

**Internal distribution code:**

- (A) ☐ Publication in OJ
- (B) ☐ To Chairmen and Members
- (C) ☐ To Chairmen
- (D) ☒ No distribution

**Datasheet for the decision  
of 8 August 2025**

**Case Number:** R 0012/23

**Appeal Number:** T 0435/21 - 3.2.05

**Application Number:** 16199493.4

**Publication Number:** 3156214

**IPC:** B29C65/14, B29C65/20, E06B3/96,  
B29K27/06, B29L31/10

**Language of the proceedings:** EN

**Title of the invention:**  
DEVICE FOR WELDING PROFILED ELEMENTS IN PLASTIC MATERIAL, IN  
PARTICULAR PVC

**Patent Proprietor:**  
Graf Synergy S.r.L.

**Opponents:**  
Urban GmbH & Co. Maschinenbau KG  
Kaban Makina San.ve Tic. Ltd. Sti.

**Headword:**  
Petition for review

**Relevant legal provisions:**  
EPC Art. 112a(2)(c), 112a(2)(d), 113(1)  
EPC R. 102(g), 111(2)

**Keyword:**  
Petition allowable (no), no violation of petitioner's right to  
be heard

**Decisions cited:**  
G 0002/10, G 0001/16, R 0002/14, R 0008/15

**Catchword:**

When the EPO refuses a request, there is no need to base the refusal on multiple **legal** grounds for refusal that were the subject of the proceedings, as long as the party adversely affected has been heard on all of these grounds.

If a request is refused and multiple **factual** approaches have been relied on by the requester to support a certain legal conclusion, then all those approaches must be assessed (affirming R 2/14, points 10 and 11).



**Große Beschwerdekammer  
Enlarged Board of Appeal  
Grande Chambre de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0

**Case Number:** R 0012/23

**D E C I S I O N  
of the Enlarged Board of Appeal  
of 8 August 2025**

**Petitioner:** Graf Synergy S.r.L.  
(Patent Proprietor) Via Galilei, 38  
41015 Nonantola (MO) (IT)

**Representative:** Hoffmann Eitle  
Patent- und Rechtsanwälte PartmbB  
Arabellastraße 30  
81925 München (DE)

**Other party:** Urban GmbH & Co. Maschinenbau KG  
(Opponent 1) Dornierstrasse 5  
87700 Memmingen (DE)

**Representative:** Patentanwälte Olbricht, Buchhold,  
Keulertz Partnerschaft mbB  
Hallhof 6-7  
87700 Memmingen (DE)

**Other party:** Kaban Makina San.ve Tic. Ltd. Sti.  
(Opponent 2) Hadimköy Atatürk Sanayi Bölgesi  
Ömerli Mahallesi 75. Yıl Caddesi  
Uzuncayir Sokak No. 12 P.K.  
34555 Arnavutköy - Istanbul (TR)

**Representative:** Herrmann, Jochen  
Herrmann Patentanwälte  
Königstrasse 30  
70173 Stuttgart (DE)

**Decision under review:** Decision T 0435/21 of the Technical Board of Appeal 3.2.05 of the European Patent Office of 17 March 2023.

**Composition of the Board:**

**Chairman:** I. Beckedorf  
**Members:** B. Müller  
W. Chandler

## Summary of Facts and Submissions

### I. The subject of the petition

The patent proprietor's petition for review filed on 16 August 2023 is directed against the decision of Technical Board of Appeal 3.2.05 (hereinafter: "the Board") in appeal case T 435/21. By that decision, the Board dismissed the patent proprietor's appeal against the decision of the opposition division revoking European patent number 3 156 214. The decision was pronounced in the oral proceedings of 17 March 2023 and the reasoned written decision was posted on 16 June 2023.

The title of the invention is: Device for welding profiled elements in plastic material, in particular PVC.

Editorial note: the narrow spaced-text portions below are all quotations; emphasis added by the Enlarged Board of Appeal (hereinafter also: "the EBA") unless otherwise indicated.

As to the proceedings before the Board, the petitioner set out in the introduction to its petition (in point 1):

The patent at issue was revoked for reasons of added subject-matter under Art. 100(c) EPC, in particular that the subject-matter of its claim 1 extended beyond the content of the earlier application as filed (Art. 76(1) EPC). The discussion and decision in the first instance was based on the "essentiality test", while the oral proceedings on appeal **revolved around the question which test to apply**, the "essentiality test" or the "gold standard", leading to the impugned Decision which concluded in favour of added matter.

The petition for review is based on:

- Article 112a(2)(c) EPC in conjunction with Article 113(1) EPC and
- Article 112a(2)(d) EPC in conjunction with Rule 111(2) EPC.

### II. The decision under review

The Board held that Article 76(1) EPC was not complied with due to the missing feature relating to a "containing presser". The relevant passages of the reasons are set out below.

Point 1.1 reads:

The patent under dispute derives from a divisional application of European patent application No. 13720049.9 (earlier application)... (**document D1**).

...the opposition division found that the **absence** of the feature "the device comprising ... at least one **containing presser** (27) ..." from claim 1 as granted extended the subject-matter beyond the content of the earlier application as filed (see document D1) and that the ground for opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted. This view is shared by the respondents but contested by the appellant.

**[Definition of the "gold standard"]**

To examine whether the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted, the **board applies** the same "**gold standard**" developed for examining compliance with Article 123(2) EPC ... According to the gold standard, any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the prohibition on extension laid down in Article 123(2) EPC, and can therefore, irrespective of the context of the amendment, only be made within the limits of what a person skilled in the art would derive **directly and unambiguously**, using common general knowledge and seen objectively and relative to the filing date, **from the whole of the documents of the application** as filed (see decision G 1/16 ... point 18 ...).

In the following point 1.2 the Board discussed the appellant's submissions that:

- Figure 5 of document D1 did not show a containing presser,
- the appellant inferred from page 7, lines 8 and 9 of document D1 that the containing presser was only optional,
- the passages on **page 4, lines 3 to 11** and page 18, lines 27 to 31 of document D1, suggested that a containing presser was not needed.

In the final paragraph of point 1.2 the Board said that it

... does not share the appellant's view that the containing presser 27 was only described as being optional in document D1. In all the embodiments and independent claims of document D1, the device for welding profiled elements also comprises a containing presser. Conversely, document D1 does not disclose a device for welding profiled elements, as defined in claim 1 as granted, that does not comprise a containing presser.

In point 1.3, first paragraph, the Board went on to discuss the appellant's submission that document D1 disclosed **two inventions**. The Board said:

The appellant submits that ... [t]he **first invention** aimed to overcome the drawbacks of the prior art and to eliminate subsequent additional operations necessary for removing the welding bead. This objective was achieved, in particular, by creating a **groove** in correspondence to at least one zone to be welded of the profiled elements by means of a removal operation such as milling. The **second invention** aimed to avoid a situation in which there was too much molten material filling the groove, for example, when the force pressing the two profiled elements together was very high. This posed the risk of the groove

overflowing. To avoid this risk, document D1 proposed a **containing presser** 27 suitable for abutting on the grooves 19.

In scrutinising this submission the Board assessed the operation of the **containing presser** and found a **functional relationship** between the containing presser and another feature. The Board also examined and found a need for **replacement means** for the missing **containing presser**. The Board then concluded in the following final paragraph of point 1.3:

The skilled person, using their common general knowledge, **thus** would not have **unambiguously and directly derived** the subject-matter of claim 1 as granted from the earlier application (see document D1).

It was in the following point 1.4 that the board expressly addressed the “essentiality test”:

... according to the case law of the boards of appeal, this test is **no longer considered appropriate** for assessing **compliance with the gold standard** (see "Case Law" [of the EPO Boards of Appeal, 10th edition 2022], II.E.1.4.4 c)); however, even if the "essentiality test" is applied, the removal of the above feature [containing presser] fails to pass this test. **For the reasons set out above**, the definition of the containing presser is **indispensable** for the **function** of the invention in the light of the technical problem it serves to solve, and its **removal** requires other features to be modified to compensate for the change.

III. The petition: observations on the duty to raise an objection under Rule 106 EPC  
(point 2)

The objection could not have been raised earlier because the petitioner became aware of the procedural defect only after notification of the written decision.

The Board indicated that it had used the “gold standard” for assessing the question of added matter (in points 1.1 and 1.3 of the decision). The petitioner had invoked the “essentiality test”. The Board had failed to indicate to the petitioner how it intended to apply the “gold standard”. In particular, the Board had not indicated that it would not examine if the skilled person were presented with new technical information due to the amendment, as required by decision G 2/10. Consequently, the Board had failed to give the petitioner the opportunity to argue why the subject-matter of claim 1 of the main request (patent as granted) was indeed directly and unambiguously derivable.

Further, the Board had given no indication in the oral proceedings of its intended deviation from the “gold standard” and gave the petitioner no opportunity to argue on the basis of the standard actually applied.

#### IV. The petition: facts and grounds (point 3)

##### 3.1 First procedural defect: violation of the right to be heard (Article 112a(2)(c) EPC in conjunction with Article 113(1) EPC)

The Board mentioned in the oral proceedings that the “essentiality test” was “overcome” and replaced by the “gold standard” of G 2/10. But it failed to give the petitioner the occasion to argue why, under such “gold standard”, the subject-matter of claim 1 of the main request (patent as granted) was indeed directly and unambiguously derivable.

The decision in point 1.3 and the preliminary opinion in point 6.1 (identical content as the decision) mentioned the “gold standard”, but went on to analyse the amended patent using the “three-point”, or “essentiality”, test. In point 1.3 (dealing with the question of the presence of two inventions) on page 14 of the decision the Board concluded that “there is a **functional relationship** between the removal means 18 for making the groove ... and the containing presser 27 ...”. Similarly, a functional relationship was found in point 6.1 of the preliminary opinion. Furthermore, the Board also assessed the requirement of a **replacement feature** (in point 1.3, page 15; preliminary opinion, point 6.1, page 10).

The petitioner concludes:

In other words, the Board applied the three-point test by dealing with the question of the omitted feature being **indispensable**, its **functional relationship** to other features and the **need** for **substitute** features while examining compliance with the “Gold Standard”! This discussion was identically held in Oral Proceedings.

In the petitioner’s view, this amounts to a violation of its right to be heard based on the case law of the EBA in certain decisions on Article 112a EPC, in particular R 16/13 and R 2/14 of 22 April 2016, both allowing the petition.

In R 16/13, the Enlarged Board stated that the right to be heard was violated when a board gave *ex officio* reasons in its decision without having given the party adversely affected an opportunity to comment on these reasons or to submit new requests.

In R 2/14 the Enlarged Board set the decision under review aside. The Board had discussed only one of three alternative argumentative approaches (the EBA adds: to establishing sufficiency of disclosure of the claimed invention) advanced by the petitioner and rejected it. The Board had not discussed the other two approaches. It had merely referred to them as suffering from the same negative conclusion.



In both cases, the EBA allowed the petition because the petitioner could not infer the board's reasoning and, hence, had no opportunity to counter them.

This situation was analogous to the present case in which the petitioner was not given the opportunity to provide its arguments as to the standard for assessing added matter actually applied by the Board which was not based on the approach laid down in G 2/10. The Board had rather given its decision without specific reasons **as to why the “essentiality test” would not be “applicable”**, and without asking if the skilled person was presented with new information.

Furthermore, the EBA in R 2/14 held that:

The right to be heard according to Article 113(1) EPC is an important procedural right to ensure that no party is caught unaware[s] by grounds and evidence in a decision turning down his request on which a party has not had the opportunity to comment ... This requirement includes the party's right to have the relevant submissions and arguments fully taken into account in the written decision in a manner that enables it to understand, on a reasonable basis, the reason of the decision. ... (emphasis omitted)

In the present case, the right to be heard had been violated. The Board **disregarded the arguments raised by the petitioner under the “essentiality test” on the assumption that this test was no longer considered appropriate for assessing compliance with the “gold standard”**. Therefore, the Board did not examine it in detail and gave no specific reason as to why the arguments put forward by the petitioner in relation to the “essentiality test” **would not provide support for claim 1** as granted.

However, had the Board asked, as mandated by G 2/10, if the skilled reader was presented with new information, the answer to this question would have been “no”; the skilled reader would have identified two inventions, and hence in particular one in which no containing presser was required (see, e.g., point VI. of the decision).

### 3.2 Second procedural defect: violation of the right to a reasoned decision (Article 112a(2)(d) EPC in conjunction with Rule 111(2) EPC) (point 3.2 of the petition)

The Board did not take into specific account in the written decision the relevant grounds of the objections raised by the petitioner under the “essentiality test”, in particular why it “would not be **applicable**, i.e. lead to a **conclusion in coherence with Article 123(2) EPC**”. The Board also did not provide proper reasoning under the “gold standard”.

As already mentioned in the context of the asserted violation of Article 113(1) EPC, the Board examined the three points of the “essentiality test” when actually it should have focussed on what information was presented to the skilled person by the amendment if they were indeed to follow the “gold standard” (see G 2/10). That this had not happened, neither in oral proceedings nor in the written decision, was not only a violation of Article 113 EPC but also of Rule 111(2) EPC.

In this context, the petitioner drew the attention to T 70/02 which required that the boards provided “at least some motivation on crucial points of dispute in the line of argumentation”, in the present case added matter under the “gold standard”. In the decision, the Board failed to provide it.

Further, it was the prevailing view in the case law that the requirement of sufficient reasoning as set out under chapter III.K.3.4.3 (of the “Case Law”) applied. The petitioner continued verbatim:

E.g., the important issues need to be discussed, and all decisive considerations in respect of the factual and legal basis must be discussed in detail (see e.g. **T 740/93**; **T 1709/06**; **T 2352/13**; **T 278/00**, and **T 1182/05**). The decision needs to “contain the logical chain of reasoning which led to the relevant conclusion” (**T 292/90**). (emphasis in the original)

In the present case, since the Board did not provide reasons which reflected the proper legal basis for assessment of Article 123(2) EPC, i.e. the “gold standard” as mandated by G 2/10, but rather reasons which reflected, as the Board itself stated, a test “no longer considered appropriate”, the right to a reasoned decision under Rule 111(2) EPC was violated.

#### V. The EBA’s communication setting out its preliminary opinion on the petition

In a communication pursuant to Article 13 RPEBA (hereinafter: “the communication”), the EBA gave a preliminary opinion on the petition arriving at the conclusion that it was obviously unfounded.

In assessing the first procedural defect: violation of the right to be heard (Article 112a(2)(c) EPC in conjunction with Article 113(1) EPC), the EBA (in point B.2.1.1), identified three asserted procedural deficiencies according to which the Board:

- (i) gave the petitioner no indication of its intended deviation from the “gold standard” in not applying the “new-technical-information criterion” of G 2/10,
- (ii) gave no specific reasons as to why the “essentiality test” “would not be applicable” (page 5, third paragraph),
- (iii) disregarded the arguments under the “essentiality test”.

The EBA addressed these deficiencies (in point B.2.1.2) in the order (ii), (iii) and (i).

#### VI. The petitioner’s response to the preliminary opinion

With a letter in response to the EBA’s communication setting out its preliminary opinion (hereinafter: “the response”) the petitioner sought to clarify its petition regarding the first procedural defect: violation of the right to be heard (Article 112a(2)(c) EPC in conjunction with Article 113(1) EPC)

##### 1. On point (ii) of the EBA’s preliminary opinion

The petitioner said that it did not complain about the “lack of application” of the “essentiality test”, but the lack of taking into consideration the arguments, set out by the proprietor/petitioner in the written and oral proceedings, **also** under the “new-information approach” as methodology for applying the “gold standard”. The Board, in the impugned decision, did not provide reasons why it did use the “essentiality test” rather than the professed “new-technical-information test” when dealing with the proprietor/petitioner’s arguments.

The EBA repeats that the petitioner, in the petition, objected that the Board had given its decision without specific reasons as to why the “essentiality test” would not be **“applicable”** (see point IV.1, fourth but last paragraph, above). The Board disregarded the arguments raised by the petitioner under the “essentiality test” and did not examine it in detail and gave no specific reason as to why the arguments put forward by the petitioner in relation to the “essentiality test” would not provide support for claim 1 as granted (*idem*, second but last paragraph), (in other words apparently) why it “would not be **applicable**, i.e. lead to a conclusion in coherence with Article 123(2) EPC” (see point IV.2, first paragraph, above).

## 2. On point (iii) of the EBA's preliminary opinion

The Board in point 1.1 declared that it would apply the “gold standard”. However, contrary to such declaration, it actually did not examine the presence of added subject-matter relying on the accepted methodology of this standard, i.e. examine if the subject-matter of claim 1 as granted presented the skilled person with new information with respect to the parent application as filed. In doing so, it also did not consider the arguments in the grounds of appeal in support of claim 1 as granted under Article 76(1) EPC; see section 3.1 of the grounds.

The EBA notes that the contents of section 3.1 are summarised at its beginning as follows:

i) As we shall show in our analysis below, the fact that the originally filed independent claims 1 and 20 of the parent application D1 contained, in their characterizing portion, the feature of the “containing presser” is, at most, circumstantial evidence that per se cannot be used to infer the essentiality of the feature. Rather, such evaluation has to be based always on the entire content of the original application (here parent application) as filed taken in context by the skilled person.

ii) Also, in arguing that the parent application D1 includes ... “the presence and the use of the containing presser” in all process and device claims and in all embodiments so that its absence would have the consequence of not achieving the technical effect stated, is a too narrow look at the disclosure which in contrast would be recognized by the skilled person as providing a solution in which the **creation of the groove is sufficient to solve the technical problem** of preventing excess material coming out of the joint.

iii) Finally, in the case at hand it is not necessary to provide replacement features or modification of features to compensate for the lack of the containing presser in claim 1 because the skilled person can easily choose the correct process parameters from his knowledge of joining plastic profiles in general, and consequently adapt them so that the technical effect is achieved by claim 1 as granted.

...

The petitioner's response goes on to state:

... at **point 1.2** of the Decision the Technical Board focuses on the disclosure of the embodiments and claims of the parent application as filed (see last paragraph of point 1.2 on page 13 of the Decision), considering that the more generic disclosure on page 4, lines 3 to 11,

“...relate[s] to embodiments involving the presence (and use) of a containing presser. These passages do not provide support for a device for welding profiled elements that does not comprise a containing presser.”

However, the point of the Proprietor/Petitioner's argument on appeal was that the original parent application disclosed **two inventions** (see sections 3.1.3 and 3.1.4 on pages 9 to 12 of the GoA). This aspect has been dealt with by the Technical Board not by establishing if new information is provided to the skilled person, as required under the “Gold Standard”, but by pursuing, already at **point 1.3** of the Decision, the essentiality test. ...

The petitioner then continues to argue that, in dealing with the issue of two inventions the Board

assesses the functional relationship and the requirement of replacement features, i.e. **applies the essentiality test**. It hence deals with the Proprietor/Petitioner's arguments exclusively under a perspective that it itself considers overcome by G 2/10 and G 1/16. When discussing *expressis verbis*, in **point 1.4** on pages 15 and 16 of the Decision, that the essentiality test is no longer applicable, the Technical Board refers to its reasons at point 1.3 (our emphasis):

"...however, even if the "essentiality test" is applied, the removal of the above feature fails to pass this test. For the reasons set out above, the definition of the containing presser is indispensable for the function of the invention in the light of the technical problem it serves to solve, and its removal requires other features to be modified to compensate for the change."

Since the Proprietor/Petitioner only learned from the Decision that the Technical Board has actually not applied the "new-technical information criterion" as mandated under G2/10 but used the overcome "essentiality test" in dealing with the question of two originally disclosed inventions, we respectfully submit that the Technical Board – by **focusing in the Oral Proceedings on the "essentiality test"** in respect of the Proprietor/Petitioner's arguments — did not give the Proprietor/Petitioner the opportunity to show why his arguments (admittedly first presented under cover of the "essentiality test") would not be convincing under the **"Gold Standard"**.

### 3. On point (i) of the EBA's preliminary opinion

In the petitioner's view, it also follows from the above that, by focusing on the rebutting of the petitioner's arguments based on the **"essentiality test"**, the Board effectively denied the possibility of discussing them under the **"new-technical information criterion"**. It contends that

... a skilled person reading the original parent application with a mind willing to understand would have found evidence in such application, at page 4, lines 3 to 11, that there was indeed disclosed an embodiment in which the technical effects were said to be achieved by a removal operation which forms a groove on the peripheral edge of the profile, and hence without the need for a containing presser. ... this text passage states the technical effect on which the invention relies, namely of *"containing a welding bead produced during the melting of the respective profiled elements 3,"* purely in terms of the groove(s) made *"by means of a removal operation..."*, without relying on the containing presser. That is, such solution without the containing presser is no new technical information.

Hence, the petitioner submits that even considering that the claims and the described embodiments of the original parent application disclose a containing presser, the overall disclosure is not limited thereby and gives the skilled person reason to derive, directly and unambiguously, the subject-matter of claim 1 as granted.

#### 4. On the significance of R 2/14

The petitioner submits that the oral proceedings on appeal revolved around the question which test to apply. This did not mean, however, that actually both tests were applied. Rather, the board did not deal with the petitioner's arguments in the light of G 2/10. The petitioner went on to say:

This means that although the board professed using the "gold standard", it did not apply it to the parts of the disclosure (inter alia page 4, lines 3-11, see above) that the Proprietor/Petitioner has used in his line of argument under cover of the "essentiality test". The Proprietor/Petitioner may have been wrong to use this test. But so was the Technical Board when rejecting our arguments on the basis of the "essentiality test" (points 1.3 and 1.4 of the Decision), whereas it should have analyzed the mentioned disclosure and the Proprietor/Petitioner's argument under the "Gold Standard".

As a consequence, in the petitioner's view, the case in hand is "analogous to the situation in R 2/14". The EBA recalls that, in R 2/14, it was found that the Board, in the decision under review, had discussed only one of three alternative approaches to establishing sufficiency of disclosure of the claimed invention (see above, point III.1).

#### VII. Requests

The petitioner requests that:

- the decision under review be set aside and that appeal proceedings be re-opened;
- in the event that the proceedings are re-opened, that they be entrusted to another Board of Appeal;
- the fee for the petition be reimbursed.

## Reasons for the Decision

### 1. Procedural aspects

The case is ready for decision which is taken in written proceedings without holding oral proceedings. In the absence of a petitioner's request for oral proceedings, the Enlarged Board of Appeal does not consider oral proceedings to be expedient (Article 116(1) EPC). The principle of the right to be heard pursuant to Article 113(1) EPC is observed since the petitioner's submissions are fully taken into account.

### 2. Admissibility of the petition for review

Pursuant to Rule 126(2) EPC (in the version in force until 31 October 2023), the decision that was posted on 16 June 2023 is deemed to have been notified on 26 June 2023. The petition for review based on 112a(2)(c), (d) EPC, together with the respective fee, was received on 16 August 2023. This was in time: see Article 112a(4), second sentence, EPC requiring the petition to be filed within two months of notification of the decision to be reviewed.

Considering that the petition for review is obviously without merit, it can remain an open question whether the petitioner has complied with Rule 106 EPC and how the remaining admissibility requirements would have to be assessed.

### 3. Merits of the petition for review

#### *3.1 The second ground: violation of the right to a reasoned decision (Article 112a(2)(d) EPC in conjunction with Rule 111(2) EPC)*

As to this procedural defect (raised in point 3.2 of the petition; see point IV.3.2 above), the EBA notes, first, that a board's duty to provide reasons for a decision is not dealt with in R 111(2) EPC covering only decisions open to appeal, i.e. decisions of certain departments of first instance. Rather, Rule 102(g) EPC entitled "Form of decision of the Board of Appeal" applies. It provides that:

The decision [of a Board of Appeal] shall contain:

...

(g) the reasons;

...

Second, any violation of Rule 102(g) EPC would not be covered by the provisions of Article 112a(2)(d) EPC. The grounds for a petition for review have been exhaustively defined in Article 112a(2) EPC in conjunction with Rule 104 EPC.

Article 112a(2)(d) EPC is not a catch all clause for procedural defects. It merely empowers the legislature to define defects in the Implementing Regulations in addition to the defects mentioned in Article 112a EPC. Rule 104 EPC exhaustively defines exactly two defects; a violation of Rule 102 EPC is not among them. See the extensive discussion in R 12/22, points II.2.2.

Against this backdrop, the petition, as far as the EBA deems it to be based on Article 112a(2)(d) in conjunction with the “right to a reasoned decision” pursuant to 102(g) instead of Rule 111(2) EPC, is obviously unfounded.

Third, the submissions made in respect of this right (under point 3.2) will instead be considered as an assertion of violations of the right to be heard. The petitioner asserts that two strands of a procedural defect are present:

- (i) the Board did not take into specific account in the written decision the relevant grounds of the objections raised by the petitioner under the “essentiality test”, in particular why it would not be “applicable”, i.e. lead to a conclusion in coherence with Article 123(2) EPC.
- (ii) The Board did also not provide proper reasoning under the “gold standard”.



### 3.2 The first ground: violation of the right to be heard (Article 112a(2)(c) EPC in conjunction *with Article 113(1) EPC*)

#### 3.2.1 Preliminary remarks

The relevant basic legal provision in the EPC is Article 113(1) EPC entitled “Right to be heard and basis of decisions”. Its paragraph 1 dealing with the first of these two topics reads:

The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

The principle of the EBA's case law on the review of substantive law under Article 112a EPC is set out in the "Case Law ") under the heading: "[V.B.]3.4.3 No suspensory effect - review of substantive law excluded". It reads in pertinent part:

Under no circumstances may the petition for review be a means to review the application of substantive law. ... The Enlarged Board has no competence under Art. 112a EPC to examine the merits of the decision and to go into the substance of a case ... It is not the purpose of petition for review proceedings to evaluate whether or not the reasons selected by the board are appropriate ... ; the Enlarged Board cannot replace a board's substantive assessment with its own ... The Enlarged Board cannot act as a third instance or second-tier appellate tribunal in petition proceedings ...

#### 3.2.2 The EBA's understanding of the asserted procedural deficiencies under the ground of Article 112a(2)(c) EPC

##### *The petition*

In the petition the patent proprietor asserted that:

##### - during the **oral proceedings**

it was denied the right to argue on the basis of

- the “gold standard” (points A.III and IV.3.1 above),
- the standard actually applied which deviated from the “gold standard” (point III above), i.e. the “essentiality test” (see the following paragraph),

##### - in the **decision**

-- the Board purported to apply the “gold standard”, but in reality **used the “essentiality test” without** the petitioner having been given the **opportunity to comment on the “gold**

**standard”** (no specific reasons given why the “essentiality test” would not be “applicable”, “i.e. lead to a conclusion in coherence with Article 123(2) EPC”; new-technical-information criterion of “gold standard” not applied) (points IV.3.1, in particular fourth but last paragraph, and IV.3.2 last paragraph)

-- the Board applied the “essentiality test” (IV.3.1, second paragraph), but disregarded the petitioner’s arguments on the “essentiality test” (IV.3.1, second but last paragraph and IV.3.2, first paragraph); therefore the board carried out no examination why the “essentiality test” would not provide support for claim 1 as granted (point IV.3.1, second but last paragraph).

#### *The response to the EBA’s communication*

Answering the EBA’s communication, the petitioner stated that it complained

- about the Board not taking into account the petitioner’s arguments under the “gold standard”, not about the board not applying the “essentiality test”, but (VI.1 above), but
- that the Board gave no reasons why it applied the “essentiality test” rather than the “gold standard” (VI.1)
- the Board did not apply the accepted methodology and not consider the petitioner’s arguments on the “gold standard”, but applied the “essentiality test” (VI.2 and VI.3)
- in line with G 2/14 the Board should have analysed the petitioner’s argument on the “gold standard”, not under the “essentiality test” (VI.4)

#### *The EBA’s analysis of the procedural deficiencies asserted*

The EBA considers that the asserted deficiencies summarised above are not fully clear and may be contradictory in part. In the following the EBA will address all the deficiencies that can possibly be derived from these submissions even if some of them may not have been the subject of the petitioner’s complaints, or have been dropped after the intended clarification in the response. This is a precaution to fully safeguard the petitioner’s right to be heard in the present proceedings. In so acting, the EBA considers the appointment of oral proceedings not to be necessary. The petitioner has not requested them.

In view of the petition and the petitioner’s response seeking to clarify its petition, the EBA considers that the petitioner asserts the following three procedural deficiencies regarding the ground for petition mentioned in Article 109(2)(c) in conjunction with Article 113(1) EPC.

These three deficiencies are:

- (i) the petitioner had no opportunity during the **oral proceedings** to argue on the **standard** the Board **applied** in the **written decision** (see section 3.2.3 below)
- (ii) the Board neglected the “**gold standard**” as one of two alternative approaches (see section 3.2.4 below)
  - in the **decision**, the Board applied only the “essentiality test” and not also the “gold standard” thereby contravening R 2/14 (points 10 and 11) [and it gave **no reasons** on the gold standard; see point (iii) below] and
  - the Board provided **no opportunity to discuss** the “gold standard”, during the **oral proceedings**.
- (iii) the decision is not sufficiently reasoned (section 3.2.5 below)
  - on the “gold standard”
  - on the “essentiality test”: the Board
    - gave no reasons on why it applied the “essentiality test” rather than the “gold standard”,
    - disregarded the petitioner’s arguments on the “essentiality test”,
    - gave no specific reasons as to why this test was not “applicable”, i.e. provide support for claim 1 as granted.

### 3.2.3 No opportunity during the oral proceedings to argue on the standard the Board applied in the written decision

The petitioner asserts that the Board had given no indication in the oral proceedings of its intended deviation from the “gold standard” and gave the petitioner no opportunity to argue on the basis of the standard actually applied (see above, point III, last para.).

This asserted procedural deficiency is **obviously unfounded**, because it is in direct contradiction with the petitioner’s own conclusion (set out above, in point III, and replicated below):

In other words, [in the decision] **the Board applied the three-point [or “essentiality”] test** by dealing with the question of the omitted feature being indispensable, its functional relationship to other features and the need for substitute features **while examining compliance with the “Gold Standard”!** This discussion was **identically held in Oral Proceedings**.

This paragraph makes it clear that the discussion in the oral proceedings was “identically” mirrored in the written decision (in examining the issue of added subject-matter under Article 76(1) EPC). It is therefore not clear how the petitioner could conceivably have been deprived of its right to comment on the grounds on which the decision under review is based as required by Article 113(1) EPC.

In addition, as the petitioner itself submits: the decision in point 1.3 **and the preliminary opinion in point 6.1 (identical content as the decision)** “mentioned the “gold standard”, but went on to analyse the amended patent using the three-point, i.e. “essentiality”, test.” (See above, point IV.1, second paragraph).

This means that the petitioner was alerted about the standard that the Board, in its perception, applied in the oral proceedings. There is no indication to the effect that the petitioner was not able to contest the applicability of the “gold standard” in the oral proceedings. The decision could therefore not have surprised the petitioner.

However, the petitioner asserts a number of different deficiencies. They are dealt with in points 3.2.4 and 3.2.5 below.

3.2.4 Only “essentiality test”, not also “gold standard” applied in the written decision and no opportunity to discuss that standard during the oral proceedings

3.2.4.1 The asserted deficiency

The petitioner states that the Board, in the **written decision**, applied the “essentiality test” in addressing the added matter issue despite purporting to apply the “gold standard”. The petitioner had relied on the former test, but should have been given the opportunity during the **oral proceedings** to argue its case on the basis of the “gold standard” as well (see above, point VI.1).

The petitioner argues that in only applying the “essentiality test” in the written decision, despite professing to rely on the “gold standard”, and not also that standard, the Board did not comply with the principles laid out in the decision in case R 2/14. In that decision the EBA set aside the Board’s decision under review in particular because the Board had discussed only one of three alternative approaches to establishing sufficiency of disclosure of the

claimed invention. This holding (derived from points 10 and 11) is referred to below as the “R 2/14 rationale”.

#### 3.2.4.2 The written decision

##### *The “gold standard”*

In the case in hand, the Board said, in points 1.2 and 1.3, as the petitioner pointed out, that it applied the “gold standard”. In point 1.4, it briefly addressed the “essentiality test”.

In examining the ground for opposition of Article 100(c) EPC, the Board (in point 1.1) said it applied the same “gold standard” developed for examining compliance with Article 123(2) EPC. In this respect, it referred to the definition of that “standard” given in G 1/16 (in point 18). Accordingly, in short, an amendment must be directly and unambiguously derivable from the application documents as filed.

As to the “gold standard”, the petitioner stressed the “new technical information criterion” mentioned in G 2/10 focusing on what information was presented by the amendment.

The EBA notes that, according to that latter decision, that criterion is linked to the foregoing definition (“amendment must be directly and unambiguously derivable”) on which the Board’s analysis of added subject-matter is purportedly based. The petitioner apparently also draws this conclusion (see above, III).

G 2/10 reads in pertinent part:

4.5.1 ... disclaiming subject-matter disclosed in the application as filed can also infringe Article 123(2) EPC if it results in the skilled person being presented with **technical information** which he would not **derive directly and unambiguously**, using common general knowledge, from the **application as filed**.

##### *The “essentiality test”*

The “essentiality” test sets out three criteria to determine added matter. It is therefore also referred to as the “three-point test”.

- Case Law

The Board, in point 1.4, referred to the "Case Law", section II.E.1.4.4 c) mentioning, in particular, T 1365/16, where it was said:

2.2 In the more recent, and now well-established, jurisprudence of the boards of appeal, the so-called "essentially test" (as set out in **T 331/87**) is no longer considered appropriate (cf. e.g. T 1852/13, Reasons, point 2.2.3 ff.).

The cited decision in case T 331/87, point 6, reads (as re-formatted by the EBA):

It is the view of the Board that the replacement or removal of a feature from a claim may not violate Article 123(2) EPC provided the skilled person would directly and unambiguously recognise that:

- (1) the feature was not explained as **essential** in the disclosure,
- (2) it is not, as such, indispensable for the **function** of the invention in the light of the technical problem it serves to solve, and
- (3) the **replacement** or **removal** requires no real modification of other features to compensate for the change

(following the decision in Case T 260/85, OJ EPO 1989, 105). The feature in question may be inessential even if it was incidentally but consistently presented in combination with other features of the invention. Any replacement by another feature must, of course, be examined for support in the usual manner (cf. Guidelines, Part C, Chapter VI, No. 5.4) with regard to added matter.

- Guidelines for Examination

The OD relied on section H-V, 3.1 of the Guidelines for Examination in the EPO (hereinafter: "the Guidelines"; see for the version of March 2023:

[https://link.epo.org/web/epo\\_guidelines\\_for\\_examination\\_2023\\_hyperlinked\\_en.pdf](https://link.epo.org/web/epo_guidelines_for_examination_2023_hyperlinked_en.pdf) ) in applying the "three-point test" (see point II.3.3 of its decision). This section reads :

3.1 Replacement or removal of features from a claim

The requirements of Art. 123(2) are only met if the replacement or removal of a feature lies within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing (or the date of priority according to Art. 89), from the whole of the application documents (G 3/89, G 11/91 and G 2/10).

If the amendment by replacing or removing a feature from a claim fails to pass the following test by at least one criterion, it necessarily contravenes the requirements of Art. 123(2):

- (i) the replaced or removed feature was not explained as essential in the originally filed disclosure;
- (ii) the skilled person would directly and unambiguously recognise that the feature is not, as such, indispensable for the function of the invention in the light of the technical problem the invention serves to solve (in this context special care needs to be taken in cases where the technical problem is reformulated during the proceedings, see H-V, 2.4 and G-VII, 11); and
- (iii) the skilled person would recognise that the replacement or removal requires no modification of one or more features to compensate for the change (it does not in itself alter the invention).

However, even if the above criteria are met, the division must still ensure that the **amendment** by replacing or removing a feature from a claim **satisfies** the requirements of **Art. 123(2)** as they also have been set out in G 3/89 and G 11/91, **referred to in G 2/10 as "the gold standard"**.

If several features are deleted from an independent claim, so that for example it is restricted to only part of the originally claimed subject-matter, the subject-matter of the amended claim must be directly and unambiguously derivable from the application as filed as being an invention per se, i.e. it must solve a technical problem and be able to work in the absence of any of the particular features being deleted.

...

*Analysis: the test(s) applied by the Board in the written decision*

The petitioner may be correct in contending that the Board, while declaring to apply the “gold standard” in points 1.2 and 1.3, of the decision under review did assess the criteria of the “essentiality test” characterised by the key words “omitted feature being indispensable”, “functional relationship” and “replacement feature” (see point IV.3.1 above). In conclusion, in the final paragraph of point 1.3, however, the Board pointed out that

[t]he skilled person, using their common general knowledge, **thus** would not have **unambiguously and directly derived** the subject-matter of claim 1 as granted from the earlier application (see document D1).

In other words, the Board declared expressly that its analysis that might have used the criteria of the “essentiality test”, constituted an application of the “gold standard”.

In this context the EBA notes that the Guidelines in section H-V, 3.1 reproduced above do appear to incorporate the criteria of the “essentiality test” in explaining the requirements of

Article 123(2) EPC. They state that these criteria must be fulfilled, but “the division must still ensure” that the subject matter complies with the “gold standard”, i.e., possibly, that additional conditions are met.

Against this backdrop, the EBA cannot find that the Board obviously did not apply the “gold standard” due to the fact that it may also have examined, in points 1.2 and 1.3, the criteria of the “essentiality test”. This is independent of the fact that the Board (in point 1.4) stated that “according to the case law of the boards of appeal, this test is no longer considered appropriate for assessing compliance with the gold standard”. The EBA rather must rely on the Board’s declaration that it applied the “gold standard”, given that the EBA is prevented from scrutiny of the application of the law i.e. whether the Board applied the “gold standard” in an incorrect manner. **Nor can it be excluded that the Board, by implication, applied the “new-technical-information” criterion that it did not mention, given its connection with the “directly and unambiguously derivable” criterion** (see above, under the heading “The gold standard”).

Furthermore, in point 1.4 of the decision, the Board *arguendo* applied the “**essentiality test**” expressly referring to its purported analysis of added matter under the “gold standard” in points 1.2 and 1.3.

As a consequence of the foregoing, the above-mentioned rationale of R 2/14, if at all pertinent to the case in hand, would have been complied with. The EBA must consider that the Board, in the written decision, applied both standards in question, the “gold standard” and the “essentiality test”, whether in a correct fashion or not.

*Whether the R 2/14 rationale would apply*

### *Summary*

In R 2/14, it was held that the Board would have needed to address (three) alternative **factual** approaches to assessing sufficiency of disclosure. In the case in hand, however, the (two) approaches in question are **legal** approaches. The Board having opted for one of them and thus having determined the law is under no obligation to apply the facts of the case to an alternative legal approach. This is explained in greater detail below.



*Details of the R 2/14 rationale*

In R 2/14 reviewing the decision in case T 1627/09, the patent proprietor had advanced three alternative cloning approaches that made it possible to carry out the claimed invention.

Points 29 and 30 of that decision read in pertinent part:

29. The appellant has argued that the information contained in the application as filed would have been sufficient to allow the skilled person to prepare a cDNA encoding the delta 8-desaturase obtainable from *Euglena gracilis*, to express it and to confirm its enzymatic activity. It referred to three cloning approaches which would have been at the disposal of the skilled person.

30. ...[The first approach] creates an undue burden on the skilled person trying to perform the invention. The same applies to the two alternative approaches mentioned by the appellant.”

The Board thus assessed, and rejected, merely the first approach as unsuitable to enable the skilled person to carry out the claimed invention. These “approaches” constituted three alternative sets of asserted facts on how the skilled person was capable of carrying out the steps necessary for performing the claimed invention.

In this regard, the EBA notes that a board deciding on a case must establish the facts and apply the law to them. If a party puts forward several alternative sets of facts in order to support a specific finding of law, then the board must assess whether any of these sets does support that finding and may only refuse to accept the suggested finding once it has concluded that none of the sets of facts justifies it. In case R 2/14, the EBA criticised that the Board did not discuss two of three sets of facts at all, but only held them to suffer from the same negative conclusion as the first set.

*The case in hand*

In the case in hand, the situation is different: as the petitioner itself argued, it set forth certain facts to establish that the original disclosure contained two inventions including one without a containing presser. The petitioner applied these facts under the “essentiality test” and asserts that the Board did apply that test, but should have afforded the petitioner the opportunity to also argue on the basis of the “gold standard” during the hearing and should also have applied the “gold standard” to these facts in the written decision.

As stated, it is however for a board to determine the right approach after having heard the party concerned. This took place; see the following section 3.2.4.3. It was then for the Board to conduct the hearing on the basis of the test it considered correct, which it did (“identically

in the oral proceedings!"; see point 2.2.3 above), and base the decision on that test and later give reasons in writing for that decision.

**There is no need to discuss alternative legal approaches, as distinguished from factual approaches, in the decision, because the board gives the law, in particular it determines the correct legal approach.** However, even though this was not necessary, as found above, the Board still applied both approaches, i.e. the "gold standard" and the "essentiality test".

### *Conclusion*

The Board was under no obligation to discuss a legal approach it did not intend to apply (the "essentiality test"), but still applied it *arguendo*.

#### 3.2.4.3 The oral proceedings

The above finding that the requirement to discuss alternative approaches set out in R 2/14 does not apply in this case presupposes that the Board had given the party an opportunity to provide its comments on the correct legal approach. The petitioner itself stated that this was so: "The discussion in the oral proceedings revolved around the question which approach to apply, the gold standard, or the essentiality test".

If, during the oral proceedings, the petitioner considered the Board should not apply the "essentiality test" under the guise of the "gold standard", then it should have alerted the Board to its view. It should have requested that the Board applied the "gold standard" the way the petitioner understood it. This means in particular that the petitioner should have requested the Board to assess the presence of two inventions, i.e. the petitioner's core argument, not (only) under the "essentiality test", but also the "gold standard" in the way the petitioner understood the application of that standard to this question of two inventions: the presence of new technical information in claim 1 as granted and whether its subject-matter could be directly and unambiguously derived from the application documents.

In its communication the EBA had expressed this view (in point B.2.1.2, re (i)), without the petitioner addressing it in its response.

#### 3.2.4.4 Conclusion

The EBA cannot find that the Board did not discuss the “gold standard” in the decision and the preceding oral proceedings. The same applies to the “essentiality test”, because the Board, in assessing it, relied on its findings on the “gold standard”.

Against this backdrop, no violation of the petitioner’s right to be heard can be found on the basis of this asserted procedural deficiency: “only “essentiality test”, not also “gold standard” applied in the written decision and no opportunity to discuss that standard during the oral proceedings” (heading of this section 3.2.4).

The following section 3.2.5 will address the question of whether a violation of the right to be heard occurred in the way the “gold standard” and the “essentiality test” were discussed in the written decision.

#### 3.2.5 Decision not sufficiently reasoned

The petitioner asserts that the decision was not sufficiently reasoned

- on the “gold standard”: the Board gave no reasons at all
- on the “essentiality test”: the Board
  - gave no reasons on why it applied the “essentiality test” rather than the “gold standard”,
  - disregarded the petitioner’s arguments on the “essentiality test”,
  - gave no specific reasons as to why this test was not “applicable”, i.e. provide support for claim 1 as granted.

##### 3.2.5.1 The legal principles on how a board should address submissions that it identified as being relevant

In R 6/20 the EBA (in point 2, at page 12) noted that it had laid out criteria for assessing the assertion of certain aspects of a violation of the right to be heard stemming only from the written decision in R 8/15 and affirmed and complemented those criteria in R 10/18.

The catchword of R 8/15 reads:

1. Article 113(1) EPC implies that decisions of the EPO boards of appeal should adequately state the reasons on which they are based in order to show that the parties were heard. A party must be able to examine whether, in its view, the board has afforded it the right to be heard in order to be in a position to decide on whether or not to file a petition under Article 112a(2)(c) EPC (in force since 13 December 2007) for violation of Article 113(1) EPC. One aspect of the right to be heard as covered by Article 113(1) EPC requires a board to consider a party's submissions, i.e. assess the facts, evidence and arguments submitted as to their relevance and correctness. Article 113(1) EPC is infringed if the Board does not address submissions that, **in its view**, are **relevant** for the decision in a manner adequate to show that the parties were heard on them, i.e. that the Board **substantively considered** those submissions. (See Reasons, point 2.2.2.)

2. Assessing the completeness of a decision would usually be beyond the scope of scrutiny under Article 113(1) EPC. As to the reasons for a decision, Article 113(1) EPC must be interpreted more narrowly than, and thus is not a substitute in review proceedings for, the broader legal provisions embodied in Rule 102(g) EPC. Those provisions require a board to give reasons for its decision, but infringement thereof is not as such a ground for review. In other words: for the purpose of compliance with the right to be heard, reasons may be incomplete, but as long as they allow drawing the conclusion that the board, in the course of the appeal proceedings, substantively assessed a certain point being part of the procedure and that it found to be relevant, there will be no violation of Article 113(1) EPC. (See Reasons, point 2.2.3.)

On the possible legal consequences of a board not addressing submissions at all, see R 10/20, in particular its catchword.

### 3.2.5.2 The case in hand.

#### *(a) In general*

In line with point 1 of the catchword of R 8/15, the Board, in sections 1.1 to 1.4, did address submissions it identified as being relevant, in the reasons for the decision, i.e. the question of whether the containing presser omitted in claim 1 of the main request led to a finding of added subject-matter pursuant to Article 76(1) EPC. The question is whether the Board also substantively considered those submissions as also required in point 1 of that catchword.

The petitioner asserts (see at the outset of section 3.2.5) that the decision was not sufficiently reasoned

- on the “gold standard”: the Board gave no reasons at all
- on the “essentiality test”: the Board
  - gave no reasons on why it applied the “essentiality test” rather than the “gold standard”,

- disregarded the petitioner's arguments on the "essentiality test",
- gave no specific reasons as to why this test was not "applicable", i.e. provide support for claim 1 as granted.

*(b) On the application of the "essentiality test" rather than the "gold standard"*

As found in the previous section 3.2.4.2 above (under "Analysis:..."), the Board declared to have applied the "gold standard" and this declaration cannot be judged to be obviously incorrect. In addition, it expressly applied the "essentiality test" (in section 1.4 referring to sections 1.2 and 1.3). This asserted deficiency therefore has no object.

*(c) On the reasons given regarding the "gold standard" and the "essentiality test"*

The EBA points out that the Board's reasons given in respect of the topic of added subject-matter in sections 1.1 to 1.4 of the decision (summarised or reproduced above in point II) were extensive.

The petitioner however asserts that the board did not deal with its arguments in the statement of grounds both under the "essentiality test" and the "gold standard". The summary of the arguments given under the "essentiality test" laid out in the statement of grounds is provided at the beginning of section 3.1, reproduced above in point VI.2.

In the **petition**, the petitioner set forth that the Board did not apply the "gold standard" and disregarded its arguments on the "essentiality test".

In the **response**, the petitioner particularly objects to the asserted lack of application of the "gold standard". More precisely, in the response, the petitioner raised the following objections regarding the Board's asserted failure to address the "gold standard":

[Re 2.1.2 point (iii), page 2]

... the original parent application disclosed **two inventions** (see sections 3.1.3 and 3.1.4 on pages 9 to 12 of the grounds). This aspect was dealt with by the board not by establishing if new information is provided to the skilled person, as required under the **"gold standard"**, but by pursuing, already at point 1.3 of the decision, the **essentiality test**.

[Re 2.1.2 point (i), page 4]

[the] skilled person ... would have found evidence in such application, at **page 4, lines 3 to 11**, that there was indeed disclosed an embodiment in which the technical effects were said to be achieved by a removal operation which forms a groove on the peripheral edge of the profile, and hence without the need for a containing presser. This text passage states the

technical effect on which the invention relies, namely of “*containing a welding bead produced during the melting of the respective profiled elements 3,*” purely in terms of the groove(s) made “*by means of a removal operation...*”, without relying on the containing presser. That is, such solution without the containing presser is no new technical information.

...

Put differently, the petitioner believes that had the board asked itself, as mandated by **G 2/10**, if the skilled reader was presented with **new information**, the answer to this question would have been “no” as the skilled reader would have identified **two inventions**, and hence in particular **one** in which **no containing presser** was required.

In this regard, the EBA reiterates that the Board is required to only deal with facts and arguments submitted by the petitioner on the basis of the test that it, after having heard the petitioner on it, considered to be correct. The distinction between the two approaches “gold standard” and “essentiality test” is thus irrelevant for assessing sufficiency of the reasons given in the decision and, in consequence, compliance with the right to be heard.

According to the Board, as explained above (in point 3.2.4.2: “Analysis...”), it applied the “gold standard” in points 1.2. and 1.3. As the EBA set forth, it is unable to dismiss this view as obviously incorrect. The Board also briefly dealt with the “essentiality test” by reference to the discussion of the “gold standard”.

The only question to be answered therefore is whether sections 1.2 to 1.3 relating to the application of the “gold standard” adequately deal with the petitioner’s submissions, given that the paragraph on the “essentiality test” (section 1.4) merely refers to sections 1.2 and 1.3. In other words: whether or not the Board adequately dealt with the petitioner’s arguments depends on sections 1.2 and 1.3.

In the portion of the response reproduced immediately above, the petitioner relied on the disclosure of two inventions in the earlier application (document D1) that it had explained in the statement of grounds of appeal. This aspect, in its view, had not been dealt with by the Board under the “gold standard”, but, in point 1.3 of the decision, under the “essentiality test”. See the first quoted paragraph of the response immediately above. The petitioner thus admits that its core point had been discussed. As reiterated above, for purposes of the right to be heard, the test applied plays no role.

The analysis below must therefore focus on whether the Board, in its analysis, considered the petitioner’s submissions that it found relevant.

The petitioner's main argument in this context is that ["the] skilled person ... would have found evidence in such application [i.e. document D1], at page 4, lines 3 to 11" . Those lines read as follows:

As will be better specified below according to the method, before the step of heating and welding the profiled elements 3, a groove 19 is made in correspondence to at least one zone to be welded 4 of the profiled elements 3 by means of a removal operation (milling, melting, chamfering, etc.). Subsequently, the zones to be welded 4 are heated and coupled, or joined, by pressing the profiled elements 3 one against the other to keep the zones 4 in reciprocal contact. This way, the groove 19 or the grooves 19 of the two profiled elements 3 define a containing compartment 19a for containing a bead or welding bead produced during the melting of the respective profiled elements.

In section 1.2 of its decision, in the paragraph bridging pages 12 and 13, the Board gave the following answer:

Similarly, the skilled person would not read the passages on **page 4, lines 3 to 11** and page 18, lines 27 to 31 of document D1, cited by the appellant, in isolation. These passages relate to embodiments involving the presence (and use) of a containing presser. These passages do not provide support for a device for welding profiled elements that does not comprise a containing presser.

The Board thus addressed this specific passage of the description that the petitioner relied on in the response to establish the presence of two inventions. This passage forms part of a discussion in section 1.2 leading to the conclusion that the containing presser was not only described as being optional in document D1.

As set out above (in point II), in section 1.2 the Board discussed the appellant's submissions that:

- Figure 5 of document D1 did not show a containing presser,
- the appellant inferred from page 7, lines 8 and 9 of document D1 that the containing presser was only optional,
- the passages on **page 4, lines 3 to 11** and page 18, lines 27 to 31 of document D1, suggested that a containing presser was not needed.

The petitioner's core point "two inventions" was then specifically discussed in section 1.3 of the decision. Again, the fact that, in that section, the Board applied the criteria of the "essentiality test" in the framework of the "gold standard", is immaterial for the assessment of compliance with the right to be heard.

Apart from the "two inventions" point, the petitioner has not mentioned any other specific submission that the Board allegedly had not dealt with in the written decision. See in

particular the following objection made in the petition referred to above (in point IV.3.1, second but last paragraph above):

***“The Board disregarded the arguments raised by the petitioner under the “essentiality test” on the assumption that this test was no longer considered appropriate for assessing compliance with the “gold standard”. Therefore, the Board did not examine it in detail and gave no specific reason as to why the arguments put forward by the petitioner in relation to the “essentiality test” would not provide support for claim 1 as granted.”***

#### 3.2.5.3 Conclusion

It follows from the foregoing that the petitioner’s assertion that the Board did not discuss the “gold standard” at all and ignored its arguments on the “essentiality test”, and thus the third procedural deficiency relating to insufficient reasons given for the decision, is clearly unfounded.

#### 4. Overall conclusion on the request that the decision under review be set aside

As the analysis in point 3 above has shown, the petition for review is clearly unallowable (Rule 109(2)(a) EPC). This is because none of the three asserted fundamental deficiencies constitute a violation of the right to be heard under Article 112a(2)(c) EPC in conjunction with Article 113(1) EPC or under Article 112a(2)(d) EPC:

- The grounds for the decision reflect the discussion during the oral proceedings (point 3.2.3),
- Both the “gold standard” and the “essentiality test” were addressed in the written decision; addressing the test considered to be the correct one would have sufficed (3.2.4),
- The written decision is sufficiently reasoned; it dealt with the petitioner’s arguments (3.2.5).

As a final remark, the EBA deems it possible that the apparent incorporation of the “essentiality test” in the “gold standard” in the decision under review (as in the Guidelines)



may have caused confusion on the part of the petitioner and triggered the present petition for review.

5. The remaining requests regarding the review of the Board's decision

The remaining requests that:

- the appeal proceedings be re-opened;
- in the event that the proceedings are re-opened, that they be entrusted to another Board of Appeal;
- the fee for the petition be reimbursed;

must equally be refused. Since the petition is clearly unallowable, the Enlarged Board cannot order reopening of the appeal proceedings under Rule 108(3) EPC; the request to entrust the proceedings to another board consequently has no object. Reimbursement of the petition fee cannot be ordered because the condition of Rule 110 EPC that the proceedings before the Board are reopened has not been met.

## Order

**For these reasons it is decided that:**

The petition for review is unanimously rejected as being clearly unallowable.

The Registrar:

The Chairman:



N. Michaleczek

I. Beckedorf

Decision electronically authenticated