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

Case Number: T 1831/22 - 3.2.07

Application Number: 18169007.4

Publication Number: 3372535

IPC: B65G1/04

Language of the proceedings: EN

Title of invention:
ROBOT FOR TRANSPORTING STORAGE BINS

Applicant:
Autostore Technology AS

Headword:

Relevant legal provisions:
EPC Art. 18(2), 116, 113, 84, 76(1)
EPC R. 103(1)
RPBA 2020 Art. 12(8), 15(1)

Keyword:

Reimbursement of appeal fee - (no)

Substantial procedural violation - (no)

Oral proceedings - limitation of time to speak

Claims - clarity (no)

Amendments - added subject-matter (yes)

Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:



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Case Number: T 1831/22 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 28 September 2023

Appellant: Autostore Technology AS
(Applicant) Stokkastrandvegen 85
5578 Nedre Vats (NO)

Representative: Onsagers AS
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 25 January 2022
refusing European patent application No.
18169007.4 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Patton
Members: V. Bevilacqua
Y. Podbielski

Summary of Facts and Submissions

- I. The appellant (applicant) filed an appeal against the decision of the examining division to refuse European patent application number 18 169 007.4, requesting
- that the decision under appeal be set aside and
 - that the case be remitted to the examining division with the instruction to grant a patent on the basis of auxiliary request 3 discussed in the appealed decision, or
 - that the case be remitted to the examining division for further prosecution on the basis of auxiliary request 3 discussed in the appealed decision or, alternatively, on the basis of the other requests discussed in the appealed decision, in the following order:
 - auxiliary request 2,
 - auxiliary request 1,
 - main request
 - auxiliary requests 4 to 8.

The appellant further requested that the appeal fee be reimbursed, arguing that a procedural violation occurred during the examination proceedings.

- II. In preparation for oral proceedings the Board communicated its preliminary assessment of the case, according to which the appellant convincingly demonstrated that the findings of the appealed decision related to the presence of added subject-matter in claim 1 of auxiliary request 4 upon which the appeal decision is based was not correct, while all preceding

requests were considered not allowable. The Board also did not see any justification for the reimbursement of the appeal fee.

The Board informed the appellant that in the event that they **agree to a decision in the written procedure**, without oral proceedings, a final decision on the appeal, remitting the case to the examining division for further prosecution on the basis of auxiliary request 4 could be promptly issued under Article 12(8) RPBA 2020.

III. With letter dated 22 August 2023 the appellant informed the Board that they

"agree to a decision in the written procedure without oral proceedings"

and

"look forward to receiving the Boards decision for remittal to the Examination Division for further prosecution on the basis of Auxiliary Request 4."

IV. Claim 1 of auxiliary request 3 discussed in the appealed decision reads as follows:

"A remotely operated vehicle assembly (1) for picking up storage bins (2) from a storage system (3), comprising
a vehicle body (4) displaying a cavity (7) for receiving a storage bin (2) within the storage system (3), a vehicle lifting device (9,9a) connected to the vehicle body (4) for lifting the storage bin (2) into the cavity (7), driving means comprising a first set of vehicle rolling means (10) connected to the vehicle

body (4) allowing movement of the vehicle (1) along a first direction (X) within the storage system (3) during use, and a second set of vehicle rolling means (11) connected to the vehicle body (4) allowing movement of the vehicle (1) along a second direction (Y) in the storage system (3) during use, the second direction (Y) being perpendicular to the first direction (X), a displacement arrangement (23-28) coupled to the driving means comprising a displacement motor (25) configured to provide power to displace at least one (10) of the first set of vehicle rolling means (10) and the second set of vehicle rolling means (11) between a displaced state where the vehicle rolling means (10, 11) is displaced away from the underlying storage system (3) during use, and a non-displaced state where the vehicle rolling means (10, 11) is in contact with the underlying storage system (3) during use, characterized in that the displacement motor (25) is situated in a lateral plane above the cavity (7) **or** near the lateral plane, and further configured to generate a power that is converted to a vertically directed pressure force acting on the first or second set of vehicle rolling means (10, 11)".

The preamble of claim 1 of auxiliary request 2 discussed in the appealed decision corresponds to the preamble of claim 1 of auxiliary request 3 (see above). The characterizing portion thereof reads as follows (amendments over claim 1 of auxiliary request 3 are in bold, deletions are struck through, emphasis added by the Board):

"characterized in that the displacement motor (25) is situated **near an upper in a** lateral plane **of above** the cavity (7), ~~or near the lateral plane~~ and further

configured to generate a power that is converted to a vertically directed pressure force acting on the first or second set of vehicle rolling means (10, 11)" "

The preamble of claim 1 of auxiliary request 1 discussed in the appealed decision also corresponds to the preamble of claim 1 of auxiliary request 3, given above.

The characterizing portion thereof reads as follows (amendments over claim 1 of auxiliary request 2 discussed in the appealed decision are in bold, deletions are struck through, emphasis added by the Board):

"characterized in that the displacement motor (25) is situated near ~~an-the~~ upper lateral plane of the cavity (7), **wherein the lateral plane is defined as any planes which are arranged parallel to the plane set up by the first (X) and second (Y) direction**, and further configured to generate a power that is converted to a vertically directed pressure force acting on the first or second set of vehicle rolling means (10,11)."

Claim 1 of the main request discussed in the appealed decision reads as follows (amendments done with respect to claim 1 of auxiliary request 3 discussed in the appealed decision are in bold, deletions are struck through, emphasis added by the Board):

"A remotely operated vehicle assembly (1) for picking up storage bins (2) from a storage system (3), comprising a vehicle body (4) displaying a cavity (7) for receiving a storage bin (2) within the storage system (3),
a top cover (72)

a vehicle lifting device (9,9a) connected to the vehicle body (4) for lifting the storage bin (2) into the cavity (7), driving means comprising a first set of vehicle rolling means (10) connected to the vehicle body (4) allowing movement of the vehicle (1) along a first direction (X) within the storage system (3) during use, and a second set of vehicle rolling means (11) connected to the vehicle body (4) allowing movement of the vehicle (1) along a second direction (Y) in the storage system (3) during use, the second direction (Y) being perpendicular to the first direction (X), a displacement arrangement (23-28) coupled to the driving means comprising a displacement motor (25) configured to provide power to displace at least one (10) of the first set of vehicle rolling means (10) and the second set of vehicle rolling means (11) between a displaced state where the vehicle rolling means (10, 11) is displaced away from the underlying storage system (3) during use, and a non-displaced state where the vehicle rolling means (10, 11) is in contact with the underlying storage system (3) during use,

wherein the vehicle body (4) is covering all sides in the first and second (X, Y) directions,

characterized in that the displacement motor (25) is situated **near the upper** ~~in a~~ lateral plane **of above** the cavity (7) ~~or near the lateral plane,~~

wherein the lateral plane is defined as any planes which are arranged parallel to the plane set up by the first (X) and second (Y) direction,

and further configured to generate a power that is converted to a vertically directed pressure force acting on the first or second set of vehicle rolling means (10, 11)".

Claim 1 of auxiliary request 4 discussed in the appealed decision reads as follows:

"A remotely operated vehicle assembly (1) for picking up storage bins (2) from a storage system (3), comprising
a vehicle body (4) comprising four exterior side walls and displaying a cavity (7) for receiving a storage bin (2) within the storage system (3),
a top cover (72) covering the top part of the vehicle body (4) and oriented perpendicular to the four exterior side walls,
a vehicle lifting device (9,9a) connected to the vehicle body (4) for lifting the storage bin (2) into the cavity (7),
driving means comprising a first set of four wheels (10) connected to the vehicle body (4) allowing movement of the vehicle (1) along a first direction (X) within the storage system (3) during use, the first set of four wheels (10) being oriented with their rotational axis perpendicular to two opposite facing side walls of the four exterior side walls, and
a second set of four wheels (11) connected to the vehicle body (4) allowing movement of the vehicle (1) along a second direction (Y) in the storage system (3) during use, the second direction (Y) being perpendicular to the first direction (X) and the second set of four wheels (11) being oriented with their rotational axis perpendicular to the other two opposite facing side walls of the four exterior side walls,
a displacement arrangement (23-28) coupled to the driving means comprising a displacement motor (25) configured to provide power to displace at least one (10) of the first set of four wheels (10) and the second set four wheels (11) between a displaced state where the wheels (10, 11) are displaced away from the

underlying storage system (3) during use, and a non-displaced state where the wheels (10, 11) are in contact with the underlying storage system (3) during use, **characterized in that** the displacement motor (25) is situated in a lateral plane above the cavity (7) or near the lateral plane, and further configured to generate a power that is converted to a vertically directed pressure force acting on the first or second set of four wheels (10, 11), wherein each of the sets of wheels (10,11) are composed of two wheel parts (10a, 10b), wherein each wheel parts (10a,10b) comprises two laterally spaced apart wheels (31a, 31b) arranged at the exterior side walls of the vehicle body (4) facing away from the cavity (7) and wherein the laterally spaced apart wheels (31a, 31b) are arranged at, or near, each of the respective two corners of the lower edge of the vehicle body (4)."

Reasons for the Decision

1. Decision in writing, Article 12(8) RPBA 2020
- 1.1 The case is ready for decision which is taken in written proceedings without holding oral proceedings in accordance with Article 12(8) RPBA 2020 and with Articles 113 and 116 EPC.
- 1.2 In reaction to the Board's communication pursuant to Article 15(1) RPBA 2020, explaining that the case could be remitted for further prosecution on the basis of auxiliary request 4, the appellant wrote:

"With reference to section 10 we agree to a decision in the written procedure without oral proceedings. We look forward to receiving the Boards decision for remittal to the Examination Division for further prosecution on the basis of Auxiliary Request 4" (letter dated 22 August 2023).

1.3 The Board considers that with this statement the appellant amended their original request for oral proceedings specifying that there is no request for oral proceedings in case a final decision on the appeal, remitting the case to the examining division for further prosecution on the basis of auxiliary request 4, is issued.

1.4 The appellant has been informed of the Board's preliminary assessment of the case with a communication under Article 15(1) RPBA 2020 taking the appellant's submissions fully into account.

The grounds and evidence upon which the present decision is based were therefore communicated by the Board pursuant to Article 15(1) RPBA 2020, and have neither been commented upon nor been contested by the appellant.

Accordingly, the principle of the right to be heard (Article 113(1) EPC) has been observed since that provision only affords the opportunity to be heard and the party's submissions have been fully taken into account (see Case Law of the Boards of Appeal, 10th edition 2022, identified as "CLB" in the following, III.B.2.7.3).

1.5 In view of the fact that the case is ready for decision on the basis of the appellants' written submissions the Board issues the present decision in written proceedings in accordance with Article 12(8) RPBA.

2. Allegation of procedural violation

2.1 With their statement setting out the grounds of appeal the appellant argues that the appealed decision, taken on the basis of D4 (WO 2015/019055 A1), was not based on grounds or evidence on which they have had the opportunity to present their comments (Article 113(1) EPC).

This was because the examining division allegedly gave the appellant less than 20 minutes to compare D4, a document with 43 pages, with its priority document (13 pages) to assess the validity of the priority of the allegedly novelty destroying embodiment identified by the examining division, and only 11 minutes to discuss whether the subject-matter of the then main request was anticipated.

According to the appellant such time frames were inadequate.

Oral proceedings had therefore not been conducted fairly (the appellant refers to section III.B.2.6 of CLB).

According to the appellant, it is irrelevant in that respect, that D4 has been under discussion during opposition proceedings concerning the parent application of the patent in suit, because the jurisprudence (the appellant refers to CLB, II.F.4.1) establishes that the procedure concerning a divisional

application is independent from the procedure concerning the parent application, and in particular that facts and evidence filed in the parent procedure are not automatically part of the divisional procedure.

The appellant also argues that Article 18(2), first and third sentences, EPC has been violated, because the decision was based on a document filed for the first time at the oral proceedings, of which clearly the chairman and the second member of the examining division had no previous knowledge, because they had not been involved in the opposition proceedings against the granted parent application, nor had they enough time to examine its disclosure before taking the decision.

- 2.2 The board disagrees, and notes that the reasons therefor, notified to the appellant with the communication pursuant to Article 15(1) RPBA 2020 (see section 1 thereof) and repeated in the following, remained uncontested.

The appellant's arguments do not convincingly show that the examining division violated their right to be heard (Article 113(1) EPC).

This is because the minutes of the oral proceedings clearly show that, after the examining division raised, for the first time, a novelty objection based on D4, the appellant, given the opportunity to comment thereupon, argued that D4 was not prior art because the priority date thereof was not validly claimed (minutes point 33). In this respect they referred to their written submissions in the proceedings of the parent application.

The minutes also show that after having discussed the priority issue, introduced by the appellant, this party was again given the opportunity to discuss whether the subject-matter of the then main request was anticipated by D4 (minutes, points 34 to 38).

As it is not apparent, from the minutes of the oral proceedings, that the appellant requested adjournment or interruption of the oral proceedings to study D4, and that such a request was not allowed by the examining division, the board is not convinced that the appellant was not given adequate time to present their comments on D4 and the novelty objection based thereupon.

As a consequence of the above the reference, made in the statement setting out the grounds of appeal, to section II.F.4.1 of CLB is not convincing.

The appellant also failed to convincingly demonstrate that a violation of Article 18(2) EPC occurred, and that the oral proceedings were not conducted fairly. This is because the allegation that the appealed decision based on D4 has been taken without the participation of all the members of the examining division is unsubstantiated.

Unsubstantiated is also the allegation that two of the three members of the examining division had no knowledge of document D4 when the decision was taken.

The citation from section III.B.2.6 of CLB is not supportive of the appellant's arguments, because the appellant has not convincingly shown that they were treated unfairly and did not have the opportunity to

present their case during the oral proceedings before the examining division.

3. Reimbursement of the appeal fee

The appeal fee is reimbursed if a substantial procedural violation occurred (Rule 103(1) (a) EPC).

However, as discussed above, the appellant failed to convince the board in that respect.

As it is not apparent that a procedural violation occurred, the Board decides not to reimburse the appeal fee.

4. Lack of clarity - auxiliary request 3 and auxiliary request 2 discussed in the appealed decision

4.1 According to the examining division, the expression "lateral plane" which is present in claim 1 of auxiliary request 3 (see point II.7.4) and of auxiliary request 2 (see point II.6.4) is unclear, because it does not specify how this plane is defined or oriented.

4.2 The appellant criticizes the above findings arguing that the expression "lateral plane" complies with the requirements of Article 84 EPC because this "lateral plane" is defined in the description, at page 2, lines 33-34, and, according to Article 69(1) EPC, the description and drawings shall be used to interpret the claims.

4.3 The board is not convinced by the above line of argument for the following reasons.

According to established case law, Article 69(1) EPC does not stipulate a general requirement that claims are to be interpreted with the help of the description, in the sense that limiting features mentioned in the description but not in the claims could be read into the latter (CLB, IV.B.2.5.1).

The appellant also did not explain why the findings at sections II.6.4 and II.7.4 of the appealed decision are not correct in view of the wording of the claim as such.

The board concurs with the finding of the examining division according to which the term "lateral plane", taken alone, as it is used in the claims, is vague and **unclear** because it leaves the reader in doubt as to the meaning of the technical feature to which it refers (Article 84 EPC) as it does not specify how this plane is defined or oriented.

As a consequence of the above, and taking also into account that the above assessment of clarity was notified to the appellant with the communication pursuant to Article 15(1) RPBA 2020 (see section 4 thereof) and remained uncontested, the auxiliary requests 2 and 3 discussed in the appealed decision are considered to lack clarity and to be unallowable.

5. Auxiliary request 1 and main request discussed in the appealed decision - Article 76(1) EPC
- 5.1 Claim 1 of auxiliary request 1 and of the main request discussed in the appealed decision contain the following feature:

"wherein the lateral plane is defined as any planes which are arranged parallel to the plane set up by the first (X) and second (Y) direction".

5.2 According to the appellant this feature does not contravene the requirements of Article 76(1) EPC because it is found in page 2, lines 33 to 34 of the parent application (it is referred herewith to the published PCT application: WO 2015/193278 A1).

5.3 The board disagrees. This feature, added to specify the orientation of the lateral plane by referring to "any planes", results in an unallowable extension of the claimed subject-matter beyond the content of the parent application.

This is because the claim now includes that the motor, being near to "any planes which are arranged parallel to the plane set up by the first (X) and second (Y) direction" can be situated near to more than one "upper lateral plane", leading to possible embodiments - depending on the situation of the upper lateral plane - which are neither disclosed nor foreseen in the parent application.

Also the above assessment, notified to the appellant with the communication pursuant to Article 15(1) RPBA 2020 (see section 5.2.1 thereof), remained uncontested.

For the above reasons auxiliary request 1 and the main request discussed in the appealed decision contravene the requirements of Article 76(1) EPC and cannot be allowed.

6. Auxiliary request 4 discussed in the appealed decision
- Article 76(1) EPC

6.1 The examining division identified the following six amendments done to claim 1 of auxiliary request 4 with respect to claim 1 of the parent application, and found that they extended beyond the content thereof (appealed decision, section II.8) and concluded, on that basis, that the requirements of Article 123(2) EPC [sic] were not satisfied:

- "a vehicle body comprising four exterior side walls" (amendment 1)
- "a top cover (72) covering the top part of the vehicle body (4) and oriented perpendicular to the four exterior side walls" (amendment 2)
- "a first set of four wheels... being oriented with their rotational axis perpendicular to two opposite facing side walls of the four exterior side walls" (amendment 3)
- "each of the sets of wheels (10,11) are composed of two wheel parts (10a, 10b)" (amendment 4)
- "wherein each wheel parts (10a, 10b) comprises two laterally spaced apart wheels (31a, 31b) arranged at the exterior side walls of the vehicle body (4) facing away from the cavity (7)" (amendment 5)
- "wherein the laterally space apart wheels (31a, 31b) are arranged at, or near, each of the respective two corners of the lower edge of the vehicle body (4)" (amendment 6)

6.2 The board finds that the features corresponding to amendments 1 to 3 are originally disclosed in the description and drawings of the parent application, which correspond, with the exception of some minor editorial amendments, to the originally filed

description and drawings of the present application (Articles 123(2) EPC and 76(1) EPC).

- 6.2.1 The features "four exterior side walls" and "top cover covering the top part of the vehicle body and oriented perpendicular to the four exterior side walls" (amendments 1 and 2) are clearly and unambiguously derivable from the originally filed documents.

These features are not only disclosed in the context of the first embodiment, depicted in figures 2 and 3 (see page 8, line 28), but also in relation to the second embodiment, depicted in figures 5, 6(a) and 6(b) (page 9, line 11) and 10a 10(b) (page 11, lines 14,15) as well as in relation to the third embodiment depicted in figures 13-16 (page 12, lines 27-28) of both the parent application and of the originally filed description.

- 6.2.2 Concerning amendment 3 in the appealed decision, the board also concurs with the appellant that a skilled reader looking at the originally filed figures (of both the parent and the present application) would see two sets of two wheels in each of the three embodiments (see figures 5, 6 and 13) and also immediately and unequivocally identify the rotational axes of the wheels of the first and second set and consider that the feature that these axes are perpendicular to the exterior side walls is also disclosed for each embodiment.

- 6.3 The board also finds that amendments 4, 5 and 6 of the decision under appeal are disclosed in the parent application (Article 76(1) EPC).

6.3.1 The board acknowledges that these features are mentioned when describing the "second embodiment" at page 9, lines 18-30 of the description of the parent application (table at page 13 of the statement of grounds), and can therefore also be clearly identified in the vehicle depicted in figure 5 of the parent application.

6.3.2 The appellant convincingly argued that as the features corresponding to amendments 4 to 6 are also derivable from figure 13, depicting the third embodiment, a person skilled in the art, reading the originally filed documents as a whole of the parent application, would conclude that these features are not limited to the vehicle depicted in figure 5, but extend to all disclosed embodiments.

A skilled person, after having read the parent application as a whole would therefore identify the wheel mechanism shown in figure 13, deprived of a master wheel (see page 13, lines 21-24) as the "wheel part" described at page 9, and conclude that the feature "wheel part" can be generalized to any embodiment.

6.4 Based on the above, the board concludes that the appellant convincingly demonstrated that

- the findings at section II.8 of the appealed decision are not correct, and that
- auxiliary request 4 fulfills the requirements of Article 76(1) EPC.

7. Remittal of the case to the examining division -
Article 11 RPBA 2020
- 7.1 The board is aware that, according to Article 11 RPBA 2020 a remittal for further prosecution should only be undertaken exceptionally, when special reasons apply.
- 7.2 The board notes that the decision under appeal on auxiliary request 4 is merely based on objections of added subject-matter in view of the parent application.

Noting that the examining division has neither addressed the other requirements of the EPC, such as those relating to novelty and inventive step of the claimed subject-matter, the board cannot come to a decision regarding these patentability requirements by reviewing the decision under appeal in a judicial manner as set out in Article 12(2) RPBA 2020.

According to the established case law, since the main purpose of appeal proceedings is to give a losing party an opportunity to challenge a decision on its merits, remittal in accordance with Article 111(1) EPC is an option to be considered by the boards where essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided on by the department of first instance (see the Case Law of the boards of appeal, 10th edition 2022, V.A. 9.3.2.a)).

Moreover, the appellant has explicitly expressed themselves in favour of a remittal on the basis of auxiliary request 4.

As a result, after considering all the relevant circumstances of the case at hand, the board, noting

that Article 11 RPBA 2020 cannot be seen as limiting the discretionary power of the board provided by Article 111(1) EPC, considers it appropriate to remit the case to the examining division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



G. Nachtigall

G. Patton

Decision electronically authenticated