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**Datasheet for the decision
of 16 December 2016**

Case Number: T 0143/14 - 3.4.02

Application Number: 04754478.8

Publication Number: 1631816

IPC: G01N11/00

Language of the proceedings: EN

Title of invention:
WIDE RANGE DYNAMIC RHEOMETER

Patent Proprietor:
Waters Technologies Corporation

Opponent:
Anton Paar GmbH

Headword:
Rheometer/Waters Technologies

Relevant legal provisions:
RPBA Art. 12(4), 13(1)

Keyword:
None of the appellant's requests admitted into the appeal proceedings

Decisions cited:

T 0296/87, T 0699/00, T 0794/02, T 0934/02, T 1276/05,
T 1587/07, T 0361/08, T 1188/09, T 1538/09, T 2453/09,
T 0028/10, T 0340/10, T 1525/10, T 0937/11, T 1873/11

Catchword:

See points 2.3 to 2.6



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Case Number: T 0143/14 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 16 December 2016

Appellant: Waters Technologies Corporation
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 7 November 2013
revoking European patent No. 1631816 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman R. Bekkering
Members: G. Zucka
T. Karamanli

Summary of Facts and Submissions

I. The appeal is against the decision of the opposition division, posted on 7 November 2013, to revoke European patent No. 1 631 816, on the basis that the subject-matter of claim 1 of the sole request, i.e. the request that the patent be maintained as granted, was not novel under Article 54(1) and (2) EPC in view of the following document:

D1 = EP 0 454 952 A1.

II. Notice of appeal filed by the patent proprietor was received on 16 January 2014, the appeal fee being paid on the same day. A statement of the grounds of appeal, to which amended claims according to a main request and two auxiliary requests were attached, was received on 14 March 2014.

III. On 18 July 2014, the respondent (opponent) filed a reply and submitted *inter alia* that the appellant's requests were inadmissible.

IV. The board issued a summons to oral proceedings. In an annex to the summons, it set out its preliminary and non-binding opinion on the appeal. In particular, it expressed its view that all of the appellant's requests were inadmissible under Article 12(4) RPBA.

V. On 16 November 2016, the appellant filed a letter together with amended claims according to a Main Request, an Auxiliary Request 1 and an Auxiliary Request 2, replacing all previously filed requests.

VI. With a letter dated 9 December 2016, the respondent informed the board that it would not attend the oral

proceedings. It made no submissions with respect to the requests filed by the appellant after the summons.

VII. The board held oral proceedings on 16 December 2016. As announced beforehand, the respondent was not represented at them.

VIII. The appellant (patent proprietor) requests that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims of the Main Request or, as an auxiliary measure, of one of Auxiliary Request 1 and Auxiliary Request 2, all requests as filed with letter dated 16 November 2016.

IX. The respondent (opponent) requests that the appeal be dismissed.

X. The Main Request comprises one independent claim, viz. claim 1, which reads as follows:

"A rheometer in which strain is effected in a test specimen while temperature is measured in the test specimen, comprising:

a test specimen temperature information sensor (160) for juxtaposition in close proximity with the test specimen (50) to provide information pertaining to the temperature of the test specimen (50);

a test specimen temperature information transmitter circuit (170; 190) for receiving test specimen temperature information from the test specimen temperature information sensor (160);

the test specimen temperature information sensor (160) and the test specimen temperature information transmitter circuit (190) being movable through

movements corresponding to the strain effected in the test specimen (50);

a test specimen temperature information receptor circuit (200) juxtaposed with the test specimen temperature information transmitter circuit (190) and being placed at a stationary location (132) relative to the test specimen temperature information transmitter circuit (190);

an isolator arrangement (186) isolating the stationary test specimen temperature information receptor circuit (200) mechanically and electrically from the movable test specimen temperature information transmitter circuit (190);

a test specimen temperature information transfer system (196, 202) for passing a test specimen temperature information signal from the movable test specimen temperature information transmitter circuit (190) across the isolator arrangement (186) to the stationary test specimen temperature information receptor circuit (200) without a direct mechanical or electrical connection between the movable test specimen temperature information transmitter circuit (190) and the stationary test specimen temperature information receptor circuit (200);

a source of power (210);

a power transmitter circuit (212) placed in a stationary location (132) relative to the test specimen temperature information transmitter circuit (190) and being connected to the source of power (210);

a power receptor circuit (220) juxtaposed with the power transmitter circuit (212) for receiving power from the power transmitter circuit (212), the power receptor circuit (220) being movable through movements corresponding to movements of

the test specimen temperature information transmitter (190) and being connected to the test specimen temperature information transmitter circuit (190) for supplying power to the test specimen temperature information transmitter circuit (190);

an isolator arrangement (186) isolating the stationary power transmitter circuit (212) mechanically and electrically from the movable power receptor circuit (220); and

a power transfer system (214, 216, 218, 222, 224, 226) for passing a power signal from the stationary power transmitter circuit (212) across the isolator arrangement (186) to the movable power receptor circuit (220) without a direct mechanical or electrical connection between the stationary power transmitter circuit (212) and the movable power receptor circuit (220),

characterised in that

the test specimen temperature information transfer system (196, 202) comprises an induction arrangement including a primary induction coil (196) in the test specimen temperature information transmitter circuit (190), and a secondary induction coil (202) in the test specimen temperature information receptor circuit (200) and juxtaposed with the primary induction coil (196) for receiving, by induction, test specimen temperature information from the primary induction coil (196), and

wherein the power transfer system (214, 216, 218, 222, 224, 226) comprises an induction arrangement including a primary induction coil (218) in the power transmitter circuit (212), and a secondary induction coil (222) in the power receptor circuit (220) and juxtaposed with the primary

induction coil (218) for receiving, by induction, power from the primary induction coil (218), wherein the test specimen temperature information signal is electrically isolated from the power signal."

- XI. Auxiliary Request 1 comprises one independent claim, viz. claim 1, which differs from claim 1 of the Main Request by having:
- XII. - the feature "wherein the test specimen is subjected to a torque about a given axis (C) in the rheometer to effect strain in the test specimen about the given axis (c) [*sic*]," inserted before the word "comprising" on the second line, and
- XIII. - the feature ", and wherein the respective primary (196, 218) and secondary induction coils (202, 222) are juxtaposed in a direction parallel to the given axis (C)" added at the end of the claim.
- XIV. Auxiliary Request 2 comprises one independent claim, viz. claim 1, which differs from claim 1 of the Main Request by having the feature "by transmitting each signal by means of a given frequency range, assigning a different range of frequencies to each signal and employing filters to isolate the signals" added at the end of the claim.
- XV. The appellant's arguments addressing the admissibility of its requests may be summarised as follows.

All requests filed in reply to the board's communication should be admitted into the appeal proceedings under Article 13(1) RPBA, even if the

provisions of Article 12(4) RPBA were taken into account.

It was acknowledged that the decision under appeal was taken only with respect to the patent as granted and that claim 1 of the main request, filed with the statement of grounds of appeal, corresponded to claim 1 of auxiliary request 1B, which was filed and subsequently withdrawn during the oral proceedings before the opposition division.

However, several board of appeal decisions held that it was allowable to file amended claims in appeal proceedings when the appellant lost before the opposition division and was therefore adversely affected by the decision under appeal pursuant to Article 107 EPC. According to decisions T 296/87, T 699/00, T 794/02, T 934/02, T 1276/05, T 1188/09 and T 937/11, it was also trite law that a request withdrawn during opposition proceedings might nonetheless be considered in any ensuing opposition appeal proceedings. Decisions T 2453/09 and T 1538/09 also confirmed that it was established case law that an appeal could be based on new amended claims insofar as the amendments were intended to address the grounds of the impugned decision.

In the present case, claim 1 of all requests filed with the statement of grounds of appeal was narrower - and not broader - than claim 1 of the patent as granted. Furthermore, the appellant had submitted detailed arguments as to why the amended claims possessed novelty and inventive step. Accordingly, it was clearly apparent that all requests were intended to address the grounds of the impugned decision.

The only difference between claim 1 of the main request filed with the grounds of appeal and claim 1 of auxiliary request 1B, which was withdrawn during the oral proceedings before the opposition division, was the replacement of the passage "in order to measure a test parameter" with "while temperature is measured". This difference was clearly intended to address the reasoning on the ground of lack of novelty in the impugned decision.

In addition, the present Main Request had been presented and had been admitted in the first-instance proceedings as "auxiliary request 1B". The present situation was therefore not covered by the wording of Article 12(4) RPBA ("... requests which could have been presented or were not admitted in the first instance proceedings ...").

A decision on patentability had not been avoided because novelty was addressed in the decision under appeal. All requests filed with the grounds of appeal were also no surprise for the respondent since similar requests had been filed and discussed in proceedings before the opposition division. In particular, novelty had been discussed. Since the opposition division had arrived at the conclusion that the subject-matter of the granted claims lacked novelty, there was no reason to discuss the issue of inventive step. Thus the present case differed from case T 937/11. The reason for the withdrawal of the requests was to save the opposition division the time for writing a decision on added subject-matter, and there was no point in retaining these requests as they all had the same problem.

The same arguments applied to Auxiliary Request 1 and Auxiliary Request 2.

XVI. The respondent's arguments addressing the admissibility of the appellant's requests may be summarised as follows.

All requests filed with the statement of grounds of appeal were inadmissible since none of them had been filed during the opposition proceedings.

In particular, the request maintained in the opposition proceedings did not include the feature that the "test specimen temperature information is electrically isolated from the power signal". Thus, the board's decision on the main request filed with the grounds of appeal would not be a review of a given decision (which was the function of appeal proceedings) but would involve a complete new examination, since the feature at issue was not taken from a dependent claim but from the description.

The first auxiliary request, filed with the grounds of appeal, was not admissible for the same reasons as the main request. In addition, a similar request had been withdrawn during the oral proceedings before the opposition division. Consequently, the opposition division had not decided on the request in question and therefore reintroducing the withdrawn request was inadmissible.

The second auxiliary request, filed with the grounds of appeal, was not admissible for the same reasons as the main request. In addition, the second auxiliary request was not converging with respect to the first auxiliary request.

No submissions were made with regard to the admissibility of the present requests filed by the appellant after the summons to oral proceedings.

XVII. At the end of the oral proceedings, the chairman announced the board's decision.

Reasons for the Decision

1. *Admissibility of the appeal*

The appeal is admissible.

2. *Admission of the Main Request; Article 13(1) RPBA*

2.1 According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion. The discretion is to be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

2.2 The appellant's present Main Request was filed **after** the filing of the statement of grounds of appeal. Thus it is an amendment to the appellant's case within the meaning of Article 13(1) RPBA, and accordingly admission of this request into the appeal proceedings is at the board's discretion.

2.3 When exercising its discretion under Article 13(1) RPBA, the board cannot ignore what happened during the opposition proceedings and, in particular, during the oral proceedings before the opposition division.

2.4 According to the minutes of the oral proceedings before the opposition division, after a short discussion on the main request which was then on file, namely on the claims as granted, and then a break in the oral proceedings, it was announced that the subject-matter of granted claim 1 lacked novelty (cf. page 1, last

paragraph). The discussion continued on the basis of the amended claims according to auxiliary request 1 as filed before the oral proceedings, and after an interruption of the oral proceedings it was announced that claim 1 of this request did not fulfil the requirements of Article 123(2) EPC (cf. page 3, fifth paragraph). The patent proprietor then filed auxiliary requests 1A, 2A and 3A "to replace auxiliary request 1, 2, 3 on file" (cf. page 3, fifth paragraph from the bottom). The discussion continued on the basis of the amended claims according to auxiliary request 1A, and after an interruption of the oral proceedings it was announced that claim 1 of this request likewise did not fulfil the requirements of Article 123(2) EPC (cf. page 5, fourth paragraph from the bottom). Thereafter, the patent proprietor filed a new auxiliary request 1B and withdrew auxiliary request 1A (cf. page 6, first paragraph). The discussion continued on the basis of the amended claims according to auxiliary request 1B. After an interruption of the oral proceedings it was announced that auxiliary request 1B also did not fulfil the requirements of Article 123(2) EPC, because still only one signal next to the power signal was present and the figure 9 embodiment could not serve as a basis for the generalisation as claimed in claim 1 of this request (cf. page 6, fourth paragraph from the bottom). The chairman then asked the patent proprietor whether the remaining auxiliary requests 2A or 3A comprised feature combinations which would overcome this objection (cf. page 6, third paragraph from the bottom). The patent proprietor responded that this was not the case and withdrew all auxiliary requests then on file and maintained only its main request (patent as granted) (cf. page 6, second paragraph from the bottom).

- 2.5 The appellant validly withdrew all auxiliary requests during the oral proceedings before the opposition division, and therefore these requests no longer existed. Consequently, the opposition division acted correctly in giving no formal decision on these requests at the end of the oral proceedings and no reasons in writing.
- 2.6 Since the present Main Request was submitted after the grounds of appeal were filed, Article 12(4) RPBA is not applicable. However, in view of the above-mentioned particular circumstances of the first-instance proceedings, the board considers it appropriate, when exercising its discretion under Article 13(1) RPBA, to take the provisions of Article 12(4) RPBA into account as well. In the board's view, the criteria which it applies when exercising its discretionary power under Article 12(4) RPBA can also be applied when it exercises its discretion under Article 13(1) RPBA. The fact that the appellant had chosen to file the present Main Request after it filed its grounds of appeal should not put the appellant in a better position than if it had filed this request with its grounds of appeal. Otherwise it would easily be possible for the appellant to circumvent the provisions of Article 12(4) RPBA.
- 2.7 According to Article 12(4) RPBA, the board has the discretionary power to hold inadmissible requests which could have been presented or were not admitted in the first-instance proceedings.

It is established jurisprudence of the boards of appeal that the board may consider that requests withdrawn during the first-instance proceedings and re-filed with the grounds of appeal are inadmissible under Article

12(4) RPBA, as the purpose of an appeal is to review what was decided by the department of first instance (see e.g. T 1587/07, T 361/08, T 340/10 and T 1525/10; see also T 1873/11). The board considers that this may also apply to requests which essentially correspond to requests that were filed and subsequently withdrawn during the first-instance proceedings.

2.8 In the present case, the appellant validly withdrew all its auxiliary requests in the oral proceedings before the opposition division. If, with its statement of grounds of appeal, the appellant had filed any of these requests or any request (re-)introducing some purely minor amendment to them, the board would have exercised its discretion under Article 12(4) RPBA and most likely not admitted any such request into the appeal proceedings. This may be inferred from the board's communication pursuant to Article 15(1) RPBA. In this communication, the board indicated that, in its preliminary opinion, the main request and the first and second auxiliary requests filed with the grounds of appeal should not be admitted into the appeal proceedings under Article 12(4) RPBA. The reason for that was basically that, if the board decided to admit these requests, it would be compelled either to give a first ruling on whether the request at issue infringed Article 123(2) EPC, although this had already been objected to by the opposition division, or to remit the case to the department of first instance. This would also have applied to the auxiliary requests filed and subsequently withdrawn in the oral proceedings before the opposition division.

2.9 In fact, the set of claims of the present Main Request is not based on the sole request underlying the decision under appeal (patent as granted). Instead, as

confirmed by the appellant, it is based on the set of claims of auxiliary request 1B filed and subsequently withdrawn during the oral proceedings before the opposition division.

Accordingly, the appellant's argument that the present Main Request *had* been presented and *had* been admitted in the first-instance proceedings as "auxiliary request 1B" is not valid.

- 2.10 Claim 1 of the present Main Request (and of the main request filed with the grounds of appeal) differs from claim 1 of auxiliary request 1B in that the beginning of the claim's wording contains the expression "while temperature is measured in the test specimen" instead of "in order to measure a test parameter in the test specimen". This statement regarding the intended use of the rheometer does not however introduce any technical limitation beyond what already follows from the remaining features of the claim, which define the rheometer itself in technical terms. Compared to claim 1 of the main request filed with the grounds of appeal, the remaining expression "test parameter information" has been replaced by "test specimen temperature information" in claim 1 of the present Main Request for reasons of consistency.

Hence, the set of claims of the present Main Request contains minor amendments compared to the claims of auxiliary request 1B and thus corresponds essentially to that of auxiliary request 1B. Therefore, the present set of claims qualifies as a request which could have been presented in the first-instance proceedings.

- 2.11 Auxiliary request 1B however was not maintained, but was withdrawn during those oral proceedings. The

opposition division was thereby prevented from giving a reasoned decision on this request, in particular on its objection under Article 123(2) EPC (cf. minutes of said oral proceedings, page 6, fourth paragraph from the bottom). By filing a set of claims which is essentially based on the set of claims of auxiliary request 1B, the appellant has presented the board with subject-matter on which no formal decision was taken by the department of first instance. This means that if the board decided to admit the Main Request, it would be compelled either to give a first ruling on the issue of added subject-matter, a task incompatible with its primary role, namely the examination of the contested decision, or to remit the case to the department of first instance, which would considerably delay the proceedings and make them more costly for the respondent.

In addition, by not filing the present Main Request, a possible ruling by the opposition division on novelty and inventive step on claims with quite different features than the granted claim 1 had also been avoided.

- 2.12 The appellant submitted that a request withdrawn during opposition proceedings might nonetheless be considered in any ensuing opposition appeal proceedings, citing decisions T 296/87, T 699/00, T 794/02, T 934/02, T 1276/05 and T 1188/09 in support of its position.

The board observes that, according to the cited decisions, it is indeed in principle possible that a request withdrawn during opposition proceedings may be considered in ensuing opposition appeal proceedings. The boards have ruled that a proprietor who has defended his patent to only a limited extent in opposition proceedings is not prohibited *a priori* (i.e.

except in specific cases where the *reformatio in peius* prohibition applies or there has been abuse of procedure) from returning to a **broader** version of his patent, including the granted version, in subsequent appeal proceedings, and that intervening limitations of the patent do not imply any express abandonment of parts of it but are to be regarded merely as attempts to word the patent so as to delimit it against objections. However, this jurisprudence also has to be interpreted in the light of the provisions of Articles 12(4) and 13 RPBA (see for example decision T 28/10 and further decisions cited in Case Law of the Boards of Appeal, 8th edition July 2016, IV.E.4.5).

Moreover, the circumstances of the present case are different from the situation underlying the decisions cited by the appellant. Those decisions concerned cases where the patent proprietor had returned to a request with *broader* claims. In the present case, however, the aim was to *narrow* the claimed subject-matter in an attempt to render said subject-matter new and inventive, which, as explained above, the present board considers could and should already have happened during the first-instance proceedings.

In addition, the board notes that, in most of the above-cited cases as well as in the further cited decisions T 2453/09 and T 1538/09, the question of whether returning to a broader or amended version of the patent was admissible was dealt with in the context of the admissibility of the appeal in question. However, the admissibility of the present appeal has not been questioned.

2.13 During the oral proceedings before the board, the appellant additionally cited decision T 937/11. He

argued that the situation in that case was similar to the present case, in that an "auxiliary request 1" had been withdrawn in proceedings before the opposition division and had been re-submitted as the main request during the appeal proceedings. The board in that case had decided to admit the request.

- 2.14 The present board however points out that, crucially and in contrast to the events in the present case, no ruling on a key element of the request had been avoided by withdrawing the request during the first-instance proceedings in case T 937/11, as is explicitly stated in the Reasons for that decision, point 2.1, first paragraph, last sentence: "Because the opposition division's reasons for rejecting the main request evidently applied likewise to the claims of auxiliary request 1 of 11 November 2010, the appellant did not avoid a decision on the ground for opposition pursuant to Article 100(c) EPC when it withdrew auxiliary request 1".

Accordingly, this decision is not relevant to the present case.

- 2.15 In view of the above, the board, exercising its discretion under Article 13(1) RPBA, decided not to admit the Main Request into the appeal proceedings.

3. *Admission of Auxiliary Request 1 and Auxiliary Request 2; Article 13(1) RPBA*

- 3.1 The board notes that claim 1 of present Auxiliary Request 1 and Auxiliary Request 2 is a re-working, introducing additional features, of claim 1 of auxiliary request 1B filed during the oral proceedings before the opposition division. Both current auxiliary

requests could therefore have been filed during those proceedings, as replacement or additional auxiliary requests, in the aftermath of the discussion on "auxiliary request 1B" that had taken place at said proceedings. Instead, the appellant chose to withdraw "auxiliary request 1B" during the first-instance proceedings. In so doing, he prevented the opposition division from rendering a decision on the issue of Article 123(2) EPC.

- 3.2 The board, exercising its discretion under Article 13(1) RPBA, therefore decided not to admit Auxiliary Request 1 and Auxiliary Request 2 into the appeal proceedings.
4. Since none of the appellant's requests were admitted into the appeal proceedings, there is no basis on which a patent could be maintained in amended form as requested by the appellant. Hence the decision cannot be set aside, and the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Kiehl

R. Bekkering

Decision electronically authenticated