Internal distribution code:

(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [X] To Chairmen
(D) [-] No distribution

Datasheet for the decision of 5 March 2020

Case Number: T 0989/15 - 3.2.05

Application Number: 08836787.5

Publication Number: 2121339

IPC: B41F31/02, B41F31/26, B41N7/06, B23K26/08

Language of the proceedings: EN

Title of invention:
A method for printing a substrate using an anilox roll, an anilox roll for a printing method and a printing apparatus

Patent Proprietor:
Apex Europe B.V.

Opponents:
Kurt Zecher GmbH
Applied Laser Engineering Ltd

Relevant legal provisions:
RPBA Art. 13(1), 13(3)
RPBA 2020 Art. 13(1), 13(2), 15(1), 16, 25
EPC Art. 104(1), 123(2)
EPC R. 103(1)(a)

Keyword:
Late-filed requests filed after arrangement of oral proceedings - admitted (main request, first to third auxiliary requests: no; fourth auxiliary request: yes)
Amendments - allowable (no)
Reimbursement of appeal fee - (no)
Apportionment of costs - (no)

Decisions cited:
J 0037/89, T 0032/16, T 0634/16

Catchword:

At the third level of the convergent approach applicable in appeal proceedings in accordance with the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020), the boards of appeal are free to use or not use the criteria set out in Article 13(1) RPBA 2020 when deciding, in the exercise of their discretion in accordance with Article 13(2) RPBA 2020, whether to admit an amendment made at this stage of the proceedings. This also holds true when Article 13 RPBA 2007, rather than Article 13(2) RPBA 2020, is to be applied. (See section 16 of the Reasons)

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0989/15 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 5 March 2020

Appellant: (Patent Proprietor)	Apex Europe B.V. Metaalweg 8-10 5527 AK Hapert (NL)
Representative:	Nederlandsch Octrooibureau P.O. Box 29720 2502 LS The Hague (NL)
Respondent I: (Opponent 1)	Kurt Zecher GmbH Görlitzer Strasse 2 33098 Paderborn (DE)
Representative:	Ostermann, Thomas Fiedler, Ostermann & Schneider Patentanwälte Klausheider Strasse 31 33106 Paderborn (DE)
Respondent II: (Opponent 2)	Applied Laser Engineering Ltd Unit 7, Ember Centre Lyon Road Hersham Surrey KT12 3PU (GB)
Representative:	Robson, Aidan John Reddie & Grose LLP The White Chapel Building 10 Whitechapel High Street London E1 8QS (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 2 April 2015 revoking European patent No. 2121339 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	M. Poock
Members:	T. Vermeulen
	T. Karamanli

Summary of Facts and Submissions

I. The patent proprietor lodged an appeal against the decision of the opposition division to revoke European patent No. 2 121 339 (hereinafter "the patent").

The decision was also appealed by opponent 2, which withdrew its appeal during the oral proceedings held before the board.

II. In the decision under appeal, the opposition division found that the amendments to claim 3 according to the main request failed to have a basis in the application as originally filed, that claim 3 according to auxiliary request 1 did not clearly define the subject-matter for which protection is sought, and that the subject-matter of claim 1 according to each of auxiliary requests 2 and 3 was not novel in view of document E1. Furthermore, the opposition division decided not to admit auxiliary request 4, which had been announced at the oral proceedings by the patent proprietor and was based on a combination of claims 1 and 7 of auxiliary request 2, into the opposition proceedings.

III. With the statement of grounds of appeal filed on 11 August 2015, the appellant (patent proprietor) submitted amended claims according to a main request and first to third auxiliary requests. The appellant requested that the decision under appeal be set aside and that the case be immediately remitted to the opposition division (main request) and, as an auxiliary measure (i.e. if the case is not immediately remitted to the opposition division), that the patent be maintained as amended on the basis of the claims

according to the main request or one of the first to third auxiliary requests.

In addition, the appellant requested reimbursement of the appeal fee and that a different apportionment of costs be ordered with respect to "all costs relating to the entire appeal proceedings".

IV. The board issued a summons to oral proceedings dated 9 April 2019. In a communication of 3 January 2020 pursuant to Article 15(1) of the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020, see OJ EPO 2019, A63), the board gave its provisional opinion.

V. With a letter dated 17 January 2020, the appellant submitted amended claims according to fourth to eighth auxiliary requests.

VI. By letter dated 7 February 2020, respondent I (opponent 1) informed the board that it would not be attending the oral proceedings.

VII. Oral proceedings were held on 5 March 2020 in the absence of the duly summoned respondent I. The appellant withdrew its main request for immediate remittal and, in addition, the main request and the first to third auxiliary requests filed with the grounds of appeal.

VIII. The appellant requested that the decision under appeal be set aside and that the patent be maintained as amended on the basis of the claims according to the main request filed by letter dated 17 January 2020 as fourth auxiliary request or, as an auxiliary measure, according to one of the first to fourth auxiliary

requests filed by letter dated 17 January 2020 as fifth to eighth auxiliary requests, respectively. In addition, it requested reimbursement of the appeal fee and the apportionment of costs.

Respondent I requested that the appeal be dismissed.

Respondent II (opponent 2) requested that the appeal be dismissed.

IX. Claim 1 of the fourth auxiliary request filed with the letter dated 17 January 2020 as the eighth auxiliary request, reads (the feature references used by the board are introduced in square brackets):

"[**A**] Anilox roll (5) for a printing apparatus for transferring a fluid, such as an ink, [**B**] comprising a cylinder having a surface (100), [**C**] wherein the surface comprises a fluid distribution structure for receiving the fluid, distributing the fluid over the cylinder, and transferring the fluid, [**D**] wherein the fluid distribution structure is arranged to transfer in a first operational mode for printing heavy layers of ink a relatively large fluid droplet and in a second operational mode for printing details a relatively small fluid droplet by a combination of restrictions in the fluid distribution structure,
characterised in, that
[**E**] the fluid distribution structure has a channel (24) formed in the surface for distributing the fluid over the fluid distribution structure, [**F'**]the channel extending generally in a circumferential direction of the anilox roll on its complete outer surface [**G"**]and having a course and opposite channel walls positioned next to each other in a parallel oscillating fashion without any phase difference such that the course of

said channel (24) is meandering over the surface and base lines of the channel and the channel walls being angled (β) relative to the circumferential direction of the anilox roll, [**H1**] and both the course of the channel and the channel walls have the form of a sine wave, [**H2**] and the channel has a generally flat bottom having a generally equal channel depth wherein the bottom has a substantially constant height level difference with respect to the surface of the anilox roll [**I**] and the channel has a channel width between 10 and 150 µm, preferably between 20 and 100 µm, and even more preferably between 30 and 80 µm, [**J**] the walls (26, 27) have a size of 1-4 µm [**K**] and being positioned next to each other have a distance (d) equal to two times an amplitude (a) of the sine wave."

X. The arguments of the appellant where relevant to the present decision may be summarised as follows:

Admittance of the appellant's claim requests filed by letter dated 17 January 2020

The requests were filed immediately after receipt of the board's communication setting out for the first time its preliminary view on some issues. Even if the preliminary opinion of the board did not raise any issues beyond those already put forward by the other parties, the amended claims filed with the requests were an immediate reaction to the objections raised in this opinion. As the opposition division did not agree with the objections under Article 123(2) EPC raised by the opponents in the first-instance proceedings, there was no reason for the appellant to anticipate such objections and already file corresponding amendments with the grounds of appeal. It would not be fair on the

appellant to expect an auxiliary request in reaction to each and every objection raised by the respondents.

Claim 2 of the main request and each of the first, second and third auxiliary requests was amended in response to the objection raised in point 11.3 of the preliminary opinion of the board. By removing the amplitude limitation from the previous claim 2, the objection was resolved. The new additional feature of claim 2 related to the same feature already on file, namely the relationship between the amplitude of the sine wave and the channel width. A basis for the amendment could be found on page 24, lines 28 to 31, of the description as originally filed.

A decision not to admit the main request and the first to third auxiliary requests should not impact the admission of the fourth auxiliary request, since it did not comprise claim 2 under dispute. The amendments to claim 1 of the fourth auxiliary request addressed the objection made in respect of feature I.

Fourth auxiliary request

The objection made by respondent II alleging added subject-matter in view of the addition of feature K was unfounded. In adding the specific wall size, amplitude and wall distance to claim 1, the amendments to claim 1 addressed the Article 123(2) EPC objections raised by the board. Page 24, lines 30 to 31, on the one hand, and page 28, lines 6 to 7, on the other hand, presented two options for the embodiment of Figure 3b. Although the different options possibly led to a slight confusion, it could not be ignored that the wording of feature K was disclosed in the application as filed in conjunction with the embodiment of Figure 3b, where the

distance d clearly referred to the width of the channel. A further option for the relationship between the amplitude and the channel width was given in the embodiment of Figure 3e. The amendments did not amount to an intermediate generalisation, since claim 11 as originally filed already disclosed the amplitude separately from the other parameters. Therefore, the amendments did not constitute an extension of subject-matter.

Reimbursement of the appeal fee

Reimbursement of the appeal fee was requested by reason of several substantial procedural violations which allegedly occurred during the first-instance proceedings.

Apportionment of costs

Apportionment of costs was requested for all costs relating to the entire appeal proceedings because, at the oral proceedings, the opposition division had rejected a further auxiliary request as a fall-back position to a claim including the additional feature of original claim 2. The lack of novelty of such claim had, however, not been argued prior to the date of oral proceedings.

XI. The arguments of respondent II where relevant to the present decision may be summarised as follows:

Admittance of the appellant's claim requests filed by letter dated 17 January 2020

The requests were filed just short of four years after the respondents' replies to the grounds of appeal.

Despite the objections raised in these replies, for example as regards feature I, the appellant chose not to respond until the board had issued its preliminary opinion. If an appellant were to be allowed to wait until after the communication of the board to react, there would be no point in filing requests beforehand. The communication of the board was not a justifiable trigger to file new requests. In the present case, the communication of the board essentially dealt with the objections raised by the respondents, which were already on file almost four years before. Particular reference was made to the letter of respondent II dated 15 December 2015, which only mentioned one objection of added subject-matter, and to the letter of respondent I dated 21 January 2016. The very nature of appeal proceedings required the patent proprietor to address issues raised by the opponents in the first-instance proceedings, even if the opposition division took a different view on these issues in the impugned decision.

The auxiliary requests included a new claim 2 with an added feature not previously discussed in the proceedings. Whereas the amplitude of the sine wave was larger than the width of the channel in claim 5 as granted, the amendment now required a distance of the walls to equal two times the amplitude. Assuming the distance referred to the width of the channel, the amendment led to a significant change in the size of the channel, largely affecting the flow through it. Clearly, not all the objections were addressed or overcome in these requests, contrary to what could be expected of such late-filed requests in order to be found admissible.

Fourth auxiliary request

The amendments in claim 1 of the fourth auxiliary request did not comply with Article 123(2) EPC. Feature J was based on page 28 of the description as originally filed, where it was disclosed with the requirement that the amplitude was larger than the width between two walls. The combination of the features described on page 24 in respect of Figures 3b and 4 and those described on page 28 was very confusing. There was no unambiguous basis for combining them. It was irrelevant for assessing the basis of the amendments whether the amplitude-distance relationship was claimed separately. What counts was that features J and K were not originally disclosed in combination.

Reimbursement of the appeal fee

Reimbursement of the appeal fee should be refused. None of the alleged deficiencies in the proceedings before the department of first instance constituted a substantial procedural violation.

Apportionment of costs

The request for apportionment of costs should be refused. In the absence of an express decision on the apportionment of costs, each party bore its own costs. The appellant did not apply for apportionment of costs during the proceedings before the opposition division. Thus, the appellant had to bear its own costs. In addition, the requested apportionment would not be equitable, because the opposition division was entitled to reject the auxiliary request. It was not clear from whom the apportionment was sought. The appellant's

grievance appeared to be with the opposition division rather than with the opponents.

Reasons for the Decision

Procedural status of parties

1. Under Article 107, second sentence, EPC, the parties to proceedings before the department of first instance are also parties to the ensuing appeal proceedings, even if they have not filed an appeal. Therefore, where more than one party to opposition proceedings lodges an appeal and one of them subsequently withdraws its appeal, it becomes a party as of right under Article 107 EPC, provided the other appeal(s) is(are) admissible.

2. Accordingly, after withdrawing its appeal during the oral proceedings before the board, opponent 2 became a party as of right under Article 107 EPC to the present appeal proceedings, i.e. respondent II.

Admittance of the appellant's main request and first to fourth auxiliary requests

3. The main request and the first to fourth auxiliary requests were filed with the letter dated 17 January 2020 as the fourth to eighth auxiliary requests. Thus, these requests were filed after the parties had been summoned to oral proceedings.

In the present case, the summons to oral proceedings was notified before the date on which the RPBA 2020 entered into force, i.e. 1 January 2020. Thus, in accordance with Article 25(3) RPBA 2020, Article 13(2) RPBA 2020 does not apply to the question whether to

admit the appellant's requests filed on 17 January 2020 into the appeal proceedings. Instead, Article 13 of the Rules of Procedure of the Boards of Appeal in the version of 2007 (RPBA 2007, see OJ EPO 2007, 536 and EPC, 16th edition, June 2016, pages 601 to 629) continues to apply.

4. Pursuant to Article 13(1) RPBA 2007, 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. This discretion 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. Article 13(3) RPBA 2007 adds that amendments sought to be made after the oral proceedings have been arranged will not be admitted "if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings".

5. Article 13(1) RPBA 2007 merely lists examples of factors to be considered by the board when exercising its discretion and not an exhaustive set of criteria which must be cumulatively met, such that other considerations and well-established criteria relevant to the admissibility issue can also be taken into account (see Case Law of the Boards of Appeal of the European Patent Office ("Case Law"), 9th edition 2019, V.A.4.1.2). Nor do these criteria have to be met cumulatively. According to the case law of the boards of appeal developed in the context of Article 13(1) and (3) RPBA 2007, for amendments within the meaning of Article 13 RPBA 2007, such as facts and evidence submitted late, further criteria may also be applied, for example the relevance of the late-filed submission, the reasons for the late filing, whether the late

filing has to be regarded as an abuse of procedure, and whether it is a legitimate reaction to the decision at first instance (see e.g. Case Law, 9th edition 2019, V.A.4.13). According to established case law, discretion has to be exercised equitably, i.e. all relevant factors which arise in the particular circumstances of the case have to be considered, and, in exercising this discretion, the circumstances of the specific case have to be taken into account (see Case Law, 9th edition 2019, V.A.4.3).

Essentially, it is a matter for each party to submit all facts, evidence, arguments and requests relevant for the enforcement or defence of its rights as early and completely as possible, in particular in *inter partes* proceedings, in order to act fairly towards the other party and, more generally, to ensure due and swift conduct of the proceedings (see Case Law, 9th edition 2019, V.A.4.1.2 and V.A.4.2.1). According to the established case law of the boards of appeal, amending a party's case at a late stage in the proceedings can be justifiable if it is an appropriate and immediate reaction to unforeseeable developments in the previous proceedings which do not lie in the responsibility of the party submitting the amendment (see Case Law, 9th edition 2019, V.A.4.4.2).

6. The present requests were submitted by the appellant "to address all objections put forward by the BoA and those of the opponents" (page 1 of the letter dated 17 January 2020).

Yet, the appellant affirmed at the oral proceedings that the preliminary opinion of the board did not include any issues not already raised by the respondents in their replies of 15 December 2015 and

21 January 2016 to the statement setting out the grounds of appeal. The relevant objections of added subject-matter, lack of clarity and lack of novelty were therefore known to the appellant at the latest at the beginning of 2016, i.e. just short of four years before the preliminary opinion of the board was issued. As a consequence, there can be no doubt that the appellant could have replied to the objections earlier, in particular in direct reply to the respondents' letters of reply mentioned above.

In fact, through the statement in its letter dated 3 December 2015 requesting "to provide the proprietor with an opportunity to reply to [a reply of the opponent directed to the proprietor's arguments and claim sets]", the appellant had expressed its intention to react to objections at an early stage of the appeal proceedings.

In contrast, the appellant opted to wait until it had received the board's preliminary opinion given in the communication of 3 January 2020. Only after that the appellant filed a rejoinder.

7. In this context the board wishes to remark that a communication under Article 15(1) RPBA 2020 is intended to set out the preliminary opinion of the board as guidance for the oral proceedings. Where the board's communication contains a preliminary opinion based solely on the issues raised by the parties and their arguments, that communication cannot be taken as a justifiable trigger for submitting new requests that the parties could have filed earlier (see also Case Law, 9th edition 2019, V.A.4.7).

8. The board concurs with respondent II that a party to appeal proceedings must always be prepared for the board to reverse a conclusion reached by the department of first instance in the proceedings leading to the impugned decision. The fact that the opposition division in point 5.1.4 of its decision gave a positive opinion, that the amendment of feature I met the requirements of Article 123(2) EPC, was in itself not a sufficient reason for the appellant to not file an appropriate fall-back position with its initial appeal submissions.

9. Also, the argument that the appellant could not have been expected to file an auxiliary request in reaction to each and every objection raised by the other parties does not persuade the board. In the present case, respondents I and II each brought forward one objection of added subject-matter to claim 1 of the then main request in their letters of reply dated 15 December 2015 and 21 January 2016. Given the circumstances of the case, it would not have posed an undue burden on the appellant as the losing party to file an auxiliary request addressing at least these two issues in an attempt to provide a fall-back position in case the board were to concur with the respondents.

10. By filing the claim requests at such a late stage of the appeal proceedings, the requirements of due process and the need for procedural economy were therefore not satisfied.

11. With the main request and each of the first to third auxiliary requests, the appellant filed an amended dependent claim 2 with the added feature:

"walls (26, 27) of the meandering channel (24) that are positioned next to each other have a distance (d) equal to two times an amplitude (a) of the sine wave".

The appellant argued that this amendment was a reaction to the view of the board expressed in point 11.3 of its preliminary opinion, in particular that "the amplitude configuration in pending claim 2 of the main request ... depends on the anti-symmetric feature, according to the claiming sequence in granted claims 4 and 5" (letter dated 17 January 2020, point 1.2.3.1). The amendment was alleged to have a basis on page 24, lines 28 to 31, of the description as originally filed.

12. Instead of addressing the objection of added subject-matter in respect of claim 2, which was raised by respondent I and referred to by the board in its preliminary opinion, the appellant chose to incorporate entirely new subject-matter taken from the description into the claim.

Admitting these requests would have meant having to analyse dependent claim 2 anew with respect to the requirements of the EPC, in particular Articles 84 and 123(2) EPC. Such an analysis would have been complex, requiring a substantial amount of time at this late stage of the appeal proceedings, contrary to the need for procedural economy.

The board is of the view that, at such a late stage, it is not reasonable for the other parties to be expected to deal with subject-matter never before presented in the proceedings, although it could easily have been done so at an earlier stage of the appeal proceedings,

and that does not appear to be a clear reaction to the objections on file.

13. In this respect, the fourth auxiliary request differs from the higher-ranking requests because claim 2 under dispute is now deleted.

The fourth auxiliary request also seems to address the objection raised by respondent II in respect of feature I and summarised in point 11.2 of the preliminary opinion of the board, in that further features of the detailed description of Figure 3b were added to claim 1. The board further observes that the "initial thoughts" of respondent II "on whether the claims of the new requests would be 'clearly allowable'" (see the letter dated 5 February 2020) did not take issue with the fourth auxiliary request. This may be regarded as tantamount to a *prima facie* finding that the amendments successfully address the issues raised without giving rise to new ones.

Admittedly, in its letter dated 5 March 2020 (pages 13 and 14), respondent II saw a lack of clarity in view of the word "size" in feature J and alleged a lack of inventive step having regard to document E1. However, these issues correspond to a full assessment of the compliance of the request with the requirements of the EPC, rather than a *prima facie* consideration with the aim of deciding on its admittance. This is underpinned by the statement in the second paragraph on page 3 of that letter, in which respondent II expressed "that we hope to discuss at the oral proceedings if the first appellant's late-filed auxiliary requests are admitted into proceedings".

14. In view of the above, the board, in exercising its discretion in accordance with Article 13(1) and (3) RPBA 2007, decided not to admit the main request and the first to third auxiliary requests into the appeal proceedings for the reasons that they were filed at a very late stage and introduced new and complex issues in respect of features taken from the description.

15. The fourth auxiliary request, on the other hand, was admitted into the appeal proceedings by the board, exercising its discretion in accordance with Article 13(1) and (3) RPBA.

16. Furthermore, in some recent decisions where, as in the case now before the board, Article 13 RPBA 2007, and not Article 13(2) RPBA 2020, was held to apply, it was also considered that Article 13(1) RPBA 2020 applied in addition, because this is not excluded by Article 25 RPBA 2020 (see e.g. decisions T 634/16 of 10 January 2020, points 7 to 14 of the Reasons, and T 32/16 of 14 January 2020, points 1.1.1 to 1.1.3 of the Reasons).

In the present case, however, the board does not consider it necessary to apply the criteria set out in Article 13(1) RPBA 2020 in addition to those which it may take into account when exercising its discretion under Article 13 RPBA 2007 (see points 4 and 5 above).

16.1 In cases where the summons to oral proceedings has been notified on or after 1 January 2020, Article 13(2) RPBA 2020 implements the third level of the convergent approach applicable in appeal proceedings (see document CA/3/19, section VI, Explanatory remarks on Article 13(2), first paragraph, first sentence; see also Supplementary publication 2 to OJ EPO 2020). Article 13(2) RPBA 2020 imposes the most stringent limitations

on appeal submissions which are made at an advanced stage of the proceedings, namely after expiry of a period set by the board of appeal in a communication under Rule 100(2) EPC or, where no such communication is issued, after notification of a summons to oral proceedings (see document CA/3/19, section VI, Explanatory remarks on Article 13(2), first paragraph, second sentence). Where an amendment is made to a party's appeal case at this advanced stage of the proceedings, Article 13(2) RPBA 2020 provides that it will, in principle, no longer be taken into account unless the party concerned has shown compelling reasons why the circumstances are exceptional. If such circumstances are shown to exist, the board of appeal may, in exercising its discretion, decide to admit an amendment made to the appeal case at this advanced stage of the proceedings (see document CA/3/19, section VI, Explanatory remarks on Article 13(2), third paragraph, last sentence).

16.2 With regard to the question whether, at the third level of the convergent approach, the provisions of Article 13(1) RPBA 2020 are to be applied in addition to those of Article 13(2) RPBA 2020, the board notes that Article 13(2) RPBA 2020 does not contain any explicit reference to the first paragraph of this article. However, the Explanatory remarks on Article 13(2) RPBA 2020 contain the following guidance:

> "*At the third level of the convergent approach, the Board **may** also rely on criteria applicable at the second level of the convergent approach, i.e. as set out in proposed new paragraph 1 of Article 13.*" (Document CA/3/19, section VI, Explanatory remarks on Article 13(2), fourth paragraph; emphasis added by the board.)

From this the board concludes that, at the third level of the convergent approach, the boards of appeal are free to use or not use the criteria set out in Article 13(1) RPBA 2020 when deciding, in the exercise of their discretion in accordance with Article 13(2) RPBA 2020, whether to admit an amendment made at this stage of the proceedings.

In this respect, Article 13(2) RPBA 2020 and Article 13(1) RPBA 2020 are also differently worded. In contrast to Article 13(2) RPBA 2020, the legislator has clarified in Article 13(1) RPBA 2020, by means of the explicit reference in the second sentence to new Article 12(4) to (6) RPBA 2020, that the criteria specified in these paragraphs and already applicable at the first level of the convergent approach also apply accordingly to any submissions made at the stage when the second level of the convergent approach applies (see also document CA/3/19, section VI, explanatory remarks on Article 13(1), second paragraph, second sentence).

16.3 Where, as in the present case, Article 13 RPBA 2007, and not Article 13(2) RPBA 2020, applies to a discretionary decision taken at the third level of the convergent approach, the board's view is that it is likewise free to use the criteria of Article 13(1) RPBA 2020 in addition. It is not apparent from either the transitional provisions of Article 25 RPBA 2020 or the explanatory remarks why the use of the criteria of Article 13(1) RPBA 2020 should be any different when Article 13 RPBA 2007, rather than Article 13(2) RPBA 2020, is to be applied at the third level of the convergent approach.

16.4 At the same time, however, the board considers that the criteria of Article 13(1) RPBA 2020 correspond in essence to those developed by the case law in the context of Article 13(1) RPBA 2007 (see also decisions T 634/16, point 14, second paragraph, of the Reasons, and T 32/16, point 1.1.3, second paragraph, of the Reasons). Since the board had already based its discretionary decision under Article 13(1) and (3) RPBA 2007 whether to admit the fourth auxiliary request into the appeal proceedings on criteria set out in Article 13(1) and (3) RPBA 2007, as well as those developed by the case law in the context of those provisions (see points 4 to 14 above), it saw no reason to apply the criteria of Article 13(1) RPBA 2020 in addition.

Fourth auxiliary request - added subject-matter

17. The only passage in the application as originally filed that discloses features I and J is on page 28, lines 7 to 11, where the size of the walls and the lower and upper limits of the width of the channel shown in Figure 3b are specified in the context of the description of Figure 4. According to the overview of the figures on page 17, lines 30 to 33, of the description as originally filed, Figures 3b and 4 pertain to the same embodiment. The detailed description of this embodiment on page 28, lines 6 and 7, however, mentions the further requirement (hereinafter referred to as "R28") that

> "the amplitude of the wave is larger than the width between two walls".

This requirement is not included in claim 1.

The insertion of features I and J taken from the detailed embodiment of the description into claim 1 therefore generalises the original disclosure and, since no basis for this generalisation was identified, leads to a combination of features which was not disclosed in the application as originally filed.

18. The argument of the appellant that feature K constituted an alternative relationship between amplitude and width of the embodiment shown in Figure 3b, which was originally disclosed in combination with feature I and J, cannot be accepted.

It is true that page 24, lines 29 to 31, of the description as originally filed contains the requirement (hereinafter referred to as "R24")

> "[Walls 26, 27 that are] positioned next to each other have a distance d that is equal to two times an amplitude a of the sinusoid"

which reflects the wording of feature K and is disclosed in the context of the embodiment of Figure 3b.

Since the distance d characterises the width between the walls, the equation of R24 (d=2a) and the inequality of R28 (a>d) are mutually exclusive.

Yet, even if R24 and R28 were alternative solutions for the relationship between amplitude and width in the embodiment of Figure 3b, there is no information in the application as filed from which it can be concluded, without any doubt, that requirement R24 (feature K) also applies to channels having a channel width in between 10 and 150 µm, preferably between 20 and 100

µm, and even more preferably between 30 and 80 µm (feature I), and to walls having a size of 1-4 µm (feature J).

In the present case, the mere fact that the same figure is mentioned in different parts of the detailed description in conjunction with two mutually exclusive requirements is not sufficient to conclude that the first requirement may be replaced in a claim by the second requirement without contravening Article 123(2) EPC.

19. Furthermore, the board is not convinced that the original disclosure of requirement R28 in claim 11 as originally filed implies that the dimensional features on page 28 are not so closely related that requirements R28 and R24 can be exchanged.

Original claim 11 depended directly on original claim 10, according to which the channel walls are positioned generally anti-symmetrical with respect to the course direction of the channel. Also, from these original claims the skilled person cannot derive directly and unambiguously that features I and J are disclosed in connection with channel walls other than those having an amplitude larger than the width between the walls.

20. Hence, the amendments to claim 1 of the fourth auxiliary request contain added subject-matter for which no basis can be found in the application as originally filed. Therefore, the fourth auxiliary request does not meet the requirements of Article 123(2) EPC.

Conclusion on the appeal

21. Since none of the appellant's main request and first to fourth auxiliary requests is allowable, the appeal is to be dismissed.

Reimbursement of appeal fee

22. The appellant requested reimbursement of the appeal fee.

23. Rule 103(1)(a) EPC stipulates that the appeal fee has to be reimbursed where the board deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

24. The precondition for reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC, namely that the appeal be allowable, is not met in the present case. According to established case law, "allowable" is to be understood in the sense that the board, in substance at least, "follows" the relief sought by the appellants, in other words that it allows their requests (J 37/89, OJ EPO 1993, 201, Reasons, point 6). That is not however the case here, since the appeal is to be dismissed (see point 21 above).

25. The request for reimbursement of the appeal fee is therefore to be refused.

Apportionment of costs

26. The appellant requests "apportionment of costs for all costs relating to the entire appeal proceedings" for the reason that the opposition division rejected a further auxiliary request as "fallback position" to a

claim including the additional feature of original claim 2. According to the appellant, the lack of novelty of such claim had not been argued prior to the date of the oral proceedings before the opposition division.

27. Under Article 104(1) EPC, each party to opposition proceedings must bear the costs it has incurred. However, the board may, for reasons of equity, order a different apportionment of costs. According to established case law (see Case Law, 9th edition 2019, III.R.2), a different apportionment of costs is justified if the conduct of one **party** is not in keeping with the care required. In view of the provisions of Article 104(1) EPC and established case law, the board has no doubt that the conduct of the opposition division cannot justify a different apportionment of costs. Thus, Article 104(1) EPC does not apply in the present case. Article 16 RPBA 2020, which applies in accordance with Article 25(1) RPBA 2020, is also not applicable in the present case, since this provision refers to "a party".

28. The request for apportionment of costs is therefore to be refused.

Order

For these reasons it is decided that:

1. The appeal is dismissed.

2. The request for reimbursement of the appeal fee and the request for apportionment of costs are refused.

The Registrar: The Chairman:

N. Schneider M. Poock

Decision electronically authenticated