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**Datasheet for the decision
of 19 April 2023**

Case Number: T 2391/18 - 3.2.03

Application Number: 06742598.3

Publication Number: 1872074

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C21C5/56, F27D3/12, F27D3/00,
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Language of the proceedings: EN

Title of invention:
EQUIPMENT FOR MEASUREMENT AND CONTROL OF LOAD MATERIAL OR
SCRAP FEEDING INTO A FURNACE AND RELATIVE METHOD

Patent Proprietor:
Tenova S.p.A.

Opponent:
DANIELI & C.
OFFICINE MECCANICHE SpA

Relevant legal provisions:
EPC Art. 54, 56, 84, 100(c), 115, 123(2)
EPC R. 80
RPBA 2020 Art. 13(1), 13(2)

Keyword:

Novelty - (yes)
Inventive step - (yes)
Grounds for opposition - subject-matter extends beyond content of earlier application (no)
Amendments - allowable (yes)
Observations by third parties - legal position of third party - relevant (no) - admissibility of a new document (no)
Amendment to appeal case - justification by party (no)
Amendment after summons - exceptional circumstances (no) - taken into account (no) - cogent reasons (no)

Decisions cited:

T 0536/88, T 0541/98, T 0652/99, T 0140/00, T 0454/02,
T 0086/03, T 2377/18, G 0003/14

Catchword:

On the application of Rule 80 EPC and the findings of the Enlarged Board of Appeal in G 3/14 in case of an alleged discrepancy between the description and a feature stemming from a granted claim, see point 4.



Beschwerdekammern

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Case Number: T 2391/18 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 19 April 2023

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 17 July 2018
rejecting the opposition filed against European
patent No. 1872074 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman C. Herberhold
Members: R. Baltanás y Jorge
F. Bostedt

Summary of Facts and Submissions

I. European patent No. 1872074 B1 relates to *"equipment for measurement and control of load material or scrap feeding into a furnace and relative method"*.

II. An opposition to the patent was filed, based on Articles 100(b) EPC, 100(c) EPC and 100(a) EPC in conjunction with Articles 54 EPC and 56 EPC.

III. The present appeal is against the decision of the Opposition Division rejecting the opposition.

The decision was appealed by the opponent (appellant).

IV. The patent proprietor (respondent) filed first to fifteenth auxiliary requests with its reply to the statement of grounds of appeal.

V. Anonymous third-party observations, in accordance with Article 115 EPC, were filed on 7 April 2022, after the statement of grounds and the corresponding reply had been filed by the parties to the appeal proceedings. The observations comprised arguments on inventive step and added subject-matter of the claims as granted, and were accompanied by the following documents.

PL1: US 2002/0110175 A1

PL2: WO 2004/036131 A1

PL3: US 6,473,446 B2

VI. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA 2020), the Board indicated its preliminary opinion on the

case. In reply to this communication, on 15 March 2023 the appellant filed submissions that included new lines of attack and a new document numbered "D12".

The summons to oral proceedings was notified by a letter of 23 November 2022. Oral proceedings were held on 19 April 2023.

VII. At the end of the oral proceedings, the parties' requests were as follows.

The appellant requested that the decision under appeal be set aside and that the patent be revoked. In addition, the appellant requested that, in its decision, the Board confirm the interpretation of features 1.5 and 1.6 as set out in the Board's communication in preparation for the oral proceedings.

The respondent requested that the patent be maintained in amended form, on the basis of the third auxiliary request as filed with the reply to the statement of grounds of appeal (i.e. the third auxiliary request was made the main request).

VIII. Claim 1 of the new main request (i.e. the third auxiliary request as filed with the reply to the statement of grounds of appeal), including the numbering of its features as adopted by the Board, reads as follows (the amendments with respect to claim 1 as filed are marked in bold) (the amendments with respect to granted claim 1 are underlined).

1.1 *Equipment for the measurement and control of load material and scrap metal feeding into an electrical arc furnace,*

- 1.2 ~~[which comprises]~~ **said equipment comprising** an automatic control device for feeding load material or scrap
- 1.3 according to the energy supplied to the bath;
- 1.4 **[and]** a measuring device for the added load material, ~~[in correlation]~~ **correlated** with the automatic control device,
- 1.5 comprising a weighing device for **weighing** the furnace shell, its contents and any other components it may support,
- 1.6 **the weighing device being coupled with a structure supporting the furnace shell,**
- 1.7 **and a data acquisition system of a reading of the measurement supplied by the weighing device, wherein**
- 1.8 - the weighing device for weighing the furnace shell, its contents and any other components supported by it, is coupled with a furnace shell support structure by means of support rollers,
- 1.9 at least two of said support rollers being composed of measuring rollers equipped with sensors for direct or indirect weight reading;
- 1.10 - the control device for feeding the load material into the furnace is arranged to feed it into the furnace continuously.

Independent method claim 5 of the new main request, including the numbering of its features as adopted by the Board, reads as follows (the amendments with respect to claim 9 as filed are marked in bold) (the amendments with respect to granted claim 9 are underlined).

- 5.1 *Method for measuring and control of load material or scrap metal feeding into an electric arc furnace, that provides the following steps:*
- 5.1a **continuously feeding the load material or scrap metal into the furnace;**
- 5.2 *- weighing of added load material or scrap metal into the bath,*
- 5.3 *supplied by a weighing device, through the weighing of the furnace shell, its content and any other components it may support;*
- 5.4 *- data acquisition of a measurement reading of the amount of load material or scrap metal added to the bath, supplied by the weighing device, differential in time **[for example]**;*
- 5.5 *- optimising of the feed flow according to **[suitable]** algorithms, through load material or scrap metal feeding speed regulation*
- 5.6 *according to the energy supplied to the bath.*

Independent device claim 8 of the new main request, including the numbering of its features as adopted by the Board, reads as follows (the amendments with respect to claim 13 as filed are marked in bold) (the amendments with respect to granted claim 13 are underlined).

- 8.1 *Equipment for steel refining comprising:*
- 8.2 *- an arc furnace for steel production for smelting and refining a metal load inside said furnace;*
- 8.3 *- electrodes that extend inside said furnace as far as the intermediate level between the slag level and the level of the melted material contained in the bath;*

- 8.4 - feeding means connected to said furnace for the introduction of load materials inside said furnace without the removal of the electrodes,
- 8.4a **the feeding of the load materials into the furnace being continuous;**
- 8.5 - post-combustion means associated to cooperate with said feeding means for preheating the load materials inside said feeding means;
- 8.6 - means for measuring and controlling the load material or scrap metal feeding, comprising an automatic load material or scrap metal feeding control device **according to the energy supplied to the bath**, and a measuring device for the added load material, [~~in correlation~~] **correlated** with the automatic control device **and**
- 8.7 **comprising a weighing device for weighing the furnace shell, its contents and any other components it may support,**
- 8.8 **the weighing device being coupled with a structure supporting the furnace shell,**
- 8.9 **and a data acquisition system of a reading of the measurement supplied by the weighing device;**
- 8.10 - a hermetically sealed mechanical device located in the load material inlet section to the feeding means;
- 8.11 - gas injection means that communicate with said furnace above and/or below the normal level of the melted metal in the bath; and
- 8.12 - means for tilting said furnace for slagging and tapping operations,

8.13 *said tapping means being positioned in a such a manner that said slant of said furnace is able to maintain a heel of melted liquid material inside said bath, said heel having a weight that is between 10% and 30% of the weight prior to the tapping stage, wherein*

8.14 *- said weighing device for weighing the furnace shell, its contents and any other components supported by it, is coupled with a furnace shell support structure by means of support rollers,*

8.15 *at least two of said support rollers being composed of measuring rollers equipped with sensors for direct or indirect weight reading.*

IX. Granted claim 2 reads as follows.

Equipment according to claim 1, characterised in that the weighing device for weighing the furnace shell, its contents and any other components supported by it, is coupled with a furnace shell support structure by means of support rollers.

X. Paragraph [0017] of the patent specification reads as follows.

In particular, the weighing device of the furnace shell and any other components it may support, provides for a support structure for the furnace shell composed of support rollers.

XI. Prior art

The following documents, which have been cited in both the statement of grounds of appeal and during the opposition proceedings, are relevant to this decision.

D1: WO 2005/052196 A2
D8: "Retrofitting of the CONSTEEL® process at ORI
Martin SpA of Brescia", J.A. Vallomy, La Revue
de Métallurgie-CIT, pages 515-525, April 2000

The appellant also relied on the "admitted prior art" which corresponds to Figures 1 and 2 and paragraphs [0033] to [0036] of the contested patent.

Finally, the appellant filed the following further document by letter of 15 March 2023.

D12-Appeal: US 6,004,504 A

In its submission, the appellant referred to this document as "D12". Since this number had already been assigned to a different document cited in the contested decision, the Board will refer to the document filed at appeal as "D12-Appeal".

XII. The appellant's arguments can be summarised as follows.

(a) Admittance of the objections under Article 100(c) EPC filed at the oral proceedings of the appeal

Even though the objections concerning added subject-matter in claim 1 as granted had partly been overcome by amending the claim, the two objections raised during the oral proceedings before the Board still applied to claim 1 of the present main request.

In particular, the wording "*weighing device being **coupled with** a structure supporting the furnace shell*" in feature 1.6 had no basis in the application as filed, which merely disclosed a weighing device **providing** a furnace shell support structure.

Furthermore, the data acquisition system specified in feature 1.7 - i.e. in connection with the reading of the measurement supplied by the weighing device - was not originally disclosed in connection with a **device** as specified in granted claim 1.

These objections had already been raised in the notice of opposition. Even if the objections were not repeated in the statement of grounds of appeal, the appeal was against the whole decision of the Opposition Division, which also concerned matters that had been raised in the notice of opposition. This justified the admittance of the objections into the proceedings.

Furthermore, the objections were *prima facie* relevant, as shown by a straightforward comparison between the features and the related passages of the application as filed.

(b) Admittance of the novelty and inventive-step attacks on the new main request

Even though no objections to the claims of the third auxiliary request (corresponding to the present new main request) had been raised in advance of the oral proceedings at appeal, the subject-matter of amended claims 1 and 8 was still not novel over the "admitted prior art" and D8, or at least not inventive in view of this prior art combined with the common general knowledge.

Furthermore, the subject-matter of amended claim 5 was not novel over D1, or at least not inventive in view of D12-Appeal combined with D11 or the "admitted prior art" and D8.

These lines of attack had to be admitted into the proceedings for the following reasons.

Amended claim 1 of the third auxiliary request (new main request) consisted of a combination of four granted claims. The appellant could not be expected to attack every possible combination of granted claims in the statement of grounds of appeal. Fifteen auxiliary requests had been filed with the respondent's reply, and it would never be possible to reply to every possible auxiliary request filed by a respondent. The oral proceedings was thus the first occasion at which it became clear which auxiliary request was in practice to be discussed, and the appellant immediately responded to this by presenting the above-mentioned objections.

Moreover, the "admitted prior art" and D8 had already been used to contest the novelty of claim 1 in the statement of grounds of appeal. Therefore, the appellant was entitled to pursue the same objection to amended claim 1, in particular since the prior art was *prima facie* relevant to the amended features as well. Figure 1 of the contested patent, which concerned the "admitted prior art", disclosed wheels with sensors which corresponded to the measuring rollers now claimed. Concerning feature 1.3 (feeding load material according to the energy supplied to the bath), D8 disclosed that the feeding rate of the charge was an input for controlling the bath temperature (i.e. the energy supplied to the bath), see first paragraph in the left-hand column on page 522, thus achieving the same result as that pursued in the contested patent, see paragraph [0022]. Thus, the solution of D8 was the

same, and the prior art *prima facie* prejudiced the patentability of claim 1.

Similarly, D1 anticipated *prima facie* the subject-matter of claim 5.

The document D12-Appeal had been used as the closest prior art at examination, and its introduction was consequently justified in opposition-appeal proceedings according to the decisions T 536/88, T 541/98, T 652/99, T 454/02 and T 86/03.

(c) Objection to paragraph [0017]

There was an inconsistency between paragraph [0017] of the description - referring to a weighing device **providing for** a support structure for the furnace shell - and amended claim 1 - specifying a weighing device being **coupled with** a structure supporting the furnace shell. Thus, paragraph [0017] had to be amended in order to eliminate this lack of consistency between the claims and the description.

(d) Request that the Board confirm its interpretation of features 1.5 and 1.6 in the decision

The Board was requested to confirm in its decision the interpretation which was given to features 1.5 (weighing device for weighing the furnace shell, its contents and any other components it may support) and 1.6 (the weighing device being coupled with a structure supporting the furnace shell) in the preliminary opinion.

XIII. The respondent's arguments can be summarised as follows.

(a) Admittance of the objections under Article 100(c) EPC filed at the oral proceedings of the appeal

No objection concerning the wording "coupled with" (feature 1.6) or the data acquisition system (feature 1.7) had been presented during oral proceedings before the Opposition Division. Consequently, the contested decision did not refer to them. As the statement of grounds of appeal did not raise these objections either, they did not form part of the appeal case and constituted an amendment made only at the oral proceedings of the appeal. Under Article 13(2) RPBA 2020, such an extremely late amendment of the appellant's case should not be taken into consideration, in particular as these objections were not *prima facie* relevant.

(b) Admittance of the novelty and inventive-step attacks on the new main request

The new objections raised during the oral proceedings to the third auxiliary request (new main request) were not to be admitted under Article 13(2) RPBA 2020 because they had been filed late.

There had been no substantiated objections concerning the novelty or inventive step of granted claims 9 and 13 - on which amended claims 5 and 8 were based - in the statement of grounds of appeal.

Moreover, no cogent reasons were provided as to the admittance of document D12-Appeal into the proceedings.

Indeed, none of the new objections was *prima facie* relevant, and neither document D12-Appeal nor the new lines of attack should be admitted under Article 13(2) RPBA 2020.

Reasons for the Decision

1. Applicable legal framework concerning the Rules of Procedure of the Boards of Appeal

The revised Rules of Procedure of the Boards of Appeal (RPBA 2020) entered into force on 1 January 2020. Subject to the transitional provisions (Article 25 RPBA 2020), the revised version also applies to appeals pending on that date.

Concerning the present appeal, the summons to oral proceedings was notified after the date of the entry into force of the RPBA 2020. Consequently, the transitional provisions in Article 25(3) RPBA 2020 do not apply, and Article 13(2) RPBA 2020 applies to the amendments made at the oral proceedings of the appeal.

2. Added subject-matter of the new main request
 - 2.1 Admittance of the objections under Article 100(c) EPC filed at the oral proceedings of the appeal - Article 13(2) RPBA 2020
 - 2.1.1 Two objections concerning allegedly added subject-matter in **granted** features 1.6 ("*coupled with*") and 1.7 (data acquisition system) of amended claim 1 were raised for the first time during the oral proceedings of the appeal.

2.1.2 Neither of these objections was dealt with in the contested decision, which only discussed a different objection in respect of Article 100(c) EPC, namely the one also raised by the appellant in the statement of grounds of appeal. This objection related to the omission of the feature "support rollers" in granted claim 1 (see point II.2 of the contested decision), which is uncontestedly overcome in the new main request by amendment, see point 2.2 below.

Since the new objections were not discussed in the decision of the Opposition Division, they do not form part of the basis of the appeal proceedings within the meaning of Article 12(1)(a) RPBA 2020. In this context, it is irrelevant that the objections were presented in the notice of opposition, since the notice of opposition is not cited in Article 12(1) RPBA 2020.

Furthermore, since the new objections were not raised in the statement of grounds of appeal, they do not form part of the basis of the appeal proceedings within the meaning of Article 12(1)(b) RPBA 2020 either.

2.1.3 The new objections are thus an amendment to the appellant's appeal case, and their admittance is to be treated according to Article 13(2) RPBA 2020, since they were presented for the first time after notification of the summons. This legal provision requires "*exceptional circumstances, which have been justified with cogent reasons by the party concerned*" if a late-filed amendment to a party's appeal case is to be admitted.

The Board does not see any exceptional circumstance which could justify the late filing of the two

objections. The features at stake belong to **granted** claim 1 and the appellant could and should have raised the objections at the beginning of the appeal proceedings. Instead, they were only presented at the last possible moment, thus taking the respondent and the Board by surprise.

Moreover, the new objections are not *prima facie* relevant. The present claim 1 specifies support rollers composed of measuring rollers, i.e. supporting structures comprising and thus being coupled with the weighing device. Moreover, data acquisition of the measurement readings was originally disclosed (see for example claim 9 as filed), as was a corresponding system (see for example the paragraph bridging pages 13 and 14).

The reasons presented (alleged *prima facie* relevance, and the objection being part of the notice of opposition) cannot therefore explain why the new objections should be taken into account in spite of the appellant's raising them at a very late stage in the proceedings.

2.1.4 Consequently, the new objections relating to features 1.6 ("*coupled with*") and 1.7 (data acquisition system) are not admitted into the proceedings (Article 13(2) RPBA 2020).

2.2 Features 1.8/8.14 (support rollers) and 1.9/8.15 (support rollers being composed of measuring rollers) - Article 123(2) EPC

Features 1.8 and 8.14 were introduced in order to address the appellant's objection to granted claims 1 and 13, from which the feature "support rollers" had

been omitted, thus resulting in an unallowable intermediate generalisation in feature 1.6/8.8 (the weighing device being coupled with a structure supporting the furnace shell).

The appellant had no further objection concerning added subject-matter with respect to these features.

The Board is also satisfied that features 1.8 and 8.14 successfully address the objection to granted features 1.6 and 8.8 by further defining the support rollers which were originally disclosed in connection with the furnace shell support structure (see claim 2 as filed and page 5, lines 12 to 15).

The Board also agrees that no **further** unallowable extension of subject-matter arises from the addition of this feature (it should be noted that the aspect "coupled with" was already specified in granted features 1.6 and 8.8; see point 2.1 above).

The added features 1.9 and 8.15 are originally disclosed in claims 3 and 4 and thus the respective amendment does not entail an unallowable extension of subject-matter.

2.3 Amended features 1.10, 5.1a, 8.4a (continuously feeding), 5.4 (deletion of "for example") and 8.6 (according to the energy supplied to the bath)

Added features 1.10, 5.1a and 8.4a are originally disclosed in claims 7, 12 and 14.

The deletion of the wording "for example" in feature 5.4 merely renders compulsory a feature - "*differential*

in time" - which was originally disclosed as an option in claim 9.

Added feature 8.6 was originally disclosed in claim 1.

The appellant has not contested this.

- 2.4 In view of the above, the requirements of Article 123(2) EPC are fulfilled.
- 3. Novelty and inventive step of the new main request
 - 3.1 Admittance of the new lines of attack - Article 13(2) RPBA 2020
 - 3.1.1 The claims of the new main request correspond to the third auxiliary request filed with the reply to the statement of grounds of appeal. This reply was filed on 5 April 2019 and contained fifteen auxiliary requests.
 - 3.1.2 The summons to oral proceedings was notified more than three years after the reply had been filed. The appellant did not submit any objection to the auxiliary requests during this period. The lines of attack on the auxiliary requests were raised for the first time at oral proceedings.

Contrary to the opinion of the appellant, the Board does not see any insurmountable or unreasonable task in dealing with fifteen auxiliary requests which have been filed in a timely manner and comprise a limited number of well-defined amendments, which are moreover repeated and combined in the different auxiliary requests - including the mere deletion of granted claims in some cases. Thus, the lines of attack on the novelty and inventive step of the third auxiliary request could and

should have been raised in a timely response to their filing. There is no obligation for a party to respond directly to the filing of auxiliary requests on appeal. However, by not raising the objections at the stage of Article 13(1) RPBA 2020, i.e. after the initial stage of the proceedings but before notification of the summons, the appellant increased the likelihood that the Board would not admit or would disregard the objections: indeed, Article 13(2) RPBA 2020 imposes the most stringent constraints on a party wishing to amend its appeal case.

The fact that amended claim 1 consists of a combination of four granted claims is of no relevance to this discussion, since the decisive point for assessing when objections could and should have been filed is the **filing of the auxiliary requests**. At that point in time it became clear which actual - and not merely possible - requests were to be replied to. However, the appellant did not respond once the respondent had presented its case in its reply within the meaning of Article 12(1)(c) RPBA 2020.

- 3.1.3 Furthermore, the preliminary opinion of the Board dated 18 January 2023 explicitly noted that "*the appellant has not commented on the auxiliary requests filed by the respondent*" (point 13.1).

The appellant filed a letter dated 15 March 2023 containing further arguments and objections to the granted claims. However, this letter did not include any observations about the auxiliary requests either.

No particular reason can be seen that could have prevented the appellant from presenting the new lines of attack in advance of the oral proceedings, as it did

with the other aspects mentioned in its letter of 15 March 2023. Instead, the appellant waited until the last possible moment of the proceedings to raise the corresponding objections, thus taking the Board and the respondent by surprise.

3.1.4 For the above reasons alone, the Board does not take the new lines of attack into account. In addition, the alleged *prima facie* relevance of the objections cannot justify their admittance, for the following reasons.

(a) Objections to claim 1

The appellant's argument that the objections raised in the statement of grounds of appeal were directly applicable to amended claim 1 cannot be accepted. Amended claim 1 comprises a considerable number of supplementary features (1.8: support rollers; 1.9: support rollers composed of measuring rollers; 1.10: continuous feeding) which distinguish it from granted claim 1 to a substantial extent. The objections raised to granted claim 1 are thus not directly applicable to amended claim 1, and the line of attack had to rely on entirely new arguments, which were only presented during the oral proceedings.

Furthermore, the Board is not persuaded of the alleged *prima facie* relevance of the "admitted prior art" and D8, for the following reasons.

The appellant argued that Figure 1 of the contested patent corresponded to the disclosure of D8. Even if this were the case, it cannot be accepted that the wheels (3) are support rollers coupling the weighing device with a furnace shell support structure as

specified in feature 1.6 combined with feature 1.5. First, wheels are not rollers.

Secondly, feature 1.5 specifies a weighing device for (i.e. suitable for) weighing the furnace shell, its contents and any other components the furnace shell may support. According to feature 1.6, the weighing device is coupled with a structure supporting the furnace shell. Such a support structure is shown in Figure 1 (reference number (2)) and explicitly referred to as such. Considering features 1.6 and 1.5 in combination, it is clear to a reader skilled in the art that the claimed furnace shell support structure only supports the furnace shell, its content (i.e. contents of the furnace shell) and any components it (i.e. the furnace shell) may support.

The alleged "rollers" in Figure 1 of the contested patent (i.e. wheels (3)) do not (only) support the furnace shell, but rather the tilting platform (5) actually supporting the furnace shell support structure (2). Thus, the alleged "support rollers" do not couple the weighing device with the furnace shell support structure as specified in feature 1.8.

Finally, as was pointed out in point 11.3.3 of the preliminary opinion and discussed again with the parties in the context of the *prima facie* relevance of the new objections, features 1.2 and 1.3 (automatic feeding according to energy supplied to the bath) are not disclosed in either the "admitted prior art" or D8, since the energy balance allegedly reached in this prior art is achieved by means of the bath **temperature control as a function of the feeding rate**, and not by the claimed control of the **feeding rate as a function**

of the energy supplied. The result might be the same, but the control specified in the claim is different.

(b) Objections to claim 5 and admittance of D12-Appeal

Claim 5 of the new main request corresponds to granted method claim 9, to which no substantiated objections were made in the statement of grounds of appeal, or even in the letter of 15 March 2023. Apart from being in a different category (method claim) from claim 1, granted claim 9 differs from granted claim 1 - the only individual claim attacked in a sufficiently substantiated manner on grounds of lack of novelty and inventive step in the statement of grounds of appeal - in the optimisation of the feed flow according to algorithms through load material or scrap metal feeding speed regulation (feature 5.5). No substantiated objection to this feature in view of D1 was presented by the appellant in advance of the oral proceedings.

Indeed, with respect to granted method claim 9 (which corresponds to the present claim 5) the statement of grounds of appeal merely stated that "*Since the distinguishing features of the other independent claims 8, 9, 11 and 13 are the same of claim 1, all the independent claims should be considered not novel with respect to D1 for the same reasons above discussed*" (see paragraph before point 2.2 on page 9 and last paragraph of page 11) and "*All the other technical features provided in the other independent claims are fully conventional in the art and fully obvious for a person skilled in the art*" (see penultimate paragraph of page 14). These are mere unsubstantiated assertions, in particular since "the distinguishing features of the other independent claims" are not the same as those of claim 1. The

letter of 15 March 2023 contained similar unsubstantiated statements (see points 28, 44, 50 and 55).

Thus, the objection to claim 5 of the main request regarding lack of novelty over D1 was introduced (in a substantiated manner) for the first time during the oral proceedings and constitutes an amendment of the appeal case within the meaning of Article 13(2) RPBA 2020.

Document D12-Appeal, which was filed for the first time after notification of the summons, and which was put forward as an attack on claim 5 - corresponding to granted claim 9 - for the first time at the oral proceedings, was filed late within the meaning of Article 13(2) RPBA 2020. It should be noted that this document was not taken into account by the Opposition Division (document D12 of the decision corresponds to a different piece of prior art). Thus, the objection based on D12-Appeal is a new line of attack which was presented at the last possible moment. Admitting it would run counter to the main purpose of the appeal proceedings, which is to review the contested decision in a judicial manner (see Article 12(2) RPBA 2020 and Case Law of the Boards of Appeal, 10th edition, V. 4.1.2).

The appellant argued that the use of D12-Appeal as the closest prior art in the contested patent justified its admittance into the appeal proceedings.

However, first, this in fact reinforces the point that the objection concerned could and should have been filed earlier (as the document was known from the patent itself).

Secondly, the decisions cited by the appellant in support of the admittance of D12-Appeal are not relevant to the present case, for a number of reasons.

The cited decisions (T 536/88, T 541/98, T 652/99, T 454/02 and T 86/03) concern situations applying the legal framework before adoption of the RPBA 2020, so their considerations cannot be applied now that the legal framework concerning the admittance on appeal has changed. In fact, the considerations in these decisions were already challenged under the RPBA 2007 (see T 2377/18, Reason 1.3). Taking into account the currently applicable legal framework, any document filed after the notification of the summons is subject to the conditions in Article 13(2) RPBA 2020.

Moreover, the Board is not persuaded that D12-Appeal was actually the closest prior art "*for the purposes of elucidating the technical problem set out in the description*". In fact, D12-Appeal is cited in paragraph [0008] only as an example of indirect furnace shell weighing control, in the context of stating that it is known to weigh by both direct and indirect means. Thus, the present case is a better fit with the situation described in T 140/00 (see Case Law of the Boards of Appeal, 10th edition, IV.C.4.4), where it was decided that documents cited as conventional background art do not automatically form part of the appeal proceedings, let alone if they are filed after the notification of summons.

In view of the above, D12-Appeal and the lines of attack on claim 5 of the main request based on this document and on D1 are not admitted into the appeal proceedings (Article 13(2) RPBA 2020).

(c) Objections to claim 8

Claim 8 corresponds to granted claim 13, to which no substantiated objections were made in advance of the oral proceedings. Granted claim 13 differs from granted claim 1, the only claim attacked, in a number of features which were never discussed with respect to the "admitted prior art", D8 or the common general knowledge in the written submissions (e.g. 8.3: position of the electrodes; 8.4: without the removal of the electrodes; 8.5: post-combustion means; 8.10: hermetically sealed mechanical device; 8.11: gas injection means; and 8.13: tapping means maintaining a heel).

Thus, the same reasons as explained in the preceding point in relation to claim 5 apply here *mutatis mutandis* as regards the absence of previous objections to the claim. Consequently, the late-filed line of attack cannot be admitted into the appeal proceedings (Article 13(2) RPBA 2020).

- 3.2 Compliance of the amended claims with Articles 54 and 56 EPC
 - 3.2.1 The only claim which was validly objected to in the appeal proceedings was granted claim 1.
 - 3.2.2 Amended claim 1 corresponds to a combination of granted claims 1, 2, 3, 4 and 7.

The Board has already examined granted claim 1 for novelty and inventive step over the "admitted prior art" and D8, in its preliminary opinion (see points 11.3.3 and 11.4.1 of that document), and reached the

preliminary conclusion that the subject-matter of granted claim 1 was novel (Article 54 EPC) and involved an inventive step (Article 56 EPC). The relevant points were discussed by the parties again in the context of the *prima facie* relevance of the objections raised by the appellant to amended claim 1.

The addition of further limitations to amended claim 1 cannot render its subject-matter less novel or inventive over the same prior art. Thus, the Board has no doubts regarding the compliance of the new main request with the requirements of the EPC, in particular with those relating to Articles 54 and 56 EPC.

4. Consistency with paragraph [0017] - Article 84 EPC

According to Rule 80 EPC, the description may be amended, provided that the amendments are occasioned by a ground for opposition.

The respondent filed an adapted description in which the words "In particular," were deleted from paragraph [0017]. The appellant argued that the introduction of feature 1.8 into claim 1 required a further adaptation of this paragraph, since there was an inconsistency between the claim and the respective paragraph. In particular, paragraph [0017] referred to a weighing device which **provides for** a support structure, whereas feature 1.8 of claim 1 specified a weighing device **coupled with** a support structure.

The amendment by which the words "In particular," were deleted is occasioned by a ground for opposition. However, this is not the case with respect to the further amendment suggested and deemed necessary by the appellant.

Regarding this further amendment, the Board observes that granted feature 1.6 already specifies a "*weighing device being **coupled with** a structure supporting the furnace shell*" (emphasis added).

Furthermore, added feature 1.8 corresponds to granted claim 2. Consequently, any alleged inconsistency in this respect between paragraph [0017] of the patent as granted and the claim 1 of the present main request was already present in the granted version.

The appellant put forward the argument that such an inconsistency, even if it was already present in the granted version, had also to be addressed by adapting the description to the wording in the claim. The reason for the alleged obligation to remove such an inconsistency was to be seen in a possible lack of support of the claims by the description within the meaning of Article 84, second sentence EPC.

However, Article 84 EPC is not a ground for opposition. Therefore, in the present case, the further amendment to the description would not be "occasioned by a ground for opposition" within the meaning of Rule 80 EPC. For this reason alone it is questionable whether such a (hypothetical) amendment would be allowable.

Moreover, the Board considers that the conclusions of the Enlarged Board in G 3/14 should be taken into consideration in this context. The allegedly required amendment to paragraph [0017] does not relate to any amendment to the claims during opposition proceedings. Instead, as set out above, this amendment relates to an alleged inconsistency that already existed in respect of a feature present in the granted claims. Such an

amendment to the description is not appropriate in opposition proceedings or opposition appeal proceedings. Even without the allegedly required amendment to the description, there is no reason for the Board (or the Opposition Division) to come to the conclusion that the requirements of the Convention (in particular the requirements of Article 84 EPC) within the meaning of Article 101(3)(a) EPC are not fulfilled. The reason for this is the conclusion of the Enlarged Board in G 3/14: in considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC. Since in a case such as the present one the amendment to the claims did not introduce an issue of non-compliance with Article 84 EPC, an opposition division or a board of appeal cannot examine the claims of the patent for compliance with the requirements of Article 84 EPC, including the requirement of "support by the description" in the second sentence of this provision. There is thus no reason for the Board to object to the wording of paragraph [0017] of the amended description as filed during the oral proceedings before the Board.

5. Admittance of third-party observations - Article 13(1) RPBA 2020

The third-party observations concern only granted claim 1 and not the amended claim 1 of the new main request, which has been supplemented by a substantial number of new features. This reason alone is sufficient to disregard the third-party observations.

For the sake of completeness, the Board adds that, since it was already of the preliminary opinion that the third-party observations objecting to the former main request (i.e. claims as granted) were not to be admitted (see point 12 of the preliminary opinion), it sees no reason to deviate from this conclusion as a result of the further restrictions introduced in the claims.

6. Request for confirming interpretation of features

The appellant requested that the Board confirm in its decision the interpretation which had been given to features 1.5 (weighing device for weighing the furnace shell, its contents and any other components it may support) and 1.6 (the weighing device being coupled with a structure supporting the furnace shell) in the preliminary opinion.

However, in its decision it is the responsibility of the deciding body to deal with those aspects which are **necessary** in order to decide upon the procedurally relevant requests. Thus, the reference to features 1.5 and 1.6 in the present decision (see for example point 3.1.4(a) above) is limited to what is required to justify the decision taken upon the procedurally relevant requests.

7. Maintenance - Article 101(3) (a) EPC

Since, taking into consideration the amendments made by the proprietor of the European patent in the new main request (i.e. the third auxiliary request filed with the reply to the statement of grounds of appeal), the patent and the invention to which it relates meet the

requirements of the EPC, the Board decides the following.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division with the order to maintain the patent as amended in the following version.

Description:

Columns 1 to 7 received during oral proceedings before the Board of Appeal on 19 April 2023.

Claims:

No. 1 to 8 according to the third auxiliary request, filed on 5 April 2019 with the reply to the statement of grounds of appeal.

Drawings of the patent specification.

The Registrar:

The Chairman:



H. Jenney

C. Herberhold

Decision electronically authenticated