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**Datasheet for the decision
of 19 December 2013**

Case Number: T 1732/10 - 3.2.07

Application Number: 03738853.5

Publication Number: 1521642

IPC: B05B15/08, B05B12/04, B05B1/32

Language of the proceedings: EN

Title of invention:
DEVICE FOR THE APPLICATION OF A FLUID

Patent Proprietor:
Eftec Europe Holding AG

Opponents:
ABB PATENT GmbH
Dürr Systems GmbH

Headword:

Relevant legal provisions:
RPBA Art. 12(1)(b), 12(2), 13(1), 13(3), 15(6)

Keyword:
Late-filed main and auxiliary requests 1 to 10 - not admitted
Reinstating a withdrawn request as late as at the oral
proceedings-late amendment of the case, not admitted

Decisions cited:
T 1621/09, T 0888/02

Catchword:

Not reacting in substance to the appeal of the opponent, but waiting for the Board's preliminary opinion before any substantive reaction is filed, is regarded as an abuse of procedure. It is contrary to the equal distribution of rights and obligations upon both sides in *inter-partes* proceedings and to the principle that both sides should set out their complete case at the outset of the proceedings. Both principles are clearly established by the Rules of Procedure of the Boards of Appeal.

This is all the more so if the substantiation for all the requests, which were filed after summons to oral proceedings have been sent, is filed only shortly before the oral proceedings before the Board. Such requests - which are not self-explanatory - are considered by the Board as submitted only on the date of their substantiation. Such very late requests are contrary to procedural economy, do not take account of the state of the proceedings and cannot be reasonably dealt with by the Board without adjournment of the proceedings or remittal to the department of first instance, contrary to Article 13(1) and 13(3) RPBA.

Where such very late requests take up subject-matter only available from the description, it cannot automatically be assumed that it was covered by the initial search, nor that it is automatically the responsibility of the opponent to perform such a search (see points 1.1 to 1.8).



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Case Number: T 1732/10 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 19 December 2013

Appellant: Dürr Systems GmbH
(Opponent 3) Otto-Dürr-Strasse 9
70435 Stuttgart (DE)

Representative: Beier, Ralph
v. Bezold & Partner
Akademiestrasse 7
80799 München (DE)

Respondent: Eftec Europe Holding AG
(Patent Proprietor) Grafenauweg 8
6304 Zug (CH)

Representative: Hepp Wenger Ryffel AG
Friedtalweg 5
9500 Wil (CH)

Party as of right: ABB PATENT GmbH
(Opponent 1) Kallstadter Strasse 1
68309 Mannheim (DE)

Representative: Miller, Toivo
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 17 June 2010 rejecting the opposition filed against European patent No. 1521642 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman: H. Meinders
Members: G. Patton
E. Kossonakou

Summary of Facts and Submissions

I. Opponent 3 (appellant I) filed an appeal against the decision of the opposition division to reject the oppositions and maintain the European patent No. 1 521 642 as granted.

Opponent 2 (appellant II) also lodged an appeal against this decision and filed a statement of grounds for it. The appeal was subsequently withdrawn with its letter of 23 March 2011 and the opposition with letter of 24 August 2011.

The oppositions had been filed against the patent as a whole and were based on the grounds according to Article 100(a) EPC (novelty and inventive step), Article 100(b) EPC (sufficiency of disclosure) and Article 100(c) EPC (extension beyond the content as originally filed).

II. In its reply to the statements of grounds of appeal dated 9 September 2011 the patent proprietor (respondent) requested "*to reject the appeal of opponent 03 as unfounded and to maintain the patent as granted*". No argument whatsoever was filed with this reply.

III. In the course of the appeal proceedings, the Board provided its preliminary non-binding opinion annexed to the summons for oral proceedings that the claims of the patent as granted did not appear to fulfil the requirements of the EPC in view of Articles 54(1) and 56 EPC.

In reaction, the respondent filed with the letter of 15 October 2013 a new main request together with

auxiliary requests 1 to 5. The substantiation for these requests with respect to novelty and inventive step came only later, with the letter dated 16 December 2013, together with additional auxiliary requests 6 to 10.

During the oral proceedings held on 19 December 2013 admissibility of the respondent's requests in the light of the provisions of Articles 12(1), 12(4), 13(1) and 13(3) RPBA was discussed.

The present decision was announced at the end of the oral proceedings.

- IV. Appellant I requests that the decision under appeal be set aside and the European patent No. 1 521 642 be revoked. It further requests that the respondent's main and auxiliary requests 1 to 5 filed with the letter of 15 October 2013 and auxiliary requests 6 to 10 filed with the submissions of 16 December 2013 not be admitted into the proceedings. If the said requests were to be found admissible, it requests the adjournment of the oral proceedings or, subsidiarily, the remittal of the case to the department of first instance and - in both cases - the apportionment of the respective costs in its favour. Further, in case the Board would consider the requests admissible, it requests the referral of a question to the Enlarged Board of Appeal regarding the proper conduct of proceedings. A proposed wording for such a question had been submitted with its letter of 6 December 2013. It further requests that the respondent's request for remittal of the case to the department of first instance not be admitted. Finally, it requests that any arguments to be presented by the respondent, in case of a discussion of the case on the merits, be considered

new arguments in the sense of Article 13(1) RPBA and not be admitted into the proceedings.

- V. The respondent requests that the decision under appeal be set aside and the patent be maintained in accordance with the new main request filed with letter dated 15 October 2013 or one of the auxiliary requests 1 to 5 filed with said letter or one of the auxiliary requests 6 to 10 filed with letter dated 16 December 2013. Subsidiarily, it requests the remittal of the case to the department of first instance.

The respondent further requests that its former main request (submitted with letter dated 9 September 2011) that the appeal be dismissed and the patent maintained as granted be considered either as a request still in the proceedings or as auxiliary request 11.

- VI. The following documents of the opposition proceedings:

D1b: WO-A-97/02901, cited in the contested patent,
paragraph [0004]

D5: US-A-4 683 912

D19: US-A-6 325 302

and as mentioned by appellant II for the first time in the appeal proceedings:

A1: EP-A-0 395 790

are cited in the present decision.

VII. Appellant I argued essentially as follows:

Admissibility of the respondent's main request and auxiliary requests 1 to 5

The behaviour of the respondent is a clear abuse of proceedings. The respondent did not submit any single argument with its reply to the statements of grounds of appeal, which should be complete to comply with Article 12(2) of the Rules of Procedure of the Boards of Appeal (hereafter "Rules of Procedure" or RPBA) and deal with both appeals. Consequently, the filing of the new main request and auxiliary requests 1 to 5 and the later corresponding substantiation for them amounts to amending the respondent's case after filing the reply so that their admission is in any case subject to Article 13(1) RPBA, i.e. to the discretion of the Board. When such requests are filed or substantiated only shortly before the oral proceedings, as in the present case, Article 13(3) RPBA becomes applicable.

The respondent has never provided any valid reason which could have justified the late filing of the requests and the even later submission of their substantiation. The Board's preliminary opinion cannot be such a reason since it merely confirmed what was raised with the appeals.

Consequently, the main request and auxiliary requests 1 to 5 should not be admitted in the proceedings.

Admissibility of the respondent's auxiliary requests 6 to 10

Auxiliary requests 6 to 10 should not be admitted in the proceedings either for the same reasons as put

forward for the main request and auxiliary requests 1 to 5.

Admissibility of the respondent's original request to dismiss the appeal and to maintain the patent as granted

It is clear from the respondent's written submissions and the requests as established at the beginning of the oral proceedings before the Board, that the respondent's original main and single request of 9 September 2011 had been withdrawn and replaced by the new main request filed with letter of 15 October 2013, so that it was no longer in the proceedings.

Re-filing the former main request as new auxiliary request 11 amounts to an amendment of the respondent's case at the last possible moment and, hence, its admission is subject to Articles 13(1) and 13(3) RPBA. Since the respondent has never filed any substantiation for this request, it should be treated as an unsubstantiated request, which is not to be admitted for the same reasons as applicable to the main request and auxiliary requests 1 to 10.

VIII. The respondent argued essentially as follows:

Admissibility of its main request and auxiliary requests 1 to 5

When the oppositions are dismissed, it can be assumed that the Board will confirm this. The respondent is therefore entitled to wait for the Board's preliminary assessment to decide on any reaction from its side, fulfilling therewith the requirement of procedural

economy. This avoids overloading the Board with too many, possibly useless, unfocused requests.

It was not necessary to file the substantiation together with the requests in view of them obviously overcoming the objections. The amendments to claim 1 of the main request, i.e. adding a lance, do not lead to a "fresh case" as they were already discussed in the opposition proceedings and are of relevance for selecting the closest prior art according to the Board's annex to the summons for oral proceedings. Furthermore, since the added features relate to preferred embodiments of the originally claimed invention, the claimed subject-matters of all requests must have been searched; they cannot be a surprise for appellant I and cannot lead to new issues/objections contrary to procedural economy. In any case, appellant I had enough time before the oral proceedings to perform such an additional search. There is, therefore, no abuse of the procedure.

Finally, the fact that the Board did not share the position of the decision under appeal but introduced new facts and arguments in the annex to the summons for oral proceedings entitled the respondent to react and file these new requests.

Consequently, the main request and auxiliary requests 1 to 5 should be admitted in the proceedings.

Admissibility of the respondent's auxiliary requests 6 to 10

Auxiliary requests 6 to 10 should be admitted in the proceedings for the same reasons as put forward for the

main request and auxiliary requests 1 to 5, since they are convergent and form combinations of these requests.

Admissibility of the respondent's original request to dismiss the appeal and to maintain the patent as granted

The former main request to dismiss the appeal and to maintain the patent as granted has never been withdrawn, so that it is still in the proceedings. Admissibility is, therefore, not an issue.

The re-filing of this (former main) request as auxiliary request 11 should be admitted since it corresponds to the claims of the patent as granted and, hence, cannot be a surprise for appellant I.

Reasons for the Decision

Admissibility of the respondent's main request and auxiliary requests 1 to 5

- 1.1 The Board establishes that the respondent did not file any reply to the appeals within the time limit of four months from receipt of the statements of grounds of appeal. Instead, it waited about nine months (until 9 September 2011) before filing its very brief reply requesting only that the appeal of appellant I be dismissed (the appeal and opposition of appellant II having by then been withdrawn), the patent be maintained as granted and, subsidiarily, oral proceedings be held. The respondent **did not submit a single argument to substantiate** why the grounds of both appeals should be regarded as unfounded.

1.2 The Board considers that the requirement of Articles 12(1)(b) and 12(2) RPBA, that the reply to the statement of grounds of appeal should contain the respondent's **complete** case, is to be seen as applying at the end of the time limit for filing such a reply, i.e. at the end of the four month time limit after deemed receipt of the statement of grounds. In the present case this would be 21 March 2011 for **both** appeals, since at that time neither the appeal nor the opposition of appellant II had been withdrawn. Absent any such timely reply, the respondent's submissions filed with its letter of 9 September 2011 are to be seen as a change in the party's position. This applies all the more to the submissions dated 15 October 2013, comprising the amended main request and the five auxiliary requests and to their substantiation with letter of 16 December 2013.

As correctly put forward by appellant I during the oral proceedings, the result is that the new main and five auxiliary requests are to be dealt with under Articles 13(1) and 13(3) RPBA.

1.3 The preliminary opinion of the Board cannot be used to justify the admittance of these requests, since it only took up some of appellant II's submissions and did not introduce any new issues.

In this respect the respondent considers that the Board introduced **new facts and arguments** in the annex to the summons. In the written procedure it referred to a "new" inventive step objection resulting from the combination of D5 with D19 in point 10.3 of the annex and at the oral proceedings to an interpretation of the "rotatable nozzle head" under point 8.1.2 of the annex.

As also put forward by appellant I during the oral proceedings, the Board cannot see in its annex any such new facts or arguments which would justify the respondent's new requests and their late substantiation.

The interpretation of the Board with respect to the "rotatable nozzle head" under point 8.1.2 was clearly in favour of the respondent in response to an objection according to Article 123(2) EPC, on which the respondent itself had been totally silent.

The objection of lack of inventive step based on the combination of D5 with D19 was already raised by appellant II in its statement of grounds of appeal, pages 12-14. The withdrawal of appellant II's appeal and opposition does not imply that its appeal submissions are withdrawn from the file or that less or no importance need be attributed to them. On the contrary, they can be taken up by the remaining appellant or the Board, as is presently the case.

For a complete reply the respondent should therefore have timely dealt with all objections raised.

- 1.4 The respondent argues that it has **deliberately waited** for the preliminary opinion of the Board before reacting as, otherwise, it would have had to file with its reply to the statements of grounds of appeals, as a precautionary measure, an extremely high number of new requests in view of the numerous new issues raised. This would have led to presenting the Board with an undue, possibly useless, burden. The respondent is of the opinion that it **was entitled to wait** for the Board's preliminary opinion before filing any reaction,

exactly for reasons of procedural economy, because the requests would then be more focused.

The Board cannot, however, share this view of the respondent, since, as put forward by appellant I during the oral proceedings, it is totally **contrary** to the very meaning of the Rules of Procedure.

The Rules of Procedure, as a whole, make it clear that appeal proceedings are primarily written proceedings, with the emphasis on the early stages of such proceedings. Indeed, as set out in Article 12(2) RPBA, the case of the parties shall be **complete** at a very early stage of the proceedings, in order to ensure a fair judicial system for all parties involved and to the benefit of the efficiency of the Board, so that it can start its work on a complete case.

The position of the respondent does not reflect this at all, unilaterally drawing all procedural advantages into its own sphere.

The Rules of Procedure also make clear that in *inter-partes* proceedings the rights as well as the obligations are equally distributed between the two opposing parties and that the Board is held to perform an independent judicial function.

The position of the respondent does not concur with this, since it expects the Board to *ex officio* deal with the appeals to the benefit of the respondent, who merely has to wait for the preliminary opinion to see on which issues it still needs to react, if at all.

Whether many or few requests are necessary to deal with an appeal depends on the facts of each case. The Rules

of Procedure, in particular Article 12(4), and the consistent case law on this issue establish that appeal proceedings are in principle a judicial review of the first instance decision; a respondent patent proprietor should indicate - normally with appropriately formulated requests - at an early stage (preferably already in the opposition proceedings) where the strength of its case and its defence lie. In light of the fact that also the other party is expected to set out its complete case in the statement of grounds of appeal, thus defining the framework of the proceedings, it should not be overly difficult to draft at least some "focused" requests at such an early stage, namely in reply to the said statement.

- 1.5 The respondent filed its main request and auxiliary requests 1 to 5 with letter dated 15 October 2013, without any substantiation with respect to novelty and inventive step of the claimed subject-matter, the main issues of both appeals. The corresponding substantiation came only with the letter of 16 December 2013, i.e. only three days before the oral proceedings.

The respondent argues in this respect that it reacted immediately upon receiving the Board's negative preliminary opinion. Regarding the even later filing of the substantiation with respect to novelty and inventive step, the respondent argues that it did not see the need to include any arguments with these requests since it considered them to be self-explanatory.

The respondent also holds the view that the amendment to claim 1 of the main request, which now includes the "lance", directs the claim to an essential feature of

the invention, which naturally was searched, and also clearly discards D5 as a possible closest prior art for assessing inventive step. Since the issue of which of the cited prior art documents D1b or D5 should be selected as the closest prior art was already discussed both in the opposition proceedings and in the Board's annex to the summons for oral proceedings, this amendment could not lead to a "**fresh case**" and, hence, could not be the reason for which oral proceedings should be adjourned or for which the case should be remitted to the department of first instance for further prosecution or even a further search. The respondent adds that appellant I obviously had enough time for performing such an additional search as shown by the 15 additional documents filed with its submissions dated 6 December 2013.

For the Board, unsubstantiated requests normally become effective only at the date on which they are substantiated. Their filing in and of itself plays therefore no role, whether one, two (as in the present case) or three months before the oral proceedings, particularly if, as in the present case, the requests are not self-explanatory as became apparent by the subsequently filed explanations and arguments.

Such behaviour of the respondent can hardly be seen as conducive to procedural efficiency for the Board or for appellant I, nor does it take account of the current state of the proceedings, both being contrary to Article 13(1) RPBA.

Furthermore, it puts appellant I and the Board in a position in which they cannot deal with these requests, unless the oral proceedings are adjourned or the case is remitted to the department of first instance. Both

situations are sufficient for the Board not to admit these requests pursuant to Article 13(3) RPBA.

For the Board, the circumstances of the present case require the application of these provisions of the Rules of Procedure to the detriment of the respondent, irrespective of the question whether a "new" case has resulted or whether appellant I was capable of performing an additional search. Where requests take up subject-matter from the description, as some of the present requests do, it cannot automatically be assumed that the initial search covered this subject-matter, nor is it automatically the responsibility of the opponent to perform itself such a search. For the Board, the amendment by inclusion of subject-matter from the description could constitute a further indication in favour of a remittal to the first instance.

- 1.6 In order to justify the late filing of the requests and their subsequent substantiation, the respondent argues further that the impugned decision was in its favour and that such decisions have a general presumption of validity before the Boards of Appeal.

This argument cannot hold. In the present Board's opinion, the Rules of Procedure establish, since their substantial revision in 2003 (OJ EPO 2003, 89), that in *inter partes* proceedings **both** parties have the same obligations where it concerns presenting their complete case at the earliest possible stage of the proceedings. This shows that there is no presumption of validity of the impugned decision.

Moreover, in the present case both statements of grounds of appeal raised new objections with respect to

the impugned decision, for which no presumption can be argued to exist nor a positive preliminary opinion of the Board be expected as a matter of course.

1.7 The Board shares appellant I's opinion that, should the present respondent's behaviour be accepted, i.e. its late requests and their even later substantiation be admitted in the proceedings despite the absence of any valid reason for their lateness and in clear contradiction with the relevant obligations established by the Rules of Procedure, this would encourage patent proprietors in the future to simply wait with their reaction to the grounds of appeal until the latest possible stage in the proceedings, contrary to the principles of efficient proceedings and of equal treatment of the parties.

1.8 In light of the preceding discussion it is clear that the present respondent's behaviour is not in compliance with the Rules of Procedure. It is considered by the Board as an **abuse of the appeal procedure**. For this reason, the main request and auxiliary requests 1 to 5 cannot be admitted in the proceedings (see T 888/02, not published in OJ EPO, points 5 and 6 of the reasons).

2. *Admissibility of the respondent's auxiliary requests 6 to 10*

The respondent did not bring forward any additional arguments for the admissibility of auxiliary requests 6 to 10 compared to those discussed above in respect of the main request and auxiliary requests 1 to 5.

Therefore, the same reasons as above apply *mutatis mutandis* to these auxiliary requests 6 to 10 which were

filed by the respondent with its letter dated 16 December 2013, i.e. only three days before the oral proceedings.

Consequently, auxiliary requests 6 to 10 are not admitted in the appeal proceedings.

3. *Admissibility of the respondent's former main request to dismiss the appeal and to maintain the patent as granted*

3.1 Upon being informed of the non-admittance of the main and 10 auxiliary requests, the respondent requested that its former main request of 9 September 2011 - that the appeal be dismissed and the patent be maintained as granted - be considered either as a request still in the proceedings or, alternatively, as new auxiliary request 11.

3.2 *As a request still in the proceedings*

3.2.1 The respondent holds the view that its former main request has never been withdrawn, so that it is still in the proceedings and would regain its status of main request by the non-admittance of the requests formerly replacing it. Consequently, admissibility could not be an issue.

3.2.2 The Board shares, however, appellant I's view that it is clear from the respondent's submissions of 15 October 2013 (see page 1, under "REQUESTS") and 16 December 2013 (page 1, under "ANTRÄGE") that its former main (and single) request of 9 September 2011 was replaced by the new "Main Request" as annexed to the letter dated 15 October 2013. There can only be one main request, which in the present case is the latter.

The former main request thus no longer exists. What no longer exists cannot be resurrected because of the non-admission of its replacement, unless replacement had been requested under this specific condition. No such condition was, however, formulated by the respondent. There is no such indication in any of its written submissions, although the last one (of 16 December 2013) took note of appellant I's request not to admit its amended requests, nor did the respondent state at the beginning of the oral proceedings, when the requests of the parties were established, that it intended to maintain its former main request for the eventuality that those of 15 December 2013 were not admitted.

Consequently, the Board cannot follow the respondent's view that its former main request was still in the proceedings or regained that status on non-admittance of the more recent requests.

3.3 *As a newly filed auxiliary request 11*

3.3.1 As a result of the above, the former main request was considered to be filed as auxiliary request 11.

However, as correctly argued by appellant I, re-filing the former main request as a further auxiliary request as late as at the oral proceedings constitutes an even later amendment to the respondent's case, this time at the latest possible moment. Therefore, its admission in the appeal proceedings is subject to Article 13 RPBA.

As set out in T 1621/09 (point 37(a) of the reasons; not published in OJ EPO) "*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".

The Board concurs with this principle; the same should apply in the present case to any substantiation on the part of the respondent in support of the earlier main request, re-instated as auxiliary request 11, since the letter of 9 September 2011 submitting that request did not contain any substantive explanations, nor has any substantiation for it been filed in the meantime. In fact, it would be presented for the very first time at the oral proceedings. This is particularly not conducive to efficient proceedings (Article 13(1) RPBA) and such submissions cannot be dealt with by the Board, unless the oral proceedings are adjourned (Article 13(3) RPBA).

Therefore, auxiliary request 11 is not admitted in the proceedings.

- 3.3.2 The respondent's view that this auxiliary request should be admitted since it corresponds to the claims of the patent as granted and, hence, could not be a surprise for appellant I, cannot be followed by the Board. It does not take account of the state of the proceedings and of the fact that its effect on the oral proceedings is not limited to a potential surprise of the other party but that in presence of an until then not argued case the oral proceedings would need to be adjourned rather than be closed with a final decision, contrary to Article 15(6) RPBA.

3.4 Since there are no more valid requests for maintenance of the patent the latter is to be revoked.

4. *Appellant I's further requests*

In view of the above, which leads to the revocation of the patent, all other requests of appellant I, which are auxiliary and conditional, such as the apportionment of costs in case of adjournment of the oral proceedings or remittal to the department of first instance, and the referral of a question to the Enlarged Board of Appeal, need not be dealt with in the present decision.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



G. Nachtigall

H. Meinders

Decision electronically authenticated