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**Datasheet for the decision  
of 23 May 2019**

**Case Number:** T 0448/16 - 3.2.04

**Application Number:** 07117586.3

**Publication Number:** 1985343

**IPC:** A63F13/04

**Language of the proceedings:** EN

**Title of invention:**  
Game operating device

**Patent Proprietor:**  
Nintendo Co., Ltd.

**Opponents:**  
Bigben Interactive SA  
Steup, Mike  
Sunflex Europe GmbH

**Headword:**

**Relevant legal provisions:**  
EPC Art. 76(1), 112  
EPC R. 106

**Keyword:**

Amendments - added subject-matter (yes)  
Referral to the Enlarged Board of Appeal - (no)  
Oral proceedings before board of appeal  
Right to be heard - violation (no)  
Oral proceedings - objection under Rule 106 EPC dismissed

**Decisions cited:**

**Catchword:**

see Reasons 9



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Case Number: T 0448/16 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 23 May 2019**

**Appellant:**  
(Patent Proprietor)

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**Decision under appeal:**      **Decision of the Opposition Division of the  
European Patent Office posted on 14 December  
2015 revoking European patent No. 1985343  
pursuant to Article 101(3)(b) EPC.**

**Composition of the Board:**

**Chairman**                    A. de Vries  
**Members:**                    J. Wright  
                                      W. Van der Eijk

## **Summary of Facts and Submissions**

I. The proprietor lodged an appeal, received 18 February 2016, against the decision of the opposition division of the European Patent Office posted on 14 December 2015 revoking European patent No. 1985343 pursuant to Article 101(3)(b) EPC. The appeal fee was paid at the same time. The appellant-proprietor's statement setting out the grounds of appeal was filed on 25 April 2016.

II. The opposition was based on, amongst other grounds, added subject matter, Articles 100 (c) EPC with 76(1) EPC.

During the opposition proceedings, a further party (opponent II) filed a notice of intervention under Article 105(1) b EPC on 23 November 2012. They withdrew their opposition on 25 April 2014.

With letters of 27 December 2012, two further parties (opponents III and IV), filed notices of intervention under Article 105(1)b EPC.

The opposition division held, amongst other things, that claim 1 (as granted) of the patent as amended according to a main request added subject matter extending beyond the parent application and so did not meet the requirements of Article 76(1) EPC.

III. In a communication dated 11 January 2019 and in preparation for oral proceedings the Board gave a provisional opinion on added subject-matter with regard to the parent, in particular concerning feature f in the various versions, see sections 3.5, 6.2 and 6.3.

Oral proceedings were held before the Board on 23 May 2019 in the absence of the opponents III and IV, who had been duly summoned. During the oral proceedings, the appellant-proprietor filed an objection under Rule 106 EPC.

IV. The appellant (patent proprietor) requested that the decision under appeal be set aside and European patent No. 1985343 be maintained in amended form, on the basis of a main request or one of auxiliary requests IA, IB, IC, IIA, IIB, IIC, IIIA, IIIB, IIIC, IVA, IVB or IVC, all filed with the grounds of appeal on 25 April 2016, or on the basis of auxiliary request ID, filed at the oral proceedings before the Board.

Alternatively, it requested that in case the claims according to the main request were found to be in compliance with Article 76(1) EPC, the case be remitted to the opposition division for a full evaluation of the ground of lack of inventive step.

Alternatively, it requested that the following questions concerning claim interpretation be referred to the Enlarged Board of Appeal:

*"1. When interpreting a claim for assessing its compatibility with EPC Article 123 (2), is it admissible to choose one of several possible interpretations of the meaning of a feature without looking at the description and drawings?*

*2. In particular, is it admissible to choose a meaning of the feature in question which is contrary to each and every embodiment shown in the drawings, which consistently exhibit a meaning corresponding to an alternative interpretation?*

*3. If the answer to question 2 is yes, under which circumstances is such a choice possible?"*

V. The respondent-opponent I requested that the appeal be dismissed.

VI. Respondent-opponents III and IV have made neither a request nor any observation in the appeal proceedings.

VII. Claim 1 of the main request reads as follows:

"A game operating device, comprising:

a longitudinal housing (12) having a thickness capable of being held by one hand; a direction designating switch (26) provided on a first plane (20) at one end side of said housing (12) along a longitudinal direction

a first operating switch (142; 28) provided on a second plane (22) opposed to said first plane (20) of said housing (12) at a position corresponding to said direction designating switch (26);

a holding portion (18) formed between said first switch (142;28) and another end side of said housing (12) along the longitudinal direction;

a second operating switch (44, 46) provided on said first plane (20) at a side of said holding portion (18);

at least one of a three-axis acceleration sensor (68) and a gyro sensor provided within said housing (12); and

an output means (66,70,72) for outputting information detected by said at least one of a three-axis acceleration sensor (68) and a gyro sensor as an operating signal, together with an operation signal

from at least one of said first operating switch (142; 28) and said second operating switch (44,46)".

In this claim, the feature "a second operating switch (44, 46) provided on said first plane (20) at a side of said holding portion (18)" has been referred to as feature f.

In claim 1 of auxiliary requests IA, IIA, IIIA and IVA, feature f reads as in the main request.

In claim 1 of auxiliary requests IB, IIB, IIIB and IVB, feature f is amended to read as follows (amendments underscored by the Board):

"a second operating switch (44,46) provided on said first plane (20) at the side of said holding portion (18) on the width-direction center line (C1) and backward of the longitudinal-direction center (C2) of the housing"

In claim 1 of auxiliary requests IC, IIC, IIIC and IVC, feature f is amended to read as follows (amendments again underscored by the Board) :

"two second operating switches (44,46) provided on said first plane (20) at the side of said holding portion (18) on the width-direction center line (C1) and backward of the longitudinal-direction center (C2) of the housing (12) in a straight line with a spacing between said two second operating switches"

In claim 1 of auxiliary request ID, feature f is amended to read as follows (amendments again underscored by the Board):



"two second operating switches (44,46) provided on said first plane (20) at the side of said holding portion (18) on the width-direction center line (C1) and backward of the longitudinal-direction center (C2) of the housing (12) in a straight line with a spacing between said two second operating switches wherein the second operating switches can be used to make adjustments to a position and a field angle of a virtual-camera"

VIII. The appellant-proprietor argued as follows:  
None of the requests on file add subject matter extending beyond the parent application as filed. In particular feature f of all requests has a basis in paragraph [0063] of the parent application. Auxiliary request ID adds to feature f all relevant structural and functional features from paragraph [0063] of the parent, so the request is clearly allowable and should be admitted into the proceedings.

IX. The appellant-opponent I argued as follows:  
Feature f of all of the requests adds subject matter extending beyond the application as filed.

Auxiliary request ID does not add all features from paragraph [0063] of the parent, which itself is only part of a complex embodiment. Therefore the request is not clearly allowable and should not be admitted.

## **Reasons for the Decision**

1. The appeal is admissible.
2. Background
  - 2.1 The patent relates (see published patent specification, paragraph [0001]) to a game operating device having a housing that is held by one hand. Various keys and operating switches are arranged on upper and lower surfaces of the housing. An object of the invention is to provide a game operating device that can be operated even by one hand in a stable manner (see specification, paragraph [0013]).
  - 2.2 This is achieved by a certain arrangement of the various keys and buttons (see for example the specification, paragraphs [0041], [0043] and [0044]).
  - 2.3 Claim 1 of the granted patent contains a feature "f" (a second operating switch provided on said first plane at a side of said holding portion), which plays an important role in the present case.
3. Main request, interpretation of feature f
  - 3.1 The Board finds it useful to first consider the context of feature f in claim 1. The claim defines a game operating device (see for example figure 2, which shows the device from all sides). A direction designating switch 26 is provided on a first plane at one end side of the housing (the plane shown in figure 2B). The claim also defines a first operating switch 142 on a second plane opposed to the first plane and at a

position corresponding to the direction designating switch (see figure 2c). The claim likewise defines a holding portion 18. Whether or not the holding portion is three dimensional, it extends in the longitudinal direction from the first operating switch to the end of the device furthest from the first operating switch.

- 3.2 Turning now to feature f (a second operating switch provided on said first plane at a side of said holding portion), the Board acknowledges that the word "side" can have different meanings. It can mean a periphery and it can mean one half of something (as in the left and right side of the face).
- 3.3 The opposition division (see impugned decision, reasons 15.7.3) interpreted feature f to mean that the second operating switch was on the periphery of the plane, but acknowledged that this was one of different possible interpretations. The appellant-proprietor and respondent-opponent I agree that feature f is ambiguous. The respondent-opponent I has interpreted feature f in the same way as the impugned decision (switch on periphery). The appellant-proprietor sees the second operating switch as being on the half of the first plane, in the longitudinal direction, that overlaps with the holding portion (see figure 2B, patent specification, the half of the plane 20 shown below the horizontal centre line C2).
- 3.4 According to established jurisprudence the skilled person interprets a claim with a mind willing to understand, so as to arrive at an interpretation which is technically sensible. See Case Law of the Boards of Appeal, 8th edition, 2016 (CLBA), II.A.6.1, and the decisions cited therein.

Where the skilled person encounters an ambiguous term, they may need to consult the rest of the disclosure (description, claims and drawings) in order to interpret the feature, see CLBA II.A.6.3.3.

- 3.4.1 As the appellant-proprietor has pointed out, none of the embodiments show operating switches at the periphery of that part of the first plane 20 that overlaps with the holding portion 18. The only switches there are those referenced 30, 32, 44 and 46. The switches 30 and 32 (see in the patent specification for example paragraph [0029] and [0099] with figures 2B, 23, 26 and 27) are, although offset from the vertical centre line C1, not at the periphery of the plane 20.

The switches 44, 46 are consistently shown away from the periphery, namely along the vertical centre line, (see patent specification, paragraph [0036] and figure 2B, switches 44, 46). Therefore, the first interpretation of feature f (switches on *periphery* of holding portion part of first plane 20) appears to be inconsistent with the description and drawings, so the skilled person might well reject it.

- 3.4.2 With respect to the second proposed interpretation of feature f (second switch on the holding portion *half* of the first plane 20), this would appear to be consistent with how the word *side* is used elsewhere in the claims, as also argued by the appellant-proprietor.

In claim 1 (second feature) *side* appears to designate an end half of the housing "end side of the housing", to explain the location of the direction designating switch. By the same token (see published patent specification, claim 3) *side* is again used to express

the same half of the housing "within the housing at a side of said direction designating switch".

Lastly, all the embodiments show switches 44 and 46 on the first plane 20 at the half of the housing where most of the holding portion 18 is located (cf. figure 2B, for example, the area below the centre line C2).

Therefore, this second interpretation would appear to be a technically sensible interpretation of feature f and one which takes into account the whole disclosure.

- 3.5 The Board thus, after reconsideration of its provisional opinion expressed in its communication, finds in favour of the appellant proprietor, and concludes that feature f is to be interpreted as defining that a second operating switch is located on the first plane and on the half of the housing that completely overlaps with the holding portion (cf., for example, figure 2B, the area below the centre line C2).
4. Request for referral of questions to the Enlarged Board of Appeal
  - 4.1 Article 112 EPC provides for the possibility of referring questions of law to the Enlarged Board "in order to ensure uniform application of the law or if a point of law of fundamental importance arises" (paragraph (1)). In the present case the appellant-proprietor has asked for referral of questions concerning claim features having different possible interpretations (see above, section IV).

- 4.2 As is apparent from the preceding section, the Board has arrived at one of different possible interpretations of feature f by, amongst other things, looking at the description and drawings, to find an interpretation that is consistent with the description and drawings. This approach, which corresponds to that argued by the appellant-proprietor, is in line with established jurisprudence (see CLBA, II.A.6 and II.A.6.3.3 which deals with interpretation of ambiguous terms). The Board therefore sees no need to refer the proposed questions to the Enlarged Board of Appeal as the jurisprudence already provides a clear answer.
- 4.3 For these reasons the Board decided not to refer the questions to the Enlarged Board of Appeal.
5. Added subject matter, main request, Article 76(1) EPC
- 5.1 Article 76(1) EPC states that the "European divisional application ... may be filed only in respect of subject matter which does not extend beyond the content of the earlier application as filed".
- 5.2 According to established jurisprudence, see CLBA, II.E.1.2, any amendment to a European patent (here with respect to the parent under Article 76(1) EPC) can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge from the whole of these documents as filed (here the parent application), see in particular CLBA, II.E.1.2.1, and in particular G2/10, reasons 4.3.
- 5.3 Feature f (a second operating switch provided on said first plane at a side of said holding portion) has no literal basis, either in the claims or description of the parent application (see published application of

EP1757343). Bearing in mind the Board's interpretation of this feature (cf. figure 2B second operating switch below centre line C2), this idea must be at least implicitly disclosed in the parent application as a teaching that the skilled person immediately recognises as distinct and separable for it to be introduced in isolation into claim 1.

- 5.4 The parent application (see paragraphs [0045] to [101] with, for example, figures 1 and 2) describes the layout of a first detailed embodiment of a controller. The layout of the first plane as claimed can best be seen in figure 2B. As well as the direction designating switch 26 (cf. claim 1), several operating switches are located on the first plane.
- 5.5 From figure 2B and its description, the skilled person would realise that the horizontal line C2 is a centre line, dividing the controller into two sides, the lower one being the side of the holding portion 18. However, with some operating switches (24, 28, 30 and 32) located above the centre line C2, and some below (44 and 46), the Board does not consider the skilled person, without foreknowledge of what they are looking for, would immediately identify the feature of providing a generic second operating switch and locating it on the holding portion side as a distinct and separable aspect of that embodiment.
- 5.6 Nor would considering the description produce a different result. For example (see paragraph [0063] cited by the appellant-proprietor as primary basis) although particular operating switches (X and Y switches 44 and 46) are said, amongst other things, to be backward of the centre line C2, in other words on the holding portion side of the controller, another

particular switch (centre switch 28), being in the middle of direction switch 26 is disclosed as being forward of the centre line C2 (see column 10, lines 16 to 24). Thus, with specific switches described as being on each side of the centre line C2, the skilled person is not presented with an immediately recognisable distinct teaching of providing a (generic) second operating switch on the holding portion side of the first plane of the controller, distinct from just anywhere on the first plane.

- 5.7 Much less does the description hint that this idea might play a role in achieving the main aim of the invention (single handed operation of the controller), which might justify its being raised to prominence by incorporating it into the independent claim.

On the contrary, the description explains (see paragraph [0114]) that the particular switches located on the holding portion side of the controller (X button 44 and the Y button 46) are "not necessarily easy to operate because they are provided in the range of the holding portion 18".

- 5.8 This is not to say that, if presented with feature f, the skilled person would not be able to confirm that the X, Y switches 44 and 46 of the embodiment fall under its definition. However, the Board believes that the presence of the feature will be discernible only to the eye that is seeking to confirm it rather than to discover it for the first time.

In other words, the Board does not believe that a skilled person, approaching the figures of the first embodiment (amongst others figure 2B) and the associated description for the very first time and



without knowledge of feature f, would positively identify it or recognise it as being in some way significant for the main purpose of the invention.

5.9 Moreover, according to established case law (see CLBA, II.E.1.7), it will normally not be allowable to base an amended claim on the extraction of isolated features from a set of features originally disclosed only in combination, e.g. a specific embodiment in the description. Such an amendment results in an "intermediate generalisation", which is justified only in the absence of any clearly recognisable functional or structural relationship among the features of the specific combination.

5.10 In the present case, feature f is disclosed only as an integral part of a broader arrangement of switches in a tight functional and structural relationship with other features of the embodiment which have not been claimed.

5.11 The only mention of any switch being located [on the] holding portion side of the controller appears in paragraph [0063] (backward of the centre line C2 of the housing, cf. figure 2B).

The paragraph itself also contains other features which have not been claimed. For a start, there is not just one but two operating switches (44 and 46), an aspect which has not been claimed. Furthermore, these switches are disclosed in a particular structural relationship with the controller which has also not been claimed. In particular, they are on the width-direction center line C1 and in a straight line with a spacing between the two.

Moreover, the buttons X, Y are not generic operating buttons but are only disclosed in a particular functional relationship with the controller which has likewise not been claimed: they are "used to make adjustments to view point position and view point direction in displaying a three-dimension game image, that is, make adjustments to a position and a field angle of a virtual camera".

- 5.12 Nor does the skilled person read paragraph [0063] in isolation, because it is part of a long description of a particular embodiment.

In this respect, the Board considers that, because the controller is made to be held in one hand (see parent application, paragraph [0046] and figures 2 and 3), the geometry of the entire arrangement can but relate to the user's hand: when the player holds the holding portion, their index finger can operate the first operating switch 42 (see column 12, lines 9 to 14); the palm of the hand wraps the holding portion (see column 12, lines 28 to 30); the thumb operates the direction switch 26, and selection switch 28 (see figure 3) and these are arranged on the centre line C1, hence collinearly with the X, Y buttons (see column 10, lines 16 to 24, paragraph [0063] and figure 2B). Thus, feature f, if indeed identifiable, would be but one feature among many structurally and functionally related features which work together in achieving a controller that can be operated by one hand. However, these aspects have not been claimed.

- 5.13 Lifting feature f out of this context (of paragraph [0063] and figure 2B) and adding it in isolation to claim 1 therefore represents a generalisation of the specific structural and functional context in which the

feature might be said to originally appear. At the same time it raises it to prominence, giving it a significance over other features that it does not have in the original parent disclosure.

5.14 Nor does the Board consider feature f is disclosed in any other parts of the parent application in a manner that the skilled person recognises it as a distinct and separable teaching. In some arrangements (see paragraphs [0102] to [0125] with figures 13 to 22), the controller of figure 2 is merely inserted into a secondary controller. In a further embodiment (see paragraphs [0126] to [0150] with figures 23 to 32), the shape and layout of some buttons differs from the first embodiment (see for example paragraph [0126]), but no more information is added with respect to their locations relative to the holding portion side or, for that matter, the other side of the controller.

5.15 In this respect, the appellant-proprietor has argued that the skilled person would recognise feature f in conjunction with using the controller of this further embodiment with two hands (cf. published parent application, paragraphs [143] to [148] with figure 32). The Board disagrees.

Various aspects of how the controller's switches are arranged for convenient two-handed operation are discussed (see paragraphs [0147] and [0148]), but not particularly in relation to the holding portion side of the device. At most (see paragraph [0148]), the skilled person merely learns that some switches are operated by the left hand and some by the right. The X and Y switches are operated by the right hand, but this is given no particular prominence (see column 33, lines 5

and 6), let alone is it mentioned that they are on the holding portion side of the device.

5.16 For all these reasons, the Board concludes that there is no original disclosure of feature f in the parent application. Therefore claim 1 adds subject matter extending beyond the parent application as filed.

6. Auxiliary requests IA, IIA, IIIA and IVA

Without prejudice to the question as to whether or not these requests should be admitted into the proceedings, they all leave feature f unamended compared to the main request. Therefore, these requests must fail for the same reasons as apply to the main request.

7. Auxiliary requests IB and IC, IIB and IIC, IIIB and IIIC, IVB and IVC

7.1 In the Board's view, feature f of claim 1 of all of these requests is not originally disclosed in the parent application. In the light of this, as with the "A" version auxiliary requests, the question as to whether or not they should be admitted is moot.

7.2 Feature f of these requests is amended compared to the main request by adding some but not all features from the description, paragraph [0063].

Feature f in B version requests adds that:

- there are two second operating switches,
- on the width-direction center line (C1) of the housing (12)

while the C version further adds that these are

- in a straight line with a spacing between them.

7.3 Thus, these amendments to feature f with respect to the main request add some of the structural context of particular operating switches from the embodiment to the idea of having two second (generic) operating switches on the holding portion side of the controller.

7.4 However, as with the main request, the Board notes that paragraph [0063] cannot be read in isolation because it is part the description of a complete embodiment. For example, the operating switches mentioned in paragraph [0063] are only disclosed arranged collinearly with the direction switch 26, and selection switch 28, thus in a particular structural relationship, an aspect which has not been claimed in either C or B version.

7.5 Nor does either version of feature f add any of the functionality of the operational switches described in paragraph [0063], where they are X and Y buttons performing a specific function in displaying a three dimensional game image. In this respect, the Board is not convinced by the appellant-proprietor's argument that it would be implicit from paragraph [0148] with figure 32 that when holding the controller with two hands that the buttons 44 and 46 can have any function, since they can be more frequently used and the paragraph does not mention any particular function. In the Board's view, the skilled person reads the paragraph in its broader context. In the absence of any suggestion anywhere that other functions might be contemplated, much less any new or different functions being explained, the skilled person reads this passage with the understanding that the X and Y buttons have

the same functions as explained previously, inter alia in paragraph [0063].

7.6 For these reasons, the amendments to feature f in either version fail to resolve the deficiency noted for claim 1 in its A version. Thus, feature f remains lifted out of its original context in the description and added to claim 1 in isolation. It therefore represents an unallowable generalisation of its specific structural and functional context in which it originally appears.

7.7 Thus, the Board concludes that claim 1 in B and C versions adds subject matter extending beyond the parent application as filed.

8. Admissibility of auxiliary request ID

8.1 Auxiliary request ID was filed at the oral proceedings before the Board, thus at the last possible moment. The request thus amounts to an amendment to the appellant's case in the sense of Article 13 of the Rules of Procedure of the Boards of Appeal (RPBA) and its admittance is subject to the Board's discretion.

8.2 Under Article 13(3) RPBA, any amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the parties cannot reasonably be expected to deal with without an adjournment.

8.3 An approach frequently adopted by the Boards when exercising their discretion in admitting an amendment filed shortly before or during oral proceedings can be summarised as follows: unless good reasons exist for filing the amendment so far into the proceedings, for

example if it is occasioned by developments in the proceedings, it will be admitted only if, amongst other things, it is clearly allowable, see CLBA, IV.E.4.2.1.

In accordance with established jurisprudence, amended claims are clearly allowable if the Board can quickly ascertain that they overcome all outstanding issues without raising new ones, see CLBA, IV.E.4.2.2 and, for example, T 183/09, reasons 4.

- 8.4 In the present case, no good reasons have been submitted that might justify the late filing of this auxiliary request, nor are any apparent to the Board. Added feature f was addressed already in the Board's communication in sections 3.5, 6.2 and 6.3. Section 3.5 addressed the issue of interpretation on which the Board in the oral proceedings subsequently changed its position in favour of the appellant. However, in the final two paragraphs (page 7) it also discussed the problem of intermediate generalisation. Thus the issue was not new.
- 8.5 In the Board's opinion, claim 1 is also not clearly allowable, in particular regarding added subject matter (feature f) with respect to the parent application.
- 8.6 The Board acknowledges that feature f of this request adds part of the functionality of the X and Y switches disclosed in paragraph [0063] (adjustments to a position and a field angle of a virtual-camera).
- 8.6.1 It is true that the feature incorporated into feature f (adjustments to position and field angle) is literally taken from paragraph [0063]. However, there it is only the second half of a sentence. The Board agrees with the respondent-opponent-I's view, that the skilled

person does not read this in isolation, but as a further explanation that builds on what is said in the first half of the same sentence. There, it is explained that these positions and direction adjustments are made in displaying a three dimensional game image, a feature that has not been incorporated into claim 1.

- 8.6.2 Nor does the Board agree with the appellant-proprietor that the information from the first part of the sentence (adjustments in a three dimensional game) is implicit in feature f. As it now reads, switches X and Y could be used to make adjustments to a position and field angle of a virtual camera in general, not necessarily in a three dimensional game image. For example, they could be made in a two dimensional image display, just as a two dimensional map can be viewed from different positions and from different field angles (zoomed in and out).

Thus, feature f generalises what is disclosed in paragraph [0063].

- 8.7 Moreover, as already explained for the higher ranking requests, the features of paragraph [0063] are but one part of a complex embodiment of a specific arrangement of multiple switches with specific functionalities in a specific location and comprising features that are structurally and functionally related with the X and Y buttons described in paragraph [0063], but which have not been claimed.

- 8.8 For all these reasons, feature f presents new information which is not directly and unambiguously derivable from the parent application as filed. Therefore, the Board considered that the request was



not clearly allowable. Consequently, the Board decided not to admit auxiliary request ID into the proceedings.

9. During the oral proceedings before the Board after non-admission of Auxiliary Request ID, the appellant-proprietor raised, in writing, the following objection under Rule 106 EPC:

*"We herewith raise an objection under Rule 106 EPC.*

*In the first part of the oral proceedings, the Chairman asked the parties to present their cases on the question of added matter over the parent application. After a break for deliberation, the Board indicated that the claims of the main request and all auxiliary requests on file contain added subject-matter, in violation of Art. 76 EPC. The Chairman indicated that the claims of all requests on file, including all auxiliary requests in versions A, B and C are inadmissibly generalized. Proprietor's representatives asked if the Board's opinion had changed over the written preliminary opinion, and for an indication as to the feature/features which caused the violation found. At a later stage in the oral proceedings, the Chairman stated that the generalization relates to feature f). Thereafter, the Proprietor's representatives asked for indication as to why this feature f) was found to be inadmissibly generalized, i.e., which missing aspects of the original disclosure of the parent application caused the objection.*

*However, the Board was not willing to provide such indication.*

*Therefore, Proprietor was not in a position to properly react, provide arguments, or remedy possible*

*deficiencies in any of the claim sets on file. In the Proprietor's view, this constitutes a fundamental violation of the right to be heard according to Article 113 EPC".*

- 9.1 The objection relates to how the Board dealt with the issue of added subject matter (cf. feature f) of certain auxiliary requests at the oral proceedings.

The core of the objection as the Board understands it is that it should have indicated to the appellant-proprietor what features were missing in the various versions of the auxiliary requests. This would have allowed the appellant-proprietor either to provide suitable arguments in favour of existing requests or formulate a new request that could have overcome the problem of added subject matter.

- 9.2 The Board first notes that, in accordance with established jurisprudence of the Enlarged Board of Appeal (see CLBA, IV.F.3.13.5), a board of appeal is not required to provide the parties in advance with all foreseeable arguments in favour of or against a request. In other words, parties are not entitled to advance indications of all reasons for a decision in detail (see for example R0004/11, reasons 2.5).

- 9.2.1 In the present case, the written opinion discussed the issue of intermediate generalization vis-a-vis the parent for feature f and this was the main issue discussed at length and in detail at the oral proceedings before the Board. The parties should therefore have been aware of this issue well before and during the oral proceedings. Nor is it disputed that the parties had the opportunity to comment on all requests at the oral proceedings. After the filing of

the objection, the Board offered the appellant-proprietor a further opportunity to discuss the auxiliary requests. The appellant-proprietor, however, declined.

9.2.2 Moreover, following the established jurisprudence outlined above, the Board was under no obligation to inform the parties in detail, either in its written preliminary opinion or at the oral proceedings, the omission of which particular features of the specific context resulted in an unallowable intermediate generalisation and which additional features a newly formulated claim would need to have for it to be allowable.

9.2.3 It is furthermore established jurisprudence of the Enlarged Board of Appeal (see CLBA IV.F.3.13.6 and, for example, R0009/09, reasons 2.3.3), that a board must remain neutral in inter partes proceedings, both in its communications to the parties and in oral proceedings.

Had the Board, after having discussed the issue exhaustively with the parties, then indicated to the appellant-proprietor, precisely which specific features were missing from claim 1 in any of its versions so that the appellant-proprietor could compose suitable counter-arguments or file a suitably adapted further request, this would have favoured the appellant-proprietor's case over that of the respondent-opponents. Such a course of action would have compromised the Board's duty to remain neutral, and thus the Board saw itself as prohibited from so doing.

- 9.3 For all these reasons, the Board considered that it had not violated the appellant-proprietor's right to be heard under Article 113 EPC, nor caused a procedural defect. Therefore, the Board dismissed the appellant-proprietor's objection raised under Rule 106 EPC.
10. The Board concludes that claim 1 according to the main request and the auxiliary requests IA to IVC, irrespective of their admissibility, is not allowable under Article 76(1) EPC. The remaining request, ID, has not been admitted into the proceedings. It follows that the Board can but confirm the appealed decision to revoke the patent.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated