

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [X] To Chairmen
- (D) [-] No distribution

**Datasheet for the decision
of 14 November 2023**

Case Number: T 1220/21 - 3.3.06

Application Number: 08784861.0

Publication Number: 2217438

IPC: B32B17/10, B32B27/30,
G02B27/01, B60J1/00

Language of the proceedings: EN

Title of invention:

CURVED VEHICLE WINDSHIELD MADE FROM LAMINATED GLASS

Patent Proprietor:

SAINT-GOBAIN GLASS FRANCE

Opponent:

Pilkington Group Limited

Headword:

Avoiding double images in Head-Up Display/Saint-Gobain

Relevant legal provisions:

EPC Art. 56, 100(a)

RPBA 2020 Art. 12(3), 12(5), 13(2), 12(4)

Keyword:

Inventive step - (no)
Statement of grounds of appeal - party's complete appeal case
Discretion not to admit submission - requirements of Art.
12(3) RPBA 2020 met (no) - submission admitted (no)
Amendment after summons - exceptional circumstances (no) -
taken into account (no)

Decisions cited:

T 2115/17, T 1659/20, T 0420/14, T 1732/10, T 1426/17,
T 0568/14, T 2598/12

Catchword:

1. According to Article 12(3) and (5) RPBA 2020, a lack of or an insufficient substantiation of an amended request may lead to the non-admittance of this request. This does however not imply that the request has not been validly filed (reasons 4.2).
2. The admittance of an amended request which is not expressly substantiated pursuant to Article 12(3) RPBA 2020 is at the discretion of the Board under Article 12(5) RPBA, even if the amendments are self-explanatory (reasons 4.3.2).
3. The substantiation of an amended request under Article 12(3) RPBA 2020 includes the primary duty of the proprietor to indicate the basis for the amendments in the application as originally filed, even if no objection under Article 123(2) EPC has been previously raised (reasons 4.3.3 (a) and 4.4.5 (c)).
4. Information that can only be found in attached documents, without an explicit reference and explanation by the party, cannot be regarded as sufficient substantiation pursuant to Article 12(3) RPBA 2020 (reasons 4.4.6.(c)).
5. The discretion not to admit a request under Article 12(5) RPBA 2020 may be exercised by taking into account the extent to which a lack of or an insufficient substantiation prevents the Board and/or the other party(ies) from recognising the proprietor's intentions (reasons 4.5.1).



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1220/21 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 14 November 2023

Appellant: Pilkington Group Limited
(Opponent) Hall Lane
Lathom
Nr. Ormskirk
Lancashire L40 5UF (GB)

Representative: Fortt, Simon Merton
Pilkington Group Limited
Intellectual Property
European Technical Centre
Hall Lane
Lathom
Ormskirk, Lancashire L40 5UF (GB)

Respondent: SAINT-GOBAIN GLASS FRANCE
(Patent Proprietor) Tour Saint-Gobain
12 place de l'Iris
92400 Courbevoie (FR)

Representative: Gebauer, Dieter Edmund
Splanemann Patentanwälte mbB
Rumfordstraße 7
80469 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 1 June 2021
rejecting the opposition filed against European
patent No. 2217438 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: S. Arrojo
 J. Hoppe

Summary of Facts and Submissions

- I. An appeal was filed by the opponent against the decision of the opposition division rejecting the opposition against European patent No. 2 217 438.
- II. In the statement of grounds of appeal, the appellant argued that the invention as granted was insufficiently disclosed and lacked inventive step in view of the disclosure of D1 (US 6,414,796 B1) combined with common general knowledge or D2 (US 5,013,134), D3 (US 2004/0166288) combined with D2, or D2 combined with D3. The invention according to auxiliary requests 1 to 3 was also insufficiently disclosed and not inventive. The invention according to auxiliary requests 2 and 3 furthermore extended beyond the content of the application as filed.
- III. In its reply dated 24 February 2022, the proprietor defended the patent as granted and filed three sets of amended claims as auxiliary requests 1 to 3, which correspond to those auxiliary requests filed during first instance proceedings.
- IV. Claim 1 as granted (**main request**) reads:
- "1. A curved vehicle windshield made from laminated glass, the curved vehicle windshield comprising an outer surface and an inner surface, the outer surface and the inner surface forming a continuously changing wedge angle with each other in one or more regions for prevention or reduction of interfering double images, the wedge angles depending on a respective local angle of incidence of light beams and on a respective local radius of curvature of the curved vehicle windshield,*

the curved vehicle windshield having a head-up display (HUD) viewing field, wherein the continuously changing wedge angles change continuously from the bottom edge to the top edge of the HUD viewing field such that it compensates the double images at every point on the vertical center line of the HUD viewing field."

Claim 1 of **auxiliary request 1** corresponds to that of the main request with the additional feature: "*..., wherein the continuously changing wedge angles are incorporated into an intermediate film*".

- V. In its preliminary opinion, the Board indicated that claim 1 of the main request was not inventive starting from D3 or from D1 as closest prior art, claim 1 of auxiliary request 1 did not appear to be inventive when starting from D3 as closest prior art, and certain clarifications were required in order to assess the patentability of auxiliary requests 2 and 3. The Board also indicated that auxiliary requests 1 to 3 had not been substantiated, so that their admittance under Articles 12(3) and (5) RPBA 2020 was at stake and would have to be discussed at the oral proceedings.
- VI. In a submission dated 14 September 2023, the appellant requested that auxiliary requests 1 to 3 not be admitted under Article 12(3) and (5) RPBA 2020. It also reiterated its opinion that auxiliary requests 2 and 3 extended beyond the content of the application as filed and were insufficiently disclosed, and argued that auxiliary requests 2 and 3 were unclear and that the main request was not novel in view of D3.
- VII. In a submission dated 19 October 2023, the respondent filed arguments against the appellant's objections under Articles 83, 84, 123(2) and 56 EPC and argued

that auxiliary requests 1 to 3 should be admitted into the appeal proceedings. It also requested that the inventive step objection starting from D3 as closest prior art not be admitted into the appeal proceedings.

VIII. At the end of the oral proceedings, which took place on 14 November 2023, the parties confirmed their original requests, namely:

The appellant requested that the decision under appeal be set aside and the patent be revoked in its entirety.

The respondent requested that the appeal be dismissed (main request) or, as an auxiliary measure, that the patent be maintained on the basis of the claims according to one of auxiliary requests 1 to 3 filed with the reply to the appeal.

Reasons for the Decision

1. Main request - Inventive step

The opposition ground under Article 100(a) EPC in combination with Article 56 EPC prejudices the maintenance of the patent as granted for the following reasons:

1.1 The **underlying invention** relates to curved windshields designed to reduce double images from reflection in head-up display devices (from now on "HUD device"). HUD devices are transparent displays of information (e.g. speed, navigation directions, ...) formed by projecting images onto the windshield using a combiner, which reflects the image onto the driver's line of sight, without requiring them to look away from the road.

It is known in the technical field that the formation of double images caused by light reflection from the HUD projection or by light transmission (i.e. light coming from outside the vehicle) can be reduced by controlling the wedge angle of the windshield glass, i.e. the angle formed between the inner and outer surfaces of this glass. The invention proposes to further reduce double image formation by means of a continuously changing wedge angle in the HUD display surface of the windshield in order to prevent the formation of double images at every point of the projection.

1.2 Closest prior art

- 1.2.1 Document D1 discloses (for example in fig. 11) a curved vehicle windshield laminated glass with a HUD device. This document proposes using a laminated glass with non-parallel internal and external reflecting surfaces forming a wedge angle in order to reduce the formation of double images in the reflection of the HUD device on the windshield. In some embodiments (see tables 1-2), the HUD viewing field (i.e. the portion of the laminated glass onto which the HUD is reflected) is divided in different regions (see 11a ,11b and 11c in figures 16 to 18) each having a different wedge angle calculated so as to eliminate the double images in the centre point thereof (see col. 13, lines 27-31). D1 does however not disclose an embodiment in which the "wedge angles change continuously from the bottom edge to the top edge of the HUD viewing field" as defined in claim 1 at issue, i.e. the wedge angles in D1 change discontinuously, as they remain constant within each of the discrete regions 11a, 11b and 11c.

1.2.2 The subject-matter of claim 1 thus differs from D1 in that the wedge angles change continuously in order to prevent double images at every point of the HUD viewing field.

1.3 Problem solved by the invention

1.3.1 According to the patent (see pars. [0015] and [0016]), the object of the invention is to reduce the formation of double images from reflection and transmission in curved windshields. As explained in pars. [0041] to [0050] and shown in figures 5 and 6, the optimal wedge angle to avoid double images from the reflection of a HUD viewing device can be calculated as a function of the relative position and orientation of the HUD device, the observer and the windshield. The calculations are performed by solving the set of equations proposed in the patent (see pars. [0045] to [0049]). In particular, the patent indicates (see par. [0050]) that the set of equations is solved numerically by nested intervals, which implies that the wedge angle is calculated for multiple discrete points (see table 2). The continuously changing wedge angle profile for the windshield is then determined by joining these points to form a continuous curved function as shown in figure 3.

1.3.2 The Board notes that both the solution in D1 and that proposed in the patent represent approximations of an ideal profile, because in both cases the wedge angle is calculated only for an unspecified finite number of discrete points. The main difference is that while in D1 the profile consists of multiple flat regions, each having a constant wedge angle, in the invention the profile has a continuously changing wedge angle.

The transitions between the calculated points in the profile according to the invention are arguably smoother than those in D1, so the Board is persuaded that this solution is potentially closer to an ideal profile than that proposed in D1. However, it should also be noted that the effect of the wedge angle on the prevention of double images ultimately depends on a number of factors which are not part of the claimed invention, such as the relative positions and orientations of the windshield and the HUD device in the vehicle. The claimed invention can therefore at best be regarded as providing a suitable profile for preventing double images once the windshield is actually installed in a vehicle with a HUD device.

In view of the above discussion, the Board concludes that the problem solved by the invention is the provision of a windshield suitable for reducing the formation of double images from reflection.

1.4 Obviousness of the solution

1.4.1 In the preliminary opinion, the Board indicated that the solution proposed appeared to be the result of an obvious optimisation of the multi-region profile proposed in D1. In particular, even though the solution proposed in D1 likely provided a cost-effective and less complex way of approximating an ideal profile, the skilled person would still be aware that a continuously changing wedge profile would have some advantages in terms of reduction of double image formation.

1.4.2 The respondent argued that there was no hint in D1 to provide a profile with a continuously changing wedge angle. The argument that this was the result of an obvious optimisation or that the solution proposed in

D1 was justified by cost-effectiveness was thus speculative and based on hindsight. In other words, if the solution proposed in claim 1 were indeed both optimal and trivial, it would have been anticipated or at least hinted in D1.

- 1.4.3 The Board notes that a person skilled in the art would clearly be aware, both in view of common general knowledge and of the contents of the prior art, that the ideal wedge angle for preventing double images from reflections changes continuously for each point of the windshield. This already follows from the fact that the ideal wedge angle is determined (both in the invention and in the prior art) by solving the known set of equations (see D2), which are based on parameters which change continuously for each point of the windshield, and whose solution is therefore a profile with a continuously changing wedge angle. This is also implicitly discussed in D1, as this document indicates (see col. 11, line 66 to col. 12, line 7) that the ideal wedge angle changes with the incident angle of the light rays for any given surface and that, consequently, it is desirable to divide the HUD viewing field in different regions with different wedge angles. The provision of multiple regions having different wedge angles in D1 (see col. 12, line 43 to col. 13, line 31) is therefore an attempt to approximate the optimal continuous profile.

Since the skilled person knows that the optimum wedge angle profile is a continuous function, the idea of improving double image formation by reproducing such a profile is necessarily trivial. In other words, the invention simply consists of solving the known equations, forming the windshield with a profile containing as many calculated points as possible and

ensuring that the transitions between the points are as smooth as possible, which would directly lead to a profile with a continuously changing wedge angle.

1.4.4 As to the additional question of why D1 does not disclose or suggest an alternative that is both known and optimal, the Board notes the following: as already hinted in the preliminary opinion, this is most likely explained by the fact that D1 teaches shaping the glass surface using a grinding process. While this technique could potentially be used to reproduce a continuous curved profile, it would likely be a comparatively costly and time-consuming process, since it is well known that grinding flat surfaces on a glass is technically easier than reproducing a specific curved profile. The question is in any case irrelevant, because the invention is not based on proposing a simple or cost-effective way of reducing double images from reflection but only on the broader problem of reducing double images from reflection. In other words, since the invention is not based on how to reproduce the curved profile, but on the idea of using the curved profile as such, the relevant question can only be whether the skilled person would recognise that a continuous curved profile provides a more suitable shape for reducing double images than a profile having multiple flat surfaces, irrespective of whether the former solution involves higher costs and/or technical complexity.

1.4.5 The Board therefore concludes that it would be obvious for the skilled person to contemplate reproducing a profile with a continuously changing wedge angle when starting from D1 for the purpose of providing a windshield suitable for reducing the formation of double images from reflection. The subject-matter of

claim 1 is thus not inventive in view of D1 combined with common general knowledge or D2.

2. Admittance of the objection based on D3 as closest prior art for auxiliary request 1
 - 2.1 In the grounds of appeal, the appellant raised an objection against granted claim 3 starting from D3 as the closest prior art.
 - 2.2 The respondent argued (in the discussion of the main request) that during first instance proceedings D3 had only been cited in combination with D2 as closest prior art, and that D3 had never been cited as the closest prior art. Since the new objection had been introduced for the first time at the appeal stage, it represented an amendment of the case that should not be admitted under Articles 12(2) and (4) RPBA 2020.
 - 2.3 Irrespective of whether an inventive step objection starting from D3 as the closest prior art should be admitted for discussing inventive step of the claims as granted, the Board considers that such an objection should be admitted at least within the context of the discussion of the first auxiliary request and thus exercised its discretion to admit this objection.

In this respect, the Board notes that the first auxiliary request was not addressed at the oral proceedings before the opposition division, because the opposition division rejected the opposition. Thus, even if the objection had been raised in the first instance, the Board would not have before it a decision that could be reviewed. Under these circumstances, arguments based on Article 12(2) RPBA 2020 and the primary purpose of the appeal (review of the first instance

proceedings), are not suitable for justifying not admitting the objection. Furthermore, D3 is *prima facie* relevant and not entirely new, as it was cited at least in combination with D2 during the opposition proceedings. The Board therefore exercises its discretion under Article 12(4) RPBA 2020 to admit the inventive step objection based on D3 as the closest prior art filed with the grounds of appeal, at least for the discussion of auxiliary request 1.

3. Auxiliary request 1 - Inventive step

3.1 Claim 1 at issue has been amended to define that the continuously changing wedge angles are incorporated into an intermediate film. This essentially means that a film with the desired profile is formed and used as an intermediate layer so that the windshield takes this shape when the inner and outer glass layers are laminated onto it.

3.2 Closest prior art

3.2.1 Document D1 does not appear to represent a promising springboard, because it explicitly teaches away (see col. 2, lines 19-26 and 51-55) from using the intermediate layer to provide the desired wedge profile.

3.2.2 Document D3, on the other hand, discloses windshields with a HUD device, wherein an interlayer having a predetermined wedge-shaped thickness profile is used to prevent double image formation (see par. [0004]). The wedge angle selected to prevent double images is based on the anticipated installation angle of the windshield, thickness of the glass sheets, and angle of incidence of the projected image (see par. [0027]). The

wedge can follow a linear profile or a continuous non-linear profile such as a curved profile, i.e. a profile with a continuously changing wedge angle (see par. [0028] and figures 4 to 6).

3.2.3 The respondent argued that D3 was not an appropriate starting point, because the main objective of this document was not to reduce double images but to simplify and improve the handling and manufacturing of the interlayer rolls. Furthermore, in the only embodiment of D3 relating to the prevention of double images (figure 3), the wedge angle was constant. There was no reason to conclude that the interlayers having a curved profile were intended to reduce double image from reflection, as the patent simply indicated (see par. [0009]) that the shape of the profile depended on the manufacturing requirements.

3.2.4 The Board disagrees with the above argumentation and notes that, in principle, a document should not be discarded as a possible starting point on the sole basis that it does not explicitly address the same problem as the invention. In the Board's view, a document may be disqualified as the closest prior art when its technical context is so far removed from that of the invention that a skilled person would only contemplate it as a starting point with the benefit of hindsight. This is clearly not the case for D3, which discloses windshields designed for reducing the formation of double images from reflection of HUD devices (see pars. [0004] and [0027]). Thus, even though the main objective of D3 is to improve the handling and manufacturing of the interlayer rolls, its technical context is identical to that of the invention.

3.2.5 Unlike D1, document D3 anticipates profiles with a continuously changing wedge angle (see figures 4 to 6 and par. [0028]) and also indicates (par. [0027]) that the wedge angle should be selected according to the installation angle of the windshield and other parameters in order to prevent double images. The only aspect which is not directly and unambiguously disclosed in D3 is that the curved or non-linear portion of the wedge should extend from the bottom to the top of the HUD viewing field in order to compensate the double images at every point.

3.3 Problem solved

As indicated in the patent, the problem solved by the invention is to provide a windshield suitable for reducing double images.

3.4 Obviousness of the solution

3.4.1 The respondent argued that the invention was not obvious in view of D3, because the main objective of the interlayer wedges was to improve the handling and manufacturing of the interlayer rolls. The skilled person would therefore have no incentive to design the non-linear or curved wedge profiles to compensate double images in every point of the HUD viewing field.

3.4.2 The Board disagrees, because as indicated above, the main purpose of the wedge profiles in D3 is that of compensating double images from reflection (see par. [0027]). The improvement in handling and manufacturing is actually not linked to the wedge profile as such, but to the idea of shaping the web in such a way that it can be cut through its centre point to obtain two interlayer wedges. Since, contrary to the respondent's

argumentation, the sole purpose of the wedge profile as such (at least the only one being mentioned) in D3 is that of reducing double images, the skilled person would strive to find optimal designs by solving the set of equations proposed in D2 and by reproducing the resulting wedge angle profile. In doing so, the skilled person would arrive in an obvious manner at a solution involving a profile with a constantly changing wedge angle throughout the entire HUD viewing field.

Furthermore, as D3 explicitly teaches to reproduce the wedge shape with an intermediate wedge, the additional feature in claim 1 of auxiliary request would also be part of the solution when starting from this document.

3.4.3 The subject-matter of claim 1 is therefore obvious in view of D3 combined with D2, and thus fails to meet the requirements of inventive step under Article 56 EPC.

3.4.4 Since auxiliary request 1 is not allowable under Article 56 EPC, there is no need to address the question of its admittance.

4. Auxiliary requests 2 and 3 - Admittance under Article 12(3) and (5) RPBA 2020

The Board exercised its discretion not to admit these requests under Articles 12(3) and (5) RPBA 2020 and not to take into account the respondent's subsequent submissions filed after notification of the summons to oral proceedings under Article 13(2) RPBA 2020 which aimed at substantiating the auxiliary requests.

4.1 *Article 12(4) RPBA 2020 - no amendment*

The claims of auxiliary requests 2 and 3 include several amendments, namely additional features that

were not present in the granted claims, and correspond to auxiliary requests 2 and 3 which were admissibly raised and maintained in the opposition proceedings. The requests are thus not to be regarded as an amendment under Article 12(4) RPBA 2020.

However, as indicated in the preliminary opinion, the requests have not been substantiated in the appeal proceedings, so their admittance was to be assessed under Articles 12(3) and (5) RPBA 2020.

In a first step, the Board thus had to assess whether the auxiliary requests were validly filed (see point 4.2 below) and whether the respondent's reply with respect to the auxiliary requests fulfilled the requirements of Article 12(3) RPBA 2020 (see points 4.3 and 4.4.1-4.4.5 below).

In a second step, the Board had to assess whether the subsequent submissions of the respondent, aiming at substantiating said auxiliary requests, should be admitted pursuant to Article 13(2) RPBA 2020 (see point 4.4 below). Based on the respective results, the Board exercised its discretion under Article 12(5) RPBA 2020 (see points 4.5 and 4.6 below).

4.2 *Unsubstantiated requests - validly filed*

In the Board's view, a lack of or an insufficient substantiation of an amended request may lead to its non-admittance, but this does not imply that the request has not been validly filed.

And even if some Boards have concluded that unsubstantiated requests which were not self-

explanatory were deemed to have been filed only at the point of time when substantiation was provided (see T 1732/10, reasons 1.5; T 1426/17, reasons 2.1; Case Law of the Boards of Appeal, 10th edition, V.A.5.12.6), this view is not shared by the present Board.

Rather, a distinction should be made between the filing of a claim request and its substantiation. This follows from Article 12(3) and (5) RPBA 2020, according to which a request, even if not substantiated, should be assessed by the Board with respect to its admittance and may eventually be admitted. Such an assessment of the request and the possibility of admitting it presupposes that the request has been validly filed despite deficiencies in its substantiation. In other words, while the lack of substantiation leaves the admittance of the claim request to the discretion of the Board, there is no basis in Article 12(3) and (5) RPBA 2020 for concluding that a claim request is not validly filed solely because it is not substantiated.

4.3 *Article 12(3) RPBA - required substantiation*

4.3.1 According to Article 12(3) RPBA 2020 the parties should set out their requests clearly and concisely and specify expressly all the requests, facts, objections, evidence and arguments relied on. These provisions reflect that it is not for the Board to speculate as to the intentions underlying the party's submissions (see also T 2115/17, reasons 6.1.3) or to further investigate the submissions made before the first instance.

4.3.2 Even if an amended request were to be considered self-explanatory, this would not meet the standard as set out in Article 12(3) RPBA 2020, because an implicit

argument does not meet the requirement that the party should specify expressly the arguments relied on (T 2598/12, reasons 1.10). Therefore, the admittance of such request would still be at the discretion of the Board (see for example T 568/14, reasons 8.4 and 8.5, where the request was explicitly admitted although it was considered to be self-explanatory). However, if a request is considered to be self-explanatory, this aspect will normally be taken into account when exercising the discretion (see points 4.5.1 and 4.5.2 below).

4.3.3 The required degree of substantiation under Article 12(3) RPBA 2020 depends on the specific circumstances of the case, namely:

(a) A proprietor who files an amended claim request is normally required to at least:

- indicate the basis in the application as filed for each amendment,
- indicate which objections are intended to be overcome (i.e. the purpose of the amendments) and
- provide reasons why an amendment overcomes the objections raised.

These requirements essentially correspond to those set out in Article 12(4), 3rd and 4th sentence RPBA 2020, which applies to those requests regarded as an amendment under Article 12(4), 1st half-sentence RPBA 2020. There is no reason to apply a different standard if - as in the present case - the submitted claim request is not an amendment under Article 12(4) RPBA 2020. Therefore, the fact that a request is not an amendment under Article 12(4) RPBA 2020 does not exempt or reduce the respondent's duty to substantiate such a request. Rather, it is the duty of the party filing an

amended claim request to present the arguments on which it relied clearly and concisely, which includes also the required information as set out in Article 12(4) RPBA 2020.

(b) If a claim request is intended to overcome novelty or inventive step objections, the proprietor should at least identify the relevant documents and the features which distinguish the claimed subject-matter therefrom (see T 1659/20, reasons 2.1). According to some Boards, where a claim request is filed to overcome an objection under Article 56 EPC, the proprietor should even substantiate it on the basis of a more detailed chain of logic (see for example T 420/14, reasons 9.5).

(c) However, the specific extent and detail of the explanations required to substantiate a claim request cannot be determined in an absolute or precise manner. This may depend on the level of detail and accuracy of the objections to be overcome in the impugned decision or as raised by the opponent (see T 1659/20, reasons 2.1). Moreover, the required degree of substantiation is not static, but might depend on how the corresponding objections evolve.

4.4 *Substantiation in the case at issue*

4.4.1 The patent as granted having been objected to under the grounds of opposition according to Articles 100(a) and 100(b) EPC, the appellant contested novelty and inventive step and based its objections on several attacks and different documents. It was thus incumbent on the respondent to explain which ground of opposition and which specific objections were supposed to be overcome with each auxiliary request. As discussed above, Article 12(3) RPBA 2020 further requires that

the party expressly specifies its arguments as to why the claim requests would be suitable to overcome the objections raised.

- 4.4.2 In the present case, when auxiliary requests 2 and 3 were filed with the reply to the appeal, the respondent explicitly refrained from submitting any observation with respect to these requests. Instead, it merely stated that since the subject-matter of the granted claims was novel and inventive, there was no need to submit any further argument in support of the auxiliary requests.

The Board notes that the only potential information given by the respondent as to the basis for the amendments appears to be provided in the marked versions of the claims that were attached to the letter of reply, which include in claim 1 the indications "[claim 5]", "[claim 5, SP[2255]]" and for auxiliary request 3 additionally: "[SP [0056]]". There was no further explanation or even mention of these references in the requests or in the letter of reply.

- 4.4.3 The respondent argued that, since in the present case the opposition division had decided that the patent as granted met the requirements of the EPC, the lack of substantiation of the auxiliary requests in advance of receiving the preliminary opinion of the Board was not critical.

This reasoning is not convincing because it ignores the requirement for substantiation set out in Article 12(3) RPBA 2020, which also applies when the opposition has been rejected in the first instance proceedings and the proprietor acts as respondent in the appeal proceedings. Article 12(3) RPBA 2020 requires each

party to set out clearly and concisely the reasons why the decision under appeal was to be reversed, upheld or amended by expressly specifying all the arguments relied on. If the proprietor requests that the patent be maintained based on a claim request which does not correspond to that found allowable in the impugned decision, this implies that the decision under appeal is to be amended and should therefore be reasoned according to Article 12(3) RPBA 2020.

- 4.4.4 The respondent also argued that no further substantiation for its auxiliary requests could be expected, because at the time of filing said requests the outstanding objections under Article 123(2) EPC had been late filed and were incomprehensible. This argument is also not persuasive, because it fails to recognise that the duty to provide a basis in the application as originally filed for amendments to a claim request is an obligation of the proprietor that does not depend on whether or not the opponent had already put forward an objection under Article 123(2) EPC. Even in examination proceedings, an applicant filing a new request must indicate the basis for the amendments in the application as filed (see Rule 137(4) EPC). Thus, this duty applies *a fortiori* to amendments in opposition proceedings, where not only the opposition division or the Board, but also the opponent must be enabled to assess whether the requirements of Article 123(2) EPC are met without the need to speculate. Even though an objection raised by the opponent might increase the requirements for substantiation under Article 12(3) RPBA 2020, the duty to provide a basis for the amendments does not depend on whether or not the allowability of the request has been previously contested under Article 123(2) EPC.

4.4.5 Finally, the Board notes that in the present case there is no need to further specify the required extent or detail of the substantiation, as the respondent did not submit any useful information as to auxiliary requests 2 and 3.

In particular, the cited references in brackets attached to the reply as a separate document do not provide the required substantiation, because information that can only be found in attached documents, without an explicit reference and explanation by the party, cannot be regarded as a substantiation, as Article 12(3) RPBA 2020 requires the parties to expressly specify their submissions.

Furthermore, the references in the marked version of the claims (i.e. "[claim 5]", "[claim 5, SP[2255]]" and "[SP [0056]]") are of no practical use for determining the basis for the amendments, not only because they are unexplained, but also because they were misleading and erroneous, as claim 5 as filed does not define any of the relevant features and no paragraph [2255] can be found in the description as filed or the patent. In fact, the description as originally filed does not even include numbered paragraphs, so the reference to "[SP [0056]]" (probably also the reference to claim 5) is either wrong or refers to the patent as granted rather to the application as filed.

4.4.6 *Admittance of subsequent explanations under Article 13(2) RPBA 2020*

The initial lack of substantiation with respect to the auxiliary requests has not been overcome by the subsequent respondent's submissions provided after notification of the summons to oral proceedings,

because the Board exercised its discretion not to take into account these submissions under Article 13(2) RPBA 2020.

In fact, the respondent attempted to substantiate the auxiliary requests for the first time with its letter of 19 October 2023, i.e. shortly before the oral proceedings before the Board. Since these submissions, which were further elaborated at the hearing, were filed after the notification of the summons to attend oral proceedings, their admittance is governed by the provisions of Article 13(2) RPBA 2020.

The respondent argued in this respect that it did not expect that further substantiation would be required for the auxiliary requests before the appellant itself provided substantiated objections with respect to these requests. Further, it held the appellant's statements vague and generic and not related to the newly added features, so they did not merit a substantive response. Furthermore, the appellant's objections in the grounds of appeal under Article 123(2) EPC against auxiliary requests 2 and 3 were not part of the first instance decision. As a consequence, they were late filed and should not be admitted at the appeal stage. And even if they were admitted, the respondent had not expected that a response would have been required. This seemed reasonable, since the new Rules of Procedure of the Boards of Appeal had only entered into force at the beginning of 2020, and the parties were not used to the new provisions.

The Board cannot accept these arguments, because as indicated above (see points 4.3.3.(a) and 4.4.4), the proprietor's duty to substantiate its claim requests (in particular to provide a basis for the amendments in

the application as originally filed) is an initial obligation which does not depend on whether or not the opponent had previously put forward an objection under Article 123(2) EPC. The respondent's expectations in view of the new rules of procedure do not qualify as an exceptional circumstance, in particular considering that the wording of Article 12(3) RPBA 2020 corresponds largely to that of Article 12(2) RPBA 2007 and accordingly, it was and still *is* common practice of the Boards of Appeal to assess whether the proprietor filing an amended set of claims has provided the required substantiation (see Case Law of the Boards of appeal, 10th edition: V.A.4.3.5 and V.A.5.12.6).

In view of the above considerations, the Board concluded that the respondent had not explained with cogent reasons why exceptional circumstances would apply which could justify admitting the new submissions aiming at substantiating the auxiliary requests after the notification of the summons under Article 13(2) RPBA 2020. Thus, the Board exercised its discretion under Article 12(3) and (5) RPBA 2020 not to take into account these submissions.

4.5 *Relevant criteria for exercising the discretion under Article 12(5) RPBA 2020*

- 4.5.1 The discretion under this specific Article is to be exercised in view of the specific circumstances of the case.

The purpose of Article 12(3) RPBA 2020 is to ensure that the relevant submissions are present in the proceedings as early as possible to enable the Board and the other party(ies) to start working on the case on the basis of the parties' complete submissions (Case

Law of the Boards of Appeal, 10th edition, V.A.4.3.5 a)) without being forced to speculate on the intentions of the other parties. The extent to which a lack of or an incomplete substantiation runs counter to this objective is a factor that may be taken into account when exercising the discretion under Article 12(5) RPBA 2020 (T 1659/20, reasons 2.1). This includes addressing the question of whether the amendments and the chain of logic underlying the claim requests are self-explanatory.

- 4.5.2 In the present case, the amendments to the claims of auxiliary requests 2 and 3 were not self-explanatory.

The said claims included several amendments, some of which were based on the description. As indicated above (point 4.4.5), the only information as to a possible basis for the amendments was unclear, erroneous and misleading. Moreover, the Board also notes that there is an unexplained change in the wording used to define the effects in the amended claims according to auxiliary requests 2 and 3. In particular, as the original effect of "preventing" double images in reflection (see claim 9 as filed) was substituted by the wording "compensating" in granted claim 1, but the wording "preventing" was maintained for the effect concerning the double images in transmission in claim 1 of auxiliary requests 2 and 3, the Board and the appellant were left with the task of figuring out whether or not the words "prevent" and "compensate" were intended to have the same meaning, whether one was considered to be more restrictive or simply different from the other, why the wording was changed for the effect relating to double images from reflection but not for the effect relating to double images from

transmission, and/or where the basis was for modifying this wording.

- 4.5.3 The respondent argued during the oral proceedings that the basis for the amendments had been submitted during opposition proceedings. This however does not change the Board's conclusions, as the relevant letters and passages of the respective submissions in the opposition proceedings were not even cited when the requests were filed in the appeal proceedings.
- 4.6 In view of the foregoing considerations, the Board exercised its discretion under Article 12(3), (5) RPBA 2020 not to admit auxiliary requests 2 and 3 into the appeal proceedings.
5. Since none of the requests submitted by the respondent is admissible and allowable, there is no basis for maintaining the contested patent.

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:



A. Pinna

J.-M. Schwaller

Decision electronically authenticated