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**Datasheet for the decision
of 22 October 2019**

Case Number: T 0123/17 - 3.2.08

Application Number: 09776408.8

Publication Number: 2328444

IPC: A47G23/06

Language of the proceedings: EN

Title of invention:

COMBINATION OF TRAYS, IN PARTICULAR FOR CATERING PURPOSES
ONBOARD AIRCRAFTS

Patent Proprietor:

deSter Holding B.V.

Opponent:

Spiriant GmbH

Headword:

Relevant legal provisions:

EPC Art. 108 sentence 3, 112(1)

EPC R. 99(2), 101(1)

RPBA Art. 12(4), 20

Keyword:

Referral to the Enlarged Board of Appeal - (no)
Late-filed request - admitted (no)
Admissibility of appeal - (yes)

Decisions cited:

T 0399/13, T 2532/11, T 0162/97, T 2001/14, T 0154/04,
G 0003/98

Catchword:



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Case Number: T 0123/17 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 22 October 2019

Appellant: deSter Holding B.V.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 26 October 2016
revoking European patent No. 2328444 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: Y. Podbielski
M. Foulger

Summary of Facts and Submissions

- I. With the decision posted on 26 October 2016 the opposition division revoked the European patent No. 2 328 444. The opposition division found that the subject-matter of claim 1 according to the then valid main request was not new with regard to D1 (US 3 811 566A).
- II. The patent proprietor filed an appeal against this decision.
- III. Oral proceedings took place before the Board on 22 October 2019.
- IV. The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained on the basis of one of the following requests: the new main request filed during the oral proceedings before the Board ("new main request"), the main request filed with the grounds of appeal on 3 March 2017 or auxiliary request I or II filed with the same letter. The appellant also requested that the case be remitted to the opposition division for further prosecution.
- V. The respondent requested that the appeal be held inadmissible, or, if the appeal be held admissible, that neither the new main request, nor the main request nor any of the auxiliary requests be admitted into the proceedings. The respondent also requested, in the event that any of the requests be admitted into the proceedings, that the case be remitted to the opposition division for further prosecution or that the appeal be dismissed.

VI. In the course of the oral proceedings the respondent requested that the following question, that was formulated in German, be referred to the Enlarged Board of Appeal:

"Must the appeal be rejected as inadmissible under Rule 101(1) EPC in conjunction with Rule 99(2) EPC when the (main) request filed with the appeal is based on new claims containing a new combination of features that not only defines more precisely features that were already present in the claims underlying the appealed decision - the intention behind doing so (evidently) being to overcome an objection that justified this ground for revocation - but also creates a new case, and where the statement of grounds of appeal contains no direct link to the decision it is appealing in the sense of indicating why and to what extent the amended claim set takes account of the factual and legal assessments on which the decision under appeal is based?"

VII. The arguments of the respondent can be summarised as follows:

Admissibility of the appeal/referral to the Enlarged Board

With the statement setting out the grounds of appeal ("the grounds of appeal") the appellant filed new requests which had not been part of the opposition proceedings. The appellant did not discuss in the grounds of appeal why the decision under appeal was not correct, but simply ignored that decision. There was therefore no "clear and direct link" between the decision of the opposition division and the grounds of appeal. Such a link was however, a requirement for the

admissibility of the appeal, as set out in decisions T 399/13 and T 2532/11.

There was conflicting case law on the issue of whether for an appeal to be admissible an appellant needed to explain in its grounds of appeal how the requests which were newly filed with the grounds of appeal overcame the reasons for the decision of the first instance department. In order to ensure a uniform application of the law a referral to the Enlarged Board of Appeal on this issue was needed.

Admittance of requests

With the grounds of appeal the appellant filed new requests which had not been part of the opposition proceedings and went into a new and different direction, especially as features had been deleted. This created a fresh case. The appellant should not be allowed to bring such a fresh case, especially as it would then only be considered by the Board and not by the opposition division.

The requests could and should have been filed during the opposition proceedings. The appellant had had several opportunities to do so. The lack of novelty objection based on D1 had been made with the notice of opposition. The respondent had further confirmed this objection after the appellant had filed a new set of claims as its new main request. The decision of the opposition division which was based on that request contained no new elements and was thus not surprising. The appellant should, at the very latest, have filed these requests during the oral proceedings before the opposition division.

The new main request filed at the oral proceedings before the Board was, in addition, extremely late filed and there was no reason which could justify this.

VIII. The arguments of the appellant can be summarised as follows:

Admissibility of the appeal/referral to the Enlarged Board

With the grounds of appeal the appellant filed requests aimed at overcoming the reasons for the revocation of the patent, which was that the subject-matter of claim 1 was not new in view of D1. In the grounds of appeal it made submissions why the newly filed requests overcame the objection of lack of novelty in view of D1. The appeal was thus admissible.

Admittance of requests

In its annex to the summons to oral proceedings the opposition division had only identified briefly the issues to be discussed and had not indicated a preliminary view. The appellant was thus surprised by the decision of the opposition division. The requests made at the appeal stage could not have been made earlier and should therefore be admitted.

With regard to the new main request filed during the oral proceedings it was important to note that this only deleted dependent claims which had been objected to by the Board in its communication. It was thus made in response to the Board's communication and contained nothing which was complex or new.

Reasons for the Decision

Admissibility of the appeal/referral to the Enlarged Board

1. The admissibility of the appeal depends on whether the grounds of appeal comply with Article 108, third sentence, EPC in conjunction with Rule 99(2) EPC. According to these provisions, in the grounds of appeal the appellant must indicate "the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based."
2. Whether the requirements of Article 108, third sentence, EPC in conjunction with Rule 99(2) EPC are met has to be decided on the basis of the grounds of appeal and of the reasons given in the contested decision, taking into account any amendments made to the claims (Case Law of the Boards of Appeal of the European Patent Office, 8th edition, IV.E.2.6.3a)) with reference to, inter alia, decisions T 162/97 and T 2001/14).
3. The opposition division had decided that the subject-matter of claim 1 of the only request then on file was not new in view of the teaching of document D1. With the statement setting out the grounds of appeal the appellant filed a main request, which had not been part of the opposition proceedings, and two auxiliary requests. In the grounds of appeal the appellant explained why the newly filed main request was new in view of D1 (p. 3 of the grounds of appeal). The Board clearly understands the legal and factual reasons why, according to the appellant, the decision under appeal

should be set aside. In these circumstances, the appeal is admissible.

4. The respondent argued that there was no clear and direct link between the decision under appeal and the grounds of appeal. It referred to decisions T 2532/11 and T 399/13 in this regard. The Board firstly notes that the concept of a clear and direct link is not an additional requirement for the admissibility of the appeal but simply a means of expressing the requirements of Article 108, third sentence, EPC in conjunction with Rule 99(2) EPC. Thus, in the present case, the Board considers that there is a clear and direct link between the impugned decision and the grounds of appeal for the reasons set out in the foregoing paragraph.
5. Secondly, the facts of each case differ from each other. The facts of the present case differ from those in T 2532/11, where the Board concluded that no reference had been made to the impugned decision and that there was therefore no direct link between the impugned decision and the grounds of appeal (Reasons 2.6.2).
6. In T 399/13 the Board found that the requests filed with the grounds of appeal were aimed at defining a substantially different invention. The appeal was held inadmissible for lack of a clear and direct link between the impugned decision and the grounds of appeal.
7. In the present case the respondent did not contest that the main request filed with the grounds of appeal sought to address the novelty objection of the opposition division by adding certain features. The

respondent objected to additional amendments whereby features were deleted. This led to a shift of the claimed subject-matter such that it created in effect a new case. The Board considers this argument to concern the issue of the admittance of the request into the proceedings rather than an issue of the admissibility of the appeal. Therefore, the arguments of the respondent as regards the admissibility of the appeal did not convince the Board.

8. The referral of any question by a board to the Enlarged Board is only admissible if a decision from the Enlarged Board is required to ensure a uniform application of the law or if a point of law of fundamental importance has arisen, or both (Article 112(1) EPC). In addition, the answer from the Enlarged Board to the referred question must be required for the board to reach a decision in its case (G 3/98, Reasons 1.2.3).
9. The respondent argued that a referral was needed in order to ensure a uniform application of the law. The Board is not convinced by this. The Board has applied the same legal principles as the cases cited by the respondent, but the specific facts of the case have resulted in a different outcome. This does not amount to a non-uniform application of the law.
10. Even if the Board's application of the law to the particular facts of the case lead to a different outcome than in a previous decision, this would not in itself amount to a non-uniform application of the law. The Rules of Procedure of the Boards of Appeal foresee a mechanism for such a situation without the obligation of a board to refer a question to the Enlarged Board, namely that the board in its decision gives grounds for

deviating from an earlier decision (Article 20 RPBA, see also T 154/04, Reasons 2).

11. Finally, the Board does not consider it necessary for the Enlarged Board to answer the question proposed by the respondent in order to reach its decision. In this context, it is worth noting that the suggested question supposes that the appellant had made no submissions which explain why the claims filed with the grounds of appeal overcome the reasons for the impugned decision. However, in the present case, such submissions have been made so that an answer from the Enlarged Board to this question, had it been referred, would not have been of assistance to the Board in reaching its decision.
12. For the reasons set out above the Board refuses the request for referral to the Enlarged Board.

Admittance of requests

13. The respondent requests that the Board exercise its discretion under Article 12(4) RPBA not to admit the following requests: the new main request filed during the oral proceedings before the Board and the requests filed with the grounds of appeal, that is the main request and auxiliary requests I and II. Claim 1 of the new main request is identical to that of the main request.
14. The Board notes that the nature of the amendments which resulted in claim sets of these requests are two-fold. One is that features have been added to try to establish novelty. The other is that in claim 1 of all requests features have been deleted which were present in claim 1 of the request on the basis of which the

opposition division rendered its decision. The omission of these features has as a consequence that the subject-matter of claim 1 has shifted. Thus the nature of these amendments results in what can be described as a fresh case.

Main request and auxiliary requests I and II

15. The Board also notes that the appellant had ample opportunity to file requests which overcame the lack of novelty objection in view of D1 during the proceedings before the opposition division, as set out further below.
16. The objection of lack of novelty in view of D1 was first raised with the notice of opposition (pages 4-8 of the notice of opposition). In reply, the appellant filed a new main request and explained why the subject-matter of the claims overcame the lack of novelty objections in view of D1 and was inventive.
17. In its annex to the summons to oral proceedings the opposition division stated that the following would be discussed during the oral proceedings: "does the subject-matter of the amended claims meet the requirements of novelty and inventive step with regard to the disclosure of the prior art documents cited by the opponent". A final date for making written submissions was set.
18. About 6 weeks prior to the oral proceedings before the opposition division the respondent filed submissions in which it raised lack of novelty objections against the main request, this time in view of two documents, one of which was D1. The appellant filed submissions in reply thereto, but no new requests.

19. As is apparent from the minutes of the oral proceedings novelty in view of D1 was one of the two main points of discussion during the oral proceedings. Before the deliberations by the opposition division the parties confirmed their requests made at the beginning of the oral proceedings, which corresponded to those made in writing.

20. The Board concludes that the issue of lack of novelty in view of D1 had been a prominent issue throughout the opposition proceedings. The number of novelty objections was limited to two and the grounds of opposition were limited to those under Article 100(a) EPC. In view of this and given that the appellant had several opportunities at which to file requests overcoming the lack of novelty objection based on D1, the requests filed with the grounds of appeal could and should have been filed during the opposition proceedings.

21. The appellant argued that it was in no position to file the requests as it had only found out with the reasons for the decision that D1 was regarded as a novelty destroying document. The Board is not convinced by this argument. The appellant had neither received a positive nor a negative opinion from the opposition division on the issue of lack of novelty in view of D1. In any event, that the opposition division follows one or the other party is to be expected and thus not surprising. It is also not apparent from the minutes nor has it been argued that the appellant was prevented from filing new requests during the oral proceedings before the opposition division.

New main request

22. The reasoning also applies in principle to the new main request filed during the oral proceedings before the Board. The only difference to the main request lies in the deletion of dependent claims to which the Board had raised an objection. As the new main request essentially mirrors the main request, the same considerations apply and the Board's objection to the dependent claims cannot be used to overcome the non-admittance.
23. In view of the above the Board exercises its discretion under Article 12(4) RPBA not to admit the following requests into the proceedings: the new main request filed during the oral proceedings before the Board and the requests filed with the grounds of appeal, that is the main request and auxiliary requests I and II. As there are no further requests on file, the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Moser

M. Alvazzi Delfrate

Decision electronically authenticated