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Datasheet for the decision of 25 February 2016

Case Number: T 0449/15 - 3.3.01

Application Number: 01998356.8

Publication Number: 1343510

IPC: A61K31/74, A61K9/70, A61F13/00

Language of the proceedings: EN

Title of invention:
LIGHT STABILIZED ANTIMICROBIAL MATERIALS

Patent Proprietor:
ConvaTec Technologies Inc.

Opponent:
Smith & Nephew plc

Headword:
Antimicrobial material/CONVATEC

Relevant legal provisions:
EPC Art. 56, 111(2), 112(1)(a), 125
RPBA Art. 13(1)

Keyword:

Auxiliary requests 4, 5 - res iudicata (yes), identity of wording not required
Auxiliary request 9, 10 - admission (no)
Referral to the Enlarged Board of Appeal (no)

Decisions cited:

T 0449/13, T 0153/93, T 0843/91, T 0079/89, T 0167/93, J 0003/95, T 0365/09, T 0934/91, T 1872/08, T 0572/07, T 0436/95, T 0021/89, T 1063/92

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Case Number: T 0449/15 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 25 February 2016

Appellant: (Patent Proprietor)	ConvaTec Technologies Inc. 6100 Neil Road, Suite 500 Reno NV 89511 (US)
Representative:	Mays, Julie Venner Shipley LLP 200 Aldersgate London, EC1A 4HD (GB)
Respondent: (Opponent)	Smith & Nephew plc Group Patents & Trademarks 15 Adam Street London WC2N 6LA (GB)
Representative:	Drysdale, Douglas Standen HGF Limited Delta House 50 West Nile Street Glasgow G1 2NP (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 16 December 2014 revoking European patent No. 1343510 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	A. Lindner
Members:	L. Seymour
	M. Blasi

Summary of Facts and Submissions

I. European patent No. 1 343 510 is based on application No. 01 998 356.8, which was filed as international patent application published as WO 2002/043743.

II. The present decision relates to the second appeal concerning the patent in suit. The following documents are referred to herein:

(1) WO 01/24839

(38) Chembiotech Report, "Silver in Wound Dressings", filed with letter dated 16 September 2014

(39) Data Graphs from Chembiotech Experiments, filed with letter dated 16 September 2014

(40) Declaration of Professor John Frederick Kennedy, filed with letter dated 16 September 2014

III. The first appeal, T 449/13, was lodged by the patent proprietor and the opponent against the opposition division's decision proposing maintenance in amended form on the basis of a main request filed at oral proceedings before the opposition division. Decision T 449/13 was based on a main request, and auxiliary requests 1 to 8, all filed with letter of 30 April 2013.

The identical claims 1 of the main request and auxiliary request 1, which had been found to be allowable by the opposition division, read as follows:

"1. A method of preparing a light stabilized antimicrobial material including gel forming fibers characterised in that the method comprises the steps of:

(a) preparing a solution comprising an organic solvent and a source of silver in a quantity sufficient to provide a desired silver concentration in said material;

(b) subjecting a polymer to said solution for a time sufficient to incorporate said desired silver concentration into said polymer, wherein said polymer comprises a polysaccharide or modified polysaccharide, a polyvinylpyrrolidone, a polyvinyl alcohol, a polyvinyl ether, a polyurethane, a polyacrylate, a polyacrylamide, collagen, or gelatin or mixtures thereof; and

(c) subjecting said polymer, during or after step (b) to one or more agents selected from the group consisting of ammonium salts, thiosulphates, chlorides and peroxides which facilitate the binding of said silver on said polymer, the agent being present in a concentration between 1% and 25% of the total volume of treatment, which material is substantially photostable upon drying, but which will dissociate to release said silver upon rehydration of said material."

Claim 1 of auxiliary request 2 differed from that of the main request in the deletion of "including gel forming fibers" from the introductory portion of the claim, and in the amendment in step (b) of the feature "subjecting a polymer to said solution" to read "subjecting a material which includes gel-forming fibres containing one or more hydrophilic, amphoteric or anionic polymers to said solution".

Claims 1 of auxiliary request 3 and 4 differed from claims 1 of auxiliary request 2 and the main request, respectively, in the insertion in step (c) of the phrase "step (c) being initiated during the course of step (b) or following it and", at the position immediately before "the agent".

Claims 1 of auxiliary request 5 and 6 differed from claims 1 of the main request and auxiliary request 2, respectively, in the insertion in step (c) of the phrase "for another period of time" in front of "during or after step (b)".

Claims 1 of auxiliary request 7 and 8 differed from claims 1 of the main request and auxiliary request 2, respectively, in the deletion in step (b) of "a polyvinylpyrrolidone, a polyvinyl alcohol, a polyvinyl ether, a polyurethane, a polyacrylate, a polyacrylamide, collagen, or gelatin".

IV. In the earlier decision T 449/13 (reasons, points 3 and 4), the decision under appeal was set aside, since the subject-matter of claim 1 of the main request and auxiliary request 1, as reproduced above in point III, did not to fulfil the provisions of Article 56 EPC: The closest state of the art was identified as being document (1). In the absence of experimental evidence comparing the method of the patent in suit to the method set out in example 25m of document (1), the problem to be solved was defined as lying in the provision of a further method to produce a light stabilised antimicrobial material. The proposed solution, namely, the use of the facilitating agent "in a concentration between 1% and 25% of the total volume of treatment", was considered to be an arbitrary choice that was obvious in the light of the teaching of document (1).

The case was then remitted to the department of first instance for further prosecution. The reasons as set out in points 5 and 6 were as follows (emphasis added):

"5. Remittal

Although the EPC does not guarantee the parties an absolute right to have all the issues in the case considered at two instances, it is well recognised that any party may be given an opportunity for two readings of the important elements of a case.

The opposition division decided on the maintenance of the patent according to the main request as amended in oral proceedings. Consequently, the auxiliary requests already on file were not to be assessed.

Even in the knowledge that these auxiliary requests would necessarily become an issue in the appeal proceedings if the board were to find the request decided upon by the opposition division not to be allowable (see notice of appeal and grounds of appeal filed by the patent proprietor) and after requesting accelerated prosecution, **the appellant (opponent) never commented on either their admissibility or their allowability**.

Concluding that the set of claims of the request dealt with by the opposition division is not allowable, **creates a new situation for the board with respect to auxiliary requests 2 to 8**. Therefore, they **should now be examined on their own merits**.

Thus, the board exercises its discretion under Article 111 EPC and remits the case to the first instance for further prosecution.

6. To conclude: the subject-matter of the main request and auxiliary request 1 lacks inventive step. **Because of the further auxiliary requests which have been filed but**

not yet examined as to their admissibility and allowability, the case is remitted."

V. The present appeal lies from the second decision of the opposition division, in which the patent in suit was revoked.

The opposition division decided not to admit into the proceedings the experimental data and declaration filed as documents (38) to (40) with the patentee's letter of 16 September 2014, owing to their late filing and their lack of relevance in changing the outcome of the proceedings.

Furthermore, the opposition division held that the amendments introduced into a number of the auxiliary requests under consideration gave rise to objections pursuant to Article 123(3) EPC (auxiliary requests 2, 3, 6 and 8), and Rule 80 EPC (auxiliary requests 7 and 8). Following the reasoning set out in decision T 449/13, the opposition division found that the subject-matter of the respective claims 1 of auxiliary requests 4 to 8 lacked an inventive step.

VI. The patentee (appellant) lodged an appeal against this decision. With the statement of grounds of appeal dated 27 April 2015, auxiliary requests 2 to 8 underlying the first appeal proceedings were resubmitted (cf. above point III), together with additional test data.

VII. In a communication sent by the board in preparation for oral proceedings, the arguments of the parties with respect to the non-admittance of documents (38) to (40) in the decision under appeal was discussed, as well as the issue of *res iudicata*.

VIII. Oral proceedings were held before the board on 25 February 2016. At the outset of these proceedings, the appellant withdrew its auxiliary requests 2, 3, 6, 7 and 8 (cf. above point VI).

During the course of proceedings, the appellant further filed two auxiliary requests, labeled as auxiliary requests 9 and 10. Claims 1 of these requests differed from those of auxiliary requests 4 and 5, respectively, in the limitation of the concentration range appearing in step (c) from "between 1% and 25%" to "between 1% and 10%".

The appellant further requested the referral of the following question to the Enlarged Board of Appeal:

"Does the principle of Res Judicata, as it applies in the case of a remittal from the Board of Appeal for further prosecution pursuant to Article 111 EPC, only apply to claims where the wording is identical to claims upon which a final decision has previously been given?"

IX. The appellant's arguments, insofar as they are relevant to the present decision, may be summarised as follows:

It was acknowledged that *res iudicata* was to be considered as representing a generally recognised principle within the meaning of Article 125 EPC. However, it should be construed narrowly, and should not be applied in the present situation in which the wording of claims 1 of auxiliary requests 4 and 5 was not identical to claim 1 as decided upon in T 449/13. The former differed from the latter in the introduction of clarifications of the term "during or after". Even if this was only a small change, this sufficed in order for the principle of *res iudicata* not to apply. Therefore,

the claims should be examined on their own merits, in accordance with the *ratio decidendi* of decision T 449/13. It could be derived from the facts and submissions of this earlier decision that the opponent had resisted remittal. It must therefore be assumed that the board of appeal had reviewed auxiliary requests 2 to 8 before reaching its decision on remittal for further prosecution. Such an order would have been pointless, if *res iudicata* applied. The appellant's case was not based on any implicit or expressed challenge to the reasons or essential findings of T 449/13. The necessity for filing comparative data had only become apparent as a result of this decision, and documents (38) to (40) had duly been filed with letter dated 16 September 2014 on resumption of opposition proceedings following remittal. In view of the potential relevance of the data filed, if admitted, the facts of the case had changed. In accordance with Article 111(2) EPC, the binding effect of the remitting decision would then no longer apply. Decisions T 153/93 and T 843/91 highlighted by the respondent were not relevant in the present context since they related to a different situation, namely, remittal for adaptation of the description.

With respect to auxiliary requests 9 and 10, the appellant argued that the principle of *res iudicata* would not apply, since the amendments introduced with respect to auxiliary requests 4 and 5 represented a significant limitation of relevance to the issue of inventive step. The new requests should be admitted into the proceedings, since they had been filed as a direct response to the earlier discussions during oral proceedings before the board. It could not have been derived from earlier decision T 449/13 or from the present board's written preliminary opinion that *res iudicata* would be an issue. There was also no hint in

the case law that *res iudicata* would apply in relation to claims which did not literally correspond to the claims upon which a decision had already been taken. The amendment introduced was foreshadowed by the examples of the patent in suit and did not change the framework of discussions or the complexity of the case. They could not therefore have taken the respondent by surprise, and could be dealt with without delay.

Finally, the appellant argued that a referral of a question to the Enlarged Board of Appeal would be appropriate in order to ensure a uniform application of the law. As explained previously, the present board's view on *res iudicata* was in contradiction with the earlier decision on remittal in T 449/13. Moreover, a point of law of fundamental importance was touched upon.

X. The respondent's arguments, insofar as they are relevant to the present decision, can be summarised as follows:

Auxiliary requests 4 and 5 had first been filed with letter of 11 October 2012 (as auxiliary requests 3 and 4), that is, at a very early stage in the proceedings, prior to the first decision of the opposition division. Claims 1 of these requests merely contained cosmetic clarifications of the term "during or after", in reply to a construction thereof initially adopted by the opposition division, but subsequently abandoned. Thereafter, there had been no dispute concerning the meaning of "during or after", as designating the initiation of step (b) prior to commencement of step (c). Thus, claims 1 of auxiliary requests 4 and 5 represented historical artefacts, which did not differ in substance from the subject-matter constituting the basis of decision T 449/13. The appellant also had not put forward any differences. In

accordance with the principle of *res iudicata*, this subject-matter was immutably settled as lacking an inventive step. In decision T 449/13, the board had ordered remittal for further prosecution without having considered the substance of auxiliary requests 2 to 8. The board was thus instructing the opposition division to examine whether these requests altered the situation such that a different decision should be reached; the intention had certainly not been to give the patentee a second bite at the cherry. It was the claimed subject-matter that was decisive in the context of *res iudicata*, rather than an identity of wording. As confirmed by decision T 79/89, after remittal for further prosecution, the allowability of the subject-matter rejected by the board could not be re-opened. An admission of the subsequently filed data could also not change the fact that *res iudicata* applied. The issue that the data sought to address had already been discussed prior to decision T 449/13 being taken. As set out in decisions T 153/93, citing T 843/91, the remittal proceedings should not be seen as a belated opportunity to attack the binding part of the decision by introducing new facts, evidence or arguments.

Regarding auxiliary requests 9 and 10, the respondent argued that the upper limit of the concentration range appearing in step (c) had never been an issue in the discussions on inventive step. The limitation of this value to 10% would not change the findings of the earlier decision T 449/13. This attempt to reopen the first appeal proceedings would be contrary to the principle of *res iudicata*. Moreover, these requests should not be admitted into the proceedings. The breath of the claims had been an issue throughout the opposition and appeal proceedings, and the question of *res iudicata* had also been raised by the respondent

during the resumed opposition proceedings and with its response to the statement of grounds of appeal. If considered necessary, said requests should therefore have been submitted at a much earlier stage of the proceedings. The introduction of a feature from the description at an incredibly late stage of the proceedings had taken the respondent by surprise.

Finally, the appellant contested that there was any contradiction with the earlier decision T 449/13, nor had the appellant identified any divergent case law on the subject of *res iudicata*. There was therefore no reason to put a question to the Enlarged Board of Appeal. Moreover, as held in decision T 79/89, once a decision was rendered, no referral could be made. Hence, since the board had already announced during the oral proceedings that *res iudicata* did not apply, a referral was no longer possible.

XI. The appellant requested that the decision under appeal be set aside and that the patent be maintained based on the claims of auxiliary requests 4 or 5 submitted with statement of grounds of appeal dated 27 April 2015, or alternatively, on the basis of auxiliary requests 9 or 10 as submitted during the oral proceedings on 25 February 2016. Furthermore, it was requested that the question as submitted during the oral proceedings be referred to the Enlarged Board of Appeal.

The respondent requested that the appeal be dismissed.

XII. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. *Auxiliary requests 4 and 5 - res iudicata*

2.1 By earlier decision T 449/13 of the previous board, the first appeal proceedings against a (first) decision of the opposition division were terminated. Therefore, the present board, dealing with the second appeal against a (second) decision of the opposition division taken following the remittal, had to assess whether and to what extent it was barred from dealing with an issue because it had already been finally decided upon and thus was *res iudicata*.

2.2 *Res iudicata* is a generally recognised principle in the contracting states and acknowledged by the boards of appeal (see e.g. T 167/93, OJ EPO 1997, 229; J 3/95, OJ EPO 1997, 493; T 365/09, Reasons 2). According to the established case law of the boards of appeal, *res iudicata* means "a matter finally settled by a Court of competent jurisdiction, rendering that matter conclusive as to the rights of the parties and their privies ... Such a final judgement ... therefore constitutes an absolute bar to a subsequent legal action involving the same claim, demand or cause of action, and the same parties or their privies" (see T 934/91, OJ EPO 1994, 184, Reasons 3).

2.3 The order of a board's decision provides a first point of reference for establishing the extent to which *res iudicata* applies. However, where a case is remitted for further prosecution on the basis of claims of auxiliary requests following rejection of higher ranking claim requests, the order is usually confined to the setting

aside of the decision under appeal and the remittal for further prosecution. Thus, the order has to be seen in context with the reasons for the decision as a whole in order to determine the extent to which the decision was final (see also T 843/91, OJ EPO 1994, 832, Reasons 3.4.1).

In the earlier decision T 449/13 (cf. above point IV), the competent board decided *inter alia* that the subject-matter of claim 1 of the main request (and of identical claim 1 of auxiliary request 1) did not fulfil the provisions of Article 56 EPC. Thus, the finding that the subject-matter of these claims is not patentable due to a lack of inventive step constitutes a matter finally settled between the parties and is therefore *res iudicata*.

2.4 Whether the present board is prevented from considering subject-matter claimed in these appeal proceedings in view of *res iudicata* depends on the question whether "the same claim, demand or cause of action" (see above) is at stake. Hence, it is necessary to compare the subject-matter of claim 1 of the main request decided upon in T 449/13 and of auxiliary requests 4 and 5 pending before the board for consideration in these second appeal proceedings.

Claims 1 of auxiliary requests 4 and 5 merely differ from claim 1 of the main request in the introduction of clarifications of the term "during or after step (b)" in step (c) of the claimed method: In auxiliary request 4, the phrase "step (c) being initiated during the course of step (b) or following it" was inserted, and in auxiliary request 5 "for another period of time" (cf. above point III). In each case, the additions further explained the meaning of "during or after

step (b)", namely, as designating a particular sequence of steps whereby step (b) is initiated prior to commencement of step (c). The fact that the added text merely served as a further clarification of what was meant by "during or after step (b)" was not disputed by the appellant. The appellant also did not dispute that the particular sequence of steps, namely, step (b) being initiated prior to commencement of step (c), was the construction of the term "during or after step (b)" accepted throughout the first appeal proceedings, and underlying the analysis of inventive step in decision T 449/13. Thus, the amendments to claims 1 of auxiliary requests 4 and 5 amount to an inclusion of redundant linguistic additions and merely represent cosmetic changes without any effect to the scope of the claims. Therefore, it is concluded that the amendments undertaken do not alter the subject-matter claimed in substance compared to the subject-matter finally decided upon in T 449/13, or the facts on which said decision was based. Consequently, the finding that the claimed subject-matter lacks an inventive step is *res iudicata* also for the subject-matter of auxiliary requests 4 and 5. Therefore, the board is prevented from deciding on this issue a second time.

In this context, the board notes that there have also been other decisions in the jurisprudence of the boards of appeal in which the competent boards considered themselves as being prevented from deciding on an issue due to the principle of *res iudicata,* even though the claims under consideration were not literally identical to the claims decided upon in the earlier decision (see e.g. T 1872/08, Reasons 4; T 572/07, Reasons 1.1; T 436/95, Reasons 2.1)

2.5 The appellant argued that the conclusion on *res iudicata* as outlined above in point 2.4 was in contradiction with the earlier decision T 449/13: it was to be assumed that the previous board had reviewed auxiliary requests 2 to 8 before reaching its decision on remittal for further prosecution, because such an order would have been pointless were *res iudicata* to apply in relation to these auxiliary requests.

However, the present board cannot infer from the earlier decision that any sort of consideration as to the substance of auxiliary requests 2 to 8 had been made. In the section of T 449/13 relating to remittal as reproduced above in point IV (see, in particular, passages in bold), the previous board berates the appellant-opponent for not having commented on either the admissibility or allowability of auxiliary requests 2 to 8 filed by the proprietor together with the statement of grounds of appeal, despite being aware that these requests might become an issue in the appeal proceedings, and despite having requested accelerated prosecution; as a result, the conclusion on the higher-ranking requests created "a new situation for the board with respect to auxiliary requests 2 to 8". From this reasoning, it is manifest that the previous board, contrary to the submissions of the appellant, did not undertake any substantive review of auxiliary requests 2 to 8 prior to remittal. Indeed, no trace whatsoever can be found in T 449/13 of any discussion concerning the nature or significance of the various amendments introduced into these requests. Therefore, it must be concluded that auxiliary requests 2 to 8 were remitted en bloc, without review. Under these circumstances, the present board cannot establish that its finding that the issue of inventive step of the subject-matter of claims 1 of auxiliary requests 4 and 5 was *res iudicata*

would be in contradiction with the decision T 449/13.

Moreover, the order for remittal for further prosecution in T 449/13 does not preclude a conclusion of *res iudicata* for remitted subject-matter. Pursuant to Article 111(2) EPC 1973 (applicable to the present case in view of Article 7 of the Act revising the EPC of 29 November 2000 and the relevant Decision of the Administrative Council of 28 June 2001 on the transitional provisions, OJ EPO 2003, Special Edition No. 1, 201), if a board remits the case for further prosecution to the department whose decision was appealed, that department shall be bound, in so far as the facts are the same, by the board's *ratio decidendi*. The "ratio" of a decision is the ground or the reason for making it, in other words, the point in a case which determines the outcome of the judgement (cf. T 934/91, *supra*, Reasons 2). The same binding effect applies to the board in the case of a subsequent appeal against a further decision of the department of first instance following remittal (self-binding effect, cf. T 21/89, Reasons 3.1). The principle of *res iudicata* and that of the binding effect of the *ratio decidendi* pursuant to Article 111(2) EPC 1973 are not mutually exclusive, but complement one another. On the one hand, the binding effect of the *ratio decidendi* extends to matter which has not become *res iudicata*, but it only applies "in so far as the facts are the same". On the other hand, matter which has become *res iudicata* is not open for reconsideration following a remittal for further prosecution. In view of the fact that such matter is finally settled, the binding effect is not limited to the *ratio decidendi*, but also precludes a change of the "facts" within the meaning of Article 111(2) EPC 1973, e.g. by introduction of new documents (see also T 1063/92, Reasons 2.5; T 153/93,

Reasons 3). Accordingly, if a board of appeal has issued a decision rejecting certain claimed subject-matter as not being allowable and has remitted the case for further prosecution in accordance with an auxiliary request, examination of the allowability of the rejected claimed subject-matter cannot thereafter be re-opened (cf. T 79/89, OJ EPO 1992, 283, Headnote I).

2.6 The appellant further argued that the principle of *res iudicata* should be construed narrowly and should not apply in cases such as the present in which the wording of claims were not identical. However, as explained in decision T 153/93 (*supra*, Reasons 2), with reference to decision T 843/91, "... remittal proceedings should not afford opponents a much belated opportunity to attack the remitting decision by introducing new facts, as it was in the general interest of the public that legal disputes be terminated ..., and that individuals (and firms) had the right to be protected from the vexatious multiplication of suits."

Although these decisions relate to a different situation than the present, namely, remittal for adaptation of the description, they nevertheless re-emphasise generally applicable principles with respect to the purpose of *res iudicata*. The principle is based on the need for an end to all litigation. It provides legal certainty, while taking account of the general public concern for the settlement of disputes (*expedit rei publicae ut sit finis litium*). Hence, it must be avoided that the same case is decided twice, possibly with a different outcome. This very purpose would be negated were it to be possible to circumvent a final judgement by means of mere linguistic modifications that had no material effect on the subject-matter claimed. Therefore, the board cannot agree with the appellant's argument that

res iudicata should be confined to situations where there is identity of wording in the claims, nor could the appellant point to any case law which stated this to be a prerequisite.

2.7 In view of the above considerations, it is concluded that the finding of lack of inventive step as set out in decision T 449/13 is *res iudicata* for the subject-matter of claims 1 of auxiliary requests 4 and 5. Since the board is barred from taking a decision on this subject-matter, it cannot be pursued in the present appeal proceedings.

3. *Auxiliary requests 9 and 10 - res iudicata, admission into the appeal proceedings*

3.1 Claims 1 of auxiliary requests 9 and 10 differ from those of auxiliary requests 4 and 5, respectively, in the amendment of the upper limit of the concentration range appearing in step (c) from 25% to 10% (cf. above point VIII). This amendment can no longer be said to be of a purely cosmetic nature compared to claim 1 of the main request (and auxiliary request 1) decided upon in case T 449/13. In view of the change of the claimed range, the scope of the claim is clearly different and it cannot be excluded *a priori* that the limitation undertaken would have a bearing on the analysis of inventive step. Hence, the board came to the conclusion that decision T 449/13 did not constitute *res iudicata* for said requests, and the board was therefore not barred from considering them.

3.2 Auxiliary requests 9 and 10 were submitted by the appellant during oral proceedings before the board (cf. above point VIII), following the conclusion of

discussions as to whether the principle of *res iudicata* applied with respect to auxiliary requests 4 and 5.

Article 13(1) RPBA provides that any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion, which 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. These last two criteria imply a requirement on a party to present appropriate requests as soon as possible if such requests are to be admitted and considered.

The board is not convinced by the justification provided by the appellant for waiting until oral proceedings to file auxiliary requests 9 and 10.

The issue of *res iudicata* was repeatedly raised by the respondent, during the resumed opposition proceedings (see letter of 26 September 2014, section bridging pages 3 and 4) and during the present appeal proceedings (see reply to the appellant's statement of grounds of 19 June 2015, point 2; letters of 30 June 2015, page 2; 25 January 2016, point 1). This question was also discussed in the communication sent by the board in preparation for oral proceedings (cf. above point VII, and, in particular, point 9 of said communication).

Moreover, contrary to the appellant's submission, the case law cannot be seen as supporting an expectation that *res iudicata* would only apply in relation to claims whose wording was literally identical to the claims decided upon in an earlier board's decision (see above). In any case, the board does not consider this aspect as being relevant for its decision on the admission of

auxiliary requests 9 and 10. Even had case law been available that endorsed the appellant's point of view, this would not be binding on the board, and the appellant should have taken into consideration that the board might agree with the respondent's position, which was set out in detail during the written proceedings (see previous paragraph).

Finally, it is noted that, at the time of filing of auxiliary requests 9 and 10, the issue of the breadth of the claims had not been addressed at oral proceedings.

Therefore, the amendment introduced cannot be recognised as constituting an immediate reaction to an issue raised for the first time at oral proceedings. If it had considered this to be necessary, the appellant should not have waited until the oral proceedings to file these additional requests. Contrary to the submissions of the appellant, the incorporation of a feature from the description at such an advanced stage of the procedure was not foreseeable either for the respondent or the board, and would have put the respondent at an unfair disadvantage in exercising its right to defend its case.

Consequently, the board decided to exercise its discretion under Article 13(1) RPBA not to admit auxiliary requests 9 and 10 into the appeal proceedings.

4. *Request for referral to the Enlarged Board of Appeal*

4.1 In view of the conclusion reached by the board in above point 2, the appellant requested that the question reproduced above in point VIII be referred to the Enlarged Board of Appeal.

According to Article 112(1)(a) EPC 1973, a board shall, either of its own motion or upon request from a party, refer any question of law to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure uniform application of the law, or if an important point of law arises.

4.2 The respondent argued that, at the point in time when the referral to the Enlarged Board was requested, the board had already taken a decision concerning auxiliary requests 4 and 5, that is, it had decided the issues in connection with which the questions of law arose. Hence, following decision T 79/89 (*supra*, Headnote II), a referral was no longer possible.

The board notes in this context that, since a decision given by a board orally becomes effective, binding and final by virtue of being pronounced, boards are generally very careful about what they announce in the course of oral proceedings and whether they render an interlocutory decision on a particular point which would prevent them from reconsideration of this point at a later stage, should the need arise.

In the present case, the chairman announced during the oral proceedings that "the board was of the opinion that claims 1 of auxiliary requests 4 and 5 were *res iudicata* and not open to consideration in view of T 449/13". Consequently, no decision on this issue had been taken prior to the appellant's submission of the request for a referral to the Enlarged Board, and the board was therefore not prevented from considering this request.

4.3 The question formulated by the appellant is based on the premise that a contradiction existed between the present board's conclusion on *res iudicata* and the earlier

decision on remittal in T 449/13, so that a referral was required in order to ensure uniform application of the law. However, as explained above in point 2.5, the board does not consider that this was indeed the case. Moreover, the appellant could not identify any further divergent case law. Indeed, as set out above (see point 2.4, last paragraph), there have also been other decisions referring to the principle of *res iudicata* where the claim under consideration was not literally identical to the claim decided upon in an earlier board decision.

4.4 As to the second alternative for a referral, namely, that of an important point of law arising, the appellant has not brought forward any arguments why it considered this to be the case. An "important point of law" within the meaning of Article 112(1)(a) EPC 1973 arises if that point is of fundamental importance in that it is relevant to a substantial number of similar cases and is therefore of great interest not only to the parties in the present appeal but also to the public at large (see e.g. T 271/85, OJ EPO 1988, 341; G 1/12, OJ EPO 2014, A114, Reasons 11). It appears to the board that the situation for which the proposed question is intended to provide an answer, namely, that subject-matter pursued after remittal and in the course of subsequent (second) appeal proceedings only differs from that decided upon in the first appeal in redundant linguistic additions, does not arise in a substantial number of cases. Therefore, it appears doubtful that an important point of law is at stake.

Moreover, even if one considered this to be an important point of law, the board has a discretion whether or not to make a referral. Given that the principle of *res iudicata* is well established in the jurisprudence of the

boards of appeal and has a clear meaning and purpose, the board could itself resolve the issues for deciding the present case on the basis of the existing jurisprudence.

4.5 Consequently, the board did not see any need to refer the question submitted by the appellant to the Enlarged Board of Appeal.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is refused.

2. The appeal is dismissed.

The Registrar: The Chairman:

M. Schalow A. Lindner

Decision electronically authenticated