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

**Case Number:** T 0451/23 - 3.2.07

**Application Number:** 08866049.3

**Publication Number:** 2242618

**IPC:** B24D3/00, B24D11/00, B01J2/22,  
C09K3/14

**Language of the proceedings:** EN

**Title of invention:**

SHAPED, FRACTURED ABRASIVE PARTICLE, ABRASIVE ARTICLE USING  
SAME AND METHOD OF MAKING

**Patent Proprietor:**

3M Innovative Properties Company

**Opponent:**

Saint-Gobain Abrasives, Inc.

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(c), 123(2), 100(b), 83, 100(a), 54, 56  
RPBA 2020 Art. 12(6), 13(1)  
EPC R. 124(1)

**Keyword:**

Grounds for opposition - added subject-matter (no) - extension of subject-matter (no) - insufficiency of disclosure (no) - lack of patentability (no)

Late-filed evidence - admitted in first-instance proceedings (no) - error in use of discretion at first instance (no) - admitted (no)

Amendment to appeal case - amendment detrimental to procedural economy (yes) - state of the proceedings - exercise of discretion - admitted (no)

Minutes of oral proceedings - essentials of oral proceedings - request to record statement in the minutes (refused)

**Decisions cited:**

T 0182/89, T 0019/90, T 0263/05, T 1690/22, R 0014/09

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 0451/23 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 25 July 2024**

**Appellant:** Saint-Gobain Abrasives, Inc.  
(Opponent) One New Bond Street  
Worcester, Massachusetts 01615 (US)

**Representative:** Zimmermann & Partner  
Patentanwälte mbB  
Postfach 330 920  
80069 München (DE)

**Respondent:** 3M Innovative Properties Company  
(Patent Proprietor) 3M Center  
P.O. Box 33427  
St. Paul, MN 55133-3427 (US)

**Representative:** Vossius & Partner  
Patentanwälte Rechtsanwälte mbB  
Siebertstrasse 3  
81675 München (DE)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 23 December  
2022 rejecting the opposition filed against  
European patent No. 2242618 pursuant to Article  
101(2) EPC.**

**Composition of the Board:**

**Chairwoman** Y. Podbielski  
**Members:** A. Cano Palmero  
B. Paul

## **Summary of Facts and Submissions**

- I. The opponent (appellant) lodged an appeal within the prescribed period and in the prescribed form against the decision of the opposition division to reject the opposition filed against European patent No. 2 242 618.
- II. The opposition was filed against the patent in its entirety and based on the grounds for opposition pursuant to Articles 100(a), (b) and (c) EPC (lack of novelty, lack of inventive step, insufficient disclosure and added subject-matter).
- III. In preparation for oral proceedings, scheduled upon the parties' requests, the board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA. The board indicated that the appeal was likely to be dismissed.
- IV. Oral proceedings before the board took place on 25 July 2024. At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes thereof.
- V. The appellant requested  
  
that the decision under appeal be set aside  
and  
that the European patent No. 2 242 618 be revoked.
- VI. The patent proprietor (respondent) requested  
  
that the decision under appeal be set aside, and

that the patent be maintained as granted (main request),

or, in the alternative,

that the case be remitted to the opposition division for further prosecution,

or, in the alternative,

that the patent be maintained in amended form according to one of the sets of claims filed as auxiliary requests 1 to 8, 8a to 8f, 9 and 9a to 9g filed in opposition proceedings.

VII. The following **documents** referred to in the decision under appeal are mentioned in the present decision:

E1: US 6,039,775 A;

E2: WO 94/02559 A1;

E3: US 5,201,916 A;

E15: US 5,366,523 A;

E15a: Affidavit by Dwight D. Erickson;

E15b: 3M's pictures of how to randomly select the shaped abrasive particles discussed in E15a in order to obtain a batch of particles;

E15c: Images of two shaped abrasive particles taken from the batch of E15b.

VIII. The lines of argument of the parties relevant for the present decision are dealt with in detail in the reasons for the decision.

IX. **Independent claim 1** of the **main request** (*i.e.* according to the patent as granted) with the feature labelling used by the parties reads as follows:

"1. A method of forming a plurality of precursor abrasive particles (23), the method comprising:

- 1.1 providing a mold (34) having a plurality of cavities (32);
- 1.2 filling the plurality of cavities (32) with an abrasive dispersion,
- 1.3 the abrasive dispersion comprising particles in a liquid that can be converted into alpha alumina, the liquid comprising a volatile component;
- 1.4 removing at least a portion of the volatile component from the abrasive dispersion while the abrasive dispersion resides in the plurality of cavities (32) thereby forming a plurality of precursor abrasive particles (23) having a predetermined size,
- 1.5 the method being characterised by fracturing at least a majority of the plurality of precursor abrasive particles (23) into at least two pieces while the plurality of precursor abrasive particles (23) reside within the plurality of cavities thereby forming a fractured plurality of precursor abrasive particles (23)."

X. **Independent claim 6** of the **main request** (*i.e.* according to the patent as granted) with the feature labelling used by the parties reads as follows:

- "6. An abrasive comprising:
- 6.1 a plurality of alpha alumina abrasive shards (21) having an abrasives industry specified nominal grade or a nominal screened grade, the plurality of alpha alumina abrasive shards (21) comprising:
  - 6.2 a first precisely formed surface (22) and a second precisely formed surface (24) intersecting with the first precisely formed surface (22) at a predetermined angle  $\alpha$ ,
  - 6.3 wherein the precisely formed surfaces (22) are

- created by at least partially drying, dewatering, or curing an abrasive dispersion while residing in a cavity (32) in a mold (34); and
- 6.4 a third surface (26) opposite the first precisely formed surface (22);
- 6.5 characterised by comprising a fractured surface (28),
- 6.6 wherein the fractured surface (28) propagates between the first precisely formed surface (22) and the opposing third surface (26)."

XI. Since the wording of the claims of the auxiliary requests is not relevant for the present decision, there is no need to reproduce it here.

### **Reasons for the Decision**

1. *Patent as granted (main request) - Amendments, Articles 100(c) and 123(2) EPC*

1.1 The appellant argued that the opposition division erred in its finding of point 2 of the reasons for the decision under appeal that claim 6 as granted, in particular feature 6.6, did not extend beyond the original disclosure.

1.1.1 The appellant indicated that, while claim 6 as granted was based on original claim 21, the only basis for added feature 6.6 was original description page 5, lines 18 to 22. This paragraph contained three features identified as follows:

[Feature f1]): The fractured surface 28 of the abrasive shard 21 generally propagates between the first precisely formed surface 22 and the opposing third surface 26

and

[Feature f2)]: between opposing sidewalls of the cavity  
32

when

[Feature f3)]: the cavity depth is relatively small  
compared to the area of the bottom  
surface 30.

1.2 According to the appellant, feature f3) could only be interpreted according to the original description on page 5 as a condition which referred to both preceding features f1) and f2). In particular, the word "propagates" was the same verb for both features f1) and f2). Since claim 6 as granted only included feature f1), the omission of features f2) and f3) resulted in an unallowable intermediate generalisation, contrary to the requirements of Article 123(2) EPC. Furthermore, claim 6 as granted encompassed the presence of fractured surfaces that propagate between the first precisely formed surface 22 and the opposing third surface 26 independently from the cavity depth as required by page 5, lines 18 to 22.

1.3 The appellant further argued that, even in the case that feature f3) was considered to be exclusively linked to feature f2) only, but not to feature f1), the combined teaching of features f2) and f3) required that a shard produced in a "relatively flat" cavity must necessarily have a fractured surface which propagated both between the first precisely formed surface 22 and the opposing third surface 26 **and** between opposing sidewalls of the cavity 32. Since granted claim 6 was silent about any cavity depth, its subject-matter also encompassed shards having a fractured surface which have been produced in "relatively flat" cavities,



thereby extending beyond what was originally disclosed on page 5, lines 18 to 20 of the description.

- 1.4 The board disagrees and rather concurs with the opposition division that original claim 21 and original description page 5, lines 18 to 22 form a sufficient basis for amended claim 6 according to the main request. The board is of the view that from these passages the skilled reader understands that it is not compulsory for the fractured surface of feature 6.6 to include feature f2), since only this feature (and not feature f1)) is subject to the condition of relatively small cavity depths. In other words, it is undisputed that page 5, lines 18 to 22 lends support to *inter alia* abrasives which could include features f1) to f3) simultaneously; however, the board concurs with the respondent that also abrasives which include only feature f1) without any further requirement or limitation such as features f2) and f3) are disclosed in this passage.

Furthermore, the board notes that there is no restriction with regard to the cavity depth in claim 6 as granted. In the absence of such a restriction the board sees no need, in order to meet the requirements of Article 123(2) EPC, to include feature f2), which is linked to relatively small cavity depths.

- 1.5 In sum, the appellant has not provided convincing arguments that could demonstrate the incorrectness of the findings of the decision under appeal, that claim 6 as granted meets the requirements of Article 123(2) EPC.

2. *Patent as granted (main request) - Sufficiency of disclosure, Articles 100(b) and 83 EPC*

2.1 The appellant argued that the opposition division erroneously found that the omission of the application of a release agent in **claim 1**, and more precisely, the absence of the border concentration of such a release agent in order to meet the requirements to fracture "*at least a majority of the plurality of precursor abrasive particles*" as required by claim 1 as granted resulted in the patent being insufficiently disclosed. Indeed, the skilled person could not establish this border concentration using routine experimentation without undue burden, when using a mold release agent.

2.1.1 The board disagrees. As correctly indicated by the respondent, the skilled person clearly understands how to carry out the invention according to claim 1, for example by using no mold release agent at all. This is also confirmed by paragraph [0049] of the description, where also some working examples using release agents are described, as indicated by the opposition division in its finding at point 3.1 of the reasons for the decision under appeal. Furthermore, as pointed out by the respondent, the skilled person also understands from paragraph [0046] that other means, such as mechanical means could be employed. The skilled person does therefore not need to find out a threshold value for the concentration of a release agent to carry out the invention, and even if there was a need to establish such a value, the appellant's argument that an undue burden would be imposed still remains as a mere allegation.

2.2 With respect to **claim 6** as granted, the appellant argued that while this claim covered any possible shape

of abrasive shards, the patent only provides exemplary abrasive shards in the form of an equilateral triangle (see paragraph [0063]). The skilled person was thus not able to perform the invention over the whole range claimed in view of the whole disclosure of the patent.

2.2.1 The board is not persuaded by these arguments either. As correctly indicated by the respondent, it is established jurisprudence of the Boards of Appeal, that an objection of lack of disclosure presupposes that there are serious doubts substantiated by verifiable facts. The burden of proof is upon the opponent to establish on the balance of probabilities that a person skilled in the art, using his common general knowledge, would be unable to carry out the invention (see the Case Law of the Boards of Appeal of the European Patent Office, 10th Edition, 2022, II.C.9, first two paragraphs, in particular in relation to T 19/90 and T 182/89). Such serious doubts that other forms of abrasive shards could be achieved by the skilled person have not been presented by the appellant. Furthermore, in the case at hand, the board concurs with the opposition division (see point 3.2 of the reasons for the decision under appeal) and with the respondent that paragraph [0040] of the patent in suit leaves open the possibility of cavities with different shapes, from which abrasive shards with shapes other than an equilateral triangle could be derived.

2.3 In sum, the appellant has not provided convincing arguments that could demonstrate the incorrectness of the findings of the decision under appeal, that the patent as granted meets the requirements of Article 83 EPC.

3. *Admittance of documents E15, E15a, E15b and E15c, Article 12(6) RPBA*

3.1 The opposition division did not admit documents E15, E15a, E15b and E15c into the opposition proceedings (see point 4 of the reasons for the decision under appeal). The appellant argued that the information involved with the Rowenhorst particles (*i.e.* E15b and E15c) were subject to confidentiality in UK invalidity proceedings and became publicly available only as of July 2022, therefore they could not have been submitted during the opposition period. Furthermore, irrespective of whether E15a to E15c would be admitted, the appellant argued that already the general disclosure of E15 took away novelty of granted claim 6, and therefore E15 was *prima facie* relevant and should have been admitted into the opposition proceedings.

3.2 The board notes that E15 is a patent document and as such was publicly available. The board understands that E15a to E15c have been submitted only as support for the disclosure of E15, which has not been further disputed by the appellant. Therefore, the board does not see any obstacle that could have prevented the appellant from having submitted E15 and the corresponding novelty objections based thereon during the opposition period. E15 was thus not submitted in due time according to Article 114(2) EPC.

3.3 The board also noted in its communication according to Article 15(1) RPBA that there was no objection made by the appellant that the discretion applied by the opposition division was not based on the correct principles; the appellant's main arguments rather amount to differences in opinion on the *prima facie* relevance of document E15 and the supporting evidence

E15a to E15c. This was also not disputed by the appellant. In this respect, the board notes that according to the established case law, which has now been codified in Article 12(6), first sentence, RPBA, such an exercise of discretion should only be overruled in the event that it suffered from an error in the use of discretion, *i.e.* if the opposition division exercised its discretion according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (see CLB, *supra*, V.A.3.4.1.b)), or unless the circumstances of the appeal case justify their admittance. It is not the duty of the board to review all the facts and circumstances of the case as if it were in that department's place and decide whether or not it would have exercised discretion in the same way. In this respect, document E15 was late-filed, namely after the opposition period, and the principle of "*prima facie* relevance" of this document and the supporting evidence E15a to E15c was correctly applied and reasonably assessed, so that an error in the use of the discretion is not apparent to the board.

3.4 In view of the above, the board does not admit document E15 and the supporting evidence E15a, E15b and E15c into the proceedings under Article 12(6), first sentence, RPBA.

4. *Patent as granted (main request) - Novelty, Articles 100(a) and 54 EPC*

4.1 With regard to **claim 1** of the main request the appellant argued that the opposition division erred in its finding that **document E1** did not anticipate feature 1.5, namely that:

*"the method being characterised by fracturing at least a majority of the plurality of precursor abrasive particles (23) into at least two pieces while the plurality of precursor abrasive particles (23) reside within the plurality of cavities thereby forming a fractured plurality of precursor abrasive particles (23)."*

4.1.1 In particular, the appellant argued that E1 disclosed molding as one way of generating precursor triangular-shaped abrasive particles in column 16, lines 17 to 20. Furthermore, according to column 17, lines 14 to 22 and to the second method of column 17, lines 35 to 52, E1 disclosed crushing techniques of the dried (alumina based) dispersion. According to the appellant, since the dispersion was dried, it must be necessarily subject to a mold process. The crushing of the dispersion is clearly carried out while the dispersion resided in the mold cavities; otherwise E1 would have described to crush the particles, as it is described in the fourth method in column 18, lines 1 to 4. In sum, document E1 anticipated all features of claim 1 as granted, including feature 1.5.

4.1.2 The board disagrees. It is to be noted that the six methods described in E1 are distinct methods and are not disclosed in combination. As correctly found by the opposition division, the second method described in column 17, lines 35 to 52 of E1 does not directly and unambiguously disclose the use of a mold. In particular, the board concurs with the respondent that the term "dispersion" cannot be interpreted as the precursor abrasive particles in the sense of the claim, and that, in addition, it does not provide any indication regarding the location of such "dispersion". With regard to the fifth method (distinct from the

second method) described in column 18, lines 19 to 39, a forming triangular shaped abrasive particles by molding is disclosed, but no fracturing of the particles in the cavities of the mold can be derived from this method.

- 4.1.3 It follows from the above that E1 does not anticipate feature 1.5, since none of the individual methods disclosed therein describes a fracturing of the precursor abrasive particles while they reside in the plurality of cavities.
  
- 4.2 The appellant argued that **document E1** disclosed all features of **claim 6** as granted, including features 6.5 and 6.6.
  - 4.2.1 In particular, the appellant argued that the particles produced by the method of E1 would have first and second precisely formed surfaces (as a consequence of the method) and also at least one fractured surface, produced either by drying of the alumina based dispersion residing in the mold cavities (see E1, column 15, line 60 to column 16, line 2) or through mechanically crushing the dried dispersion (according to the "second" method on column 17, lines 35 to 52). In any case it was irrelevant in the case of product claim 6 whether the crushing was performed inside the mold or not. The fractured surface would propagate between a first precisely formed surface and an opposing third surface (which could also be a precisely formed surface) according to claim 6. According to column 18, lines 1 to 18 of E1, the "child" particles resulting from fracturing the particles during calcining will result in a particle having the precisely formed surfaces from the mold which includes

a further third formed surface according to claim 6 of the main request.

4.2.2 The board is not persuaded by the appellant's arguments for the following reasons.

Firstly, the board concurs with the finding of the opposition division in point 5.1.2.1 of the reasons for the decision under appeal that a crushed particle, irrespective of whether the particle has been crushed inside or outside a mold cavity, does not necessarily contain a fractured surface propagating between a first precisely formed surface and an opposing third surface in accordance with feature 6.6, which therefore cannot be seen as directly and unambiguously derivable from D1.

Secondly, the board agrees with the respondent and with the opposition division that the precisely formed surfaces according to claim 6 (feature 6.3) are an identifiable structural feature and a direct consequence of mold forming. Similarly to the discussion concerning claim 1, the drying conditions disclosed in column 15, line 60 to column 16, line 2, of E1 are not directly and unambiguously linked to the forming of shaped abrasive particles in a mold and therefore to particles having at least two precisely formed surfaces. This is also not the case for the "second" method including mechanically crushing described in column 17, lines 35 to 52, as already discussed for claim 1. The reference to column 18, lines 1 to 18 of E1 relates to a separate "fourth method", which again is not performed on particles prepared by molding.



It follows that the subject-matter of claim 6 as granted differs from E1 at least in features 6.3 and 6.6, so that the board does not see an error in the decision under appeal.

- 4.3 The appellant contested the reasoned finding of the opposition division in point 5.1.1.2 of the reasons for the decision under appeal, that **E2** did not disclose that a majority of the plurality of precursor abrasive particles are fractured according to feature 1.5 of **claim 1** of the main request. It is common ground that the same arguments and considerations apply to document **E3**.
- 4.3.1 In particular, the appellant argued with regard to step (d) of the general method, which dealt with the removal of a volatile component, that the term "minimizing the formation of cracks" (on page 17, line 27 to page 18, line 4 of E2) did not automatically mean that only a "minority" of precursor abrasive particles are fractured. Indeed, the cracking could be minimized but still the fractured particles could be a majority according to the claimed feature.
- 4.3.2 The board disagrees. Indeed, the relevant question is what the skilled person can directly and unambiguously derive from the cited passage that a majority of the particles are fractured. In the board's view, the possibility of the fractured particles being a majority is already ruled out in E2 by the term "minimizing". In any case, independent from the question whether the term "minimizing" in E2 could rule out such possibility or not, the board concurs with the opposition division that a fracturing of the majority of the abrasive particles is not directly and unambiguously disclosed by E2.

4.3.3 In sum, the appellant has not convincingly demonstrated the incorrectness of the finding of the opposition division, that the subject-matter of claim 1 as granted is novel over E2 and E3.

4.4 With respect to product **claim 6**, the appellant argued that in **E2** or **E3** the fracturing of the precursor abrasive particles within the mold cavities might happen even if such cracks are undesirable and to be minimized. In addition, in view page 13, lines 19 to 21 of E2, some of the edges of the precursor abrasive particles might "break off" when they are removed from the mold cavities, so that the cracks referred to in E2 and E3 which are formed in the abrasive particles always inevitably result in a fractured surface that propagates between the first precisely formed surface and the opposing third surface (which could also be a precisely formed surface), according to claim 6 of the main request. In any case, even if a fractured surface according to the claim could not be seen as an inevitable consequence of the removal of the abrasive particles from the mold cavities, the appellant argued that as long as there is at least one edge of one particle that breaks off entirely, novelty would not be given.

4.4.1 The board disagrees and rather concurs with the respondent that, contrary to the appellant's allegations, the removal of the precursor abrasive particles from the mold cavities as indicated in the passage of E2 does not always inevitably result in edges breaking off. There is also no certainty that the removal results in at least one edge of one particle breaking off entirely, thereby anticipating the fractured surface of feature 6.6. In contrast, the

board finds that the passage of E2, that "some of the edges may break off" is also to be understood to comprise the cases where only one part of the edge (*i.e.* not the complete edge) breaks off. These cases, which are not deprived of technical sense, do not result in a fractured surface that propagates between the first precisely formed surface and the opposing third surface. It follows the cracks of E2 or E3 do not necessarily form a fractured surface propagating between a first precisely formed surface and an opposing third surface in accordance with feature 6.6, so that this feature is not directly and unambiguously disclosed.

- 4.5 The appellant further argued in point 7.2.2 of its letter dated 2 February 2024 and at the oral proceedings (*i.e.* after the appellant has filed its statement setting out the grounds of appeal), that since document E2 (and also E3) disclosed a practically identical process as claim 1, the process of E2/E3 would inevitably result in an abrasive according to claim 6, so that its the subject-matter was at least implicitly anticipated by this document.
- 4.5.1 The respondent argued that this was a new objection which resulted in an amendment of the appellant's case and requested that the amendment not be admitted by the board under Article 13(1) RPBA. The appellant disagreed and argued that these arguments were a mere development of the objection raised in point 6.2 of the statement setting out the grounds of appeal, so that they could not be regarded as an amendment to the appellant's case.
- 4.5.2 The board concurs with the respondent. Contrary to the appellant's view, the board cannot find in points

6.2.14 to 6.2.19 of the statement setting out the grounds of appeal any argument in the direction that the abrasive according to claim 6 could be the result of a method allegedly disclosed in E2/E3. It follows that the new arguments, presented after the statement setting out the grounds of appeal were submitted are an amendment of the appellant's case for which the appellant has not providing a convincing reason for its late filing. The admittance of such amendment is subject to the board's discretion under Article 13(1) RPBA. Furthermore, the board sees in the present case no particular circumstance that could have deprived the appellant to file these arguments at least with its statement setting out the grounds of appeal. In addition, the admittance of these arguments would be detrimental to procedural economy, since it would oblige the parties and the board at this particularly late stage of the proceedings to assess which method steps referred by the appellant are allegedly disclosed in E2/E3 and whether the allegedly disclosed method steps resulted in an abrasive according to claim 6.

4.5.3 In view of the above, the board, exercising its discretion under Article 13(1) RPBA, does not admit the newly introduced novelty objection to claim 6 of the main request as raised in opponent's letter of 2 February 2024 into the proceedings.

4.6 In consequence of the above, the board concludes that the subject-matter of claims 1 and 6 according to the patent as granted is new over E1 and E2/E3.

5. *Patent as granted (main request) - Inventive step, Articles 100(a) and 56 EPC*
- 5.1 The appellant argued that the subject-matter of claims 1 and 6 was obvious starting from any of documents E1 or E3 as closest prior art.
- 5.2 In particular, the appellant indicated that, starting from **E1 as closest prior art** and even if it could not be considered to disclose where exactly the fracturing of the precursor abrasive particles took place (*i.e.* whether the particles were fractured inside the mold cavity according to claim 1 as granted), the skilled person would arrive at the subject-matter of claim 1 in an obvious manner **in view of the common general knowledge or of the teaching of E3**.
- 5.2.1 According to the appellant, the skilled person, yielding for forming sharp abrasive particles, would only have to choose between two alternatives, namely fracturing of the dried dispersion within the mold or outside the mold. In view of the common general knowledge (already suggested by E1, column 17, lines 19 to 22) or the teaching of E3, the skilled person would be aware that fracturing (dried) precursor abrasive particles is generally possible within the mold, and by doing so, would choose one of the two possible alternatives and thereby arrive at the subject-matter of claim 1 without exercising an inventive skill.
- 5.2.2 The board is not persuaded by the appellant's arguments and rather concurs with the opposition division (see point 5.2.1 of the reasons for the decision under appeal) that E1 teaches either to crush the particles without a mold process (according to the "second method") or to mold the particles without crushing them

(according to the "fifth" method). There is no hint or motivation for combining both processes. On the contrary, in the particular case of molding the particles the aim is to retain the shape of the mold upon further processing (see column 18, lines 34 to 38). Therefore, the consideration of a generally known crushing process or the teaching of E3 in combination with a mold process of the particles according to the second method of E1 can only be seen as the result of an *ex post facto* analysis. The board further notes that even if the teachings of E1 and E3 could be combined, the skilled person would still not arrive at the subject-matter of claim 1 as granted, since there is no teaching in E3 that a majority of the particles are fractured.

5.2.3 With regard to claim 6, the appellant indicated that the combination of documents E1 and E3 would inevitably result in at least two particles with the features of claim 6, including feature 6.6. In this respect, the board agrees with the finding of point 5.2.2 of the reasons for the decision under appeal that neither E1, E2 or E3 disclose feature 6.6 (see also the conclusions on novelty in point 4. above), that there is no clear hint for the skilled person to combine these documents, and that even under a forced combination of these documents the skilled person would not arrive at the subject-matter of claim 6 according to the main request.

5.3 The appellant argued that starting from the known method and abrasive of **E3 as closest prior art**, the skilled person, by getting a motivation for intentionally fracturing the precursor abrasive particles **taught by E1** (fifth method), would arrive at

the subject-matter of claims 1 and 6 according to the patent as granted without exercising inventive skill.

5.3.1 The board disagrees. Indeed, as correctly found by the opposition division in point 5.2.1.1 of the reasons for the decision under appeal, starting from E3, which is directed to minimising the formation of cracks in the particles during drying in a mold cavity, the skilled person has no motivation, and also no hint from E1, to perform more intentional fractures while the particles reside in the mold cavities, and/or that such an intentional fracturing would extend to a majority of the plurality of precursor abrasive particles in the mold. For these reasons, the consideration of the teaching of E1 starting from the disclosure of E3 can only be considered as the result of an *ex post facto* analysis.

5.4 In consequence of the above, the board concludes that the subject-matter of claims 1 and 6 according to the patent as granted is inventive starting from any of documents E1 and E3 as closest prior art.

6. *Appellant's request to include a statement in the minutes of the oral proceedings before the board*

6.1 During the oral proceedings before the board, the appellant requested to include in the minutes an factual statement allegedly made orally by the respondent.

6.2 The board notes that Rule 124(1) EPC requires that the minutes contain the essentials of the oral proceedings and the relevant statements made by the parties. What is "essential" or "relevant" lies within the discretion of the minute writer. It is to be determined by

reference to what the board has to decide, and is thus what is essential or relevant for the decision to be taken (CLB, *supra*, III.C.7.10.1; T 263/05, Reasons 8). Examples are an objection under Rule 106 EPC (R 14/09, Reasons 4), the requests of the parties on which a decision is required and a relevant statement of surrender or abandonment of subject-matter (see e.g. T 263/05 Reasons 8.5-8.8).

6.3 By contrast, the arguments of the parties on patentability are usually not recorded; they are apparent from the written decision. In addition, there is no right of a party to have oral submissions recorded in the minutes (see e.g. T 1690/22, Reasons 4.12 with reference to several decisions). It is furthermore not the function of the minutes to record statements for national proceedings (CLB, *supra*, III.C.7.10.2).

6.4 In the present case, the alleged factual statement made by the respondent was neither a request nor was it a statement of surrender or abandonment of subject-matter. It occurred in the context of the discussion on patentability and simply reflected what the respondent considered to be disclosed in a document. The board fails to see how this can be seen as "essential" or "relevant" within the meaning of Rule 124(1) EPC. Therefore, the board refused the appellant's request to include in the minutes of the oral proceedings before the board an alleged factual statement made by respondent.

## 7. *Conclusions*

It follows from the above that the appellant has not provided convincing and/or admissible objections that



could demonstrate the incorrectness of the decision under appeal, that none of the grounds for opposition under Article 100 EPC prejudice the maintenance of the patent as granted. The appeal is thus to be dismissed.

## Order

### For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



G. Nachtigall

Y. Podbielski

Decision electronically authenticated