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**Datasheet for the decision
of 28 August 2023**

Case Number: T 1800/19 - 3.5.02

Application Number: 13845612.4

Publication Number: 2901431

IPC: G08B1/00

Language of the proceedings: EN

Title of invention:

Inference Electronic Shelf Life Dating System for Perishables

Applicant:

Infratab, Inc.

Relevant legal provisions:

RPBA Art. 12(2), 12(4)

EPC Art. 123(2)

Keyword:

Late-filed request - main request and auxiliary requests 1-7
could have been filed in first instance proceedings (yes)
Statement of grounds of appeal - party's complete case -
auxiliary request 8 substantiated (no)
Amendments - auxiliary request 9 - added subject-matter (yes)

Decisions cited:

G 0003/89, G 0011/91, G 0002/10



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1800/19 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 28 August 2023

Appellant: Infratab, Inc.
(Applicant) 4347 Raytheon Road
Oxnard CA 93033 (US)

Representative: Latham, Stuart Alexander
Withers & Rogers LLP
2 London Bridge
London SE1 9RA (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 14 January 2019
refusing European patent application No.
13845612.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Lord
Members: G. Flyng
A. Bacchin

Summary of Facts and Submissions

- I. The appeal contests the examining division's decision to refuse European patent application no. 13 845 612.4, which is based on an international application published as WO 2014/059048 A1.
- II. In the contested decision, the examining division considered the applicant's request for grant on the basis of the claims of the main request filed on 5 November 2018, or the auxiliary request 1A or 1B filed on 30 November 2018, or the auxiliary request 1, 2, 3 or 4 filed on 5 November 2018.
- III. For the main request and auxiliary requests 1 to 4, the examining division held that the wording "*one or more sensors in the container operative at sensing time periods to sense the temperature of each of the plurality of perishables in the container*" did not meet the clarity requirement of Article 84 EPC, as it was unclear how one sensor could sense the (individual) temperature of each of the plurality of perishables.
- IV. Furthermore, the examining division held that the subject-matter of claim 1 of the main request and of auxiliary requests 1A, 1B and 1 to 4 did not fulfil the requirement of Articles 52(1) and 56 EPC.
- V. With the statement setting out the grounds of appeal the appellant (applicant) filed claim sets according to a main request and auxiliary requests 1 to 9. Auxiliary requests 8 and 9 correspond respectively to the main request and the auxiliary request 1B as considered in the contested decision. None of the other

requests filed with the grounds of appeal were presented in the first instance proceedings. The appellant furthermore filed three documents as evidence: E1, E2 and E3.

- VI. In the statement setting out the grounds of appeal, the appellant did not directly address the reasoning given in the contested decision. The appellant submitted in the grounds of appeal that the amendments according to each request had a basis in the application as filed (Article 123(2) EPC) and that the claimed subject-matter was novel and inventive (Articles 52(1), 54 and 56 EPC). The grounds of appeal did not address the clarity objection raised in respect of the feature "*one or more sensors*" at all. Considering inventive step, the appellant submitted that the claimed invention addressed the technical problem of determining whether a perishable item was fit for use when it had been stored in a temperature controlled environment but had been removed for a period of time.
- VII. The appellant stated that they cite "the Wikipedia definition for the Arrhenius equation as E1" and that they cite "E2 and E3 as evidence of the technical nature of the invention". Other than these statements, no further explanation of documents E1 to E3 was given.
- VIII. In a communication pursuant to Article 15(1) RPBA the Board set out its preliminary observations on the appeal. The Board expressed doubts on the admissibility of the appeal and the admissibility of the main request and auxiliary requests 1 to 8 filed with the appeal. The Board questioned the validity of the reasoning on inventive step in the contested decision, but set out reasons as to why the content of the amended claims of the requests filed on appeal was considered to extend

beyond the content of the (international) application as originally filed, contrary to Article 123(2) EPC.

- IX. The appellant addressed the Boards observations in a reply dated 26 June 2023.
- X. Oral proceedings were held on 28 August 2023, at the appellant's request, by videoconference.
- XI. The appellant requested finally that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request, or on the basis of one of the auxiliary requests 1 to 9, all filed with the statement of grounds of appeal.

Reasons for the Decision

Admissibility of the appeal, Article 108, third sentence, EPC in conjunction with Rule 99(2) EPC

- 1. Whilst the statement of grounds of appeal did not address the clarity objection raised in the decision in respect of the feature "*one or more sensors*", it is evident that at least auxiliary request 9 addresses that clarity issue by amendment.
- 2. Furthermore, considering the inventive step issue raised in the decision, the statement of grounds of appeal presents detailed arguments in favour of novelty and inventive step. Whilst the arguments on inventive step do not correlate with all aspects of the reasons given in the decision, they are exceptionally considered to be sufficient to enable the board to

assess whether or not the appealed decision is incorrect on this issue.

3. The Board is therefore satisfied that there is a causal relationship as well as a correlation between the arguments in the statement of grounds of appeal and the reasons given in the decision under appeal (Case Law of the Boards of Appeal, 10th Edition, 2022, in the following "Case Law", V.A.2.6.3 b)). Hence, the appeal is admissible.

Admissibility of the requests filed on appeal, Articles 12(2) and 12(4) RPBA 2007

4. In ex parte cases it is established case law that proceedings before the boards of appeal are primarily concerned with examining the contested decision. (G 10/93, OJ 1995, 172 and Case Law V.A.5.2.2). The appeal proceedings are intended to review the correctness of the decision of the first instance rather than to continue examination by other means (*ibid.*). Article 12(4) RPBA 2007, which remains applicable in the present case, expressly refers to the boards' power to exclude requests which could have been filed in the first-instance proceedings.
5. In the present case, the appellant filed auxiliary requests 8 and 9 on appeal that correspond respectively to the main request and the auxiliary request 1B as considered in the contested decision, but also filed a number of higher-ranking requests, i.e. the main request and auxiliary requests 1 to 7, that were not filed in the first-instance proceedings.
6. The Board considers that the the main request and auxiliary requests 1 to 7 could and should have been

presented in the first-instance proceedings. The appellant (then applicant) had opportunities to file amendments in response to the objections of lack of clarity and inventive step that had been raised by the examining division in the communications and telephone consultations prior to the oral proceeding held on 5 December 2018, the latest opportunity being at the proceedings. However, the appellant chose not to attend the oral proceedings.

7. As regards the reasons why these higher-ranking requests should be admitted, the appellant merely argued that they met the requirements for clarity and inventive step, and did not offend Article 123(2) EPC. The appellant did not present any arguments as to why it would not have been possible to file these requests at first-instance.
8. As the Board stated in their preliminary observations, admitting these higher-ranking requests would entail a re-opening of the first-instance examination, rather than being a review of the contested decision. Hence, in the absence of any reasons why these requests could not have been filed at first-instance, they exercised their discretion under Article 12(4) RPBA not to admit the main request and auxiliary requests 1 to 7 into the proceedings.
9. Considering the auxiliary request 8 (corresponding to the main request considered in the contested decision), the appellant did not present any arguments in the statement of grounds of appeal as to why the examining division's finding of lack of clarity of the feature "one or more sensors" in claim 1 of what was then the main request should be incorrect.

10. In the letter dated 26 June 2023 the appellant submitted that "reasons for the clarity of the objected-to phrase were given under the heading of "Amendment and Support" in the statement of grounds of appeal. However that is incorrect. In the statement of grounds of appeal, the arguments presented under the headings "EIGHT AUXILIARY REQUEST - AR8", "AR8 - Amendment and Support" (see page 13) do not address the feature "one or more sensors" at all, let alone explain why this feature should be clear. Furthermore, the arguments presented under the headings "MAIN REQUEST - MR", "MR - Amendment and Support" (see page 2) in respect of the feature "one or more sensors" merely quotes the paragraph spanning pages 10 and 11 of the international application as filed, which refers to "sensors at specified grid locations within the container".
11. In the oral proceedings, the appellant also referred to the arguments presented on page 6 of the grounds of appeal under the heading "MR - Novelty". This section discusses the disclosures on description pages 10 to 13 in respect of the embodiments of figures 1 to 4. However, the cited passages of the description only refer to arrangements with more than one sensor (see "sensors at specified grid locations", "liner 23 comprising a sensor grid", "multi-sensor inner liner", and "sensors at spaced locations").
12. There is nothing in the cited passages of the statement of grounds of appeal that explains how one sensor could sense the (individual) temperature of each of the plurality of perishables. Hence, the statement of grounds of appeal failed to address the clarity objection raised in the decision in respect of the feature "one or more sensors" which is included in

auxiliary request 8. Thus, the submissions in respect of auxiliary request 8 do not meet the requirements of Article 12(2) RPBA 2007, according to which the statement of grounds of appeal must contain a party's complete case, must set out the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and must specify expressly all the requests, facts, objections, arguments and evidence relied on. Hence, the Board did not take auxiliary request 8 into account, pursuant to Article 12(4) RPBA 2007.

13. There were no doubts as to the fact that auxiliary request 9 (corresponding to the auxiliary request 1B considered in the contested decision) is in the proceedings.

Auxiliary request 9, Amendments, Article 123(2) EPC

14. The claims as originally filed did not make any mention of many of the features that are now present in claim 1 of auxiliary request 9, such as:
- "a sensing grid or liner comprising a plurality of sensors";
 - "operative at sensing periods to sense the temperature of each of the plurality of perishables";
 - "operative to calculate and/or record at each sensing the shelf life status of the plurality of perishables";
 - "calculat[ing] and/or record[ing] the exit shelf life status for the associated perishable based upon the exit temperature of the perishable";
 - "operative to sense the temperature of the perishable entering the container";

- "calculat[ing] an inferred shelf life used while away"; and
- "subtract[ing] the inferred shelf life used while away, ... , from the exit shelf life status".

15. Under Article 123(2) EPC any amendment to the parts of a patent application relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension and can therefore only be made 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 these documents as filed (G 3/89, OJ 1993, 117; G 11/91, OJ 1993, 125; G 2/10, OJ 2012, 376, referring to this test as "gold standard").

16. In the statement of grounds of appeal, the appellant identified, and cited at length, various paragraphs of the originally filed description that purportedly provided a basis for these features that have been added to claim 1. However the citations given do not correspond verbatim to these features, and a correspondence between them is not evident prima facie. Furthermore, the appellant gave no explanation of how the features that have been added to claim 1 are derivable, directly and unambiguously, from the differently-worded text in the paragraphs cited. Furthermore, no explanation was given of why it would be evident to the skilled reader that the features that have been extracted and abstracted from the description should be taken in isolation from the context in which they were originally disclosed.

17. Regarding the feature of "a sensing grid or liner comprising a plurality of sensors ...", the appellant

referred to figure 1A and the associated description in the paragraph spanning pages 10 and 11 of the international application as filed as a basis for this feature.

18. This paragraph does not disclose a "sensing grid or liner", but rather an inner liner 2 that comprises a shelf life monitoring device 9 that is configured with sensors at specified grid locations within the container. There is no disclosure of a "sensing grid" as an alternative to a "liner", so there is no basis for the claimed feature of a "sensing grid or liner".
19. Furthermore, the features of the "sensing grid" and the "liner" have been extracted from that original disclosure and taken in isolation from the "shelf life monitoring device 9", which formed an integral part of the disclosed device, but has not been included in claim 1. This creates an undisclosed intermediate generalisation.
20. The appellant submitted that the disclosure in the third paragraph on page 6 was applicable to all requests and provided a basis for generalising the disclosures in respect of the embodiment of figure 1A. The Board did not find this convincing as the "shelf life monitoring device 9", was presented as an integral part of the system of figure 1A.
21. At least for these reasons, claim 1 of auxiliary request 9 contravenes Article 123(2) EPC.
22. In view of this finding, the question of the allowability of the various other amendments need not be addressed.

Conclusion

23. In the absence of an admissible and allowable request, the appeal had to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated