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**Datasheet for the decision  
of 13 December 2023**

**Case Number:** T 0004/22 - 3.2.01

**Application Number:** 09764017.1

**Publication Number:** 2382069

**IPC:** B26D7/08, B26F1/24, A61L15/42,  
B32B3/10

**Language of the proceedings:** EN

**Title of invention:**  
PERFORATION OF LAMINATED MATERIALS

**Patent Proprietor:**  
Brightwake Limited

**Opponents:**  
Herrmann Ultraschalltechnik GmbH & Co. KG  
Mölnlycke Health Care AB  
Optima life science GmbH  
Schiweck Weinzierl Koch Patentanwälte  
Partnerschaft mbB  
Franke & Partner Patent- und Rechtsanwaltskanzlei  
HGF Limited  
HGF B.V.

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(c), 123(2)  
RPBA 2020 Art. 11, 12(6)

**Keyword:**

Admissibility of appeal - appeal fee (paid)  
Remittal - (no)  
Grounds for opposition - subject-matter extends beyond content  
of earlier application (yes)  
Late-filed request - should have been submitted in first-  
instance proceedings (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0004/22 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 13 December 2023**

**Appellant:** Brightwake Limited  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 20 October 2021  
revoking European patent No. 2382069 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** A. Pieracci  
O. Loizou

## **Summary of Facts and Submissions**

- I. An appeal was filed by the patent proprietor in the prescribed form and within the prescribed time limit against the decision of the opposition division revoking the European patent No. 2 382 069.
- II. The opposition division found that Article 100 c) EPC prejudiced the maintenance of the patent as granted and did not admit auxiliary request 1 into the proceedings.
- III. The Board communicated its preliminary assessment of the case with a communication pursuant to Rule 100 (2) EPC. The patent proprietor was invited to take position on its entitlement to pay a reduced appeal fee. The Board indicated that should the appeal found to be admissible, the decision under appeal could be set aside and the case be remitted to the opposition division for further prosecution.
- IV. The patent proprietor reacted with letter dated 20 January 2023 to the above communication of the Board providing arguments in support of the admissibility of the appeal and filing the following documents:
  - A1: Group Strategic Report, Report of the Directors and Consolidated Financial Statements for the Year ended 31 March 2020 for Brightwake Limited.
  - A2: Group Strategic Report, Report of the Directors and Consolidated Financial Statements for the Year ended 31 March 2021 for Brightwake Limited.

V. Opponent 2 further contested with letter dated 6 March 2023 the admissibility of the appeal in view of documents A1 and A2 submitted by the patent proprietor. Opponents 1, 3, 5, 6 and 8 also reacted to the Board's communication.

VI. Oral proceedings before the Board took place on 13 December 2023. At the end of the oral proceedings the decision was announced. For further details of the proceedings reference is made to the minutes thereof.

VII. The final requests of the patent proprietor (appellant) are:

that the case be remitted to the opposition division for admission of the auxiliary requests 5 to 8 and the new auxiliary request 1, all requests filed during the oral proceedings before the opposition division.

Furthermore the patent proprietor requested that the decision under appeal be set aside and that the patent be maintained as granted (main request), or in the alternative, that the patent be maintained in amended form on the basis of the set of claims according to one of auxiliary requests 1 to 3 filed with the statement setting out the grounds of appeal.

VIII. The final requests of the opponents 1, 2, 3, 5 and 8 (respondents 1, 2, 3, 5 and 8) are:

that the appeal be rejected as inadmissible, or in the alternative, that the appeal be dismissed.

The final request of opponent 6 (respondent 6) are:

that the appeal be dismissed.

Opponent 7 (respondent 7) made no submissions and had no requests.

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

X. Claim 1 of the patent as granted (main request) reads as follows:

"A method for introducing perforations (8) into a sheet (1) of laminated material that includes a layer (4) of silicone gel, which method involves contacting perforating elements (13) with the sheet and subjecting the sheet, at least in the regions contacted with the perforating elements, to high frequency mechanical vibrations, such that the perforating elements puncture the sheet of laminated material, wherein the perforating elements remain in the sheet of laminated material for sufficient time to allow re-moulding of the silicone gel around the perforating elements."

XI. Claim 1 of the patent as amended according to auxiliary request 1 in appeal proceedings reads as follows (additions with respect to claim 1 of the patent as granted being underlined):

"A method for introducing perforations (8) into a sheet (1) of laminated material that includes a layer (4) of hydrophobic silicone gel, which method involves contacting perforating elements (13) with the sheet and subjecting the sheet, at least in the regions contacted with the perforating elements, to high frequency mechanical vibrations, such that the perforating elements puncture the sheet of laminated material,

wherein the perforating elements remain in the sheet of laminated material for sufficient time to allow remoulding of the laminated material including the layer of hydrophobic silicone gel around the perforating elements."

XII. Claim 1 of the patent as amended according to auxiliary request 2 in appeal proceedings reads as follows (additions with respect to claim 1 of the patent as amended according to auxiliary request 1 being underlined):

"A method for introducing perforations (8) into a sheet (1) of laminated material that includes a layer (4) of hydrophobic silicone gel, which method involves contacting perforating elements (13) with the sheet and subjecting the sheet, at least in the regions contacted with the perforating elements, to high frequency mechanical vibrations, wherein the sheet of laminated material is held under pressure between the perforating elements and a sonotrode (14) which applies the high frequency mechanical vibrations, such that the perforating elements puncture the sheet of laminated material, wherein the perforating elements remain in the sheet of laminated material for sufficient time to allow remoulding of the laminated material including the layer of hydrophobic silicone gel around the perforating elements."

XIII. Claim 1 of the patent as amended according to auxiliary request 3 in appeal proceedings reads as follows (additions with respect to claim 1 of the patent as amended according to auxiliary request 2 being underlined, deletions being stroke-through):

"A method for introducing perforations (8) into a sheet (1) of laminated material that includes a layer (4) of hydrophobic silicone gel, which method involves contacting perforating elements in the form of a plurality of projections extending from a support (13) with the sheet such that the tips of the perforating elements contact the sheet of laminated material and subjecting the sheet, at least in the regions contacted with the perforating elements, to high frequency mechanical vibrations, wherein the sheet of laminated material is held under pressure between the perforating elements and a sonotrode (14) by which the high frequency mechanical vibrations are applied and wherein the sheet of laminated material is compressed between the sonotrode surface and the projections at the points in which it is in contact with the tips of the projections, ~~which applies the high frequency mechanical vibrations~~ such that the perforating elements puncture the sheet of laminated material, wherein the perforating elements remain in the sheet of laminated material for sufficient time to allow re-moulding of the laminated material including the layer of hydrophobic silicone gel around the perforating elements."

## **Reasons for the Decision**

1. Admissibility of the appeal
  - 1.1 Opponent 2, followed by opponents 1, 3, 5 and 8, argued that the patent proprietor's appeal should be held inadmissible since the fee for filing the appeal has not been paid in full. The patent proprietor had paid the fee foreseen for small or medium enterprises, so

the opponents, without having the right to benefit from the fee reduction, since the patent proprietor does not appear to be a small or medium sized enterprise as defined in the European Commission Recommendation 2003/361/EC of 6 May 2003 to which the declaration for the reduction of the appeal fee refers.

1.2 In reply to a communication of the Board inviting them to take position on this issue, the patent proprietor filed the consolidated financial statements for the year ended on 31 March 2020 and 31 March 2021 (documents A1 and A2, see point IV above) and indicated why on the basis of the data provided it was evident that the necessary requirements for benefiting of a fee reduction were fulfilled, i.e. having less than 250 employees, an annual turnover not exceeding 50 millions EUR, and an annual balance sheet total not exceeding 43 millions EUR.

1.3 The Board on the basis of the information provided by the patent proprietor, the validity of which has not been contested by the opponents, has concluded that it has been reasonably proven that the patent proprietor is a small or medium sized enterprise as required for benefiting of a fee reduction. The Board is thus not convinced by the counter arguments submitted by the opponents, e.g. in relation to the actual number of the employees, to possible associations and partnerships with other companies and the related turnover, as explained in the following.

The Board cannot follow the argument of the opponents that the financial statements filed, documents A1 and A2, do not relate to all the companies linked the patent proprietor, i.e. to the patent proprietor as a group. This is because at page 18, fifth paragraph of

A2 it is stated that the financial statement is that of the consolidated group and reference is made to all subsidiary operations (see also page 27, point 13, in which the subsidiaries are indicated).

The Board also concurs with the patent proprietor that the number of employees of the Medi Group is not relevant for assessing its status as SME, since this company only acted as a distributor of the patent proprietor's products as convincingly argued at the oral proceedings.

The Board is also not convinced by the argument of the opponents that the criteria of the headcount being lower than 250 are not fulfilled. As indicated by the patent proprietor the number of employees when considering the part-time work is lower than 250. Furthermore, the data of 2019 and 2020 show that the Brightwake Group satisfy each of the requirements of staff headcount, turnover and balance sheet figures for an SME for the two accounting period proceeding the year ending in March 2021, whereby the patent proprietor would not lose its status of SME even if the data for that year would not be considered as fulfilling the necessary requirements.

The argument that the managing director (Geschäftsführer) of the patent proprietor appears also to act as managing director of other companies and thus have to be somehow related to the patent proprietor is also not convincing because every company is, independent of the natural persons it is composed, an entity on its own. Furthermore if the patent proprietor bears the burden of proof that they are entitled to the reduction of the appeal fee and has provided proof thereof, it is up to the opponents to rebut this and substantiate their objections, in particular when the relevant information appear, without any undue burden, to be available in public registries.

Since the patent proprietor is entitled to a reduction of the appeal fee, the appeal is admissible.

2. Patent proprietor's request for remittal of the case to the opposition division

2.1 The patent proprietor requested that the case be remitted to the opposition division for admittance of auxiliary requests 5 to 8 and of the new auxiliary request 1, all requests having been filed during the oral proceedings before the opposition division.

2.2 The patent proprietor argued that the auxiliary requests filed at the oral proceedings in opposition proceedings should have been admitted by the opposition division since the division changed its preliminary opinion on added subject-matter few days before the oral proceedings on one issue and at the oral proceedings on two further issues.

Auxiliary requests 5 to 8, filed and withdrawn during the oral proceedings before the opposition division, should be admitted since the patent proprietor was essentially forced to withdraw them in order to be able to proceed with a further request to overcome the objections of convergence of the auxiliary requests raised by the opposition division.

The new auxiliary request 1 filed at the oral proceedings after withdrawal of all the other auxiliary requests should also be admitted since it was erroneously dealt with by the opposition division using the criterion of *prima facie* allowability.

2.3 The Board is not convinced by the arguments of the patent proprietor.

According to Article 11 RPBA a Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department of first instance constitute such special reasons.

- 2.4 The Board finds that no special reasons and in particular no fundamental deficiencies are apparent in the present case for remitting it to the opposition division as discussed in the following.
- 2.5 After the change of opinion of the opposition division the patent proprietor admittedly filed auxiliary requests 5 to 8 to take into account the new opinion of the opposition division on added subject-matter. After the discussion on the admissibility of auxiliary request 5, followed by a break for deliberation, the chairman of the opposition division announced that auxiliary request 5 was not admitted into the proceedings (see minutes of the oral proceedings, page 4, 1st and 2nd paragraphs). The patent proprietor then withdrew all auxiliary requests on file, i.e. auxiliary requests 1 to 8 and filed a new auxiliary request 1.
- 2.6 The allegation that the withdrawal of the auxiliary requests was made as a consequence of the fact that the opposition division exerted undue pressure on the patent proprietor is, however, completely unsubstantiated.
- Firstly, it is not supported by any evidence and in particular no information in this regard can be derived from the minutes, the correctness of which has not been disputed. Secondly, the allegation was raised only at the oral proceedings before the Board, whereas it would

normally be expected that such a serious allegation is filed as early as possible in the proceedings and in any case raised with the statement of grounds of appeal. Moreover, the respondents denied, at the oral proceedings before the Board, that there was any undue pressure exerted by the Opposition Division.

2.7 Since the patent proprietor on their own free volition has chosen to withdraw auxiliary requests 1 to 8, there is no special reason for the Board to remit the case to the opposition division in order to now consider again auxiliary requests 5 to 8.

2.8 The patent proprietor acknowledged at the oral proceedings before the Board that they reacted with the filing of auxiliary requests 5 to 8 to the change of opinion of the opposition division. Filing the new auxiliary request 1 after withdrawal of auxiliary requests 1 to 8 was thus a further tentative to react to the change of opinion of the opposition division. Under these circumstances, the Board does not see anything wrong in the use of the criterion of *prima facie* allowability for assessing the admittance of this new auxiliary request by the opposition division. As a matter of fact, the opposition division essentially found that the opponent was in this way attempting to reintroduce subject-matter which had been already objected to (see the appealed decision, page 11, second paragraph and the Guidelines, E-VI.2.2.2, penultimate paragraph, second sentence)

2.9 The Board thus cannot recognize a fundamental deficiency committed in the opposition proceedings nor special reasons for remitting the case also in relation to the new auxiliary request 1 filed at the oral proceedings before the opposition division.

- 2.10 The request of the patent proprietor of remittal of the case to the opposition division is therefore refused.
3. Added subject-matter of claim 1 of the patent as granted (Article 100 c) and 123(2) EPC)
- 3.1 The opposition division found that the introduction in claim 1 of the feature "a layer of silicone gel" to replace the feature "a layer of hydrophobic gel" made during prosecution adds subject-matter with respect to the application as originally filed, since a silicon gel can be hydrophilic, as stated in D14, paragraph bridging pages 2 and 3, and not contested by the patent proprietor in opposition proceedings (see impugned decision, page 10, last two paragraphs).
- 3.2 The patent proprietor in the statement setting out the grounds of appeal (see paragraph [0024] thereof), indicated the passages in the application as originally filed where the term "silicon gel" is used, however the Board notes that in the passages indicated the silicon gel is always indicated in the specific context of realizing an hydrophobic gel layer, but no basis is given for a silicon gel layer in general, taking into consideration that a silicon gel layer can also be hydrophilic, i.e. not hydrophobic. Accordingly, by encompassing any kind of silicon gels, i.e. both hydrophilic and hydrophobic silicon gels, claim 1 of the patent as granted provides a teaching going beyond the disclosure of the application as originally filed. The Board therefore does not see any reason for deviating from the finding of the opposition division that by substituting the feature "a layer of hydrophobic gel" with the feature "a layer of silicone gel" in claim 1 during prosecution, subject-matter has

been added extending beyond the content of the application as originally filed.

3.3 The above assessment of the Board was communicated to the parties with the Board's communication pursuant to Rule 100(2) EPC. No further submission was made by the patent proprietor in this regard, either in writing or at the oral proceedings before the Board.

3.4 The Board thus concurs with the finding of the opposition division that the ground for opposition under Article 100 c) EPC is prejudicial to the maintenance of the patent as granted.

4. Admittance of auxiliary requests 1 to 3

4.1 Auxiliary requests 1 to 3 have been filed with the statement setting out the grounds of appeal.

The patent proprietor argued that auxiliary requests 1 to 3 were an honest attempt to overcome the finding of added subject-matter of the opposition division. These requests could not have been filed at the oral proceedings before the opposition division because it was evident that no further requests including the expression "such that" would have been admitted and that the only way to proceed would have been through filing an appeal. Considering the course of the proceedings before the opposition division the Board should exercise its discretion in favour of the patent proprietor and admit the auxiliary requests.

4.2 The Board disagrees and rather shares the view of the respondents that the patent proprietor could and should have submitted the auxiliary requests at the oral proceedings before the opposition division.

In fact, it is undisputed that the objections of added subject-matter were raised by the opponents from the very beginning of the opposition proceedings. The patent proprietor could not, therefore, have been taken by surprise by these objections. The only possible element of surprise at the oral proceedings before the opposition division was their change of opinion (at least as compared to the first opinion given by the opposition division with communication dated 2 September 2019, in which it was concluded that the opponents' objections on added-subject matter were not convincing; this opinion was however changed with communication dated 8 June 2021 in which the opposition division considered that one objection of added subject-matter raised by the opponents was convincing). However, the patent proprietor was given the possibility to react to this change of opinion, and did so by filing auxiliary requests 5 to 8, which were subsequently withdrawn. There is thus no justification for the patent proprietor filing further auxiliary requests to overcome the known objections with the statement of grounds of appeal, as the opportunity to do so clearly presented itself in opposition proceedings.

- 4.3 Finally, the argument of the patent proprietor that auxiliary requests 1 to 3 would not have been admitted by the opposition division as it became clear at the oral proceedings that no further auxiliary requests including the expression "such that" would have been admitted, does also not justify the filing of these auxiliary requests only with the statement of grounds of appeal. The expression "such that" was discussed at the oral proceedings (page 1, penultimate paragraph of the minutes) and was regarded by the opposition division as problematic after deliberation (page 2, 5<sup>th</sup>

paragraph of the minutes). As stated above, the patent proprietor reacted to the change of opinion of the opposition division announced after the deliberation by way of auxiliary requests 5 to 8. At that stage, it was at least to be expected that auxiliary requests containing the expression "such that" would not have been considered allowable by the opposition division, but in any case the patent proprietor was not prevented from filing such requests and having their admissibility discussed, and, in case, the conclusions of the opposition division being later reviewed in appeal.

In any case, as stated above, the patent proprietor chose to withdraw auxiliary requests 5 to 8 thus deliberately depriving themselves of the possibility of such a review.

Auxiliary requests 1 to 3 are therefore not admitted into the proceedings pursuant to Article 12(6) RPBA.

**Order**

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

The appeal is dismissed

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated