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**Datasheet for the decision
of 1 December 2022**

Case Number: T 1851/19 - 3.2.07

Application Number: 13729424.5

Publication Number: 2892657

IPC: B05C19/00, B05C19/04, B05D3/06,
B05D5/00, B05C21/00, B05D1/12,
B05D1/38, B44C1/00

Language of the proceedings: EN

Title of invention:
METHOD AND MACHINE FOR THE DIGITAL DECORATION OF PRODUCTS WITH
GRANULAR MATERIALS AND THE LIKE

Patent Proprietor:
Projecta Engineering S.r.l.

Opponents:
Arias Sanz, Juan
System S.p.A.

Headword:

Relevant legal provisions:
EPC R. 100(2)
RPBA Art. 12(4)
RPBA 2020 Art. 12(3), 13(1)

Keyword:

Late-filed requests - admitted (no)

Decisions cited:

G 0009/91, G 0010/91

Catchword:



Beschwerdekammern

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Case Number: T 1851/19 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 1 December 2022

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 23 April 2019
revoking European patent No. 2892657 pursuant to
Article 101(3)(b) EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Beckman
 A. Pieracci

Summary of Facts and Submissions

- I. An appeal was filed by the patent proprietor in the prescribed form and within the prescribed time limit against the decision of the opposition division revoking European patent No. 2 892 657.
- II. The opposition division found that the claimed subject-matter of the then main request was not inventive. The then auxiliary requests were not admitted into the proceedings.
- III. The Board communicated its preliminary assessment of the case by means of a communication pursuant to Rule 100(2) EPC, wherein the Board indicated its preliminary opinion that there was no admissible and allowable request relied upon by the patent proprietor on the basis of which the patent could be maintained.
- IV. The patent proprietor responded in substance to the Board's communication with letter dated 31 May 2022.
- V. Oral proceedings before the Board took place by videoconference on 1 December 2022. At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes thereof.
- VI. The patent proprietor (appellant) requested

that the decision under appeal be set aside and that a patent be maintained in amended form on the basis of one of the sets of claims filed as main request and first to fourth auxiliary requests,

wherein
the main request, the first and the second
auxiliary request were submitted with the statement
setting out the grounds of appeal,
the third and the fourth auxiliary request were
submitted with letter dated 22 April 2021,
and the fourth auxiliary request was decided upon
in the decision under appeal (as then main
request).

Opponents I and II (respondents) requested

that the appeal be dismissed.

VII. As the present decision solely concerns procedural
issues of admittance into the proceedings of the patent
proprietor's main request and of the first to fourth
auxiliary requests, it is not necessary to reproduce
the wording of these requests here.

VIII. The lines of argument of the parties are dealt with in
detail in the reasons for the decision.

Reasons for the Decision

1. *Revised Rules of Procedure of the Boards of Appeal
(RPBA 2020) - transitional provisions*

The present proceedings are governed by the revised
version of the Rules of Procedure which came into force
on 1 January 2020 (Articles 24 and 25(1) RPBA 2020),
except for Article 12(4) to (6) RPBA 2020 instead of
which Article 12(4) RPBA 2007 remains applicable
(Article 25(2) RPBA 2020).

2. *Admittance into the proceedings of the main request and of the first to third auxiliary requests*

2.1 The main request as well as the first and second auxiliary requests were filed for the first time with the statement of grounds of appeal, whereas the third auxiliary request was submitted for the first time with the patent proprietor's letter dated 22 April 2021, and therefore these requests did not form part of the decision under appeal.

2.2 The opponents argued that none of these requests should be admitted into the appeal proceedings as being late filed.

2.3 The patent proprietor brought forward that an appellant patent proprietor had the right to file new requests at any stage of the appeal proceedings.

The patent proprietor argued that since the main request and the first and second auxiliary request were presented with the statement of grounds of appeal, the requirements of Article 12(3) RPBA 2020, that the statement of grounds of appeal should contain a complete case, were fulfilled.

The patent proprietor further argued that Article 12(4) RPBA 2007 aimed at providing the Board with the discretion to refuse requests, but it was far from constituting an insuperable bar for the submissions of claim amendments.

According to the patent proprietor, Article 13 (1) RPBA 2020 clarified that amendments could also be filed at a stage later than the grounds of appeal, and even just

before or during oral proceedings (see also Article 13(2) RPBA 2020). This clearly supported their assumption that the amendments filed with the statement of grounds of appeal were timely filed.

The patent proprietor argued further that under Article 13(1) RPBA 2020, the Board must exercise its discretion in view of the need for procedural economy and thus requests filed very late (*i.e.* shortly before or during the oral proceedings) will therefore be admitted only if they are *prima facie* allowable. Clearly, this was not the case of requests filed with the grounds of appeal.

The patent proprietor brought forward that they had been more than fair towards the opponents, when also considering that the requests submitted with the statement of grounds of appeal were focused on amendments obtained on the basis of depending claims or on aspects already discussed during the opposition proceedings. The amendments were well known to the opponents and have been proposed about three years ago, and thus they would not prevent the appeal proceedings to be conducted in swift manner and ensuring legal certainty of the procedure. It was clear that admitting these requests would not adversely affect the opponents' right to submit observations on them.

The patent proprietor further argued that the jurisprudence supported their reasoning according to which a request could be submitted even during the appeal proceedings and not only at the start thereof.

2.4 The Board is not convinced by the patent proprietor's lines of argument.

The main request and the first and second auxiliary requests have not been subject of the decision under appeal so their admittance into the proceedings depends on the board's discretion under Article 12(4) RPBA 2007.

The third auxiliary request was submitted for the first time in appeal proceedings with the patent proprietor's letter dated 22 April 2021 so that its admittance into the proceedings depends on the Board's discretion under Article 13(1) RPBA 2020, wherein Article 12(4) RPBA 2007 applies mutatis mutandis (see Articles 13(1), second sentence, RPBA 2020; see also explanatory remarks to Article 13(1) RPBA 2020).

- 2.5 The Board follows established case law that, by virtue of Article 12(4) RPBA 2007, a Board has discretion not to admit requests which could and should have been presented by the patent proprietor already in opposition proceedings (see the Case Law of the Boards of Appeal, 10th edition 2022, V.A.5.11.3e).

For the Board decisive in this respect is the issue whether justifying reasons exist for the filing of such requests only with the statement setting out the grounds of appeal or after the patent proprietor has filed its grounds of appeal.

However, the Board follows the opponents' view that the patent proprietor has not submitted any justifying reasons as to why the main request and first to third auxiliary requests had not been filed earlier to allow a decision on their allowability by the opposition division. In fact, a justification for filing these request only in appeal proceedings has not been addressed by the patent proprietor at all.

The Board cannot identify any surprising change in the opposition proceedings that could have prevented the patent proprietor from filing these request already in opposition proceedings. Thus, the Board concludes that the patent proprietor ought have presented its requests already in opposition proceedings.

If the patent proprietor's requests were admitted and decided upon by the Board, the opponents would in effect be deprived of the opportunity to have the matter reviewed at two instances. Irrespective of the fact that there no absolute and unconditional right to have each and every matter examined and decided on at two instances, the Board accepts the opponents' view that, in the particular circumstances of the case at hand, admitting these requests into the appeal proceedings would put the opponents at an unfair disadvantage.

The purpose of the *inter partes* appeal procedure is mainly to give the adversely affected party a possibility to challenge the decision of the opposition division on its merits and to obtain a judicial ruling on whether the decision of the opposition division is correct (G 9/91 and G 10/91). The appeal proceedings are not about bringing an entirely fresh case. However, contrary to the patent proprietor's opinion, such a situation has been created in the present case.

2.6 Hence, in compliance with the opponents' corresponding requests, the main request and the first and second auxiliary requests are not admitted into the appeal proceedings pursuant to Article 12(4) RPBA 2007. The third auxiliary request is not admitted into the appeal

proceedings pursuant to Articles 12(4) RPBA 2007 and 13(1) RPBA 2020.

3. *Admittance into the proceedings of the fourth auxiliary request*

3.1 After having directed its requests in appeal to the sets of claims attached to its statement of grounds of appeal (new main request, new first auxiliary request and new second auxiliary request), the patent proprietor filed with its letter dated 22 April 2021 as fourth auxiliary request a set of claims corresponding to its previous main request filed with letter dated 11 January 2019 and decided upon in the decision under appeal (see statement of grounds of appeal, page 1, fourth paragraph; letter dated 22 April 2021, point 5).

Regarding the previous main request decided upon in the decision under appeal, this request has been replaced by the new main request explicitly referred to in the substantive appeal request on page 1, fourth paragraph, of the statement of grounds of appeal and enclosed to the statement of grounds of appeal as "main request". Hence, it is only this main request filed in appeal which qualifies as request within the meaning of Article 12(3) RPBA 2020.

The patent proprietor chose with its statement of grounds of appeal not to pursue with the main request decided upon in the decision under appeal but with a new main request. Hence, introducing the previous main request as fourth auxiliary request at a later stage, after the opponents' replies, falls under Article 13(1) RPBA 2020.

3.2 According to Article 13(1) RPBA 2020 any amendment to a party's appeal case after it has filed its grounds of appeal is subject to the party's justification for its amendment and may be admitted only at the discretion of the Board. The party shall provide reasons for submitting the amendment at this stage of the appeal proceedings.

3.3 The patent proprietor argued that it should be admissible for the patent proprietor to file new requests at any stage of the appeal proceedings. The patent proprietor brought forward that they reacted to the opponents' replies by submitting the fourth auxiliary request. A request concerning the alternative recited in the fourth request was submitted in opposition proceedings. The same request was presented as one of the alternatives with the grounds of appeal. The fourth auxiliary request was again submitted as such on April 22, 2021, *i.e.* more than one year ago. The fourth auxiliary request included a claim 1 obtained as a combination of granted claims. The opponents had examined and discussed in detail the subject-matter of claim 1 of the fourth auxiliary request both during the opposition and during the appeal proceedings, and thus would not be deprived of the opportunity to have the matter reviewed at two instances. The admittance of the fourth auxiliary request would not determine an entirely fresh case and would not be detrimental to procedural economy of the appeal.

3.4 The Board is not convinced by the patent proprietor's argumentation.

The fourth auxiliary request constitutes an amendment to the patent proprietor's case within the meaning of

Article 13(1) RPBA 2020. The fourth auxiliary request was not only filed after the patent proprietor's notice of appeal and statement of grounds of appeal, like the third auxiliary request. In addition, with respect to claim 1 of the new main request, wherein only this main request filed in appeal qualifies as request within the meaning of Article 12(3) RPBA 2020 (see point 3.1 above), two alternatives in claim 1 of the fourth auxiliary request were deleted.

In fact, by this amendment the fourth auxiliary request corresponds to the previous main request in opposition proceedings. However, when filing the fourth auxiliary request, the patent proprietor made no reference to the previous main request decided in the decision under appeal, nor did the patent proprietor submit any substantiated argumentation why the opposition division had been wrong in finding the previous main request non-patentable (see letter dated 22 April 2021, point 5).

The Board considers the patent proprietor's argument not convincing that the filing of the fourth auxiliary request was in reaction to the opponents' replies, since, as acknowledged by the patent proprietor, the opponents' objections were already present in opposition proceedings with respect to the previous main request. Thus, the patent proprietor was aware of the objections long before the opponents' replies to the statement of grounds of appeal and could and should have filed the fourth auxiliary request from the outset.

Since the patent proprietor did not provide any convincing reasons for submitting this amendment only after having received the opponents' replies to the

statement of grounds of appeal, the requirements of Article 13(1) RPBA 2020 as to the required justification have not been met by the patent proprietor.

Thus, the Board does not admit the fourth auxiliary request according to Article 13(1) RPBA 2020, in accordance with the opponents' corresponding requests.

4. Hence, there is no admissible request relied upon by the patent proprietor on the basis of which the patent could be maintained. The patent proprietor has not shown in a convincing manner that the decision under appeal was incorrect in revoking the European patent No. 2 892 657.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated