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**Datasheet for the decision
of 4 February 2021**

Case Number: T 1707/16 - 3.2.07

Application Number: 09756486.8

Publication Number: 2376350

IPC: B65D85/10, B31F1/07, B65B19/22,
B65B61/00

Language of the proceedings: EN

Title of invention:
A PACK FOR SMOKING ARTICLES

Patent Proprietor:
British-American Tobacco (Holdings) Limited

Opponent:
JT International S.A.

Headword:

Relevant legal provisions:
EPC Art. 123(2)

Keyword:

Decisions cited:

Catchword:



Beschwerdekammern

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Case Number: T 1707/16 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 4 February 2021

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
12 May 2016 concerning maintenance of the
European Patent No. 2376350 in amended form.**

Composition of the Board:

Chairman V. Bevilacqua
Members: S. Watson
R. Cramer

Summary of Facts and Submissions

- I. The appeal arises from the interlocutory decision of the opposition division to maintain European patent No. 2 376 350 in amended form on the basis of the then auxiliary request 2.
- II. The opposition was directed against the patent as a whole and was based on Article 100(a) EPC (lack of novelty and lack of inventive step); Article 100(b) EPC (insufficiency of disclosure) and Article 100(c) EPC (extension of subject-matter beyond the content of the application as originally filed).
- III. In its statement setting out the grounds of appeal, the appellant contested the findings of the opposition division relating to Article 123(2) EPC and Article 56 EPC. It further raised a new objection of lack of novelty with respect to the disclosure of the newly filed document D16 (WO 2009/132905 A1).
- IV. With its reply to the statement setting out the grounds of appeal, the patent proprietor (respondent) requested (main request) that the appeal be dismissed, and filed auxiliary requests 1 to 12. In addition it requested that D16 not be admitted into the proceedings and that, if D16 were to be admitted, document D17 (US 12/341,810), the priority document of the contested patent, also be admitted.
- V. In preparation for oral proceedings scheduled at the request of both parties, the Board communicated its preliminary assessment of the case by means of a communication pursuant to Article 15(1) RPBA 2020. The Board indicated that the arguments presented by the

appellant regarding an extension of the subject-matter of claim 1 of the main request appeared to be convincing; auxiliary requests 1 to 9 also appeared to contain subject-matter that extended beyond the application as filed; the subject-matter of claim 1 of auxiliary request 10 however did appear to overcome the appellant's objections and in particular to fulfil the requirements of Article 123(2) EPC.

- VI. With letter dated 8 January 2021 the respondent responded to the communication and also filed new auxiliary requests 10 to 13, whereby auxiliary requests 11 to 13 corresponded to auxiliary requests 10 to 12 filed with the reply to the statement of grounds of appeal.
- VII. With letter of 11 January 2021 the appellant responded to the communication pursuant to Article 15(1) RPBA 2020.
- VIII. Oral proceedings before the Board took place on 4 February 2021. During the oral proceedings auxiliary requests 1-3 were withdrawn, and at the conclusion thereof the decision was announced. Further details of the proceedings can be found in the minutes thereof.
- IX. The lines of argument of the parties are dealt with in detail in the reasons for the decision.
- X. The final requests of the parties are as follows,

for the opponent:

that the decision under appeal be set aside and
that the patent be revoked;

for the patent proprietor:

that the appeal be dismissed;
if the contested decision is set aside that the patent be maintained in amended form on the basis of one of auxiliary requests 4 to 9 filed with the statement setting out the grounds of appeal; or one of auxiliary requests 10 or 11 filed with letter of 8 January 2021.

XI. Independent claim 1 according to the main request reads as follows (amendments with respect to granted claim 1 are shown as additions or ~~deletions~~):

"A pack (1) for smoking articles comprising major front (2) and rear (3) planar panels and minor side planar panels (4,5) configured to form ~~the~~ a pack (1), characterised in that at least one of the major panels (2,3) includes a plurality of discrete protrusions (18) spaced from each other and projecting outwardly from an outer surface (2a,3a) of the major panel(s) (2,3), said outer surface (2a,3a) measuring a first distance (t) from the back side of said major panel(s) (2,3) and said discrete protrusions (18) having a height (h) measured from said outer surface (2a,3a) so as to measure a second distance (t+h) from the back side of said major panel(s) (2,3), and wherein said back side of said major panel(s) is flat."

Independent claim 1 of auxiliary request 4 differs from claim 1 of the main request through the addition of a further feature, namely:

"and wherein the discrete protrusions are configured to space an outer wrapper from the outer surface (2a,3a) of the major panel(s) (2,3) to

create an air gap between the wrapper and the outer surface (2a,3a) of the major panel(s) (2,3)."

Independent claim 1 of auxiliary request 5 differs from claim 1 of the main request through the addition of a further feature, namely:

"and wherein the pack further comprises an outer wrapper spaced from the outer surface (2a,3a) of the major panel(s) (2,3) by said protrusions (18) to define an air gap between the wrapper and the outer surface (2a,3a) of the major panel(s) (2,3)."

Independent claim 1 of auxiliary request 6 differs from claim 1 of the main request through the addition of a further feature, namely:

"and wherein the protrusions (18) are formed in regular rows and columns on the outer surface (2a,3a) of the major panel(s) (2,3)."

Independent claim 1 of auxiliary request 7 differs from claim 1 of auxiliary request 6 through the addition of a further feature, namely that the protrusions are:

"generally circular and convex in shape".

Independent claim 1 of auxiliary request 8 differs from claim 1 of auxiliary request 7 request through the addition of the further feature:

"and wherein all of the protrusions (18) project from the outer surface (2a,3a) of the major panel(s) (2,3) by the same distance."

Independent claim 1 of auxiliary request 9 differs from claim 1 of auxiliary request 8 through the addition of the further features that both of the major panels include a plurality of projections "formed on

substantially the entire outer surface areas of the major panels (2,3)".

Independent claim 1 of auxiliary request 11 reads as follows (amendments with respect to granted claim 1 are shown as additions or ~~deletions~~):

"A pack (1) for smoking articles comprising major front (2) and rear (3) planar panels and minor side planar panels (4,5) configured to form ~~the~~ a pack (1), characterised in that ~~at least one~~ both of the major panels (2,3) includes from 5 to 2000 ~~a plurality of~~ discrete protrusions (18) spaced from each other and projecting outwardly from an outer surface (2a,3a) of ~~the~~ each major panel~~(s)~~ (2,3), said outer surface (2a,3a) measuring a first distance (t) from the back side of ~~said~~ each major panel~~(s)~~ (2,3) and said discrete protrusions (18) having a diameter (d) of 1.0-1.5 mm, and a height (h) of 0.1-0.2 mm measured from ~~said~~ each outer surface (2a,3a) so as to measure a second distance (t+h) from the back side of ~~said~~ each major panel~~(s)~~ (2,3), wherein said back sides of said major panels are flat, wherein the protrusions (18) are formed on substantially the entire outer surface areas of the major panels (2,3), are generally circular and convex in shape, are of the same diameter, and are formed in regular rows and columns on the outer surfaces (2a,3a) of the major panels (2,3), and wherein all of the protrusions (18) project from the outer surfaces (2a,3a) of the major panels (2,3) by the same distance.".

Reasons for the Decision

Main request

1. *Article 123(2) EPC*

1.1 In the contested decision (see Reasons, II.5.2.3), the opposition division found that the subject-matter of claim 1 of then auxiliary request 2 met the requirements of Article 123(2) EPC.

The opposition division found that the newly introduced feature of a flat back side was disclosed in figure 9 of the original application documents, in combination with other features, and that the resulting intermediate generalisation was allowable.

In support of this finding, the opposition division referenced an earlier section of the contested decision (II.3.2.2 c) in which it had reasoned that page 18, line 30 to page 20, line 17 of the description provided explicit indications of possible modifications and variations of the disclosed embodiments [all cited passages of the description refer to the publication of the international application WO 2010/072482 A1].

Thus, the opposition division found that the feature, "wherein said back side of said major panel(s) is flat", could be taken in isolation from the first embodiment of the application documents (as shown in figures 1 to 9) without an extension of subject-matter.

1.2 With its statement of grounds of appeal (point 2.2), the appellant contested this finding. The appellant argued that the combination of the feature of the flat back side, taken from figure 9, with arbitrary features described generically on page 18, line 30 to page 20, line 17, led to the artificial creation of claimed

embodiments which were disclosed neither explicitly nor implicitly in the original application documents.

The appellant argued that the passage on pages 18 to 20, to which the appealed decision refers, was of a generic nature and essentially aimed to identify every feature of the disclosure as optional. The appellant further contested the allegation that every one of the numerous combinations of the different parameters relating to the protrusions would still achieve the heat transfer reduction effect aimed for in the contested patent.

At the oral proceedings before the Board, the appellant also argued that the absence of protrusions or depressions on the inner surface of a pack inevitably required that the protrusions on the outer surface of the pack must achieve the required reduction in heat transfer. There was however no general disclosure in the application relating to how the features and parameters of the protrusions on the outer surface could be combined with a flat inner surface, there was only the disclosure of the first embodiment. Therefore it was not clearly and unambiguously disclosed to the skilled person, that a flat inner side of the pack could be combined at will with any combination of protrusion number, shape, size, arrangement or location on the outer surface.

- 1.3 It is common ground between the parties that there is no literal basis in the description or claims of the original application documents for the disclosure of the feature "wherein said back side of said major panel(s) is flat".

1.4 The respondent, in its reply to the statement of grounds of appeal (pages 11 to 12), puts forward that the originally filed description implicitly disclosed that the back side of the panel was flat. The respondent cites passages of the description (page 1, lines 8-10 and page 2 lines 16-17 and lines 24-27) to support this position, and argues that if protuberances are formed only on the outer surface, in the absence of any further modification, the back side of the major panel must inevitably be flat.

In this context the respondent noted that the only other surface modifications originally disclosed, the depressions mentioned in claims 25-28, were optional.

The Board disagrees.

The argument of the respondent that the back side necessarily is flat because this is the logical complement of the embodiment of the feature that protuberances are formed on the outer surface cannot be followed.

When embossing sheet material, and forming a protuberance on one surface, it is possible, depending on the tools and process used, that a depression is formed on the opposite surface. Therefore the mention of an embodiment having protuberances embossed only on the outer surface cannot be seen as an unambiguous disclosure that the back side of this embodiment is flat.

The description on page 1, lines 8 to 10 refers to the surface of the "conventional packs" as being generally smooth.

This does not unambiguously refer also to the back side (inside) surface of the pack according to the invention, in particular as on page 1, lines 13-14 the heating elements are described as being "pressed

against the wrap on the pack surface", *i.e.* the outer surface.

On page 2, lines 16-17, the "formations" are described as being formed in the thickness of the sheet material such as by embossing. This also cannot be seen as an unambiguous disclosure of a flat back side, as the "formations" are not defined and could be formed on both sides of the sheet "within the thickness of the sheet material". The term sheet material does not unambiguously imply a flat surface.

The Board also does not see, even if the original dependent claims relating to the depressions (claims 25-28) were not dependent on the dependent claims relating to the protuberances (claims 14-17), how this could amount to a positive, unambiguous disclosure of the back side being flat. In addition, the original description (page 4, lines 4-5) states that the pack may include both protuberances and depressions, and the wording of the claims to which the respondent refers does not exclude this.

- 1.5 The respondent contested the argument of the appellant that page 18, line 30 to page 20, line 17 of the application represents a generic "catch-all" and argued that this passage is an "in depth discussion of how individual elements of the specific disclosure may be varied while still achieving the desired technical effect" (reply to the statement of grounds of appeal, page 19, lines 2-6).

In point 2.1 of its submissions of 8 January 2021, the respondent argued that page 18, lines 30 to 31 states that "Many modifications and variations of the described packs fall within the scope of the invention. For example...", which shows an explicit disclosure of

the combination of all the alternatives listed in the following pages with any of the embodiments.

The Board disagrees. The passages on these pages are essentially a listing of individual features of the pack with the indication that they can be varied in a non-limiting manner, whilst still achieving the desired effect. It gives no indication of suitable ranges of values for the parameters of the protrusions, nor does it show how the parameters may interact with one another nor, in particular, how they interact with a flat back surface.

From these passages the skilled person learns that the size, shape, location and arrangement of each protrusion can be varied, as can the number of protrusions, and these variations will still achieve the desired technical effect. As argued by the appellant, the respondent merely alleged, without providing any proof, that any of these variations and combinations achieves the technical effects aimed for in the contested patent.

In the absence of a specific disclosure in these passages of suitable ranges for parameters or any indication of how the different features may interact with one another, or with the feature of a flat back surface, the Board finds that the section of the description on pages 18-20 does not provide the skilled person with unambiguous information allowing a generalisation of the first embodiment.

This passage does not provide an unambiguous disclosure that a pack with a flat back side can have an outer surface with any arbitrary combination of features of the protrusions, in contradiction to the specific disclosure of the description relating to the only

embodiment which shows a flat back side with protrusions on the outer surface.

Therefore the Board agrees with the appellant that the opposition division was incorrect in finding that this part of the description as originally filed explicitly indicates that the additional features of the protrusions, described as forming part of the first embodiment, are optional.

- 1.6 In point 2.2 of its submissions of 8 January 2021, the respondent further argued that the written description of the first embodiment also discloses that the features found in the first embodiment but not included in claim 1 are optional. The respondent cited page 8, line 31 to page 9, line 8 and argued that use of the words "can vary", "typically" and "may" would lead the skilled person to understand that the values of the ranges shown are not restrictive and that these features are optional.

The Board disagrees and follows the argumentation of the appellant, that a skilled reader, when reviewing the description relating to the first embodiment (in particular page 8, line 31 to page 9, line 8 and page 9, line 28 to page 10, line 9) would understand that certain values for the parameters relating to the protrusions are necessary to achieve the required technical effect.

The description specifies, in relation to the first embodiment of the contested patent (which shows the back side as flat), that to obtain the heat transfer reduction effect it is necessary for the protuberances to have certain features (page 10, lines 6-9).

The description also specifies (page 8, lines 18-24) that the protrusions of the first embodiment are circular convex protuberances, arranged in rows and columns and covering substantially the entire surface area of the front and rear panels. In addition, the protuberances of the first embodiment are disclosed on page 8, line 31 to page 9, line 8, as being within certain diameter, height and number ranges, namely a diameter in the order of 1.0 to 1.5 mm, height in the order of 0.1-0.2 mm and from 5 to 2,000 protrusions on each panel.

The Board therefore follows the argument of the appellant that it could not be derived from the original description that the required technical effect could still be achieved if one of these features was removed from the embodiment, and no further modifications were carried out to compensate for this modification.

Claim 1 of the main request therefore contains an **unallowable intermediate generalization**.

- 1.6.1 With its reply to the statement of grounds of appeal (page 12, third paragraph), the respondent further brought forward the argument that, in the present case, it is permissible to extract the feature of the flat back side from figures 6 and 9 of the first embodiment, as this feature is not inextricably linked to any of the remaining features of the embodiment.

In its submissions of 8 January 2021 (point 2.3), the respondent developed this point, arguing that as the fourth embodiment (as shown in figure 18) disclosed a flat back surface where the outer surface did not have

the allegedly missing features, and the third embodiment (figure 15), disclosed these features but without the flat back surface, it is clear to the skilled person, that the flat back side is not inextricably linked to the allegedly missing features relating to the protrusions.

The Board, however, follows the argumentation of the appellant, that as figure 18 shows depressions rather than protrusions on the outer surface, it cannot have the allegedly missing features as they relate specifically to protrusions.

Further, that the protrusions on both inner and outer surfaces of figure 15 are depicted as having the allegedly missing features from the first embodiment does not imply that there is no inextricable link between the flat inner surface and an outer surface with protrusions, it merely discloses that protrusions on both surfaces of the pack may have the allegedly missing features.

- 1.6.2 In its submissions of 8 January 2021 the respondent also brought forward the argument (see point 2.4), that the allegedly missing features were not essential in order to achieve the heat transfer reduction effect, as for example the fourth, fifth and sixth embodiments had no protrusions at all and still achieved the thermal insulation. The skilled person would also understand that the protrusions did not need to number from 5 to 2,000; or have the same height in the range of 0.1 to 0.2 mm; or have a diameter of 1.0 to 1.5 mm or be arranged in regular rows and columns over substantially the entire front and rear panels in order to achieve the air gap, each of these features could be omitted and a thermally insulating air gap would still be present.

The Board does not find this argument convincing. The skilled person understands that there may be other embodiments which can achieve the same effect using different means, for example, depressions instead of protrusions, but this cannot be seen as disclosing that specific features of a different embodiment are not essential to the functioning of that embodiment itself. In the present case, the question is not whether the skilled person could conceivably, or indeed easily, imagine other combinations of features than those disclosed in the first embodiment, that might achieve the same technical effect, it is rather what does the skilled person directly and unambiguously derive from the application as originally filed. The skilled person understands that the first embodiment relates to a pack with protrusions having specific features on the outer surface and a flat inner surface. Nowhere in the application is the skilled person given an unambiguous indication as to how these features should be varied and in which combinations, maintaining the required technical effect, when the inner surface is flat.

- 1.6.3 At the oral proceedings before the Board, the respondent argued that the technical effect to be achieved by the claimed invention was not the reduction of heat transferred to the articles inside the pack, but the creation of an air gap between the outer surface and the wrapper. This air gap could be achieved with just the features present in the claim, such that any other features of the first embodiment could not be considered as essential for obtaining the desired technical result in the embodiment. In addition, as the form that the back (inner) surface takes has no effect on the creation of an air gap on the front (outer) surface of the pack, the features of the front and back

surface could not be considered to be inextricably linked.

The Board does not find this argument convincing either and again follows the argumentation of the appellant, also made at the oral proceedings, that the skilled person understands from the disclosure as a whole that the desired technical effect is not to create an arbitrary air gap, but rather to prevent heat transfer through the pack to the smoking articles contained within. The provision of protrusions on the outer surface only, together with a flat inner surface inevitably constrains the values of the parameters relating to the protrusions, as only the protrusions on the outer surface are available to achieve the required thermal insulation. The features of the protrusions on the outer surface are therefore inextricably linked to the back side being flat.

1.7 The Board thus concludes that the amendment made to claim 1 does extend the subject-matter beyond the content of the application as originally filed and the requirements of Article 123(2) EPC are not fulfilled.

2. *Admittance into the proceedings of a new line of argument submitted by the appellant during the oral proceedings*

At the oral proceedings before the Board, the appellant raised for the first time in the opposition or appeal proceedings, the objection that the feature, "wherein the back side of said major panel(s) is flat", is not disclosed in figure 9.

- 2.1 The appellant argued that there is no clear and unambiguous disclosure of a flat back surface in the figure.
Figure 9 shows the absence of protrusions, but whether the back was in fact flat, cannot be assumed from such an absence. During the embossing process which produces the protrusions on the outer surface, depressions could be formed on the back side of the panel. The drawing of figure 9 was a schematic drawing and it could be that the illustration of a flat back side merely represented the artistic licence of the draftsman.
- 2.2 The appellant argued that the new objection was not an amendment to its appeal case, but rather a further development of the argument raised in the statement of grounds of appeal. The objection was to the same feature (back side of the major panel(s) is flat) and under the same legal provision (Article 123(2) EPC), the only difference was the stage of the assessment of compliance with Article 123(2) EPC. When considering if a feature newly introduced into a claim leads to an extension of subject-matter, it must first be determined if there is any disclosure at all in the original application of the feature, and then determined whether this disclosure may be taken in isolation and combined with the existing features of the claim. In the present case only the second stage had been dealt with in the statement of grounds of appeal, and now the first stage was also being considered.
- 2.3 The respondent contested the admittance of the new objection into the appeal proceedings, arguing that it was an amendment to the case of the appellant and that no exceptional circumstances were present, as required

under Article 13(2) RPBA 2020, in order for amendments made at this stage to be considered.

2.4 The Board finds that the new objection does constitute an amendment to the appellant's case. Although the objection is made to the same feature under the same legal provision, it is an objection that was neither dealt with in the contested decision nor raised in the statement of grounds of appeal. The question of whether or not figure 9 unambiguously discloses a flat back (inner) surface of the pack completely changes the framework of the discussion relating to Article 123(2) EPC and therefore is regarded as an amendment to the party's case.

2.5 The appellant argued, that even if the new objection were to be regarded as an amendment to its case, it was submitted in reaction to the preliminary opinion of the Board (Rule 15(1) RPBA 2020 communication of 29 October 2020). On page 7, first two paragraphs, of the communication, the Board had noted that depending on the processes used, a panel having protuberances on one side only, may have depressions on the opposite side. The new objection of the appellant was raised in reaction to a previously unexpressed point made by the Board, such that exceptional circumstances were present.

The Board finds that, as the cited passage of the preliminary opinion relates to a general passage of the description and not to figure 9 or its associated description, it does not give rise to the necessity of an amendment to the case of the appellant. The amendment to the granted claim was made during the oral proceedings before the opposition division. The appellant, during those oral proceedings, raised the

objection that a single feature had been taken from figure 9 leading to an inadmissible intermediate generalisation, this objection was then repeated in the statement of grounds of appeal. The appellant therefore had had ample time to formulate its reaction to the amended claim. The Board's preliminary opinion in relation to a different argument cannot be seen, in the present case, as an exceptional circumstance as required under Article 13(2) RPBA 2020.

2.6 Thus the Board does not take the newly raised objection into account.

3. In light of the above findings of the Board under point 1., the main request is not allowable.

Auxiliary requests 4 and 5

4. *Article 123(2) EPC*

4.1 Auxiliary requests 4 and 5 both comprise newly introduced features that specify that the protrusions are configured to or define an air gap between the outer surface and the wrapper (see point XI above).

4.2 The respondent argued that the whole disclosure of the contested patent made evident that the protrusions were intended to fulfil this purpose. In particular the respondent referenced page 3, lines 9-10, page 5, lines 5-9, page 9, lines 6-8 and 28-31 and page 12, lines 5-9. In addition, there could be no intermediate generalisation as all the features required to achieve the insulating effect must, necessarily, be present in these claims.

- 4.3 At the oral proceedings the appellant argued that the intermediate generalisation was still present as there was no disclosure in the original application of an embodiment with a flat back surface and the general teaching of a plurality of protrusions configured to define an air gap.
- 4.4 The Board does not doubt that the passages of the description cited by the respondent disclose that the protrusions space the wrapper from the outer surface of the pack to create an air gap. However, the unallowable intermediate generalisation detailed in point 1.6 above is still present in auxiliary requests 4 and 5 as the specific features of the protrusions which the skilled person understands as being inextricably linked with the flat back surface in the first embodiment are still not found in amended claim 1 of either request.
- 4.5 Auxiliary requests 4 and 5 therefore do not fulfil the requirements of Article 123(2) EPC and are not allowable.

Auxiliary requests 6 to 9

5. *Article 123(2) EPC*

- 5.1 The amendments made to auxiliary requests 6 to 9 also do not overcome the objection discussed above (point 1.6) in relation to the main request.

The features of the first embodiment disclosed on page 10, lines 6-7 (the protrusions are of the same height and in sufficient numbers) and page 8, line 18 to page 9, line 5 (shape, size, arrangement, location and

number) are inextricably linked with the flat back side and essential for obtaining the desired result in the first embodiment.

- 5.2 Auxiliary requests 6 to 9 therefore also do not fulfil the requirements of Article 123(2) EPC and are not allowable.

Auxiliary request 10

6. *Admittance into the proceedings*

- 6.1 The respondent filed a new auxiliary request 10 with its submissions of 8 January 2021. The respondent argued, at the oral proceedings before the Board, that the new auxiliary request should be admitted as it was filed in reaction to the preliminary opinion of the Board of 29 October 2020. In particular, the second and third paragraphs of page 9 of the opinion implied that the features of the protrusions being of the same diameter and generally circular and convex in shape were not necessary to overcome the objection under Article 123(2) EPC raised by the appellant against claim 1 of the main request.

The respondent argued that the indication in this passage of the preliminary opinion constituted exceptional circumstances as required by Article 13(2) RPBA 2020.

- 6.2 At the oral proceedings before the Board, the appellant argued that the passage of the Board's preliminary opinion cited by the respondent related to a summary of the appellant's arguments made in its statement setting out the grounds of appeal.

6.3 The Board finds that, contrary to the requirements of Article 13(2) RPBA 2020, no exceptional circumstances exist which would warrant the taking into account of the new request. The respondent submitted the new auxiliary request in order to overcome an objection that had already been raised by the appellant with the statement setting out the grounds of appeal. In its preliminary opinion, the Board merely agreed with the arguments of the appellant.

The respondent therefore could and should have formulated auxiliary request 10 in reply thereto, in a timely manner, before the Board had given its preliminary opinion.

Therefore no exceptional circumstances are present and auxiliary request 10 is not admitted into the proceedings (Article 13(2) RPBA 2020).

Auxiliary request 11

7. In its communication under Article 15(1) RPBA 2020 the Board had indicated that auxiliary request 10, corresponding to auxiliary request 11 filed on 8 January 2021, appeared to be allowable. In the absence of any subsequent objections from the appellant to the claims of auxiliary request 11, the Board has no reason to depart from this view.

8. *Admittance into the proceedings of documents D16 and D17*

In the light of the above findings, it is not necessary for the Board to consider whether or not documents D16 and D17 should be admitted into the proceedings.

Order

For these reasons it is decided that:

1. **The decision under appeal is set aside.**
2. **The case is remitted to the department of first instance with the order to maintain the patent in amended form on the basis of the claims of auxiliary request 11 filed with the letter of 8 January 2021, and a description to be adapted.**

The Registrar:

The Chairman:



G. Nachtigall

V. Bevilacqua

Decision electronically authenticated