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**Datasheet for the decision
of 23 September 2022**

Case Number: T 1213/19 - 3.2.05

Application Number: 12724706.2

Publication Number: 2699408

IPC: B29C67/00

Language of the proceedings: EN

Title of invention:

Method for producing a three-dimensional object

Patent Proprietor:

DWS S.R.L.

Opponent:

Formlabs Inc.

Relevant legal provisions:

RPBA 2020 Art. 13(1), 13(2)
EPC Art. 54(1), 113(1), 123(1)
EPC R. 100(1), 81(3)

Keyword:

Late-filed document - admitted (yes)
Novelty - main request (no)
Amendment after summons - exceptional circumstances (no)
Right to be heard - opportunity to comment (yes)

Decisions cited:

G 0007/93, R 0009/11, R 0001/13, R 0006/19, J 0003/20,
T 0724/08, T 1715/08, T 0731/16, T 0966/17, T 2796/17,
T 0310/18, T 2125/18



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Case Number: T 1213/19 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 23 September 2022

Appellant: Formlabs Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 February
2019 rejecting the opposition filed against
European patent No. 2699408 pursuant to Article
101(2) EPC.**

Composition of the Board:

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

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division rejecting the opposition against European patent No. 2 699 408.
- II. The opposition had been filed against the patent as a whole on the basis of the grounds for opposition under Article 100(a) together with Article 54(1) EPC (lack of novelty) and Article 56 EPC (lack of inventive step).
- III. By letter dated 30 December 2019, the appellant (opponent) submitted, *inter alia*, document EP 2 505 341 A1 (D8).
- IV. A summons to oral proceedings was issued on 22 July 2021.
- V. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal in the 2020 version (RPBA 2020) issued on 27 June 2022, the parties were informed that the board was inclined to admit document D8 under Article 13(1) RPBA 2020. The board further expressed its preliminary opinion that the subject-matter of claim 1 as granted lacked novelty over document D8 under Article 54(1) and (3) EPC.
- VI. By letters dated 22 July 2022 and 16 September 2022, the respondent (patent proprietor) filed auxiliary requests 1 to 4 and auxiliary request 1A, respectively.
- VII. The oral proceedings before the board took place on 23 September 2022. During the oral proceedings, the

respondent withdrew auxiliary request 2 filed with the letter dated 22 July 2022.

- VIII. The appellant requested that the decision under appeal be set aside and that the European patent be revoked. The appellant further requested not to admit the respondent's auxiliary requests 1, 1A, 3 and 4.

The respondent requested that the appeal be dismissed (main request) or that the appealed decision be set aside and the patent be maintained on the basis of the claims of auxiliary request 1 filed with the letter dated 22 July 2022, or of auxiliary request 1A filed with the letter dated 16 September 2022, or on the basis of the claims of auxiliary requests 3 or 4 filed with the letter of 22 July 2022. The respondent further requested not to admit document D8 into the proceedings or, alternatively, that the case be remitted to the opposition division in case of admittance of any auxiliary request into the proceedings.

- IX. Claim 1 as granted has the following wording (the feature numbering used in the impugned decision is in square brackets):

"Method for producing a three-dimensional object (11) in layers by means of a stereolithography machine (1) of the type comprising:

[a] - a container (2) for a fluid substance (3) in the liquid or paste state suited to be solidified through exposure to predefined radiation (4a);

[b] - means (4) for emitting said predefined radiation (4a), suited to selectively irradiate a layer of said fluid substance (3) having a predefined thickness and arranged adjacent to the bottom (2a) of said container (2) in order to solidify it;

[**c**] - a modelling plate (5) suited to support said solidified layer (6);

[**d**] - actuator means (7) suited to move said modelling plate (5) with respect to said bottom (2a) at least according to a modelling direction (X) that is perpendicular to said bottom (2a);

[**e**] - levelling means (8) arranged in contact with said fluid substance (3);

said method comprising the following operations:

[**fa**] - selectively irradiating said layer of fluid substance (3) in such a way as to obtain said solidified layer (6);

[**fb**] - moving said solidified layer (6) away from said bottom (2a) so as to make it emerge from said fluid substance (3);

[**fc**] - redistributing said fluid substance (3) in said container (2) so as to fill the depression (3a) caused by said movement of said solidified layer (6) away from said bottom (2a), characterized in that [**fd**] said modelling plate (5) or respectively said modelling plate and the solidified layers is/are immersed in said fluid substance (3) until arranging said modelling plate (5) or respectively the last solidified layer at a distance from said bottom (2a) equal to said predefined thickness, and in that [**fe**] said redistribution process takes place by moving said levelling means (8) between said modelling plate (5) and said container (2) from a first area of said container (2), in which the level of said fluid substance (3) is higher than the level of said depression (3a), towards said depression (3a)."

- X. The appellant's submissions were essentially as follows.

Admittance of document D8

Document D8 constituted prior art relevant for novelty under Article 54(3) EPC. From the figures alone, it was clear that the disclosure of document D8 was *prima facie* highly relevant and seriously prejudiced the validity of the patent in its entirety.

The appellant was aware that the document was late filed. Nevertheless, it was filed at the earliest time possible, namely as soon as it had been found by chance during a search against another patent of the respondent and its contents had been identified as relevant. Not finding a prior-art document could not qualify as negligence or ill-intentioned behaviour on behalf of the appellant. In view of the low complexity of document D8 - an A1 publication of merely five description pages - and its straightforward disclosure, the respondent had been in a position to immediately assess the disclosure. Its discussion was therefore not detrimental to procedural economy. This applied all the more since the respondent had been aware of document D8 from the examination proceedings on a divisional application where this document had been cited as particularly relevant and in which the respondent had replied to several communications of the examining division. Thus, the respondent must have had sufficient time to consider an appropriate response. In addition, document D8 was filed about six months after the statement of grounds of appeal, shortly after the respondent's reply. Hence, no undue delay had occurred, and adequate procedural care had been taken. However, the respondent chose to react only two-and-a-half years

later, after the board had issued its communication pursuant to Article 15(1) RPBA 2020, in spite of pending infringement proceedings against the appellant. Therefore, the respondent could hardly argue that the submission of document D8 had slowed down the proceedings or was in any way unfair. Furthermore, document D8 addressed the ground for opposition of lack of novelty which was already present and which had been extensively discussed in the proceedings before the opposition division. Therefore, no new case was made.

Decision J 3/20 cited by the respondent concerned the introduction of a new case in appeal proceedings. The current case was different in that the ground for opposition of lack of novelty was already on file. Decisions T 724/08 and T 1715/08 differed from the case at hand in that the late-filed documents submitted at the appeal proceedings were not known to the patent proprietor.

Main request - novelty over document D8

The subject-matter of claim 1 as granted lacked novelty over the disclosure of document D8.

This document was concerned with a method for constructing layer-by-layer a formed body out of highly viscous photopolymerisable resin material. From paragraphs [0001], [0021], [0022] and [0023] and Figures 1 to 4 of document D8, it was clear that features **a**, **b**, **c**, **d**, **fa**, **fb** and **fd** were disclosed. It further followed from Figure 3 and paragraph [0024] that a depression was caused by the modelling platform 12 moving away from the bottom of the container. Due to its high viscosity, the resin material did not

spontaneously flow back into this depression. To refill material into the depression, an elongated mixing element 32 was moved through the resin material beneath its surface in the container. It took the form either of an elongated wire supported by a carrier 30, or an elongated plate or paddle as shown in the example of Figure 7. In the further examples shown in Figures 8 and 9, the mixing element 32 was either a wiper lip or an aerofoil-shaped plate. It was clear from paragraphs [0019] and [0028] of document D8 that these examples were further embodiments of the mixing element 32. In all cases, the mixing element 32 was in contact with the resin material. Figures 3 and 4 showed successive phases of the method before and after passage of the mixing element 32 (see paragraph [0019]). It followed from a comparison of these figures that the effect of the mixing element was to level the surface of the resin material, similar to the disclosure in paragraphs [0012], [0014], [0047], [0050] and [0052] of the patent. Hence, feature **e** was also disclosed.

The aim of the redistributing step of feature **fc** was merely to bring resin material into the depression by whatever means possible to form a next layer. Accordingly, the motion of the mixing element 32 in document D8 caused the resin material to flow across the mixing element and made the resin material flow into the depression (see paragraph [0025] of document D8). Hence, the depression was filled to the level where a next layer could be generated. Paragraph [0008], in particular lines 5 to 13 in column 4, explained that the highly viscous resin material was pulled along the region of the depression. A pushing movement was not required by the claim wording. Hence, feature **fc** was also disclosed. The mixing element 32 moved between the modelling plate 12 and the container

4, starting in an area where the resin level was higher than the resin level in the depression and moving towards the depression (see Figures 3 and 12). Therefore, feature **fe** was also disclosed.

Admittance of the auxiliary requests

Auxiliary requests 1, 1A, 3 and 4 should not be admitted under Article 13(2) RPBA 2020. No cogent reasons were given by the respondent that the requests were being filed under exceptional circumstances. The board's provisional opinion set out in the communication pursuant to Article 15(1) RPBA 2020 did not justify filing auxiliary requests shortly before the oral proceedings. The respondent should have taken into account that the board might have accepted the appellant's arguments. Furthermore, there had been sufficient time during the second level of the convergent approach to file the requests in reaction to the submission of document D8, especially since the respondent had already been aware from the proceedings concerning the divisional application that document D8 was potentially highly relevant. Instead, the respondent opted to wait two-and-a-half years before filing the auxiliary requests, until after the board had issued its provisional opinion. This was unfair to the appellant, which no longer had sufficient time to carry out an additional search.

Also under Article 13(1) RPBA 2020 the auxiliary requests should not be admitted. Not only did they not resolve the issues raised about the main request, but some of the auxiliary requests clearly constituted fresh cases because they used elements from the description. The subject-matter of claim 1 of auxiliary requests 1 and 1A *prima facie* lacked novelty over

document D8, and auxiliary requests 3 and 4 *prima facie* suffered from a lack of clarity and added-matter issues.

XI. The respondent's submissions were essentially as follows.

Admittance of document D8

Document D8 should not be taken into consideration for the following reasons. The purpose of appeal proceedings was the revision of the appealed decision in a judicial manner (see Article 12(2) RPBA 2020). Something that had not been discussed at all in the first-instance proceedings should therefore not be admitted in appeal. In the current case, document D8 could and should have been submitted in the proceedings before the opposition division. The appellant did not show which special circumstances required by Article 12(6) RPBA 2020 had made it impossible to cite document D8 at an earlier stage. The burden to prove this was on the appellant. It was the duty of the appellant to file a complete opposition and a complete case with the statement of grounds of appeal. None of these duties had been performed. In fact, document D8 was published on 3 October 2012, i.e. more than four years before the opposition had been filed. Therefore, it could have been found earlier, in particular since it belonged to the same technical field as the patent. Most significantly, document D8 had been cited in the search report of 16 March 2017 against a divisional application derived from the application on which the patent was based. Its connection with the patent had thus already been clear to the public. The fact that the respondent was aware of document D8 from the examination proceedings on the divisional application

was irrelevant because, in the respondent's view, the document was not prejudicial to the novelty of the claimed subject-matter. Furthermore, document D8 was submitted only after the statement of grounds of appeal. A complete case was thus not presented with the grounds of appeal, contrary to Article 12(3) and (5) RPBA 2020. Document D8 presented an amendment of the appeal case which should not be admitted. It was detrimental to procedural economy. Had it been filed before, the discussion about the contents of the document would have been carried out before the opposition division, giving the respondent the possibility to argue and amend the patent to establish novelty.

Reference was made to the case law. Decision J 3/20 ruled that new submissions were not to be admitted because the appellant could and should have presented the facts forming the basis for the alleged protection of legitimate expectations earlier in the proceedings. Decision T 724/08, in accordance with Article 12(6) RPBA 2020, set out that it did not matter whether the opponent had only found the late-filed documents after the opposition proceedings or whether the documents were *prima facie* relevant. The board had the discretion not to admit documents cited for the first time in appeal, even if they were novelty-destroying, if they could have been filed before the opposition division. Decision T 1715/08 was also referred to.

Contrary to the appellant's assumptions, document D8 was not *prima facie* highly relevant. It was clear that the mixing element was a wire moving under the surface of the resin material. Its function could therefore not be to level the resin material. Hence, features **e** and **fc** were not apparent from document D8, which was thus

not novelty-destroying. As it was prior art under Article 54(3) EPC, its possible relevance for inventive step could be discarded.

Main request - novelty over document D8

The subject-matter of claim 1 as granted was novel over document D8.

Features **e** and **fc** of claim 1 were not disclosed by document D8. The mixing element 32 of document D8 was a wire which was continuously submerged and moved beneath the surface of a resin material. Its function was to instigate the flow of the resin material and, hence, to make it easier to fill the depression, not to level the fluid surface. Even if the surface of the resin material was flat in Figure 4, this was not necessarily ascribed to the action of the mixing element 32. Maybe some time had passed between the phases of Figures 3 and 4, in which gravity had brought the surface of the resin material back to the level state. Likewise, it was not unambiguously disclosed in document D8 that the depression was filled because of the action of the mixing element. This stood in contrast to the patent, which was clear that the levelling means redistributed the fluid substance to fill up the depression (see paragraphs [0047] and [0052]). Furthermore, unlike document D8, the patent clearly described that the levelling means pushed the fluid substance towards the depression. The examples of Figures 7, 8 and 9 referred to different embodiments. It was not permissible to combine these embodiments with the embodiment of Figures 1 to 4 for the examination of novelty.

Admittance of the auxiliary requests

Auxiliary requests 1, 1A, 3 and 4 should be admitted for the following reasons. In the communication under Article 15(1) RPBA 2020, the board indicated that it was inclined to admit document D8, which had been filed for the first time after the statement of grounds of appeal. This came as a surprise to the respondent and thus qualified as an exceptional circumstance, particularly since the admission of late-filed documents was rather unlikely. The respondent had to be given the opportunity to react to the belated filing of document D8 and amend the claims accordingly. Reference was made to Article 113(1) EPC. If document D8 had been filed in the proceedings before the opposition division, the respondent would have had such an opportunity. Instead, novelty over document D8 was discussed for the first time during the oral proceedings before the board. It should further be taken into account that the auxiliary requests were filed more than two months before the oral proceedings, in immediate reaction to the board's communication. There was thus sufficient time for the appellant to carry out an additional search.

Furthermore, by claiming that the levelling means comprised a paddle and that a uniform thickness was conferred, the amendments to claim 1 of each of auxiliary requests 1, 3 and 4 overcame the objection of lack of novelty over document D8. Auxiliary request 1A was a mere method reformulation of the last feature of claim 1 of auxiliary request 1. The clarity and added-matter issues raised by the appellant had not been substantiated; they had to be disregarded.

Request for remittal

Remittal of the case was requested to discuss before the opposition division auxiliary requests 1, 1A, 3 and 4, if these were admitted, eventually in the light of document D8.

Reasons for the Decision

Admittance of document D8

1. The respondent requested not to admit document D8 into the appeal proceedings. Document D8 is a European patent application filed before but published after the priority date of the contested patent. In accordance with the provisions of Article 54(3) EPC, it is considered as comprised in the state of the art for the patent in suit.

2. Document D8 was submitted by the appellant with letter dated 30 December 2019, i.e. more than six months after the filing of the statement of grounds of appeal. Thus, it represents an amendment to the appellant's appeal case, which, pursuant to Article 25(1) RPBA 2020, falls under the second level of the convergent approach of Article 13(1) RPBA 2020. Accordingly, it is subject to the party's justification for its amendment and may be admitted only at the discretion of the board. This discretion must be exercised in view of, *inter alia*, the current state of the proceedings and whether the amendment is detrimental to procedural economy. The list of criteria for applying the discretion is not exhaustive (see document CA/3/19, section VI, Explanatory remarks on Article 13(1), second paragraph, first sentence, Supplementary publication 2 to OJ EPO

2020). It is established case law that further decisive criteria for admitting late-filed documents under Article 13(1) RPBA 2020 can be their *prima facie* relevance and whether they introduce any complex matter (see T 731/16, Reasons 2.2; T 2796/17, Reasons 5.5 and T 310/18, Reasons 1).

3. The appellant's justification for the late filing was that it was found by chance during a search against another patent of the respondent and was submitted at the earliest possibility in the present proceedings.
4. The board shares the respondent's view that document D8 could have been found and filed in the proceedings at an earlier stage. It lies in the same technical field of the patent and was published almost five years before the end of the nine-month opposition period. Moreover, at least since 2017, it seems to have been pivotal in the examination proceedings of EP16195931.7, a divisional application derived from the European patent application on which the patent is based, after it had been cited in the search report. Thus, no reasons are immediately apparent that could justify the appellant submitting document D8 for the first time in appeal proceedings and only after the filing of the grounds for appeal.
5. Conversely, its role in the examination proceedings on the divisional application also implies that the respondent must have been familiar with the content of document D8 more than two years before it was submitted in the appeal proceedings. This was confirmed by the respondent at the oral proceedings before the board. It is also noted that document D8 was filed more than two-and-a-half years before the date of the oral proceedings before the board, so that the respondent

had in principle sufficient time to assess its content and, where necessary, to react in an appropriate manner. Hence, there is a strong case for arguing that the respondent could not have been taken by surprise by the filing of document D8.

6. The respondent has cited Article 12(6) RPBA 2020 and referred to decisions J 3/20, T 724/08 and T 1715/08 in support of its request to disregard the late-filed evidence. However, under the transitional provisions of Article 25(2) RPBA 2020, Article 12, paragraphs 4 to 6, RPBA 2020 does not apply to any statement of grounds of appeal filed before the date of the entry into force, i.e. 1 January 2000, or any reply to it filed in due time. This provision is therefore not applicable in the present case. Similarly, decision J 3/20, which concerns the admittance under Article 12(4) to (6) RPBA 2020 of submissions concerning a correction under Rule 139 EPC and the protection of legitimate expectations, is not relevant to the current case. Decisions T 724/08 and T 1715/08 concern whether evidence can be admitted under Article 12(4) of the Rules of Procedure of the Boards of Appeal in the version of 2007 (RPBA 2007), i.e. they are related to the basis of appeal proceedings. Their bearing on the current case, where the admittance of an amendment of the appellant's appeal case after the filing of the grounds of appeal is under consideration, is not apparent. Incidentally, the board in T 724/08, when applying its discretionary power pursuant to Article 12(4) RPBA 2007, made the following observation (Reasons 3.4): "Bei der Ausübung dieser Befugnis kann die Kammer die Zulassung einer Entgegenhaltung in das Beschwerdeverfahren davon abhängig machen, ob diese Entgegenhaltung prima facie relevant ist" or "In exercising this power, the board

could make admitting a document dependent on whether it is *prima facie* relevant" (translation by the board).

7. As to the *prima facie* relevance of document D8, the respondent's arguments are not convincing. A mere glance at the rather straightforward figures of document D8 reveals that it discloses an additive manufacturing technique of the bottom-up type, i.e. repeatedly raising and lowering a build platform relative to a fluid substance in a container irradiated by a light source placed at the bottom of the container. Undeniably, the fluid depression illustrated in Figure 3 draws the immediate attention. Furthermore, the different position of the component with reference sign 32 in Figures 3 and 4 implies that it moves and interferes with the fluid substance. No matter what shape the component has, the lack of any depression in Figure 4 suggests that it must have some effect on the free surface of the fluid substance. Therefore, at first glance, document D8 appears to represent a straightforward disclosure with particular relevance for the case at issue in the sense that it could reasonably be expected to prejudice the maintenance of the patent.
8. In view of the above, the board exercised its discretion to admit document D8 under Article 13(1) RPBA 2020.

Main request - novelty over document D8

9. It is uncontested that the stereolithography machine known from document D8 comprises features **a** to **d** listed in claim 1 as granted. Container 4 shown in Figures 1 to 6 of document D8 has a transparent bottom 6 close to which means 10 for emitting a predefined

radiation through the bottom is placed (paragraph [0020]: "Belichtungseinheit 10, die unter dem Wannenboden angeordnet ist" or, translated by the board, "exposure unit 10, which is arranged below the tank bottom"). A modelling plate 12 supports the solidified layers 22. It is moved perpendicularly to the bottom by means of an actuator (paragraph [0021]: "Hubmechanismus"). Moreover, paragraph [0001] of document D8 refers to a method for producing a three-dimensional object in layers by means of such a stereolithography machine.

10. The disclosure of method steps **fa**, **fb** and **fd** is not disputed by the respondent. As shown in Figures 1 and 2 of document D8, the last solidified layer 22 is immersed (paragraph [0022]: "eintaucht") in the fluid substance until it is arranged at a distance from the bottom equal to the predefined thickness of the subsequently solidified layer. After selectively irradiating the fluid substance through the transparent bottom 6, a new solidified layer is formed (paragraph [0022]: "Nach Einstellung [...] erfolgt die für diese Schicht gewünschte ortsselektive Belichtung der Schicht, um sie in der gewünschten Form auszuhärten" or, translated by the board, "After setting [...] the desired position-selective layer exposure is carried out for this layer, in order to cure it in the desired shape"). The modelling plate 12 is then raised so that all solidified layers emerge from the fluid substance (Figure 3).
11. Lifting the modelling plate 12 and the solidified layers out of the container has the immediate consequence that a depression (paragraph [0024]: "Materialdefizit"; paragraph [0005]: "Freiraum", "Loch") is created in the exposed region below the

plate. This is illustrated in Figure 3. Document D8 expressly acknowledges that the high viscosity of the fluid substance prevents the depression from filling by itself (paragraph [0024]: "Aufgrund der hohen Viskosität des Materials fließt dieses jedoch nicht von selbst wieder in den belichteten Bereich [...] zurück" or, translated by the board, "Due to the high viscosity of the material, however, it does not flow by itself back into the exposed region"; paragraph [0005]: "da das hochviskose Material aufgrund seiner hohen Viskosität nicht ohne weiteres aus den umgebenden Bereichen nachfließt" or, translated by the board, "since the material due to its high viscosity does not readily flow back from the surrounding regions"). The aim of document D8 is therefore to effectively supply photopolymerisable material to depressions formed in the exposed region of the container (paragraph [0006]). This is done by moving an elongated mixing element 32 below the surface of the fluid substance. According to paragraphs [0014] and [0033] of document D8, the mixing element moves from one side of the container through the exposed region below the modelling plate to the other side of the container, possibly followed by a reverse movement. A comparison of the successive phases of the method as shown in Figures 3 and 4 confirms that it is the movement of the mixing element that is responsible for redistributing the fluid substance in the container to fill the depression and level the surface of the fluid substance. Hence, in the board's view, features **e**, **fc** and **fe** are also disclosed by document D8.

12. The respondent argued that features **e** and **fc** were not disclosed by document D8. Its view was based on the assumption that the mixing element 32 of document D8 was not directly responsible for filling the depression

and levelling the surface of the fluid substance. This, in turn, was attributed to the shape of the mixing element shown in Figures 1 to 6. Unlike the patent, the elongated wire did not push the fluid substance into the depression.

It is true that the movement of the wire-like mixing element 32 in the first embodiment of document D8 entrains or *drags* (paragraph [0008]: "Mitziehen"), rather than *pushes*, the highly viscous photopolymerisable material in the container. According to paragraph [0025] of document D8, the viscous material even undergoes a slight upward movement ("eine leichte Aufwärtsbewegung"). But the wording of claim 1 does not specify how the fluid substance is set in motion. It certainly does not require it to be pushed by the levelling means. Instead, the fluid substance is redistributed "so as to fill the depression" (feature **fc**), the redistribution process taking place "by moving said levelling means" (feature **fe**). This is exactly what happens when the wire-shape mixing element 32 of document D8 moves in the container. It entrains and locally lifts the highly viscous photopolymerisable material so that the material flows from the peripheral regions of the container to the depleted region below the modelling plate. There, the highly viscous photopolymerisable material will flow into the depression. Unavoidably, gravity will play an auxiliary role during the filling process, like in the method described in the contested patent. Ultimately, however, it is the mixing element that is responsible for setting in motion and redistributing the fluid substance. And since its movement will cause the surface of the viscous material to drop in the peripheral region and to rise in the depleted region below the modelling plate, the mixing element

effectively evens out the inequalities in the surface level caused by the depression. In other words, the mixing element serves as a levelling means.

13. This view is, if anything, reinforced when considering the embodiments of Figures 7 to 9 of document D8. According to the figure description in paragraph [0019], the mixing elements shown in these figures are further embodiments of the mixing element depicted in Figures 1 to 5. Therefore, the machine and the method steps disclosed in the context of Figures 1 to 4 also find application in combination with the mixing elements of Figure 7, 8 or 9. There can be little doubt that the movement of the elongated plate of Figure 7 or 8 or of the wing-like profile of Figure 9 will push highly viscous photopolymerisable material from the peripheral region of the container to the depleted region below the modelling plate to fill the depression caused by the movement of the solidified layer.

14. In view of the above, the subject-matter of claim 1 as granted lacks novelty over document D8 (Article 54(1) and (3) EPC). The ground for opposition under Article 100(a) together with Article 54(1) EPC therefore prejudices the maintenance of the patent as granted.

Admittance of the auxiliary requests

15. The amended claims of auxiliary requests 1, 1A, 3 and 4 were all filed after notification of the summons to oral proceedings. As the summons was notified after 1 January 2020, the transitional provisions of Article 25(1) and (3) RPBA 2020 stipulate that these requests are subject to Article 13(2) RPBA 2020, under which any amendment to a party's appeal case made after notification of a summons to oral proceedings is, as a

rule, not to be taken into account unless there are exceptional circumstances justified with cogent reasons by the party concerned.

16. In accordance with the explanatory remarks on Article 13(2) RPBA 2020 in section VI of document CA/3/19, this provision implements the third level of the convergent approach applicable in appeal proceedings. The underlying principle of the convergent approach is that, as the appeal proceedings progress, it becomes increasingly difficult for parties to amend their cases. The third level comes into effect at an advanced stage of the appeal proceedings (here, after the summons was notified), when a party has made its complete appeal case and any amendments to that appeal case which may have been appropriate under Article 13(1) RPBA 2020 (see T 2125/18, Reasons 2.1). It imposes the most stringent limitations on a party wishing to amend its appeal case at this advanced stage. Only if exceptional circumstances are shown to exist may the board, in exercising its discretion, admit the amendment made to the party's appeal case.

17. The respondent essentially argued that the board's provisional opinion on the admittance of document D8 set out in the communication pursuant to Article 15(1) RPBA 2020 meant that the circumstances under which the auxiliary requests were filed were exceptional.

The board is not persuaded that this is so.

The section "Admittance of document D8" on pages 7 and 8 of the board's communication provided the relevant legal basis, it summarised the appellant's reasons given on page 2 of its letter dated 30 December 2019 and highlighted the criteria the board had to weigh up

when exercising its discretion whether to admit the late-filed document. The board's preliminary findings on the *prima facie* relevance in point 17 of the communication were entirely based on the appellant's submissions presented in section 1.1 ("The disclosure of document D8 is *prima facie* highly relevant and seriously prejudices the validity of the patent-in-suit in its entirety (see below at section 1.2)") and section 1.2 of its letter dated 30 December 2019. As the respondent had not reacted to the appellant's submissions regarding document D8 at the time the communication was issued, the board's tentative view in point 18 of the communication ("the board is inclined to exercise its discretion and to admit the submission under Article 13(1) RPBA 2020") was based solely on the appellant's submissions. It can therefore not have come as a surprise to the respondent. The same applies to the board's preliminary assessment in the subsequent section "Novelty objection over document D8" on pages 8 and 9 of the communication, which was entirely based on the appellant's submissions set out in section 1.2 of its letter dated 30 December 2019.

In consequence, the board's provisional opinion on document D8 could not be regarded as creating exceptional circumstances within the meaning of Article 13(2) RPBA 2020 (see also "Case Law of the Boards of Appeal of the European Patent Office", tenth edition, July 2022, V.A.4.5.6.c).

18. In a further line of argument, the respondent justified exceptional circumstances by submitting that it was highly improbable that late-filed documents were admitted in appeal.

While the board acknowledges that already at the second level of the convergent approach strict conditions apply, the question whether late-filed evidence is admitted in appeal proceedings under Article 13(1) RPBA 2020 is actually very much dependent on the circumstances of the case. It therefore serves little purpose to assign a probability to the admission of late-filed evidence, let alone to use that probability as justification that the circumstances two-and-a-half years after the evidence had been filed were exceptional.

19. The respondent further argued that it should be given the opportunity to react to the belated filing of document D8 and amend the claims accordingly. Reference was made to Article 113(1) EPC.

Article 113(1) EPC enshrines the fundamental right of a party to be heard before a decision is issued against it. Neither this provision nor the principle of party disposition expressed in Article 113(2) EPC, according to which the EPO is forbidden from considering and deciding upon any text of an application or a patent other than that "submitted to it, or agreed, by the applicant or proprietor of the patent ...", give any right to an applicant or patent proprietor in the sense that the EPO is in any way bound to consider a request for amendment put forward by the applicant or patent proprietor (see also G 7/93, Reasons 2.1).

The right to file amended claims is defined in Article 123(1) EPC *in accordance with the Implementing Regulations*. These provisions, and not Article 113 EPC, set the conditions for taking amendments to the claims into account.

Since the parties in the present case have not objected as to which provision in the EPC provides a legal basis for the discretion to admit amendments to claims, the present board does not see a need to discuss whether Article 123(1) EPC or also Article 114(2) EPC and/or Rule 116(2) EPC constitute an appropriate legal basis. With a view of deciding the underlying case, the present board concurs with the jurisprudence having found that the first sentence of Article 123(1) EPC in conjunction with Rules 81(3) and 100(1) EPC gives the deciding organ a discretionary power to consider amendments filed in opposition and opposition appeal proceedings (see e.g. R 6/19, Reasons 6 to 11 and T 966/17, Reasons 2.2.1). According to Rule 81(3) EPC, the opportunity for a patent proprietor to amend the description, claims and drawings in opposition proceedings is given *only where necessary*. Under Rule 100(1) EPC, this provision also applies in opposition appeal proceedings, albeit further subject to the provisions of the Rules of Procedures of the Boards of Appeal, particularly Articles 12 and 13 RPBA.

It follows that the opportunity to present comments does not inevitably extend to having any auxiliary request *submitted at any time* automatically admitted into the proceedings (see also R 9/11, Reasons 3.2.2); its admittance in the appeal proceedings is subject to the applicable provisions of the Rules of Procedure of the Boards of Appeal, in this case Article 13(2) RPBA 2020. This applies even if the auxiliary request was submitted in response to late-filed evidence. If that were not the case, Article 13(2) RPBA 2020 would have little purpose since any amendment filed after notification of a summons to oral proceedings - in the present case in response to the board's communication pursuant to Article 15(1) RPBA 2020 - would have to be

admitted, even if there were clearly no exceptional circumstances. This is not contrary to the principle of Article 113(1) EPC, according to which the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

In the current case, the respondent had the right and the opportunity to react and present their comments, including by filing amended claims, to the appellant's submissions regarding document D8. However, auxiliary requests 1, 3 and 4 were filed only with the letter dated 22 July 2022, i.e. more than two-and-a-half years after the appellant had submitted document D8 and provided detailed argument on why it was of the view that the subject-matter of claim 1 as granted lacked novelty over document D8. Auxiliary request 1A was filed a further two months later. On account of these actions, it is clear that the respondent did not wish to react to the appellant's submissions, but instead chose to wait until after the board had given its preliminary opinion in the communication pursuant to Article 15(1) RPBA 2020 to file the auxiliary requests. None of these claim amendments can thus be regarded as a timely reaction to the appellant's filing of document D8, as required by the Rules of Procedures of the Boards of Appeal. For this reason alone, the board rejects the respondent's argument that it was not given an opportunity to amend the claims in reaction to the submission of document D8.

By choosing not to react until the board had given its preliminary assessment on document D8, the admittance of the auxiliary requests became subject to the stringent limitations of Article 13(2) RPBA 2020. Under the present circumstances, however, the respondent had

the possibility and, with more than one-and-a-half years before the summons were issued, sufficient time to react to the appellant's submissions regarding document D8 by filing amended claim requests under the less stringent limitations of Article 13(1) RPBA 2020.

But even after the board's communication was issued, the respondent still had the opportunity to react and amend its appeal case. In fact, point 36 at the end of the communication drew the attention of the parties to the provision of Article 13(2) RPBA 2020, under which a limited exception is provided for amending their appeal cases. At the heart of this provision, based on the principle of Article 123(1) EPC and Rules 81(3) and 100(1) EPC, is the board's discretion to admit such an amendment. The respondent therefore had the right to react to the board's provisional opinion by filing auxiliary requests. It had the opportunity to comment on the admittance of these requests, but there was no certainty that these would be admitted (see R 1/13, Reasons 13.3 and R 6/19, Reasons 5 to 11).

20. Also, the further argument of the respondent that novelty over document D8 was discussed for the first time during the oral proceedings cannot convince the board that the circumstances warranted admitting the late-filed auxiliary requests.

The argument is based on the false premise that the discussion of the novelty objection was confined to the exchange of facts and arguments at the oral proceedings. However, the discussion whether the subject-matter of claim 1 as granted lacked novelty over document D8 was initiated with the written submissions in the appellant's letter dated 30 December 2019, i.e. when the document was filed. The fact that

the respondent chose not to present its counterarguments until the day of the oral proceedings does not alter this conclusion. Indeed, even after the board had provided a summary of the appellant's submissions in the communication pursuant to Article 15(1) RPBA 2020 and given its tentative view on the matter based solely on these submissions, the respondent replied by letters dated 22 July 2022 and 16 September 2022 without addressing the merits of the objection on novelty over document D8. It was only during the oral proceedings before the board that the respondent argued that features **e** and **fc** were not disclosed by document D8.

21. In view of the above, the board concludes that the respondent has not presented cogent reasons justifying exceptional circumstances for filing auxiliary requests 1, 3 and 4 on 22 July 2022 and auxiliary request 1A on 16 September 2022. The auxiliary requests are therefore not taken into account pursuant to Article 13(2) RPBA 2020.

Request for remittal

22. The respondent's request for remittal of the case to the opposition division for further prosecution was dependent on at least one of auxiliary requests 1, 1A, 3 or 4 being admitted in the proceedings. As none of the auxiliary requests were admitted (see point 21. above), the request for remittal is without object and has to be refused.

Conclusion

23. Since the only request taken into account by the board cannot be allowed for the reasons set out in points 9. to 14. above, the patent must be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated