

**Internal distribution code:**

- (A) [ - ] Publication in OJ  
(B) [ - ] To Chairmen and Members  
(C) [ - ] To Chairmen  
(D) [ X ] No distribution

**Datasheet for the decision  
of 28 January 2014**

**Case Number:** T 1214/12 - 3.2.08  
**Application Number:** 04800260.4  
**Publication Number:** 1684657  
**IPC:** A61C5/08, A61C5/10, A61C13/00  
**Language of the proceedings:** EN

**Title of invention:**

SYSTEM AND ARRANGEMENT FOR PRODUCING A DENTAL REPLACEMENT  
COMPONENT, AND SUCH A COMPONENT

**Patent Proprietor:**

Nobel Biocare Services AG

**Opponent:**

BEGO Medical GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 107, 113(2), 114(2)  
EPC R. 99(1)(c), 99(2), 101, 115(2), 116  
RPBA Art. 12(4)

**Keyword:**

Basis of decision - text submitted or agreed by applicant (no)  
Late-filed request - request could have been filed in first  
instance proceedings (yes)

**Decisions cited:**

G 0007/93, G 0009/91, G 0010/91

**Catchword:**



**Beschwerdekammern  
Boards of Appeal  
Chambres de recours**

European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 1214/12 - 3.2.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.08**  
**of 28 January 2014**

**Appellant:** Nobel Biocare Services AG  
(Patent Proprietor) Postfach  
8058 Zürich-Flughafen (CH)

**Representative:** Roman Ekstedt, Måns  
Nobel Biocare AB  
P.O. Box 5190  
402 26 Göteborg (SE)

**Respondent:** BEGO Medical GmbH  
(Opponent) Wilhelm-Herbst-Strasse 1  
28359 Bremen (DE)

**Representative:** Eisenführ Speiser  
Patentanwälte Rechtsanwälte PartGmbB  
Postfach 10 60 78  
28060 Bremen (DE)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 23 March 2012  
revoking European patent No. 1684657 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman:** T. Kriner  
**Members:** C. Herberhold  
D. T. Keeling

## **Summary of Facts and Submissions**

- I. By decision posted on 23 March 2012 the Opposition Division revoked European patent EP-B-1 684 657.
- II. During the oral proceedings in opposition proceedings on 5 March 2012 the proprietor (now the appellant) withdrew the hitherto discussed Main and Auxiliary Requests (both filed on 3 February 2012) and replaced them by a new Main and a new Auxiliary Request. The Opposition Division did not admit these new requests into the proceedings under Article 114(2) and Rule 116 EPC. When asked by the chairman, the proprietor explicitly stated that it did not wish to file any further requests (see item 16 of the minutes). The patent was then revoked because it "does not include claims, which is a prerequisite for a patent application (see Article 78(1)c) EPC) and thus also for a patent."
- III. The appellant lodged an appeal against this decision on 23 May 2012, paying the appeal fee on the same day. In the notice of appeal it requested reversal of the decision and maintenance of the patent as granted. The statement setting out the grounds of appeal, including a new Main Request, was filed on 2 August 2012.
- IV. In a notification dated 27 June 2013 the Board summoned the parties to oral proceedings, which both the appellant and the respondent (opponent) had requested.
- V. With letter dated 25 November 2013 the respondent withdrew its request for oral proceedings and announced that it would not attend the oral proceedings. On the day before the scheduled date (27 January 2014) the appellant likewise withdrew the request for oral

proceedings and requested a decision according to the state of the file.

- VI. In accordance with Rule 115(2) EPC oral proceedings were held in the parties' absence on 28 January 2014.

In the written proceedings, the appellant had requested that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 4 filed on 2 August 2012 with the statement of grounds of appeal.

The respondent requested - likewise in the written proceedings - that the appeal be dismissed as inadmissible or unallowable. In addition, it requested that claims 1 to 4 filed on 2 August 2012 not be admitted into the proceedings.

- VII. Claim 1 of the sole request filed on 2 August 2012 reads as follows:

"A system for production of a dental replacement component (23, 24) and comprising identification equipment (2) for identifying the treatment situation, modeling equipment (9), ordering equipment by means of which one or more first information items (15) can be generated as a function of one or more second information items (5) obtained from or with the aid of the identification equipment (2) and/or the modeling equipment, and also an at least substantially fully automated production arrangement (16), designed to receive the first information item (15) and, as a function of the latter, effect at least most of the dental replacement component, characterized in that,

as a function of the first information item or items (15), the production arrangement (16), designed to effect production, by pressing or pressure-casting, of an integrated dental replacement component in the form of one or more dental crowns (23,24), each dental crown being made up of two layers (26a, 26b), and the first layer comprises or consists of porcelain material forming the outer shape or substantially the outer shape of the dental crown, and the second layer consists of or comprises a densely sintered material different than the porcelain material, for example aluminum oxide, zirconium oxide, etc., which is inlaid in the porcelain material and forms a cap (26b) with an inner shape which with great accuracy, for example 0.02-0.1 mm, matches an outer shape (e. g. tooth stump) in the treatment situation, wherein the production arrangement includes a milling tool (34) to mill a die (33) in embedding compound with the inner shape (33a) of the cap, means to scan (40) the cap mounted on the die using adhesive applied to the inner shape (33a) of the cap, means to immerse the cap and the die in molten wax or an equivalent thereof, a milling tool (48) to mill the outer shape (47) of the dental crown from the hardened wax (45), and means to apply a casting channel (50) to the shaped molten wax, or includes a milling tool to mill a die corresponding to the outer shape of the cap, means to immerse the milled die in molten wax, a milling tool (59) to mill the outer shape of the dental crown in the hardened wax, and means to apply a casting channel to the wax mold separated from the die and mounted on the cap."

VIII. The essential arguments of the appellant can be summarised as follows:

*Admissibility of the appeal*

The appellant was adversely affected by the Opposition Division's decision rejecting all of the requests and revoking the patent. Neither the initial request in the notice of appeal to maintain the patent as granted, nor the claims as filed with the grounds of appeal could have any influence on the adverse effect of the decision rendered. Furthermore, the extent to which the decision was to be amended, i.e. the claims requested for maintaining the patent, were indicated in the statement setting out the grounds of appeal as required by Rule 99(2) EPC. Consequently the appeal was admissible.

*The decision of the Opposition Division*

The Main and Auxiliary Requests had been filed at the oral proceedings before the Opposition Division in a fair attempt to overcome objections discussed during the oral proceedings against the requests submitted on 3 February 2012. The new requests filed were prima facie suited to overcome the added matter objections because they were based on a combination of claim 1 as granted, against which no objections under Article 123 had been raised, and originally filed dependent claims 5 and 6, which had only been objected to for lack of clarity. Moreover, the newly filed requests covered the same inventive concept as the claims filed on 3 February 2012, such that the respondent was neither faced with a new situation nor could he have been surprised by the newly requested subject-matter. It was a legitimate interest of the proprietor to have amendments discussed, hence the new requests should not have been rejected as late filed by the Opposition Division.

*Admissibility of the request filed on 2 August 2012*

The claims filed on 2 August 2012 with the grounds of appeal covered - apart from some amendments to conform the features to the apparatus category - the same concept as the claims of the Main and Auxiliary Request filed during the oral proceedings, which - as already discussed - should have been admitted into the opposition proceedings. These claims were thus not late filed and should be admitted into the appeal proceedings.

- IX. The essential arguments of the respondent can be summarised as follows:

*Admissibility of the appeal*

In the notice of appeal the appellant requested maintenance of the patent as granted although the patent claims as granted were neither defended during the opposition proceedings nor subject of the impugned decision. Hence, the appellant was not adversely affected as regards his request for maintaining the patent as granted contrary to the requirements of Article 107 EPC. Furthermore, the claims filed on 2 August 2012 were not equal or narrower either than the subject-matter of the claims first discussed and later withdrawn during oral proceedings before the Opposition Division, or than the new requests filed during the oral proceedings. Therefore, their subject-matter had to be considered an *aliud*, and the appellant was not negatively affected with respect to the main request based on these claims. Consequently the appeal had to be rejected under Rule 101(1) in view of Article 107 EPC.



*The decision of the Opposition Division*

The admission of the late filed requests during the oral proceedings lay within the discretion of the Opposition Division. The Board of Appeal should only overrule such a discretionary decision if the wrong principles were applied or if the decision was taken in an unreasonable way. This was clearly not the case: Firstly, an amendment based on claims which had been objected to under Article 84 EPC and consequently had been removed from the claim set proposed for grant could not have reasonably been expected either by the opponent or by the Opposition Division. Secondly, such an amendment was *prima facie* not allowable, because the requirement of clarity was not met.

*Admissibility of the request filed on 2 August 2012*

The claims filed on 2 August 2012 were late filed and also *prima facie* unallowable for lack of clarity. The claims were furthermore not allowable under Article 123(2) EPC and introduced new subject-matter into the proceedings which had until now not been discussed. Hence, the request was to be rejected as inadmissible.

**Reasons for the Decision**

1. Admissibility of the appeal

Article 107 EPC stipulates that any party to proceedings adversely affected by a decision may appeal. According to established case law a party is adversely affected if the decision does not accede to its Main Request or to Auxiliary Requests preceding the

allowed auxiliary request (Case Law of the Boards of Appeal, seventh edition, 2013, IV.E.2.4.2.a). In the present case, the proprietor's final requests before the decision was taken were directed at the maintenance of the patent on the basis of the Main Request or on the basis of the Auxiliary Request filed during the oral proceedings (see item 11 of the minutes). Said newly filed requests were not admitted into the proceedings and the patent was revoked. Consequently, the appellant's requests were not granted and it was negatively affected by the decision in the sense of Article 107 EPC.

Furthermore the notice of appeal contained a petition to reverse the decision and to maintain the patent as granted (item 1 of the notice of appeal), i.e. a request defining the "subject of the appeal" as required by Rule 99(1)(c) EPC.

Moreover, in point II.2 of the statement setting out the grounds of appeal, the appellant discusses the reasons why in its opinion the Main and Auxiliary Requests filed during the oral proceedings should not have been rejected as late filed, thus indicating the reasons for setting aside the impugned decision and the facts on which the appeal is based. The statement of grounds thus fulfills the requirements of Rule 99(2) EPC.

In view of the above analysis the appeal is admissible no matter whether the request filed with the grounds of appeal claims subject-matter broader than, narrower than or even different from a previous request. Such an evaluation may be taken into account by the Board when exercising its discretion to admit or not admit requests which were held inadmissible or could have

been presented in first instance under Article 12(4) RPBA. It does however have no bearing on the admissibility of the appeal once the party is negatively affected and the reasons for setting aside the impugned decision and the relevant facts have been sufficiently set out.

2. The decision of the Opposition Division

Article 114(2) and Rule 116 EPC give the Opposition Division the discretionary power not to consider late filed new requests, unless admitted on the grounds that the subject of the proceedings has changed.

According to the minutes (items 2-6) and the impugned decision (item III.3), the question whether or not the amendments introduced in the requests filed on 3 February 2012 resulted in a violation of Article 123(2) EPC was discussed during the oral proceedings on the basis of the same passages and with respect to the same objections as already put forward in item 2.5 of the opponent's letter dated 16 November 2011 (received 17 November 2011). In particular the respondent had argued in said letter as well as during the oral proceedings that only pages 8, line 31 et seq., Figures 3 and 4 and claims 5 and 6 as originally filed might serve as a basis for the amendment to granted claim 1. Omission of features of this possible basis would inadmissibly extend the subject-matter beyond the boundaries of the original disclosure. Although the appellant has stated that the claims of the newly filed Main and Auxiliary Requests were a fair attempt to overcome objections discussed during the oral proceedings, it was not contested that the objections had already been raised with the respondent's letter dated 16 November 2011.

The Board is thus satisfied that the subject of the proceedings did not change and that the Opposition Division indeed had the discretionary power to admit or not admit the Main and Auxiliary Requests filed during the oral proceedings.

As set out in G7/93 (OJ EPO 1994, 775), point 2.6 of the reasons, if a discretionary decision is appealed, it is not the function of a Board of Appeal to review all the facts and circumstances of the case as if it were in the place of the first instance department, in order to decide whether or not it would have exercised such discretion in the same way as the first instance department. A Board of Appeal should only overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion either that the first instance department in its decision has not exercised its discretion in accordance with the right principles or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper limits of its discretion.

In the present case, the Opposition Division based its decision on the following two findings:

Firstly, it had been surprising for the respondent that claims 5 and 6 as originally filed had been reintroduced into the claims. These claims had been removed from the claim set during grant proceedings in order to overcome a clarity objection, their subject-matter being however still present in paragraphs [0029] and [0030] of the patent specification.

Secondly, the amendment introduced subject-matter for which the respondents had no opportunity to perform a necessary additional search for pertinent prior art.

Although in principle it may be expected that a proprietor files amendments in order to overcome an added matter objection, the Board agrees with the Opposition Division that it is indeed at least surprising if not abusive to base newly filed requests - submitted at the last possible moment of the opposition procedure - on features extracted from the description, for which a clarity objection had already been raised and overcome by deletion of the respective dependent claims from the claim set during examination. Even if the introduction of the subject-matter of former dependent claims may be *prima facie* suited to overcome an added matter objection, the fact that these claims had been objected to for lack of clarity during examination proceedings likewise *prima facie* raises concerns as to their allowability. It appears that also the appellant was well aware of potential clarity issues ("only clarity objections", see point II.2 of the statement of grounds) and saw the need to address these issues in the request filed later on with the grounds of appeal. The filing of the non-admitted requests thus cannot be considered a "fair attempt to overcome the objections raised" and there are convincing reasons why the respondent could not have expected such an amendment.

It is also true that, for example the feature that the production arrangement is "designed to...apply a casting channel to the shaped molten wax" was neither mentioned in the claims as granted nor in one of the claim sets discussed during the opposition proceedings. The new requests thus raised new issues with respect to

the previously discussed requests and an additional search for pertinent prior art might have been necessary. Due to the late filing of the amendments only during oral proceedings, the respondent was deprived of the possibility to perform such an additional search.

With the added matter objection being known, the appellant could and should have submitted such claims in good time to allow the respondents to properly prepare their case.

The Board thus comes to the conclusion that the Opposition Division applied reasonable criteria, weighing the respective interests of the opponent and the proprietor, thus exercising its discretion in a reasonable way within the limits of that discretion. There is thus no reason to overrule the way the first instance exercised its discretion. Without an agreed text, the Opposition Division acted correctly in revoking the patent.

3. Admissibility of the request filed on 2 August 2012

The present request was filed on 2 August 2012 with the statement setting out the grounds of appeal. Its claims correspond to the claims of the Main Request filed (and not admitted) during the oral proceedings with further amendments "to conform the features to the apparatus category" (see item II.2 of the appellant's letter dated 10 May 2013). Given the fact that already the Examining Division had found it not clear which technical features of the system itself could be derived from the definition in dependent claims 5 and 6 as originally filed (see the office action dated 3 July 2008), "conforming the features to the apparatus

category" could (and should) have been performed during the opposition proceedings. In this context it is noted that the appellant was explicitly given the opportunity to file further requests during the oral proceedings (item 16 of the minutes).

Therefore, the admission of the present request is in the discretion of the Board, in accordance with Article 12(4) RPBA.

If the present request were to be admitted, the Board would be obliged either to rule for the first time on the substantive issues of the case in appeal proceedings or to remit the case to the Opposition Division.

The first alternative would deprive the opponent of the possibility to have the case examined in two instances and would be at odds with the purpose of *inter partes* appeal proceedings, namely to give the losing party a possibility to challenge the decision of the Opposition Division on its merits and to obtain a judicial ruling on whether the decision of the Opposition Division was correct (G 9/91 and G10/91 - OJ EPO 1993, 408, 420). It would further allow the appellant to bypass the Opposition Division, jeopardizing the proper splitting of functions between the departments of first instance and the Boards of Appeal.

The second alternative would delay the final decision, thus being at odds with the principle of procedural economy and depriving the respondents as well as the public of legal certainty about the validity of the patent in suit in due time.

Moreover, both alternatives would make the discretionary decision of the Opposition Division effectively meaningless, although the discretion was correctly applied. Additionally, they would put the respondent in a worse procedural position than if the requests had been accepted during oral proceedings by the Opposition Division, which would unduly favour the appellant and disadvantage the respondent although it was the appellant's late filing of the requests which caused the procedural situation.

In view of the above analysis, the Board exercises its power under Article 12(4) RPBA not to admit the request filed with the statement of grounds.

Hence, there is again no admitted request and therefore no text agreed by the proprietor of the patent in the sense of Article 113(2).

## **Order**

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

The appeal is dismissed.



The Registrar:

The Chairman:



V. Commare

T. Kriner

Decision electronically authenticated