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**Datasheet for the decision
of 15 December 2023**

Case Number: T 1853/22 - 3.2.07

Application Number: 08876638.1

Publication Number: 2212067

IPC: B26D1/157

Language of the proceedings: EN

Title of invention:

FOOD ARTICLE FEED APPARATUS FOR A FOOD ARTICLE SLICING MACHINE

Patent Proprietor:

Formax, Inc.

Opponents:

GEA Food Solutions Germany GmbH
Weber Maschinenbau GmbH Breidenbach

Headword:

Relevant legal provisions:

EPC Art. 54, 107, 111(1), 123(2)
RPBA 2020 Art. 10(3), 12(2), 12(6) sentence 2

Keyword:

Amendments - added subject-matter (yes)

Novelty - (no)

Decisions cited:

G 0001/93, G 0002/10, T 0522/11, T 2619/11, T 2210/12,
T 1194/15, T 0266/16, T 2282/16, T 0479/20, T 0487/20,
T 1404/20, T 1809/22

Catchword:



Beschwerdekammern

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Case Number: T 1853/22 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 15 December 2023

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
1 June 2022 concerning maintenance of the
European Patent No. 2212067 in amended form.**

Composition of the Board:

Chairman	G. Patton
Members:	S. Watson
	Y. Podbielski
	B. Paul
	R. Cramer

Summary of Facts and Submissions

- I. Appeals were filed by the patent proprietor on 28 July 2022 and opponents 2 and 3 on 8 August 2022 against the decision of the opposition division maintaining European patent Nr 2 212 067 in amended form according to the then seventh auxiliary request (auxiliary request I_cor).
- II. After merging with opponent 2, opponent 3 ceased to exist in September 2022.
- III. With its reply to the statement of grounds of appeal of opponents 2 and 3 the patent proprietor requested acceleration of the appeal proceedings under Article 10(3) RPBA, in light of pending infringement proceedings at Munich I regional court.

With its communication of 14 March 2023 the board informed the parties that the appeal proceedings would be accelerated and that oral proceedings would be held on 15 December 2023.

- IV. In preparation for oral proceedings, the board gave its preliminary opinion in a communication pursuant to Article 15(1) RPBA, which took into account the appellants' statements of grounds of appeal and their respective replies, as well as the reply of opponent 1 to the patent proprietor's appeal.

For the sake of clarity the appellants/respondents will be referred to as "patent proprietor", "opponent 1" and "opponent 2" in this decision.

- V. The patent proprietor responded to the board's preliminary opinion with submissions of 1 December 2023 and opponent 2 with submissions of 11 December 2023.
- VI. Oral proceedings before the board took place on 15 December 2023.
- VII. At the conclusion of the proceedings the decision was announced. Further details of the oral proceedings can be found in the minutes.
- VIII. The final requests of the parties are as follows:

for the patent proprietor

- that the decision under appeal be set aside; and
- that the opposition be rejected so that the patent be maintained as granted (main request),
- or that the patent be maintained in amended form on the basis of one of the sets of claims according to auxiliary requests A, A_cor, I, I_cor, I1, I1_cor, E, E0, E1, E1_cor, E2, E2_cor, E3, E3_cor, B, B_cor, B', B'_cor, C, C_cor, C', C'_cor, C'', C''_cor, C''', C'''_cor, F, F_cor, G, G_cor, J, J_cor, J', C1, C1_cor, C'1, C'1_cor, C2, C2_cor, C'2, C'2_cor, C3, C3_cor, C'3, C'3_cor, C4, C4_cor, C'4, C'4_cor, D, D_cor, H, H_cor, whereby
 - auxiliary requests A, B, C, D, E, F, G, H, I, J were filed on 28 March 2019;
 - auxiliary requests B', C', C'', C1, C'1, C2, C'2, C3, C'3, C4, C'4 were filed on 29 April 2020;
 - auxiliary requests C''' and E1 were filed on 29 September 2020;
 - auxiliary requests E2, E3 and J' were filed on 11 March 2021;
 - auxiliary requests A_cor, B_cor, B'_cor, C_cor, C'_cor, C''_cor, C'''_cor, C1_cor, C2_cor,

C3_cor, C4_cor, C'1_cor, C'2_cor, C'3_cor,
C'4_cor, D_cor, E0, E1_cor, E2_cor, E3_cor,
F_cor, G_cor, H_cor, I_cor and J_cor were filed
during oral proceedings before the opposition
division held on 11 and 12 May 2021;

- I1 and I1_cor were filed with the statement of grounds of appeal,
- and whereby auxiliary request I_cor was found by the opposition division to meet the requirements of the EPC.

for opponent 1

- that the patent proprietor's appeal be dismissed.

for opponent 2

- that the decision under appeal be set aside, and
- that the patent be revoked in its entirety.

IX. The following documents are referred to in this decision:

- D29: Weber delivery note No. 145219 dated 11 March 2005
- D30: Weber invoice No. 489211 dated 11 March 2005
- D31: Junker service report No. 11217 of 6 March 2005
- D33: Weber delivery note No. 146190 dated 6 April 2005
- D34: Weber invoice No. 490194 dated 6 April 2005
- D37: Weber delivery note No. 147130 dated 28 April 2005
- D38: Weber invoice No. 491240 dated 28 April 2005
- D44: Weber delivery note No. 163029 dated 28 March 2006

- D45: Weber invoice No. 508003 dated
28 March 2006
- D47: Weber delivery note No. 280708 dated
9 August 2011
- D48: Weber invoice No. 615576 dated
9 August 2011
- D50: Junker service report No. 10498 dated
2 June 2006
- D51: Weber delivery note No. 277899 dated
30 June 2011
- D52: Weber invoice No. 613357 dated 30 June 2011
- D54: Junker service report No. 10751 dated
28 June 2006
- D55: Junker service report No. 10783 dated
29 June 2006
- D104: General sales and delivery terms and
conditions of the Weber Group
- D121: Weber delivery note No. 189855 dated
27 August 2007
- D122: Weber invoice No. 533938 dated
27 August 2007
- D125: E-mail from H. Wefelnberg of 2 August 2007
- D126: Letter from S. Senechal dated
31 August 2007
- D127: E-mail from M. Klein of 19 October 2007

X. Independent claim 1 as granted (main request) reads as follows:

"A food article feed apparatus (120) for a food article slicing machine, comprising:

at least three food article paths configured to intersect a cutting path (2080) of a slicing machine; characterized by

at least three conveyors, each conveyor having a conveyor belt (802, 804, 806) configured to independently move a food article along one of

said food article paths into the cutting path (2080)."

- XI. Independent claim 1 of auxiliary requests A, A_cor, I, I_cor, I1, I1_cor, E, E0, E1, E1_cor, E2, E2_cor, E3, E3_cor, B, B_cor, B', B'_cor, C, C_cor, C', C'_cor, C'', C''_cor, C''', C'''_cor, F, F_cor, G, G_cor, J, J_cor, J', C1, C1_cor, C'1, C'1_cor, C2, C2_cor, C'2, C'2_cor, C3, C3_cor, C'3, C'3_cor, C4, C4_cor, C'4, C'4_cor, D, D_cor, H and H_cor are annexed to this decision.
- XII. The arguments of the parties relevant for the decision are dealt with in detail in the reasons for the decision.

Reasons for the Decision

1. *Status of opponent 3*
- 1.1 Opponents 2 and 3 merged in September 2022. As opponent 2 was the acquiring entity, the status of opponent 3 was transferred to opponent 2 on the date of the merger, and opponent 3 ceased to exist as a legal entity. Therefore, it was no longer a party to the current appeal proceedings thereafter (Article 107 EPC).

Patent proprietor's appeal

2. *Main request - claim 1 as granted - added subject-matter (Articles 100(c) and 123(2) EPC)*
- 2.1 The opposition division found that the ground for opposition under Article 100(c) EPC prejudiced the

maintenance of the patent as granted as claim 1 did not fulfil the requirements of Article 123(2) EPC due to the features "food article slicing machine" and "a slicing station comprising a knife blade and a knife blade drive driving the blade along a cutting path" being omitted from the claim.

- 2.2 In its statement of grounds of appeal, the patent proprietor contested the opposition division's findings, arguing that claims 58, 59 and 72ff; the chapter on the food article feed apparatus starting on page 23 of the description; and figures 14 and 15 of the published application provided a basis for claim 1 as granted.

The patent proprietor argued that the skilled person derived from claims 58 and 59 all the technical information found in claim 1 as granted. The claim still included the relationship between the food article feed apparatus and the slicing machine as it included the features that the food article paths were configured to intersect a cutting path of a slicing machine.

- 2.3 The board does not find the patent proprietor's arguments convincing.

- 2.3.1 Claims 58 and 59 of the published application read as follows:

"58. A food article slicing machine, comprising:
a slicing station comprising a knife blade and a knife blade drive driving the blade along a cutting path;

a food article feed apparatus supporting food articles for movement along food article paths intersecting the cutting path; and said food article feed apparatus for independently moving at least three loaves into said cutting path.

59. The food article slicing machine of claim 58, wherein said food article feed apparatus comprises:

a first conveyor for independently moving a first food article toward said cutting path;
a second conveyor for independently moving a second food article toward said cutting path;
a third conveyor for independently moving a third food article toward said cutting path."

2.3.2 As indicated by the patent proprietor, it is established case law that the "gold standard" (G 2/10, Reasons 4.3) is used to determine whether subject-matter has been added which extends beyond the content of the application as originally filed (Case Law of the Boards of Appeal ("CLB"), 10th edition 2022, II.E. 1.3.1).

The gold standard sets out that any amendment to the description, claims and drawings can be made only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as originally filed.

2.3.3 The board agrees with the opposition division's findings that the skilled person, when reading original claims 58 and 59 would not directly or unambiguously

derive the disclosure of a food article feed apparatus alone, without the slicing machine including the slicing station comprising a knife blade and a knife blade drive.

- 2.3.4 The patent proprietor argued that the opposition division focused disproportionately on the structure of the claims as filed.
- 2.3.5 The board however is of the view that a skilled person when reading a claim directed to a food slicing machine comprising a slicing station with certain features and a food article feed apparatus with features which are directly related to the slicing station (the cutting path), does not derive, directly and unambiguously, that the slicing machine with a slicing station and associated features was an optional feature of the claim.
- 2.3.6 The board also agrees with the opposition division that the further claims and passages of the description indicated by the patent proprietor do not disclose, in isolation, the combination of the features of claim 1 as granted.

Although claim 72 directly and unambiguously discloses a food article feed apparatus, the feed apparatus of this claim has two conveyors (or four conveyors in claim 77), not three conveyors, and a specific drive shaft arrangement with hollow and inner shafts which is not found in claim 1 as granted. Therefore claims 72 to 77 do not disclose the specific combination of features of claim 1 as granted.

The passage of the description, starting from page 23, as well as figures 14 and 15 disclose a specific

embodiment of a lower conveyor of a food article feed apparatus with four conveyors and a drive arrangement using drive rollers and belts, not an apparatus with the features of claim 1 as granted in isolation.

2.4 The patent proprietor has therefore not shown that the opposition division was incorrect in finding that the subject-matter of claim 1 of the main request extended beyond the content of the application as originally filed.

3. *Consideration of auxiliary requests A, A_cor and I before auxiliary request I_cor*

3.1 Opponent 2 objected to the positioning of auxiliary requests A, A_cor and I as higher ranking in the appeal proceedings than auxiliary request I_cor, which the opposition division found to meet the requirements of the EPC.

These requests had been lower ranking requests during opposition proceedings, as the patent proprietor had placed only the auxiliary requests E, E0, E3_cor, B_cor, F_cor and G_cor above auxiliary request I_cor in the opposition proceedings (see minutes of oral proceedings of 12 January 2022 to 14 January 2022, points 5.1, 5.7 to 5.11 and 6.2.4).

Opponent 2 argued that auxiliary requests A, A_cor and I could and should have been presented as higher ranking requests than auxiliary request I_cor before the opposition division, with the consequence that the opposition division would then have decided on these requests.

They should therefore not be admitted into the appeal proceedings under Article 12(6) RPBA.

- 3.2 The board notes that the order in which the requests were considered before the opposition division was determined by the patent proprietor (see minutes of oral proceedings of 12 January 2022 to 14 January 2022, point 5.1 and minutes of oral proceedings of 11 May 2021 to 12 May 2021, points 3.1, 4.1.12, 6.6 and 6.8).

As the set of claims according to auxiliary request I_{cor} was placed above auxiliary requests A, A_{cor} and I during opposition proceedings, requests A, A_{cor} and I were never procedurally active as there was no need for the opposition division to decide on them once a higher ranking request was found allowable.

As the opposition division could not decide on these requests, there is no decision for the board to review for these requests (Article 12(2) RPBA).

They cannot be made higher ranking than auxiliary request I_{cor} for the first time in the appeal proceedings, unless the circumstances of the appeal case justify this (see T 1404/20, Reasons 1.1 to 1.8 and T 1809/22, Reasons 4.1 to 4.4).

- 3.2.1 The patent proprietor argued that all the features of auxiliary requests A and A_{cor} were dealt with in the decision under appeal as the decision dealt with auxiliary requests E and E0.
- 3.2.2 However, claim 1 of both auxiliary requests A and A_{cor} is broader than claim 1 of auxiliary requests E and E0 due to the shear frame features included in claim 1 of

auxiliary requests E and E0. Claim 1 of auxiliary request I also does not include the shear frame features but instead has other features relating to a lift tray, which are also not found in auxiliary requests A and A_cor.

- 3.2.3 Therefore, objections which could have been raised regarding claim 1 of auxiliary requests A, A_cor and I, in particular for, but not limited to, added subject-matter, novelty or inventive step, would not necessarily have been raised for claim 1 of auxiliary requests E or E0. As these possible objections are not part of the decision under appeal they cannot be reviewed.
- 3.3 The board, therefore, cannot see any circumstances in the present case which would justify changing the order of requests to place lower ranking requests, not decided upon by the opposition division, above a higher ranking request which was found by the opposition division to meet the requirements of the EPC.
- 3.4 Auxiliary requests A, A_cor and I cannot be considered in the appeal proceedings before considering auxiliary request I_cor (Article 12(6) RPBA).
- 3.5 In addition, none of these requests is allowable (see below, point 12. for auxiliary requests A and A_cor and point 6. for auxiliary request I).
4. The appeal of the patent proprietor must therefore be dismissed.

Opponent 2's appeal

5. *Auxiliary request I_cor - claim 1 - Article 123(2) EPC*

- 5.1 Opponent 2 contested the findings of the opposition division that the requirements of Article 123(2) EPC were fulfilled for claim 1 of auxiliary request I_cor arguing *inter alia* that the absence of a food article transfer mechanism in claim 1 leads to an unallowable intermediate generalisation.
- 5.2 The opposition division reasoned that the basis for the amendments to claim 1 of auxiliary request I_cor were claims 58, 59 and 107 of the published application and found that there was no contravention of Article 123(2) EPC in combining the independent claims 58 and 107, as the combination of features was disclosed "in combination in the description as being part of the same machine and the combination requires no more features than those contained in claims" (see decision under appeal, point II.10.2).
- 5.3 Opponent 2 argued that as the application as originally filed contained twenty-six independent claims, the combination of any two of these twenty-six claims (as, for example, claims 58 and 107 for claim 1 of auxiliary request I_cor) could not be considered to be directly and unambiguously derivable from the application documents but instead represented an arbitrary selection from a very large number of alternatives.
- 5.4 The patent proprietor argued, in its submissions of 1 December 2023 and at the oral proceedings, that the combination of the two independent claims 58 and 107 could not be considered an arbitrary combination as there were a number of pointers to this specific combination.

The patent proprietor considered that the status of the features as claimed features; the common features of the two independent claims; and the presence of the features, in combination, in an embodiment of the description, were all explicit pointers to the specific combination.

5.5 *Claims of application as published as the basis for the amendments*

5.5.1 In a first line of argument, the patent proprietor put forward that the claims alone provided the basis for the combination of features in claim 1 of auxiliary request I_{cor}.

5.5.2 According to the patent proprietor, a finding that the combination of the two independent claims was not directly and unambiguously derivable from the documents as originally filed, would place a disproportionate focus on the structure of the claims rather than considering what was disclosed to the skilled person by the application as a whole.

The patent proprietor cited decisions T 2619/11, T 479/20, T 1194/15 and T 266/16 in support of its argument.

5.5.3 The board notes that the purpose of Article 123(2) EPC is to create a fair balance between the interests of patentees on the one hand and competitors and other third parties on the other; what constitutes a fair balance depends on the circumstances of the individual case (G 1/93, Reasons 8.).

Therefore, although a common standard for assessing compliance is used, namely the gold standard (as set

out above in point 2.3.2), whether an amendment is directly and unambiguously derivable can only be determined by taking into account the disclosure of the specific case (CLB, *supra*, II.E.1.1).

- 5.5.4 In the decisions cited by the patent proprietor, the competent boards found that combinations of dependent claims which were originally claimed only as individually directly dependent on the independent claim, were found to be directly and unambiguously derivable (see T 2619/11, Facts and submissions, X. and Reasons 2.8 to 2.10; T 479/20, Reasons 4.1 and 4.2; T 1194/15, Reasons 3.1 to 3.5; T 266/16, Reasons 3.3).

As put forward by opponent 2 at the oral proceedings before the board, none of these decisions dealt with the same or a similar claims structure as that of the present case.

The published application of the patent in suit contains one hundred and fifty-seven claims. Twenty-six of the claims are independent and of these twenty-six, twenty independent claims are directed to a slicing machine or a food article slicing machine.

- 5.5.5 The board agrees with the patent proprietor that when considering a combination of features pertaining to separate embodiments (in this case separate independent claims), it is established case law that the presence of a clear pointer to a specific combination can render the combination directly and unambiguously derivable (see CLB, *supra*, II.E.1.6.1 a)).

The board cannot, however, agree that in the present case a clear pointer exists.

5.5.6 The patent proprietor argued that the common features of claims 58 and 107 serve as a pointer. However, as argued by opponent 2, there is no indication in the application as published that these common features form a particular embodiment to which other features of the independent claims may be optionally added.

In any case, as indicated by the patent proprietor itself at the oral proceedings before the board, there are at least fifteen independent claims, with these same common features, so that if these common features are considered to be a pointer, they do not point to the specific combination of claims 58 and 107, but rather to any arbitrary combination of two or more of these fifteen independent claims.

5.5.7 Similarly, the mere fact that all the features of claim 1 of auxiliary request I_cor are found in the claims cannot be considered to be a clear pointer to the specific combination of claims 58 and 107. The skilled person would regard the individual independent claims themselves as specific embodiments, but not any arbitrary combination of these independent claims.

5.5.8 The patent proprietor argued further that the set of claims should be seen as part of the general part of the disclosure, from which it was unproblematic to add preferred features to an independent claim. The multiple independent claims in the present case did not constitute alternatives and always referred to the same embodiment.

In the board's view, although an overly formulistic focus on the claim structure should be avoided (T 2619/11, catchword and Reasons 2.6), the structure of the claims also cannot be completely ignored

(T 522/11, Reasons 1.9; T 487/20, Reasons 1.2.3; T 2282/16, Reasons 2.3).

Claims 58 and 107 were intentionally formulated as independent claims in a claims set with a further twenty-four independent claims, many with subsequent dependent claims. The skilled person clearly derives from this formulation that the independent claims are to be considered as separate embodiments, not merely a set of preferred features which can be combined at will.

- 5.5.9 There is, therefore, no direct, explicit disclosure of the combination of features of claim 1 of auxiliary request I_cor in the claims as originally published as claims 58 and 107 are formulated as separate independent claims.
- 5.5.10 There is also no implicit disclosure based only on the claims of the published application. The common features cannot constitute a pointer to the specific combination of claims 58 and 107 because the same pointer also points to all the other combinations of the fifteen claims with the same common features, so that any of these combinations has to be considered to be arbitrary and not unambiguously derivable.
- 5.5.11 The patent proprietor argued further, that the description acted as a pointer to the combination of features of independent claims 58 and 107 as all the features of these claims were disclosed in combination in the embodiment described.
- 5.5.12 The board does not agree. In the application as published there appears to be a main embodiment directed to a high speed slicing apparatus and a

weighing or classifying conveyor or output conveyor, which is discussed over forty-two pages of description (application as published, pages 5 to 47) and eighty-three figures.

- 5.5.13 This embodiment cannot be considered to constitute a pointer to the specific combination of claims 58 and 107. It appears to be a pointer to all or any possible combinations of features of the independent claims as originally published. The particular combination of features of claims 58 and 107 are not indicated as being particularly necessary or desirable to solve any technical problem.

The board understands a pointer as a disclosure which indicates or suggests a specific combination. The combination then cannot be considered to be arbitrary and is thus directly and unambiguously derivable by the skilled person. However, if a pointer points at everything, it is no longer indicating a specific combination and the skilled person cannot directly and unambiguously derive the specific combination.

- 5.6 *Description of application as published as the basis for the amendments*

- 5.6.1 In a second line of argument, in its written submissions, the patent proprietor gave page 16, lines 10ff; page 45, line 15 to page 46, line 4; figures 7 to 10, 61 and 62 as a basis for the combination of the slicing station, food article feed apparatus and food article loading apparatus in one and the same machine.

- 5.6.2 The patent proprietor argued that there was no unallowable intermediate generalisation in the present case. The test whether features taken from an

embodiment were disclosed in structural or functional isolation was not suitable in the present case. The combination claimed in claim 1 of auxiliary request I_cor was not based on features taken from the embodiment but rather on the claims themselves, which already disclosed the features in isolation from the embodiment. The patent proprietor again cited decisions T 2619/11, T 479/20, T 1194/15 and T 266/16 in support of its argument.

- 5.6.3 The board does not agree. As set out in points 5.5.4 to 5.5.8 above, the board regards the circumstances of the cases of the cited decisions as significantly different from the present case.

The combination of features of claims 58 and 107 is not disclosed in the set of claims as published (see point 5.5 of this decision).

The board follows the established case law that it is not normally allowable to base an amended claim on the extraction of isolated features from an embodiment, unless a clearly recognisable structural and functional relationship is absent (see CLB, *supra*, II.E.1.9.1).

- 5.6.4 The passages of the description cited by the patent proprietor cannot be seen as a basis for the specific combination of features in claim 1 of auxiliary request I_cor for the following reasons.

The description on pages 45 and 46 does not relate to a food article feed apparatus or a food article loading apparatus so that the skilled person cannot directly and unambiguously derive the combination of features of claim 1 from this passage.

Figures 7 to 10, 61 and 62 show (parts of) a slicing machine but with many additional features which clearly have a functional and structural relationship to those features claimed. There is no indication to the skilled person that only the combination of features found in claim 1 could be isolated from the other features shown.

The description, page 16, lines 10 to 17, discloses a food article loading apparatus but clearly indicates that the food article lateral transfer apparatus 236 forms part of the food article loading apparatus and is structurally and functionally connected to the further features of the loading apparatus, i.e. the lift tray assembly 220 and lift tray positioning apparatus 228, in order to load food articles from the lift tray into the food article feed apparatus 120. In addition this embodiment shows four food article support plates, i.e. four lanes not three.

There is no indication that the food article transfer apparatus is an optional feature of the food article loading apparatus and there is no direct and unambiguous disclosure of a loading apparatus together with a food article feed apparatus with three conveyors.

- 5.7 In view of the above points, opponent 2 has convincingly demonstrated that the decision was incorrect on this point and claim 1 of auxiliary request I_{cor} does not fulfil the requirements of Article 123(2) EPC.
6. The board notes that the reasons set out above for auxiliary request I_{cor} apply equally to claim 1 of auxiliary request I.

7. Auxiliary requests I1 and I1 cor

Claim 1 of auxiliary requests I1 and I1_cor differs from claim 1 of auxiliary request I_cor only through the addition of the word "pivotable" in both requests and the re-introduction of the term "at least" in auxiliary request I1. These amendments do not overcome the objection under Article 123(2) EPC to auxiliary request I_cor, so that auxiliary requests I1 and I1_cor are also not allowable.

8. "Shear frame" - auxiliary requests E, E0, E1, E1 cor, E2, E2 cor, E3, E3 cor, C3, C3 cor, C'3, C'3 cor, C4, C4 cor, C'4 and C'4 cor - claim 1 - Article 123(2) EPC

- 8.1 Auxiliary requests E, E0 and E3_cor were considered in the decision under appeal.
- 8.2 The patent proprietor gave a combination of claims 58, 59 and 47-49 of the application as published, as well as page 36, line 17 to page 38, line 2; page 45, line 15 to page 46, line 4 and figures 43, 44, 61 and 62 of the application as published as the basis for claim 1 of auxiliary requests E and E0.
- 8.3 Opponent 2 argued that the combination of independent claims 58 and 47 is an arbitrary selection which is not directly or unambiguously derivable for the skilled person from the documents as originally filed.
- 8.4 The board agrees with opponent 2 that the combination of features of claims 58 and 59 of the application as published, together with the features of claims 47 to 49 is not directly and unambiguously derivable from the

claims alone for analogous reasons to those set out in point 5.5 above.

- 8.5 Regarding the disclosure of the combination of features in the description, the opposition division reasoned that the "U-shaped frame is part of the same machine to which the whole description refers" and also that pages 37 and 38 disclosed a shear support as a separate entity without any link to a specific embodiment of the food article slicing machine (decision under appeal, page 17, final paragraph with respect to auxiliary request E0).

Further, as the top cross bar did not form part of claim 49, its absence was not to be objected to, so that the subject-matter of claim 1 of auxiliary request E0 (and analogously auxiliary request E) did not extend beyond the application documents as originally filed (decision under appeal, page 18, point II.4.2.4).

- 8.6 The board agrees with the opposition division's reasoning that the U-shaped frame is part of the same machine to which the whole description refers. However, the passage on pages 37 to 38, which refers to figures 43 and 44, shows a specific shear support in a specific machine, i.e. the machine to which the whole description refers, not a shear support as a separate entity.

In any case, it has to be considered whether the specific extraction of some features from the embodiment without other features present in the embodiment is allowable or if it leads to a claim which goes beyond the content of the application as originally filed.

Some features of the shear support described on pages 37 to 38 are disclosed as being optional, for example the material of the support or the number, shape or size of the openings in the support (published application, page 37, lines 20 to 24, page 38, line 11). The specific shear frame, however, includes further features in addition to the U-shaped frame which are functionally and structurally linked to the U-shaped frame.

As opponent 2 argued, the embodiment described on pages 37 and 38 has a top cross bar 3076 which fits on the support 3060 and is bolted to the upright members of the U-shaped frame. It is the top cross bar together with the U-shaped frame which form the shear frame, not the U-shaped frame alone. The skilled person understands the top cross bar as being functionally and structurally linked to the U-shaped frame to form the complete frame.

8.7 The further passages of the description cited by the patent proprietor do not show a U-shaped frame in combination with the other features of claim 1 of auxiliary request E or E0.

The passage of the description of the published application on page 45, line 15 to page 46, line 4 does not relate to the shear frame and the embodiments shown in figures 61 and 62 show no detail of a shear frame.

8.8 Therefore opponent 2 has convincingly shown the incorrectness of the decision under appeal and that the subject-matter of claim 1 of auxiliary requests E and E0 extends beyond the content of the application as originally filed and contravenes Article 123(2) EPC.

8.9 As the amendments made to claim 1 in auxiliary requests E1, E1_cor, E2, E2_cor, E3 and E3_cor do not overcome this objection, these requests also do not meet the requirements of Article 123(2) EPC.

8.10 The same objection also applies to claim 1 of auxiliary requests C3, C3_cor, C'3, C'3_cor, C4, C4_cor, C'4 and C'4_cor.

9. "Output conveyor" - auxiliary requests B, B cor, B', B' cor, C, C cor, C', C' cor, C'', C'' cor, C''' and C''' cor - claim 1 - Article 123(2) EPC

9.1 Auxiliary request B_cor was considered in the decision under appeal.

9.2 The patent proprietor gives a combination of claims 1, 58 and 59 of the application as published, as well as page 23, lines 1 to 5; page 45, line 15 to page 46, line 4 and figures 4A, 59, 61 and 62 as the basis for claim 1 of auxiliary requests B and B_cor.

9.3 Opponent 2 argued that the combination of independent claims 1 and 58 is an arbitrary selection which is not directly or unambiguously derivable for the skilled person from the documents as originally filed.

9.4 The board agrees with opponent 2 that the combination of features of claims 1 and 58 of the published application is not directly and unambiguously derivable from the claims alone for analogous reasons to those set out in point 5.5 above.

9.5 Regarding the disclosure of the combination of features in the description, the opposition division reasoned that an embodiment was disclosed in the description of

the application as published, starting from the last paragraph of page 43, with a device comprising all the features of claims 1, 58 and 59 (decision under appeal, page 41, second paragraph with respect to auxiliary request B_cor).

However, as argued by opponent 2, the disclosure in the description of the published application is to a specific output conveyor, namely the weighing and classifying conveyor. This conveyor has a number of features which are functionally and structurally linked, such as the pair of rails and slide bearings which allow the conveyor to be in a normal position or a clean-up position as claimed.

- 9.6 The further passages of the description cited by the patent proprietor do not show an output conveyor with the other features of claim 1 of auxiliary request B and B_cor in isolation.

The passage on page 23, lines 1 to 5 does not relate to an output conveyor. Figure 59 and page 45, line 15 to page 46, line 4 relate to the weighing and classifying conveyor discussed in point 9.5 above, not a general output conveyor. The embodiments shown in figures 61 and 62 do not show a normal and clean-up position or a general output conveyor.

- 9.7 Opponent 2 has therefore convincingly shown the incorrectness of the decision under appeal with respect to whether claim 1 of auxiliary request B_cor (and analogously claim 1 of auxiliary request B) fulfils the requirements of Article 123(2) EPC.

- 9.8 As the amendments made to claim 1 in auxiliary requests B', B'_cor, C, C_cor, C', C'_cor, C'', C''_cor, C'''

and C'''_cor do not overcome this objection, these requests are also considered not to meet the requirements of Article 123(2) EPC.

- 9.9 The same objections apply to claim 1 of auxiliary requests C1, C1_cor, C'1, C'1_cor, C2, C2_cor, C'2, C'2_cor, D and D_cor, and also to auxiliary requests C3, C3_cor, C'3, C'3_cor, C4, C4_cor, C'4, C'4_cor, in addition to the objections dealt with under point 8. above.
10. "Lateral positioning" - auxiliary requests F, F cor, G, G cor - claim 1 - Article 123(2) EPC
- 10.1 Auxiliary request F_cor was considered in the decision under appeal (see section II.8 of the reasons for the decision under appeal).
- 10.2 The patent proprietor gives a combination of claims 58, 59, 140 and 153 of the published application, as well as page 45, line 15 to page 46, line 22 and figures 61, 62 and 80 to 83 as the basis for claim 1 of auxiliary requests F and F_cor.
- 10.3 Opponent 2 argued that the combination of independent claims 58 and 140 is an arbitrary selection which is not directly or unambiguously derivable for the skilled person from the documents as originally filed.
- 10.4 The board agrees with opponent 2 that the combination of features of claims 58 and 140 of the description as published, or claims 58 and 153, is not directly and unambiguously derivable from the claims of the published application alone, for analogous reasons to those set out in point 5.5 above.

10.5 Regarding the disclosure of the combination of features in the description, the opposition division reasoned that in the embodiment shown in figure 80 of the published application (see description page 46, line 8 to page 47, line 2), the position at which slices were received on the first conveyor could be changed by laterally moving the upstream end of the conveyor (decision under appeal, page 44, fifth paragraph, with respect to auxiliary request F_cor).

However, as argued by opponent 2 this embodiment does not appear to disclose a general lateral positioning of slices but rather a lateral positioning of conveyors to ensure that slices are positioned at the same lateral position. In any case, this embodiment relates to a specific conveyor which is disclosed only in combination with other features not found in claim 1 of auxiliary request F and F_cor, such as four deceleration conveyors.

10.6 The further passages of the description cited by the patent proprietor do not disclose the lateral positioning of the slices in combination with the other features of claim 1 of auxiliary request F or F_cor.

The description on page 45, line 15 to page 46, line 22 also relates to the specific embodiment mentioned in conjunction with figure 80. Figures 61 and 62 do not show lateral positioning of slices.

10.7 Therefore opponent 2 has convincingly shown the incorrectness of the decision under appeal with respect to whether claim 1 of auxiliary request F_cor (and analogously claim 1 of auxiliary request F) fulfils the requirements of Article 123(2) EPC.

10.8 Claim 1 of auxiliary requests G and G_cor is also based on the combination of independent claims 58 and 140.

The same reasoning as given above for auxiliary request F_cor applies also to auxiliary requests G and G_cor and claim 1 of these auxiliary requests does not fulfil the requirements of Article 123(2) EPC.

11. "Drive arrangement" - Auxiliary requests J, J' and J_cor

11.1 None of auxiliary requests J, J' and J_cor were decided on by the opposition division in the decision under appeal. The subject-matter of claim 1 of these requests is based on claims 1, 13, 6 and 11 as granted.

11.2 Opponent 1 requested in writing that the case be remitted to the opposition division for further prosecution for auxiliary requests which did not form part of the decision under appeal, including auxiliary requests J, J' and J_cor.

In view of the patent proprietor's request for acceleration of the appeal proceedings due to the pending infringement proceedings and also the age of the contested patent, the board saw no reason to grant this request under Article 111(1) EPC.

11.3 *Auxiliary requests J, J' - Article 123(2) EPC*

11.3.1 The patent proprietor gave the basis for these claims as claims 58, 59, 61 and 66 of the published application.

11.3.2 Claim 66 is directly dependent on claim 61, which in turn is directly dependent on claim 59. Claim 59 is

dependent on claim 58, therefore the application documents as originally filed disclose directly and unambiguously the combination of these four claims.

However, claim 1 of auxiliary requests J and J' is not a direct combination of the four claims.

Claim 58 specifies "said food article feed apparatus for independently moving at least three loaves into said cutting path". Claim 59 recites a first, a second and a third conveyor "for independently moving" a first, second and third food article respectively "toward said cutting path".

The corresponding feature in claim 1 of auxiliary requests J and J' reads, however, "at least three conveyors, each conveyor having a conveyor belt (802, 804, 806) configured to independently move a food article along one of said food article paths into the cutting path (2080)."

There is no disclosure in original claims 58, 59, 61 or 66 of more than three conveyors configured to move a food article along one of said food article paths into the cutting path.

- 11.3.3 In the decision under appeal, with respect to auxiliary request E, the opposition division found that original claim 58 provided support for more than three conveyor belts as it referred to "at least three loaves" (see decision under appeal, page 14).

The board cannot agree with this reasoning and follows the arguments of opponent 2.

Claim 58 only specifies a food article feed apparatus for independently moving at least three loaves into the cutting path but does not mention conveyors or conveyor belts. Claim 59 specifies a first, second and third conveyor for independently moving a first, second and third food article toward the cutting path.

There is therefore no disclosure in these two claims of more than three conveyors, each conveyor having a conveyor belt being configured to independently move a food article along a food article path into the cutting path.

11.3.4 Therefore claim 1 of both auxiliary requests J and J' contravenes Article 123(2) EPC.

11.4 *Auxiliary request J_cor - novelty (Article 54 EPC) - alleged public prior use Weber 904 slicer*

11.4.1 Opponent 2 repeated its objection of lack of novelty of claim 1 of auxiliary request J_cor from the written opposition proceedings.

It argued that the alleged public prior use Weber 904 slicer showed all features of claim 1 of auxiliary request J_cor.

11.4.2 The patent proprietor argued that the Weber 904 slicer was (a) not made publicly available before the priority date of the contested patent and (b) did not show the following feature present in claim 1 of all requests:
"each conveyor having a conveyor belt (802, 804, 806) configured to independently move a food article along one of said food article paths into the cutting path (2080)."

11.5 (a) *Public availability of Weber 904 slicer*

The opposition division found that the Weber 904 slicer had been made available to the public before the priority date of the contested patent through delivery to the following customers:

- Kemper GbmH & Co. KG, ("Kemper") documents D29, D30, D31, D33, D34, D37, D38, machine numbers 904-7004, 904-7005, 904-7006;
- Egetürk GmbH & Co. KG ("Egetürk"), documents D44 to D45, machine number 904-7032;
- Westfleisch Erkenschwick GmbH ("Westfleisch"), documents D47, D48, D50, D51, D52, D54 and D55, machine numbers 904-7045 and 904-7046;
- Den Hollander Food BV ("Den Hollander"), documents D121, D122, D125, D126, D127, machine number 904-7117.

The Kemper installation was confirmed by the witness testimony of Mr Junker and Mr Rother; the Egetürk installation by witness Junker; the Westfleisch installation by witnesses Junker, Rother and Sus and the Den Hollander installation by witnesses Rother and Kamsteeg.

- 11.5.1 The patent proprietor contested the findings of the opposition division and argued that the alleged public prior use had not been proven up to the hilt as sales contracts and valid general terms and conditions of the sales were missing. In addition, the patent proprietor argued that the opposition division failed to appreciate the industry practice on secrecy; the alleged public prior uses took place on non-public property and relevant technical features could not be recognised from the outside of the machines.

- 11.5.2 The board does not find the patent proprietor's arguments convincing and agrees with the findings of the opposition division.

Regarding the sales contracts and general terms and conditions of sale, as reasoned by the opposition division, there is no obligation on a party to file a specific type of evidence. The opposition division was convinced that the installations had taken place when taking into account the documentary evidence provided in the documents submitted by opponent 2 and the testimony of the witnesses. It was therefore unnecessary for opponent 2 to provide further evidence.

- 11.5.3 The patent proprietor argued that the general terms and conditions of the Weber group dated 2008 (item X.1. of document D104) defined a non-disclosure agreement relating to "information" in general.

The board understands this to mean that the patent proprietor sees the existence of an explicit confidentiality agreement.

The board however agrees with the opposition division that there was no explicit confidentiality agreement. The witness testimonies confirmed that witnesses from both the manufacturer and at least two of the customers were unaware of any confidentiality agreement in relation to the general technical set-up of the machine.

Item X.1 of D104 refers to the copyright of documents, not to any general confidentiality agreement and in any case in the sales of the Weber slicers 904-7004/5/6 the general terms and conditions were not applicable.

11.5.4 Regarding the tacit secrecy agreement that the patent proprietor argued was standard in the industry, the board again follows the reasoning of the opposition division that the documents on file and the witness testimonies confirmed that no tacit secrecy agreement could be considered to exist.

Firstly, the machines were not individually manufactured for each client, but rather were standard machines which were customised if necessary. Secondly, Weber promoted the slicer at trade fairs and had sold the slicer to a number of different customers. Finally, the buyers were free to sell the machine, including technical documentation.

The patent proprietor's argument that the machines were used on non-public property also cannot be followed. As opponent 2 argued, the opposition division's findings were that the customers Kemper, Egetürk, Westfleisch and Den Hollander formed part of the public, so that whether the customers' facilities were restricted or not is not relevant (see T 2210/12, Reasons 1.2.2). It is therefore also not relevant whether the inner workings of the machine could clearly be viewed when in use, as the production and maintenance employees of the customers as well as third party service technicians from other suppliers would all have had access to the machine and/or its documentation, as reasoned in the decision under appeal.

11.6 (b) *feature "into the cutting path"*

11.6.1 It is not contested by the opponents that the product feed belt of the Weber 904 slicer is not arranged directly upstream of the cutting path of the knife blade. There is a lower conveyor and an upper conveyor

over the lower conveyor, downstream of the product conveyors and before the knife.

11.6.2 However, the opponents argued that the feature did not require any particular arrangement or position of the conveyor belts in relation to the slicer, it only required that the conveyor belts were configured to independently move a food article along one of said food article paths into the cutting path.

11.6.3 The patent proprietor argued that the skilled person would interpret the claim, from the claim wording alone, to mean that the conveyor belts have to be arranged directly upstream of the cutting path. The description of the contested patent, according to the patent proprietor, also supported this interpretation as shown in figures 16 and 61 to 63 of the application as published.

The patent proprietor also submitted that the Weber 904 slicer did not show conveyors where each conveyor independently moved a food article along a food article path, but rather had conveyors which interdependently moved the food articles, as the movement of each conveyor in the Weber 904 slicer was coordinated and adapted to the other conveyors, in order to align the ends of the food articles with one another. The Weber 904 slicer therefore did not have the function of track-independent slice thickness adaption.

11.6.4 It is established case law that limitations cannot be read into a claim if they are not suggested by the explicit wording of the claim (CLB, *supra*, II.A.6.3.4).

11.6.5 The board agrees with opponent 2 that the feature in question does not require that the conveyors are

directly upstream as there is no limitation in the claim that there must be no other elements between the conveyor belts and the cutting path of the knife. It only requires that the conveyors move the food articles into the cutting path. This was found by the opposition division in relation to claim 1 of auxiliary request B_cor in the Weber slicers (including Weber slicers 904-7004/5/6), because *"it is the 'Produktförderband' which has the ability of conditioning the speed of the product so as to allow products of different lengths to start and end simultaneously. Therefore it is that conveyor which is mainly responsible for moving the products into the cutting path for a substantial part of the product length, despite not preceding the knife directly"* (see decision under appeal, page 42, fifth paragraph and paragraph bridging pages 38 and 39).

- 11.6.6 The term "independently move" in claim 1 has to be interpreted broadly, as argued by opponent 2 at the oral proceedings before the board. It does not require that the slice thicknesses are varied, it requires only that the food articles are moved independently, which is the case in the Weber 904 slicer as each conveyor is separately driven by its own motor.

The patent proprietor's arguments that the conveyor belts in the Weber slicer were not "configured to" independently move a food article are not convincing. The conveyor belts of the Weber slicer are configured to independently move the food articles as they are configured to move the food articles separately from one another, at differing speeds.

- 11.6.7 The patent proprietor did not contest the disclosure of any other feature of claim 1 of auxiliary request J_cor in the Weber 904 slicer.

11.6.8 The board thus finds that the subject-matter of claim 1 of auxiliary request J_cor is not novel over the prior use Weber 904 slicer.

12. The same reasoning as given above in points 11.4 to 11.6 applies to the subject-matter of claim 1 of auxiliary requests A and A_cor, which both contain only features which are present in claim 1 of auxiliary request J_cor, and are therefore also not novel with respect to the Weber 904 slicer.

13. *"Upper conveyors" - auxiliary requests H and H_cor*

13.1 The patent proprietor gives a combination of claims 58, 59, 78 and 83 of the published application as the basis for claim 1 of auxiliary requests H and H_cor.

13.2 Opponent 2 argued that the combination of independent claims 58 and 78 is an arbitrary selection which is not directly or unambiguously derivable for the skilled person from the documents as originally filed. In addition, the further features of independent claim 78 relating to the two drive shafts have been inadmissibly omitted from the claim.

13.3 The board agrees with opponent 2 that the combination of features of claims 58 and 59, together with part of the features of claims 78 and 83 is not directly and unambiguously derivable from the claims of the published application alone, for analogous reasons to those set out in point 5.5 above.

In addition the board agrees that claim 78 also includes features of a hollow/inner drive shaft arrangement for two upper conveyors which is not in

claim 1 of auxiliary requests H or H_cor, although it is clearly functionally and structurally related to the feature of the first and second upper conveyor as it defines how the conveyors are driven.

- 13.4 Therefore claim 1 of auxiliary requests H and H_cor also contravenes Article 123(2) EPC.

Conclusion

14. In view of the above reasons, none of the requests are allowable as claim 1 of the main request, auxiliary requests I, I_cor (maintained version), I1, I1_cor, E, E0, E1, E1_cor, E2, E2_cor, E3, E3_cor, B, B_cor, B', B'_cor, C, C_cor, C', C'_cor, C'', C''_cor, C''', C'''_cor, F, F_cor, G, G_cor, J, J', C1, C1_cor, C'1, C'1_cor, C2, C2_cor, C'2, C'2_cor, C3, C3_cor, C'3, C'3_cor, C4, C4_cor, C'4, C'4_cor, D, D_cor, H and H_cor does not fulfil the requirements of Article 123(2) EPC and the subject-matter of claim 1 of auxiliary requests A, A_cor and J_cor is not novel (Article 54 EPC) with respect to the public prior use Weber 904 slicer.
15. In the absence of any allowable request the patent must be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



G. Nachtigall

G. Patton

Decision electronically authenticated