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D E C I S I O N
of 30 September 2004

Case Number: T 0476/03 - 3.2.7

Application Number: 95929427.3

Publication Number: 0790880

IPC: B24D 13/14

Language of the proceedings: EN

Title of invention:
Abrasive products

Patentee:
NORTON COMPANY

Opponent:
3M Innovative Properties Company 3M Center

Headword:
-

Relevant legal provisions:
EPC Art. 54, 56, 83, 100(b), 123(2)(3)
EPC R. 57a, 71a

Keyword:

"Amended claims filed about one month before date of oral proceedings - admitted"
"Extension of subject-matter (auxiliary request 2 - yes, auxiliary request 4 - no)"
"Enabling disclosure (yes)"
"Novelty (auxiliary request 4 - yes)"
"Inventive step (auxiliary request 4 - no)"
"Admissibility of auxiliary requests 5 and 6 (no - amendments to the claims of the patent as granted not occasioned by the grounds of appeal)"
"Request for remittal to first instance for further examination of auxiliary requests 5 and 6 - rejected"

Decisions cited:

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Catchword:

-



Case Number: T 0476/03 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 30 September 2004

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 27 February 2003
revoking European patent No. 0790880 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: A. Burkhart
Members: H. E. Hahn
E. Lachacinski

Summary of Facts and Submissions

- I. The Patentee lodged an appeal against the decision of the Opposition Division to revoke the European patent No. 0 677 364.
- II. An opposition had been filed against the patent as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(b) EPC (lack of enabling disclosure).

The Opposition Division held that the invention was sufficiently disclosed, but that the amended independent claim 1 did not meet the requirement of Article 84 EPC and that the subject-matter of claim 1 lacked an inventive step with respect to the documents D5 and D7. A late filed auxiliary request filed during the oral proceedings was considered not to be *prima facie* allowable and was therefore not admitted by the Opposition Division under Rule 71a EPC.

- III. Oral proceedings were held on 30 September 2004.
- (a) During the oral proceedings the appellant (patentee) requested that the decision under appeal be set aside and the patent be maintained on the basis of either claim 1 of the auxiliary requests 2, 4, 5 or 6, all filed on 27 August 2004 by fax. As a further auxiliary request the appellant requested to remit the case to the first instance for further examination.
- (b) The respondent (opponent) requested that the appeal be dismissed.

(c) The following documents of the prior art were considered to be relevant:

D1 = US-A-794 495

D2 = US-A-4 047 902

D3 = US-A-5 174 795

D4 = US-A-5 318 604

D5 = EP-A-0 259 187

D7 = US-A-2 876 086

D8 = US-A-5 103 598

IV. Independent claim 1 of auxiliary request 2 as filed on 27 August 2004 reads as follows (differences to claim 1 as granted are in bold):

"1. A coated abrasive having a plurality of abrasive elements, said elements being adhered to a backing material in a predetermined configuration, characterized in that each element comprises a base pad and a plurality of abrasive particles **having one dimension longer than the others**, each adhered by one extremity to one surface of the pad."

V. Independent claim 1 of auxiliary request 4 as filed on 27 August 2004 reads as follows:

"1. A coated abrasive having a plurality of abrasive elements, said elements being adhered to a backing material in a predetermined configuration, characterized in that each element comprises a base pad and a plurality of **filamentary** abrasive particles, each adhered by one extremity to one surface of the pad."

VI. The independent claims 1 and 9 of auxiliary request 5 as filed on 27 August 2004 read as follows:

"1. A process for manufacturing a coated abrasive characterized in that it comprises the following steps:
forming a plurality of base pads
- adhering a plurality of abrasive particles to the surface of each pad, each particle being adhered by one extremity to one surface of a pad - this forming a plurality of "abrasive elements"
- adhering the said "abrasive elements" to a backing material in a predetermined configuration."

"9. A coated abrasive characterized in that it is manufactured by a process according any one of claims 1 to 8."

VII. The independent claims 1 and 8 of auxiliary request 6 as filed on 27 August 2004 read as follows (differences to auxiliary request 5 are in bold):

"1. A process for manufacturing a coated abrasive characterized in that it comprises the following steps:
forming a plurality of base pads
- adhering a plurality of **filamentary** abrasive particles to the surface of each pad, each particle being adhered by one extremity to one

surface of a pad - this forming a plurality of "abrasive elements" adhering the said "abrasive elements" to a backing material in a predetermined configuration."

"8. A coated abrasive characterized in that it is manufactured by a process according any one of claims 1 to 7."

VIII. The appellant argued essentially as follows:

The auxiliary requests 2, 4, 5 and 6 represent a reaction to the communication of the Board annexed to the summons for the oral proceedings and should therefore be allowed, particularly since the amendments made therein can be easily understood. They were filed three days and one month before the date of the oral proceedings, i.e. in due time within the time limit as set out in the communication of the Board annexed to the summons for the oral proceedings.

According to the decision of the Opposition Division the term "significantly" of the definition "significantly longer" has no technical meaning and has to be interpreted as simply meaning longer. Following this view of the Opposition Division claim 1 of auxiliary request 2 is clear and meets the requirements of Article 123(2) EPC.

Claim 1 of auxiliary request 4 defines the filamentary particles which feature has a basis in the application as filed (cf. page 2, lines 35-37). It is not difficult for the skilled person to orient the filamentary particles (compare document D7) and the definition "one

extremity" actually means that one end of the filamentary particle is adhered to or rooted in the pad (compare patent, figure 1). The product of claim 1 of auxiliary request 4 is novel, particularly with respect to document D3. The product according to figure 1 of document D3 does not comprise a plurality of pads, let alone pads containing filamentary abrasive particles.

It is denied that the products according to documents D1, D2, D4 and D5 are only distinguished by the filamentary particles from those according to claim 1 of auxiliary request 4. These documents aim to solve different technical problems, they use different processes and they do not disclose abrasive elements comprising pads in the meaning of claim 1. The problem underlying the invention is the customizing of coated abrasives with minimized wastage of grain and maximized targeted effectiveness in order to meet the demands of the customers (cf. patent, section [0007]). The documents D7 and D8 only disclose the oriented coated abrasives but cannot be combined with either of D1, D2, D4 and D5 in an obvious manner. Therefore claim 1 involves an inventive step.

The Opposition Division did not admit the late filed auxiliary request, which comprised a process claim, for not being clearly allowable. Thereby the Opposition Division deprived the appellant from its right to have a discussion on the patentability of the subject-matter of the auxiliary request. Process claim 1 of auxiliary request 5 corresponds to said process claim of said non-admitted auxiliary request, while process claim 1 of auxiliary request 6 except the limitation to filamentary abrasive particles is identical with

claim 1 of auxiliary request 5. Therefore in order to avoid a loss of instance it is requested to remit the case to the first instance for further examination of auxiliary requests 5 and 6.

IX. The respondent argued essentially as follows:

The filing of the auxiliary requests 2, 4, 5 and 6 only about one month before the oral proceedings is objected to as being late. Furthermore, all these requests are formally not allowable either under Rule 57a, Article 84 EPC and/or Article 123(2) EPC.

The deletion of "significantly" from the feature "one dimension significantly longer" according to claim 1 of auxiliary request 2 contravenes Article 123(2) EPC. The originally filed application only discloses "one dimension significantly longer than the others". The term "significantly, however," has a specific technical meaning in the context of the length although this meaning is not defined by a figure. The deletion gives the term "longer" a different meaning than it had before. Auxiliary request 2 additionally contravenes Rule 57a EPC since the dependent claims 2 and 3 have been amended (e.g. according to new claim 2 all pads are circular whereas according to claim 2 as granted not all had to have circular pads) and since claim 9, which in the form as granted was an independent product claim, has been made dependent upon claims 1, 5, 7 and 8. Thereby the appellant made amendments which are not occasioned by the grounds of opposition. Furthermore, since the dependent claims referred to by amended claim 9 already define those features which were comprised in independent claim 9 as granted, this

amendment results in a redundant claim so that the requirement of Article 84, i.e. conciseness, is additionally not met.

The patent in suit does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art due to the definition of claim 1 of auxiliary request 4 "each adhered by one extremity to one surface of the pad". The term "extremity" in connection with coated abrasives represents no common term and the application as filed gives no definition thereof. The only method disclosed in the patent in suit, i.e. UP coating, does not ensure that the particles are adhered by one extremity of the filamentary particles, i.e. at an edge part of a filament such as a corner at one end thereof. Therefore the requirements of Article 100(b) EPC are not met.

The product of claim 1 of auxiliary request 4 lacks novelty with respect to the product according to figure 1 of document D3. In any case, the subject-matter of claim 1 of auxiliary request 4 lacks an inventive step. The patent as granted was not limited to filamentary abrasive particles (cf. patent, column 2, line 24). The invention was seen in that abrasive particles of any type were adhered onto abrasive elements which then were adhered in a predetermined manner to a backing material (cf. patent, column 2, lines 3-8). The documents D1 (cf. figure 1; page 2, line 57 to line 83), D2 (cf. figure; column 1, lines 55-63; column 2, lines 1-6; column 4, lines 1-8), D4 (cf. figures 2) and D5 (cf. page 7, lines 23-43; figure 5-7) described the core of the patent in suit,

i.e. to apply abrasive particles to a pad and to arrange these pads in a predetermined manner. The documents D7 (cf. column 4, lines 3-12) and D8 (cf. column 4, lines 46-63) provide the filamentary abrasive particles which are described as being advantageous with respect to conventional particles. Since the only distinguishing feature with respect to the documents D1, D2, D4 and D5 resides in the filamentary abrasive particles the object to be solved for the skilled person is to provide an alternative product. Either document D1 or D5 needs to be combined with D8 to arrive at the product of claim 1. However, there is no additional or unexpected effect combined with the substitution of the conventional abrasive particles. Therefore claim 1 lacks an inventive step.

Auxiliary request 5 comprises a process claim 1, which defines a process for making the product claimed in claim 1 as granted, and a product-by-process claim 9. Thus, the change of category of claim 1 is not occasioned by a ground of opposition. Furthermore, the dependent claims 2-4 have also been amended. Consequently, Rule 57a EPC is contravened. Finally, the appellant has not given any reasons as to why it is necessary to define the product in terms of a process of manufacture, which is only allowed in exceptional cases.

Auxiliary request 6 contravenes Rule 57a for the same reasons since it identically comprises a process claim 1 in combination with additionally amended claims 2-4 and a product claim 8 worded as product-by-process claim.

Reasons for the Decision

Admissibility of auxiliary requests 2, 4, 5 and 6

1. Although the respondent objected to the auxiliary requests 2, 4, 5 and 6 - which were filed on 27 August 2004 - as having been late filed the Board notes that these auxiliary requests were filed 3 days before the one month time limit in advance of the oral proceedings before the Board on 30 September 2004. These requests were thus filed in due time within the time limit as set out in paragraph 9 of the communication of the Board dated 1 July 2004 annexed to the summons for the oral proceedings. Consequently, these auxiliary requests are not considered to be late filed.

Therefore, the Board takes into consideration the auxiliary requests 2, 4, 5 and 6.

Auxiliary request 2

2. *Admissibility of amendments (Article 123(2) and (3) EPC)*

Claim 1 of auxiliary request 2 has been amended with respect to claim 1 as granted by introducing the feature "abrasive particles **having one dimension longer than the others**".

The application as originally filed, however, only discloses "that the particles have one dimension significantly longer than the others" (cf. page 2, lines 30-32). There is no basis in the originally filed application for the feature "abrasive particles having one dimension longer than the others". The term

"significantly longer" has a different meaning than the term "longer" for the person skilled in the art. Consequently, claim 1 of auxiliary request 2 contravenes Article 123(2) EPC. Thus, auxiliary request 2 is not allowable.

Auxiliary request 4

3. *Admissibility of amendments of claim 1 (Article 123(2) and (3) EPC)*

Claim 1 of auxiliary request 4 has been amended by restricting the abrasive particles to "**filamentary**" abrasive particles. This amendment has a basis in the application as originally filed (cf. page 2, lines 35-37; page 3, lines 36-38; page 4, lines 30-33; page 5, lines 1-2; claim 8) and the scope of claim 1 as granted has been limited thereby.

Consequently, claim 1 of auxiliary request 4 meets the requirements of Article 123(2) and (3) EPC.

4. *Enabling disclosure (Articles 83 and 100(b) EPC)*

The respondent's allegation that the patent in suit does not enable the skilled person to obtain a coated abrasive in accordance with claim 1 of auxiliary request 4 is based on its interpretation of the definition "one extremity" of the abrasive particles, i.e. an edge part thereof.

The Board concurs with the Opposition Division that the skilled person in the context of filamentary abrasive particles would interpret the said expression "one

extremity" as meaning one of the two ends of a filamentary particle which should be adhered to the base pad. This definition, however, does not exclude that the filamentary particles actually can be embedded, e.g. by applying a size coat (cf. patent, column 4, lines 5-7). Consequently, the disclosed UP coating method (UP = upward propulsion method) adheres filamentary abrasive particles to a backing member in such a manner that the filamentary abrasive particles are oriented with the long axis thereof normal to the backing member. This implies that at least a part of the particles end is adhered to the backing member (compare document D7) so that the said requirement is fulfilled.

Additionally the Board remarks that the skilled person is able to make an abrasive element according to figure 1 by manually positioning and adhering filamentary abrasive particles in a desired configuration to a base pad and then to adhere a plurality of said abrasive elements onto a backing member.

The Board therefore considers that the skilled person is able to produce a product in accordance with claim 1 of auxiliary request 4. Consequently, the requirements of Article 83 EPC are met and the ground of opposition under Article 100(b) EPC is not justified.

5. *Novelty (Article 54 EPC)*

5.1 The respondent alleged a lack of novelty with respect to the coated abrasive product as shown in figure 1 of

document D3. The Board cannot accept this allegation for the following reasons.

Although the patent in suit includes an embodiment according to which the pad and the filamentary abrasive particles are made from the same material (cf. patent, column 2, lines 39-41), the product according to figure 1 of document D3 does not meet all the requirements of claim 1. The abrasive product according to figure 1 of document D3 is an abrasive pad (10) which comprises a planar sheet portion (12) and a plurality of protrusions (14) having abrasive end surfaces (18); said protrusions are intimately molded with a backing sheet and the material includes an intimate mixture of abrasive grit and thermoplastic or thermosetting material (cf. figure 1; column 1, lines 44-51; column 2, lines 28-37). In the case that the said plurality of protrusions (14) are considered to represent a plurality of filamentary abrasive particles on a base pad then this product forms one abrasive element within the meaning of claim 1 but this product does not comprise a plurality of abrasive elements on a backing as required by claim 1; in the other case when said protrusions (14) are considered to form a plurality of base pads on a backing then said pads do not comprise any filamentary particle, let alone a plurality thereof - as required by claim 1 -, since document D3 is silent with respect to the shape of the abrasive grit material (cf. column 3, lines 23-40; example 1).

5.2 All other cited documents are less relevant than document D3 and either do not disclose filamentary

particles or do not disclose a plurality of pads adhered to a backing material.

5.3 The Board therefore concludes that the subject-matter of claim 1 of auxiliary request 4 is novel.

6. *Inventive step (Article 56 EPC)*

6.1 Closest prior art

The Board considers that document D5 represents the closest prior art although documents D1, D2 or D4 could equally be chosen.

Document D5 discloses a grinding or polishing pad which comprises a laminate substrate (1, 2, 3) being adhered to a rubber cloth (4) via a polyurethane adhesive layer (7) and having on the rubber cloth a number of hexagonal pieces of a metallic foil (5) which comprises abrasive particles (6) such as diamond particles adhered thereto via a nickel layer as the adhesive (cf. page 7, lines 13-43; figures 5-7). The shape of the used abrasive particles is stated merely to have been shown for illustrative purposes to be generally triangular in cross section (cf. page 4, lines 27-29) but for the example it is neither explicitly nor implicitly described.

6.2 Problem to be solved

The diamond particles (6) adhered to the metal foil (5) via an adhesive nickel layer according to document D5 represent abrasive elements comprising base pads in the sense of the patent in suit. According to the patent in

suit the said base pads may have any shape and may be made from metal or may be made from a material conventionally used as a binder in the construction of coated abrasives (cf. patent, sections [0010], [0014] and [0016]).

Therefore the only distinguishing feature with respect to the document D5 resides in the fact that the abrasive particles are filamentary particles. Since the patent in suit does not attribute any specific effect to this distinguishing feature, the objective technical problem to be solved is thus considered to provide an alternative product.

6.3 Solution to the problem

The problem is solved by a coated abrasive as defined in claim 1.

6.4 The Board considers that the subject-matter of the independent claim 1 is obvious for the person skilled in the art for the following reasons:

6.5 Document D8 discloses a coated abrasive containing abrasive filaments of polycrystalline alumina, preferably sol-gel alumina (cf. abstract) which filaments have an aspect ratio of up to 12:1 or more and which are adhered to a flexible backing proximate one end of the filament by an adhesive maker coat (cf. column 3, line 66 to column 4, line 34; column 5, line 55 to column 6, line 8; column 7, line 62 to column 8, line 28; and column 8, line 35 to column 9, line 14). The said filamentary abrasive particles are preferably applied using UP coating techniques and have therefore

an upright orientation. These filamentary abrasive particles result in superior coated abrasive products having many advantages compared with those comprising conventional abrasive particles, such as an exact size distribution for a particular application, or a more economical and efficient overall manufacturing operation, or e.g. being particularly effective in low pressure grinding (cf. column, 4, lines 43-63).

- 6.6 The coated abrasives for grinding and polishing lenses according to document D5 include abrasive particles (which may comprise small diamond or other super hard particles) which are affixed to the pad such that, when in use, its particles will project a uniform distance from the surface of the associated lap, thereby assuring that their lens blank engaging edges will lie in a plane precisely comparable to the surface that is to be ground on a lens blank (cf. document D5, page 4, lines 26-34). Consequently, substantially all the abrasive particles should have the same size and length.
- 6.7 The Board therefore considers it an obvious option for the skilled person knowing both documents D5 and D8 to use in the abrasive material according to document D5 the filamentary abrasive particles known from document D8, since the said filamentary particles can advantageously be selected to have the same length and size. Thereby the skilled person would arrive at the subject-matter of claim 1 of auxiliary request 4 in an obvious manner.
- 6.8 The appellant argued that the coated abrasive according to document D5 does not comprise base pads and/or abrasive elements in the sense of the patent in suit.

These arguments cannot be accepted with respect to paragraph 6.2 above since claim 1 of auxiliary request 4 does neither define any specific shape of said base pads nor excludes brass as the base pad material. Similarly, claim 1 does not exclude nickel for adhering the abrasive particles to a metallic base pad.

Furthermore, the appellant's arguments concerning differences of the process for making the coated abrasives according to document D5 and the process according to the patent in suit are considered not to be particularly relevant since claim 1 is related to a product and not to a process. The same conclusion is valid with respect to the definition of the objective technical problem of customizing coated abrasives as submitted by the appellant.

- 6.9 The subject-matter of independent claim 1 of auxiliary request 4 thus does not involve an inventive step as required by Article 56 EPC.

Auxiliary request 5

7. *Rule 57a EPC*

Auxiliary request 5 does not meet the requirement of Rule 57a EPC for

- (a) comprising an additional independent claim of a new category, namely a process claim, which had no counterpart in the patent as granted, and
- (b) the further amendments made in the dependent claims 2-4, and

- (c) the re-wording of the product claim as product-by-process claim.

According to Rule 57a EPC and to the established jurisprudence of the Boards of Appeal amendments to the text of a granted patent during opposition or subsequent appeal proceedings should only be considered appropriate and necessary if they can fairly be said to be occasioned by grounds for opposition laid down in Article 100 EPC (compare **Case Law** of the Boards of Appeal of the EPO, 4th edition 2001, section VII.C.10.1.1).

Considering this premise the Board comes in the present case to the following conclusions:

- (a) The patent as granted comprised two independent product claims 1 and 9 directed to coated abrasives. The patent as granted did not comprise any process claim.
- (b) Auxiliary request 5, however, comprises an independent process claim 1 with seven dependent process claims 2-8, and an independent product claim 9 directed to a coated abrasive worded as a product-by-process claim.
- (c) The proprietor is, however, not entitled additionally to file an independent process claim which had no counterpart in the patent as granted. Such an additional independent claim of a new category is clearly not occasioned by the grounds of opposition within the meaning of Rule 57a EPC.

Particularly, since process claim 1 of auxiliary request 5 does not contain any further feature compared with claim 1 as granted, which would serve to overcome a ground of opposition, i.e. Article 100(a) or (b) EPC, as brought forward against product claim 1 as granted.

- (d) The proprietor is also not entitled to amend dependent claims in order to improve his position. Nevertheless, the proprietor amended claim 2 (which - due to the wording "that the base pads are ..." now defines that **all** base pads are in the form of a circular disc - whereas due to the wording "in which the abrasive elements have base pads ..." according to claim 2 as granted not all base pads had to have this form), claim 3 (by introducing a reference to claim 2) and claim 4 (now defining that "the abrasive elements are adhered to **a** backing material" - claim 4 as granted defined "adhered to the backing material").
- (e) Furthermore, the Board cannot identify any reason for amending independent product claim 9 by rewording the same as a product-by-process claim.

Therefore, independent claims 1 and 9 and the dependent claims 2-4 of auxiliary request 5 do not meet the requirements of Rule 57a EPC, and consequently, auxiliary request 5 is not allowable.

Auxiliary request 6

8. *Rule 57a EPC*

The conclusion of paragraph 7 above applies *mutatis mutandis* to auxiliary request 6 which equally comprises a process claim 1 and an independent product claim 8 worded as product-by-process claim, and which comprises the identical amendments in the dependent claims 2-4. Process claim 1 of auxiliary request 6 comprises only the further feature "filamentary" and thus does not appear to add any further limitation compared to auxiliary request 4.

Therefore, independent claims 1 and 8 and the dependent claims 2-4 of auxiliary request 6 likewise do not meet the requirements of Rule 57a EPC, and consequently, auxiliary request 6 is not allowable.

9. *Request for remittal of auxiliary requests 5 and 6 to the first instance*

The appellant argued that the auxiliary request should have been admitted during the oral proceedings before the Opposition Division because Rule 71a EPC never applies to the admission of an auxiliary request and the Guidelines for examination point out that the oral proceedings must be conducted so as to thoroughly discuss any issue of interest in relation with patentability and compliance with EPC. The Opposition Division misused its right to exercise a power of discretion and did not admit the late filed auxiliary request during the oral proceedings finding it not clearly allowable. Thereby the appellant was deprived

of its right to have a fair discussion on the patentability of the subject-matter of the auxiliary request, which comprised an independent process claim 1. Therefore in order to avoid a loss of instance the appellant requested to remit the case to the first instance for further examination of the auxiliary requests 5 and 6. Process claim 1 of auxiliary request 5 corresponds to the process claim 1 of said non-admitted auxiliary request, while process claim 1 of auxiliary request 6 is compared to auxiliary request 5 further limited to filamentary abrasive particles.

- 9.1 The Board notes that Rule 71a(2) EPC unmistakably states that, if the patent proprietor has been notified of the grounds prejudicing the maintenance of the patent, he may be invited to submit, by the date specified in paragraph 1 (i.e. in the present case by the date specified in the summons for the oral proceedings before the Opposition Division), documents which meet the requirements of the EPC, and paragraph 1, third and fourth sentences, shall apply *mutatis mutandis*. With the summons dated 15 October 2002 the Opposition Division informed the appellant that the time limit for filing final submissions and/or amendments in accordance with Rule 71a EPC was the 12 January 2003, i.e. one month before the date of the oral proceedings fixed on 12 February 2003. In the annex to the summons the Opposition Division had presented its negative opinion with respect to inventive step of product claim 1. Thereby the appellant was made aware of the possibility that the patent was likely to be revoked (cf. summons, paragraph 5). However, the appellant did not file any amendment such as an auxiliary request before the time limit set

and consequently it took the risk that a late-filed request would not be admitted. It was only during the oral proceedings before the Opposition Division that the appellant submitted an auxiliary request (cf. minutes of the oral proceedings dated 27 February 2003), which in addition to the independent process claims 1-8 and a product-by-process claim 9 comprised the new product claims 10-15 directed to abrasive elements. The Opposition Division then exercised its discretion conferred under Rule 71a(2) EPC and considered that this auxiliary request was definitely late-filed since it was submitted after the one month time limit as set out in the summons. Thereafter the Opposition Division checked the allowability thereof on a *prima facie* basis as set out in the Guidelines wherein it is stated that, if the amendments are clearly not allowable, they will not be admitted (cf. Guidelines, E-III, 8.6, fourth paragraph). Since the new product claims 10-15 of the auxiliary request are directed to abrasive elements whereas product claim 1 as granted was directed to a coated abrasive comprising a plurality of such elements it is immediately evident that these added claims contravene Article 123(3) EPC since they extend the protection conferred by claim 1 as granted.

- 9.2 Thus the Board cannot see that the behaviour of the Opposition Division was tainted with procedural error or that it misused its power of discretion. On the contrary, the Opposition Division came to the correct conclusion, i.e. that the auxiliary request is *prima facie* not allowable for formal reasons and as a consequence it had not to admit said auxiliary request.

However, the Board remarks that the further conclusions drawn by the Opposition Division concerning process claim 1 (i.e. lack of inventive step) and product-by-process claim 10 (i.e. lack of novelty) should not have been made without discussing these issues with both parties.

9.3 Therefore the appellant's request to remit the auxiliary request 5 and 6 to the first instance for further examination has to be rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

A. Burkhart