventh auxiliary requests filed with letter dated 13 October 2017.

The appellant requested further that, should novelty be acknowledged, the case be remitted to the opposition division for having a first instance decision on inventive step.

The appellant requested moreover that the intervention of respondent II be found inadmissible.

The appellant also requested that, should the Board find the intervention of respondent II to be admissible, the following question be referred to the Enlarged Board of Appeal pursuant to Article 112(1)(a) EPC:

"whether or not the instigation of independent evidentiary proceedings under German law and practice ("selbstständiges Beweisverfahren" / "Beweissicherungsverfahren" / "Düsseldorfer Verfahren") like the one pending against opponent/respondent II in the present case qualify as "proceedings for infringement" under Article 105(1)(a) EPC".

V. Respondent II requested
that its intervention be found admissible.

Respondent I requested
that the appeal be dismissed and
that the first to seventh auxiliary requests filed
with letter dated 13 October not be admitted into
the proceedings.

VI. Claim 1 of the main request (patent as granted) reads
as follows (in strike-through the printing error in the
published contested patent, emphasis added by the
Board; see text of the patent agreed with by the
appellant with letter dated 27 April 2012, annexed to
the communication pursuant to Rule 71(3) EPC dated
29 December 2011):

"An apparatus (1) for transport and controlled
discharge of products (12), comprising at least a
transport container (2) for supporting a product (12),
a loading station for receiving a product (12) by the
transport container (2), a discharging station for
discharging the product (12) from the transport
container (2) and driving means for transporting the
transport container (2) in a transporting direction (X)
from the loading station to the discharging station,
wherein the transport container (2) comprises a pushing
member (4) for ~~transport container (2) comprises a~~
~~pushing member (4) for pushing~~ the product (12) from
the transport container (2) when this is at the
discharging station, which pushing member (4) is
displaceable transversely with respect to the
transporting direction (X), characterized in that the
transport container (2) comprises at least another
pushing member (4) for pushing the product (12) from
the transport container (2) at the discharging station,

wherein at least both pushing members (4) are located behind each other as seen in the transporting direction (X)."

Claim 1 of the first auxiliary request reads as follows (in bold the amendments with respect to claim 1 of the main request; emphasis added by the Board)

"An apparatus (1) for transport and controlled discharge of products (12), comprising at least a transport container (2) for supporting a product (12), a loading station for receiving a product (12) by the transport container (2), a discharging station for discharging the product (12) from the transport container (2) and driving means for transporting the transport container (2) in a transporting direction (X) from the loading station to the discharging station, wherein the transport container (2) comprises a pushing member (4) for pushing the product (12) from the transport container (2) when this is at the discharging station, which pushing member (4) is displaceable transversely with respect to the transporting direction (X), characterized in that the transport container (2) comprises at least another pushing member (4) for pushing the product (12) from the transport container (2) at the discharging station, wherein at least both pushing members (4) are located behind each other as seen in the transporting direction (X), **wherein the pushing member (4) comprises an actuator (5) which is guidable along a guide (7) extending obliquely with respect to the transport direction (X), wherein at least two actuators (5) of a transport container (2) are located at substantially the same distance with respect to each other as two corresponding guides (7), as seen in the transporting direction (X).**"

Claim 1 of the fifth auxiliary request reads as follows (in bold the amendments with respect to claim 1 of the first auxiliary request; emphasis added by the Board)

"An apparatus (1) for transport and controlled discharge of products (12), comprising at least a transport container (2) for supporting a product (12), a loading station for receiving a product (12) by the transport container (2), a discharging station for discharging the product (12) from the transport container (2) and driving means for transporting the transport container (2) in a transporting direction (X) from the loading station to the discharging station, wherein the transport container (2) comprises a pushing member (4) for pushing the product (12) from the transport container (2) when this is at the discharging station, which pushing member (4) is displaceable transversely with respect to the transporting direction (X), characterized in that the transport container (2) comprises at least another pushing member (4) for pushing the product (12) from the transport container (2) at the discharging station, wherein at least both pushing members (4) are located behind each other as seen in the transporting direction (X), wherein the pushing member (4) comprises an actuator (5) which is guidable along a guide (7) extending obliquely with respect to the transport direction (X), wherein at least two actuators (5) of a transport container (2) are located at substantially the same distance with respect to each other as two corresponding guides (7), as seen in the transporting direction (X), **wherein the apparatus (1) comprises a series of said transport containers (2), which are transportable by the driving means.**"

In view of the following decision, the wording of claim 1 of the second, third, fourth, sixth and seventh auxiliary requests is irrelevant.

VII. The appellant argued essentially as follows:

Admissibility of opponent/respondent II's intervention

The independent evidentiary proceedings to which respondent II is currently subject in Germany ("selbstständiges Verfahren", also known as "Beweissicherungsverfahren" or "Düsseldorfer Verfahren"), hereafter referred to as "BSV proceedings", do not qualify as proceedings for infringement pursuant to Article 105(1)(a) EPC.

Proceedings initiated by the patent proprietor are deemed to be "proceedings for infringement" pursuant to Article 105(1)(a) EPC only where a court is called upon to establish by a ruling "whether a third party is commercially active in an area that falls within patentee's right to exclude".

This is not the case in BSV proceedings, since no facts are established by a court in the sense that the opinion provided by the expert inspecting the alleged infringing product or process is not binding for the subsequent distinct infringement proceedings to be initiated by an action.

There is no automatic or procedural link between BSV proceedings and subsequent infringement proceedings. There is no time limit for bringing the case to infringement proceedings, so that opponent/respondent II in the present case may not even be faced with an actual accusation of infringement.

Respondents in BSV proceedings are not faced with injunctions, contrary to the order in the Belgian proceedings discussed in T 188/97 (not published in OJ EPO), in which the assumed infringer is unambiguously prohibited from "releasing or alienating" in any way the infringing articles described by the expert.

In BSV proceedings, the assumed infringer is not left without any means of defence, since, according to § 494a German Code of Civil Procedure (Zivilprozessordnung, hereafter "ZPO"), it can force the patent proprietor to bring the case to infringement proceedings.

According to the Case Law of the Boards of Appeal (see T 1713/11 and T 305/08, neither published in OJ EPO), "saisie-contrefaçon" in France or "descrizione" in Italy, which are proceedings comparable to BSV proceedings, do not qualify as "proceedings for infringement" pursuant to Article 105(1)(a) EPC.

As a consequence, BSV proceedings under German law cannot be considered as proceedings for infringement within the meaning of Article 105(1)(a) EPC. Therefore, the intervention of opponent/respondent II should not be admitted.

Main request

Since D1 does not explain how the pusher should be divided, it should be seen as a non-enabling disclosure to be disregarded when assessing the patentability of the claimed subject-matter.

Should the skilled person nevertheless consider dividing the pusher, he would do it in consideration of the disclosure of D1 as a whole, in particular in view of the passages in column 2, lines 31-38 and column 5, lines 48-57 that teach to divide the pusher in a manner such as to individually discharge small products from the container to the right or to the left. Hence, he would come up with a longitudinally divided pusher and would locate the resulting pushing members in the middle of the tray.

D1 relates to small products, so there is no disclosure about discharging one product by two pushers, in particular in a synchronous manner. For this reason too, the skilled person would have no reason to divide the pusher transversally.

The skilled person would not come up with the idea of dividing the pusher of D1 transversally, as he does not know how to implement an actuation mechanism for the second pushing member resulting from the divided pusher. There is no disclosure in D1 about duplicating the actuation means, and the second pushing member would be hanging in the air.

Should the skilled person come up with the idea of dividing the pusher transversally, he would consider having one pushing member located on the right of the transport container and another one on the left, in order to be able to discharge products to the right or to the left in accordance with the teaching of D1, in which case the pushing members would not be located behind each other as claimed.

Finally, the skilled person would further consider dividing the pusher horizontally, i.e. locating one of

the pushing members above the other, so as to be able to discharge products to the right and the left. This configuration does not amount to having pushing members located behind each other as claimed either.

Since the skilled person would not derive directly and unambiguously from D1 the configuration of the pushing members as claimed, novelty of the subject-matter of claim 1 of the main request should be recognised.

First auxiliary request

The first auxiliary request was filed with the statement setting out the grounds of appeal, i.e. in due time in view of the course of the opposition proceedings. It should therefore be admitted into the proceedings.

Unlike the apparatus of claim 1, which is suitable for performing such synchronous discharge of large products with two pushing members, D1 does not disclose to operate the pushing member of a transversally divided pusher synchronously. Hence, novelty of the subject-matter of claim 1 over D1 should be recognised.

Second to seventh auxiliary requests

Only claim 1 of the fifth auxiliary request could overcome the lack of novelty objection regarded as valid against claim 1 of the first auxiliary request, should Figure 6 be taken as the basis for said lack of novelty objection.

The subject-matter of claim 1 of the fifth auxiliary request should therefore be regarded as *prima facie*

novel over D1, such that at least said request should be admitted into the proceedings.

VIII. Respondent I argued essentially as follows:

Main request

D1 discloses two distinct alternatives, one of which concerns a divided pusher. The skilled person considering this alternative will immediately and unambiguously derive that there is only one technically feasible solution corresponding to the claimed one, in view of the disclosure of D1 taken as a whole. In particular, he will see no technical difficulties in duplicating for one transport container the disclosed actuation means such as to provide two pushing members as claimed.

Hence, the subject-matter of claim 1 of the main request should be regarded as lacking novelty over D1.

First auxiliary request

The first auxiliary request could have been filed during the opposition proceedings, so it should not be admitted into the appeal proceedings.

Claim 1 does not specify that the claimed apparatus is suitable for synchronously discharging large products with two pushing members. Hence, this feature cannot be argued as being a distinguishing feature over the disclosure of D1.

Therefore, the subject-matter of claim 1 of the first auxiliary request should be regarded as lacking novelty

over D1 for the same reasons as those given for claim 1 of the main request.

Second to seventh auxiliary requests

The subject-matter of claim 1 of the second to seventh auxiliary requests is *prima facie* not novel over D1, such that said late-filed auxiliary requests should not be admitted into the proceedings.

IX. Respondent II argued essentially as follows:

Admissibility of opponent/respondent II's intervention

The evidence gathered during BSV proceedings can be used in subsequent proceedings, including infringement proceedings.

Unlike "saisie" proceedings, such as "saisie-contrefaçon" proceedings in France, German law does not provide for a time limit within which the patent proprietor must make use of the gathered evidence. BSV proceedings also differ from "saisie" proceedings in that the court ordering the inspection must be convinced that infringement is probable. Such threshold does not exist in "saisie-contrefaçon" proceedings in France. Therefore, "saisie" and BSV proceedings are not comparable, and the conclusions of decisions T 1713/11 and T 305/08, *supra*, do not apply.

The order in BSV proceedings is comparable to that of the Belgian proceedings referred to in T 188/97, *supra*, which had led to the conclusion that the intervention was admissible.

In BSV proceedings, the assumed infringer is left with no means of defence, such that Article 105 EPC is meant for that purpose, i.e. to provide means of defence.

For these reasons, the intervention should be regarded as admissible.

Reasons for the Decision

1. *Admissibility of opponent/respondent II's intervention*

1.1 The present intervention of respondent II was filed pursuant to Article 105(1)(a) EPC, which states the following (emphasis added by the Board):

"(1) Any third party may, in accordance with the Implementing Regulations, intervene in opposition proceedings after the opposition period has expired, if the third party proves that
*(a) **proceedings for infringement** of the same patent have been instituted against him, or..."*

Hence, for an intervention to be admissible and treated as an opposition pursuant to Article 105(2) EPC, "proceedings for infringement" must have been initiated against the intervener, i.e. respondent II in the present case.

It must then be assessed whether the independent evidentiary proceedings under § 485 ZPO ("selbständiges Beweisverfahren", also known as "Beweissicherungsverfahren" or "Düsseldorfer Verfahren") which have been initiated against respondent II qualify as proceedings for infringement (see order of the Landgericht Düsseldorf: "Beschluss

des Landgerichts Düsseldorf", filed by respondent II with its letter dated 27 April 2015).

- 1.2 The Board follows T 1713/11, *supra* (point 2.6 of the reasons), according to which "proceedings for infringement" pursuant to Article 105(1)(a) EPC are "proceedings meant to **establish** whether a third party is commercially active in an area that falls within the patentee's right to exclude".

However, contrary to the view of respondent II, the BSV proceedings initiated against it by decision of the Landgericht Düsseldorf do not constitute the "establishment" of an infringement within the above meaning.

As a matter of fact, according to German law, the expert opinion produced in BSV proceedings will be just one of the evidentiary means in a **possible subsequent and separate** infringement proceedings to be initiated by an action. The expert opinion is **by no means binding for the court** of the subsequent infringement proceedings, and the assumed infringer has the opportunity to contest the expert opinion and to file its own evidence or counter-evidence. Hence, it cannot be regarded as establishing facts.

This is all the more true since BSV proceedings are ex-parte proceedings in which the assumed infringer ("Antragsgegnerin") (see §§ 491 and 493 ZPO) does not participate. This is also reflected in the order of the Landgericht Düsseldorf, which states that the expert opinion is to be conducted without informing the assumed infringer in advance (see page 3, No. 5: "Die Begutachtung soll ... ohne vorherige Ladung und Anhörung der Antragsgegnerin erfolgen").

1.3 Even though BSV proceedings are only ordered by a court if a legal interest ("rechtliches Interesse"; § 485(2) ZPO) exists and the arguments are sufficiently convincing ("Glaubhaftmachung"; § 487 ZPO), such that infringement appears to be highly probable ("hinreichende Wahrscheinlichkeit") pursuant to § 140c German Patent Law (Deutsches Patentgesetz, hereinafter "PatG") implementing EU Directive 2004/48/EC on the enforcement of intellectual property rights, this still does not constitute the **establishment** of an infringement that would in any way be binding in subsequent infringement proceedings.

Said requirements are only a legal prerequisite to justify a third person (expert) being allowed to access the assumed infringer's premises and/or production facilities to inspect the alleged infringing products or processes and to prohibit the assumed infringer from altering, destroying or removing these products or processes before said inspection has been performed.

1.4 The further submission of respondent II during the oral proceedings to the effect that the information obtained by the expert in the context of BSV proceedings could also be used elsewhere apart from in any infringement proceedings does not - even if it were possible and true - impart any legal interest for an intervention to the present opposition proceedings. In any case, respondent II has not provided any evidence in support of its allegation.

1.5 Respondent II cannot successfully rely on T 188/97, *supra*, since the order in the Belgian proceedings underlying that case is not comparable to that of the present BSV proceedings.

In both proceedings, an expert is allowed to access to the assumed infringer's premises to inspect the alleged infringing products or methods.

However, the order served by the Judge of Seizures in T 188/97 differs significantly from the order of the present BSV proceedings since, in the Belgian proceedings, the assumed infringer is prohibited from "releasing or alienating" in any way the infringing articles described by the expert (point 3 of the reasons), i.e. it is prohibited from selling or transferring to third parties, whereas in the present BSV proceedings the assumed infringer is only prohibited from altering, modifying or destroying the articles at issue before the expert has completed his inspection. Therefore, in T 188/97 the order was considered to have "all the features of an injunctive order" (point 4 of the reasons), which according to the case law of the Boards of Appeal is regarded as "infringement proceedings" within the meaning of Article 105(1)(a) EPC.

In the present case, however, the assumed infringer **is not faced with any such injunctions** as it is not prohibited from performing trade or business or selling the alleged infringing products or processes after the inspection and is not requested to cease the infringement or to pay damages.

At the oral proceedings, respondent II submitted that the wording "releasing and alienating" should be understood, in view of the T 188/97 case seen as a whole, as having exactly the same meaning as the order in the present BSV proceedings. For respondent II, the

order was wrongly translated from the original language.

The Board cannot follow this view, since respondent II has not provided any evidence of its allegation of wrong translation or misinterpretation of the Belgian order, such that T 188/97 can only be considered in accordance with its published text, which is clear and unambiguous.

- 1.6 According to the case law of the Boards of Appeal, "saisie" proceedings, e.g. "**saisie-contrefaçon**" in France, are not regarded as "infringement proceedings" in terms of Article 105(1)(a) EPC (T 1713/11, point 2.4.1 of the reasons and T 305/08, point 1 of the reasons, *supra*).

It is true, as pointed out by respondent II, that, unlike BSV proceedings, "saisie-contrefaçon" does not require any threshold in terms of infringement probability. A "saisie" can indeed be ordered simply at the request of the patent proprietor. Such threshold in infringement probability does not, however, qualify as establishing an infringement, as already discussed under points 1.2 and 1.3 above.

After "saisie" proceedings, the assumed infringer has the right to claim the initiation of (separate) infringement proceedings. Similarly, the assumed infringer in BSV proceedings can, once the proceedings are over, ask the court to order the patent proprietor to file an action for infringement within a certain time limit (§ 494a(1) ZPO), otherwise the patentee must pay the assumed infringer the costs occasioned by the BSV proceedings (§ 494a(2) ZPO).

Hence, the Board considers that "saisie" proceedings are comparable to BSV proceedings in this respect.

It further appears that, contrary to the view of respondent II, the assumed infringer subject to BSV proceedings is **not left without any means of defence**. As mentioned, it is indeed entitled after termination of the BSV proceedings to compel the patent proprietor to initiate patent infringement proceedings within a certain time limit (§ 494a(1) ZPO).

Furthermore, the assumed infringer, who did not and could not participate in the BSV proceedings, can object to the use of the result obtained therein in subsequent (infringement) proceedings (§ 493(2) ZPO).

1.7 It follows from the above that there is no need for a "balance of interests" to allow an intervention. Further, the BSV proceedings and the possible subsequent infringement proceedings are **two separate proceedings** which are independent from each other. There is no automatic or procedural link between them. Only the latter qualify as "proceedings for infringement" according to Article 105(1)(a) EPC and Boards of Appeal's case law.

1.8 The intervention of respondent II is therefore not admitted pursuant to Article 105(2) EPC.

As a consequence, since the Board came to a conclusion which matches the appellant's opinion concerning the inadmissibility of the intervention and the appellant's respective requests, and moreover since said conclusion is in line with the Boards of appeal's case law (see T 188/67, T 305/08 and T 1713/11, *supra*), the

appellant's auxiliary request for referral to the Enlarged Board of Appeal becomes moot.

2. *Main request (patent as granted)*

Since the Board concludes that the subject-matter of independent claim 1 of the main request lacks novelty over D1 (see below), there is no need to discuss the further objections raised by respondent I against this request.

2.1 Disclosure of D1

2.1.1 Document D1 discloses an apparatus ("Stückgutförderer") for the transport and controlled discharge of products ("Stückgut", "Kleingut", "Güter"), comprising at least a transport container ("Transportwagen" 1, 1', 1") for supporting a product, a loading station for receiving a product ("Eingabestation" 22) by the transport container (1), a discharging station ("Auschleusestelle" 19, 19', 19") for discharging the product from the transport container (1, 1', 1") and driving means for transporting the transport container (1, 1', 1") in a transporting direction ("Bewegungsrichtung" 10) from the loading station (22) to the discharging station (19, 19', 19"), wherein the transport container (1, 1', 1") comprises a pushing member ("Schieber" 7) for pushing the product from the transport container (1, 1', 1") when this is at the discharging station (19, 19', 19"), which pushing member (7) is displaceable transversely ("Auswurfrichtung" 8) with respect to the transporting direction (10) (column 4, line 27 to column 5, line 55; figures).

As a result, and as is not disputed by the parties, D1 discloses all the features of the preamble of claim 1 (see also impugned decision, point 20.1).

2.1.2 Hence, the issue at stake in view of the parties' submissions relates to whether the passage of D1, column 2, lines 31-41 discloses the features of the characterising portion of claim 1 of the main request.

2.1.3 The Board follows the opinion of respondent I, according to which said passage of D1 actually discloses **two distinct alternatives**.

The first alternative, alternative A, column 2, line 34, concerns a divided pusher ("Hierzu muß der Schieber unterteilt...werden") and the second alternative, alternative B, column 2, lines 35-38 concerns a pusher adapted such that it divides the surface of the container into two parts and is moveable to the left or to the right so as to discharge products to the right or to the left of the container ("...derart angeordnet werden, daß er die Ladefläche in zwei Teilflächen teilt und wahlweise die eine oder die andere Teilfläche überstreicht") (see also the statement setting out the grounds of appeal, point 4.3.1, page 11).

In this respect, the Board cannot share the appellant's view that the second part of the sentence of column 2, lines 34-38 (alternative B) would be a preferred embodiment of the first part (alternative A), because of the use of the word "preferably" or the fact that the two alternatives A and B are mentioned in one single sentence. As a matter of fact, as discussed at the oral proceedings, the Board considers that the word "or" ("oder") used to separate the two alternatives does not equate to "and accordingly" ("beziehungsweise")

in German), as alleged by the appellant. The word "or" unambiguously defines two distinct alternatives.

- 2.1.4 The disclosure of D1, column 2, lines 31 to 34, that a container can comprise more than one product, each product to be **individually discharged**, ("...jedes Teil individuell ausschleusen zu können...") applies to both alternatives A and B (see also in this respect column 2, lines 39-41). Hence, the Board considers, as also argued by respondent I, that the transport container of the first alternative A comprises "individual pushers" (pushing members) as a result of the divided pusher, i.e. at least another pushing member, each of the "individual pushers" being individually activated so as to be suitable for pushing the products individually from the transport container at the discharging station.
- 2.1.5 Consequently, it remains to be assessed whether the skilled person, using his common general knowledge, would derive directly and unambiguously from the disclosure of D1 as a whole the remaining features of the characterising portion of claim 1, namely whether the pushing members as a result of the divided pusher according to alternative A are located behind each other as seen in the transporting direction.
- 2.1.6 As correctly put forward by the appellant, the word "unterteilt" used in D1 for alternative A does not explicitly specify a direction for the division of the pusher ("Schieber" 7). However, the Board is of the opinion that, provided with the information that the pusher (7) is to be divided, the skilled person will immediately and unambiguously come to the conclusion that it could **only** be longitudinally or transversally.

Longitudinally would lead to the configuration shown in the figure below, taken from the impugned decision, point 20.6, which is technically nonsensical in view of the disclosure of D1, since one of the two pushers (the upper one) would not be able to push products out of the container.

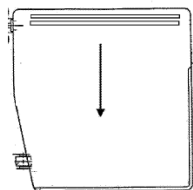


Figure taken from the decision, point 20.6

This configuration would then be excluded by the skilled person, who would only retain the **transversal** division of the pusher shown in the figure below, taken from the impugned decision, point 20.5.

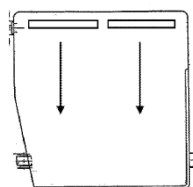


Figure taken from the decision, point 20.5

2.1.7 With respect to whether the disclosure of a transversally divided pusher (two pushers on a single transport container) would be enabled, the Board is of the opinion, as expressed by respondent I, that the skilled person would have no technical difficulty to duplicate the actuation mechanism disclosed in Figure 5 of D1 twice beneath a single transport container (1, 1', 1"), in such a way that the two tilting arms ("Führungshebel" 15) would not obstruct each other (see Figures 4 and 5).

In this respect, the Board notes that, contrary to appellant I's view, claim 1 does not specify that the pushing members resulting from the divided pusher are synchronous. It can hence not be seen as a distinguishing feature over D1.

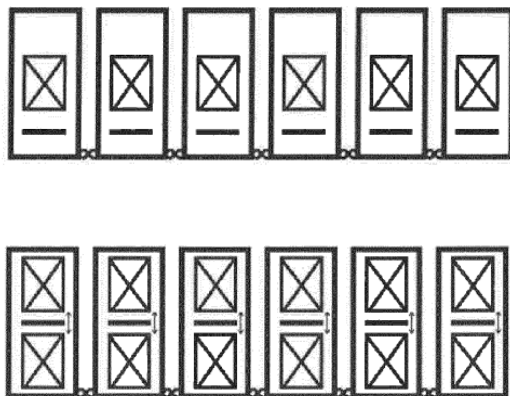
2.1.8 The Board further notes that, with a pusher transversely divided into two pushing members, each activated by a mechanism as disclosed in D1 and able to independently eject products laterally, these pushing members will necessarily have a component of their movement which is laterally directed, and can be regarded as being displaceable transversely with respect to the transporting direction (10).

2.1.9 The appellant considers that in the context of the passage of D1, column 2, lines 34 to 41, i.e. including alternative A, and in view of the disclosure of D1 as a whole and the fact that D1 only discloses in this context to discharge the products independently to the left and to the right, it can only be interpreted that the pusher is subdivided longitudinally, which also remains an imaginary embodiment.

The Board cannot share this view, for the reasons given above. Further, D1 does not disclose only pushing to the left and to the right, but explicitly also in one direction only (see Figures 1 to 5).

2.1.10 The appellant also argues that the skilled person would derive further embodiments from the disclosure of D1, column 2, lines 31-38, such as to provide shorter carriers and/or split the transport containers into two surfaces to discharge the products independently to the left and the right (see figures below taken from the statement setting out the grounds of appeal, page 14),

in order to increase the capacity of the apparatus for small products as mentioned in D1, column 2, lines 38 to 41.



Figures taken from the statement setting out the grounds of appeal, page 14

The Board cannot, however, follow the appellant's view, since the proposed embodiments do not relate to the alternative A ("unterteilt") of D1, as the pushers are not divided. Similarly, the configuration shown below, also taken from the statement setting out the grounds of appeal, page 14, does not concern alternative A, but rather a combination of alternatives A and B which is not disclosed in D1, see point 2.1.3 above.

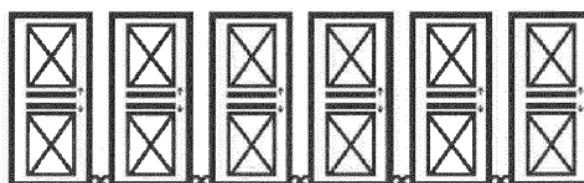


Figure taken from the statement setting out the grounds of appeal, page 14

2.1.11 At the oral proceedings, the appellant further argued that, in addition to longitudinally or transversally as discussed under point 2.1.6 above, the skilled person would also derive from alternative A that the pusher

can be divided horizontally, i.e. that one pusher would be located above the other.

The Board is not convinced by this argument. As a matter of fact, as put forward by respondent I, the skilled person would construct the pushing members resulting from the divided pusher as disclosed in D1. Consequently, said pushing members would have to be suitable for sweeping and brushing the surface of the container (see column 2, lines 13-30, "Der erfindungsgemäße Schieber arbeitet nach dem umgekehrten Prinzip eines Handfegers zur Bodenreinigung... "fegt" er...") (see also column 4, lines 59-60, "...an ihm angebrachte Bürste 9..."; Figure 3). This would not be the case if one pushing member were located above the other. The teaching of such a "located above" pushing member is hence neither disclosed nor suggested in D1. D1 even seems to teach away from such a pushing member. Consequently, the Board considers that this configuration is not directly and unambiguously derivable by the skilled person from the disclosure of D1 taken as a whole.

- 2.1.12 The appellant also argued at the oral proceedings that the skilled person, were he to come up with the idea of dividing the pusher transversally, would consider having one pushing member located on the right and another one on the left of the transport container, in order for the apparatus to be able to discharge products to the right or to the left in accordance with the teaching of D1.

The Board cannot, however, see in which respect such configuration would depart from the one claimed. As a matter of fact, it is not specified in claim 1 that the pushing members need to be exactly behind each other. A

lateral shift is indeed not excluded, as long as they are located behind each other **as seen in the transport direction**. Further, when moving to discharge the products, the pushing members inevitably come exactly behind each other.

2.2 In view of the above, it appears that the only technically feasible configuration that the skilled person would immediately and directly derive from alternative A in view of the teaching of D1 taken as a whole is that the two pushing members resulting from the divided pusher are located behind each other as claimed.

2.3 Therefore, the subject-matter of claim 1 of the main request lacks novelty over D1 (Article 54(1) EPC).

3. *First auxiliary request*

3.1 Admissibility

3.1.1 The first auxiliary request was filed with letter dated 13 October 2017, i.e. after the summons had been sent to the parties, so that its admission into the proceedings is subject to Article 13(3) RPBA. It differs from the former, withdrawn, first auxiliary request filed with the statement setting out the grounds of appeal only in that the repeated wording (printing error) has been deleted from claim 1 (see point VI above, in particular claim 1 of the main request, for the deleted wording).

The Board considers that this deletion does not raise any issues which the Board or respondent I cannot reasonably be expected to deal with without adjournment of the oral proceedings, so that it cannot form as such

a justification for not admitting the first auxiliary request into the proceedings.

- 3.1.2 Respondent I also contested the admission of the first auxiliary request into the proceedings on the basis that the former, withdrawn, first auxiliary request could have been filed during the first instance proceedings.

The Board considers, however, that the former, withdrawn, first auxiliary request was filed "**in due time**" with the statement setting out the grounds of appeal pursuant to Article 114(2) EPC and Article 12(2) RPBA, i.e. taking account of the positive preliminary opinion of the opposition division in its summons for oral proceedings dated 1 September 2014, and that at the oral proceedings the opposition division clearly stated that it would not admit any further requests (impugned decision, point 21).

- 3.1.3 The first auxiliary request is hence admitted into the proceedings (Article 12(4) RPBA).

3.2 Novelty

Since the Board concludes that the subject-matter of independent claim 1 of the first auxiliary request lacks novelty over D1 (see below), there is no need to discuss in this decision the further objections raised by respondent I against this request.

- 3.2.1 As argued at the oral proceedings, the appellant considers that novelty of the subject-matter of claim 1 should be recognised on the basis of the fact that D1 does not disclose to operate the pushing members of a transversally divided pusher **synchronously** (see also

appellant's letter dated 7 April 2016, paragraph bridging pages 15 and 16). For the appellant, D1, column 2, lines 33, teaches to discharge small products individually, so the disclosed apparatus would not be suitable for such a synchronous discharge. Contrary to that, the apparatus of claim 1 would be suitable for performing such synchronous discharge of large products with two pushing members, as disclosed in paragraph [6] of the contested patent.

- 3.2.2 The Board cannot follow the appellant's view, for the reasons given by respondent I at the oral proceedings that claim 1 does not comprise the feature that the pushing members operate synchronously. As stated in paragraph [6] of the contested patent, the features now included in claim 1 of the first auxiliary request **allow** to displace two pushing members synchronously, i.e. they do not represent an obstacle for performing this function. This, however, does not equate to the functional feature being necessarily provided to the claimed apparatus, since other features might still be necessary. Further, the Board cannot see any reason why the apparatus of D1 as derived by the skilled person as discussed under point 2 above would not be suitable, like the claimed one, to discharge products synchronously, should it also be suitable for discharging products individually in an independent manner, even though the products in D1 are small. The appellant has not provided any persuasive arguments or evidence in support of its allegation regarding the non-suitability of D1. As a result, the appellant's arguments are not convincing, and hence the reasons given for the main request still apply.

3.2.3 As a consequence, the subject-matter of claim 1 of the first auxiliary request lacks novelty over D1 (Article 54(1) EPC).

4. *Second to seventh auxiliary requests*

4.1 The second to seventh auxiliary requests were filed by letter dated 13 October 2017 and differ from the former, withdrawn, second to seventh auxiliary requests filed by letter dated 7 April 2017, i.e. after the reply of respondent I, only in that the repeated wording (printing error) has been deleted from claim 1 (see point VI above, in particular claim 1 of the main request, for the deleted wording).

As for the first auxiliary request, this deletion cannot justify the non-admission of said auxiliary requests into the proceedings (see point 3.1.1 above).

4.2 Respondent I contests the admission of the second to seventh auxiliary requests into the proceedings for *prima facie* lack of novelty of the subject-matter of claim 1 of all the requests pursuant to Article 13(1) RPBA (see annex to the summons, point 9).

4.3 During the oral proceedings, the appellant confirmed that only claim 1 of the fifth auxiliary request could comprise features which would enable to *prima facie* overcome the lack of novelty objection regarded as valid against claim 1 of the first auxiliary request, contrary to claims 1 of the second to fourth, the sixth and the seventh auxiliary requests. These auxiliary requests were in fact filed merely in order to overcome objections based on or in combination with other documents.

4.4 With respect to claim 1 of the first auxiliary request, claim 1 of the fifth auxiliary request comprises the features of claim 2 of the patent as granted, i.e. that the apparatus "comprises a series of said transport containers, which are transportable by the driving means".

4.5 The appellant considers that these added features would confer novelty over Figure 6 of D1, should said Figure 6 be the basis for justifying lack of novelty of the subject-matter of claim 1 of the first auxiliary request, in the sense that the apparatus as a whole as shown in Figure 6 would be regarded as a single transport container providing synchronous discharge of the products (see also point 3.2.1 above).

4.6 The Board does not, however, consider this interpretation of Figure 6 of D1 as relevant for arguing lack of novelty of the subject-matter of claim 1 of the first auxiliary request (see point 3.2.2 above). Further, it follows respondent I's view that the apparatus of D1 unambiguously comprises a series of transport containers, which are transportable by the driving means (see for instance Figures 4 and 5), said containers being those of Figure 1 considered in the discussion of novelty of the subject-matter of claim 1 of the main request and first auxiliary request (see D1, column 4, lines 64-65).

As a consequence, the subject-matter of claim 1 of the fifth auxiliary request *prima facie* lacks novelty over D1.

4.7 In the absence of any arguments from the appellant, the same applies *de facto* to the subject-matter of claim 1

of the second, third, fourth, sixth and seventh auxiliary requests.

- 4.8 As a consequence, the second to seventh auxiliary requests are not admitted into the proceedings (Article 13(1) RPBA).

Order

For these reasons it is decided that:

1. The intervention by SDI Group Material Handling Solutions GmbH is inadmissible.
2. The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated