

Internal distribution code:

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

**Datasheet for the decision
of 17 March 2023**

Case Number: T 0435/21 - 3.2.05

Application Number: 16199493.4

Publication Number: 3156214

IPC: B29C65/14, B29C65/20, E06B3/96,
B29K27/06, B29L31/10

Language of the proceedings: EN

Title of invention:
Device for welding profiled elements in plastic material, in particular PVC

Patent Proprietor:
Graf Synergy S.r.L.

Opponents:
Urban GmbH & Co. Maschinenbau KG
Kaban Makina San.ve Tic. Ltd. Sti.

Relevant legal provisions:
EPC Art. 76(1), 100(c)
RPBA 2020 Art. 12(6)

Keyword:

Grounds for opposition - subject-matter extends beyond content of earlier application (yes)

Patent as amended (auxiliary request 1) - subject-matter extends beyond content of earlier application (yes)

Late-filed requests (auxiliary requests 2 to 5) - admitted in first-instance proceedings (no) - circumstances of appeal case justify admittance (no)



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 0435/21 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 17 March 2023

Appellant: Graf Synergy S.r.L.
(Patent Proprietor) Via Galilei, 38
41015 Nonantola (MO) (IT)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Respondent I: Urban GmbH & Co. Maschinenbau KG
(Opponent 1) Dornierstrasse 5
87700 Memmingen (DE)

Representative: Patentanwälte Olbricht, Buchhold, Keulertz
Partnerschaft mbB
Hallhof 6-7
87700 Memmingen (DE)

Respondent II: Kaban Makina San.ve Tic. Ltd. Sti.
(Opponent 2) Hadimköy Atatürk Sanayi Bölgesi
Ömerli Mahallesi 75. Yil Caddesi
Uzuncayir Sokak No. 12 P.K.
34555 Arnavutköy - Istanbul (TR)

Representative: Herrmann, Jochen
Herrmann Patentanwälte
Königstrasse 30
70173 Stuttgart (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 16 April 2021
revoking European patent No. 3156214 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: M. Holz
 T. Karamanli

Summary of Facts and Submissions

- I. The patent proprietor filed an appeal against the opposition division's decision revoking European patent No. 3 156 214 (hereinafter: the "patent").
- II. Document D1 (WO 2013/132406 A1) submitted during the opposition proceedings is relevant to this decision.
- III. Oral proceedings before the board took place on 17 March 2023.

IV. Final requests

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, as an auxiliary measure, that the decision under appeal be set aside and that the patent be maintained as amended on the basis of the claims of one of auxiliary requests 1 to 5 filed with the statement of grounds of appeal.

Respondents I and II (opponents 1 and 2) requested that the appeal be dismissed.

V. Claim versions

Claim 1 as granted (corresponding to the appellant's main request) reads as follows (the feature identification used by the board is between square brackets):

"[1] Device for welding profiled elements in plastic material, in particular PVC, comprising:

[2] - a base frame (38) that supports a pair of retaining members (2) of respective profiled elements (3; 3a, 3b; 60, 61), to engage said profiled elements (3; 3a, 3b; 60, 61) with corresponding zones to be welded (4; 62, 63) facing one another;

[3] - heating means (11) for heating said zones to be welded (4; 62, 63) of the profiled elements (3; 3a, 3b; 60, 61), comprising at least a hotplate heat-sealing element (12) and

[4] mobile between an active condition wherein they are placed between said profiled elements (3; 3a, 3b; 60, 61) and a non-use condition wherein they are spaced at a distance from said profiled elements (3; 3a, 3b; 60, 61);

[5] - movement means (7) of said retaining members (2), to shift the profiled elements (3; 3a, 3b; 60, 61) between a first reciprocal away direction and a second reciprocal closer direction wherein the zones to be welded (4; 62, 63) are coupled together;

[6] - removal means (18) to make at least one groove (19) on a peripheral edge of at least one zone to be welded (4; 62, 63); characterised in that:

[7] - said removal means (18) are composed of removal means by milling; and

[8] - said removal means (18) by milling comprise:

[8.1] - a supporting frame (20) positioned in correspondence to said retaining members (2);

[8.2] - at least one machining tool (21) facing a respective profiled element (3; 3a, 3b; 60, 61) to make said groove (19) on the zone to be welded (4; 62, 63);

[8.3] - a motor part (22) associated with said tool (21); and

[8.4] - a movement member (23) of the tool (21), to move it between a first idle condition and a second working condition wherein it is placed between the profiled elements (3; 3a, 3b; 60, 61)."

Claim 1 of the appellant's auxiliary request 1 differs from claim 1 as granted in that the following feature 9 is included at the end of the claim:

"**[9]** wherein the device comprises a pair of said machining tools (21), each of which equipped with ahead [sic] (21a) active on a peripheral edge of a respective zone to be welded (4; 62, 63); said tools (21) being opposite one another to work at the same time on two facing edges of the profiled elements (3; 3a, 3b; 60, 61)."

Claim 1 of the appellant's auxiliary request 2 differs from claim 1 as granted in that the following feature 10 is included between features 6 and 7:

"**[10]** - the device comprises at least one containing presser (27), mobile along a direction transversal both to the direction of movement of the profiled elements (3; 3a, 3b; 60, 61) and to the lying plane on which they lie, to abut on the grooves (19)-made [sic] in the respective zones to be welded (4; 62, 63),"

Claim 1 of the appellant's auxiliary request 3 differs from claim 1 of auxiliary request 1 in that the following feature 10' is included between features 6 and 7:

"**[10']** - at least one containing presser (27), mobile along a direction transversal both to the direction of movement of the profiled elements (3; 3a, 3b; 60, 61)

and to the lying plane on which they lie, to abut on the grooves (19)-made [sic] in the respective zones to be welded (4; 62, 63),"

Claim 1 of the appellant's auxiliary request 4 differs from claim 1 of auxiliary request 3 in that the following feature 11 is included at the end of the claim:

"[11] said supporting frame (20) comprises a supporting bar (24) arranged above the retaining members (2), said tools (21) being mounted on the extremity of the bar (24) and said bar (24) being operatively connected to said movement member (23) to be moved in correspondence to said zones to be welded (4)."

Claim 1 of the appellant's auxiliary request 5 differs from claim 1 of auxiliary request 4 in that the following feature 12 is included at the end of the claim:

"[12] wherein the movement of the bar (24) is by means of a controlled-axis system which enables the tools (21) to shift along the peripheral edge of the profiled elements (3) to obtain the grooves (19)."

VI. The parties' submissions, where relevant to this decision, can be summarised as follows:

(a) *Appellant's main request - ground for opposition under Article 100(c) EPC*

(i) *Appellant*

Document D1, which corresponded to the earlier (parent) application for the patent in suit, provided support

for a device for welding profiled elements that did not comprise a containing presser, as defined in claim 1 as granted. The entire earlier application, including the claims, description and drawings, had to be considered in context. Figure 5 of document D1 did not show a containing presser. From page 7, lines 8 and 9 of document D1, the skilled person understood that the containing presser was only optional. The problem to be solved in document D1 was that, using prior-art techniques, welding beads were formed and needed to be removed. Page 4, lines 3 to 11 of document D1 suggested that a groove be made to create a containing compartment to remedy the drawbacks of the prior art. This solution did not involve a containing presser. The sentence on page 17, lines 7 to 9 of document D1 had two parts. The first part related to the possibility of maintaining the welding bead inside the compartment. The second part related to the operation of the containing presser. Hence, there were two different means from which the skilled person could choose. The cited passage did not imply that both means were needed, and the use of the word "and" in this passage did not give the skilled person this impression. A containing presser was not mentioned on page 18, lines 27 to 31 of document D1, either. This indicated that the removal means for making the groove in itself provided a solution to the problem posed.

The deletion of the containing presser from claim 1 of the earlier application was allowable under the "essentiality test". The skilled person would have recognised that the structure, function and effects of the removal means were not inextricably linked to any other structural elements of the device disclosed in document D1, in particular not to the containing presser. The skilled person would have unambiguously

and clearly recognised that the removal means defined in claim 1 as granted constituted an invention in its own right. Document D1 disclosed two inventions. The first invention aimed to overcome the drawbacks of the prior art and to eliminate subsequent additional operations necessary for removing the welding bead. This objective was achieved, in particular, by making a groove in correspondence to at least one zone to be welded of the profiled elements by means of a removal operation such as milling. The second invention aimed to avoid a situation in which there was too much molten material filling the groove, for example, when the force pressing the two profiled elements together was very high. This posed the risk of the groove overflowing. To avoid this risk, document D1 proposed a containing presser 27 suitable for abutting on the grooves 19. It was not necessary to provide replacement features or to modify other features to compensate for the absence of the containing presser from claim 1 as granted. The skilled person could easily choose the correct process parameters in view of the common general knowledge in the art of joining plastic profiles and adapt them so that the technical effect was achieved by the features of claim 1 as granted.

(ii) *Respondents I and II*

The feature of the containing presser was present in all the independent claims and in all the embodiments in the earlier application (document D1). A device for welding profiled elements which did not comprise a containing presser, as defined in claim 1 as granted, was not unambiguously and directly derivable from document D1. The removal of the feature of the containing presser did not pass the "essentiality test". The passage on page 18, lines 27 to 31 of

document D1 referred to a particular solution to a further problem, not to the invention as such. The absence of the containing presser from this passage did not imply that the technical problem addressed in document D1 could be solved without a containing presser. This passage referred to the embodiment in Figure 13 of document D1, which comprised a containing presser. The same applied to the passage on page 17, lines 7 to 12 of document D1, which had to be read in context. This passage explicitly disclosed that the invention in document D1 solved the problem posed by providing a compartment and by the operation of a containing presser. The passage on page 4, lines 3 to 11 did not define the invention and had to be read in context.

(b) Appellant's auxiliary request 1 - objection under Article 76(1) EPC

(i) Appellant

Auxiliary request 1 met the requirements of Article 76(1) EPC for the same reasons as those set out regarding the ground for opposition under Article 100(c) EPC.

(ii) Respondents I and II

Auxiliary request 1 did not meet the requirements of Article 76(1) EPC for the same reasons as those set out regarding the ground for opposition under Article 100(c) EPC.

(c) Appellant's auxiliary requests 2 to 5 - admittance into the appeal proceedings

(i) *Appellant*

Auxiliary requests 2 to 5 had been filed during the oral proceedings before the opposition division and were filed late. They were, however, to be admitted into the appeal proceedings. Claim 1 of auxiliary requests 2 to 5 comprised the definition of the containing presser and thus clearly overcame the ground for opposition under Article 100(c) EPC. The feature relating to the containing presser had been the subject of discussion throughout the entirety of the opposition proceedings. The respondents could have anticipated that the appellant would have included this feature in claim 1. Notwithstanding its late filing, the subject-matter of auxiliary requests 2 to 5 did not present a new case and had not put the opponents or the opposition division at a disadvantage, respecting procedural fairness without delaying the proceedings even though presented at a late stage. In point 6 of the Reasons for the decision, the opposition division regarded late-filed auxiliary requests 2 to 5 as not being clearly allowable because it would not be possible to assess whether the added feature was clear, novel and inventive; however, this disregarded the fact that the amended feature clearly overcame the ground for opposition of added matter raised in respect of the previously filed auxiliary requests 2 to 5. The opposition division did not explain why the subject-matter claimed would have been unclear. The arguments in respect of novelty and inventive step filed by the appellant on 11 January 2021 had not been considered in the opposition division's assessment. Hence, the opposition division's discretionary decision not to admit auxiliary requests 2 to 5 filed during the oral proceedings was insufficiently reasoned.

The circumstances of the appeal case also justified the admittance of auxiliary requests 2 to 5. The decision under appeal was based on the absence of the definition of the containing presser from claim 1 as granted. The appellant's defence strategy included two lines of defence, the first being to argue that the patent, contrary to the opposition division's conclusion, did not include subject-matter extending beyond the content of the earlier application as filed, and the second being to overcome this objection by amendment, i.e. by including the feature that was allegedly missing. It was legitimate to pursue both lines of defence.

(ii) *Respondents I and II*

Auxiliary requests 2 to 5 were filed late in the first-instance proceedings and it was therefore at the opposition division's discretion not to admit these requests into the proceedings. Therefore, these requests were not to be admitted into the appeal proceedings. No reasonable justification for the late filing had been put forward by the appellant. The opposition division had correctly exercised its discretion and had not admitted auxiliary requests 2 to 5. If these requests had been admitted, this would have required the new subject-matter to be examined in greater detail and would have likely required an additional prior-art search, for which, in view of the delay, there was not sufficient time left for the respondents. The oral proceedings would thus have had to be postponed and re-scheduled for a new date. Claim 1 of auxiliary requests 2 to 5 was amended using features that were not present in the claims as granted, but that allegedly had their basis in the description. While the absence of the definition of the containing presser from claim 1 as granted had been

objected to throughout the opposition proceedings, the specific feature wording included in claim 1 of auxiliary requests 2 to 5 had been at the appellant's discretion and could not have been anticipated by the respondents. This wording defined more than just the presence of a containing presser.

The appellant had not set out any circumstances of the appeal case that would justify the admittance of auxiliary requests 2 to 5 in the appeal proceedings, nor were such circumstances apparent. If the appellant's argument regarding the allegedly legitimate lines of defence was followed, an appellant in the appeal proceedings would always be allowed to amend the patent to overcome the objections on which the decision under appeal was based. The appellant's argument was, however, not consistent with the Rules of Procedure of the Boards of Appeal. The fact that the appellant had been unsuccessful in the opposition proceedings did not in itself constitute circumstances justifying the admittance of auxiliary requests 2 to 5.

Reasons for the Decision

1. Appellant's main request - ground for opposition under Article 100(c) EPC
- 1.1 The patent under dispute derives from a divisional application of European patent application No. 13720049.9 (earlier application) filed as international application PCT/IB2013/051698, which was published as WO 2013/132406 A1 (document D1).

In points 3.3 and 3.4 of the Reasons for the decision under appeal, the opposition division found that the

absence of the feature "*the device comprising ... at least one containing presser (27) ...*" from claim 1 as granted extended the subject-matter beyond the content of the earlier application as filed (see document D1) and that the ground for opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted. This view is shared by the respondents but contested by the appellant.

To examine whether the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted, the board applies the same "gold standard" developed for examining compliance with Article 123(2) EPC (see "Case Law of the Boards of Appeal of the European Patent Office", Tenth Edition July 2022, hereinafter: "Case Law", II.E.1.1). According to the gold standard, any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the prohibition on extension laid down in Article 123(2) EPC, and can therefore, irrespective of the context of the amendment, only be made within the limits of what a person skilled in the art would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the filing date, from the whole of the documents of the application as filed (see decision G 1/16, OJ EPO 2018, A70, point 18 of the Reasons for the decision).

- 1.2 Respondents I and II are of the opinion that the feature of the containing presser was present in all the independent claims and in all the embodiments of document D1. In their view, a device for welding profiled elements which did not comprise a containing

presser was not unambiguously and directly derivable from document D1.

The appellant submits that Figure 5 of document D1 did not show a containing presser.

Figure 5, however, does not show any of the features of the device for welding profiled elements defined in claim 1 as granted. From the absence of the containing presser from Figure 5, it cannot be derived that document D1 discloses a device for welding profiled elements that does not comprise a containing presser.

The appellant infers from page 7, lines 8 and 9 of document D1 that the containing presser was only optional; however, as also submitted by the appellant, for the purposes of Article 100(c) EPC, the entire earlier application has to be considered in context. The passage cited by the appellant refers to the embodiment shown in Figures 1a to 3. With reference to the same embodiment, page 6, lines 32 to 35 states that "*[t]he device 1 is also equipped with a containing presser 27 ...*". Considering the disclosure relating to the device for welding profiled elements illustrated by Figures 1a to 3 as a whole, the skilled person thus would not have unambiguously and directly derived that the containing presser 27 was a feature that was merely optional.

Similarly, the skilled person would not read the passages on page 4, lines 3 to 11 and page 18, lines 27 to 31 of document D1, cited by the appellant, in isolation. These passages relate to embodiments involving the presence (and use) of a containing presser. These passages do not provide support for a

device for welding profiled elements that does not comprise a containing presser.

In document D1, the containing presser 27 is not only present (and used) for open compartments 19a (see page 7, lines 8 and 9), but Figures 8a, 8b and 8c (see page 6, line 29 et seq.) also illustrate a situation in which the compartments are closed (see page 10, line 29 to page 11, line 3). Document D1 discloses on page 11, lines 7 to 9 that the containing presser 27 is also used for closed compartments.

The board does not share the appellant's view that the containing presser 27 was only described as being optional in document D1. In all the embodiments and independent claims of document D1, the device for welding profiled elements also comprises a containing presser. Conversely, document D1 does not disclose a device for welding profiled elements, as defined in claim 1 as granted, that does not comprise a containing presser.

- 1.3 The appellant submits that document D1 disclosed two inventions. The first invention aimed to overcome the drawbacks of the prior art and to eliminate subsequent additional operations necessary for removing the welding bead. This objective was achieved, in particular, by creating a groove in correspondence to at least one zone to be welded of the profiled elements by means of a removal operation such as milling. The second invention aimed to avoid a situation in which there was too much molten material filling the groove, for example, when the force pressing the two profiled elements together was very high. This posed the risk of the groove overflowing. To avoid this risk, document D1

proposed a containing presser 27 suitable for abutting on the grooves 19.

The board does not share this view. The objective of document D1 is explained on page 2, lines 7 to 17 as that of eliminating all subsequent additional operations suitable for removing the welding bead and of envisaging a method for welding profiled elements in plastic material that is fast, cheap and with reduced space. Regarding the same objective, page 17, lines 7 to 12 states that, "*[i]n particular, the possibility of maintaining the welding bead inside the compartment 19a and the operation of the containing pressers 27 prevents excess material coming out. Consequently, all the surface finishing jobs suitable for removing excess material are eliminated, with the consequent advantages in terms of time, energy and saving relating to the use of further machinery*". Hence, document D1 discloses that the compartment 19a defined by the groove 19 cooperates with the operation of the containing presser 27 to solve the technical problem posed. Consequently, there is a functional relationship between the removal means 18 for making the groove (see feature 6) and the containing presser 27 since they interact to produce the desired effect of eliminating the surface finishing jobs for removing excess material, with the consequent advantages in terms of time, energy and savings relating to the use of further machinery.

The appellant submits that it was not necessary to provide replacement features or modifications to features to compensate for the absence of the definition of the containing presser from claim 1 because the skilled person could easily choose the correct process parameters from common general

knowledge in the art of joining plastic profiles and adapt them so that the technical effect was achieved by claim 1 as granted.

However, document D1 does not disclose the alternative solution of appropriately adapting the process parameters suggested by the appellant. The only solution envisaged in document D1 relies on the combination of the removal means and the containing presser. The appellant's submission is therefore purely speculative. It is thus not relevant whether or not it was within the common general knowledge of the skilled person to choose appropriate process parameters to ensure that the molten material is confined within the groove without using a containing presser. Moreover, even assuming that the alternative solution suggested by the appellant is possible, replacement means for the missing containing presser would be needed for its implementation, namely, for example, means for controlling process parameters of the welding process such that the molten material fills the containing compartment but does not protrude over the surface. It is not evident that these process parameters would be the same as those for the solution disclosed in document D1 in which a containing presser is provided.

The skilled person, using their common general knowledge, thus would not have unambiguously and directly derived the subject-matter of claim 1 as granted from the earlier application (see document D1).

- 1.4 Regarding the "essentiality test" invoked by the appellant, the board notes that, according to the case law of the boards of appeal, this test is no longer considered appropriate for assessing compliance with the gold standard (see "Case Law", II.E.1.4.4 c));

however, even if the "essentiality test" is applied, the removal of the above feature fails to pass this test. For the reasons set out above, the definition of the containing presser is indispensable for the function of the invention in the light of the technical problem it serves to solve, and its removal requires other features to be modified to compensate for the change.

1.5 The subject-matter of the patent therefore extends beyond the content of the earlier application as filed. The ground for opposition under Article 100(c) EPC thus prejudices the maintenance of the patent as granted.

2. Appellant's auxiliary request 1 - objection under Article 76(1) EPC

The containing presser is not defined in claim 1 of auxiliary request 1 either. Its subject-matter therefore extends beyond the content of the earlier application as filed for the same reasons as those set out above regarding the appellant's main request. Consequently, auxiliary request 1 does not comply with Article 76(1) EPC.

3. Appellant's auxiliary requests 2 to 5 - admittance into the appeal proceedings

It is uncontested that the current auxiliary requests 2 to 5 are identical to auxiliary requests 2 to 5 filed during the oral proceedings before the opposition division. The opposition division exercised its discretion and decided not to admit these auxiliary

requests into the opposition proceedings (see point 6.4 of the Reasons for the decision under appeal).

In accordance with Article 25(1) and (2) of the Rules of Procedure of the Boards of Appeal of the European Patent Office as applicable as from 1 January 2020 (RPBA 2020; see OJ EPO 2019, A63 and OJ EPO 2021, A35), Article 12(6), first sentence), RPBA 2020 applies to the appeal at hand. In accordance with this provision, the board will not admit requests which were not admitted in the proceedings leading to the decision under appeal, **unless** the decision not to admit them suffered from an error in the use of discretion **or unless** the circumstances of the appeal case justify their admittance.

3.1 *Alleged error in the opposition division's use of its discretion*

It is common ground between the parties that auxiliary requests 2 to 5 submitted during the oral proceedings before the opposition division had been filed late and that the opposition division correctly concluded that it had discretion not to admit these requests into the opposition proceedings. The appellant, however, is of the opinion that the opposition division's discretionary decision not to admit auxiliary requests 2 to 5 filed during the oral proceedings was insufficiently reasoned.

As correctly pointed out by the appellant, discretionary decisions must be reasoned pursuant to Rule 111(2) EPC. For the following reasons, the opposition division's discretionary decision is sufficiently reasoned at least in respect of the criteria of a fair and expedient procedure.

In the last sentence in point 6.3 of the Reasons for the decision under appeal, the opposition division sets out that the assessment of novelty and of inventive step of the new requests would have required the new subject-matter to be examined in greater detail and would have likely required an additional search, for which, in view of the delay, there was not sufficient time left for the opponents. In the board's view, it is evident from this passage that, when exercising its discretion, the opposition division considered the criteria of a fair and expedient procedure.

The opposition division also exercised its discretionary power in a reasonable way. While the appellant correctly points out that the absence of the definition of the containing presser from claim 1 as granted had been discussed from the outset of the opposition proceedings, the context of the amended features has to be considered. The amendments to claim 1 of auxiliary requests 2 to 5 (see, in particular, features 10 and 10') are not limited to the definition of the containing presser, but contain further features taken from the description, as also set out by the respondents. The wording of the amendments included in claim 1 of auxiliary requests 2 to 5 could not have been anticipated from the outset of the opposition proceedings. It therefore could not have been reasonably expected that the respondents would have carried out an exhaustive prior-art search regarding features 10 and 10' before the appellant submitted auxiliary requests 2 to 5 during the oral proceedings before the opposition division. To safeguard the procedural fairness, the admission of these requests would therefore have required that the respondents be given sufficient time to carry out an

additional prior-art search and to raise objections, if needed. It can be reasonably assumed that this would have given rise to the oral proceedings being postponed and thus would have affected the procedural economy.

On the date on which the opposition division's decision was announced at the oral proceedings (i.e. 21 January 2021), the Guidelines for Examination in the European Patent Office of November 2019 (hereinafter: the "Guidelines") were in force. In the board's view, the opposition division correctly applied the Guidelines, E-VI, 2.2:

"However, if late-filed requests are based on subject-matter not previously covered by the claims, they will normally not be admitted into the proceedings also for reasons of procedural efficiency. Admission of such requests could give rise to a postponement of oral proceedings, and to a decision on apportionment of costs."

The opposition division's discretionary decision is sufficiently reasoned at least with regard to the criteria of fair and expedient proceedings. In the board's view, these criteria were also sufficient criteria in this case for the opposition division's discretionary decision not to admit auxiliary requests 2 to 5 into the proceedings. The question of whether the discretionary decision is sufficiently reasoned with regard to the criterion of clear allowability therefore does not need to be addressed.

In view of the above, the opposition division's decision not to admit auxiliary requests 2 to 5 does not suffer from an error in the use of its discretion.

3.2 *Circumstances of the appeal case*

The appellant submitted that it was a legitimate line of defence to file amended claims according to a request not admitted in the first-instance proceedings to overcome the objection on which the decision under appeal was based.

In view of the provisions of the RPBA, the parties are subject to certain restrictions on their procedural conduct, given, in particular, the need in *inter partes* proceedings to act fairly towards the other party and, more generally, the requirements of due process. The parties to *inter partes* proceedings are subject to a particular duty to facilitate due and swift conduct of the proceedings, which includes submitting all relevant facts, evidence, arguments and requests as early and completely as possible. The appellant therefore cannot expect requests not admitted in the first-instance proceedings to be automatically admitted into the proceedings.

One of the restrictions imposed by the RPBA is set out in Article 12(6), first sentence, RPBA 2020. In accordance with this provision, the board will not admit requests which were not admitted without error in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance. This provision addresses, *inter alia*, cases like the one at hand, in which requests that had been filed during the opposition proceedings, but were not admitted by the opposition division, are re-filed during the appeal proceedings.

The board agrees with the respondents that if the appellant's argument on the allegedly legitimate line

of defence were followed, an appellant patent proprietor in appeal proceedings would always have to be allowed to amend the patent in order to overcome the grounds for opposition or objections on which the decision under appeal is based. The fact that the appellant was unsuccessful in the opposition proceedings is therefore not in itself a circumstance justifying the admittance of auxiliary requests 2 to 5. The fact that auxiliary requests 2 to 5 were re-filed with the statement of grounds of appeal in order to overcome the ground of opposition under Article 100(c) EPC or the objection under Article 76(1) EPC raised against auxiliary request 1 cannot, therefore, in itself constitute circumstances of the appeal case that could justify the admittance of auxiliary requests 2 to 5 into the appeal proceedings. The board does not see any other circumstances that could justify the admittance of auxiliary requests 2 to 5 into the appeal proceedings, either.

3.3 Exercising its discretion under Article 12(6), first sentence, RPBA 2020, the board therefore decided not to admit auxiliary requests 2 to 5 into the appeal proceedings.

4. Conclusion

The ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted (corresponding to the appellant's main request) and the appellant's auxiliary request 1 does not meet the requirements of Article 76(1) EPC. Exercising its discretion under Article 12(6), first sentence, RPBA 2020, the board decided not to admit the appellant's auxiliary requests 2 to 5 into the appeal proceedings.

Since none of the appellant's requests is allowable,
the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated