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**Datasheet for the decision  
of 20 September 2024**

**Case Number:** T 0972/21 - 3.4.02

**Application Number:** 16168884.1

**Publication Number:** 3081315

**IPC:** B07C5/38, B07C5/16, A22C17/00,  
G01G19/30

**Language of the proceedings:** EN

**Title of invention:**

Method and System for Sorting of Foodstuff Items

**Patent Proprietor:**

Marel A/S

**Opponent:**

Nordischer Maschinenbau  
Rud. Baader GmbH + Co. KG

**Headword:**

Recirculating deviant foodstuff products for batching/MAREL

**Relevant legal provisions:**

EPC Art. 100(a), 56, 111(1)  
RPBA 2020 Art. 12(4), 11

**Keyword:**

Grounds for opposition - inventive step (no)

Amendment to case - amendment within meaning of Art. 12(4) RPBA (yes) - admitted (yes)

Remittal - special reasons for remittal (yes)

**Catchword:**

In an appeal against the rejection of the opposition the filing of auxiliary requests with the reply to the statement of grounds of appeal leads to essentially the same procedural situation on appeal as the filing of the same auxiliary requests within the time limit of Rule 79(1) EPC. This is a reason in favour of admittance under Article 12(4) RPBA and can represent circumstances justifying their admittance within the meaning of Article 12(6), second sentence, RPBA. See reasons 3.



**Beschwerdekammern**

**Boards of Appeal**

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**Case Number:** T 0972/21 - 3.4.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.02**  
**of 20 September 2024**

**Appellant:**

(Opponent)

Nordischer Maschinenbau  
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Geniner Straße 249  
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**Representative:**

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**Respondent:**

(Patent Proprietor)

Marel A/S  
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8200 Århus N (DK)

**Representative:**

Guardian  
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**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted on 17 May 2021  
rejecting the opposition filed against European  
patent No. 3081315 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

**Chairman**

R. Bekkering

**Members:**

F. Giesen

G. Decker

## **Summary of Facts and Submissions**

- I. The present appeal by the opponent is directed against the decision of the opposition division dated 17 May 2021 with which the opposition against European patent No. EP 3 081 315 was rejected pursuant to Article 101(2), second sentence, EPC.
- II. In a communication under Article 15(1) RPBA, the board drew attention to matters that seemed to be of particular significance for the decision to be taken and provided a preliminary opinion, making reference to the following documents:

D1: WO 2004/030439 A2  
D2: DE 10 2004 056 031 A1.

- III. Oral proceedings before the board took place on 20 September 2024. The final requests of the parties were as follows:

The appellant (opponent) requested that

the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested

as a main request that the appeal be dismissed, i.e. that the patent be maintained as granted.

Alternatively, it requested that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution, i.e. examination of the auxiliary requests 1 to 21

filed with the reply to the statement of grounds of appeal dated 2 February 2022.

As a further alternative, it requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims according to one of the auxiliary requests 1 to 21 filed with the reply to the statement of grounds of appeal, dated 2 February 2022, or according to one of the auxiliary requests 22 and 23 filed with the letter dated 17 July 2024.

IV. Claim 1 of the main request (i.e. patent as granted) reads as follows:

- M1.1 *Method of processing foodstuff items (30) that are supplied to a batching apparatus (6),*
- M1.2 *said batching apparatus (6) comprising at least one handling means of the robot type (50)*
- M1.3 *configured to operate in an effective operation area and designed for picking-up a foodstuff item and placing it within the effective operation area,*
- M1.4 *- where by means of said batching apparatus (6) a first process is performed,*
- M1.5 *according to which foodstuff items (30) are selectively batched*
- M1.6 *in consideration of measured, detected and/or estimated data for the individual foodstuff items (30) and*
- M1.7 *in consideration of at least one predefined criterion,*

- M1.8 *said measured, detected and/or estimated data for the individual foodstuff items (30) comprising weight data,*
- M1.9 *- where said at least one predefined criterion, in consideration of which the foodstuff items are selectively batched, comprises the total weight,*  
*characterised in that*
- M1.10 *- the particular foodstuff items (44) are identified and led (14, 42) to another process (16, 46; 58, 54, 56),*
- M1.11 *whereby said another process (16, 46; 58, 54, 56) comprises a cutting and/or trimming of the particular foodstuff item (44), and*
- M1.12 *whereby said cutting and/or trimming of the particular foodstuff item (44) provides one or more processed foodstuff items,*
- M1.13 *said one or more processed foodstuff items being suitable for said first process.*

## **Reasons for the Decision**

### **1. *Admissibility of the appeal***

The appeal meets the requirements of Articles 106 to 108 EPC and of Rule 99 EPC. It is therefore admissible.

### **2. *Main request - inventive step starting from D2***

- 2.1 The subject-matter of claims 1 and 9 of the main request does not involve an inventive step in view of

D2 in combination with D1. The ground for opposition under Article 100(a) EPC in conjunction with Articles 52(1), 56 EPC therefore prejudices the maintenance of the European patent, Article 101(1) EPC.

2.2 The board agrees that document D2 is closer to the subject-matter of claims 1 and 9 than document D1, which was used by the opposition division, since it concerns batching in the same sense as claim 1, namely of combining foodstuff items so as to achieve a desired total weight in a package.

2.3 D2 does not disclose features M1.11 to M1.13, i.e. that the another process comprises trimming and/or cutting thereby producing a processed foodstuff item that is suitable for the first (i.e. batching) process.

It is apparent from paragraph [0024] of D2 that slices of meat that are outside of predetermined weight tolerances, in particular end pieces which are too small, are discarded. Whether they are used for another process or put to waste is not disclosed. However, it is clear that these foodstuff items are not used for batching.

The technical effect associated with the distinguishing features is therefore that foodstuff items which are unsuitable for package batching can still be used for the batching.

The objective technical problem is therefore to reduce loss of foodstuff items which do not meet the batching requirements. With a view to the respondent's argument that "finding a further use" already represented a pointer to the claimed solution, the board wishes to

emphasise that reducing loss of foodstuff items is not part of the claimed solution.

- 2.4 The solution to this problem was obvious in view of D1. D2 already teaches in paragraph [0024] that not all slices of meat leaving the pre-cutter (1) are within the required weight tolerances. In the board's view, there are exactly two possible situations in which weight tolerances are not met. The slices of meat according to D2 can be too light, in which case recirculating and cutting would not make sense, or too heavy. The board is not convinced by the respondent's argument that the teaching of D2 was limited to the implications of the specific case of slices of meat that are too light. Rather, a skilled person consulting document D2 would understand that meat slices that are too heavy also cannot be used for batching.

Document D1 is also in the technical field of batching foodstuff items. The board is not persuaded by the respondent's argument that the difference in criteria for batching according to D2 and D1 would have prevented a skilled person from consulting D1. Rather, D1 contains a teaching as to how to avoid loss of foodstuff items whose size or weight do not meet batching requirements and therefore it holds the promise of a solution to the objective technical problem.

D1 teaches to recirculate foodstuff items which are overweight and to have them reworked by a worker. The board agrees with the respondent that D1 does not directly and unambiguously disclose that this reworking comprises cutting and/or trimming. However, the question to be answered is whether the solution was obvious in view of the prior art, and not whether the



solution elements are directly and unambiguously derivable from a secondary document.

D1 discloses on page 15, line 21 to page 16, line 1:

*"Such a non-standard product may be transferred back to product delivery station 12 or it may be rejected entirely, or it may be acted upon a worker [sic] so that the non-standard product 52 is adjusted to conform to the standard configuration of products 13. It will be appreciated that in the case of line 10 such non-standard products could be a product which is overweight or underweight, or an instance in which pickup arm 42 has picked up two products from turntable 14 rather than one."*

Applying this general teaching to the specific foodstuff items disclosed in D2 readily leads a skilled person to the realisation that overweight meat items can be cut, thereby making them lighter and hence bringing them to within the weight tolerances, making them thus suitable for the batching process.

The board wishes to note here that the opposed patent does not contain any teaching as to why foodstuff items could be overweight. The board has to conclude that realising that overweight foodstuff items occur in batching is a matter of common practice and does not represent any surprising insight. In view of D1, making overweight foodstuff items suitable for the batching process would have been implemented by cutting them on a recirculation line and by feeding the re-worked, i.e. cut, product back into the batching process, thereby avoiding the loss of such overweight slices of meat for the batching process. The board cannot see any reason as to why the type of batching of D1 would have

prevented the skilled person from implementing a recirculation line with cutting for the type of batching of D2.

- 2.5 The respondent's counter-arguments do not persuade the board. The respondent argued that the starting point of the analysis, document D2, concerned meat slices. A skilled person would not cut meat slices to reduce their weight because this would negatively affect their visual appearance. While reworking may be done with bulk chicken parts according to D1, especially when different parts stick together, a skilled person would not rework meat slices.

However, the board agrees with the appellant's argument submitted at the oral proceedings, according to which slices of meat could be reworked so as to reduce their weight without affecting their round shape. The respondent tacitly presumes that a cut for reworking had to be perpendicular to the main meat slice faces, but it is of course also possible to cut off a thin oblique slice so as to make the main meat slice faces parallel.

It is furthermore conceivable that the pre-cutter does not perfectly separate slices of meat, similar to the situation of sticking chicken parts in D1. Even if D2 does not explicitly mention this, a skilled person would recognise that such an error could occur.

In conclusion, the board is persuaded that a skilled person would consider combining the teaching of D2 with that of D1, and thus arrive at the claimed subject-matter in an obvious manner.

3. *Auxiliary requests 1 to 21 - Admittance*

- 3.1 Auxiliary requests 1 to 21 are admitted into the proceedings pursuant to Article 12(4), fifth sentence, RPBA.
- 3.2 Auxiliary requests 1 to 21 were filed for the first time with the respondent's reply to the appeal. Hence, they do not meet the requirements in Article 12(2) RPBA and are thus to be treated as an amendment pursuant to Article 12(4), first sentence, RPBA. Their admittance is therefore at the discretion of the board under Article 12(4), second sentence, RPBA. Under Article 12(4), fifth sentence, RPBA, the board exercises its discretion in view of, *inter alia*, the need for procedural economy. The question therefore arises whether the present situation is detrimental to procedural economy when compared to a hypothetical scenario in which the auxiliary requests had been filed with the reply to the notice of opposition.
- 3.3 In the hypothetical scenario that the respondent had filed auxiliary requests 1 to 21 in reply to the statement according to Rule 76(2)(c) EPC within the time limit according to Rule 79(1) EPC, the opposition division would not have had a discretion regarding their admission. The auxiliary requests would have been admissibly raised in the first instance proceedings. Pursuant to Article 12(4), first sentence, RPBA, these auxiliary requests, if maintained, would therefore not have been regarded as an amendment, with the consequence that the board would not have had discretion not to admit them. In the circumstances of this hypothetical scenario, demonstrating that the requests were admissibly raised and maintained represents such a low hurdle that it can be disregarded

in the discussion. (This requirement would amount to pointing out that the requests were filed within the time limit of Rule 79(1) EPC and were not withdrawn, which the board could easily verify itself.)

- 3.4 The opposition division issued a preliminary opinion with the intention to reject the opposition, which was later to become the order of the decision under appeal. It follows that there would have been no need for the opposition division to comment on any auxiliary requests already pending at the time the preliminary opinion was prepared.
- 3.5 In the hypothetical scenario of the auxiliary requests having been filed within the time limit of Rule 79(1) EPC, at the time of drafting the communication pursuant to Article 15(1) RPBA the board would have been faced with the following submissions:
- The appellant's statement setting out the grounds of appeal containing the reasons why the decision under appeal was to be set aside. The appellant would not have been obliged to file objections against auxiliary requests filed at first-instance within the time limit of Rule 79(1) EPC as a precaution. After all, it would not be clear at this stage whether and, if so, which of the auxiliary requests would be (re-)filed by the respondent.
  - The respondent would have re-filed (some or all of) the auxiliary requests with the reply to the appeal.
  - In all likelihood no non-binding and preliminary opinion of the opposition division concerning the auxiliary requests would have been on file.

- There would in all probability have been a rejoinder by the appellant dealing with the auxiliary requests.

3.6 The submissions the board is faced with in the present appeal case are the same. Moreover, while there are two minor differences between the hypothetical scenario and the present situation, these differences do not have any bearing on the question of procedural economy:

- In the present case, the appellant's objections against the auxiliary requests were not (and could in fact not have been) included in the statement setting out the grounds of appeal. Instead, they were submitted in the rejoinder to the respondent's reply to the statement of grounds of appeal, the rejoinder being nevertheless at the board's and respondent's disposal before beginning the review of the case.
- In the absence of any auxiliary requests on file, the opposition division was prevented (from the outset) from possibly giving a preliminary and non-binding opinion on the auxiliary requests. However, even if the opposition had given such an opinion, this opinion could not have been a valid basis for the board's review in appeal proceedings due to the opinion's non-binding (and possibly incomplete) nature.

3.7 Since the board in the hypothetical scenario would have had a rather limited discretion to disregard the auxiliary requests if they had been filed within the time limit of Rule 79(1) EPC in the first instance opposition proceedings (in essence only if the conditions under Article 12(4), first sentence, RPBA of

demonstrating that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal were not met) and since, by comparison, the procedural situation with which the board and the appellant are faced in the present situation is not detrimental to procedural economy, it would be disproportionate not to admit the auxiliary requests.

3.8 Furthermore, it could be argued that the respondent could and should have filed any auxiliary requests in the first-instance proceedings, in response to the objections raised by the appellant. This would give the board the option not to admit the auxiliary requests in the appeal proceedings under Article 12(6), second sentence, RPBA. However, since the procedural situation is unaffected by the timing of filing the auxiliary requests (see the reasoning above), the board considers this to represent circumstances of the appeal case that justify the admittance of the auxiliary requests within the meaning of Article 12(6), second sentence, RPBA.

3.9 The appellant's argument that 21 auxiliary requests (not taking into account auxiliary requests 22 and 23) were complex (see the further discretionary criterion of "complexity of the amendment" under Article 12(4), fifth sentence, RPBA) did not change the exercise of the board's discretion. This level of complexity would have been the same in the hypothetical scenario in which all requests would have been submitted within the time limit of Rule 79(1) EPC. Furthermore, the board considers the complexity of the present requests not to be prohibitive.

4. *Auxiliary requests - Remittal*

4.1 The case is remitted to the opposition division for further prosecution.

4.2 According to Article 111(1) EPC, following the examination as to the allowability of the appeal, the board of appeal shall decide on the appeal. The board of appeal 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.

This legal provision gives the board a discretionary power to decide on remittal, see Case Law of the Boards of Appeal, 10th edition, July 2022 ("CLBA"), V.A.9.5.

4.3 According to Article 11 RPBA, a board should not remit a case for further prosecution, unless special reasons present themselves for doing so.

4.4 In the present case, a discussion of the auxiliary requests 1 to 21 would go beyond a judicial review of the decision under appeal, which is the primary object of the appeal proceedings, see Article 12(2) RPBA. In particular, it is to be expected that for an exhaustive examination, further documents might have to be considered.

4.5 Moreover, the respondent argued that it would lose an instance if the case were not remitted. While it is settled case law that parties do not have a fundamental right to have their case examined at two levels of jurisdiction (CLBA, V.A.9.2.1), the board acknowledges that this would be desirable to a certain degree.

4.6 The appellant initially also requested that the case be remitted but changed this request at the oral

proceedings before the board, arguing that in view of the short remaining lifetime of the opposed patent, it would be helpful to have a final decision.

- 4.7 The arguments advanced by both parties were considered by the board to have equal weight. Therefore, the board concluded that the examination of a high number of auxiliary requests, which goes beyond the primary object of the appeal proceedings of providing a judicial review, was the decisive factor for a remittal and constituted special reasons within the meaning of Article 11 RPBA.
5. Under these circumstances it was not necessary to decide on the admittance of auxiliary requests 22 and 23 filed after notification of the communication under Article 15(1) RPBA.



## 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.

The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated