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**Datasheet for the decision  
of 27 June 2023**

**Case Number:** T 1198/20 - 3.2.03

**Application Number:** 16161403.7

**Publication Number:** 3222911

**IPC:** F23C10/10, F22B31/00

**Language of the proceedings:** EN

**Title of invention:**

A FLUIDIZED BED HEAT EXCHANGER AND A CORRESPONDING  
INCINERATION APPARATUS

**Patent Proprietor:**

Doosan Lentjes GmbH

**Opponent:**

Sumitomo SHI FW Energia Oy

**Headword:**

**Relevant legal provisions:**

EPC Art. 101(1), 113(1), 116(1), 100(a), 52(1), 54, 104(1)

EPC R. 111(2), 116(1)

RPBA 2020 Art. 12(2), 12(4), 12(6), 12(3), 16(1)

**Keyword:**

Right to be heard - opportunity to comment (yes) - obligation for the opposition division to communicate their preliminary opinion (no) - appealed decision sufficiently reasoned (yes) - substantial procedural violation (no)

Novelty - main request (no)

Late-filed request - auxiliary requests 1 to 13 - admissibly raised in first-instance proceedings (no) - should have been submitted in first-instance proceedings (yes) - circumstances of appeal case justify admittance (no) - admitted (no)

Apportionment of costs - different apportionment of costs justified (no)

**Decisions cited:**

G 0012/91

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 1198/20 - 3.2.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.03**  
**of 27 June 2023**

**Appellant:** Doosan Lentjes GmbH  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 17 March 2020  
revoking European patent No. 3222911 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** C. Herberhold  
**Members:** M. Olapinski  
N. Obrovski

## **Summary of Facts and Submissions**

- I. The appeal was filed by the patent proprietor against the opposition division's decision to revoke the patent in suit.

The opposition division decided without oral proceedings, finding *inter alia* that claim 1 as granted was not novel in view of either of documents E1 and E7.

- II. Oral proceedings were held before the Board.

- III. At the end of the oral proceedings, the requests were as follows.

The appellant (patent proprietor) requested that the decision under appeal be set aside and the case be remitted to the opposition division with the order to issue a communication under Article 101(1), second sentence, EPC, giving more specific reasons for the opposition division's understanding of the claim language. As auxiliary measures, the appellant requested that the patent be maintained as granted, that the patent be maintained as amended on the basis of one of auxiliary requests 1 to 13 filed with the statement of grounds of appeal, or that the case be remitted to the opposition division for further prosecution on the basis of auxiliary requests 1 to 13.

The respondent (opponent) requested that the appeal be dismissed and that a different apportionment of costs be ordered in view of the late filing of the auxiliary requests. It also requested that the case not be remitted to the opposition division and that none of the auxiliary requests be admitted.

IV. Claim 1 as granted (main request) reads as follows:

"A fluidized bed heat exchanger, which comprises a runner (20), at least one inlet opening (18), a heat exchange zone (40) and at least one outlet opening (48), arranged to each other in a way to allow a stream of solids, deriving from an associated combustor (C), to enter the heat exchanger (10) via said opening (18), to pass through said heat exchange zone (40) and to leave the heat exchanger (10) via said outlet opening (48), wherein

a) the Inlet opening (18) is arranged at an upper part of the runner (20),

b) the runner (20) extends downwardly from an upper section of the heat exchanger towards a bottom-section (16r) of the heat exchanger (10) and ends close to said bottom-section (16r), thereby allowing a downwardly oriented flow of the solids through said runner (20),

c) the runner (20) is open at its end close to said bottom-section (16r), thereby providing at least one passage (TR) for the solids to leave the runner (20) and to flow into at least one heat exchange zone (40), which is arranged adjacent to said runner (20) and provided with a fluidized bottom (16c),

*characterized in that,*

d) the outlet opening (48) is arranged at an upper part of the heat exchanger (10) and extends from the at least one heat exchange zone (40) as part of an outlet channel (46), which outlet channel (46) extends from said heat exchange zone (40) through said runner (20)

to an aperture (47) in an outer wall (14a) of the heat exchanger (10)."

V. In the present decision, reference is made to the following documents:

E1: US 5 218 931

E7: US 5,325,823

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

*Alleged substantial procedural violations and request for remittal*

The opposition division had not met its obligation to communicate its preliminary opinion and to invite the parties to file their observations pursuant to Article 101(1), second sentence, EPC before issuing its decision. Moreover, the decision under appeal did not take into account the appellant's submissions and auxiliary requests filed on 11 March 2020. Lastly, the decision under appeal was not sufficiently reasoned in respect of the division's understanding of claim 1. For these reasons, the parties' right to be heard had not been respected. Hence, the request for the case to be remitted to the department of first instance with the order to issue a communication and invitation under Article 101(1), second sentence, EPC was justified.

*Main request - Novelty*

The subject-matter of claim 1 as granted was novel with respect to document E1.

*Auxiliary requests 1 to 13 - Admittance*

Auxiliary requests 1 to 13 were based on auxiliary requests 1 to 6 filed with the letter of 11 March 2020 during the opposition proceedings and combinations of these as indicated in said letter. They addressed the opposition division's understanding of claim 1 in the decision under appeal. Even though the opposition proceedings had already ended on 10 March 2020, the auxiliary requests were only two days late. Hence, the circumstances of the appeal case justified these requests being admitted on appeal.

*Different apportionment of costs*

It was the appellant's responsibility to present its complete case with the statement of grounds of appeal. Filing and maintaining auxiliary requests was part of the appellant's due diligence and did not represent a culpable action or abuse of procedure. A different apportionment of costs was thus not justified.

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

*Alleged substantial procedural violations and request for remittal*

There was no procedural violation in issuing the decision under appeal without first setting out a preliminary opinion and without considering the auxiliary requests and submissions filed on 11 March 2020. Moreover, the decision was sufficiently reasoned. Hence, the case should not be remitted to the opposition division.

*Main request - Novelty*

The subject-matter of claim 1 as granted lacked novelty with respect to document E1.

*Auxiliary requests 1 to 13 - Admittance*

Auxiliary requests 1 to 13 should have been filed with the appellant's reply to the notice of opposition. No reasons had been submitted as to why they could only be filed on appeal and not with said reply. There was nothing new in the decision to which the auxiliary requests could be considered a reaction. The auxiliary requests should thus not be admitted.

*Different apportionment of costs*

Submitting auxiliary requests 1 to 13 at the appeal stage, maintaining them in spite of the Board's preliminary opinion and the lack of convergence, target-orientation and substantiation of these requests caused extra work and expense on the respondent's part. This was also true for the appellant's further submissions filed shortly before the oral proceedings, which had even forced the respondent's representative to postpone his holidays. As these costs were caused by the appellant's conduct, a different apportionment of costs was justified.



## Reasons for the Decision

1. Alleged substantial procedural violations and request for remittal
  - 1.1 In its reply to the notice of opposition received on 4 November 2019, the patent proprietor had not requested oral proceedings or filed any auxiliary requests. On 11 March 2020, the patent proprietor filed a further submission together with six auxiliary requests.
  - 1.2 The decision under appeal was issued without oral proceedings and only deals with the patent as granted. It does not take into account the submissions and requests of 11 March 2020 and does not give reasons for this. The decision bears the date of despatch of 17 March 2020 (date stamp on sheet 1 of Form 2331) but had been handed over to the EPO postal service on 10 March 2020 by the opposition division's formalities department (as indicated on sheet 2 of Form 2331).
  - 1.3 With the statement of grounds of appeal (page 19, last paragraph) the appellant submitted that "*[a]t the beginning of the letter dated 11 March 2020 it was also emphasized that a preliminary opinion of the Opposition Division is expected. If the Opposition Division would have issued an invitation to file observations on its understanding of granted claim 1 according to Art. 101 (1), second sentence EPC the auxiliary requests would have been considered already in the first instance, given both parties the right to be heard for the auxiliary requests*".

The Board takes these statements as a rebuke of a violation of the parties' right to be heard, firstly

because the opposition division did not set out its preliminary opinion together with an invitation to file observations before issuing its decision and secondly because the decision under appeal does not take into account the appellant's submissions and auxiliary requests of 11 March 2020.

In its statement of grounds of appeal, the appellant further submitted that its right to be heard had been infringed because the decision was not sufficiently reasoned. In its view, the opposition division did not reason how it came to its interpretation of certain claim features, in particular its finding that "the wording of the granted claim does not exclude the possibility of part of the stream of solid particles bypassing the heat exchange zone" (points 10.3 and 11.3). The division also failed to give reasons why the proprietor's interpretation of the patent as granted (points 10.2 and 11.2) was incorrect, why the compartments 90 of E1 embodied the claimed "outlet channel" - despite having bypass openings 84a - and why the "seal pot segment" 92b of E7 without heat exchange means could be considered the claimed "heat exchange zone".

For these reasons, the appellant requested that the case be remitted to the opposition division with the order to issue a communication under Article 101(1), second sentence, EPC, giving reasons for the division's understanding of the claim language.

#### 1.4 Article 101(1), second sentence, EPC

Article 113(1) EPC stipulates that 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". Article 101(1), second sentence, EPC requires the opposition division to invite the parties to file observations on communications from another party or issued by itself "as often as necessary" in order to satisfy the right to be heard as per Article 113(1) EPC.

However, contrary to the appellant's assertion, Article 101(1), second sentence, EPC does not require the opposition division to send a communication with a preliminary opinion before giving its decision. In addition, not issuing at least one communication under Article 101(1) EPC cannot in itself substantiate an assertion of an infringement of the right to be heard (see Case Law of the Boards of Appeal of the EPO, 10th edition, 2022, IV.C.6.2).

On 4 July 2019, the opposition division had indeed issued a communication to the patent proprietor with a request to file its observations on the notice of opposition. On 4 November 2019, the patentee filed its reply to the notice of opposition. The opposition division based its decision on the grounds and evidence set out in the notice of opposition, i.e. on grounds and evidence on which the patent proprietor had already had an opportunity to present its comments. Hence, the requirements of Article 113(1) EPC are fulfilled.

As the patent proprietor had not requested oral proceedings as per Article 116(1) EPC, the proceedings could be concluded with the decision to revoke the patent in written proceedings. Hence, there was also no need to issue a summons accompanied by a preliminary opinion and fixing a final date for making written submissions according to Rule 116(1) EPC.

1.5 Auxiliary requests and submissions of 11 March 2020

The date of 17 March 2020 stamped on sheet 1 of Form 2331 of the decision under appeal corresponds to the date of despatch of the decision. However, pursuant to decision G 12/91 (see the order and point 1 of the Reasons), the relevant date on which the decision-making process is completed and after which it is no longer possible to take account of further party submissions is the date on which the decision is handed over to the EPO postal service by the decision-taking department's formalities section. In the case in hand, the decision under appeal had been handed over to the EPO postal service on 10 March 2020 (as indicated on sheet 2 of Form 2331).

Hence, the auxiliary requests and letter filed one day later, on 11 March 2020, arrived when the decision-making process had already been completed and the proceedings before the opposition division terminated. Therefore, these submissions (including the statement at the beginning of the letter that a preliminary opinion of the opposition division was expected) could not be taken into account in the decision under appeal. In fact, the opposition division was not even competent to do so anymore. Accordingly, the fact that the auxiliary requests and the reply filed on 11 March 2020 were not taken into account in the decision under appeal and that no reasons are given for disregarding them is procedurally correct and does not violate the right to be heard.

1.6 Alleged lack of reasoning

The appellant rightfully pointed out that the requirement of a reasoned decision under Rule 111(2)

EPC forms an important aspect of the right to be heard, as it allows to ascertain whether the comments submitted by the parties have been duly considered.

In the case in hand, the patent proprietor was aware of the ground (lack of novelty) and the evidence (E1, E7) submitted by the opponent. The notice of opposition also specified which specific elements of E1 and E7 were considered to correspond to the features of claim 1 as granted.

In its reply to the opposition, the patent proprietor submitted a number of arguments, which are, as conceded by the appellant, more or less correctly summarised in the decision under appeal (points 10.2 and 11.2).

In the Board's view, the decision under appeal sufficiently addresses each of these arguments in its reasons. The level of detail of the reasons corresponds to the level of detail with which the patent proprietor's arguments were presented. For example, the proprietor did not explain in more detail why, in its view, claim 1 as granted excluded the possibility of a stream of solids bypassing the heat exchange zone. The opposition division thus cannot be expected to set out in more detail why it could not derive this restriction from the wording of claim 1.

Hence, the reasoning in the decision under appeal shows that each of the comments provided by the patent proprietor was heard and duly considered.

1.7 Accordingly, in the Board's view the decision under appeal fulfils the requirement of a reasoned decision, and the right to be heard has been fully respected. The

Board cannot discern any substantial procedural violation.

1.8 Without a substantial procedural violation, the Board also sees no reason to remit the case in hand to the opposition division.

2. Main request - Novelty

2.1 In line with the decision under appeal and as submitted by the respondent, E1 discloses:

A fluidized bed heat exchanger ("integral recycle heat exchanger", col. 1, lines 8-14; heat exchange zone 80, Figure 1; col. 9, lines 10-19), which comprises a runner (part of troughs 76, 78 including compartments 88 but not compartments 90, at the lower end of the troughs), at least one inlet opening (along the troughs), a heat exchange zone (80) and at least one outlet opening (openings 22c, 24c), arranged to each other in a way to allow a stream of solids, deriving from an associated combustor (28, 30), to enter the heat exchanger via said [inlet] opening, to pass through said heat exchange zone (heat exchange section 80) and to leave the heat exchanger via said outlet opening, wherein

a) the inlet opening is arranged at an upper part of the runner,

b) the runner (76, 78, 88) extends downwardly from an upper section of the heat exchanger towards a bottom-section of the heat exchanger and ends close to said bottom-section, thereby allowing a downwardly oriented flow of the solids through said runner (Figure 1),

c) the runner (76, 78, 88) is open at its end close to said bottom-section (openings 22b, 24b in the compartments 88, Figures 2 to 5), thereby providing at least one passage for the solids to leave the runner and to flow into at least one heat exchange zone (80), which is arranged adjacent to said runner and provided with a fluidized bottom (col. 9, lines 10-19), wherein

d) the outlet opening (22c, 24c) is arranged at an upper part of the heat exchanger (Figure 1) and extends from the at least one heat exchange zone (80) as part of an outlet channel (compartments 90, Figures 2 to 5), which outlet channel extends from said heat exchange zone through said runner (76, 78, 88) to an aperture (openings 20b, 26b, Figures 1 to 5) in an outer wall (20, 26) of the heat exchanger.

2.2 The appellant submitted the following counter-arguments.

2.2.1 Claim 1 required an arrangement of a heat exchanger with a runner, an inlet opening, a heat exchange zone and an outlet opening such that "a stream of solids" fulfilled the three conditions "to enter the heat exchanger via said opening, to pass through said heat exchange zone and to leave the heat exchanger via said outlet opening". According to the appellant's understanding, the stream of solids was defined by the solids deriving from an associated combustor and entering the heat exchanger via said opening. Hence, claim 1 required that the entire "stream of solids which enters the heat exchanger" via an inlet opening at an upper part of the runner had "to pass through said heat exchange zone and to leave the heat exchanger via said outlet opening". Owing to this wording, claim

1 excluded the possibility that a substream of the solids could bypass the heat exchange zone.

E1, however, disclosed bypass openings (84a, 86a) directly connecting the compartments 88 and 90 and bypassing the heat exchange section 80 (column 7, lines 23-28). Therefore, the stream of solids entering the inlet opening did not entirely pass through the heat exchange zone as required by claim 1.

Even during "steady-state operation" when according to E1 "the solids in the compartments 88 pass through the openings 22b and 24b into the heat exchange section 80" by fluidising the heat exchange section (column 8, line 67 to column 9, line 26), the bypass openings remained open, so some solids would bypass the heat exchange section contrary to claim 1.

Moreover, the bypass openings in E1 provided locations at which plugging and a discontinuous flow could occur and were thus incompatible with the objectives of the invention according to paragraph [0015].

Consequently, E1 did not disclose a heat exchanger with an arrangement as defined in the first paragraph of claim 1.

2.2.2 Due to the bypass openings, the compartments 90 did not qualify as an "outlet channel" which "extends from said heat exchange zone [...] to an aperture in an outer wall of the heat exchanger" according to feature d) of claim 1. The bypass openings allowed alternative flow paths, e.g. from the heat exchange zone back into the compartments 88. Hence, the compartments 90 did not fulfil the function and definition of the "outlet channel" according to claim 1.



2.2.3 In the statement of grounds of appeal, the appellant initially submitted the further counter-argument that even if the compartments 90 were regarded as an "outlet channel", they did not "extend through said runner". According to the appellant's letter of 13 June 2023, this argument was based on the understanding that the runner was embodied by a (single) compartment 88. In the same letter, the appellant acknowledged that - when construing the runner as a comb-like structure comprising a trough 76/78 and the compartments 88 as set out under point 6.3.3 of the Board's preliminary opinion - the compartments 90 could be considered to "extend through" the adjacent compartments 88 of the runner. Hence, the Board understands this to mean that said counter-argument, which was not used during the oral proceedings either, was not maintained.

2.3 The Board is not convinced by the appellant's counter-arguments for the following reasons.

E1 discloses two operating modes, according to which the flow path of the solids can be selected by controllably and separately fluidising either the compartments 88 or the heat exchange section from below (column 8, line 67 to column 9, line 26). The bypass openings are only used during start-up. During steady-state operation, "the solids in the compartments 88 pass through the openings 22b and 24b into the heat exchange section 80". In addition to the unimpeded flow by gravity, a slight positive pressure difference between the compartments 90 and 88 due to the fluidisation of the heat exchange section during "steady-state operation" prevents particles from using the bypass route. Hence, during steady-state operation

the bypass openings are explicitly disclosed as being functionally closed.

Even if the possibility of some solids nevertheless entering the bypass openings cannot be entirely excluded, such a degree of particle loss is negligible and covered by the skilled person's understanding of the claimed feature. Similarly, in the embodiments according to the patent the possibility of some loss from the stream due to particle deposition cannot be excluded but would not be considered to fall beyond the scope of the claim.

For the issue of novelty, it is immaterial whether the bypass openings in E1 provide locations at which plugging and a discontinuous flow could occur, contrary to the objectives of the patent according to paragraph [0015], because these objectives are not specified in claim 1 and so do not limit its subject-matter (see Case Law of the Boards of Appeal of the EPO, 10th edition, 2022, II.A.6.3.4).

For these reasons, in E1 the components are arranged in a way that, in the appellant's words, allows the entire "stream of solids which enters the heat exchanger" via an opening at an upper part of the runner "to pass through said heat exchange zone and to leave the heat exchanger via said outlet opening". Hence, regardless of whether the narrow claim interpretation submitted by the appellant or the broader claim interpretation adopted by the opposition division is accepted, E1 explicitly discloses an arrangement of the heat exchanger's components as defined in claim 1.

- 2.3.1 It appears that the appellant is of the opinion that a "channel" may not have junctions and branch

connections, and that, when a "channel" is defined as extending from one location to another, it cannot have additional openings and connections to further locations. The Board, however, does not agree with this understanding.

The compartments 90 "extend from the heat exchange zone" (openings 22c, 24c) and "to an aperture in an outer wall of the heat exchanger" (openings 20b, 24b in the outer walls 20, 24). The fact that the compartments 90 also extend to compartments 88 via bypass openings (84a, 86b) defining a branch connection does not disqualify them as an "outlet channel".

Hence, the compartments 90 represent an outlet channel as defined in feature d) of claim 1.

2.4 Accordingly, E1 discloses all the features of claim 1 as granted, the subject-matter of which is thus not novel.

2.5 The maintenance of the patent as granted is therefore prejudiced by the ground of opposition under Article 100(a) EPC in conjunction with the requirement of novelty according to Articles 52(1) and 54 EPC.

3. Auxiliary requests 1 to 13 - Admittance

3.1 As the proceedings before the opposition division had already been terminated on 10 March 2020, when the decision was handed over to the internal postal service (see above), the auxiliary requests filed on 11 March 2020 were not filed "in the proceedings leading to the decision under appeal" within the meaning of Article 12(4) RPBA 2020.

- 3.2 Accordingly, auxiliary requests 1 to 13 filed with the statement of grounds of appeal represent an amendment as per Article 12(4) RPBA 2020, the admittance of which is subject to the provisions of Article 12(4) and (6) RPBA 2020.
- 3.3 The appellant submitted that auxiliary requests 1 and 13 had been filed "in response to the opposition division's understanding of claim 1" (statement of grounds of appeal, pages 11 and 19) and that "[f]or each auxiliary request a reason and explanation in view of the foregoing argumentation and reasoning of the opposition division was given" (letter of 22 February 2021, page 9, fourth paragraph).
- 3.4 The Board does not deny that each of auxiliary requests 1 to 13 addresses and tries to overcome the findings in the opposition division's decision. However, this does not mean that the issues they address were not in play before and only became apparent in the opposition division's written decision. The Board is not aware of any such new issue in the decision under appeal - nor did the appellant assert any. In particular, whether the presence of a bypass can be considered a distinguishing feature (see the decision under appeal, reasons 10.3) had already been discussed by the appellant in its reply to the notice of opposition (see the second-to-last paragraph on page 2, the paragraph bridging pages 2 and 3 and the last paragraph on page 3). Moreover, some of the auxiliary requests had already been filed on 11 March 2020 when, as the appellant itself stated, it was not even aware that the opposition division had issued a decision. In sum, this indicates that these requests could and should already have been filed in reply to the notice of opposition.

Lastly, auxiliary request 13 only concerns the deletion of a passage from the description. But this passage was not used to the appellant's disadvantage in the decision under appeal, and its deletion cannot thus be seen as a reaction to the decision under appeal.

Hence, the Board concludes that the auxiliary requests address issues which had already been raised in the notice of opposition, and so they "should have been submitted [...] in the proceedings leading to the decision under appeal". Under Article 12(6) RPBA 2020, the Board "shall not admit" such requests, "unless the circumstances of the appeal case justify their admittance".

- 3.5 The patent proprietor's choice during the opposition proceedings not to request oral proceedings and not to file the auxiliary requests at an earlier point in time, in particular together with its reply to the notice of opposition within the time limit set by the opposition division, do not qualify as circumstances of the appeal case that justify the admittance of these requests on appeal. The patent proprietor's unmet (and unjustified; see point 1.4 above) expectation of receiving a preliminary opinion with another opportunity to react before the opposition division's decision was issued does not represent such circumstances either.

In its statement of grounds of appeal and its letter of 22 February 2021, the appellant assumed that the auxiliary requests submitted on 11 March 2020 had been admissibly filed during the opposition proceedings. It submitted that auxiliary requests 1 to 12 filed with the statement of grounds of appeal represented combinations of the earlier auxiliary requests that had

already been proposed when the requests of 11 March 2020 were filed. At the oral proceedings, the appellant argued that the auxiliary requests of 11 March 2020 would have become part of the opposition proceedings had they been filed just two days earlier. In view of this small time difference, it was justified to admit the auxiliary requests on appeal.

For the Board, the main issue as regards the auxiliary requests not being submitted and considered in the first-instance proceedings is not that they were filed two days late but rather that they were not filed together with the reply to the notice of opposition around four months earlier (in combination with the decision not to request oral proceedings and the misconception of the opposition proceedings regarding the expectation of a preliminary opinion before any adverse decision is taken). Hence, the Board cannot accept that the circumstances of the case justify the admittance of these requests in the appeal proceedings.

Last but not least, dealing with these auxiliary requests would not be in line with the "primary object of the appeal proceedings to review the decision under appeal in a judicial manner" either (Article 12(2) RPBA 2020).

3.6 For these reasons, auxiliary requests 1 to 13 are not admitted into the appeal proceedings.

4. Different apportionment of costs

4.1 The respondent requested a different apportionment of costs under Article 104(1) EPC and Article 16(1) RPBA 2020.

It argued that the filing of the auxiliary requests for the first time at the appeal stage not only went beyond the framework of the appeal proceedings pursuant to Article 12(2) RPBA, calling into question their admittance, but also inequitably led to the respondent incurring extra costs. Although the requests were ultimately not admitted, it had nevertheless been necessary to prepare the discussion on admittance and to decide how to deal with them in substance at the oral proceedings in the event they were admitted. This was all the worse in the case in hand because the auxiliary requests were directed to different, non-converging restrictions instead of addressing the core issue in the decision under appeal, that is, whether the entire incoming stream had to pass through the heat exchange zone and bypass routes were excluded. Furthermore, on 13 June 2023 the appellant filed further submissions shortly before the oral proceedings, leading the respondent's representative to postpone his holidays. In this letter, the appellant submitted arguments regarding the main request but did not address the auxiliary requests, despite the Board already having indicated its intention not to admit them. Hence, instead of withdrawing its auxiliary requests, the appellant maintained the uncertainty for the respondent, which necessitated the above-mentioned preparation. As these extra costs were caused by the appellant's conduct, they should be borne by the appellant.

- 4.2 The Board does not agree with the respondent's request and arguments for the following reasons.

Under Article 104(1) EPC, each party to opposition proceedings must, as a rule, bear the costs it has

incurred. An exception to this rule may only be ordered for reasons of equity.

According to the established case law, such reasons of equity are acknowledged if costs arise from culpable actions of another party, such as irresponsible or even malicious conduct or an abuse of procedure (see Case Law of the Boards of Appeal of the EPO, 10th edition, 2022, III.R.2). Article 16 RPBA 2020 lists examples of specific situations in which an apportionment of costs may be justified. The Board notes that this article mentions only amendments under Article 13 RPBA but not amendments under Article 12 RPBA - which occur at the earliest stage of the appeal proceedings.

In any case, as submitted by the appellant, it was part of its due diligence to present (and maintain) its complete case, including all requests, with the statement of grounds of appeal in view of Article 12(3) RPBA 2020. The Board does not consider the appellant's conduct in this respect to be culpable, irresponsible, malicious or even abusive.

Moreover, preparations for discussing the admittance and substance of auxiliary requests are part of the normal work that can be expected of any party (see Case Law, III.R.2.1, penultimate paragraph).

In addition, it appears that it was not the belatedness of the auxiliary requests that caused the expense but rather their very filing. The respondent did not establish that it would have incurred less effort and costs if the auxiliary requests had been filed during the opposition proceedings as actually intended by the appellant. Under these circumstances, the alleged deficiencies of the auxiliary requests regarding



convergence, target-orientation and substantiation and their maintenance in the appeal proceedings do not justify a different apportionment of costs either.

The submissions in the appellant's letter of 12 June 2023 filed shortly before the oral proceedings concern arguments in reply to the Board's preliminary opinion, and providing them is considered normal and appropriate behaviour on the appellant's part.

4.3 Hence, the respondent's request for a different apportionment of costs cannot be granted.

## Order

### **For these reasons it is decided that:**

1. The appeal is dismissed.
2. The request for a different apportionment of costs is refused.

The Registrar:

The Chairman:



C. Spira

C. Herberhold

Decision electronically authenticated