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**Datasheet for the decision
of 5 July 2016**

Case Number: T 0692/14 - 3.3.09

Application Number: 07816204.7

Publication Number: 2079319

IPC: A23L1/09, A23L1/236, A23L2/60

Language of the proceedings: EN

Title of invention:
CONSUMABLES

Patent Proprietor:
Givaudan SA

Opponents:
Geitz, Holger
Cargill, Incorporated

Headword:

Relevant legal provisions:
RPBA Art. 13(1), 13(3)
EPC Art. 104, 111(1), 123(2)
EPC R. 88, 97

Keyword:

Admissibility of new main request (yes)

Remittal (yes)

Reimbursement of costs (no)

Decisions cited:

T 1282/05, T 0144/09, T 0421/09, T 0936/09, T 0154/12

Catchword:



Beschwerdekammern
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Case Number: T 0692/14 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 5 July 2016

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 10 January 2014
revoking European patent No. 2079319 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman	W. Sieber
Members:	N. Perakis
	D. Prietzel-Funk

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the patent proprietor against the decision of the opposition division to revoke European patent No 2 079 319.
- II. Notices of opposition were filed by two opponents, requesting revocation of the patent in its entirety on the grounds of Article 100(a) (lack of novelty and inventive step), 100(b) and 100(c) EPC. Additionally, third parties filed observations under Article 115 EPC on sufficiency of disclosure and lack of novelty and inventive step of the granted claims.

With letter of 23 September 2013 the proprietor filed new requests before the opposition division, namely a main request and ten auxiliary requests. At the oral proceedings of 23 October 2013, the opposition division decided not to admit these requests into the proceedings. Thereupon the proprietor filed a new main and three auxiliary requests which were also not admitted. As there were no further requests on file, the opposition division decided to reinstate claims 1 to 14 as granted "in the interest of the public and economy of the procedure", and revoked the patent because claim 14 as granted contained subject-matter which extended beyond the application as filed (Article 100(c) EPC).

- III. On 19 March 2014 the patent proprietor (in the following: the appellant) filed an appeal against the decision of the opposition division. The statement setting out the grounds of appeal was filed on 20 May 2014, including a main request and six auxiliary requests. As the decision to revoke the patent had not considered the objections under Article 100(a) and (b)

EPC, the appellant requested that the case be remitted to the opposition division for further prosecution. Furthermore, the appellant requested that the appeal fee be refunded on the grounds that the opposition division had committed various procedural violations.

- IV. With letter of 24 September 2014, opponent 2 (in the following: respondent 2) requested that the appeal be dismissed, the appellant's newly filed requests not be admitted into the proceedings, and, if they were admitted, the case be remitted to the opposition division. Lastly, an apportionment of costs was requested "for preparing the arguments concerning the newly filed claims in addition to all procedural steps to be taken after the admission of the new claim request into the proceedings, should the Board decide to do so".
- V. With letter of 2 October 2014, opponent 1 (in the following: respondent 1) requested that the appeal be dismissed. Respondent 1 questioned the admissibility of the appeal and further requested that the appellant's newly filed requests not be admitted into the proceedings.
- VI. In a communication dated 20 May 2016, the board gave its preliminary opinion on the issues raised.
- VII. With letter of 3 June 2016, the appellant filed a new main request and auxiliary requests 1 to 7. The main request consisted of claims 1 to 13 as granted (claim 14 as granted, objected to by the opposition division, was deleted).

The appellant requested that:

- the decision under appeal be set aside, the subject-matter defined in the claims of the main request or auxiliary request 1 be acknowledged as complying with Article 123(2) EPC, and the case be remitted to the opposition division for further prosecution, or alternatively that
- the subject-matter defined in the claims of auxiliary requests 2 to 7 be acknowledged as complying with Rule 80 and Articles 84 and 123(2) EPC, and the case be remitted to the opposition division for further prosecution.

Furthermore, the appellant withdrew its previous assertions of procedural violations and the request for reimbursement of the appeal fee. It also declared that reinstating the granted claims into the proceedings by the opposition division had not occurred against its will, since as proprietor it had agreed to the text of the patent as granted (see minutes of the oral proceedings before the opposition division, sections 4.7 and 4.8).

VIII. On 5 July 2016, oral proceedings were held before the board, in the course of which respondent 1 stated that it was not pursuing the issue regarding the admissibility of the appeal. Respondent 1 also requested an apportionment of costs. Respondent 2 made it clear that its previous request for remittal concerned the previous requests of the appellant. Regarding the new main request, it asked that it not be remitted to the opposition division.

IX. The relevant arguments put forward by the appellant in its written submissions and during the oral proceedings may be summarised as follows:

- The main request should be admitted into the appeal proceedings. It corresponded to the claims as granted, with the exception of claim 14. The deletion of claim 14 as granted overcame the reason for revoking the patent in suit, namely the non-compliance of claim 14 with Articles 100(c)/123(2) EPC.
- The decision on Articles 100(c)/123(2) EPC regarding claim 14 had been announced at the end of the oral proceedings before the opposition division, after the opposition division had stated that the appellant would not be allowed to file further requests (see minutes of the oral proceedings, sections 4.7 and 5.2).
- The opposition division had decided that claim 14 as granted did not comply with Articles 100(c)/123(2) EPC, although it had previously communicated to the parties that these requirements appeared to be met. Reference was made to the communication accompanying the summons to oral proceedings dated 20 November 2012 (see point 3.3).
- As the appellant could not have presented the new main request during the proceedings before the opposition division, Article 12(4) RPBA should be no bar to its admissibility.
- Furthermore, the main request should also be admitted under Article 13 RPBA, because the deletion of claim 14 from the granted claims did

not introduce any complexity into the case and did not give rise to a situation or issues which would require the adjournment of the oral proceedings. On the contrary, the new main request was *prima facie* allowable in the sense that it fully addressed the objections raised in the contested decision.

- Regarding the other objections raised in the proceedings before the opposition division by the respondents or the third parties, they could be dealt with after remittal of the case to the opposition division for further prosecution.

X. The relevant arguments put forward by the respondents in their written submissions and during the oral proceedings may be summarised as follows:

- The new main request should not be admitted into the proceedings. The board should exercise its discretion under Article 13(1) RPBA strictly, in view of the added complexity and the need for procedural economy.
- One month before the oral proceedings, the appellant had filed a new main request which was broader in scope than the main request filed with the statement setting out the grounds of appeal, and had thus introduced complexity at this late stage of the proceedings.
- The claims of the main request did not *prima facie* overcome the objections raised with the notices of opposition and thus they should not be admitted into the proceedings.

- The new main request could have been filed earlier and thus the work of the respondents on the requests now withdrawn could have been avoided. As a consequence, if the case were remitted to the opposition division, the board should order apportionment of costs in favour of the respondents.
- Anyway, the case should not be remitted to the opposition division since this would be at odds with procedural economy and inappropriate to the circumstances of the present case. The granted claims - except claim 14 which had been deleted - would be brought once more before the opposition division after four years of opposition and appeal proceedings.
- The request for remittal by respondent 2 concerned not the new main request but the requests previously filed by the appellant.

XI. The appellant (patent proprietor) requested that the decision under appeal be set aside, that the subject-matter defined in the claims of the main request or auxiliary request 1, both filed with the letter dated 3 June 2016, be acknowledged as complying with Article 123(2) EPC and that the case be remitted to the opposition division for further prosecution, or alternatively that the subject-matter defined in the claims of auxiliary requests 2 to 7, submitted with the letter dated 3 June 2016, be acknowledged as complying with Rule 80 EPC and Articles 84 and 123(2) EPC and that the case be remitted to the opposition division for further prosecution.

- XII. The respondents (opponents) requested that the appeal be dismissed, that the case not be remitted to the opposition division and that apportionment of costs be ordered.

Reasons for the Decision

1. Admissibility of the main request

- 1.1 At the oral proceedings of 23 October 2013, the opposition division did not admit any of the appellant's claim requests into the proceedings. As there was at that stage of the proceedings no valid claim request on file, the opposition division should have terminated the proceedings by revoking the patent on this basis.

Instead, the chairman of the opposition division asked the appellant, whilst simultaneously announcing that no further opportunity to file new requests would be allowed, whether it still agreed to the text of the patent as granted. The appellant indicated that this was the case (see points 4.7 and 4.8 of the minutes of the oral proceedings before the opposition division).

The opposition division then decided to reinstate the claims as granted, namely claims 1 to 14, and eventually revoked the patent because claim 14 as granted contained subject-matter which extended beyond the application as filed (Article 100(c) EPC).

- 1.2 With letter dated 3 June 2016, i.e. two years after filing the statement setting out the grounds of appeal and only one month before the oral proceedings, the

appellant filed a new main request consisting of claims 1 to 13 as granted while claim 14 was now deleted. Thus the admissibility of this request has to be assessed in view of Article 13(1) and (3) RPBA.

- 1.3 In accordance with Article 13(1) RPBA, any amendment to a party's case, in the present case the admission of the new main request, is at the board's discretion, which is to 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.

In accordance with Article 13(3) RPBA, amendments sought to be made after oral proceedings have been arranged are not admitted if they raise issues which the board or the other parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

Although the new main request was submitted late, it overcame the sole reason for revoking the patent by simply deleting claim 14. Furthermore, the mere deletion of claim 14 did not complicate the case at this stage of the proceedings in such a way that the board or the respondents could not reasonably be expected to deal with the new main request without adjournment of the oral proceedings.

Procedural economy speaks only at first glance against the admission of the new main request. The respondents' argument in this context was that they would have to deal with the other issues raised already in the notices of opposition and by the third parties only now, four years after the beginning of the opposition proceedings. The board is not convinced by this

argument because these issues would have to be investigated for any request considered allowable under Article 123(2) EPC. As pointed out above, the decision under appeal dealt only with added subject-matter in relation to granted claim 14. Thus, considerations of procedural economy are no obstacle to the admission of the new request.

- 1.4 The respondents criticised the fact that the new main request was filed only one month before the oral proceedings and its subject-matter was broader than that of the previous requests. In this context reference was made to T 1282/05.

However, in T 1282/05 new, broader claims with which the board had never been confronted were filed one month before the oral proceedings. In the present case, the claims as granted were the basis for the appeal, and the parties and the board were aware of these claims from the beginning of the appeal. Thus this argument of the respondents must fail.

- 1.5 The respondents also argued that the new main request should not be admitted into the proceedings because the subject-matter of claims 1 to 13 was not *prima facie* allowable. Reference was made to T 421/09 where the board did not admit a late-filed request which it considered not clearly allowable.

The board does not agree with the respondents. The question to be answered in the present case is not whether the new main request is *prima facie* allowable in respect of all patentability issues. Rather the question is whether it *prima facie* overcomes the (sole) objection raised in the appealed decision, namely the objection of added subject-matter, without giving rise

to new ones. As this appears to be the case, this argument of the respondents must also fail.

- 1.6 Lastly, the respondents argued that the new main request should not be admitted under Article 12(4) RPBA because it could have been presented before the opposition division.

Article 12(4) RPBA relates to facts, evidence and requests submitted with the statement setting out the grounds of appeal, and therefore cannot be the legal basis for refusing to admit the new main request in the present case. Nevertheless, the argument has to be considered also under Article 13(1) RPBA, because parties should not be able to circumvent Article 12(4) RPBA by simply filing a request at a later stage in the proceedings. The argument fails, however, for the following reasons:

Firstly, as set out in point 1.1 above, after the reinstatement of the granted claims by the opposition division, the appellant was not allowed to file any new request. Therefore, even if it had envisaged refiling a further request without the disputed claim 14, it could not have done so. Secondly, on the basis of the opposition division's positive preliminary view of claim 14 as granted in the communication accompanying the summons to oral proceedings (see point 3.3), the appellant would not have expected a negative decision on this issue, certainly not without being given the opportunity to react to such a change of mind and thus had no cause to file a new request with a claim set without claim 14.

The respondents referred to T 144/09, T 154/12 and T 936/09. However, these decisions do not apply to the

present case because of the different circumstances: in these decisions the patent proprietor did not submit amended claims in order to overcome the added subject-matter objection although the opposition division had offered such an opportunity.

1.7 In view of the above, the board admitted the new main request into the proceedings.

2. Article 123(2) EPC

2.1 The opposition division revoked the patent for the sole reason that claim 14 as granted did not comply with the requirements of Articles 100(c)/123(2) EPC.

2.2 The new main request corresponds to claims 1 to 13 as granted. The fact that the new main request no longer contains the disputed claim 14 means that the appellant has successfully overcome the objection raised in the appealed decision which led to the revocation of the patent (see appealed decision, sections 18 to 20).

2.3 The board remarks that at the oral proceedings both respondents acknowledged that the subject-matter of claims 1 to 13 of the new main request complied with Article 123(2) EPC. The board has no reason to disagree.

3. Remittal

3.1 Ultimately both respondents requested that the case not be remitted to the opposition division for reasons of procedural economy. In particular, they referred to the length of the proceedings before the opposition division.

3.2 Although the board has some sympathy for the respondents' request, it notes that the appealed decision dealt only with the issue of added subject-matter of claim 14 as granted. It did not deal at all with the objections of lack of sufficiency, novelty and inventive step raised against the claims as granted, and thus against claims 1 to 13 as granted and now set out in the new main request.

3.3 In view of the above and the rather unusual course of the proceedings, the board exercising its discretion under Article 111(1) EPC has decided to remit the case to the opposition division for further prosecution.

4. Apportionment of costs

Both respondents requested apportionment of costs, including future costs, according to Art. 16 RPBA. However, the board sees no misconduct in the appellant's way of proceeding, and in particular not in the filing of the new main request, which would justify ordering a different apportionment of costs under the circumstances of this rather unusual case.

On this basis, the board rejects the request of the respondents for apportionment of costs.

Order

For these reasons it is decided that:

1. The decision under appeal be set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of claims 1 to 13 filed as main request with letter dated 3 June 2016.
3. The requests for apportionment of costs are rejected.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated