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**Datasheet for the decision
of 25 November 2024**

Case Number: T 0336/23 - 3.3.05

Application Number: 12840022.3

Publication Number: 2767526

IPC: C04B35/66, C04B35/10,
C04B35/18, C04B35/185,
C04B35/565, F27D1/16

Language of the proceedings: EN

Title of invention:

REFRACTORY PROTECTIVE MATERIAL FOR CLINKER FURNACES, WHICH PREVENTS THERMOCHEMICAL ATTACK WITHOUT THE FORMATION OF ENCRUSTATION OR RINGS

Patent Proprietor:

Refractaria S.A.

Opponent:

Refractory Intellectual Property GmbH & Co. KG

Headword:

Refractory protective material/Refractaria

Relevant legal provisions:

RPBA 2020 Art. 12(2), 12(6)

Keyword:

Primary object of appeal proceedings to review decision -
appeal case directed to requests on which decision was based
(no)

Patent as granted - no longer maintained in first-instance
proceedings

Decisions cited:

R 0010/09, R 0011/11, R 0004/18, R 0011/20, R 0004/22,
T 0052/15, T 1214/21

Catchword:



Beschwerdekammern
Boards of Appeal
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Case Number: T 0336/23 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 25 November 2024

Appellant: Refractaria S.A.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 21 December
2022 revoking European patent No. 2767526
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman E. Bendl
Members: S. Besselmann
P. Guntz

Summary of Facts and Submissions

- I. The appeal of the patent proprietor (appellant) is against the opposition division's decision to revoke European patent EP 2 767 526 B1.
- II. The opposition division found that the claims of what was then the main request did not meet the requirement of Article 123(3) EPC.
- III. The patent in suit concerns a refractory protective material for clinker furnaces, which prevents thermochemical attack without the formation of encrustation or rings.

The sole claim in the patent as granted reads as follows:

"Use of a protective refractory material for clinker kilns, of the rotary kiln type used in the cement industry, which prevents thermochemical attack and the formation of coating or rings, in the outlet zone (A), the lower transition zone (B), the upper transition zone (D), the safety zone (E) and the calcination zone (F) of the clinker kiln, in which said material is composed of the following minerals, defined as percentage by weight: andalusite or sintered alumina or fused alumina or electrofused alumina-zirconia of between 30 and 80%; silicon carbide of between 5 and 60%; zirconium silicate of between 5 and 60%; and clay of between 5 and 15%; the sum of percentages being 100%."

- IV. In their statement of grounds of appeal, the appellant defended the patent as granted as their sole request,

the claims of which were re-submitted and labelled "main request".

- V. In their reply to the appeal, the opponent (respondent) was of the opinion that, *inter alia*, the appellant's sole claim request should not be admitted into the proceedings pursuant to Article 12(6) RPBA.
- VI. In a communication pursuant to Article 15(1) RPBA, the board informed the parties of its preliminary opinion that the appellant's request could not be admitted into the proceedings pursuant to Article 12(6) RPBA.
- VII. Oral proceedings were held on 25 November 2024.

During the oral proceedings, the appellant took the view that their request for the patent to be maintained as granted had never been withdrawn, that the patent as granted had been a major point of discussion during the opposition proceedings and that the opposition division had taken an "intermediate" decision on the patent as granted. This decision was to be reviewed by the board. Furthermore, the patent as granted necessarily formed part of the appeal proceedings. Denying the appellant the right to revert to the patent as granted constituted a violation of their right to be heard (Article 113(1) EPC). Alternatively, the board should admit the request as an amendment on the basis of Article 12 RPBA because the amendment was not complex and did not present the other party or the board with a fresh case since the patent as granted had been discussed during the opposition proceedings. It was not detrimental to procedural economy either.

The respondent took the view that Article 12(6) RPBA applied because the appellant had clearly withdrawn the

patent as granted by filing a new main request during the oral proceedings before the opposition division. There was no indication either in the minutes of those oral proceedings or in the impugned decision, or even in the appellant's statement of grounds of appeal, that the withdrawal of the main request had been erroneous and that the intention had actually been to further prosecute the patent as granted. Under these circumstances, it would be detrimental to legal certainty and unfair to the respondent if the appellant were allowed to revert to the patent as granted.

After the Chair had declared the debate closed, interrupted the proceedings for deliberation, interrupted them again to provide the appellant's representative with the requested opportunity to converse with their client about a possible withdrawal of the appeal, announced the decision, closed the oral proceedings and thanked the interpreters for their invaluable service, the appellant announced that they reserved the right to file a petition for review because not re-admitting the present (and initial) main request in their view constituted a violation of their right to be heard.

The Chair informed the appellant that having closed the debate and announced the decision, an objection under Rule 106 EPC could no longer be filed.

VIII. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. Consideration of the claim request

1.1 The impugned decision was based on an amended "main request" (items I.8 and I.9 of the decision under appeal) as the sole request. It does not additionally deal with the patent as granted. That the patent as granted was discussed extensively during the oral proceedings before the opposition division does not change this fact. Indeed, the opposition division stated that "the ground of opposition according to Art. 100(c) EPC prejudices the maintenance of the patent as granted", as reported in the minutes (pages 1-2). However, contrary to the appellant's view, this statement does not form an intermediate decision which automatically forms part of the final decision. It is the consistent view of the boards of appeal that the minutes of oral proceedings are not decisions within the meaning of Article 106 EPC (R 4/18, Reasons 11-12).

1.2 The appellant was also of the view that the patent as granted had never been expressly withdrawn.

However, a request can be withdrawn implicitly and there is an implicit withdrawal when the circumstances leave no doubt that the party did not intend to pursue a request (Case Law of the Boards of Appeal of the EPO, 10th edn., 2022, III.I.5).

Parties are generally required to file requests in a clear order (Case Law of the Boards of Appeal of the EPO, 10th edn., 2022, III.I.2.1), implying that there normally cannot be two requests of the same rank. It is therefore not objectionable that the opposition division understood the filing of the amended "main request" as replacing the previous sole and thus "main" request. The term "main request" might not be precise where there is only a single request, but it is frequently used in such a case. Similarly, the appellant used the term "main request" also in relation to their sole request during the appeal proceedings.

The present case is similar to T 52/15, in which the competent board found that the opposition division did not err when considering that each newly filed "main request" superseded and was clearly intended to replace the previously filed one/s (Reasons 1, in particular 1.2-1.4).

It is not clear whether the opposition division did - as it should have done - clarify the parties' final requests before closing the debate. The minutes of the oral proceedings do not report that the parties were asked to confirm their final requests. Nevertheless, as outlined in T 52/15 (Reasons 1.7), *"if a procedural act performed by a party is clear and there are no reasons to suggest that its intentions were not correctly understood, e.g. on account of subsequent actions and/or statements, that party cannot expect not to have to bear the consequences of that procedural act"*. It was found in that decision that this applied all the more when the party was represented by a professional representative (Reasons 1.7), but it also applies in the present case in which the patent proprietor was represented by an authorised employee who was not a

professional representative as such but could nevertheless be expected to competently handle the labelling and submission of requests.

A similar approach was adopted in T 1214/21 (Reasons 1) in relation to a request labelled "New Main Request".

- 1.3 In the present case, the opposition division clearly stated in the impugned decision that the filing of the amended "main request" *replaced* [emphasis added] the claim as granted (point I.8 of the impugned decision), i.e. that the claim as granted was not maintained, and it went on to exclusively deal with the amended main request (point II, in particular point II.4). Thus, the appellant must have realised at the latest when receiving the written decision that the opposition division had understood the filing of a new "main" request as replacing the previous request of the same rank. It can be assumed that the appellant shared this view as a request for a correction of the minutes was not submitted.

Furthermore, when the appellant resubmitted the claim as granted as their sole claim request with the statement of grounds of appeal, they did not contest the facts established by the opposition division or the request that was taken as a basis for its decision. Moreover, the appellant did not respond to the respondent's objection that the resubmitted claim as granted should not be considered pursuant to Article 12(6) RPBA, or to the board's preliminary opinion agreeing with this objection. It was only during the oral proceedings before the board that the appellant asserted for the first time that they had never withdrawn the patent as granted.

Thus, the handling of the case by the appellant up until the oral proceedings before the board supports the understanding by the opposition division, which is followed by the board, that the previous request for the patent to be maintained as granted was indeed replaced by the new "main" request. In these circumstances, the assertion of the appellant - raised at a late stage of the proceedings - is not sufficient to establish that the request for the patent to be maintained as granted had never been withdrawn. It would be unfair to the other party if this assertion were accepted.

- 1.4 According to another line of reasoning brought forward by the appellant, the patent as granted always forms part of the proceedings. In their view, not allowing a patent proprietor to revert to the patent as granted amounted to a violation of their right to be heard.

However, while the board agrees that the granted version of an underlying patent forms part of the proceedings since it is needed when dealing with an objection under Article 123(3) EPC, for example, this does not mean that an appellant-patent proprietor has an absolute right to revert to the granted version. Instead, this is a discretionary decision of the board. It thus does not amount to a violation of the right to be heard when a board, in exercising this discretion, does not allow an appellant to revert to the granted version.

Indeed, it is already established by the case law relating to Article 12(4) RPBA 2007 - taken up in Article 12(6) RPBA 2020 - that it is at the discretion of a board of appeal whether a patent proprietor is allowed to revert to the granted version on appeal

(Case Law of the Boards of Appeal of the EPO, 10th edn., 2022, V.A.5.12.14).

1.5 The appellant also argued that the board should take a discretionary decision to re-admit the granted version. Reverting to the claim as granted was not complex and did not present the other party with a fresh case. Taking the granted version into account would not be detrimental to procedural economy, either.

1.6 However, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner (Article 12(2) RPBA). Re-introducing the claim as granted, which was not maintained during the opposition proceedings and was not dealt with in the decision under appeal, would run counter to this object.

Thus, pursuant to Article 12(6) RPBA, boards shall not admit requests which were not maintained in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance.

It would go against the very purpose of this provision if the justification for admitting such a request at the appeal stage was the mere fact that the request had already been discussed at the opposition stage.

Moreover, in the present case the board cannot see how procedural economy could justify reverting to the patent as granted, considering that the amended main request had been filed in reaction to the opposition division's view that the patent as granted infringed the requirements of Article 123(2) EPC, which point of discussion would thus arise anew.

- 1.7 In conclusion, the appellant's sole request is not to be admitted into the proceedings.
- 1.8 Not admitting a request into the proceedings does not amount to denying the right to be heard. A party has to be heard on the question of whether or not its request should be admitted into the proceedings, which has been extensively done in the case at hand. However, when a board decides to exercise its discretion not to admit the request, it is merely the legal consequence of Article 114 EPC and Articles 12 and 13 RPBA that the request will not be discussed on the merits. This has been confirmed on several occasions by the Enlarged Board of Appeal (cf. R 10/09, Reasons 2.2; R 11/11, Reasons 6; R 11/20, Reasons 8 and 9; and R 4/22, Reasons 2.1).
- 1.9 The question of whether the right to be heard was properly given in the case at hand was also explicitly discussed with the parties before the board deliberated on its final decision. Thus, even if the respective objection had been submitted in time, there would have been no reason for the board to reopen the debate.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated