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**Datasheet for the decision  
of 21 May 2015**

**Case Number:** T 2536/12 - 3.2.03

**Application Number:** 03768445.3

**Publication Number:** 1583626

**IPC:** B22F3/105

**Language of the proceedings:** EN

**Title of invention:**

ARRANGEMENT AND METHOD FOR PRODUCING A THREE-DIMENSIONAL  
PRODUCT

**Patent Proprietor:**

ARCAM AB

**Headword:**

**Relevant legal provisions:**

EPC Art. 108

EPC R. 99(2)

**Keyword:**

Admissibility of appeal -  
appeal sufficiently substantiated (no)

**Decisions cited:**

**Catchword:**



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Case Number: T 2536/12 - 3.2.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.03**  
**of 21 May 2015**

**Appellant:** ARCAM AB  
(Patent Proprietor) Krokslätts Fabriker 30  
431 37 Mölndal (SE)

**Representative:** Zacco Sweden AB  
P.O. Box 5581  
114 85 Stockholm (SE)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 15 October 2012  
revoking European patent No. 1583626.**

**Composition of the Board:**

**Chairman** G. Ashley  
**Members:** V. Bouyssy  
I. Beckedorf

## **Summary of Facts and Submissions**

- I. European patent No. 1 583 626 (in the following: "the patent") as a whole was opposed on the grounds of Article 100(b) EPC and Article 100(a) EPC, for lack of novelty and inventive step.
  
- II. During the oral proceedings before the Opposition Division, the patent proprietor withdrew its (sole) previous request on file, and replaced it by a main request and an auxiliary request (Annex A of the minutes) and, after an extensive discussion of the novelty and inventive step of these requests, the patent proprietor again withdrew these and replaced them by a new main request and a new auxiliary request (Annex B of the minutes) (see the minutes, page 2, point 4). The opponent objected to the admission of these new requests. After deliberation, the Opposition Division announced that the new requests were not admitted into the proceedings, pursuant to Article 114(2) and Rule 116(1) EPC. After the closure of the debate, when asked to confirm its requests, the patent proprietor confirmed that it maintained its non-admissible new requests (see the minutes, page 2, point 6). The Opposition Division then revoked the patent.
  
- III. This decision has been appealed by the patent proprietor (here the appellant).
  
- IV. With the summons to oral proceedings, the Board sent a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) indicating to the parties its preliminary opinion that the appeal is apparent to be inadmissible for lack of substantiation.

V. By letter dated 12 May 2015, the opponent (here respondent) withdrew its opposition.

VI. Oral proceedings before the Board were held on 21 Mai 2015.

VII. Requests

The appellant requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of one of the sets of claims filed as main request and auxiliary requests 1 to 4 with the letter of 25 February 2013 and as auxiliary requests 5 to 8 with the letter of 14 October 2013.

VIII. Prior art

In the statement of grounds of appeal, the appellant referred to the following prior art documents which were filed in the opposition proceedings and are cited in the decision under appeal:

D1: DE 43 02 418 A1

D4: WO 01/8031 A2

IX. The arguments of the appellant and of the respondent before the withdrawal of the opposition, insofar as relevant for the present decision, can be summarised as follows:

Respondent's case:

It is stated in the statement of grounds of appeal that the appellant "appeals the decision to revoke the claims submitted as main request on 20 September 2011" (see page 1). However, during the

opposition proceedings, this request had been withdrawn and thus was not the subject of the decision under appeal. The same holds for the new main request in appeal, which corresponds to the main request of 20 September 2011, and for auxiliary requests 1 to 4, which were filed for the first time in appeal. Since the appellant has not been adversely affected by the decision under appeal with respect to any of these requests, the appeal is inadmissible, in particular because the purpose of an appeal is to review what was decided at first instance and not what was not decided. Since the statement of grounds does not relate to the Opposition Division's decision, the appeal must be rejected as inadmissible for lack of substantiation.

Appellant's case:

The appeal has been sufficiently substantiated as required by Rule 99(2) EPC. It follows from the reasoning in the statement of grounds of appeal that the subject-matter of claim 1 of the main request as filed in appeal is novel and inventive in the light of D1 and D4. From this it is implicit that the subject-matter of the more limited claims of the requests according to Annex B is also novel and inventive. Therefore, it is apparent from the statement of grounds of appeal that the appellant contests the Opposition Division's decision that the subject-matter of the requests according to Annex B *prima facie* lack an inventive step. The statement of grounds of appeal thus implicitly challenges the way in which the Opposition Division exercised its discretion not to admit these requests.

In addition, the Opposition Division deprived the appellant of the opportunity to comment on its finding

that its requests of Annex B lack inventive step. In support of this allegation, a witness was offered.

### **Reasons for the Decision**

1. Withdrawal of the opposition by the respondent means it ceases to be party to the proceedings in respect of the substantive issues. This does not affect the appeal proceedings, insofar as the Board still has to examine the admissibility of the appeal of its own motion and, if found admissible, to then examine the correctness of the decision under appeal on the basis of the appellant's case. In this context, the Board can take into account the facts, arguments and evidence submitted by the respondent prior to the withdrawal of the opposition (see also Case Law of the Boards of Appeal, 7th edition, 2013, in the following "CL", IV.C.4.1.2 and IV.E.3.4.1).
  
2. Admissibility of the appeal
  - 2.1 The question is whether the statement of grounds of appeal meets the requirements of Article 108, third sentence, EPC and Rule 99(2) EPC, i.e. whether the appellant's submissions of 25 February 2013 can be considered as sufficiently substantiated.
  
  - 2.2 In accordance with the established case law, the appellant has to present its arguments clearly and concisely to enable the Board and the other party or parties to understand immediately why the decision under appeal is alleged to be incorrect, and on what facts the appellant bases its arguments, without first having to make investigations of their own (see also CL IV.E.2.6.3 a)). This interpretation is in line with Article 12(2) RPBA requiring that the statement of

grounds of appeal has to set out the totality of the appellant's case.

- 2.3 In the present case, the decision under appeal deals solely with the discretionary decision under Article 114(2) and Rule 116(2) EPC of the Opposition Division not to admit into the proceedings the main request and the auxiliary request according to Annex B as filed during the oral proceedings before it. Since there was no text submitted or agreed by the patent proprietor for maintaining the patent in amended form (Article 113(2) EPC), the patent was revoked.
- 2.4 The decision under appeal also comprises a reasoning as to why claim 1 of the main request and the auxiliary request according to Annex A lacks an inventive step (see points 6.1 to 6.6). However, this does not constitute a ground for the patent revocation, because these requests had been withdrawn and replaced by those of Annex B. Hence, this reasoning must be read merely as an introduction to the reasoning as to why the late-filed requests according to Annex B *prima facie* lacked an inventive step and thus were not admitted (see points 6.7 and 6.8).
- 2.5 In the statement setting out the grounds of appeal, the appellant does not dispute that there was no admissible request on file and that, as a consequence, the Opposition Division was entitled to revoke the patent. The appellant also does not challenge the way in which the Opposition Division had exercised its discretion. The requests submitted and not admitted in the opposition proceedings, i.e. those of Annex B, are neither maintained nor mentioned in the grounds of appeal.

2.6 Instead, it is stated under the heading "Grounds of appeal" on page 1 of the letter of 25 February 2013 that "the patent proprietor appeals the decision to revoke the claims submitted as main request on 20 September 2011 as a response to the Communication pursuant to R. 79(1) EPC issued 30 May 2011, since the claims are both novel and involve inventive step for the reasons stated below" and that "the patent proprietor protests against the decision choosing D1 as closest prior art". However, during the opposition proceedings, the main request and the auxiliary requests filed with letter of 20 September 2011 were withdrawn and replaced by the (sole) request filed with letter of 14 June 2012, the requests according to Annex A and eventually the requests according to Annex B. Thus, contrary to this appellant's statement, the main request of 20 September 2011 was not the subject of the decision to revoke the patent. The decision does mention the main request of 20 September 2011 but only in the history of the proceedings (see point 2.2) and it does not discuss the novelty and inventive step of its subject-matter. Although, as explained under point 2.4 above, the decision under appeal comprises a discussion as to why D1 can be selected as closed prior art to assess the inventive step of the requests according to Annex A, this point is not the ground for the patent revocation.

2.7 With the statement of grounds, the appellant resubmitted the claims of the main request of 20 September 2011 as a new main request and filed more limited claims according to new auxiliary requests 1 to 4. The appellant also challenged the Opposition Division's choice of D1 as closest prior art when assessing inventive step of this main request, explaining that D4 provides a more appropriate starting



point from which the subject-matter of the new requests has an inventive step (see the reasoning under the headings "Grounds of appeal", "Closest prior art", "Novelty" and "Inventive step").

However, neither the filing of these new requests, nor these arguments for novelty and inventive step can deprive the decision under appeal of its legal basis. Firstly, the arguments for novelty and inventive step are technical arguments that cannot prove that the Opposition Division has not exercised its discretion in accordance with the right legal principles or that it has exercised its discretion in an unreasonable way. Secondly, the filing of new requests cannot remedy the absence of any admissible request as identified by the Opposition Division in its decision.

2.8 Upon reading the statement of the grounds of appeal vis-à-vis the decision to revoke the patent, the Board cannot see any reason why the latter contested decision is alleged to be incorrect. In addition, the Board cannot derive from the decision under appeal and the minutes of the oral proceedings that the Opposition Division incorrectly exercised its discretion under Article 114(2) and Rule 116(2) EPC in not admitting the appellant's requests according to Annex B, particularly given that the requests were filed at a very late stage of the opposition proceedings.

2.9 Hence, the appeal is inadmissible for lack of substantiation.

2.10 The appellant argues that it follows implicitly from the reasons given in the statement of appeal grounds that the Opposition Division was wrong in deciding that the subject-matter of the requests according to Annex B

*prima facie* lacked an inventive step. The Board does not agree. In the statement of grounds, there is no mention of the Opposition Division's discretionary decision to not admit the requests of Annex B, still less of the decision that its subject-matter *prima facie* lacks inventive step. In fact, the only information that can be gleaned from the statement of grounds is that the appellant considered the patent revocation to result from a lack of inventive step over D1, rather than from the lack of any admissible request. In particular, the appellant submitted new requests and arguments in support of novelty and inventive step of these requests, but neither mentioned nor maintained the requests according to Annex B. These requests were re-filed only at a later stage in the appeal proceedings, with the letter of 14 October 2013 in response to the respondent's reply to the statement of grounds.

- 2.11 In a further submission filed on 19 May 2015, the appellant alleged for the first time that, during the oral proceedings before the Opposition Division, the employee representing the patent proprietor had been deprived of its right to comment on the Opposition Division's decision to not admit the requests of Annex B for lack of inventive step. However, this allegation of breach of Article 113(1) EPC was filed very late, i.e. only two days before the oral proceedings before the Board. Further, it cannot support the admissibility of the appeal, which must be decided on the face of the statement of grounds of appeal vis-à-vis the decision under appeal. Thus, there is no need to grant the appellant's request for the employee to be heard as a witness. In addition, it follows from the minutes of the oral proceedings before the Opposition Division that the appellant has had an opportunity to address

the Opposition Division regarding its discretion to admit the requests (see the minutes, page 2, point 6). Since the appellant did not at any time request correction of the minutes, the Board can only assume that these reflect accurately the course of the proceedings before the Opposition Division. Thus, no substantial procedural violation has occurred.

**Order**

**For these reasons it is decided that:**

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated