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**Datasheet for the decision
of 18 March 2025**

Case Number: T 0929/23 - 3.2.07

Application Number: 19191428.2

Publication Number: 3611137

IPC: C03B7/00, G05B13/04

Language of the proceedings: EN

Title of invention:

APPARATUS AND METHOD TO CONTROL GOB WEIGHT, LENGTH AND/OR
SHAPE

Patent Proprietor:

Emhart Glass S.A.

Opponent:

Heye International GmbH

Headword:

Relevant legal provisions:

EPC Art. 83, 84, 100(b), 111, 113(1), 114(1)

EPC R. 103(1)

RPBA 2020 Art. 11

Keyword:

Late-filed objection - error in use of discretion at first instance (no)

Stay of proceedings - (no)

Sufficiency of disclosure - (yes)

Remittal - (yes)

Reimbursement of appeal fee - (no)

Decisions cited:

G 0009/91, G 0007/93

Catchword:



Beschwerdekammern
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Case Number: T 0929/23 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 18 March 2025

Appellant: Emhart Glass S.A.
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Respondent: Heye International GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 5 April 2023
revoking European patent No. 3611137 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman V. Bevilacqua
Members: B. Paul
E. Mille

Summary of Facts and Submissions

- I. An appeal was filed by the patent proprietor (appellant) within the prescribed time limit and in the prescribed form against the decision of the opposition division to revoke the European patent No. 3 611 137.
- II. In preparation for the oral proceedings the Board gave its preliminary opinion in a communication pursuant to Article 15(1) RPBA, dated 13 November 2024, according to which the decision under appeal could be set aside and the case be remitted to the opposition division. The appellant's request for reimbursement of the appeal fee was likely to be refused.
- III. The opponent (respondent) responded to the Board's preliminary opinion with written submissions of 9 January 2025. The appellant did not react in written proceedings.
- IV. Oral proceedings before the Board took place on 18 March 2025.

At the conclusion of the oral proceedings the decision was announced. Further details of the oral proceedings can be found in the minutes.

- V. The final requests of the parties are as follows.

The appellant requested that
the decision under appeal be set aside,
the case be remitted to the opposition division for
further prosecution on the basis of the set of
claims of the patent as granted (Main Request) and
the appeal fee be reimbursed,

or in the alternative,

when setting aside the decision under appeal, that the case be remitted to the opposition division for further prosecution on the basis of one of the sets of claims of any of Auxiliary Request 1 to Auxiliary Request 15, filed with the statement setting out the grounds of appeal.

The respondent requested that

the appeal be dismissed

and in the alternative

that if the Board would consider to setting aside the decision and to remit the case for further prosecution to the Opposition Division, the proceedings be stayed to await the publication of the decision of the Enlarged Board in the pending referral G 1/24.

VI. This communication makes reference to the claim feature analysis as set out in point II.2 of the grounds for decision.

Independent claim 1 of the main request reads as follows:

"F1: A control arrangement for controlling a system for producing gobs for an individual section machine having a plurality of sections including at least a first section and at least a second section,

F2: the system cyclically producing a set of gobs including at least one gob for each of the plurality of sections including at least one first gob for the first individual section and at least one second gob for the second individual section,

F3: wherein each gob has a predetermined first physical characteristic value,

F4: *the system producing gobs including:*

F4.1: *a gob feeder apparatus and*

F4.2: *a gob shearing mechanism,*

F5: *the gob feeder apparatus having:*

F5.1: *(A) a spout bowl with at least one discharge orifice hole located in the bottom thereof;*

F5.2: *(B) a cylindrical feeder tube within the spout bowl;*

F5.3: *(C) a cylindrical feeder tube vertical adjustment arrangement for adjusting the vertical offset of the cylindrical tube feeder relative to the bottom of the spout bowl;*

F5.4: *(D) at least one plunger needle located within the feeder tube above the at least one discharge orifice hole; and*

F5.5: *(E) a drive arrangement operably coupled to the at least one plunger needle to reciprocally drive the plunger needle toward and away from the discharge orifice hole to emit at least one molten glass stream,*

F6: *the gob shearing mechanism having a reciprocating shear blade located below the spout bowl to repeatedly cut the at least one molten glass stream emitted from the discharge orifice hole to form the gobs that form the set of gobs,*

F7: *the control arrangement comprising: a controller configured to cyclically control, based on a set of feeder control settings for forming the set of gobs:*

F7.1: *A) actuation of the drive arrangement to reciprocally drive the at least one plunger needle towards and away from the discharge orifice hole;*

F7.2: *B) actuation of the reciprocating shear blade; and*

F7.3: *C) actuation of the cylindrical feeder tube vertical adjustment arrangement to control a*

vertical offset of the cylindrical feeder tube relative to the bottom of the spout bowl;

F8: the controller being configured to determine the set of feeder control settings by determining and using an optimal and feasible set of feeder control setting deviations which is a set of deviations from a set of predetermined nominal feeder control settings;

F9: wherein a magnitude of each feeder control setting deviation has a deviation magnitude range of between zero deviation and a maximum deviation from the corresponding nominal feeder control setting;

F10: wherein the feeder control setting deviations have a predetermined priority order from lowest priority to highest priority;

F11: wherein the optimal and feasible set of feeder control setting deviations is feasible if the set of feeder control settings that are determined using the optimal and feasible set of feeder control setting deviations will create the set of gobs with each gob having the corresponding predetermined first physical characteristic value and

F12: is optimal if a magnitude of any one of the feeder control setting deviations within the set of feeder control setting deviations is reduced, and wherein a magnitude of a feeder control setting deviation having a lower priority must be increased for the set of feeder control setting deviations to be feasible."

VII. The wording of independent claims 20 and 21 and the independent claims of Auxiliary Requests 1 to 15 is not relevant to this decision so it is not reproduced here.

VIII. The arguments of the parties relevant for the decision are dealt with in detail in the reasons for the decision.

Reasons for the Decision

1. *Admittance of new ground of opposition*
(Art 114(1) EPC)

1.1 The appellant contested the Opposition Division's decision in point II.3 to admit the new ground of insufficiency (Article 100(b) EPC) into proceedings.

1.2 They submitted that the Opposition Division did not correctly exercise its discretion by incorrectly assessing the criteria of *prima facie* relevance. Further, the Opposition Division failed to provide the legal and factual reasons substantiating the new ground once it had been admitted into oral proceedings before the Opposition Division leaving the appellant in doubt on the basis of this objection, which constitutes a substantial procedural violation.

1.3 The Board does not concur with the appellant's arguments, as set out in point 8. of its communication pursuant to Article 15(1) RPBA.

In oral proceedings, both parties merely referred to their written submissions. The Board does not see any reasons to change its view, as put forward in its preliminary opinion.

1.4 The ground of insufficiency was not raised with the notice of opposition. Neither was this ground of

opposition raised *motu proprio* by the Opposition Division for the first time in oral proceedings. Yet, it was the respondent who raised this objection for the first time in their written submission dated 9 December 2022, *i.e.* within the time limit set with the summons to oral proceedings before the Opposition Division.

The respondent's submissions on Article 83 EPC and thus on Article 100(b) EPC were objectively and clearly to be understood in the context of the entire point II. of the written submission dated 19 December 2022 as a whole.

This section does not primarily deal with the question of inventive step but with the understanding of the teaching of claim 1 according to the Main Request. It clearly discusses arguments with respect to insufficiency that let in their essence to the conclusions in point II.3.2.3 of the decision under appeal, namely the alleged contradiction between the teaching of claim 1 according to the Main Request and the description of the patent.

The respondent therefore provided sufficient arguments to substantiate the newly raised insufficiency objection.

- 1.5 The Opposition Division, as well as all parties, acknowledged that it is established case law of the Boards of Appeal, in accordance with the principles set out by the Enlarged Board in the cases G 9/91 and G 10/91, that the introduction of a new ground of opposition at a late stage during the opposition proceedings of first instance is only admissible in exceptional cases. In particular, the opposition

division may in application of Article 114(1) EPC consider other grounds for opposition, which, *prima facie*, in whole or in part seem to prejudice the maintenance of the patent. (cf. Case Law of the Boards of Appeal [CLB], 10th edition 2022, IV.C.3.4.1)

1.6 The Opposition Division correctly based the exercise of its discretion on the criteria of *prima facie* relevance when it was considering admissibility of the new ground of opposition under Article 114(1) EPC.

1.7 The appellant submitted that the Opposition Division decided that the new ground was *prima facie* relevant because the interpretation of the feature F12 was important for inventive step, which did not give *prima facie* grounds for examining whether the feature F12 was sufficiently disclosed or not. It did therefore not correctly exercise its discretion.

However the decision under appeal merely stipulates that the new ground of opposition appears to be *prima facie* relevant because of a specific understanding of feature F12, which also underlies the assessment of inventive step. This rationale does not mean, that a certain assessment of inventive step incurs a certain evaluation of sufficiency. Instead, it is the understanding of feature F12 as such that supported the *prima facie* reasons justifying the admittance of the new ground of opposition of sufficiency of disclosure and ultimately the rejection of the main request on the basis of this ground.

The Opposition Division therefore exercised its discretion, taking into account the correct criteria. Neither was the assessment of these criteria performed in an arbitrary or severely erroneous manner.

- 1.8 The exercise of discretion by the Opposition Division is to be reviewed by the Boards of Appeal in accordance with the principles set out in G 7/93, according to which a board of appeal should only overturn discretionary decisions of first instance if it has concluded that the first instance exercised its discretion according to the wrong principles, or without taking the right principles or in an unreasonable way (*cf.* CLB, *supra*, IV.C.3.4.1).

None of the aforementioned exceptions, which would allow a review of the discretionary decision of the Opposition Division, apply in the present case.

- 1.9 The appellant further submitted that the fact that the Opposition Division did not indicate the legal and factual reasons substantiating the new ground of opposition, once it had admitted this ground, constitutes a substantial procedural violation.
- 1.10 The Board does not accept this argument either.

The respondent had provided sufficient and detailed arguments on the disputed new ground of opposition in their written submissions dated 9 December 2022, which was also known to the appellant.

The Board cannot recognise any procedural violation in the fact that it was to the appellant to have to initially present their arguments on the substance of the new grounds of opposition during the debate in oral proceedings before the Opposition Division. Nor does the fact that the Opposition Division did not present any preliminary opinion and reasoning on the substantive and legal issues of the admissibility of

the new grounds of opposition at the beginning of the debate during oral proceedings amount to a substantial procedural violation.

There is no legal basis giving a party a right to receive a preliminary opinion on the merits of the adversary party's arguments from an opposition division before presenting their own arguments. Rather, the right to be heard according to Article 113(1) EPC means *inter alia* that the decision may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. It is irrelevant whether the underlying arguments or evidence were provided by the opposition division or, as in the present case, by an other party of the proceedings.

The Board considers that a requirement for a presentation of the initial reasoning of an objection as guaranteed by the appellant's right to be heard according to Article 113(1) EPC arises only when a party does not have any indication of the legal and factual basis upon which a new ground for opposition could be decided, as it was the case in the decision T 433/93 cited by the appellant.

In the present case, the legal and factual basis for the discussion was known to the appellant by the respondent's written submission dated 9 December 2022. The appellant, when having exercised due diligence in preparing the case based on the preceding written procedure and considering all arguments put forward by the opponent, was thus able to adequately address the issue of the admissibility and merits of the newly introduced ground for opposition during the oral proceedings without further comments or explanations by the Opposition Division.

The Opposition Division did therefore not violate the appellant's procedural rights, in particular regarding the right to be heard according to Article 113(1) EPC, when taking its decision on the admissibility of the new ground of opposition.

1.11 The discretionary decision of the Opposition Division admitting the ground of opposition of Article 100(b) EPC into the proceedings is accordingly not to be set aside.

2. *Stay of proceedings*

2.1 During oral proceedings before the Board the respondent requested that if the Board would consider to set aside the decision and to remit the case for further prosecution to the Opposition Division, the proceedings be stayed to await the publication of the decision of the Enlarged Board in the pending referral G 1/24. The appellant objected to that request.

2.2 It was however not evident from the respondent's submissions why the questions subject to the referral G 1/24, all of which concern claim interpretation in the context of patentability under Articles 52 to 57 EPC, should be relevant to the present case, which at this stage of proceedings merely relates to sufficiency of disclosure under Article 83 and 100(b) EPC, *i.e.* a different legal issue. The Board cannot identify any way in which the outcome of the referral G 1/24 could have a possible influence on the present case.

2.3 The request to stay the proceedings is, consequently, to be refused.

3. *Sufficiency of disclosure (Article 83 and 100(b) EPC) - Main Request*

- 3.1 The appellant contests the Opposition Division's findings in point II.3.2 of the decision under appeal that Article 100(b) EPC prejudiced the maintenance of the patent as granted, i.e. according to the Main Request.
- 3.2 They argued that the Opposition Division erred in its understanding of feature F12 by reading the last part of feature F12 entirely separately from the first part of feature F12, while those wordings were inseparable and together described the test for whether the feasible feeder control settings of feature F11 are optimal or not.
- 3.3 The Opposition Division on the contrary found that feature F12 had a clear meaning and should (only) be understood to require that for a set of feeder control settings to be feasible, the magnitude of a setting having a low priority must be increased.
- 3.4 Neither the Opposition Division's findings nor the respondent's arguments that the wording of claim 1 of the Main Request, in particular the second part of feature F12, made sense on its own and is without doubt to be understood according to their interpretation, are convincing.

The skilled person understands claim 1 as a whole and not deconstructed into individual portions. This corresponds to the established case law that the skilled person should try, with synthetic propensity, i.e. building up rather tearing down, to arrive at an interpretation of the claim which is technically

sensible (*cf.* CLB, *supra*, II.6.1), as also reflected in decision T 190/99 cited by the appellant.

In consequence, feature F12 has to be understood in conjunction with features F8, F10 and F11. These features conjunctively indicate the criteria for setting adjustments, i.e. determining and using the optimal and feasible set of feeder control settings deviations, with features F11 and F12 further commonly clarifying and addressing the interdependence among adjustments in view of these criteria.

This becomes already evident from the fact that the wording of feature F12, and in particular the last half-sentence, refers to the terminology of these other features F8, F10 and F11 with the terms "*optimal*", "*feeder control setting deviation*", "*priority*" and "*feasible*".

Feature F12, which may have been formulated in a somewhat cumbersome manner, and in particular the last half-sentence, is not understood by the skilled person as an independent procedural step, but rather as a further definition of what is considered optimal in the context of those other features, named above.

Against this background, the reading of the second part of feature F12 given by the appellant, according to which "*a set of feeder control setting deviation is optimal if any of the control setting deviations cannot be reduced without increasing the magnitude of a deviation with a lower priority for the set of control setting deviation to remain feasible*" appears to be correct.

3.5 Even if one were to assume in favour of the respondent that the wording of feature F12 could be considered ambiguous, this argument would primarily relate to the requirement of Article 84 EPC, *i.e.* clarity of the claim formulation, and not to the requirement of sufficiency (Articles 83 and 100 (b) EPC).

It is generally not enough to establish lack of clarity in order to establish lack of compliance with Article 83 EPC, *i.e.* to sufficiently support an objection under 100(b) EPC. Rather it is necessary to show that the patent as a whole (*i.e.* not only the claims) does not enable the skilled person - who can avail themselves of the description and their common knowledge - to carry out the invention (*cf.* CLB, *supra*, II.C.8.2). There were neither according findings in the decision under appeal nor such objections or arguments by the respondent. Their arguments were instead merely based on an alleged contradiction between the scope of the claim and description.

3.6 In consequence, the ground of opposition based on Article 100(b) EPC does not prejudice the maintenance of the patent as granted. The decision under appeal is thus to be set aside.

4. *Reimbursement of the appeal fee (Rule 103(1) (a) EPC)*

With their statement setting out the grounds of appeal the appellant requested the reimbursement of the appeal fee.

The appellant argued that, in the present case, a reimbursement of the appeal fee would be equitable because at least one substantial procedural violation occurred in the proceedings before the Opposition

Division (Rule 103(1) (a) EPC, see also point 1.9 above) when deciding on the admission of the new ground of appeal of Article 100(b) EPC.

4.1 Yet, as established in point 1.10 above of the present decision, as no violation of the right to be heard or any other substantial procedural violation is evident, the request for reimbursement of the appeal fee is to be refused.

5. *Remittal of the case to the opposition division, (Articles 11 RPBA 2020 and 111(1) EPC)*

5.1 The appellant requested that the case be remitted to the Opposition Division for further prosecution based on the Main Request in case that the Board concluded that the ground for opposition under Article 100(b) EPC did not prejudice the maintenance of the patent as granted.

5.2 The respondent objected to this request in their reply to the statement setting out the grounds of appeal.

5.3 In point 10. of its communication pursuant to Article 15(1) RPBA the Board expressed its preliminary opinion to remit the case.

During oral proceedings, both parties merely referred to their written submissions. The Board does not see any reasons to change its view, as put forward in its preliminary opinion.

5.4 According to Article 11 RPBA, a remittal for further prosecution should only be undertaken, exceptionally, when special reasons apply.

In the present case, the decision under appeal dealt only with the grounds of opposition under Article 100(b) EPC. There are no findings in view of Article 100(a) EPC.

During appeal proceedings, the respondent repeated *verbatim* their first instance arguments on the objection of lack of inventive step.

The appellant only made a cursory submission on this objection.

In view of the above, the Board would have had to deal comprehensively with the ground for opposition according to 100(a) EPC for the first time in oral proceedings. This, in any case, is not compatible with the primary objective of the appeal proceedings of a judicial review of the contested decision (Article 12 (2) RPBA).

- 5.5 After considering all the relevant circumstances of the case at hand, the Board therefore comes to the conclusion that the issues relevant to the ground of opposition in accordance with Article 100(a) EPC, cannot not be decided upon without undue burden.

Consequently, there are special reasons within the meaning of Article 11, first sentence, RPBA that apply.

The present case is to be remitted to the Opposition Division for further prosecution based on the patent as granted, in accordance with Article 111(1) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The request of the respondent for stay of the appeal proceedings is refused.
3. The request for reimbursement of the appeal fee is refused.
4. The case is remitted to the Opposition Division for further prosecution on the basis of the set of claims of the patent as granted.

The Registrar:

The Chairman:



G. Nachtigall

V. Bevilacqua

Decision electronically authenticated