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**Datasheet for the decision
of 26 January 2023**

Case Number: T 1004/21 - 3.2.07

Application Number: 14755893.6

Publication Number: 3030504

IPC: B65G1/04

Language of the proceedings: EN

Title of invention:

APPARATUS FOR RETRIEVING UNITS FROM A STORAGE SYSTEM

Patent Proprietor:

Ocado Innovation Limited

Opponents:

Gebhardt Fördertechnik GmbH
NOVAGRAAF INTERNATIONAL SA

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(2), 83, 54, 56
RPBA 2020 Art. 12(2), 12(6), 15(1)

Keyword:

Grounds for opposition - added subject-matter (yes)
Auxiliary request 1 - Sufficiency of disclosure - (yes)
Auxiliary request 1 - Amendments - added subject-matter (no)
Auxiliary request 1 - Novelty - (yes)
Auxiliary request 1 - Inventive step - (yes)
Late-filed objection - should have been submitted in first-
instance proceedings (yes) - admitted (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

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Case Number: T 1004/21 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 26 January 2023

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
10 May 2021 concerning maintenance of the
European Patent No. 3030504 in amended form.**

Composition of the Board:

Chairman B. Paul
Members: A. Cano Palmero
 C. Brandt

Summary of Facts and Submissions

- I. The patent proprietor and opponent 2 (appellants) lodged appeals within the prescribed period and in the prescribed form against the decision of the opposition division to maintain European patent No. 3 030 504 in amended form on the basis of the then auxiliary request 1.
- II. Two oppositions were filed, which were directed against the patent in its entirety and based on all grounds for opposition pursuant to Article 100 EPC.
- III. In preparation for oral proceedings, scheduled upon the appellants' requests, the Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA 2020. The Board indicated that the appeals were likely to be dismissed.
- IV. In response to the communication under Article 15(1) RPBA 2020, opponent 1 (party as of right) announced with letter of 14 July 2022 that it did not intend to attend the oral proceedings. Opponent 2 and the patent proprietor submitted arguments in the substance with letters dated 21 December 2022 and 20 January 2023 respectively.
- V. Oral proceedings before the Board took place on 26 January 2023 in the absence of opponent 1 in accordance with Rule 115(2) EPC and Article 15(3) RPBA 2020.

At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes thereof.

VI. The patent proprietor requested

that the decision under appeal be set aside and that the patent be maintained as granted (main request),

or, in the alternative,

that the appeal of opponent 2 be dismissed, *i.e.* that the patent be maintained in the amended form found by the opposition division to meet the requirements of the EPC (auxiliary request 1, filed as main request A on 3 April 2020),

or in the alternative,

that the patent be maintained in the amended form according to the set of claims according to auxiliary requests 2 to 31, filed during opposition proceedings with letters of 29 March 2019, 3 April 2020, 1 June 2020 and 14 January 2021.

VII. Opponent 2 requested

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

VIII. Opponent 1 neither lodged an appeal nor filed requests.

IX. The following **documents** referred to in the decision under appeal are mentioned in the present decision:

E13: WO 2014/090684 A1;

E14: "Swisslog Autostore White paper";

E15: Youtube Video: Autostore Logistic Technical presentation

(<https://www.youtube.com/watch?v=iyVDMp2bL9c>);

E16: WO 2014/203126 A1;
E17: WO 2015/193278 A1;
E18: NO 20140773 (priority document of E17);
E23: CN 103612882 A;
E24: WO 2013/167907 A1;
E29: US 2011/0243698 A1;
E35: US 2020/0307911 A1.

X. The lines of argument of the parties relevant for the present decision are dealt with in detail in the reasons for the decision and address the following issues:

- revision of the findings of the Opposition Division as regards the ground for opposition under Article 100(c) EPC;
- objections on sufficiency of disclosure of auxiliary request 1;
- objections on added subject-matter of claim 1 according to auxiliary request 1 and admittance of such objections into the appeal proceedings;
- objections on novelty and inventive step of auxiliary request 1.

XI. **Claim 1** of the **main request** (*i.e.* according to the patent as granted) and of **auxiliary request 1** (*i.e.* according to the patent as maintained by the opposition division) reads as follows:

"A storage system comprising:

a first set of parallel rails or tracks and a second set of parallel rails or tracks extending transverse to the first set in a substantially horizontal plane to form a grid pattern comprising a plurality of grid spaces;

a plurality of stacks of containers (106) located beneath the rails, and arranged such that each stack is located within a footprint of a single grid space; and
a load handling device (100) arranged to move laterally above the stacks on the rails, wherein the load handling device (100) is for lifting and moving the containers (106) stacked in stacks in the storage system and the load handling device (100) comprises:

a lifting device, the lifting device comprising a gripper device (110), the gripper device (110) being configured to grip a container (106) from above,

the load-handling device (100) also comprises:

a wheel assembly, the wheel assembly comprising a first set of wheels (116) for engaging with the first set of rails or tracks to guide movement of the device in a first direction and a second set of wheels (118) for engaging with the second set of rails or tracks to guide movement of the device (100) in a second direction, wherein the second direction is transverse to the first direction; and

a lifting mechanism, the lifting mechanism (104) being configured to raise and lower the gripper device (110) relative to the container-receiving space (120), the lifting mechanism (104) being located above a container-receiving space (120), wherein the lifting device is arranged to lift a single container from a stack into the container-receiving space;

characterised in that the load-handling device (100) further comprises:

an upper part (112) and a lower part (114), the upper part (112) housing components such as power components, control components, drive components and/or lifting components, the lower part (114) arranged directly beneath the upper part (112), and the lower part (114) including the container-receiving space (120) located above the rails for accommodating a container (106);
and wherein the load handling device (100) has a footprint that occupies only a single grid space in the storage system."

XII. Claim 7 of the **main request** (*i.e.* according to the patent as granted) reads as follows:

"A storage system according to any preceding claim in which the wheel assembly is arranged around the peripheral outer wall of the lower part."

XIII. Claim 5 according to **auxiliary request 1** (*i.e.* according to the patent as maintained by the opposition division) reads as follows:

"A storage system according to claim 1 wherein the lifting device comprises a pair of lifting arms arranged on either side of the container-receiving space, the gripper device being mounted to ends of the arms and the arms being configured to extend and retract to move the gripper device vertically."

XIV. Claim 30 according to **auxiliary request 1** (*i.e.* according to the patent as maintained by the opposition division) reads as follows:

"A storage system according to any preceding claim, further comprising one or more load handling devices (100) capable of lifting a plurality of containers (106) from a stack in a single operation."

- XV. Since the wording of the claims of auxiliary requests 2 to 31 is not relevant for the present case, there is no need to reproduce it here.

Reasons for the Decision

Appeal of the patent proprietor

1. *Patent as granted (main request) - Added subject-matter of claim 7, Articles 100(c) and 123(2) EPC*
- 1.1 The following findings on added subject-matter as regards claim 7 according to the patent as granted correspond to the view of the Board which had been communicated to the parties with the communication pursuant to Article 15(1) RPBA 2020 (see point 7. thereof). The parties have neither reacted nor objected to the opinion expressed in that communication. After having reconsidered all relevant legal and factual aspects of the case, the Board does not see any reason to deviate from its preliminary opinion.
- 1.2 The patent proprietor contested the finding of the opposition division, that the subject-matter of claim 7 as granted extended beyond the original disclosure (see point 4.2 of the reasons for the decision under appeal).
- 1.2.1 According to the patent proprietor in page 2 of its statement of grounds of appeal, original page 11, line

23 and figures 5 and 6 constituted sufficient basis for the amendment in claim 7 according to the patent as granted of the wheel assembly being arranged around the peripheral outer wall of the lower part. The patent proprietor argues that the amendment from "wheels" as in original claim 7 to "wheel assembly" as in claim 7 as granted could not constitute an unallowable intermediate generalisation since the wheels were part of the wheel assembly. As for the amendment from "a periphery of the container-receiving space" to the peripheral outer wall of the lower part", the patent proprietor is of the view that this could be derived from figure 6, contrary to the conclusion of the opposition division.

1.2.2 The Board disagrees with the patent proprietor. As correctly put forward by opponent 2 in point 2 of its reply to the statement of grounds of appeal of the patent proprietor, neither the indicated description passage nor figures 5 and 6, nor original claim 7 directly and unambiguously show that the whole wheel assembly (including all parts thereof) is arranged around the peripheral outer wall of the outer part. Contrary to the view of the patent proprietor in the bridging paragraph between pages 2 and 3 of its statement of grounds of appeal, the Board is of the view that claim 7 as granted does indeed require that *all* parts of the wheel assembly need to be around the peripheral outer wall, so that the alleged unambiguous disclosure of the wheels being arranged around the outer peripheral wall does not provide sufficient basis for the provision of the wheel **assembly** located in that position.

1.2.3 The Board consequently concludes that the patent proprietor has not convincingly demonstrated the

incorrectness of the findings of the opposition division, that the ground of opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted.

Appeal of opponent 2

2. *Auxiliary request 1 - Sufficiency of disclosure, Article 83 EPC*

2.1 The following findings on sufficiency of disclosure of auxiliary request 1 correspond to the view of the Board which had been communicated to the parties with the communication pursuant to Article 15(1) RPBA 2020 (see point 8 thereof). The parties have neither reacted nor objected to the opinion expressed in that communication. After having reconsidered all relevant legal and factual aspects of the case, the Board does not see any reason to deviate from its preliminary opinion.

2.2 Opponent 2 argued in point 6 of its statement of grounds of appeal that the opposition division erred in its findings of point 3 of the reasons of the decision under appeal that claims 5 and 30 according to auxiliary request 1 were sufficiently disclosed.

2.3 With regard to claim 5, opponent 2 held that the embodiment of a pair of extendable/retractable lifting arms arranged on either side of the container-receiving space entered in contradiction with the requirement of claim 1, that the lifting mechanism was located above the container receiving space. Further, paragraph [0044] required that the footprint of the vehicle was larger than the size of the bin only enough to accommodate the wheels on the sides, so that there were

no room for the lifting arms arranged on the sides. The embodiment of claim 5 had thus not been disclosed in sufficient detail for a skilled person to reproduce the invention.

- 2.4 The Board is not persuaded by the arguments of opponent 2. As correctly reasoned by the opposition division in point 3.5 of the decision under appeal, the lifting mechanism, including the retractable arms, can be arranged both above as well as extending on the sides of the container-receiving space. In addition, even if paragraph [0044] could restrict the invention as defined in claims 1 and 5, opponent 2 has not provided **serious doubts substantiated by verifiable facts** that the wheels would leave no space for the lifting arms on either side of the container-receiving space, so that the skilled person could not carry out the invention as defined in claim 5 of auxiliary request 1.
- 2.5 With respect to claim 30 (equivalent to claim 31 of the patent as granted), opponent 2 argued that there was no sufficient disclosure on how the load handling device, which was the load handling device previously defined in claim 1, could achieve the capability of lifting a plurality of containers from a stack in a single operation.
- 2.6 The Board disagrees with the arguments of opponent 2 and rather follows the reasoned finding of the opposition division of point 3.6 of the reasons for the decision under appeal, that the wording of claim 30 according to auxiliary request 1 leaves open the possibility for further one or more load handling devices different from the one defined in claim 1, so that there is no apparent serious doubt present that

the skilled person could not put into practice the lifting of a plurality of containers in a single operation.

3. *Auxiliary request 1 - Added subject-matter, Article 123(2) EPC*

3.1 Opponent 2 indicated in point 7.1 of its statement of grounds of appeal that, contrary to the conclusion of the opposition division in point 4.1 of the reasons of the decision under appeal, the omission of the word "substantially" in claim 1 as granted and according to auxiliary request 1 in the feature "the load handling device (100) has a footprint that occupies *substantially* only a single grid space" resulted in an extension of subject-matter beyond the original disclosure, contrary to the requirements of Article 123(2) EPC.

3.2 The Board is not persuaded by the arguments of opponent 2 and is convinced that the skilled person is not presented with any new technical information due to the omission of the word "substantially", for the following reasons.

3.2.1 While it could be agreed with opponent 2 (see point 5.1 of its statement of grounds of appeal) that the term "grid space" could be understood as the space between the rails or tracks of the grid pattern, the Board is of the view that the term "footprint" is to be seen as the projected surface in an x-y plane of the entire load handling device including its wheel assemblies, rather than the defined area by the contact points of the load handling device with the rail system, as suggested by opponent 2 as a possible interpretation

for this term (see point 5.2 of its statement of grounds of appeal).

- 3.2.2 Furthermore, a footprint occupying only a single grid space is to be understood under the Board's view such that this footprint is equal or larger than that grid space, but without interfering a neighbouring grid space. Taking this into account, and contrary to the arguments put forward by opponent 2 in page 19, third paragraph, of its statement of grounds of appeal, it is well possible that, even when removing the word "substantially", the footprints of the stack and the loading device (including its wheel assemblies) are different while both occupy the same grid space, namely the footprint of the stack matching the grid space and the footprint of the load handling device exceeding the surface of the grid space without interfering the neighbouring grid spaces. This is in line with the original disclosure and makes technical sense.
- 3.2.3 On the basis of these interpretations the Board fails to identify which load handling devices are now covered by the the amended claim (*i.e.* having a footprint that occupies only a single grid space) that were not covered in the original disclosure, occupying *substantially* only one single grid space, so that no extension of subject-matter is apparent. In addition, the opposition division (cf. points 4.1.5. and 4.1.7. of the reasons for the decision under appeal) correctly identified in page 6, lines 24 to 26 and page 11, lines 36 to 40 of the original description a sufficient basis for a handling device occupying (without the word "substantially") a single grid space which is consistent with the interpretations above.

3.3 Opponent 2 further argued in point 7.2 of its statement of grounds of appeal that the use of the term **"lifting device comprising a gripping device"** rather than a "crane device" resulted in an extension beyond the original disclosure.

3.3.1 The Board notes that this objection has been raised for the first time in appeal proceedings. Opponent 2 justified the filing of this objection for the first time in appeal proceedings as being triggered by the findings on the assessment of novelty in view documents E17/E18 (see points 7.5.10 and 7.5.11 of the reasons for the decision under appeal), according to which the the features relating to the gripping means were interpreted by the opposition division in a particular way which had not been previously discussed. According to opponent 2, the objection was thus submitted at the earliest opportunity.

3.3.2 The Board is not persuaded by the justification provided by opponent 2 and is rather of the view that, being well aware during opposition proceedings of the amendments that had been carried out in claim 1 according to the patent as granted (which corresponds also to claim 1 according to auxiliary request 1), opponent 2 was in a position to form its complete case on added subject-matter already at the time of filing the notice of opposition. In doing so, an opponent may argue possible ways of interpreting the subject-matter the claims of the granted version in order to substantiate an alleged unallowable extension beyond the original disclosure. In this light, the Board considers that the opponent 2 could and should have submitted the objection as regards the feature "lifting device comprising a gripping device" during opposition proceedings.

3.3.3 Considering that the primary object of the appeal proceedings is that of reviewing the decisions of the administrative departments of the EPO (cf. Article 12(2) RPBA 2020), the Board does not consider it appropriate that opponent 2 starts a complete fresh case in appeal. Therefore, in the absence of any convincing justifying circumstances, the Board does not admit this new objection into the proceedings under Article 12(6), second sub-paragraph RPBA 2020.

4. *Priority*

The Board notes that the opposition division found in point 6 of the reasons for the decision under appeal that the priority claimed by the patent in suit and by the claims according to auxiliary request 1 was not valid. This issue turned to be not decisive for deciding on the appeal of opponent 2, as it will be shown in the following points. The Board thus refrains from issuing a preliminary opinion on the validity of the priority of the patent in suit and, for the sake of the argument and to the benefit of opponent 2 as appealing party, will consider for the purposes of novelty and inventive step the prior art under the assumption that the effective filing date of the patent is the application date (24 July 2014) and not the priority date (9 August 2013).

5. *Auxiliary request 1 - Novelty, Article 54 EPC*

5.1 Documents E13 and E14

5.1.1 The following findings on novelty of the subject-matter of claim 1 according to auxiliary request 1 in view of documents E13 or E14 correspond substantially to the

view of the Board which had been communicated to the parties with the communication pursuant to Article 15(1) RPBA 2020 (see point 11.1 thereof). The parties have neither reacted nor objected to the opinion expressed in that communication. In particular, opponent 2 relied on the broader interpretation of the term "footprint". After having reconsidered all relevant legal and factual aspects of the case, the Board does not see any reason to deviate from its preliminary opinion.

- 5.1.2 Opponent 2 argued in points 9.1 and 9.3 of its statement of grounds of appeal that under an alternative broad interpretation of the term "footprint" being the area defined by the contact points of the load handling device, both documents E13 and E14 would anticipate all features of claim 1 according to auxiliary request 1, including that the load handling device has a footprint that occupies *only* a single grid space in the storage system.
- 5.1.3 The Board disagrees. As it has been explained in point 3.2.1 above, the footprint of the load handling device is considered to be the plan view in the x-y plane of the entire load handling device, so that the load handling devices of E13, whose footprint extends beyond a single grid space, and the cantilever-type devices of E14, whose footprint occupies two grid spaces, cannot anticipate the subject-matter of claim 1, as correctly found by the opposition division in points 7.3.5 and 7.4.4 of the reasons for the decision under appeal.
- 5.2 Document E17 with priority of E18
 - 5.2.1 The Board notes that E17 was published after the filing date of the patent in suit and could only be

prejudicial for novelty for the parts present in the priority document E18, with the proviso that the finding of the opposition division on the priority of the patent is not required to be overruled.

- 5.2.2 Opponent 2 argued that the embodiments of figures 7, 8(a) and 8(b) of E18 comprised only vehicle lifting device motor 9a and therefore it could only be linked to one lifting device. In contrast, the robots disclosed in document E35, which cover multiple grid spaces, comprised also multiple lifting devices. This was a direct indication that the stripped robot of the figures E18 occupied only one single grid space.

Furthermore, opponent 2 also indicated that it is an inherent feature that the gripping devices of E18 grip the container from above, since there is no other possibility to grip the containers, which are located below the handling devices, in any other way.

- 5.2.3 The Board disagrees for the following reasons.

In first place, it is to be noted that the embodiments of figures 2 to 4 disclose load handling devices with footprints occupying more than one grid space.

In second place it is agreed with the patent proprietor that none of the figures 5 to 8 nor the corresponding description passages directly and unambiguously show the size of the load handling devices in comparison to the grid spaces. Contrary to the allegation of opponent 2, one single vehicle lifting motor such as 9a could serve to actuate multiple lifting devices, so that a concept such as the one shown in document E35 is compatible with these embodiments of E18. Even in the case that it could only be considered that these

embodiments of E18 comprise exactly one lifting device, the possibility that the load handling device occupies more than one grid space would still be not deprived of technical sense. In this light, the Board concludes that E18 does not directly and unambiguously disclose the feature that the footprint of the load handling device occupies only a single grid space in the storage system.

Furthermore, the Board cannot agree with the allegation of opponent 2 that the containers could only be gripped from above. Rather, the Board considers that other ways of lifting the device are possible and not deprived from technical sense, such as gripping the container with fork lifts from below. As correctly indicated by the patent proprietor in point 8.3.7, there is no disclosure in E18 of how the container is lifted, let alone that the container is gripped from above.

5.2.4 It follows that, as correctly found by the opposition division in point 7.5.16 of the decision under appeal, neither E18 nor E17 are prejudicial to novelty of claim 1 according to auxiliary request 1, even under the assumption that the priority of the patent in suit is not valid.

5.2.5 In view of this conclusion, the request of the patent proprietor of point 8.3.5 that this objection not be admitted under Articles 12(3) and 12(5) RPBA 2020 does not need to be addressed.

5.3 Document E16

5.3.1 Opponent 2 argues in point 9.5 of its statement of grounds of appeal that document E16 disclosed all features of claim 1 according to auxiliary request 1

including the gripping device being part of a lifting mechanism and being configured to grip a container from above (the device 40 in figure 17 includes a lifting device, as illustrated for the embodiment of device 40 shown on figure 4). According to opponent 2, the gripping device necessarily had to be configured to grip the container from above in accordance with claim 1, specially in view of the embodiments of figures 9 and 17 and due to the fact that the storage containers were stacked (see paragraph [0048]). There was thus no other possible way to perform such a gripping of the containers. The lifting mechanism was further located above a container receiving space in the load handling device, and the load handling device occupied one single grid space as shown in figures 9, 16 and 20.

5.3.2 The Board is not persuaded by these arguments and rather follows the conclusion of point 7.6.7 of the reasons for the decision under appeal, that the gripping means of the embodiment of figure 4 of E16 cannot be extrapolated to the embodiment of figure 17, which clearly shows different load handling devices. The Board is furthermore convinced, in line with the conclusion of point 5.2.3, last paragraph, that there is no direct and unambiguous disclosure in figure 9 of the location of the alleged lifting mechanism and that neither figure 17 nor any other passage of E16 can serve as an unambiguous disclosure of gripping means configured to grip a container **from above**.

5.3.3 It follows that, as correctly found by the opposition division in point 7.6.8 of the decision under appeal, document E16 is not prejudicial to novelty of claim 1 according to auxiliary request 1 in the sense of Article 54(3) EPC, under the assumption that the priority of the patent in suit was not valid.

- 5.3.4 In view of this conclusion, the request of the patent proprietor of point 8.4.5 that this objection not be admitted under Articles 12(3) and 12(5) RPBA 2020 does not need to be addressed.
- 5.4 Document E29 - Admittance, Article 12(6) RPBA 2020
- 5.4.1 The following findings on admittance of document E29 and the line of arguments for lack of novelty based on this document into the appeal proceedings correspond to the view of the Board which had been communicated to the parties with the communication pursuant to Article 15(1) RPBA 2020 (see point 11.4 thereof). The parties have neither reacted nor objected to the opinion expressed in that communication. After having reconsidered all relevant legal and factual aspects of the case, the Board does not see any reason to deviate from its preliminary opinion.
- 5.4.2 Opponent 2 argued in point 9.6 of its statement of grounds of appeal that the opposition division erred when finding that E29 was not admitted into the proceedings as it was considered not be *prima facie* relevant (see point 7.2 of the decision under appeal). On the contrary, E29 is *prima facie* relevant since it discloses all features of claim 1 as granted and according to auxiliary request 1.
- 5.4.3 According to Article 12(6), first sub-paragraph, RPBA 2020, the Board shall not admit facts, objections or evidence which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion
or

unless the circumstances of the appeal case justify their admittance.

- 5.4.4 In the present case, the opposition division applied its discretion not to admit **E29** for being late filed and *prima facie* not being novelty destroying, in particular by failing to disclose at least features regarding the grid pattern or the wheels in two perpendicular directions.
- 5.4.5 The Board notes that there is no apparent objection that the discretion applied by the opposition division was not based on the correct principle; the argument of opponent 2 rather amounts to differences in opinion. In this respect, the Board notes that according to the established case law, which is now contemplated under Article 12(6), first sub-paragraph, RPBA 2020, such an exercise of discretion should only be overruled in the event that it suffered from an error in the use of discretion, *i.e.* if the opposition division exercised its discretion according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (see Case Law of the Boards of Appeal [CLB], 10th edition 2022, V.A.3.4.1 b)). It is not the duty of the Board to review all the facts and circumstances of the case as if it were in that department's place and decide whether or not it would have exercised discretion in the same way. In this respect, since the evidence E29 was filed after the opposition period and the *prima facie* relevance of this evidence for the case was assessed, no error in the use of the discretion is apparent for the Board.
- 5.4.6 For the reasons above, and since the circumstances of the case with respect to the relevance of E29 have not changed in appeal proceedings, the Board follows the

patent proprietor's request for not admitting document E29 and the line of arguments for lack of novelty based on this document into the appeal proceedings.

6. *Auxiliary request 1 - Inventive step, Article 56 EPC*

6.1 E13 as closest prior art in combination with the common general knowledge

6.1.1 Opponent 2 argued that in the case that the Board considered that E13 did not anticipate the subject-matter of claim 1 of auxiliary request 1, the alleged distinguishing feature that the footprint of the load-handling device occupied only a single grid space did not render claim 1 as inventive.

According to opponent 2, starting from E13 as closest prior art, the technical effect associated to this distinguishing feature identified in paragraph [0025] of the patent in suit of preventing obstruction among the load-handling devices was already achieved by E13 as it could be seen in figure 9. The technical effect achieved by this alleged distinguishing feature should therefore just be seen as how to reduce the size of the robots. E13 itself already provided in multiple instances a hint to this problem, see for example page 1, lines 36 to 37, page 2, lines 17 to 21, page 3, lines 9 to 11 and page 4, lines 31 to 32. In the opponent 2's view, the problem of miniaturisation of the load-handling device was to be seen as a mere routine optimization matter that the skilled person would consider without exercising inventive skills. In this light, and starting from E13, the skilled person would arrive at the subject-matter of claim 1 of auxiliary request 1 in an obvious manner.

6.1.2 The Board is not convinced by the arguments of opponent 2 for the following reasons. As correctly indicated by the patent proprietor, there is no hint in E13 to adapt the load-handling devices to occupy only a single space. In addition, even if the skilled person would be hinted to restrict the footprint of the load handling device to one grid space, the skilled person would have to face the supplementary problem of finding a new location for the driving means without compromising the space needed for the receiving section. The Board is of the view that this would require an extensive re-design of the load handling device that goes beyond the alleged routine optimization asserted by opponent 2.

In sum, the Board is convinced that starting from E13 as closest prior art the skilled person would only arrive at the subject-matter of claim of claim 1 of auxiliary request 1 as the result of an *ex post facto* analysis.

6.1.3 In view of this conclusion, the request of the patent proprietor that this objection not be admitted into appeal proceedings does not need to be addressed.

6.2 E23 as closest prior art in combination with the teachings of any of E24, E13, E14 or E15

6.2.1 Opponent 2 argued in point 10.8 of its statement of grounds of appeal that starting from E23, the objective technical problem could be seen as improving the vehicle to pick up an element stored below the rails and transport the picked-up element. During the oral proceedings before the Board, opponent 2 formulated an alternative problem in view of paragraph [0013] of E23,

namely as how to adapt the known robot of E23 for a different type of storage system.

- 6.2.2 The skilled person, starting from E23 and in view of the technical problem, would arrive in an obvious way at the subject-matter of claim 1 of auxiliary request 1 in view of the teachings of a lifting device and mechanism to lift a container stored below the rails into a container receiving space present in any of documents E24, E13, E14 or E15. In view of these teachings, the skilled person would be hinted to modify the vehicle of E23 to include a container receiving space within the limitations of the single space, for example, by making the vehicle taller.
- 6.2.3 The Board is not persuaded by the arguments of opponent 2 and rather concurs with the patent proprietor (see point 9.8.2 of its reply to the statement of grounds of appeal) that E23 deals with a different environment and is fundamentally unsuitable for lifting containers from above. Furthermore, the adoption of the teachings of documents E24, E13, E14 or E15 would require a complete re-design of not only the load handling device, but also the provision of a storage system disposed below the grid system, which is part of the subject-matter of claim 1 according auxiliary request 1 and seems to be absent in E23.
- 6.2.4 For these reasons, and even under the assumption that the priority of the patent in suit was not valid and therefore E23 and E24 could be considered as part of the prior art, the Board is convinced that the subject-matter of claim 1 is inventive in view of these combinations.

6.2.5 In view of this conclusion, the requests of the patent proprietor of point 9.8.5 of the reply to the statement setting out the grounds of appeal that this objection not be admitted under Articles 12(3) and 12(5) RPBA 2020 and that the alternative problem formulated by opponent 2 for the first time at the oral proceedings before the Board not be admitted under Article 13(2) RPBA 2020, do not need to be addressed.

7. *Conclusions*

7.1 It follows from the above that the patent proprietor has not convincingly demonstrated the incorrectness of the findings of the opposition division, that the ground of opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted. Therefore, **the appeal of the patent proprietor is to be dismissed.**

7.2 In addition, opponent 2 has not provided convincing and admissible arguments that would demonstrate the incorrectness of the decision under appeal, that auxiliary request 1 meets the requirements of the EPC. Therefore, **the appeal of the opponent 2 is also to be dismissed.**

Order

For these reasons it is decided that:

The appeals are dismissed.

The Registrar:

The Chairman:



G. Nachtigall

B. Paul

Decision electronically authenticated