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**Datasheet for the decision  
of 15 March 2021**

**Case Number:** T 2243/18 - 3.2.01

**Application Number:** 11776131.2

**Publication Number:** 2621653

**IPC:** B23D35/00, B23P15/40

**Language of the proceedings:** EN

**Title of invention:**

SHEAR FOR SHEARING ROLLED PRODUCTS AND ASSOCIATED PRODUCTION  
PROCESS

**Patent Proprietor:**

Danieli & C. Officine Meccaniche SpA

**Opponent:**

Uddeholms AB

**Headword:**

**Relevant legal provisions:**

EPC Art. 84, 56, 113(1)

RPBA 2020 Art. 13(2)

EPC R. 103(1)(a)

**Keyword:**

Claims - clarity - auxiliary request 1 (no)  
Oral submissions - taken into account (yes)  
Amendment after summons - auxiliary request 2 - taken into  
account (yes)  
Inventive step - auxiliary request 2 - non-obvious alternative  
Reimbursement of appeal fee - violation of the right to be  
heard (no)

**Decisions cited:**

G 0002/12, G 0002/13, T 0956/04, T 0768/08, T 0150/12,  
T 0967/10, T 1988/12, T 1480/16, T 0995/18, G 0004/95,  
T 0263/93

**Catchword:**



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Case Number: T 2243/18 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 15 March 2021**

**Appellant:** Danieli & C. Officine Meccaniche SpA  
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**Decision under appeal:** **Interlocutory decision of the Opposition**  
**Division of the European Patent Office posted on**  
**18 July 2018 concerning maintenance of the**  
**European Patent No. 2621653 in amended form.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** S. Mangin  
A. Jimenez

## **Summary of Facts and Submissions**

- I. The appeals were filed by the appellant 1 (opponent) and appellant 2 (proprietor) against the interlocutory decision of the opposition division finding that, on the basis of the first auxiliary request, the patent in suit (hereinafter "the patent") met the requirements of the EPC.
- II. In particular, the opposition division decided that:  
(1) Claim 1 of the first auxiliary request fulfils the requirements of Article 84 EPC;  
(2) The subject-matter of claims 1 and 4 of the first auxiliary request is new and inventive over D1, D2, D4 and D13.
- III. Oral proceedings were held before the Board on 15 March 2021.
- IV. During oral proceedings, the appellant 2 (proprietor) withdrew their main request. Consequently, the proprietor defended the patent as maintained by the opposition division based on the first auxiliary request and became de facto respondent.
- V. The appellant (opponent) requested that the decision under appeal be set aside, the European patent be revoked, and the appeal fee be reimbursed for reason of substantial procedural violation.

The respondent (patent proprietor) requested that the appeal of the appellant (opponent) be dismissed (and the patent be maintained in the form allowed by the opposition division) or in the alternative that the

patent be maintained on the basis of the auxiliary request 2 filed during oral proceedings.

VI. Independent claims of the first auxiliary request

(a) Claim 1 reads as follows:

Shear for rolling mill having at least one blade made of steel

- whose chemical composition, in mass percentage, consists of 0,454-0,55% carbon, 0,104-0,30% silicon, 0,204-0,50% manganese, 4,004-5,50% chromium, 2,004-3,00% molybdenum, 0,454-0,65% vanadium and the remainder being iron and inevitable impurities,
- produced by means of a process according [sic] claim 4 and
- whose microstructure is composed of tempered martensite.

(b) Claim 4 reads as follows:

A production process for producing a blade of a shear according to claim 1, comprising the following steps:

- providing a first steel ingot whose chemical composition, in mass percentage consists of 0,454-0,55% carbon, 0,10-0,30% silicon, 0,204-0,50% manganese, 4,004-5,50% chromium, 2,004-3,00% molybdenum, 0,454-0,65% vanadium and the remainder being iron and inevitable impurities;
- providing electro-slag-remelting of said first ingot and obtaining a second newly solidified ingot;
- providing rolling of said second ingot until obtaining a blade blank having a predetermined shape;
- providing a quenching cycle consisting in heating the blade to the steel austenitising temperature, comprised between 1035°C and 1055°C, by means of two preheating steps at intermediate temperatures respectively equal

to 590-610°C and 840-860°C, and then cooling the blade under vacuum to ambient temperature;

- providing three tempering cycles at temperatures between 510°C and 550°C.

VII. Claim 1 of auxiliary request 2 filed during oral proceedings reads as follows:

A production process for producing a blade of a shear for rolling mill made of steel whose chemical composition, in mass percentage, consists of 0,45÷0,55% carbon, 0,10÷0,30% silicon, 0,20÷0,50% manganese, 4,00÷5,50% chromium, 2,00÷3,00% molybdenum, 0,45÷0,65% vanadium and the remainder being iron and inevitable impurities, and whose microstructure is composed of tempered martensite, the process comprising the following steps:

- providing a first steel ingot whose chemical composition, in mass percentage, consists of 0,45÷0,55% carbon, 0,10÷0,30% silicon, 0,20÷0,50% manganese, 4,00÷5,50% chromium, 2,00÷3,00% molybdenum, 0,45÷0,65% vanadium and the remainder being iron and inevitable impurities;

- providing electro-slag-remelting of said first ingot and obtaining a second newly solidified ingot;

- providing rolling of said second ingot until obtaining a blade blank having a predetermined shape;

- providing a quenching cycle consisting in heating the blade to the steel austenitising temperature, comprised between 1035°C and 1055°C, by means of two preheating steps at intermediate temperatures respectively equal to 590-610°C and 840-860°C, and then cooling the blade under vacuum to ambient temperature;

- providing three tempering cycles at temperatures between 510°C and 550°C.

VIII. In the present decision, reference is made to the following prior art:

D1: Alleged prior use supported by:

- D1a: TKM Packing list "Packliste" to the delivery 8121310 dated 19.03.2007 of 8 rotary slitter knives "Rollscherenmesser aus Werkstoff UNIMAX" for order No. "Kundenauftrag" 125559/10. Material 410034.
- D1b: "Lieferschein" for delivery 8121310 dated 16.03.2007 for "Auftragsnummer 125559 /10.11.2006" addressed to LASOTEX in Molndal, Sweden.
- D1c: Drawing 1-361003.967 "Rollscherenmesser". Material 410034.
- D1d: Leaflet "UDDEHOLM UNIMAX®", Edition 4, 09.2009.
- D1e: Leaflet "UDDEHOLM UNIMAX©", Edition 1, 10.2004, 7 pages.
- D1f: Backside ("Baksida") of "ANALYSFÖRESKRIFT" Nr. 5490 for UNIMAX, internal and confidential document of the Opponent.

D4: Leaflet: Bohler W360 ISOBLOC®, Hot work tool steel, printed 08.2007, retrieved from the Internet on 02.03.2016, in the version dated 2007.10.15: <http://web.archive.org/web/20071015050548/http://www.bohleredelstahl.com/files/W360DE.pdf>

D4': Leaflet: Bohler W360 ISOBLOC©, Premium Hot work and Cold Work Tool Steel, Revision date 16 January 2008, retrieved from the Internet on 02.03.2016, [http://www.bucorp.com/media/W36Q\\_HTR\\_Rev\\_Jan16\\_2008.pdf](http://www.bucorp.com/media/W36Q_HTR_Rev_Jan16_2008.pdf),

D13: Uddeholm POCKET BOOK, The Uddeholm range of tooling materials, Edition 2, 10.2008, retrieved from the Internet on 19.03.2018, [http://www.uddeholm.nl/dutch/files/Uddeholm\\_Pocket\\_book\\_E2\\_.pdf](http://www.uddeholm.nl/dutch/files/Uddeholm_Pocket_book_E2_.pdf).

## **Reasons for the Decision**

1. First auxiliary request (request found allowable by the opposition division)- Clarity, Article 84 EPC.

1.1 Claim 1 defines a shear for rolling mill having at least one blade made of steel defined by its composition (product features) and by its manufacturing process (process features). Claim 1 is to be construed as a claim to the shear for rolling mill as such.

According to well established case law, claims for products defined in terms of processes for their preparation (known as "product-by-process" claims) are admissible only if the products themselves fulfil the requirements for patentability and there is no other information available in the application which could have enabled the applicant to define the product satisfactorily by reference to its composition, structure or some other testable parameter (see e.g. G 2/12, OJ 2016, A28 and G 2/13, OJ 2016, A29; T 956/04; T 768/08; T 150/12).

Furthermore with regard to product-by-process claims, the requirement of clarity means that the skilled person should be able to determine, either from the claim alone or, by construction of the claim in the light of the description, or by construction in the light of the skilled person's common general knowledge, which identifiable and unambiguous technical features are imparted to the product by the process by which it is defined (T 967/10, T 1988/12, Case Law of the Board of Appeal, edition 2019, II, A, 7.1)



1.2 The appellant was of the opinion that the product of claim 1 can be defined by reference to its composition, structure or other parameters. The appellant referred to paragraph [0018] of the patent specification *"three tempering cycles at temperatures between 510°C and 550°C, which give a microstructure composed entirely of tempered martensite and having a hardness of 56-58 HRC"* and paragraph [0019] of the patent specification *"there has been a full penetration of quenching, both at the surface and in depth"*. The appellant concluded that claim 1 could be defined by such features, i.e. its hardness and its uniform microstructure between the surface and the innermost zone and not by the process. Furthermore the appellant noted that the burden of proof lied with the patentee to define the identifiable structural feature or characterizing property inevitably and unambiguously resulting from the defined process.

Moreover the appellant was of the opinion that the product of claim 1 per se was not novel and not inventive as the shear known from D13 and the alleged prior use D1 has a uniform tempered martensite microstructure and a hardness between 56 and 58 HRC (page 17 of D13, hardness of UNIMAX up to 58 HRC and page 4 of D1d, *"yielding a working hardness of 56-58 HRC"*).

Finally the appellant was of the opinion that the circular reference between claim 1 and claim 4 made both claims unclear.

1.3 The respondent was of the opinion that the steel blade of claim 1 cannot only be described by its hardness, as this would not enable to define the steel's microstructure imparted by the process of claim 4. In

their opinion the uniformity of the steel structure, and in particular the martensite structure throughout the thickness of the blade cannot be described in any other way than by reference to the manufacturing process. None of the documents D1d, D4 and D13 discloses a shear having a blade with the surface and the inner zone of the blade having a similar microstructure.

The respondent was further of the opinion that the skilled person is able to determine what are the technical features of the steel blade according to claim 1 that are obtained as a result of the process of claim 4. According to paragraph [0018] of the patent specification the three tempering cycles at temperatures between 510°C and 550°C impart "*a microstructure composed entirely of tempered martensite*" and according to paragraph [0019] of the patent figures 1 and 2 show two extremely similar images of the microstructure at the surface and at the innermost zone of the blade, meaning that "*there is a full penetration of quenching, both at the surface and in depth*".

- 1.4 The Board judges that claim 1 does not fulfil the requirement of Article 84 EPC for the following reasons:

In the present case, the thickness of the blade is not defined in claim 1. However, the thickness of the blade according to the patent specification (paragraphs [0018], [0019] and examples 1-4) should be equal to or less than 60 mm to obtain the uniform martensite microstructure throughout the thickness of the blade. Accordingly, a blade with a thickness greater than 60 mm which is encompassed by claim 1 would exhibit a

microstructure in the innermost zone that is different to that obtained with a blade having a thickness which is equal to or less than 60 mm, as the quenching would not penetrate up to the core of such a thicker blade. Therefore, since claim 1 does not specify that the thickness of the blade is equal to or less than 60 mm (which feature is presented in the description as being necessary for obtaining the intended microstructure resulting from the manufacturing process) and encompasses blades with a thickness greater than 60 mm, the skilled person is not in a position to identify which unambiguous technical features are imparted to the claimed product by the process defined in claim 4. Hence, claim 1 lacks clarity in the sense of Article 84 EPC.

Furthermore, the uniformity of the microstructure of the steel obtained by the process of claim 4 referred to by the respondent is a parameter which is vague and only subjectively quantifiable. The two images on figures 1 and 2 depict the microstructure of a shear blade at the surface and at the innermost zone or heart of the blade. While the two images are similar, an objective comparison of the microstructure in particular the comparison of the ratio of martensite, the ratio of retained austenite and of the grain size is not possible.

Therefore, the alleged uniformity of the microstructure imparted by the process of claim 4 cannot be considered as an unambiguous technical feature characterising the product. The skilled person is not in a position to determine whether, for a given product, the uniformity of the microstructure is such to fulfil the requirements of claim 1 or not.

2. Admissibility of auxiliary request 2

The Board judges that auxiliary request 2 does not constitute an amendment to the respondent's appeal case. Therefore Article 13 RPBA 2020 does not apply and the Board has no discretion in respect of the admissibility of auxiliary request 2 into the appeal proceedings.

Auxiliary request 2 submitted by the respondent during oral proceedings contains only one claim corresponding to the process claim 4 of the auxiliary request 1, in which the reference to the product "according to claim 1" has been replaced by the integral wording of claim 1, except for the passage "produced by means of a process according [sic] claim 4".

Similarly to decisions T 1480/16 and T 995/18, the Board considers that with auxiliary request 2 the respondent renounced to some of the claims of the auxiliary request 1 thereby limiting their case in appeal but not amending it.

3. Admissibility of the oral submissions of Mr. Bergman

3.1 With letter of 15 February 2021, the appellant requested to allow Mr. Bergman to make oral submissions regarding the general knowledge about the influence of steel composition and processing parameters on the final product. It was indicated that Mr. Bergman was to make oral submissions on:

- i) the temperature of the preheating steps
- ii) the austenitising temperature
- iii) the number of tempering cycles.

This request is in line with the criteria set in G 4/95. This was not disputed by the respondent.

- 3.2 The respondent however was of the opinion that the request for Mr. Bergman to make oral submission filed with letter of 15 February 2021 after the notification of the summons to oral proceedings should not be admitted into the proceedings. In their view the appellant should have made this request at the latest with the grounds of appeal. There were no exceptional circumstances justified with cogent reasons by the appellant that would allow taking into consideration this request.
- 3.3 During the oral proceedings, the Board took the view that the request to allow Mr. Bergman to make oral submissions regarding the common general knowledge about the influence of steel composition and processing parameters on the final product did not constitute an amendment to the appellant's appeal case. The submissions would only elaborate on allegations of common general knowledge that had already been made in the written proceedings. Under these premises, the Board saw no reasons to make use of its discretionary power pursuant to Article 13 RPBA 2020 not to admit the appellant's request.
- 3.4 Mr. Bergman was thus allowed to make oral submissions during the oral proceedings.
4. Inventive step of auxiliary request 2

The subject-matter of claim 1 involves an inventive step according to Article 56 EPC.

The appellant submitted the following objections:

- D13 in combination with the common general knowledge or D1d;

- D1 (D1a-D1f) in combination with the common general knowledge or D13;
- D4 with the information in D4'.

These objections are not convincing, as explained below. There is thus no need to discuss the issues of admissibility raised by the respondent in respect of those objections that were submitted for the first time with the statement of grounds of appeal of the opponent.

#### 4.1 Inventive step objection starting from D13

The subject-matter of claim 1 involves an inventive step starting from D13 in combination with the common general knowledge or D1d.

##### 4.1.1 The subject-matter of claim 1 undisputedly differs from D13 in that:

(i) The austenitising temperature is comprised between 1035-1055 °C (in D13, page 7 for UNIMAX, the austenitising temperature is 1000-1025°C and page 9 for UNIMAX, the austenitising temperature is 1020°C).

(ii) The preheating steps are made at intermediate temperatures respectively equal to 590-610°C and 840-860°C (in D13, the preheating temperatures are not disclosed).

(i) The blade is cooled to the ambient temperature (in D13 the blade is cooled down to 50-70°C).

(i) Three tempering cycles at temperatures between 510°C and 550°C are provided (in D13, page 9 and page 35 only two tempering cycles are provided).

The problem to be solved may be regarded as to provide an alternative production process for producing a shear blade which is tough and thermal shock resistant, with

a high surface hardness, and which is wear resistant (see paragraph [0008] of the patent in suit).

Starting from D13, there is no incentive for the skilled person to modify the known production process such as to arrive at the process of claim 1.

Furthermore, considering the number of parameters that can be adjusted in such a production process the skilled person cannot arrive at the subject-matter of claim 1 without undue burden. Adjusting the austenitising temperature, the temperature of preheating steps, the cooling temperature and the number of cycles to those of claim 1 without any indication to do so, is the result of an ex post facto analysis.

D1d relates to the same steel as D13, namely "Uddeholm Unimax". D1d discloses preheating temperatures between 600-650°C and 850-900°C. While the skilled person would combine the teaching of D13 and D1d as they relate to the same product, the skilled person would not arrive at the production process of claim 1. Indeed, heating the steel blade to an austenitising temperature between 1035°C and 1055°C, cooling the blade to ambient temperature and providing three tempering cycles is not disclosed in D1d.

- 4.1.2 The appellant is of the opinion that since on the right column of page 6 of D1d it is recommended to temper at least twice and since tempering is seldom performed more than three times and never more than 4 times, the requirements for a selection invention are not met. The appellant adds that even if the number of tempering cycles is considered as a distinguishing feature, it is well known that tempering is made for reducing or

eliminating the amount of retained austenite (see Tempering graph on the right column on page 6 of D1d) and that with a higher austenitising temperature, the skilled person would temper 3 times.

Furthermore, the appellant argues that it is well known that the hardness increases strongly with increasing austenitising temperature as shown on the graph "Hardness, grain size and retained austenite as functions of austenitizing temperature" on the left column of page 6.

The appellant concludes that it is obvious for the skilled person to increase the austenitising temperature to 1035-1050°C in order to obtain an increased hardness before tempering followed by three tempering cycles to decrease the amount of retained austenite. The skilled person would thus arrive to the production process of claim 1 without any inventive skills.

- 4.1.3 The Board does not agree with the appellant's above reasoning, which is based on an ex post facto analysis.
- Firstly, there is no incentive for the skilled person to change the process such as to increase the hardness of the intermediate product before tempering. The hardness and the microstructure of the end product are what matter and depend on the complete production process.
  - Secondly, should the skilled person change the process and increase the austenitising temperature between 1035°C and 1055°C this will not necessarily increase the retained austenite as can be seen from the graph on the left column of page 6 of D1d. The percentage of retained austenite is the same with an austenitising temperature of 1005°C and an



austenitising temperature of 1050°C. It is therefore not obvious to carry out an additional tempering cycle i.e. a third tempering cycle to further reduce the retained austenite.

- Thirdly, the number of tempering cycles is not the only parameter that can be adjusted to decrease the retained austenite; the temperature of the tempering cycle also plays an important role as can be seen on the tempering graph on the right column of page 6 of D1d.

- Fourthly, even if the skilled person would adjust the austenitising temperature between 1035°C and 1055°C and provide three tempering cycles between 510°C and 550°C, claim 1 still requires cooling the blade to the ambient temperature, while D13 (page 35 under point 3) discloses "*discontinue cooling at approx. 50-70°C and temper immediately*" and D1d (page 5, last note) "*temper the tool as soon as its temperature reaches 50-70°C*".

4.2 Inventive step objection starting from the alleged prior use based on documents D1a-D1f.

Irrespective of whether the alleged prior use based on documents D1a-D1f was made available to the public before the date of filing of the patent, the subject-matter of claim 1 involves an inventive step starting from this prior use.

The subject-matter of claim 1 undisputedly differs from D1d in that:

(i) The austenitising temperature is comprised between 1035°C and 1055 °C (in D1d, p.5 under "Hardening", the austenitising temperature is 1000-1025°C).

(ii) The blade is cooled to ambient temperature (on page 5 of D1d the blade is cooled down to 50°-70°C).

(iii) three tempering cycles at temperatures between 510°C and 550°C are provided (page 6 of D1d discloses under "tempering" to temper at least twice where the lowest tempering temperature should be 525°C).

The problem to be solved may be considered the same as that starting from D13, namely to provide an alternative production process for producing a shear blade which is tough and thermal shock resistant, with a high surface hardness, and which is wear resistant.

In D1d there is no indication and no incentive for the skilled person to increase the austenitising temperature to a temperature between 1035°C and 1055°C, to cool the blade at ambient temperature and to provide three tempering cycles.

- 4.2.1 The appellant is of the opinion that it would be desirable to increase the hardness in the hardened and tempered condition of the circular slitting knife according to the alleged prior use by one or two HRC. As a result, it would be obvious to increase the austenitising temperature in order to have a higher hardness before tempering and to submit the blade to three tempering cycles.

The Board does not agree with the appellant's argumentation for the same reasons as starting from D13. Reference is made to point 4.1.3.

- 4.3 Inventive step objection starting from D4

Claim 1 is directed to a production process for producing a blade of a shear for rolling mills. D4 relates to a hot work tool steel in particular for dies (see "application and uses" on page 2), but is silent

about blades of shears for rolling mills. As the latter are very specific objects and quite different from dies, D4 does not represent an appropriate starting point for assessing inventive step.

Anyway, even if the skilled person would start from D4 as it discloses a steel having a composition (see page 6 of D4) that falls under the composition according to claim 1 of the patent in suit, the temperatures of the preheating steps and the tempering cycles are not disclosed in D4.

Starting from D4, the problem to be solved may be seen in providing a production process for producing a blade of a shear made of the steel according to D4.

Although both leaflets D4 and D4' refer to the tool steel W360 Isobloc produced by Böhler, it is questionable whether D4 and D4' can be regarded as a single piece of prior art because D4 is dated 08.2007 and D4' discloses a *"Revision Date: 16 January 2008"* and states: *"This information is based on our present state of knowledge and is intended to provide general notes on our products and their uses. It should not therefore be construed as a warranty of specific properties of the products described or a warranty for fitness for a particular purpose. It is your responsibility to confirm you have the latest version of this document (verify on our website) and that you forward to your Heat treatment service provider"*. Thus it cannot be concluded clearly and unambiguously that the BOHLER W360 ISOBLOC of D4 was processed according to the heat treatment recommendation disclosed in D4' as D4' is revised regularly.

But even if this were the case, the skilled person does not arrive at the production process of claim 1. D4' recommends under vacuum to have two preheating temperatures 1200°F (649°C) and 1500°F (816°C) and to temper immediately after quenching when the complete tool reaches 150°F (66°C). These recommendations do not correspond to the temperatures defined in claim 1. Claim 1 defines a first and second preheating steps temperature of 590°C-610°C and 840-860°C and cooling the blade down to ambient temperature.

According to the appellant the specific preheating temperatures have no influence on the final product. Nevertheless the appellant failed to explain why the skilled person would be prompted to provide temperatures different from those disclosed in D4' when processing the steel of D4 to produce a blade of a shear for a rolling mill.

5. Violation of the right to be heard (Article 113(1) EPC) and reimbursement of the appeal fee under Rule 103(1) (a) EPC
- 5.1 With the notice of appeal, the appellant refers to the proceedings before the opposition division, during which the opposition division issued a summons to oral proceedings dated 15 September 2017, accompanied by a preliminary opinion which did not take into account the last submissions of the opponent dated 11 September 2017 although these had been duly announced in advance with letter dated 15 June 2017. With letter of 28 September 2017, the opponent informed the opposition division that it made a serious procedural mistake by not taking into account the last submissions and requested that the oral proceedings be cancelled and a new summons issued. This request was

reiterated with letter dated 15 November 2017.

In substance, in the notice of appeal the appellant argues that by not taking into account the last submissions and by not cancelling the oral proceedings and issuing new summons, the opposition division did not respect the requirements of impartiality and of fairness towards the parties.

Furthermore, the appellant submits that although the opposition division issued a new preliminary opinion on 19 February 2018, taking into account the last submissions of the opponent, it did not postpone the oral proceedings and maintained the final date of 16 March 2018 for making written submissions in preparation for the oral proceedings. Accordingly, the opposition division committed a substantial procedural violation because the shortest time limit which is to be observed by the EPO is two months (Article 120(a) EPC and Rule 132(2) EPC; see T 263/93).

Finally, the appellant submits that the reimbursement of the appeal fee is equitable also in view of undue and unfair bias in the conduct of the opposition division in the handling of the opposition proceedings.

During the oral proceedings the appellant did not further elaborate on these issues and only referred to its written submissions.

5.2 The Board disagrees for the following reasons:

There is no requirement in the EPC for the opposition division to wait for further submissions of the parties after the notice of opposition and the reply of the proprietor have been received. On the contrary, parties should expect that the opposition division will prepare the next action at any time after receiving the reply

of the proprietor (see notice from the EPO concerning the opposition procedure as from 1 July 2016, point 3, OJ May 2016).

Nor is there any legal obligation for the opposition division to issue a new preliminary opinion after receiving further submissions from parties.

As regards the fact that the opposition division did not set a new time limit when issuing a new preliminary opinion with the communication dated 19 February 2018, but merely reminded the parties of the deadline of 16 March 2018 for making further submissions in accordance with Rule 116 EPC (see point 9.2 of said communication), it is noted that the preliminary opinion as set in the above-mentioned communication was not meant as an invitation for the parties to file observations or amended documents within a period to be specified by the EPO in the sense of Article 101(1) EPC, for which Rule 132(2) EPC would apply.

Accordingly, the opposition division did not commit a substantial procedural violation in not setting a new time limit (which would have required postponing the oral proceedings, as requested by the opponent) and in referring to the still open time limit for making further submissions in preparation for the oral proceedings in accordance with Rule 116(1) EPC.

Accordingly, the opposition division neither failed to respect the right to be heard of the opponent, nor did it acted impartially or unfairly towards the opponent. Hence the Board cannot recognise that a substantial procedural violation was committed by the opposition division, justifying the reimbursement of the appeal fee pursuant to Rule 103(1) (a) EPC.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent on the basis of claim 1 of auxiliary request 2 filed during the oral proceedings and a description to be adapted thereto.

The Registrar:

The Chairman:



D. Magliano

G. Pricolo

Decision electronically authenticated