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**Datasheet for the decision
of 12 October 2021**

Case Number: T 2018/18 - 3.2.07

Application Number: 13162092.4

Publication Number: 2650237

IPC: B65G1/137

Language of the proceedings: EN

Title of invention:

Method and device for collecting products from product containers in collecting containers according to orders

Patent Proprietor:

Vanderlande Industries B.V.

Opponent:

SSI Schäfer Automation GmbH

Headword:

Relevant legal provisions:

EPC Art. 111(1), 113(1)
RPBA 2020 Art. 11, 12(8)
EPC R. 103(1)(a)

Keyword:

Right to be heard - opportunity to comment (no) - opposition
procedure - substantial procedural violation (yes)
Appeal decision - remittal to the department of first instance
(yes)
Reimbursement of appeal fee - equitable by reason of a
substantial procedural violation

Decisions cited:

Catchword:



Beschwerdekammern

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Case Number: T 2018/18 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 12 October 2021

Appellant: SSI Schäfer Automation GmbH
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Respondent: Vanderlande Industries B.V.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 5 June 2018
rejecting the opposition filed against European
patent No. 2650237 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: S. Watson
A. Cano Palmero

Summary of Facts and Submissions

- I. The opponent lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division to reject the opposition against European patent number 2 650 237.
- II. The opposition division found that the grounds for opposition pursuant to Article 100(a) EPC, lack of novelty and inventive step and pursuant to Article 100(b) EPC did not prejudice the maintenance of the patent as granted. In its decision the opposition division held *inter alia* that the alleged public prior use 'Walmart', was not sufficiently proven.
- III. In preparation for oral proceedings scheduled at the request of both parties, the Board gave its preliminary assessment of the case by means of a communication pursuant to Article 15(1) RPBA 2020. The Board indicated its preliminary opinion, that a substantial procedural violation had occurred as the opponent's right to be heard had been contravened.
- IV. Both parties withdrew their requests for oral proceedings in written submissions in response to the preliminary opinion, the opponent on 7 July 2021 and the patent proprietor on 28 September 2021. The opponent further requested reimbursement of the appeal fee.

V. The opponent (appellant) requests

that the decision under appeal be set aside;
and
that the public prior use 'Walmart' be considered
as forming part of the state of the art,
and
that the case be remitted to the opposition
division for further prosecution;
alternatively, that Mr Thomas Kießling be heard
as a witness;
or
that the case be remitted to the opposition
division with the instruction to hear Mr Kießling
as a witness;
and
that the appeal fee be reimbursed.

The patent proprietor (respondent) requests

that the appeal be dismissed;
that apportionment of costs be ordered , should
Mr Kießling be heard as a witness or should the
opposition division be instructed to hear Mr
Kießling as a witness.

VI. The lines of argument of the parties are dealt with in
detail in the reasons for the decision. The
reproduction of the patent claims is not required as
the decision is concerned with procedural issues only.

Reasons for the Decision

1. *Decision in written proceedings*

The present decision is taken in written proceedings without holding oral proceedings.

Both parties were informed of the Board's preliminary assessment of the case according to which the contested decision was to be set aside and the case was to be remitted to the opposition division for further prosecution. Both parties agreed to this procedure and withdrew their requests for oral proceedings without making any further substantive submissions.

The principle of the right to be heard according to Article 113(1) EPC has been observed since the parties' submissions have been fully taken into account.

In view of the fact that the case is ready for decision on the basis of the parties' written submissions the Board, while cancelling the oral proceedings arranged for 15 November 2021, issues this decision in written proceedings in accordance with Article 12(8) RPBA 2020.

2. *Substantial procedural violation*

2.1 As part of its opposition case, the appellant filed a written declaration of Mr Thomas Kießling together with a CD-ROM containing video material and a general layout drawing, as evidence of an alleged public prior use 'Walmart' (see notice of opposition, section B., pages 9 to 13).

The appellant argued that the alleged public prior use showed all features of independent claims 1 and 9 as granted.

2.2 The opposition division found that the alleged public prior use did not form part of the state of the art as it was not sufficiently proven and consequently did not examine the appellant's objection relating to lack of novelty of the subject-matter of claims 1 and 9 of the patent as granted with respect to this disclosure (see decision under appeal, II.13.1).

2.3 The opposition division found that the contents of Mr Kießling's written declaration could not be relied upon as it was written some years after visiting the Walmart distribution centre in Laurens (US) and might have been influenced by viewing the video which was recorded at a later date:

"The affidavit of Mr Kießling, in turn, seems to have been drafted after the latter watched the above mentioned video. This fact, as long as the time elapsed may have therefore influenced Mr Kießling's recollection."

(decision under appeal, II.11.2, lines 9 to 12).

2.4 The appellant argued that this reasoning of the opposition division was surprising as at no point during the opposition proceedings had the opposition division or the respondent raised doubts as to the influence of the video itself or of the passage of time upon Mr Kießling's ability to remember his visit (see statement of the grounds of appeal, page 8, point 12.).

The appellant had therefore not been able to respond to these objections, as it had not previously been made aware of them (see statement of grounds of appeal, page 12, final paragraph).

2.5 It is therefore necessary for the Board to determine whether the reasoning given by the opposition division in the decision under appeal was indeed raised for the first time in that decision, meaning that the appellant did not have the opportunity to respond to the reasoning used in the decision.

In its communication pursuant to Article 15(1) RPBA 2020, points 7.5 to 7.10, the Board gave the following opinion on this point:

"7.5 The respondent replied to the notice of opposition with submissions of 4 April 2016. In these submissions (page 4, fifth paragraph) the respondent argued that the appellant had not proved the alleged public prior use 'Walmart' "up to the hilt" as a "CDROM with videos...was the only enclosure with the affidavit of [M]r Kiessling.". The enclosed videos were undated and the layout drawing "General Layout Level 6" did not show the dates of the revisions A to M. No other concrete objections were raised by the respondent regarding the public availability of the alleged prior use.

7.6 In the annex to the summons to oral proceedings before the opposition division, the opposition division gave its preliminary opinion (see points II.7.5 and II.7.6) that the alleged public prior use was not sufficiently proven. The videos could not provide direct evidence of details of the picking station as it stood in May 2011 when Mr Kießling allegedly visited the facility. The creation and revision dates could not be ascertained from the layout drawing. This led the opposition division to the conclusion that the only

direct evidence on which the prior use was based, was the "written statement of Mr Kießling", and "[l]acking any circumstances allowing the division to entirely rely on the content of that statement, the latter cannot remove by itself the doubts expressed by the proprietor" (point 7.6, last sentence).

7.7 After the summons to oral proceedings had been issued, the respondent made no further submissions during the written opposition proceedings on the substance of the opposition.

7.8 With its submissions of 2 January 2018, the appellant filed a second written declaration from Mr Frank Boberg and re-filed copies of the layout drawing.

7.9 The minutes of the oral proceedings before the opposition division (@9:29) note that

- the respondent listed reasons why the prior use could not be taken into consideration as prior art;
- the respondent argued that the appellant could have provided more evidence relating to the commissioning of the 'Walmart' system;
- the value given to the affidavits submitted by the appellant was discussed, "especially as the witnesses are absent from the oral proceedings".

No further detail regarding any of these points was given in the minutes of the oral proceedings and no requests for correction of the minutes were filed. Therefore the Board assumes that the minutes are a correct record of the oral proceedings and no further new statements were made by the parties.

7.10 *None of the above objections can be understood to have cast doubt on the reliability of Mr Kießling's recollection of the prior use in his written statement.*

Only two concrete objections regarding the date of the public availability of the 'Walmart' prior use were made during the opposition proceedings, namely that the videos were undated and had been recorded after the priority date of the patent and that the layout drawings did not clearly show the dates of creation and revision.

Therefore, the Board is of the opinion that neither the opposition division nor the respondent raised any objections regarding either the possible influence of viewing the video, or the effect of the amount of time which had passed since his visit, on Mr Kießling's ability to remember details of the visit to the picking station of the 'Walmart' alleged public prior use.

In its decision the opposition division effectively found that Mr Kießling's recollection was insufficient to be entirely relied upon, but the Board is of the view that the opposition division was not in a position to make such an assumption as it amounted to an anticipated assessment of evidence which had not actually been taken."

2.6 The Board, having once again considered the parties' written submissions and in the absence of any further arguments, confirms its preliminary opinion.

2.7 The Board therefore finds that the opposition division did base its decision on reasoning given for the first time in the decision.

Article 113(1) EPC states that decisions may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. It is established jurisprudence of the Boards of Appeal that the term "grounds" in Article 113(1) EPC refers to the essential reasoning which led to the decision taken (see Case Law of the Boards of Appeal (CLB), 9th edition 2019, III.B.2.3.2).

In the present case, the appellant had not been able to respond to the objections raised by the opposition division in the decision, as it had not previously been made explicitly aware of them, this amounts to a breach of the appellant's fundamental right to be heard to an extent that potentially could have affected the outcome of the proceedings in substance.

2.8 Therefore as a substantial procedural violation has occurred the decision under appeal is to be set aside (see CLB, *supra*, V.A.9.5.8).

3. *Remittal*

3.1 According to Article 111(1) EPC the Board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. Under Article 11 RPBA 2020, a Board shall not remit a case unless special reasons present themselves for doing so, fundamental deficiencies, as a rule, constitute such special reasons.

3.2 Since the provision of Article 113(1) EPC represents a fundamental procedural principle in proceedings before

the EPO, a breach of this principle amounts to a fundamental deficiency.

Therefore in the present case it is appropriate to remit the case to the opposition division for further prosecution.

4. *Reimbursement of the appeal fee*

4.1 The appellant requests reimbursement of the appeal fee in full (see submissions of 7 July 2021, final sentence).

4.2 According to Rule 103(1)(a) EPC, the appeal fee shall be reimbursed in full, where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

For the reimbursement of the appeal fee to be equitable, a causal link must exist between the alleged procedural violation and the decision that necessitated the filing of an appeal.

The opposition division found that the alleged public prior use was not proven as the written declaration of Mr Kießling could not be relied upon and that the objections raised by the appellant based on the alleged public prior use could therefore not be considered. Further, the opposition division found that none of the objections raised by the opponent prejudiced the maintenance of the patent as granted and rejected the opposition. These findings resulted in the present appeal being filed, therefore a causal link exists and reimbursement of the appeal fee in full is equitable.

5. *Further requests of the parties*

As far as the appellant requested

that the public prior use 'Walmart' be considered as forming part of the state of the art, alternatively, that Mr Thomas Kießling be heard as a witness, further alternatively, that, when remitting the case, the opposition division be instructed to hear Mr Kießling as a witness,

the Board notes that, due to the fact that the case is to be remitted to the opposition division for further prosecution due to a fundamental procedural deficiency, it cannot decide on substantive issues by acknowledging the alleged public prior use "Walmart" as being part of the state of art, or by hearing witnesses, or by instructing the opposition division on the proceedings after termination of the appeal proceedings to hear witnesses.

The Board understands that the appellant accepts this as in its letter of 7 July 2021, it announced its intention to offer two witnesses in the proceedings after remittal of the case.

Similarly, the Board makes no statement confirming whether the decision of the opposition division in relation to claims 1 to 8 and 10 to 15 is correct or not, as requested by the respondent. Such statement concerned the substance of the case whereas the present decision is limited to procedural deficiencies in the proceedings leading to the contested decision.

Finally, it is not necessary for the Board to consider the respondent's request for apportionment of costs. The Board takes no position on whether the offered witness should be heard or not, that is for the opposition division to decide.

Order

For these reasons it is decided that:

- 1. The decision under appeal is set aside.**
- 2. The case is remitted to the opposition division for further prosecution.**
- 3. The appeal fee is reimbursed in full.**

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated