

Internal distribution code:

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

**Datasheet for the decision
of 11 September 2019**

Case Number: T 2307/15 - 3.2.07

Application Number: 10716052.5

Publication Number: 2398709

IPC: B65B5/10, B65B15/04, B65B61/02,
B65B61/26, B65D75/32, A61J1/03

Language of the proceedings: EN

Title of invention:
METHOD AND DEVICE FOR THE COMMISSIONING OF PIECE GOODS

Patent Proprietor:
Ethilog Sas

Opponent:
SWISSLOG ITALIA S.p.A.

Headword:

Relevant legal provisions:

EPC Art. 108, 100(c)
EPC R. 2(1), 99(2), 101(1), 131(1), 131(4)
RPBA Art. 12(2), 12(3)
Decision of the President of the European Patent Office dated
12 July 2007 concerning the filing of patent applications and
other documents by facsimile Art. 6

Keyword:

Admissibility of appeal - (yes)

Grounds for opposition - added subject-matter (yes)

Decisions cited:

T 0003/90, T 2061/12, T 2317/13, T 0858/18

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 2307/15 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 11 September 2019

Appellant: SWISSLOG ITALIA S.p.A.
(Opponent) Via Vittor Pisani, 20
20124 Milano (MI) (IT)

Representative: Provvisionato, Paolo
Provvisionato & Co S.r.l.
Piazza di Porta Mascarella 7
40126 Bologna (IT)

Respondent: Ethilog Sas
(Patent Proprietor) Parc Eurasante
70 rue Dr. Yersin
59120 Loos (FR)

Representative: Lebkiri, Alexandre
Cabinet Camus Lebkiri
25, Rue de Maubeuge
75009 Paris (FR)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
5 October 2015 concerning maintenance of the
European Patent No. 2398709 in amended form.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Pieracci
K. Poalas

Summary of Facts and Submissions

- I. The opponent lodged an appeal in the prescribed form and within the prescribed time limit against the interlocutory decision of the opposition division concerning the opposition against European patent No. 2 398 709.

- II. The opposition had been filed against the patent as a whole based on Article 100(a) EPC (lack of inventive step), on Article 100(b) EPC (insufficiency of disclosure) and on Article 100(c) EPC (added subject-matter). The opposition division decided to maintain the patent as amended according to the patent proprietor's main request.

- III. With the statement setting out the grounds of appeal, the appellant (opponent) requested

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

- IV. With the reply to the statement setting out the grounds of appeal, the respondent (patent proprietor) requested

that the appeal be rejected as inadmissible
or, in the alternative,
that the appeal be dismissed.

- V. To prepare the oral proceedings scheduled upon both parties' requests, the Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA. The Board indicated that the appeal appeared to be admissible and, since the claimed subject-matter

appeared not to comply with the requirement of Article 123(2) EPC, it also appeared to be allowable.

VI. Whereas the appellant did not respond to aforementioned communication of the Board, the respondent, with letter dated 26 August 2019, indicated that it would not attend the oral proceedings and further argued only that the appeal should be considered inadmissible.

VII. The parties argue substantially as follows.

The appellant argues that the use of storage rolls is only disclosed in combination with two belt elements, an indication that a storage roll is to be used in the case of only one belt element is not present. Subject-matter has therefore been added.

The respondent argues that the appeal is inadmissible since the statement setting out the grounds of appeal sent by facsimile was incomplete. The respondent also argues that the person skilled in the art would consider using a storage roll also when only a belt element is used, so that subject-matter has not been added.

VIII. The lines of arguments of the parties are dealt with in detail in the reasons for the decision.

IX. Independent claim 1 as maintained by the opposition division reads as follows:

Method for the commissioning of piece goods from a storage pack (2), wherein a piece goods unit (3, 26, 27, 28) which comprises a piece good (7) to be commissioned and a part (8) of the storage pack (2) surrounding the piece good (7) is separated from the

rest of the storage pack (2), characterized in that piece goods units (3, 26, 27, 28) which derive from different feed devices (22, 23, 24, 25) are placed on a conveyor belt (18) so as to feed these to at least one belt element (50, 51) of a packing device (5), wherein a fixing device (52) connects the piece goods units (3, 26, 27, 28) to the belt element (50, 51), and a control device (12) controls a marking device (4) in such manner that a corresponding marking (40) is each time applied to an associated part of the belt element (50, 51) unwound from a storage roll (48, 49), said marking (40) enabling the piece good (7) to be unequivocally identified.

X. Independent claim 4 as maintained by the opposition division reads as follows:

Device for the commissioning of piece goods (7) from a storage pack (2), wherein a piece goods unit (3, 26, 27, 28) which comprises a piece good (7) to be commissioned and a part (8) of the storage pack (2) surrounding the piece good (7) is separated from the rest of the storage pack (2) by means of a separating device (10) characterized in that said device comprises:

- different feed devices (22, 23, 24, 25) adapted to feeding piece goods units (3, 26, 27, 28) on a conveyor belt (18) so as to feed these to at least one belt element (50, 51) of a packing device (5), the packing device (5) comprising a fixing device (52), by means of which piece goods units (3, 26, 27, 28) are connected to the belt element (50, 51),

- a marking device (4) adapted to mark (40, 68) the piece goods unit (3, 26, 27, 28),

- a control device (12) adapted to controlled said marking device (4) in such manner that a corresponding marking (40) is each time applied to an associated part of the belt element (50, 51) unwound from a storage roll (48, 49), said marking enabling the piece good (7) to be unequivocally identified.

Reasons for the Decision

1. Right to be heard

The present decision is taken without holding oral proceedings. The principle of the right to be heard pursuant to Article 113(1) EPC is however observed since that provision only affords the opportunity to be heard. By explicitly declaring their intention not to attend the oral proceedings, to which both parties were duly summoned, the respondent gave up that opportunity and its declaration that it would not attend the oral proceedings is considered equivalent to a withdrawal of the request for oral proceedings, whereby the respondent is treated as relying only on its written case (see the Case Law of the Boards of Appeal, 9th edition 2019, sections III.B.2.7.3 and III.C.4.3.2, in particular with reference to T 3/90, OJ EPO 1992, 737).

The appellant's request for oral proceedings is auxiliary to its main request that the decision under appeal be set aside and that the patent be revoked. Thus, since the appellant's main request is followed by the Board, see order below, the aforementioned auxiliary request does not become active.

In view of said declaration, the Board, while cancelling the oral proceedings arranged for 17 September 2019, takes the decision in written proceedings on the basis of both parties' written submissions.

2. Admissibility of the appeal

2.1 The respondent argues that, pursuant to Article 108, second sentence, EPC in combination with Rule 131(1) and (4) EPC, the delay for filing the statement setting out the grounds of appeal expired on 15 February 2016. The statement received by facsimile on that day was incomplete and therefore the document shall be deemed as not have been received by the EPO. That the appellant re-sent a complete statement of the grounds of appeal on 16 February 2016 was not to be taken into account because this occurred only after the due date.

The respondent further argues in reply to the Board's communication pursuant to Article 15(1) RPBA that the first issue to be addressed is not whether the incomplete statement of grounds of appeal complies with the requirements of Rule 99(2) EPC but rather whether the incomplete statement of grounds of appeal should be considered as properly received at the EPO. Article 6 of the decision of the President of the EPO dated 12 July 2007 (special edition No. 3 OJ EPO, A.3) should be taken into account together with Rule 2(1) EPC and accordingly the fax sent on 15 February 2016 shall be deemed not to have been received at the EPO.

Hence, the appeal should be rejected as inadmissible according to Rule 101(1) EPC.

- 2.2 The appellant reacted neither to this objection of the respondent nor to the Board's communication pursuant to Article 15(1) RPBA.
- 2.3 The Board finds that although some paragraphs are missing in the statement setting out the grounds of appeal filed by the appellant on 15 February 2016 when compared with the version filed on 16 February 2016, the document received by the EPO on 15 February 2016 still allows the reader to understand the reasons according to which the appellant requests the impugned decision to be set aside and the facts and evidence on which the appeal is based.

The contrary is neither shown nor argued in the respondent's reply to the grounds of appeal or in its reply to the Board's communication pursuant to Article 15(1) RPBA.

Rather, it appears from the respondent's reply letter to the statement setting out the grounds of appeal and the arguments submitted therein that the respondent was well aware of what the appellant argued in support of its request that the decision under appeal be set aside and that the patent be revoked for non-compliance with Articles 100(b), 100(c), 83 and 123(2) EPC and for lack of inventive step (Article 100(a) and 56 EPC).

Since the reasons for setting aside the decision impugned and the facts and evidence on which the appeal is based are evident to the Board as well as to the respondent from the statement setting out the grounds of appeal filed by fax on 15 February 2016, the latter is considered to properly define the appellant's case

in accordance with Rule 99(2) EPC and Article 12(2) RPBA.

The statement setting out the grounds of appeal received by fax on 15 February 2016 is therefore to be seen as being complete, also in the sense of Article 6 of the President's decision referred to by the respondent, since it fulfills the purpose which it is meant to achieve.

In this view, the Board follows and confirms its own approach taking in decision T 2061/12 of 19 October 2016 (in a different composition), point 1 of the Reasons, as well as interlocutory decision taken by Technical Board of Appeal 3.3.04 in case T 2317/13 of 14 April 2014 (neither of them published in the OJ EPO). The recent dissenting decision T 858/18 of Technical Board of Appeal 3.5.02 of 20 May 2019 (not published in the OJ EPO) concerning the issue of admissibility of an opposition remains an isolated decision in an individual case based on a factual basis different from the current case, which is marked by the specific purpose of the requirements of an admissible appeal explicitly provided for in Article 12(2) RPBA and in Rule 99(2) EPC.

Thus, the appeal is admissible because it complies with the requirements of Article 108 EPC in combination with Article 12(2) RPBA and Rule 99(2) EPC .

3. Added subject-matter of claims 1 and 4 as maintained by the opposition division (Article 100(c) EPC)

3.1 The appellant contests that the following combination of features added to claim 1 during examination, namely that

"...a fixing device (52) connects the piece good units (3, 26, 27, 28) to the belt element (50, 51)..."

and that

"...the belt element is unwound from a storage roll (48, 49)..."

are not disclosed in combination with the other features of claim 1 in the application as originally filed.

The appellant argues that in the application as originally filed the use of storage rolls is explicitly described only in combination with two belt elements and that an indication that a storage roll could also be used with a single belt element is not present.

The appellant referring to page 29, lines 5-11, of the application as originally filed also contests the statement of the opposition division, that
"...the application as filed does not disclose or suggest any other way of feeding the belt element...".

The appellant also argues that contrary to the assertion of the opposition division (see point 10.1 of the impugned decision) there is no basis in the application as originally filed for applying the storage rolls to unwind any number of belt elements. The appellant argues that rolls are only disclosed in connection with two belt elements, thus neither for only one belt element nor for more than two belt

elements.

The appellant also considers that corresponding objections apply to claim 4, which comprises analogous features to the ones objected for claim 1.

- 3.2 The respondent argues that basis for the first of the objected combinations of features of claim 1 can be found on page 7, lines 6-17, of the application as originally filed and published and that this has not been objected to by appellant in the grounds of appeal.

The respondent also argues that basis for second of the objected combinations of features of claim 1 can be found on page 19, lines 26-27, together with page 11, lines 24-26, of the application as filed.

From the passage on page 19 it is derivable that each storage roll is configured to receive one belt element. Therefore, in the embodiment where only one belt element is used a person skilled in the art would conclude that only one storage roll is necessary. The passage on page 11 indicates that a characteristic described as part of an embodiment can be combined with another embodiment. Consequently there is no doubt that the person skilled in the art would consider using a storage roll also when only one belt element is used.

The respondent also argues that analogous arguments apply to claim 4.

- 3.3 The Board cannot follow the argument of the respondent and the reasons given by the opposition division in the impugned decision and substantially concurs with the appellant for the following reasons.

As acknowledged by the parties, both in the specific examples and in the general description of the opposed patent a single belt element which is unwound from a storage roll is not shown.

The argument of the respondent that, where only one belt element is used, a person skilled in the art would then immediately conclude that only one storage roll is required, cannot be followed. This argument, based on an obviousness approach, is appropriate for the analysis of inventive step but not for assessing what is directly and unambiguously derivable from the teaching of the application as originally filed.

The argument based on the statement on page 11 of the application as originally filed, that

"...characteristics described or represented as part of an embodiment may equally be used in another embodiment to create a further embodiment of the invention..."

can also not be followed. Such a statement does not provide a basis for the disclosure of a specific features' combination.

As argued by the appellant, the statement of the opposition division that

"...the application as filed does not disclose or suggest any other way of feeding the belt element..."

can also not be followed.

As indicated by the appellant, the passage on page 29, lines 5-11, of the application as originally filed, expressly states that it is not necessary to derive the

belt elements from storage rolls and an alternative realization is also suggested in the same passage.

Hence, the combination of features that

"...the belt element is unwound from a storage roll (48, 49)..."

cannot be derived directly and unambiguously from the application as originally filed and therefore subject-matter which extends beyond the application as filed has been added to claim 1 during examination proceedings.

Analogous objections apply to claim 4.

- 3.4 The above Board's opinion has been communicated to the parties with the communication pursuant to Article 15(1) RPBA. The respondent has not reacted to the above opinion.

After having reconsidered the parties' submissions and the circumstances of the case the Board holds that claims 1 and 4 contain subject-matter which extends beyond the content of the application as originally filed.

4. As a consequence, the Board finds that the appeal is admissible and that the appellant has convincingly demonstrated that the decision under appeal cannot be upheld. In the absence of any allowable request of the respondent, the patent is to be revoked.

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:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated