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**Datasheet for the decision
of 2 March 2021**

Case Number: T 0469/17 - 3.5.02

Application Number: 07706201.6

Publication Number: 1984122

IPC: B07C5/16, B07C5/38, A22C25/04,
B25J9/00, B25J11/00

Language of the proceedings: EN

Title of invention:

Apparatus and method for grading fresh food articles based on weight

Patent Proprietor:

Valka Ehf

Opponent:

Nordischer Maschinenbau
Rud. Baader GmbH + Co. KG

Relevant legal provisions:

EPC Art. 123(2)
RPBA 2020 Art. 13(2)

Keyword:

Amendments - main request - allowable (no)
Amendment after summons - auxiliary requests 1 to 3 -
exceptional circumstances (no)



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Case Number: T 0469/17 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 2 March 2021

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
22 December 2016 concerning maintenance of the
European Patent No. 1984122 in amended form.**

Composition of the Board:

Chairman R. Lord
Members: H. Bronold
W. Ungler

Summary of Facts and Submissions

- I. The appeal of the opponent lies from the decision of the opposition division concerning the maintenance of European patent No. 1 984 122 in amended form according to the then second auxiliary request.
- II. The appellant (opponent) requested that the decision under appeal be set aside and that the European patent be revoked.
- III. The respondent (patent proprietor) requested that the appeal be dismissed, or, if that was not possible, that the decision under appeal be set aside and the patent be maintained in amended form according to one of their auxiliary requests 1 to 3 filed together with their reply to the appeal dated 13 September 2017.
- IV. In a communication under Article 15(1) RPBA 2007 the board informed the parties that it tended to agree with the appellant in that claims 4 and 8 according to the respondent's main request filed with letter dated 13 September 2017 did not fulfil the requirement of Article 83 EPC and that claims 1 and 9 according to this main request contravened Article 123(2) EPC.
- V. With letter dated 11 August 2020 the respondent filed a main request and auxiliary requests 1 to 3 and requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of one of these requests. However, no statement was made regarding the status of the then already pending requests, i.e. the main request and

auxiliary requests 1 to 3 as filed with the reply to the appeal dated 13 September 2017.

VI. During the oral proceedings before the board, which were held on 2 March 2021 as a videoconference with the consent of both parties, the respondent withdrew the main request and auxiliary requests 1 to 3 as filed with letter dated 13 September 2017.

VII. Claim 1 according to the main request (11 August 2020) reads as follows:

"An apparatus for grading fresh food articles (100) based on at least one characteristic of the fresh food articles (100), wherein the grading comprises building up portions of the fresh food articles in containers (20, 21, 40-45), the apparatus comprising:
determining means (2, 3) for determining one or more characteristic parameters indicating the characteristics of the fresh food articles;
• a first conveyor (6) for conveying the fresh food articles along a closed-loop conveying path, the conveyor comprising a number of article holders (10, 11, 14) attached to the conveyor for holding the fresh food articles (103, 104) during the conveying along the closed-loop conveying path;
• arranging means (7, 8) for arranging the articles onto the article holders (10, 11, 14), the article holders being adapted to preserve the initial plane direction and the initial orientation of the fresh food articles from where the fresh food articles are arranged in a pre-defined way onto the article holders until the articles have been released into the containers;

- a processor for using the one or more characteristic parameters for selecting article holders suitable for the grading; and
- removing means (54) for removing the fresh food articles from the article holders into the containers; and
- wherein the determining means comprises a weight determining means (3), and wherein the characteristic parameters indicating the characteristics of the articles includes the weight of the fresh food articles; and

the apparatus further comprising at least one second conveyor (12, 13, 85, 85a-c) for conveying the containers during building up the portion, the at least a second conveyor comprising a first filling conveying section arranged below the first conveyor where the releasing of the fresh food articles from the article holders into the containers takes place, wherein the at least one second conveyor (12, 13, 85, 85a-c) is adapted to move in forward and backward direction substantially perpendicular to the conveying path of the first conveyor (6), wherein the conveyors (12, 13, 85, 85a-c) are further adapted to control the position of the containers (20, 21, 40-45) during building up the portions of the fresh food articles in containers (20, 21, 40-45)."

Independent method claim 7 defines a corresponding method of grading fresh food articles.

VIII. The wording of the respondent's auxiliary requests 1 to 3 is not presented here since none of them was found to be admissible.

IX. The arguments of the appellant, as far as they are relevant for this decision, can be summarised as follows:

Admittance

The main request was inadmissible since not all outstanding objections were overcome with this request.

The auxiliary requests 1 to 3 were also inadmissible because auxiliary request 1 included no reaction to the central objection, which was the one according to Article 123(2) EPC. Auxiliary request 2 returned to the previous wording "article holders" and thus returned to subject-matter involving objections that would already have been discussed with respect to the higher ranking requests. Finally, auxiliary request 3 included additional apparatus features to further limit the method of claim 1. This had no effect on the claimed method such that it was not foreseeable how auxiliary request 3 could overcome any of the outstanding objections. *Prima facie*, none of the auxiliary requests 1 to 3 was allowable. Moreover, the aspects of the objection of Article 123(2) EPC discussed in the board's communication under Article 15(1) RPBA 2007 did not represent a change in the procedure which could justify the submission of new requests. Further, not all of the respondent's new requests dealt with the features affected by the objection under Article 123(2) EPC.

Amendments

None of the cited passages of the application as originally filed disclosed the disputed features that the article holders were adapted to preserve the

initial plane direction and the initial orientation until the articles have been released into the containers. The arrangement and the orientation of articles was exclusively disclosed with respect to the described method, not with respect to the article holders. Further, the condition "have been released" as claimed in claim 1 could only be achieved after the articles had left the article holders which implied that this functionality could not be a feature of the article holders. The application as originally filed provided no basis for the disputed feature which therefore constituted an inadmissible intermediate generalisation.

- X. The arguments of the respondent, as far as they are relevant for this decision, can be summarised as follows:

Admittance

The main request and the auxiliary requests 1 to 3 were admissible. In the main request the amendment compared to the request on which the contested decision was based was merely that dependent claims 4 and 7 had been deleted. Thereby, the appellant's objection under Article 83 EPC was overcome. The main request did not change the case. Independent claims 1 and 7 were identical to those according to the previous main request. The main request and the auxiliary requests 1 to 3 further represented direct reactions to the issues raised in the board's communication under Article 15(1) RPBA 2007. In particular the board's detailed opinion on Article 123(2) EPC that the initial arrangement of articles was disclosed in combination with shovel-shaped grids supplemented the opponent's reasoning. This represented a new level of abstraction of the

discussion to which the respondent should be allowed to react with new requests.

Amendments

Claims 1 and 7 of the main request did not contravene Article 123(2) EPC. The originally filed application provided a basis for the disputed amendment on page 1, lines 4 to 8, page 2, lines 19 to 23 and 25, page 3, lines 15, 16 and 21, page 4, lines 2 and 3, page 5, lines 2, 3, 22 and 30, page 6, lines 1, 8 and 10, page 9, lines 4 to 20, page 10, lines 23 to 27, page 12, lines 19 to 29, page 15, line 14 and page 23, lines 6 and 7 of the description, figures 1 to 3, 8 and 9 and claims 1, 21 and 25. From the original disclosure, it was evident that controlling the arrangement comprised preserving the initial plane direction and the initial orientation of the articles on the holders. Thus, the holders were implicitly adapted to preserve the arrangement. The preservation of the direction and orientation was clearly dedicated to the article holders. The described method and the described apparatus corresponded to each other and the disclosure on page 10, lines 23 to 27 was not limited to the method. The disputed feature had been taken literally from originally filed claim 25. Merely the reference to controlling had been left out. This was also in line with original claims 1 and 21. Further, from figures 6a to 6c it followed that the article holders 70 had a rim unit 71 on which the articles could rest. Thus, the article holders were disclosed as being adapted to preserve the initial plane direction and the initial orientation of the articles.

Reasons for the Decision

1. Admissibility of the appeal

The appeal was filed in due form and time and sufficiently substantiated. Thus, the appeal is admissible.

2. Main request - Admittance - Article 13(2) RPBA 2020

The only amendment in the main request is the deletion of dependent claims 4 and 7 as a reaction to the objections under Article 83 EPC. Independent claims 1 and 7 are identical to the independent claims of the former main request.

Therefore, the board decided to exercise its discretion under Article 13(2) RPBA to admit the main request filed with letter dated 11 August 2020 into the appeal proceedings.

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

3.1 Claims 1 and 7 according to the main request contravene Article 123(2) EPC. The disputed feature in claims 1 and 7, namely

"the article holders being adapted to preserve the initial plane direction and the initial orientation of the fresh food articles from where the fresh food articles are arranged in a pre-defined way onto the

article holders until the articles have been released into the containers" (emphasis added by board),

extends beyond the content of the application as originally filed.

Although independent claim 7 is directed to a method, the features disputed with respect to apparatus claim 1 have been added to the wording of claim 7 in an identical manner, i.e. as apparatus features of the article holders, such that the arguments regarding apparatus claim 1 apply equally to method claim 7.

The only part of the original specification defining the initial plane direction and the initial orientation of the articles as added to claims 1 and 7 of the main request is on page 10, lines 23 to 27 of the description. This disclosure is, however, directed to an embodiment of the described method and defines how the arrangement of articles is controlled.

The board does not concur with the respondent in that the original disclosure of the embodiment of the described method of grading articles can be interpreted as an apparatus feature of the article holders as defined in claims 1 and 7. It is not conceivable how the activity "controlling" could imply any features of the article holders, which are defined as an entity. In particular, the patent is completely silent about how and by what technical apparatus features of the article holders the arrangement is controlled "until the articles have been released into the containers". The board is further not convinced that there is a basis in the originally filed documents that would allow deletion of the fact that the arrangement of fresh food articles is controlled. The independent claims 1 and 7

merely define that the arrangement is preserved, which is only the result of the "controlling".

- 3.2 While it is true that according to originally filed claim 1, the article holders are disclosed as being adapted to preserve the arrangement of the articles in the article holders, this original disclosure is limited in two aspects compared to the wording added to claims 1 and 7 of the main request.

Firstly and contrary to the wording added to claims 1 and 7, the article holders according to original claim 1 are adapted to preserve the arrangement in the article holders, whereas the added wording defines that the initial plane direction and the initial orientation is preserved.

Secondly, the original disclosure is limited to the period during the conveying, i.e. the period during which the articles are in the article holders, whereas the added wording extends further in time and location to until the articles have been released into the containers.

The board is further not convinced that the original disclosure for the added feature on page 10, lines 23 to 27 represents a specific embodiment of the disclosure on page 9, lines 4 to 20, as argued by the respondent. While it is true that the disclosure on page 9 is more general with respect to preserving the arrangement, both disclosures define a method of grading articles and neither of the two disclosures provides any further apparatus details of the article holders.

The same applies *mutatis mutandis* to originally filed claims 21 and 25, which correspond to the disclosure on page 9, lines 4 to 20 and page 10, lines 23 to 27, respectively. Further, although it is true that neither claim 1 nor claim 21 as originally filed comprise the feature controlling, it is evident that the expression "controlling the arrangement" used in originally filed claim 25 directly refers to the expression "arranging" used in claim 21. Again, no technical apparatus feature of the article holders can be found in claim 25. The respondent's argument, that it was the article holders, which preserved the initial plane direction and the initial orientation of articles, overlooks the fact that at least the last part of the controlling explicitly refers to a location outside the article holders, namely, the containers. Thus, the respondent's conclusion about the properties of the article holders based on the wording of originally filed claim 25 does not convince the board.

3.3 The fact that a person skilled in the art might understand from the disclosure of the application as a whole that the article holders support the preservation of the initial plane direction and the initial orientation of the articles during the conveying, i.e. the technical effect of the controlling, is not to be confused with the question of whether the application as a whole discloses any corresponding technical apparatus features which would justify the addition of the disputed features in claims 1 and 7.

3.4 In any case, if the respondent were of the opinion that the cited rim units 71 shown in figures 6a to 6c provided for a corresponding technical effect, they should have added them to the wording of claim 1. In general, one single specific technical example cannot

justify the addition of a broad general functional feature in a claim. The same holds true for the shovel-shaped grids disclosed on page 5 and the push-out mechanism disclosed on page 6.

3.5 Moreover, none of the parts of the original disclosure cited by the respondent covers the condition "until the articles have been released into the containers" added to claims 1 and 7. Thus, even if it were acknowledged that the parts of the original disclosure cited by the respondent formed a valid basis for the general feature that the article holders are adapted to preserve the initial plane direction and the initial orientation of the articles, such a general feature would still not cover the preservation of the arrangement until the articles are released into the containers, which forms the last part of the objected addition to claims 1 and 7.

3.6 Therefore, the board concurs with the appellant in that there is no original disclosure for the above-mentioned feature. Consequently, the above-mentioned feature added to claims 1 and 7 of the main request constitutes an undisclosed generalisation of the content of the application as originally filed and for this reason contravenes Article 123(2) EPC.

Consequently, the respondent's main request is not allowable.

4. Auxiliary requests - Admittance - Article 13(2) RPBA 2020

4.1 With respect to auxiliary requests 1 to 3, the board disagrees with the respondent that new objections had

been introduced with the board's communication under Article 15(1) RPBA which justified the late submission of new requests under Article 13(2) RPBA 2020.

Although it is correct that the board indicated on page 3, 3rd paragraph of that communication that it considered preserving the initial arrangement of articles in the article holders to be disclosed in combination with shovel-shaped grids, the content of that paragraph merely refers to the factual background of the appellant's corresponding objection under Article 123(2) EPC. Thus, the board's corresponding preliminary opinion did not introduce new objections, but rather merely clarified the background of an existing objection raised by the appellant with their statement setting out the grounds of appeal.

4.2 Moreover, the board has reached the conclusion that also in substance the amendments carried out in auxiliary requests 1 to 3 do not justify their admission into the proceedings at such a very late stage.

In auxiliary request 1 the expression "arrangement of the fresh food articles in the article holders during the conveying by preserving the" was added between "the article holders being adapted to preserve the" and "initial plane direction" in independent claims 1 and 7. Since the added wording does not relate to the disputed feature "until the the articles have been released into the containers", it cannot contribute to the disclosure of this feature in the sense of Article 123(2) EPC.

In independent claims 1 and 4 according to auxiliary request 2, the amendment carried out in auxiliary

request 1 was reversed and the wording of dependent apparatus claims 2 and 4 to 6 was added to independent claims 1 and 4. Firstly, auxiliary request 2 diverges from auxiliary request 1. Secondly, the added wording relates to the weight determining means and the corresponding rods and shovel-shaped grids. The weighing is however carried out before the articles are placed onto the article holders. Thus, the added wording is not suitable to contribute to the disclosure of the aspect of the article holders which had been objected to, which is defined as including the point of time "until the articles have been released into the containers". Moreover, since the method according to claim 4 of auxiliary request 2 has been further limited by apparatus features, the board concurs with the appellant in that these features are not suitable to further limit the method according to claim 4.

In auxiliary request 3, the only amendment is that the apparatus claims according to auxiliary request 2 were deleted. Consequently, the above argument concerning the method claim 4 of auxiliary request 2 applies *mutatis mutandis* for auxiliary request 3.

Consequently, the board has reached the conclusion that none of the auxiliary requests 1 to 3 addresses the objection presented by the opponent that there was no disclosure that article holders provided the claimed function of preserving the initial plane direction and the initial orientation until the articles have been released into the containers. Thus, none of the auxiliary requests 1 to 3 is suitable to overcome the objection under Article 123(2) EPC.

4.3 Therefore, the board decided to exercise its discretion under Article 13(2) RPBA 2020 not to admit the

auxiliary requests 1 to 3 filed with letter dated 11 August 2020 into the appeal proceedings.

5. Conclusion

Since all of the respondent's requests are either not admissible or not allowable, the board accedes to the appellant's request.

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:



U. Bultmann

R. Lord

Decision electronically authenticated