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Datasheet for the decision of 17 November 2015

Case Number: T 2359/12 - 3.2.07

Application Number: 05795017.2

Publication Number: 1816934

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Language of the proceedings: EN

Title of invention:
Capsule with biasing sealing member

Patent Proprietor:
Nestec S.A.

Opponent:
DEMB Holding B.V.

Headword:

Relevant legal provisions:
EPC Art. 100(c), 111(1)
EPC R. 139
RPBA Art. 13(1)

Keyword:
Correction of error - obvious error
Ground for opposition (main request) - added subject-matter (yes)
Late-filed auxiliary request Ia - request clearly allowable (no)
Late-filed auxiliary request II - converging version of claims (admitted)
Late-filed argument - admitted (yes)
Remittal to the opposition division (yes)

Decisions cited:
G 0003/89, R 0001/13, T 1018/02, T 0223/05

Catchword:

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Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2359/12 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 17 November 2015

Appellant I: (Patent Proprietor)	Nestec S.A. Avenue Nestlé 55 1800 Vevey (CH)
Representative:	Rupp, Christian Mitscherlich PartmbB Patent- und Rechtsanwälte Sonnenstraße 33 80331 München (DE)
Appellant II: (Opponent)	DEMB Holding B.V. Vleutensevaart 35 3532 AD Utrecht (NL)
Representative:	V.O. P.O. Box 87930 2508 DH Den Haag (NL)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 5 October 2012 concerning maintenance of the European Patent No. 1816934 in amended form.**

Composition of the Board:

Chairman	H. Meinders
Members:	K. Poalas
	R. Cramer

Summary of Facts and Submissions

I. Appellants I and II (patent proprietor and opponent, respectively) lodged each an appeal against the interlocutory decision maintaining European patent No. 1 816 934 in amended form.

II. Opposition had been filed against the patent as a whole based on Articles 100(a) EPC (lack of novelty and inventive step), 100(b) EPC (insufficient disclosure) and 100(c) EPC (unallowable amendments).

III. The Opposition Division found that the set of claims filed during the oral proceedings on 20 September 2012 as auxiliary request II meets the requirements of the EPC.

IV. Oral proceedings took place before the Board on 17 November 2015.

a) Appellant I requested that the decision under appeal be set aside and that the patent be maintained according to its main request filed during the oral proceedings of 17 November 2015, namely with corrected claim 1 of the patent as granted and claims 2 to 13 of the patent as granted, or, alternatively, that the patent be maintained in amended form on the basis of the sets of claims filed during the oral proceedings of 17 November 2015 as auxiliary requests Ia), II (renumbered method claims of the patent as granted) and III (renumbered method claims of auxiliary request I filed with the statement of grounds of appeal). It furthermore requested that the appeal filed by appellant II be dismissed.

b) Appellant II requested that the decision under appeal be set aside and that the patent be revoked. It furthermore requested that the appeal filed by appellant I be dismissed.

V. The independent claims 1 (amendments over claim 1 of the patent as granted are in bold or struck through), 11 and 12 according to the main request read as follows:

"1. A capsule for containing beverage ingredients, the capsule (1) being designed for insertion in a beverage production device (2) in order to have a liquid under pressure have enter the capsule (1) in order to interact with the ingredients (3) in the capsule (1), wherein the exterior of the capsule (1) presents a resiliently deflectable sealing member (8) by the ~~fluid~~ **liquid** under pressure, wherein the sealing member is part of a flange-like rim (6) of the capsule, characterized in that:
the flange-like rim comprises a clamping portion (29) that bears the clamping forces when the capsule is held in position in the beverage device, wherein said clamping portion (29) forms an annular surface and the sealing member (8) prolongs the clamping portion (29), and it further comprises a foil member(5) adapted to be torn onto relief elements of the beverage device".

"11. A method for producing a beverage, the method comprising the following steps:
- providing a capsule (1) containing ingredients,
- positioning the capsule (1) in a beverage production device (2),
- providing clamping on a clamping portion (29) of the flange-like rim so that the capsule is held in position in the device,

- producing at least a first opening in a first wall member (4) of the capsule (1),
- having a liquid enter the capsule (1) at said least first opening in the base body (4) and,
- producing at least a second opening in a second wall member and draining a beverage from the second opening of the capsule (1),
wherein it comprises:
- separating the two openings by a sealing engagement of at least one sealing surface of the beverage production device (2) and a sealing member (8) at the exterior of the capsule (1),
the sealing member (8) being biased against the sealing surface of the beverage producing device (2) and
wherein said clamping portion (29) forms an annular surface and the sealing member (8) prolongs the clamping portion (29)".

"12. A method for producing a beverage, the method comprising the steps of:
- providing a capsule (1) containing ingredients,-
positioning the capsule in a beverage production device (2),
- providing clamping on a clamping portion (29) of the flange-like rim so that the capsule is held in position in the device,
- producing at least a first opening in a first wall member of the capsule,
- having a liquid enter the capsule (1) at the first opening in the base body (4),
- producing at least a second opening in a second wall member and draining a beverage from the second opening of the capsule (1), and
- separating the at least first and second openings by a sealing engagement of at least one sealing surface of the beverage production device (2) and a sealing member

(8) at the exterior of the capsule (1),
the sealing engagement being self-reinforcing when pressurized and wherein said clamping portion (29) forms an annular surface and the sealing member (8) prolongs the clamping portion (29)".

Independent claim 1 of auxiliary request Ia) (amendments over claim 1 of the main request are in bold) reads as follows:

"A capsule for containing beverage ingredients, the capsule (1) being designed for insertion in a beverage production device (2) in order to have a liquid under pressure have enter the capsule (1) in order to interact with the ingredients (3) in the capsule (1), wherein the exterior of the capsule (1) presents a resiliently deflectable sealing member (8) by the liquid under pressure **flowing outside the capsule (1)**, wherein the sealing member is part of a flange-like rim (6) of the capsule,
characterized in that:
the flange-like rim comprises a clamping portion (29) that bears the clamping forces when the capsule is held in position in the beverage device, wherein said clamping portion (29) forms an annular surface and the sealing member (8) prolongs the clamping portion (29), and it further comprises a foil member(5) adapted to be torn onto relief elements of the beverage device, **wherein the sealing member (8) is a flexible lip extending from the outer edge of the flange-like rim (6)**".

Independent claims 1 and 2 of auxiliary request II are identical with the independent claims 11 and 12 of the patent as granted.

Independent claims 1 and 2 of auxiliary request III are identical with the independent claims 11 and 12 of auxiliary request II with the additional feature:

"wherein the sealing member (8) is a flexible lip extending from the outer edge of the flange-like rim (6)".

VI. In the present case reference is made to the following document:

D1: WO 2006/045537 A1,

said document corresponding to the originally filed application.

VII. Appellant I's arguments, in so far as they are relevant for the present decision, may be summarised as follows:

Correction of an error in claim 1 according to the main request, Rule 139 EPC

In the set of claims filed during the examination proceedings with letter of 13 October 2008 the term "fluid" was erroneously inserted into claim 1. There exists no mention of the term "fluid" in D1, said last disclosing only the term "liquid".

Claim 1 of the patent as granted starts by claiming that the capsule is designed for insertion into a beverage production device in order to have **a liquid under pressure** enter the capsule in order to interact with the ingredients in the capsule, wherein the exterior of the capsule presents a resiliently deflectable sealing member by **the fluid under pressure.**

Due to the use of the above underlined indefinite, respectively definite articles it is evident that the "fluid under pressure" refers to the antecedent term "liquid under pressure" and is identical with this term.

For the above-mentioned reasons, the term "fluid" in claim 1 of the patent as granted represents an obvious error and has to be corrected into "liquid".

Claim 1 according to the main request – amendments, Article 100(c) EPC

In claim 1 **feature 1c)** (= "wherein the exterior of the capsule presents a resiliently deflectable sealing member by the liquid under pressure") first and foremost requires that the sealing member is resiliently deflectable. The reference to the liquid under pressure for resiliently deflecting the sealing member thereby does not provide for a further limitation of this feature, in particular as the liquid under pressure is not part of the claimed capsule.

D1 teaches on page 5, lines 27 to 33 that "The sealing member can be geometrically arranged to be biased against at least one sealing surface of the beverage production device when the capsule is positioned in the beverage production device **and/or** when water pressure is build (*sic*) up in the beverage production device in order to make water traverse the interior of the capsule".

Accordingly, at least the second alternative of said text passage provides support for the feature of the sealing member being biased by the water pressure built

up in the beverage production device and thus by the liquid under pressure as required in claim 1.

According to page 5, lines 24 to 35 of D1 the sealing member is always present and sealing occurs due to the liquid pressure.

According to page 14, lines 26 to 30 of D1 the sealing member, in the form of a free lip, deflects freely under liquid pressure. This proves that it is designed so that the liquid pressure can act on it. Accordingly, the expression "presented by the liquid under pressure" in claim 1 means that the sealing member is so designed that the water under pressure can access it and can then develop a sealing effect.

Admissibility of auxiliary request Ia) – Article 13(1) RPBA

Basis for the introduction into claim 1 of the **feature 1i)** (="wherein the sealing member is a flexible lip extending from the outer edge of the flange-like rim") and for the introduction of the expression "flowing outside the capsule" into **feature 1c)** of said claim can be found on page 3, lines 23 to 34, on page 4, lines 1 to 8 and on page 6, lines 1 to 5 and lines 32 to 33 of D1.

Figures 2 to 4 show a sealing member under liquid pressure for a liquid flowing outside the capsule, said sealing member being a flexible lip and extending from the outer edge of the flange-like rim.

Admissibility of auxiliary request II – Article 13(1) RPBA

Claims 1 and 2 of auxiliary request II correspond to the method claims 11 and 12 of the patent as granted. They were always part of all appellant I's requests filed during the appeal proceedings.

Furthermore, during the appeal proceedings both appellant II and the Board have presented arguments concerning the patentability of said claims.

Therefore, the filing of auxiliary request II relating exclusively to the method claims of the patent as granted cannot take appellant II or the Board by surprise.

In addition, since the discussion during the oral proceedings concentrated on the allowability of claim 1 due to the presence of **feature 1c)** in said claim, and claims 1 and 2 of auxiliary request II do not involve said feature, the filing of this set of claims is appellant I's contribution to the streamlining of the appeal proceedings by filing a converging request.

Admissibility of a further detailed line of argument based on the ground for opposition according to Article 100(c) EPC presented by appellant II during the oral proceedings – Article 13(1) RPBA

Claims 1 and 2 are based on claims 13 and 14 of D1 together with the introduction of the following further features:

different feature 1c), respectively **different feature 2c)**: "providing clamping on a clamping portion (29) of

the flange-like rim so that the capsule is held in position the device",
different feature 1i), respectively **different feature 2i)**: "wherein said clamping portion (29) forms an annual surface", and
feature 1j), respectively **feature 2j)**: "the sealing member prolongs the clamping portion (29)".

Basis for the above-mentioned added features is to be found on page 13, lines 8 to 14 and page 14, lines 14 to 30 of D1.

Appellant II's further detailed line of argument in support of its objections is based on Article 100(c) EPC and said line of argument being presented for the first time during the oral proceedings is an amendment of the appellant II's case and should therefore not be admitted into the proceedings in accordance with Article 13(1) RPBA.

VIII. Appellant II's arguments, in so far as they are relevant for the present decision, may be summarised as follows:

Correction of an error in claim 1 according to the main request, Rule 139 EPC

Given that there exists no technical necessity for the "liquid under pressure" which enters the capsule to be identical with the "fluid under pressure" that "presents the resiliently deflectable sealing member", the use of the term "fluid" in claim 1 is not an obvious error and cannot be corrected under Rule 139 EPC.

Claim 1 according to the main request – amendments, Article 100(c) EPC

In claim 1 "a liquid under pressure" is first mentioned in said claim as entering the capsule in order to interact with the ingredients in the capsule. Then, according to **feature 1c)** the capsule "presents a resiliently deflectable sealing by the liquid under pressure". In other words, the liquid under pressure entering the capsule causes the presentation of the sealing member.

A sealing member which, according to the preamble of claim 1, is part of the flange-like rim of the capsule and "presented" at the exterior of the capsule "by the liquid under pressure" entering the capsule makes technical sense, as illustrated with drawings during the oral proceedings.

There is no basis in D1 for the **feature 1c)** of claim 1.

There are several other embodiments falling within the scope of claim 1 due to the insertion of **feature 1c)** into said claim and not only the one depicted in figures 2 to 4 of D1.

Admissibility of auxiliary request Ia) – Article 13(1) RPBA

There exists no basis in D1 for the combination the features of claim 1 concerning the exterior of the capsule presenting a resiliently deflectable sealing member by the liquid under pressure "flowing outside the capsule", nor for **feature 1i).**

Given that on the one hand according to **feature 1i)** the

sealing member in the form of a flexible lip extends from the outer edge of the flange-like rim and is thus always present and on the other hand according to **amended feature 1c)** the sealing member is presented only after the liquid under pressure has entered the capsule in order to interact with the ingredients and at the same time said liquid under pressure flows outside the capsule, the **amendment of feature 1c)** in combination with the introduced **feature 1i)** renders the subject-matter of claim 1 unclear and thus makes claim 1 not *prima facie* allowable.

Therefore, auxiliary request Ia) should not be admitted into the proceedings.

Admissibility of auxiliary request II – Article 13(1) RPBA

There was no indication in the appeal proceedings until as late as the oral proceedings that appellant I intended to focus its case only on the method claims.

The late filing of auxiliary request II is not in accordance with Article 13(1) RPBA and the Board should not admit it into the proceedings.

Admissibility of a further detailed line of argument based on the ground for opposition according to Article 100(c) EPC presented by appellant II during the oral proceedings – Article 13(1) RPBA

Auxiliary request II consists of a totally new set of claims, said last being directed now only to method claims.

It is only at a very late stage of the appeal

proceedings, namely towards the end of the oral proceedings, that the discussion under Article 100(c) EPC focused only on said method claims. It is therefore a matter of fairness that Appellant II be given the opportunity for presenting a further detailed line of argument based on the ground for opposition under Article 100(c) EPC.

Through the introduction of **different features** 1c), 2c), 1i), 1j), 2i) and 2j) into claims 1 and 2 respectively, the method claims are now directed to the combination capsule - beverage production device depicted in figures 2 and 4 of D1.

According to the corresponding passages of the description of D1 the following features are indispensable for an appropriate functioning of said combination:

a) the sealing member has to be a **flexible free lip** extending from the outer edge of the rim, otherwise it cannot provide the sealing function as disclosed in D1, see page 13, line 11 and page 14, line 5;

b) the beverage production device has to be **bell-shaped** and to be provided with an **annular support skirt** for covering the end of the flange-like rim, see page 11, lines 5 to 6 and page 15, lines 35 to 36.

Since the above-mentioned indispensable features are not present in claims 1 and 2 of auxiliary request II an inadmissible intermediate generalisation has occurred and the ground for opposition under Article 100(c) EPC holds against claims 1 and 2 of auxiliary request II.

Reasons for the Decision

1. *Correction of an error in claim 1 according to the main request, Rule 139 EPC*

1.1 The second sentence of Rule 139 EPC reads: "if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction".

1.2 In G 3/89 (OJ EPO 1993, 117; see also G 11/91, OJ EPO 1993, 125) the Enlarged Board of Appeal specified that, for a correction under Rule 88, second sentence, EPC 1973, i.e. under present Rule 139, second sentence, EPC 2000 to be allowed, the respective part of the European patent had to contain such an obvious error that a skilled person was in no doubt that the feature concerned could not be meant to read as such.

1.3 The Board follows appellant I in its argument that the disclosure of D1 is directed to a capsule for containing beverage ingredients as well as to methods for producing beverages using such a capsule. The capsule is therefore designed for insertion in a beverage production device in order to have a liquid under pressure, in the specific examples water under pressure, enter the capsule in order to interact with the ingredients in the capsule for producing the beverage, see page 1, lines 6 to 23, page 5, line 19 to page 6, line 7, page 7, line 36 to page 8, line 37, page 10, lines 18 to 26, page 11, lines 5 to 12, claims 1, 13 and 14 of D1. It is thus evident that the disclosure of D1 focuses on liquids and not on gases or

vapours falling under the general term of "fluid(s)".

1.4 Furthermore, claim 1 of the patent as granted starts claiming that the capsule is designed for insertion in a beverage production device in order to have a liquid under pressure enter the capsule in order to interact with the ingredients in the capsule, wherein the exterior of the capsule presents a resiliently deflectable sealing member by the fluid under pressure. Due to the use of the above underlined indefinite, respectively definite articles it is evident that the term "fluid under pressure" can only refer to the antecedent term "liquid under pressure" in said claim and that the use of the term "fluid under pressure" is an obvious error.

1.5 The Board notes further that the term "liquid under pressure" is narrower than the term "fluid under pressure" and thus corrected claim 1 does not violate the requirements of Article 123(3) EPC.

1.6 For its allegation that it is technically feasible to have on the one hand the "liquid under pressure" entering the capsule and on the other hand another "fluid under pressure" which "presents the resiliently deflectable sealing member", appellant II presented no basis in D1. That it is technically feasible may be so, but for such an interpretation there should have been supporting information in D1, because that would be a rather particular arrangement. Such an information lacks in D1.

The Board therefore does not consider said appellant II's allegation to be valid.

1.7 For the above-mentioned reasons, the request for correction under Rule 139 EPC is allowed.

2. *Claim 1 according to the main request – amendments, Article 100(c) EPC*

2.1 The Board notes that Article 69 EPC and its Protocol do not provide a basis for excluding what is literally covered by the terms of the claims, see T 223/05, not published in OJ EPO, headnote. This is in conformity with the statement under point 3.8 of T 1018/02, not published in OJ EPO: "Still, the description cannot be used to give a different meaning to a claim feature which in itself imparts a clear, credible technical teaching to the skilled reader. This also applies if the feature has not been initially disclosed in the form appearing in the claim. Otherwise third parties could not rely on what a claim actually states (cf. Article 69(1) EPC: The terms of the claims determine the extent of protection whereas the description is only used to interpret the claims) and Article 123(2) EPC would become meaningless in respect of amendments to the claims".

2.2 In **feature 1c)**, the object is "resiliently deflectable sealing member", the verb is "presents", and the actor of the verb is "the liquid under pressure". This word order, as a matter of fact, does not grammatically permit **feature 1c)** to be understood such that "by the liquid under pressure" refers solely to "deflectable" in the sense of flexible by the liquid pressure, as argued by appellant I. Furthermore, in claim 1 "a liquid under pressure" is first mentioned as entering the capsule in order to interact with the ingredients in the capsule. Then, according to **feature 1c)** the capsule "presents a resiliently deflectable sealing by

the liquid under pressure". In other words, the liquid under pressure entering the capsule causes the presentation of the sealing member.

2.3 It is further undisputed that **feature 1c)** is clear in itself and thus an interpretation of said feature by recourse to the description is not necessary.

2.4 Additionally, a sealing member which, according to the preamble of claim 1, is part of the flange-like rim of the capsule and presented at the exterior of the capsule by the liquid under pressure entering the capsule technically makes sense as demonstrated by the appellant II in the oral proceedings before the Board.

2.5 Furthermore, the passage at page 5, lines 27 to 35 of D1, which according to appellant I clarifies the sense of "by the liquid under pressure", only explains that the sealing member of the capsule can be biased against a sealing surface of the device to form a sealing engagement between the capsule and the device. This biasing effect can occur in a variety of ways, including under water pressure. However, that a biasing effect provided by water pressure may be applied to the resiliently deflectable sealing member does not equate to the presentation of the sealing member being caused by liquid under pressure.

2.6 Also the immediately preceding paragraph at page 5, lines 19 to 25 of D1 does not provide any basis for the feature of "presents ... by the liquid under pressure" (underlining added). The first sentence of said paragraph defines that a capsule is designed for allowing a liquid under pressure to enter the capsule in order to interact with the ingredients in the capsule. The second sentence states "The exterior of

the capsule thereby presents a resiliently deflectable sealing member" (underlining added). The presence of "thereby" does not define that the presentation of the resiliently deflectable sealing member at the exterior of the capsule is caused by the liquid under pressure.

2.7 According to page 14, lines 26 to 30 of D1 the sealing member in the form of a free lip deflects freely toward the inclined surface 15, whereby a perfect watertight sealing can be obtained. This means according to appellant I that the sealing member is so designed that liquid under pressure can access it and deflect it, so that it can then develop a sealing effect. Even if this is the case, an access of a liquid under pressure to the sealing member and thereby a development of a sealing effect does not equate to the presentation of the sealing member being caused by liquid under pressure.

2.8 **Feature 1c)** requires that said sealing member has specific material and design characteristics in order to be presented at the exterior of the capsule by liquid pressure. Accordingly, the Board cannot follow appellant I's argument that feature 1c) does not provide a further limitation for the sealing member and that for this reason feature 1c) does not need to be assessed for inadmissible amendment according to Article 100(c) EPC.

2.9 From the above it follows that not only does D1 not disclose the feature of the sealing member being presented by the liquid under pressure but also that sealing member configurations other than the one depicted in figures 2 to 4 of D1 and described in the corresponding passages of the description, namely as the one(s) presented during the oral proceedings, now

fall under the wording of claim 1. The result is that the ground for opposition according to Article 100(c) EPC holds against **feature 1c)** in claim 1.

3. *Admissibility of auxiliary request Ia) – Article 13(1) RPBA*

3.1 According to Article 13(1) RPBA it is in the Board's discretion to admit and consider any amendment to a party's case **after** it has filed its grounds of appeal or reply. 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.

3.2 Since the above-mentioned "*inter alia*" makes clear that this list of criteria is not exhaustive, the jurisprudence of the Boards of Appeal has brought forward further aspects which can be taken into account in this context, in particular whether the new request with amended claims is likely (i.e. *prima facie*) to overcome the objection(s) in response to which it was filed, see R 1/13, not published in OJ EPO, reasons nr. 16.2 and Case Law of the Boards of Appeal, 7th edition, 2013, IV.E.4.2.1, 3rd paragraph.

3.3 According to established jurisprudence of the Boards of Appeal the claims *per se* must be free of contradiction and clear in themselves when read by the person skilled in the art, without any reference to the content of the description, see Case Law of the Boards of Appeal of the EPO, 7th edition 2013, II.A.3.1, first paragraph.

3.4 The Board follows appellant II arguing that given that on the one hand according to **feature 1i)** the sealing member is in the form of a flexible lip extending from

the outer edge of the flange-like rim and is thus always present and on the other hand according to **amended feature 1c)** the sealing member is presented after the liquid under pressure has entered the capsule in order to interact with the ingredients and at the same time said liquid under pressure flows outside the capsule, the **amended feature 1c)** in combination with the introduced **feature 1i)** renders the subject-matter of claim 1 *prima facie* unclear and makes thus claim 1 not *prima facie* allowable. This is independent of whether the amendments in claim 1 overcome the objections under Article 100(c) EPC against claim 1 of the main request, see point 2 above.

3.5 Auxiliary request Ia) is for the above-mentioned reasons not admitted into the proceedings.

4. *Admissibility of auxiliary request II – Article 13(1) RPBA*

4.1 It is also consistent jurisprudence of the Boards of Appeal that the admissibility according to Article 13(1) RPBA of any amendment to a party's case after it has filed its grounds of appeal or reply to the appeal depends, among other things, on whether the amended claims converge with or diverge from the subject-matter previously claimed, i.e. whether they develop and increasingly limit the subject-matter of the independent claim of a main request in the same direction and/or in the direction of a single inventive idea, or whether the requests go in different lines of development because, for instance, they each incorporate different features, see Case Law of the Boards of Appeal, 7th edition, 2013, IV.E.4.4.4, 1st paragraph.

4.2 **Feature 1c)** in product claim 1 in all appellant I's previous requests was central to the allowability and admissibility discussions during a substantial part of the oral proceedings before the Board.

4.3 The amendment in auxiliary request II filed for the first time during the oral proceedings consists in the deletion of all product and system claims of appellant I's higher ranking requests and the maintenance of only two method claims 1 and 2, said claims being identical with the method claims 11 and 12 of the patent as granted. Furthermore, said method claims 1 and 2 do not involve **feature 1c)**.

4.4 The Board considers this auxiliary request II with only two claims, none of them having **feature 1c)** objected to previously, as a converging request, conclusive to a streamlining of the appeal proceedings.

4.5 Given that method claims 1 and 2 of auxiliary request II are identical with the method claims 11 and 12 of the patent as granted, said last being objected by the appellant II during the whole opposition-appeal-proceedings, appellant II cannot be taken by surprise when having to argue against this auxiliary request.

4.6 For the above-mentioned reasons the Board admits auxiliary request II into the proceedings.

5. *Admissibility of a further detailed line of argument based on the ground for opposition according to Article 100(c) EPC presented by appellant II during the oral proceedings – Article 13(1) RPBA*

5.1 In paragraphs A.2 and A.3 of its notice of opposition appellant II presented a line of argument as to why

Article 100(c) EPC holds against the introduction of **features 11c), 11i), 11j),** respectively **features 12c), 12i), 12j),** during examination, into the then method claims 11 and 12 of the patent as granted (now method claims 1 and 2).

5.2 Under point 2.2.2.3 of its decision the opposition division found that the introduction of **features 11i), 11j),** respectively **features 12i), 12j),** contravenes the requirements of Article 123(2) EPC, i.e. that the ground for opposition according to Article 100(c) EPC holds against the presence of said features in claims 11 and 12.

5.3 In the last paragraph of page 10 of its statement setting out the grounds of appeal appellant II agrees with the above-mentioned finding of the opposition division and argues against the presence of further unallowable amendments in said claims, i.e. obviously against the presence of **feature 11c),** respectively **feature 12c),** in claim 11, respectively claim 12.

5.4 Furthermore, the Board gave under point 4.2.1 of its communication pursuant to Article 15(1) RPBA a provisional opinion as to whether the ground for opposition according to Article 100(c) EPC holds against the presence of **features 11i), 11j),** respectively **features 12i), 12j),** in claim 11 respectively 12.

5.5 It was only at a late stage of the oral proceedings that appellant I filed auxiliary request II consisting only of the two independent methods claims 1 and 2 corresponding to the independent method claims 11 and 12 of the patent as granted.

Subsequently, the question whether the ground for opposition according to Article 100(c) holds against the claims of the auxiliary request II was discussed with the parties and appellant II presented a further detailed line of argument based on said ground for opposition.

This submission of arguments by appellant II was then contested by appellant I as being inadmissible under Article 13(1) RPBA, since it has been presented only during the oral proceedings.

5.6 In the view of the Board this submission of arguments by appellant II does not alter the legal and factual framework of the proceedings, given that it is a further detailed line of arguments, essentially based on the statement setting out the grounds of appeal, see point 5.3 above. Therefore, there is no substantial amendment of the case as set out in the statement setting out the grounds of appeal.

5.7 For the above-mentioned reasons, the Board decided to admit this further detailed line of argument presented during the oral proceedings into the proceedings.

6. *Procedural matters*

In view of the new situation created by the admission of both appellant I's auxiliary request II and appellant II’s further detailed line of argument as discussed above and in order not to deprive the parties of the opportunity to argue their case before two instances, the Board exercises its discretion according to Article 111(1) EPC not to examine auxiliary request II for the first time in the appeal proceedings but to

remit the case to the opposition division 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 opposition division for further prosecution.

The Registrar: The Chairman:

G. Nachtigall H. Meinders

Decision electronically authenticated