

**Internal distribution code:**

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

**Datasheet for the decision  
of 12 September 2019**

**Case Number:** T 2344/15 - 3.2.06

**Application Number:** 03813805.3

**Publication Number:** 1597420

**IPC:** D05C15/18, D05C15/34

**Language of the proceedings:** EN

**Title of invention:**

YARN FEED SYSTEM FOR TUFTING MACHINES

**Patent Proprietor:**

Card Monroe Corporation

**Opponent:**

COBBLE BLACKBURN LIMITED

**Headword:**

**Relevant legal provisions:**

EPC Art. 54(2), 114(2), 69, 140  
EPC R. 116(1), 79(1), 115(1), 124(4)  
EPC 1973 R. 71a  
RPBA Art. 12(4), 13, 12(1), 12(2)

**Keyword:**

Novelty - main request (no)

Late-filed requests - auxiliary requests could have been filed  
in first instance proceedings (yes)

Admission of auxiliary requests filed with statement of  
grounds of appeal (no)

**Decisions cited:**

T 0677/12, T 0360/12, G 0008/91, G 0001/99, T 0034/90,  
G 0009/91, G 0010/91, T 1705/07, T 0356/08, T 1067/08,  
T 1685/07, T 0936/09

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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

Case Number: T 2344/15 - 3.2.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.06**  
**of 12 September 2019**

**Appellant:** Card Monroe Corporation  
(Patent Proprietor) 4936 Adams Road  
Chattanooga, TN 37343 (US)

**Representative:** Hofstetter, Schurack & Partner  
Patent- und Rechtsanwaltskanzlei  
PartG mbB  
Balanstrasse 57  
81541 München (DE)

**Respondent:** COBBLE BLACKBURN LIMITED  
(Opponent) Gate Street  
Blackburn BB1 3AH (GB)

**Representative:** Boulton Wade Tennant LLP  
5th Floor, Salisbury Square House  
8, Salisbury Square  
London EC4Y 8AP (GB)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 3 November 2015  
revoking European patent No. 1597420 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** M. Harrison  
**Members:** P. Cipriano  
W. Ungler

## Summary of Facts and Submissions

- I. The appellant (patent proprietor) filed an appeal against the decision of the opposition division revoking European Patent No. 1 597 420.
- II. The appellant requested that the decision be set aside and the patent be maintained as granted (notwithstanding a correction under Article 140 EPC) or according to one of auxiliary requests 1 to 5.
- III. The respondent (opponent) requested that the appeal be dismissed and that the auxiliary requests filed with the grounds of appeal be found inadmissible.
- IV. The following documents, referred to by the respondent in its notice of opposition and also in its response to the grounds of appeal, are relevant to the present decision:  
D1 US 5 983 815  
D4 US 4 688 497
- V. In its notice of opposition, the opponent had argued that the subject-matter of claim 1 lacked novelty over *inter alia* D1.
- VI. By communication dated 17 April 2013 pursuant to Rule 79(1) EPC during the opposition proceedings, the EPO invited the patent proprietor to file its observations within a period of four months from notification of the communication.
- VII. With letter dated 14 August 2013, the proprietor requested rejection of the opposition and provided arguments in support. As an auxiliary measure, oral proceedings were requested.

- VIII. With letter dated 17 October 2013, the opponent replied to the arguments presented by the proprietor.
- IX. The opposition division issued a summons dated 27 January 2015 to attend oral proceedings pursuant to Rule 115(1) EPC, in which it stated that novelty would be discussed on the basis of *inter alia* D1 and D4. It further noted that any request from the proprietor for maintenance in amended form should be submitted one month before the date of oral proceedings in accordance with Rule 71(a) EPC.
- X. Oral proceedings before the opposition division were held on 21 October 2015, at the end of which the opposition division found that the subject-matter of claim 1 was not new in view of D1. As a result, the patent was revoked.
- XI. The minutes of the oral proceedings in accordance with Rule 124(4) EPC included the following at the end of page 2:  
"The oral proceedings were adjourned from 10:41 to 10:50 to deliberate about the novelty of claims 1 and 6.

After resumption of the proceedings the Chairman announced that the opposition division was of the opinion that the subject-matter of claims 1 and 6 was not new in view of document D1.

The Patentee expressed the wish to submit amendments.

The Chairman asked the Patentee if he has prepared an auxiliary request.

The Patentee answered that he does not have any prepared auxiliary request.

The Chairman pointed out that the preparation of an auxiliary request during the oral proceedings would be regarded by the opposition division as late filed.

The Chairman announced the decision to revoke the patent and closed the oral proceeding at 10:54 hours."

- XII. In the appeal proceedings, the Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the reference in D1 to D4 was considered to be a disclosure in D1 of all the features of claim 1. Additionally, the Board mentioned that there was a question of whether it should exercise its discretion under Article 12(4) RPBA to hold the auxiliary requests inadmissible, in particular regarding the matter of whether the requests should have been filed earlier.
- XIII. With letter dated 28 August 2019, the appellant filed new auxiliary requests 1 to 11 replacing the previous auxiliary requests 1 to 5.
- XIV. Oral proceedings were held before the Board on 12 September 2019, during which the appellant filed a feature analysis of claim 1 of the main request (see annex).

The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted (main request), auxiliarily that the patent be maintained in amended form on the basis

of one of auxiliary requests 1 to 11 filed with letter dated 28 August 2019.

The respondent (opponent) requested that the appeal be dismissed.

XV. Claim 1 as granted (main request) and of auxiliary request 1 reads as follows, with features denoted M1.1 to M1.9 by the Board and as per the feature denotation used by the parties during the oral proceedings (see the minutes of oral proceedings before the Board):

"M1.1 A method of assembling a tufting machine (11, 301) having a frame (16, 303) and at least one reciprocable needle bar (17) having a series of spaced needles (13) mounted therealong and carrying a series of yarns (12, 306) for forming tufts of yarn in a backing material (14) passing beneath the needles (13), characterized by:

M1.2 mounting at least one yarn feed unit (50, 302) on the frame (16, 303) of the tufting machine (11, 301),

M1.3 the yarn feed unit (50, 302) having a predetermined number of yarn feed devices (70, 304) mounted therein for feeding a series of yarns (12, 306) to the needles (13),

M1.4 yarn feed controllers (140) controlling the yarn feed devices (70, 304) and

M1.5 a yarn feed distribution device (307) associated with the yarn feed devices (70, 304) of the at least one yarn feed unit (50, 302);

M1.6 connecting the yarn feed controllers (140) to a system controller (165) for controlling the feeding of the yarns (12, 306) to the needles (13) by each of the yarn feed devices (70, 304); and

M1.7 feeding multiple yarns (12, 306) from each of the yarn feed devices (70, 304) to selected ones of the needles (13) of the tufting machine (11, 301)

M1.8 with the yarns (12, 306) fed through separate yarn feed tubes (105, 312) of a tube bank (308) of the yarn feed distribution device (307) and

M1.9 with the yarn feed tubes (105, 312) of the tube bank (308) of the yarn feed distribution device (307) arranged into two or more tube bank sections or repeats (309, 311)."

Claim 1 of auxiliary requests 2 and 3 differs from claim 1 of the main request in that the following features have been added:

"selecting one or more standardized, self-contained yarn feed units (50, 302) each having a predetermined number of yarn feed devices (70, 304) for mounting on the tufting machine (11, 301), and each further comprising a housing (56) having a pair of opposed sidewalls (54) and a series of mounting plates (72) for mounting said yarn feed devices (70, 304) within said housing (56);"

Claim 1 of auxiliary requests 4 and 5 differs from claim 1 of the main request in that the following features have been added:

"wherein each of said yarn feed devices (70, 304) includes a drive motor (71), a drive roll (82), and an idler roll (84) between which multiple yarns (12, 306) are engaged and drawn for feeding to a needle (13), and wherein the yarn feed unit (50, 302) is provided with a predetermined number or series of yarn feed devices (70, 304) that corresponds to some multiple of the needles (13) of the tufting machine (11, 301),"



Claim 1 of auxiliary requests 6 and 7 differs from claim 1 of the main request in that the following features have been added:

"selecting two or more standardized, self-contained yarn feed units (50, 302) each having a predetermined number of yarn feed devices (70, 304) for mounting on the tufting machine (11, 301);",

and the feature regarding the mounting of the yarn feed unit reads:

"mounting said yarn feed units (50, 302) on the frame (16, 303) across the tufting machine (11, 301), each yarn feed unit (50, 302) having said predetermined number of yarn feed devices (70, 304) mounted therein for feeding a series of yarns (12, 306) to the needles (13), yarn feed controllers (140) controlling the yarn feed devices (70, 304) and a yarn feed distribution device (307) associated with the yarn feed devices (70, 304) of the at least one yarn feed unit (50, 302);"

Claim 1 of auxiliary requests 8 and 9 differs from claim 1 of the auxiliary requests 6 and 7 in that the following features have been added:

"wherein the yarns (12, 306) from the yarn feed devices (304) of each of the yarn feed units (50, 302) are fed to the tubes (105, 312) of a tube bank (308) associated with that particular yarn feed unit (50,302)."

Claim 1 of auxiliary requests 10 and 11 differs from claim 1 of the auxiliary requests 2 and 3 in that the feature regarding the mounting of the yarn feed unit reads:

"mounting said yarn feed units (50, 302) on the frame (16, 303) of the tufting machine (11, 301), each yarn feed unit (50, 302) having said predetermined number of yarn feed devices (70, 304) mounted therein for feeding

a series of yarns (12, 306) to the needles (13), yarn feed controllers (140) controlling the yarn feed devices (70, 304) and a yarn feed distribution device (307) associated with the yarn feed devices (70, 304) of the at least one yarn feed unit (50, 302);"

XVI. The arguments of the appellant may be summarised as follows:

*Main request - novelty*

D1 did not disclose all the features of claim 1.

Article 69 EPC should be used to interpret the features in the claim based on the description and Figures.

D1 disclosed only the features M1.1 and M1.7 (see the feature denotation above).

D1 did not disclose feature M1.2, since the assembly 118 in Figure 1b of D1 could not be considered a unit. It was too big to be assembled as a single piece.

D1 also disclosed a single motor 10 (see Fig. 1A), which corresponded to a single yarn feed device and was not mounted in the unit. Thus D1 did not disclose multiple yarn feed devices mounted "therein" as defined in feature M1.3 of claim 1. Also, each yarn feed device had to have its own motor in order to feed yarn as required.

The clutches in D1 did not correspond to yarn feed controllers as defined in feature M1.4 of claim 1, since they did not control anything; they were simply on/off coupling elements. In D1 the clutches were

activated by a single controller and not by more than one as defined in claim 1.

D1 did not disclose a yarn feed distribution device as defined in feature M1.5 of claim 1, since the tube bank 130 was not part of the yarn feed unit, even if assembly 118 of D1 were considered a yarn feed unit.

D1 disclosed a single yarn feed controller for controlling the clutches; it did not disclose connecting multiple yarn feed controllers to a system controller as defined in feature M1.6 of claim 1.

*Auxiliary requests 1-11*

The requests should not be held inadmissible.

The notice of opposition did not contain a complete discussion on novelty over D1. The burden was shifted to the appellant to make the case for the respondent. The respondent also failed to provide an analysis of all features of the whole claim in its following reply letter.

The opposition division did not issue a preliminary opinion on novelty. Thus, the decision to revoke the patent based on lack of novelty represented a new situation, to which the appellant was not allowed to react and which violated its right to be heard.

Further, since the preliminary opinion of the opposition division was not negative, it was reasonable to assume that the opposition division would follow the arguments of the appellant and maintain the patent unamended. Thus, filing auxiliary requests at that stage was contrary to the appellant's arguments and the

efficient resolution of the opposition. The mention of a final date for filing amendments in the opposition division's communication was simply a standard clause, which itself provided no reason to file amendments.

There was no opportunity to present an auxiliary request after the conclusion on novelty given by the opposition division was announced. Although not stated in the minutes, the chairman of the opposition division had actually declared that it was too late to file a further auxiliary request and had immediately announced the decision, thereby preventing a further auxiliary request from being filed.

In addition, there were two possible fallback positions that could have been pursued during during the oral proceedings, but the choice needed to be discussed with the client.

T 677/12 supported the idea that auxiliary requests filed for the first time with the grounds of appeal could form the basis of the appeal proceedings. As could be seen in T 360/12, the simple deletion of claims did not raise further issues and should also be allowed.

Further, claim 1 of each of the auxiliary requests was a limitation of the granted claims which took into consideration the reasons for revocation of the patent given by the opposition division and thus addressed the decision of the opposition division.

XVII. The arguments of the respondent may be summarised as follows:

*Main request - novelty*

D1 disclosed all the features of claim 1.

The embodiment of Figure 1b of D1 disclosed a tufting machine 104 comprising a yarn feed drive assembly 118 that corresponded to the yarn feed unit defined in claim 1, since it was mounted on the frame 119 (feature M1.2) and also had a predetermined number of rollers 122A and 122B mounted in the assembly 118 therein and feeding the yarns to the needles (feature M1.3) as defined in claim 1. This assembly thus had the same features as the claimed unit and thus any difference perceived by the appellant was nothing more than a choice of nomenclature and thus did not exist.

The tufting machine of D1 necessarily required yarn feed controllers, which were therefore implicit; their presence was also implied by the possibility of selectively feeding the yarns, as disclosed e.g. at the end of claim 1 of D1. D1, column 7, lines 14-16 further disclosed that the pattern yarn feed drive 118 of the embodiment of Figure 1B was the one disclosed in D4. D4 disclosed that the rolls 108 and 109 (which corresponded to rollers 122A and 122B in D1 and which corresponded to the yarn feed devices defined in claim 1) were activated by clutches 102 and 103, each one of these clutches having an individual circuit control as disclosed in column 5, lines 52 to 55. Thus, the clutches of D4 referred to in D1 corresponded to the claimed yarn feed controllers, since they controlled the rollers which corresponded to the claimed yarn feed devices as defined in feature M1.4.

The patent in suit disclosed in paragraph [0060] that the yarn feed distribution device could include the yarn feed distribution device of D1. Thus, the tube

bank 130 of D1 was a yarn feed distribution device as defined in feature M1.5 of claim 1.

The wording of claim 1 did not require a system controller to be part of the unit. D4 generally disclosed in column 5, line 54, an electrical control which was necessary to coordinate the individual circuits of the clutches. This electrical control corresponded to the system controller of feature M1.6.

Article 69 EPC was irrelevant and unnecessary for interpreting the claim, as the features of claim 1 were clear and simply did not contain the limitations which the appellant alleged.

*Admittance of auxiliary requests 1-11*

The auxiliary requests should be excluded from the appeal proceedings, since they could have been filed earlier before the opposition division.

The appellant should have filed auxiliary requests at the opposition stage, since the respondent objected to lack of novelty with its notice of opposition. The appellant was well aware of all the facts and underlying arguments regarding lack of novelty over D1 and could already have filed auxiliary requests in response to the notice of opposition, but could also have done so in response to the letter of the respondent dated 17 October 2013 or even when prompted by the time limit under Rule 116 EPC as expressly pointed out in point 7 of the preliminary opinion of the opposition division.

The appellant also chose not to file any auxiliary requests at the beginning of the oral proceedings

before the opposition division. It was only after the chairman announced that the subject-matter of claim 1 was not new that the appellant expressed its wish to make amendments.

The opposition division did give the appellant the opportunity to file an auxiliary request after stating that the subject-matter of claim 1 was not new. The respondent had no recollection that the chairman had said that it was too late to file amendments, merely that they would be regarded as late-filed. The appellant had also made no statement about it having to decide between two directions of possible auxiliary requests. Further, the appellant had not attempted to correct the minutes or argue, in its complete appeal case as filed, that there had been a violation of the right to be heard. Thus, the written record shows that, at the time of filing the appeal grounds, the appellant had no perception that there had been a violation of the right to be heard.

### **Reasons for the Decision**

1. Main request - novelty
  - 1.1 It was not contested between the parties that features M1.1 and M1.7 were disclosed in D1. The Board also finds no reason to disagree.
  - 1.2 The embodiment of Figure 1B in D1 (see also e.g. column 7, lines 3 to 13) discloses a tufting machine 105 that has necessarily been assembled and which has a frame 105, 119 and a reciprocable needle bar 113 having a

series of spaced needles 115 mounted therealong a carrying a series of yarns 124 as defined in feature M1.1 of claim 1.

- 1.3 The pattern yarn feed drive assembly 118 of D1 corresponds to the yarn feed unit defined in claim 1 and is mounted on frame 119 of the tufting machine 105 (see e.g. column 7, lines 14 to 20). Thus feature M1.2 is disclosed in D1.

The appellant argued that the assembly was not a unit, since it was too big and thus could not be assembled to the tufting machine as a pre-assembled single piece already comprising the yarn feed devices. The Board is however not convinced by this argument. Neither D1 nor the patent disclose any dimensions of the tufting machine or of the yarn feed drive/unit, both of which are variable and dependent on the industrial scale of the tufting machine, i.e. the maximum size of the carpets to be tufted and the number of different yarn feed rollers required.

In addition, the claim does not define that the unit needs to be pre-assembled and mounted as a single piece. A unit may refer simply to the machine parts that perform a particular function - in the present context, feeding the yarns to the needle bar - and not to the particular way or order in which its parts were assembled or mounted on the finished tufting machine. Even the patent does not require or define a unit as being necessarily pre-assembled, let alone mounted as a single piece. For example, paragraphs 7 or 21 of the patent disclose only as a possibility that such a unit be standardized, self-contained or provided as an attachment capable of being releasably mounted to and



removable from the tufting machine frame as a one-piece unit.

- 1.4 As regards feature M1.3, D1 (see e.g. column 7, lines 19 to 22) discloses that the pattern yarn feed assembly 118 comprises a predetermined number of yarn feed drive rollers 122A and 122B. These rollers correspond to yarn feed devices as defined in the claim, which additionally defines that these feed devices are explicitly for feeding a series of yarns to the needles. In D1 this feeding is performed by the yarn feed drive rollers 122A and 122B.

Contrary to the argument of the appellant, the wording of the claim does not require that each yarn feed device comprises its own drive motor. Nor is this implicit from the word "feed device" since a feed device in this context is merely a device which can feed the yarn which is precisely what the rollers do when rotated by whatever means. Thus, even if in D1 the feed drive rollers 122A and 122B were driven by a single motor in a similar way to that shown in the embodiment of Figure 1A, the feed drive rollers 122A and 122B in of D1 would anyway still be yarn feed drive devices as defined in the claim.

- 1.5 D1 discloses in column 7, lines 14-16, that the pattern yarn feed drive assembly (corresponding to the yarn feed unit) of the embodiment of Figure 1B is of a type disclosed in D4. This reference in D1 to D4 forms a single disclosure in D1 comprising the yarn feed mechanism of D4. It is also explicit and unambiguous as to which part of D4 is incorporated in D1. The rollers 108 and 109 in D4 (corresponding to the yarn feed drive rollers 122A and 122B in D1 and to the yarn feed devices of the claim) are activated through clutches

102 and 103 as explained in column 5, lines 18-35 of D4. Each of these clutches has an individual circuit that allows "individual control" of each roller as disclosed in D4, column 5, lines 55-57. These clutches, each with their individual circuit, do therefore control the rotation of the rollers 108 and 109 and thus correspond to the yarn feed controllers that control the yarn feed devices defined in feature M1.4 of claim 1.

The argument of the appellant that the clutches cannot be considered controllers, since they are merely mechanical on/off coupling elements activated by a controller, is not persuasive. Each clutch and its individual circuit in D4 connects or disconnects each roller to a shaft driven by a motor, allowing the roller to switch between a high speed shaft and a low speed shaft, i.e. it controls how the roller rotates.

Contrary to the further argument of the appellant, the wording of the claim does not require that the yarn feed devices be individually controlled. It defines simply controllers controlling the feed devices, which can equally mean that more than one controller may control more than one device. The clutches and their individual circuits in D4 control several rollers and therefore correspond to yarn feed controllers according to feature M1.4 of claim 1.

- 1.6 The tube bank 130 of D1 corresponds to the yarn feed distribution device defined in feature M1.5. As disclosed in paragraph [0060], the patent itself explicitly foresees that the yarn feed distribution device of the invention be a tube bank as disclosed in D1. The appellant did not dispute this disclosure in D1.

Contrary to the argument of the appellant on this matter, feature M1.5 of claim 1 does not define that the yarn feed distribution device be necessarily part of the yarn feed unit since in accordance with the claim it need only be "associated with" the yarn feed devices of said unit. This association requires only the correct disposition of both yarn feed unit and yarn feed distribution device such that the yarn may be distributed correctly. The first sentence of paragraph [0060] in the patent itself also defines that the yarn feed distribution device is mounted along the frame of the tufting machine and along lower portion of the yarn feed unit, i.e. the yarn feed distribution device of the patent also does not form an entity with either the frame or the unit and is mounted along both.

As explained above, the patent itself foresees in paragraph [0060] that the yarn feed distribution device of the invention is a tube bank as disclosed in D1. The features M1.7, M1.8 and M1.9 of the claim defining the way the yarn is distributed to the needles are therefore (contrary to the argument of the appellant) also necessarily disclosed in D1.

The tube bank 130 of the embodiment of Figure 1B in D1 feeds the yarns 124 from the rollers 122A and 122B (corresponding to the claimed yarn feed devices) to the needles 115 as defined in feature M1.7. As disclosed in D1, column 7, lines 39 to 49, and corresponding Figure 2A, the yarns 124 are fed through yarn tubes 131 of the tube bank 130 as defined in feature M1.8. Figure 2A and column 7, lines 7 to 13, also disclose that these yarn tubes 131 are arranged into two or more repeats as defined in feature M1.9.

1.7 D1 further discloses at least implicitly some kind of system controller for controlling the feeding of the yarns to the needles by each of the yarn feed devices, i.e. a system that controls the rotation of the rolls 122A and 122B, otherwise the tufting machine would not be able to selectively feed the yarn to the respective needle in order to form a graphic pattern as D1 requires (see e.g. last 3 lines of claim 1 of D1). In addition, D4, column 5, lines 52 to 57, discloses the use of an unspecified electrical control to control the yarn feed mechanisms. The individual electric circuits of the clutches defined in D4 are necessarily connected together through a general controller in a way that they can be coordinated to make the tufting machine actually function. Feature M1.6 is thus also disclosed in D1 through the reference to D4.

The appellant argued that in D1 there was a single yarn feed controller to control all the clutches and that a further system controller to control this single yarn feed controller was not disclosed in D1. Since the Board has a different interpretation and finds that each clutch and its individual circuit in D1 correspond to a yarn feed controller (see point 1.5 above), this argument does not alter the Board's conclusion.

1.8 The Board does not accept that Article 69 EPC should be used to interpret the features in the claim based on the description and Figures for the purposes of considering novelty of the subject-matter of the present claim.

A claim should be interpreted in a technically sensible manner and be given the broadest, technically logical interpretation (see also Case Law of the Boards of Appeal, II.A.6, Interpretation of claims). In the

present case, the Board finds that the terms of the claim have a clear technical meaning for the skilled person, thus there would anyway be no need to use the description or drawings to interpret any of them.

Furthermore, Article 69 EPC is concerned with the extent of protection conferred by a European patent, with which the Board is not concerned when analysing novelty of the claimed subject-matter. In relation to Article 54 EPC it is evidently not the aim of Article 69 EPC to provide, in the event of a discrepancy between the claim wording and the description and/or the figures, a legal basis for a re-interpretation of the clear technical meaning of a claim. In case of such a discrepancy between the claims and the description and/or the figures, the claim wording must be interpreted as it would be understood by a person skilled in the art, i.e. the description and/or figures cannot be used to interpret the claim wording in a different way.

- 1.9 Since the embodiment of Figure 1B in D1, including the reference to D4, discloses all the features of claim 1, the subject-matter of claim 1 is not novel under Article 54(2) EPC. The main request is therefore not allowable.
2. Admittance of auxiliary requests 1-11
  - 2.1 The respondent requested the Board to exercise its discretion to exclude all the auxiliary requests 1 to 11 from the proceedings on the ground that these could and should have been filed earlier.
  - 2.2 According to the principles developed by the Enlarged Board of Appeal and along the lines of T 936/09, the

appeal procedure is to be considered as a judicial procedure (G 1/99, OJ EPO 2001, 381, Reasons point 6.6, G 8/91, OJ EPO 1993, 346, Reasons point 7). Appeal proceedings are wholly separate and independent from the preceding, purely administrative, first-instance proceedings and not a mere continuation of those first-instance proceedings (see e.g. T 34/90, OJ EPO 1992, 454, point 2 of the Reasons). The function of appeal proceedings is to give a judicial decision on the correctness of a separate earlier decision taken by a first-instance department (see e.g. T 34/90, loc. cit., and G 9/91 and G 10/91, OJ EPO 1993, 408, 420). It follows that the purpose of the *inter partes* appeal procedure is mainly 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 is correct (G 9/91 and G 10/91, loc. cit., point 18 of the Reasons).

The appeal proceedings are thus largely determined by the factual and legal framework of the preceding opposition proceedings and the parties have only limited scope to amend the subject of the dispute in appeal proceedings (see e.g. T 1705/07, Reasons 8.4). 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 admittance 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).

The aforementioned principles are reflected in the provisions of Articles 12(4) and 13 RPBA. Since the appellant filed auxiliary requests for the first time with its statement of grounds of appeal, Article 12(4) RPBA is the relevant provision to be applied in the present case.

- 2.3 Article 12(4) RPBA requires the Board to take into account everything presented by the parties under Article 12(1) RPBA (including any answer to a communication sent by the Board filed pursuant to directions of the Board) 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 and requests that could have been presented or were not admitted in the first instance proceedings.
- 2.4 In the present case, a novelty objection regarding D1 was already in the proceedings along with the notice of opposition, in which all the features of claim 1 were discussed.

The appellant argued that the notice of opposition did not contain a sufficiently complete analysis of D1 such that the burden of establishing what case was being made, and where the individual features were to be found, had been shifted to the proprietor (now appellant). The Board however does not accept this and finds that the paragraphs in point 2 of the notice of opposition regarding the novelty attack based on D1 deal generally with all the different features of claim 1, albeit some rather succinctly, but allow the understanding of the attack without any undue burden.

2.4.1 In its reply to the counter-statement of the proprietor of 14 August 2013, the opponent replied to the arguments of the proprietor, in which the proprietor had argued that D1 did not disclose features M1.2 and M1.6 and that a tufting mechanism was not the same as a unit, without adding any new facts or arguments that had not been known previously by the parties. Contrary to the argument of the appellant, there was no need at this point in the opposition proceedings for the opponent to enter into a further analysis of the claim in its entirety again but simply to refute the counter-arguments which the proprietor had further presented. The factual context did not change.

2.4.2 The preliminary opinion of the opposition division also did not add any new substantive point and stated, having given a positive opinion on other objections, neutrally, that novelty would be discussed during the oral proceedings. Further, in point 7 of this communication the opposition division had indicated that any request from the proprietor for maintenance in amended form should also be submitted by the date indicated in accordance with Rule 71(a) EPC 1973 (now Rule 116 EPC).



Although the opposition division had not given a preliminary opinion on novelty, but had given a positive opinion in favour of the proprietor on two other grounds of opposition, it should at least have been taken into account as an indication that the outcome was evidently uncertain. With this, the proprietor should have prepared possible fallback positions if it wished to have a patent maintained at least in amended form at the end of the oral proceedings. Contrary to the argument of the appellant, it is not reasonable to assume that the opposition division would follow the arguments of the appellant simply because there was no specific negative opinion from the opposition division.

All the features and arguments on novelty in view of D1 had been presented, disputed and later clarified in response to a counter-statement, so the proprietor was aware of the attack and its underlying arguments at that stage, such that this did not constitute a new situation for the proprietor.

Consequently, the proprietor could have prepared possible fallback positions if it wished to have a patent maintained at least in amended form at the end of the oral proceedings, but instead made the deliberate choice not to do so at this stage. The Board cannot see that this would have been contrary to the appellant's arguments and the efficient resolution of the opposition (as the appellant argued), since the party's case should have been made as early as possible. Indeed, the efficient resolution of the case is entirely undermined.

- 2.4.3 In its opening requests at the oral proceedings before the opposition division, the proprietor maintained its sole request on file to reject the opposition and maintain the patent as granted (see the minutes of those proceedings page 1). No further request was made, although the opportunity was clearly present. According to the minutes, it was only after the Chairman announced that the subject-matter of claim 1 was not new in view of D1, that the proprietor expressed the wish to submit amendments. Upon questioning by the Chairman, the appellant declared that no auxiliary request had been prepared at that point (see item XI above).
- 2.4.4 Further, according to the minutes, the Chairman then pointed out that the preparation of an auxiliary request during the oral proceedings would be regarded as late-filed. Such a statement does not imply that a further request could not have been admitted into the proceedings but simply points out that such a request would not have been filed within the time limit set under Rule 79(1) EPC nor in accordance with Rule 116 EPC. Thus, at least according to the minutes, there was no hindrance for the proprietor to have filed further requests at that stage.
- 2.4.5 The appellant argued before the Board that the Chairman of the opposition division had then declared that it was too late to file further requests and had subsequently announced the decision immediately, thus denying the proprietor an opportunity to file a further auxiliary request. On the other hand, the respondent stated during oral proceedings before the Board that it had no recollection of the Chairman having ever pronounced that it was too late to file further

requests or of the appellant having attempted to further intervene.

Since the parties do not agree on the recollection of the events that took place during the oral proceedings before the opposition division, the Board restricts itself to what is explicitly written in the minutes of those proceedings, which do not include a statement from the Chairman that it was too late to file further requests. The Board points out that the appellant had not requested a correction of those minutes, such that there is no reason for the Board to assume that they are incorrect or incomplete. Thus, there is no evidence on file that the Chairman of the opposition division limited the procedural possibilities of the proprietor during the oral proceedings. In that regard the Board would also note that the appellant did not once mention the alleged violation of its right to be heard in the grounds of appeal. Indeed, the appellant simply filed a set of auxiliary requests without any explanation as to why they were being filed only with the grounds of appeal. Thus, the Board finds that the appellant had the opportunity to file further requests during the oral proceedings before the opposition division and that its right to be heard had not been violated.

2.4.6 Consequently, the Board finds that the appellant made a deliberate and considered choice not to pursue his intervention or even take action after the Chairman declared that the preparation of an auxiliary request during the oral proceedings would be regarded as late-filed. Contrary to its argument, the appellant could not have been surprised by the decision of lack of novelty since the arguments presented had essentially remained the same since the filing of the notice of opposition.

The appellant's representative further argued that he had recognised during the oral proceedings before the opposition division that two optional fallback positions could have been pursued, but that he needed to discuss the choice of these fallback positions with his client before proceeding with a further request. The Board finds however that this is another indication that the appellant could and indeed should have presented auxiliary requests, at the very latest during the oral proceedings, but made a conscious choice not to do so.

The Board does not accept that the appellant is free to present or complete its case at any time during the opposition or the appeal proceedings, depending, for example, on its procedural strategy. In particular, in view of the judicial nature and purpose of *inter partes* appeal proceedings (see point 2.2 above) and in the interests of an efficient and fair procedure, the Board considers it necessary that all parties to opposition proceedings complete their submissions during the proceedings before the opposition division in so far as this is possible. If the proprietor chooses not to complete its submissions before the opposition division, as in the present case, but rather completes its case only in the grounds of appeal, then it will have to face the consequence of being held to account by the Board for such conduct when, for example, exercising its discretion under Article 12(4) RPBA, which gives the Board discretion to hold inadmissible requests which could have been filed in the first instance proceedings.

2.5 The appellant filed a set of auxiliary requests for the first time with its grounds of appeal despite having

had several opportunities to do so in the course of opposition proceedings and despite the reasons for revoking the patent relying on the objections raised by the opponent in its written submissions (see point 2.3 above).

The appellant's argument that claim 1 of each of the auxiliary requests on appeal was a straightforward limitation of the granted claims which took into consideration the reasons for revocation of the patent given by the opposition division, does not alter the fact that the requests could have been filed earlier, since the reasons referred to (e.g. that yarn feed unit as defined in the claim 1 corresponded to the assembly 118 of D1 or that the yarn feed devices defined in claim 1 corresponded to feed drive rollers 122A and 122B of D1) correspond to the arguments presented by the opponent in its notice of opposition (see e.g. last paragraph of page 1 and first paragraph of page 2) and in its response to the counter-statement of the proprietor dated 14 August 2013 (see e.g. page 2, third, seventh and eighth paragraphs).

- 2.6 In decision T 677/12 cited by the appellant, the Board did not hold inadmissible auxiliary requests 3 to 8A submitted with the grounds of appeal, since they were an appropriate reaction by the appellant to the decision of the opposition division. As explained above in point 2.4, this does not correspond to the present case, where there were several opportunities to do so in the course of opposition proceedings and the reasons for revoking the patent were those already known from the opponent's submissions.

T 360/12, also cited by the appellant, lacks relevance to the present case since it relates to amendments to a

party's case made on appeal and not to the question whether the requests could have been presented in the opposition proceedings.

- 2.7 For completeness it is noted that the appellant did not put forward any arguments as to why a specific one of the auxiliary requests 1 to 11 could not have been filed before the opposition division. Indeed, it is evident from the amendments made in claim 1 of each auxiliary request (see the amendments noted in item XV. *supra*), that each of these is directed to overcoming the novelty objection based on D1 (and D4), which is precisely the type of amendment which could have been made during the opposition proceedings.
- 2.8 Taking into account the course of the proceedings before the opposition division and the opportunities available, the Board finds that the appellant could indeed have filed auxiliary requests earlier and thus the Board exercised its discretion to hold the auxiliary requests filed with the grounds of appeal and those filed during the appeal proceedings (auxiliary requests 1 to 11) inadmissible (Article 12(4) RPBA) and thus excluded these from the proceedings.
3. Lastly it is noted that the request for correction under Article 140 EPC made by the appellant concerned the printed version of claim 6 (see e.g. the Board's communication sent prior to the oral proceedings, items 2.2 to 2.2.3) and is consequently not relevant for the purposes of the present decision.
4. In the absence of a request in the proceedings, on the basis of which the patent can be maintained, the appeal must be dismissed.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated