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**Datasheet for the decision  
of 21 September 2016**

**Case Number:** T 1228/13 - 3.3.06

**Application Number:** 04810883.1

**Publication Number:** 1689832

**IPC:** C10G11/00

**Language of the proceedings:** EN

**Title of invention:**

MOBILE FLUID CATALYTIC CRACKING INJECTION SYSTEM

**Applicant:**

Johnson Matthey Process Technologies, Inc.

**Headword:**

Mobile FCC-catalyst injection system / JOHNSON MATTHEY PROCESS  
TECHNOLOGIES

**Relevant legal provisions:**

EPC Art. 123(2)  
RPBA Art. 12(4), 13(1)

**Keyword:**

Amendments (Main Request) - extension beyond the content of the application as filed (yes)

Requests submitted during oral proceedings (not admitted) - filed unjustifiably late

Requests submitted with the statement of grounds of appeal (not admitted) - filed unjustifiably late

**Decisions cited:**

**Catchword:**



**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 1228/13 - 3.3.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.06**  
**of 21 September 2016**

**Appellant:** Johnson Matthey Process Technologies, Inc.  
(Applicant) Ramshorn Executive Center  
2399 Highway 34, Suite C-1  
Manasquan, NJ 08736 (US)

**Representative:** Bown, Mark Richard  
Johnson Matthey PLC  
Intellectual Property Department  
P.O. Box 1  
Belasis Avenue  
Billingham, Cleveland TS23 1LB (GB)

**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 14 December 2012 refusing European patent application No. 04810883.1 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** L. Li Voti  
**Members:** P. Ammendola  
C. Heath

## Summary of Facts and Submissions

- I. This appeal is against the decision of the Examining Division to refuse European patent application No. 04 810 883.1 (internationally published as WO 2005/051528).
- II. During the examination proceedings the Applicant received a first communication of the Examining Division under Art. 94(3) EPC, dated 3 November 2010. In this communication, issues under Art. 123(2), 84 and 56 EPC were raised.

Thereupon, the Applicant submitted amended claims by letter of 14 March 2011.

In a communication dated 10 May 2011, referring to the version of the claims then on file, the Examining Division maintained objections under Art. 123(2) and 56 EPC and stated in the last paragraph:

*"The present application does not fulfill the requirements of EPC and, if the applicant insists with the present formulation of claims, it is likely to be refused both in written and in oral proceedings, so that at this point of the procedure oral proceedings seem to be useless."*

The Applicant replied with letter of 14 September 2011, enclosing a new amended version of the claims (in replacement of the version previously on file) and explicitly stating, *inter alia*, that it maintained the request for oral proceedings as an auxiliary measure.

The Examining Division thereupon appointed oral proceedings for 23 October 2012 and, in an annex to the

summons, examined the last filed amended claims, raising issues under Art. 123(2), 54 and 56 EPC.

With letter dated 21 September 2012, the Applicant filed another amended version of the claims (in replacement of the version previously on file). In the accompanying letter the Appellant indicated the basis for claim 1 to be in paragraphs [0030] - [0039] of the application as filed. The Appellant further indicated that "*[i]n the event that Oral Proceedings are maintained, the Applicant will not attend and requests that a decision is made on the basis of the presently pending claims.*"

The Examining Division maintained the oral proceedings and took a decision on the basis of the final set of claims as filed with the letter of 21 September 2012.

III. Claim 1 as filed with the letter of 21 September 2012 reads as follows:

*"1. A mobile catalyst injection system (400) for providing catalyst to an FCC unit (110), the mobile catalyst injection system (400) comprising:*

*a transportable platform (402);*

*an injection module (406), which comprises a storage vessel (410) coupled to a metering device (412) to meter the amount of catalyst delivered to FCC unit, wherein the injection module (406) is coupled to the FCC unit (110);*

*a control module (404), coupled to the metering device (412) to control the rates and/or amounts of*

*catalyst provided to the FCC unit (110) by the injection module (406); and*

*a pressure control apparatus (418), coupled to the storage vessel (410) of the injection module (406), that controls the pressure within the storage vessel (410)."*

IV. In the decision under appeal the Examining Division, *inter alia*, identified the features present in claim 1, apart from the feature corresponding to the system being suitable for providing catalyst to a FCC unit, only to be present in the particular embodiment disclosed in paragraphs [0030] - [0043] of the original application as internationally published, also referring to Figure 4.

The disclosure of this particular embodiment in paragraphs [0030] - [0043] (herein below referred to as **the disclosure of [0030] - [0043]**) was found to also necessarily comprise other features, listed in section 13.2.1 of the decision (starting with the following passage:

*"13.2.1 However, in correspondence with the embodiment of Figure 4, the original description additionally discloses:*

- the platform as being in the form of a trailer (which instead is not included in the definition of claim 1) and that supports the injection module and the control module (see lines 2 to 4 of paragraph [0030]; ....").*

This feature is also referred to below as **the specified platform's form**.

As this latter feature as well as the other features of the invention listed in section 13.2.1 were not present in claim 1, the Examining Division *inter alia* concluded (see sections 13.3 and 13.4 of the decision) that the claim included subject-matter not originally disclosed and, thus, that claim 1 did not fulfil the requirements of Article 123(2) EPC.

- V. With its statement of grounds of appeal the Applicant (herein below **Appellant**) filed:
- again the same set of claims already considered in the decision under appeal, as **Main Request**, and
  - two further sets of claims as **Auxiliary Requests 1 and 2**.
- VI. In the statement of grounds of appeal (see the last paragraph on page 1) claim 1 of Auxiliary Request 1 was presented as being a modified combination of the features present in claims 1 and 5 of the Main Request which "*additionally lists the features noted in the Decision*" (clearly referring to those in section 13.2.1 of the decision).
- Claim 1 of the Auxiliary Request 2 also filed with the statement of grounds of appeal was identical to claim 1 of said Auxiliary Request 1.
- VII. In a communication enclosed to the summons to oral proceedings, the Board informed the Appellant of, *inter alia*, its preliminary opinion that the pending Main Request appeared not to comply with Article 123(2) EPC. In particular, at point VII the Board stated:
- "VII. Admissibility of the amendments in claim 1 of the main request in view of Article 123(2) EPC*

*Claim 1 according to the main request has been found by the examining divisions to contain added features that were only disclosed in paragraphs [0030] to [0043] of the application as filed (and depicted in Figure 4) in combination with other features (listed under 13.2.1 in the decision under appeal), which are however missing in the claim.*

*The appellant in writing has not given any reason for reversing this finding.*

*.....*

*In the absence of any such reasoning, the board concurs preliminarily with the reasoning in the decision under appeal and, thus, preliminarily concludes that claim 1 of the present main request appears to contravene Article 123(2) EPC.*

*The board remarks also that the combination of the features of claim 1 at issue with at least some of the features contained in the dependent claims, like certain kinds of platform (claim 2), .....appear not to be supported in the application as originally filed."*

In the same communication (point IX(a)) the Board also indicated that the admissibility into the appeal proceedings of the Auxiliary Requests 1 and 2 as filed with the statement of grounds of appeal was going to be discussed at the forthcoming hearing.

VIII. With a letter of 3 August 2016 the Appellant filed two further sets of claims, respectively labelled Auxiliary Requests 3 and 4, each containing a claim 1 differing from claim 1 of the main request inter alia insofar as



it specified that "*the injection module and the control module are supported on the platform*".

- IX. At the oral proceedings, after the discussion of the compliance of claim 1 of the Main Request with Art. 123(2) EPC and deliberation on this point, the Board announced its conclusion that claim 1 of the Main Request did not comply with Art. 123(2) EPC.

The Appellant then withdrew the Auxiliary Requests 3 and 4 and filed two new sets of claims labelled as Auxiliary Requests 1 and 2 (below these are indicated as **the Auxiliary Requests 1 and 2 as filed at the oral proceedings**).

- X. The versions of claim 1 in the Auxiliary Requests 1 and 2 as filed at the oral proceedings differed respectively from the previously filed Auxiliary Requests 3 and 4 (filed with letter of 3 August 2016) in that the former specified that the "*platform is in the form of a trailer that supports the injection module and the control module*".

- XI. As final requests, the Appellant requested that the decision under appeal be set aside and that a patent be granted based on the Main Request (i.e. the set of claims decided upon by the Examining Division), or Auxiliary Requests 1 or 2 as filed during oral proceedings, or Auxiliary Requests 1 or 2 as filed with the statement of grounds of appeal.

- XII. The Appellant's submissions as to the compliance of claim 1 of the Main Request with the requirements of Article 123(2) EPC may be summarized as follows.

The **mobile fluid catalytic cracking injection system** (herein below **MI system**) defined in present claim 1 had a basis in the disclosure of [0030] - [0043] (which, although also referring to Figure 4, encompassed variants not reflected in Figure 4).

The Appellant conceded that the passages in these paragraphs actually referring to the claimed MI system (which is characterized, *inter alia*, by the presence of a metering device) also explicitly described the presence therein of "*a platform in the form of a trailer 402*" (herein below also simply **a trailer**). However, the explicit reference in [0034] of the original description, on the one hand, to the "*storage vessel 410...typically .....mounted to the trailer 402*" having size limitations in view of "*road regulations and routing requirements (e.g. overpasses, etc.)*" and, on the other hand, to another variant of the same storage vessel "*configured for mounting to a barge*" (that "*may be larger*" than the the storage vessel 410) was an implicit indication that the features disclosed in [0030] to [0043] could as well be present on platforms having the other forms mentioned in [0029].

In any case, the requirement that the platform be a trailer was not essential to the embodiment described from paragraphs [0030] to [0043]. The trailer was just one option for the transportable platform, as apparent from the preceding paragraph [0029] which contained many examples of other possible platforms. That these alternative forms of the platform were generally applicable to the whole group MI systems disclosed in the application as filed, was also apparent from the wording of the original claim 1 in combination with [0009]. It was thus evident that, in the context of the invention, any form of transportable platform, including the trailer, only had the function of

providing a transportable support, i.e. each disclosed alternative for the transportable platform was a feature technically independent from all the other features present in the MI systems described in the application as filed, inclusive of the MI system comprising a metering device according to paragraphs [0030] to [0043] and, thus, each alternative was generally applicable also within this latter system. Hence, the skilled person, making technical sense of the document, would realise that also the MI system comprising a metering device described from paragraphs [0030] to [0043] was not essentially linked to a trailer and could equally be applied to the other platform's forms.

Finally, paragraph [0047], relating to the disclosure of another embodiment of the invention - in which the injection system was a "*multi-catalyst*" injection system and comprised, *inter alia*, also a metering device - explicitly indicated that such system "*may be utilized at least with the various embodiments of the mobile catalyst injection system described above*".

Hence, the definition of the MI system in claim 1 in which the support was described as a "*transportable platform*" represented a permissible generalization of the embodiment of the invention disclosed in [0030] to [0043].

As to the admissibility into the appeal proceedings of the Auxiliary Requests 1 and 2 only filed at the oral proceedings before the Board, the Appellant argued that it had been convinced that the finding in the decision under appeal that claim 1 of the Main Request contravened Article 123(2) EPC was wrong until it had received the Board's communication enclosed to the

summons to oral proceedings (in which the Board indicated to preliminarily concur with such finding).

After hearing the Board's conclusion had it thus become clear that the presence of the trailer was considered a mandatory feature of the originally disclosed embodiment of the invention that the Appellant intended to claim.

In any case, these Auxiliary Requests 1 and 2, although only filed at the hearing, overcame all the outstanding objections and were, thus clearly allowable.

As to the admissibility into the appeal proceedings of the Auxiliary Requests 1 and 2 filed with the statement of grounds of appeal, the Appellant argued as follows:

- It was conceded that Claim 1 of the Main Request (which had been filed before the Examining Division) was substantially different from all claim versions also previously filed before the Examining Division and, thus, that by filing this Main Request just one month before the oral proceedings, the Department of First Instance had to deal with a fresh case at the hearing, which the Applicant did not attend.
- Therefore it remained the fact that the Appellant had only become aware of the objections of the Examining Division to the patentability of the Main Request upon reading the reasons of the decision under appeal.
- Thus, these Auxiliary Requests 1 and 2, which addressed these objections, had been filed at the

earliest possible moment in time, i.e. at the very beginning of the appeal proceedings.

- The Appellant indicated as reason for its absence at the oral proceedings before the Examining Division the Examining Division's letter of 10 May 2011, after which the Appellant had to reasonably assume that there was no point in participating in the oral proceedings.
- Finally, also these requests overcame all the outstanding objections and were, thus, clearly allowable.

## **Reasons for the Decision**

### *Main Request*

1. Compliance of claim 1 with Article 123(2) EPC

1.1 The Board notes that claim 1 at issue is formulated on the basis of a combination of features that is neither present as such in any of the original versions of the dependent claims nor has a literal counterpart in the explicit content of the original description.

This is not in dispute.

1.2 The Appellant has argued that the combination of features characterising the MI system of claim 1 would find an implicit basis in the disclosure of [0030] - [0043] as construed by a skilled reader also in view of the rest of the application as originally filed.

- 1.3 The Board notes that claim 1 at stake now describes a MI system which is characterised, *inter alia*, by the presence in the injection module of a metering device coupled to a storage vessel.
- 1.4 The Board also notes that MI systems in which the injection module comprises a metering device coupled to a storage vessel are indeed disclosed in the cited paragraphs [0030] to [0043].
- 1.4.1 However, the disclosure in [0030] - [0043] that refers to such MI systems also indicates that the transportable platform present therein (and onto which the other parts of the MI system are mounted) is in the form of a trailer.
- 1.4.2 In particular, this is apparent when considering the following passages in [0030], [0033] and [0034] (emphasis added by the Board) :
- "[0030] Figure 4 depicts another embodiment of a mobile catalyst injection system 400. The mobile catalyst injection system 400 includes **a platform in the form of a trailer 402** that supports an injection module 406 and a control module 404.*
- ...
- [0033] In one embodiment, the injection module 406 includes a storage vessel 410 coupled to a metering device 412.*
- .....
- [0034] The storage vessel 410 is typically a metal container **mounted to the trailer 402**. ... The size of the storage vessel 410 is generally selected based on shipping considerations. For example, **the storage vessel 410 configured to mount on a trailer 402** is limited by road regulations and routing requirements (e.g. overpasses, etc.), while another*

*storage vessel configured for mounting to a barge may be larger."*

- 1.4.3 The Board considers it appropriate to stress that the final sentence in paragraph [0034] does not refer to two examples of the same group of embodiments disclosed in the remainder of the cited passages in [0030] to [0034]. In particular, whereas the cited teaching in [0034] relating to the "storage vessel 410" which is also mounted "to the trailer 402" is manifestly the continuation of the preceding paragraph [0033] (i.e. refers to the same embodiment that is also disclosed to contain the metering device and is represented in figure 4), the statement of the "barge" at the end of [0034] does not concern figure 4 and refers to a (not further specified) "another storage vessel", which in fact does not comprise any reference number at all. Thus, the information in the cited passages in [0030], [0033] and [0034] clearly applies to the group of embodiments of relevance for present claim 1, i.e. the trailer is implicitly disclosed also in combination with, *inter alia*, the storage vessel being coupled with the metering device. The Board also stresses that the cited passage in [0034] also does not necessarily imply that the kind of storage vessel is the sole difference between the embodiment with the "trailer 402" and that with a "barge". On the contrary, the information referring to the "barge" in the same paragraph [0034] is rather disclosed relevant for "another" unspecified embodiment of the MI system of the invention, e.g. an embodiment also possibly not containing any metering device coupled to the storage vessel, like that disclosed in [0009] (see 1.5, *infra*) or [0029]. Thus, the Board finds unconvincing the Appellant's argument that the skilled reader of [0034] would consider implied therein that the features of the MI system

disclosed in [0030] to [0043] in combination with the trailer can as well be present in combination with the other forms mentioned in [0029] for the transportable platform.

1.4.4 As no other passage in [0030] to [0043] comprises any direct or indirect reference as to another form of platform in alternative to the trailer, the Board concludes that these paragraphs explicitly and implicitly only disclose a MI system comprising a metering device coupled to a storage vessel in which the transportable platform is "*the trailer 402*".

1.5 According to the Appellant's line of reasoning, it would nevertheless be permissible to generalize the relevant disclosure in [0030] to [0043] to MI systems comprising any other form of transportable platform.

The permissibility of such generalization would be apparent from the broadest definition of the invention as given in claim 1 and in the corresponding paragraph [0009] as originally filed, reading:

*"[0009] Embodiments of the invention generally relate to a fluid cracking catalyst injection system which is easily transportable and integratable with a fluid cracking catalyst unit (FCCU), thereby enabling a refiner to utilize additional types of catalyst for process control on short notice. In one embodiment, a fluid catalyst injection system includes a platform, a catalyst reservoir coupled to a platform and having a catalyst flow control device coupled to an outlet of the reservoir, wherein the platform, reservoir and flow control device are transportable as a unit. In alternative embodiments, the platform may*



*comprise a trailer, a barge, a ship, a pallet, a railcar or a container, and the like."*

Moreover, the skilled person would consider the features of the other parts of the MI system disclosed in [0030] - [0043] to be technically independent from the features of the transportable platform onto which the former were mounted.

1.6 As already indicated above (point 1.4.3) the list of embodiments encompassed by claim 1 and paragraph [0009] include MI systems possibly not containing any metering device coupled to the storage vessel. Moreover, in the opinion of the Board, the technical independence from the specified platform's form (of a trailer) of the other features of the embodiments disclosed in [0030] to [0043] is neither evident from the disclosure in application as filed nor self-evident.

1.6.1 Firstly, the explicit statements referring to the trailer in [0030] to [0043] do not contain any indication that such form of the transportable platform is e.g. optional or just preferred.

1.6.2 Secondly, the passage of paragraph [0034] already discussed above (see 1.4.3), in which the storage vessel mounted on a "barge" is described as "*another storage vessel*" (and not e.g. again as "the storage vessel 410"), does not imply that the kind of storage vessel is the sole difference between the embodiment with a "*trailer 402*" and that with a "barge". On the contrary, it suggests to the skilled reader that the whole combination of features of the embodiment of [0030] to [0043] is conceived in view of the limitations as to the overall dimensions of the MI system that are implied by the specified platform's

form of a trailer. In other words the Board considers rather self-evident to the skilled person that already the explicitly stressed difference in the dimensions between the storage vessels possibly mountable on a trailer and on a "barge" can indeed require or render manifestly more suitable to transport on the "barge" MI systems with combinations of features that are different from those described in [0030] to [0043] as mounted on the trailer.

1.6.3 Finally, also the teaching in [0047] that the whole "*multi-catalyst injection system 700*" of figure 7 which includes the trailer "*may be utilized **at least with the various** embodiments of the mobile catalyst injection system described above*" (emphasis added) is not only intrinsically vague, but cannot possibly be considered to necessarily imply that any form of the platform is equally suggested as support for each configuration of the remaining parts of the MI system that is disclosed - starting from [0009] up to [0047] - in the application as filed.

1.7 Hence, if only for the reason that the application in suit does not provide any clear and unambiguous disclosure of MI system comprising a metering device coupled with a storage vessel mounted on a transportable platform, claim 1 of the Main Request is found not to comply with the requirements of Article 123(2) EPC.

1.8 Thus, the Main Request is not allowable.

#### *Procedural issues*

2. Admissibility of Auxiliary Requests 1 and 2 as filed during oral proceedings

2.1 During oral proceedings and after taking note of the Board's conclusion that the Main Request failed to comply with Art. 123(2) EPC, the Appellant filed two new sets of claims. These differed from the previously filed Auxiliary Requests 3 and 4 (filed with letter of 3 August 2016) in that it was specified that the *"platform is in the form of a trailer that supports the injection module and the control module"* (see X, *supra*).

As a justification for the filing of these requests only at the oral proceedings, the Appellant submitted that it had been initially convinced that the finding in the decision under appeal that claim 1 of the Main Request contravened Article 123(2) EPC was wrong until it had received the Board's communication enclosed to the summons to oral proceedings (in which the Board indicated to preliminarily concur with such finding).

After hearing the Board's conclusion had it become clear that the presence of the trailer was considered a mandatory feature of the originally disclosed embodiment of the invention that the Appellant intended to claim.

In any case, these Auxiliary Requests 1 and 2, although only filed at the hearing, overcame all the outstanding objections and were, thus, clearly allowable.

2.2 The Board notes, however, that the conclusion reached by the Board at the oral proceedings was the same already taken by the Examining Division in the decision under appeal (point 13.2.1), and also announced as a preliminary opinion in the Board's communication sent

as an annex to the summons to oral proceedings (point VII). The Appellant was therefore well aware of this possible finding of the Board since the beginning of the appeal proceedings and had even been explicitly reminded of the possibility of such finding when summoned to oral proceedings.

- 2.3 Even if the Appellant did not share the finding of the Examining Division and the Board's preliminary opinion, if it was interested in patenting at least the embodiments of the invention with the transportable platform in the form of a trailer (such as in the requests filed during oral proceedings), it **could and should**, as a measure of prudence, have filed at an earlier stage of the appeal procedure auxiliary requests in which claim 1 was limited to these embodiments.

Nor has the Board's conclusion that the Main Request was not allowable resulted in confronting the Appellant with any new issues or arguments.

- 2.4 Thus, the fact that the Board arrived at a - very well foreseeable - conclusion as to the lack of compliance with Article 123(2) EPC of claim 1 of the Main Request does not justify the filing of the Auxiliary Request 1 and 2 at the very last stage of the appeal proceedings.

The filing of these Auxiliary Requests can therefore only be regarded as a piecemeal approach which the Board finds objectionable. The Appellant's argument that these requests might overcome the added-matter objections is no justification in this respect.

2.5 On that basis alone, the Board exercising its discretion under Article 13(1) RPBA decides not to admit these requests into the procedure.

3. Admissibility of Auxiliary Requests 1 and 2 as filed with the statement of grounds of appeal

3.1 The Auxiliary Requests at issue were filed with the grounds of appeal and therefore, as far as the appeal proceedings are concerned, at the earliest possible stage. In order to decide whether to hold these requests admissible or not under the provisions of Art. 12(4) RPBA, it is convenient to take a closer look at the course of the examination procedure already resumed above under point II. of the Facts and Submissions.

3.2 As indicated above (see II *supra*) the Examining Division stated in the communication of 10 May 2011 referring to the set of claims then on file, that "*at this point of the procedure oral proceedings seem to be useless*".

With letter dated 21 September 2012 - i.e. after the Appellant had filed another version of the claims and the Examining Division had summoned it to oral proceedings for 23 October 2012 and had also informed the Appellant of the preliminary opinion of the Examining Division on the then pending request - the Appellant filed a new (and final) set of claims onto which the decision under appeal is based, i.e. a set of claims in which claim 1 was for the first time based on an embodiment disclosed, according to the Applicant in paragraphs [0030] - [0039] of the application as filed. The Appellant further indicated that "*[i]n the event that Oral Proceedings are maintained, the Applicant*

*will not attend and requests that a decision is made on the basis of the presently pending claims."*

The Examining Division at the oral proceedings that were held as scheduled in the announced absence of the Appellant, had admitted such last filed set of claims, found this latter not to comply with Articles 56 and 123(2) EPC and refused the application.

- 3.3 The Auxiliary Requests 1 and 2 as filed with the statement of grounds of appeal allegedly make an attempt to remedy the defects identified in the decision under appeal and the Board examines their admissibility into the appeal proceedings in view of Art. 12(4) RPBA assuming, for the benefit of the Appellant, that these Requests would overcome the grounds for refusal as set out in the decision of the Examining Division.
- 3.4 The Board in exercising its discretion under Art. 12(4) RPBA needs to establish *inter alia* whether the requests at issue could have been filed in first instance.
- 3.5 The Appellant's argument advanced in the oral proceedings before the Board was that, since the Appellant was not present at the hearing before the Department of first instance, it had become aware of the reasons why the Examining Division had not found allowable the set of claims filed with letter of 21 September 2012 only when it received the reasons of the decision under appeal. In particular, only upon reading the decision under appeal the Appellant had become aware of the objections under Art. 123(2) EPC raised by the Examining Division to the last filed version of claim 1.

Therefore, these requests should be considered a response to the decision under appeal and could not have been filed earlier.

3.5.1 Asked about the Applicant's absence in the oral proceedings before the Examining Division, the Appellant argued that, based on what the Examining Division had written on 10 May 2011 (see II *supra*), it was reasonable for the Appellant to assume that there was no point in participating in a hearing.

3.6 The Board notes however the following:

The Appellant with the latest submission prior to oral proceedings in first instance presented a completely fresh case. The Examining Division could very well have refused this new set of claims under Rule 137 (3) EPC.

Further, the statement of the Examining Division when appointing oral proceedings as "useless" was made in respect to a set of claims different from that submitted by Appellant in preparation of the oral proceedings that had nevertheless been appointed (as explicitly requested again by the Applicant). There appears to be no reason to assume from this statement that the Examining Division saw no point in the Applicant participating in oral proceedings in general, or for assuming that taking part in oral proceedings before that Examining Division was a pointless exercise in general. To the contrary, the Board notes that each time the Appellant filed amended claims, the Examining Division issued a reasoned communication under Article 94(3) EPC.

3.6.1 Moreover, in view of the fact that the Applicant prior to oral proceedings in first instance filed a set of

claims amounting to a fresh case, and nevertheless **renounced to attend oral proceedings** and **requested a decision** on the basis of the pending claims, the Board cannot agree that a response to the reasons as advanced in the decision under appeal **could not** have been filed earlier than with the statement of grounds of appeal.

This argument might carry some weight where e.g. an Examining Division refuses a set of claims that had long been in the procedure based on grounds that had not been previously communicated, or perhaps only transpired during oral proceedings. The argument could also be correct if, in the case at issue, the Appellant upon filing new claims prior to oral proceedings had defended this set of claims in oral proceedings and attempted to overcome problems as identified by the Examining Division then and there.

Indeed, by presenting a fresh case just prior to oral proceedings, and not attending these proceedings, the Appellant deliberately renounced to defend its case before the Department of first instance at least in respect of any new objections possibly arising on the basis of the same provisions of the EPC that had already been identified as relevant for the allowability of the amended claims filed previously.

Thereby, it deliberately created a situation where any further amended requests that the Appellant considered suitable for addressing these new objections of the Examining Division, rather than be dealt by the Department of first instance, as it **could and should have been** the case if the Appellant had taken part in the oral proceedings, had to be considered for the first time in appeal.



3.6.2 The Board thus concludes that such requests could and should have been filed before the Examining Division.

3.7 For this reason, the Board, exercising its discretionary power under Art. 12(4) RPBA, holds inadmissible into the appeal proceedings also the Auxiliary Requests 1 and 2 as filed with the statement of grounds of appeal.

## Order

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

The appeal is dismissed.

The Registrar:

The Chairman:



D. Magliano

L. Li Voti

Decision electronically authenticated