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**Datasheet for the decision
of 29 September 2020**

Case Number: T 0693/17 - 3.2.07

Application Number: 05784742.8

Publication Number: 1809422

IPC: B02C4/08, B02C4/32, B02C4/28

Language of the proceedings: EN

Title of invention:
MINERAL BREAKER

Patent Proprietor:
MMD DESIGN & CONSULTANCY LIMITED

Opponent:
thyssenkrupp Industrial Solutions AG

Headword:

Relevant legal provisions:
EPC Art. 54, 56, 123(2)
RPBA Art. 12(4), 12(2)
RPBA 2020 Art. 12(3), 13(1), 15(1)

Keyword:

Statement of grounds of appeal - New lines of argument -
admitted (no)
Amendment of appellant's case after Board's communication
pursuant to Article 15(1) RPBA 2020 - admitted (no)

Decisions cited:

Catchword:



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Case Number: T 0693/17 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 29 September 2020

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
17 January 2017 concerning maintenance of the
European Patent No. 1809422 in amended form.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Pieracci
A. Cano Palmero

Summary of Facts and Submissions

- I. The opponent lodged an appeal in the prescribed form and within the prescribed time limit against the interlocutory decision of the opposition division to maintain the European patent No. 1 809 422 in amended form.
- II. The opposition had been filed against the patent as a whole based on Article 100(a) EPC (lack of novelty and inventive step), on Article 100(b) EPC (insufficiency of disclosure) and on Article 100(c) EPC (added subject-matter). The opposition division considered the patent as amended according to auxiliary request 3 to fulfil the requirements of the EPC and the patent proprietor made this request its sole request at the end of the oral proceedings before the opposition division.
- III. In the present decision reference is made to the following documents also considered in opposition proceedings:
- D1: JP 9-155215;
- D3: JP 2004-174393;
- D4: WO 00/35585.
- IV. To prepare the oral proceedings scheduled upon both parties' requests, the Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA 2020. The Board indicated *inter alia* that it considered

not admitting into the proceedings any of the objections of the opponent.

V. Oral proceedings before the Board took place on 29 September 2020 at the end of which the decision was announced and for further details of which reference is made to the minutes thereof.

VI. The final requests of the appellant (opponent) are that the decision under appeal be set aside and that the European patent No. 1 809 422 be revoked or, in the alternative, that the case be remitted to the opposition division for further prosecution concerning the objections under Articles 123(2), 54 and 56 EPC submitted with the statement setting out the grounds of appeal and with the submissions dated 10 August 2020.

VII. The final request of the respondent (patent proprietor) are

that the appeal be dismissed (*i.e.* that the patent be maintained in the amended form held by the opposition division to meet the requirements of the EPC - main request) or, in the alternative, when setting aside the decision under appeal, that the patent be maintained in amended form on the basis of the set of claims filed as first auxiliary request with the reply to the appellant's statement of grounds of appeal.

VIII. The lines of argument of the parties are dealt with in detail in the reasons for the decision.

IX. Independent claim 1 according to the patent as maintained in opposition proceedings reads as follows:

"A mineral breaker including a single row of exactly four side-by-side breaker drum assemblies (30) having radially projecting breaker teeth (38), each breaker drum assembly in said row being arranged to rotate in an opposite direction to its adjacent breaker drum assembly, the row arranged to define an inner pair of adjacent breaker drum assemblies (30a) located in-between a pair of outer breaker drum assemblies, said inner pair of breaker drum assemblies defining therebetween a mineral deposit region (DM) for receiving mineral in-flow, the breaker drum assemblies of said inner pair of breaker drum assemblies (30a) being rotated in opposite directions such that, in use, breaker teeth on each of said inner breaker drum assemblies act upon mineral being deposited in said deposit region to cause agitation of the deposited mineral in-flow in order to encourage undersized mineral to pass therebetween whilst preventing oversized mineral passing therebetween, and each breaker drum assembly (30a) of said inner pair of breaker drum assemblies acting upon oversized mineral in the material in-flow to cause the oversized mineral to be moved outwardly towards a respective one of said outer breaker drum assemblies (30), which outer breaker drum assembly is arranged to co-operate with its neighbouring breaker drum assembly such that the breaker teeth on the breaker drum assemblies co-operate to grip and break down oversized mineral."

X. The wording of claim 1 according to the first auxiliary request is not reported herewith as this request is not relevant for the decision.

Reasons for the Decision

1. Added subject-matter of claim 1 (Article 123(2) EPC)

The appellant (see point III of the statement setting out the grounds of appeal) objects to claim 1 as maintained in opposition proceedings, arguing that the combination of features that the mineral breaker includes:

"...a single row of exactly four side-by-side breaker drum assemblies (30) having radially projecting breaker teeth (38)..."

provides subject-matter extending beyond the content of the application as originally filed.

This objection is not dealt with in the appealed decision, which only deals with novelty and inventive step of the subject-matter of claim 1 of the patent as maintained in opposition proceedings.

The appellant acknowledged at the appeal oral proceedings that the above objection was not explicitly raised at the oral proceedings in opposition (see also point 6.1 to 6.17 of the minutes thereof).

The Board notes that it is the party's responsibility to present their case and to submit promptly all their objections.

As acknowledged by the appellant, the opposition division in the annex to the summons to oral proceedings expressed its opinion that the objection of

added subject-matter was unfounded (see point 3.4 on page 3 thereof). This should have prompted the appellant to pursue the matter further at the oral proceedings before the opposition division, if they had the intention to sustain their objection.

The Board remarks that the appellant did not contest in the statement setting out the grounds of appeal that the opposition division had taken into account in the impugned decision all the relevant objections they submitted.

The Board has thus no reason not to believe that this has indeed been the case.

The Board concludes therefore that the above objection of added subject-matter could and should have been maintained during the oral proceedings in opposition and therefore exercises its discretion pursuant to Article 12(4) RPBA 2007 by not admitting this objection into the appeal proceedings.

2. Novelty of the subject-matter of claim 1 with respect to document D1 (Article 54 EPC)

The appellant (see point IV.1 of the statement setting out the grounds of appeal) argues that the opposition division, on page 9 of the reasons for the decision, has not correctly identified the features distinguishing the subject-matter of claim 1 as maintained from the disclosure of document D1 and that therefore the subject-matter of the claim is not new in view of document D1.

The Board notes that the part of the impugned decision referred to by the appellant relates to the analysis of inventive step of the claimed subject-matter.

In fact the appealed decision does not deal with lack of novelty in view of document D1 for the version of the claims held allowable by the opposition division (see point 2 of the reasons for the decision) and, as acknowledged by the appellant at the oral proceedings before the Board, this issue was not raised at the oral proceedings before the opposition division, where novelty was only contested in view of document D3 (see points 6.1 to 6.3 of the minutes).

The Board cannot follow the argument of the appellant, that the present objection should be admitted into the proceedings because the lack of novelty in view of D1 was not pursued at the oral proceedings in opposition only for reasons of procedural economy, since the opposition division considered D1 not to deprive novelty of the subject-matter of claim 1 according to the initial main request. Further, should the objection not be admitted, the appellant would be deprived of the possibility of addressing this issue in appeal as the respondent withdrew all the other requests at the end of the oral proceedings in opposition.

The Board is not convinced by the argument of the appellant, since, as argued by the respondent at the oral proceedings before the Board, the appellant was in the position at the oral proceedings in opposition to state that the objection of lack of novelty in view of D1 was raised also for the then auxiliary request 3 and to indicate where the additional features of claim 1 of that request with respect to claim 1 of the main request were to be found in D1.

The appellant however did none of the above.

The Board notes that the fact that the decision does not deal with D1 is solely the consequence of the appellant's own procedural strategy. Had the appellant raised the objection at the oral proceedings, the opposition division would necessarily have dealt with it in the decision under appeal.

The Board concludes that the above objection of lack of novelty could and should have been submitted during the oral proceedings in opposition and thus exercises its discretion pursuant to Article 12(4) RPBA 2007 by not admitting this objection into the proceedings.

3. Inventive step of the subject-matter of claim 1 (Article 56 EPC)
 - 3.1 Document D3 in combination with the common general knowledge or with the teaching of document D1
 - 3.1.1 In the statement setting out the grounds of appeal (see page 13, fourth paragraph) the appellant argues that the subject-matter of claim 1 is distinguished from the mineral breaker shown in the figures of D3 by the feature that the claimed mineral breaker has "...a single row of exactly four side-by-side breaker drum assemblies..." and that the objective technical problem linked to this distinguishing feature is that of adjusting throughput capacity to a lower, expected throughput (see page 14, fifth paragraph and page 16, second paragraph, of the statement setting out the grounds of appeal).

The Board notes that the technical problem identified by the appellant in opposition proceedings was a different one, in particular that of providing a mineral breaker which is cost effective (see point 3.2,

second paragraph and point 3.3, first paragraph of the reasons for the decision).

The Board cannot accept the argument of the appellant that the problem considered in opposition proceedings on the one hand and the problem formulated with the grounds of appeal on the other hand are just two different designations for the same technical effect (see page 8, first paragraph, last sentence and page 11, second paragraph, last sentence of the appellant's submissions dated 10 August 2020).

Even if one followed the argument of the appellant that an increased throughput of a machine is accompanied by reduced costs for the machine, the problems formulated by the appellant are indeed different.

3.1.2 The argument of the appellant that at the oral proceedings in opposition they indicated that reducing the number of rolls from six to four in D3 was obvious if the person skilled in the art knows beforehand that the throughput of the device with the reduced number of rolls meets his throughput requirements (see page 5, third paragraph of the reasons for the decision) does not imply that the objective problem now submitted in appeal was addressed in opposition, since there the appellant clearly indicated that the problem to be solved by the distinguishing feature had to be seen as providing a mineral breaker which is cost effective (see page 5, second paragraph and page 6, second paragraph of the reasons for the decision).

3.1.3 The appellant also argues that the distinguishing feature of the claim, *i.e.* that the claimed mineral breaker has "...a single row of exactly four side-by-side breaker drum assemblies..." is an arbitrary selection among the possible realizations disclosed in

the original application (see page 14, third paragraph of the statement setting out the grounds of appeal). The appellant acknowledged at the oral proceedings before the Board that also this line of argument had not been previously submitted in opposition proceedings.

- 3.1.4 The inventive step attacks starting from D3 submitted in the appeal proceedings differ therefore substantially from the inventive step argumentation brought forward in opposition proceedings.

No reason why these new lines of argument are presented for the first time in appeal proceedings has been indicated by the appellant, nor is it apparent to the Board.

The Board therefore concludes that the above objections of lack of inventive step could and should have been submitted during the oral proceedings in opposition to allow the respondent to react to them and the opposition division to decide on them, and thus considers it appropriate to exercise its discretion not to admit these new lines of argument into the proceedings pursuant to Article 12(4) RPBA 2007.

- 3.2 Document D4 in combination with document D1

The appellant (see point V.3 of the statement setting out the grounds of appeal) argues that the subject-matter of claim 1 as maintained also lacks an inventive step in view of the combination of the teaching of document D4 with that of document D1.

In point 3.4 of the reasons for the decision under appeal, in particular in the second paragraph on page

8, the opposition division indicated in detail why the person skilled in the art would not arrive at the claimed subject-matter to solve the problem of providing a mineral breaker with high throughput capacity starting from document D4 in combination with the teaching of document D1.

In the statement setting out the grounds of appeal, the appellant contests the conclusions of the opposition division in relation to the combination of the teaching of documents D4 and D1 but does not indicate why the reasoning of the opposition division is incorrect.

Furthermore, while in opposition proceedings the appellant argued that the person skilled in the art would add two additional drums to the breaker of D4, as shown in the embodiment of figure 1 (b) of D1, since D1 provides a hint that throughput will increase (see the first paragraph of point 3.4 of the reasons for the decision), in the statement setting out the grounds of appeal the appellant submits that the person skilled in the art would provide a two-stage breaker arrangement as known from D1 in the breaker of D4, whereby the secondary stage would comprise the combination of features of claim 1.

The appellant considers the secondary stage of a breaker of D1 as a breaker on its own and thus argues that this secondary breaker would then show all the features of claim 1, whose subject-matter would then not be inventive.

This line of attack has not been addressed in the proceedings before the opposition division and is therefore not dealt with in the decision.

The appellant argues with submissions of 10 August 2020 (see point 3.3.2 thereof) and at the oral proceedings before the Board that this further line of attack is justified and admissible since it results from a reaction to the considerations of the opposition division given on page 8, second paragraph of the reasons for the decision.

The Board is not convinced by the argument of the appellant since, as indicated above, no reasons have been provided as to why the arguments of the opposition division given on page 8, second paragraph of the reasons for the decision are incorrect. This has also been acknowledged by the appellant at the oral proceedings before the Board. Therefore, the new line of argument cannot be seen as a reaction justified by the reasoning of the decision.

The Board is of the opinion that this line of argument could and should have been submitted in opposition proceedings, to allow the respondent to react to it and the opposition division to decide on it, and considers it therefore appropriate to exercise its discretion by not admitting this new objection of lack of inventive step into the proceedings pursuant to Article 12(4) RPBA 2007.

4. Admittance into the proceedings of the objections of lack of inventive step submitted after the Board's communication pursuant to Article 15(1) RPBA 2020.

After having received the Board's communication pursuant to Article 15(1) RPBA 2020 the appellant submitted as auxiliary measures two lines of argument of lack of inventive step starting from D3 in combination with the common general knowledge and with

D1, in which the same objective technical problem as addressed in opposition proceedings is considered (see point 3.1.3 and 3.2.3 of the submissions dated 10 August 2020).

The Board notes that a party should be aware of the fact that, as indicated in Article 12(3) RPBA 2020, which substantially corresponds to Article 12(2) RPBA 2007, the statement of grounds of appeal shall contain the appellant's complete case.

The lines of argument of lack of inventive step indicated above have been presented for the first time in appeal proceedings after the appellant has filed its grounds of appeal and after having received the Board's communication and thus represent an amendment to the appellant's case, subject to Article 13(1) RPBA 2020.

The Board cannot accept the appellant's justification for submitting these lines of argument at this stage of the proceedings, that they were taken by surprise by the preliminary opinion of the Board.

Every party should be aware that the admittance of submissions which could have been made in opposition proceedings are subject to the Board's discretion pursuant to Article 12(4) RPBA 2007 and therefore, when making such submissions, they should consider the possibility that contrary to their expectation these might not be admitted into the proceedings.

The parties should therefore prepare their case accordingly.

In the present case a surprise cannot thus be invoked to justify the filing of further submissions after receiving the Board's communication.

The Board considers that the course of action taken by the appellant, of adapting their strategy and requests depending on the communication of the Board instead of defining their complete case at the beginning of the appeal procedure, is not only contrary to Article 12(3) RPBA 2020, corresponding essentially to Article 12(2) RPBA 2007, but also to the requirement of procedural economy and therefore considers it appropriate to exercise its discretion by not admitting the amendment of the appellant's case into the proceedings pursuant to Article 13(1) RPBA 2020.

5. Conclusion

The Board notes that, since none of the objections and lines of argument of the appellant are admitted into the proceedings, as also acknowledged by the appellant at the oral proceedings before the Board, there are no admissible reasons for allowing the appeal or for remitting the case to the opposition division.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated