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**Datasheet for the decision
of 26 October 2012**

Case Number: T 0007/12 - 3.2.07

Application Number: 01928636.8

Publication Number: 1276916

IPC: C23C 4/10

Language of the proceedings: EN

Title of invention:
THERMAL SPRAY POWDER

Patentee:
Saint-Gobain Ceramics and Plastics, Inc.

Opponent:
H.C. Starck GmbH

Headword:

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Relevant legal provisions:
EPC Art. 84, 111(1), 123(2), 123(3)
EPC R. 103
RPBA Art. 12(4)

Keyword:
"Request not to admit the auxiliary requests (refused)"
"Claims - clarity (main request and first auxiliary request - no, second auxiliary request - yes)"
"Admissibility of amendments (second auxiliary request - yes)"
"Reimbursement of appeal fee (no)"
"Remittal to the department of first instance"

Decisions cited:
R 0017/11, R 0011/11,

Catchword:

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Case Number: T 0007/12 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 26 October 2012

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 28 October 2011
revoking European patent No. 1276916 pursuant
to Article 101(3) (b) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: H. Hahn
E. Kossonakou

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division to revoke the European patent EP-B-1 276 916.
- II. The following document of the opposition procedure is cited in the present decision:
- D1 = WO-A-01 81647 (the published document corresponds to the application as originally filed, underlying the patent in suit)
- III. The opposition had been filed against the patent in its entirety under Article 100(a) EPC, for lack of inventive step, under Article 100(b) EPC, that the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art, and under Article 100(c), for extending beyond the content of the application as originally filed.

The Opposition Division held that claim 1 of the main request as filed at the oral proceedings of 4 October 2011 (corresponding to claims 1-9 as granted) contravened Article 123(2) EPC. The Opposition Division then considered that the first and second auxiliary request subsequently filed at the oral proceedings comprised amendments, in particular a new independent claim of the same category as claim 1, which were not occasioned by any ground of opposition defined in Article 100 EPC and thus contravened Rule 80 EPC. They were also considered to be late filed so that the opponent was not prepared for discussing them. The

first and second auxiliary requests were therefore not admitted. Further requests were not permitted by the Opposition Division since these two auxiliary requests did not appear to be serious attempts to overcome the outstanding objections. Consequently, the patent was revoked.

- IV. With a communication dated 7 August 2012 and annexed to the summons to oral proceedings the Board presented its preliminary opinion with respect to claims 1-9 of the patent as granted according to the main request and on the set of claims according to the first to fifth auxiliary requests as filed together with the grounds of appeal dated 28 February 2012.

The Board remarked amongst others with respect to the issue of Article 123(2) EPC that the claims 1 of the main, first and second auxiliary requests appeared not to be derivable in a clear and unambiguous manner from the application as originally filed (corresponding to the published D1: WO-A-98 37990), due to the omission of the feature "of the total weight of chromium oxide".

Furthermore, the third and fourth auxiliary requests appeared to contravene Article 84 EPC due to their added second independent process claims 5 and 3, respectively.

Reimbursement of the appeal fee as requested by the appellant appeared not to be equitable.

The respondent's (opponent) request for rejecting the auxiliary requests in line with decision R 11/11 and a remittal of the case to the department of first

instance was considered to result in an undue delay of the opposition proceedings; R 11/11 appeared not to be applicable in the present case.

The Board further stated that the case could be remitted on the basis of the fifth auxiliary request for further examination of inventive step and enabling disclosure.

- V. With letter dated 26 September 2012 the appellant submitted, as a response to the summons to oral proceedings, new requests in combination with further arguments. The appellant maintained its request for remittal of the case to the department of first instance for evaluation of novelty and inventive step of the main or auxiliary requests. The request for reimbursement of the appeal fee was also maintained.
- VI. With letter dated 26 September 2012 filed by fax on the same date the respondent maintained its objections.
- VII. Oral proceedings before the Board were held on 26 October 2012. On the issue of admittance (Article 12(4) RPBA) of the main, first and second auxiliary requests both parties refrained from submitting further arguments. Thereafter the amendments made in the claims of these three requests were discussed in the light of the requirements of Articles 84, 123(2) and (3) and Rule 80 EPC. Finally, the issue of reimbursement of the appeal fee was discussed.
 - (a) The appellant requested that the decision under appeal be set aside and that the Board find that

the claims of either the main request or of the first or second auxiliary requests as submitted with letter of 26 September 2012 fulfil the requirements of Articles 84, 100(c), 123(2) and 123(3) and of Rule 80 EPC. Should the Board so find, he requested that the case be remitted to the department of first instance for further prosecution.

The appellant further requested that the appeal fee be reimbursed.

- (b) The respondent requested that the appeal be dismissed. If not, he also requested that the case be remitted to the department of first instance for further prosecution.

At the end of the oral proceedings the Board announced its decision.

VIII. The independent claims 1 and 5 of the main request read as follows (amendments as compared to the claims 1 and 9 of the patent as granted are in bold with deletions in brackets, emphasis added by the Board):

"1. A process for the production of a chromium oxide thermal spray powder which comprises calcining chromium oxide powder with a particle size range of 0.1 to 125 µm and comprising at least 5 % by volume of chromium oxide particles smaller than 10 µm for a time sufficient to reduce the volume of particles with sizes less than 10 µm to below 5 %, **of the total weight of chromium oxide.**"

"5. A [The] process [according to claim 1] for the production of a chromium oxide thermal spray powder, which process comprises:

- a) Feeding chromium oxide particles with a size range of from 0.1 to 125 μm into a furnace along with from 0 to 100 % based on the weight of the comminuted product, of chromium oxide powder with a particle size less than 10 μm to produce a mixture of particles in which at least 5 % by volume of the particles are smaller than 10 μm ;
- b) calcining the mixture at a temperature above 1000°C for a time sufficient to cause reduction of the content of chromium oxide particles smaller than 10 μm to below 5 %; and
- c) cooling and classifying the resultant product."

IX. The independent claims 1 and 3 of the first auxiliary request are identical with or correspond to the subject-matter of the independent claims 1 and 5 of the main request, respectively.

X. Claim 1 of the second auxiliary request is identical with claim 1 of the main request.

XI. The appellant argued, insofar as relevant for the present decision, essentially as follows:

With respect to the admittance of the present main, first and second auxiliary requests (corresponding to the third to fifth auxiliary requests of the written proceedings) the appellant entirely agrees with the Board's reasoning given in point 5.3 of its communication annexed to the summons to oral proceedings.

The amendment made in claim 1 of the main request, i.e. the insertion of the definition "of the total weight of chromium oxide" addresses the Article 123(2) EPC problem underlying the impugned decision so that a discussion is superfluous. Since claim 1 as granted covered two interpretation possibilities for the percentages mentioned the restriction to one of them cannot contravene Article 123(3) EPC. Taking account of the fact that the particles comprise only chromium oxide it is clear that 100 volume % of these particles are equal to 100 weight % thereof. Therefore this addition was not really necessary since "volume %" and "weight %" are identical for such a defined product.

The patent in suit defines in paragraph [0017] how the particle size defined in claim 1 is to be measured, i.e. as the volume average particle size.

It is admitted that D1 discloses ceramic powders with other chemistries as well as core/shell particles (see e.g. claim 1 or page 10, lines 9 to 15) but claim 1 as granted has been restricted to **chromium oxide** and the examples 5-8 no longer represent embodiments, but have been marked as comparative examples in the patent in suit. Chromium **metal** is therefore only contained as an impurity in the comminuted product and what is to be understood by "chromium oxide" cannot be redefined in the sense of the comparative examples.

There is no indication that the chromium metal, being comprised as an impurity, would not be statistically distributed among these particles, nor that it would

have a distribution of its particle sizes which is different from that of the chromium oxide particles.

The comminuted product of claim 5 corresponds to the chromium oxide particles of from 0.1 to 125 μm , which, in case that no particles with a size of less than 10 μm are added, then must contain at least 5 volume % of such particles. It is admitted that, for the latter case, no mixture of particles is produced.

The above arguments likewise apply to the corresponding independent claims of the first and second auxiliary requests.

With respect to the reimbursement of the appeal fee it emphasised that the two auxiliary requests filed at the oral proceedings before the Opposition Division have been filed in reaction to the main request surprisingly being considered to contravene Article 123(2) EPC. It had been expected that the Opposition Division, after its deliberation concerning said auxiliary requests, at least would have asked the patent proprietor whether or not it would like to make further comments but this was not the case. Were they so asked, it was intended to delete the second independent process claim comprised in these auxiliary requests. The representative cannot remember the exact sequence of events and whether or not he reacted to the opponent's objections to their late filing. It was intended to explain to the Opposition Division the reasons for filing two independent claims, however, the Opposition Division did not give the patent proprietor a chance to do so.

With respect to the Board's remark concerning a correction of the minutes not having been requested it remarks that it "did not have a reason to request a correction of the minutes of the oral proceedings dated 28 October 2011, because the minutes describe what happened" and that it "was never asked by the Opposition Division to explain the claim structure of the First and Second Auxiliary Requests filed during the hearing of October 4, 2011, nor did patentee have the slightest chance to explain to the Opposition Division the motivation to file two independent claims of his own accord (the minutes of the oral proceedings do not mention any explanations of patentee). Rather, the chairman of the Opposition Division - after reopening the oral proceedings after a break to allow the Opposition Division to study the claims filed by patentee as new First and Second Auxiliary Requests - immediately announced the decision to revoke to (sic) opposed patent and closed the oral proceedings. According to patentee's understanding, this behaviour of the Opposition Division constitutes a severe procedural violation which justifies the reimbursement of the appeal fee" (see letter dated 26 September 2012, page 7, first full paragraph).

XII. The respondent argued, insofar as relevant for the present decision, essentially as follows:

The appellant's first to fifth auxiliary requests (the third to fifth auxiliary requests thereof correspond to the present main, first and second auxiliary requests as filed with letter dated 26 September 2012) and the request for a remittal to the department of first instance should be rejected in line with decision

R 11/11 (not published in OJ EPO) for them representing an abuse of procedure and because a remittal of the case for dealing with the grounds of opposition under Articles 100(a) and 100(b) EPC would result in an undue delay of the opposition proceedings.

Claim 1 of the main request contravenes Article 123(3) EPC since claim 1 as granted defined "at least 5 by volume" so that the percentage-reference in the feature "sizes less than 10 μm to below 5%" was necessarily to "volume %". The present reference to "the total weight of chromium oxide" then extends beyond the scope of claim 1 as granted, as it changes it to "weight %".

Claim 1 of the main request further contravenes Article 84 EPC due to the added feature "of the total weight of chromium oxide". According to this added feature "volume" is made synonymous with "mass". Finally, it is not clear which particle size is meant when referring to the ranges of "0.1 to 125 μm " and "less than 10 μm " and the patent in suit is silent in this respect. Said particle size, however, influences the volume and thus also the weight proportion. The measurement method mentioned in paragraph [0017] of the patent in suit for determining the D_{10} or D_{50} values does not contain any indication how the particle size shall be determined.

Claim 5 creates the same problem and additionally does not specify the basis of the mentioned "5%" but differing from claim 1 defines a "reduction of **the content** of chromium oxide particles". Step a) of claim 5 additionally defines "... **along with** 0 to 100% based on the weight of **the** comminuted product" which

latter feature has no earlier counterpart in claim 5 and thereby renders claim 5 unclear.

Since the comminuted product can contain up to 5% chromium metal (see D1, page 6, lines 1 and 2) the appellant's arguments that the chromium oxide would be pure chromium oxide with chromium metal only as an impurity cannot hold. Consequently, also the arguments that "volume" and "mass" of chromium oxide would be equivalent cannot hold. Chromium metal, which is always present in the comminuted product (see D1, page 2, lines 19 to 30), has a density about twice as high as that of chromium oxide, 5% of it will make a difference. Further, the original application was for ceramic materials and was not restricted to pure chromium oxide (see D1, page 10, line 23 to page 11, line 1 and claim 1).

Both independent claims have to be examined in the light of Article 84 EPC since the feature added to claim 1 as granted has been taken from the description while the subject-matter of independent claim 5 of the main request has been taken from page 3, lines 23 to 31 of the description and has never been examined before in this respect.

The objections concerning claims 1 and 5 of the main request likewise apply to the identical claims 1 and 3 of the first auxiliary request and to claim 1 of the second auxiliary request. Therefore none of these requests is formally allowable.

No statements concerning the sequence of events at the oral proceedings before the Opposition Division will be

made. It is only remarked in this context that oral proceedings are not a patent drafting course.

Reasons for the Decision

1. *Admissibility of the new requests (Article 12(4) RPBA)*

In its response to the statement of grounds of appeal the respondent requested that the set of five auxiliary requests filed with the grounds of appeal (the claims of the present main, first and second auxiliary requests correspond to the third to fifth auxiliary requests of this set) as well as the appellant's request for a remittal should be rejected, in line with decision R 11/11 (not published in OJ EPO). They represented an abuse of procedure and a remittal of the case to the department of first instance for dealing with the grounds of opposition under Articles 100(a) and 100(b) EPC would result in an undue delay of the opposition proceedings.

The Board does not share the respondent's opinion.

- 1.1 First of all, the decision R 11/11 (*supra*) quoted by the respondent is **not** considered to be applicable in the present case. In that case the chairman of the Opposition Division had asked the representative of the patentee during the oral proceedings whether he would like to file any further requests in order to deal with the Article 123(2) EPC objection, see point IV of the facts and submissions. In the present case, however, the Opposition Division has **not** offered the appellant the chance during the oral proceedings to file further

requests to meet the Article 123(2) EPC objection but actually denied the appellant the right to file any further requests (see point 5.11 of the minutes dated 28 October 2011).

1.2 Secondly, since the Board has given the case - which originates from the decision taken by the Opposition Division at the oral proceedings held on 4 October 2011 - advanced treatment, any remittal thereof should not result in an undue delay of the opposition proceedings.

1.3 Thirdly, taking account of the sequence of events at the oral proceedings before the Opposition Division the Board cannot see any abuse of procedure on the part of the appellant (see points 5.1 to 5.5 below).

1.4 Furthermore, in accordance with Article 12(4) RPBA it is at the Board's discretion to accept into the proceedings or not requests which could have been presented or - as in the present case - were not admitted in the first-instance proceedings.

1.5 Therefore the respondent's request not to admit these requests is refused.

2. *Clarity (Article 84 EPC)*

Since the Board considers that the second independent claim of the main request and the first auxiliary request contravene Article 84 EPC (see points 2.1 and 2.2 below) there is no need to discuss whether or not the amendments made in these two requests comply with Articles 123(2) and (3) EPC.

Main request

2.1 The subject-matter of independent process claim 5 of the main request has been derived by amendment from page 3, lines 22 to 31 of the description of D1 and the appellant has not contested at the oral proceedings this view of the respondent. As a consequence of this amendment, in accordance with Article 101(3)(a) EPC, the Board has to examine whether or not claim 5 complies with Article 84 EPC (see Case Law of the Boards of Appeal of the European Patent Office, 6th edition 2010, section VII.D.4.2).

The Board considers that claim 5 is rendered unclear by the following definitions which are inconsistent with each other (emphasis added by the Board):

- i) "**feeding** chromium oxide particles **with a size range of from 0.1 to 125 µm** into a furnace **along with from 0 to 100 %** based on the weight of **the comminuted product**, of chromium oxide powder with a particle size **less than 10 µm to produce a mixture** of particles ..." and
- ii) "calcining **the mixture** ..." (see point VIII above).

2.1.1 First of all, claim 5 comprises **no** antecedent to its feature "**the comminuted product**" which determines the weight basis for the mixture of particles and powder.

As stated by the appellant at the oral proceedings (see also its letter dated 26 September 2012, paragraph bridging the pages 3 and 4) the chromium oxide particles with a size range of from 0.1 to 125 µm represent this comminuted product so that a mixture of

the two components of from 100/0 to 100/100 would be encompassed.

However, as derivable from D1 the comminuted product is (usually) obtained by crushing the ingot obtained by the fusion process and thus includes the particle size range of from 0.1 to 125 μm **as well as** the powder with a particle size of less than 10 μm (see page 2, lines 19 to 25; page 3, lines 16 to 21; and page 4, lines 5 to 21). Taking account of this disclosure the second component "powder" replaces the first component, "particles".

2.1.2 Even when ignoring said two interpretations of the weight basis, claim 5 in any case requires "**feeding** chromium oxide particles with a size range of from 0.1 to 125 μm into a furnace **along with from 0 to 100%** ... of chromium oxide powder with a particle size of less than 10 μm **to produce a mixture** of particles". This means for the first extreme value, i.e. **0%** of chromium oxide powder with a particle size of less than 10 μm is added, that only the particles with a size of from 0.1 to 125 μm are fed to the furnace so that **no particles** are **fed along** into the furnace **to produce a mixture** so that this requirement of claim 5 cannot be fulfilled. The appellant admitted at the oral proceedings that for this extreme case no mixture can be produced for further calcining according to step b) of claim 5.

On the other hand, in case that the comminuted product includes said particles and the powder (second interpretation of point 2.1.1 above) and **100%** of chromium oxide powder with **a size of less than 10 μm** are fed into the furnace, i.e. only the powder is fed

therein, then there will not be particles **fed along to produce a mixture**.

2.1.3 The clarity objection to claim 5 can be made as it is not a combination of granted claims 1 and 9, but a claim independently formulated from only dependent claim 9.

2.1.4 Consequently, claim 5 of the main request contravenes Article 84 EPC. The main request is therefore not allowable.

First auxiliary request

2.2 Independent process claim 3 of the first auxiliary request comprises the identical definitions as claim 5 of the main request (see points VIII and IX above).

Consequently, the objection raised under Article 84 EPC in point 2.1 above applies *mutatis mutandis* to claim 3 of the first auxiliary request.

The first auxiliary request is therefore not allowable.

Second auxiliary request

2.3 Independent process claim 1 of the second auxiliary request is based on claim 1 as granted which has been amended by only incorporating at the end the omitted definition "**of the total weight of chromium oxide**" in order to comply with Article 123(2) EPC (see points VIII and X).

2.3.1 At the oral proceedings the respondent argued for the first time in the entire appeal proceedings that claim 1 as amended would be unclear due to the introduced feature "**of the total weight of chromium oxide**". Due to this feature a specific "volume" is now compared with a "mass". However, the respondent basically repeated its arguments originally brought forward with respect to insufficiency of disclosure and focused on features which were already comprised in claim 1 as granted. These features relate to "a particle size range of 0.1 to 125 μm ", "particles with sizes less than 10 μm " and the "volume of particles". Also the question arises whether appropriate account is taken of the fact that the chromium oxide powder, before it is calcined, still contains chromium metal particles.

These arguments cannot hold for the following reasons.

2.3.2 Even if claim 1 does not in itself define which dimension of the particles, e.g. the diameter or the length (or both), has to be taken into account when determining the particle sizes of the chromium oxide particles according to the two specified ranges of "0.1 to 125 μm " and "less (or smaller) than 10 μm " it is clear from paragraph [0017] of the description of the patent in suit. According to paragraph [0017], when reference is made in the patent in suit to "particle sizes", these are **volume average particle sizes** measured using a Leeds & Northrop "Microtrac" particle size analyzer, which employs a laser light scattering technique to measure **the sizes**.

Hence it is clear that volume average particle sizes are meant and a "Microtrac" particle size analyzer has

to be used for measuring the particle sizes of the chromium oxide particles as defined in claim 1. The respondent's allegations to the contrary therefore cannot hold, particularly since it is evident from said paragraph [0017] that the "Microtrac" analyzer has to be run in the "percent passing mode" in order to determine the particle size distributions D_{10} or D_{50} .

2.3.3 Likewise it is clear that the "chromium oxide powder with a particle size range of 0.1 to 125 μm " defined in claim 1 represents 100 % by volume but comprises an amount of "at least 5 % by volume of chromium oxide particles smaller than 10 μm ". Thus there exist two volumes of small particles. The respective volumes of such masses of small particles can, however, easily be determined by the person skilled in the art since, as long as the same method is used for measuring both of them, it boils down to a simple relative comparison of the "100 % volume" and that of the "at least 5 % volume". This approach involves only applying the common general knowledge of the skilled person by either using the Archimedes' principle for measuring the volumes of said two masses of particles using an appropriate non-wetting solvent, and/or by measuring the bulk volume by filling e.g. a 100 millilitres graduated measuring glass or measuring cylinder with said particles of the size range 0.1 to 125 μm until the 100 millilitres marking is reached. Thereafter taking this mass of particles, which corresponds to the 100 % volume, and removing all particles therefrom which are not "smaller than 10 μm " (which is commonly done by sieving; see e.g. patent in suit, paragraph [0030]) and then measuring the volume of the remaining

particles in the same measuring cylinder to see whether or not it is above 5 millilitres.

- 2.3.4 The feature "... to reduce the volume of particles with sizes less than 10 μm to below 5%, of the total weight of chromium oxide" links the volume of the particles with a size of less than 10 μm after the calcination treatment with an uppermost value of 5 % of the total weight of the chromium oxide.

Taking account of the fact that the chromium oxide particles, before they are calcined, may contain up to 5 % of chromium metal (see paragraph [0020] of the patent in suit) the appellant's argument that the particles comprise only chromium oxide or chromium metal only as an impurity and that 100 volume % of these particles would be equal to 100 weight % thereof cannot hold.

However, this does not affect the outcome, as the total weight of only chromium oxide of the calcined chromium oxide particles can simply be determined by weighing the calcined chromium oxide product and analysing its chromium and oxygen content in order to verify how much any, possibly present, chromium metal comprised in the starting material - it may be comprised in an amount of up to 5 % (see patent in suit, paragraph [0020]) - has been oxidised during the calcination treatment (see patent in suit, paragraph [0014]). Any non-oxidised chromium can then be deducted. As described above the volume of the particles with sizes smaller than 10 μm comprised in the calcined product can be determined (see point 2.3.3 above) but has to be linked with its weight, which can be determined by weighing said volume

to verify whether or not the condition "below 5 %, of the total weight of chromium oxide" specified in claim 1 is fulfilled.

2.3.5 The respondent's arguments based on the core/shell embodiments discussed in D1 (e.g. page 10, line 9 to page 11, line 1) relating to the calcination of a ceramic powder as was defined in original claim 1 of D1 cannot be accepted either since the patent as granted has been restricted to calcining chromium oxide powder and the corresponding examples of these core/shell embodiments have been marked as comparative examples (see patent in suit, paragraphs [0033] to [0036] and claim 1 as granted).

2.3.6 Therefore the Board considers that the subject-matter of claim 1 of the second auxiliary request is clear and complies with Article 84 EPC.

3. *Allowability of amendments made in the second auxiliary request (Articles 123(2) and (3) and Rule 80 EPC)*

The second auxiliary request comprises only the independent process claim 1 and the dependent claim 2.

3.1 Claim 1 of the second auxiliary request is based on page 3, lines 10 to 15 of D1 (corresponding to claim 1 in combination with page 3, line 6 of the patent as granted).

The feature "**of the total weight of chromium oxide**" has been incorporated in claim 1 to overcome an objection under Article 100(c) EPC raised by the respondent during the opposition procedure and in order to comply

with Article 123(2) EPC, respectively (see points III, VIII and X).

3.1.1 The identical amendment, which has also a basis on page 3, line 15 of D1, has been made in dependent claim 2 of the second auxiliary request (corresponding to claim 2 in combination with page 3, line 6 of the patent as granted) in order to comply with Article 123(2) EPC.

3.1.2 Claims 1 and 2 of the second auxiliary request therefore comply with Article 123(2) and Rule 80 EPC.

Since claims 1 and 2 have been amended accordingly the objections raised under Article 100(c) EPC do not apply any longer.

3.2 At the oral proceedings before the Board the respondent for the first time in the proceedings argued that claim 1 as amended would contravene Article 123(3) EPC because claim 1 as granted defined "at least 5 % by volume" so that the reference of the feature "sizes less than 10 μ m to below 5%" could only be "volume %" so that the present reference to "the total weight of chromium oxide" would change the scope of claim 1 as granted.

3.2.1 The Board cannot accept these arguments since claim 1 as granted did not define the basis of said feature "below 5 %" and therefore covered both alternatives, namely "% by volume" and "% by weight". Consequently, the restriction to one of these two alternatives does not extend the scope of claim 1 of the second auxiliary request beyond that of claim 1 as granted.

3.2.2 Claim 1 of the second auxiliary request therefore also complies with Article 123(3) EPC.

4. Consequently, taking account of points 2.3 to 3.2.2 above, claims 1 and 2 of the second auxiliary request are considered to comply with Articles 84, 123(2) and (3) and Rule 80 EPC. The second auxiliary request is therefore formally allowable.

5. *Reimbursement of the appeal fee (Rule 103 EPC)*

The appellant's request for reimbursement of the appeal fee is considered **not** to be equitable for the following reasons (see also Case Law of the Boards of Appeal of the European Patent Office, 6th edition 2010, section VII.E.17.3.2):

5.1 The appellant does not argue that the minutes or the decision do not reflect what actually was the course of events at the oral proceedings. To the contrary, on the remark of the Board in its preliminary opinion that it had not requested correction of the minutes, it stated expressly that it did not need to as the minutes correctly reflected what happened.

From these reactions the Board can establish that the admissibility of the two auxiliary requests, filed at the oral proceedings, was at that point challenged by the respondent (minutes point 5.9; decision, page 2, penultimate paragraph) on the basis of their late filing as well as for their compliance with Rule 80 EPC (the decision mentions erroneously Article 80 EPC).

The minutes do not mention any arguments by the appellant on this point, only its explanation of what was the content of the requests, after which follows the statement of the respondent that it considered their filing late. After that the minutes state that the proceedings were adjourned for deliberation and resulted in the Opposition Division's statement after the reopening of the proceedings that the requests were not admitted for their (i) lateness, (ii) not being occasioned by a ground of opposition (Rule 80 EPC) and (iii) not fulfilling Article 84 EPC.

- 5.2 The above leads the Board to the conclusion that the appellant did have the opportunity to react to the question of admissibility of these requests, but did not use it.

This is confirmed by the statement of the appellant that it had expected the Opposition Division, after its deliberation, to ask the appellant to explain the claim structure, in particular the necessity to file an extra independent claim. It was under the impression that the deliberation served only the purpose of allowing the Opposition Division and the other party to study the claims (see the first full paragraph of page 7 of the appellant's letter of 26 September 2012). It was then surprised that the deliberation resulted immediately in the requests not being admitted.

- 5.3 However, if the respondent raises in the discussion the issue of admissibility of requests filed at the oral proceedings, more in particular the issue whether they are related to grounds of opposition (Rule 80 EPC), it is up to the appellant to bring forward its arguments

in favour of admissibility, including reasons why they do comply with Rule 80 EPC. It cannot expect the Opposition Division, which has to stay neutral in such *inter-partes* proceedings, to prompt the appellant to make further submissions or to ask - as the appellant stated - for further explanations. The Opposition Division was therefore not at fault in deciding to deliberate on the admissibility of these requests and pronouncing its conclusion after the deliberation.

- 5.4 Moreover, if there is a doubt or a certain expectation on what will be the subject of a deliberation, it is up to the parties to verify this before the oral proceedings are interrupted for deliberation. It can be expected of the parties to actively participate, in particular at the oral proceedings, and to actively safeguard their interests.

In this respect the Board concurs with R 17/11, reasons no. 19 in which the Enlarged Board of Appeal made it clear that in appeal proceedings it is upon a party to make sure that the points it wishes to raise are actually raised in the proceedings. If it considers something is going to be overlooked, it should raise the issue, if necessary with a formal request, which should then be minuted.

The present Board considers these principles to apply also in proceedings before an Opposition Division.

- 5.5 In that sense, the appellant had the opportunity to raise the necessary points before the Opposition Division interrupted the proceedings for deliberation. Contrary to its statement that it did not "have the

slightest chance to explain to the opposition Division the motivation to file two independent claims of its own accord", it did have that chance, but did not use it.

The Board therefore cannot find fault in the manner in which the Opposition Division handled the issue of admissibility of the requests in question; the right to be heard has been observed (Article 113(1) EPC).

5.6 In the notice of appeal the appellant simply requests "reimbursement of the appeal fee" but does not give any reasoning in support. In the statement of grounds the request is not repeated, nor is a substantiation of that request to be found *expressis verbis*. However, in point 3.a) of the latter it is argued against the manner in which the discussion was held at the oral proceedings and against the reasoning in the impugned decision that the requests were not occasioned by grounds of opposition. If this is to be considered the substantiation of the request for reimbursement of the appeal fee, in the sense that the appellant was not able to react to such reasoning, the Board establishes the following:

5.7 The decision states with respect to the two auxiliary requests in question that they were late filed and **were not based on granted claims**. Further, the auxiliary requests introduced a **new** independent claim in the same category (emphasis added by the Board).

The appellant is partly right in that where it concerns claim 1 of these requests, they could not be filed earlier, as the Opposition Division had given a

positive opinion on the main request, which it only changed as late as at the oral proceedings. The amendment of claim 1, by reintroducing the passage deleted in examination, therefore was clearly occasioned by the ground of opposition of Article 100(c) EPC, raised by the respondent and was - as such - not late filed.

- 5.8 However, the requests with this claim 1 also comprised a further independent claim (5, respectively 3) resulting from **only** the features of claim 9 of the patent as granted, which was dependent on claim 1, but without taking up the features of claim 1 itself.

The conclusion of the Opposition Division that this concerned a **new** independent claim was therefore not without merit.

The case law on introduction of new independent claims in opposition and its compliance with Rule 80 EPC is quite clear in that this is not necessarily seen as occasioned by grounds of opposition (see Case Law of the Boards of Appeal of the European Patent Office , 6th edition 2010, section VII.D.4.1.3 b)). The non-admittance of the auxiliary requests on this basis is therefore also defensible.

- 5.9 As the appellant has not furnished any arguments regarding the admissibility of these requests, let alone on the question of Rule 80 EPC, introduced by the respondent in the oral proceedings (see above), the impugned decision could be based on merely establishing that fact, without infringing the appellant's right to be heard.

5.10 In view of the above, the Board concludes that a reimbursement of the appeal fee would not be equitable, the request for reimbursement is therefore refused.

6. *Remittal to the department of first instance
(Article 111(1) EPC)*

Since the Opposition Division has not yet dealt with the other grounds of opposition under Articles 100(a) and 100(b) EPC it is not appropriate for the Board to express an opinion on this matter. Furthermore, both parties requested that the case be remitted to the department of first instance for further prosecution regarding inventive step and enablement. In accordance with Article 111(1) EPC, the Board therefore considers it appropriate to remit the case to the department of first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders