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**Datasheet for the decision
of 29 October 2021**

Case Number: T 0471/20 - 3.2.07

Application Number: 13003671.8

Publication Number: 2657138

IPC: B65B5/10, B65B35/04, B65G47/90

Language of the proceedings: EN

Title of invention:
A food product handling system

Patent Proprietor:
Formax, Inc.

Opponent:
Weber Maschinenbau GmbH Breidenbach

Headword:

Relevant legal provisions:
EPC Art. 69(1), 100(c), 111(1), 112(1)(a), 113(1), 116(1),
123(2)
RPBA 2020 Art. 11, 12(8)

Keyword:

Decision taken in written proceedings - (yes)
Grounds for opposition - extension of subject-matter (no)
Referral to the Enlarged Board of Appeal - (no)
Remittal - special reasons for remittal

Decisions cited:

T 0503/96, T 0500/01, T 0061/03, T 0725/05, T 0452/08,
T 1227/10, T 1147/11, T 2450/17, G 0002/10

Catchword:



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Case Number: T 0471/20 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 29 October 2021

Appellant: Formax, Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 10 February
2020 revoking European patent No. 2657138
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Pieracci
V. Bevilacqua

Summary of Facts and Submissions

- I. The patent proprietor (appellant) 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. 2 657 138.
- II. The opposition had been filed against the patent as a whole based on all grounds for opposition pursuant to Article 100 EPC (lack of novelty and inventive step, insufficiency of disclosure and added subject-matter). The opposition division found that the ground for opposition pursuant to Article 100(c) EPC prejudiced the maintenance of the patent as granted. Since the auxiliary requests were found to be either not admissible or not allowable the opposition division revoked the patent.
- III. With the statement setting out the grounds of appeal the appellant (patent proprietor) requested
- that the appealed decision be set aside and
that the opposition be rejected, *i.e.* that the
patent be maintained as granted,
or in the alternative,
that oral proceedings be arranged,
or in the further alternative,
that the patent be maintained in amended form
according to auxiliary requests A, A amended, A.1,
B, C, C.1, D to I, I.1 and J, wherein
auxiliary requests A and C were filed in opposition
proceedings with submissions dated
4 September 2019,
auxiliary request C1 was filed together with the
statement setting out the grounds of appeal,

auxiliary requests A, amended A1, and I.1 were filed at the oral proceedings before the opposition division, and auxiliary requests B, D to I and J were filed with the reply to the notice of opposition, or in the further alternative, that the case be remitted to the opposition division for further prosecution.

IV. With the reply to the statement setting out the grounds of appeal the respondent (opponent) requested:

that the appeal be dismissed,
or in the alternative,
that oral proceedings be arranged.

V. The Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Rule 100(2) EPC. The Board indicated that the ground for opposition according to Article 100(c) EPC did not appear to prejudice the maintenance of the patent in suit. The Board also indicated that a decision could be taken in the written procedure should the parties withdraw their requests for oral proceedings and that it intended to remit the case to the opposition division for further prosecution.

VI. With letter dated 9 March 2021 the appellant indicated that it agreed to the decision being taken in the written procedure and that it no longer requested oral proceedings should the Board remit the case to the opposition division for further prosecution.

VII. With letter dated 8 July 2021 the respondent agreed to the decision being taken in the written procedure while

providing further arguments against the patent as granted and requesting a referral to the Enlarged Board of Appeal should the Board not share its interpretation of the case law.

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

IX. Claim 1 of the patent as granted reads:

A food product position vacancy reduction system, comprising :

- a) a main conveyor (120) configured to move food products (150),
- b) a food product parking station (230) configured to holding food products (150);
- c) a vacancy detector (210, 214a, 214b) configured to detect a vacant food product position on the main conveyor (120);
- d) a robot (200) having a working range for moving between the food product parking station (230) and the main conveyor (120);
- e) a controller (180), wherein
 - e1) the controller (180) is signal-connected to the vacancy detector (210, 214a, 214b) and configured to receive a signal from the vacancy detector (210, 214a, 214b) indicating a vacant food product position on the main conveyor (120), and
 - e2) the controller (180) is signal-connected to the robot (200) and having control instructions for instructing the robot (200) to move the food product (150) from the food product parking station (230) to the vacant food product position on the main conveyor (120).

- X. In view of the decision taken by the Board there is no need to reproduce the claims of the auxiliary requests.

Reasons for the Decision

1. The decision is issued in written proceedings without oral proceedings.

According to Article 12(8) RPBA 2020, the Board may in *inter partes* proceedings, subject to Articles 113 and 116 EPC, decide the case at any time after the expiry of the period for filing the reply to the statement of grounds of appeal.

Given the agreement of the parties to a decision in written proceedings (see the appellant's letter dated 9 March 2021 and the respondent's letter dated 8 July 2020, page 2, first paragraph under point 1) the parties' auxiliary requests for oral proceedings filed with the statement setting out the grounds of appeal and the reply thereto are no longer relevant.

The case is ready for decision on the basis of the parties' written submissions and the decision under appeal.

For this reason, the issuing of the decision in written procedure without oral proceedings is in compliance with the requirements of Articles 113(1) and 116(1) EPC.

2. Added subject-matter of claim 1 of the patent as granted (Articles 100(c) and 123(2) EPC)

2.1 The Board shares the view of the appellant (see point 3 of the statement setting out the ground of appeal), that the introduction during examination proceedings of paragraph [0012] of the description of the patent in suit, namely:

"Finally, EP 0803 440 A1 discloses an alternative solution for providing a completed product stream with the help of a filling unit, which is not a robot",

does not cause the subject-matter of the patent in suit to extend beyond the content of the application as filed.

2.2 The Board cannot share the finding of the opposition division (see third and fifth paragraph of point 2.2 of the reasons for the decision), that

"... the statement that the filling unit disclosed in D8 [EP 0803 440 A1] 'is not a robot' is not merely a factual description of the disclosure of D8, but is to be considered a subjective statement which, when the claims are interpreted in the light of the description (Art. 69(1) EPC) disclaims a part of the scope which claim 1 would otherwise cover when the term 'robot' is interpreted according to the common understanding in the art ...",

and that

"... Consequently, the addition which has been made during the examination procedure of a particular interpretation of the term 'robot' and which excludes a

particular piece of prior art must be regarded as contravening Art. 123(2) EPC because there is no basis in the application as filed for this added definition."

- 2.3 The Board finds that, independently from whether the statement in paragraph [0012] of the patent in suit is correct or not, *i.e.* whether it provides a "subjective" rather than a "factual" description of the disclosure of D8 as argued by the opposition division, paragraph [0012] has no effect on the interpretation of the claims, since there is no indication in the patent in suit which would lead the person skilled in the art using the common general knowledge, to interpret the claims in a way somehow linked to the prior art acknowledged in the description, nor is there a basis in the EPC for doing so.

Article 69(1) EPC, invoked by the opposition division, does not provide such a basis since it relates to the extent of protection conferred by the claims.

- 2.4 The Board concurs with the respondent (see page 13, third and fourth paragraph of the reply to the statement setting out the grounds of appeal) referring to the Case Law of the Boards of Appeal [CLB], 9th edition, 2019, II.E.1.14.4, and in particular to T 0500/01 that an amendment which defines a term of a claim in a way which has no basis in the originally filed application could contravene Article 123(2) EPC. However, as indicated above, paragraph [0012] of the patent in suit does not provide such a definition.

- 2.5 The Board cannot follow the further argument of the respondent (see letter dated 8 July 2021, page 3, first paragraph, - page 4, first paragraph) that paragraphs

[0011] and [0012] of the patent specification define the term robot and that since there is no later redefinition of that term in the patent specification this constitutes a direct and unambiguous indication that paragraphs [0011] and [0012] should be used to interpret the claims.

- 2.6 This argument is based on the assumption that paragraphs [0011] and [0012] provide a definition of the term robot to be used for interpreting the claims; this however is not correct (see point 2.3 above). This argument is therefore also not convincing.
- 2.7 The Board thus cannot follow the finding of the opposition division (see point 2.2 of the reasons for the decision) and the argument of the respondent (see point B.1.1.4 of the reply to the statement setting out the grounds of appeal and point 2 of the respondent's letter dated 8 July 2021) that paragraph [0012] of the patent in suit is relevant for the interpretation of claim 1 and that consequently subject-matter has been added extending beyond the content of the application as filed.
- 2.8 In view of the above, it is not necessary to address the issue of whether the acknowledgement of the prior art in paragraph [0012] of the patent in suit is correct.
- 2.9 The Board therefore concludes that the ground of opposition according to Article 100(c) EPC does not prejudice the maintenance of the patent in suit and that the appealed decision cannot be upheld.

3. Request of referral to the Enlarged Board of Appeal

3.1 The respondent (see point 2.3 of the letter dated 8 July 2021) referring to decisions T 0500/01, T 0725/05, T 0452/08, T 2450/17, T 1227/10, T 0061/03 and T 1147/11 alleges that legal standards exist in the EPC for addressing the issue of added subject-matter when amending a patent application for acknowledging the prior art, namely:

- A reference to a prior art disclosure is sufficiently direct for defining a claim term, even if the prior art disclosure has to be studied to establish the definition.
- Any subsequent use of the claim term (even without definite article) without any further accompanying definition is directly linked to the prior definition.
- A statement in the prior art section of the description implying an originally undisclosed meaning regarding a claim term goes beyond the content of the application as filed.

The respondent requested the referral of the following questions to the Enlarged Board should the Board intend to diverge from such alleged legal standards (see point 2.5 of the letter dated 8 July 2021), namely:

- "Does the insertion of a statement with reference to a prior art disclosure in the specification of a patent (application) constitute an inadmissible amendment in violation of Art. 123(2) EPC, if a term as used in the claims of the patent (application) is used in the statement implying a

different meaning as the generally used definition of the term and/or defined in the originally filed documents?"

- "Does it exclude a violation of Art. 123(2) EPC, if the prior art disclosure has to be studied to establish the implication of the different meaning in the statement?"
- "Is it a violation of Art. 123(2) EPC, if the term for which a different meaning is implied by the statement, is subsequently used without any further accompanying definition, and initially without definite article, in particular in the claims?"
- "Is it sufficient for a violation of Art. 123(2) EPC, if a statement in the prior art section of the description implies an originally undisclosed meaning regarding a claim term?"

3.2 The Board notes that its duty is to review the appealed decision and in the present case to decide whether the introduction before grant of paragraph [0012] of the description acknowledging a prior art document provides subject-matter extending beyond the content of the application as filed on the basis of the specific facts of the case.

As indicated above, paragraph [0012] of the patent specification does not provide a definition of the term "robot" which is to be used when interpreting the claims, so that the person skilled in the art is not provided with any new technical information by the introduction of this paragraph.

Therefore the amendment made in examination proceedings does not change the claimed subject-matter and does not provide subject-matter which would not be derived by a skilled person directly and unambiguously, using common general knowledge from the application as a whole at the filing date, as required by the case law developed by the Boards of Appeal for dealing with the requirements of Article 123(2) EPC, in particular by the "gold standard" (see G2/10 and CLB, *supra*, II.E.1.1, fourth paragraph)

This fact cannot be changed by the existence or not of the alleged legal standards argued for by the respondent.

Even if such legal standards were in fact derivable from the case law, as for other tests developed for different cases of amendments, they can only assist in determining the allowability of an amendment but can not take the place of the "gold standard" and thus should not lead to a different result (see CLB, *supra*, II.E.1.3.1, fourth paragraph).

Whether the respondent is correct in arguing the existence of the alleged legal standards is thus not decisive for the present case.

As a consequence, a decision on the questions proposed by the respondent to be referred to the Enlarged Board of Appeal under Article 112(1)(a) EPC is not required to enable the Board to decide the appeal case at hand (see CLB, *supra*, V.B.2.3.3, first paragraph). Thus, the respondent's request is refused.

4. Remittal

- 4.1 According to Article 111(1) EPC the Board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. Under Article 11 RPBA 2020, a Board shall not remit a case unless special reasons present themselves for doing so.
- 4.2 According to established jurisprudence, parties do not have an absolute right to two instances (see CLB, *supra*, V.A.7.2.1). However, under Article 111(1) EPC and Article 11 RPBA 2020, the Board does have the discretion to decide upon or to remit a case, based on the individual circumstances of the particular appeal.
- 4.3 The Board notes that the grounds of opposition under Articles 100(a) and (b) EPC have not been dealt with by the opposition division and that the appellant has requested the remittal of the case to the opposition division (see point 1 and 33 of the statement setting out the grounds of appeal) which has not been objected to by the respondent.
- 4.4 Against this background, and taking into account the circumstances of this particular case, the Board is of the opinion that the further grounds for opposition raised by the respondent cannot be decided upon without undue burden (cf. explanatory notes to Article 11 RPBA 2020, Supplementary publication 2 - OJ EPO 2020, 54).
- 4.5 Therefore, special reasons within the meaning of Article 11, first sentence, RPBA 2020 apply, and it is appropriate to remit the present case to the opposition

division for further prosecution, in accordance with Article 111 (1) EPC.

5. Request for an additional search

The Board cannot grant the respondent's request to indicate the necessity of an additional search to the opposition division (see point A.3.2 of the reply to the statement setting out the grounds of appeal) as whether or not an additional search is necessary is a matter for the administrative discretion of the opposition division when dealing with the auxiliary requests (see CLB, *supra*, IV.C.5.2.1, in particular with reference to T 0503/96).

Order

For these reasons it is decided that:

1. **The decision is set aside.**
2. **The case is remitted to the opposition division for further prosecution.**
3. **The respondent's request of referral to the Enlarged Board of Appeal is refused.**

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated