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**Datasheet for the decision
of 28 February 2024**

Case Number: T 1820/22 - 3.2.04

Application Number: 14767260.4

Publication Number: 3043639

IPC: A01K43/00, A01K45/00

Language of the proceedings: EN

Title of invention:

APPARATUS FOR SELECTIVELY INJECTING EGGS, AND ASSOCIATED
METHOD

Patent Proprietor:

Zoetis Services LLC

Opponent:

Egg-Chick Automated Technologies

Headword:

Relevant legal provisions:

EPC 1973 Art. 123(2)

RPBA 2020 Art. 12(6), 13(1)

Keyword:

Amendments - allowable (no)

Late-filed request - circumstances of appeal case justify
admittance (no)

Decisions cited:

Catchword:

Reasons 3.3 to 3.7 on non-admission of requests filed on
appeal



Beschwerdekammern

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Case Number: T 1820/22 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 28 February 2024

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 23 May 2022
revoking European patent No. 3043639 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman A. de Vries
Members: G. Martin Gonzalez
K. Kerber-Zubrzycka

Summary of Facts and Submissions

- I. The appeal was filed by the appellant (patent proprietor) against the decision of the opposition division to revoke the patent in suit.
- II. The opposition division held inter alia that claim 1 of the main request contained added subject-matter.
- III. In preparation for oral proceedings the board issued a communication setting out its provisional opinion on the relevant issues.

Oral proceedings before the Board were held by videoconference on 28 February 2024.

- IV. The appellant (proprietor) requests that the decision under appeal be set aside and that the patent be maintained in amended form based on the main request before the opposition division (filed on 14 February 2022), or one of the auxiliary requests 1, 1a, 1b, 1c, 2, 2a, 2b, 3, 3a, 4, 4a, 5-8 with auxiliary requests 1-8 filed on 4 October 2022 and auxiliary requests 1a, 1b, 1c, 2a, 2b, 3a and 4a on 13 June 2023.

The respondent (opponent) requests that the appeal be dismissed.

- V. Independent claim 1 of the requests relevant to this appeal reads as follows:

(a) Main request

"An egg injection apparatus (100), comprising:

an egg processing head (200); and

a plurality of injection devices (300) operably engaged with the egg processing head (200) so as to be capable of moving in a substantially vertical direction thereby, each injection device (300) having an end configured to contact an avian egg and further having a needle (302) and/or punch configured to pierce the avian egg,

characterized in that;

each injection device (300) is capable of alignment with a respective avian egg and capable of selectably engaging the egg such that the injection devices are selectively held in one of a non-contact position and a contact position during a processing sequence such that a first subset of the ends of the injection devices (300) is in the non-contact position while simultaneously having a second subset of the ends of the injection devices (300) in the contact position for injecting a treatment substance."

(b) Auxiliary requests 1 and 1a

Claim 1 as in the main request with the following features added to the claim (emphasis by the Board to indicate added text):

"...an egg processing head (200);

a conveyor assembly (112) configured to automatically convey avian eggs to the egg processing head (200) for processing thereof; and

a plurality of injection devices (300)...

...each injection device (300) is capable of alignment with a respective avian egg by automatically conveying the avian eggs via the conveyor assembly (112) and capable of selectably engaging..."

(c) Auxiliary requests 1b and 1c

Claim 1 as in auxiliary request 1 with the following features added to the claim (emphasis by the Board to indicate added text):

"...an egg processing head (200);

a flat (20) for positioning eggs therein;

a conveyor assembly (112) configured to automatically convey...

...each injection device (300) is capable of alignment with a respective avian egg by automatically conveying the avian eggs positioned within the flat (20) via the conveyor assembly (112) and capable of selectably engaging..."

(d) Auxiliary request 2

Claim 1 as in auxiliary request 1 with the following features added at the end of the claim (emphasis by the Board to indicate added text):

"...(300) in the contact position for injecting a treatment substance, wherein the egg processing head (200) has a clamp plate (220) defining a plurality of holes (222) for receiving the injection devices (300), the clamp plate (220) being configured to selectively

secure the end of each injection device (300) in one of the non-contact position and the contact position, and further comprising a lift plate (240) operating in conjunction with the clamp plate (220)."

(e) Auxiliary requests 2a and 2b

Claim 1 as in auxiliary request 2 with the same additional amendments as added to auxiliary requests 1b and 1c.

(f) Auxiliary requests 3 and 3a

Claim 1 of auxiliary request 3 as in auxiliary request 1. Claim 1 of auxiliary request 3a as in auxiliary request 1b.

(g) Auxiliary request 4

Claim 1 as in auxiliary request 3 (or auxiliary request 1) with the following feature added to the claim (emphasis by the Board to indicate added text):

"...a first subset of the ends of the injection devices (300) is in the non-contact position in order to avoid contact with eggs classified as non-viable while simultaneously having a second subset..."

(h) Auxiliary request 4a

Claim 1 as in auxiliary request 4 with the same additional amendments as added to auxiliary requests 1b and 1c.

(i) Auxiliary request 5

Claim 1 as in the main request with the following amendments (emphasis by the Board to indicate added or ~~deleted~~ text):

"...characterized in that;

~~each~~ the plurality of injection devices (300) is capable of alignment..."

(j) Auxiliary requests 6 and 7

Claim 1 as in auxiliary request 5 with the same additional features as added to auxiliary request 3.

(k) Auxiliary request 8

Claim 1 as in auxiliary requests 6 and 7 with the same additional features as added to auxiliary request 4.

VI. The appellant's arguments can be summarised as follows:

The conclusions of the opposition division in section 15 that the subject-matter of claim 1 of the main request extends beyond the disclosure of the application as filed are wrong. Claim 1 does not contain added subject-matter. The admission of auxiliary requests 1, 1a, 1b, 1c, 2, 2a, 2b, 3, 3a, 4, 4a, 5-8 in appeal is justified, since the possibility of amendment became distinctively apparent only through the opposition division's explanations in the contested decision.

VII. The respondent's arguments can be summarised as follows:

The opposition division was right to conclude added subject-matter for claim 1 of the main request. All auxiliary requests are late filed, in appeal, without justification. They are thus not admissible.

Reasons for the Decision

1. The appeal is admissible. The respondent opponent does not maintain their challenge to admissibility of the proprietor's appeal and the Board also sees no cogent reason to call admissibility into question.
2. Main request - Added subject-matter.
 - 2.1 As noted by the Board in its written communication:

"6.1 The conclusions of the opposition division in section 15 of the decision appear to be correct. The division held that the feature "each injection device is capable of alignment with a respective avian egg", added to claim 1 during examination, contains added subject-matter.

6.2 A pivotal point of contention is the meaning and scope of the added feature, that has no original literal basis. As variously stated in case law, the claims should essentially be read and interpreted on their own merit rather than with the aid of the description and drawings. Their wording should typically be given the broadest technically sensible meaning, cf. CLBA II.A. 6.1 and the cases cited therein.

6.3 *It is common ground that the original application documents do not disclose injection devices having active alignment capacity, that is they cannot themselves align with the respective egg. The original documents disclose a conveyor 112 that moves and positions egg flats 20 in the injection position below the injectors (also called processing devices in the original application), cf. PCT publication, p. 5, ln. 1-8 and p. 3, ln. 1-2. That is the eggs are brought into alignment with the injection devices.*

6.4 *Turning to the added feature, the word alignment in its normal sense encompasses both the passive and the active meanings (see Merriam-Webster, alignment: 1: the act of aligning or state of being aligned). Thus the claimed terms "each injection device is capable of alignment" appear to include active as well as passive alignment capacity of the injectors, as held by the opposition division, and so to contain added subject-matter. This conclusion also holds when reading the feature in combination with the other feature of claim 1 "...a plurality of injection devices (300) operably engaged with the egg processing head (200) so as to be capable of moving in a substantially vertical direction thereby...". The latter feature does not exclude horizontal movement of the injection devices and thus does not exclude active alignment capacity, contrary to the appellant's contention. The Board notes that had the appellant proprietor at grant wished to limit the claim to injection devices that were capable of being aligned they could have easily formulated to say so.*

6.5 *Claim 1 also appears to contain added subject-matter in that by using the term "each" the scope of the contested feature includes individual alignment*

capacity (whether active or passive) of the injectors, as also held by the division. The original application, in contrast, only discloses simultaneous alignment capacity of the plurality of injection devices."

- 2.2 The appellant proprietor refrained from comment after issuance of the communication. Absent any further submissions the Board sees no reason to change its point of view . The Board thus confirms the conclusion of the opposition division that claim 1 of the main request contains added subject-matter, Art 123(2) EPC.
3. Auxiliary request - Admission.
 - 3.1 At the oral proceeding the Board decided not to admit auxiliary requests 1, 1a, 1b, 1c, 2, 2a, 2b, 3, 3a, 4, 4a, 5-8 for the following reasons.
 - 3.2 The appellant filed auxiliary requests 1 to 8 with the statement of grounds, and auxiliary requests 1a, 1b, 1c, 2a, 2b, 3a, and 4a with the further reply dated 13 June 2023. None of these requests had been submitted before; all were first filed in appeal and thus represent amendments to the proprietor's appeal case. The first set of requests is subject to the discretion of Art 12(6) RPBA. For the second set discretion is exercised according to the provisions of Art 13(1) RPBA and Articles 12(4) to (6) which apply mutatis mutandis.
 - 3.3 All auxiliary requests contain amendments that are said to address the added subject-matter objection on which the decision was based, and confirmed above by the Board.

3.4 However, the Board notes that the proprietor did not make any attempt to address the objection by amendment during the opposition proceedings, even though the objection was known to them from the outset, see pages 6 through 9 of the notice of opposition, and the annex to the summons of 28.10.2021, where in section 7 the issue was again raised. The appellant proprietor was given ample opportunity to address the issue by amendment, and indeed submitted various requests in the course of the opposition proceedings (submissions of 04.12.2020 and 14.02.22) none of which however dealt with the issue of added subject-matter. Thus, though they could have addressed the issue of added subject-matter, they chose not to do so, instead addressing by amendment only other issues raised.

3.5 The appellant explained at the oral proceedings that they chose not to address the issue by amendment in the opposition proceedings because they were convinced that this was futile due to the Art 123(3) trap. They refer to point 4.4 of the minutes, that this also seems to have been the understanding of both parties and the opposition division.

They argue that they only became aware of the possibility of amendment for the first time upon reading the reference to the conveyor assembly in point 15.4 of the decision. They then realized, so the argument goes, that it might be possible to escape the trap by limiting the claim to include the feature that each injection device is capable of alignment... "by automatically conveying the avian eggs via the conveyor assembly".

3.6 It is clear from the above, however, that nothing has changed in the underlying facts. Thus, the issue of added subject-matter arising from the feature added before grant that *each injection device is capable of alignment* is still the very same as at the outset of the opposition proceedings, as are the basic reasons that this would add subject-matter and the relevant passages cited (page 3, ln.1-2 and figure 5) of the A1 publication), cf. summons of 28 October 2021, point 7.1, and reasons 15.2 and 15.3 of the decision under appeal.

The only thing that has changed seems to be the appellant's assessment of the need for amendment and the possibility to do so in the light of the decision's rebuttal (reasons 15.4) of their main argument that the added feature referred to a passive capacity. Whereas before they did not appear to see a need to try and clarify such a reading by amendment, possibly because they saw no clear basis, the decision's mention of claim 18 is now seen as offering an opening. At best (and leaving aside that claim 18 in the Board's view does not offer a basis) this indicates an initial failure to identify a potential basis for their own reading of the added feature. In the Board's view the appellant proprietor should know ab initio what is the basis in the original disclosure of their patent for a reading of a claim feature they are arguing. If they are unable or fail to do so earlier, then they must bear the consequences. Thus, the Board is unable to see a justification for the late submission of amendments only in appeal as a result of a belated realization on their part, however that realization may have come about.

3.7 Nor do the amendments of these requests appear suitable to overcome the added subject-matter objection on which the decision was based, while some include amendments not occasioned by a ground of opposition in the sense of Rule 80 EPC. Thus, additionally, the requirements of Art 12(4) RPBA are not met.

Auxiliary requests 1-4, as filed with the statement of grounds, and any later a, b and c versions filed with the letter of 13 June 2023, maintain the expression "each injection device" and thus still include individual alignment capabilities, not originally disclosed.

Claim 1 of auxiliary requests 5-8 on the other hand do not attempt any amendment of the objectionable feature and thus retain the active alignment capability of the injectors not originally disclosed.

Auxiliary requests 1,1a,2,5 and 6 further include two new dependent claims, numbered 3 and 4 in auxiliary requests 1,1a,2 and 5, and 2 and 3 in auxiliary request 6. In accordance with established jurisprudence the filing of new dependent claims when amending in opposition (or a following appeal) is not allowable under Rule 80 EPC, see CLBA, 10th edition, 2022, IV.C. 5.1.2 c).

Finally, the nature and number of the requests, 16 in all, most of which offer different attempts to resolve the issue of added subject-matter, is fairly complex and considered disproportionate to that issue. This is all the more so in view of the argument that a single passage, as filed claim 18, would provide a basis for amendment.

- 3.8 Therefore, the Board at the oral proceedings concluded that the circumstances of the appeal case do not justify the admission of these auxiliary requests that should have been filed during opposition proceedings, Art 12(6) RPBA and Art 13(1) RPBA. It therefore decided not to admit these requests.
4. The appellant's main request fails and the remaining requests have not been admitted. The Board therefore confirms the decision of the opposition division.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated