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**Datasheet for the decision
of 22 February 2021**

Case Number: T 1855/16 - 3.2.05

Application Number: 09724662.3

Publication Number: 2262633

IPC: B29C44/18, B60R13/08, B62D29/00

Language of the proceedings: EN

Title of invention:
Baffle

Patent Proprietor:
Sika Technology AG

Opponent:
L&L Products Europe S.A.S.

Relevant legal provisions:
EPC Art. 54(1), 54(2), 111(1)
RPBA Art. 12(2), 12(4)

Keyword:

Novelty - (main request, auxiliary requests 1, 3, 4, 6, 7: no)
Late-filed evidence - admitted (yes)
Remittal - (no)
Late-filed auxiliary requests - not admitted (auxiliary requests 2, 5, 8, 9: not substantiated) - admitted (auxiliary requests 3, 4; auxiliary requests 6, 7: resubmitted after withdrawal)

Decisions cited:

T 0557/94, T 1070/96, T 0908/07, T 0160/09, T 0936/09,
T 1525/10, T 1848/12, T 0568/14



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 1855/16 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 22 February 2021

Appellant:
(Patent Proprietor)

Sika Technology AG
Zugerstrasse 50
6340 Baar (CH)

Representative:

Isler, Jörg
c/o Sika Technology AG
Intellectual Property Department
Tüffenwies 16-22
Postfach
8048 Zürich (CH)

Respondent:
(Opponent)

L&L Products Europe S.A.S.
1 Rue Lindberg
ZA Activeum, Altorf
67129 Molsheim, cedex (FR)

Representative:

Wolff, Felix
Kutzenberger Wolff & Partner
Waidmarkt 11
50676 Köln (DE)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 17 June 2016
revoking European patent No. 2262633 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Lanz
Members: T. Vermeulen
A. Bacchin

Summary of Facts and Submissions

- I. The appeal was filed by the patent proprietor against the decision of the opposition division to revoke European patent No. 2 262 633 (hereinafter "the patent").
- II. In the impugned decision the opposition division came to the conclusion that neither the main request (patent as granted) nor the first to fifth auxiliary requests, submitted at the beginning of the oral proceedings in replacement of first, second and third auxiliary requests filed with letter dated 4 May 2016, were allowable. In particular, the subject-matter of claim 1 according to the main request and according to each of the first to the fourth auxiliary requests was considered to lack novelty in view of document

D1 EP 1 362 683 A2.

The subject-matter of claim 1 according to the fifth auxiliary request was found not to involve an inventive step when starting from document D1.

- III. Together with its reply to the statement setting out the grounds of appeal the respondent (opponent) filed following documents:

D10 JP 3748938 B2;

D11 translation of D10 into English;

D12 US 2005/0072116 A1.

- IV. Oral proceedings before the board were held by videoconference on 22 February 2021.

V. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, alternatively, that the patent be maintained in amended form on the basis of one of the auxiliary requests 1 to 9 filed with the statement setting out the grounds of appeal.

The respondent requested that the appeal be dismissed.

VI. Claim 1 of the main request has the following wording (the feature numbering used by the board is introduced in square brackets):

"**[M1]** A baffle (10) comprising: **[M2]** a body portion (12) having a first layer (14) and a second layer (16) defining a space (18) therebetween; **[M3]** a sealer (24) disposed on said body portion (12) in said space (18) between said first layer (14) and said second layer (16); characterized in that **[M4]** said sealer (24) is disposed on the first layer (14), the second layer (16), or both layers (14, 16), and **[M5]** said space (18) has a predetermined volume and said sealer (24) is expandable in said space (18)."

All the remaining claims including vehicle claims 8 to 14 comprise the features M1 to M5 and are therefore dependent on claim 1.

VII. The wording of claim 1 according to auxiliary requests 1 to 9 is as follows:

(a) Claim 1 of auxiliary request 1 corresponds to claim 1 of the main request with the additional feature:

"[**M6**] and the sealer (24) is disposed in the space (18) such that as the sealer (24) expands, the space (18) is filled by the sealer (24)".

- (b) Claim 1 of auxiliary request 2 corresponds to claim 1 of the main request with the additional feature:

"[**M6'**] and as the sealer (24) expands, the volume of the space (18) remains constant so that the sealer (24) may fill the space (18)".

- (c) Claim 1 of auxiliary request 3 corresponds to claim 1 of the main request except for following amendments in feature **M4**:

"[**M4'**] said sealer (24) is disposed on the first layer (14), or the second layer (16), ~~or both layers (14, 16),~~ and".

- (d) Claim 1 of auxiliary request 4 corresponds to claim 1 of auxiliary request 3 with the additional feature **M6**.

- (e) Claim 1 of auxiliary request 5 corresponds to claim 1 of auxiliary request 3 with the additional feature **M6'**.

- (f) Claim 1 of auxiliary request 6 corresponds to claim 1 of the main request except for following amendments in feature **M4**:

"[**M4''**] said sealer (24) is disposed only on the first layer (14), or only on the second layer (16), ~~or both layers (14, 16),~~ and".

(g) Claim 1 of auxiliary request 7 corresponds to claim 1 of auxiliary request 6 with the additional feature **M6**.

(h) Claim 1 of auxiliary request 8 corresponds to claim 1 of auxiliary request 6 with the additional feature **M6'**.

(i) Claim 1 of auxiliary request 9 corresponds to claim 1 of the main request with the additional features:

"[**M7**] wherein at least a portion of said first layer (14) and said second layer (16) are planar and at least a portion of said first layer (14) is parallel to at least a portion of said second layer (16), [**M8**] wherein the first layer (14) and the second layer (16) are spaced at any distance at or between 2 mm and 150 mm".

VIII. The appellant's submissions may be summarised as follows:

Main request - novelty in view of document D1

It was not possible for an expandable material to expand in a space with a predetermined volume, when the expandable material completely occupied that space already before its expansion. Document D1 disclosed a sealer expanding in an unpredictable manner through openings in the upper and lower layers into a space without a predetermined volume. As a consequence, feature M5 was not disclosed by document D1. The subject-matter of claim 1 according to the main request was therefore novel over document D1.

Admittance of documents D10 to D12

Documents D10, D11 and D12 were not submitted during the opposition period. Hence, they were late-filed and should not be admitted by the board. The respondent did not argue why these documents were not presented in the proceedings before the opposition division. This was all the more important as the main request had remained unchanged since the beginning of the opposition proceedings. Also the features of the auxiliary requests could not have surprised the respondent, since they were already submitted and discussed during the first-instance proceedings. Nor could the respondent invoke the preliminary opinion of the opposition division, which was not binding on the outcome of the opposition proceedings, as an excuse to having refrained from submitting further prior art they deemed relevant in preparation to the oral proceedings.

The appeal proceedings served to review the decision taken by the opposition division. The respondent's attempt to deprive the appellant of the opportunity to have the late-filed documents considered at two instances amounted to a procedural abuse. Introducing these documents would also have as a consequence that the subject of the appeal proceedings did not relate any longer to that of the first-instance proceedings.

Further, none of the late-filed documents could be considered as *prima facie* relevant for the claimed subject-matter. Document D10 and its translation D11 disclosed two different expandable materials, each preventing the other material to fill the predetermined volume. Material 15 did not have the function of a sealer in the sense of the contested patent, since it failed to seal off the space between the plates 12. The

second material 16 expanded outside the space between the plates 12. Document D12, on the other hand, did not clearly demonstrate whether the sealer expanded in the space with a predetermined volume defined between the two layers.

Request for remittal

If documents D10 to D12 were admitted into the appeal proceedings, the case should be remitted to the first instance in order not to deprive the parties of their right to have the issue heard before two instances. The interpretation of feature M5 was clearly a deciding issue; it had to be construed for all prior art documents in the proceedings, including for D10 and D12. Therefore, it would amount to a procedural abuse not to have the full case considered at two instances.

Main request - novelty in view of documents D10 to D12

Document D10, on the one hand, related to a method to block cavities by means of two materials 15 and 16 with different foaming properties. The first material 15 did not seal off the cavity and could, therefore, not be considered as a sealer in the sense of the patent. The second material 16 expanded in particular outside of the space between the layers. Each material prevented the other material from expanding in the predetermined volume. Hence, feature M5 was not disclosed by document D10. If both materials 15 and 16 together were taken to form the sealer, also the feature M4 would not be disclosed.

Figure 4 of document D12, on the other hand, was merely a fragmentary view of a baffle. It did not clearly demonstrate whether the sealer expanded in the space

with a predetermined volume defined between the two layers. Figures 1 and 2 of document D12 suggested that the foamable material had the same base area as the first half-shell so that it would appear that the material expanded outside of the space between the layers.

Auxiliary request 1 - novelty in view of documents D10 to D12

In view of the definition of "space" in feature M2 and the formulation "such that ... the space (18) is filled" in feature M6, the only possible understanding was that the space between the layers must be completely filled. Furthermore, the expression "by the sealer" in feature M6 meant that a second sealer could not come into play.

In document D10, the entire space defined between the layers 12 must be considered. Because of the presence of two foam material 15 and 16 between the layers, expansion in the entire space was not possible.

The upper layer 1 in document D12 was not flat, but formed separate compartments. It was unclear, even improbable, whether all these compartments were filled by the sealer. Ribs placed at intermediate positions could, for example, prevented the expansion throughout the gap.

Admittance of auxiliary requests 2 to 9

The grounds of appeal contained a general reference to the argumentation provided in regard of similar requests in the opposition proceedings. In view of the

new documents filed and admitted in the appeal proceedings, fall-back positions should be allowed. Claim 1 of auxiliary request 2 was filed in response to an interpretation of document D6. Auxiliary request 3 corresponded to the fourth auxiliary request filed at the oral proceedings before the opposition division. In claim 1 of auxiliary request 3, the alternative arrangement of the sealer on both layers was deleted. The reasoning provided in point 4.2.4 of the decision under appeal in regard to the interpretation of "or" in feature M4' and to meaning of "spot deposition" in paragraph [0021] of document D1 was not correct. Claim 1 of auxiliary request 6 comprised the amended feature M4", in respect of which the opposition division had taken a decision in the context of the fifth auxiliary request filed at the oral proceedings. Their assumptions regarding the weight saving of the baffle in function of the arrangement of the sealer on one vs. on both layers could, however, not be followed. Also the opposition division's view on the possible alternative solutions to save weight was not convincing. The solution offered by feature M4" was not plausible and therefore not obvious. The subject-matter of claim 1 according to auxiliary request 9 was limited by including a specific distance between the layers, which was not disclosed in document D10 or D12.

Auxiliary requests 3, 4, 6, 7 - novelty in view of documents D10 to D12

The sealer 15 in document D10 was disposed on both layers 12, contrary to what was claimed in auxiliary requests 3, 4, 6 and 7. Figure 4 of document D12 showed only a fragmentary view of the baffle. It was therefore not clear how the expanded sealer would be arranged in the entire baffle. For these reasons, the subject-

matter claimed in auxiliary requests 3, 4, 6 and 7 was new.

IX. The respondent argued essentially as follows:

Main request - novelty in view of document D1

The subject-matter of claim 1 according to the main request was not novel with respect to document D1. Reference was made to the reasoning of the decision under appeal. The term "expandable" implied that the material of the sealer had not yet expanded.

Admittance of documents D10 to D12

In view of its *prima facie* relevance for the present case, particularly for the appellant's interpretation of feature M5, document D10 and its translation D11 should be admitted into the appeal proceedings. Document D10 was also relevant for the auxiliary requests. The admission of patent document D12 was also requested for the reason that it was *prima facie* highly relevant for the present case, particularly for the auxiliary requests calling for the sealer being on one or only one of the layers. Therefore, the new evidence was advanced in reaction to the line of argumentation of the appellant, to the auxiliary requests filed and to the impugned decision. A further consideration for the admittance of documents D10 to D12 must be that the preliminary opinion of the opposition division was very favourable for the respondent, that three auxiliary requests were filed with letter dated 4 May 2016, i.e. only one month in advance of the oral proceedings held before the opposition division, that they were replaced by five new auxiliary requests at the oral proceedings and that only document D1 was discussed in the impugned

decision. As a consequence, there existed a need for the respondent to carry out an additional search to cover the features of the auxiliary requests. Documents D10 to D12 were submitted right at the beginning of the appeal proceedings so that the appellant had time enough to familiarize themselves with their content.

Request for remittal

There was no need to remit the case. Not only documents D10 to D12, but also documents D2 to D8, which had already been discussed in the notice of opposition, were very relevant. If the argumentation of the appellant were correct, the case should also be remitted for examining the claims of the main request in view of documents D2 to D8, which were not even mentioned in the decision under appeal. A remittal would result in a substantial delay in the procedure. For "courtesy reasons", a remittal could be consented to, but only for the sake of discussing documents D10 to D12.

Main request - novelty in view of documents D10 to D12

In document D10 the expandable material 16 used for performing the function of a sealer was only disposed on the left layer. Before expansion, a free space was provided between the two layers 12. The sealer was expandable in the space formed between the two layers. Hence, all features of claim 1 were known from document D10. The additional requirements that only one sealer should be used and that the space between the layers should be completely filled were not part of claim 1 nor were they brought forward before. It was noted that the word space used in paragraph [0008] of the published application that led to the patent had an

entirely different meaning. Due to the use of the word "comprising" in claim 1, other additional sealing materials could be foreseen between the layers. This also followed from the statement in paragraph [0018] of the patent, according to which the use of singular articles such as "a" did not exclude more of the indicated elements.

Figure 4 of document D12 clearly showed that the heat expansible sealer material 8 was provided on the first half shell 9 leaving a free space between the shells, which was subsequently filled by the sealer during its expansion. Even if this was not required by claim 1, the expansion of material 8 caused the space between the shells to be completely filled.

Auxiliary request 1 - novelty in view of documents D10 to D12

From Figures 1 and 2 of document D10 it clearly followed that the sealer 15, 16 filled the space between the two plates 12 while it expanded. Initially, there was a free space between the two sidewalls, which was filled during expansion of the sealer.

Figure 4 of document D12 clearly showed that the sealer 8 filled the space between the half-shells 1 and 9 while it expanded, see paragraph [0029].

Admittance of auxiliary requests 2 to 9

Auxiliary requests 2 and 3 were not admissible, because they had not been presented before and included claims that were not converging relative to auxiliary request 1. Regarding auxiliary request 3, it was not clear how its claim 1 narrowed and distinguished over the main

request, particularly when considering that it purported to differ from auxiliary request 6. Moreover, if the appellant intended that the wording of feature M4' covered that the sealer was "only" on one of the layers, the scope of claim 1 was identical to that of claim 1 according to the first auxiliary request filed with letter dated 4 May 2016 and later withdrawn. Auxiliary requests that were withdrawn could not be re-admitted on appeal (cf. T 1525/10 and T 936/09). This also applied for auxiliary request 4, which could be considered to correspond to the second auxiliary request filed with letter dated 4 May 2016 and later withdrawn. Auxiliary requests 6 and 7 were identical to the first and second auxiliary requests, respectively, filed with letter dated 4 May 2016 and later withdrawn. They should not be re-admitted. Also auxiliary requests 8 and 9 were not substantiated. The appellant failed to indicate which objections were meant to be overcome by the amendments in the auxiliary requests. Documents D10 to D12 were filed with the reply to the grounds of appeal. The appellant had, however, not seen the need to substantiate the auxiliary requests. A substantiation during the oral proceedings was considered too late.

Auxiliary requests 3, 4, 6, 7 - novelty in view of documents D10 to D12

Both documents D10 and D12 took away the novelty of the subject-matter of claim 1 according to auxiliary requests 3, 4, 6 and 7. Figure 2 of document D10 disclosed that sealer 16 was disposed only on the left plate 12, whereas Figure 4 of document D12 disclosed that the sealer 8 was disposed only on the half-shell 9. Thus, the subject-matter claimed in auxiliary requests 3, 4, 6 and 7 lacked novelty.

Reasons for the Decision

1. Main request - novelty in view of document D1
 - 1.1 In the case at hand, the question whether the subject-matter of claim 1 according to the main request is new over document D1 hinges to a great extent on the understanding of feature M5, i.e. under which circumstances a sealer can expand in a space with a predetermined volume, which is defined between a first and a second layer. The appellant adopts the approach that an expandable material completely occupying a space with a predetermined volume cannot expand in that space. The respondent takes the contrasting view also held by the opposition division in point 4.1 of the reasons for the decision under appeal: if a sealer is expandable and it is in a space, it is expandable in said space.
 - 1.2 In the present context, the term "expandable" has the meaning "that can be caused to fill a larger space; that can be dilated or enlarged" (Oxford English Dictionary). The board therefore concludes that it is imperative for a sealer disposed in a space (feature M3), in order for it to be expandable in that space (feature M5, emphasis added), that the sealer can dilate and, hence, occupy a larger volume within the space. In other words, the initial volume occupied by the sealer in the space before its expansion must be less than the predetermined volume of the space defined in feature M5. The board further notes that the wording of feature M2 ("defining a space", emphasis added) leaves it open whether or not the space should occupy

the entire physical extent between the first and second layers.

1.3 The baffle of document D1 comprises a foamable material sandwiched between two superimposed plates. Figure 4A shows how the sealer formed by the foamable material 13 projects from both ends of the plates or layers 1 and 2 in the unexpanded state. Upon heat activation, the foamable material 13 expands through the holes 3 and 4 outside of the space between the layers (Figures 4B and 4C). It can therefore be assumed that already before the expansion the entire space defined between the layers is occupied by the sealer.

1.4 In view of the above interpretation of feature M5, the board arrives at the conclusion that the sealer of the prior art baffle disclosed by document D1 is not expandable in a space between the layers. Therefore, document D1 does not take away the novelty of the subject-matter of claim 1 (Article 54(1) and (2) EPC).

2. Admittance of documents D10 to D12

2.1 Document D10, its translation into English D11 and document D12 were filed with the reply to the statement of grounds of appeal.

2.2 The admission of submissions filed for the first time in the statement setting out the grounds of appeal or in the written reply thereto is governed by Article 12(4) of the Rules of Procedure of the Boards of Appeal in its version of 2007 (RPBA 2007), which applies in the present case according to Articles 24 and 25(2) of the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020). Following this provision, the board has the power to hold inadmissible facts,

evidence or requests which could have been presented or were not admitted in the first-instance proceedings.

2.3 It clearly emanates from the case history that documents D10 to D12, two patent documents and a translation of one of them into English, could have been filed during the proceedings leading to the decision under appeal. Not only did the claims of the main request remain unchanged during the opposition proceedings, claim 1 of each of the three auxiliary requests filed with letter dated 4 May 2016 in preparation for the oral proceedings held before the opposition division already included feature M4". The respondent can therefore not invoke the additional requirement posed by some of the auxiliary requests filed with the statement setting out the grounds of appeal, namely that the sealer is disposed "only on the first layer (14) or only on the second layer (16)", as a justification for submitting the evidence D12 only at the appeal stage. Similarly, the second auxiliary request filed with letter dated 4 May 2016 and the subsequent submission of the respondent with letter dated 6 May 2016 show that the interpretation of feature M5 was already an issue during preparation for the oral proceedings before the opposition division. The argument of the respondent that document D10 and its translation D11 were filed in reaction to that interpretation is therefore not convincing.

2.4 Nonetheless, the fact that a document could have been filed during the proceedings leading to the appealed decision does not automatically render it inadmissible. The crucial question is in fact whether the party *should* have submitted that document at first instance under the circumstances (see also T 1848/12, point 1.2.4 of the reasons). In the present case, the

communication of the opposition division annexed to the summons for oral proceedings set out, albeit in a very concise way, their preliminary opinion that document D1 comprised all features of claim 1 of the main request. In view thereof, the respondent could not have reasonably been expected to submit further prior art documents, even if this would arguably have been justified by the appellant's reaction to file three auxiliary requests one month before the date of the oral proceedings. Nor could the respondent have anticipated the course of action of the appellant, who substituted the three auxiliary requests by five new auxiliary requests during the oral proceedings leading to the decision under appeal. Against this background and taking account of a total of nine new auxiliary requests filed with the statement setting out the grounds of appeal, the submission of documents D10 to D12 can be seen as a justified reaction of the respondent to developments in the procedure at the earliest possible opportunity, i.e. with the reply to the grounds of appeal.

- 2.5 The board further takes account of the fact that the opposition division in the impugned decision chose to examine the novelty of the subject-matter of claim 1 according to the main request only in view of document D1. Neither the terse reasoning given in the communication annexed to the summons for oral proceedings nor the decision under appeal addresses any of the novelty objections over documents D2 to D8 presented in the notice of opposition. It cannot be held against the respondent that they attempted to underpin their arguments in respect of the main request by citing two further documents with the reply to the grounds of appeal for the case that the board would come to a different conclusion in view of document D1.

2.6 Moreover, a glance at the figures of patent documents D10 and D12, both of which relate to acoustic baffles for isolating cavities in motor vehicles, reveals that an expandable material is placed in a space between two layers. Unlike document D1, the expandable material does not seem to occupy the entire space defined between the layers. This speaks for their *prima facie* high relevance.

2.7 On account of all circumstances, the board admits documents D10 to D12 into the proceedings (Article 12(4) RPBA 2007).

3. Request for remittal

3.1 The appellant requested to remit the case to the first instance in case documents D10 to D12 were admitted into the appeal proceedings.

3.2 Article 111(1), second sentence, EPC leaves it to the board's discretion to decide on the appeal either by exercising any power conferred on the department of first instance or by remitting the case to that department. The appropriateness of remittal to the department of first instance is thus a matter for decision by the board, which assesses each case on its merits. In the exercise of its discretion a board takes due account of several factors, *inter alia* the need for procedural economy and whether the new submissions in appeal result in a "fresh case". It is established case law that this provision does not imply an absolute right to have an issue decided on at two instances (cf. Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019, in the following "Case Law", V.A.7.2.1).

Under Article 11 RPBA 2020, which applies here in view of Articles 24 and 25(1) RPBA 2020, a board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. The explanatory remarks (see Supplementary publication 2, OJ EPO 2020, 54) contain the following guidance:

- The aim of the new provision is to reduce the likelihood of a "ping-pong" effect between the Boards and the departments of first instance, and a consequent undue prolongation of the entire proceedings before the EPO. When exercising its discretion under Article 111 EPC, the Board should take account of this aim.
- Whether "special reasons" present themselves is to be decided on a case-by-case basis. If all issues can be decided without an undue burden, a Board should normally not remit the case.

3.3 Applying these principles to the present case, the board arrives at following considerations.

The opposition division had based their decision to reject the main request solely on an objection of lack of novelty in view of document D1. Their reasoning hinged on a broad interpretation of feature M5 (see point 4.1 of the reasons for the decision under appeal). The board disagrees with this interpretation and, instead, concurs with the appellant that feature M5 of claim 1 according to the main request underlying the impugned decision should be read more narrowly (see point 1.2 above). This has led to the conclusion that document D1 does not anticipate the claimed subject-matter (see point 1.4 above). Documents D10 to D12, on the other hand, do seem to disclose feature M5 in its

more restricted reading and are therefore, on the face of it, highly relevant (see point 2.6 above).

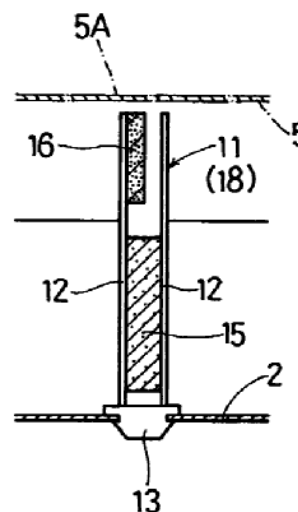
Article 111(2) EPC provides that, where a board of appeal remits a case for further prosecution to the department of first instance, that department is bound by the *ratio decidendi* of the board, in so far as the facts are the same. Remitting the present case for a discussion of novelty in view of documents D10 to D12 would therefore bind the opposition division to the board's conclusions on the interpretation of the claim wording and on the *prima facie* high relevance of documents D10 to D12. Given that it is clear which position the opposition division would be compelled to take on the relevant issue and in view of the further appeal which would likely result therefrom, it appears of little purpose to remit the case at this stage (cf. T 557/94, Reasons 1.3; T 1070/96, Reasons 4.3; T 908/07, Reasons 4.1; T 160/09, Reasons 1).

Furthermore, the relevant circumstances of the case at hand as outlined hereinbefore imply that a continuation of the appeal proceedings with an assessment of novelty in regard of documents D10 to D12 would not impose an undue burden. This is confirmed by the fact that the appellant already took position on the content of documents D10 to D12 in their letter dated 22 September 2017, more than three years before requesting the remittal. Remitting the case would therefore run counter to what was intended with Article 11 RPBA 2020.

- 3.4 In view of the above, the board exercises its discretion not to remit the case to the first-instance department at this stage (Article 111(1) EPC and Article 11 RPBA 2020).

4. Main request - novelty in view of documents D10 to D12

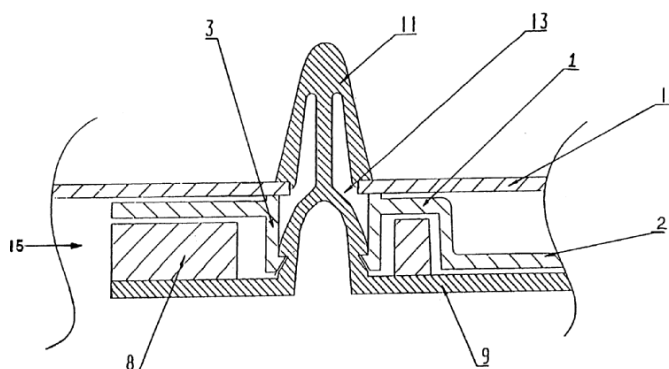
4.1 A baffle with a body portion having first and second layers is known from document D10, see Figure 3 and paragraphs [0001] and [0013] of the translation D11. In the cross-sectional view of Figure 2 of document D10, which is reproduced below, a foam material 15 is disposed on both layers 12 of the baffle and occupies an initial volume within the gap formed between the layers. The foam material 15 can be held to prevent the passage of gas or liquid through at least part of the gap and, hence, functions as a sealer. According to paragraph [0016] of the translation D11, the material 15 expands in reaction to a heating step. In the expanded state 15A shown in Figure 1 of document D10, the material occupies a larger volume still within the gap so that it is clearly expandable in a space of a predetermined volume defined between the layers. It is not without importance to note that the extent of the space defined in feature M2 is left entirely open in the wording of claim 1 (see point 1.2 above).



Whilst the baffle of document D10 comprises a second foam material 16 disposed in the gap between the layers 12, the first foam material 15 is not prevented from expanding, i.e. gaining in volume, within that gap. This follows clearly from the arrangement shown in Figure 2 of document D10, where sufficient free space is foreseen between the foam materials to allow the expansion of the first foam material 15.

Hence, the subject-matter of claim 1 according to the main request is not new in view of document D10 (Article 54(1) and (2) EPC).

4.2 Figure 4 of document D12 is reproduced below. It shows a cross-sectional view of a baffle composed of a heat-expansible element 8 placed between two layers: a lower half-shell 9 and an upper half-shell 1, see paragraph [0027]. When the heat-expansible element 8 disposed on the lower half-shell 9 undergoes a heating step, it expands in the gap 15 formed between the two half-shells, both upwards in direction of the upper half-shell 1 and sideways to fill in the free spaces that exist between the heat-expansible element and the inner contour 2, on the one hand, and between the heat-expansible element and the latching cylinders 3, on the other hand, see paragraphs [0025] und [0029].



The argument of the appellant that Figure 4 of document D12 was merely a fragmentary view, which did not reveal which part of the gap between the half-shells was eventually filled in the expanded state, does not dissuade the board from its conclusion that the expansion definitely takes place in a space of a predetermined volume defined between the half-shells. Claim 1 does not require that the *entire* space between the half-shells is filled (see point 1.2 above).

As a consequence, the subject-matter of claim 1 according to the main request also lacks novelty with respect to document D12 (Article 54 (1) and (2) EPC).

5. Auxiliary request 1 - novelty in view of documents D10 to D12

5.1 The additional feature M6 requires that the sealer is disposed in the space such that as the sealer expands, the space is filled by the sealer.

The board concurs with the respondent, that both documents D10 and D12 disclose a sealer that fills a space between the layers as it expands. As claim 1 does not impose any restriction on the space other than that it is defined between the first and the second layer (feature M2) and has a predetermined volume (feature M5), any volume enclosing the sealer in its unexpanded state with some free space would fulfill the requirement of feature M6. This is clear both from Figure 2 of document D10 and from Figure 4 of document D12.

The argument of the appellant that the volume occupied by the second sealer 16 in document D10 would prevent the first sealer 15 from filling the space between the layers is not convincing, as it is based on the assumption that the space defined in feature M2 of claim 1 must reflect the entire volume formed between the layers. In fact, the presence of the second foam material 16 in document D10 is irrelevant when it comes to filling a space between the layers with the first foam material 15.

The same applies to the separate compartments formed by the upper half-shell 1 in document D12: as long as the

heat-expansible element 8 expands and fills in a space between the half-shells, the requirement of feature M6 is met.

5.2 In view of the above, the board arrives at the conclusion that the subject-matter of claim 1 according to auxiliary request 1 is not new in view of document D10 or document D12 (Article 54(1) and (2) EPC).

6. Admittance of auxiliary requests 2 to 9

6.1 Auxiliary requests 2 to 9 were submitted with the statement setting out the grounds of appeal. The respondent has argued against admitting the auxiliary requests into the appeal proceedings.

Unsubstantiated requests (Auxiliary requests 2, 5, 8 and 9)

6.2 Article 12(4) RPBA 2007 requires the board to take into account everything presented by the parties under Article 12(1) RPBA 2007 if and to the extent that it relates to the case under appeal and meets the requirements in Article 12(2) RPBA 2007. If a party to the appeal proceedings fails to set out clearly and concisely the reasons why they request that the decision under appeal is reversed, amended or upheld, the requirements of Article 12(2) RPBA 2007 are not met and the corresponding submissions shall not be taken into account by the board.

6.3 The appellant has not provided reasons in the statement setting out their grounds of appeal or in the letter dated 22 September 2017 that explain why the claim amendments introduced with auxiliary requests 2, 4, 5, 7, 8 and 9 would overcome the objections raised in the

decision under appeal. The mere reference to argumentation presented in the first-instance proceedings is not sufficient, both because it does not take position on the reasons set out in the decision of the opposition division and because the subject-matter claimed in the new auxiliary requests was not filed before. Also in the letter dated 5 November 2020, which was filed in reaction to the preliminary opinion of the board issued on 28 October 2020, no explanation was given by the appellant despite an express statement to that effect in point 16 of the opinion.

- 6.4 In regard to auxiliary requests 2, 5 and 8 the amendments to claim 1 are not self-explanatory. In particular, feature M6', which appears in claim 1 of each of these requests (see point VII.(b), (e) and (h) above), was not claimed in any of the requests underlying the decision under appeal. The appellant's failure to address this amendment has left the board and the respondent in the dark as to the motives behind these requests. This is contrary to the requirements of Article 12(2) RPBA 2007.

At the oral proceedings before the board, the appellant referred to an unspecified interpretation of document D6 in the first-instance proceedings. Yet it does not transpire to the board how this can qualify as a substantiation of auxiliary requests 2, 5 and 8. Not only was document D6 left unmentioned by the opposition division, the appellant has not shed any light on a possible causal link between the additional feature M6' and the content of document D6. Nor can the board find in the entire case history an objection made by the respondent in view of document D6, that could have prompted the appellant to specify in claim 1 that the volume of the space remains constant.

6.5 Also the reasons behind the amendments carried out in claim 1 according to auxiliary request 9 are not immediately apparent to the board. In view of the conclusion of the opposition division in the context of the second and third auxiliary requests underlying the decision under appeal, that features M7 and M8 were known from document D1 (cf. points 4.2.2 and 4.2.3 of the reasons of the decision under appeal), it is a matter of speculation how auxiliary request 9 (cf. point VII.(i) above) addresses the objections raised in the decision under appeal. This runs counter to the principle of Article 12(2) RPBA 2007.

6.6 Regarding auxiliary requests 4 and 7, they correspond to a combination of auxiliary requests 3 and 6, respectively, with the additional feature M6 of auxiliary request 1 (cf. point VII.(d) and (g) above). The substantiation provided by the appellant in regard of auxiliary requests 1, 3 and 6 therefore carries over to auxiliary requests 4 and 7, which are therefore self-explanatory (cf. T 568/14, Reasons 8). Hence, the requirements of Article 12(2) RPBA 2007 are met for these requests.

6.7 In conclusion, the board does not admit auxiliary requests 2, 5, 8 and 9 into the proceedings under Article 12(4) RPBA 2007, as they do not meet the substantiation requirements of Article 12(2) RPBA 2007.

Resubmission of requests withdrawn during opposition proceedings (Auxiliary requests 6 and 7)

6.8 Auxiliary requests 6 and 7 correspond to the first and the second auxiliary request, respectively, filed with letter dated 4 May 2016 in preparation of the oral

proceedings before the opposition division. At the beginning of those oral proceedings, they were withdrawn and substituted by five new auxiliary requests.

- 6.9 The case law is clear that auxiliary requests that were filed but subsequently withdrawn during first-instance proceedings also fall under the category of requests that could have been presented in first-instance proceedings. A criterion often cited in this context is whether the withdrawal of the request has prevented the department of first instance from giving a reasoned decision on the critical issues, thereby compelling the board either to give a first ruling on those issues or to remit the case to the department of first instance (cf. "Case Law", V.A.4.11.3.f).
- 6.10 It is the board's view that auxiliary requests 6 and 7 do not amount to an entirely fresh case. The critical issue in the first auxiliary request filed with letter dated 4 May 2016 was whether the sealer was disposed only on the first layer or only on the second layer (feature M4"). Claim 1 of the second auxiliary request filed with letter dated 4 May 2016 merely differed from claim 1 of said first auxiliary request by the additional feature M6. Both issues were discussed at the oral proceedings and decided on by the opposition division, albeit in the context of different auxiliary requests (cf. points 4.2.5 and 4.2.1, respectively, of the reasons of the decision under appeal). The admission of auxiliary requests 6 and 7 would therefore not put the board in a position where it was forced to give a first ruling on the critical issues.
- 6.11 This was different in the case underlying T 1525/10, on which the respondent relies for its request not to re-

admit withdrawn claim requests in the appeal proceedings. In that decision, the board ruled that the withdrawal of the claim requests in opposition proceedings had appeared to be made with the intention of avoiding an adverse decision on novelty and inventive step (Reasons 2.2 and 2.3).

In T 936/09, also cited by the respondent, the patent proprietor filed a set of amended claims for the first time with its statement setting out the grounds of appeal, after having remained inactive in opposition proceedings that led to their patent being revoked. The board cannot see how this decision bears relevance on the question of re-admitting withdrawn requests.

- 6.12 Hence, the board does not see any reason not to admit auxiliary requests 6 and 7 into the appeal proceedings (Article 12(4) RPBA 2007).

Auxiliary requests 3 and 4

- 6.13 Claim 1 of both auxiliary requests 3 and 4 includes feature M4', which imposes the following condition:

"said sealer (24) is disposed on the first layer (14) or the second layer (16)".

- 6.14 The respondent argued that, inasmuch as the wording of feature M4' were construed similarly to feature M4" so that the sealer were disposed *only* on one of the layers, there would not be any difference in scope between the claims of auxiliary requests 3 and 4, on the one hand, and 6 and 7, on the other hand.

- 6.15 The board concurs with the respondent that there is room for interpretation of feature M4'. A case can be

made that, depending on whether an exclusive "or" or an inclusive "or" is used, feature M4' is to be construed as M4" ("only or") or as M4 ("or both layers"), so that the subject-matter of claim 1 of auxiliary requests 3 and 4 would be identical either to that of claim 1 of auxiliary requests 6 and 7, respectively, or to that of claim 1 of the main request and auxiliary request 1, respectively.

Yet for the purposes of admitting auxiliary requests under Article 12(4) RPBA 2007, consideration should also be given to the circumstances of the specific case. By filing the auxiliary requests at the beginning of the appeal proceedings, the appellant, who had lost before the opposition division, attempted to narrow down the claimed subject-matter with respect to the only document mentioned as relevant for novelty in the impugned decision. Considering that document D1 only discloses a sealer disposed on both layers, the appellant submitted auxiliary requests 3 and 4 with a modified feature M4' wherein the option "or both layers" was deleted. At the same time, the appellant strongly argued against the finding in point 4.2.4 of the reasons for the impugned decision that the amended feature M4' still did not exclude an arrangement of the sealer on both layers. As a further auxiliary measure, feature M4' was amended by adding the word "only" in auxiliary requests 6 and 7. In the opinion of the board, these successive amendments are clear attempts to formulate fall-back positions that converge relative to the subject-matter claimed in the main request and thus constitute developments of the approach taken by the appellant during the first instance.

6.16 In view of the foregoing, the board also admits auxiliary requests 3 and 4 into the appeal proceedings (Article 12(4) RPBA 2007).

7. Auxiliary requests 3, 4, 6, 7 - novelty in view of documents D10 to D12

7.1 The baffle shown in Figure 2 of document D10 has a sealer 15 disposed between and in contact with the left and the right layer 12 (cf. point 4.1 and 5.1 above). As set out in point 6.15 above, assuming that an inclusive "or" is claimed, this means that also feature M4' is disclosed by document D10.

7.2 In Figure 4 of document D12, on the other hand, the sealer 8 is disposed only on the lower half-shell 9 (cf. points 4.2 and 5.1 above).

7.3 Consequently, the subject-matter of claim 1 according to auxiliary requests 3 and 4 is not new in view of document D10 and D12, whereas document D12 takes away the novelty of the subject-matter of claim 1 according to auxiliary requests 6 and 7 (Article 54(1) and (2) EPC).

8. Conclusion

As none of the requests contains an allowable set of claims, the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated