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**Datasheet for the decision  
of 17 October 2023**

**Case Number:** T 1523/22 - 3.2.07

**Application Number:** 10006878.2

**Publication Number:** 2239109

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B26D7/30

**Language of the proceedings:** EN

**Title of invention:**

A food article slicing machine with a food article end sensor

**Patent Proprietor:**

Formax, Inc.

**Opponents:**

GEA Food Solutions Germany GmbH  
Weber Maschinenbau GmbH Breidenbach

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(a), 54, 111(1), 113, 116, 123(1)

EPC R. 79(1), 81(3), 103(1)(a), 103(4)(c)

RPBA 2020 Art. 11, 12(2), 12(6), 12(8), 15(1)

**Keyword:**

Oral proceedings - withdrawal of request for oral proceedings

- request for continuation of proceedings in writing

Grounds for opposition - lack of patentability (yes)

Novelty - (no)

Auxiliary requests - admitted in opposition proceedings (no) -

error in use of discretion at opposition proceedings (yes) -

admitted (yes)

Remittal - (yes)

Reimbursement of appeal fee - (no)

**Decisions cited:**

T 0966/17, T 0908/19, R 0006/19

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 1523/22 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 17 October 2023**

**Appellant:** Formax, Inc.  
(Patent Proprietor) 9150 191st Street  
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**Representative:** v. Bezold & Partner Patentanwälte - PartG mbB  
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**Respondent:** GEA Food Solutions Germany GmbH  
(Opponent 1) Im Rutttert  
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**Representative:** Kutzenberger Wolff & Partner  
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50676 Köln (DE)

**Respondent:** Weber Maschinenbau GmbH Breidenbach  
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35236 Breidenbach (DE)

**Representative:** Grünecker Patent- und Rechtsanwälte  
PartG mbB  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 9 May 2022  
revoking European patent No. 2239109 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**            G. Patton  
**Members:**            A. Cano Palmero  
                             R. Cramer

## **Summary of Facts and Submissions**

I. The patent proprietor lodged within the prescribed time limit and in the prescribed form an appeal against the decision of the opposition division revoking European patent No. 2 239 109.

II. The patent proprietor (appellant) requested

that the decision under appeal be set aside  
and

that the patent be maintained as granted (main  
request),

or, in the alternative,

that the patent be maintained in amended form  
according to one of the sets of claims filed as  
auxiliary requests 1 to 24, already filed during  
opposition proceedings as auxiliary requests 1 to  
8, 1.1 to 8.1 and 1.2 to 8.2,

or

that the case be remitted to the opposition  
division for further prosecution,

that the appeal fee be reimbursed in full,

and

in the event that the non-admittance of auxiliary  
requests 4 to 8 is confirmed, that questions be  
referred to the Enlarged Board of Appeal.

III. Opponents 1 and 2 (respondents 1 and 2, respectively)  
requested

that the appeal be dismissed.

IV. In preparation for oral proceedings, which were  
initially requested by all parties, the board

communicated its preliminary assessment of the case in a communication pursuant to Article 15(1) RPBA, according to which:

- (a) the decision under appeal was likely to be set aside;
- (b) the appeal fee was likely not to be reimbursed; and
- (c) the case was likely to be remitted to the opposition division for further prosecution.

- V. In response to that communication all parties withdrew their respective initial requests for oral proceedings pursuant to Article 116(1) EPC: the appellant with letter dated 4 September 2023 and respondents 1 and 2 with letters of 10 October 2023 and 12 October 2023, respectively.
- VI. In addition, the appellant and respondent 1 agreed to a decision on the merits according to the board's preliminary opinion and respondent 2 withdrew its request for oral proceedings under the condition that the board did not depart from its preliminary opinion.
- VII. On 12 October 2023 the board cancelled oral proceedings initially appointed for 18 October 2023.
- VIII. The lines of argument of the parties relevant for the present decision are dealt with in detail in the reasons for the decision.
- IX. Claim 1 according to the patent as granted (main request), with the feature labelling used by the parties, reads as follows:

- 1.1 A food article slicing machine (100), comprising:
- 1.2 a slicing station comprising

- 1.2.1 a knife blade and a knife blade drive driving the blade along a cutting path (2080); and
- 1.3 a food article feed apparatus (120) supporting one or more food articles for movement along a food article path
  - 1.3.1 intersecting the cutting path (2080);  
**characterized by**
- 1.4 a sensor (770) configured to determine a location of an end of the food article loaded onto said food article feed apparatus (120),
- 1.5 wherein said sensor (770) determines the distance between the sensor (770) and the food article.

X. Claim 1 of auxiliary request 1 corresponds to claim 1 as granted with the following feature added at the end of the claim:

"...wherein said sensor (770) is located so that a food article passes a sensing range of the sensor (770) as the food article is loaded onto said food article feed apparatus (120)".

XI. Claim 1 of auxiliary request 1.1 is based on claim 1 of auxiliary request 1 whereby feature 1.5 has been amended to read as follows (additions shown underlined):

"...wherein said sensor (770) determines the distance between the sensor (770) and the back end of the food article, ...".

XII. Claim 1 of auxiliary request 1.2 is based on claim 1 of auxiliary request 1.1 whereby feature 1.3 has been amended to read as follows (additions shown underlined, deletions struck-through):

"...a food article feed apparatus (120) supporting ~~one~~  
~~or more~~ food articles for movement along a food article  
paths...".

XIII. Claim 1 of auxiliary request 2 corresponds to claim 1  
of the main request whereby the following feature has  
been added at the end of the claim:

"...wherein the sensor (770) comprises a laser distance  
sensor emitting a beam to determine the distance  
between the sensor (770) and the back end of each food  
article as the food articles pass by during transfer."

XIV. Claim 1 of auxiliary requests 2.1 and 2.2 are based on  
claim 1 of auxiliary request 2 with the same amendments  
carried out as those in auxiliary requests 1.1 and 1.2  
with respect to auxiliary request 1.

XV. Claim 1 of auxiliary request 3 corresponds to claim 1  
of the main request whereby the following features of  
claims 5, 6 and 7 of the patent as granted have been  
added at the end of the claim :

"c3) wherein the sensor (770) comprises a laser  
distance sensor emitting a beam to determine the  
distance between the sensor (770) and the back end  
of each food article as the food articles pass by  
during transfer,

- d) a machine control,
- d1) configured to record the distance between the food  
article and the sensor (770),
- d2) wherein the machine control is configured to  
associate the distance between the food article  
and the sensor (770) with the food article and the



path to be occupied by the food article during slicing."

- XVI. Auxiliary requests 3.1 and 3.2 are based on auxiliary request 3 with the same amendments carried out as those in auxiliary requests 1.1 and 1.2 with respect to auxiliary request 1.
- XVII. Since the wording of the claims of auxiliary requests 4 to 8, 4.1 to 8.1 and 4.2 to 8.2 is not relevant for the present decision, there is no need to reproduce it here.

### **Reasons for the Decision**

1. *Procedural matters*
- 1.1 The case is ready for decision which is taken in written proceedings without holding oral proceedings in accordance with Article 12(8) RPBA and with Articles 113 and 116 EPC.
- 1.2 The board communicated its preliminary assessment of the case to the parties by means of a communication pursuant Article 15(1) RPBA.
- 1.3 In response to that communication all parties withdrew their respective requests for oral proceedings pursuant to Article 116(1) EPC.
- 1.4 In addition, the appellant and respondent 1 agreed to a decision on the merits according to the board's preliminary opinion and respondent 2 withdrew its request for oral proceedings under the condition that the board did not depart from its preliminary opinion.

- 1.5 Since all parties were informed of the board's preliminary assessment of the case, on which the present decision is based, the principle of the right to be heard pursuant to Article 113(1) EPC is observed.
2. *Patent as granted (main request) - Novelty in view of E5 (GB 2 335 488 A), Articles 100(a) and 54 EPC*
- 2.1 The appellant argued that E5 does not explicitly show feature 1.4 of claim 1 as granted, which defines that the measurement is made during the transfer process whereas E5 shows a measurement of the food articles after the loading process, *i.e.* on the conveyors 10 and 18. In particular, the appellant argued that the infeed conveyor 10 and the outfeed conveyor 18 of E5 together formed a food article feed apparatus according to feature 1.3, and not only the outfeed conveyor 18.
- 2.2 The board is not persuaded by the arguments of the appellant and rather concurs with the findings of the opposition division (see point 3.3.1.1 of the reasons for the decision under appeal) that the wording of claim 1 does not exclude machines where the location of food articles is measured once they are already loaded. The board notes that the term "loaded" is considered clear, so that a more restrictive interpretation of this feature in the light of the description is not appropriate.
- 2.2.1 In addition, the board is also satisfied that the conveyor 18 of E5 anticipates by itself a food article feed apparatus according to feature 1.3, so that the loading process of E5 is to be considered with respect to that conveyor alone.

2.2.2 In this light, the board further agrees with the opposition division and with the respondents that E5 does not only disclose in figure 3B a sensor measuring the location of the food article when the food article has already been loaded onto a food article feed apparatus (*i.e.* the conveyor 18), but also, in figure 3A, a sensor measuring the distance of the food article as the food article is being loaded onto that conveyor 18 is shown, so that the more restrictive interpretation of this term is also anticipated by E5.

2.3 The appellant has therefore not convincingly demonstrated that the opposition division erred in its finding that the subject-matter of claim 1 according to the main request lacks novelty in view of E5.

3. *Auxiliary request 1 - Novelty in view of E5, Article 54 EPC*

3.1 Similarly as in the assessment of the main request in point 2.2.1 above, the board, contrary to the appellant's view, considers that the conveyor 18 of E5 can be seen as a food article feed apparatus according to claim 1.

3.2 As already discussed in point 2.2.2 above and correctly pointed out by the respondents in their respective replies to the statement setting out the grounds of appeal figure 3A of E5 discloses measurement of the food products with the sensors arranged at the ring 32 while the food products are transferred from conveyor 10 to conveyor 18.

3.3 The board is thus not convinced that the opposition division erred in its finding that the subject-matter of claim 1 of auxiliary request 1 lacks novelty.

4. *Auxiliary request 1.1 - Novelty in view of E5, Article 54 EPC*
- 4.1 The appellant argued that, while claim 1 of auxiliary request 1.1 requires a measurement of the food article from the back end, E5 performs the measurement from the side, and therefore cannot determine the distance between the sensor and the back end of the food article.
- 4.2 The board disagrees for the following reasons. As correctly found by the opposition division (see point 3.3.1.3 of the reasons for the decision under appeal) E5 discloses on page 6, paragraphs 2 and 4 that the sensors provide information to the computer control as to when a product is about to enter or leave the inspection plane or when a product is absent from the inspection plane, which implies that the food product, including the front and the rear portion, are measured as the food article passes the sensor arrangement.
- 4.3 The board is thus not convinced that the opposition division was wrong in its finding that the subject-matter of claim 1 of auxiliary request 1.1 lacks novelty.
5. *Auxiliary request 1.2 - Novelty in view of E5, Article 54 EPC*
- 5.1 The appellant contested the reasoned finding of the opposition division in point 7.4 of the reasons for the decision under appeal that the term "food path" has been misinterpreted by the opposition division. In the patent in suit, the terms "food path" and "lane" are synonyms referring to parallel tracks or lanes of the

food article feed apparatus. The claim would be deprived of technical sense if the term "food path" was considered to be the abstract geometric line followed by each individual food article within a single lane, so that no other interpretation than several parallel food article feed paths is possible for the skilled person.

- 5.1.1 In contrast, document E5 did not disclose food paths for supporting food articles as defined by feature 1.3, because E5 could not convey several food products in parallel food paths (lanes), side-by-side.
- 5.2 The board is not persuaded by the arguments of the appellant. It is firstly to be noted that the paths according to claim 1 of auxiliary request 1.2 are defined as "food article paths", so that such paths are intrinsically linked to the food articles and are not necessarily a physical entity pertaining to the apparatus, as alleged by the appellant.
  - 5.2.1 As correctly indicated by respondent 1, E5 discloses food articles following their own (food article) path down the conveyor. This interpretation of the term "food article path" does not lack technical sense, since it would, for example, be sensible to consider the individual paths when slicing the food object, as argued by respondent 2.
  - 5.2.2 The appellant's interpretation that the "food article paths" can only be understood, in view of the description, as parallel tracks or lanes of the apparatus for the food article, is therefore not convincing.

5.3 In sum, the board sees no error in the finding of the opposition division that the subject-matter of claim 1 of auxiliary request 1.2 is not new in view of E5.

6. *Auxiliary requests 2, 2.1 and 2.2 - Novelty in view of E5, Article 54 EPC*

6.1 It does not appear from the statement setting out the grounds of appeal that the appellant disputes that E5 discloses a sensor comprising a laser distance sensor. The appellant merely argues that the subject-matter of claim 1 of these requests is novel for the same reasons as for the main request.

6.2 As already discussed for the main request, figure 3A anticipates a sensor measuring the distance of the food article during the loading process. This sensor can be a laser displacement transducer, as correctly found by the opposition division in point 8.3 of the reasons for the decision under appeal (see page 8, sixth paragraph of E5).

6.3 Since E5 anticipates the added feature, the board is thus convinced that the opposition division correctly found that the subject-matter of claim 1 of auxiliary requests 2, 2.1 and 2.2 lacks novelty in view of E5.

7. *Auxiliary requests 3, 3.1 and 3.2 - Novelty in view of E5, Article 54 EPC*

7.1 Although the opposition division found that the subject-matter of claim 1 of auxiliary requests 3, 3.1 and 3.2 was not novel in view of E5 (see points 11.3 and 13.3 of the reasons for the decision under appeal), the appellant does not dispute this finding as the

statement setting out the grounds of appeal refers only to the arguments presented for the preceding requests.

7.2 In this light, the board is not faced with any arguments that could convincingly demonstrate that the added features in these requests are not anticipated by E5, so that the reasoned finding of the opposition division, that E5 anticipates the subject-matter of claim 1 of auxiliary requests 3, 3.1 and 3.2, holds a revision in appeal.

8. *Auxiliary requests 4 to 8 - Admittance*

8.1 The opposition division did not admit auxiliary requests 4 to 8 into the opposition proceedings. According to Article 12(6), first sentence, RPBA 2020, the board shall not admit requests which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance.

8.1.1 In point 14.1.6 of the reasons for the decision under appeal it was concluded that claim 1 of auxiliary request 4 was *prima facie* not inventive and in point 15.1.2 that auxiliary request 5 did not contribute to overcoming the objections to the patentability of claim 1 of the main request.

8.1.2 Furthermore, the opposition division concluded in points 14.1.8 and 15.1.2 that with maintenance of auxiliary requests 4 to 8 the appellant was not seriously trying to overcome the objections to the patentability of claim 1 of the main request but was

rather trying to delay the proceedings, which amounted to an abuse of the procedure.

- 8.2 The board cannot concur with the decision of the opposition division and is of the view that auxiliary requests 4 to 8 should have been admitted into the proceedings.
- 8.2.1 It is established case law that an opposition division's discretion in deciding whether to admit amended claims emanates in essence from Article 123(1), first sentence, EPC in conjunction with Rules 79(1) and 81(3) EPC (see Case Law of the Boards of Appeal [CLB], 10th edition 2022, IV.C.5.1.4.a), with reference to T 966/17 and R 6/19).
- 8.2.2 In the present case, it is undisputed that auxiliary requests 4 to 8 were filed with the reply to the notices of opposition, namely within the time limit set by Rule 79(1) EPC. These requests were thus filed in due time and the opposition division had **no discretion** to decide on the admittance of these requests but was restricted to consider whether they met the criteria in Rule 80 EPC. Since **no exercise of discretion** was available to the opposition division, any criteria to be applied by the opposition division for the exercise of the alleged discretion are irrelevant (see CLB, *supra*, IV.C.5.1.4.b) with reference to T 908/19).
- 8.2.3 In addition, the board is of the view that in the case at hand, at least auxiliary request 4 was at the time of its filing a *bona fide* attempt of the appellant to overcome the objections raised in the notices of opposition. The appellant was confronted with an objection of lack of inventive step against this request for the first time with the preliminary opinion



of the opposition division dated 26 April 2021, point 4.4. This objection was addressed by the appellant in its submissions dated 15 September 2021, point 9. These arguments were however not duly considered by the opposition division in the decision under appeal in points 14.1.6 and 14.1.8, where it was concluded that auxiliary request 4 was *prima facie* not inventive and that the auxiliary request was not a serious attempt to overcome the objections of patentability. Moreover, it is not apparent from the minutes of the oral proceedings before the opposition division whether the appellant had been able to take position on the reasons provided in the decision under appeal for not admitting the request with respect to the *prima facie* lack of inventive step. In the oral proceedings the explanation given for the non-admittance of the auxiliary request was the lack of convergence (see minutes, point 12). The lack of convergence was, however, not regarded as conclusive in the decision under appeal, see point 14.1.4. Finally, the decision under appeal lacks sufficient reasoning as to in which way the efficiency of the proceedings was impaired, see point 14.1.7.

- 8.2.4 In sum, the board is of the view that the opposition division incorrectly decided not admit auxiliary requests 4 to 8 as, on the one hand, it based its decision on criteria that are not applicable to the admittance of requests filed with the reply to a notice of opposition, and on the other hand, took developments of the proceedings that occurred after the filing of these requests into consideration when deciding not to admit them, thereby ignoring the principle that the admissibility of requests is to be judged with regard to the point in time when they were filed. A request that was admissible when it was filed cannot become inadmissible later.

8.2.5 Therefore, auxiliary requests 4 to 8 are admitted into the proceedings.

8.2.6 In this light, the appellant's request to refer questions to the Enlarged Board of Appeal does not become procedurally effective and does not need to be addressed as the questions were merely linked to the above discussed issue of admittance of auxiliary requests (see statement of grounds, page 13).

9. *Reimbursement of the appeal fee - Rule 103(1)(a) and (4)(c) EPC*

9.1 The appellant requested that the appeal fee be reimbursed, since the opposition proceedings suffered from a substantial procedural violation. In particular, the opposition division exercised a discretionary decision to not admit auxiliary requests 4 to 8 without any legal basis to do so, and the decision under appeal was not sufficiently reasoned with regard to some auxiliary requests.

9.2 The board is not persuaded by the appellant's arguments.

9.2.1 In the first place, the board is not convinced that the non-admittance of the auxiliary requests, even if it can be ultimately proven to be incorrect, automatically amounts to a procedural violation, let alone a substantial one that could justify the reimbursement of the appeal fee. Rather, the relevant question is whether the law was correctly applied by the opposition division, and is thus of a substantive nature rather than of a procedural nature (CLB, *supra*, V.A.11.6.1).

9.2.2 Secondly, the board notes that even if a procedural violation had occurred in opposition proceedings, such an alleged procedural violation must be causally linked with the necessity of the appellant to file an appeal (see CLB, *supra*, V.A.11.7.1). In the present case, the patent as granted (main request in appeal proceedings) was revoked for lack of novelty, so that the appellant would have had to file the appeal even if the opposition division had admitted the auxiliary requests.

9.3 In sum, the board concludes that in the case at hand a reimbursement of the appeal fee would not be equitable, so that the request for reimbursement of the appeal fee in full is to be refused.

9.4 However, as the appellant withdrew its request for oral proceedings within one month of the board's communication under Article 15(1) RPBA and no oral proceedings took place, the appeal fee is reimbursed at 25% under Rule 103(4)(c) EPC.

10. *Remittal of the case to the opposition division - Articles 111(1) EPC and 11 RPBA*

10.1 The board is aware that, according to Article 11 RPBA, a remittal for further prosecution should only be undertaken, exceptionally, when special reasons apply.

10.2 The board notes that since the opposition division decided not to admit auxiliary requests 4 to 8, 4.1 to 8.1 and 4.2 to 8.2 into the proceedings, the decision under appeal does not deal with the substantive allowability of these requests. While it is true that the opposition division expressed a preliminary opinion with regard to inventive step of auxiliary request 4 in

point 14.1.6 of the reasons of the decision under appeal, this preliminary view cannot be taken as a reasoned decision since it did not take into account any arguments of the parties.

- 10.3 As set out in Article 12(2) RPBA, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner. This principle would not be respected if the board were to conduct a complete substantive examination on the auxiliary requests which were not admitted by the opposition division (see CLB, *supra*, V.A.9.3.2).

Moreover, as correctly indicated by respondent 2, the decision under appeal did not deal with the admissibly raised objections with respect to sufficiency of disclosure of claim 3 as granted and extension of subject-matter with respect to feature 1.5 of claim 1 as granted. Such unexamined objections could be relevant for the auxiliary requests.

- 10.4 Consequently, the board is of the view that there are special reasons within the meaning of Article 11, first sentence, RPBA that justify a remittal. Following the requests of the appellant and of respondent 1, the board holds it appropriate, in accordance with Article 111(1) EPC, to remit the present case to the opposition division for further prosecution and examination of auxiliary requests 4 to 8, 4.1 to 8.1 and 4.2 to 8.2 in the order specified by the appellant on page 2 of the statement setting out the grounds of appeal.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The request for reimbursement of the appeal fee in full is refused.
3. The appeal fee is reimbursed at 25%.
4. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



G. Nachtigall

G. Patton

Decision electronically authenticated