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**Datasheet for the decision
of 1 April 2022**

Case Number: T 1227/19 - 3.2.03

Application Number: 09831134.3

Publication Number: 2382430

IPC: F25D25/00

Language of the proceedings: EN

Title of invention:

DUAL TEMPERATURE AUTOMATED STORAGE AND RETRIEVAL SYSTEM

Applicant:

Translogic Corporation

Headword:

Relevant legal provisions:

EPC Art. 83, 123(2), 54, 111(1), 114(1)
RPBA 2020 Art. 13(2), 11

Keyword:

Sufficiency of disclosure - (yes)

Amendments - added subject-matter (no)

Novelty - (yes)

Amendment after summons - exceptional circumstances (yes)

Amendment to appeal case - suitability of amendment to resolve issues raised (yes)

Remittal - special reasons for remittal

Decisions cited:

T 1241/17, T 0982/18

Catchword:



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Case Number: T 1227/19 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 1 April 2022

Appellant: Translogic Corporation
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 14 November
2018 refusing European patent application No.
09831134.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman B. Miller
Members: B. Goers
E. Kossonakou

Summary of Facts and Submissions

- I. European patent application No. 09 83 11 34 ("the application") concerns an automated storage and retrieval system and methods of storing an item in or retrieving an item from this system.
- II. With the decision under appeal, the examining division refused the application on the grounds of Articles 83, 54 and 56 EPC. The appellant is the applicant.
- III. With the consent of the party, oral proceedings before the Board were held on 1 April 2022 by videoconference using the Zoom platform.
- IV. At the end of the oral proceedings, the appellant requested that the decision under appeal be set aside, that the main request filed on 1 April 2022 immediately before the oral proceedings be admitted into the proceedings and that the case be remitted to the examining division for further prosecution on the basis of this main request.
- V. The following prior art documents relevant for this decision were cited in the examination proceedings.

D1: WO 03/073018 A1

D3: US 5,240,139 A

D4: WO 02/29194 A1 (introduced by the appellant with the letter dated 8 October 2018)

The following document, which is cited in D4, paragraph [0003], was introduced into the proceedings by the Board under Article 114(1) EPC.

D5: WO 99/043234 A1

VI. The claims of the main request addressed in this decision read as follows (feature numbering added in "[]").

(a) Claim 1

"[1.1] An automated storage and retrieval system, comprising:

[1.2] an enclosed area including a first zone having a first plurality of storage locations and a second zone having a second plurality of storage locations,

[1.3] wherein said second zone is substantially thermally isolated from said first zone;

[1.4] and an automated transport member operable to selectively transport an item between one of said first plurality of storage locations and said second plurality of storage locations,

[1.5] and at least one predetermined area in said enclosed area,

the automated storage and retrieval system further comprising:

[1.6] an access member at an interface between said first zone and said second zone,

[1.7] said access member providing selective access to said second plurality of storage locations,

[1.8] wherein said access member includes a first screen and a second screen which can define an aperture therebetween that is positionable adjacent to said second plurality of locations,

[1.9] so that the aperture may be selectively located adjacent to a given storage location,

[1.10] wherein said aperture is controllable in a first direction and a second direction, wherein said second direction is opposite to said first direction,

[1.11] so that the aperture may close in the position that it was in during a removal of an item."

(b) Claim 3 (based on claim 4 of the main request on which the decision under appeal was based)

"The automated storage and retrieval system of any one of claims 1-2, wherein:
said automated transport member is operable to transport a first item between said first zone and a predetermined area in said enclosed area,
said automated transport member is operable to transport a second item between said second zone and said predetermined area,
said automated transport member is operable to travel in at least a first dimension and is operable to travel in a second dimension from a first position in said first zone to a second position in said second zone;
and said access member is controllable in said first dimension to enable said automated transport member to access said second zone."

(c) Claim 4 (based on claim 7 of the main request on which the decision under appeal was based)

"[4.1] A method of retrieving an item from an automated storage and retrieval system, the method comprising:
[4.2] locating an automated transfer member in a first zone adjacent to a storage location in a second zone,
[4.3] wherein the first zone and the second zone are thermally isolated;
[4.4] establishing a temperature of said second zone that is different than a temperature of said first zone
[4.5] interrupting said thermal isolation between said first zone and said second zone;

[4.6] *communicating said automated transfer member from said first zone at least partially into said second zone;*

[4.7] *removing said item from said storage location;*

[4.8] *returning said automated transfer member to said first zone;*

[4.9] *restoring said thermal isolation between said first zone and said second zone; and*

[4.10] *depositing said item into an access port,*

[4.11] *wherein said thermal isolation is accomplished by physical separation of said first zone and said second zone by means of an access member and wherein said interrupting comprises establishing an aperture between said first zone and said second zone, the aperture being defined between a first screen and a second screen of the access member,*

[4.12] *the aperture being selectively located adjacent to a given storage location,*

[4.13] *said aperture being controllable in a first direction and a second direction, wherein said second direction is opposite to said first direction,*

[4.14] *so that the aperture may close in the position that it was in during a removal of said item."*

(d) Claim 7 (based on claim 11 of the main request on which the decision under appeal was based)

"[7.1] *A method of storing an item in an automated storage and retrieval system, the method comprising:*

[7.2] *retrieving said item from an access port with an automated transport member;*

[7.3] *locating said automated transport member in a first zone adjacent to a storage location in a second zone,*

[7.4] *wherein said first zone and said second zone are thermally isolated;*

[7.5] *establishing a temperature of said second zone that is different than a temperature of said first zone*
[7.6] *interrupting said thermal isolation between said first zone and said second zone adjacent to said storage location;*
[7.7] *communicating said automated transport member from said first zone at least partially into said second zone;*
[7.8] *depositing said item into said storage location;*
[7.9] *returning said automated transport member to said first zone; and*
[7.10] *restoring thermal isolation between said first zone and said second zone*
[7.11] *wherein said thermal isolation is accomplished by physical separation of said first zone and said second zone by means of an access member and wherein said interrupting comprises establishing an aperture between said first zone and said second zone, the aperture being defined between a first screen and a second screen of the access member,*
[7.12] *the aperture being selectively located adjacent to a given storage location,*
[7.13] *said aperture being controllable in a first direction and a second direction, wherein said second direction is opposite to said first direction,*
[7.14] *so that the aperture may close in the position that it was in."*

VII. The appellant's arguments relevant to the present decision may be summarised as follows.

(a) Admittance of the sole main request

The sole main request should be admitted since it provided a direct reaction to all objections raised or maintained in the communication under Article 15(1)

RPBA 2020. Furthermore, the Board invited the appellant to file a respectively amended claim set.

(b) Article 83 EPC

The subject-matter claimed was sufficiently disclosed. The skilled person knew how to design a common shutter comprising two screens and a guiding means according to Figure 7a. Such a shutter was sufficiently rigid to be pushed up by the roller device also against the force of gravity.

(c) Article 123(2) EPC

The subject-matter of the independent claims 1, 4 and 7 did not extend beyond the application as filed but was substantially based on claims 1, 12, 15 and 16. The further features of two screens forming an aperture in between, the aperture being positionable adjacent to a given storage location, were disclosed on page 20, lines 7 to 8 and page 23, lines 4 to 6.

(d) Novelty

The subject-matter of the independent claims was novel over D1. D1 only disclosed, also in conjunction with the referred to disclosure in D3, a single screen access member. A single screen was also not capable of providing an aperture which could be positioned adjacent to a given storage location and closed in this position. Furthermore, D1 did not disclose a method of storing an item according to claim 7.

(e) Remittal

The case should be remitted to the examining division for assessment of the main request in view of the requirements of Article 56 EPC.

Reasons for the Decision

Admittance of the sole main request

1. The sole main request was submitted on 1 April 2022 in response to the communication under Article 15(1) RPBA 2020. It is thus an amendment to the appellant's appeal case as per Article 13(2) RPBA 2020, and the admittance of the request is at the Board's discretion.
- 1.1 Under Article 13(2) 2020, an amendment to a party's appeal case made after notification of the summons shall, in principle, not be taken into account unless there are exceptional circumstances. However, at the third level of the convergent approach (see document CA/3/19, page 43, explanatory remarks on Article 13(2) RPBA 2020), in exercising its discretion, the Board may also rely on criteria applicable at the second level. These criteria include suitability to *prima facie* overcome the issues raised and procedural economy (see Article 13(1) RPBA 2020).
- 1.2 The appellant filed with the grounds of appeal a sole claim set amended with respect to the claim sets on which the decision under appeal was based. Compared to these claim sets, the amendments further limited the subject-matter in an attempt to address and overcome the objections under patentability. This was done mainly by adding the features of claim 4 of the claim

sets on which the decision under appeal was based to the independent claims. These amendments set forth the subject-matter of features of claim 1 directed towards the access member (corresponding to feature groups [1.6] and [1.7] of the main request). Therefore, they directly address the grounds of refusal in the contested decision.

- 1.3 With the communication under Article 15(1) RPBA 2020, the Board presented its preliminary opinion that a part of the reasoning with respect to sufficiency of disclosure in the decision under appeal was not convincing. This concerned the objections with respect to feature groups [1.10], [4.13] and [7.13], i.e. those added to the independent claims of the amended main request.
- 1.4 With respect to the features added from the description (*inter alia*, feature groups [1.9] and [1.11]), the Board raised for the first time objections under Article 123(2) and 84 EPC. The appellant had no opportunity to react to these objections other than after notification of the summons. In addition, the Board indicated in the communication accompanying the summons that if the issues under Articles 83, 84 and 123(2) EPC were rectified, it intended to remit the case to the examining division for further prosecution, thus inviting the appellant to submit further amendments.
- 1.5 The amendments submitted with the current main request overcome all objections raised under Article 83, 84 and 123(2) EPC as explained in the following. Furthermore, the former main request was withdrawn, contributing to procedural economy.

- 1.6 In view of these exceptional circumstances, the main request is taken into account in the proceedings under Article 13(2) RPBA 2020.

Sufficiency of disclosure

2. The examining division concluded that the subject-matter of claims 4 and 6 of all requests on which the decision under appeal was based was not sufficiently disclosed.
- 2.1 Due to the deletion of the features of claim 6 of the claim sets on which the decision under appeal was based and the amendments made to current claim 3 (claim 5 of the requests on which the decision was based), the Article 83 EPC objections with respect to an access member controllable in "**at least** the first dimension" as raised by the Board in its communication under Article 15(1) RPBA 2020 and an access member controllable in "the first **and the third dimension**" as raised in the contested decision no longer apply (emphasis added).
- 2.2 The following feature which was subject to the objection under Article 83 EPC in the decision under appeal with respect to claim 4 of all requests at that time is still present in the main request in independent claims 1, 4 and 7 as features [1.10], [4.13] and [7.13]:

"... said aperture is controllable in a first direction and a second direction, wherein said second direction is opposite to said first direction ..."

2.3 The examining division argued that this feature did not sufficiently disclose how the second screen of the access member (in the embodiment of Figure 5, this is the lower screen) could be independently moved upwards against gravity. This argument is not persuasive for the following reasons.

2.4 The first and second (opposite) directions in which the screens are moved are not to be confused with the first, second and third dimensions in which both the transport and the access member can be controlled (see page 22, lines 17 to page 23, line 9). According to the current claims, the screens move in a first and opposite second direction, i.e. **in the first dimension only**.

2.5 Features [1.10], [4.13] and [7.13] are embodied in Figures 5 to 7a by a shutter comprising two screens capable of moving in opposite directions within the first dimension. Figure 7b is not relevant here since it is not an embodiment of the invention. The appellant convincingly argued that the design of a shutter including screens (page 19, lines 6 and 7) sufficiently rigid to enable the upward movement against gravity is within the usual skills of a practitioner (see also D4, paragraph [0026], which further supports this argument). This requirement is also implied for the embodiment depicted in Figure 5 of the application in which the lower second screen 552 is driven by the second roller device 157. The access member of Figure 7a is disclosed to be an embodiment of the access member of the system of Figure 5 (see page 22, lines 1 to 3). It shows that the screens are held in place by a guiding means (704/705) provided at the sides. The skilled person understands immediately from the figures and the text on page 22, lines 3 to 17 that to enable

an upward movement of the second screen, the screen has to be designed accordingly. Such design measures (i.e. using sufficiently rigid and self-supporting materials and providing a suitable connection) are common practice.

Therefore, the invention is sufficiently disclosed in the application as required by Article 83 EPC.

Added matter

3. The main request is allowable under Article 123(2) EPC.

3.1 The features of claim 1 have a basis in the following parts of the application as filed, which are a combination of generic features of the original claims and the features presented as essential for the embodiment according to Figures 5, 6 and 7a:

- [1.1] to [1.5]: Claim 1
- [1.6] and [1.7]: Claim 12
- [1.8]: Claim 15 and page 19,
lines 6 to 9
- [1.9]: Page 20, lines 7 and 8
- [1.10]: Claim 16
- [1.11]: Page 20, lines 11 to 13 and
page 26, lines 9 and 10

3.2 In the most general disclosure of the embodiment on page 19, lines 7 to 8, an access member is defined to comprise a shutter including two screens. The omission of the term "shutter" constitutes, however, no extension of the subject-matter. In the remaining specification, the term is not further specified by additional features. Instead, the term "shutter" is related to the concept of providing an aperture (553,

703); see page 22, lines 1 to 3. Therefore, this term conveys no further technical limitation than already provided by the definition of the two screens, movable in opposite directions to provide an aperture.

3.3 According to the embodiment of Figure 7a and the description, pages 20 and 26, the functional features [1.9] and [1.11] are inherently achievable with the concept of providing two screens which can be controlled in opposite directions. They are not disclosed to require any additional technical features. Consequently, it is directly and unambiguously apparent that their addition to claim 1 without adding further details of the embodiment of Figures 5 to 7a does not constitute an unallowable intermediate generalisation.

3.4 This assessment applies *mutatis mutandis* to the independent method claims 4 and 7, which have analogous amendments.

3.5 To conclude, the subject-matter of claims 1, 4 and 7 does not extend beyond the subject-matter of the application as filed.

Clarity

4. The clarity objection raised by the Board against the main request filed with the statement of grounds of appeal no longer applies due to the deletion of the features in question. The Board does not have any (further) clarity objections to the current wording.

Novelty

5. The subject-matter of claims 1, 4 and 7 is novel over the disclosure of D1.
- 5.1 Features [1.1] to [1.5] are disclosed in D1 as concluded by the examining division in the decision under appeal. Furthermore, features [1.6] and [1.7] are encompassed by the disclosure of D1 (see e.g. Figure 1) in the form of the access member with a first screen ("door 14") capable of selectively providing access to one or more storage locations and movable in opposite directions. This function is also fulfilled by the alternative embodiments of doors disclosed in Figures 11 and 12 of D3 which are incorporated in the disclosure of D1 by reference (D1, paragraph [0008]).
- 5.2 However, none of the access members disclosed in D1 and D3 encompasses features [1.8] to [1.11], i.e. a second screen forming the aperture with the first screen, such that this aperture is movable in a first and opposite second direction to be positioned adjacent to a given storage location and closable in that position.
- 5.3 This also applies for the corresponding features of claims 4 and 7. In addition, the subject-matter of claim 7 provides the further distinguishing method step feature of storing an item. Such a feature is not disclosed in D1 as also noted in the decision under appeal.

Inventive step and remittal of the case

6. Under Article 111(1) EPC, the Board may either proceed with the examination of the application or remit the

case to the department responsible for the decision under appeal for further prosecution. Article 11 RPBA 2020 provides that the Board should not remit a case for further prosecution unless special reasons present themselves for doing so. However, this provision is to be read in conjunction with the principle that the primary object of appeal proceedings is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020).

6.1 In view of the following facts, the Board considers that special reasons as per Article 11 RPBA 2020 are indeed present.

- The invention now claimed has not been considered in the examination proceedings under patentability but was considered as insufficiently disclosed.
- The requirement of Article 56 EPC has not been assessed in the examination proceedings more than cursorily and not in conjunction with the invention now claimed.
- An additional search for further prior art appears to be necessary (see also T 1241/17, Reasons 7.6 and 9 and T 982/18, Reasons 3.1 and 4).

6.2 The invention according to the main request is focused on an embodiment of the access member comprising two screens movable in opposite directions (features [1.8] to [1.11]). This embodiment is substantially based on the features of dependent claim 4 of the claim sets on which the decision under appeal was based. It is further the main embodiment described in the application.

6.3 Although related to this main embodiment, features [1.8] to [1.11] were not considered with respect to

patentability during the examination proceedings. To the contrary, the examining division considered the embodiment of claim 4 (at that time) as not sufficiently disclosed (see point 2.). Therefore, the obviousness of the features of the access member still have to be examined. In the decision under appeal, Article 56 EPC was only invoked for the feature "storing of an item" with respect to independent claim 11 at that time.

- 6.4 The above circumstances indicate the potential necessity of an additional search for relevant prior art documents focusing on access members having two screens movable in opposite directions and providing selective access to storage locations in storage systems. Examples of such potentially relevant disclosures for the assessment of patentability are D4 (cited by the appellant) and D5 (cited in D4).
- 6.5 Considering all this, the case is remitted to the examining division for further prosecution as also requested by the appellant.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



C. Spira

B. Miller

Decision electronically authenticated