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**Datasheet for the decision
of 23 February 2022**

Case Number: T 1052/20 - 3.2.07

Application Number: 12862132.3

Publication Number: 2800652

IPC: B26D1/29, B26D1/36, B26D1/62,
B26D3/26, B26D1/147

Language of the proceedings: EN

Title of invention:
APPARATUSES FOR CUTTING FOOD PRODUCTS

Patent Proprietors:
URSCHEL LABORATORIES, INC.
Frito-Lay North America, Inc.

Opponent:
FAM

Headword:

Relevant legal provisions:
EPC Art. 108, 83, 123(2), 111(1), 104(1)
RPBA 2020 Art. 12(1)(a), 12(2), 12(3), 12(6), 13(2), 11, 16(1)
EPC R. 99(2)

Keyword:

Admissibility of appeal - appeal sufficiently substantiated (yes) - directed to requests on which the decision under appeal was based (yes)

Sufficiency of disclosure - (yes)

Amendments - extension beyond the content of the application as filed (no) - added subject-matter (no) - allowable (yes)

Amendment after summons - objection - cogent reasons (no) - exceptional circumstances (no) - taken into account (no)

Remittal - special reasons for remittal - (yes)

Apportionment of costs - (no)

Decisions cited:

G 0003/89, G 0011/91, G 0002/10, G 0001/16, T 3247/19

Catchword:



Beschwerdekammern

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Case Number: T 1052/20 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 23 February 2022

Appellant: URSCHEL LABORATORIES, INC.
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Appellant: Frito-Lay North America, Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 26 February
2020 revoking European patent No. 2800652
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The patent proprietors (appellants) lodged an appeal within the prescribed period and in the prescribed form against the decision of the opposition division revoking European patent No. 2 800 652.
- II. The opposition was filed on all grounds of opposition pursuant to Article 100 EPC.
- III. The opposition division held, *inter alia*,
- (a) that the ground of opposition pursuant to Article 100(b) EPC (sufficiency of disclosure) did not prejudice the maintenance of the patent as granted;
 - (b) that the ground of opposition under Article 100(c) EPC (added subject-matter) prejudiced the maintenance of the patent as granted; and
 - (c) that auxiliary request 6, filed as auxiliary request 2 with letter of 13 November 2019, was not admitted into the proceedings for being late-filed and clearly unallowable.
- IV. The final requests of the parties are as follows:
- for the appellants:
- that the decision be set aside and the patent be maintained in amended version according to the set of claims according to the auxiliary request 6, filed as auxiliary request 2 with letter of 13 November 2019 (main request),
 - or, in the alternative,
 - that the patent be maintained as granted (auxiliary request 1), or according to the set of claims according to any of auxiliary requests 2, 3, 4, 4A

to 4C, 5, 5A to 5C, 6, 6A to 6C, 7, 7A to 7K, 8, 8A to 8K, 9, 9A, 10 or 10A, whereby auxiliary request 4A, 9A and 10A correspond to auxiliary requests 1, 3 and 4 filed with letter of 13 September 2019; and auxiliary requests 5A, 6A, 7, 7A, 7D, 7E, 7H, 7I, 8, 8A, 8D, 8E, 8H, 8I correspond to auxiliary requests 2, 3, 5A, 4A, 5C, 4C, 5D, 4D, 5B, 4B, 5E, 4E, 5F and 4F filed during the oral proceedings before the opposition division; and the rest of auxiliary requests being filed for the first time in appeal proceedings, or, in the further alternative, that the case be remitted to the opposition division for further prosecution.

for the opponent (respondent):

that the appeal be rejected as inadmissible, or in the alternative, that the appeal be dismissed, or, in the further alternative, that the case be remitted to the opposition division for further prosecution, and that a different apportionment of costs be ordered.

- V. In preparation for oral proceedings, scheduled upon both parties' requests, the Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA 2020, according to which:
- the appeal seemed to be admissible;
 - the decision under appeal was likely to be set aside,
 - the case could be remitted to the opposition division for further prosecution,

and

- a different apportionment of costs was likely to be refused.

- VI. The respondent replied on the substance to this communication with letter dated 23 December 2021.
- VII. Oral proceedings before the Board were held on 23 February 2022. At the conclusion of the proceedings the decision was announced. For further details of the oral proceedings, in particular the issues discussed with the parties, reference is made to the minutes.
- VIII. The lines of arguments of the parties relevant for the present decision are dealt with in detail in the reasons for the decision.
- IX. Independent claim 1 of the **main request** reads:
- "An apparatus for cutting food product, the apparatus comprising an annular-shaped cutting head (12) and an impeller (10) coaxially mounted within the cutting head (12) for rotation about an axis of the cutting head (12) in a rotational direction relative to the cutting head (12), the impeller (10) comprising one or more paddles (16) circumferentially spaced along a perimeter thereof for delivering food product radially outward toward the cutting head (12), the cutting head (12) comprising two or more knife assemblies arranged in sets spaced around the circumference of the cutting head (12), each knife assembly comprising:
- a knife (14) extending radially inward toward the impeller (10) in a direction opposite the rotational direction of the impeller (10), the knife (14) having a corrugated shape with a large-amplitude having peaks and valleys; and

securing and aligning means (26, 27) for securing the knife (14) to the cutting head (12), aligning the peaks of the knife (14) of a first of the knife assemblies to the peaks of the knife (14) of a second of the knife assemblies, and aligning the valleys of the knife (14) of the first knife assembly to the valleys of the knife (14) of the second knife assembly to produce food product slices with a generally parallel-cut cross-section having a large-amplitude periodic shape having peaks and valleys, wherein the large-amplitude cross-section of the food product slice has an amplitude of 2.5 to 9 millimeters;

wherein the knife (14) and the securing and aligning means (26, 27) of each knife assembly define a rake-off angle for the knife assembly of at least 17 degrees and less than 23 degrees."

- X. Since the wording of the claims according to the auxiliary requests is not relevant for the present decision, there is no need to reproduce it here.

Reasons for the Decision

1. *Admissibility of the appeal - Article 108 EPC, Rule 99(2) EPC and Article 12(3) RPBA 2020*
- 1.1 The respondent requested that the appeal be rejected as inadmissible.
- 1.1.1 The respondent argued in point I of its reply to the statement of grounds of appeal that none of the requests of the appellant were *prima facie* admissible, because the requests:
 - were not admitted by the opposition division, or

- did not overcome the objections raised in the decision under appeal, or
- were not convergent, or
- were the result of a "pick and mix" approach, or
- gave raise to new objections such as clarity, or
- had been filed for the first time in appeal proceedings.

1.1.2 Additionally, the respondent argued during the oral proceedings before the Board that the main request of the appeal had been based on an auxiliary request which had been held inadmissible by the opposition division, whereby the maintenance of the patent as granted, on which the substantive findings of the decision under appeal were based, was only pursued in the form of an auxiliary request. It was this order of the requests with the patent as granted being put as first auxiliary request after the patent in amended form according to auxiliary request 6 (present main request) that the respondent objected to as inadmissible. The respondent underlined that the appellants had not provided in their statement of grounds of appeal any reason as to why the opposition division exercised erroneously its discretion of not admitting the present main request. Hence, the appellants failed to set out why the opposition division's findings were wrong.

1.1.3 The respondent expressed also its view that it should be not sufficient that the filing of amended claims automatically renders an appeal admissible. In the present case, the appeal could only be seen as admissible if the main request corresponded to a request which was already admitted in opposition proceedings, such as the patent in its granted version.

- 1.2 The Board disagrees with the respondent for the following reasons.
 - 1.2.1 First, the Board notes that both the appellants' main request (auxiliary request 6 in opposition proceedings) and their first auxiliary request 1 (patent as granted) had been decided upon by the opposition division. Hence, the appellants directed their appeal to requests on which the decision under appeal was based; this is in compliance with Article 12(1)(a) and (2) RPBA 2020.
 - 1.2.2 Second, the appellants presented in their statement setting out the grounds of appeal reasons as to why the contested decision should be set aside, specially by providing arguments that the finding of the opposition division that the patent as granted infringed Article 123(2) EPC is incorrect.
 - 1.2.3 This applies not only with regard to the patent as granted which the appellant maintains also in the appeal proceedings, but also with regard to the main request (auxiliary request 6 during the opposition proceedings), since this request was not admitted by the opposition division based on the substantive ground that the request was *prima facie* not clearly allowable, presenting the same deficiency as the patent as granted with respect to Article 123(2) EPC.
 - 1.2.4 Therefore, by contesting the opposition division's findings on the patent as granted with regard to Article 123(2) EPC, the appellants also addressed the incorrectness of the opposition division's exercise of discretion as regards the admittance of the then auxiliary request 6.

1.2.5 In the present case, the fact that the patent as granted is not defended by the appellants as main request but (only) as auxiliary request 1, has no negative procedural effect in respect of the admissibility of the appeal as such, which is primarily directed, also when considering the admittance of the main request into the proceedings, to reviewing the contested decision, in particular concerning the opposition division's reasoned findings on added subject-matter in the patent as granted.

1.2.6 It follows that the appeal meets the requirements of Article 108 EPC in combination with Rule 99(2) EPC and of Article 12(3) RPBA 2020, and therefore is admissible.

2. *Main request - Admittance, Article 12(6) RPBA 2020*

2.1 The respondent requested not to admit the main request in appeal proceedings, since it was not admitted by the opposition division, which applied its discretion based on the procedural ground that the request was late-filed and on the substantial ground that the request was *prima facie* not clearly allowable, presenting the same deficiency as the patent as granted with respect to Article 123(2) EPC.

2.2 The Board however, in the light of its findings as regards the issue of Article 123(2) EPC which are presented in point 3 below, concludes that the opposition division based its discretion on an erroneous substantive ground, so that the decision of the opposition division not admitting the present main request for that particular ground only cannot be upheld. It follows that, although the main request was not admitted in opposition proceedings, the

circumstances of the case justify the admittance of the main request in appeal proceedings in accordance with Article 12(6) RPBA 2020, first sentence.

3. *Main request - Amendments, Article 123(2) EPC*

3.1 It is established jurisprudence of the Boards of Appeal that the question to be considered in assessing the allowability of an amendment in view of the requirements of Article 123(2) or Article 100(c) EPC is what a skilled person would have derived directly and unambiguously, using common general knowledge from the description, claims and drawings of a European patent application and seen objectively and relative to the date of filing (see Case Law of the Boards of Appeal [CLB], 9th edition 2019, II.E.1.3.1, in particular G 3/89; G 11/91; G 2/10; and G 1/16, referring to this test as "**gold standard**").

3.2 Original claim 1 required that the knife of the knife assembly presents a **corrugated** shape to produce a food product slice having generally parallel cuts and a periodic shape and large amplitude cross-section. In contrast, the knife in amended claim 1 as granted and according to the main request has a **large-amplitude having peaks and valleys**. The respondent objected that this amendment resulted in an extension of subject-matter, contrary to the requirements of Article 123(2) EPC.

3.3 It is undisputed that there is no explicit disclosure of a knife having large-amplitude peaks and valleys, this feature is indeed always directed in the original disclosure to the food product, not to the knife.

- 3.4 *Replacement of "corrugated" by "large-amplitude having peaks and valleys"*
- 3.4.1 The first issue to be clarified is whether the skilled person is presented by the amended claim as granted with new technical information compared to the originally disclosed corrugated shape of the knife.
- 3.4.2 The Board is convinced that this is not the case. While it can be agreed with the respondent that "having peaks and valleys" as amended is not synonymous for the term "corrugated" as originally filed (see reply to the statement of grounds of appeal, point 17), it has been also correctly put forward by the appellants in page 7 of their statement of grounds of appeal, that, in general terms, a shape having peaks and valleys is always corrugated; *i.e.* in general terms, a shape having peaks and valleys is a particular case of a corrugated shape.
- 3.4.3 The respondent additionally argued that the term "corrugated" has to be interpreted in the light of the description, in which it is always described as meaning that the knife has a "periodic pattern". In contrast, a shape having a "large-amplitude having peaks and valleys" encompasses also shapes that are non-periodic, such as the cross-sectional shape of a Mexican sombrero.
- 3.4.4 The Board disagrees and concurs with the view of the appellants, that in the event that both terms "corrugated" and "large amplitude having peaks and valleys" are to be interpreted in the light of the description and the drawings, the only possible interpretation as it is required in original paragraph [0007] is that a periodic pattern must be also present

when interpreting the feature "having large amplitude having peaks and valleys".

3.4.5 Therefore, the skilled person is just confronted with one of the possible knife shapes originally claimed rather than being presented with new technical information.

3.4.6 In consequence, the finding of the opposition division in point 3.2 of the decision under appeal, that the feature "securing and aligning means", when deprived of the feature "corrugated" in connection with the shapes of the knife assembly infringes Article 123(2) EPC, does not withstand a revision under appeal. Since the feature "having a large-amplitude peaks and valleys" is more restrictive - even in the light of the description and drawings - than the term "corrugated", the introduction of the feature "securing and aligning means" in combination with the replacement of "corrugated" with "having peaks and valleys" does not result in an unallowable intermediate generalisation.

3.5 *Interpretation of "large amplitude"*

3.5.1 The second question to be addressed is to determine the technical meaning and the limitation imposed by the term "large-amplitude" when it relates to the knife shape.

3.5.2 The Board has no doubt that the term "large" is a relative term and as such has to be interpreted with the help of the description, which discloses, when referring to the food product, that the term "large-amplitude cross-section" means cross sections with amplitudes **of about 2.5 mm or greater** (see paragraph [0008] of the original description).

3.5.3 The Board, contrary to the argumentation of the respondent in point 11 of the reply to the statement of grounds of appeal, sees no reason to interpret the term "large amplitude cross-section" differently for the knife and for the food product. Quite apart that it seems to be technically sensible to employ the same type of standard when measuring both knife and food product, the same feature "large-amplitude", when used multiple times in a claim cannot be given different interpretations in order to establish the protection sought by the claim.

3.5.4 Therefore, it can be concluded, in line with the interpretation given by the opposition division (see minutes of the oral proceedings before the opposition division, page 8, penultimate paragraph), that the feature that the knife has large-amplitude having peaks and valleys means that this amplitude is within the range of about 2.5 mm or greater.

3.6 The third issue is the alleged difference between the shapes of the knife and the produced food product.

3.6.1 The opposition division followed the arguments of the respondent that taking into account that there was no disclosure in the original disclosure of a knife having large-amplitude and that a food product having large-amplitude could be also achieved by knives with smaller amplitudes, the subject-matter of claim 1 as granted extended beyond the original disclosure, see point 3.3 of the reasons of the decision under appeal.

3.6.2 While the appellants argued that the amplitude of the knife must at least be the same as the amplitude of the food product (see declaration of M. Jacko, point 32),

the respondent was of the view that products with large-amplitude can be obtained with knives with smaller amplitude (see declaration of Brent L. Bucks, point 7).

3.6.3 In the event that the declaration of Mr. Bucks (as argued by the respondent) was to be followed, a knife with an amplitudes below 2.5 mm (*i.e.* outside the scope of the claim as granted) could be suitable to produce, depending on the rake-off angle, a food product with a large-amplitude (*i.e.* of 2.5 mm or higher). According to this assessment, knives not having large-amplitude would be originally disclosed, but would not be covered by independent claim 1 as granted or according the main request.

3.6.4 Furthermore, it seems consistent with both declarations and therefore uncontested that knives having a large-amplitude as required by claim 1 as granted (*i.e.* of about 2.5 mm or greater) will inevitably produce food products having also a large-amplitude. It follows that knives having large-amplitude were also originally disclosed.

3.6.5 Consequently, the Board, based on the conclusions above, cannot follow the reasoning of the opposition division that by restricting the claim to knives having large-amplitude of 2.5 mm or more, the subject-matter of claim 1 as granted or according to the main request extends beyond the original disclosure, which encompassed also knives having smaller amplitudes.

3.7 *Combination of selected ranges*

3.7.1 The respondent further argued in point C of its letter of 23 December 2021 that claim 1 according to the main

request contains a combination of selected ranges, namely the knife having a large-amplitude of about 2.5 mm or greater and being positioned such that, together with the securing and aligning means, the rake-off angle is between 17 and 23 degrees.

- 3.7.2 The appellants argued that this new line of attack was to be seen as an amendment to the respondent's appeal case made after notification of the summons to oral proceedings before the Board, and requested not to admit this objection under Article 13(2) RPBA 2020.
- 3.7.3 The respondent indicated that this objection was an elaboration of the argumentation already presented in points 14 and 15 of the reply to the statement of grounds of appeal, and that it was not a new line of argumentation, let alone an amendment of the appeal case.
- 3.7.4 The Board is not persuaded by the argument of the respondent that this objection consists in a mere elaboration of the already presented arguments. Indeed, in points 14 and 15 of the reply to the statement of grounds of appeal, the respondent comments upon the declarations of Mr Jacko and Mr Buck and arrives to the conclusions that the amplitude of the corrugations of the slice does not always correspond to the amplitude of the corrugations of the knives and that it is further possible to cut food product slices with a corrugated shape having a "large amplitude" while the knife amplitude is not a "large amplitude". There is no indication in these points of the reply to the statement of grounds of appeal, or in the experts' declarations of an alleged unallowable combination of selected ranges pertaining to different embodiments, as

it is the case in point C of the respondent's letter of 23 December 2021.

- 3.7.5 The Board is thus convinced that this objection has been made for the first time after notification of the summons and constitutes an amendment to the respondent's appeal case which, in the absence of any cogent reasons that could justify exceptional circumstances, cannot be admitted into the proceedings under Article 13(2) RPBA 2020.
- 3.8 In conclusion, taking into account the findings of the opposition division with respect to the patent as granted and the admissibly raised objections by the respondent, the appellant has convincingly demonstrated that the main request meets the requirements of Article 123(2) EPC and that the opposition division based its discretion not to admit the then auxiliary request 6 on an erroneous substantive ground. Consequently, the decision under appeal has to be set aside.
4. *Main request - Sufficiency of disclosure, Article 83 EPC*
- 4.1 The respondent made reference during the oral proceedings before the Board and in point II.1.2, item 19 of its reply to the statement of grounds of appeal to the submissions made during the opposition proceedings to argue that the patent as granted was not sufficiently disclosed.
- 4.2 The Board notes that facts, evidence, arguments and requests put forward in opposition proceedings are not automatically part of the appeal proceedings. The parties should clearly set out their case, it cannot be

left to the Board and to the other party to search through the history of the file to reconstruct what the possible lines of arguments of a party could be. A statement referring to the submissions made in opposition proceedings is generally not sufficient to properly set out the party's case as required by Article 12(3) RPBA 2020 (see also CLB, *supra*, V.A.2.6.4 a), second paragraph). In view of this, the Board does not admit these lines of arguments into the appeal procedure.

- 4.3 As for the objection specifically directed to the main request in point 20 of the reply to the statement of grounds of appeal, the Board notes that the assumption that the skilled person would not be in place of providing a knife arrangement suitable to produce "food product slices with a generally parallel-cut cross-section having a large amplitude periodic shape having peaks and valleys, wherein the large-amplitude cross-section of the food product slice has an amplitude of 2.5 to 9 millimeters" remains a mere allegation that cannot constitute serious doubts substantiated by verifiable facts that could result in an insufficiency of disclosure (see CLB, *supra*, II.C.9).
- 4.4 The respondent also argued at the oral proceedings before the Board that since the subject-matter of claim 1 according to the main request covered also knives presenting large amplitudes over e.g. 10 millimeters, the skilled person would not be able to produce food slices in the range of 2.5 to 9 millimeters as claimed.
- 4.4.1 The Board is not persuaded by this argument either and is rather convinced that knives with extremely large amplitudes would be immediately ruled out by the skilled person when interpreting the claim for not

making technical sense or not being clearly directed to the production of food slices within the claimed range.

- 4.5 The Board concludes that the respondent has not convincingly shown that main request does not meet the requirements of Article 83 EPC.
5. *Remittal of the case to the opposition division - Articles 111(1) EPC and 11 RPBA 2020*
- 5.1 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.
- 5.2 The Board notes that the decision under appeal only dealt with the grounds of opposition according to Articles 100(b) and (c) EPC. Noting that the appellants have not addressed the issues of novelty and inventive step of the subject-matter claimed in the main request and that the respondent mainly relies on references to its submissions during the opposition proceedings, the Board cannot come to a decision regarding further patentability requirements such as, but not limited to, novelty and inventive step of the main request on the basis of the current appeal case alone. Moreover, all parties have requested that the case be remitted in the case that the decision was to be set aside.
- 5.3 Against this background, after considering all the relevant circumstances of the case at hand, the Board comes to the conclusion that the issues relevant to patentability in the present case, including but not limited to, the examination of novelty 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).

5.4 Consequently, in line with decision T 3247/19, taken by the same Board in different composition (points 8. to 12. of the reasons), 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' requests, remits the present case to the opposition division for further prosecution in accordance with Article 111(1) EPC.

6. *Request for a different apportionment of costs - Article 104(1) EPC*

6.1 Under Article 104(1) EPC each party to opposition (appeal) proceedings shall, as a rule, bear its own costs. However, the Board may for reasons of equity order a different apportionment of costs. In addition, according to Article 16(1) RPBA 2020 the Board may at request of a party order a party to pay some or all of another party's costs (see also CLB, *supra*, III.R.2).

6.2 The respondent requested a different apportionment of costs arising at the respondent's side due to the high number of auxiliary requests, which are *prima facie* inadmissible, are non-converging and are identical or based on requests which had already been rejected as inadmissible by the opposition division. Since Article 12(3) RPBA 2020 requires that the response to the statement of grounds of appeal should contain the Respondent's complete case, the respondent had no other choice than to consider each and every one of these requests.

6.3 None of the situations foreseen under Article 16(1) RPBA 2020 seem to apply to the present case. This is obvious for categories (a) to (d) in Article 16(1) RPBA

2020. It is also true in respect of the abuse of procedure alleged by the respondent because of the total number of requests (category (e) of Article 16(1) RPBA 2020). However, the majority of requests pursued by the appellants with their appeal had been decided upon by the opposition division in the appealed decision. The Board cannot find an abuse in the appellants' approach to seek that the Board reviews the opposition division's findings under Article 12(2) RPBA 2020.

6.4 Rather, the appellant in exercising its rights under Article 106(1), first sentence, EPC to legitimately seek the maintenance of the patent and that the respondent's alleged costs to build a defense of its case lie exclusively within the interest and sphere of control of the opponent , does not recognise any justification to order different apportionment of costs.

6.5 The above view of the Board has been communicated to the parties with the communication pursuant to Article 15(1) RPBA 2020. The parties have neither reacted nor objected to the opinion expressed in that communication. After having reconsidered all the aspects of the case the Board does not see any reason to deviate from its preliminary opinion, so that the respondent's request for apportionment of costs is refused.

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.
3. The request for apportionment of costs is refused.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated