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**Datasheet for the decision
of 16 July 2024**

Case Number: T 0321/23 - 3.2.07

Application Number: 16843219.3

Publication Number: 3202693

IPC: B65G47/86, H01L21/677,
H05K13/02, B23P21/00

Language of the proceedings: EN

Title of invention:
TRANSFERRING DEVICE

Patent Proprietor:
Ueno Seiki Co., Ltd.

Opponent:
MB Automation GmbH & Co. KG

Headword:

Relevant legal provisions:
EPC Art. 100(c), 123(2), 112(1)(a)
Guidelines for examination H-V, 3.2.1

Keyword:

Grounds for opposition - added subject-matter (yes) - extension of subject-matter (yes)

Amendments - allowable (no) - extension beyond the content of the application as filed (yes)

Referral to the Enlarged Board of Appeal - admissibility (no)

Decisions cited:

T 0714/00, T 1471/10, T 2392/10, T 2154/11, T 2287/11,

T 1791/12, T 0775/17, T 1762/21

Catchword:



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Case Number: T 0321/23 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 16 July 2024

Appellant: MB Automation GmbH & Co. KG
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 15 December
2022 rejecting the opposition filed against
European patent No. 3202693 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman G. Patton
Members: A. Cano Palmero
E. Mille

Summary of Facts and Submissions

- I. The opponent (appellant) lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division rejecting the opposition which had been filed against European patent No. 3 202 693.
- II. The opposition had been filed against the patent in its entirety on all grounds for opposition pursuant to Article 100(a) (novelty and inventive step), (b) (sufficiency of disclosure) and (c) EPC (added subject-matter).
- III. The appellant (opponent) requested

that the decision be set aside and
that the patent be revoked in its entirety, and
that the case be remitted to the opposition
division for further prosecution of the auxiliary
requests.
- IV. The respondent (patent proprietor) initially requested

that the appeal be dismissed and that the patent be
maintained as granted (main request);
or, in the alternative,
when setting aside the decision under appeal,
that the patent be maintained in amended form
according to one of the sets of claims filed as
auxiliary requests I to V during opposition
proceedings;
or, in the alternative,

that the case be remitted to the opposition division for further prosecution regarding auxiliary requests I to V;
and that the ground of appeal of the appellant based on insufficiency of disclosure of the claimed invention (Article 100(b) EPC) not be admitted into the proceedings.

V. In order to prepare the oral proceedings scheduled upon the parties' requests, the board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA. The board indicated that the subject-matter of claim 1 of the patent as granted and according to auxiliary requests I to V appeared to extend beyond the content of the original disclosure. The patent was likely to be revoked.

VI. Both parties replied in the substance to the board's communication, the respondent with letter dated 17 June 2024 and the appellant with letter dated 4 July 2024.

In point 1.4 of its letter the respondent further requested

that three questions be referred to the Enlarged Board of appeal under Article 112(1)(a) EPC, in the case the board finds that the main request does not meet the requirements of Article 123(2) EPC.

VII. Oral proceedings before the board took place on 16 July 2024. During the oral proceedings the respondent further requested

that two additional questions be referred to the Enlarged Board of appeal under Article 112(1)(a) EPC (see page 1 of the annex to the minutes of the oral proceedings before the board).

VIII. The final requests of the respondent are thus as follows:

that the appeal be dismissed and that the patent be maintained as granted (main request);

and, in case that the board comes to the conclusion that the main request does not fulfil the requirements of Article 100(c) EPC in combination with Article 123(2) EPC

that the board refers five questions to the Enlarged Board of Appeal:

- three questions listed in the respondent's letter dated 17 June 2024, and
- two questions submitted during the oral proceedings before the board,

or, in the alternative, in case that the decision under appeal is set aside,

that the patent be maintained in amended form according to one of the sets of claims filed as auxiliary requests I to V during opposition proceedings;

or, in the alternative,

that the case be remitted to the opposition division for further prosecution regarding auxiliary requests I to V; and

that the ground of appeal of the appellant based on insufficiency of disclosure of the claimed invention (Article 100(b) EPC) not be admitted into the proceedings.

IX. The final requests of the appellant correspond to its initial requests.

- X. The order of the present decision was announced at the end of the oral proceedings and for further details of which reference is made to the minutes thereof.
- XI. The lines of arguments of the parties are dealt with in detail in the reasons for the decision.
- XII. Independent claim 1 according to the patent as granted (main request) with the feature labelling used by the parties reads as follows:

" A transfer apparatus (1) comprising:

- F1a a carrying path for an electronic component (W), the carrying path being formed between a first storage unit (5a) and a second storage unit (5b);
- F1b a holder unit (21) holding and releasing the electronic component (W) via a tip; and
- F1c N number (where $N \geq 2$) of rotary pickups (2a, 2b) including a plurality of the holder units (21) around a rotation axis of an axial frame (27), and intermittently rotating around the rotation axis by a predetermined angle so as to always direct the tip of the holder outwardly, wherein:
- F1d at least two of the rotary pickups (2a, 2b) are a first carrying structure and a second carrying structure that are parts of the carrying path;
- F1e the rotary pickup adjacent to the first carrying structure is the second carrying structure installed so as to not overlap with each other, to have the respective rotation axes orthogonal to

each other, the second carrying structure being another part of the carrying path;

- F1f the holder unit (21) of the first carrying structure and the holder unit (21) of the second carrying structure are each a sucking nozzle having an axis along a radial direction of the rotatory pickup; and
- F1g the respective tips of the holder units of the first carrying structure and the second carrying structure have a common stop position facing with each other, and the electronic component is transferred at only a transfer point (A) that is the stop position, characterized in that
- F1h the holder unit (21) is installed on an axial frame (22) via a sliding unit (24) so as to be capable of moving forward in a centrifugal direction going apart from a center of the rotary pickup, and of retracting in a centripetal direction directed toward the center;
- F1i the first carrying structure is adjacent to the second carrying structure and installed so as to not overlap with each other, to have the respective rotation axes orthogonal to each other;
- F1j at least at the transfer point (A), a control is performed to decelerate the moving-forward speed of the one holder unit (21) as coming close to the electronic component (W)."

XIII. Independent claim 1 according to auxiliary request I corresponds to claim 1 according to the main request

with the following feature introduced at the end of the claim:

"... wherein the transfer apparatus (1) further comprises an imaging optical system (45) arranged to take an image of the electronic component (W), prior to pickup from the first storage unit (5a), with an optical axis extending along a radial direction of the rotary pickup."

XIV. Independent claim 1 according to auxiliary request II corresponds to claim 1 according to auxiliary request I with the following feature introduced at the end of the claim:

"... wherein the imaging optical system (45) includes an imaging unit (45a) in form of a camera and an optical member (45b) configured to convert a direction of the optical axis so as to guide the image to the imaging unit (45a)."

XV. Independent claim 1 according to auxiliary requests III, IV and V correspond to claim 1 according to the main request, auxiliary request I and auxiliary request II respectively with the following feature introduced at the beginning of feature Flh:

"... at least one of the first rotary pickup and the second rotary pickup has a drive unit (25) for driving the holder unit (21) to move forward and retract at the common stop position,...".

Reasons for the Decision

1. *Patent as granted (main request) - Added subject-matter, Articles 100(c) and 123(2) EPC*
- 1.1 The opposition division found in point 14.2 of the reasons for the decision under appeal that feature Flh, that

"the holder unit (21) is installed on an axial frame (22) via a sliding unit (24) so as to be capable of moving forward in a centrifugal direction going apart from a center of the rotary pickup, and of retracting in a centripetal direction directed towards the center"

did not extend beyond the original disclosure.
- 1.2 The appellant argued that the opposition division erred in its finding since the original disclosure did not provide a direct and unambiguous basis for a sliding unit without its detailed structure of original paragraph [0056] comprising the slide shaft 24b, the sleeve 24a and the arm 24c.
- 1.3 The respondent argued that claim 1 as granted could be derived from original claims 1 and 2. Although the sliding unit was not explicitly disclosed in the combination of these claims, the skilled person could realize from original paragraph [0050] that the sliding unit was the structural element provided to carry out the functional definition of original claim 2. According to the respondent, the skilled person was aware of multiple types of sliding units. Furthermore, it was apparent to the skilled reader of the application as filed that the more specific details of the sliding unit were not mandatory or essential. In

particular, the skilled person would understand from original paragraphs [0049] to [0056] that first, in paragraph [0050], a general description of the rotary pickups and the elements (including the sliding unit) were given, wherein exemplary additional details were provided in the following paragraphs. In the particular case of the sliding unit, paragraph [0056] gave additional details such as the slide shaft 24b, the sleeve 24a and the arm 24c, which were not indispensable for providing the movement functionality of the holder unit of original claim 2. The respondent further concurred with the finding of the opposition division that the the feature of the sliding unit was not extracted from a group of several features at the same level, and that the overarching mechanism (*i.e.* the sliding unit) on a higher level did not have any specific structural or functional relationship with the details (*i.e.* the sleeve, the slide shaft and the arm) on a lower level. In sum, by omitting the features of the sliding unit detailed in paragraph [0056] of the original description, the skilled person was not presented with new technical information.

- 1.4 The board disagrees for the following reasons. It is established jurisprudence of the Boards of Appeal that the question to be considered in assessing the allowability of an amendment in view of the requirements of Article 123(2) or Article 100(c) EPC is what a skilled person would have derived directly and unambiguously, using common general knowledge from the description, claims and drawings of a European patent application and seen objectively and relative to the date of filing (see Case Law of the Boards of Appeal [CLB], 10th edition 2022, II.E.1.3.1), referring to this test as "**gold standard**").

- 1.4.1 As correctly argued by the appellant, the board sees that paragraphs [0049] to [0056] relate to one and the same embodiment with only one way of carrying out the functional movement of the holder unit via a sliding unit, the sliding unit comprising a slide shaft, a sleeve and an arm. Contrary to the respondent's allegation, the board does not see that the skilled reader would directly and unambiguously understand that the features of paragraph [0056] are on a lower level. On the contrary, the board is of the view that the skilled reader would derive from paragraphs [0049] to [0056] a detailed description of the "rotary pickup", which is to be considered as a whole. It follows that the only realisation of the movement of the holder unit via a sliding unit that can be directly and unambiguously derivable for the skilled person in view of the original disclosure is with sliding units with the structural features of paragraph [0056].
- 1.4.2 In sum, the board concludes that the introduction of the feature "sliding unit" in combination with the omission of its structural features such as the sleeve, the slide shaft and the arm, results in a new technical teaching, namely providing the functional movement of the holder unit **via sliding units** with different structural features, which are possible as acknowledged by the respondent, than the ones that are necessary to carry out the sole originally disclosed embodiment of realising the claimed movement of the holder unit via a sliding unit.
- 1.5 The respondent further argued that the alleged intermediate generalisation in claim 1 as granted met the criteria established by case law as explained in the CLB, *supra*, II-E.1.9 and in section H-V, 3.2.1 of the "Guidelines for Examination". As such, claim 1 as

granted would meet the requirements of Article 123(2) EPC. In particular, the respondent was not aware of a situation in which the above criteria were met but the requirements of Article 123(2) were not fulfilled.

- 1.5.1 The board is however of the view that there is no necessity in the present case to apply any additional test to assess the compliance of Article 123(2) EPC, since, as it has already been established in point 1.4 above, the result after applying the "gold standard" is that the subject-matter of claim 1 of the patent as granted extends beyond the original disclosure (see also point 2.2 below with reference to the request for referral of question to the Enlarged Board of appeal).

For the sake of completeness the board also notes that even in the part of the Guidelines for Examination cited by the respondent the criteria are explicitly referred to an aid and that "*[I]n any case it has to be ensured that the skilled person is not presented with information which is not directly and unambiguously derivable from the originally filed application, even when account is taken of matter which is implicit to a person skilled in the art using the common general knowledge*".

- 1.6 In consequence, the board concludes that the subject-matter of claim 1 as granted does not meet the requirements of Article 123(2) EPC.
2. *Request of the respondent for referral of questions to the Enlarged Board of Appeal, Article 112(1)(a) EPC*
- 2.1 The respondent requested with letter dated 17 June 2024 (see point 1.4) that, in the case that the board considered a presentation of the "other features" as

being facultative would be necessary for the finding of compliance with Article 123(2) EPC and/or that the coverage of sliding units with undisclosed structural features would be relevant for the assessment of compliance with Article 123(2) EPC, the following questions be referred to the Enlarged Board of Appeal:

"Q1: In case of a disclosure of a feature of a general nature (e.g. a sliding unit) together with further explanations of more specific details of such feature (e.g. the sliding unit comprising a sleeve, a slide shaft and an arm), and where only the general feature is introduced in a claim without the further details, is it necessary for compliance with Art. 123(2) EPC that the details are explicitly presented as being optional or facultative?"

Q2: In order for it to be established -in regard to an intermediate generalization- that a "feature is not related or inextricably linked to the other features of the embodiment" (cf. inter alia T 714/00, T 2154/11, T 2287/11, T 775/17, as also reflected, for example, in section H-V, 3.2.1 of the Guidelines for Examination), is it necessary that the original disclosure includes an explicit indication to such end?"

Q3: To what extent, if at all, is the fact that a claim amended by introduction of a feature (e.g. a functionally defined unit) isolated from other features (e.g. structural details or elements of the unit) of a common embodiment in the course of an intermediate generalization then covers also embodiments with structural features (within the framework of the isolated feature) different from

those disclosed in the embodiment of relevance for the assessment of compliance with Art. 123(2) EPC?"

2.1.1 The board notes that the referral of these questions has been requested under the condition that the board considered that it would be necessary that the "other features" be presented as facultative find compliance of Article 123(2) EPC and/or that the coverage of sliding units with undisclosed structural features would be relevant for the assessment of compliance with Article 123(2) EPC. However, the board rather based its findings on different reasons (see point 1.4.2 above), namely that the omitted features resulted in new technical teaching since they were necessary to carry out the sole embodiment of the invention consisting in realising the claimed movement of the holder unit via a sliding unit. Since the above conditions are not given, the board does not see a necessity for referring questions Q1 to Q3.

2.2 During the oral proceedings before the board, the respondent further requested that the following questions be referred to the Enlarged Board of Appeal:

"Q4: In case of an intermediate generalization, is the proper way to assess compliance with the "gold standard" to use the criteria established by case law (as explained in section II-E, 1.9 of the "Case law" and section H-V, 3.2.1 of the "Guidelines for Examination")?"

Q5: If the criteria for an allowable intermediate generalization are met, which considerations may further apply in order to ensure compliance with the "gold standard"?"

- 2.2.1 The respondent argued that according to the established Case Law of the Boards of Appeal, the application of the criteria of section H-V, 3.2.1 of the Guidelines for Examination delivered identical results to those when applying the "gold standard". There was to the knowledge of the respondent no single case given in which these criteria were fulfilled and the requirements of Article 123(2) EPC were not met. The respondent referred *inter alia* to the CLB, *supra*, II.E.1.9 and to decision T 1762/21. In view of the above, the respondent was of the view that a point of law of fundamental importance was present so that a referral of the questions Q4 and Q5 was justified in order to ensure uniform application of the law.
- 2.2.2 The board is not persuaded by the arguments of the respondent for the following reasons. It is also established case law that the ultimate standard for assessing compliance with the requirements of Article 123(2) EPC in the case of an intermediate generalisation is the "gold standard" (see CLB, *supra*, II.E.1.9.1 with reference to decisions T 1471/10, T 2392/10 and T 1791/12). The various tests developed for different cases of amendments, including the one related to intermediate generalisations, may assist in determining the allowability of an amendment but do not take the place of the "gold standard" and should not lead to a different result (see CLB, *supra*, II.E.1.3.1).
- 2.2.3 This view is also reflected in the Guidelines for Examination as put forward under point 1.5.1 above. In particular, the board is of the view that the criteria of section H-V, 3.2.1 of the Guidelines for Examination are to be seen as ***condiciones sine quibus non***, which

means that fulfilment of these criteria is a **necessary** requirement **but not a sufficient** one for the compliance of Article 123(2) EPC.

- 2.2.4 In view of the above established case law, the board was in a position to decide on the objection of added subject-matter in the present case and, by the same token, to answer question Q4. While the use of the *"criteria established by case law (as explained in section II-E, 1.9 of the "Case law" and section H-V, 3.2.1 of the "Guidelines for Examination"* might be appropriate in some specific cases to assess compliance with the "gold standard" as an assisting aid, the board is convinced that the assessment of the "gold standard" should be carried out on its own, whenever possible, irrespective of the assisting tests. This is what the board was able to do in the present case, see section 1.4 above.
- 2.2.5 Therefore, the use of the above-mentioned criteria cannot be regarded as "the proper way" to assess compliance of the "gold standard". The proper way is rather to assess what a skilled person would have derived directly and unambiguously from the original patent application, using common general knowledge and seen objectively and relative to the date of filing.
- 2.2.6 Since the board is able to answer question Q4, a referral of this question is not seen as necessary. Furthermore, as the question Q4 is answered in the negative, the board understands that question Q5 is no longer relevant.
- 2.3 In view of the above, the board refuses the respondent's request to refer questions Q1 to Q5 to the Enlarged Board of Appeal.

3. *Auxiliary requests I to V; requests for remittal*

3.1 The deficiency as regards Article 123(2) EPC of claim 1 of the main request with respect to feature Flh applies for the same reasons to claim 1 of auxiliary requests I to V. This has not been further disputed by the respondent. In consequence, the board concludes that none of auxiliary requests I to V meets the requirements of Article 123(2) EPC.

3.2 In this light, a remittal of the case to the opposition division for further prosecution of the auxiliary requests, which are not allowable under Article 123(2) EPC, is not appropriate.

4. *Conclusions*

4.1 In view of the above considerations, the board finds that the arguments presented by the appellant demonstrate the incorrectness of the decision under appeal as regards added subject-matter of the patent as granted. The findings of the opposition division that the patent as granted meets the requirements of Article 123(2) EPC and that the ground for opposition under Article 100(c) EPC does not prejudice the maintenance of the patent as granted cannot be upheld by the board. In addition, auxiliary requests I to V do not overcome this deficiency.

4.2 Consequently, the decision under appeal is to be set aside. Since the patent cannot be maintained as granted and in the absence of any other set of claims on the basis of which the patent could be maintained, the patent is to be revoked.

Order

For these reasons it is decided that:

1. The request of the respondent for a referral of questions to the Enlarged Board of Appeal is refused.
2. The decision under appeal is set aside.
3. The patent is revoked

The Registrar:

The Chairman:



G. Nachtigall

G. Patton

Decision electronically authenticated