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

**Case Number:** T 1427/21 - 3.2.01

**Application Number:** 14179985.8

**Publication Number:** 2835237

**IPC:** B27D5/00

**Language of the proceedings:** EN

**Title of invention:**

Machine to process wood panels or the like

**Patent Proprietor:**

BIESSE S.p.A.

**Opponent:**

Winter, Brandl - Partnerschaft mbB

**Headword:**

**Relevant legal provisions:**

EPC Art. 115

EPC R. 100(2)

RPBA 2020 Art. 12(2), 12(6), 12(8), 15(1)

**Keyword:**

Observations by third parties - admitted (no)

Late-filed evidence - should have been submitted in first-  
instance proceedings (yes)

Late-filed objection - should have been submitted in first-  
instance proceedings (yes)

**Decisions cited:**

T 1348/11

**Catchword:**



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Case Number: T 1427/21 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 14 August 2023**

**Appellant:** Winter, Brandl - Partnerschaft mbB  
(Opponent) Alois-Steinecker-Straße 22  
85354 Freising (DE)

**Respondent:** BIESSE S.p.A.  
(Patent Proprietor) Via della Meccanica, 16  
Pesaro (IT)

**Representative:** Manconi, Stefano  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
24 June 2021 concerning maintenance of the  
European Patent No. 2835237 in amended form.

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** A. Pieracci  
E. Mille

## **Summary of Facts and Submissions**

- I. An appeal was filed by the opponent in the prescribed form and within the prescribed time limit against the interlocutory decision of the opposition division maintaining the European patent No. 2 835 237 in amended form according to the patent proprietor's main request.
- II. In preparation for oral proceedings, the Board gave its preliminary opinion in a communication pursuant to Article 15(1) RPBA 2020, in which it indicated that the patent could be maintained as amended according to the main request filed by the patent proprietor with the reply to the statement setting out the grounds of appeal.
- III. With letter dated 17 April 2023 the opponent withdraw its request for oral proceedings under the condition that the patent proprietor would not change its requests.
- IV. With a communication pursuant to Rule 100(2) EPC dated 15 May 2023 the Board indicated to the parties that it was its intention to decide in written proceedings and to maintain the patent in amended form with the claims according to the patent proprietor's main request as filed with its reply to the statement setting out the grounds of appeal and the description and the figures of the patent specification. The patent proprietor was asked to confirm that the set of documents indicated was the correct one.
- V. With letter dated 3 July 2023 the patent proprietor confirmed that the description and the figures to be

associated to the main request were those of the patent specification. The opponent did not file any submissions within the two months time limit set in the Board's communication.

VI. The Board cancelled the oral proceedings and decided in written proceedings pursuant to Article 12(8) RPBA 2020.

VII. The final requests of the parties are as follows:

The opponent (appellant) requested:

that the appealed decision be set aside and that the patent be revoked.

The patent proprietor (respondent) requested:

that the patent be maintained as amended according to the main request,  
or in the alternative,  
that the patent be maintained on the basis of the set of claims according to auxiliary requests 1 to 3, the claims of all requests having been filed with the reply to the statement setting out the grounds of appeal.

VIII. The following evidence is mentioned in the present decision:

- E1: DE 101 24 695 A1;
- E3: WO 97/05993 A1;
- E4: Operating instructions 716746,  
Kantenleimaggregat VT 100, Chapter 7, Version  
02.03, pages 111 to 118;
- E5: Order confirmation number 13004248 with

commission number 24266;

E6: Delivery receipt number 13004248/714617  
with commission number 24266;

E7: Screenshot of the web page of a Youtube video;

E8: USB stick with a downloaded video;

E9: EP 0 945 235 B1;

E10: DE 10 2011 015 898 A1.

IX. The arguments of the parties relevant for the decision are dealt with in detail in the reasons for the decision.

X. Independent claim 1 of the patent as amended according to the main request reads as follows:

"A machine to process wood panels (2) or the like comprising a base (5); a locking device (10) to hold at least one panel (2) on the base (5); an edgebanding assembly (16) to edgeband a lateral edge (4) of the panel (2) with a finishing band (17), the edgebanding assembly (16) comprising, in turn, a glueing roller (22) to apply glue onto the lateral edge (4), a pressing roller (26) to press the finishing band (17) against the lateral edge (4) itself, and a heating device (28) to heat the finishing band (17) and allow it to be connected to the lateral edge (4); actuating means (11) to move the locking device (10) and the edgebanding assembly (16) relative to one another in two directions (6, 9), which are substantially horizontal and transverse to one another; a first operating device to move the glueing roller (22) around a first rotation axis (25), which is perpendicular to a support surface (P) supporting the panel (2), and is parallel to and distinct from a longitudinal axis (23) of the glueing roller (22) itself; wherein the heating device (28) is configured so as to feed a hot gas, in

particular a hot gas under pressure, onto the finishing band (17) and comprises a hot gas outlet duct (31), which faces the finishing band (17) and is mobile around the first rotation axis, which is parallel to and distinct from a longitudinal axis (32) of the outlet duct (31) itself; and characterized in that the machine further comprises a second operating device to move the pressing roller (26) around a second rotation axis, which is perpendicular to a support surface (P) supporting the panel (2), and is parallel to and distinct from a longitudinal axis (27) of the pressing roller (26) itself".

### **Reasons for the Decision**

1. Admittance of E4 to E8 into the proceedings and of the objections based on this evidence
  - 1.1 The opponent filed E4 to E8 for the first time with the statement setting out the grounds of appeal, in order to support objections of lack of novelty and of lack of inventive step of the claimed subject-matter, in particular having regard to E4. The opponent argues that due to the difficulty in retrieving E4 and its prima facie relevance, E4 as well as E5 to E8, which the opponent filed in further support of its objections based on E4, should be admitted into the proceedings (see statement of grounds of appeal, point 1.2.1, pages 6 and 7, and point 1.2.4, pages 14 to 18).
  - 1.2 According to Article 12(6) RPBA 2020, second sentence, RPBA 2020 the Board shall not admit requests, facts, objections or evidence which should have been

submitted, or which were no longer maintained, in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance.

- 1.3 The Board is of the opinion that E4 to E8 could and should have been submitted in opposition proceedings, to allow the patent proprietor to react to this evidence in those proceedings and the opposition division to decide on them. The alleged difficulty in retrieving that evidence and the alleged relevance are alleged facts not linked to any development of the appeal case and thus do not constitute a circumstance of the appeal case justifying the admittance of this evidence. The Board therefore considers appropriate to disregard E4 to E8 and the objections based on them pursuant to Article 12(6) RPBA 2020.
  
2. Admittance of the objections of lack of inventive step in view of the combination of the teachings of documents E3 and E1
  - 2.1 The opponent filed for the first time in appeal proceedings an inventive step objection based on the combination of the teachings of E3 and E1.
  
  - 2.2 The opponent (see statement setting out the grounds of appeal, point 2.3.1, page 27, first to fourth paragraph) argues that the above objection should be admitted into the proceedings since both E1 and E3 were filed with the notice of opposition and their combination is *prima facie* relevant for assessing inventive step of the subject-matter of claim 1. The opponent also argues that the filing in appeal proceedings of the new objection is due to the fact that the opposition division has for the first time



indicated in the decision that the characterizing features of claim 1 also covers the possibility of having very small and very large axial distances (see statement setting out the grounds of appeal, point 2.3.1, page 27, fifth paragraph).

2.3 The Board rather shares the view of the patent proprietor (see reply to the statement setting out the grounds of appeal, page 6, point 2.3.3, first paragraph) that the course of action of the opponent is contrary to the primary object of the appeal proceedings, which is to review the decision under appeal in a judicial manner (see Article 12(2) RPBA 2020).

2.4 The Board is of the opinion that the objection of lack of inventive step based on the combination of the teaching of E3 and E1 could and should have been submitted in opposition proceedings, to allow the patent proprietor to react to this objection in those proceedings and the opposition division to decide on it.

2.5 This even more since documents E3 and E1 had been cited with the notice of opposition and thus the opponent clearly had the possibility of filing an objection based on these documents in opposition proceedings. It is the duty of the opponent to submit all the relevant lines of attack as soon as possible in the proceedings and not to wait for the outcome of the opposition proceedings to refine its strategy.

2.6 As regards the interpretation of the characterizing features of the claim (features "9", see appealed decision, point 16.1), the opposition division (see the second paragraph of point 16.1) accepted the opponent's

interpretation that "*the claim does not define ranges for the offset of the two axes and its scope includes very small and very large offsets*". Indeed such reading of the claim was already mentioned in the opponent's letter dated 18 February 2021, page 4 ("*Zu Merkmal 9 ist zunächst festzustellen...*"). Hence, the opposition division's interpretation of the claim was not a new fact justifying filing a new objection on inventive step in appeal proceedings.

2.7 Hence, why the objection based on the combination of the teachings of E3 and E1 specifically results from the reasoning of the appealed decision and why this objection could not have been filed in opposition proceedings is not apparent from the submissions of the opponent.

Furthermore the relevance of the objection is not a criteria foreseen for the application of Article 12(6) RPBA 2020 to which the new objection of lack of inventive step is subjected.

2.8 The Board therefore analogously to point 1. above considers it appropriate not to admit this objection of lack of inventive step into the proceedings pursuant to Article 12(6) RPBA 2020.

3. Admittance of the third party observations into the proceedings

3.1 A third party filed documents E9 and E10 and objections based on these documents for the first time in appeal proceedings pursuant to Article 115 EPC. According to the established case law submissions provided by a third party should not be given a more favourable status than submissions of a party to the proceedings (see the Case Law of the Boards of Appeal, 10<sup>th</sup>

edition, 2022, III.N.4.4.1, in particular the last sentence of the penultimate paragraph with reference to T 1348/11).

Should the third party observations, *i.e.* documents E9 and E10 and the corresponding objections, be admitted into the proceedings, the third party would then receive a more favourable treatment than the opponent (see points 1 and 2 above).

The Board considers thus appropriate to disregard the third party observations.

4. Allowability of the patent as amended according to the main request

4.1 The patent proprietor filed with the reply to the statement setting out the grounds of appeal a new main request with an independent claim 1 corresponding to the one decided upon by the opposition division in which the following combination of features:

"A glueing roller (22) to apply glue onto the lateral edge (4) and/or onto the finishing band (17)",

has been amended by deleting the second alternative, so that the claim only foresees that the roller applies glue onto the lateral edge.

4.2 No objection has been admissibly raised in appeal proceedings based on the first alternative of the above combination of features of claim 1 of the patent as maintained in opposition proceedings, to which claim 1 of the main request is presently limited (see the statement setting out the grounds of appeal, points 1.1, 2.1 and 2.2, and the reply to that statement, point 2.2.1, page 4, first two lines). Instead, all the

objections admissibly raised are based on the assumption that document E1 discloses the second alternative of the above mentioned combination of features of claim 1 of the main request as decided upon by the opposition division but not the first alternative, as can also be derived from the notice of opposition (see page 6, second paragraph thereof).

- 4.3 Therefore no admissibly raised objection stands against the maintenance of the patent as amended according to the main request submitted by the patent proprietor with the reply to the statement setting out the grounds of appeal.
  
5. The above opinion of the Board has been communicated to the parties with the communication pursuant to Article 15(1) RPBA 2020 to which the parties have not reacted apart from the opponent's conditional withdrawal of the request for oral proceedings.
  - 5.1 After having reconsidered all the factual and legal aspects of the case the Board does not see any reason to deviate from its preliminary opinion. The Board thus considers that claim 1 of the main request fulfils the requirements of the EPC.
  
  - 5.2 The dependent claims, the description and the drawings of the main request correspond to those which the opposition division considered to fulfill the requirements of the EPC. The opponent did not had any objections in this respect and the Board also does not see any.
  
6. In view of the above the patent is to be maintained as amended according to the patent proprietor's main request.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended form on the basis of the following documents:

Description, paragraphs

1 to 32 of the patent specification,

Claims

1 to 6 according to the main request as filed with letter dated 15 March 2022,

Figures

1, 2 of the patent specification.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated