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**Datasheet for the decision
of 30 April 2014**

Case Number: T 2502/10 - 3.2.01

Application Number: 04707578.3

Publication Number: 1590235

IPC: B63C11/04, B63C9/087

Language of the proceedings: EN

Title of invention:

A SUIT FOR USE IN OR IN ASSOCIATION WITH WATER

Patent Proprietors:

Gordon, John
Gordon, Corey

Opponent:

Patagonia, Inc.

Headword:

Relevant legal provisions:

RPBA Art. 13(1)

Keyword:

Late-filed request - admitted (no)
Late-filed auxiliary requests - admitted (no)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 2502/10 - 3.2.01

**D E C I S I O N
of Technical Board of Appeal 3.2.01
of 30 April 2014**

Appellant: Gordon, John
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Appellant: Gordon, Corey
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Respondent: Patagonia, Inc.
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Representative: Müller, Wolfram Hubertus
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 16 November
2010 revoking European patent No. 1590235
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman	G. Pricolo
Members:	H. Geuss
	D. T. Keeling

Summary of Facts and Submissions

- I. The European patent No. 1 590 235 was revoked by the decision of the Opposition Division posted on 16 November 2010. Against this decision an appeal was filed by the patent proprietors on 17 December 2010. The statement of grounds of appeal was filed on 16 March 2011. The written reply of the respondent (opponent) was filed on 29 July 2011.
- II. In its decision the Opposition Division held that the subject-matter of the claims as amended during the opposition proceedings extended beyond the content of the application as filed (Article 123(2) EPC) and was not clear (Article 84 EPC).
- III. Oral proceedings were held on 30 April 2014. The appellants (patent proprietors) requested that the decision under appeal be set aside and the patent be maintained in amended form in accordance with the main request filed by letter of 15 April 2014 or in the alternative in accordance with the first auxiliary request, which was filed as auxiliary request 2 on 28 March 2014, or the second or third auxiliary requests, which were submitted during the oral proceedings on the basis of the documents filed with the grounds of appeal.

The respondent (opponent) requested that the appeal be dismissed.

- IV. Claim 1 according to the main request reads as follows:
- "A suit (4) to be worn by a person (2) in contact with water, said suit having three layers consisting of a layer of material (6), an outer protective layer and a

layer (8) of Merino wool blended with other fibres or materials, which forms an inner layer of the suit in contact with the person and said inner layer provided to contact and retain at least some of the liquid which enters the suit from an external source and/or from the person (2) wearing the suit (4) said inner layer is laminated to the layer of material (6) and provided of a weight of between 50-500 grammes per square metre such that the wool of the inner layer retains the liquid therein such that the liquid retained in the wool forms a substantially non-compressible, thermal barrier between the said person and the layer of material (6) of the suit, and characterised in that the other fibres or materials of the wool blend includes a synthetic yarn in a proportion of between 1 and 40% by weight of the overall weight of the blend and the wool and the other fibres or materials are knitted".

- V. Claim 1 of the first auxiliary request differs from claim 1 of the main request in that at the end of the claim it is further added that "the synthetic yarn is set by applying heat thereto whilst maintaining very low extension of the same during the dyeing and subsequent drying processes when preparing the wool blend".

- VI. Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that the wordings "Merino", "the wool and the other fibres or materials are knitted" and "whilst maintaining very low extension of the same during the dyeing and subsequent drying processes when preparing the wool blend" have been omitted.

- VII. Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that the

wording "material (6)" is replaced by the wording "substantially closed cell compressible foam rubber (6)".

VIII. The appellants' submissions may be summarized as follows:

Although filed shortly in advance of the oral proceedings before the Board, the main and first auxiliary requests should be admitted in the appeal proceedings since they were filed in order to streamline the oral proceedings. Neither the Board nor the respondent was put in a serious disadvantage since both could reasonably deal with the amendments made. These requests did not represent a complete new case but a further limitation to the patent as granted. The appellants further considered justified the filing shortly before the oral proceedings of these requests due to coordination difficulties with one of the patent proprietors residing in New Zealand and because no specific deadline for filing amendments was set.

The second and third auxiliary requests filed during the oral proceedings should be admitted in the appeal proceedings since they were filed in response to the unexpected finding of the Board that the main and first auxiliary requests were not admitted and because they represented a reinstatement of the main and auxiliary requests filed with the statement of grounds. Neither the Board nor the respondent could be surprised by this reaction and the respondent had further already addressed these requests previously in his reply, so that it would have been reasonable to expect that he was prepared to deal with them during the oral proceedings.

IX. The respondent's submissions may be summarized as follows:

The main request was inadmissible because it was late filed, included substantial amendments and represented a new case in comparison to the one of the requests filed with the grounds of appeal.

There was no reason justifying the late filing shortly before the oral proceedings as nothing had changed in the case since the reply to the statement of grounds of appeal was filed.

In particular, the amendments to claim 1 were substantial. These amendments reinstated one aspect of the invention relating to the added feature "the wool and the other fibres are knitted" that was abandoned during the opposition proceedings. Indeed, this feature was present in dependent claim 21 as granted and only as an alternative to a woven material, and all dependent claims including this feature were removed during the opposition proceedings as is apparent from the set of claims filed with letter of 6 September 2010.

Further, the wool had been specified as being Merino wool and the feature "the synthetic yarn is set by applying heat thereto" had been omitted while being present in all requests filed with the statement of grounds, as well as in claim 1 of the sole request of the patent proprietors in the contested decision. Thus, with these amendments the patent proprietors had substantially amended his case in a surprising manner for the respondent. In order to provide a reasonable reply to this new case a further search would be necessary.

The first auxiliary request was also inadmissible. Claim 1 of this request also included the feature "the

wool and the other fibres are knitted" and thus the same reasoning with respect to this feature as for the main request applied. Moreover, the added feature to claim 1 of the first auxiliary request "whilst maintaining very low extension of the same during the dyeing and subsequent drying processes when preparing the wool blend" did not further specify the thermosetting feature but implied an additional distinctive step for the preparation of the wool blend (see appellants' letter of 31 March 2014, page 2 second paragraph) which would require again a further search from the respondent in order to provide a reasonable reply to this request.

The second and third auxiliary requests were inadmissible. These requests had been withdrawn in advance of the oral proceedings. Although the respondent dealt with them in his reply to the statement of grounds, they would represent a change of case in the oral proceedings that was not expected and was not prepared for. Accordingly, adjournment of the oral proceedings would be necessary so that he would be able to suitably prepare for these requests. Further, the reinstatement of these withdrawn requests did not amount to procedural economy.

Reasons for the Decision

1. The appeal is admissible.

Admissibility of requests

2. The main and first auxiliary requests are not admitted into the proceedings at the Board's discretion according to Article 13(1) of the Rules of Procedure of

the Boards of Appeal (RPBA, OJ EPO 2007, 536).

- 2.1 According to Rule 13 (1) RPBA any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. 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.

According to established jurisprudence relating to Article 13 (1) RPBA there must be sound reasons for filing a request at a late stage in the proceedings, as may be the case where amendments are occasioned by developments during the proceedings (see Case Law of the Boards of Appeal, 7th edition, IV.E.4.4.).

- 2.2 In the present case the respondent replied to the arguments and the requests as filed with the statement of grounds of appeal with letter of 29 July 2011. The Board summoned to oral proceedings pursuant to Rule 115(1) EPC on 18 February 2014, however, without sending a communication according to Article 15 (1) RPBA. Almost three years after the filing of the aforesaid letter of reply the appellants filed - as a reaction to the summons to oral proceedings - amended main and auxiliary requests.

The main request under consideration was filed with letter of 15 April 2014, i.e. two weeks before the date of oral proceedings before the Board and the first auxiliary request under consideration was filed with letter of 28 March 2014 as auxiliary request 2, i.e. one month before the date of oral proceedings before the Board, and was made first auxiliary request with letter of 15 April 2014.

First, it is to be noted that the factual situation has not changed since the respondent's letter of reply. Therefore, no developments during the proceedings took place at all, so that amendments to the party's case, two weeks before the oral proceedings before the Board of appeal cannot be justified on that ground.

- 2.3 The appellants argued that these requests were filed shortly before the date of the oral proceedings due to difficulties in communicating with one of the patent proprietors residing in New Zealand.

The fact that one of the patent proprietors resides in a far-away country is not an objective excuse for not filing a reaction to the respondent's letter of reply in appropriate time. Indeed, after the appellants had omitted to respond to the respondent's arguments until four weeks before the oral proceedings, the respondent could assume that the requests as brought forward with the statement of grounds of appeal would be pleaded in the oral proceedings. A change of requests at this stage of the proceedings would put the respondent's preparation (as well as the Board's preparation) of the case in question, which must be regarded as an unjustified discrimination.

- 2.4 This situation does not change even in the case that no explicit time limit for the submissions was set as submitted by the appellants. Article 13 (1) RPBA states that any amendment of a party's case after the statement of grounds of appeal or the letter of reply is at the Board's discretion. The question whether a time limit has been set or not, does not alter the criteria for the exercise of the discretion referred to in Article 13(1) RPBA.

2.5 The appellants further argued that the substitution of the main and auxiliary requests filed with the statement of grounds of appeal for the current main and first auxiliary requests should streamline the oral proceedings before the Board and therefore should be admitted as they include minor amendments which the respondent could reasonably be expected to deal with.

The Board considers that the amendments according to the main and auxiliary requests are not minor but rather substantial. In particular these amendments are not apt to streamline the appeal proceedings for the following reason:

2.5.1 Specifically, claim 1 of the main request in suit differs from claim 1 of the main request filed with the statement of grounds in particular by replacing the feature - "the synthetic yarn is set applying heat thereto" - by - "the wool and the other fibres or materials are knitted".

The Board agrees with the respondent that this amendment presents a new case in comparison to the case made by the appellants with the statement of grounds of appeal. With this added feature the appellants shift the invention into another one, namely into the specific way the wool and the other fibres or materials are layered into a fabric. This added feature represents a reinstatement into claim 1 of subject-matter that was claimed in the granted patent (see dependent claim 21 as granted) but was removed from the claims during the opposition proceedings by amendment of the patent with letter of 6 September 2010.

- 2.5.2 The same applies to claim 1 of the first auxiliary request which also includes the above mentioned feature relating to the knitting of the fibres and further the feature "whilst maintaining very low extension of the same during the dyeing and subsequent drying processes when preparing the wool blend".

Second and third auxiliary requests

3. The second and third auxiliary requests are not admitted into the proceedings at the Board's discretion according to Article 13(1) RPBA.

- 3.1 The second and third auxiliary requests filed during the oral proceedings correspond to the main and first auxiliary requests as filed with the statement of grounds of appeal and withdrawn with letter of 15 April 2014. The appellants invited the Board to reconsider them during the oral proceedings before the Board of appeal.

- 3.2 The appellants argued that the reinstatement of these requests cannot be surprising because it is seen as a foreseeable reaction to the inadmissibility of the previous requests, and that it would be reasonable to expect that the respondent is prepared to deal with them during the oral proceedings since he had fully addressed them in the reply to the grounds of appeal.

In the Board's view the filing of the main and first auxiliary requests shortly before the oral proceedings before the Board of Appeal has to be seen as a belated attempt to overcome objections under Article 123(2) EPC raised by the respondent in his reply to the statement of grounds of appeal. Allowing the appellants to reinstate these requests would entail re-opening a

discussion on Article 123(2) EPC issues that the appellants sought to solve by means of the amendments made in accordance with the main request and the first auxiliary request.

The filing of these requests must therefore be considered as a further change of case which is subject to the Board's discretion pursuant to Article 13(1) RPBA (see e.g. T 1732/10, reasons 3.3.1).

Thus, for reasons of procedural economy, the Board considers that it is not justified to allow the appellants during the oral proceedings to go back to a situation which was regarded by the respondent and the Board as not intended to be pursued anymore.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated