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**Datasheet for the decision
of 28 September 2023**

Case Number: T 0447/22 - 3.2.05

Application Number: 10769374.9

Publication Number: 2425173

IPC: F16L55/26, F16L55/179,
B29C63/00

Language of the proceedings: EN

Title of invention:

A tool and a method for renovation of a pipe system

Patent Proprietor:

Picote Solutions Oy Ltd

Opponents:

Sukitustukku Oy (Fixaline)

Boldan Oy

Relevant legal provisions:

RPBA 2020 Art. 10(3), 13(2), 15(5)

EPC Art. 54(1), 56, 83, 84, 100(a), 100(c), 101(3), 112(1)(a),
123(2)

EPC R. 80

Keyword:

Acceleration of appeal proceedings (yes)
Claim interpretation
Grounds for opposition - subject-matter extends beyond content of earlier application (no) - lack of patentability (yes)
Novelty (auxiliary request 1: no; auxiliary request 2: yes)
Amendments - added subject-matter (auxiliary request 2: no)
Sufficiency of disclosure (auxiliary request 2: yes)
Inventive step (auxiliary request 2: yes)
Late-filed objection - admitted (no)
Claims - support in the description (overcoming objections arising out of amendments made in the course of the opposition proceedings: yes)
Re-opening the debate (no)
Referral to the Enlarged Board of Appeal (no)

Decisions cited:

G 0010/91, G 0012/91, G 0003/98, G 0003/14, R 0010/08,
T 0345/90, T 0701/91, T 0997/94, T 0367/96, T 0433/97,
T 1149/97, T 0190/99, T 0881/01, T 0556/02, T 1018/02,
T 0431/03, T 0154/04, T 0300/04, T 1408/04, T 0323/05,
T 1808/06, T 1582/08, T 0197/10, T 0712/10, T 1597/12,
T 1646/12, T 1360/13, T 1249/14, T 1817/14, T 1391/15,
T 1646/16, T 1904/16, T 2766/17, T 1024/18, T 2293/18,
T 2391/18, T 2773/18, T 1983/19, T 3097/19, T 0169/20,
T 0500/20

Catchword:

1. On the limits of claim interpretation in the light of the description (see point 13 of the reasons).
2. In application of decision G 3/14, an objection under Article 84 EPC that a claim is not supported by the description is open to examination in opposition or opposition appeal proceedings only when, and then only to the extent that, the lack of support has been introduced by an amendment to the patent. It must thus be accepted that the removal of an inconsistency between the description and a claim amended in opposition or opposition appeal proceedings is not possible when the inconsistency previously existed in the patent as granted (see point 83 of the reasons).



Beschwerdekammern

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Case Number: T 0447/22 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 28 September 2023

Appellant I: Picote Solutions Oy Ltd
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
23 December 2021 concerning maintenance of the
European Patent No. 2425173 in amended form.**

Composition of the Board:

Chairman P. Lanz
Members: T. Vermeulen
 A. Bacchin

Summary of Facts and Submissions

- I. Both the patent proprietor and opponents 1 and 2 lodged an appeal against the interlocutory decision of the opposition division finding that European patent No. 2 425 173 as amended according to auxiliary request 4 met the requirements of the European Patent Convention.
- II. The oppositions had been filed against the patent as a whole on the basis of the grounds for opposition under Article 100(a) together with Article 54(1) EPC (lack of novelty) and Article 56 EPC (lack of inventive step), under Article 100(b) EPC and under Article 100(c) EPC.
- III. In the decision under appeal, the opposition division held that the subject-matter of claim 1 as granted and the subject-matter of claim 1 according to each of the auxiliary requests 1 to 3 extended beyond the content of the application as originally filed.
- IV. The following documents cited in the proceedings before the opposition division are referred to in the present decision:

D4 "Merit Abrasives Products Catalog 2008-2009";

D6	US 2,418,966;	D13	GB 1 392 733;
D7	US 2006/0233619 A1;	D14	US 4,893,389;
D8	DE 299 10 931 U1;	D15	US 2,808,689;
D9	US 4,251,958;	D16	US 3,600,861;
D10	US 4,277,917;	D17	US 4,090,333;
D11	US 4,612,738;	D18	US 4,969,299;
D12	GB 1 289 951;	D19	EP 0 700 753 A1;

D20 "Product Catalog", Ridgid, 2008;

D21 US 3,653,856;

D31 US 3,512,311;

D22 US 1,612,842;

D32 US 2,423,992;

D25 US 4,245,970;

D33 US 4,004,316;

D26 JP 63-127808;

D34 US 7,318,770 B2;

D29 judgment of the Landgericht Düsseldorf (Regional Court of Düsseldorf) in infringement proceedings, case number 4a O 40/19.

- V. In its statement of grounds of appeal, the patent proprietor maintained its main request and auxiliary requests 1 to 5, 6a/b/c to 14a/b/c, 15 to 24 as filed with letter dated 29 July 2021 during the first instance opposition proceedings.
- VI. With its statement of grounds of appeal, opponent 2 requested acceleration of the appeal proceedings in view of infringement proceedings pending under case number 4a O 38/19 before the Regional Court of Düsseldorf.
- VII. In reply to the patent proprietor's statement of grounds of appeal, also opponent 1 requested acceleration of the appeal proceedings, referring to Article 10(3) RPBA 2020. Its request was based on infringement proceedings pending under case number 4a O 39/19 before the Regional Court of Düsseldorf. Opponent 1 also referred to appeal proceedings pending before the Higher Regional Court of Düsseldorf under case number I-2 U 6/20 and submitted, inter alia, following documents:

- BR1 notification of infringement and court order issued by the Landgericht Düsseldorf (Regional Court of Düsseldorf), case number 4a O 39/19;
- BR2 summons for oral proceedings (case number 4a O 39/19);
- BR5 interim judgment of the Market Court of Finland (case number 571/20);
- BR8 expert opinion by Prof. Bernd Künne, submitted during appeal proceedings before the Oberlandesgericht Düsseldorf (Higher Regional Court of Düsseldorf), case number I-2 U 6/20;
- BR11 indicative and conditional order (Hinweis- und Auflagenbeschluss) issued by the Higher Regional Court of Düsseldorf (case number I-2 U 6/20);
- BR12 "Abrasive expert", Suhner catalogue, dated 10/04;
- BR12b "Abrasive expert", Suhner catalogue, English and German version, 2005;

Opponent 1 also submitted

BR14 to BR17 several documents and a video in support of alleged public prior uses "INTEC";

and offered the hearing of four witnesses in regard of the alleged public prior uses "INTEC". Furthermore, it submitted

- BR4 "Demonstration of Picote Smart CutterTM", a video by the patent proprietor available under <https://www.youtube.com/watch?v=bZ5O48b19YY>;

BR19, BR20 two videos by the patent proprietor, submitted in the appeal proceedings pending before the Higher Regional Court of Düsseldorf (case number I-2 U 6/20).

- VIII. The board informed the parties by communication dated 30 September 2022 that the opponents' requests for acceleration were granted pursuant to Article 10(3) RPBA 2020.
- IX. A summons to oral proceedings was issued on 9 November 2022.
- X. In a communication pursuant to Article 15(1) RPBA 2020 issued on 3 March 2023, the parties were informed of the board's provisional opinion on the issues of the case, which could be of relevance for the decision.
- XI. By letter dated 10 March 2023, the patent proprietor filed eleven further auxiliary requests, as follows: "Main Request A", "Main Request B", auxiliary requests 1A and 1B, auxiliary requests 2A and 2B, auxiliary requests 3A and 3B, and auxiliary requests 4A, 4B and 4C.
- XII. Oral proceedings before the board took place on 15 March 2023 (hereinafter: the first oral proceedings). During these oral proceedings, the patent proprietor withdrew "Main Request A", "Main Request B", as well as auxiliary requests 1A and 1B. After the board had reached the conclusion that the claims of auxiliary request 2 were allowable, it was decided to continue the proceedings in writing exclusively for the question of adaptation of the description to the claims of this request. The parties were informed that the debate was closed with regard to the issue of claim interpretation

and the objections under Article 100(a) in conjunction with Articles 54 and 56 EPC, Article 100(b) and (c) EPC against the claims of the main request and the objections under Articles 123, 54, 56 and 83 EPC against the claims of auxiliary requests 1 and 2.

XIII. In a communication pursuant to Rule 100(2) EPC issued on 6 April 2023, the board provided the conclusions reached at the oral proceedings on claim interpretation and provisionally indicated which amendments to the description were necessary and admissible both within the meaning of Rule 80 and Article 84 EPC and invited the parties to comment on the question of adaptation of the description within a time limit of two months from notification of the communication.

XIV. By letter dated 16 June 2023, the patent proprietor filed an amended description and provided comments. Also the opponents provided comments with respective letters dated 16 June 2023. In its letter, opponent 1 requested, inter alia, to arrange further oral proceedings and to re-open the debate on the claim interpretation and on novelty and inventive step, in particular having regard to the prior uses "INTEC" and documents BR12 and BR12b. Opponent 1 provided additional submissions with letter of 29 June 2023.

XV. A summons to oral proceedings was issued on 12 July 2023. In a communication sent in annex to the summons, the board gave its provisional opinion on the outstanding questions in respect of adaptation of the description to the claims of auxiliary request 2.

XVI. By letter dated 10 August 2023, opponent 2 withdrew its request for oral proceedings. It enclosed a letter submitted on 12 July 2023 by the patent proprietor in

parallel appeal proceedings pending before the Higher Regional Court of Düsseldorf under case number I-2 U 6/20.

XVII. The oral proceedings before the board took place on 28 September 2023 (hereinafter: the second oral proceedings). During these oral proceedings, opponent 1 submitted four questions to be referred to the Enlarged Board of Appeal pursuant to Article 112 EPC (see under point XVIII.).

XVIII. Appellant I (hereinafter: the patent proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or, alternatively, in amended form on the basis of the claims of one of

- auxiliary request 1 filed before the opposition division with letter dated 29 July 2021,
- auxiliary request 2 filed before the opposition division with letter dated 29 July 2021 and an adapted description filed with letter dated 16 June 2023,
- auxiliary requests 2A or 2B filed with letter dated 10 March 2023,
- auxiliary request 3 filed before the opposition division with letter dated 29 July 2021,
- auxiliary requests 3A or 3B filed with letter dated 10 March 2023,
- auxiliary request 4 filed before the opposition division with letter dated 29 July 2021,
- auxiliary requests 4A, 4B or 4C filed with letter dated 10 March 2023,
- auxiliary requests 5, 6a to 6c, 7a to 7c, 8a to 8c, 9a to 9c, 10a to 10c, 11a to 11c, 12a to 12c, 13a to 13c, 14a to 14c or 15 to 24 filed before the opposition division with letter dated 29 July 2021,

or, further alternatively, on the basis of the claims of auxiliary request 25 filed before the board with its reply to the opponents' statements of grounds of appeal.

Both appellant II and appellant III (hereinafter: opponents 1 and 2) requested that the decision under appeal be set aside and that the patent be revoked. They further requested not to admit auxiliary requests 5 to 25 into the proceedings. In addition, both opponents requested that the board's narrow interpretation of feature c. ("steering device") of claim 1 of auxiliary request 2 be integrated in the patent specification and in case the patent specification was not amended accordingly, or amendments were carried out that were not necessitated by the grounds for opposition, the patent be revoked.

Opponent 1 further requested that

- the debate be re-opened with regard to the issues of claim interpretation and the objections under Article 123, 54, 56 and 83 EPC against auxiliary request 2 and the case be remitted to the opposition division;
- in view of reopening the debate, that documents BR12 and BR12b, as well as the alleged "IN.TEC" prior uses be admitted into the proceedings;
- the following questions of law concerning the issue of claim interpretation be referred to the Enlarged Board of Appeal:

"A. If a claim feature construction that excludes embodiments that are described as embodiments of the invention in the patent description (such that there is an inconsistency) is used in the course of

post-grant proceedings and the patent is upheld based on this claim feature construction, is full examination of the patent allowable, especially with respect to the requirement of Article 84, when this might not be required if the principles laid out in G 3/14 were followed?

B. Does it change the situation if such a claim feature construction has been expressly included neither in the text of the patent claim nor in the description?

C. Does it change the situation if there are contradictory decisions from national courts specifically with regards to the claim feature construction, particularly to find a balance between Article 84 and Article 69 and the Protocol on its interpretation, to facilitate finding a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties?

D. Is it allowable for the Board to require such a claim feature construction to be inserted in the patent claim or to be inserted into the description?"

XIX. The independent claims of the main request (patent as granted) have the following wording:

"1. A machining device (100) for machining the material of a pipe system comprising a joint area between a pipe having a smaller inner diameter and a pipe having a larger inner diameter, characterized in that the devices [sic] comprises:

a. protruding parts (102) adapted to position the device or at least a part of it inside the pipe having smaller diameter of the pipe system,

- b. steerable, actuator operable means (106 and/or 201) for removing material from the joint area of the pipe system and
- c. steering device (301) for controlling the direction of the machining device in relation to the longitudinal axis of the pipe having thinner [sic] diameter in the pipe system while removing material from the edges of a hole made to the joint area of the pipe system."

"12. A method of machining the joint area of two pipes of a pipe system using a machining device of any of claims 1 to 11."

XX. Claim 1 of auxiliary request 1 corresponds to claim 1 as granted, except for the following additional feature:

"d. a bendable torque transmitting member (105)".

In auxiliary request 1, dependent claim 11 was deleted and independent method claim 12 as granted was renumbered to claim 11. The reference to the device claims in the method claim was changed as follows:
"[...] using a machining device of any of claims 1 to ~~11~~10."

XXI. Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 1 by the following amendment:

"a'. protruding parts (102) adapted to position the device or at least a part of it inside the pipe having smaller diameter of the pipe system, wherein said protruding part [sic] (102) comprises a rough sanding surface (106),"

Compared to auxiliary request 1, also dependent claim 3 was deleted. Independent method claim 11 was renumbered to claim 10, with the reference to the device claims amended as follows: "[...] using a machining device of any of claims 1 to ~~10~~9."

XXII. The parties' submissions, as far as they are relevant to the present decision, were essentially as follows.

Claim interpretation

- Patent proprietor

A separate steering device was not required by the wording of claim 1. Instead of a cable, a weight or the alternative steering device of Figure 4e, the protruding parts of feature a. could also act as a steering device. In paragraph [0030] of the patent, the action of keeping the rotational axis of the spindle in the direction of the longitudinal axis of the pipe was defined as steering. This definition also followed from paragraphs [0019] and [0037] of the patent. Maintaining the direction of the claimed device against external forces must thus be understood as steering. The patent did not disclose that a separate steering device, such as a cable or a rope, was required. Following the description in paragraph [0034] of the patent, a relatively short machining device would behave in an uncontrollable manner when entering the thicker pipe from the thinner pipe. The axial length of the protruding parts was thus decisive for the type of steering device required. Either the machining device was provided with longer protruding parts, as in the embodiment of Figure 6a, which then controlled the direction of the machining device in relation to the longitudinal axis of the thinner pipe while removing

material from the edges of the hole. Or a separate steering device was foreseen, as in Figures 4c and 4d, for deviating the machining device from the direction of the longitudinal axis of the thinner pipe. The fact that the protruding parts and the steering device were defined in separate features of claim 1 did not prevent the steering device from comprising the protruding parts. In fact, also the removing means of feature b. could comprise the protruding parts. Claim 1 could thus be regarded as defining one single feature but with three different functional requirements. For the material removing function a sanding coating or surface had to be foreseen; for the steering function a certain axial length was indispensable.

- Opponents 1 and 2

The patent did not disclose without ambiguity a configuration wherein the protruding parts acted as a steering device. Nor did it contain any indication that the axial length of the protruding parts was a criterion for such a configuration. Even though the protruding parts had a positioning function, they were not capable of deviating the direction of the machining device. Only a cable and a weight were mentioned as possible steering devices in the patent. Furthermore, feature c. required the steering device to control the direction of the machining device while removing material from the edges of a hole made to the joint area. The rotating protruding parts, however, could not at the same time remove material from the edges of the hole and steer the machining device. It was underlined that claim 1 as granted did not comprise any limitation on the material of the pipe or on the angle between the thicker and thinner pipes.

Paragraph [0030] of the patent was not concerned with the removal of edge material, so it could not be used to interpret feature c. Moreover, it followed from the wording of paragraph [0034] of the patent, in particular from column 7, lines 26 to 31, that, similarly to the example of Figure 1, the machining device of Figures 4a and 4b did not comprise a steering device. In fact, paragraphs [0035] and [0038] of the patent entailed that the steering device shown in Figures 4c and 4d was attached only at a later stage in order to prevent the uncontrolled behaviour of the machining device. Also the figure description in paragraph [0027] indicated that the machining device of Figures 3a and 3b had a steering device while the device shown in Figures 2a and 2b - and, hence, also the device shown in Figures 4a and 4b - did not have a steering device. Regarding the example of Figure 6a, not only did the machining device not comprise a steering device, there was not even a hole made to the joint area. The use of "embodiment of the invention" in the description of some of these figures went back to the Finnish priority application of the patent, which did not comprise a steering device in claim 1.

In document BR5, an interim decision on infringement proceedings concerning a utility model with identical claim wording, the Finnish Market Court had confirmed the opponents' view that the protruding parts of the machining device could not serve as a steering device. Even though the Regional Court of Düsseldorf took a different view in infringement proceedings 4a O 40/19 and failed to recognise that paragraph [0016] of the patent related to the much broader claim 1 as originally filed, it noted in its judgment, submitted as document D29, that the steering device of feature c. must be configured to act during the entire material

removal process. This aspect was also emphasised by the Higher Regional Court of Düsseldorf in its indicative and conditional order issued in appeal proceedings I-2 U 6/20, submitted as document BR11. Unless there was a dedicated steering device, it was not possible to hold a machining device in place until the edges of the area of the hole in the thinner pipe were sanded completely flat. In this respect, reference was also made to the expert opinion submitted in appeal proceedings I-2 U 6/20, submitted as document BR8.

Main request - added subject-matter

- Patent proprietor

The only amendment to claim 1 as granted was the addition of "the edges of a hole made to" to feature c. This concerned the material removing means rather than the steering device; how the steering was performed did not have any influence on the edge material removal. The amendment had basis in the originally filed description, namely in the general description in the fourth paragraphs on both pages 4 and 6, neither of which made any reference to protruding parts, and in particular not to any elastic properties or abrasive bands thereof. The skilled person appreciated from these passages that material removal from the edges of a hole could also be performed by a component different from the protruding parts. In fact, the disc 201 of the embodiments of Figure 2a and Figures 4a and 4b was also configured for removing material. After puncturing the initial hole, material was further removed from the edges of the hole by the disc, even if the protruding parts were still fully supported by the thinner pipe. The axial movement of the disc gradually enlarged the hole without involvement of the protruding parts. This

implicit disclosure was a clear and unambiguous consequence of what was explicitly mentioned in the application as filed. Because of the "and/or" clause, there was no need to further add the puncturing aspect mentioned in the passage in the fourth paragraph on page 4. It was correct that the passage in the fourth paragraph on page 6 related to method claims that were deleted during examination proceedings. But it should be taken into account that the patent as granted still had a method claim.

The removal of material from the edges of a hole made to the joint area was also not inextricably linked to any specific steering device. From the claim interpretation, it was clear that also the protruding parts could act as a device for keeping the rotational axis of the machining device along the longitudinal axis of the pipe, i.e. for steering the machining device.

Furthermore, it was clear from the sixth paragraph on page 4 that there were two alternatives for the way in which the protruding part could be adapted to lean to a pipe in a flexible manner and four alternative solutions for the protruding part to remove material from the edges of a hole. Further relevant disclosure could be found on page 10, line 25 to page 11, line 5, and in the paragraph bridging pages 11 and 12. The added feature of claim 1 as granted did not have any impact on the importance (or lack thereof) of the "elastic protruding parts comprising abrasive bands". On the contrary, the originally filed application disclosed several alternatives for the elastic protruding parts comprising abrasive bands in embodiments where material was removed from edges of a hole made to the joint area. The added feature "edges

of a hole" was therefore not inextricably linked to elastic protruding parts comprising abrasive bands.

Therefore, the amendment to feature c. of claim 1 as granted did not amount to an unallowable intermediate generalization so that the subject-matter of the patent did not extend beyond the content of the application as filed.

It was further noted that both the objection regarding the mutual angle of the two pipes and the objection regarding the different properties of the steering device in different uses could have been presented already in the notice of opposition because the referred feature already had the same wording in the originally filed application.

- Opponents 1 and 2

The feature "removing material from the edges of a hole" was only described in the application as filed in combination with a specific steering device, such as a cable or a weight. Claim 1 as granted did not comprise such a specific steering device. From Figures 4d, 4e and 6a, it was clear that different uses of the machining device required different properties from the steering device. Also, the possible angles between the pipes were not limited by claim 1 as granted. Contrary to the patent proprietor's argument, the protruding parts only acted as a positioning means, not as a steering device. They did not control the direction of the machining device while material was removed from the edges of a hole made to the joint area of the pipe system. It was particularly clear from the description as filed that the device turned in an uncontrollable manner if it was not provided with a separate steering

device. This was the case, for example, in Figure 4b. Therefore, the amendment to claim 1 was an unallowable intermediate generalisation.

The fourth paragraph on page 4 referred to by the patent proprietor specifically mentioned a "punctured" hole produced by a special means for removing, i.e. a disc. It was not a sufficient basis for the amendment. The sixth paragraph on page 4, in turn, described the protruding parts, but not the steering device. The reference to using pneumatic force did not apply to the removal of material from the edges of a hole made to the joint area of the pipe system. The abrasive bands and a specific steering device were essential features of the machining device. In contrast to the broad definition in claim 1 as granted, the fourth paragraph on page 6 disclosed that the material was removed by the protruding parts. No other examples of removing means were disclosed. This paragraph concerned a method in which a particular device was required. Such a device was described in the paragraph bridging pages 8 and 9 and on page 10, lines 8 to 10 of the application as filed. It comprised a disc for puncturing a hole. No other examples of a puncturing device were disclosed. In addition, no steering device was mentioned in the fourth paragraph on page 6. There was no direct link between this passage and the embodiment shown in Figures 3a and 3b. Moreover, only "sanding" was disclosed as a way to remove the material. This was, however, not reflected by the wording of claim 1 as granted. The passage on page 10, line 25 to page 11, line 5 disclosed that the machining device must be relatively short in order to be able to be pushed through the possible bends in the branch line. Hence, a separate steering device was required. There was no general disclosure of a steering device, neither in

that passage nor in the paragraph bridging pages 11 and 12. The "various different steering devices" of the fourth paragraph on page 11 were not explained; it was not clear how they could be used to deviate the machining device from the direction of the longitudinal axis of the pipe.

Regarding the patent proprietor's argument that the puncturing disc could also remove edge material, it had to be taken into account that the application as filed did not disclose any steering device in case the machining device had the disc connected, see Figures 4a and 4b. In the detailed embodiments, only the protruding parts were disclosed as responsible for removing material from the edges of the hole. The puncturing disc was not suitable for doing that.

Therefore, the amendment to claim 1 as granted introduced subject-matter that extended beyond the content of the application as filed.

Main request - lack of novelty

- Patent proprietor

Document D22 disclosed a non-rotating scraping cleaner unsuitable for machining material from a pipe system, let alone from the edges of a hole. Instead, it was intended to remove accumulations of solid matter from a pipe without damaging the pipe. There was no clear and unambiguous disclosure that the spring bias of the cleaning scrapers would be sufficient to also remove pipe material, even if it were from a liner which, in view of the disclosure in paragraph [0003] of the patent, had to have a similar material strength compared to the pipe itself. The inability to remove

material from the edges of a hole was immediately clear from the figures of document D22. The fact that the object of the invention according to page 1, lines 5 to 18 of document D22 was to act upon the entire inner surface of the pipe made it unsuitable to machine the joint area between two pipes. The scrapers would lift off and lose contact with the surface. Also, the requirement on page 1, lines 58 of 61 of document D22 that the outer edges of the scrapers were shaped to conform to the curvature of the inner surface of the pipe implied that they would only contact the inner surface of the pipe lining material at two points. This was insufficient to prevent water accumulation in the joint area. Document D22 did not even mention any joint area, just a straight pipe. The prior art device would thus be unsuitable for the task defined in claim 1. In addition, the device of document D22 would get stuck in the pipe system shown in Figure 4e of the patent. Its scrapers would act as barbed hooks. It would be impossible to turn the device around the edge of the hole because of the length of each of its units. Regarding feature c., the machining device was expected to be steered during the edge removal process. In document D22, however, the non-rotating scrapers quickly passed over the inner surface of the pipe in an axial direction of movement and then were gone.

In conclusion, the subject-matter of claim 1 as granted was novel over document D22.

- Opponents 1 and 2

Document D22 disclosed an apparatus for cleaning pipes that was provided with scrapers. The term "machining" of claim 1 as granted was defined as generally processing by means of a machine, specifically in order

to reduce or to finish as if by turning. Considering that the term "scraping" also involved a surface treatment that implied the removal of material, the apparatus known from document D22 was suitable for machining edges of a hole. The mention of sewage in document D22 meant that draining pipes with smaller and larger diameters had to join each other. Also the apparatus of document D22 would remove material accumulated at the joint area, such as dirt or calcium build-up layers, all the more so since the scraper blades were made of steel and the material of pipes was left open in claim 1. The apparatus of document D22 could be adjusted for varying the tension with which the scrapers acted on the inner surface of the pipe, see page 1, lines 5 to 15. The protruding scrapers held the device in position within the pipe, see page 1, lines 78 to 91 and page 2, lines 69 to 91. The scrapers were steerable and operable by means of a shaft 'A' from one end of the device, see page 2, lines 4 to 32. The direction of the apparatus was controlled by the scrapers. It was important to realise that claim 1 as granted was a device claim, not a method claim. The intended use of the apparatus of document D22 was therefore not relevant. The patent proprietor was wrong that the prior art apparatus could not be manoeuvred in a pipe system. This depended on the dimensions of the pipe and on the angle between the pipe, none of which were claimed.

Hence, the subject-matter of claim 1 as granted lacked novelty over document D22.

Auxiliary request 1 - lack of novelty

- Patent proprietor

The bendable torque transmitting member of feature d. conveys the function of the actuator to rotate the means for removing material, see paragraph [0021] of the patent. In contrast, according to page 1, line 34 to 37 of document D22, the prior art device was moved lengthwise through the pipe. As the scrapers were arranged in a circumferential direction, material was only removed when the scrapers were moved lengthwise, i.e. without torque transmission. Furthermore, in view of the wording "actuator operable" of feature b., claim 1 of auxiliary request 1 must now be understood in the sense that the bendable torque transmitting member of feature d. was used to connect the removing means to an actuator. The removing means was thus rotatably driven. There was no such teaching in document D22. Instead, in document D22 torque is applied only to expand the scrapers, not to remove material from the pipe system.

Therefore, the subject-matter of claim 1 according to auxiliary request 2 was novel over document D22.

- Opponents 1 and 2

A bendable torque transmitting member was also disclosed by document D22, see page 1, lines 37 to 53. No link was claimed between feature d. on the one hand and features a., b., c. on the other hand. It must further be stressed that claim 1 of auxiliary request 1 did not make any reference to a rotary motion. Nor was it required that the member of feature d. was actually used for transmitting torque. Anyhow, this was also disclosed by document D22, see page 2, lines 75 to 82, according to which the shafts and the universal joints or coupling were operable by an actuator in order to move the scrapers into contact with the inner pipe wall.

Hence, the subject-matter of claim 1 according to auxiliary request 1 was not novel over document D22.

Auxiliary request 2 - admittance of late-filed objections

- Patent proprietor

Opponent 1 filed the objection under Article 123(2) EPC against dependent claims 8 and 9 of auxiliary request 2 for the first time at the first oral proceedings. It seemed to be an issue with clarity rather than with Article 123(2) EPC. The objection could have been made already with respect to the claims of the main request. The board should therefore not admit the late-filed objection into the proceedings under Article 13(2) RPBA 2020. In addition, claims 8 and 9 of auxiliary request 2 corresponded to claims 9 and 10 of the application as filed. The original claim tree structure allowed a combination of these claims with independent claim 1 and dependent claims 3 and 11. There was no requirement that both the claims and the description of the application as filed should contain basis for an amendment. The subject-matter did thus not extend beyond the content of the application as filed.

Also opponent 1's novelty objection with respect to document D21 was presented for the first time at the first oral proceedings. No convincing arguments for exceptional circumstances were put forward. The substantiation of the claims of auxiliary request 2 derived from the substantiation given in respect of the claims of auxiliary request 4 underlying the contested decision, which comprised similar features. Hence, this

novelty objection should not be admitted under Article 13(2) RPBA 2020.

Furthermore, opponent 1's objection of lack of sufficiency regarding dependent claims 8 and 9 in combination with claims 1, 5 and 6 of auxiliary request 2 was presented for the first time at the first oral proceedings. It could have been presented already before the opposition division or at least with the statement of grounds of appeal. The objection was not prima facie relevant. It was not apparent how the new attack could succeed in view of the embodiments of the patent. It was requested not to admit the objection under Article 13(2) RPBA 2020.

- Opponent 1

The combination of dependent claims 8 and 9 of auxiliary request 2 contravened Article 123(2) EPC. Admittedly, the objection was raised for the first time at the first oral proceedings. The reference to Article 123(3) EPC in point 3.2.8 of the opponent 1's reply to the patent proprietor's grounds of appeal was a typing error; it had been the intention to raise an objection under Article 123(2) EPC instead. Nevertheless, the late objection should be admitted in view of the addition of "having a rough sanding surface" in feature a'. of claim 1 of auxiliary request 2, which had shifted the claimed subject-matter. Even if the claim tree structure of the application as originally filed already disclosed a machining device with the additional features of claims 8 and 9 of auxiliary request 2, this combination seemed incompatible with the disclosure of the description and the drawings of the application as filed.

Furthermore, the subject-matter of claim 1 according to auxiliary request 2 was not novel over document D21. This was a new objection raised for the first time at the first oral proceedings. It should be admitted into the appeal proceedings for the reasons that auxiliary request 2 was not found allowable by the opposition division and the board's preliminary opinion in its communication pursuant to Article 15(1) RPBA 2020 had been negative on all auxiliary requests. Furthermore, the claims of auxiliary request 2 were not substantiated by the patent proprietor on appeal.

Claims 8 and 9 of auxiliary request 2 depended on any of claims 1 to 7. The patent did not disclose in a sufficiently clear manner how the steering device should be mounted on the machining device when there was already a rotating puncturing disk installed. Admittedly, this objection was presented for first time at the first oral proceedings. But opponent 1's representative had changed recently.

Auxiliary request 2 - added subject-matter

- Patent proprietor

Apart from the addition "the edges from a hole made to the" in feature c., claim 1 of auxiliary request 2 corresponded to a combination of claims 1, 3 and 11 of the application as filed. The original claim tree structure allowed a combination of these claims; this could not result in subject-matter which extended beyond the content of the application as filed. There was no requirement that both the claims and the description of the application as filed should contain basis for an amendment. Hence, Article 123(2) EPC was complied with.

- Opponent 1

The amendment to claim 1 of auxiliary request 2 contravened Article 123(2) EPC. The application documents did not comprise an unambiguous basis for the combination of features of claims 1, 3 and 11 as granted. There was only a disclosure based on the claim tree structure. Furthermore, the only disclosure of "rough surface" on page 4, lines 24 to 30 of the application as filed did not relate to the embodiments contained in Figures 3a and 3b.

Auxiliary request 2 - insufficient disclosure

- Patent proprietor

The figures of the patent showed that the protruding parts were positioned in a symmetrical manner around the spindle of the machining device. The location of the protruding parts was thus sufficiently disclosed.

Paragraph [0034] of the patent contained instructions on how to configure the parts of the machining device to achieve the steering effect. In the context of three embodiments of the invention, it was disclosed that either a rope, a weight or a steering device as in Figure 4e could be used for steering the machining device. In the technical field of mechanics, not more was required for a sufficient disclosure. Paragraph [0034] also taught that a steering device 301 could be arranged in front of the device. But this was only necessary when a relatively short device entered the thicker pipe. The opponents were wrong that the patent description disclosed that the machining device would turn in an uncontrollable manner when removing material

from the edges of a hole made to the joint area. No rope or weight was required when sanding the edges of a hole with a relatively long machining device. Only under specific, exceptional conditions the machining device turned in an uncontrollable manner. It was further noted that a machining device with protruding parts acting as the steering device was not the only option defined by claim 1.

Paragraph [0025] of the patent taught how a hole was made to the joint area. The skilled person would aim to make a large hole as this would require removing less edge material.

The line of argument presented by opponent 2 regarding the angular range between the pipes was completely new. It could have already been presented in the notice of opposition. Anyway, in practice, the skilled person would only consider common angles for which an international standard was applicable. In such a scenario, the invention could easily be performed over the whole claimed range. Imaginary scenarios, in contrast, were irrelevant for the skilled person. Also here, it was important to consider that claim 1 did not limit the steering device to the protruding parts.

Regarding the objection against the embodiment of Figures 4c and 4d, the opponents had not taken position on the considerations of the opposition division in the decision under appeal. This objection should therefore not be admitted into the appeal proceedings. In case it were admitted, reference was made to the submissions in the first instance opposition proceedings as well as to the reasons for the decision under appeal.

The patent thus disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

- Opponents 1 and 2

It was not evident from the patent how the protruding parts were connected within the device. Yet the location of the protruding parts was essential for their functionality, namely to position the device within a pipe. In particular the feature "at least a part of it inside the pipe" did not allow a person skilled in the art to perform the teaching of claim 1 of auxiliary request 2 without any difficulties.

Furthermore, it could not be envisaged without any additional teaching how the protruding parts acted as a steering device controlling the direction of machining while removing material from the edges. The patent did not contain any instructions on how the parts of the machining device should be configured to achieve the alleged effect when there was no steering device apart from the protruding parts. To the contrary, the patent described in several places that, without a separate steering device, the machining device turned in an uncontrollable manner when entering a thicker pipe. The bendable torque transmitting member did not function as a steering device and could therefore not overcome the lack of sufficiency of disclosure. Even if there was a separate steering device, claim 1 of auxiliary request 2 would still be very broad. Apart from a cable or a rope, the patent description did not mention any further example of a separate steering device. Moreover, no details were provided of the steering device used in Figure 4e.

The machining device of claim 1 could not be used for pipe systems and joint areas with a randomly designed hole made to the joint area; the hole had to have a certain size. The person skilled in the art would face an undue burden when trying to design protruding parts for a machining device designed for use in pipes with a small inner diameter and an undefined hole in the joint area of the pipe system.

Also, claim 1 was not limited to pipes arranged at a particular angle relative to one another. According to the established case law, the person skilled the art had to be able to perform the invention over the whole range claimed, hence 0 to 90 degrees. However, it was clear that the invention would only work over a very narrow part of that angle range.

Furthermore, the patent did not comprise sufficient instructions for implementing the embodiments of Figures 4c and 4d. In particular, it was not clear how to end up in the situation of Figure 4d, where the steering device was pulled upwards by a rope. The description did not contain any instructions on how to attach the rope and how it could be accessed through the main pipe.

It was apparent from video BR19 that the result of the sanding by the patent proprietor's machining device was rough and therefore obviously not suitable to prevent debris from agglomerating the joint area. Also video BR20 demonstrated that the result of the sanding operation was of an unacceptable quality. In fact, based on the videos BR4, BR19 and BR20, none of the machining devices, which the patent proprietor had found to be according to claim 1 of auxiliary request 2, could fulfill the task of sanding the edges of the

hole in the joint area completely flat. Without a separate steering device, the device did not work as required.

In conclusion, the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Auxiliary request 2 - lack of novelty

- Patent proprietor

The scraping blades of document D22 were not associated with a rough sanding surface. Hence, the subject-matter of claim 1 was novel over document D22.

In the understanding of the skilled person, the abrasive diamonds mentioned in document D14 did not protrude with respect to the bell-shaped body. The bands 323 did not protrude either, they were merely attached to the body. Document D14 did therefore not have an unambiguous disclosure of protruding parts comprising a rough sanding surface. It was further noted that the position mentioned in feature a'. of claim 1 could not be arbitrary. The abrasive diamonds of document D14 were not adapted to position the machining device inside a pipe. On the contrary, the bell-shaped element 20 in Figure 3 of document D14 prevented positioning of the machining device inside the pipe. As a consequence, document D14 did not take away the novelty of claim 1 of auxiliary request 2.

- Opponents 1 and 2

In document D22, the scraping blades B formed a rough sanding surface, see page 1, lines 54 to 60. Hence, the prior-art document was also prejudicial to the novelty of the subject-matter of claim 1 according to auxiliary request 2.

Document D14 disclosed a method using a device for reinstating branch lines to a main sewer, see column 2, lines 53 to 57 and Figure 1 to 3. The device comprised a reaming tool 20 provided with a bell-shaped body 321 with bands of abrasive diamonds on its outer surface, see column 3, lines 35 to 43 and Figure 6. The bands had to protrude from the device, otherwise they would not have any function. They were also suitable to position at least a part of the device inside the branch line 11, see Figure 3. The abrasive diamonds formed a rough sanding surface. The reaming tool was connected to a flexible drive shaft 18, i.e. a bendable torque transmitting member. The diamonds controlled the direction of the device while material was removed from the edges of a hole made to the joint area of the pipe system. They thus functioned as a steering device. All features of claim 1 according to auxiliary request 2 were thus disclosed by document D14, which was therefore novelty destroying.

Auxiliary request 2 - lack of inventive step

- Patent proprietor

Document D21 did not disclose feature a'. of claim 1. Even if the plies 25 were considered as protruding parts, they were too soft to position the device inside the pipe. The passage in column 3, lines 23 to 31 of document D21 explained that there was no inherent bias that would allow such positioning. The reason behind

this was evident from the passage in column 1, lines 30 to 36. In contrast, the invention of the patent aimed at scratching the joint area of the pipes. Also column 2, lines 10 to 16 of document D21 emphasised that all rigidity was to be eliminated. Instead of scratching the surface, the device of document D21 was intended to wipe the surface, see also column 3, lines 32 to 35. Further differences with the claimed subject-matter were the lack of a steering device and the bendable nature of the torque transmission member. The rigid shaft 13 disclosed by document D21 was actually too short to direct or to control the position of the device. From the embodiment of Figures 4a and 4b of the patent, it was clear that the steering device was required to counter the uncontrollable turning tendency caused by having a bendable torque transmission member. Therefore, there was synergy between the distinguishing features. The skilled person would not be incited to have a bendable transmission member because it would make the device inoperable. With a rigid shaft, there was no need for a steering device to control the direction of the machining device.

Also starting from document D20 in combination with document D4 the skilled person would not have arrived at the subject-matter of claim 1 of auxiliary request 2 in an obvious manner. Document D4 concerned polishing devices having very high rotational speeds, see pages 67 and 68. In contrast, the drum machine disclosed on page 59 of document D20 was used for drain cleaning by means of a motor operated at only 1725 rpm. It was impossible for the drum machine with a bendable torque transmission cable that extended several meters long to achieve the 25000 rpm disclosed in document D4. The documents were not compatible.

The device of document D25 was designed to cut through grout; it did not remove material from the edges of a hole. Rather it first drilled a pilot hole and then cut away a large disc around that pilot hole with a diamond-tipped hole saw. Tools for deburring bores in metal pieces were not suitable for removing grout in any meaningful quantity. Hence, the devices of documents D25 and D21 were technically incompatible. The skilled person would have lacked motivation to replace the ball-shaped guides of document D25, since they were so far back that they would never reach the edges of a hole of the joint area. Furthermore, the hole made in the joint area with the device of document D25 did not have any protruding edges, so there would not have been any motivation to modify the device of document D25 in the way suggested by the opponents.

- Opponents 1 and 2

The subject-matter of claim 1 of auxiliary request 2 did not involve an inventive step in view of document D21 in combination with any of documents D7, D14, D22, D25 or D26, in view of document D20 combined with document D4, or in view of document D25 in combination with the common general knowledge or any of documents D4, D6, D8 to D19, D21 or D31 to D34.

Document D21 disclosed a rotary abrasive device, which, even if it was not explicitly disclosed, was suitable for machining a pipe system with two pipes. Abrasive units 20 were provided with pads 23 of overlying abrasive-coated cloth or paper plies 25. The plies were permanently set with a curvature adapted for tangential engagement with the work surface, see column 2, lines 3 to 6 and lines 72 to 75. Therefore, the abrasive units were protruding parts comprising a rough sanding

surface. Upon rotation, they would position the machining device to a certain extent. Moreover, they controlled the direction of the machining device. The plies were adapted to engage with the work surface at a transition from one diameter to another, when the tool was shifted to the different diameter, see column 3, lines 20 to 31. Shaft 13 was a torque transmitting member attached to a power source for rotating the tool, see column 2, lines 32 to 40. The subject-matter of claim 1 thus differed from the device of document D21 in that the shaft 13 of document D21 was not bendable and in that no steering device was foreseen. The technical effect of the first distinguishing feature was that the device could be steered through turns of a pipe. Regarding the second distinguishing feature, it was observed that the device of document D21 was very similar to that of Figures 4a and 4b of the patent. It could therefore be assumed that also the prior art device had an uncontrollable turning tendency. Hence, the technical effect of the second distinguishing feature was to prevent uncontrollable turning while material was removed from the edges of a hole. The bendable torque transmission member and the steering device were not linked to one another; they could therefore be considered as separate solutions to two objective technical problems. The first objective technical problem was to provide a machining device that could be steered through turns of a pipe. The second objective technical problem was to prevent uncontrollable turning while material was removed from the edges of a hole. The person skilled in the art would have looked for the solution to the first objective technical problem in any of documents D7, D14, D22, D25 or D26, each of which disclosed a device that could be steered through turns of a pipe by means of a bendable torque transmitting member. The skilled

person would have either replaced the shaft of document D21 by a bendable torque transmitting member or attached a bendable torque transmitting member to a shorter shaft. Anyway, there were only two alternatives: either the torque transmitting shaft was bendable or it was not. Furthermore, the skilled person would have easily solved the second objective technical problem by adding a device that maintained or deviated the direction of the machining device known from document D21. Thus the skilled person would have arrived at the subject-matter of claim 1 of auxiliary request 2 in an obvious manner.

On page 59 of document D20 a drum machine for cleaning drains was disclosed, quite similar to the device of document D21. Through the use of one of the tools mentioned on page 76, it was suitable for removing even hard materials from a pipe. Document D20 could thus be considered as a promising springboard for an inventive step assessment of claim 1 of auxiliary request 2. As was clear from the figure on page 59 of document D20, a cable could be retracted from the drum and inserted in a pipe. Hence, the drum machine was provided with a bendable torque transmitting member. The drum machine was also compatible with tools having deformable parts, see for example the flue brush shown on page 76. In view of the teaching of document D4, and for the same reasons as when starting from document D21, it would have been obvious for the skilled person to add a steering device to the drum machine of document D20. Page 67 of document D4 disclosed a hand tool that was used for deburring. Despite the difference in maximum rotation speeds, it was not incompatible with the drum machine of document D20. According to page 68 of document D4, the tool was used together with elastic deformable abrasive lamellae. The lamellae were both

protruding parts adapted to position the device and a steering device for controlling the direction of the machining device. They also comprised a rough sanding surface. It would have been evident to the skilled person that the use of such lamellae was not limited to the use with a rigid mandrel connected to a rigid tool. By combining the teachings of documents D20 and D4, the skilled person would thus have arrived at the subject-matter of claim 1 in an obvious manner.

The only difference between document D25 and the subject-matter of claim 1 of auxiliary request 2 was that document D25 did not disclose a protruding part comprising a rough sanding surface. The technical effect of the distinguishing feature was enhanced material removal by the protruding parts. The objective technical problem was thus how to enhance material removal by the protruding parts. The person skilled in the art would have looked for the solution to the objective technical problem in any of documents D4, D6, D8 to D19, D21 or D31 to D34, each of which disclosed devices that comprised protruding parts with rough sanding surfaces. Furthermore, the use of rough sanding surfaces for enhanced material removal was well-known to a skilled person.

Request for re-opening the debate

- Patent proprietor

As set out in point 30 of the board's communication dated 6 April 2023, the debate had been closed at the end of the first oral proceedings with regard to all substantial issues. There was thus no reason to re-open the debate on any of those issues, in particular not the claim interpretation which had already been

discussed during the debate on novelty of claim 1 of auxiliary request 2. The only issue left to discuss after closure of the first oral proceedings was the adaptation of the description.

- Opponent 1

It was requested to re-open the debate in order to reconsider the claim interpretation and to take into account also the prior uses "INTEC" and documents BR12 and BR12b, which were submitted at the beginning of the appeal proceedings, for the discussion on novelty and inventive step. This was not a request to start the debate all over again. The board had only arrived at a conclusion on novelty and inventive step with respect to some prior art documents at the end of the first oral proceedings. No decision had been made, however, on the admittance of the prior uses "INTEC" and, in particular, of documents BR12 and BR12b into the appeal proceedings. Furthermore, the broader claim understanding of the Regional Court of Düsseldorf in the parallel infringement cases against the opponents, namely the assumption that the protruding parts could also act as a steering device, would likely result in a finding of infringement despite the fact that the patent had an embodiment which was anticipated by the prior uses "INTEC" and documents BR12 and BR12b. Furthermore, there was a certain mismatch to close the debate on claim interpretation, novelty and inventive step before having reached a conclusion as to what the acceptable form of the description and the drawings should be, since they also had an impact on the definition of the subject-matter of the patent by virtue of Article 69 EPC. Opponent 1 had only realised these aspects after the first oral proceedings had been closed. They were triggered by the letter dated 12 July

2023 presented by the patent proprietor before the Higher Regional Court of Düsseldorf in case number I-2 U 6/20.

Adaptation of description

- Patent proprietor

The alleged inconsistency between claim 1 of auxiliary request 2, as interpreted by the board, and certain embodiments in the description and the figures of the patent was the result of the fact that these embodiments were ignored by the board for the purpose of the claim interpretation. In fact, the board chose to interpret claim 1 solely based on the claim wording without any reference to the description. For this reason, no amendments to the description of the patent were required except those already carried out in paragraphs [0007], [0017] and [0021]. The adapted passages concerned the amendments carried out in claim 1 of auxiliary request 2. The patent proprietor did not consent to the board's view regarding an alleged inconsistency between the steering device feature of claim 1 as granted and some passages of the description and figures of the granted patent. Rather, when interpreting granted claim 1 in line with Article 69 EPC, i.e. when also taking into account the description and the drawings of the patent, no such inconsistency was created in the first place. In any case, decision G 3/14 prevented any such amendment to the description.

- Opponents 1 and 2

For legal security, it was essential that the claims were not interpreted more broadly in infringement proceedings than in opposition proceedings. Hence, the

description of the patent had to be adapted not only in view of the amendments of claim 1 as introduced by auxiliary request 2, but also in view of the board's narrow claim interpretation. As some of the claim limitations were not reflected by the description, in particular by embodiments referred to in paragraphs [0027] and [0030] of the patent which did not require a separate steering device, there was a risk that the Regional Court of Düsseldorf would arrive at a broader, incorrect understanding of the claim in application of Article 69(1) EPC and thus arrive at a negative finding for the opponents in the pending infringement proceedings based on the patent in suit. Only the board's narrow claim interpretation made it possible for the patent proprietor to maintain and enforce claim 1 in the form of auxiliary request 2. If feature c. were to be interpreted more broadly, the claim would be anticipated by several prior art documents and the patent had to be revoked. Therefore, apart from the description amendments proposed by the patent proprietor, also paragraphs [0027], [0030], [0032], [0034] and [0039] had to be amended in order to make clear that the machining devices of Figures 1, 2a, 2b, 4a, 4b and 6a did not fall under the scope of claim 1. It followed from Article 69 EPC that the description had a role in the interpretation of the claims. This was confirmed by several decisions of the Boards of Appeal (see T 1360/13, T 997/94, T 300/04). Under Rule 80 EPC amendments to the description can be occasioned by a ground for opposition if they affect the claim construction and thus define the scope of protection. Decision G 3/14 was not applicable here. It dealt with claim amendments and, more particularly, the question to which extent the clarity of amended claims could be examined in post-grant proceedings. In contrast, the present discussion was about amendments of the

description. They did not relate to a clarity issue in a strict sense, but to incorrect labelling of non-patentable subject-matter as embodiments or to statements which might lead to an incorrect assumption that such subject-matter fell under the scope of the independent claims. This contradicted both Article 84 EPC and Article 83 EPC. Reference was also made to decisions T 1024/18 and T 3097/19.

Questions to be referred to the Enlarged Board of Appeal

- Patent proprietor

The referral was not admissible. Opponent 1 could have already submitted the questions during the discussion of novelty at the first oral proceedings held before the board. In addition, question A seemed to imply that Article 84 EPC was a ground for opposition, which it was not. It implied to go against the ruling of decision G 3/14. Questions B, C and D were not entirely clear.

- Opponent 1

In the first oral proceedings held before the board, it had not been possible to discuss novelty in respect of the claimed subject-matter having regard to the disclosure of the patent description. Therefore, the request to refer questions A to D to the Enlarged Board of Appeal was only made at the second oral proceedings. Opponent 1 was not aware of divergent case law of the Boards of Appeal in this respect. But the present case was a different situation compared to that of decision G 3/14. Also, there were no final decisions from national courts that were contradictory. Even if the

Market Court of Finland had decided in case number 571/20 on a utility model with similar claim wording as the patent in suit, the appeal proceedings before the Higher Regional Court of Düsseldorf with case number I-2 U 6/20 was still pending. However, the aim of the questions A to D was precisely to avoid such contradictory decisions. For a better understanding, questions B and C referred to question A. By means of "such a claim feature construction", question D also referred to question A; it was thus limited to post-grant proceedings.

Reasons for the Decision

Acceleration of the appeal proceedings

1. Pursuant to Article 10(3) RPBA 2020, the board may accelerate the appeal proceedings on request by a party. This request must contain reasons justifying the acceleration and must, where appropriate, be supported by documentary evidence.
2. Both opponents requested the board to accelerate the appeal proceedings. They referred to infringement proceedings instituted against them by the patent proprietor on the basis of the patent in suit, respectively pending under case numbers 4a O 39/19 and 4a O 38/19 before the Regional Court (Landgericht) of Düsseldorf.
3. With its reply to the patent proprietor's statement of grounds of appeal, opponent 1 submitted, inter alia, documents BR1 and BR2 as evidence of the infringement

proceedings 4a O 39/19. In this connection the board's attention was drawn to the opponent 2's request for acceleration of the opposition proceedings and the documentary evidence filed in support thereof, in view of the infringement proceedings with case number 4a O 38/19, which had been stayed until the decision of the opposition division became final (see points 6 and 15 of the 'Facts and Submissions' of the decision under appeal).

4. The board further took note that an appeal was pending before the Higher Regional Court (Oberlandesgericht) of Düsseldorf under case number I-2 U 6/20. The appeal was directed against the judgment by the Regional Court of Düsseldorf in further infringement proceedings with case number 4a O 40/19 brought by the patent proprietor on the basis of the patent in suit (see document D29).
5. Considering the above, the board concluded that it was fully justified to give priority to present appeal proceedings and decide it in front of other pending cases. Accordingly, the opponents' request for acceleration under Article 10(3) RPBA 2020 was granted.

Claim interpretation

6. The present case is one where the understanding of claim 1 as granted has given rise to a considerable discussion between the parties. Since the claim interpretation was of prime importance for the outcome of the case, as it formed the basis for the subsequent findings on added subject-matter and novelty, it seems appropriate to deal with this aspect before turning to any other matter.

7. The subject-matter of claim 1 as granted is concerned with a device for machining the material of a pipe system. The pipe system itself, including the pipe having a smaller inner diameter, the pipe having a larger inner diameter and the joint area there-between, is not part of the claimed subject-matter, which is solely defined in terms of three structural features a., b. and c.

(a) Feature a.

8. Feature a. requires some parts of the machining device to protrude, i.e. they should project or stick out. What portion of the machining device the parts are projecting from is not specified in the claim. Nor does it say in which direction the parts project. Nevertheless, they should be adapted to position at least a part of the machining device inside a pipe of a certain (smaller) diameter. This is understood as implying that the protruding parts are arranged in such a way that, during use of the machining device inside a pipe, they extend away from the longitudinal axis of the pipe in different directions so as to make contact with the inner surface of the pipe and, by doing so, they place at least part of the device in a particular position inside the pipe.

(b) Feature b.

9. The second feature of the machining device foresees that means are provided for removing material of a joint area between two pipes. Other than that it *can* be steered ("steerable") and *can* be operated by an actuator ("actuator operable") no details are given of how the material removing means is shaped, where it is placed or how, if at all, it relates to the protruding

parts of feature a. As a consequence, feature b. leaves open whether or not the material removing means is actually steered and driven by an actuator. By no means does it require the presence of a rotating member or a relative movement of the protruding parts with respect to a pipe.

(c) *Feature c.*

- *"steering device for controlling the direction"*

10. The natural reading of the expression "steering device" is that an **actual physical component** is to perform the task of steering the machining device. The steering is thus not merely a functional aspect that can be assigned to one of the other components of the machining device. It then follows from the syntax of claim 1 as granted

"A machining device [...] characterized in that the devices [*sic*] comprises:

- a. protruding parts [...],
- b. [...] means [...] for removing material [...]
- c. steering device [...]"

that the machining device has at least three distinct components, each with its own function.

11. Furthermore, a distinction must be made between steering and positioning. The generally accepted meaning of the term "steering" is the control of a direction. This entails an ability to change the direction. Hence, a steering device for controlling the direction in the sense of feature c. is a component that is capable of **actively** changing the direction of

the machining device in relation to the longitudinal axis of the pipe it is positioned in. This is not to say that the steering device cannot be used to hold, keep or maintain the position of the machining device along a certain course. Depending on the circumstances, it can very well be that the steering device does not need to deviate the machining device from the direction of the longitudinal axis of the pipe at all. But it must at least be able to do so.

12. In view of above considerations, the steering device of feature c. is construed as an actual physical component of the machining device which is adapted for actively controlling the direction of the machining device in relation to the longitudinal axis of the pipe having a smaller diameter in the pipe system.

13. The patent proprietor argued that a dedicated steering device was not required, since various passages in the description of the patent indicated that the protruding parts, by maintaining the direction of the machining device, already acted as a steering device. The board disagrees for the following reasons.

13.1 There is an extensive body of case law of the Boards of Appeal according to which, within certain limits, a claim may be interpreted with the help of the description and the drawings for understanding the subject-matter to be assessed under the requirements of the EPC.

It is a general principle applied throughout the EPC that a term of a claim can be interpreted only in context. The claims do not stand on their own, but together with the description and the drawings they are part of a unitary document, which must be read as a

whole (see e.g. T 556/02, Reasons 5.3; T 1646/12, Reasons 2.1, T 1817/14, Reasons 7.3, and T 169/20, Reasons 1).

The extent to which description and drawings can provide an aid to interpret the claims is however subject to certain limitations.

A decision often cited in this context is T 190/99, which in point 2.4 of the Reasons states that the skilled person when considering a claim should rule out interpretations which are illogical or which do not make technical sense. He should try, with synthetical propensity i.e. building up rather than tearing down, to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent; the patent must be construed by a mind willing to understand not a mind desirous of misunderstanding.

The present board concurs with T 1408/04 (Reasons 1) that this statement must be understood to mean only that technically illogical interpretations should be excluded (see also T 1582/08, Reasons 16, and T 169/20, Reasons 1.3.3). A claim can thus be interpreted in the light of the description and the drawings to the extent that they contain logical and technical sensible information.

Furthermore, interpreting the claims in the light of the description and the drawings does not make it legitimate to read into the claim features appearing only in the description or the drawings and then relying on such features to provide a distinction over the prior art. This would not be to interpret claims but to rewrite them (see T 881/01, Reasons 2.1). In

this context, it is important to differentiate between a claim consisting of terms with a clear technical meaning and an unclear claim wording. The preparatory material available on the discussions leading up to the European Patent Convention shows that even in the framework of Article 69 EPC and its Protocol on Interpretation (see for instance Armitage, "Die Auslegung europäischer Patente", in GRUR Int. 1983, 242; Decker in Stauder/Luginbühl, "Europäisches Patentübereinkommen", 9th edition, Art 69, marginal no. 22, with reference to Stauder, "Die Entstehungsgeschichte von Art 69(1) EPÜ und Art 8(3) StraßbÜ über den Schutzbereich des Patents", GRUR Int. 1990, 793, 799), it was never the scope to exclude what on the clear meaning was covered by the terms of the claims. Accordingly, many decisions of the Boards of Appeal have concluded that a discrepancy between the claims and the description is not a valid reason to ignore the clear linguistic structure of a claim and to interpret it differently (see, for example, T 431/03, Reasons 2.2.2; T 1597/12, Reasons 3.2.1; T 1249/14, Reasons 1.5). The description cannot be used to give a different meaning to a claim feature which in itself imparts a clear, credible technical teaching to the skilled reader (T 1018/02, Reasons 3.8; T 1391/15, Reasons 3.5). On a similar note, the board in T 197/10 (Reasons 2.3) held that, in the event of a discrepancy between the claims and the description, those elements of the description not reflected in the claims are not, as a rule, to be taken into account for the examination of novelty and inventive step.

13.2 In paragraphs [0017] and [0018] of the patent, in what constitutes the general part of the description, different aspects of the protruding parts are described. The description continues in paragraph

[0019] by indicating that "[t]he machining device may also comprise a steering device". In the board's view, this is an unequivocal statement that the protruding parts and the steering device must be considered **different components** of the machining device. Paragraph [0019] of the patent then explains how the steering device controls the direction of the machining device: "by deviating the machining device from the direction of the longitudinal axis of the pipe or keeping the machining device in a certain direction". Similarly, in the context of a method for machining the joint area of a pipe system using the machining device described before, paragraph [0025] of the patent points out that the longitudinal axis of the machining device is controlled "e.g. deviated from the direction of the longitudinal axis of the thinner pipe using the steering device or [...] kept in a certain direction using the steering device, e.g. in the direction of the thinner pipe". This is understood by the board as meaning that the steering device is adapted both to change and to maintain the relative direction of the machining device, in accordance with the interpretation given in point 11. above.

13.3 The detailed description of the patent concerns different machining devices illustrated in the drawings of Figures 1 to 6b. Following paragraphs [0032] to [0038], each of the examples of Figures 3a, 3b, 4c to 4e and 5b has an actual physical component performing the task of steering the machining device. In the case of Figures 3a and 3b, this is additionally acknowledged in paragraph [0027]. The steering device either appears in the form of a bendable rope or cable connected to a weight or pulled by hand (Figures 3a, 3b, 4c, 4d and 5b), or as some undefined structure mounted at the rear of the machining device (Figure 4e).

13.4 Despite the persistent reference to "embodiments of the invention" in paragraphs [0027] to [0039], which the opponents have suggested originates from a broader claim wording in the priority application, the examples of Figure 1, 2a, 2b, 4a, 4b, 5a, 6a and 6b do not have a steering device for controlling the direction of the machining device. This becomes particularly evident when reading paragraph [0034], where the machining device of Figure 4b is described as suffering from an "uncontrolled turning tendency" (see lines 26 to 31 of column 7 of the patent) which can only be controlled by a steering device "turning the device away from the direction of the branch line or keeping the rotational axis of the spindle in a certain direction" (see lines 34 to 40 of column 7 of the patent). In the subsequent paragraphs [0035] to [0037], the patent is explicit that the machining device of Figures 4c to 4e, unlike that of Figures 4a and 4b, has such a steering device. Similarly, paragraph [0038] opposes the machining device without steering device of Figure 5a, which is "allowed to turn in an uncontrollable manner as show [sic] in figure 4b" (lines 16 to 20 of column 8 of the patent), to the machining device with a steering device of Figure 5b, which "may be deviated, as needed upwards or downwards using the cable 302 or other suitable steering device as shown also in figures 4c and 4d" (lines 24 to 27 of column 8 of the patent).

13.5 The above passages show that the patent description is consistent in its disclosure of a steering device according to the interpretation given in points 10. and 11. above. Nevertheless, one sentence in paragraph [0030] stands out:

"It should be noted, that because the protruding parts 102 center the spindle 101 in the pipe and keep the rotational axis of the spindle in the direction of the longitudinal axis of the pipe, the springy *protruding parts act as the steering device* of the disc 201 that is in this embodiment the device for removing material" (emphasis by the board).

This mental note made by the drafter of the patent is **unmistakably at variance** with the wording of claim 1 as granted. Not only does it contradict the requirement of a dedicated steering device (see point 10. above), it relies on a manifestly different interpretation of the term "steering" (see point 11. above). As a matter of fact, the protruding parts are essentially passive components; they are only instrumental in positioning the machining device in the pipe. This is due to the underlying mechanics: it is the reaction force acting on a protruding part in contact with the pipe wall that dictates the position of the device in the pipe. The protruding parts are not able to actively change the direction of and, hence, steer the machining device with respect to the longitudinal axis of the pipe.

- 13.6 In line with the case law cited above, it must be concluded that the present case is one where the interpretation of a claim in the light of the description reaches its limits. Taking account of the deviant note in paragraph [0030] would mean ignoring the natural reading of claim 1 (see points 10. and 11. above) and disregarding the extensive contextual information provided by the rest of the description (see points 13.2 to 13.4 above). It can only lead to a technically discrepant claim interpretation which the

skilled person would be unwilling to adopt and would actually deprive the claims of their intended function.

- 13.7 The board is well aware that the Regional Court of Düsseldorf arrived at a different conclusion in its judgment concerning infringement proceedings 4a O 40/19 based on the patent in suit (see in particular pages 13 to 16 of document D29). Also the expert opinion BR8 submitted during the subsequent appeal proceedings which are pending before the Higher Regional Court of Düsseldorf under case number I-2 U 6/20 and the indicative and conditional order issued by the Court on 30 June 2022 seem to confirm the position of the patent proprietor that the protruding parts can act as a steering device in the sense of feature c. (see in particular the second paragraph on page 15 of document BR8 and the second paragraph of section II of document BR11, respectively). However, after having considered all the relevant aspects of the case, the board does not see any reason to deviate from its interpretation of claim 1 as granted, as set out hereinbefore, and concurs with the Market Court of Finland who, in its interim judgment in case number 571/20 concerning infringement proceedings based on a utility model with similar claim wording as the patent in suit, found that a dedicated steering device is required (see in particular points 11, 15 and 16 of document BR5).

- *"the pipe having thinner diameter"*

14. Feature c. further specifies that the steering device is adapted to control the direction of the machining device in relation to the longitudinal axis of "the pipe having thinner diameter of the pipe system". This is understood as referring to the "pipe having smaller diameter of the pipe system" of feature a., namely the

same pipe in which the protruding parts can position at least a part of the machining device.

- *"while removing material"*

15. A structural link between the steering device of feature c. and the protruding parts of feature a. or the material removing means of feature b. is not apparent from claim 1 as granted. The function of the steering device is only expressed in a temporal relationship with the step of removing material from the edges of a hole made to the joint area of the pipe system. The use of the gerund in the expression "while removing material" suggests that the steering device is in charge of removing the material. With a dedicated means for removing material in feature b., however (see also point 10. above), such an interpretation would be illogical. Feature c. is therefore construed in that the material removing means is adapted to remove material from the edges of a hole and that during this process, the direction of the machining device can be controlled by a steering device. The steering device and the removing means should thus be such that they can operate simultaneously.

Main request - added subject-matter

16. The only difference between claim 1 as granted and claim 1 as originally filed lies in the following addition to feature c.:

"c. steering device (301) for controlling the direction of the machining device in relation to the longitudinal axis of the pipe having thinner diameter in the pipe system while removing

material from the edges of a hole made to the joint area of the pipe system."

17. In the decision under appeal, the opposition division held that third amendment introduced subject-matter that extended beyond the content of the application as filed. The board disagrees, for the following reasons.

18. Basis for the amendment can be found in the third paragraph on page 9, in the second and third paragraphs on page 11 and in the paragraph bridging pages 11 and 12, which describe the embodiments of Figures 3a, 4c-d and 5a-b, respectively, of the application as filed. It is true that each of these embodiments discloses a specific steering device 301 in the form of a cable 302 with an optional weight. However, the board is not convinced that a close link between the claim amendment and a specific steering device can be derived from the whole of the documents as filed. The general description of the invention in the fourth and sixth paragraphs on page 4, for example, concerns the removal of material from the edges of a hole without mentioning any bendable rope, cable, weight or other steering device. Similarly, the fourth paragraph on page 6 and the paragraph bridging pages 6 and 7 of the application as filed do not refer to any specific steering device. Actually, examples of steering devices that can be used for controlling the direction of the machining device in relation to the longitudinal axis of a pipe only appear once in the general description of the invention, namely at the end of the second paragraph on page 5, as possible ("may", "e.g.") implementations of the general steering device of claim 1. Moreover, their subordinate role in the context of the machining device of the application as filed is reflected by the clause "it is possible to construct various different steering

devices" in the fourth paragraph on page 11 in the context of the alternative embodiment of Figure 4e. Also the wording "or other suitable steering device" used in the first paragraph on page 12 in the context of the embodiment of Figures 5a-b emphasises the lack of a clearly recognisable functional or structural relationship between the removal of material from the edges of a hole and the specific type of steering device. The opponents' argument that the omission of a specific steering device from claim 1 as granted amounted to an unallowable intermediate generalisation is therefore not persuasive.

19. This view of the matter also extends to the relationship between the protruding parts and the removal of material from the edges of a hole. The opponents argued that it is the protruding parts that remove the edge material of the hole in the detailed embodiments mentioned above, and in particular in Figures 4d and 5b. This may be correct, but the general description of the invention disproves that there is an intricate link between these two elements of the invention. By reference to the fourth paragraphs on both pages 4 and 6 of the application as filed, the patent proprietor has convincingly shown that the edge material removal is not necessarily the result of the action of the protruding parts in the application as filed, let alone that it is linked to the elastic properties of the protruding parts or any abrasive bands mounted thereon, two aspects that are presented as optional throughout the application as filed. Even if the board does not follow the patent proprietor in its argument that the puncturing disc would be a suitable alternative for removing material from the edges of a hole, this does not mean, conversely, that

the protruding parts must be the only component responsible for the edge material removal.

20. In view of the general character of the last sentence of the sixth paragraph on page 4 ("The protruding part [...] may comprise e.g. [...] for removing material [...] e.g. from the edges of a hole made to the joint area"), the board does not follow the opponents' view that further unclaimed aspects, such as "punctured" or "sanded" are linked so closely to the amendment of claim 1 as granted that their omission would extend the claimed subject-matter beyond the content of the application as filed. The board is not convinced that the reference in the third paragraph on page 6 to a "third aspect of the invention", namely a method for machining the joint area of a pipe system, and the abandonment of original method claims 12 to 14 during examination proceedings leads to a different conclusion, particularly considering that with claim 12 as granted the patent still has an independent claim directed to a method of machining the joint area of two pipes of a pipe system.

21. In sum, by requiring the machining device of claim 1 as granted to remove material from the edges of a hole made to the joint area of the pipe system, the amendment in feature c. does not unduly generalise the specific disclosure of the application as filed. The subject-matter of the patent does therefore not extend beyond the content of the application as filed, so that the ground for opposition under Article 100(c) EPC does not prejudice the maintenance of the patent as granted.

be suitable for removing material also from the joint area of a pipe system in accordance with feature b. of claim 1 as granted. Depending on the angle under which the cable or rope acts on the clevis K, the direction of the device can be changed in relation to the longitudinal axis of the pipe. It follows that also a steering device is disclosed in the sense of feature c. of claim 1 as granted.

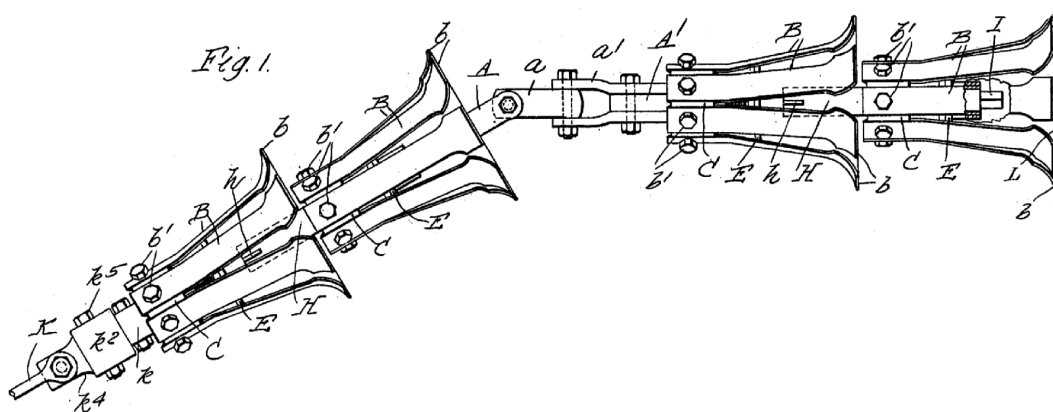
23. The patent proprietor argued that the pipe-cleaning device of document D22 is not suitable for *machining* a pipe system in the sense of claim 1. This view is not shared by the board. The scrapers B of document D22 are made of steel and their outer edges b can be pushed with a certain pressure against the inner surface of a pipe. It therefore stands to reason that the prior-art device can remove material other than accumulations of solid matter from the pipe (page 3, lines 78 to 81). Considering that the pipe material is not specified in claim 1 and the arrangement of a liner sleeve on the inner surface of the pipe is not excluded, the device of document D22 must also be adapted to abrade the material of the generally claimed pipe system. Hence, the device of document D22 is suitable for machining the material of a pipe system comprising a joint area.
24. Any considerations the patent proprietor presented on the degree of contact between the prior-art device and a liner, and on the behaviour or handling speed of the device at the joint area are rejected as irrelevant for the novelty objection over document D22. The opponents correctly pointed out that claim 1 as granted is a device claim defined with relation to a set of pipes for which neither the shape nor the dimensions are given. Furthermore, claim 1 does not mention any

detailed aspects related to the operation of the machining device.

25. In view of the above, the board concludes that document D22 discloses all features of claim 1 as granted, the subject-matter of which thus lacks novelty. In consequence, the ground for opposition under Article 100(a) EPC together with Article 54(1) EPC prejudices the maintenance of the patent as granted. The main request is thus not allowable.

Auxiliary request 1 - lack of novelty

26. The only difference between claim 1 of auxiliary request 1 and claim 1 as granted lies in the additional feature d. (see point XX. above).
27. As set out in point 22. above, the shafts of the different units of document D22 are interconnected through universal couplings in order to transmit rotary movement. Figure 1 of document D22 is reproduced below. It illustrates how the connecting members a, a'



mentioned on page 1, lines 37 to 53 of document D22 link the shaft A of a front unit to the shaft A' of a rear unit. Page 2, lines 75 to 82 of document D22 explains that a socket wrench may be placed into

engagement with the rear end I of the shaft A' so that all shafts of the device may be turned "through the medium of the universal joints or couplings between the shafts". Document D22 thus discloses a bendable torque transmitting member in the sense of feature d.

28. From the wording of claim 1 of auxiliary request 1, no structural or functional link between features b. and d. is apparent so that the patent proprietor's argument directed to the rotation of the material removing means must fail.
29. In conclusion, document D22 discloses a device according to claim 1 of auxiliary request 1. The requirements of Article 54(1) and (2) EPC are therefore not fulfilled. Auxiliary request 1 is not allowable.

Auxiliary request 2 - admittance of late-filed objections

30. At the first oral proceedings held before the board, opponent 1 raised objections of lack of compliance with Article 83 and 123(2) EPC in respect of the combination of dependent claims 8 and 9 of auxiliary request 2. Opponent 1 had already objected in the written appeal proceedings to corresponding claims of the main request and of auxiliary request 4 underlying the contested decision. However, those objections concerned the provision of Article 123(3) EPC (see point 3.2.8 on page 21/48 of opponent 1's reply to the patent proprietor's statement of grounds of appeal). Before the first oral proceedings, no objection of added subject-matter or insufficient disclosure had been brought against claims 8 and 9 of auxiliary request 2.

31. Furthermore, at the first oral proceedings, opponent 1 raised a novelty objection against the subject-matter of claim 1 of auxiliary request 2 in view of the disclosure of document D21. In the written appeal proceedings, however, the opponents had limited its submissions on novelty against the subject-matter of claim 1 of auxiliary request 2 to objections in respect of the disclosure of documents D14 and D22.

32. Therefore, opponent 1's objections under Article 123(2), 83 and 54 EPC raised for the first time at the first oral proceedings constitute an amendment within the meaning of Article 13(2) RPBA 2020, which applies in the case at hand according to Article 25(1) and (3) RPBA 2020.

33. Article 13(2) RPBA 2020 implements the third level of the convergent approach applicable in appeal proceedings. The provision imposes stringent limitations on appeal submissions which are made after notification of a summons to oral proceedings. Where an amendment is made to a party's appeal case at this advanced stage of the proceedings, Article 13(2) RPBA 2020 provides that it will, in principle, no longer be taken into account unless the party concerned has shown compelling reasons why the circumstances are exceptional.

34. One of the reasons invoked by opponent 1 for the late objections was that the requirement "wherein said protruding part (102) comprises a rough sanding surface (106)" in feature a'. of claim 1 of auxiliary request 2 had shifted the claimed subject-matter. In the board's view, this is not a convincing argument for regarding the circumstances at the time of the first oral proceedings exceptional. Not only were the claims of

auxiliary request 2 already filed before the opposition division, the claim amendment goes back to claim 3 as granted and had already been part of claim 1 as early as auxiliary request IV filed by the patent proprietor in reply to the notices of opposition.

35. Opponent 1 further argued that the objections should be considered as a reaction to the board's negative preliminary opinion on all auxiliary requests expressed in its communication pursuant to Article 15(1) RPBA 2020. In the board's view, this could, if at all, justify exceptional circumstances for the patent proprietor, but not for the opponents who had already submitted their objections on auxiliary request 2 in writing.
36. Also opponent 1's argument with regard to the recent change of representative is difficult to follow. In the absence of any indication to the contrary, it must be assumed that all the actions taken by the previous representative of opponent 1 prior to the change reflected the way in which opponent 1 wished to conduct its case and the new representative is bound by them (see T 1904/16, Reasons 16.4). A mere change of representative, which is not so uncommon that it *de facto* qualifies as an exceptional circumstance, would otherwise give a party the opportunity to influence which of their procedural moves have to be considered as belated or not (see T 1646/16, Reasons 3.2).
37. In the absence of cogent reasons justifying exceptional circumstances, the board exercised its discretion under Article 13(2) RPBA 2020 not to take the objections into account that were raised for the first time at the first oral proceedings.

Auxiliary request 2 - added subject-matter

38. The board concurs with the patent proprietor that, apart from the addition "the edges of a hole made to " in feature c., claim 1 of auxiliary request 2 corresponds to a combination of claims 1, 3 and 11 of the application as filed. From the the dependencies in the original claim tree support it is evident that such a combination was originally disclosed.
39. Therefore, opponent 1 did not convincingly argue that the requirements of Article 123(2) EPC were not fulfilled in respect of auxiliary request 2.

Auxiliary request 2 - insufficient disclosure

40. The opponents raised several objections concerning non-compliance with Article 83 EPC.
41. Regarding the location of the protruding parts, the board notes that Figures 3a and 3b of the patent show a detailed embodiment of the machining device of claim 1 of auxiliary request 2. The protruding parts are formed by four elastic lamellae 102 radially projecting from a spindle 101, the removing means by an abrasive band 106 attached to the lamellae, and the steering device by a bendable rope or cable 302 in combination with a weight 303. In addition, the lamellae have a rough sanding surface and the spindle is attached to a flexible cable 105 for transmitting torque. It is evident from the description of the device shown in Figure 1 (paragraph [0028] of the patent) that the lamellae 102 of Figure 3a are arranged symmetrically around the longitudinal axis of the central spindle 101 by means of

corresponding grooves and screws. The arguments of the opponents regarding the connection of the protruding parts within the machining device and the possible impact of an asymmetric configuration on the machine's direction control can therefore not be followed.

42. An exemplary use of the machining device of Figures 3a and 3b is explained in the context of Figures 4c, 4d, and 5b. Paragraphs [0032], [0035], [0036] and [0038] of the patent indicate that the direction of the spindle may be deviated in a controlled manner by the steering device 302 when sanding the edges of a hole made in the joint area between two pipes. In view of the board's interpretation of the steering device (see point 12. above), the opponents' grievance with the lack of steering ability of the protruding parts cannot have any bearing on the question whether the invention is sufficiently disclosed. The mere fact that claim 1 of auxiliary request 2 is broad is not in itself a ground for not considering the claimed invention sufficiently disclosed. Regarding the embodiment of Figure 4e, the opponents have not convinced the board that the skilled person would be unable to provide a steering device for actively controlling the direction of the machining device at a location rearward of the protruding parts.

43. With regard to argument on the size of the hole, the board shares the patent proprietor's view that the skilled person would aim to make a large hole at the joint area of a pipe system as this would require less edge material to be removed. Furthermore, the board agrees that paragraph [0025] of the patent ("at least 1 %, 5% or 10% smaller") provides the skilled person with some guidance as to the relative size of the punctured hole with respect to the diameter of the pipe.

44. Furthermore, it can be expected from the skilled person, who may rely on common general knowledge to supplement the information contained in the patent, that they properly select the dimensions of the claimed machining device in function of the size of the pipe it is supposed to operate in. Even if the angle between the pipes at the joint area is not defined in claim 1 of auxiliary request 2, it stands to reason that the skilled person would take the information in paragraphs [0010], [0034] and [0038] of the patent ("typically however in the angle of 30-60 degrees, most advantageously in the angle of 45 degrees", "at an angle of e.g. 45 degrees") at face value in order to put the claimed invention into practice without undue burden. In this context, the board wishes to emphasise that objections of insufficiency of disclosure that question whether the invention can be carried out over the entire breadth or the whole range of the claims have their roots in case law that was mainly developed in the field of chemistry for inventions where a central aspect of the claimed invention is a range of compositions or of parameter values (see T 2773/18, Reasons 3.2, T 1983/19, Reasons 2.1.3, and T 500/20, Reasons 3.6). In the field of mechanics, however, such objections are rarely successful. In the case in hand, the skilled person would readily exclude exotic embodiments that were not used in practice, such as pipes arranged at a very small angle relative to one another, even if these would theoretically fall under the claimed subject-matter. Considering the board's view on this objection, which the patent proprietor requested to dismiss because late-filed, there was no need to discuss the issue of admittance.
45. Also the opponents' objection against the mode of operation shown in Figure 4d of the patent is not

convincing. Attaching the cable 302 to the front part of the machining device and pulling it by hand from a top opening of a main pipe - in case of a building this could be the roof opening of the soil stack - would not require an undue effort for the skilled person.

46. A further objection of insufficiency of disclosure was raised by reference to videos BR4, BR19 and BR20 from the hand of the patent proprietor, which allegedly proved that the sanding quality at the edges of a hole was unacceptable when machined by the claimed device, contrary to the requirement formulated in paragraph [0034] of the patent. None of the videos, however, discloses a steering device that is able to actively control the direction of the machining device in relation to the longitudinal axis of a pipe into which it is inserted, in the interpretation of point 12. above (see BR4: starting at 1'27"; BR19 starting at 4'06"; BR20: starting at 0'18"). The objection must therefore fail.
47. For the reasons set out above, the opponents have not convincingly shown that the contested patent does not disclose the invention of claim 1 of auxiliary request 2 in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The requirements of Article 83 EPC are therefore fulfilled.

Auxiliary request 2 - lack of novelty

48. In the board's view, document D22 does not disclose a rough sanding surface. The only information that can be derived from page 1, lines 54 to 61 of document D22 is that the scrapers are made of steel and that the edges are shaped to conform to the curvature of the inner

surface of the pipe to be cleaned. No mention is made of the roughness of the scraper edges, let alone of the use of sandpaper to scratch the inner surface of the pipe.

49. Regarding document D14, the bands 323 of industrial diamonds illustrated in Figure 6 are provided on the exterior of a solid body 321 (column 3, lines 35 to 41). Similarly to the bands 119 of industrial diamonds provided on the frusto-conical body 120 in Figure 4, they are attached to the outer surface, but do not protrude, i.e. project or stick out from the machining tool (see point 8. above). The board thus agrees with the patent proprietor that the reaming tool of document D14 does not have any protruding parts in the sense of feature a'. of claim 1 according to auxiliary request 2.
50. In sum, it has not been convincingly shown by the opponents that the subject-matter of claim 1 of auxiliary request 2 lacks novelty over document D22 or document D14. The same applies to the method of claim 10 of auxiliary request 2, which *de facto* defines a use of the device of claim 1. The requirements of Article 54(1) and (2) EPC are therefore fulfilled.

Auxiliary request 2 - lack of inventive step

(a) Starting from document D21

51. In a first line of argument, document D21 was considered as a the starting point for the inventive step assessment. There was agreement between the parties that the device known from document D21 comprised not only protruding parts with a rough

sanding surface, but also steerable, actuator operable means for removing material. It was also undisputed that a steering device in the sense of feature c. and a bendable torque transmission member in accordance with feature d. was not disclosed by document D21. The parties' views diverged, however, on feature a'. The patent proprietor held that the overlying plies 25 were too soft to position the device inside a pipe. The board is not convinced by this argument. At least when the plies are rotated and urged radially outwardly into engagement with the inner pipe surface (column 3, lines 27 to 31), the device of document D21 will occupy a position along the central axis of the pipe.

52. The board thus concurs with the opponents that the subject-matter of claim 1 of auxiliary request 2 differs from the device of document D21 in that it comprises a steering device for controlling the direction of the device in relation to the longitudinal axis of the pipe and in that the torque transmission member is bendable. The technical effect of the first distinguishing features lies therein that an uncontrollable turning tendency is prevented when the machine is used to remove material from the edges of a hole, see paragraph [0034] of the patent. The technical effect of the second distinguishing features is that it allows the device to operate in a pipe with bends, see also paragraph [0034] of the patent. A combinative effect going beyond the sum of the individual effects is not apparent to the board. According to paragraph [0034] of the patent (column 7, lines 26 to 31: "the relatively short machining device"), it is the axial length of the machining device rather than the flexibility of the torque transmission shaft that determines whether the device attempts to turn in an uncontrolled manner when entering the thicker pipe from

the thinner pipe. Thus, the claim defines an aggregation of features in which the technical problem underlying the invention consists of two separate partial problems: to prevent an uncontrollable turning tendency when the machine is used to remove material from the edges of a hole and to enable operation in a pipe with bends. For the subject-matter of the claim to be considered inventive, it suffices to show that just one of the distinguishing features is not obvious (see T 345/90, Reasons 5; T 701/91, Reasons 6.4 and 6.5).

53. In the opponents' view, the skilled person would have easily solved the first partial problem by adding a device that maintained or deviated the direction of the machining device known from document D21. The board is not convinced by this argument. First, it has to be considered that, unlike a steering device, a device that *maintains* the direction of the machining device known from document D21 does not necessarily involve an active control of the direction of the machining device (see also point 11. above). Furthermore, the device of document D21 is intended for operation inside "cylinders" (see column 2, lines 19 to 21 and 34 to 36). Pipe systems with bent walls are not mentioned in document D21, let alone branch lines or joint areas formed at the intersection of pipes of smaller and pipes of larger diameters. It is therefore hardly conceivable that the skilled person would have used the device of document D21 also for removing material from the edges of a joint area of two pipes. But even if it were used for this purpose, providing the machining device with a steering device goes beyond what a skilled person would have been prompted to do based solely on its common general knowledge and without the benefit of hindsight knowledge of the invention, in

particular since no evidence of such common general knowledge was submitted by the opponents.

54. Since the board considers that it is not obvious to solve the first partial problem by foreseeing a steering device in the sense of feature c. of claim 1, the question of whether the solution to the second partial problem involves an inventive step having regard to the disclosure of any of documents D7, D14, D22, D25 or D26 may be left open. The opponents have thus not convincingly argued that the subject-matter of claim 1 of auxiliary request 2 does not involve an inventive step starting from document D21.

(b) Starting from document D20

55. A further inventive step objection started from document D20 in combination with document D4. In the opponents' view, it would have been obvious for the skilled person to adapt the drum machine illustrated on page 59 of the product catalogue D20 by adding a steering device disclosed in connection with the tool on pages 67 and 68 of the product catalogue D4. The patent proprietor countered this line of argument by pointing at the different nature of the prior art devices.
56. It is not contested by the opponents that the drum machine of the first catalogue D20 is a rather bulky device designed to clean drains at the moderate speed of 1725 rpm (see "Specifications [...] Motor" on page 59), whereas the device of catalogue D4 is a polishing tool which is driven at rotational speeds up to 25000 rpm (see "Maximum rpm's" on page 67). Moreover, where the machine of document D20 uses a long torque transmission cable unreeled from a drum, the polishing

tool of document D4 is driven by a hand-held actuator through a rigid shaft. Against this background, the board concurs with the patent proprietor that the respective machining devices are not compatible with one another so that the skilled person would not have combined the teachings of documents D20 and D4.

57. The opponents' inventive step objection starting from document D20 is therefore unpersuasive.

(c) Starting from document D25

58. Starting from document D25, the opponents considered the only difference with respect to the subject-matter of claim 1 of auxiliary request 2 to lie in the provision of protruding parts having a rough sanding surface. In combination with either the common general knowledge or with any of documents D14, D21, D4, D6, D8 to D13, D15 to D19 and D31 to D34, the skilled person would have arrived at the claimed subject-matter in an obvious manner.
59. The device illustrated in Figure 3 of document D25 has a flexible shaft 58 with universal joints 56 through which a central pilot drill 54 and a set of cutting slots 50 with carbide tips are rotatively driven. Ball-shaped guides 60 protrude from the shaft for aligning the device in a lateral pipe 16. A rough sanding surface is, however, not disclosed. Nor is there any indication that the machining device comprises a steering device for controlling the direction. The board concludes that subject-matter of claim 1 of auxiliary request 2 differs from the machining device of document D25 by features a'. and c. Also here, the distinguishing features are merely aggregated without functional interdependence.

60. In agreement with the opponents, the technical effect of the distinguishing feature a'. is an enhanced removal of material. The first partial problem is thus how to enhance material removal. Similarly to the inventive step objection starting from document D21, the second partial problem is to prevent an uncontrollable turning tendency when the machine is used to remove material from the edges of a hole (see point 52. above).
61. With regard to the first partial problem, it must be considered that, even if the use of rough sanding surfaces on protruding parts is well-known in the art, the skilled person would have recognised that it goes counter to the teaching of document D25 to use the ball-shaped guides 60, the only protruding components of the prior-art machining device, for removing material from the pipe 16. In addition, the patent proprietor was correct in arguing that the machining device known from document D25 does not remove any material from the edges of a hole. It is clear from the position of the pilot drill 54 and the cutting holes 50 in Figure 3 of document D25 that the prior art device is not suitable for edge material removal. There would thus not have been any motivation for the skilled person to modify the device of document D25 in the way suggested by the opponents.
62. Since the board considers that it is not obvious to solve the first partial problem by foreseeing protruding parts with a rough sanding surface in the sense of feature a'. of claim 1 of auxiliary request 2, the question of whether the solution to the second partial problem involves an inventive step may be left

open. Hence, also the inventive step objection starting from document D25 cannot be successful.

Conclusion on inventive step

63. The opponents have not convincingly shown that the subject-matter of claim 1 of auxiliary request 2 does not involve an inventive step. The same applies to the method of claim 10 of auxiliary request 2, which *de facto* defines a use of the device of claim 1. Therefore, the requirements of Article 56 EPC are fulfilled.

Request for re-opening the debate

64. At the end of the first oral proceedings held on 15 March 2022, the chairman informed the parties that the debate was closed with regard to the issue of claim interpretation and the objections under Article 100(a) in conjunction with Articles 54 and 56 EPC, Article 100(b) and (c) EPC against the claims of the main request and the objections under Articles 123, 54, 56 and 83 EPC against the claims of auxiliary requests 1 and 2. The parties were further informed that the proceedings would be continued in writing, exclusively with respect to the question of adaptation of the description to the claims of auxiliary request 2 (see the penultimate paragraph on page 13/14 of the minutes of the first oral proceedings).
65. By letter dated 16 June 2023, opponent 1 requested to re-open the debate on the interpretation of claim 1 of auxiliary request 2 and on novelty and inventive step, in particular having regard to the prior uses "INTEC" and documents BR12 and BR12b.

66. Pursuant to Article 15(5) RPBA 2020, no submissions may be made by the parties after the closure of the debate unless the board decides to re-open the debate. Moreover, in decision G 12/91 (OJ EPO 1994, 285, Reasons 3) the Enlarged Board of Appeal clarified that, once the debate has been closed, further submissions by the parties must be disregarded unless the decision-making department allows the parties to present comments within a fixed time limit or decides to re-open oral proceedings for further substantive debate of the issues. The Enlarged Board decided in R 10/08 (Reasons 8) that the debate is re-opened only in exceptional cases.
67. The interpretation of claim 1 as granted was discussed at length both before and during the first oral proceedings held before the board. After the main request and auxiliary request 1 had been found unallowable at the first oral proceedings, the discussion moved to the allowability of claim 1 of auxiliary request 2, which differs from claim 1 as granted by an addition to feature a. and a new feature d. The interpretation of these amendments was not disputed by the opponents. Nor did they affect the board's understanding of feature c. in any way. Given that the factual situation did not change after the debate was closed at the end of the first oral proceedings - the parties merely presented their view on the adaptation of the description -, the board did not consider it appropriate to re-open the debate in order to discuss the interpretation of claim 1 of auxiliary request 2.
68. Opponent 1's argument that the debate had to be re-opened because the admittance of the prior uses "INTEC"

and documents BR12 and BR12b had not been discussed at the first oral proceedings did not convince the board. The reasons are as follows. The allegation of the public prior uses "INTEC", including documents BR14 to BR16 and video BR17 filed in support thereof as well as the offer to hear four witnesses, was presented for the first time with opponent 1's reply to the patent proprietor's statement of grounds of appeal in the context of novelty and inventive step objections raised against the independent claims of the patent as granted and of auxiliary request 4 underlying the contested decision (see points 3.2.3, 3.2.4 and 3.2.6 of that reply). In points 35 to 42 of its communication pursuant to Article 15(1) RPBA 2020 in preparation of the first oral proceedings, the board gave its provisional view that it was not minded to admit documents BR12, BR12b or the allegations of public prior uses "INTEC" into the appeal proceedings under the provision of Article 12(4) RPBA 2020, because opponent 1 could and should have submitted them in the proceedings before the opposition division and because none of them appeared *prima facie* relevant in view of the board's preliminary opinion on feature c. of claim 1 as granted. During the first oral proceedings, after having discussed the novelty and inventive step in respect of the subject-matter claimed in auxiliary request 2, the opponents when asked by the chairman declared that they did not have any further novelty or inventive step objections (see sixth paragraph on page 7/14 of the minutes of 15 March 2023). They did not mention or make reference to the alleged public prior uses "INTEC" or to documents BR12 or BR12b. In these circumstances, the only conclusion that could be drawn was that opponent 1 either did not wish to pursue its original novelty and inventive step objections on the basis of the alleged public prior uses "INTEC" or

documents BR12 and BR12b, or that these objections were not extended to the subject-matter claimed in auxiliary request 2. Under these circumstances, the board did not see any justification for re-opening the debate.

69. Whilst it is understandable that opponent 1 deplores that claim 1 of auxiliary request 2, in particular the steering device of feature c., if it were understood in a less restrictive manner, could have resulted in a different assessment of novelty and inventive step, which in turn might affect the way national courts of competent jurisdiction decide on questions of infringement, the board cannot accept the premise that it should re-open the debate and examine the objections of novelty and inventive step anew for a broader claim interpretation, which neither the board nor the opponents endorse, in order to thwart potential findings of infringement negatively affecting the opponents.
70. Finally, the board does not subscribe to opponent 1's view that the debate on claim interpretation and novelty and inventive step cannot be closed before the adaptation of the description is discussed. Apart from the fact that it is the normal way of proceeding to adapt a description only after the establishment of an allowable claim set and that, if appeal proceedings are not accelerated, a case is often remitted to the opposition division for adaptation of the description, opponent 1's view on this matter is based on the circular argument that the adaptation of the description necessarily has an impact on the understanding of a claim which led to the need for adapting the description in the first place. But even if it were the case, this argument is not persuasive since it actually speaks against pre-emptively re-

opening the debate before the issue of adaptation of the description is settled.

71. In view of the above, the board therefore exercised its discretion pursuant to Article 15(5) RPBA 2020 not to re-open the debate closed at the conclusion of the first oral proceedings.

Adaptation of description

72. The first question to be addressed is whether or to which extent there is a legal basis for adapting the description under the present circumstances.
73. Article 84 EPC requires that *the claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.*
74. This provision, in its second sentence, covers three distinct requirements, amongst which "supported by the description" is a requirement of its own (see e.g. T 1024/18, Reasons 3.1.7; T 2293/18, Reasons 3.3.5, and G 3/14, Reasons 48: "these requirements", "the requirements of Article 84 EPC"). Essentially, support by the description is required to avoid inconsistencies between the claims and the description and/or the drawings which could cast doubt on the extent of protection conferred by the patent (T 1149/97, Reasons 6.1.11; T 1808/06, Reasons 2; T 2766/17, Reasons 6; T 3097/19, Reasons 24; T 169/20, Reasons 1.2.5).
75. There is a large body of case law developed by the Boards of Appeal, with which the present board concurs, according to which Article 84 EPC is the basis for

bringing the description in line with the amended claims in order to avoid inconsistencies (see, for example, T 977/94, Reasons 6.1; T 1808/06, Reasons 2; T 2293/18, Reasons 3.3.5). Any disclosure in the description and/or drawings inconsistent with the amended subject-matter should normally be deleted or a statement should be added that an embodiment is not covered by the claims (see e.g. T 1808/06, Reasons 2).

76. The requirements of Article 84 EPC apply - like all other requirements of the EPC - *mutatis mutandis* to claims which have been amended in opposition proceedings (Article 101(3) EPC). However, Rule 80 EPC establishes a limit to any amendment made to the patent in opposition proceedings, namely that it must be occasioned by grounds of opposition specified in Article 100 EPC, even if the respective ground has not been invoked by the opponent (see T 323/05, which concerned a request to adapt the description).
77. In opinion G 10/91 (OJ EPO 1993, 420, Reasons 19.) the Enlarged Board of Appeal concluded that in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, only such **amendments** are to be fully examined as to their compatibility with the requirements of the EPC. The Enlarged Board in decision G 3/14 (OJ EPO 2015, 102) considered this to mean that the subject-matter to be examined must have some direct nexus with the amendment (Reasons 16 and 17), and subsequently concluded that, in considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that, the

amendment introduces non-compliance with Article 84 EPC (Reasons 81).

78. In the present case, claim 1 of auxiliary request 2 has been amended by the addition of following features to claim 1 as granted:

(i) wherein said protruding part (102) comprises a rough sanding surface (106),

(ii) a bendable torque transmitting member.

79. Pursuant to decision G 3/14, objections under Article 84 EPC are thus admissible insofar as they arise out of the addition of features (i) and (ii).

80. The board is satisfied that the patent proprietor's amendments to paragraphs [0007], [0017] and [0021] of the description filed with letter dated 16 June 2023 are both necessary and admissible under Article 84 EPC, Rule 80 EPC and decision G 3/14. Not only are they directed to non-compliances with the third requirement of Article 84 EPC (support by the description), which were not already present in the granted patent but were introduced by the addition of features (i) and (ii) to claim 1 as granted, they can also be regarded as occasioned by the ground for opposition of lack of sufficient disclosure, in accordance with Rule 80 EPC.

81. This was not disputed by the opponents, who argued that the amended description still contained passages that were inconsistent with the subject-matter of claim 1 of auxiliary request 2. The board agrees. The detailed description from paragraph [0027] to paragraph [0039] refers to each of Figures 1, 2a, 2b, 4a, 4b and 6 as illustrating machining devices of "an embodiment of the

(present) invention" despite the absence of a steering device in the sense of feature c. of claim 1 (see point 13.4 above). Also, the note at the end of paragraph [0030] contradicts the requirement of claim 1 that the machining device has an actual physical component able to perform the task of steering the machining device (see point 13.5 above).

82. Nevertheless, these inconsistencies between claim 1 of auxiliary request 2 and the amended description of the patent do not arise out of the amendments made in auxiliary request 2; they already existed in the patent as granted. In fact, feature c. relating to the steering device remained unamended after grant. And the addition of features (i) and (ii) did not change the claimed subject-matter concerning the steering device vis-à-vis the claims as granted. Therefore, the board fails to see a direct nexus between the amendments to claim 1 and the passages identified by the opponents, the removal or adaptation of which is thus not possible in view of decision G 3/14.

83. In this context, it is worth noting that the Enlarged Board of Appeal in decision G 3/14 concluded that a granted claim may turn out not to comply with Article 84 EPC but that "such non-compliance must be lived with" (see Reasons 55). By analogy, the same must apply in respect of a claim amended in opposition proceedings where a non-compliance with Article 84 EPC - whether it concerns a lack of clarity or a lack of support by the description - already existed in the patent as granted. Since neither clarity nor lack of support as expressed in Article 84 EPC constitute a ground for opposition under Article 100 EPC, it must thus be accepted that the removal of an inconsistency between description and claims is not be possible in such a case (see, for

example, T 433/97, Reasons 4, and T 367/96 of 3 December 1997, Reasons 6.2, both cited by the Enlarged Board of Appeal in decision G 3/14, and T 1808/06, Reasons 2, T 2391/18, Reasons 4).

84. In view of the above, the board concludes that the inconsistencies put forward by the opponents between the steering device of feature c. and the passages of the amended description indicated above are not open to examination in opposition appeal proceedings, in accordance with decision G 3/14.

85. As regards the case law cited by opponent 1 in this respect, the board observes that T 1024/18 refers to a case in which an inconsistency between claims and description, and thus a lack of compliance with Article 84 EPC, was caused by a post-grant amendment introduced into the claims, and T 3097/19 to a case in which the description was held to be inconsistent with the amended claims after an appeal against a decision of the examining division. These cases are therefore fundamentally different from the present one in which the lack of compliance with Article 84 EPC relating to feature c. as interpreted by the board was not introduced by the amendment to auxiliary request 2, but had previously existed in the granted claims.

86. Thus the opponents' request to revoke the patent, due to the absence of further amendments to the description, is lacking a legal basis and must be rejected.

Referral of questions to the Enlarged Board of Appeal

87. For a board to refer questions to the Enlarged Board of Appeal under Article 112(1)(a) EPC, certain conditions need to be fulfilled. Either the board considers that a decision is required for the purpose of ensuring uniform application of the law, or in order to decide on a point of law of fundamental importance that arises. The referral questions must be of considerable practical relevance, rather than have merely theoretical significance, as would be the case if the referring board were to reach the same decision on the basis of the file regardless of the answer to the referred question (G 3/98, OJ EPO 2001, 62, Reasons 1.2.3). The answer to the referred questions must be essential for the board to reach a decision on the appeal in question (T 154/04, Reasons 2).
88. These conditions do not apply in the present case. As regards question A (see point XVIII. above), the Enlarged Board of Appeal decided in G 3/14 that the extent to which the requirements of Article 84 EPC may be examined for the purposes of Article 101(3) EPC is restricted, namely only when, and then only to the extent that, an amendment of the patent introduces non-compliance with Article 84 EPC. A full examination of the patent in respect of Article 84 EPC is thus not allowable in opposition proceedings. Whether or not the interpretation of a claim feature leads to an inconsistency with the patent description is irrelevant to this issue. What counts is whether the inconsistency has arisen out of the amendments made during opposition proceedings. The board sees no reason for deviating from decision G 3/14 in the present case. Nor has opponent 1 provided any convincing argument or referred to any conflicting decisions of the Boards of Appeal or

to a non-uniform application of the case law on this matter, which would render it necessary to refer the issue again to the Enlarged Board. Hence, no decision is required for the purpose of ensuring uniform application of the law, nor has a point of law of fundamental importance arisen.

89. Questions B and C are understood as directly referring to question A ("Does it change the situation [...]"). Considering that the limits the Enlarged Board in decision G 3/14 has set to the extent to which the requirements of Article 84 EPC can be examined in opposition proceedings are not defined or in any way bound by the interpretation of a claim feature, also questions B and C must be answered in the negative. The board further remarks that, although a lack of uniformity between the law as applied by the Boards of Appeal and national courts could, in theory, bring to the fore a point of law of fundamental importance (T 712/10, Reasons 8.2), the purpose of referring a question to the Enlarged Board of Appeal cannot be to ensure uniform application of the law *between national courts*. Having said this, the board is at a loss to know how the answers to questions B and C could be considered essential for the board to reach a decision on the appeal in question, given that the issue at hand - the extent of examination in opposition proceedings with respect to the requirements of Article 84 EPC - has already been decided by the Enlarged Board in G 3/14.

90. As regards question D, it is undeniably very general. The board fails to see to which extent it differs from the question under A. But regardless of the answer to this question, it cannot possibly affect the board's decision in the present case. It is therefore not

relevant for deciding on the specific situation under consideration, but is of purely theoretical interest. This is no justification for a referral to the Enlarged Board of Appeal under Article 112(1) (a) EPC.

91. In view of the above, opponent 1's request for referral is refused.

Order

For these reasons it is decided that:

1. The request for referral of questions of law to the Enlarged Board of Appeal is refused.
2. The decision under appeal is set aside.
3. The case is remitted to the opposition division with the order to maintain the patent as amended on the basis of the following documents:
 - claims: 1 to 10 of auxiliary request 2, filed with letter of 29 July 2021,
 - description: paragraphs 1 to 40, filed with letter of 16 June 2023,
 - drawings: figures 1 to 6b of the patent specification.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated