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**Datasheet for the decision
of 21 December 2023**

Case Number: T 2213/21 - 3.2.05

Application Number: 06011591.2

Publication Number: 1731284

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B60R13/08, B29K677/00,
B29K705/00, B29K63/00

Language of the proceedings: EN

Title of invention:
Noise reduction member and system

Patent Proprietor:
Zephyros Inc.

Opponent:
Sika Technology AG

Relevant legal provisions:
EPC Art. 56, 111(1), 123(2)
RPBA 2020 Art. 11, 12(2), 12(4), 12(6)

Keyword:

Amendments - allowable (yes)

Documents - admittance (no)

Inventive step (no)

Auxiliary request - admittance (yes)

Remittal to the department of first instance (yes)



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Case Number: T 2213/21 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 21.12.23

Appellant: Sika Technology AG
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
25 October 2021 concerning maintenance of the
European Patent No. 1731284 in amended form.**

Composition of the Board:

Chairman P. Lanz
Members: B. Spitzer
A. Bacchin

Summary of Facts and Submissions

- I. The opponent filed an appeal against the opposition division's interlocutory decision finding that, account being taken of the amendments made by the patent proprietor during the opposition proceedings according to auxiliary request 1A, European patent No. 1 731 284 (the patent) and the invention to which it related met the requirements of the EPC.
- II. The opposition was filed against the patent as a whole based on the grounds for opposition set out in Article 100(a) (lack of novelty and lack of inventive step), Article 100(b) and Article 100(c) EPC.
- III. Oral proceedings before the board were held by videoconference on 21 December 2023.
- IV. Requests

The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked. As an auxiliary measure, it was requested to remit the case to the opposition division.

The respondent (patent proprietor) requested that the appeal be dismissed, or as an auxiliary measure, that the decision under appeal be set aside and the patent be maintained as per one of auxiliary requests 2A to 4A, 2B to 4B as submitted with their reply to the statement of grounds of appeal, or of auxiliary request 1B, filed in an amended version on 12 July 2022.

V. The following documents are referred to in the appeal proceedings:

- E1: US 2005/0081383 A1;
- E6: Testimony by Mr Andreas Finkenzeller on the BMW E65 baffle;
- E6a: Evidence on the BMW E65 baffle.

VI. The independent claim of auxiliary request 1A underlying the decision under appeal has the following wording (references in square brackets):

" **[M1.1]** A noise reduction system comprising a structure of an automotive vehicle structure and a noise reduction member, the noise reduction member (10) being located within a cavity of the automotive vehicle structure and including:

[M1.2] i. a carrier member (12) having a first wall (20), a second wall (22) and a side wall (24) and the cavity of the carrier member is at least partially defined by each of the first wall, the second wall and the side wall **[M1.3]** wherein the first wall is parallel to the second wall and **[M1.4]** an opening is formed in the side wall;

[M1.5] ii. a mass (14) of expandable material located within the cavity of the carrier member adjacent the first wall

[M1.6] iii. an attachment (44) attached to the carrier member, the expandable material or both and locating the noise reduction member relative to the structure; wherein:

[M1.7] A. upon expansion the expandable material (14) forms a foam that occupies a volume that is at least 500% of the volume occupied by the original unexpanded mass of expandable material,

[M1.8]** B. the first wall is designed so that it

shields the expandable material from forming a foam material in a space within the cavity of the automotive vehicle structure and adjacent the structure, **[M1.9]** wherein the second wall is located adjacent an opening of the structure for, upon expansion of the mass of expandable material, shielding the expandable material from forming a foam material that covers the opening."

VII. Auxiliary request 2A

Compared to claim 1 of auxiliary request 1A underlying the decision under appeal, claim 1 of auxiliary request 2A is amended by the wording at the end of feature M1.9 being changed to: "by forming a foam material with a cavity (110) that provides a space about the opening."

Since the further auxiliary requests are not relevant to the present decision, their wording is not reflected here.

VIII. The submissions of the parties relevant to the decision can be summarised as set out below.

(a) Admittance of new arguments on the objection of unallowable amendments

(i) Appellant (opponent)

The argument of added subject-matter concerning the combination of features M1.4, M1.5 and M1.8** (see appellant's submissions of 20 October 2023) was not an independent objection but followed from the argument of added subject-matter concerning the individual features M1.4, M1.5 and M1.8**. The argument of added subject-

matter concerning the connection between the carrier and the expandable material in feature 1.5 was not a new argument but a further elaboration of previous arguments.

(ii) Respondent (patent proprietor)

The argument of added subject-matter concerning the combination of features M1.4, M1.5 and M1.8** was raised for the first time with the appellant's letter dated 20 October 2023. The argument of added subject-matter concerning the connection between the carrier and the expandable material in feature 1.5 was raised for the first time in the oral proceedings. These arguments should not be admitted into the proceedings since they were late filed.

(b) Added subject-matter

(i) Appellant (opponent)

The patent was amended in such a way that it contained subject-matter which extended beyond the application as originally filed. The features concerned were features M1.8**, M1.5 and M1.4.

Feature M1.4 claimed an opening in the side wall. Paragraph [0008] of the application as published did not specify the wall or the function of the opening. An opening in the side wall was only disclosed in paragraph [0015] of the application as published. However, the disclosure in this paragraph was restricted to a rectangular opening. The rectangular shape of the opening was essential for fulfilling its function as disclosed in paragraph [0042] of the application as published. According to this paragraph,

the opening in the side wall allowed the foam material to expand and/or extend through the opening. Furthermore, since paragraph [0015] of the application as published was part of an embodiment disclosed in paragraphs [0012] to [0034] and in Figures 1 and 2 of the application as published, several further features were disclosed in combination, like e.g. the first and second walls being parallel. The omission of these features from claim 1 constituted an unallowable intermediate generalisation.

The addition of the wording "within the cavity of the carrier member" in feature M1.5 also contravened Article 123(2) EPC. Paragraph [0011] of the application as published, which according to the respondent formed a basis for this amendment, was restricted to an expandable material being connected to the carrier member. This was in line with Figures 1 and 2 of the application as published where a fixing of the mass of expandable material was implemented via securement flanges. Since according to feature M1.5 the mass of expandable material was not connected to the carrier member but just located within the cavity of the carrier member, this resulted in an unallowable intermediate generalisation.

Feature M1.8 as originally filed only referred to a space adjacent the structure and therefore implied, due to the openings in the structure, a space inside and outside the structure. The added feature "within the cavity of the automotive vehicle structure" limited the space to the inside of the structure. The application as originally filed did not disclose this limitation to the cavity of the automotive vehicle structure. Figure 4 as published, for instance, was a cross-section of the automotive vehicle structure and did not

exclude that foam outside this cross-section might pass through openings of the automotive vehicle structure.

Building on the above-mentioned objections of added subject-matter, the combination of features M1.4, M1.5 and M1.8** also did not fulfil the requirements of Article 123(2) EPC.

(ii) Respondent (patent proprietor)

An opening according to feature M1.4 was disclosed in paragraph [0015] of the application as published. The rectangular shape was only an illustrated example and not a requirement. Furthermore, the function of the opening as disclosed in paragraph [0042] of the application as published was not inextricable linked to a rectangular shape.

Basis for the amendment of feature M1.5 could be found in the second sentence of paragraph [0011] of the application as published. The term "located" was already present in the claims as originally filed. To fulfil the requirements of Article 123(2) EPC, it was not necessary to include the connection of the mass of expandable material to the carrier member. Paragraph [0019] of the application as published, which was referred to by the appellant, disclosed the securement flanges as optional features.

Concerning the amendment in feature M1.8**, the appellant's argument was contradictory. Feature M1.8 of claim 1 as originally filed was restricted to a space adjacent the structure. While this implied a space inside and outside the structure, feature M1.8** was limited to the inside, i.e. "within the cavity of the automobile vehicle structure adjacent the structure".

This was supported by the whole disclosure of the application as originally filed.

(c) Admittance of documents E6/E6a

(i) Appellant (opponent)

Document E6a together with the declaration E6 on the baffle disclosed in document E6a were filed in reaction to point 9.4 of the Reasons of the opposition division's decision. They were filed as pieces of prior art and as evidence for the common general knowledge. Evidence for the common general knowledge could be filed at any stage of the proceedings. Document E6a was filed to show that automotive vehicle structures had openings adjacent a noise reduction system and that the walls of it guided the foam. This had been disputed.

(ii) Respondent (patent proprietor)

Documents E6 and E6a were late filed. They should have been submitted in the first-instance proceedings. The late filing of these documents constituted a procedural abuse because the appellant had possessed these items since 2004 and had not presented them earlier. Furthermore, these documents did not reflect the common general knowledge but a late-filed alleged public prior use which had not been established beyond reasonable doubt, especially in view of what was disclosed and whether it was available to the public. Furthermore, it was not *prima facie* relevant since it did not disclose how the baffle was produced. It could only serve as proof for the presence of holes in an automotive vehicle structure, which, however, was not disputed. If the alleged prior use were admitted by the board, the case should be remitted to the opposition division to

decide on it.

(d) Inventive step of the subject-matter of claim 1 of auxiliary request 1A underlying the decision under appeal

(i) Appellant (opponent)

Document E1 disclosed a noise reduction system. The subject-matter of claim 1 differed from document E1 in feature M1.9. The shielding effect was known from document E1. The technical effect of feature M1.9 was that the opening in the automobile vehicle structure was kept open for installation purposes. Thus, the objective technical problem was to prevent the foam from blocking the opening in the automobile vehicle structure.

Figure 3 of document E1 showed the automotive vehicle structure before the expansion, and Figures 4 and 5 of document E1 showed this structure after the expansion of the expandable material. Although there might be a gap between the wall 24 and the structure, the situation was similar to the gap shown in Figures 4 and 5 of the patent. Hardly any foam passed this gap.

Since the presence of a hole in the structure adjacent the wall was not disputed and the shielding effect was disclosed in document E1, feature M1.9 was obvious.

Therefore, the subject-matter of claim 1 did not involve an inventive step.

(ii) Respondent (patent proprietor)

The subject-matter of claim 1 differed from document E1 in features M1.8 and M1.9. The technical effect was to keep the foam from entering the opening of the automotive vehicle structure. Therefore, the objective technical problem could be formulated as how to keep the openings in the automobile vehicle structure open so that they can be used for wiring.

This was not a one-way solution as alleged by the appellant. Rather, there were several possibilities for the person skilled in the art to solve the above-mentioned objective technical problem. They could, for instance, use plugs for the openings or drill holes after the foaming.

Figures 3 and 4 of document E1 were schematic drawings. The foam would pass the gaps in Figure 4 and cover the adjacent openings of the structure. The walls 24 and 26 did not have a shielding effect. On the contrary, paragraph [0046] of document E1 disclosed that the walls guided the foam to the structure. There was no hint in document E1 for the person skilled in the art to shield the expandable material from forming a foam material that covers the opening.

Therefore, the subject-matter of claim 1 involved an inventive step.

(e) Admittance of auxiliary request 2A

(i) Appellant (opponent)

Auxiliary request 2A was filed with the reply to the statement of grounds of appeal. It should have been

filed in the opposition proceedings. Since the respondent did not reason its late filing, auxiliary request 2A should not be admitted.

(ii) Respondent (patent proprietor)

Auxiliary request 2A corresponded to former auxiliary request 2 filed during the opposition proceedings, the only modification being the removal of the amendment which had been objected to under Rule 80 EPC. Therefore, this request should be admitted.

(f) Remittal

Both parties requested that the case be remitted to the opposition division.

Reasons for the Decision

1. Admittance of new arguments on the objection of added subject-matter (Article 123(2) EPC)
 - 1.1 The board agrees with the respondent that the objection of added subject-matter on the combination of features M1.8**, M1.5 and M1.4 of claim 1 of auxiliary request 1A was filed for the first time with the appellant's letter dated 20 October 2023. The objection of added subject-matter with regard to the missing attachment of the mass of expandable material to the carrier member in feature M1.5 was brought forward by the appellant for the first time in the oral proceedings before the board.
 - 1.2 The appellant explained that the argument on the lack of original disclosure of the combination of features

M1.4, M1.5 and M1.8** was not a separate objection but a logical consequence of the previous submission that these features, when considered individually, had no basis in the application as originally filed. The board agrees and does not consider this argument to be a separate objection but a further elaboration made in the context of the added subject-matter objection for the individual features M1.4, M1.5 and M1.8**, which therefore does not give rise to new matter of discussion. The same applies for the appellant's argument made in the context of feature M1.5 that the location within the cavity of the carrier member was only originally disclosed together with the attachment of the expandable material. The board considers this submission a further substantiation of its previous added subject-matter objection in the context of feature M1.5.

Therefore, these submissions do not constitute an amendment of the appellant's appeal case under Article 12(4) RPBA or Article 13(2) RPBA and are therefore taken into account in the proceedings.

2. Auxiliary request 1A underlying the decision under appeal - amendments (Article 123 (2) EPC)

The appellant raised objections under Article 123(2) EPC against claim 1, especially features M1.8**, M1.4 and M1.5. Since features M1.8**, M1.4 and M1.5 were not directly and unambiguously disclosed individually, their combination also had no basis in the application as originally filed.

- 2.1 Feature M1.8**

Feature M1.8** reads "the first wall is designed so

that it shields the expandable material from forming a foam material in a space **within the cavity of the automotive vehicle structure and** adjacent the structure", with the bold printed part added compared to the version as originally filed.

While the original wording "a space adjacent the structure" did not specify whether the space was inside or outside the automotive vehicle structure, the amended feature M1.8** is limited to a space inside the automotive vehicle structure. This is not disputed. The board shares the respondent's view that the application as filed as a whole is directed to foaming that takes place within the automotive vehicle structure (see application as filed, page 3, lines 7 to 12; page 10, lines 23 to 35; Figures 4 and 5). Therefore, there is direct and unambiguous disclosure for this amendment. The exclusion of the other possibility does not result in added subject-matter.

2.2 Feature M1.4

According to feature M1.4, an opening is formed in the side wall.

Unlike the appellant, the board does not find that the omission of the rectangular shape of the opening and further features of the embodiment disclosed on page 3, line 24 to page 11, line 8 of the originally filed description (corresponding to paragraphs [0012] to [0043] of the application as published) constitutes an unallowable intermediate generalisation.

Feature M1.4 is disclosed on page 4, lines 10 to 11 of the application as filed. Concerning the rectangular shape, the application as filed discloses on page 4,

lines 11 to 13 that the rectangular through-hole is part of the illustrated example and thus not inextricably linked to the opening in general. In contrast to the appellant's allegations, the function of the opening is not linked to its shape. Page 10, lines 30 to 35 of the application as filed (corresponding to the second part of paragraph [0042] of the application as published) does not refer to the shape of the opening.

With regard to further allegedly missing features of the embodiment disclosed on page 3, line 24 to page 11, line 8 of the application as filed (paragraphs [0012] to [0043] of the application as published) and shown in Figures 1 and 2 as filed, the board notes that these are not linked to the shape of the opening and, furthermore, are disclosed as optional or preferred features, such as the first and second walls being parallel (see application as filed, page 4, lines 4 to 9).

2.3 Feature M1.5

According to feature M1.5, "a mass (14) of expandable material is located **within the cavity of the carrier member** adjacent the first wall", with the bold printed part added compared to originally filed claim 1.

The board agrees with the respondent that page 3, lines 18 to 23 of the application as filed (paragraph [0011] of the application as published) and all originally filed figures provide a clear and unambiguous disclosure for the amendment that the expandable material is "within the cavity of the carrier member". The remaining parts of feature 1.5 are not amended compared to claim 1 as originally filed.

In the appellant's view, this paragraph on page 3, lines 18 to 23 of the application as filed (paragraph [0011] of the application as published) as well as Figures 1 and 2 as filed limited the expandable mass as being "connected to" the carrier member, while, according to feature M1.5, a loose location of the expandable mass in the carrier member was possible. The board finds this argument unconvincing. As submitted by the respondent, the term "located" was already present in claim 1 as originally filed. Moreover, the securement flanges shown in Figures 1 and 2 are clearly presented as optional (see page 4, line 34 of the application as filed and paragraph [0019] of the application as published).

2.4 Combination of features M1.4, M1.5 and M1.8**

As stated by the appellant, the argument of added subject-matter concerning the combination of features M1.4, M1.5 and M1.8** is not an independent objection, but follows from the objections of added subject-matter concerning the individual features M1.4, M1.5 and M1.8**. Since these individual features concern one embodiment and do not contravene Article 123(2) EPC (see points 2.1 to 2.3), this conclusion equally applies for their combination.

2.5 Conclusion on added subject-matter

Claim 1 of auxiliary request 1A meets the requirements of Article 123(2) EPC.

3. Admittance of documents E6/E6a

3.1 With its statement of grounds of appeal and in reaction to point 9.4 of the Reasons of the opposition division's decision, the appellant filed documents E6 and E6a, allegedly, as proof for the common general knowledge and also as separate pieces of prior art for the objection of lack of inventive step. According to the appellant, these documents should be admitted since it was not foreseeable in the opposition proceedings that the common general knowledge was decisive and since these documents were *prima facie* relevant.

3.2 Under Article 12(2) RPBA, a party's appeal case should be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based. However, in its statement of grounds of appeal, the appellant filed for the first time documents E6 and E6a as alleged proof for the common general knowledge and as separate piece of prior art in regard to the objection of lack of inventive step. Therefore, these documents do not meet the requirements of Article 12(2) RPBA and are, according to Article 12(4) RPBA, to be regarded as an amendment to the appellant's case, the admittance of which is subject to the board's discretion.

3.3 Article 12(6), second sentence, RPBA stipulates that evidence which should have been submitted in the proceedings leading to the decision under appeal shall not be admitted unless the circumstances of the appeal case justify their admittance.

3.4 The board notes that under established case law, common general knowledge is to be found in basic handbooks, monographs, encyclopedias, textbooks and reference

books. It constitutes knowledge that an experienced person in the field in question is expected to have or at least to be aware of to the extent that they know they could look it up in a book if they needed it (see Case Law of the Boards of Appeal of the European Patent Office, 10th edition, July 2022, I.C.2.8.1). As such, documents E6 and E6a do not show the common general knowledge, but are considered to relate to an alleged public prior use of a "Baffle BMW E65", which, if relevant, should have been presented in the opposition proceedings, especially given that the appellant has had these documents since 2004.

3.5 Not only should documents E6/E6a have been filed in the opposition proceedings, the prior use as presented in these documents is not sufficiently substantiated. For a prior use to be sufficiently substantiated, facts have to be provided which make it possible to determine the date of prior use to ascertain its prior character, the object of prior use to examine its relevance, and the circumstances relating to the alleged prior use (i.e. where, how and by whom the subject-matter was made public through that use) to confirm its availability to the public. Arguments and evidence in support of the alleged prior use must also be provided. On the basis of the information made available by documents E6 and E6a, it is not possible to establish whether the pictures on page 1 of document E6a show a baffle BMW E65 and whether this is the "Formteil 02041017". Furthermore, documents E6 and E6a are *prima facie* not relevant for the issue under dispute since they do not provide information about the shielding effect of the walls.

3.6 In view of the above, the board, exercising its discretion under Article 12(4) and (6) RPBA, did not

admit documents E6 and E6A into the appeal proceedings. Consequently, there was no need to address the respondent's request for remittal to the opposition division in this context.

4. Inventive step of the subject-matter of claim 1 of auxiliary request 1A underlying the decision under appeal

4.1 It is undisputed that document E1 constitutes a suitable starting point for the assessment of inventive step of the subject-matter of claim 1. Both parties also agreed that an automotive vehicle structure like that of document E1 inherently has several openings for allowing components such as wiring to extend into and through these openings and that these holes are adjacent the wall 24.

The respondent contested that document E1 disclosed features M1.8 and M1.9 of claim 1. There was agreement between the parties on the technical effect of these features and the objective technical problem. The technical effect of these distinguishing features was identified as keeping the holes in the automotive vehicle structure open for wiring extending through them. There was also consensus that the objective technical problem is to have holes in the automotive vehicle structure which remain open and can be used for cables, etc., even after foaming, i.e. to prevent the holes from being filled with foam.

4.2 The board concurs with the appellant's view that the walls 24 and 26 in document E1 prevent the foam from penetrating, especially because these walls do not have openings. Figure 3 of document E1 shows the structure 52 before the expansion of the expandable material, and

Figure 4 of document E1 shows the structure after the expansion. Figures 3 and 4 of document E1 are reproduced below.

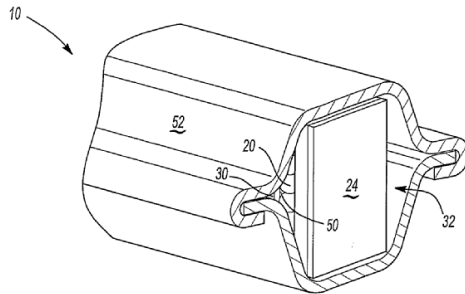


Fig-3

Figure 3 of document E1

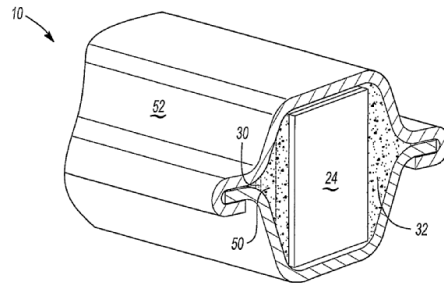


Fig-4

Figure 4 of document E1

The respondent pointed to paragraph [0046] of document E1 as allegedly leading away from the shielding effect. The last sentence of this paragraph reads: "*Preferably, the expandable material, the container 12 or both substantially span the entire cross-section of the cavity 50 to prevent passage of materials therethrough.*" The respondent concluded that in document E1 the walls guided the foam to the container, i.e. the structure, which was different from a shielding effect.

The board does not see this difference. On the contrary, this sideways guiding of the foam in the automobile vehicle structure of document E1 inevitably implies that the foam is prevented from passing through the walls 24 and 26 and hindered from passing in the structure's longitudinal direction. The walls therefore shield the expandable material from forming a foam material in a space within the cavity of the automotive vehicle structure and adjacent the structure, as required by feature M1.8. The shielding effect as claimed in features M1.9 is also known from document

E1. Since the presence of an opening in the structure adjacent the walls is not disputed, the second part of feature M1.9 is disclosed as well, i.e. the shielding effect of the walls 24 and 26 inevitably implies that no foam material is formed that covers the opening in the automotive vehicle structure.

- 4.3 The respondent's argument that the shielding effect was not a one-way solution but that there were several different possibilities for the person skilled in the art to provide openings in a structure which remain open and can be used for wiring cannot justify the presence of an inventive step since the claimed solution directed to the shielding effect is disclosed in document E1.

Furthermore, it is not relevant that Figures 3 and 4 of document E1 are schematic drawings because paragraph [0046] of document E1 explicitly discloses the guiding of the expandable material upon expansion.

- 4.4 In view of the reasons set out above, the subject-matter of claim 1 of auxiliary request 1A underlying the decision under appeal is not based on an inventive step (Article 56 EPC).

5. Admittance of auxiliary request 2A

- 5.1 The appellant requests that auxiliary request 2A not be admitted since it was a new request which should have been submitted in the first-instance proceedings. Furthermore, the respondent did not provide reasons for its late filing.

- 5.2 Auxiliary request 2A is based on former auxiliary request 2 filed during the opposition proceeding and

contains an amendment that addresses the opposition division's objection under Rule 80 EPC against former auxiliary request 1 (see decision under appeal, Reasons, point 4). It was filed for the first time with the respondent's reply to the statement of grounds of appeal.

5.3 The board decided to admit auxiliary request 2A into the proceedings under Article 12(6), second sentence, RPBA. Since the patent was maintained in the version of auxiliary request 1A, the patent proprietor, now respondent, did not have any reason to adapt former auxiliary request 2 in view of the objection under Rule 80 EPC against former auxiliary request 1 in the opposition proceedings. It is thus not apparent that auxiliary request 2A should have been filed during the opposition proceedings. Consequently, the circumstances of the appeal case justify its admittance (Article 12(6) RPBA).

6. Remittal to the opposition division

6.1 Under Article 111(1), second sentence, EPC, the board may either decide on the appeal or remit the case to the department responsible for the decision appealed. The appropriateness of remittal to the department of first instance and the existence of special reasons within the meaning of Article 11 RPBA are matters for the discretionary decision by the board, which assesses each case on its merits. Even if there is no absolute right to have every issue decided upon at two levels of jurisdiction, it has to be emphasised that it is the primary function of an appeal to review the decision under appeal in a judicial manner (Article 12(2) RPBA).

6.2 In the decision under appeal, the opposition division held that claim 1 of auxiliary request 1A fulfilled the requirements of the EPC. Therefore, there was no need to discuss the lower-ranking auxiliary requests then on file. Consequently, the objections raised by the opponent (now: appellant) in view of former auxiliary request 2, on which auxiliary request 2A is closely based, have not yet been discussed.

6.3 In the board's view, these circumstances constitute special reasons for remitting the case. Taking further account of the fact that both the appellant and the respondent considered a remittal appropriate, the board exercised its discretion under Article 111(1) EPC to remit the case to the opposition division for further prosecution.

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 for further prosecution.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated