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**Datasheet for the decision
of 7 June 2023**

Case Number: T 1738/21 - 3.2.07

Application Number: 09837040.6

Publication Number: 2384260

IPC: B24D5/08, B24D5/12, B24D18/00

Language of the proceedings: EN

Title of invention:
REINFORCED BONDED ABRASIVE TOOLS

Patent Proprietors:
Saint-Gobain Abrasives, Inc.
Saint-Gobain Abrasifs

Opponent:
August Rüggeberg GmbH & Co. KG

Headword:

Relevant legal provisions:
EPC Art. 54, 56, 113, 117, 112(1)(a)
RPBA 2020 Art. 11, 12(4), 13(2)
EPC R. 103(1)(a)

Keyword:

Novelty - main request (yes)

Inventive step - main request (no)

Referral to the Enlarged Board of Appeal - (no)

Substantial procedural violation - (yes) - right to be heard -
witnesses not heard

Remittal - special reasons (yes)

Late-filed facts - admitted (no)

Decisions cited:

G 0002/10, T 1875/15, T 1852/11, T 1201/14, T 1525/17,

T 1425/16, T 0110/18

Catchword:



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Case Number: T 1738/21 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 7 June 2023

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 5 August 2021
rejecting the opposition filed against European
patent No. 2384260 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman	G. Patton
Members:	S. Watson
	Y. Podbielski

Summary of Facts and Submissions

- I. An appeal was filed by the opponent against the decision of the opposition division rejecting the opposition against European patent No. 2 384 260.
- II. The opposition division found that the subject-matter of claims 1 and 13 of the patent as granted was both novel and inventive (Articles 54 and 56 EPC) so that the ground of opposition under Article 100(a) EPC did not prejudice the maintenance of the patent in its granted form.
- III. In preparation for oral proceedings, the board gave its preliminary opinion in a communication pursuant to Article 15(1) RPBA 2020, which took into account the opponent's statement of grounds of appeal and the patent proprietor's reply to the appeal.
- IV. The opponent responded to the preliminary opinion with submissions of 24 April 2023 and the patent proprietor with submissions of 19 May 2023.
- V. Oral proceedings before the board took place on 7 June 2023. At the conclusion of the proceedings the decision was announced. Further details of the oral proceedings can be found in the minutes.
- VI. The final requests of the parties are as follows:

The opponent (appellant) requests
 - that the decision under appeal be set aside and
 - that the patent be revoked;

- that the questions submitted in its statement of grounds of appeal be referred to the Enlarged Board of Appeal;
- that the appeal fee paid be reimbursed at 100%.

The patent proprietors (respondents) request

- that the appeal be dismissed, or
- if the decision under appeal is set aside, that the patent be maintained in amended form according to one of the sets of claims of auxiliary requests I to XI filed with the reply to the statement of grounds of appeal and corresponding to auxiliary requests I to VII filed on 28 August 2019 and VIII to XI filed on 29 April 2021.

VII. The following documents are referred to in this decision:

- E1: US 3,838,543 A;
- E2: Ehrenstein, G., "Faserverbund-Kunststoffe" 2006, pages 99, 100 and 148;
- E3: "Faserverbundwerkstoffe Handbuch", 3rd edition, 2000, pages 16, 150 to 152; 159 to 162, 223 to 232;
- E15: Declaration of Ernst Schneeberger, 4 December 2015;
- E16: Declaration of Susanne Henkel, 22 October 2015;
- E17: Declaration of Darius Stodtko, 22 October 2015;
- E18: Delivery note 81983817 from 14 January 2008;
- E19: List of materials for cut-off wheel;
- E20: Reinforcement arrangement No. 1878 14 October 2004;
- E21: Annual consumption of webs in 2007 and 2008;

- E22: Gräfen, H., "Lexicon Werkstofftechnik", VDI-Verlag, Düsseldorf 1993, pages 417 to 418;
- E23: Falbe J. and Regitz, M. "Römpp Chemie Lexikon", 9th edition, volume 6, Georg Thieme Verlag, 1995, pages 4972 to 4973
- E24: Catalogue "Schleif- und Trennscheiben 206", 2007.

VIII. The arguments of the parties relevant for the decision are dealt with in detail in the reasons for the decision.

IX. Independent claim 1 of the patent as granted reads as follows (with feature labelling as used in the decision under appeal):

A bonded abrasive cut-off wheel (10, 40) comprising:

- 1.1 a. a first face (46), a second face (48) and a grinding zone (18) between the first face (46) and the second face (48), the grinding zone (18) extending from an unused zone (16) to a wheel outer diameter;
- 1.2 b. a first reinforcement (50) near the first face (46);
- 1.3 c. a second reinforcement (54) near the second face (48);
- 1.4 wherein one or more of said reinforcements (50, 54) are fiberglass webs
- 1.5 wherein the fiberglass webs are coated with a sizing system

and the bonded abrasive cut-off wheel characterised by

- 1.6 the fiberglass webs having a second coating,

1.7 being a second coating that excludes wax.

- X. In view of the decision taken, it is not necessary to reproduce the independent claims of the auxiliary requests here.

Reasons for the Decision

1. *Novelty - claim 1 as granted - document E1 - Articles 100(a) and 54 EPC*

1.1 In the decision under appeal, the opposition division found that E1 disclosed features 1.1 to 1.6 of claim 1 as granted, but the subject-matter of claim 1 was novel over the disclosure of document E1 as there was no disclosure in document E1 of feature 1.7, namely that the second coating excluded wax.

1.2 In its statement of grounds of appeal, the appellant argued that the opposition division's findings were incorrect as E1 did not disclose the presence of wax in the second coating and implicitly disclosed that wax was excluded from the coating.

1.2.1 The appellant argued that the exclusion of wax from the second coating was a disclosed disclaimer, and according to G 2/10, EPO OJ 2012, 346 (Reasons 4.5.2) a disclaimer did not define a feature of the claimed invention as such, but rather defined something which is not claimed.

Therefore, it should not be necessary to prove anything more than that wax was not disclosed in the second coating of the fiberglass web in E1.

1.2.2 In connection with the appellant's argument that feature 1.7 was a disclosed disclaimer, the appellant requested the referral of the following questions in German to the Enlarged Board of Appeal:

"1. Wie sind offenbarte Disclaimer bei der Beurteilung der Neuheit und der erfinderischen Tätigkeit zu berücksichtigen, insbesondere wenn die Neuheit und die erfinderische Tätigkeit mit dem Disclaimer begründet wird?

2. Gelten für offenbarte Disclaimer dieselben Anforderungen hinsichtlich der Neuheit und der erfinderischen Tätigkeit wie für Positivmerkmale?

3. Wer trägt die Beweislast? Muss das Europäische Patentamt bzw. ein Einsprechender nachweisen, dass der Disclaimer unmittelbar und eindeutig aus dem Stand der Technik bekannt ist? Oder muss umgekehrt die Anmelderin bzw. Patentinhaberin nachweisen, dass der von ihr beanspruchte Disclaimer aus dem Stand der Technik nicht bekannt ist?"

The questions can be translated into English, the language of the proceedings, as follows:

1. How are disclosed disclaimers to be taken into account when assessing novelty and inventive step, in particular when the novelty and inventive step are based on the disclaimer?

2. Do the same requirements regarding novelty and inventive step apply to disclosed disclaimers as to positive features?

3. Who has the burden of proof in such cases? Does the EPO or an opponent have to prove that the disclaimer is directly and unambiguously derivable from the prior art? Or must the applicant or patent proprietor prove that the claimed disclaimer is not known from the prior art?

The appellant argued that the questions posed related to a point of law of fundamental importance that should be considered by the Enlarged Board of Appeal (Article 112(1)(a) EPC).

According to the appellant, an applicant or patent proprietor would have an unfair advantage if claims could be formulated with "absurd" disclaimers which would put an undue burden on examining divisions and opponents to prove the lack of the existence of such an absurd element in the prior art.

1.2.3 In order to refer a question to the Enlarged Board of Appeal, however, the point of law concerned must have more than just theoretical significance for the case before the board, the answers to the referred questions must be essential for the board to be able to dispose of the appeal (see Case law of the Boards of Appeal (CLB), 10th edition 2022, V.B.2.3.3).

In the present case, the board agrees with the respondents that feature 1.7 is not a disclosed disclaimer in the sense of G 2/10 as it does not represent the later disclaiming of something that had originally been claimed but is, and always was, a feature of the claimed invention (see original claims 15, 22 and 23).

Further, and as explicitly agreed by the appellant, the present case does not involve an "absurd" disclaimer.

Therefore, the present board sees no need to refer the questions to the Enlarged Board of Appeal as the assessment of novelty can be made according to established principles, namely whether the feature is directly and unambiguously disclosed in document E1 (see CLB, *supra*, I.C.4.1, fourth paragraph).

- 1.2.4 In general, parties at the EPO bear the burden of proof for the facts which they allege (CLB, *supra*, III.G. 5.1.1). There is no reason to depart from this principle in the present case.

The appellant alleges that wax is excluded from the second coating of the fiberglass web of the wheel in document E1.

The appellant has not shown that E1 explicitly discloses that wax is excluded from the second coating. It is undisputed that E1 makes no mention of wax.

- 1.2.5 The appellant also argued that E1 implicitly discloses that wax is excluded from the second coating because it is indicated in E1 that adhesion between the glass and the organic bond material is important, so that the resin (second) coating, which per se does not contain wax, must be compatible with the wheel bond material (E1, column 7, lines 24-32). In addition the high values of the G-ratios shown in Table II of document E1 could only be achieved if the second coating excluded wax.

It was therefore implicit for the skilled person that no wax was present in the resin coating of the wheel of document E1.

- 1.2.6 The board however follows the reasoning given by the opposition division, that there is no implicit disclosure in E1 of a second coating excluding wax.

According to established case law, an implicit disclosure must be the direct, inevitable and unambiguous consequence of the explicit disclosure (CLB, *supra*, I.C.4.3.).

The exclusion of wax is not the inevitable consequence following from the indications in E1 relating to adhesion and compatibility.

Regarding the G-ratios shown in E1, as argued by the respondents, the high G-ratios are said to be achieved through the reduced twist in the fibers of the fiberglass web and the web's location in the wheel (E1, claim 1). It is therefore also not immediately apparent to the skilled person that the achievement of a particular G-ratio inherently requires the exclusion of wax in the second coating.

- 1.3 As there is no explicit or implicit disclosure of the exclusion of wax from the second coating in E1, there is no direct and unambiguous disclosure of feature 1.7 in the wheel of E1.

Therefore the appellant has not convincingly shown that the opposition division was incorrect on this point.

- 1.4 *Respondents' submissions relating to feature 1.5 - admittance into the appeal proceedings*
- 1.4.1 At the oral proceedings before the board the respondents argued that E1 also did not disclose feature 1.5.
- 1.4.2 The appellant argued that this new line of defence was an amendment to the respondents' appeal case and should not be admitted into the appeal proceedings as Article 13(2) RPBA 2020 sets out that amendments to a party's appeal case made after the summons to oral proceedings should not be taken into account unless there are exceptional circumstances justified with cogent reasons by the party concerned.
- 1.4.3 The respondents, although agreeing that they had not made this point in the appeal proceedings to date, argued that it was merely a new argument which did not introduce new facts, so that it did not represent an amendment to their appeal case.
- 1.4.4 The board considers that by alleging for the first time in appeal proceedings, at the oral proceedings, that document E1 did not disclose feature 1.5, the respondents have amended their appeal case.

It is established case law that late-filed submissions with factual elements may be disregarded on the basis of Article 114(2) EPC (see CLB, *supra*, V.A.4.2.2.1)).

The respondents' assertion that the skilled person would not have understood the silane treatment disclosed in E1 to be a sizing system, is based on an allegation of fact, relating to the skilled person's

common general knowledge, and is therefore not only an argument (see also T 1875/15, reasons 2.3 to 2.4).

- 1.4.5 The respondents did not indicate any exceptional circumstances in the present case and the board cannot see any.
- 1.4.6 In the decision under appeal the opposition division noted that it was undisputed that features 1.1 to 1.6 of claim 1 were disclosed in E1 (see decision under appeal, II.3.1.1). The respondents did not contest this point in their reply to the statement of grounds of appeal.

Therefore, for the first time at the oral proceedings before the board, both the appellant and the board were confronted with a factually different case.

If new submissions of this nature were admitted into the appeal proceedings, the alleged facts would have to be considered for the first time by the other parties and the board at the oral proceedings.

This would be detrimental to procedural economy as it would change the framework of the appeal proceedings not only for the assessment of novelty but also for inventive step. It could also require adjournment of the oral proceedings in order to present evidence relating to the skilled person's common general knowledge on this point.

- 1.4.7 Therefore this amendment to the respondents' appeal case was not admitted into the appeal proceedings (Article 13(2) RPBA 2020).

2. *Lack of novelty - Article 100(a) EPC with Article 54 EPC - alleged public prior use*

In addition to raising an objection of lack of novelty of the subject-matter of claim 1 with respect to the disclosure of document E1, the appellant also raised an objection of lack of novelty with respect to an alleged public prior use.

The opposition division found that the alleged public prior use did not disclose any specific cut-off wheel with all the features of claim 1 (see decision under appeal, point II.3.2.1).

2.1 Substantial procedural violation - right to be heard (Article 113(1) EPC) - hearing of witnesses

2.1.1 The appellant contended in its statement of grounds of appeal that its right to be heard was infringed during the opposition proceedings.

The appellant argued that the opposition division should have heard the witnesses who had been offered to corroborate its case, before deciding that the alleged public prior use did not show a cut-off wheel with the features of claim 1 as granted.

2.1.2 The board set out in its communication pursuant to Article 15(1) RPBA 2020, its preliminary opinion that a substantial procedural violation had occurred.

2.1.3 The respondents did not comment on the board's preliminary opinion regarding this point.

At oral proceedings before the board the respondents confirmed that witnesses had been offered, but raised

no arguments with respect to the appellant's right to be heard, merely reiterating their contention that the alleged public prior use did not show all the features of claim 1 of the patent as granted.

2.1.4 The board therefore confirms its preliminary opinion, set out below, that by not hearing the witnesses offered the opposition division violated the appellant's basic procedural rights under Article 117(1) EPC and Article 113(1) EPC, namely that a party can give evidence in an appropriate form and have that evidence heard.

2.1.5 The board notes that it is established case law that an opposition division has violated an opponent's right to be heard under Article 113(1) EPC if witnesses have been offered in connection with the disclosure of certain features of an alleged public prior use considered as adequately substantiated, but the opposition division decides that the alleged public prior use does not constitute novelty-destroying state of the art without hearing the witnesses (CLB, *supra*, III.B.2.6.4 and III.G.3.1.2).

Therefore, if witnesses have been offered to corroborate alleged facts which are decisive for the decision to be taken, then the opposition division should hear the witnesses regarding the alleged facts in order to be in a position to take a decision on the basis of all the available evidence (see CLB, *supra*, III.G.3.1.1 and III.G.4.1).

2.1.6 It is therefore necessary to consider which alleged facts the appellants intended the witnesses to corroborate and if these facts were decisive for the outcome of the decision under appeal.

In its notice of opposition of 22 March 2019 the appellant alleged that a public prior use of a cut-off wheel with all the features of the subject-matter of claim 1 of the patent as granted took place on 14 January 2008 through the sale by the appellant itself of 225 cut-off wheels with reference number 61721100 to R.Krueckmeyer GmbH & Co. KG, Dortmunder Str. 4, 57234 Wilnsdorf (DE).

To substantiate its allegations, the appellant filed a delivery note (E18), three written declarations from direct and indirect suppliers of the appellant (E15 to E17), a list of materials (E19), a reinforcement arrangement (E20) and a table showing annual consumption of fiberglass webs (E21).

Five witnesses were offered by the appellant (see notice of opposition, pages 5, 6 and 13) to corroborate the following alleged facts:

- (i) Mr Schneeberger to confirm the contents of his declaration (E15) that fiberglass webs with a sizing coating and a coating of BAKELITE® PF6212IL for use in grinding wheels were manufactured by TISSA Glasweberei AG and delivered throughout 2007 and 2008 to the appellant (see notice of opposition, pages 4 and 5);
- (ii) Ms Henkel to confirm the contents of her declaration (E16) that Hexion GmbH had regularly delivered BAKELITE® PF6212IL to TISSA Glasweberei AG during 2007 and 2008 (notice of opposition, pages 4 and 5);
- (iii) Mr Stodtko to confirm the contents of his declaration (E17) that BAKELITE® PF6212IL

- did not contain wax, including in 2007 and 2008 (notice of opposition, page 6);
- (iv) Mr Härtelt and Mr Schmale to confirm that the structure and composition of the cut-off wheels delivered to R.Kueckemeyer GmbH & Co. KG on 14 January 2008 disclosed all the features of claim 1 of the patent as granted, as demonstrated by E15, E17, E19 and E20 (notice of opposition, pages 10 to 14).

In the decision under appeal the opposition division found that the alleged public prior use cut-off wheel did not show the subject-matter of claim 1 because:

- (a) the public prior use cut-off wheel did not disclose a specific cut-off wheel with all the features of claim 1; and
- (b) it was not proven that the BAKELITE® coating was still present in the finished cut-off wheel.

In the board's view, the witnesses who had been offered, were in a position to corroborate the alleged facts which were found not convincing by the opposition division.

2.1.7 Specific cut-off wheel

The opposition division appears to have acknowledged that the sales of both fiberglass webs and cut-off wheels did take place. However, the opposition division reasoned that reinforcement arrangement E20 showed a very schematic drawing and although the list of materials E19 disclosed a reference number corresponding to the first cut-off wheel in the

delivery note E18 as well as a reference corresponding to E20, E19 was difficult to read and had no date.

The witnesses, Mr Härtelt and Mr Schmale, were however offered by the appellant to confirm the alleged fact that the public prior use cut-off wheel disclosed the features of claim 1 as granted, demonstrated by the list of materials E19 and the reinforcement scheme E20 as well as the declarations E15 and E17.

- 2.1.8 Although witnesses should be heard in order to corroborate what has been alleged and not to fill in gaps in facts, additional clarifications provided by a witness to close a potential gap in the documentary evidence on file cannot be considered per se new facts, or the hearing of witnesses would be futile (see CLB, *supra*, III.G.2.4.1).

It therefore appears that the witness testimonies of Mr Härtelt and Mr Schmale would have been of great relevance for the opposition division when deciding whether the alleged facts were proven.

- 2.1.9 Presence of two coatings

It is not clear to the board whether the opposition division, in the decision under appeal intended to refer to it not being proven whether the sizing system was still present in the finished cut-off wheel, rather than the BAKELITE® coating (point II.3.2.3, first sentence). The second sentence of point II.3.2.3 refers to the disclosure of E2 and E3 and states that "*it is usual to free the fiberglass web from a sizing coating that has been used during the manufacturing, so that the end product has no sizing system anymore*".

It is also not clear whether the opposition division was referring in this sentence to the manufacture of the fiberglass webs or the cut-off wheels.

The contention that the BAKELITE® coating is not present in the finished cut-off wheel was not raised during the opposition proceedings.

The appellant appears to have understood the finding of the opposition division in point II.3.2.3 as relating to the removal of the sizing system during the manufacture of the cut-off wheels themselves at the opponent's facility, rather than during the manufacture of the web at TISSA Glasweberei.

The respondents repeated their contention made in opposition proceedings that the appellant had not proved that the sizing system was still present on the fiberglass prior to coating with the BAKELITE® coating at TISSA Glasweberei AG.

Regardless of how the opposition division's reasoning is interpreted, it would appear that the testimony of at least three of the witnesses could have been crucial to corroborate this point. Mr Schneeberger, Mr Härtelt and Mr Schmale were offered to confirm the alleged facts that (i) the sizing system remained on the web prior to coating with the BAKELITE® coating (Mr Schneeberger) and (ii) the coating and sizing systems remained on the web during manufacture of the cut-off wheels (Mr Härtelt and Mr Schmale).

It therefore appears that the witness testimonies, as argued by the appellant, were relevant for the features which were decisive for the decision.

2.1.10 The board can find no mention in the decision under appeal of the appellant's offer of witnesses nor any indication of the opposition division's reasons for not hearing the witnesses who were offered. The board therefore cannot review which principles the opposition division took into account, nor how it applied these principles, when it decided not to hear the witnesses.

In a first summons to oral proceedings dated 27 January 2020 the opposition division gave its preliminary opinion that no specific cut-off wheel was disclosed in the alleged public prior use. The opposition division wrote (see page 3, penultimate paragraph) in relation to hearing of witnesses that:

"Hearing the witness for proving the public prior use of the mentioned materials would be irrelevant for the discussion of novelty of claims 1 and 13. The witnesses will thus not be invited to the oral proceedings".

With its letter of 16 July 2020 the appellant again offered Mr Härtelt and Mr Schmale as witnesses to corroborate the alleged facts raised in relation to the structure of the cut-off wheel. The appellant also filed therewith the catalogue E24 in order to show the offer for sale of the cut-off wheel of E18.

In a second summons to oral proceedings dated 6 October 2020 the opposition division gave its preliminary opinion that even if the information filed were to be considered as proven prior art, it did not disclose *"any cut-off wheel with specific features"* (page 4, point 2.1.2, first paragraph).

In relation to the hearing of witnesses, the opposition division stated (page 4, penultimate paragraph):

"Hearing witnesses for proving the public prior use of the mentioned materials would be irrelevant for the discussion of novelty of claims 1 and 13 which deal with a cut-off wheel and not just with materials suitable for a cut-off wheel. The witnesses will thus not be invited to the oral proceedings."

The opposition division made no reference to the repeated offer to hear Mr Härtelt and Mr Schmale to corroborate the structure of the cut-off wheel.

- 2.1.11 Article 117(1) EPC and Article 113(1) EPC embody a basic procedural right, namely that a party can give evidence in an appropriate form and have that evidence heard. If the evidence offered relates to alleged facts that are decisive to the decision to be taken, the department hearing the case must as a rule order it to be taken (CLB, *supra*, III.G.1, eighth to tenth paragraphs).
- 2.1.12 Therefore, in the board's view, the opposition division's failure to hear at least Mr Schneeberger, Mr Härtelt and Mr Schmale amounts to a serious procedural violation (Article 113(1) EPC).
- 2.2 In its statement of grounds of appeal, the appellant had also contested the opposition division's findings relating to inventive step of the claims of the granted patent, to which the respondent also provided its argument in its reply. Therefore, for the sake of procedural economy, the board also considered the question of inventive step, rather than remitting the

case to the opposition division with no decision on this ground of opposition for the patent as granted.

3. *Inventive step - claim 1 as granted - Articles 100(a) and 56 EPC - document E1 with common general knowledge*

3.1 Admittance of documents E22 and E23 into the appeal proceedings as proof of the skilled person's common general knowledge

3.1.1 In the decision under appeal, the opposition division admitted document E22 into the opposition proceedings. The decision does not mention whether document E23 was admitted or not.

3.1.2 The respondents requested that E22 and E23 not be admitted into the appeal proceedings and the appellant requested that E22 and E23 be admitted into the appeal proceedings.

3.1.3 Document E22 was admitted and considered by the opposition division in its decision.

The EPC does not provide any legal basis for excluding, in appeal proceedings, documents which were already correctly admitted into the first-instance proceedings, (CLB, *supra*, V.A.3.4.4; for example, see T 1852/11, reasons 1.3; T 1201/14, reasons 2.; T 1525/17, reasons 4.3; T 1425/16, VII.2.3; T 110/18, reasons 3.).

It is well-established case law that it is not for a board, when reviewing a discretionary decision of an opposition division, to consider all the facts and circumstances of the case as if it were the opposition division to see if it would have made the same

decision. A board may only overrule such a discretionary decision if the opposition division reached its decision by using the wrong principles, without taking into account the right principles or in an arbitrary or unreasonable way (CLB, *supra*, IV.C.4.5.2 and V.A.3.4.1b)).

The respondents have not made any arguments relating to the opposition division's exercise of its discretion, they argue only that the opposition division's assessment of prima facie relevance was incorrect.

Therefore there is no legal basis on which the board could overrule the decision to admit E22.

3.1.4 With respect to E23, the board agrees with the appellant that this document was admissibly filed in reaction to the opposition division's preliminary opinion. Document E23 is an extract from a handbook representing common general knowledge regarding the properties of wax, which is prima facie relevant for the contested issue. Whilst the opposition division did not consider the admittance of this document in its decision, it was maintained and forms part of the appeal proceedings (Article 12(2) and 12(4) RPBA 2020).

3.2 In the decision under appeal, the opposition division found that the subject-matter of claim 1 of the patent as granted was inventive starting from the teaching of document E1.

The single distinguishing feature was regarded as being feature 1.7, that the second coating of the fiberglass web excludes wax.

The opposition division found that the objective technical problem to be solved was to improve the mechanical properties of a cut-off wheel, for example, by improving its G-ratio.

In the absence of any document teaching that excluding wax from a second coating of the fiberglass web would solve this problem, the opposition division found the subject-matter of claim 1 as granted to be not obvious.

- 3.3 The appellant agreed that document E1 represented a suitable starting point for the assessment of inventive step but contested the opposition division's finding that the objective technical problem was to improve mechanical properties of the cut-off wheel.

The appellant argued that the objective technical problem had to be regarded as merely to provide an alternative second coating because there was no technical effect present in the claimed wheel with respect to the wheel of document E1.

The appellant further argued that, at most, the objective technical problem could be regarded as to provide a second coating which improved adhesion between the fiberglass web and the bond material.

- 3.4 The respondents argued that the objective technical problem solved by the invention was considered to be improved mechanical properties and improved wheel performance.

According to the respondents, the contested patent showed that the exclusion of wax in the second coating resulted in improved grinding performance. The respondents referred, in particular, to figure 9, wheel

I in support of their argument. The comparison between the G-ratios of wheel I and the standard wheel shown in figure 9 proved that the exclusion of wax in the second coating led to improved G-ratios.

3.5 However, as pointed out by the appellant, it is not clear whether the improvement in the G-ratio of wheel I compared to the "standard wheel" of figure 9 is due to the exclusion of wax in the second coating. In the paragraphs describing figure 9 (paragraphs [0068] and [0069] of the patent specification), it is indicated that the standard wheel has a "conventional resin type (including wax lubricant) and a conventional sizing agent" and that modified wheel I "included a reinforcement that was prepared without wax". No further details are given in the description, in particular whether a sizing agent was used in wheel I, and if so, which one.

3.6 The respondents argued that as line 1 of paragraph [0069] disclosed that the modified wheels (wheels I and II of figure 9) were "reinforced according to aspects of this invention", that wheel I corresponded to the claimed invention. However, the original filing of the contested patent contained a number of independent claims, none of which correspond to claim 1 of the main request, so that it is not certain which features are included in the "aspects" of the invention in paragraph [0069] (corresponding to paragraph [0085] of the original application with the publication number WO2010/078191 A2).

The further paragraphs referred to by the respondents do not directly link or provide evidence that the exclusion of wax improves grinding performance. Paragraph [0047] describes, in general terms, that the

"*composition and/or other characteristics associated with*" the second coating improve the compatibility between the second coating and the organic resin of the bond. Paragraph [0007] does state that wheel performance is enhanced by improved adhesion between the fiber reinforcement and the bond mixture but without giving any detail regarding the exclusion of wax. Paragraphs [0065] and [0066] state that the exclusion of wax in the second coating of the fiberglass reinforcement improves the adhesion between the reinforcement and the organic bond mixture.

It is therefore apparent to the skilled person from the contested patent that the exclusion of wax in the second coating may in some way improve the adhesion of the fiberglass web and the bond material, but the extent to which the exclusion of wax improves the grinding performance is not proven.

The respondents also argued at the oral proceedings before the board, that it was not possible to measure the adhesion between the fiberglass web and the bond material so that this could not be taken as the objective technical problem. This was an unsubstantiated allegation. The board cannot see that the skilled person is unable to develop tests in order to evaluate adhesion strength between two components.

Therefore the objective technical problem to be solved is regarded as being to improve adhesion between the fiberglass reinforcement and the bonding material in the cut-off wheel of E1.

- 3.7 The board agrees with the appellant that the subject-matter of claim 1 is obvious with respect to the teaching of E1 together with common general knowledge.

As argued by the appellant, E1 indicates that the adhesion between the glass fiber and the bond material is very important in the wheel of E1 (column 7, lines 22 to 35).

The skilled person is well-aware from their common general knowledge, as shown for instance in document E23, page 4972, right-hand column ("als Trennmittel", "als Schmierstoffe", "als Gleitmittel"), that wax is a release agent and a lubricant and as such is detrimental to adhesion between substances.

It is obvious for the skilled person, that the inclusion of wax in the second coating of the fiberglass web in E1 would negatively affect the necessary adhesion between the fiberglass and the matrix material and the skilled person would therefore exclude wax from the second coating in an obvious manner.

- 3.8 The respondents argued that the subject-matter of claim 1 is only obvious with hindsight, i.e. with knowledge of the invention. The skilled person has many options available which would improve the adhesion between the reinforcement layer and the matrix, it is therefore not obvious to concentrate immediately on the second coating.

The board however follows the established case law that it has to be assessed whether a particular solution is (or is not) obvious. The existence of other possible options is not necessarily relevant for this assessment (see CLB, *supra*, I.D.9.21.9.b)).

Other possible solutions to the objective technical problem brought forward by the proprietor, such as using different fiberglass types, modifying the sizing systems or the bond matrix, may or may not be obvious when considering relevant prior art. If the existence of other solutions rendered any given solution inventive then it would be difficult to assess obviousness as there is rarely only one solution to a given problem.

It has to be assessed, taking into account the particulars of each case, whether the skilled person would have arrived at the claimed invention in an obvious manner.

In the present case, the teaching of E1 prompts the skilled person that a careful choice of the second coating is necessary to ensure good adhesion between the glass cloth (web reinforcement) and the bond material. From the skilled person's general knowledge it would be clearly detrimental to add a lubricant or release agent to the coating. As wax is a well-known lubricant and release agent, the skilled person would inevitably, when excluding lubricants and release agents, also exclude wax.

The appellant has therefore convincingly shown that the opposition division was incorrect in finding that the subject-matter of claim 1 was inventive. The decision under appeal should therefore be set aside.

4. *Remittal of the case to the opposition division*

The respondents requested remittal of the case to the opposition division for further prosecution as the

decision under appeal did not deal with any of the auxiliary requests.

The appellant requested that the board decide on the auxiliary requests.

According to Article 12(2) RPBA 2020, the primary object of an appeal proceedings is to review the decision under appeal. Although there is no absolute right of parties to have every matter examined at two levels of jurisdiction, it is also not the function of the board to decide upon issues which have not been examined at all by the opposition division, and parties should have, where possible, two readings of the important elements of the case (see CLB, *supra*, V.A. 9.2.1).

Article 11 RPBA 2020 sets out that remittal should only take place when special reasons are present. A fundamental deficiency in the proceedings leading to the decision under appeal is generally regarded as constituting special reasons (Article 11, second sentence, RPBA 2020).

In the present case, a substantial procedural violation occurred and the auxiliary requests did not form part of the decision under appeal.

Therefore special reasons are present and the case is to be remitted to the opposition division for further prosecution.

5. *Appeal fee reimbursement*

The appellant requested reimbursement of the appeal fee due to the substantial procedural violation. According

to Rule 103(1)(a) EPC, the appeal fee shall be reimbursed in full if a board deems that an appeal is allowable and reimbursement of the appeal fee is equitable by reason of a substantial procedural violation.

In the present case, the appeal is allowable, a substantial procedural violation occurred and it appears equitable to reimburse the appeal fee.

6. In conclusion, the subject-matter of claim 1 of the patent as granted is not inventive, so that the decision under appeal should be set aside. The opposition division did not consider any auxiliary requests and as a substantial procedural violation occurred, the case is to be remitted to the opposition division for further prosecution.

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 for further prosecution.
3. The request for referral to the Enlarged Board of Appeal is refused.
4. The appeal fee is reimbursed.

The Registrar:

The Chairman:



G. Nachtigall

G. Patton

Decision electronically authenticated