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**Datasheet for the decision
of 29 February 2024**

Case Number: T 0321/21 - 3.2.02

Application Number: 06789408.9

Publication Number: 1912582

IPC: A61B17/88, A61B17/34, A61B17/70

Language of the proceedings: EN

Title of invention:
SYSTEM FOR SPINAL IMPLANT PLACEMENT

Patent Proprietor:
Stryker European Holdings I, LLC

Opponent:
Roth, Sebastian

Headword:

Relevant legal provisions:
EPC Art. 123(2), 123(3)
RPBA 2020 Art. 12(3), 12(5), 13(1), 13(2)

Keyword:

Substantiation requirement - general applicability
Amendment after notification of a communication under Article
15(1) RPBA - exceptional circumstances (no)
Amendments - extension beyond the content of the application
as filed (no) - broadening of claim (no)

Decisions cited:

G 0002/88, T 0547/08, T 1732/10, T 2288/12, T 1784/14,
T 0574/17, T 0970/17, T 1776/18, T 2117/18, T 0449/20,
T 1128/21, T 1800/21, T 2013/21

Catchword:



Beschwerdekammern

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Case Number: T 0321/21 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 29 February 2024

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
2 February 2021 concerning maintenance of the
European Patent No. 1912582 in amended form.**

Composition of the Board:

Chair M. Alvazzi Delfrate
Members: A. Martinez Möller
N. Obrovski

Summary of Facts and Submissions

I. Appeals were filed by the patent proprietor and by the opponent against the interlocutory decision of the opposition division finding that auxiliary request 3 filed during the oral proceedings before the opposition division met the requirements of the EPC.

II. Oral proceedings before the board took place on 29 February 2024. At the oral proceedings, the patent proprietor withdrew its appeal. At the end of the oral proceedings the requests were as follows:

The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the patent be maintained on the basis of the 14th auxiliary request filed by letter dated 22 December 2023 or, in the alternative, on the basis of one of the 15th to 19th auxiliary requests filed with the same letter.

III. Claim 1 of the 14th auxiliary request reads as follows:

"A system for providing access to a spine of a patient, the system comprising:
a connecting element (140) implantable in a first vertebra (24) of the spine (10), the connecting element (140) having a cage (152) configured to be coupled to a pedicle screw (150); and
a cannula (142) comprising a distal end (192) and a proximal end (190), the distal end being securable to the cage of the connecting element (140),

wherein the proximal end (190) of the cannula (142) is adapted to extend out of the body of the patient through an incision in the skin when the distal end (192) is secured to the connecting element (140) implanted in the first vertebra (24) of the spine (10), the system comprising

- a first blade (194) and
- a second blade (196)

the system being characterized in that the second blade (196) is discrete from the first blade, wherein the first and second blades are positionable substantially parallel to each other and spaced apart from each other to provide the cannula (142), the cannula (142) having first and second slots (220) extending along its entire longitudinal length along opposite sides of the cannula (142), the first and second slots (220) extending to the cage (152) and being contiguous with recesses defined between arms (172) of the cage (152) to permit passage of a rod (146) through the first and second slots (220) of the cannula (142) along a direction transverse to a central axis of the cannula and into a trough of the cage (152), and

wherein the distal end (200) of each of the blades (194, 196) has a docking element (204) discrete from and securable to the connecting element (140), such that the first and second blades (194, 196) are independently securable to and independently removable from the connecting element."

IV. The following documents are relevant to the present decision:

- D1 US 2003/0149438 A1
- D2 US 2005/0065517 A1
- D3 US 2004/0138662 A1

V. The appellant's arguments relevant to the present decision can be summarised as follows.

Admittance of the 14th auxiliary request

According to Article 13(2) RPBA, the 14th auxiliary request should not be admitted.

Article 123(2) EPC - added subject-matter

Claim 1 comprised added subject-matter. The embodiment of Figures 7 and 8 only disclosed the feature "spaced apart from each other" together with other features, the omission of which resulted in added subject-matter. In that embodiment, the blades comprised distal tabs which were introduced through corresponding slots of the cage of the connecting element. Upon being placed in a locked configuration, the blades were secured parallel to each other and spaced apart from each other by an abutment member. All these features had been omitted in claim 1.

Paragraph [0101] disclosed that docking elements other than the distal tabs could be used. This paragraph followed paragraph [0100], which referred to different cannulas. It was not disclosed how a system with differently designed cannulas and/or differently designed docking elements could be implemented and whether the blades would be spaced apart from each other in such a system. The only system which was properly disclosed used distal tabs.

In the original claim 1 and in the embodiment of Figures 7 and 8, each of the blades was movable with a specific rotational movement between a locked and an

unlocked configuration. Different locking elements or different mechanisms were not disclosed in an enabling manner. Hence the omission of the locked/unlocked configurations and of the specific rotational movement also resulted in added subject-matter, as did the generalisation by the feature "such that the first and second blades are independently securable to and independently removable from the connecting element".

A stable arrangement of the blades to form the cannula could only be achieved if the abutment member was present, as otherwise the surrounding tissue would press the blades inwards and proper functioning of the system would not be able to be ensured. The application as filed did not present the abutment member as optional but as essential, so its omission was not justified.

Moreover, the feature "securable to the cage of the connecting element" was disclosed only for the cannula upon assembly, in the locked configuration and with an abutment member.

The original claims and description of the invention did not include the connecting element within the scope of protection. Addition of the connecting element shifted the subject-matter to an *aliud*.

Article 123(3) EPC - extension of scope of protection

The addition of the connecting element resulted in an extension of the scope of protection because a connecting element could now result in contributory patent infringement in many Contracting States.

Admittance of objections of lack of clarity

Claims 10 and 11 were not clear because the system did not comprise second and third connecting elements. There were no exceptional circumstances for filing the objection at such a late stage, but it might be in the interest of the respondent to address the clarity issue.

Admittance of objections of lack of novelty and lack of inventive step

The subject-matter of claim 1 of the 14th auxiliary request was neither novel nor inventive. As for the substantiation of these objections, reference was made to objections of lack of novelty and lack of inventive step in the written submission dated 23 December 2021 against claim 1 of the 9th auxiliary request, the objections in turn referring to the previous objections against claim 1 of the main request. The slots in claim 1 were also present in each of D1, D2 and D3.

- VI. The respondent's arguments relevant to the present decision can be summarised as follows.

Admittance of the 14th auxiliary request

The 14th auxiliary request corresponded to the previously filed 9th auxiliary request with the deletion of several dependent claims. It did not add to the complexity of the proceedings.

Added subject-matter

Claim 1 did not comprise added subject-matter.

According to paragraph [0101] of the application as filed, different docking elements could be used in place of the distal tabs employed in the embodiments of Figures 7 and 8. The docking elements listed in that paragraph were commonly-understood concepts in the art which did not require further disclosure. Hence it was directly and unambiguously derivable that distal tabs were only one example and that their omission was allowable.

Use of different docking elements such as threaded engagement would not result in blades movable with the specific rotational movement of the original claim 1 between locked and unlocked configurations. Hence paragraph [0101] provided a basis for using other docking elements without those features. Using other docking elements with a different movement to secure the blades would not impact the whole system and require a different construction.

According to the application as filed, the abutment member helped to hold the cannula. The blades were secured to the connecting element and formed the cannula without the abutment member. The cannula's stability without the abutment member was irrelevant for assessing whether claim 1 comprised added subject-matter.

The feature "securable to the cage of the connecting element" had a basis in paragraph [0056].

Admittance of objections of lack of clarity

The late-filed objections should not be admitted because there were no exceptional circumstances.

Admittance of objections of lack of novelty and lack of inventive step

Objections of lack of novelty and lack of inventive step had not been substantiated and should not be admitted.

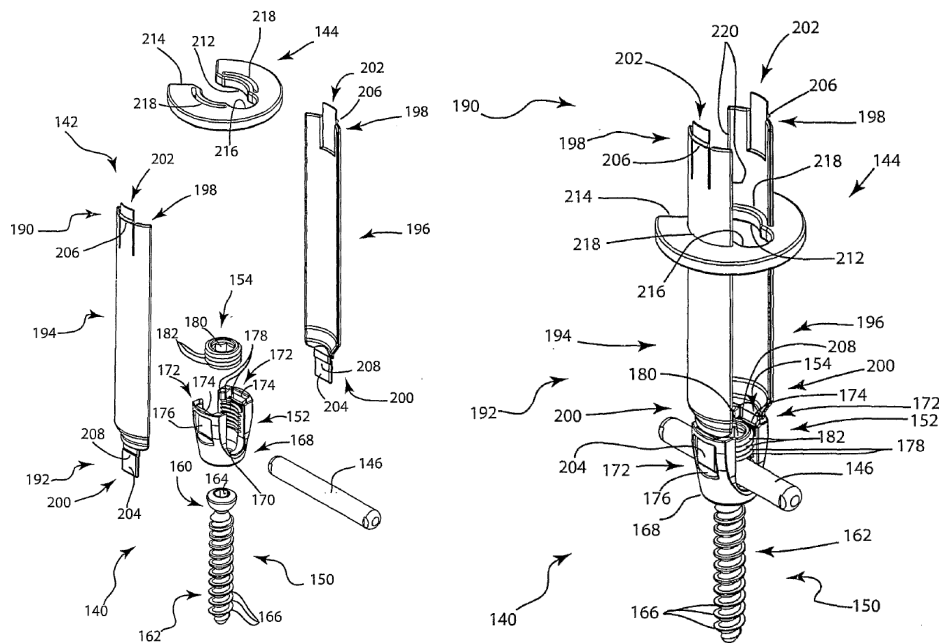
Reasons for the Decision

1. The patent

- 1.1 Many people suffer from back pain related to spinal pathologies. Some such pathologies are treated by fusing two or more adjacent vertebrae to prevent their relative motion. According to a known method for fusing adjacent vertebrae, pedicle screws are implanted in the pedicles and are rigidly secured to a rod.

- 1.2 The patent deals with fusion rod implantation systems. Claim 1 of the patent as granted is directed to a system for providing access to the spine of a patient. The system comprises two blades which are used to provide a cannula, the distal end of which is securable to a connecting element implantable in a vertebra (e.g. an element including a pedicle screw). The blades are positionable substantially parallel to each other and spaced apart from each other to provide the cannula. The distal end of each of the blades has a docking element discrete from and securable to the connecting element, such that the blades are independently securable to and independently removable from the connecting element.

1.3 Figures 7 and 8 of the specification reproduced below show an exploded view and an assembled view with a cannula 142, an abutment member 144, a connecting element 140 and a rod portion 146. The blades forming the cannula are shown with reference signs 194 and 196. Each blade comprises a distal tab 204 which is insertable through a respective slot 174 of a cage 152 of the connecting element 140.



1.4 Once the cannula is provided, various tools can be inserted into it, for example to implant a connecting element in a vertebra or, once several connecting elements have been implanted in adjacent vertebrae, to insert, seat and secure a rod in the connecting elements to fuse those vertebrae (see Figures 10 to 21). When the spinal fusion system is fully assembled with the rod preventing relative motion of the vertebrae, access is no longer required and the blades may be removed (see Figures 22 and 23 and paragraphs [0095]-[0099]).

2. Admittance of the 14th auxiliary request

2.1 The 14th auxiliary request, which was filed after notification of a communication under Article 15(1) RPBA, constitutes an amendment to the respondent's appeal case. Under Article 13(2) RPBA, it must, in principle, not be taken into account unless there are exceptional circumstances justified with cogent reasons by the respondent.

2.2 As the bar for admitting an amendment under Article 13(2) RPBA is higher than that under Article 13(1) RPBA, Article 13(2) RPBA is a *lex specialis* in relation to Article 13(1) RPBA, and the direct application of the latter should be limited to the second level of the convergent approach. Having said this, according to established case law it is possible to rely on the criteria referred to in Article 13(1) RPBA when applying Article 13(2) RPBA. Relying on these criteria is part of the Board's exercise of discretion under Article 13(2) RPBA (see T 574/17, Reasons 2.3.1; see also T 719/22, Reasons 3.2, with further references).

While there is no obligation for a Board to use the criteria set out in Article 13(1) RPBA when deciding whether to admit an amendment under Article 13(2) RPBA, applying the criteria set out in Article 13(1) RPBA may not only lead to the conclusion that the amendment in question is *not* admitted under Article 13(2) RPBA, but also to the conclusion that *is* admitted under Article 13(2) RPBA (as to the deletion of claims see, for example, T 1800/21, Reasons 3.4.7 and 3.4.8).

2.3 In the present case, the 14th auxiliary request corresponds to the - eventually withdrawn - 9th auxiliary request, the admittance of which was not disputed by the opponent, except for the deletion of the dependent claims objected to by the appellant in his reply to the proprietor's statement of grounds of appeal. It is immediately apparent that the 14th auxiliary request *prima facie* overcomes the objections to the dependent claims without giving rise to new objections. Its admittance is not detrimental to procedural economy either. Moreover, the request was filed without undue delay after notification of the Board's communication, thereby allowing the Board and the appellant sufficient time to familiarise themselves with it prior to the oral proceedings. Finally, although the appellant had formally objected to the admittance of the 14th auxiliary request, he - also during the oral proceedings before the Board - refrained from providing any arguments in support of this objection.

2.4 For the reasons set out above, the Board decided to admit the 14th auxiliary request into the proceedings.

3. Article 123(2) EPC - added subject-matter

3.1 Claim 1 of the 14th auxiliary request comprises several amendments as compared with claim 1 as originally filed. One of the amendments is the addition of "the first and second blades are ... spaced apart from each other". It is disputed whether this amendment, which is based on the embodiment of Figures 7 and 8, results in added subject-matter.

3.2 Omission of the feature "distal tabs"

3.2.1 In the embodiment of Figures 7 and 8, the distal end of each of the blades has a docking element in the form of a distal tab 204 that is insertable through the respective slot 174 of the cage of the connecting element (see paragraph [0058] of the application as filed). The first sentence of paragraph [0101] of the application as filed discloses that "*[a] variety of different docking elements may be used in place of the distal tabs 204 and the slots 174*".

3.2.2 The appellant argued that this sentence could not be used as a basis for omitting the distal tabs because it should be read together with the last two sentences of paragraph [0100], which refer to different cannulas, because it was not meant to provide an alternative to the particular construction in Figures 7 and 8, and because using a different docking mechanism would require further changes to the whole construction.

3.2.3 Paragraphs [0100] to [0102] disclose alternatives that may be used in place of the components illustrated in Figures 1 to 23 (see first sentence of paragraph [0100]). The paragraphs indicate alternatives for individual components/elements of the figures such as the connecting elements, cannulas, docking elements and locking mechanisms. Nothing in these paragraphs suggests any link between the last two sentences of paragraph [0100], which refer to alternative cannulas, and the first two sentences of paragraph [0101], which refer to alternative docking elements. Moreover, the alternative docking elements listed in paragraph [0101] (such as threaded engagement, collets and interference fit couplings) are well-known fastening mechanisms which do not imply or require any further changes to

the entire construction, let alone a modification of the spaced-apart condition of the blades as shown in Figures 7 and 8.

3.2.4 The reference signs 204 and 174 in the sentence of paragraph [0101] quoted above correspond to the distal tabs and slots of Figures 7 and 8. The sentence is thus unmistakably indicating that other docking elements may be used in that embodiment.

3.2.5 It follows that a basis is provided in the first two sentences of paragraph [0101] for generalising the distal tabs of Figures 7 and 8 to docking elements as defined in claim 1 of the 14th auxiliary request.

3.3 Omission of the features relating to the locked/unlocked configuration

3.3.1 The following features are part of claim 1 as originally filed and are absent in claim 1 of the 14th auxiliary request:

"each of the first and second blades comprising a locked configuration when positioned relative to the connecting element to provide the first cannula [sic], in which the blade is secured to the connecting element by the docking element, and an unlocked configuration, in which the blade is removable from the connecting element, wherein each of the first and second blades is movable between the locked and unlocked configurations in response to rotation of the blade about an axis substantially normal to a plane including said central axis"

- 3.3.2 In the embodiment of Figures 7 and 8, with the docking elements implemented as distal tabs, each of the blades is docked to the connecting element by inserting the distal tab through the corresponding slot of the cage and rotating the blade to a position parallel to the axis of the cage (see paragraphs [0058]-[0059] and [0064] of the application as filed). This way of docking/undocking the blades corresponds to the features from claim 1 quoted above.
- 3.3.3 If instead of distal tabs a different docking element from the list of alternatives in paragraph [0101] is used, e.g. threaded engagement or a pin-and-locking-groove system, this does not result in blades with locked and unlocked configurations wherein each blade is movable between the configurations in response to rotation of the blade about an axis normal to a plane including the central axis of the cannula. It is thus clear from the application as filed that the way of docking/undocking specified in the disputed features is only one of several ways of securing and removing each blade from the connecting element. A different docking element would involve a different docking/undocking mechanism and a different movement to secure the blade to and remove it from the connecting element. It is therefore allowable to omit the disputed features.
- 3.3.4 The feature "*such that the first and second blades are independently securable to and independently removable from the connecting element*" reflects the possibility of securing and removing each blade separately. This possibility is present in the embodiment of Figures 7 and 8 and is not linked to the use of distal tabs as docking elements or to the specific docking/undocking mechanism of the disputed features.

3.4 Omission of the abutment member

3.4.1 The system defined by claim 1 as originally filed did not comprise an abutment member, which was only introduced in dependent claim 6. An abutment member is however present in the embodiment of Figures 7 and 8. It is disputed whether it is allowable to incorporate the spaced-apart feature from that embodiment without also incorporating the abutment member.

3.4.2 The appellant submits that the abutment member was presented as essential and that without it the blades would be pushed inwards by the patient's tissue and would not remain spaced apart from each other.

3.4.3 This submission does not correspond to the disclosure in the application as filed. The purpose of the abutment member in the embodiment of Figures 7 and 8 is partly related to the positioning of the blades, but only as an aid to the connecting element in stabilising the cannula (see the last sentence of each of paragraphs [0050] and [0062] of the application as filed). Even without the abutment member, the blades are spaced apart from each other when they are secured to the connecting element (see Figure 22 as well as paragraphs [0058]-[0059], [0064] and the first sentence of paragraph [0095]). There is thus no inextricable link between the spaced-apart feature and the abutment member. It follows that the omission of the abutment member in claim 1 of the 14th auxiliary request does not result in added subject-matter.

3.5 Feature "securable to the cage of the connecting element"

- 3.5.1 The second sentence of paragraph [0056] of the application as filed provides a basis for the distal end of the cannula being securable to the cage of the connecting element. The appellant, referring to the first sentence of paragraph [0056], argues that this was only disclosed for the cannula "[u]pon assembly", in the locked configuration and with the abutment.
- 3.5.2 As set out under point 3.3 above, the locked/unlocked configurations described in connection with the embodiment of Figures 7 and 8 relate to the docking elements implemented as distal tabs. The omission of the locked/unlocked configurations is justified in view of the disclosure of alternative docking elements in paragraph [0101], and the inclusion of the feature that the distal end of the cannula is securable to the cage of the connecting element does not affect this.
- 3.5.3 The abutment member aids in stabilising the cannula but is not inextricably linked to the cannula being securable to the cage of the connecting element because, as set out under point 3.4 above, the blades are secured to the connecting element even when the abutment member is removed.
- 3.5.4 It follows that there is no added subject-matter in connection with the feature "securable to the cage of the connecting element".
- 3.6 Inclusion of the connecting element / *aliud*
- 3.6.1 On page 8 of the appellant's written submission dated 23 December 2021 and entitled "Auf die Eingabe der Patentinhaberin vom 18.10.21", the appellant raised two objections against claim 1 of the 9th auxiliary request, namely one under Article 123(2) EPC and one

under Article 123(3) EPC. Claim 1 of the 14th auxiliary request is identical to claim 1 of the 9th auxiliary request. Hence the Board deems it appropriate to deal with these objections even though the appellant did not refer to them when discussing the objections to claim 1 of the 14th auxiliary request at the oral proceedings.

3.6.2 The appellant submits that the application as filed did not describe a connecting element as part of the invention, so inclusion of the connecting element resulted in the subject-matter being shifted to an *aliud*, which contravened Article 123(2) EPC.

3.6.3 The claims define the matter for which protection is sought (see Article 84 and Rule 43(1) EPC). Amendments to the claims generally change this matter, but contravene Article 123(2) EPC only if they lead to subject-matter which extends beyond the content of the application as filed. A basis for a system comprising a cannula and a connecting element is provided *inter alia* in the embodiment of Figure 7 and paragraph [0050], so including the connecting element does not contravene Article 123(2) EPC.

3.7 In summary, none of the objections under Article 123(2) EPC is convincing.

4. Article 123(3) EPC

4.1 Claim 1 as granted and claim 1 of the 14th auxiliary request are both directed to "[a] system for providing access to a spine of a patient". The amendment by specifying that the system further comprises a connecting element results in a restriction of the claimed system and not in an *aliud*.

4.2 The appellant's submissions concerning a possible contributory patent infringement of a connecting element under national laws are not relevant to the issue of extension of the scope of protection, since the national laws of the Contracting States are not to be considered when deciding whether or not an amendment contravenes Article 123(3) EPC (see G 2/88, Reasons 3.3 and Order, as well as T 970/17, Catchword and Reasons 6.2, and T 547/08, Reasons 3.2).

4.3 It follows that the objection under Article 123(3) EPC is not convincing.

5. Admittance of objections of lack of clarity

5.1 At the oral proceedings before the Board, the appellant raised new objections of lack of clarity against dependent claims 10 and 11. These objections constitute an amendment to the appellant's appeal case.

5.2 Dependent claims 10 and 11 of the 14th auxiliary request correspond to dependent claims 13 and 14 of the 9th auxiliary request, to which the appellant had not raised any clarity objection despite having had the opportunity to do so. The appellant conceded that there were no exceptional circumstances within the meaning of Article 13(2) RPBA, stating that he had noticed the problems of clarity only during the oral proceedings before the Board.

5.3 In view of the absence of exceptional circumstances, the Board did not take the objections of lack of clarity into account under Article 13(2) RPBA.

6. Admittance of objections of lack of novelty and inventive step

- 6.1 At the oral proceedings before the Board, the appellant raised objections of lack of novelty and lack of inventive step against claim 1 of the 14th auxiliary request. He alleged that the slots of claim 1 were disclosed in each of D1, D2 and D3. In reply to the Chair's question whether these objections had already been presented in a substantiated manner before, the appellant stated that substantiation had been provided in writing, namely in the context of claim 1 of the 9th auxiliary request, which was identical to claim 1 of the 14th auxiliary request. The respondent contested that sufficient substantiation had been provided, and requested that these objections not be admitted.
- 6.2 There is a considerable body of case law according to which claim requests and objections must be substantiated to become effective. According to this approach, unsubstantiated claim requests and objections are not considered validly filed and do not form part of the proceedings. An unsubstantiated claim request or objection is considered to become effective, i.e. to have been validly submitted, for the first time when sufficient substantiation is provided (for claim requests, see T 1732/10, Reasons 1.5, T 2288/12, Reasons 3.1, and T 1784/14, Reasons 3.5 and 3.7; for objections, see T 2117/18, Reasons 2.2.17, and T 449/20, Reasons 1.4).
- 6.3 Alternatively, a Board may come to the same conclusion by not admitting an unsubstantiated claim request or objection contained in the statement of grounds of appeal or reply under Article 12(3) and (5) RPBA, and by not admitting a subsequently submitted substantiation for that request or objection under

Article 13(1) or (2) RPBA (see T 2013/21, Reasons 2.4 to 2.6, and T 1128/21, Reasons 2.3.4).

6.4 In the view of the present Board, a lack of substantiation in relation to a certain objection or claim request in the statement of grounds of appeal or in the reply means that the objection or claim request in question was submitted without the required minimum level of explanation, i.e. the level of explanation which allows the Board and, if applicable, the other party or parties to understand why the decision under appeal should be reversed, amended or upheld in view of this objection or claim request. This entails that it must be possible to assess the merits of the claim request or objection in question without undue burden.

6.5 The principle that a party must contribute to the conduct of the proceedings by substantiating its own requests and objections in a minimum way is a general procedural principle underlying the EPC (see T 1776/18, Reasons 4.5.7). In Article 12(3) RPBA, second sentence, this principle is specifically applied to the statement of grounds of appeal and reply, which must set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld. However, the substantiation requirement is not limited to the statement of grounds of appeal and reply and applies in the context of Article 13(1) and (2) RPBA as well. Hence it must also be complied with in regard to claim requests and objections filed after the statement of grounds of appeal and reply. For such claim requests and objections, not only the decision under appeal but also subsequent party submissions in the appeal proceedings and, if applicable, issues raised by the Board *ex officio* provide the context

against which the substantiation requirement must be assessed.

- 6.6 Strictly speaking, Article 12(5) RPBA only provides that the Board has discretion not to admit any part of a submission by a party which does not meet the requirements of Article 12(3) RPBA, without explicitly referring to criteria for the exercise of this discretion. However, in regard to the substantiation requirement the applicable criterion for the exercise of discretion under Article 12(5) RPBA follows directly from Article 12(3) RPBA, second sentence. Accordingly, it must be assessed, in regard to the (part of the) submission concerned, whether the required minimum level of explanation was provided to understand why the decision under appeal should be reversed, amended or upheld in view of that submission (see point 6.4 above). In the present Board's view a submission either *is* substantiated (explicitly or implicitly, by being self-explanatory) or is *not* substantiated. If it is not, a Board will usually not take it into account under Article 12(5) RPBA.
- 6.7 Article 12(5) RPBA implicitly foresees the possibility of admitting a party submission although it does not comply with the requirements of Article 12(3) RPBA. In the present Board's view this may in particular occur in the context of a Board's power of examination under Article 114(1) EPC. Under this provision, a Board may raise an objection of its own motion. Hence it is possible for a Board to consider an unsubstantiated party objection in the appeal proceedings, albeit, in view of the right to be heard, with the proviso that the substantiation lacking must then be provided subsequently, either by one of the parties or by the Board itself.

- 6.8 A main difference between the two approaches in the case law on substantiation referred to in points 6.2 and 6.3 seems to be whether or not a Board must take a formal admittance decision on a claim request or objection which it considers unsubstantiated. If, for example, an unsubstantiated claim request is considered not validly filed, no such decision is required. If, on the other hand, it is considered that an unsubstantiated claim request *is* validly filed, a negative admittance decision is required, which may also play a role under Rule 104(b) EPC. Furthermore, if unsubstantiated objections in the appeal proceedings (for example submitted in the form of a single sentence without any reasoning) are considered to be validly filed, a Board would also have to take negative admittance decisions on all such objections.
- 6.9 In the present Board's view, for reasons of legal certainty, it will often be expedient to take a formal non-admittance decision on an unsubstantiated claim request or objection. Following the first line of case law, such a decision should, however, be considered to have only declaratory character.
- 6.10 In the following, the Board will apply the principles as set out above to the facts of the present case.
- 6.10.1 In the present case, the appellant stated in the oral proceedings before the Board that he had previously raised objections of lack of novelty and lack of inventive step against claim 1 of the 9th auxiliary request. The reasons provided in this context equally applied to claim 1 of the 14th auxiliary request.

- 6.10.2 The appellant referred to the last sentence on page 8 of his written submission dated 23 December 2021 and entitled "Auf die Eingabe der Patentinhaberin vom 18.20.21". This sentence states, in connection with the 9th auxiliary request, that the further objections to claim 1 of the main request are maintained.
- 6.10.3 Page 12 of the appellant's statement of grounds of appeal indicates, in relation to the main request, that the objections of lack of novelty and lack of inventive step based on D1, D2 and D3 are maintained on appeal. There is, however, no indication in what passages the appellant considers what claim features to be disclosed in these documents. Instead, it is only argued therein that the Opposition Division had construed two features too narrowly, so the submissions in points 2.1, 2.2 and 2.3 of the appellant's letter dated 22 July 2020 - which was filed in the opposition proceedings - were valid.
- 6.10.4 In these points in the letter dated 22 July 2020, the opponent argued that the Opposition Division's preliminary opinion was allegedly wrong with regard to some specific features of claim 1 of the main request in the context of novelty. However, in this letter there is no indication of where the appellant considers what claim features to be disclosed in the prior art documents. Therefore, even if these points in the appellant's letter in the opposition proceedings dated 22 July 2020 were to be taken into account as part of the appellant's submissions in the appeal proceedings - which is not the case - there would be no adequately substantiated objection of lack of novelty against claim 1 of the main request in there, let alone an objection of lack of inventive step, which is not even mentioned therein.

6.10.5 Moreover, claim 1 of the 9th auxiliary request contains several additional features compared with claim 1 of the main request. Hence an adequately substantiated novelty or inventive-step objection against claim 1 of the 9th auxiliary request would require additional substantiation in regard to all additional features, which is also lacking.

6.10.6 In view of the above, the appellant, up until the oral proceedings before the Board, had not raised any substantiated novelty and inventive-step objections against claim 1 of the 9th auxiliary request or claim 1 of the 14th auxiliary request. These objections not having been submitted with the required minimum level of substantiation, they were not validly filed. The appellant's attempt in the oral proceedings before the Board to raise novelty and inventive-step objections - legally speaking for the first time - constituted an amendment under Article 13(2) RPBA. The appellant did not argue that there were exceptional circumstances justifying the admittance of these objections into the appeal proceedings in the event that the Board considered the appellant's previous submissions unsubstantiated.

6.10.7 Accordingly, the novelty and inventive-step objections against the 14th auxiliary request were not taken into account under Article 13(2) RPBA.

7. It follows from the above that there is no objection prejudicial to the maintenance of the patent on the basis of the 14th auxiliary request.

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 as amended in the following version:
 - claims 1 to 11 filed as 14th auxiliary request by letter dated 22 December 2023
 - description and drawings of the patent specification

The Registrar:

The Chair:



G. Magouliotis

M. Alvazzi Delfrate

Decision electronically authenticated