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**Datasheet for the decision
of 19 July 2022**

Case Number: T 2179/16 - 3.3.02

Application Number: 10730191.3

Publication Number: 2453739

IPC: A01N25/04, A01N47/24,
A01N43/653, A01N43/56

Language of the proceedings: EN

Title of invention:

A PROCESS FOR PREPARING AN AQUEOUS SUSPENSION OF AN ORGANIC
PESTICIDE COMPOUND

Patent Proprietor:

BASF SE

Opponent:

Rotam Limited

Headword:

Relevant legal provisions:

EPC Art. 83, 56

RPBA Art. 12(2), 12(4)

Keyword:

Admittance - objections raised in appeal which had been raised against a different claim request before the opposition division

Admittance - unsubstantiated objection (added subject-matter and novelty)

Sufficiency of disclosure

Inventive step

Decisions cited:

T 0016/14, T 0087/15, T 0341/15, T 2730/16

Catchword:

Admittance of objections raised in appeal, said objections having been raised before the opposition division against a different claim request (point 4.3 of the Reasons)



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 2179/16 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 19 July 2022

Appellant: Rotam Limited
(Opponent) 26/F, E-Trade Plaza
24 Lee Chung Street
Chai Wan
Hong Kong (CN)

Representative: Akers, Noel James
N.J. Akers & Co
63 Lemon Street
Truro, Cornwall TR1 2PN (GB)

Respondent: BASF SE
(Patent Proprietor) Carl-Bosch-Strasse 38
67056 Ludwigshafen am Rhein (DE)

Representative: Reitstötter Kinzebach
Patentanwälte
Postfach 21 11 60
67011 Ludwigshafen (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
26 July 2016 concerning maintenance of the
European Patent No. 2453739 in amended form.**

Composition of the Board:

Chairman M. O. Müller
Members: P. O'Sullivan
P. de Heij

Summary of Facts and Submissions

I. The appeal of the opponent (hereinafter appellant) lies from the interlocutory decision of the opposition division according to which European patent 2 453 739 in amended form met the requirements of the EPC.

II. The following documents *inter alia* were cited in opposition proceedings:

D2: EP 0 548 028 A1

D6: US 5,624,884

D7: US 5,147,412

D8: US 6,338,742 B1

D9: US 2002/0128154 A1

D10: US 6,541,426 B1

D11: US 2008/0234350 A1

III. The contested decision is based, *inter alia*, on sets of claims of a main request (claims as granted) and a first auxiliary request. According to the decision, the invention defined in claim 1 of the main request was not sufficiently disclosed. The set of claims according to the first auxiliary request was found to be allowable, and in particular, to involve an inventive step over D10 as closest prior art.

IV. Requests relevant to the present proceedings

The appellant requested that the contested decision be set aside and the patent be revoked in its entirety.

The patent proprietor (hereinafter respondent) requested that the appeal be dismissed, implying maintenance of the patent on the basis of the (then)

first auxiliary request found allowable by the opposition division. In addition the respondent requested that the appeal be held inadmissible.

V. In preparation for oral proceedings, scheduled according to the parties' requests, the board issued a communication pursuant to Article 15(1) RPBA 2020. Therein the board provided the preliminary opinion that the appeal was admissible and that the objections of added subject-matter pursuant to Article 123(2) EPC and novelty pursuant to Article 54 EPC had not been substantiated by the appellant in appeal proceedings, and were thus not to be examined by the board. Furthermore, the subject-matter defined in the claims of the main request was sufficiently disclosed, and involved an inventive step over D10 as closest prior art. Finally, the preliminary view was expressed that the further inventive step objections raised in the appellant's statement of grounds of appeal were not to be admitted into appeal proceedings pursuant to Article 12(4) RPBA 2007.

VI. The appellant's submissions insofar as relevant to the present decision can be summarised as follows:

Main request

Articles 123(2) and 54 EPC - Admittance

- the reference in the statement of grounds of appeal to the objections submitted with the notice of opposition were sufficient. Thus these objections were to be admitted into appeal proceedings.

Sufficiency of disclosure

- The invention defined in claim 1 was not disclosed in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art.

Inventive step (Article 56 EPC)

- The subject-matter of claim 1 lacked inventive step starting at D10 as closest prior art.
- The further objections starting from the common general knowledge referred to in the patent, paragraph [0005] as closest prior art, D2 as closest prior art, D6 to D8 as closest prior art, and D9 or D11 as closest prior art, were to be admitted into the appeal proceedings.

VII. The respondent's submissions insofar as relevant to the present decision can be summarised as follows:

Articles 123(2) and 54 EPC - Admittance

- The appellant's objection in this regard were late filed and not to be admitted into appeal proceedings.

Sufficiency of disclosure

- The invention defined in claim 1 was disclosed in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art.

Inventive step (Article 56 EPC)

- The subject-matter of claim 1 involved an inventive step starting at D10 as closest prior art.

Reasons for the Decision

1. Admissibility of the appeal

The respondent took the view that the appeal was inadmissible for lack of substantiation. The board came to the conclusion that the appeal met the requirements of Article 108 EPC in combination with Rule 99(2) EPC and was admissible. In view of the outcome of the appeal, reasons for holding the appeal admissible are not required.

Main request

The set of claims of the main request corresponds to that of the first auxiliary request found allowable by the opposition division, annexed to the contested decision.

2. Admittance - Added subject-matter (Article 123(2) EPC)

- 2.1 In its decision, the opposition division explained why it considered the then first auxiliary request (present main request) to meet the requirements of Article 123(2) EPC (page 9, *"Added subject-matter, Article 123(2) EPC"*), with back-reference to the section *"Extension of subject-matter beyond the content of the application as originally filed,*

Art. 123(2) EPC", starting on page 2 of the contested decision.

- 2.2 The appellant's statement of grounds of appeal, in relation to added subject-matter (page 4, "D"), solely comprised the following statement:

"We refer to the submissions set out in the Statement of Grounds of Opposition and have nothing further to add on this ground at this time."

- 2.3 The respondent in written proceedings submitted that the objection pursuant to Article 123(2) EPC was late filed and was not to be admitted into appeal proceedings.

Pursuant to Article 12(4) RPBA 2007, applicable to the appellant's statement of grounds of appeal pursuant to Article 24 and 25(2) RPBA 2020, everything presented in the statement of grounds of appeal and the reply is taken into account, if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA 2007. According to Article 12(2) RPBA 2007 (which corresponds substantially to Article 12(3) RPBA 2020), the statement of grounds of appeal shall contain a party's complete appeal case, i.e. shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should **specify expressly** all the facts arguments and evidence relied on.

It is established case law that a mere general reference to a party's submissions in the proceedings before the opposition division is not sufficient to meet this requirement (see for example T 16/14, points

3.1 and 3.2 of the Reasons). As set out in the board's communication pursuant to Article 15(1) RPBA 2020 (section 2.1), the appellant did not address the opposition division's decision at all (see point 2.1 above), thereby preventing the board from understanding why the appellant considered this decision to be incorrect in relation to the present main request.

This is all the more the case since the objection in the notice of opposition (Section D, pages 4-5) concerning added subject-matter for claim 1 of the patent as granted is irrelevant to claim 1 of the present main request. Specifically, this objection concerned the presence in step a) of the feature "solid amorphous form". Since this feature is deleted from claim 1 of the present main request, it is thus self-explanatory that the objection has been rendered moot, with the consequence that said objection cannot explain why the contested decision was incorrect in relation to the present main request. For the same reason, the appellant's justification for admitting said objection, namely because of the very brief reasons provided by the opposition division with regard to added subject-matter in claim 1 of the (then) main request (contested decision, page 5, first full paragraph), cannot be accepted. Specifically, said reasons are not relevant to claim 1 of the present main request. Rather, the part of the contested decision relevant to the present main request is set out on page 9 thereof, and no explanation as to why the decision is incorrect in this regard has been submitted.

The obligation is on the appellant, in line with Article 12(2) RPBA 2007, to set out clearly and concisely the reasons why, and to specify expressly all

the facts arguments and evidence relied on. The appellant failed in this regard.

The appellant's objections under Article 123(2) EPC were thus not examined by the board pursuant to Article 12(4) RPBA 2007.

2.4 Admittance - Novelty (Article 54 EPC)

In its decision, the opposition division acknowledged novelty of the then first auxiliary request (present main request) (section "*Novelty, Art. 54 EPC*", pages 10-11).

In relation to the objection of lack of novelty, the appellant's statement of grounds of appeal (page 7, point 1) merely refers back to submissions set out in the notice of opposition.

The respondent in written proceeding submitted that this ground was late filed and was not to be admitted into appeal proceedings.

According to the contested decision, novelty of the subject-matter of the then first auxiliary request (present main request) was acknowledged vis à vis D2.

As set out above, Article 12(2) RPBA 2007 requires that the statement of grounds of appeal shall contain a party's complete appeal case, i.e. shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts arguments and evidence relied on.

This requirement is not fulfilled with regard to the novelty of the claimed subject-matter.

Hence, for the same reasons as provided above for added subject-matter, the appellant's objections under Article 54 EPC were not examined by the board pursuant to Article 12(4) RPBA 2007.

3. Sufficiency of disclosure

3.1 Claim 1 of the main request reads as follows:

"1. A process for preparing an aqueous suspension of an organic pesticide compound, which has a solubility in water of not more than 2 g/l at 20°C and a melting point of not more than 110°C and which is capable of forming at least one crystalline form, wherein the organic pesticide compound is present in the form of essentially crystalline particles and wherein [sic] at least 90 % of the pesticide compound, which is present in the aqueous suspension, is in the crystalline state, which process comprises:

a) providing an aqueous emulsion of the organic pesticide compound, wherein the organic pesticide compound is present in the form of droplets of an amorphous form of the organic pesticide compound, where the amorphous form is a melt or a supercooled melt, and

b) addition of an aqueous suspension of said organic pesticide compound, wherein the organic pesticide compound is present in the form of essentially crystalline particles, wherein at least 90 % of the pesticide compound, which is present in the aqueous suspension, is in the crystalline state,

wherein the addition in step b) is performed at a temperature below the melting temperature of the crystalline form of the organic pesticide compound and where the relative amounts of the aqueous suspension, which is added in step b), and the aqueous emulsion is chosen such that the amount of the organic pesticide compound contained in the aqueous suspension is from 0.01 to 0.3 part by weight, per 1 part by weight of the pesticide compound contained in the aqueous emulsion,

where the concentration of the organic pesticide compound in the aqueous emulsion is from 10 to 50 % by weight,

and where the concentration of the organic pesticide compound in the aqueous suspension, which is added in step b), is from 1 to 60 % by weight."

3.2 The appellant submitted that the invention defined in claim 1 was not disclosed in a manner sufficiently clear and complete for it to be carried out by the skilled person. Specifically,

- the broad definition for the organic pesticide compounds led to undue burden for the skilled person;
- claim 1 included embodiments in which a surfactant was not required; there was no evidence that such a process would work; and
- claim 1 in combination with claim 4 indicated that claim 1 covered embodiments carried out below the freezing point of water, for which the patent did not comprise any teaching.

Each of these aspects will be addressed in turn in the following.

3.3 The organic pesticide compound

According to contested claim 1, the organic pesticide compound is defined by the following physical characteristics:

- its solubility in water is not more than 2 g/l at 20°C
- its melting point is not more than 110°C,
- it is capable of forming at least one crystalline form.

3.3.1 It was argued that contested claim 1 not only covered known pesticide compounds, but also encompassed pesticide compounds yet to be discovered, and possessing the physical properties recited. Specifically, it was argued that the determination of whether a particular compound existed in at least one crystalline form was a significant and non-trivial undertaking for which the skilled person would be faced with undue burden.

3.3.2 The board's view is as follows. Claim 1 sets out the above three physical requirements for the organic pesticide compound, namely that it has a certain solubility in water, an upper limit for its melting point, and that it is capable of forming at least one crystalline form. The process has been demonstrated in the examples of the patent for one such organic pesticide, pyraclostrobin, having the required physical characteristics. Since said physical characteristics of organic pesticides are either well known and documented, or alternatively are easily determined through routine experimentation, there is no undue burden for the skilled person to identify further

organic pesticides for which the claimed process would be suitable, at least insofar as known organic pesticides known to exist in a crystalline form are concerned.

3.3.3 With regard to whether the skilled person would be faced with undue burden to determine whether a particular compound exists in at least one crystalline form, the board holds the following view. The invention as defined in claim 1 concerns the concept that an aqueous suspension can be prepared from compounds having the physical properties recited. The implication is that in order to carry out the process of claim 1, it is not required to investigate whether a crystalline form of a known or yet to be discovered compound may be prepared. Rather, all that is needed for the requirement of sufficiency of disclosure to be fulfilled is that the skilled person, using common general knowledge and the information in the patent, is capable of carrying out the process for compounds once the physical criteria set out above are or will have been established.

3.3.4 It was also argued that it was not credible that all compounds meeting the physical criteria set out in claim 1 behaved in an identical manner, with the consequence that it was also not credible that the process of claim 1 would work for all such compounds. This held in particular because the claimed process had only been demonstrated for a single organic pesticide compound (pyraclostrobin). The burden of proof in this regard lay with the respondent.

3.3.5 The board disagrees. There is neither credible argument nor evidence on file, nor can the board see any reasons apparent, which would cast doubt on whether the process

of contested claim 1 can indeed be carried out for organic pesticides meeting the physical requirements of claim 1. Consequently, the argument that the claimed process may not work for some organic pesticides covered by claim 1 amounts to an unsubstantiated allegation, and hence must fail.

3.4 The surfactant

3.4.1 The appellant noted that although the presence of a surfactant in the aqueous emulsion was not required by contested claim 1, step a), all of the examples of the patent employed surfactants. It was generally known that surfactants were required to stabilise aqueous suspensions. Hence, a surfactant was essential, or at the very least, there was a serious doubt as to whether the claimed process could be carried out without employing a surfactant. The burden of proof in this regard lay with the respondent.

3.4.2 In a similar manner to that set out above with regard to the organic pesticide compound, the argument that the claimed process will not work without a surfactant represents an unsubstantiated allegation. As noted by the respondent, the skilled person can determine by routine trial-and-error experimentation whether a surfactant is required to prepare an aqueous emulsion according to contested claim 1. It is also technically credible, as stated by the respondent, that in certain instances stabilisation with a surfactant may not be required, such as in the case of self-emulsifying amphoteric substances. The appellant's arguments in this regard hence must also fail.

3.5 The temperature

3.5.1 Contested claim 1 requires that the addition in step b) of an aqueous suspension to the emulsion provided in step a) is performed at a temperature below the melting temperature of the crystalline form of the organic pesticide compound. Dependent claim 4 in turn requires said addition to be performed at a temperature of 10 to 60K below the melting point of the crystalline form.

3.5.2 The appellant argued that since many organic pesticide compounds, including pyraclostrobin, the sole exemplified pesticide, had melting points below 60°C (patent, table in paragraph [0024]), claim 1 covered embodiments for which the temperature of addition in step b) was below 0°C. At those temperatures the aqueous suspension employed in step b) would be a frozen solid, which would in turn cause freezing of the entire mixture upon addition, thus not resulting in an aqueous suspension as required by claim 1. Hence claim 1 was not sufficiently disclosed across the range of temperatures disclosed (in claim 4) for the addition in step b).

3.5.3 The board disagrees. As noted by the board at oral proceedings, by virtue of the fact that contested claim 1 requires the preparation of an aqueous suspension, not a frozen solid, it does not cover such embodiments. Therefore, the question of whether contested claim 1 is sufficiently disclosed in this regard does not arise. Rather, the patent indicates to the skilled person (paragraph [0013]) that the addition of an aqueous suspension in step b) at a temperature lower than the melting point of the pesticide compound is required in order to induce rapid and complete crystallisation of

the amorphous droplets. The appellant's arguments in this regard hence must also fail.

3.6 It follows that the invention defined in claim 1 of the main request is sufficiently disclosed.

4. Inventive step - Article 56 EPC

The appellant in the statement of grounds of appeal submitted that the subject-matter of claim 1 at issue lacked inventive step *inter alia* in view of D10 as closest prior art.

4.1.1 D10 is concerned with a method for producing suspension concentrates of *inter alia* pesticides, in particular those having a low water solubility (D10, column 1, lines 6-9) and having a low melting point (column 1, lines 27-29; column 2, lines 52-55). The method comprises the steps of a) combining a stream comprising melted solid (the pesticide) with a stream comprising a solvent and b) mixing the combined streams in a confined chamber under high shear conditions wherein the melted solid first emulsifies, forming particles of 5 µm or less, which then cool to below their melting point and solidify before leaving the chamber (claim 1; column 2, lines 6-22).

4.1.2 Since D10 is concerned with the same subject-matter as the present patent, the board sees no reason to differ from the appellant's position that D10 can be considered to represent the closest prior art.

4.1.3 It was undisputed by the parties that the distinguishing feature of contested claim 1 over D10 is the use of an aqueous suspension of seed crystals to

control the crystallisation of the molten material in the melt emulsion, i.e. step b) of claim 1 at issue.

4.1.4 Furthermore, it was undisputed by the parties that the objective technical problem underlying the subject-matter of claim 1 is the provision of an alternative process for preparing an aqueous suspension of an organic pesticide compound.

4.2 Obviousness

4.2.1 The appellant argued that in order to solve this problem, it would have been obvious to the skilled person to control crystallisation in the process of D10 by employing a suspension of seed crystals of the organic pesticide compound according to step b) of contested claim 1.

4.2.2 Firstly, it was argued that the use of seed crystallisation was taught in D10, since the solvent stream may contain a second pesticide which may be the same as the solid (column 3, lines 10-12). Therefore, the appellant argued, the solvent stream could contain the solid pesticide in the form of crystals, which would then act to induce crystallisation in the melt emulsion.

4.2.3 The board disagrees with this interpretation. Although D10 teaches that the solvent stream added to the molten pesticide may contain a second pesticide, it also teaches that preferably the second pesticide is different from the first (the pesticide of the melt). Furthermore, when the solvent is water, preferably the second pesticide is water soluble (column 3, lines 16-18). Hence, D10 does not teach the addition of an aqueous solvent stream comprising the same solid

pesticide as a suspension therein, let alone such a stream in which 90% of said solid is in the crystalline state as required by claim 1, step b). Finally, as stated by the respondent during oral proceedings, even if the skilled person were to add seed crystals to the solvent stream of D10, he would still not arrive at the subject-matter of claim 1, which requires the addition in step b) of an aqueous suspension to the aqueous emulsion prepared according to step a), and not to a melted solid stream disclosed in D10 (e.g. column 2, lines 7-8).

4.2.4 Secondly, the appellant argued that using seed crystals to control crystallisation in a melt emulsion would have been part of the common general knowledge of the skilled person. Specifically, D10 taught the skilled person that control of the crystallisation could be achieved by selection of the appropriate residence time in the confined chamber (i.e. the mixing chamber; D10, column 3, line 56 - column 4, line 16). The skilled person reading D10 would have realised that the residence time discussed in D10 was just one factor controlling the rate of crystallisation. To improve control over the process, the skilled person would have considered additional known techniques known to control crystallisation, such as the addition of seed crystals.

4.2.5 The board acknowledges that seed crystallisation is known in the art. Nevertheless, the board disagrees with the appellant's argument. The process of D10 involves specific conditions under which a suspension concentrate of the desired compound having a desired final particle size is obtained (column 2, lines 1-6). A critical aspect of the invention according to D10 is the residence time in the confined chamber (column 3, line 55 - column 4, line 16). The residence time must

be sufficiently long such that the melted solid is first emulsified to form small droplets of the desired particle size, and such that the droplets have sufficient time to crystallise before exiting the chamber. If the residence time is too short, unacceptably large crystals are obtained. On the other hand, if the residence time is too long, crystallised particles can agglomerate into unacceptably large agglomerates. As noted by the respondent, D10 lists factors which influence the optimum residence time in the confined chamber, such as the nature of the surfactant, the heating temperature, the rate and length of homogenisation, quenching, storage, solid loading, pressure, and emulsification media (column 4, lines 8-67).

There is however no indication in D10 that the crystallisation process disclosed therein could also be controlled by the addition of an aqueous suspension of seed crystals of the same pesticide compound to a melt emulsion thereof as required by claim 1. Furthermore, as stated above, to arrive at the subject-matter of contested claim 1, it would not be sufficient to simply add seed crystals to the solvent stream disclosed in D10. Rather, contested claim 1 first requires in step a) the preparation of an aqueous emulsion before the addition of an aqueous suspension in step b).

- 4.2.6 In the same context, the appellant submitted during oral proceedings that D10 provided a further incentive to the skilled person to use seed crystals, because doing so would have reduced the residence time in the mixing vessel, thereby allowing the use of process vessels having a lower volume.

However, there is no evidence on file demonstrating that reduced residence time has indeed been achieved by the claimed subject-matter. Hence this argument must also fail.

4.2.7 For the foregoing reasons, the subject-matter of claim 1 of the main request involves an inventive step vis à vis D10 pursuant to Article 56 EPC.

4.3 Inventive step - Admittance of further objections

4.3.1 With the statement of grounds of appeal, the appellant submitted further inventive step objections (hereinafter: "further objections") starting from:

- the common general knowledge referred to in the patent, paragraph [0005] as closest prior art;
- D2 as closest prior art;
- D6 to D8 as closest prior art; and
- D9 or D11 as closest prior art.

According to Article 12(4) RPBA 2007, the board has the discretion to hold inadmissible *inter alia* facts which could have been presented in opposition proceedings. As set out in e.g. T 0341/15 (point 2.1 of the Reasons), for claim requests filed in appeal, the purpose of Article 12(4) RPBA 2007 is *inter alia* to prevent a party from being able to act such that a decision on a certain subject-matter by the first instance department is avoided, and a board is forced to decide on said subject-matter for the first time in appeal. In the view of the present board view, the same rationale applies to facts and objections filed in appeal. As set out below, it is exactly this situation that occurred in the present appeal proceedings in the form of the appellant's further objections.

4.3.2 The further objections filed with the appellant's statement of grounds of appeal had initially been submitted with the notice of opposition at the outset of opposition proceedings. At that point in time, those objections were directed against the claims of the granted patent, which were the basis for the main request before the opposition division.

4.3.3 Subsequently, with the letter dated 15 April 2016, the respondent filed a first auxiliary request, corresponding to the present main request. Claim 1 of this request differed from claim 1 of the then main request (claims as granted) *inter alia* in the addition of the following text:

*"where the concentration of the organic pesticide compound in the aqueous emulsion is from 10 to 50 % by weight,
and where the concentration of the organic pesticide compound in the aqueous suspension, which is added in step b), is from 1 to 60 % by weight"*

Subsequent to the submission of this request, the appellant made no further written submissions in advance of oral proceedings before the opposition division. Hence, the first time that the then first auxiliary request (present main request) was addressed by the appellant was during the oral proceedings before the opposition division. Up to that point in time, no inventive step objections had been raised against the then first auxiliary request.

4.3.4 According to the minutes of oral proceedings before the opposition division, the accuracy of which was undisputed, the discussion in relation to inventive

step of the first auxiliary request took place starting at 11:30 (page 8 of the minutes). Here it is stated that

"The Chairman announces ... that the first auxiliary request meets the requirements of Article 54 EPC. The next objection to be discussed should be with regard to Article 56 EPC. The Chairman invites the parties to provide their arguments using the problem solution approach".

Thus, at the outset of the discussion on inventive step, the parties were not requested to limit their oral submissions on inventive step in any way, but were simply requested to provide their arguments.

- 4.3.5 There then ensued a discussion starting only from D10 as closest prior art. Even if one were to assume, in favour of the appellant, that at that point in time there remained some doubt as to whether the further objections raised in the notice of opposition against the then main request were pursued by the appellant also in relation to the claim set of the then first auxiliary request, this doubt, if present at all, would have been dispelled in the further course of the oral proceedings before the opposition division. Specifically, the minutes (page 11, "12:30") state the following:

"The parties having indicated that they have nothing more to add, the Chairman announces a break of 15 minutes to deliberate on the question of inventive step"

Hence, the chair of the opposition division, having opened the discussion in relation to inventive step and

having heard arguments from the appellant only in relation to D10 as closest prior art, subsequently confirmed with the parties whether there was anything further to add to their submissions. In the absence of any further submissions, it can only have been concluded that the parties had nothing to add. This in turn can only mean that the further objections that had previously been raised against the then main request, were not pursued or raised against the then first auxiliary request.

- 4.3.6 At 12:45 (minutes, page 11), oral proceedings were resumed, and the chair announced the conclusion that the first auxiliary request met the requirements of Article 56 EPC.

At this point in the oral proceedings, it would still not have been too late for the appellant to have raised the further objections had it so desired, or at the very least, to have enquired with the opposition division as to whether said further objections had been taken into account in reaching its conclusion. However, the appellant remained silent.

- 4.3.7 In view of the above, there can be no doubt that the further objections were not pursued or raised against the then first auxiliary request during the opposition proceedings.

- 4.3.8 The further objections, submitted with the statement of grounds of appeal, thus clearly deviate from the appellant's position during opposition proceedings. By not pursuing or raising these objections before the opposition division and introducing them for the first time before the board, the appellant effectively avoided a decision by the opposition division on the

merits of these objections. Their admittance would therefore oblige the board to decide for the first time on their relevance.

4.3.9 Appeal proceedings are not intended to represent a second chance for filing an opposition based on objections not previously pursued or raised during opposition proceedings. On the contrary, the main purpose of appeal proceedings is to obtain a judicial ruling on the correctness of the first-instance decision.

4.3.10 The appellant's further arguments failed to convince the board.

During oral proceedings before the board, the appellant confirmed that the further objections raised previously against the then main request had not been verbally reiterated during oral proceedings before the opposition division when dealing with the then first auxiliary request. However, this did not mean that they had been abandoned. Rather, it was standard procedure at the outset of oral proceedings for the chair of the opposition division to request that the parties not repeat their written submissions. Abandonment of the further objections would have required an express statement to that effect from the appellant. Hence, it should have been clear to the opposition division that the further objections were maintained.

The board does not find this argument convincing. It does not appear from the minutes that, albeit possibly being standard practice, in the specific case the opposition division indeed requested that the parties not repeat their written submissions. On the contrary, as set out above, at the outset of the discussion on

inventive step of the then first auxiliary request, the parties were not requested to limit their oral submissions on inventive step in any way, but were simply requested to provide their arguments. That the oral proceedings before the opposition division followed this course was not disputed by the appellant during oral proceedings before the board.

- 4.3.11 It was furthermore argued by the appellant that the amendments to the then first auxiliary request (present main request) compared to the then main request had been intended to overcome objections concerning sufficiency of disclosure, not inventive step. It would therefore have been clear to the opposition division, in the absence of an express statement of abandonment, that the further objections in relation to inventive step applied also to this request.

The board disagrees. Even if the amendments in claim 1 (compared to claim 1 of the then main request) were not intended to overcome inventive step objections as stated by the appellant, the fact remains that they resulted in a limitation of the scope of the claim. It cannot be said to be immediately apparent that said limitations were irrelevant to inventive step, because reaching that conclusion would first require, in respect of each further objection, an examination as to whether said amendments resulted in a claim comprising further distinguishing features over the respective starting point. For this reason, after the parties at oral proceedings had confirmed that they had nothing to add in relation to inventive step (*supra*), it was reasonable for the opposition division to consider that the further objections were no longer pursued and therefore either had been abandoned, or were no longer

considered relevant to the new set of claims under discussion.

- 4.3.12 The appellant also argued that at the outset of oral proceedings before the opposition division, it had maintained its request that the patent be revoked, and that that request was never abandoned. Thus, it should have been clear to the opposition division that the further objections had also not been abandoned.

A request to revoke the patent is however different from the objections and evidence upon which that request is based. In the present case, the request to revoke is thus not incompatible with the apparent conclusion of the opposition division, based on the discussion that took place during oral proceedings according to the minutes, that the further objections were not raised by the appellant against the then first auxiliary request, as set out above. Specifically, despite the request to revoke the patent, there was no reason for the opposition division to understand that the appellant raised said further objections previously made in relation to the then main request also against the then first auxiliary request.

- 4.3.13 Finally, the appellant argued that it would be unjust and unfair if the objections were not admitted for the sole reason that they had not been addressed in the decision under appeal. The RPBA 2007, in force at the of filing of the appeal, were more lenient than RPBA 2020 on the issue of admittance.

The board fails to see the relevance of this argument. Albeit potentially being more lenient than the RPBA 2020, as set out above, Article 12(4) RPBA 2007 still

leads to the conclusion that the further objections cannot be admitted.

4.3.14 Consequently, the board decided not to admit the appellant's further inventive step objections and the facts and evidence on which they are based starting from common general knowledge as set out in the patent specification or starting from any of documents D2, D6 to D8, D9 or D11 into the proceedings pursuant to Article 12(4) RPBA 2007 (see also T 87/15 (point 2 of the Reasons) and T 2730/16 (point 4.2 of the Reasons)).

5. Since there were no further objections in relation to the claims of the main request, this request is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated