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**Datasheet for the decision  
of 31 May 2022**

**Case Number:** T 1853/19 - 3.4.02

**Application Number:** 12791535.3

**Publication Number:** 2745649

**IPC:** H05G2/00, H01S3/09

**Language of the proceedings:** EN

**Title of invention:**  
SHORT PERIOD UNDULATOR

**Applicant:**  
Pécsi Tudományegyetem

**Relevant legal provisions:**

EPC Art. 84  
EPC R. 116  
RPBA Art. 12(4)  
RPBA 2020 Art. 13(2)

**Keyword:**

Clarity of claims (main request: no)  
Admission of requests (first to fifth auxiliary requests: no)

**Decisions cited:**

T 1321/04, T 0372/90



**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 1853/19 - 3.4.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.02**  
**of 31 May 2022**

**Appellant:** Pécsi Tudományegyetem  
(Applicant) Vasvári Pál u. 4.  
7622 Pécs (HU)

**Representative:** Szabo, Zsolt  
Danubia  
Patent & Law Office LLC  
Bajcsy-Zsilinszky út 16  
1051 Budapest (HU)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 18 January 2019  
refusing European patent application No.  
12791535.3 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** R. Bekkering  
**Members:** F. J. Narganes-Quijano  
G. Decker

## **Summary of Facts and Submissions**

I. The appellant (applicant) lodged an appeal against the decision of the examining division refusing European patent application No. 12791535.3.

II. In the decision under appeal the examining division held as follows in respect of the main request and the first to fourth auxiliary requests then on file:

- main request: claim 1 did not comply with the requirements of Article 84 EPC and its subject-matter was not new over document D3 (WO 2010/130924 A1) (Articles 52(1) and 54(1) EPC); and

- first to fourth auxiliary requests: the claims were not admitted into the proceedings under Rule 137(3) together with Rule 116(1) EPC.

III. With the statement setting out the grounds of appeal the appellant submitted claims according to a main request and first and second auxiliary requests.

In addition, in the statement of grounds of appeal the appellant made reference to "the contents of our argumentation filed simultaneously with the previous 2nd Auxiliary request on 7 December 2018", followed by the statement "..., which is also asked here to be admitted into the proceedings".

IV. Oral proceedings were held before the board on 31 May 2022.

During the oral proceedings, which were held by videoconference, the appellant filed by email claims according to a fourth and a fifth auxiliary request.

The email contained the following statement of the appellant:

"Attached please find enclosed Auxiliary Requests 4 and 5 submitted to defend European patent Application no. 12791535.3.

Auxiliary Request 4, besides some formal modifications, contains an amendment of claim 1 in the form of using the correct term 'antinodal plane' and a new feature taken from the text of the specification as filed on the international filing date (see the WO document, page 8, lines 22-29, specifically, lines 27-29) in order to also clearly, i.e. prima facie, demarcate the present invention from the technical solution disclosed in document D3.

Auxiliary Request 5 is based on Auxiliary Request 4, but concentrating merely on the method for generating electromagnetic [sic] radiation, in particular coherent electromagnetic radiation. That is, the claims related to an optical undulator and a free electron laser are deleted from the set of claims as submitted hereby under Auxiliary Request 4.

Admittance of these two requests into the procedure is respectfully solicited."

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims according to the main request or, alternatively, according to the first or the second auxiliary request, all these requests filed with the statement of grounds of appeal dated 28 May 2019, or according to the third auxiliary request filed as second auxiliary request with the letter dated 7 December 2018, or according to the fourth or the fifth auxiliary request both filed during the oral proceedings on 31 May 2022.

At the end of the oral proceedings the chairman announced the decision of the board.

V. Claim 1 of the main request reads as follows:

"A method for generating electromagnetic radiation using a high-energy electrically charged particle beam, wherein

- high-intensity electromagnetic pulses (7; 7a, 7b) are generated, said pulses falling into terahertz frequency range, each pulse being characterized by a respective wavelength;

- by interfering said pulses (7; 7a, 7b) with one another an electromagnetic standing wave is created, said standing wave having an electric field strength of a pre-determined peak value at antinodes of the standing wave;

- said particle beam is directed through the non-steady electromagnetic field of the standing wave in or in the vicinity of a plane spanned by the maximal electric field strength at said antinodes of said electromagnetic standing wave, said vicinity represents a distance of at most 0.07 times said wavelength measured from said plane, while

- by the electromagnetic field of the standing wave the particle beam is forced to travel along an undulating path and thereby, upon undulator effect of the electromagnetic field, in the form of radiation emitted by said particle beam, electromagnetic radiation that propagates in the propagation direction of the particle beam is generated."

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the second and

third sub-paragraphs of the claim are replaced by the following two sub-paragraphs:

"- by interfering said pulses (7; 7a, 7b) with one another an electromagnetic standing wave with antinodal plane is created, said standing wave having an electric field strength of a pre-determined peak value at the antinodal plane;

- said particle beam is directed through the non-steady electromagnetic field of the standing wave in or in the vicinity of the antinodal plane of said electromagnetic standing wave, said vicinity represents a distance of at most 0.07 times said wavelength measured from said plane, while".

Claim 1 of the second auxiliary request differs from claim 1 of the main request in that the second to fourth sub-paragraphs are replaced by the following three sub-paragraphs:

"- by interfering said pulses (7; 7a, 7b) with one another along a first direction (y) an electromagnetic standing wave is created, said standing wave having an electric field strength of a pre-determined peak value in a first plane (xz) perpendicular to the first direction (y);

- said particle beam is directed through the non-steady electromagnetic field of the standing wave in or in the vicinity of the first plane (xz), said vicinity represents a distance of at most 0.07 times said wavelength measured from said plane along the first direction (y), while

- by the electromagnetic field of the standing wave the particle beam is forced to travel in a second direction (z) essentially parallel with said first plane (xz) along an undulating path and thereby, upon

undulator effect of the electromagnetic field, in the form of radiation emitted by said particle beam, electromagnetic radiation that propagates in the propagation direction of the particle beam is generated."

Claim 1 of the third auxiliary request is identical to claim 1 of the first auxiliary request.

Claim 1 of the fourth auxiliary request differs from claim 1 of the first auxiliary request in that the term "while" at the end of the third sub-paragraph is replaced by the term "wherein", and the following sub-paragraph is inserted between the third and the last sub-paragraphs:

"in the step of directing said particle beam through the non-steady electromagnetic field of the standing wave in or in the vicinity of the antinodal plane of said electromagnetic standing wave, the relative position of the particle beam and said standing wave is fine tuned by means of delaying the pulses (7a, 7b) relative to one another so as to the particle beam propagate in or in the vicinity of the antinodal plane, while".

Claim 1 of the fifth auxiliary request is identical to claim 1 of the fourth auxiliary request.

### **Reasons for the Decision**

1. The appeal is admissible.

2. *Main request - Article 84 EPC*

2.1 The claims of the main request correspond to the claims of the main request underlying the decision under appeal. In its decision the examining division held that claim 1 of the main request did not satisfy the requirements of Article 84 EPC essentially because

- the feature of claim 1 reading "a plane spanned by the maximal electric field strength at said antinodes of said electromagnetic standing wave" was ambiguous in that the plane could be identified with an antinodal plane (i.e. a plane parallel to the plane XZ in Fig. 3 of the application and containing antinodes), but also with a plane spanned between antinodes belonging to different antinodal planes (i.e. a plane parallel to plane XY in Fig. 3 of the application), and

- as a consequence, the feature of claim 1 reading "said particle beam is directed [...] in or in the vicinity of" the plane mentioned above could be interpreted in the sense that the particle beam would travel in a direction perpendicular (Z-direction in Fig. 3) or, alternatively, in a direction parallel (Y-direction in Fig. 3) to the electromagnetic pulses, in contradiction with the description according to which the particle beam was specifically directed in a direction perpendicular to the direction of propagation of the electromagnetic pulses (see direction 5 in Fig. 1 and 3 and the corresponding description, in particular the sentence bridging pages 9 and 10).

2.2 In the statement of grounds of appeal the appellant referred to decisions T 372/90 (erroneously cited by the appellant as T 32/90) and T 1321/04 and submitted that it was established case law to refer to the description and the figures to interpret a feature of a claim, and submitted by reference to different passages



of the description (page 5, line 25, to page 6, line 2; the sentence bridging pages 7 and 8; page 8, lines 6 to 13, and lines 22 to 29; and description of Fig. 3) that the skilled person would understand from the description that the plane mentioned in claim 1 was the XZ-plane represented in Fig. 1 and 3 of the application and that, consequently, the direction of propagation of the particle beam was also in the XZ-plane, i.e. that the beam did not travel in the Y-direction, but in the Z-direction represented in Fig. 3 and 4.

The board, however, cannot follow the appellant's submissions in this respect. As held by the examining division in its decision, the claimed feature relating to the definition of the plane is ambiguous - thus rendering unclear what plane is actually referred to (Article 84 EPC) - and, in addition, as a consequence of this lack of clarity, the direction of propagation of the particle beam can be interpreted as being different from that disclosed in the description of the application - with the consequence that the claim is not supported by the description within the meaning of Article 84 EPC. In addition, these two objections cannot simply be ignored by remitting the skilled reader of the claim to the disclosure of the invention in the description. It is noted in this respect that according to the established case law the claims must be clear within the meaning of Article 84 EPC in themselves when read by the skilled person, independently of the description. The mere fact that in specific situations - for instance, in the assessment in opposition proceedings of an ambiguous or self-contradictory granted claim - an unclear claim might be interpreted under consideration of the description is not a reason that would justify during examination proceedings disregarding the requirements of Article 84

EPC that the claims must be clear and supported by the description.

In addition, the decisions cited by the appellant in support of their submissions are not pertinent for the following reasons:

- According to decision T 1321/04 (point 2.3, third paragraph) "the description and the drawings are used to interpret a claim when an objective assessment of its content has to be made". In its context, however, the decision referred to "the meaning of the terms used in a patent document" (see statement "Terms used in patent documents should be given their normal meaning in the relevant art, unless the description gives the terms a special meaning." in point 2.2 of the reasons), and in particular to the interpretation of the term "predetermined value" (reasons, point 2.1 to 2.3), and not to the linguistic formulation of a feature of a claim. In the present case, the formulation of the feature "a plane spanned by the maximal electric field strength at said antinodes of said electromagnetic standing wave" is, as already noted above, ambiguous as to the plane being defined by the mentioned formulation, and this ambiguity does not result from the interpretation of the different terms used in the formulation of the feature, but from the formulation of the feature itself.

- The statements in decision T 372/90 cited by the appellant (point 2.2 of the reasons, second paragraph) relate only to the parts of the application as filed relevant in the assessment of amendments under Article 123(2) or Article 100(c) EPC, and they are silent as to the assessment of a claim under Article 84 EPC.

2.3 During the oral proceedings before the board the appellant also submitted that it belonged to the common general knowledge of the skilled person working in this technical field that a standing wave as claimed comprised maxima at antinodes along antinode lines (Fig. 3 and 4 of the application) and therefore antinode planes each associated with a respective antinode line. Therefore, the skilled person would understand that the plane defined in claim 1 corresponded to an antinode plane (plane XZ in Fig. 3 and 4) and that the remaining planes, in particular the plane XY represented in Fig. 3 and 4, were, contrary to the examining division's opinion, not antinode planes because they also included points, in particular nodes, that were not antinodes.

The board notes, however, that the plane referred to in claim 1 is defined as "a plane spanned by the maximal electric field strength at said antinodes", and that this plane can be identified with a plane parallel to the plane XZ in Fig. 3 and 4 and containing a line of antinodes, but the formulation of the claim does not exclude identifying this plane with other planes, and in particular with a plane parallel to the plane XY in Fig. 3 and 4 and containing antinodes of different antinode lines because also this plane is "spanned by" the electric field strength at antinodes as claimed. Therefore, it is not clear in claim 1 which plane is actually defined and therefore, as also held by the examining division in its decision, it is also not clear in the claim whether the particle beam travels in a direction perpendicular (Z-direction in Fig. 3) or in a direction parallel (Y-direction in Fig. 3) to the electromagnetic pulses, in contradiction with the description according to which the particle beam is specifically directed in a direction perpendicular to

the direction of propagation of the electromagnetic pulses (see Fig. 3 and 4). Therefore, in the board's view also the appellant's submissions in this respect are not persuasive.

2.4 In view of the above considerations the board concludes that claim 1 of the main request does not satisfy the requirements of Article 84 EPC.

3. *First auxiliary request - Admittance*

3.1 The claims of the first auxiliary request correspond to the claims of the first auxiliary request underlying the decision under appeal. In its decision the examining division, in the exercise of its discretion under Rule 137(3) together with Rule 116(1) EPC, did not admit this request into the proceedings. In particular, the examining division noted during the oral proceedings in respect of amendments that were filed late that they would have to remedy the objections *prima facie* (minutes, page 2, second paragraph), and in its decision the examining division gave reasons why the amendments of claim 1 of the first auxiliary request did not comply with Article 123(2) EPC.

The appellant contested the way the examining division exercised its discretion in several respects.

3.2 The appellant submitted during the oral proceedings before the board that, in reply to the communication dated 11 April 2018 annexed to the summons to the first-instance oral proceedings scheduled for 11 December 2018 and in which the examining division gave a preliminary opinion of the case, they filed amended claims with their letter dated 11 October 2018

in time, i.e. before the date of 9 November 2018 indicated in the summons as final date for making written submissions and/or amendments according to Rule 116 EPC. Subsequently, the appellant tried several times to contact the first examiner by telephone and, when they finally reached the first examiner on 8 November 2018, i.e. one day before the mentioned time limit under Rule 116 EPC, the first examiner gave a second preliminary opinion (see results of the consultation dated 12 November 2018). The appellant then filed new amended claims with the letter dated 7 December 2018 in reply to this second preliminary opinion, and during the first-instance oral proceedings dated 11 December 2018 they filed further amended claims. During this time, and due to personal circumstances (death of the representative's father at the end of October 2018), the appellant was not in a position to appropriately prepare the case, but refrained from asking for a postponement of the oral proceedings. None of these special circumstances was considered by the examining division when exercising its discretion in the admission of the new requests, and this was contrary to procedural fairness. In addition, the composition of the examining division was changed between the time of the telephone consultation of 8 November 2018 and the oral proceedings held on 11 December 2018 by replacement of two of its members, and in particular by replacement of the first examiner, and this fact was to be taken into account when assessing the way the examining division exercised its discretion during the oral proceedings in view of the relevance of the scientific knowledge for the substantive assessment of the case.

- 3.2.1 The board first notes that the appellant has had the opportunity to file amended claims before the time

limit indicated in the summons under Rule 116 EPC, as they actually did by filing with the letter dated 11 October 2018, among other claims, the claims of the then first auxiliary request and now main request. The appellant subsequently filed amended claims according to a second auxiliary request - and now third auxiliary request - in writing on 7 December 2018 in reply to the telephone consultation of 8 November 2018 with the then first examiner and, during the first-instance oral proceedings, further amended claims according to a new first auxiliary request - i.e. the present first auxiliary request - and a fourth auxiliary request - and now second auxiliary request. Therefore, the requests filed with the letter dated 7 December 2018 and the requests filed during the oral proceedings were filed after the date of 9 November 2018 specified under Rule 116 EPC in the summons as time limit for making written submissions and/or amendments and, therefore, all these requests were late filed. The board notes in this respect that, contrary to what the appellant's submissions appear to suggest, the telephone consultation maintained by the then first examiner with the appellant's representative did not trigger a new time limit for filing new submissions or new amended claims before or during the oral proceedings - let alone entitle the appellant to file amended claims in the same conditions as they are entitled within the period provided in Rule 116 EPC. Therefore, the requests filed with the letter dated 7 December 2018 and during the oral proceedings were late filed and their admission into the proceedings was at the examining division's discretion.

Furthermore, the substantive issues addressed in the telephone consultation and during the oral proceedings emphasised the objection of lack of clarity under

Article 84 EPC already raised in the communication annexed to the summons and relating to the plane defined in claim 1, and the board is unable to identify in the telephone consultation and in the minutes of the oral proceedings any new specific substantive issue - and the appellant has indicated none - that would have justified filing, in reaction thereto, new amended claims and a possible admission of the same.

In addition, the appellant had ample time between the summons and the expiry of the time limit under Rule 116 EPC to prepare their case before the oral proceedings - as they actually did, see the letter dated 11 October 2018 and the claims submitted therewith -, and if the appellant wanted to dispose of more time for a further preparation of the case under consideration of the telephone consultation with the then first examiner they could, in view of the personal circumstances in which the representative found himself at that time, have requested a postponement of the oral proceedings, but they opted for not doing so.

As regards the change of composition of the examining division before the oral proceedings, the board notes that during the oral proceedings the examining division in its new composition maintained in substance the preliminary opinion of the examining division in the previous composition, and that the appellant has identified no specific circumstance relating to the substantive assessment of the case with which they might have been confronted as a consequence of the change of composition of the examining division. Therefore, the board sees in the circumstances of the case no reason to conclude that the change of composition of the examining division before the oral proceedings would have resulted in an unfair procedure

or in a procedural deficiency that would have had an impact on the way the examining division exercised its discretion when considering the issue of the admission of the late filed requests into the proceedings.

3.2.2 In view of all these considerations, and as regards the examining division's decision not to admit into the proceedings the first auxiliary request under consideration, i.e. the first auxiliary request submitted during the first-instance oral proceedings, the board does not see in the different appellant's submissions any reason that would justify the conclusion that the examining division exercised its discretion under Rule 137(3) together with Rule 116(1) EPC in an unfair or procedurally incorrect way.

3.3 The appellant also submitted that the reasons given by the examining division in its decision in support of its view that claim 1 of the first auxiliary request did not comply with Article 123(2) EPC were lengthy and were addressed in much more detail than done during the oral proceedings, and that the mentioned reasons went beyond the discussion on the *prima facie* assessment that took place during the oral proceedings.

The board notes, however, that the compliance of the claims of the first auxiliary request with the requirements of Article 123(2) EPC was extensively discussed during the oral proceedings (see minutes, passage on page 1, line 23, to page 2, line 9, where the main request mentioned in this passage became at the end of the oral proceedings the first auxiliary request underlying the decision under appeal, see minutes, page 1, lines 21 and 22, together with page 4, lines 11 to 13). In addition, the appellant has not identified any specific substantive issue addressed in



the reasons given by the examining division in the decision under appeal that was not previously addressed during the oral proceedings.

As regards the appellant's submissions that the corresponding reasons given in the decision were lengthy and were exposed in more detail than done during the oral proceedings, the board notes that during the oral proceedings the appellant referred to a definition in a textbook submitted with the letter dated 7 December 2018 (minutes, page 1, lines 23 to 26), to several passages of the description and to Fig. 3 of the application, and also to the common general knowledge (minutes, page 2, lines 1 to 6), and that the examining division gave in its decision reasons as to why the appellant's submissions in this respect were not persuasive. In view of the number of submissions made by the appellant, and of the need to justify why they were not persuasive on a *prima facie* basis, the examining division could not summarily reject all of them, and it was unavoidable in the circumstances of the case that, in order to sufficiently substantiate why the amendments did not *prima facie* comply with Article 123(2) EPC, the reasons required some length and that the specific reasons required some degree of detail. In any case, in the board's opinion the length of the reasons depends on the specific circumstances of the case and does not constitute *per se* a criterion for evaluating whether or not a reasoning in support of a *prima facie* assessment is appropriate, and the degree of detail of the reasons given by the examining division in its decision was in the board's opinion reasonable and, in any case, it did not exceed what is expected from, and required in, an appropriate and sufficient substantiation of a *prima facie* assessment.

3.4 In the statement of grounds of appeal the appellant also contested the substantive arguments given by the examining division to justify the non-admission of the first auxiliary request into the proceedings and relating to the requirements of Article 123(2) EPC and referred in particular to their submissions filed during the first-instance proceedings with the letter dated 7 December 2018 and relating to the then second auxiliary request, and also to the fact that the assessment under Article 123(2) EPC was to be carried out under consideration of the common general knowledge of the skilled person.

However, the mere reference by the appellant to substantive arguments already presented during the first-instance proceedings and to the common general knowledge are not sufficient to contest the way the examining division exercised its discretion because the examining division already took into account the mentioned substantive arguments of the appellant and the common general knowledge referred to by the appellant.

3.5 In view of the above considerations, the board does not see in the different appellant's submissions any justification for concluding that the examining division exercised its discretion under Rule 137(3) together with Rule 116(1) EPC in not admitting the claims of the first auxiliary request into the proceedings in an unfair or procedurally incorrect way, or applying wrong principles, or without taking into account the right principles, or in an unreasonable way. Therefore, the board sees no reason to overturn the examining division's decision in this respect.

According to Article 12(4) RPBA 2007 (which applies in the present case according to Article 25(2) RPBA 2020) it is within "the power of the Board to hold inadmissible [...] requests which [...] were not admitted in the first instance proceedings". The board sees in the circumstances of the case no reason either that would justify exercising its own discretion under Article 12(4) RPBA 2007 to admit the mentioned claims into the appeal proceedings.

The board concludes that the first auxiliary request is not admitted into the proceedings.

4. *Second auxiliary request - Admittance*

4.1 The claims of the second auxiliary request correspond to the claims of the fourth auxiliary request underlying the decision under appeal, and in its decision the examining division, in the exercise of its discretion under Rule 137(3) together with Rule 116(1) EPC, did not admit this request into the proceedings. The examining division referred in this respect to the non-compliance of the claims of this request with the requirements of Articles 123(2) and 54(2) EPC.

4.2 During the oral proceedings before the board the appellant referred to the submissions previously presented in respect of the first auxiliary request and summarised in point 3.2 above and in the first paragraph of point 3.3 above, and emphasised that the reasons given by the examining division in its decision were based on a lengthy argumentation and that if such a lengthy argumentation was required to prove *prima facie* non-compliance, it could not be seen as a *prima facie* assessment.

The board first notes that the claims of the present second auxiliary request were submitted as fourth auxiliary request during the oral proceedings (*cf.* point 3.2.1 above, first paragraph) and that, as regards the appellant's submissions relating to the first auxiliary request and applicable to the second auxiliary request, analogous considerations to those noted by the board in point 3 above also apply to the second auxiliary request. In particular, the issue of the compliance of the claims of the second auxiliary request with Article 123(2) EPC was also discussed during the oral proceedings (see minutes, page 3, last four lines, where the third auxiliary request mentioned in this passage became at the end of the oral proceedings the fourth auxiliary request underlying the decision under appeal, see page 2, lines 20 to 23, and page 4, lines 11 to 13, of the minutes), and the appellant has not identified any specific issue addressed in the reasons given by the examining division in the decision under appeal that was not previously addressed during the oral proceedings.

As regards the appellant's submissions that the argumentation presented by the examining division in the decision under appeal was too lengthy to be considered a *prima facie* assessment, the board first notes that the reasons given by the examining division in the decision in respect of the issue of the compliance with Article 123(2) EPC (see decision under appeal, reasons, points 20.1.2 and 20.1.3) refers to the parts of the application as originally filed cited by the appellant during the oral proceedings and explains why in the examining division's opinion the appellant's submissions were not persuasive. In addition, analogous considerations to those already

presented in point 3.3 above, third paragraph, apply to the appellant's submissions in this respect.

- 4.3 In view of these considerations, and for reasons analogous to those given in point 3 above in respect of the first auxiliary request, the board sees no circumstance that would justify overturning the examining division's decision in respect of the non-admission of the second auxiliary request into the proceedings or that would justify the board exercising its own discretion under Article 12(4) RPBA 2007 in the sense of admitting this request into the appeal proceedings.

The board concludes that the second auxiliary request is not admitted into the proceedings.

5. *Third auxiliary request - Admittance*

- 5.1 During the oral proceedings the appellant confirmed that the second auxiliary request filed with the letter dated 7 December 2018 and referred to by the appellant in the statement of grounds of appeal (see point III above, second paragraph) was maintained in appeal as a third auxiliary request. The claims of the third auxiliary request correspond to the claims of the second auxiliary request underlying the decision under appeal, and in its decision the examining division, in the exercise of its discretion under Rule 137(3) together with Rule 116(1) EPC, did not admit this request into the proceedings. In its decision the examining division noted that claim 1 of this request was identical to claim 1 of the first auxiliary request, so that the claim contained the same deficiencies as claim 1 of the first auxiliary request

and, therefore, it did not *prima facie* comply with Article 123(2) EPC.

5.2 The board notes that, since claim 1 of the third auxiliary request is identical to claim 1 of the first auxiliary request, there is no circumstance that would justify the admission of the third auxiliary request into the proceedings for the same reasons given in point 3 above in respect of the first auxiliary request.

The appellant submitted that, contrary to the first auxiliary request which was submitted during the first-instance oral proceedings, the third auxiliary request was submitted on 7 December 2018, i.e. four days before the oral proceedings, and that this request was submitted in reaction to the preliminary opinion given by the then first examiner in the telephone consultation of 8 November 2018. In addition, the appellant emphasised that the circumstances already noted in point 3.2 above, and in particular the difficulties in reaching the first examiner by telephone and the personal situation in which the representative found himself, constituted special circumstances that should be taken into account by the board when exercising its discretion in the admission of the request into the proceedings.

However, as already noted in the first paragraph of point 3.2.1 above, the request under consideration was submitted after the time limit fixed under Rule 116 EPC and was therefore late filed, and the mere fact that this request was - contrary to the first auxiliary request - already filed before the first-instance oral proceedings does not justify in the present circumstances a different treatment for the third

auxiliary request than for the first auxiliary request. In addition, none of the specific circumstances mentioned by the appellant would justify the admission of the third auxiliary request into the appeal proceedings for the reasons already given in point 3.2.1 above in respect of the first auxiliary request.

5.3 The board concludes that the third auxiliary request is not admitted into the proceedings for the same reasons given in point 3 above in respect of the first auxiliary request.

6. *Fourth and fifth auxiliary requests - Admittance*

6.1 The claims of the fourth and fifth auxiliary requests were submitted during the oral proceedings before the board.

According to Article 13(2) RPBA 2020 (which applies in the present case according to Article 25 RPBA 2020) "[a]ny amendment to a party's appeal case made [...] after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned".

6.2 The appellant referred to the fact that the examining division did not admit several requests submitted during the first-instance proceedings and to the different circumstances already mentioned in respect of the admission of the present first to third auxiliary requests and noted in point 3.2 above.

However, all these submissions relate to the first-instance proceedings, and not to circumstances arising during the present appeal proceedings before or during

the oral proceedings before the board, and therefore they do not justify filing the present fourth and fifth auxiliary requests at a late stage of the oral proceedings before the board. In particular, the board does not see in the preliminary assessment of the case presented in the communication annexed to the summons or in the course of the oral proceedings before the board any new issue that would have justified filing new amended claims in reaction thereto, let alone at such a late stage of the appeal proceedings.

- 6.2.1 The appellant also referred to the merits of the claimed invention for which a patent was already granted in USA. These submissions, however, are not pertinent for the question of the admission of the fourth and the fifth auxiliary requests under Article 13(2) RPBA 2020.
- 6.2.2 Therefore, the board is unable to see any exceptional circumstance within the meaning of Article 13(2) RPBA 2020 that would justify taking into account the fourth and the fifth auxiliary requests in the present appeal proceedings. Therefore, these two auxiliary requests are not taken into account (Article 13(2) RPBA 2020).
7. In the absence of an admissible and allowable request, the board concludes that the appeal is to be dismissed.

## **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.



The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated