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**Datasheet for the decision
of 9 November 2021**

Case Number: T 2904/19 - 3.2.07

Application Number: 03731295.6

Publication Number: 1534478

IPC: B26D7/30, A22C17/00, G01N33/12,
B26D7/18

Language of the proceedings: EN

Title of invention:

Optical grading system and method for slicer apparatus

Patent Proprietor:

Formax, Inc.

Opponents:

Weber Maschinenbau GmbH Breidenbach
TEXTOR Maschinenbau GmbH

Headword:

Relevant legal provisions:

EPC Art. 54, 56, 83, 100(a), 100(b), 100(c), 105, 107, 123(2)
EPC R. 89
RPBA Art. 12(4)
RPBA 2020 Art. 11, 12(2), 12(3), 13(2), 15(1), 25(2)

Keyword:

Sufficiency of disclosure - main request (yes)
Amendments - main request - deletion of features (yes) - added
subject-matter (yes) - broadening of claim (yes) - extension
beyond the content of the application as filed (yes)
Intervention of assumed infringer - notice of intervention
filed after notification of the decision announced at the oral
proceedings before the opposition division - admissible (yes)
Late-filed auxiliary requests - admitted (yes)
Amendment to appeal case - re-ordering of auxiliary requests 6
and 7 - admitted (yes)
Auxiliary request 7 - amendments - added subject-matter (no)
Late-filed evidence - admitted (no)
Inventive step - auxiliary request 7 (yes)

Decisions cited:

G 0003/89, G 0004/91, G 0011/91, G 0002/10, T 0182/89,
T 0019/90, T 0063/06, T 0791/06, T 1297/16, T 0716/17,
T 1937/17

Catchword:



Beschwerdekammern

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Case Number: T 2904/19 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 9 November 2021

Appellant: Weber Maschinenbau GmbH Breidenbach
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Party as of right: TEXTOR Maschinenbau GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 20 August 2019
rejecting the opposition filed against European
patent No. 1534478 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Cano Palmero
 B. Paul

Summary of Facts and Submissions

I. Opponent 01 (appellant) lodged an appeal within the prescribed period and in the prescribed form against the decision of the opposition division rejecting the opposition and maintaining European patent No. 1 534 478 as granted and requested revocation of the patent in suit.

II. The opposition was directed against the patent in its entirety and based on the grounds for opposition pursuant to Articles 100(a), (b) and (c) EPC (lack of novelty and inventive step, lack of sufficiency of disclosure and unallowable amendments).

III. The decision under appeal was announced at the end of the oral proceedings held before the opposition division on 12 June 2019.

Two days later, on 14 June 2019, an intervention of an assumed infringer according to Article 105 EPC was filed. The intervention was directed against the patent as granted on the grounds for opposition pursuant to Articles 100 (a) EPC (lack of novelty and inventive step) and Article 100(c) EPC (unallowable amendments).

IV. With letter of 16 April 2021, the appellant submitted further documents and further requested

that auxiliary requests 1 to 14 not to be admitted in the proceedings, and
that the case be remitted to the opposition division if the patent is not revoked.

V. The patent proprietor (respondent) filed observations with letter dated 28 May 2021 in response to the letter of the appellant of 16 April 2021.

VI. In preparation for oral proceedings, scheduled upon the parties' requests, 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 decision was likely to be set aside,
that the intervention was likely not to be rejected
and
that the case could be remitted to the opposition
division for further prosecution.

VII. Oral proceedings before the Board took place on 9 November 2021. At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes thereof.

VIII. The final requests of the parties are as follows,

for the appellant:

that the decision be set aside and
that the patent be revoked,
or in the alternative,
that the case be remitted to the opposition
division.

for the intervener (opponent 02 and party as of right):

that the patent be revoked.

for the respondent:

that the appeal be dismissed, *i.e.* that the patent be maintained as granted (main request),
or, in the alternative,
when setting aside the decision under appeal,
that the case be remitted to the opposition division for further prosecution of the sets of claims according to auxiliary requests 1 to 14 filed with the reply to the statement of grounds of appeal and to the intervention, with the proviso that auxiliary requests 6 and 7 are re-ordered and,
that the intervention be rejected,
or, in the alternative,
in the event that the intervention is found admissible,
that the case be remitted to the opposition division insofar it relates to the new matters raised in the notice of intervention.

IX. In the present decision reference is made to the following evidence:

Documents which were submitted during opposition proceedings:

D1: EP 0 449 512 A1;
D2: WO 00/61338 A1;
E1: GB 2 239 787 A;
E2: DE 198 20 058 A1;
E9: US 4,519,041;
GRU5: YouTube Video "Cashin® CashinEDGE® HS Retail Bacon Slicing System";
GRU6: YouTube Video "Anco Bacon Slicer";
DEC: Declaration of Mr Lindee.

Document filed for the first time with the intervention and referenced by the appellant in the statement of grounds of appeal:

E16: EP 0 726 098 A2.

Document filed by the appellant with letter of 16 April 2021, *i.e.* after notification of the summons for oral proceedings before the Board:

E41: US 4,016,788.

X. The lines of arguments of the parties relevant for the present decision are dealt with in detail in the reasons for the decision. These lines of arguments are focused on following points:

- sufficiency of disclosure of the patent as granted (ground of opposition under Article 100(b) EPC);
- added subject-matter of the patent as granted (ground of opposition under Article 100(c));
- admittance into appeal proceedings of the attacks on added subject-matter in the patent as granted submitted by the appellant for the first time in appeal proceedings;
- respondent's request for rejection of the intervention;
- admittance into appeal proceedings of auxiliary requests 1 to 14 submitted by the respondent for the first time with the reply to the statement of grounds of appeal and to the intervention;
- added subject-matter of auxiliary requests 1 to 5 (Article 123(2) EPC);
- admittance of the respondent's re-ordering of auxiliary requests 6 and 7;

- added subject-matter of auxiliary request 7;
- admittance of document E41 into the proceedings;
- inventive step of the subject-matter of claims 1 and 9 of auxiliary request 7 (Article 56 EPC) with regard to the following combinations:
 - D1 as closest prior art with E1, with further references to E9 and E41;
 - E1 as closest prior art with D1 or D2, with further reference to E9;
 - E2 as closest prior art with D1 or D2;
 - D1 as closest prior art with E1 and E16/E41 and admittance of this attack into the appeal proceedings; and
- remittal of the case to the opposition division for further prosecution.

XI. Independent **claim 1** according to the **patent as granted** (main request) reads as follows:

"A method of classifying groups of slices cut from a food product and collected in stacks, said method comprising the steps of:

accumulating the removed slices in a stack on the conveyor surface (18,19,24) of a conveyor system;
moving the stack of slices on the conveyor surface of a conveyor system into an image field (49) of a digital image receiving device (30);
generating pixel-by-pixel image data of the top slice of the stack using the digital image receiving device;
determining a surface area of said slice from the data;
determining a fat content of said slice on a pixel-by-pixel basis;

comparing the fat content to at least one predetermined limit;
classifying the stack according to said determined fat content and limit; and
after said classifying step, conveying the stack to a destination according to its classification."

XII. Independent **claim 9** according to **the patent as granted** reads as follows:

"A system for classifying slices from a slicing machine based on fat content, comprising
a slicing apparatus (14) for cutting a series of slices from a food loaf;
a conveyor (18,19,24) arranged to receive slices from the slicing apparatus;
a control (12) having a memory section and a data processing section;
an image capturing device (30) arranged above the conveyor, and signal-connected to the control to input into its memory section a two-dimensional pixel field corresponding to an image captured of a surface area of the slice located on the conveyor (24), each pixel classified by the control as either a fat or lean portion of the surface area, depending on image, the control data processing section being adapted to sum fat pixels and compare the sum of fat pixels to a predetermined limit; and
a classifying conveyor (40) signal-connected to the control, and movable to direct the slice to a destination depending on the number of fat pixels, characterized in that ,
said slice is a top slice of a stack of slices; and
said conveyor (18, 19, 24) is arranged to receive slices from the slicing apparatus in a stack."

XIII. Independent **claim 1** according to **auxiliary request 1** corresponds to claim 1 according to the patent as granted with the additional following feature at the end of the claim:

"...wherein in that the step of classifying is carried out using a classifying conveyor adjustable to direct the stack alternatively to a pass or reject conveyor."

XIV. Independent **claim 1** according to **auxiliary request 2** corresponds to claim 1 according to the patent as granted with the additional following feature at the end of the claim:

"...and weighing the stack at the same time as the step of generating pixel-by-pixel image data."

XV. Independent **claim 1** according to **auxiliary request 3** corresponds to claim 1 according to the patent as granted with the additional following feature at the end of the claim:

"...and wherein the stack is classified according to the classification of the top slice of the stack and the top slice of a preceding stack."

XVI. Independent **claim 1** according to **auxiliary request 4** corresponds to claim 1 according to the patent as granted with the additional following feature at the end of the claim:

"...and wherein local areas constituting flaws in the slice are quantified in size by calculating and summing adjacent non-lean pixels and are then compared to a limit."

XVII. Independent **claim 1** according to **auxiliary request 5** corresponds to claim 1 according to the patent as granted with the additional following amendment at the beginning of the claim (emphasis added by the Board):

"A method of classifying groups of slices cut from a food product and collected in stacks, said method comprising the steps of:
accumulating the removed slices in a straight stack on the conveyor surface (18,19,24) of a conveyor system; ..."

XVIII. Independent **claim 1** according to **auxiliary request 7** reads as follows (the amendments with respect to claim 1 as granted are emphasized by the Board):

"A method of classifying groups of slices cut from a food product and collected in stacks, said method comprising the steps of:
removing slices from a food product by cutting,
accumulating the removed slices in a stack on the conveyor surface (18,19,24) of a conveyor system;
moving the stack of slices on the conveyor surface of a conveyor system into an image field (49) of a digital image receiving device (30);
generating pixel-by-pixel image data of the top slice of the stack using the digital image receiving device;
determining a surface area of said slice from the data;
determining a fat content of said slice on a pixel-by-pixel basis;
comparing the fat content to at least one predetermined limit;
classifying the stack according to said determined fat content and limit; and
after said classifying step, conveying the stack to a destination according to its classification."

- XIX. Independent **claim 9** according to **auxiliary request 7** is identical to claim 9 according to the patent as granted.
- XX. As the wording of auxiliary requests 6 and 8 to 14 is not relevant for this decision, it is not necessary to reproduce them here.

Reasons for the Decision

1. *Transitional provisions*

The appeal proceedings are governed by the revised version of the Rules of Procedure which came into force on 1 January 2020 (Articles 24 and 25(1) RPBA 2020), with the exception of Article 12(4) to (6) RPBA 2020 instead of which Article 12(4) RPBA 2007 remains applicable (Article 25(2) RPBA 2020).

2. *Request for rejection of the intervention - Article 105 EPC and Rule 89 EPC*

2.1 The respondent requested that the intervention be rejected since it deals with with new matters on which the decision is not based, therefore the requirements of Article 12(2) RPBA 2020 are not met.

2.2 The Board disagrees for the following reasons.

The decision under appeal was announced at the end of the oral proceedings held before the opposition division on 12 June 2019. Two days later, on 14 June 2019, the intervention of an assumed infringer according to Article 105 EPC was filed. The

intervention meets the formal requirements and is substantiated and therefore is seen as admissible in the sense of Rule 89 EPC. In accordance with G 4/91, point 6 of the reasons, in this particular situation where an intervention is filed after the opposition division announced its decision and where a party to the opposition proceedings files an appeal, the notice of intervention will be deemed to be filed in appeal proceedings, see also T 791/06 of the same Board in different composition, point 2.2 of the reasons.

2.3 Therefore, the Board concludes that the intervention cannot be rejected and that it forms part of the proceedings.

3. *Patent as granted - Sufficiency of disclosure, Articles 100(b) and 83 EPC*

3.1 The appellant argued in point I of the statement of grounds of appeal that the invention is not sufficiently disclosed, since the skilled person does not have sufficient information to carry out the invention, in particular how to determine where a top slice of a **shingled** stack is located, in particular how to determine its boundary, which is necessary to be able to determine its surface area as claimed. In particular, the appellant argued that the requirement of sufficiency must be complied with as of the date of first filing of the patent in suit (in this case April 2002). The appellant held that the technology of image recognition in the year 2002 was without any doubt not advanced enough to carry out a determination of the surface area or the fat content of the top slice of a shingled stack. The provisions of Article 83 EPC are thus not met.

- 3.2 The Board disagrees. As correctly put forward by the respondent, according to the established case law an objection of lack of sufficiency disclosure presupposes that there are serious doubts substantiated by verifiable facts. The burden of proof is upon the opponent to establish on the balance of probabilities that a person skilled in the art, using his common general knowledge, would be unable to carry out the invention (see the Case Law of the Boards of Appeal [CLB], 9th edition 2019, II.C.9, first two paragraphs, in particular in relation to T 19/90 and T 182/89).
- 3.3 In this respect, the appellant argued that in cases as the present one, in which the patent does not give any information as how a feature of the invention can be put into practice, the opponent can discharge its burden by plausibly arguing that common general knowledge would not enable the skilled person to put this feature into practice (see CLB, *supra*, third paragraph, in particular in relation to T 63/06).
- 3.4 The Board cannot agree with the appellant that the patent does not give any information as to how to carry out the determination of the surface area of the top slice in the particular case of a shingled stack of slices. Contrary to the appellant's view, paragraph [0021] of the patent in suit describes the image processing system including a camera and a light source. In paragraph [0025] it is described that the slice perimeter or boundary dimensions are determined due to the brightness or color contrast between the slice and the weigh scale belting. In view of this information provided by the patent, the Board sees no justification that could amount to the appellant being discharged from its burden of proof.

3.5 The Board is not convinced that the skilled person, even in situations of shingled stacks, would not have been able, also at the date of first filing, of determining the perimeter of the top slice with the equipment and the data analysis described in the patent without undue burden, in particular when making use of the image processing system described in the patent. The statements of the appellant that "[i]n the relevant year 2002, image recognition software having this capability was not available" and the allegation that the skilled person would be unable to determine the boundary of the top slice of a shingled stack on that date remain mere assertions that cannot amount to verifiable facts substantiating serious doubts that could justify an objection on sufficiency of disclosure.

3.6 In order to support the parties' arguments on how precise the positioning of the slices is when forming a stack, they relied upon the evidence GRU5, GRU6, the declaration of Mr. Lindee (DEC), which with no obvious error in the exercise of the opposition division's discretion were not admitted into the opposition proceedings (see points 1 and 2 of the reasons of the decision under appeal). The Board notes that **the degree of preciseness of the positioning of the slices in the shingled stack is not relevant for the question on sufficiency of disclosure in the present case**, which is rather focused on the question whether the skilled person could carry out the step of determining the perimeter and surface area of the top slice with the image processing system and an analysis on the digital image data as described in the patent(see points 3.1 to 3.5 above). Hence, the question of the admittance of GRU5 and GRU6 and Mr. Lindee's declaration (DEC),

remains irrelevant for the revision of the decision under appeal on the issue of sufficiency of disclosure.

3.7 In view of the above, the Board concludes that the reasoned finding of the opposition division according to which the patent as granted meets the requirements of Article 83 EPC and that the ground for opposition pursuant to Article 100(b) EPC does not prejudice the maintenance of the patent as granted has not been convincingly rebutted by the appellant.

4. *Patent as granted - Added subject-matter, Articles 100(c) and 123(2) EPC*

4.1 The appellant is of the view in point II.1 of their statement of grounds of appeal that the omission of the feature (a) "removing a slice from a food product by cutting" in claim 1 as granted contravenes Article 123(2) EPC.

4.1.1 The "gold standard" as established by the Enlarged Board of Appeal in opinion G 3/89 and in decisions G 11/91 and G 2/10 and confirmed in other decisions of the Enlarged Board of Appeal and of the Boards of Appeal (see CLB, *supra*, II.E.1.3.1 and 1.4.2) requires that any amendment must be directly and unambiguously derivable, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application as filed.

4.1.2 According to point 2.3.1 of the reasons of the decision under appeal, the omission of the cutting step was justified and did not represent new (technical) information for the skilled person, since in original claim 1 and description page 2, last paragraph, the method was identified as a "method of classifying

slices ... ". The opposition division concluded that the cutting step was never intended to restrict the scope of claim 1 and confirmed by the definition of the objective problem on paragraph [0004], so that "the replacement of the cutting step by the accumulation step in granted claim 1 relates more to a clarification of granted claim 1". The respondent further argued that a patent proprietor should be entitled to focus on the invention and on the inventive contribution, in the present case focusing on the features relating to the classification of the groups of slices. Therefore, the omission of the cutting step was justified.

4.1.3 The Board cannot agree with this finding of the opposition division and with the argument of the respondent. In the present case, due to the omission of the cutting step, the subject-matter of claim 1 as granted now covers at least the additional possibility that the method starts from stored slices or stacks of slices that have been previously removed from a food product by cutting. This holds true irrespective of the fact that the method is presented as a method for classifying slices. Consequently, the subject-matter of claim 1 as granted seeks protection for methods with and without a cutting step, whereas the original disclosure covered only methods with a cutting step. As correctly set forth by the appellant in point II.1 of their statement of grounds of appeal, in the original application as filed, there is no basis for removing the cutting step from the independent claims that could justify such an amendment.

4.1.4 The respondent further argued that in any case, since claim 1 as granted deals with a method of classifying slices **cut** from a food product, the step of removing slices from a food product is implicitly included in

the subject-matter of the claim, so that the originally disclosed feature has not been effectively removed.

4.1.5 The Board again disagrees. It is not disputed, as stated by the respondent, that the slices originate from a food product. The Board sees however, that the cutting step is not implicitly derivable from the wording of claim 1 as granted, which covers the possibility of applying the method to already removed (or cut) slices or stacks of slices whereas the only possibility originally disclosed is that the starting point for the claimed method and apparatus is a loaf of food product followed by a separation step of the slices by cutting.

4.1.6 The Board thus concludes that the omission of the feature (a) "removing a slice from a food product by cutting" in claim 1 as granted extends beyond the original disclosure, contrary to the requirements of Article 123(2) EPC so that the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted already for this very reason.

4.2 The appellant and the intervener (see point II.1.1 of the notice of the intervention) additionally argued that the introduction of the term "**conveyor surface**" in claim 1 as granted results in an extension of subject-matter, contrary to the requirements of Article 123(2) EPC.

4.2.1 The respondent requested not to admit this line of attack as it was not dealt with in the decision under appeal.

4.2.2 The Board is however of the view that, even in the case that this line of attack of the appellant was to be

admitted into the proceedings and bearing in mind that it was also submitted by the intervener, the amendment with regard the conveyor surface would still not prejudice the patent as granted under Articles 100(c) and 123(2) EPC. Indeed, the Board concurs with the findings of the opposition division in points 2.1.1 to 2.1.3 of the reasons for the decision under appeal that although the term "surface" is not used *verbatim* in the original description, it does not constitute an unallowable amendment because page 6, line 6 gives a clear and unambiguous basis for this expression. In particular, the term "deposited" implies a receiving surface for the conveyor.

4.3 The appellant additionally submitted in point II.2 of the statement of grounds of appeal and during the oral proceedings before the Board that the amendments carried out in **claims 1 and 9** of the patent as granted with regard to the **number of conveyors** results in an extension of subject-matter, contrary to the requirements of Article 123(2) EPC. The appellant indicated that, although this line of attack had been raised for the first time in appeal proceedings, this objection was a mere development of the objection raised in the notice of intervention, which could be applied for the same *prima facie* arguments to claim 9 as granted and requested the Board to exercise its discretion to admit it under Article 12(4) RPBA 2007.

4.3.1 The Board is not persuaded by the arguments of the appellant and concurs with the respondent that the line of attack based on the number of conveyors is a distinct line of attack from the one relating to the conveyor surfaces. Furthermore, the allowability of the amendment carried out on claim 9 has been also objected to for the first time in appeal proceedings. The Board,

considering that the main aim of appeal proceedings is that of reviewing the decisions of the administrative departments of the EPO (cf. Article 12(2) RPBA 2020) does not consider it appropriate that the appellant raises new lines of attack in appeal, thereby avoiding having a decision from the competent EPO department.

4.3.2 The Board, following the request of the respondent, and exercising its discretion under Article 12(4) RPBA 2007, does not admit the line of attack with regard to the number of conveyors in granted claims 1 and 9.

4.4 In view of the above (see point 4.1.6), the Board concludes that the appellant has convincingly demonstrated the incorrectness of the decision under appeal as regards the ground of opposition under Article 100(c) EPC with regard to the omission of the feature (a) "removing a slice from a food product by cutting" in claim 1 as granted extends. Consequently, **the decision under appeal must be set aside.**

5. *Auxiliary requests 1 to 14 - Admittance, Article 12(4) RPBA 2007*

5.1 The appellant requested in point 2 of its letter of 16 April 2021 and during oral proceedings before the Board that auxiliary requests 1 to 14 not be admitted in appeal proceedings in view of Article 12(4) RPBA 2007. In particular, the appellant indicated that the respondent could have presented these auxiliary requests during opposition proceedings, since the objections against the patent as granted were already known by the respondent and that it had several opportunities to present auxiliary requests in an attempt to overcome those objections, thereby giving the opportunity to the then opponent to provide

evidence and arguments in response. In contrast, the respondent merely chose to request the rejection of the opposition.

5.2 The Board is not convinced by these arguments.

In the case at hand, new matters have been raised in view of the notice of intervention, which was filed after oral proceedings before the opposition division were held. The respondent was thus not in place of reacting to these new matters during opposition proceedings with arguments and/or auxiliary requests.

The Board concludes that due to the course of the opposition proceedings and the subsequent intervention, the filing of auxiliary requests 1 to 14 with the reply to the statement of grounds of appeal and to the intervention, where the respondent is required to form its complete appeal case in the sense of Article 12(3) RPBA 2020, was, in the present case, an appropriate point of time to present the auxiliary requests. In view of these particular circumstances, the Board, exercising its discretion under Article 12(4) RPBA 2007, admits auxiliary requests 1 to 14 into the appeal proceedings.

6. *Auxiliary requests 1 to 5 - Added subject-matter, Article 123(2) EPC*

6.1 Claim 1 of auxiliary requests 1 to 5 contain the same deficiency with respect to Article 123(2) EPC as claim 1 of the patent as granted, due to the omission of the feature "removing a slice from a food product by cutting".

6.2 For the same reasons mentioned in points 4.1.1 to 4.1.6 above with respect to the patent as granted, the Board concludes that none of auxiliary requests 1 to 5 meets the requirements of Article 123(2) EPC due to the omission of the feature "removing a slice from a food product by cutting" in claim 1 of auxiliary request 1 to 5.

7. *Re-ordering of auxiliary requests 6 and 7 - Admittance, Article 13(2) RPBA 2020*

7.1 During the oral proceedings before the Board, the respondent requested that auxiliary requests 6 and 7 be re-ordered to the effect that auxiliary request 7 was to be dealt with prior to auxiliary request 6.

7.2 The appellant and the intervener objected to this re-ordering indicating that this constituted an amendment to the respondent's appeal case, and requested that the re-ordering not be admitted under Article 13(2) RPBA 2020.

7.3 The Board agrees with the appellant and the intervener that by changing the order of the claim requests already on file, and since this re-ordering has been carried out after notification of the summons before the Board, the respondent put itself in a situation in which the provisions of Article 13(2) RPBA 2020 were to be applied as for the filing of a completely new set of claim requests (see T 1297/16, point 4.1 of the reasons, T 167/17, points 2 and 3 of the reasons, T 716/17, point 9 of the reasons).

7.4 The Board notes that in decision T 1297/16 (point 4.3 of the reasons) the re-ordering of requests was admitted under Article 13(2) RPBA 2020, whereas it was

not admitted in the other two decisions (T 167/17, point 5.5 of the reasons, T 716/17, point 9 of the reasons).

- 7.5 The Board notes further that both auxiliary requests 6 and 7 had been filed for the first time with the reply to the statement of grounds of appeal and to the intervention. As correctly indicated by the respondent, in view of the intermediate decisive conclusions reached by the Board, that claim 1 according to the patent as granted and to auxiliary requests 1 to 5 did not meet the requirements of Article 123(2) EPC, both auxiliary requests 6 and 7 appeared to *prima facie* overcome this objection either by cancellation of the claim in question (auxiliary request 6) or by amendment of the claim (auxiliary request 7).

In analysing the case the Board finds the procedural situation underlying T 1297/16 rather comparable to the situation of the case at hand, which is to be distinguished from the specific procedural situations underlying T 167/17 and T 716/17.

In the present case the re-ordering of auxiliary requests 6 and 7 does not add anything as regards the assessment of compliance with the requirements of Article 123(2) EPC and, thus, is not to the detriment of procedural economy. The Board agrees with the respondent that due to the course of the proceedings, the case could be indistinctly continued with either auxiliary request 6 or 7 without entailing a substantive impact in the procedural economy.

- 7.6 In view of these specific circumstances, the Board considers the respondent's reasons to be cogent justifying exceptional circumstances and hence decided

to admit the re-ordering of auxiliary requests 6 and 7 into the proceedings, with the effect that auxiliary request 7 was dealt with prior to auxiliary request 6.

8. *Auxiliary request 7 - Added subject-matter, Article 123(2) EPC*

8.1 The appellant argued that the subject-matter of claim 1 according to auxiliary request 7 extended beyond the original disclosure, since original claim 1 only discloses "removing a slice" (singular) and then processing that singular slice, while amended claim 1 according to auxiliary request 7 requires "removing slices" (in plural). Furthermore, there is no basis in the original disclosure of a combination of the steps "removing slices" (in plural) with the step of "accumulating the removed slices".

8.2 In this respect, the respondent requested that the part of the appellant's objection relating to the feature of "accumulating the removed slices" not be admitted into the proceedings, since this feature had not been objected to for the patent as granted although the feature was already present.

8.3 Even if all of the appellant's objections were to be admitted into the proceedings, the Board does not find the arguments of the appellant convincing on their substance.

8.3.1 As correctly indicated by the respondent, the Board sees that original claim 6, which discloses a slicing apparatus and a conveyor arranged to receive slices from said slicing apparatus provides sufficient basis for amended claim 1, *i.e.* the wording of original claim 6 implies a direct and unambiguous disclosure of the

combination of the steps of removing slices (in plural) and accumulating such slices.

8.3.2 For completeness, the Board notes that the original description page 6, lines 4 to 6, could also be considered as sufficient basis for the amendment, since the passage contains directly and unambiguous disclosure of the combination of features objected to by the appellant.

8.3.3 Therefore, the Board is not convinced by the appellant's objections on added the subject-matter of claim 1 of auxiliary request 7, even if all these objections were to be admitted into the proceedings.

9. *Auxiliary request 7 - Inventive step, Article 56 EPC*

The appellant argued that the subject-matter of claims 1 and 9 according to auxiliary request 7 was not inventive in view of the following combinations of the teachings of

- D1 as closest prior art with E1, with further references to E9 and E41;
- E1 as closest prior art with D1 or D2, with further reference to E9;
- E2 as closest prior art with D1 or D2;
- D1 as closest prior art with E1 and E16/E41.

9.1 *Admittance of document E41 - Article 13(2) RPBA 2020*

9.1.1 Document E41, which was relied upon by the appellant in its argumentation presented during oral proceedings before the Board on lack of inventive step of the subject-matter of claims 1 and 9 of auxiliary request 7, was filed by the appellant with letter dated

16 April 2021, *i.e.* after notification of the summons for oral proceedings before the Board. Its admittance into the proceedings is thus subject to Article 13(2) RPBA 2020, which foresees the admittance of late-filed submissions only if there are exceptional circumstances, which have been justified by cogent reasons.

9.1.2 The Board, in the absence of any cogent reasons provided by the appellant that could justify exceptional circumstances, and following the request of the respondent, does neither admit document E41 nor the lines of attack based on this document into the proceedings.

9.2 *Document D1 as closest prior art*

9.2.1 It is common ground that the subject-matter of claims 1 and 9 of auxiliary request 7 differs from the known method and system of **D1** at least in the step of generating pixel-by-pixel image data **of the top slice of the stack** using the digital image receiving device, and in the image capturing device **capturing an image of a surface area of a top slice of a stack of slices** located on the conveyor. In contrast, D1 teaches to capture the cut face of a product while being sliced.

9.2.2 According to the appellant, this distinguishing feature would enable a longer shutter time, which results in a higher image quality compared to taking a picture of the cut face in the short time span between the passages of the rapidly rotating slicing blade as in **D1**. The objective problem to be solved should be seen as to provide a more accurate weight control at high slicing speeds.

9.2.3 The appellant further argued that the skilled person, starting from **D1** as closest prior art and in view of the technical problem to be solved, would be aware of the teaching of **E1**, namely to scan a top slice on the conveyor belt instead of the cut face, thereby arriving at the subject-matter of claim 1 according to auxiliary request 7 in an obvious manner. In order to illustrate how a scanner works, which according to the appellant is general knowledge of the skilled person, reference was made to document **E9**.

9.2.4 As for **claim 9**, the appellant pointed out that even in case that the features regarding to the classifying conveyor could be considered as not being anticipated by document **D1**, these alleged distinguishing features would be related to the separate problem of enabling a downstream classification conveyor which is unrelated and has no functional interdependency with the problem solved by the features relating to the scanning of the top slice on the conveyor belt.

Consequently, a partial problem approach could be used in this case. The partial unrelated problem solved by these alleged distinguishing features could be seen as how to convey stacks of slices to different locations depending on their classification, which is obvious in view of the teaching of **E16**, which discloses a classifying conveyor in a conveyor system for a food product machine directed to the same technical problem. Consequently, claim 9 according to auxiliary request 7 is not obvious in view of the teachings of **D1** with **E1** and **E16**.

9.2.5 The Board is not persuaded by the arguments of the appellant. As correctly indicated by the respondent, the teaching of **E1** is not compatible with the system of

D1, which requires that the information obtained from the image of the food product is used in a closed control loop to adjust the slicer feed and the thickness of the subsequent slice to be separated to produce slices of constant weight (see **D1**, column 3, lines 48 to 54). In contrast, **E1** is concerned with producing packs of food slices of a controlled weight, in which each of the slices are of a similar thickness (see **E1**, page 7, lines 20 to 26), *i.e.* the thickness of the individual slices is not adjusted at all. Already for this fact, the Board is convinced that the skilled person, starting from **D1**, would not look to **E1**, since, as correctly reasoned by the opposition division in points 2.2.1 and 2.2.3 of the decision under appeal, by applying the teaching of **E1**, the slice-by-slice control of **D1** would be lost. The Board notes that this incompatibility between the teaching of **E1** and the system of **D1** is independent of the skilled person's general knowledge of how scanner works and therefore independent of the appellant's reference to **E9**.

9.2.6 The Board thus concludes that starting from **D1** as closest prior art, the skilled person, in view of the teaching of **E1**, would not arrive at the subject-matter of claim 1 according to auxiliary request 7 in an obvious manner. As far as the respondent objected to taking document **E9** and the respective appellant's line of arguments into account, there is no need to decide on their admittance, because the conclusion that the subject-matter of claim 1 of according to auxiliary request 7 is inventive in view of this combination would still hold even if they were to be admitted.

9.2.7 As regards claim 9 of auxiliary request 7, the respondent requested not to admit the partial problem approach and the teaching of **E16** presented by the

appellant for the first time with the statement of grounds of appeal. The Board however notes that in view of the decisive conclusions of point 9.2.6 above, and at least for the same reasons, even if document **E16** and the partial problem approach would be admitted, the skilled person would still not arrive at the subject-matter of claim 9 according to the auxiliary request 7 in an obvious manner in view of the combination of **D1** as closest prior art in combination with the teachings of **E1** and **E16** solving partial problems, at least since the combination of the teachings of **D1** and **E1** is not obvious.

9.3 *Documents E1 or E2 as closest prior art*

9.3.1 It is common ground that hat the subject-matter of claims 1 and 9 of auxiliary request 7 at least differs from the known method and system of either **E1** or **E2** in that no fat determination on a pixel-by-pixel basis of the top slice of the stack takes place, such determination being carried out by the image capturing device and control. In contrast, **E1** and **E2** determine the surface area of the slices.

9.3.2 According to the appellant, this distinguishing feature provides a more refined and upgraded determination not only of the weight, but also of the fat content of the slices. The objective technical problem to be solved could be seen as to provide a more efficient and reliable system for classifying groups of slices of food product during high speed processing.

9.3.3 The appellant further argues that the skilled person, starting from any of documents **E1** or **E2** and in view of the objective technical problem, would consider the teachings of either **D1** or **D2**, both of them suggesting

the use of such a pixel-by-pixel fat content determination of the slices of a food product through a scanner, and would thereby arrive at the subject-matter of claims 1 and 9 according to auxiliary request 7 without exercising inventive skills. In order to illustrate how such a scanner works, which according to the appellant is general knowledge of the skilled person, reference was again made to document **E9**.

- 9.3.4 The Board is not persuaded by the arguments of the appellant for the following reasons. As correctly indicated by the respondent, both **E1** and **E2** are silent in the determination of the fat content at all, and rather focus in the determination of the surface area or of the edge contour of the slices in order to provide slices of constant weight. The Board is convinced that the skilled person would not be motivated to implement a much more complex control based in pixel-by-pixel fat determination of the slices, specially when the weight determination is already achieved by a simpler solution such as determining the surface or the edge contour of the top slice of the stack. It follows that the incorporation of the pixel-by-pixel fat determination of either **D1** or **D2** into the method and system of **E1** or **E2** can only be seen as the result of an *ex post facto* analysis. Moreover, it must be stressed that the control loop of **D1**, in which the thickness is adjusted for every slice of food product, and the quality control of **D2**, which serves for a different purpose than weight controlling, are both incompatible with the controls of either **E1** or **E2**. Similarly as in points 9.2.5 and 9.2.6 above, the Board notes that this conclusion holds true even if the skilled person's general knowledge of how scanner works and the appellant's reference to **E9** was to be considered into the proceedings, so that their

admittance, which has been objected by the respondent, does not need to be decided upon.

9.3.5 The Board thus concludes that starting from either **E1** or **E2** as closest prior art, the skilled person, in view of the teachings of either **D1** or **D2**, would not arrive at the subject-matter of claims 1 and 9 according to auxiliary request 7 in an obvious manner.

9.4 It follows that the appellant has not provided admissible objections and/or convincing arguments that would demonstrate that the subject-matter of claims 1 and 9 according to auxiliary request 7 lacks an inventive step in the sense of Article 56 EPC.

10. *Remittal of the case to the opposition division - Article 11 RPBA 2020*

10.1 The respondent requested that, in the event that the intervention would be considered, the case be remitted to the opposition division insofar it relates to the new matters raised in the notice of intervention (point 4 of the reply letter).

10.2 The appellant requested that, in the event that the Board would not fully revoke the patent, the case be remitted to the opposition division "such that patentability in view of the facts and evidence from the intervention may be examined" (point 3 of the letter dated 16 April 2021).

10.3 The intervener confirmed that it had objections to the claimed subject-matter of auxiliary request 7 other than the appellant's objections. The intervener also requested that the case be remitted to the opposition

division (page 7 of the minutes of the oral proceedings before the Board).

- 10.4 The Board, following the procedurally active requests of all parties, and in view of the **additional objections, facts, arguments and evidence** originated by the intervention and the reply of the respondent, finds a remittal of the case to the opposition division appropriate, for the following reasons.
- 10.5 The primary task of the Boards of Appeal is to review the decision of the department of the administrative departments of the EPO. The additional facts, evidence, arguments and the objections relied upon by the intervener have not been examined by the opposition division. While taking account of the legislator's intention that Article 11 RPBA 2020 aims at reducing the likelihood of a "ping-pong" effect between the Boards and the administrative departments of the EPO and at avoiding an undue prolongation of the entire proceedings before the EPO, the particular circumstances of the present case, in particular in view of the filing of an intervention after the decision under appeal had been announced by the opposition division, call for remitting the case to the opposition division.
- 10.6 The Board thus concurs with the parties who concordantly requested that the case be remitted to the opposition division and concludes that new facts, evidence, arguments and objections filed with the intervention, in combination with the new auxiliary requests filed by the respondent cannot be decided without an undue burden for all parties and the Board, amount to special reasons in the meaning of Article 11

RPBA 2020 that, hence, **justify a remittal to the opposition division for further prosecution.**

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 Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated