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**Datasheet for the decision
of 21 June 2022**

Case Number: T 0423/18 - 3.2.07

Application Number: 10716654.8

Publication Number: 2421777

IPC: B65G47/26

Language of the proceedings: EN

Title of invention:
ZONED ACCUMULATION CONVEYOR

Patent Proprietor:
Intelligrated Headquarters LLC

Opponents:
SSI Schäfer Peem GmbH
Vanderlande Industries B.V.

Headword:

Relevant legal provisions:
EPC Art. 54, 111(1)
RPBA Art. 12(4)
RPBA 2020 Art. 11, 13(2), 15(1)

Keyword:

Novelty - main request (no) - auxiliary request (yes)
Late-filed request - admitted (no)
Amendment after summons - taken into account (no)
Remittal - special reasons for remittal

Decisions cited:

T 1707/17, T 0348/18, T 0713/18, T 1115/18

Catchword:



Beschwerdekammern

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Chambres de recours

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Case Number: T 0423/18 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 21 June 2022

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 29 November
2017 revoking European patent No. 2421777
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairwoman A. Beckman
Members: A. Pieracci
 R. Cramer

Summary of Facts and Submissions

- I. The patent proprietor lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division to revoke the European patent No. 2 421 777.
- II. The oppositions were filed against the patent as a whole based on the grounds for opposition pursuant to Article 100(a) and (b) EPC (lack of novelty and inventive step; insufficiency of disclosure).
- III. The opposition division held that the subject-matter of claims 1 and 8 as amended according to the main request was not novel over the disclosure of D1 (US 2007/0119690 A1) and that the auxiliary requests were either not allowable or not admissible.
- IV. In preparation for oral proceedings, the Board communicated its preliminary assessment of the case by means of a communication pursuant to Article 15(1) RPBA 2020.
The Board indicated that the subject-matter of claim 1 of the patent as amended according to the main request appeared not to be new, but that the subject-matter of claim 1 of auxiliary request 2, corresponding to claim 8 of the main request, appeared to be novel.
- V. Opponent 1 and the patent proprietor reacted, respectively, with letter dated 20 October 2021 and 2 June 2022 to the communication of the Board pursuant to Article 15(1) RPBA 2020.
- VI. Oral proceedings before the Board took place on 21 June 2022. At the end of the oral proceedings the decision

was announced. For further details of the proceedings reference is made to the minutes thereof.

VII. The final requests of the patent proprietor (appellant) were:

that the decision under appeal be set aside and the case be remitted to the opposition division for consideration of inventive step if the Board would consider the set of claims of any of the main request or of the first to eighth auxiliary requests, all filed with the statement of grounds of appeal, to be novel. The request not to remit presented in the letter of 2 June 2022 was withdrawn.

VIII. The final requests of opponents 1 and 2 (respondents) were:

that the appeal be dismissed, or that the case be remitted to the opposition division for further prosecution if the Board would consider the claims of any request to be novel.

IX. The lines of argument of the parties are dealt with in detail in the reasons for the decision.

X. Independent claim 1 according to the patent as amended according to the main request reads as follows:

"A method of controlling an accumulation conveyor (2) configured to convey articles, the accumulation conveyor (2) comprising a plurality of zones (4a, 4b, 6a, 6b, 8a, 8b, 10a, 10b, 12a, 16a, 16b, 18a, 18b, 20a, 24a, 26a, 26b, 28a, 28b, 38a, 40a, 40b, 42a, 42b, 44a, 50a, 50b, 52a, 52b, 78a, 80, 82, 84, 86, 88, 114, 116,

118, 120, 122, 124, 152, 154, 156, 158, 160, 162, 190, 192, 104, 196, 198, 200), one of said plurality of zones comprising a discharge zone, said plurality of zones comprising at least a first zone and second zone, said second zone being downstream of said first zone, comprising the steps of:

- a. determining whether said second zone is occupied by a second article;
- b. determining whether said first zone is occupied by a first article;
- c. setting said first zone to inactive state if said first and said second zones are occupied; and
- d. setting said first zone to active state if said second zone is not occupied."

XI. Independent claim 8 according to the patent as amended according to the main request and corresponding to claim 1 of auxiliary request 2 reads as follows:

"A method of controlling an accumulation conveyor (2) configured to convey articles, the accumulation conveyor (2) comprising a plurality of zones (4a, 4b, 6a, 6b, 8a, 8b, 10a, 10b, 12a, 16a, 16b, 18a, 18b, 20a, 24a, 26a, 26b, 28a, 28b, 38a, 40a, 40b, 42a, 42b, 44a, 50a, 50b, 52a, 52b, 78a, 80, 82, 84, 86, 88, 114, 116, 118, 120, 122, 124, 152, 154, 156, 158, 160, 162, 190, 192, 104, 196, 198, 200), one of said plurality of zones comprising a discharge zone, said plurality of zones comprising at least a first zone, a second zone and a third zone, said second zone being downstream of said first zone, said third zone being downstream of said second zone, comprising the steps of:

- a. determining whether said second zone is occupied

- by a second article and said third zones is occupied by a third article;
- b. determining whether said first zone is occupied by a first article;
 - c. setting said first zone to inactive state if said first, second and third zones are occupied; and
 - d. setting said first zone to active state if said second zone or third zone is not occupied."

XII. The wording of any of the claims of auxiliary requests 1 and 3 to 8 is not given here since auxiliary request 1 is not admitted into the proceedings for procedural reasons and auxiliary requests 3 to 8 are not relevant for the decision.

Reasons for the Decision

1. Novelty of the subject-matter of claim 1 of the main request (Article 54 EPC)

1.1 The Board cannot share the opinion of the patent proprietor (see point 2.3.21 of the statement setting out the grounds of appeal) that figure 8G of D1 does not show step c of claim 1, namely:

- c. setting said first zone to inactive state if said first and said second zones are occupied,

when considering zone 3 and zone 2 of figure 8G as being the first and second zone of feature c.

The Board also cannot share the argument of the patent proprietor that:

"...zone 3 is only inactive because zone 2 is occupied...",

and

"...the occupancy of zone 3 has no bearing on whether zone 3 is set to active or inactive...".

1.2 Zone 2 is set to inactive as a consequence of its sensor 16 sensing item C (see paragraph [0028], line 11 of D1) and zone 3 is then set to inactive when item E interrupts the light-beam of the corresponding sensor 16, however on the condition that zone 2 has already been stopped, otherwise item E would proceed further to zone 2 as item D does in figure 8F.

1.3 Therefore zone 3, corresponding to the first zone of claim 1, is set into inactive state in response to the signal of sensors 16 of both zones 2 and 3, corresponding to the second and first zone of claim 1, respectively, indicating that both zones are occupied according to feature c of claim 1, contrary to the opinion of the patent proprietor (see point 2.3.23 of the statement setting out the grounds of appeal).

1.4 In the above finding the occupancy of a zone of D1 is understood as the detection of an article on said zone by the corresponding sensor. This is in line with the decision of the opposition division (see impugned decision, page 5, first paragraph) and also with the understanding of the person skilled in the art, as confirmed by the patent proprietor when amending the main request to the first auxiliary request by introducing respective sensors for the different zones and arguing that a person skilled in the art understands that zones are occupied when the

corresponding sensor is occupied by an article (see steps a to d of claim 1 of the first auxiliary request and points 3.1.2 and 3.1.3 of the statement setting out the grounds of appeal).

1.5 Even if the Board would follow the argument of the patent proprietor, also referring to the prior art acknowledged in paragraphs [0003] to [0006] of D1, that the rules governing the method of D1 are meant to be generally different from those according to claim 1 of the opposed patent, this is not the relevant issue for assessing whether feature c is disclosed in document D1 or not and this argument is thus not convincing.

1.6 The Board furthermore cannot follow the argument of the patent proprietor (see the letter dated 2 June 2022, page 10, lines 11 to 23) that no consideration is given in D1 to the occupancy and that, when setting a zone to active or inactive state, the state of the downstream zone is not relevant. As indicated above, the patent proprietor's view is contrary to what can be derived from figure 8G of D1 and the corresponding explanation in paragraph [0028] of the description of D1.

The fact that paragraph [0005] of D1 might be understood as disparaging a system that considers the current zone and the next downstream zone, as argued by the patent proprietor (see the letter dated 2 June 2022, page 10, lines 23 to 26), is not relevant for the specific issue of whether figure 8G discloses step c of claim 1 or not.

1.7 The Board is thus not convinced by the arguments of the patent proprietor that the finding of the opposition division that feature c is disclosed in document D1 is incorrect. The Board has therefore no reason not to

concur with the opposition division that the subject-matter of claim 1 is not novel in view of D1.

2. Admittance of auxiliary request 1 into the proceedings
- 2.1 The patent proprietor filed for the first time with the statement setting out the grounds of appeal the current auxiliary request 1 with the reason that "only at the time of the oral proceedings did it became apparent that the Opposition Division would take such a broad ... interpretation of the claims" (see point 3.1.7 of the statement setting out the grounds of appeal).
- 2.2 The Board does not consider this being in the present case a reason justifying the submission of auxiliary request 1 for the first time in appeal proceedings.
- 2.3 The fact that the opposition division might be convinced by the arguments of the other party is something that a party to the oral proceedings should be prepared to face and react to. This is not as such a justification for reacting only in appeal proceedings or changing strategy at that stage.
- 2.4 The reference to decision T 1868/16 made by the patent proprietor at the oral proceedings to support its argumentation with respect to admittance of auxiliary request 1 into the proceedings cannot change the facts above and does not lead the Board to change its assessment of the case.
- 2.5 In fact, by not submitting auxiliary request 1 in opposition proceedings the patent proprietor has impeded the opponents to take position on this request already in opposition proceedings. Moreover, the

opposition division could not decide on the matter. This course of action thus runs contrary to the primary object of the appeal proceedings, which is to revise the appealed decision in a judicial manner.

- 2.6 The Board therefore considers it appropriate to make use of its discretion pursuant to Article 12(4) RPBA 2007 to not admit auxiliary request 1 into the proceedings.
3. Admittance of auxiliary request 2 into the proceedings
 - 3.1 The claims of auxiliary request 2 correspond to those of the main request wherein claims 1 to 7 have been deleted.
 - 3.2 The opponents requested not to admit auxiliary request 2 into the proceedings (see the paragraph bridging page 5 and 6 of the reply of opponent 1 to the statement setting out the grounds of appeal and page 7, fourth paragraph of the reply of opponent 2 to the statement setting out the grounds of appeal).
 - 3.3 Since the claims of auxiliary request 2 are identical to claims 8 to 15 of the main request, which have been already discussed and also decided upon by the opposition division, the Board considers it appropriate not to apply its discretion under Article 12(4) RPBA 2007 to not admit auxiliary request 2 into the proceedings. Auxiliary request 2 is therefore in the proceedings.
4. Admittance of the new line of argument of lack of novelty of the subject-matter of claim 1 of auxiliary request 2 presented by opponent 1 at the oral proceedings

- 4.1 Opponent 1 presented at the oral proceedings a new objection of lack of novelty based on a new identification of the first, second and third zone in the example of figure 8 of D1.
Opponent 1 argued that since the new objection was *prima facie* relevant for assessing novelty of the subject-matter of claim 1 it should be considered by the Board.
- 4.2 This objection is an amendment to the appeal case of opponent 1 and its admittance into the proceedings is thus subject to Article 13(2) RPBA 2020, whereby any amendment to a party's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
- 4.3 A purported *prima facie* relevance is however no "exceptional circumstance" within the meaning of Article 13(2) RPBA 2020. Furthermore, the "cogent reasons" to be given include reasons why the amendment could not have been presented earlier (T 1707/17, T 348/18, T 713/18, T 1115/18).
- 4.4 The new objection of lack of novelty raised by opponent 1 at the oral proceedings is thus not admitted into the proceedings pursuant to Article 13(2) RPBA 2020.
5. Novelty of the subject-matter of claim 1 of auxiliary request 2 (Article 54 EPC)
- 5.1 Claim 1 of auxiliary request 2 is identical to claim 8 of the main request and the same arguments of the parties apply for both requests.

5.2 The Board concurs with the patent proprietor (see point 2.3.37 and 2.3.38 of the statement setting out the grounds of appeal) that, contrary to what is argued by the opposition division (see the last paragraph at page 5 of the appealed decision), figure 8F in combination with line 10 of paragraph [0028] of D1 does not show feature d of claim 8, namely,

d. setting said first zone to active state if said second zone or third zone is not occupied,

under the assumption of zone 3 being the first zone, zone 2 being the second zone and zone 1 being the third zone.

5.3 The sentence starting in D1 on line 10 of paragraph [0028] reads:

"...Zone 2 will continue to run until either article C breaks the beam of photo-eye 16 or the photo-eye 16 of zone 3 clears the trailing edge of article D...",

which thus does not disclose the second condition expressed by step d, namely that if the third zone is not occupied, the first zone is set to active state.

5.4 The Board concurs with the patent proprietor (see point 2.3.29 to 2.3.32 of the statement setting out the grounds of appeal) that step d does not relate to two alternatives as apparently considered by the opposition division, but to a single step of the control method. Therefore prior art to deprive novelty of the subject-matter of claim 1 should disclose both alternatives and not just one, as found by the opposition division in

the decision under appeal and as alleged by the opponents.

- 5.5 The Board cannot follow the arguments presented by the opponents at the oral proceedings that the interpretation given by the patent proprietor of feature d is against the common interpretation of that feature. The Board considers this argumentation an unsubstantiated allegation and rather finds that the interpretation given by the patent proprietor corresponds to the understanding of a person skilled in the art when reading method claim 1 (see point 5.4 above), that is that the method is such to check the occupancy of both the second and the third zone.

Since the teaching of step d is considered to be unambiguous for a person skilled in the art, there is no need to recur to the description of the disputed patent, and the arguments of the parties based on the description do not need to be addressed (see the statement setting out the grounds of appeal, points 2.3.26 and 2.3.28 and the letter of opponent 1 dated 20 October 2021, points 5.2 to 5.2.5)

- 5.6 Opponent 2 presented at the oral proceedings and in writing (see page 4, table 4 to page 6, third paragraph of the reply to the statement setting out the grounds of appeal) arguments based on permutation of the occupancy condition of the zones, as claimed, drawing the conclusion that D1 deprives the subject-matter of claim 8 of the main request of novelty, and thus claim 1 of auxiliary request 2 as well.
- 5.7 As confirmed at the oral proceedings, the lines of argumentation of opponent 2 are based on the considerations that step d relates to two alternatives

and not to a single step of the control method as found by the Board, concurring with the patent proprietor (see point 5.4 above). The lines of argumentation of opponent 2 cannot be convincing.

5.8 The Board is therefore convinced by the arguments of the patent proprietor that the finding of the opposition division that feature d is disclosed by D1 is not correct. The subject-matter of claim 1 of auxiliary request 2 is therefore new over the disclosure of D1.

6. Conclusions

6.1 As a consequence, the Board, in reviewing the decision under appeal on the basis of the parties' mutual submissions in the appeal proceedings, has come to the conclusion that

- the patent proprietor has not convincingly demonstrated the incorrectness of the decision under appeal and its underlining reasons in respect of the issue of novelty of the subject-matter of claim 1 of the main request;
- the patent proprietor has however convincingly shown the incorrectness of the decision under appeal and its underlining reasons in respect of the issue of novelty of the subject-matter of claim 8 of the main request corresponding to the subject-matter of claim 1 of auxiliary request 2.

6.2 Therefore the decision under appeal cannot be upheld and should be set aside.

7. Remittal of the case to the opposition division
(Articles 111(1) EPC and 11 RPBA 2020)
- 7.1 The Board is aware that, according to Article 11 RPBA 2020, a remittal for further prosecution should only be undertaken exceptionally, when special reasons apply. The Board notes that the decision under appeal only dealt with the issue of lack of novelty.
- 7.2 Noting that neither the patent proprietor with its statement setting out the grounds of appeal nor the opponents have addressed the issue of inventive step of the subject-matter claimed in auxiliary request 2, the Board cannot come to a decision regarding the inventive step of the subject-matter claimed in auxiliary request 2 on the basis of the parties' submissions in appeal proceedings alone. Moreover, all parties have requested that the case be remitted in the event that the decision was to be set aside and the subject-matter of any request be found to be novel. Against this background, after considering all the relevant circumstances of the case at hand, the Board comes to the conclusion that the issue of inventive step could not be decided upon without undue burden (cf. explanatory notes to Article 11 RPBA 2020, Supplementary publication 2 - OJ EPO 2020, 46, 54).
- 7.3 Consequently, the Board is convinced that there are special reasons within the meaning of Article 11, first sentence, RPBA 2020 that apply, and, following the parties' corresponding requests, remits the present case to the opposition division for further prosecution in accordance with Article 111(1) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairwoman:



G. Nachtigall

A. Beckman

Decision electronically authenticated