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**Datasheet for the decision  
of 2 July 2024**

**Case Number:** T 0849/22 - 3.2.03

**Application Number:** 15833528.1

**Publication Number:** 3183505

**IPC:** F24D3/14, F24D3/12, E04B5/48,  
E04F15/18, E04F15/02, F24D13/02

**Language of the proceedings:** EN

**Title of invention:**

UNDERLAYMENT FOR POSITIONING HEATING ELEMENTS AND FLOOR  
ASSEMBLY

**Patent Proprietor:**

Progress Profiles SPA

**Opponents:**

Isola AS  
Warmup Plc  
Wischemann Kunststoff GmbH  
Elements S.r.l.

**Headword:**

**Relevant legal provisions:**

EPC Art. 54(2), 111(1)  
RPBA 2020 Art. 11, 12(4), 12(6), 13(2)

**Keyword:**

Novelty - main request (no) - auxiliary request (yes)  
Appeal decision - remittal to the department of first instance  
(yes)  
Remittal - special reasons for remittal - fundamental  
deficiency in first-instance proceedings (yes)  
Amendment to case - amendment within meaning of Art. 12(4) RPBA  
2020 - amendment overcomes objection (yes)  
Late-filed request - admitted in first-instance proceedings  
(no) - should have been submitted in first-instance  
proceedings (no) - error in use of discretion at first  
instance (yes) - admitted (yes)  
Amendment after summons - exceptional circumstances (no) -  
taken into account (no)

**Decisions cited:**

T 0368/16, T 0222/16

**Catchword:**



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Case Number: T 0849/22 - 3.2.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.03**  
**of 2 July 2024**

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**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted on 24 January 2022  
revoking European patent No. 3183505 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**

C. Herberhold

**Members:**

R. Baltanás y Jorge

D. Prietzel-Funk

## **Summary of Facts and Submissions**

- I. European patent No. 3 183 505 B1 relates to an *"underlayment for positioning heating elements and floor assembly"*.
- II. Four oppositions were filed against the patent, which were based on Article 100(a) EPC in conjunction with Articles 54 EPC and 56 EPC, on Article 100(b) EPC and on Article 100(c) EPC.
- III. The present appeal is against the decision of the opposition division to revoke the European patent. The opposition division did not admit either the main request or auxiliary requests 1 to 3, 5 to 11 or 13. Auxiliary request 4 had been abandoned prior to the oral proceedings before the opposition division. Auxiliary request 12 was considered not allowable for lack of novelty (Article 54(2) EPC) and auxiliary requests 14 to 16 were held not allowable for lack of clarity (Article 84 EPC).
- IV. This decision was appealed by the patent proprietor (the appellant).
- V. Requests

At the end of the oral proceedings the requests were as follows:

The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the New Main Request (NMR) as filed with the statement setting out the grounds of appeal, or, alternatively, on the basis of one of New

Auxiliary Requests 1 to 3 and 5 to 11 (NAR 1 to 3 and 5 to 11), Auxiliary Request 12 (AR 12), New Auxiliary Request 12A (NAR 12A), New Auxiliary Requests 14 to 16 (NAR 14 to 16) or Additional Auxiliary Requests 17 and 18 (AAR 17 and 18). The appellant further requested that the case be remitted to the opposition division for further prosecution.

Respondent 1 (opponent 1), respondent 2 (opponent 2) and respondent 4 (opponent 4) requested that the case not be remitted to the opposition division and that the appeal be dismissed. Procedurally, they also requested that none of the claim requests filed for the first time with the statement setting out the grounds of appeal (i.e. the NMR, NAR 1 to 3, NRA 5 to 11, NAR 12A, NAR 14 to 16 and AAR 17 and 18) be admitted into the appeal proceedings.

Respondent 3 (opponent 3) did not file a reply to the statement setting out the grounds of appeal and did not attend the oral proceedings.

VI. Claim 1 of the New Main Request (NMR) reads as follows (with the feature labelling as adopted by the parties; amendments as compared to claim 1 as originally filed are marked in bold; amendments as compared to claim 1 as granted are underlined):

- A)** *An underlayment **(1)** adapted to receive and secure at least one heating element of a radiant heating assembly, comprising:*
- B)** *a base material **(6)** defining an area and having a first side and a second side disposed opposite the first side;*

- C) a first protrusion **(2a)** disposed on the first side of the base material **(6)**, the first protrusion **(2a)** configured as a geometric shape having at least two sides, wherein ~~[one]~~ **two** or more of the at least two sides include~~[s]~~ an element receiving surface **(9)**; and
- D) a second protrusion **(2a)** disposed on the first side of the base material and adjacent to the first protrusion **(2a)**, the second protrusion **(2a)** configured as a geometric shape having at least two sides, wherein ~~[one]~~ **two** or more of the at least two sides include~~[s]~~ an element receiving surface **(9)**, and
- E) wherein **one of** the element receiving surfaces **(9)** of the second protrusion **(2a)** is offset from and facing **one of** the element receiving surfaces **(9)** of the first protrusion **(2a)** forming an element receiving cavity **(3)** therebetween; and
- F) wherein the element receiving cavity **(3)** is configured to contain at least one heating element of the radiant heating assembly,
- G) **characterised in that the first and second protrusions (2a) further comprise at least one cutout portion (10) extending partially into the first and second protrusions (2a) respectively.**

The NMR is based on the main request dealt with in the decision (the MROP) - i.e. the request filed on 5 October 2021, after the expiration of the time limit set in accordance with Rule 116(1) EPC - with the **only amendment** being in claim 4, which now reads as follows (amendments as compared to the MROP filed on 5 October 2021 are marked in bold):

*The underlayment of claim 1, wherein said element receiving surface (9) is one of an arcuate*

*receiving surface, **and** an angular receiving surface  
~~and a linear receiving surface.~~*

The MROP was based on the main request filed on 8 June 2020 with the patentee's reply to the notices of opposition, with the **only amendment** being the deletion of dependent claim 15.

Independent claim 6 of the NMR consists basically of a floor assembly comprising the underlayment layer defined in claim 1. Claim 6 has been amended as compared to originally filed claim 8 in a manner corresponding to that of claim 1.

VII. Claim 1 of NAR 1 is based on claim 1 of the NMR, wherein feature G) has been replaced by the following feature, i.e. feature G1) (amendments marked in bold):

**G1)** *characterised in that the first and second protrusions (2a) further comprise at least one cutout portion (10) extending **from a respective top surface (7) of the first and second protrusions (2a)** partially into the first and second protrusions (2a) respectively, **and wherein each of the at least one cutout portion (10) of the first and second protrusions (2a) is different from the element receiving cavities (3).***

VIII. Claim 1 of NAR 2 is based on claim 1 of NAR 1, wherein feature G1) has been replaced by the following feature, i.e. feature G2) (amendments marked in bold):

**G2)** *characterised in that the first and second protrusions (2a) further comprise at least one cutout portion (10) **configured as a hole and** extending from a respective top surface (7) of the*



*first and second protrusions (2a) partially into the first and second protrusions (2a) respectively, and wherein each of the at least one cutout portion (10) of the first and second protrusions (2a) is different from the element receiving cavities (3).*

IX. Claim 1 of NAR 3 is based on claim 1 of NAR 1, wherein feature G1) has been replaced by the following feature, i.e. feature G3) (amendments marked in bold):

**G3)** *characterised in that the first and second protrusions (2a) further comprise at least one cutout portion (10) extending from a respective top surface (7) of the first and second protrusions (2a) partially into the first and second protrusions (2a) respectively, wherein each of the at least one cutout portion (10) of the first and second protrusions (2a) is different from the element receiving cavities (3), and wherein each of the at least one cutout portion (10) of the first and second protrusions (2a) is configured as a hole having a circular cross section when viewed perpendicular to the respective top surface (7).*

Claim 6 of NAR 3 reads as follows (amendments as compared to claim 6 of NAR 1 are marked in bold):

*A floor assembly, comprising: an underlayment layer (1) having a base material (6) defining an area and having a first side and a second side disposed opposite the first side, a first protrusion (2a) disposed on the first side of the base material (6), the first protrusion (2a) configured as a geometric shape having at least two sides, wherein two or more of the at least two sides include an element receiving surface (9), and a second*

*protrusion (2a) disposed on the first side of the base material (6) and adjacent to the first protrusion (2a), the second protrusion (2a) configured as a geometric shape having at least two sides, wherein two or more of the at least two sides include an element receiving surface (9), and wherein one of the element receiving surfaces (9) of the second protrusion (2a) is offset from and facing one of the element receiving surfaces (9) of the first protrusion (2a) forming an element receiving cavity (3) therebetween; and wherein the element receiving cavity (3) is configured to contain at least one heating element of the radiant heating assembly; and a heating member (5) positioned between the first and second protrusions (2a) wherein the first and second protrusions (2a) secure the heating member (5), characterised in that the first and second protrusions (2a) further comprise at least one cutout portion (10) extending from a respective top surface (7) of the first and second protrusions (2a) partially into the first and second protrusions (2a) respectively, wherein each of the at least one cutout portion (10) of the first and second protrusions (2a) is different from the element receiving cavities (3), **and wherein each of the at least one cutout portion (10) of the first and second protrusions (2a) is configured as a hole having a circular cross section when viewed perpendicular to the respective top surface (7).***

- X. NAR 1 to 3 differ from auxiliary requests 1 to 3 filed on 5 October 2021 (ARop 1 to 3) only in the same amendment to dependent claim 4 as that in the NMR as compared to the MROP (see point VI above).

XI. Prior art

The following document was cited both in the statement setting out the grounds of appeal and during the opposition proceedings, and is relevant to this decision:

D1: US 2014/0069039 A1

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

(a) Admittance of the NMR and of NAR 1 to 3 and 5 to 11

The NMR and NAR 1 to 3 and 5 to 11 were filed as a reaction which was justified in view of the circumstances and which was made at the first possible opportunity, i.e. at the time of filing the statement setting out the grounds of appeal.

The criterion used by the opposition division to decide on the admittance of the main request filed on 5 October 2021 (the MRop) was wrong, since claim 1 - which *prima facie* had not been considered novel - had not been amended compared with the main request that had been filed in a timely manner with the patent proprietor's reply to the notices of opposition (the MRrep), and since claim 4 - which *prima facie* had not been considered to be compliant with Rule 80 EPC - was also unamended compared with the MRrep. Furthermore, the case law of the boards of appeal did not support the use of Rule 80 EPC within the context of admittance since this legal provision related only to the allowability of amendments.

The chapter of the Guidelines for Examination cited by respondent 2 (E-VI, 2.2.3) referred to late-filed **amendments**. The only amendment in the MOp was the deletion of claim 15, which actually served to shorten the necessary discussion. The cited passage of the Guidelines did not support a discussion about the *prima facie* allowability of unamended claims 1 and 4 when deciding about the admittance of the MOp.

The application of a wrong criterion for assessing admittance *de facto* prevented the appellant from filing the NMR at that stage of the proceedings since claim 1 was identical to claim 1 of the MOp and therefore it would not have been admitted.

The NMR and NAR 1 to 3 and 5 to 11 were only amended as compared to the requests not admitted by the opposition division in order to overcome the Rule 80 EPC objection which had been raised for the first time during the oral proceedings before the opposition division. Claim 4 was amended for this purpose by the deletion of the alternative which had been added, thus it was returned to the wording of claim 4 as granted. This amendment simplified the proceedings since it reduced the number of issues to be discussed and did not give rise to new objections. Consequently, it was not detrimental to procedural economy.

(b) The NMR, novelty over D1

The conic cavity or bowl (20) delimited by the stepped walls (22) was not identified as a "cutout" in D1.

The conic cavity or bowl (20) did not extend **partially** into each protrusion but completely, as shown in Figure 1 of D1. Furthermore, the disclosure of a cavity

"with less of a depth" in paragraph [0036] had to be read within the context of the previous paragraphs. Consequently, the feature "extending partially" was not disclosed in a clear and unambiguous manner in D1.

Therefore, feature G) was not disclosed in D1 and the subject-matter of claims 1 and 6 was novel over this document.

(c) NAR 1 and 2, novelty over D1

Since the respective independent claims 1 and 6 of NAR 1 and 2 contained feature G), these requests were also novel over document D1.

(d) NAR 3, novelty over D1

The term "circular" had a clear and well-defined meaning for the skilled person, which could not be confused with an octagonal shape rounded at the corners such as the one shown in D1.

The new objection based on the term "conic", which was raised for the first time during the oral proceedings before the Board by respondent 2, was late filed and should not be admitted into the proceedings under Article 13(2) RPBA. Furthermore, the objection was not relevant since the term was only used within the context of the embodiments shown in the figures, all of which relate to a cone having a non-circular cross section.

(e) Remittal to the opposition division

A remittal of the case to the opposition division was justified in view of the circumstances since several

issues had to be addressed within the new framework of discussion which had never been the subject of the opposition proceedings.

XIII. The respondents' arguments, where relevant to this decision, can be summarised as follows:

(a) Admittance of the NMR and of NAR 1 to 3 and 5 to 11

The clear allowability test used by the opposition division when deciding not to admit the NMR or NAR 1 to 3 and 5 to 11 was correctly applied and since no error was apparent in this context, the Board should not admit the pending requests on the grounds of Article 12(6) RPBA, first paragraph.

The opposition division was bound by the Guidelines for Examination, which stated in chapter E-VI, 2.2.3 of the current version that if objections are presented in the annex to the summons issued by the opposition division and the patent proprietor files a new request in response, the clear allowability of the whole request had to be analysed in order to decide on its admittance. The issue of novelty was raised in the annex to the summons and the MOp was filed in response. Thus, the opposition division was entitled - and actually obliged - to assess the clear allowability of the MOp **as a whole**, as indicated in chapter H-II, 2.7.1 of the Guidelines for Examination.

The appellant could and should have filed the NMR and NAR 1 to 3 and 5 to 11 during the oral proceedings before the opposition division since the amendment made in claim 4 was the most immediate way of addressing the objection on the grounds of Rule 80 EPC. Consequently,

the requests were late filed and were not to be admitted into the appeal proceedings on the grounds of Article 12(6) RPBA, second paragraph.

The alleged procedural violation by the opposition division was not substantial since it had no impact on the decision. Thus, this could not justify the late filing of the NMR and NAR 1 to 3 and 5 to 11.

Finally, these requests were also *prima facie* not allowable with regard to other issues, namely clarity and added subject-matter. The Board should therefore not admit them into the appeal proceedings under Article 12(4) RPBA, since admitting them would be contrary to the principle of procedural economy.

(b) The NMR, novelty over D1

Document D1 disclosed all of the features of claims 1 and 6, and in particular feature G), since the conic cavity or bowl shown in D1 corresponded to a "cutout portion" within the meaning of the claims. This cutout portion extended partially into the protrusions as shown in Figure 1, Figure 4 and paragraph [0036] of D1.

(c) NAR 1 and 2, novelty over D1

The cutout portions ("conic cavity or bowl 20") of D1 extended from a respective top surface of the first and second protrusions (see Figure 1) and were different from the element receiving cavities defined by the side walls (16) of the protrusions (18).

Furthermore, the conic cavity or bowl (20) represented a "hole" within the meaning of claims 1 and 6.

Consequently, neither NAR 1 nor NAR 2 could overcome the novelty objection over D1.

(d) NAR 3, novelty over D1

Firstly, the term "circular" encompassed the concept "partially circular" in particular since Figure 5 of the contested patent - which was the basis of this added feature in the originally filed application - disclosed circular and rectangular holes. Partially circular holes were anticipated by the rounded cross section of the hole shown in Figure 1 of D1.

Secondly, the disclosure of D1 was not limited to the embodiments shown in the figures. The description of D1 explained that a "**conic** cavity of bowl" could be present in the protrusions (see paragraphs [0007], [0034] and [0035]) and that the embodiments shown in the figures were mere examples (see paragraph [0042]). The combinations of claim 1 plus claim 6 and claim 15 plus claim 19 also anticipated a "conic cavity" at the protrusions. Since the usual meaning of "conic" implied a circular cross section, D1 also anticipated this added feature.

The objection based on the term "conic" was a new argument in reaction to the preliminary opinion of the Board and was therefore to be admitted in view of the circumstances.

(e) Remittal to the opposition division

A remittal of the case to the opposition division was not justified in view of the *prima facie* relevance of the objections raised against NAR 3.



Procedural efficiency required an assessment of inventive step starting from D1 and *prima facie* compliance with Article 123(2) EPC before a remittal of the case to the opposition division.

## **Reasons for the Decision**

### 1. Rule 115(2) EPC and Article 15(3) RPBA

Respondent 3 did not attend the oral proceedings, as it had announced with its letter dated 27 June 2024.

The oral proceedings were thus continued without this party in accordance with Rule 115(2) EPC and Article 15(3) RPBA.

### 2. Admittance of the NMR, NAR 1 to 3 and 5 to 11 - Articles 12(4) and (6) RPBA

#### 2.1 Sequence of relevant events during the opposition proceedings

2.1.1 The patent proprietor filed an amended main request (the MRrep) and four auxiliary requests (ARrep 1 to 4) with its reply to the four notices of opposition. These requests were **filed in a timely manner**.

2.1.2 In reply to the summons for oral proceedings, the patent proprietor filed auxiliary requests 5 to 15 within the time limit set in accordance with Rule 116(1) EPC.

2.1.3 One day before the oral proceedings (i.e. on 5 October 2021), the patent proprietor filed a new main

request (the MOp) and auxiliary requests 1 to 3 (ARop 1 to 3), which were to replace the corresponding requests filed on 8 June 2020 (i.e. the MRrep and ARrep 1 to 3). ARrep 4 was abandoned. **The only difference** between the MOp and the MRrep was the deletion of dependent claim 15 (allegedly comprising an unallowable intermediate generalisation, see point 10.1.6 of the annex to the summons in the opposition proceedings). The same applies to ARop 1 to 3 with respect to ARrep 1 to 3.

- 2.1.4 During the oral proceedings, the opposition division did not admit the MOp on the grounds of being late filed. The opposition division applied the "clear allowability" criterion and concluded that claim 1 was *prima facie* not novel and that the amendments in claim 4 were not occasioned by a ground for opposition (Rule 80 EPC). Claim 4 was objected to under Rule 80 EPC **for the first time** during the oral proceedings.
- 2.1.5 The patent proprietor reacted to this development by filing new auxiliary requests 12 and 13 (which were to replace the previously filed auxiliary requests with the same numbering). ARop 1 to 3, auxiliary requests 5 to 11 as filed on 5 August 2021 and the renumbered auxiliary requests 14 to 16 corresponding to those filed as auxiliary requests 12 to 14 on 5 August 2021 remained unchanged.
- 2.1.6 ARop 1 to 3 and 5 to 11 were not admitted by the opposition division for not complying with Rule 80 EPC. New auxiliary request 12 was admitted and treated in substance.

2.2 Wrong application of admittance criteria in opposition proceedings

2.2.1 *Prima facie* novelty of the MROp

Although the MROp is not the subject of the appeal proceedings as the appellant filed the NMR instead, it is essential to consider the reasons behind the decision of the opposition division not to admit the MROp in order to properly assess the circumstances surrounding the filing of the NMR, in particular given that both differ only in the amendments made to dependent claim 4 in order to overcome the Rule 80 EPC objection that was first raised during the oral proceedings.

The opposition division applied the criterion of *prima facie* allowability when deciding about the admittance of the MROp (see points II.18 to II.18.2; minutes 3.4, statement of the opposition division at 11:00).

This criterion is, in principle, correct when assessing the admittance of a late-filed amended request such as the MROp.

However, the opposition division applied this criterion by assessing the *prima facie* novelty of claim 1, which **had not been amended** compared with the MRrep, which had been filed in a timely manner.

This is wrong.

The aim of the *prima facie* allowability criterion is to assess whether the admittance of late-filed **amendments** - which may **change the subject** of the proceedings with respect to the previous discussion of the case - is

justified from the point of view of procedural economy. In the present case, the deletion of dependent claim 15 clearly overcame any objection to this claim that had been under discussion, without resulting in any change in the subject of the proceedings in respect of any of the other claims.

Assessing whether an independent claim of the request - which is unamended compared with the **reply to the notices of opposition, which had been filed in a timely manner**, and which is unaffected by and unrelated to the amendment made - is *prima facie* novel for the purpose of admittance represents an incorrect application of this criterion (see Case Law of the Boards of Appeal, 10th edition, IV.C.5.1.4.d) (i), in particular T 368/16, Reasons 1.4 and 1.5, and T 222/16, Reasons 4.1.9).

The *prima facie* analysis of allowability which the opposition division was actually entitled to carry out in this context was that related to the deletion of dependent claim 15, which was the only amendment that had been made compared to the MRrep.

The arguments of respondent 2 based on the alleged obligation of the opposition division to follow the procedure provided in the Guidelines for Examination is not persuasive.

Firstly, on the date of the oral proceedings the opposition division had to take into consideration the Guidelines for Examination in force at that moment, namely those of March 2021. In this version of the Guidelines, there was no chapter E-VI, 2.2.3 but a related chapter E-VI, 2.2(c) which dealt with the situation where the opposition division states in the annex to the summons that the patent is likely to be

revoked, and in response the patent proprietor submits amendments after the final date set in accordance with Rule 116(1) EPC. In this context, the March 2021 version of the Guidelines states that "*the division **could, in principle,** treat such requests as late-filed and apply the criterion of 'clear allowability' (see H-II, 2.7.1) in judging whether they can be admitted into the proceedings*" (emphasis added).

Chapter H-II, 2.7.1 of the March 2021 version of the Guidelines states that "*...late-filed claims will only be admitted into the proceedings if they are clearly allowable. This means that it must be immediately apparent to the examining division that the **amendments** successfully overcome the objections without giving rise to new ones (prima facie assessment)*" (emphasis added). It is also stated in this chapter that "*The 'clear allowability' criterion is generally also applied to patent proprietors' late-filed requests in opposition proceedings*".

Thus, the opposition division was only entitled to use the "clear allowability" criterion for the **amendments** made in the MRep and their impact on the resulting focus of the proceedings. The deletion of claim 15 - which was the only amendment in the MRep compared with the MRrep, which had been filed in a timely manner - clearly overcame the objection raised against this claim and did not give rise to further objections (since the respective claim had simply been deleted).

Furthermore, the amendment had no impact on the obligation of the opposition division to discuss the novelty of claim 1 of the MRrep in substance. The patent proprietor had the procedural right to have the question of novelty of the subject-matter of claim 1

(as filed with the reply to the notice of opposition) discussed in substance during the oral proceedings. The deletion of dependent claim 15 cannot change this. Therefore, the opposition division was **not** entitled to carry out just a *prima facie* assessment of the novelty objection against independent claim 1 when deciding about the admittance of the MOp.

The Board further notes in this context that the impugned decision does not even provide any reasons as to why claim 1 of the MOp was ***prima facie*** not novel over D1. A mere reference to the preliminary reasoning in the annex to the summons does not qualify as sufficient reasoning in the decision (see point II.18.2 of the decision).

#### 2.2.2 *Prima facie* compliance with Rule 80 EPC

The fact that claim 4 - which was **unamended** compared with the MRrep - may not comply with Rule 80 EPC could not be used as a criterion **not to admit** the MOp, ARop 1 to 3 or auxiliary requests 5 to 11, which had been filed within the period set in accordance with Rule 116(1) EPC, for being *prima-facie* not allowable since this issue had been present in the requests that had been filed in a timely manner and had not been created by the amendments made. This fact alone renders the discussion about whether or not *prima facie* compliance with Rule 80 EPC can be used in general as a criterion for non-admittance superfluous in the present context.

It is noted that the opposition division would have been entitled to introduce the Rule 80 EPC objection into the proceedings and to examine the MOp, ARop 1 to 3 and auxiliary requests 5 to 11 in substance in this

respect. On the same token, according to the Guidelines, chapter H.II, 2.7, in the version then in force, a request filed in response to such a change of the subject of the proceedings would have had to have been admitted (such as, for example, the amendment made to dependent claim 4 of the NMR and NAR 1 to 3 and 5 to 11, see point 2.3 below).

It is uncontested that the Mrop, AOp 1 to 3 and auxiliary requests 5 to 11 fail to fulfil the requirements of Rule 80 EPC.

### 2.2.3 Conclusion

Although the Board has concluded that the decision of the opposition division not to admit the MOp, AOp 1 to 3 or auxiliary requests 5 to 11, which had been filed within the period set in accordance with Rule 116(1) EPC, was procedurally not correct, this does not change the fact that these requests were in fact not allowable in substance on the grounds of Rule 80 EPC.

In this regard, the Board agrees with respondent 2 that even if a procedural violation in this context was present, it would not be a substantial one since the MOp - once admitted - was deemed to fail on the grounds of Rule 80 EPC.

However, the decisive point when deciding about the **admittance** of the pending requests (which uncontestedly overcome the Rule 80 EPC objection) is that the incorrect use of the "*prima facie* not novel" criterion in the context of claim 1 of the MOp deprived the patent proprietor of the opportunity to have the question of novelty discussed in substance, which had a

negative effect on the options available to the patent proprietor when reacting to the Rule 80 EPC objection that was raised for the first time during the oral proceedings (see point 2.4(a) below).

### 2.3 Amendments in the NMR

The NMR is basically identical to the MOp, with the exception of claim 4, where the amendments considered not allowable under Rule 80 EPC by the opposition division have been reverted to the text of granted claim 4.

As stated above, according to chapter H-II, 2.7 of the Guidelines of March 2021, during opposition oral proceedings a request that is a direct response to a change of the subject of the proceedings, in that it constitutes a response to a newly raised objection under Rule 80 EPC, would be admitted under Rule 116(2) EPC.

This request was not, however, filed in the opposition proceedings and thus was not the subject of the opposition proceedings. It is therefore an amendment within the meaning of Article 12(4) RPBA and its admittance is subject to the discretion of the Board under Article 12(4) and (6) RPBA.

### 2.4 Application of discretion in admitting the NMR

#### 2.4.1 Article 12(6) RPBA

Respondents 1, 2 and 4 requested that the NMR not be admitted into the appeal proceedings since it could and should have been submitted during the opposition proceedings in view of the objection on the grounds of



Rule 80 EPC that was raised against claim 4 of the MRep during the oral proceedings.

This is not convincing.

The objection against claim 4 of the MRep based on Rule 80 EPC was raised **for the first time during the oral proceedings** before the opposition division, despite the fact that claim 4 of the MRep was identical to claim 4 of the MRep, which had been filed in a timely manner. Contrary to what is stated in the reply to the appeal of respondent 1, the letter of opponent 1 dated 5 August 2021 did not contain this objection but rather a reference to Rule 80 EPC in the context of claims 1 and 6 (see the corresponding letter, page 8, point d)).

It is true that the omission of the amendment in claim 4 would have been a straightforward way to overcome the late objection. However, the patent proprietor had been informed by the opposition division about its position regarding the non-admittance of the MRep because of the further alleged **prima facie** lack of novelty of claim 1 (minutes, point 3.4, statement of the OD at 11:00). Presenting the NMR (which overcomes the Rule 80 EPC objection but comprises unchanged subject-matter of claim 1 compared with the MRep) during the oral proceedings would thus foreseeably have resulted in a further non-admittance finding based on the same (wrong) ground of *prima facie* non-allowability due to the alleged lack of novelty of claim 1.

Given the statement from the opposition division during the oral proceedings (see point 3.4, after the break from 10:30 to 11:00, which explicitly referred to **both** the *prima facie* lack of novelty of claim 1 and the

violation of Rule 80 EPC for claim 4 as grounds for not admitting the MOp), the filing of the NMR during the opposition oral proceedings would not have made sense for the patent proprietor from a procedural point of view. A newly filed auxiliary request with a reasonable chance of admittance would have had to overcome the (inappropriately raised) *prima facie* lack of novelty objection against claim 1 as well.

By explicitly taking both the *prima facie* novelty objection against claim 1 and the Rule 80 EPC objection against claim 4 as a basis for *prima facie* non-allowability, the opposition division deprived the patent proprietor of the opportunity to submit an appropriate response to the newly raised Rule 80 EPC objection by filing the NMR, NAR 1 to 3 and NAR 5 to 11 in the opposition proceedings, and also deprived it of the opportunity to have a substantial discussion of these claims during the oral proceedings.

Consequently, it cannot be considered under these circumstances that the NMR should have been submitted during the opposition proceedings, even if it could have been filed then from a purely theoretical point of view (Article 12(6) RPBA).

#### 2.4.2 Criteria under Article 12(4) RPBA

The only amendment in the NMR (see point 2.3 above) is straightforward since it is merely a reversion to the wording of granted claim 4 (corresponding to originally filed claim 6), which was already considered when the notices of opposition were filed.

The amendment addresses in an expedient manner the objection on the grounds of Rule 80 EPC as considered

by the opposition division and it does not itself raise any new issues which were not discussed during the opposition proceedings. Thus, it is not detrimental to procedural economy *per se*.

The argument of the respondents concerning an alleged *prima facie* non-allowability of the NMR due to issues of clarity and added subject-matter, which would justify its non-admittance on the grounds of Article 12(4) RPBA, third paragraph, is not persuasive. It is true that the admittance of the NMR (and NAR 1 to 3 and 5 to 11 below) may require additional issues to be dealt with which were not addressed in the opposition proceedings. However, this is to be accepted in order to allow the patent proprietor to defend the patent in a way that - as explained above - had been blocked for it in an inappropriate manner in the opposition proceedings. In short, in the present circumstances the principle of procedural economy is outweighed by the principle of procedural fairness.

#### 2.4.3 Conclusion

In view of the above, the Board admits the NMR into the appeal proceedings since it constitutes a fair reaction to the contested decision at the first possible point in time in the appeal proceedings, and its filing is justified on the grounds of procedural fairness (Article 12(4) RPBA).

#### 2.5 Application of discretion in admitting NAR 1 to 3 and 5 to 11

In the same incorrect manner, the opposition division applied the ***prima facie* relevance criterion** related to the objection on the grounds of Rule 80 EPC against

claim 4 to each of ARrep 1 to 3 and auxiliary requests 5 to 11 as filed on 5 August 2021 (see point II.19 of the contested decision and point 2.2.2 above).

Furthermore, since the opposition division deprived the patent proprietor in an unjustified manner of an in-depth discussion about the novelty of claim 1 of the MOp, the patent proprietor could not properly assess which amendments were suitable for overcoming this objection. In fact, taking into account how the opposition division applied the *prima facie* allowability criterion to an unamended independent claim in the MOp, the patent proprietor had to assume that this argument would again be used against ARrep 1 to 3 and auxiliary requests 5 to 11 as filed on 5 August 2021 if they were simply amended to address the objection under Rule 80 EPC related to claim 4. Consequently, it cannot be considered that NAR 1 to 3 and 5 to 11 should have been filed during the oral proceedings before the opposition division (see also point 2.4.1 above).

NAR 1 to 3 and 5 to 11 only differ from AOp 1 to 3 and auxiliary requests 5 to 11 as filed on 5 August 2021 by the same amendment in claim 4 as that which was made in the NMR.

Therefore, the same logic as explained above applies *mutatis mutandis* to each of ARrep 1 to 3 and 5 to 11 and the admittance thereof is justified as well on grounds of procedural fairness.

3. The NMR, novelty, D1 - Article 54(2) EPC
- 3.1 The parties did not submit any new arguments related to the novelty of claim 1 of the NMR during the oral proceedings. Therefore, the Board remains of the same opinion as that set out in its communication under Article 15(1) RPBA.
- 3.2 Document D1 was discussed in the contested decision within the context of the objection on the grounds of a lack of novelty of auxiliary request 12 (see point II. 20.4). Since all of the features of claim 1 of the NMR were present in claim 1 of auxiliary request 12, this is a decision which can be revised within the context of the current objection.
- 3.3 It is undisputed that D1 discloses:
  - an underlayment (10) adapted to receive and secure at least one heating element of a radiant heating assembly (see heating element (62) in Figure 4) (feature A)), comprising:
    - a base material (12) defining an area and having a first side and a second side disposed opposite the first side (see Figure 1) (feature B));
    - a first protrusion (14) disposed on the first side of the base material (12), the first protrusion (14) configured as a geometric shape having at least two sides (see Figure 1), wherein two or more of the at least two sides include an element receiving surface (16) (feature C)); and
    - a second protrusion (14) disposed on the first side of the base material and adjacent to the first

protrusion (14) (see Figure 1), the second protrusion (14) configured as a geometric shape having at least two sides, wherein two or more of the at least two sides include an element receiving surface (16) (feature D)), and

wherein one of the element receiving surfaces (16) of the second protrusion (14) is offset from and facing one of the element receiving surfaces (16) of the first protrusion (14) (see Figure 1) forming an element receiving cavity (see Figure 4) therebetween (feature E)); and

wherein the element receiving cavity is configured to contain at least one heating element (62) of the radiant heating assembly (see Figure 4) (feature D)).

3.4 The appellant argued that the conic cavity or bowl (20) delimited by the stepped walls (22) was not identified as a "cutout" in D1.

This is not convincing since the disclosure of a particular subject-matter in the prior art is not necessarily dependent on the specific wording chosen to define the same.

Feature G) merely specifies "*that the first and second protrusions further comprise at least one cutout portion extending partially into the first and second protrusions respectively*".

This wording only implies that the elements defined as "protrusions" must comprise at least one "cutout portion". The conic cavity or bowl (20) of D1 represents what the skilled person understands as a "cutout portion" with respect to the protrusion (14)

since it consists of a substantial cavity within the latter which is defined by the stepped walls (22) and the "support foot" (24). Indeed, according to the impugned patent, paragraph [0011], lines 44 to 46, "*the cutouts may be provided via the forming process of the underlayment*".

- 3.5 The appellant argued that the cavity (20) did not extend **partially** into each protrusion but completely, as shown in Figure 1 of D1. Furthermore, the disclosure of a cavity "*with less of a depth*" in paragraph [0036] had to be read within the context of the previous paragraphs. Paragraph [0034] disclosed two embodiments related to the cavity (20), namely a cavity completely or partially surrounded by the outer wall. Paragraph [0036] did not specify to which of these two embodiments the remark therein applied. Consequently, the feature "extending partially" was not disclosed in a clear and unambiguous manner in D1.

This is not convincing.

The protrusion (14) of D1 is formed by a number of walls: an outer wall (16), an internal wall (22), a top wall (see Figure 1, for example) and a support foot (24). The skilled person would consider all these elements as defining the outer limits of a protrusion in which the cutout portion (20) is provided. The cutout portion (20) does not go **beyond** the walls defining the bottom of the protrusion but remains within the limits of the protrusion as a whole. Paragraph [0036] discloses in a clear and unambiguous manner that - whichever option from those considered in paragraph [0034] is taken into account - the support foot (24) can be thicker, such that the cutout portion (20) has a lower depth. Furthermore,

paragraph [0036] starts with the wording "*While the cavity or bowl 20 is **shown in the figures** terminating flush with the base of the underlayment...*" (emphasis added). The skilled person has no doubt in view of this wording that the content of the paragraph is intended to be applied within the context of the embodiments shown in the figures. Consequently, D1 discloses in a clear and unambiguous manner that the cutout portion (20) extends **partially** into the protrusions (14).

In view of the above, the subject-matter of claim 1 of the NMR is not novel over D1.

### 3.6 Claim 6

Since independent claim 6 relates to a floor assembly comprising the underlayment layer of claim 1, and since the amendments made in the claim also correspond to those made in claim 1, the same conclusions as above also apply to the subject-matter of claim 6.

## 4. NAR 1 and 2, novelty, D1 - Article 54(2) EPC

4.1 In the absence of new arguments by the parties after the issuance of the communication according to Article 15(1) RPBA, the Board remains of the same view as that set out in its communication.

4.2 The cutout portions (20) of D1 extend from the top surface of the protrusions (14) (see Figure 1 and Figure 4) and do not correspond to the element receiving cavities formed between one of the element receiving surfaces (16) of the second protrusion (14) and one of the element receiving surfaces (16) of the



first protrusion (14), which is offset from and facing the earlier (see Figure 4).

Consequently, the supplementary features added in feature G1) do not represent a difference with respect to D1, and the subject-matter of claims 1 and 6 - where corresponding amendments have been made - is not novel over D1 for the same reasons as those explained in point 3. above, *mutatis mutandis*.

- 4.3 The cutout portions (20) of D1 fall within the scope of what the skilled person considers to be a "hole" (see Figure 1 and Figure 4).

The supplementary features added in feature G2) therefore cannot distinguish the subject-matter of claims 1 and 6 - amended in the same way as claim 1 - from that of D1, and NAR 1 is not allowable on the grounds of a lack of novelty over D1 for the same reasons as those explained in points 3. and 4.2 above, *mutatis mutandis*.

5. NAR 3, novelty, D1 - Article 54(2) EPC and Article 13(2) RPBA

- 5.1 Embodiment represented in the figures of D1

Respondents 1 and 4 argued that the "conic cavity or bowl" (20) of D1 corresponding to the cutout portions defined in claim 1 were "at least rounded" or "partially circular". Since Figure 5 of the contested patent - disclosing rectangular holes - forms the alleged basis of the added wording "*a hole **having a circular cross section** when viewed perpendicular to the respective top surface*" (emphasis added) in feature G3), the contested claim 1 had to be

interpreted as encompassing embodiments in which the hole was "partially circular" as in D1.

However, feature G3) does not comprise the alleged feature "**partially** circular" but reads "*each of the at least one cutout portion of the first and second protrusions is configured as a hole having a **circular** cross section when viewed perpendicular to the respective top surface*" (emphasis added). The skilled person has no reason to consult the rest of the patent specification in order to interpret a feature which is technically clear in itself and even if they did, they would only conclude that Figure 5 indeed discloses holes having a circular cross section as defined in feature G3) independently of the shape of the cross-section of **other** cutout portions or holes disclosed therein. In particular, there is no reason for the skilled person to infer from the additional presence of holes having a **perfectly rectangular** cross section in Figure 5 that the feature "circular" can be interpreted as "partially circular".

A **circular** cross section is not merely a "rounded shape" of any cross section; it has a well-defined geometrical meaning for the skilled person which does not correspond with the **octagonal** cross section rounded at the corners of the holes of D1 (see Figure 1).

Thus, the subject-matter of claim 1 of NAR 3 is novel over D1 (Article 54(2) EPC).

Since claim 6 of NAR 3 has been amended in an analogous manner to claim 1, the subject-matter of claim 6 is also novel over D1 for the same reasons, *mutatis mutandis*.

## 5.2 "Conic cavity" embodiment

### 5.2.1 Considerations on Article 13(2) RPBA

It is undisputed that the objection based on the wording "**conic** cavity" in the description and claims of D1 was not raised until the oral proceedings before the Board. This therefore constitutes an amendment of the case of respondent 2 at the last possible moment of the proceedings and its admittance is subject to the discretion of the Board under the strict provisions of Article 13(2) RPBA.

Contrary to what was argued by respondent 2, this objection cannot be considered a reaction to the preliminary opinion of the Board set out in the communication under Article 15(1) RPBA.

NAR 3 was filed with the statement setting out the grounds of appeal and the respondents had an opportunity to comment on it at the time of filing their respective replies. The only substantiated objection concerning amended feature G3) within the context of a lack of novelty with respect to D1 (as discussed in point 5.1 above) was raised by respondents 1 and 4, whereas respondent 2 did not specify where this feature was to be found in this piece of prior art (see point 10.4 of its letter of reply).

The preliminary opinion of the Board on the only substantiated objection raised against NAR 3 within the context of a lack of novelty with respect to D1 (see point 13 of the communication under Article 15(1) RPBA) could not constitute a surprise for any of the respondents, justifying the late filing of further

objections, even if based on the same document. Thus, no exceptional circumstances can be seen which justify the admittance of this late-filed objection.

#### 5.2.2 Considerations on the substance

In any case, the late-filed objection is not convincing since the skilled person reading D1 understands the term "conic cavity" within the context of this document. All of the embodiments represented in the figures comprise a "conic cavity" (see paragraphs [0034], [0035] and [0036]) which does not have a circular cross section as defined in feature G3) (see Figure 1, for example). In fact, the word "conic" does not **necessarily** imply by itself a circular base plane but merely a closed base plane, a cone being a solid bounded by a circular **or other closed plane base** and the surface formed by line segments joining every point of the boundary of the base to a common vertex (Merriam-Webster dictionary). The figures of D1 - together with paragraphs [0034], [0035] and [0036] - are a confirmation of this general meaning. Therefore, even if the combination of claim 1 and claim 6 or claim 15 and claim 19 of D1 are taken into account, these embodiments do not disclose in a **clear and unambiguous manner** a "conic cavity" having a circular cross section when viewed perpendicular to the respective top surface.

#### 5.2.3 In view of the above, the objection is not admitted by the Board in the exercise of its discretion under Article 13(2) RPBA, even if it is irrelevant for substantial reasons in any case.

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

6.1 Main aim of the appeal proceedings - Article 12(2) RPBA

As has been repeatedly stated in the jurisprudence of the boards, the primary object of the appeal proceedings is to **review** the decision under appeal in a judicial manner (see Case Law of the Boards of Appeal, 10th edition, V.A.1.1 and Article 12(2) RPBA).

By reviewing the admittance of requests which were not admitted by the opposition division and concluding that one of these requests actually overcomes the only substantive objection dealt with by the opposition division (i.e. novelty with respect to D1), the Board has reached the limits of what actually corresponds to the main aim of the appeal proceedings in this case.

6.2 Objections for which no decision to be revised exists

Any further examination of the case would entail the Board dealing for the first time with objections on which no decision to be revised exists.

Indeed, numerous further objections have been raised by the respondents in connection with Articles 56, 83, 84, 123(2) and 123(3) EPC, including objections on the grounds of a lack of novelty with regard to a number of other documents apart from D1 (D2, D7, D8, D11, D12, D13, D17, D19 and D20).

It is agreed that generally, the efficiency of proceedings is an important aspect and that a back and forth between the opposition divisions and the boards should be avoided.

However, in the present case the opposition proceedings were tainted by procedural violations which in sum considerably restricted the patent proprietor's procedural options in an inappropriate way.

As discussed above, the inappropriate use of the *prima facie* allowability criterion deprived the patent proprietor of the opportunity for a substantive discussion of the novelty objection and prevented it from filing the NMR, NAR 1 to 3 and NAR 5 to 11 in the opposition proceedings. Even though these requests have now been admitted in appeal, discussing all of the objections for the first time in the appeal proceedings under the strict regime of the new RPBA considerably reduces the patent proprietor's range of manoeuvres with respect to what is procedurally possible in opposition proceedings.

The fact that the appellant was not able to exercise its right of defence in a proper manner during the opposition proceedings is considered a special circumstance within the meaning of Article 11 RPBA and speaks in favour of the remittal of the case.

### 6.3 Conclusion

In view of the above, the appeal is allowable, and the Board is remitting the case to the opposition division for further prosecution.

## Order

### For these reasons it is decided that:

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

The Registrar:

The Chairman:



C. Spira

C. Herberhold

Decision electronically authenticated