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**Datasheet for the decision
of 22 September 2011**

Case Number: T 1621/09 - 3.2.03

Application Number: 02754043.4

Publication Number: 1417063

IPC: B22D 18/04

Language of the proceedings: EN

Title of invention:

Method for low pressure casting metal foam

Patentee:

Cymat Corp.

Opponent:

Hütte Klein-Reichenbach Gesellschaft m.b.H.

Headword:

-

Relevant legal provisions:

EPC Art. 113(1), 114(1),(2)

EPC R. 99(2), 116(1)

RPBA Art. 12(1),(2), 13(1),(2),(3), 15(3)

Relevant legal provisions (EPC 1973):

EPC R. 71a(1)

Keyword:

"Admission of late-filed arguments in appeal proceedings
having the effect of amending the party's case (no)"

"Novelty (yes)"

"Inventive step (yes)"

Decisions cited:

G 0004/92, G 0006/95
T 0092/92, T 0501/92, T 0861/93, T 0086/94, T 0414/94,
T 0432/94, T 0706/00, T 0604/01, T 0131/02, T 1421/05,
T 0704/06, T 0926/07, T 1553/07, T 0624/08, T 1050/09

Catchword:

(a) A new argument brought forward in appeal proceedings by a party which would have the effect of amending its case, even if the argument is based on evidence and facts already in the proceedings, can only be introduced into the proceedings at the discretion of the Board of Appeal by way of an amendment under Article 13 RPBA (Point 37(a) of the Reasons).

(b) To the extent that the decision of the Enlarged Board of Appeal in G 4/92 deals with the general admissibility of new arguments in appeal proceedings, it must be taken to have been modified in accordance with (a) above by the amendments to the RPBA introduced with effect from 1 May 2003 (Point 37(b) of the Reasons).

(c) Article 13(2) RPBA must be read subject to Article 15(3) RPBA, with the result that the absence of a duly summoned party does not prevent a Board from allowing an amendment to another party's case and reaching a decision on the basis of the amended case. The absence of the party is nevertheless a factor to be taken into account in the exercise of the discretion (Points 43 and 44 of the Reasons).



Case Number: T 1621/09 - 3.2.03

DECISION
of the Technical Board of Appeal 3.2.03
of 22 September 2011

Appellant: Hütte Klein-Reichenbach Gesellschaft m.b.H.
(Opponent) Kleinreichenbach 25
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
26 June 2009 concerning maintenance of European
patent No. 1417063 in amended form.

Composition of the Board:

Chairman: U. Krause
Members: G. Ashley
K. Garnett

Summary of Facts and Submissions

I. European patent EP-B1-1 417 063 concerns a method for casting articles from metal foam and was granted to the respondent in this case. Grant of the patent was opposed on the grounds of lack of novelty and inventive step (Article 100(a) EPC). The opposition division considered that the claims filed during the oral proceedings as the first auxiliary request met the requirements of the EPC, and hence decided that the patent could be maintained on this basis.

II. The above decision, which was posted on 26 June 2009, was appealed by the opponent (appellant), who filed notice of appeal on 5 August 2009 paying the appeal fee on the same day. A statement containing the grounds of appeal was filed on 19 October 2009.

III. In accordance with Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), the Board issued a preliminary opinion of the case, together with a summons to attend oral proceedings. In a letter dated 20 September 2011 the respondent announced that it would not be represented at the oral proceedings.

IV. Oral proceedings were held on 22 September 2011 in the absence of the respondent.

V. Requests

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested (in its letter of 22 February 2010) that the appeal be dismissed.

VI. Claims

Claim 1 as upheld by the opposition division reads as follows:

"1. A method of casting an article from metal foam comprising steps in the sequence as follows:

- a) providing a bath (32) containing said molten metal;
- b) providing a die (36) having a die cavity (38) in fluid communication with said bath through a tube (39), the die (36) being located above said bath (32);
- c) establishing a pressure within said bath (32) by passing a pressurizing gas into the bath (32) through a port (40), said pressurization causing the molten metal to be forced up the tube (39) and into the die cavity (38), and said pressurization being continued until the die cavity is filled with the molten metal;
- d) after the die cavity is filled in this manner, bubbling a gas through said molten metal to form a foam of said molten metal,
- e) causing said foam to enter and fill said die cavity (38);
- f) after allowing the foam to cool and solidify within the die cavity (38), releasing the pressure in said bath (32);

g) removing said foamed article (46) from said die cavity (38)."

Dependent claims 2 to 4 concern preferred embodiments of the method of claim 1.

VII. Prior Art

Of relevance for this decision are the following documents, which were mentioned in the contested decision and in the grounds of appeal:

D2: 15 Slides forming the basis of a presentation entitled "Development of a new processing technique based on the melt route to produce near net shape foam parts", given by Mr H. Flankl at the conference MetFoam 2001 held 18-20 June 2001, Bremen, Germany.

D6: DE-C1-43 26 982

VIII. Submissions of the Parties

(a) Novelty

In the grounds of appeal the appellant contested novelty and inventive step on the basis of the presentation by Mr Flankl (D2). Slide seven of the presentation depicts a process for low pressure casting of metal foam, in which gas bubbles rise through a melt to form a foam that collects in a mould cavity.

According to the appellant, the skilled person would readily see that the process shown in slide seven is carried out by either producing foamed molten metal which is then pressed into the mould, or by filling the mould with molten metal which is then foamed; both of these approaches are thus disclosed in D2 and hence the claimed method lacks novelty. In support of this submission the appellant provided affidavits ("*eidesstattliche Erklärungen*") from Dr John Banhart (D4) and Dr Brigitte Kriszt (D9).

At the oral proceedings, the appellant for the first time referred to slides six and thirteen of D2, which show components made from foamed metal. These components have a homogenous pore structure and a smooth outer surface, which the appellant submits can only be achieved by a process in which the mould is filled with molten metal prior to foaming. If the mould were filled with foam it would not be possible to obtain a smooth surface, and the act of pushing the foam into the mould would distort its structure.

The respondent submitted in the written part of the proceedings that slide seven clearly states that the sequence steps are "1. Melting, 2. Foaming and 3. Casting", ie the mould is filled with foam and not molten metal as defined in the method of claim 1. The claimed method is thus novel.

(b) Inventive Step

Starting from the process shown in slide seven of D2, the appellant defined the objective problem as being the provision of an alternative process for making cast

parts out of metal foam. A process in which the mould is filled with metal prior to foaming is readily apparent to the skilled person, as evidenced by affidavits D4 and D9. Hence the claimed method lacks an inventive step.

The respondent argued that a process in which the mould is filled with molten metal is inconsistent with the process shown in slide seven. In addition, there is no reason to assume that there are only two modes of operation. Starting from D2, the claimed sequence of process steps can only be derived by having knowledge of the invention.

Reasons for the Decision

1. The appeal is admissible.

Admissibility of Submissions Based on Slides Six and Thirteen of D2

2. It is first necessary to consider whether the new submission or argument of the appellant, referred to in Point VIII(a), above, should be taken into consideration. As to this, it may be helpful to set out the issues which the Board has considered in this respect, together with its conclusions. These are as follows:

- 2.1 Does the appellant's new argument amount to an amended case within the meaning of the RPBA, with the result that it is only admissible at the Board's discretion

under Article 13(1) RPBA? Answer: prima facie, yes (Points 4 to 14, below).

2.2 Given, however, that this new argument is based upon facts and evidence already in the appeal proceedings, is this prima facie conclusion affected by the well-established proposition that new arguments, as opposed to new facts or evidence, can be introduced at any stage of proceedings? Answer: no, because:

(a) This proposition admittedly holds good for proceedings before the departments of first instance (Points 17 to 22, below).

(b) Until 1 May 2003 it also held good for appeal proceedings (Point 24, below).

(c) In respect of appeals filed after this date, however, the position has been changed by the amendments to the RPBA which then came into force. In respect of such appeals, new arguments which have the effect of amending a party's case are admissible only at the Board's discretion (Points 25 to 35, below).

(d) Statements in decisions of the boards of appeal in respect of appeals filed since 1 May 2003, which appear to be contrary to this conclusion were either obiter dicta and/or were taken without reference to the RPBA (Points 36 to 37, below).

2.3 Where a new argument which constitutes an amendment to a party's case is put forward for the first time at

oral proceedings, how is the exercise of the Board's general discretion to admit the amendment affected if the party prejudiced is not present at the oral proceedings, even though duly summoned? Answer (points 39 to 44, below):

(a) The apparent conflict between Article 15(3) and Articles 13(2) and (3) RPBA is to be resolved in favour of permitting the exercise of such discretion.

(c) Nevertheless, the absence of the prejudiced party is a factor to be taken into account when exercising the discretion.

3. These issues are discussed in the following paragraphs.

Does the appellant's new argument amount to a new or amended case within the meaning of the RPBA?

4. Appeal proceedings are a judicial procedure (see e.g., Case Law of the Boards of Appeal of the European Patent Office, 6th Edition, page 821 VII.E.1), which is governed by the RPBA. These rules are enacted pursuant to the EPC (see Article 23(4) and Rule 12(3) EPC) and are binding on the boards of appeal (Article 23 RPBA).

5. The basic principle relating to the conduct of appeal proceedings is to be found in Article 12(1) RPBA, which states that: "(1) Appeal proceedings shall be based on (a) the notice of appeal and statement of grounds of appeal, (b) any written reply of any other party and (c) any communication sent by the Board and any answer thereto filed pursuant to directions of the Board."

6. Article 12(2) RPBA specifies that, in the case of an appellant, the statement of grounds of appeal must contain the party's complete case. It should set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed (or amended) and should specify expressly all the facts, arguments and evidence relied on. All documents referred to shall be identified in the prescribed way. If the appellant subsequently wishes to put its case in another way, this requires the case to be amended. This is clear from Article 13(1) RPBA, which provides inter alia that any amendment to an appellant's case after it has filed its grounds of appeal may be admitted and considered at the Board's discretion
7. It is therefore important to consider what is meant by a party's "case". The equivalent expression appears in at least two different forms in the German version of the RPBA. In Article 12(2) the equivalent expression is "*Sachvortrag*" but in Article 13(1) the expression used is "*Vorbringen*". In the French version the expression used in both articles is "*moyens invoqués*" (although in Article 13 this appears only in the title). Since the relevant parts of *travaux préparatoires* for these articles are in English, the Board has taken the English language version as its starting point.
8. A party's "case" may not be a very precise judicial concept but it is generally well understood: in the case of an appellant, it describes the totality of the reasons why it says that a decision should be set aside (or amended) and why any other requests it makes should be granted. It clearly includes, in the words of

Article 12(2) RPBA, the "facts, arguments and evidence relied on" by a party to justify the setting aside of the decision under appeal. This is consistent with Rule 99(2) EPC, which requires the statement of the grounds of appeal to indicate the reasons for setting aside the decision impugned (or the extent to which it is to be amended), and the facts and evidence on which it is based.

9. Since the arguments relied on thus constitute part of a party's case, it appears to the Board that new arguments, even when based on facts and evidence already in the proceedings, can have the effect of altering a party's case: the facts and evidence relied on can be assembled in different ways using different arguments. On the other hand, there will clearly be many situations where a new argument does not change a party's case. For example, it may be just be a different way of looking at the same point. So, in the present appeal it might be said that the appellant's case on novelty is that D2 is novelty destroying. The Board considers, however, that this is too simplistic a view. In reality, the two ways of presenting the novelty attack set out in Point VIII(a), above, are different in substance, and, in the Board's view, are different cases. Such a conclusion is very case-specific (i.e., it depends very much on the specific circumstances of the appeal) but the Board reaches it taking into account in particular the fact that the two attacks are inconsistent, and the second attack is a departure from and not just a development of the first.
10. This can be seen from a close examination of the course of the proceedings. The Opposition Division held that

slide seven of D2 was not novelty destroying as regards the present request since inter alia there was no clear disclosure whether the foaming step took place with the die cavity already full of molten metal, as required by claim 1, or whether the cavity was first empty and then filled with foamed metal. The other documents cited in this respect (D4 and D3) did not clarify the position. The appellant had argued that since there were only two possibilities, both known to the skilled person, the skilled person would inevitably consider this feature of claim 1 as being disclosed. In this respect, the appellant had in fact argued that it made no difference to the product where foaming took place (see Point 7, page 3, paragraph 4 of the minutes). The inventive step argument also turned on whether the choice of an alternative method of foaming was obvious (see Point 4.4 of the Reasons)

11. In the statement of grounds of appeal the appellant complained at length of the opposition division's failure to hear Dr Barnhart in support of his statement (D4) regarding what the skilled person would have gathered from the presentation (D2). In D4 Dr Barnhart explained that to him, as an expert, it was irrelevant in which of the above two ways the foaming took place, both of which were known to him. He referred to Figure 2 of D3, which is in effect the same as slide seven of D2. The appellant also offered a further witness, Dr Kriszt, who in her statement (D9) effectively said the same thing as Dr Barnhart. The appellant's case was thus that the relevant steps (steps (d) and (e)) were disclosed from the relevant slide of D2 (slide seven) coupled with the explanation by Dr Barnhart and Dr Kriszt (see page 5 of the statement of the grounds

- of appeal). The point was repeated at length in the context of the argument on lack of inventive step: even if there was no clear and unambiguous disclosure of this aspect of the method, it was not inventive to choose one of the disclosed methods (see pages 5 to 8 of the statement of grounds of appeal).
12. This case was addressed by the respondent in its reply dated 22 February 2010 and at length in the Board's communication sent with the invitation to oral proceedings (see pages 2 to 5).
13. As indicated above, during oral proceedings before the Board the appellant sought to advance a different (or at least alternative) case, now based on the disclosure of slides six and thirteen. It was now said that from the appearance of the articles shown in these slides it would have been clear to the skilled person that the method as disclosed in D2 involved filling the empty mould with molten metal and then foaming it. In the Board's view, although based on facts and evidence already in the proceedings, this was a new or alternative case based on those facts and evidence. Indeed, not only was it a new case, it was a case which was contrary to the appellant's previous case.
14. Prima facie, therefore, this new or amended case could only be admitted at the board's discretion.

Submissions Based on Slides Six and Thirteen of D2: a new argument only?

15. Nevertheless, there are many statements in the jurisprudence of the boards of appeal which clearly

state that new arguments can always be admitted or advanced by a party if such arguments are based on facts or evidence which are already part of the proceedings. It is therefore necessary to examine how this apparent conflict is to be resolved.

16. The Board will first consider the jurisprudence of the boards of appeal in this respect.

17. In T 92/92, the appellant argued that the opposition division had been wrong to accept a new line of argument based on documents already in the opposition proceedings. The Board observed (Point 2 of the Reasons) that the right to a fair hearing included the right to present facts, evidence and arguments relevant to the decision to be made. Article 114(2) EPC provided a basis for disregarding "facts or evidence" not submitted in due time and thus in effect placed a limit on the extent of this right. By contrast, there was no mention in the article of "arguments" (which the Board understood as including the parties' submissions as to the consequences that result from applying the law to the facts and evidence). There was therefore no basis in the article for disregarding arguments, whenever they were brought forward.

18. So far as concerns first instance oral proceedings, this principle is given further procedural effect by Rule 116(1) EPC (formerly Rule 71a EPC 1973), which provides that: "When issuing the summons, ... a final date for making written submissions in preparation for the oral proceedings shall be fixed. ... New facts and evidence presented after that date need not be

considered, unless admitted on the grounds that the subject of the proceedings has changed."

19. In G 4/92 (OJ EPO 1994, 149), decided shortly after T 92/92, the Enlarged Board considered the question whether, if one party chooses not to attend oral proceedings, a decision against that party can be based on new facts and evidence, and/or new arguments, put forward during those oral proceedings. As to new facts and evidence, the Enlarged Board started from Article 113(1) EPC, which recognises that a decision may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. The Board referred to Articles 114(1) and (2) EPC and the possibility of the opposition division or Board of Appeal examining late-filed facts or evidence, but concluded that the other party must be given the opportunity to comment on such material, and a decision may therefore not be based on facts or evidence put forward for the first time during oral proceedings when the other party is absent. As to the admissibility of new arguments during oral proceedings at which the other party is not present, the Board said: "... the requirements of Article 113(1) EPC have been satisfied even if a party who has chosen not to appear consequently did not have the opportunity to comment on them during oral proceedings, insofar as such new arguments do not change the grounds on which the decision is based. In principle, new arguments do not constitute new grounds or evidence, but are reasons based on the facts and evidence which have already been put forward." (Point 10 of the Reasons). As part of its Conclusions, the Board said: "... new arguments may in

principle be used to support the reasons for the decision." (Conclusions, Point 2).

20. The main principle to be extracted from G 4/92 is therefore that a decision may not be taken at the end of oral proceedings based on new facts or evidence presented for the first time during those oral proceedings in the absence of the prejudiced party. The subsidiary point is that in principle such a decision can be based on new arguments presented at such oral proceedings.

21. In the light of later statements about this decision, it is worth noting that the statement of the Enlarged Board about new arguments was not absolute. New arguments brought forward in the absence of the other party may "in principle" be used to support the reasons for the decision but new arguments which have the effect of changing the grounds on which the decision is based are not acceptable under this principle. The Board thus apparently recognised the possibility of new arguments having the potential to change the grounds on which a decision was based, and therefore potentially infringing the absent party's rights under Article 113(1) EPC. In T 501/92 (OJ EPO 1996, 261) the Board indeed recognised that a submission which amounted to a new legal reason why an appeal should be allowed, even though based upon the facts already in proceedings, was a new "ground" within the meaning of Article 113(1) EPC, rather than merely a new argument. It would therefore have been contrary to Article 113(1) EPC, and contrary to the principles underlying G 4/92, to act on the basis of the submission, without first

giving the absent party an opportunity to present comments in reply. See Point 1 of the Reasons.

22. As regards first instance proceedings, the combined effect of Articles 113(1) and 114(2), as explained in G 4/92 and T 92/92, has been consistently applied by the Boards of Appeal.

(a) In T 861/93 the Board held that the opposition division had been wrong to exclude citations from board of appeal decisions as late-filed documents under Article 114(2), since these were part of the party's arguments.

(b) In T 131/02 (OJ EPO 2003, 115), the opposition division had under Rule 71a(1) EPC 1973 refused to admit a new argument on lack of inventive step based on documents already in the proceedings. The Board held that this was wrong. Only new facts and evidence could be excluded under Rule 71a(1) EPC 1973. Nor could such a step be justified under Article 114(2), the Board citing G 4/92.

(c) In T 604/01 the opponent had during the opposition proceedings raised objections under Articles 123(2) and (3) but did not further explain the objections until oral proceedings. The Opposition Division excluded the objection, relying on Rule 71a(1) EPC 1973. The Board held that this was wrong: the relevant facts (the application, the granted claims and the amended claims) were all in the proceedings; the objections were then a matter of argument.

23. Before 2003 the same principles were applicable to appeal proceedings. Article 114(2) applied to such proceedings, even though Rule 71a EPC 1973 did not: see G 6/95 (OJ EPO 1966, 649). The then current RPBA (see OJ EPO 1980, 171, as amended: OJ EPO 1983,7; OJ EPO 1989, 361; and OJ EPO 2000, 316) made no special provision relating to facts, evidence or arguments, the only relevant provision being Article 11(1) RPBA (since deleted), which stated that: "If oral proceedings are to take place, the Board concerned shall endeavour to ensure that the parties have provided all relevant information and documents, before the hearing." The principles enunciated in G 4/92, above, also applied to appeal proceedings since they concerned the right to be heard under Article 113(1) EPC.

24. The case law of the boards of appeal also confirms this position as regards appeal proceedings:

(a) In T 432/94 it was stated that although in accordance with Article 108 EPC an appellant had to state in its grounds of appeal the legal and factual reasons why the contested decision should be set aside, this did not mean that an appellant was bound to this line of argument for the whole appeal proceedings. Such a strict rule would prevent an appellant from reacting appropriately if it came to realise that its original arguments were not convincing. The general procedural provisions of the EPC, such as Article 114(2) and Rule 57 EPC 1973, provided enough flexibility for preventing possible misuse by means of delaying relevant submissions.

(b) In T 86/94 the Board stated that whilst it was desirable that all relevant arguments be brought at the earliest possible stage of the proceedings, there was again no requirement in Article 108 EPC that the statement of grounds of appeal be exhaustive as to the arguments to be brought. The new argument in that case was not a new ground of appeal and it was the very purpose of appeal proceedings, and in particular of oral proceedings, to provide an opportunity to a losing party to throw new light on relevant aspects of matters which had been decided to its detriment and/or to draw attention to facts in the reasoning of the first instance department that resulted in an adverse decision. This could in practice be best achieved by reliance on new arguments: a mere rehearsal of what went before would be ineffectual.

The amendments to the RPBA and the travaux préparatoires

25. With effect from 1 May 2003, the RPBA were amended and inter alia the provisions of what are now Articles 12, 13 and 15 were introduced: OJ EPO 2003, 89. (In what follows references will be to the current numbering of the articles, although this numbering has changed over time.) This was part of a major revision of the RPBA, the first draft of which was prepared by the "Procedure Working Party" as part of a report to the chairmen and members of the boards of appeal ("the PWP Report"). In paragraphs 1.2 to 1.4 of the PWP Report it was explained that the changes being made contained measures which were intended to increase the efficiency and shorten the length of appeal proceedings, these measures relating to the "core" of appeal proceedings,

namely written and oral proceedings and certain related matters such as late-filing and costs. The existing "philosophy" of the appeal procedure as developed by the boards and the Enlarged Board was to be maintained, in particular the established discretionary powers of the Boards, while introducing some elements of case-law into the RPBA and at the same time seeking to ensure that the RPBA contained a similar degree of detail and certainty as were found in the procedural rules of other courts. The measures were aimed at achieving the goal of more efficient and shorter appeal proceedings to include a more defined and controlled initial phase of proceedings, a more pragmatic exercise of discretion under Article 114(2) EPC thereafter, increased case management (as practised in many national courts), and the incorporation from the then current practice and case-law in the RPBA of certain principles of oral proceedings and costs to give those principles a clear legal basis.

26. In relation to Articles 12 and Article 13(1), paragraph 2.1 of the PWP Report explained that they provided a cut-off point after which any further material submitted would be ipso facto late, codified the Board's existing power to ignore material unrelated to a case, and made extensions of time not only discretionary (as was already the case) but also exceptional. It concluded that the moment in time when a party's case would be considered to be complete (so that the Board was able to assess a case in its entirety and, subject to oral proceedings, take a decision) would now be fixed objectively by the rules and no longer subject to the procedural strategy of the parties.

27. As to Article 13 itself, the PWP Report explained in paragraph 2.2 that it made the admissibility of any amendment to a party's case as filed ("whether relating to facts, evidence, arguments or requests") after the cut-off point defined by Articles 12(1) and 13(1) a matter for the Board's discretion, but gave the Board a specific authority to refuse the amendment on the grounds of complexity of the new subject matter submitted, of the current state of proceedings and the need for procedural economy. In particular, amendments should not be admitted if they would lead to adjournments of oral proceedings.
28. Paragraph 2.3 of the PWP Report explained that the intended overall effect of these amendments was to prevent "ping pong" submissions and "salami" tactics in written proceedings and to provide the Board (and the rapporteur in particular) with an appeal file containing one comprehensive submission from each party.
29. Express consideration was not given in the PWP Report to the possible effect of the amendments to the RPBA on the jurisprudence of the boards of appeal regarding new arguments as developed in G 4/92, T 92/92 and subsequent decisions (see Points 16 - 24, above). Although the PWP Report referred to G 4/92, this was not in the context of Articles 12 and 13 but in the different context of Article 15 RPBA (see Point 41, below).
30. The PWP Report was considered by the Presidium of the Boards of Appeal on 16 September 2002 and the draft amended rules, with some additional amendments, were

sent to the Committee on Patent Law with explanatory notes (CA/PL 11/02).

31. The Committee on Patent Law considered the amendments at its meeting held on 15 and 16 October 2002. In reply to a question from the German delegation about Article 13(1) (i.e., concerning amendment to a party's case), the Office confirmed that the article "precluded new substantive submissions, but not a change in their legal appraisal. The wording chosen was designed to give the case law room to evolve." (See Point 105 of the minutes, CA/PL PV 19).

32. The Presidium of the Boards of Appeal adopted the amended rules, with certain further small changes, at its meeting on 28 October 2002, and the rules were sent to the Administrative Council with a consultative document (CA/133/02, original language English, hereafter the "Consultative Document") which largely repeated the wording of the PWP Report. One potentially significant difference is that whereas the PWP Report had referred in the context of Article 13(1) to amendment to a party's case as filed, "whether relating to facts, evidence, arguments or requests" (see Point 3.11, above) the Consultative Document referred only to an amendment to a party's case "whether relating to facts, evidence or requests".

33. In summary, the *travaux préparatoires* do not address expressly the question whether the general principle that new arguments are allowable at any stage of proceedings should continue to apply in appeal proceedings. Nevertheless it can be said that overall the changes were aimed at increasing the efficiency and

shortening the length of appeal proceedings, inter alia by providing that the appeal file should contain one comprehensive submission from each party. The exchange of the grounds of appeal and reply would thus effect a more defined and controlled initial phase of proceedings, providing a moment in time fixed by the rules when a party's case would be complete and could be assessed in its entirety, and such that any further material submitted would be ipso facto late. Again, the *travaux préparatoires* do not make explicit what was meant by a party's "case" or when amendment to it might be required, except that (apparently - see Point 31, above) the requirement for amendment was intended to make new substantive submissions admissible only by way of amendment, although the wording chosen was designed to give the case law room to evolve. As already seen (Point 8, above), Article 12(2) implies that the concept of a party's "case" refers to all the facts, arguments and evidence relied on to justify its requests. Against this, the change in the wording between the PWP Report and Consultative Document noted in Point 32 above indicates perhaps that new arguments alone were not considered to be the subject matter of amendment, although the extended wording ("whether relating to facts, evidence or requests") is in fact not limiting and was not repeated in the accompanying draft text and is not found in the present rule.

34. It appears to the Board that the choice of the word "case" as opposed, for example, "facts, evidence and requests" must have been intended to have some effect. One of the ways of making appeal proceedings more efficient was to require the parties to state their position (their case) from the outset, not least so

that the other party or parties and the Board could know what it was and react accordingly. So far as the *travaux préparatoires* are concerned, it does not appear to have been the intention to permit a party, having grounded its appeal on arguments based on specific evidence and facts, then to be able to alter its case with new arguments as it went along, or at least not without taking the formal step of gaining permission to amend its case.

35. These considerations are therefore consistent with the above preliminary conclusion reached by the Board (Point 14, above).

Subsequent case law

36. So far as the Board is aware, the possible effect of this alteration of the RPBA has not been considered in detail in any decisions of the boards of appeal.

- 36.1 In T 704/06, the applicant/appellant raised a new inventive step argument during the oral proceedings, described by the Board as "an entirely new approach", which the Board nevertheless admitted into the proceedings, saying:

"3. In accordance with the case law, Article 114(2) EPC does not provide a legal basis for disregarding late-filed arguments on the grounds that they were presented for the first time at the oral proceedings (cf. T 92/92 of 21 September 1993). It is the very purpose of appeal proceedings, particularly oral proceedings, to provide an opportunity for a losing party to throw

new light on relevant aspects of matters which have been decided to its detriment (cf. T 86/94 of 8 July 1997). The appellant is not bound to the line of arguments he used in the statement of grounds for the whole appeal proceedings (cf. T 432/94 of 19 June 1997). Thus the new argument is not rejected for being late-filed."

The Board did not refer to Article 13(1) RPBA, even though the appellant's new argument appears to have amounted to an amendment of its case in the sense understood by the present Board. It may well be that in such an ex parte case the Board would in any event have been willing to exercise its discretion to allow such an amendment, since the new argument raised a difficult issue and the Board said it was not willing to issue a positive decision to grant a patent on less than solid grounds nor to refuse an application which might contain patentable subject-matter (see Point 5 of the Reasons). The Board therefore remitted the case to the Examining Division for further prosecution taking into consideration the situation created by the appellant's new argument.

36.2 In T 926/07 the opposition division had refused to allow the opponent to present a new inventive step attack during oral proceedings based on evidence of a prior use which was already part of the proceedings. The Board of Appeal, referring to Article 114(2) EPC and Rule 71a EPC 1973, held that this had been wrong, since the attack was a new argument, not new facts or evidence. However, the Board appears to have taken the view that new arguments could be brought forward at any stage of proceedings, including appeal proceedings.

("Dementsprechend sind Argumente, denen rechtzeitig vorgebrachte Tatsachen zugrunde liegen, in jeder Phase des Einspruchs - oder Einspruchsbeschwerdeverfahrens zuzulassen." (Underlining added)). However, no reference was made to the RPBA and the remark relating to appeal proceedings was clearly obiter.

36.3 In T 1553/07 the opposition division again refused to allow the opponent to bring forward a new attack based on prior use. The Board considered that the facts and evidence for this prior use were already in the proceedings and that therefore the opposition division had been wrong to exclude the attack, referring to Article 114(2) EPC and Rule 71a EPC 1973, since it was a new argument only. The Board, however, also stated that new arguments could be brought forward at any stage of proceedings, citing T 131/01 and T 926/07 (*"Regel 71a (1) EPÜ 1973 bezieht sich wie auch der zugrundeliegende Artikel 114 (2) EPÜ 1973 auf verspätet vorgebrachte Tatsachen und Beweismittel, nicht jedoch auf neue Argumente, die während des gesamten Verfahrens vorgebracht werden können."* Emphasis added). Again, however, insofar as the Board intended to include appeal proceedings in this statement, the remark was obiter and, again, no reference was made to Article 13 RPBA.

36.4 In T 1050/09 the Board rejected the proprietor's submission that a new argument from the opponent should not be considered, on the grounds that new arguments, opposed to new facts and submissions were always allowable, even though brought forward for the first time at oral proceedings, citing Article 114(2), T 92/92 and G 4/92. See Point 2.1 of the Reasons. The

Board did not, however, refer to the RPBA, and in any event it would seem that the new argument did not amount to an amendment to the opponent's case.

36.5 In T 1421/05 and T 624/08 the respective Boards, without discussion, proceeded on the basis that a new Article 83 EPC attack, although based on documents already in the appeal proceedings, would require amendment to the party's case, which was not allowed. (Points 14.3, and 4.2 and 4.3 of the Reasons respectively).

37. The relevant case law therefore consists of either obiter statements and/or statements made without reference to the RPBA or cases in which the point has not been discussed. The Board therefore considers that there is nothing in the jurisprudence of the boards of appeal or in the *travaux préparatoires* to cause it to think that the view provisionally reached in Point 14 above is wrong, above and concludes that:

(a) A new argument brought forward in appeal proceedings by a party which would have the effect of amending its case, even if the argument is based on evidence and facts already in the proceedings, can only be introduced into the proceedings at the discretion of the Board of Appeal by way of an amendment to the party's case.

(b) To the extent that the decision of the Enlarged Board in G 4/92 deals with the general admissibility of new arguments, it must be taken to have been modified in accordance with (a) above

by the Rules of Procedure of the Boards of Appeal introduced with effect from 1 May 2003.

38. The above considerations relating to amendment of a party's case obviously do not apply where the Board has *ex officio* raised an issue. Article 12(1) RPBA provides that appeal proceedings shall be based not only the parties' written submissions but also any communication from the Board.

Admissibility of Submissions Based on Slides Six and Thirteen of D2 in the absence of the respondent: the Board's discretion.

39. The exercise of the Board's discretion to allow amendments to a party's case is governed by Article 13 RPBA, which provides:

"(1) ... The discretion shall be exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy.

(2) Other parties shall be entitled to submit their observations on any amendment not held inadmissible by the Board *ex officio*.

(3) Amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings."

40. In the present case, there is a further complicating factor, namely that the respondent was not present at the oral proceedings when the question of amendment arose, although duly summoned. As to this, Article 15(3) RPBA provides:

"The Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case."

41. It is not immediately clear what the relationship is between Article 15(3) and Articles 13(2) and (3) RPBA. As with Article 13, Article 15(3) RPBA was entirely new when introduced with effect from 1 May 2003. The main intention behind Article 15(3) RPBA appears to have been to nullify the effect of G 4/92 in so far as it prevented a board of appeal admitting new facts and evidence at oral proceedings in the absence of a party and then deciding the case without giving the absent party the opportunity to comment. See the Consultative Document (CA/133/02), page 20, and T 706/00, Point 2.2 of the Reasons (obiter).

42. The Board, however, is concerned with a different issue, namely the amendment to a party's case at oral proceedings in the absence of the party prejudiced. Articles 13(2) and (3) RPBA both essentially provide that the other party is always entitled to comment and react to an amended case. New facts, evidence and arguments can support a party's existing case without requiring amendment to the case and so in such circumstances it makes perfect good sense to say that

the absent party can be taken to rely on its written submissions in answer to that case. But it perhaps makes less good sense to say that where a party amends its case, an absent party can be taken to rely on its written submissions: it may well never have addressed the amended case in those submissions, being unaware that the other party would wish to put its case in such a way.

43. Nevertheless, the wording of Article 15(3) RPBA is perfectly general and appears to be quite broad in its intended effect. The Board considers that it provides an exception to the more general provisions of (in particular) Article 13(2) in the special case of a duly summoned party being absent. This is consistent with the intention expressed on page 20 of the Consultation Document which, although primarily concerned with the effect of G 4/92, indicates generally that the absence of a party at the oral proceedings need not delay any subsequent step in the case:

"[Article 15(3)] provides that the absence of a party at the oral proceedings need not delay any subsequent step in the case, including the decision, and that a party which absents itself may be treated as relying only on its written case. These powers are discretionary, and a Board would no doubt take into account any reason provided for absence ..."

44. The Board therefore concludes that it remains a matter for the Board's discretion to allow an amendment to a party's case in the absence of the prejudiced party. The absence of the prejudiced party is a factor to be

taken into account but does not prevent the board from allowing the amendment and proceeding to reach a decision on the basis of the case as now amended.

Admissibility of Submissions Based on Slides Six and Thirteen of D2 in the absence of the respondent: the exercise of the Board's discretion

45. The Board, in the exercise of this discretion, decided however not to allow the appellant to amend its case, for the following reasons:

- (a) As already explained, the new argument amounts to a new way of putting the appellant's case on novelty. Indeed, it is contradictory to the appellant's previous case.
- (b) The new argument also impacts on the inventive step attack.
- (c) The new argument was raised at the last stage of the appeal, namely during oral proceedings.
- (d) There was no reason why the new argument could not have been raised earlier. It was not occasioned by a new point raised by the respondent in its reply or by the Board in its communication.
- (e) The new case was raised during oral proceedings in the absence of the respondent. The implications of this have already been referred to (Points 39 to 44, above) but the fact remains that the respondent had never dealt with the new case in

its written submissions since it had never been part of the appellant's case.

- (f) An absent party must expect reactions of the opposing party within the legal and factual framework of the case established prior to oral proceedings, and thus the possibility of decisions taking account of, and being based on, such reactions (T 414/94, Point 2.3 of the Reasons). However, the respondent had no reason to expect that the appellant would wish to raise this new argument or amend its case in this way.

- (g) The new argument was not based on a simple, incontrovertible piece of evidence in the proceedings. Rather it was based upon the inferences to be drawn from what was shown by slides six and thirteen. The appellant argued that from the smooth surfaces of the products shown in these slides it would have been clear to the skilled person that these products had been produced by a process according to claim 1 of the main request, i.e., by foaming the liquid aluminium after it had been introduced into the mould. During the oral proceedings the appellant explained the reasons for drawing this inference, and while the explanation seemed plausible to the Board, the Board was not able to say that it was clearly correct, involving, as it did, technical expertise. The respondent, not being present, was also not able to give its comments on the explanation.

Novelty (Article 54 EPC)

46. The following deals with the arguments according to appellant's case as formulated in the grounds of appeal (i.e. without any amendment).
47. The appellant argued that on viewing slide seven of D2 the skilled person would recognise that either foamed metal is introduced into the mould or the mould is filled with molten metal which is foamed *in situ*; hence both methods are clearly disclosed.
48. In support of its submission, the appellant relies upon the opinions of Dr Banhart (D4) and Dr Kriszt (D9), whom the appellant submits are "real" persons skilled in the art.

That Dr Banhart and Dr Kriszt are skilled practitioners in the art of metal foam casting is not in doubt. However, the skilled person for the purposes of the EPC is a legal fiction, and can be described as being an ordinary practitioner aware of common knowledge in the art and having access to everything in the state of the art available at the priority date, but having no inventive capability, as it is this capability that distinguishes the inventor from the notional skilled person (see Case Law Book, 6th Edition, I.D.7.1, page 180). It is questionable whether either Dr Banhart or Dr Kriszt could be described as merely being ordinary practitioners having no inventive capability, and the affidavits were in any event written with the knowledge of the disputed invention. The Board therefore treats the evidence of Dr Banhart and Dr Kriszt with caution.

49. Slide seven depicts a bath of molten aluminium and a mould located on the surface of the melt. Gas bubbles are shown rising through the melt to form a foam that collects in the mould cavity. The melted metal is shown in grey, the left-hand side of the mould is coloured black and the right-hand side is schematically shown to contain bubbles. There is no indication from the figure that foaming takes place in a mould full of molten metal. The processing steps indicated on the slide read "1. Melting, 2. Foaming, 3. Casting", and thus there is also no indication here that foaming occurs after the mould is filled. There is also, as argued by the respondent, no disclosure of pressure being applied to the melt in order to force the liquid metal into the mould, as is required in claim 1.
50. For the claimed method to lack novelty with respect to D2, all the features must be directly and unambiguously derivable from the disclosure. The test for novelty is strict, and the figure and wording of slide seven, while not explicit, in fact tend more to indicate that foaming takes place before the mould is filled rather than afterwards. To derive a different sequence of processing steps goes beyond the disclosure, even taking into account the common knowledge of the skilled person. The claimed method is thus novel when compared with slide seven.

Inventive Step (Article 56 EPC)

51. D2 can be considered as a suitable starting point for the assessment of inventive step as, like the claimed method, it is concerned with the casting of foamed

metals. Slide seven discloses a method involving the steps of melting the metal, foaming it and then casting it, ie introducing the foamed metal into the mould. However, the exact manner by which the foamed material is cast is not derivable from the slide.

52. Therefore, starting from slide seven of D2, the objective problem to be solved is how to put the schematically depicted process into practice.
53. There were several methods known at the priority date of the disputed patent by which foam could be cast. Document D6, for example, discloses embodiments by which foam is introduced into the mould either by pressure on the melt or by the action of piston (see Figures 2, 3, 4 and 5). On seeing slide seven the skilled person would therefore consider one of these techniques.
54. As set out above, the appellant argues that there are only two ways by which the process of slide seven can be put into practice, either by filling the mould with foam or by filling it with metal and foaming it *in situ*. The opposition division and the respondent consider this analysis can only be made by having prior knowledge of the claimed invention (see page 9, third paragraph of the disputed decision); the Board agrees with this for the following reasons.
55. None of the cited prior art documents mentions the possibility of filling the mould with molten metal prior to foaming; such a technique is only referred to in the affidavits D4 and D9, ie by specialists having knowledge of the invention. But importantly, slide

seven appears to teach the step of foaming before casting; there is no indication either from the figure or the wording of the slide that the mould could be filled with melt prior to foaming. The skilled person would have had no incentive to adopt such a step, particularly as it does not correspond to the information presented in the slide.

56. The claimed method thus has an inventive step.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Hampe

U. Krause