

Internal distribution code:

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

**Datasheet for the decision
of 28 May 2025**

Case Number: T 0236/22 - 3.2.03

Application Number: 11718513.2

Publication Number: 2526241

IPC: E04F11/17, E04F11/108,
E04F11/104, E04F11/16

Language of the proceedings: EN

Title of invention:

STAIR TREAD ELEMENT, STAIR RENOVATION ORNAMENT, KIT AND METHOD

Patent Proprietor:

SIP B.V.

Opponent:

Van Eyck Shutters B.V.

Headword:

Relevant legal provisions:

EPC Art. 111(1), 113(1)
EPC R. 103(1) (a), 111(2)
RPBA 2020 Art. 11

Keyword:

Right to be heard - substantial procedural violation (yes)
Reimbursement of appeal fee - substantial procedural violation
(yes) - violation of the right to be heard (yes)
Substantial procedural violation - appealed decision reasoned
(no)
Appeal decision - remittal to the department of first instance
(yes)
Remittal - fundamental deficiency in first-instance
proceedings (yes)

Decisions cited:

T 0070/02

Catchword:



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

Case Number: T 0236/22 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 28 May 2025

Appellant: Van Eyck Shutters B.V.
(Opponent) Oude Graaf 6
6002 NL Weert (NL)

Representative: Algemeen Octrooi- en Merkenbureau B.V.
P.O. Box 645
5600 AP Eindhoven (NL)

Respondent: SIP B.V.
(Patent Proprietor) Risseweg 17
6004 RM Weert (NL)

Representative: Brantsandpatents bv
Pauline Van Pottelsberghelaan 24
9051 Ghent (BE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
30 November 2021 concerning maintenance of the
European Patent No. 2526241 in amended form.

Composition of the Board:

Chairman C. Herberhold
Members: R. Baltanás y Jorge
O. Loizou

Summary of Facts and Submissions

- I. European patent No. 2 526 241 B1 relates according to its title to a stair tread element, stair renovation ornament, kit and method.
- II. An opposition was filed against the patent based on Article 100(b), (c) and (a) EPC in conjunction with Articles 54 and 56 EPC.
- III. The present appeal is against the opposition division's interlocutory decision, which found that the amended main request filed during oral proceedings met the requirements of the EPC.

This decision was appealed by the opponent (appellant).

- IV. In a communication pursuant to Article 15(1) RPBA, the Board indicated its preliminary opinion that the case should be remitted to the opposition division and the appeal fee refunded to the appellant on the grounds of a substantial procedural violation.

The parties were also informed thereby that a decision to remit the case and to refund the appeal fee in view of the circumstances could be taken in written proceedings if both parties withdrew their respective requests for oral proceedings with respect to this point.

- V. The appellant withdrew its request for oral proceedings as regards the identified substantial procedural violation by letter dated 11 April 2025.

VI. By letter dated 18 April 2025, the patent proprietor (respondent) took note of the opponent-appellant's withdrawal of its request for oral proceedings and confirmed its agreement to waive the right to oral proceedings as well.

VII. Requests

The appellant requested that the decision under appeal be set aside and that the patent be revoked on the grounds of insufficiency of disclosure (Article 83 EPC), added subject-matter (Article 123(2) EPC) and lack of novelty and inventive step (Articles 54 and 56 EPC).

The appellant further requested that the appeal fee be refunded on the grounds of a substantial procedural violation under Rule 103(1) EPC, and that the case be remitted to the opposition division if any of auxiliary requests I to VII were admitted into the appeal proceedings.

The respondent requested that the appeal be dismissed (main request) and, in the alternative, that the patent be maintained in amended form on the basis of one of auxiliary requests I to VII filed with the reply to the appeal.

By letter dated 18 April 2025, the respondent further requested that the case not be remitted to the opposition division.

VIII. Claim 1 as maintained (main request in appeal proceedings), including the numbering of its features as adopted in the contested decision, reads as follows:

- F1-1** *Stair tread element (1), such as a stair tread cover element or stair tread renovation element, for the purpose of providing a durable surface with a predetermined appearance to a stair tread (11), wherein the stair tread element (1) comprises:*
- F1-2** *- a tread surface element (5) which can be arranged during use on the tread surface of a stair tread (11),*
- F1-3** *- a nose element (6) which can be arranged during use against the nosing of the stair tread, which nose element (6) is connected to the tread surface element, and*
- F1-4** *- a surface finishing layer (2) for covering and protecting what is during use the upper side of the tread surface element and the front side of the nose element (6), characterized in that:*
- F1-5** *- the tread board and the nose element (6) are fixed to each other forming one stair tread element, and in that:*
- F1-7** *- the surface finishing layer (2) is a laminate layer such as a floor laminate layer and*
- F1-6** *is applied to the front side of the nose element (6) and to the complete rear side of the nose element (6).*

IX. Prior art

The following document has been cited, both in the statement setting out the grounds of appeal and during

the opposition proceedings, and is relevant to this decision:

D14: US 2002/0029532 A1

X. The appellant's arguments, where relevant to this decision, can be summarised as follows:

(a) Substantial procedural violation

The contested decision did not provide any reasoning as regards the novelty of the maintained main request at all and for this reason violated Rule 111(2) EPC.

Point 45 of the minutes of the oral proceedings before the opposition division made it clear that the appellant raised an objection of lack of novelty in view of D14. This objection was not addressed in the contested decision, and the appellant therefore could not understand whether or not the decision was justified as regards novelty. Consequently, the appellant was deprived of having a fair idea why its submission as regards novelty had not been considered convincing in order to base its grounds of appeal related to novelty on the decision (Case Law of the Boards of Appeal, 10th edition, III-B-2.4.1).

Points II.39 and II.40 of the contested decision did not deal with the issue of novelty, but solely that of inventive step. The contested decision merely reproduced a statement by the opponent's representative when presenting its arguments relating to inventive step in view of the conclusion previously announced by the opposition division.

The lack of a reasoned decision constituted a substantial procedural violation and a refund of the appeal fee under Rule 103(1)(a) EPC was therefore due.

(b) Remittal

The case was to be remitted to the opposition division if any of auxiliary requests I to VII were admitted into the appeal proceedings under Article 11 RPBA.

XI. The respondent's arguments, where relevant to this decision, can be summarised as follows:

(a) Substantial procedural violation

The opposition division's decision contained a reasoned assessment enabling the skilled reader to follow the line of argument concerning the issue of novelty. As is evident from the reasoning provided in the decision, the grounds relating to novelty were addressed in a manner that allowed the parties to understand them and respond accordingly. The fact that the appellant was in a position to submit detailed arguments relating to novelty before the Board further illustrated that it was neither deprived of the opportunity to present its case nor otherwise procedurally disadvantaged.

More particularly, points II.39 and II.40 of the contested decision touched upon D14 in view of the presented amendments, which later served as the basis for maintaining the patent.

In point II.39 the opposition division considered that D14 did not comprise a laminate layer for the following reasons:

"[...] given that in D14 the two layers of coating shown in Figure 7 are not to be considered as a laminate layer (F1-7) by the OD"

This sentence provided sufficient insight into the opposition division's reasoning since claim 1 as amended was considered novel in view of D14 because this document did not disclose a stair tread comprising a laminate layer. It could thus be derived from this that the appellant's argument that Figure 7 of D14, and more specifically, the two layers of coating, showed such a laminate had been rejected by the opposition division.

Novelty was a very clear-cut requirement for patentability which did not require a lengthy argument: either an element was present or it was not. The opposition division clearly decided that the appellant's argument with regard to lack of novelty could not be followed, and the decision correctly reflected the discussion held on that topic and gave proper insight into the opposition division's reasoning. Consequently, the decision could not be seen as being in breach of Rule 111(2) EPC.

The appellant's request with regard to a refund of the appeal fee was therefore to be rejected as well.

(b) Remittal

The remittal of the case to the opposition division would unduly prejudice the respondent, which would continue to face prolonged uncertainty regarding the enforceability of its patent rights. Such a delay in a case already pending for a considerable duration would

only serve to exacerbate the uncertainty and burden faced by the respondent.

In view of this, the Board was to give due consideration to the principle of procedural economy, the advanced age of the patent, the overall length of the opposition and appeal proceedings, and the clear ability of the appellant to defend its case on the merits. A fair and proportionate outcome was to be ensured by weighing the parties' respective procedural positions and consequently refraining from remitting the case.

Reasons for the Decision

1. Substantial procedural violation - Article 113(1) EPC and Rule 111(2) EPC
 - 1.1 Oral proceedings before the opposition division
 - 1.1.1 The appellant raised an objection against claim 1 of the main request on the grounds of lack of novelty with respect to D14 (see point 45 of the minutes).
 - 1.1.2 This objection was discussed and substantive arguments were presented by the parties concerning whether feature F1-7 (the surface finishing layer is a laminate layer) was disclosed in D14 (see points 45 and 46 of the minutes).
 - 1.1.3 The opposition division took a break for deliberation and immediately afterwards announced its conclusion that the subject-matter of claim 1 was novel over D14 (see points 47 and 48 of the minutes).

1.1.4 All of this is undisputed.

1.2 Content of the contested decision

1.2.1 The contested decision does not include any points focusing on the discussion of novelty (Article 54 EPC). As regards patentability, the contested decision only discusses inventive step (Article 56 EPC; see points II.38 to II.45 of the contested decision).

1.2.2 Points II.39 and II.40 of the contested decision analyse the objection on the grounds of lack of inventive step starting from D14.

1.2.3 It is stated in point II.39 that *"O stated that, given that in D14 the two layers of coating shown in figure 7 are not to be considered as a laminate layer (F1-7) by the OD, the problem that the claim solves is how to provide a wooden appearance to the stair tread element."*

1.3 Requirements of Rule 111(2) EPC

1.3.1 Rule 111(2) EPC stipulates that *"[d]ecisions of the European Patent Office which are open to appeal shall be reasoned"*. In the present case, this means that the opposition division was obliged to explain why the arguments by the then opponent relating to the alleged disclosure of feature F1-7 in D14 had not been persuasive, since this was a key point for the outcome of the case.

1.3.2 The respondent argued in their reply to the statement of grounds, page 6, [17] that the above-quoted sentence of point II.39 *"provides sufficient insight in the reasoning of the OD: Claim 1 as amended was considered*

novel in view of D14, because D14 did not show a stair thread with laminate layer". Furthermore, the respondent put forward that "Novelty obviously is a very clear-cut requirement for patentability and does not require a lengthy argumentation: either an element is present or it is not. The OD clearly decided that the argument of the Opponent Appellant with regard to lack of novelty could not be followed, and the Decision correctly reflects the discussion that took place on that topic and gives proper insight in the reasoning of the OD".

1.3.3 This is not persuasive.

1.3.4 The contested decision does not contain the reasons why the opposition division did not deem the arguments put forward by the then opponent persuasive with respect to the alleged disclosure of feature F1-7 in D14. Point II.39 of the decision merely repeats the acknowledgement by the then opponent of the opposition division's conclusion which had been previously announced to the parties (see points 47 and 48 of the minutes), but it does not explain the opposition division's arguments for having taken this decision.

1.3.5 Contrary to what has been argued by the respondent, a decision in favour of novelty cannot merely be a list of the features which the opposition division found not to be disclosed in the prior art, but it must include the reasons which thoroughly explain this conclusion in relation to the points which are essential for the conclusion drawn, taking into account the key arguments of the losing party. This is the case here in particular since the parties' arguments were based on the interpretation of the feature involved (see paragraphs 45 and 46 of the minutes), including a

possible interpretation of the claim "in the light of the description".

1.4 Conclusion

- 1.4.1 In view of the above, the contested decision violated the provisions of Rule 111(2) EPC since it was not reasoned.
- 1.4.2 Moreover, the appellant's right to be heard under Article 113(1) EPC was not respected, since this right not only requires that those involved be given an opportunity to present comments on the facts and considerations pertinent to the decision, but also requires that those comments be considered, i.e. reviewed with respect to their relevance for the decision on the matter (see Case Law of the Boards of Appeal, 10th edition, III.B.2.4.1).
- 1.4.3 The contested decision should contain at least some reasoning on the crucial points of dispute relating to novelty in order to give the appellant a fair idea of why its submissions were not considered convincing and to enable it to base its grounds of appeal on relevant issues (see Case Law of the Boards of Appeal, 10th edition, III.B.2.4.2, in particular T 0070/02, points 6. and 7. of the Reasons).
- 1.4.4 The appellant was left in the dark concerning the reasons that it had to counter in its appeal (see also point 2.2.3 below), and for the review of the decision under appeal by the Board, the reasoning of the decision is missing in this respect (Article 12(2) RPBA). This is a substantive procedural violation since the lack of reasoning in connection with an objection relating to patentability is an objective deficiency

affecting the entirety of the proceedings and the rights of the appellant (see Case Law of the Boards of Appeal, 10th edition, III.B.2.2.2).

2. Remittal - Article 111(1) EPC and Article 11 RPBA

2.1 The respondent argued that remitting the case to the opposition division would unduly prejudice this party by it facing prolonged uncertainty regarding the enforceability of its patent rights. According to the respondent, the principle of procedural economy, the advanced age of the patent, the overall length of the opposition and appeal proceedings, and the clear ability of the appellant to defend its case on the merits spoke in favour of not remitting the case to the opposition division. The respondent considered this as a fair and proportionate outcome.

2.2 This is not persuasive for the following reasons.

2.2.1 The incurred substantial procedural violation entailed such prejudice to the appellant in terms of its right to be heard (see point 1.4.4 above) that, even if the Board understands the prejudice to the respondent with regard to prolonged uncertainty, the right of the appellant to fair proceedings must prevail.

This right can best be ensured by remitting the case to the opposition division in order to provide the appellant with that to which it was always entitled, namely a reasoned decision which can be countered on appeal by grounds based on it.

The Board notes in this context that if prolonged uncertainty for the proprietor was of particular concern, it would have been possible to request

acceleration of the appeal proceedings (Article 10(3) RPBA). No such request has been received.

2.2.2 Furthermore, part of the "prolonged uncertainty" has been caused by a further appeal being filed concerning the content of the minutes and the decision (see case T 0255/22), and the subsequent requested delay of the present appeal until the first one had been settled with a decision dated 10 October 2023. This delay was necessary since the final content of the minutes and the decision forms the basis for the present appeal dealing with the substance of the contested decision.

2.2.3 The principle of procedural economy, which is certainly negatively affected by the referral, cannot justify not repairing the damaged basic rights of the appellant. In this context, the fact that the appellant made the effort to guess at hypothetical reasoning which could have been behind the contested decision in order to draft a sensible statement of grounds of appeal cannot be held against it. Drafting the statement of grounds of appeal in the absence of a reasoned decision was clearly sub-optimal and does not prove that the proceedings could be continued before the Board without affecting the basic rights of the appellant. This would be neither fair nor proportionate.

2.3 In consideration of the above, the substantial procedural violation related to the appellant's right to be heard (Article 113(1) EPC) and the lack of a decision to be revised in relation to the objection on the grounds of lack of novelty with respect to D14 constitutes special reasons within the meaning of Article 11 RPBA. The Board thus decides to remit the case to the opposition division for further prosecution (Article 111(1) EPC).

3. Refund of the appeal fee - Rule 103 EPC

In view of the substantial procedural violation identified above, the Board orders the refund of the appeal fee according to the provisions of Rule 103(1) (a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The appeal fee is to be refunded.
3. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



C. Spira

C. Herberhold

Decision electronically authenticated