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**Datasheet for the decision  
of 3 July 2014**

**Case Number:** T 1400/11 - 3.2.07

**Application Number:** 06021743.7

**Publication Number:** 1777048

**IPC:** B27D5/00, B27C9/02, B23Q1/54

**Language of the proceedings:** EN

**Title of invention:**  
Operating machine for machining wooden elements

**Patent Proprietor:**  
SCM Group S.p.A.

**Opponent:**  
Homag Holzbearbeitungssysteme AG

**Headword:**

**Relevant legal provisions:**  
RPBA Art. 12(4)

**Keyword:**  
Admissibility of all appellant's requests filed with  
the statement setting out the grounds of appeal - (no)

**Decisions cited:**  
G 0007/91, G 0008/91, G 0009/91, G 0010/91, G 0009/92,  
G 0004/93, G 0007/93, G 0008/93, G 0001/99, R 0010/09,  
R 0011/11, T 0931/06, T 1685/07, T 0356/08, T 1067/08,  
T 0144/09, T 0936/09, T 0023/10

**Catchword:**

Reasons, points 3.2 to 3.11



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Case Number: T 1400/11 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 3 July 2014**

**Appellant:**  
(Patent Proprietor)

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**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted on 28 April 2011  
revoking European patent No. 1777048 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** I. Beckedorf  
**Members:** K. Poalas  
G. Patton

## Summary of Facts and Submissions

I. The appeal of the patent proprietor (hereinafter: the appellant) lies from the decision of the opposition division dated 28 April 2011 revoking European patent No. EP 1 777 048 (patent in suit).

II. Claim 1 of the granted patent reads as follows:

"Operating machine for machining elements (100) made of wood or similar material comprising:

- edge-banding means (2) provided with gluing means for distributing adhesive on edge portions of an element (100) made of wood or similar material;
- operating means (3) provided with an anthropomorphic operating head with controlled axes comprising a spindle means (5) suitable for driving tool means (30) for performing a plurality of machinings on said elements (100), said operating means (3) being movable with respect to said element (100) along three controlled rectilinear axes substantially perpendicular to one another and around two controlled rotation axes (B, C) not parallel to one another and substantially incident; and
- supporting means (20, 21) for slidably supporting said edge-banding means (2) and said operating means (3), said supporting means (20, 21) comprising fixed portal means (20) and/or movable portal means (21),

whereby said edge-banding means (2) and said operating means (3) are mounted on the same side of said fixed portal means (20) or of said movable portal means (21) and said operating machine comprises interconnecting means (15, 16) suitable for connecting said edge-banding means (2) to said operating means (3)".

III. An opposition was filed against the patent in suit based on the ground for opposition under Articles 100(a), 52(1) and 56 EPC (lack of inventive step).

As far as inventive step was concerned, the opponent (hereinafter: the respondent) submitted *inter alia* that the publicly available machining centre "BAK 41" according to documents E1 and E3 to E6 in combination with the teaching of E8 rendered the subject-matter of claim 1 not inventive.

IV. The appellant failed to participate in any way in the opposition proceedings. Nor did it respond to either of the two communications under Rule 79(1) EPC or request oral proceedings. Thus, it did not file any requests, amended claims or submissions of any kind that the opposition division could have taken into consideration when assessing the respondent's submissions during the opposition proceedings.

V. Consequently, the decision under appeal was issued without prior oral proceedings or a prior communication on substantive issues to the parties.

The opposition division, in essence following the respondent's arguments, found that the subject-matter of claim 1 of the patent as granted did not involve an inventive step over the combination of the publicly available machining centre "BAK 41" according to documents E1, E3, E5 and E6 in combination with the teaching of E8.

VI. With its admissible appeal the appellant defended the patent in suit in unamended form (patent claims as granted) and, alternatively, in amended form on the

basis of one of three auxiliary requests.

In support of its requests, the appellant questioned the admissibility of documents E1, E3, E5 and E6 and presented arguments in support of its view that the subject-matter of claim 1 of the patent as granted involves an inventive step over the machining centre "BAK 41" as defined in the aforementioned documents in combination with the teaching of E8. In respect of its three auxiliary requests, the appellant stated that claim 1 of the first auxiliary request encompassed claims 1, 2 and 3 of the patent as granted, claim 1 of the second auxiliary request encompassed claims 1, 3, 7, 8 and 9 of the patent as granted and claim 1 of the third auxiliary request included the subject-matter of claims 1, 10 and 11 of the patent as granted and of paragraph 30 of the patent in suit. The appellant further argued that the subject-matter of amended claims 1 of said auxiliary requests involved an inventive step over the documents cited by the respondent during the opposition proceedings.

VII. In its reply, the respondent submitted arguments as to why claims 1 according to all the appellant's requests did not involve an inventive step.

VIII. In its communication under Article 15(1) RPBA annexed to the summons to oral proceedings, the Board expressed its provisional and non-binding opinion in which it referred *inter alia* to the course of the opposition proceedings, to Article 12(4) RPBA and to decision T 936/09 of 1 March 2012, not published, see in particular points 2.4 to 2.6 of said communication.

IX. Oral proceedings before the Board took place on 3 July 2014.

X. The appellant's arguments, in so far as they are relevant to the present decision, may be summarised as follows.

It did not present any requests or arguments during the opposition proceedings as it considered the grounds for opposition manifestly unfounded as the respondent relied on an alleged prior use so clearly inadmissible that there was no need for the appellant to discuss inventive step based on that allegation. It rather thought to leave it to the opposition division to take account of the inadmissibility of the prior use and, thus, to maintain the patent as granted. For the same reason it did not consider it imperative to file amended claims in the proceedings before the opposition division.

The point at issue in the opposition proceedings was whether the subject-matter of claim 1 of the patent as granted involved an inventive step. Hence, the decision under appeal was limited to the issue of the allowability of the granted claim.

Since its main request was aimed at maintaining the patent as granted, said request could not be considered as being a new request in appeal, as it related to the same issue dealt with during the opposition proceedings.

By admitting the appellant's main request the Board's review of the decision under appeal would concern the same subject-matter that had been dealt by the opposition division. Consequently, the Board would not

be confronted with a fresh case and the case would be examined before two instances, as foreseen in the EPC.

The procedural situation in case T 936/09 was distinct from the present one in that the patent proprietor had filed a request directed to amended claims for the first time with its statement of grounds of appeal. However, in the present case, the appellant's main request was not directed to amended claims but to the granted claims underlying the impugned decision. Thus, the conclusions of T 936/09 were not applicable to the present case.

XI. The respondent's arguments, in so far as they are relevant to the present decision, may be summarised as follows.

The decision under appeal did not go beyond the content of what had been submitted in the notice of opposition against the allowability of claim 1 of the patent as granted on the basis of a public prior use based *inter alia* on documents E1, E3, E5 and E6. Thus, all the reasons for revoking the patent in suit were known to the appellant from the very beginning of the opposition proceedings. In those proceedings, the appellant had not been hindered from submitting any arguments and evidence against the opposition. In particular, the appellant had not been prevented from filing any requests to defend its patent in the version as granted or in an amended version, which were only filed with its statement setting out the grounds of appeal. It had been the appellant's considered and deliberate choice to remain completely silent and inactive during the opposition proceedings. The appellant, therefore, had implicitly demonstrated that it had no interest in defending the patent in suit on its merits.



By filing an appeal based on a main request requesting the maintenance of the patent as granted, the appellant was aiming at defending its patent exclusively in appeal proceedings, thereby circumventing the opposition proceedings. Allowing such a shifting of the case and admitting the main request into the appeal proceedings would jeopardise the procedural principles of two-tier *inter partes* proceedings first before the opposition division and then on appeal before the Board. In addition, it also put the respondent at a serious disadvantage in any event. If the Board remitted the case to the opposition division the respondent would be faced with a prolongation of the proceedings by several years because there would not only be a new decision of the opposition division but possibly also second appeal proceedings.

The conclusions of T 936/09 were fully applicable to the present appeal and the present case in respect of the main request was even worse.

The above arguments in respect of the appellant's main request applied even more to the auxiliary requests. If the Board admitted those requests it would have to decide on the patentability of the subject-matter of the amended claims of said requests. Since said subject-matter had never been examined by the opposition division the respondent would be deprived of an examination of said claims before two instances.

XII. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, alternatively, that the patent be maintained in amended form on the

basis of one of the sets of claims filed as first to third auxiliary requests with letter dated 7 September 2011.

The respondent requested that the appeal be dismissed.

### **Reasons for the Decision**

1. The present case is marked by special circumstances that affect the legal nature of the appeal proceedings and raise the issue of whether the appellant, in submitting its case for the first time in its appeal, is complying with the purpose of the appeal according to Article 106 EPC.
  
2. Appeal proceedings are wholly separate and independent from proceedings before the administrative departments of the EPO, here the opposition division (see G 8/93, OJ EPO 1994, 887, point 1 of the Reasons). Their function is to give a judicial decision upon the correctness of a separate earlier decision taken by a department in order to relieve the appellant from the adverse effect of the decision under appeal (see G 9/92 and G 4/93, OJ EPO 1994, 875, points 5 and 9 of the Reasons; G 1/99, OJ EPO 2001, 381, point 6.1 of the Reasons). In decisions G 7/91 and G 8/91 (OJ EPO 1993, 356, 346, point 7 of the Reasons), G 9/91 and G 10/91 (OJ EPO 1993, 408, 420, point 18 of the Reasons) and G 1/99 (*supra*, point 6.6 of the Reasons), the Enlarged Board held that the appeal procedure is to be considered as a judicial procedure proper to an administrative court.

It follows from the characteristics set out by the Enlarged Board that the general principles of court procedure, such as the entitlement of parties to direct the course of the proceedings themselves ("principle of party disposition"), also apply to appeals, that a review of the decision taken by the administrative department can, in principle, only be based on the reasons already submitted before that department, and that the proceedings are determined by the petition initiating them (*ne ultra petita*) (see Case Law of the Boards of Appeal, 7th edition 2013, Chapter IV.E.1).

To guarantee their judicial function, proceedings before the boards of appeal are governed by rules of procedure (RPBA).

2.1 Article 12(4) RPBA requires the Board to take into account everything presented by the parties under Article 12(1) RPBA if and to the extent that it relates to the case under appeal and meets the requirements in Article 12(2) RPBA. However, according to Article 12(4) RPBA, the Board has the discretionary power to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first-instance proceedings. This discretionary power serves the purpose of ensuring fair and reliable conduct of judicial proceedings (see T 23/10, not published, point 2.4 of the Reasons).

2.2 It follows from the above that a party to appeal proceedings has no absolute right to have a request which could have been filed in the proceedings before the administrative department but was only filed with the statement setting out the grounds of appeal, considered in the appeal proceedings (see e.g. R 10/09, point 3.2 of the Reasons; R 11/11, point 9 of the

Reasons; T 144/09, point 1.14 of the Reasons; T 936/09, point 2 of the Reasons, all decisions not published).

Consequently, a patent proprietor who files such a request cannot defend its patent on the basis of that request in appeal proceedings if the Board, exercising its discretion under Article 12(4) RPBA, holds it inadmissible.

According to established jurisprudence, discretion has to be exercised equitably, i.e. all relevant factors which arise in the particular circumstances of the case have to be considered (see G 7/93, OJ EPO 1994, 775, point 2.5 of the Reasons; R 11/11, point 9 of the Reasons; T 931/06, not published, point 3.5 of the Reasons; T 23/10, point 2.3 of the Reasons).

3. In the opposition proceedings, the appellant, although having received several EPO communications, see points IV to VI above, did not react at all to the opposition filed against its patent. The appellant did not file any submissions, such as requests, arguments or amended claims, in the course of the opposition proceedings, despite being given several opportunities to do so, see points IV to VI above. Undeniably, throughout the opposition proceedings, the appellant declined to take the opportunity to defend in writing its patent as granted or in amended form. Nor did the appellant file a request for oral proceedings, with the result that the opposition division was not obliged to hold oral proceedings in case of a revocation of the patent.

3.1 In the Board's view, by its conduct the appellant thus made a "considered and deliberate choice" to remain completely passive and not to play any active role by reacting to the opposition in writing or orally,

despite being given the opportunity to do so by the opposition division.

The Board considers the appellant's conduct in the opposition proceedings particularly significant since a patent proprietor usually files at least a request for maintenance of its patent in unamended or amended form, together with arguments as to why the grounds for opposition raised do not prejudice the maintenance of the patent as granted if it wants to maintain its patent in that form, or why its patent in a limited form meets the requirements of the EPC.

- 3.2 The Board fully concurs with the principle established in T 936/09 (see also Case Law of the Boards of Appeal, Chapter IV.E.4.3.2 b)) that a patent proprietor is not free to present or complete its case at any time it so wishes during the opposition or opposition appeal proceedings, depending, for example, on its procedural strategy or its financial situation:

*"It is not the purpose of the appeal to conduct the case anew and, therefore, the issues to be dealt with in appeal proceedings are determined by the dispute underlying the opposition proceedings (see e.g. T 356/08, point 2.1.1 of the Reasons). Thus the appeal proceedings are not just an alternative way of dealing with and deciding upon an opposition. Parties to first-instance proceedings are therefore not at liberty to shift their case to the second instance as they please, thereby compelling the board of appeal either to give a first ruling on the critical issues or to remit the case to the department of first instance (see also T 1067/08, point 7.2 of the Reasons). The filing of new submissions (requests, facts or evidence) by a party are not precluded in appeal proceedings, but their*

*admission is restricted, depending inter alia on the procedural stage at which the submissions are made (see e.g. T 356/08, point 2.1.1 of the Reasons, T 1685/07, point 6.4 of the Reasons; Brigitte Günzel, "The treatment of late submissions in proceedings before the boards of appeal of the European Patent Office", Special edition OJ EPO 2/2007, 30)."*

- 3.3 There is no legal obligation under the EPC for a patent proprietor to take an active part in opposition proceedings, for example by filing at least a request, arguments or amended claims. However, if it chooses not to complete its submissions at the stage of the opposition proceedings, but rather to present or complete its case only in the appeal proceedings, then it will need to face the prospect of being held to account for such conduct by the Board when, for example, exercising its discretion under Article 12(4) RPBA.
- 3.4 This applies in particular if all the reasons for revocation of the opposed patent were known to the patent proprietor before it received the impugned decision.

In the present case the notice of opposition clearly indicated the grounds for opposition, together with the supporting evidence and submissions, and the appellant could and should have expected that the ground for opposition raised in the notice of opposition would most probably be dealt with in the decision of the opposition division. Due to the appellant's complete failure to participate in the opposition proceedings these facts had never been contested by the appellant and, therefore, could be regarded as uncontested.

There is nothing in the decision under appeal which goes beyond the content of the notice of opposition.

3.5 Thus, all the reasons for revocation of the opposed patent were known to the appellant before it received the impugned decision, and it could have reacted to them by at least requesting during the opposition proceedings the rejection of the opposition, i.e. maintenance of the patent as granted. Moreover, the appellant was given several opportunities to argue against the grounds for opposition or to react to them, see points IV and VI above. Consequently, at that stage the appellant could well have filed a request and/or arguments as it did with its statement setting out the grounds of appeal.

3.6 The reason given by the appellant for not reacting to the opposition was that it was persuaded that the grounds for opposition were unfounded and that the opposition division would reject the opposition without it needing to file any requests or arguments.

The Board notes that such motives cannot justify the appellant's complete failure to defend its patent that had been substantively opposed by the respondent. Even if the appellant thought that the objections submitted with the respondent's opposition would not compromise maintenance of the patent as granted and that it could refrain from submitting any arguments and evidence and from filing any request to counterbalance the opposition, this does not mean that it could not have done so or that it could await passively the final decision of the opposition division.

In view of the foregoing, the Board concludes that the appellant could well have defended the patent in suit

in the opposition proceedings in response to the objections raised in the notice of opposition. Hence the Board considers that the provisions of Article 12(4) RPBA are pertinent for the present case.

Allowing the appellant to shift the defence of its patent entirely from the opposition proceedings to the appeal proceedings would be at odds with the judicial nature of appeal proceedings.

- 3.7 The Board is well aware that the appellant's main request is directed to setting aside the decision under appeal and to maintaining the patent as granted, and that not admitting its request and supporting submissions would create a situation where the appellant effectively cannot argue with the grounds for opposition on which the decision under appeal is based.

The appellant is right that in this respect the present case differs from the factual situation in case T 936/09.

- 3.8 However, the aforementioned consequence is direct result of the appellant's considered and deliberate choice not to respond at all to the objections submitted with the opposition during the opposition proceedings, and to defend its patent for the first time in appeal proceedings.

As argued by the respondent, the appellant effectively circumvented the opposition proceedings by defending its patent exclusively in the appeal proceedings. In this way, the appellant has tried to shift its case entirely to the second instance, thereby compelling the Board either to give a first ruling on the appellant's case or to remit the matter to the opposition division.



Such a shifting of the appellant's case would also put the respondent at an unjustified disadvantage because if the appellant's main request were admitted and decided upon by the Board, at least the part of the appellant's case relating to the admissibility of documents E1, E3, E5 and E6 would have been dealt with only by the Board and the respondent would be factually deprived of an examination of that issue before two instances.

3.9 Furthermore, the Board cannot follow the appellant's argument that since the impugned decision examined the issue of inventive step in respect of the subject-matter of claim 1 of the patent as granted, and the appellant's main request is directed to maintenance of the patent as granted, the Board examining that request would not be dealing with a fresh case but would be acting as second instance for the same issue, namely whether the subject-matter of claim 1 of the patent as granted involves an inventive step, for the following reasons.

3.10 The respondent submitted with its opposition *inter alia* documents E1, E3, E5 and E6 supporting its prior-use based attack asserting that the subject-matter of claim 1 of the patent as granted lacked inventive step.

This evidence and the corresponding arguments were not contested by the appellant during the opposition proceedings. The opposition division, on the basis of said **uncontested** evidence, saw no reason not to follow the respondent's equally uncontested arguments and found that the subject-matter of claim 1 of the patent as granted did not involve an inventive step.

The appellant's action in contesting the admissibility of said evidence for the first time in its statement setting out the grounds of appeal means that the Board would have to start the examination of the present case anew, i.e. from a situation where the admissibility of the evidence leading to the impugned decision has been contested for the first time by the appellant.

Since the opposition division was prevented by the appellant's behaviour during the opposition proceedings from evaluating the admissibility of prior use evidence E1, E3, E5 and E6 in the light of the appellant's arguments, which were presented for the first time in its statement setting out the grounds of appeal, if the Board were now to evaluate the admissibility of that uncontested prior use evidence it would be examining the appellant's admissibility objections for the first time, rather than evaluating the decision under appeal about them, as the opposition division was not confronted with any such objections at any time.

- 3.11 For the above reasons, the Board, exercising its power under Article 12(4) RPBA, decided to hold inadmissible the appellant's main request and its supporting submissions.
4. The issue of whether the appellant's three auxiliary requests could be held admissible in the appeal proceedings is to be examined against the background of the conclusions set out above.
  - 4.1 As stated by the appellant, claims 1 of its first to third auxiliary requests filed for the first time with its statement setting out the grounds of appeal are mainly based on combinations of the independent claim 1 with different dependent claims of the patent as

granted.

- 4.2 Accordingly, claims 1 of said auxiliary requests are directed to subject-matter which has not been taken into consideration in the opposition division's decision, which was based only on claim 1 of the patent as granted.
- 4.3 This indisputably generates a fresh case for the Board to deal with.
- 4.4 The Board's reasoning above leading to excluding the appellant's main request from the appeal proceedings applies *mutatis mutandis* also to the auxiliary requests.

Hence, the Board, exercising its power under Article 12(4) RPBA, decided to hold inadmissible the appellant's three auxiliary requests.

5. Since there is no admissible request of the appellant on which the appeal proceedings could be based, the appeal must be dismissed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

I. Beckedorf

Decision electronically authenticated