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**Datasheet for the decision
of 19 September 2024**

Case Number: T 0026/22 - 3.2.06

Application Number: 13842177.1

Publication Number: 2900191

IPC: A61F13/15, A61F13/49,
A61F13/496

Language of the proceedings: EN

Title of invention:

DISPOSABLE ABSORBENT ARTICLE WITH EXTENSIBLE AND RETRACTABLE
CORE

Patent Proprietor:

Drylock Technologies NV

Opponent:

Ontex BV

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(2), 112(1)(a)
RPBA 2020 Art. 13(2)

Keyword:

Amendments - added subject-matter (yes)
Amendment after notification of Art. 15(1) RPBA communication
(yes) - exceptional circumstances (no)
Referral to the Enlarged Board of Appeal - ensure uniform
application of the law - (refused)-

Decisions cited:

G 0002/10, T 0494/18, T 1836/22, T 1800/21, T 2295/19,
T 1480/16, T 0981/17, T 0482/19, T 2604/18, T 2222/15,
T 1857/19, T 0532/20, T 2482/22, T 1598/18, T 1533/15,
R 0016/09, R 0007/14, T 1569/17

Catchword:



Beschwerdekammern

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Case Number: T 0026/22 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 19 September 2024

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
5 October 2021 concerning maintenance of the
European Patent No. 2900191 in amended form.**

Composition of the Board:

Chairman M. Dorfstätter
Members: M. Hannam
J. Hoppe

Summary of Facts and Submissions

I. Appeals were filed by each of the appellant (patent proprietor) and the appellant (opponent) against the interlocutory decision of the opposition division in which it found that European patent No. 2 900 191 in an amended form (corresponding to auxiliary request 1 in appeal) met the requirements of the EPC.

II. The appellant (patent proprietor) requested with its grounds of appeal/reply that the decision under appeal be set aside and the patent be maintained as granted (main request) or, as an auxiliary measure, that the patent be maintained in amended form according to one of the following requests:

- auxiliary requests 1 to 16;
- auxiliary requests *2bis* to *16bis*; or
- auxiliary requests *1tris* to *16tris*.

Auxiliary requests 1 to 16 were filed already during the opposition proceedings, while auxiliary requests *2bis* to *16bis* were merely referred to but not filed. With the reply to the opponent's grounds of appeal auxiliary request *2bis* and auxiliary request *1tris* were filed but not the remaining auxiliary requests *3bis* to *16bis* and *2tris* to *16tris*.

III. The appellant (opponent) requested with its grounds of appeal/reply that the decision under appeal be set aside and the patent be revoked.

IV. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the ground for opposition under Article 100(c) EPC

prejudiced maintenance of the patent as granted. It indicated further that the respective claim 1 of each of the auxiliary requests referred to by the proprietor, even if not filed, seemed not to overcome this objection of subject-matter extending beyond the content of the application as filed.

V. In its submission of 24 July 2024, the patent proprietor filed new auxiliary requests *1quater* to *4quater* which correspond to auxiliary requests 1 to 4 on file with claims 1 to 12 deleted. It further requested that, should these requests not be admitted, a referral be made to the Enlarged Board of Appeal according to the questions as set out in that letter.

VI. Oral proceedings were held before the Board on 19 September 2024. At the close of the oral proceedings the parties' requests were thus as follows:

The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or, as an auxiliary measure, that the patent be maintained in amended form according to one of the following requests in the given order:

- auxiliary requests 1 to 16, filed with the reply
- auxiliary requests *2bis* to *16bis*,
auxiliary request *2bis* filed with the reply,
- auxiliary requests *1tris* to *16tris*,
auxiliary request *1tris* filed with the reply,
- auxiliary requests *1quater* to *4quater*,
filed with letter of 24 July 2024.

The proprietor further requested to refer the questions as presented in its letter of 24 July 2024 to the Enlarged Board of Appeal if the Board did not admit

auxiliary requests 1*quater* to 4*quater* into the appeal proceedings.

The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked and that the request for referral be refused.

VII. Claim 1 of the main request (with feature annotation as used by the opposition division in its decision) reads as follows:

- F1 A disposable absorbent garment (400),
comprising:
 - F1.1 a waistband assembly (407) configured to be worn about a waist of a subject; and
 - F1.2 an absorbent panel assembly (409) having first and second ends that are coupled to the waistband assembly,
 - F1.3 the absorbent panel assembly including a liquid-pervious body-side layer, a liquid impervious external layer, and an absorbent core (410) positioned between the body-side and external layers; characterized in that
- F2 the absorbent panel assembly and the waistband assembly include a first contraction region (408A) that extends continuously between opposite upper edge regions of the waistband assembly and across the absorbent core (410), along a longitudinal axis of the absorbent core;
- F3 the first contraction region (408A) is configured to be extensible and retractable along the longitudinal axis of the absorbent core; and
- F4 wherein the first contraction region (408A) is configured to elastically retract the absorbent

core toward the upper edges of the waistband assembly.

Claim 13 of the main request (with feature annotation as used by the opposition division in its decision) reads as follows:

- F1 A disposable absorbent garment, comprising:
 - F1.1 a front panel (530) having a longitudinal first length (536) and a first width (535);
 - F1.2 a rear panel (520) having a longitudinal second length (526) and a second width (525); and
 - F1.3 an absorbent panel assembly (509) having a longitudinal third length (513) extending from an absorbent panel assembly first end (511) to an absorbent panel assembly second end (512), the absorbent panel assembly including an absorbent region that extends along a portion of the third length;
 - F1.4 wherein the first and second lengths are oriented substantially transverse to the third length;
 - F1.5 wherein the first end of the absorbent panel assembly (509) is coupled to the front panel (530), and the second end of the absorbent panel assembly (509) is coupled to the rear panel (520); and
- F2 wherein at least one of the front and rear panels (520, 530) includes a contraction region (508A, 508B), positioned overlapping with one of the first and second ends of the absorbent panel assembly (509),
- F3 wherein the contraction region (508A, 508B) is extensible and retractable in the direction of the third length and is configured to retract the

absorbent panel assembly toward the at least one of the front and rear panels;

F4 wherein the contraction region (508A, 508B) comprises an extensible and retractable base material or includes a non-extensible base material to which one or more extensible and retractable materials are affixed.

Other than noting that the respective independent claims of auxiliary requests 1 to 16, *2bis* to *16bis* and *1tris* to *16tris* each fail to recite that the absorbent garment included multiple contraction regions, the specific wording of the independent claims of these requests is not relevant to the present decision.

Claim 1 of auxiliary request *1quater* reads as for claim 13 of the main request.

Claim 1 of auxiliary request *2quater* reads as for claim 1 of auxiliary request *1quater* with the following feature appended:

"wherein the front and rear panels include respective front and rear contraction regions positioned overlapping with the first and second ends, respectively, of the absorbent panel assembly".

Claim 1 of auxiliary request *3quater* reads as for claim 1 of auxiliary request *2quater* with the following feature appended:

"wherein the absorbent panel assembly includes an absorbent core configured to absorb bodily fluids; wherein the front contraction region overlaps with the absorbent core".

Claim 1 of auxiliary request *4quater* reads as for claim 1 of auxiliary request *2quater* with the following feature appended:

"wherein a portion of the rear panel overlaps with an end portion of the absorbent panel assembly and wherein a portion of the front panel overlaps an opposite end portion of the absorbent panel assembly".

VIII. The opponent's arguments relevant to the present decision may be summarised as follows:

Main request

The taking up of the single contraction region into claim 1 lacked a direct and unambiguous basis in the application as filed. Fig. 4 and the description on page 10, lines 5 to 16 as filed disclosed a specific embodiment in which multiple contraction regions were disclosed in combination. Limiting claim 1 to just a first contraction region thus comprised an unallowable intermediate generalisation of the application as filed.

Auxiliary requests 1 to 16, *2bis* to *16bis* and *1tris* to *16tris*

These should not be admitted since their filing only with the proprietor's reply to the opponent's grounds of appeal was too late. These could have been filed before the opposition division. Even if admitted, all the requests anyway failed to overcome the added-matter objection to claim 1 of the main request.

Auxiliary requests *1quater* to *4quater*

These should also not be admitted. The deletion of claims was to be regarded as an amendment. The added-matter objection had already been raised in writing during the opposition procedure and so could not have taken the proprietor by surprise. The auxiliary requests thus should have been presented as part of its complete appeal case. An unfavourable preliminary opinion did not amount to exceptional circumstances justifying the admittance of these requests. Hence, the late filing was not excused. These requests both resulted in a re-weighting of the case and a disproportionate shift in focus for the Board and the opponent as different features in different claims would need to be discussed. This would be unfair for the opponent as it was not foreseeable that these requests would be filed at such a late stage despite the objection being on file before.

The Board was able to take a decision on the admittance of these auxiliary requests without requiring a referral, so the request for referral should be rejected.

IX. The patent proprietor's arguments relevant to the present decision may be summarised as follows:

Main request

The subject-matter of claim 1 did not extend beyond the content of the application as filed.

Regarding feature F2, Fig. 4 and page 10, lines 5 to 16 of the application as filed clearly disclosed to the skilled person that the first contraction region (408A) alone was essential to the invention, as was further clear from claims 1, 2 and 7 as filed. This understanding was further corroborated on page 3, lines 25 to 27 and page 5, line 24 which disclosed 'a

contraction region' rather than multiple contraction regions. Figs. 2 and 3 also each disclosed a single essentially longitudinally extending contraction region. The further contraction regions disclosed in Fig. 4 were thus clearly optional.

The disclosure as a whole consistently disclosed the specific function of the first contraction region (408A) to be drawing the absorbent panel assembly into the crotch region of the wearer; it achieved this technical effect alone. The further contraction regions (408A) merely optionally contributed to this effect. This was further evident from claim 4 as filed which defined the second contraction region being arranged orthogonally to the longitudinal axis of the absorbent core and thus being unable to contribute to the desired effect of drawing the absorbent panel assembly into the wearer's crotch region.

Auxiliary requests 1 to 16, *2bis* to *16bis* and *1tris* to *16tris*

The respective claim 1 of each of these requests met the requirement of Article 123(2) EPC for the same reasons as those presented for claim 1 of the main request.

Auxiliary requests *1quater* to *4quater*

These requests should be admitted. The deletion of claims 1 to 12 of the former requests in each request simplified the number of issues to be discussed. The remaining claims in these requests had been discussed in detail by both parties in their written submissions such that no new burden resulted from the filing of the new requests. The objection under Article 100(c) EPC relating to the omission of the multiple contraction

regions was only briefly mentioned in the grounds of appeal and the Board's preliminary opinion in this regard was totally unexpected. This amounted to exceptional circumstances supporting the admittance of these new requests. Exceptional circumstances could be of a legal nature. T 1800/21 and T 2295/19 supported the admittance of new auxiliary requests under similar circumstances. The new requests did not result in a re-weighting of the case, did not change the legal and factual framework of the proceedings and had no impact on procedural economy. Despite the differences in the features, the prior art was identical and it did not make any sense to file so many requests.

In view of diverging decisions relating to deletion of claims from a request, should the Board not admit these requests, a referral to the Enlarged Board of Appeal should be made according to the questions as set out in the letter of 24 July 2024.

Reasons for the Decision

1. *Main request*

1.1 *Article 100(c) EPC*

The ground for opposition under Article 100(c) EPC prejudices maintenance of the patent as granted.

1.2 Relative to claim 1 as filed, feature F2 of claim 1 has been amended *inter alia* to recite that the first contraction region 'extends continuously between opposite upper edge regions of the waistband assembly and across the absorbent core, along a longitudinal axis of the absorbent core'. This specific wording

defining the nature of the first contraction region is disclosed solely in the description on page 10, lines 8 to 10 as filed.

- 1.3 These three lines of the description are however part of a more detailed paragraph of the description, starting on line 5 of page 10, of an absorbent garment as illustrated in Fig. 4. Not only does this paragraph begin by disclosing the absorbent article to include multiple contraction regions 408A, 408B, 408C and 408D, but Fig. 4 also clearly depicts these. The extraction of just the first contraction region for inclusion in claim 1 from the more detailed disclosure including multiple contraction regions thus lacks a direct and unambiguous basis according to the gold standard (G 2/10; Reasons 4.3).

- 1.4 The proprietor's argument, with reference to claims 1, 2 and 7 and page 10, lines 5 to 16, that the first contraction region alone was essential to the invention is not accepted. Whilst claims 1, 2 and 7 as filed are indeed directed to the first contraction region only, the proprietor has not relied solely on these claims as a basis for the claimed subject-matter, rather using page 10, lines 5 to 16 for the definition that *inter alia* the first contraction region extends continuously between opposite upper edge regions of the waistband assembly. In this paragraph of the description the first contraction region is disclosed in structural combination with multiple contraction regions and the allegation that solely a first contraction region was disclosed in claims 1, 2 and 7 as filed does not allow a direct and unambiguous conclusion to be drawn that the first contraction region alone is of relevance to the disclosed garment. The relevant standard to be used in this respect is the gold standard. Other tests may

not take the place of this standard (Case Law of the Boards of Appeal, 10th edition, II.E.1.3.1 and 1.4.2). Indeed, as far as any concept of features being 'essential to the invention' can be followed, there is no such isolated disclosure of solely the first contraction region satisfying this requirement in the application as a whole.

1.5 The proprietor's reference to page 3, lines 25 to 27 and page 5, line 24 which disclosed 'a contraction region' rather than multiple contraction regions and Figs. 2 and 3, also each disclosing a single essentially longitudinally extending contraction region, does not provide a disclosure of the claimed subject-matter to the required 'gold standard'. Whilst the references to pages 3 and 5 indeed disclose 'a contraction region', this is not contradictory to the disclosure of multiple contraction regions in relation to Fig. 4 on page 10, lines 5 to 16; the focus is simply placed on just a single contraction region. However, the detail of the first contraction region included in feature F2 of claim 1 is specifically extracted from page 10, lines 8 to 10, which relates to Fig. 4 and an explicit disclosure of multiple contraction regions. When relying on this passage to formulate feature F2 of claim 1, therefore, the first contraction region is disclosed solely in combination with multiple contraction regions. As for Figs. 2 and 3 which each disclose a single essentially longitudinally extending contraction region, these figures do not disclose the detail of the contraction region recited in feature F2 and so cannot provide a basis for this feature.

1.6 The proprietor's contention that the disclosure as a whole consistently disclosed the specific function of

the first contraction region (408A) to be drawing the absorbent panel assembly into the crotch region of the wearer is not disputed. However, this function is not performed alone by the first contraction region. From Fig. 4 it is evident, not least from a technical viewpoint, that not only the first contraction region 408A would act to draw the absorbent panel assembly into the wearer's crotch region, but additionally that the second and third contraction regions (408B, 408C) would contribute towards this function. This would be the case due to the second and third contraction regions being coupled to the absorbent core (see the sentence bridging pages 10 and 11 as filed) and extending towards the waistband, albeit at an angle to the longitudinal axis but nonetheless with a substantial directional component of contraction towards the waistband. Even if the drawing effect of the second and third contraction regions were less than that of the first contraction region, there would still be a functional link of drawing the absorbent core into the wearer's crotch region between at least the first, second and third contraction regions.

- 1.7 The proprietor's reference to claim 4 as filed to argue that the second contraction region did not contribute to this drawing function, since it acted orthogonally to the longitudinal axis of the absorbent core, is not accepted. The second contraction region is depicted as 408B in Fig. 4 and clearly has a significant component of extension along the longitudinal axis of the absorbent core. In this portion of its length it will therefore, as described in point 1.6 above, at least contribute towards drawing the absorbent core into the wearer's crotch region. Whether the second contraction region is additionally extensible and retractable along a direction substantially orthogonal to the

longitudinal axis of the absorbent core (as recited in claim 4 as filed) does not negate its very clear, technical function of contributing to the drawing of the absorbent core towards the wearer's crotch region.

1.8 In summary, therefore, the omission from claim 1 of at least the detail relating to the multiple contraction regions results in its subject-matter extending beyond the content of the application as filed.

1.9 The ground for opposition under Article 100(c) EPC is thus prejudicial to maintenance of the patent as granted.

2. *Auxiliary requests 1 to 16, 2bis to 16bis and 1tris to 16tris*

2.1 *Article 123(2) EPC*

2.2 After having concluded that the subject-matter of claim 1 of the main request extends beyond the content of the application as filed, the Board at oral proceedings indicated that, in view of claim 1 of each request failing to recite that the absorbent garment included multiple contraction regions, none of the auxiliary requests 1 to 16, 2bis to 16bis and 1tris to 16tris overcame the corresponding objection under Article 123(2) EPC. This opinion is also consistent with that indicated by the Board in its communication under Article 15(1) RPBA.

2.3 To this preliminary opinion the proprietor declined to submit any counter-arguments.

2.4 Irrespective of the question of admittance of these auxiliary requests, the Board thus confirms its

preliminary opinion herewith. The subject-matter of claim 1 of each of auxiliary requests 1 to 16, *2bis* to *16bis* and *1tris* to *16tris* fails to meet the requirement of Article 123(2) EPC. These auxiliary requests are consequently not allowable.

3. *Auxiliary requests 1quater to 4quater*

3.1 *Admittance*

The Board exercised its discretion not to take auxiliary requests *1quater* to *4quater*, which were filed after notification of the Board's communication under Article 15(1) RPBA, into account.

3.2 *Amendment of the proprietor's appeal case pursuant to Article 13 RPBA*

Auxiliary requests *1quater* to *4quater* differ from auxiliary requests 1 to 4 by the deletion of respective claims 1 to 12.

The admittance of auxiliary requests *1quater* to *4quater* is subject to the Board's discretion as they are regarded as an amendment of the proprietor's appeal case according to Article 13(2) RPBA.

Under Article 13(2) RPBA any amendment to the party's appeal case shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

3.2.1 In the case law of the Boards of Appeal, different approaches have been taken regarding the question of whether the deletion of a claim category, of dependent

claims or of alternatives within a claim of a request is *always* to be regarded as an amendment, or whether an amendment is only recognised if the deletions change the legal and factual framework of the appeal (see Case Law of the Boards of Appeal, 10th edition, V.A.4.2.2 d) and particularly T 494/18, reasons 1.3.1). However both approaches nonetheless come to the same conclusion i.e. that a deletion is an amendment of the proprietor's appeal case if it changes the factual and legal framework of the appeal. Some of the criteria for assessing whether the legal and factual framework has changed correspond to those that are applied to decide whether the amendment is justified by exceptional circumstances (see for example T 1836/22, reasons 3; T 1800/21, reasons 3.4.2 to 3.4.6; T 2295/19, reasons 3.4.14). The criteria that might be applied according to the case law (see for example T 1480/16, reasons 2.3; T 981/17, reasons 3.2; T 482/19, reasons 5.7; T 2604/18, reasons 1.1; T 1569/17, reasons 4.3.2-4.3.4; T 2222/15, reasons 29; T 1857/19, reasons 1.1) are in particular whether the claim(s) remaining after the deletion:

- resulted in the matters at issue being thoroughly re-weighted;
- had been discussed exhaustively in writing;
- showed modifications such that a fresh discussion of novelty and inventive step would be required;
- had been discussed in the preliminary opinion of the Board;
- raised new issues;
- limited the issues to be discussed.

3.2.2 The Board concludes that, irrespective of which approach is followed, amended auxiliary requests *1quarter* to *4quarter* are to be regarded as an amendment

of the proprietor's appeal case pursuant to Article 13(2) RPBA.

Even if the deletion of certain claims from a claim set were not regarded as an amendment *per se*, applying the criteria as set out above, the Board holds that, in the present case, the deletion of claims 1 to 12 in auxiliary requests 1 to 4 indeed changes the factual and legal framework of the appeal. This is because, due to the deletion, the consideration of these requests would change the discussion from Article 123(2) EPC to Articles 54 and 56 EPC which would in view of the modified wording of the remaining claim 1 in auxiliary requests 1*quater* to 4*quater* and the numerous attacks raised by the opponent entail thoroughly re-evaluating the matters at issue, i.e. change the focus of the proceedings. In their written submissions, the parties addressed some features of the then pending claim 13 for the discussion of novelty and inventive step. However, comparing features F1 to F4 in the respective claim 1 of the higher ranking requests with those in each claim 1 of auxiliary request 1*quater* to 4*quater* shows that only feature F1 is identical while significant differences pervade nearly all the other features of the respective claims. For example, claim 1 of auxiliary request 1*quater* to 4*quater* all define a front panel having a longitudinal length and width (feature F1.1), a rear panel having a longitudinal length and width (feature F1.2), the lengths of these panels being oriented transverse to the length of an absorbent panel assembly (feature F1.4) and at least one of the front and rear panels overlapping one of the ends of the absorbent panel assembly (feature F2). None of these features was present in claim 1 of any of the higher ranking requests. Hence, for assessing the new requests, the specific differences between the subject-

matter of the respective claim 1 of the higher ranking auxiliary requests and claim 1 of the late-filed auxiliary requests 1*quater* to 4*quater* would need to be established first. Subsequently, in view of these specific differences, a new discussion concerning novelty and inventive step would be necessary, a factor that is considered to indicate a change of the legal and factual framework of the appeal (T 1480/16, reasons 2.3; T 482/19, reasons 5.7; T 1569/17, reasons 4.3.4).

This is not questioned by the proprietor's argument that the same prior art was relied upon for the assessment of novelty and inventive step of claim 1 of the higher ranking requests and claim 1 of auxiliary requests 1*quater* to 4*quater*. Rather, it is evident that the assessment of novelty and inventive step must be based on the specific features in the claim under examination (T 1569/17, reasons 4.3.4).

- 3.2.3 In view of the individual circumstances of the case, shifting the focus of the proceedings from the discussion of Article 123(2) EPC to Articles 54 and 56 EPC is a further aspect that amounts to a new weighting of the subject of the proceedings, as it would require an additional assessment which was not essential and had not been the focus before, neither in the preliminary opinion of the Board nor in the oral proceedings.

Hence, contrary to the proprietor's assumption, the amended requests would not have facilitated or shortened the matters to be discussed. Rather, they would have required an additional assessment that had not been necessary for the higher-ranking requests after the Board had concluded in the oral proceedings that these contravened Article 123(2) EPC. In this

respect it should be considered that the non-allowability of a single claim in a request has the consequence that the whole request is not allowable. Hence, further claims or objections are not relevant for the outcome of the appeal and their discussion in the oral proceedings is not necessary (R 7/14, reasons 4.2.2; T 532/20, reasons 9.8; T 1800/21, reasons 3.3).

In view of this, the proprietor's argument that auxiliary requests *1quater* to *4quater* had no adverse impact on procedural economy is not convincing. In this respect it is also noted, that the proprietor has not limited the number of requests but added four additional auxiliary requests without withdrawing any of the previous ones. To the relevance of this aspect see, for example, T 1836/22, reasons 1 and 3.

- 3.2.4 An additional aspect supporting the deletion to be regarded as an amendment in view of the specific circumstances of the case, is the requirement to present the complete appeal case at the beginning of the appeal proceedings according to Article 12(3) RPBA (and thus the need to file all the requests the proprietor wishes to rely on already with the grounds of appeal/reply) which allows the Board and the other party to identify and focus on the essential issues of the case. This would not be possible if the proprietor were allowed to file new requests even at the final stage of the appeal proceedings such that the relevant issues and the focus of the required examination would change. Moreover, the Board's communication under Article 15(1) RPBA serves to identify the essential issues (in particular those which are relevant for *all* the requests on file) to be discussed at the oral proceedings. This follows not least from the wording of Article 15(1), 4th sentence RPBA ("In order to help

concentration on essentials during the oral proceedings, ..."). Even if a preliminary opinion in the communication is just provisional, such that preparation of the remaining issues by the Board is still required, its purpose to focus the discussion on the essential issues would become devalued if the proprietor were allowed to change the focus at any time of its own volition by deleting the claims under discussion and shifting attention to the remaining claims. This also holds true for the opponent's preparation of the oral proceedings which is based on the requests on file such that the opponent might decide to focus on specific issues according to its own evaluation of the probability of a potential change in the Board's preliminary opinion. The proprietor's allegation that the opponent must anyway prepare for everything, ignores this legitimate interest of the opponent. To allow a focussed preparation of the case in the interests of both procedural economy and fair and predictable proceedings for the other party, Article 12(3) RPBA provides that the parties present their complete submissions already at the beginning of the appeal proceedings. Hence, the proprietor's further argument that filing of all its requests, including those which merely entailed deletion of claims from higher ranking requests at the initial stage of the appeal proceedings not making sense, is neither convincing nor supported by the provisions of the Rules of Procedure of the Boards of Appeal.

3.2.5 The Board therefore concludes that under the specific circumstances of the case, late-filed auxiliary-requests *1quarter* to *4quarter* changed the factual and legal framework of the appeal case. Hence, irrespective of which of the two approaches set out in the Case Law discussed above is followed, late-filed auxiliary

requests 1*quater* to 4*quater* are an amendment of the proprietor's appeal case and their admittance is subject to the discretion of the Board.

3.3 *Exceptional circumstances according to Article 13(2) RPBA*

The proprietor has not justified the late filing of auxiliary requests 1*quater* to 4*quater* with exceptional circumstances as required by Article 13(2) RPBA.

3.3.1 Some decisions seemingly consider that exceptional circumstances are limited to unforeseen developments in the appeal proceedings (T 2482/22, reasons 3.2). Other boards are more lenient and hold that it is not necessary that the late amendment is caused by exceptional developments. Rather, according to this approach, a late filed request which does not change the legal and factual framework of the appeal might be admitted into the proceedings if the amendment does not impair procedural economy or the legitimate interests of the other party (see for example: T 2295/19, reasons 3.4.12; T 1800/21, reasons 3.4.2; T 1598/18, reasons 25.1).

3.3.2 However, in the present case, the two approaches would not lead to different results as the proprietor's amendment is neither caused by a procedural development nor justified by other exceptional circumstances.

3.3.3 In the present case, the amendment was not caused by unforeseen developments in the proceedings as, contrary to the proprietor's argument, the proprietor had no reason to be surprised by the Board's preliminary opinion that omission of the multiple contraction regions 408B, 408C and 408D in claim 1 of the higher-

ranking requests offended Article 123(2) EPC. Rather, this objection had already been raised by the opponent under point 5.1.1 of its statement of grounds of appeal and also previously during the opposition proceedings. As the appeal proceedings are intended for reviewing the impugned decision, the parties have to expect that the Board expresses a preliminary opinion different from that of the opposition division. Filing requests in reaction to the preliminary opinion of the Board which merely assesses objections raised from the very beginning of the appeal proceedings does therefore not qualify as exceptional circumstances and cannot justify these requests being taken into account (Case Law of the Boards of Appeal, 10th edition, V.A.4.5.6.c)).

Contrary to the proprietor's argument, it is also not discernible that further explanations would have been required to substantiate this objection. Rather, already with its grounds of appeal (point 5.1.1) the opponent had referred to the embodiment of figure 4 as filed and argued that this required multiple contraction regions which were not included in claim 1 of the higher-ranking requests. Therefore, the proprietor's contention that the objection under Article 123(2) EPC against the then pending claim 1 of auxiliary request 1 was substantiated for the first time in the Board's communication under Article 15(1) RPBA is not correct. Hence, the proprietor could and should have reacted to this objection already with its reply to the opponent's grounds of appeal as required by Article 12(3) RPBA.

3.3.4 Moreover, the late-filing of auxiliary requests 1^{quarter} to 4^{quarter} has not been justified with other exceptional circumstances.

The criteria applied to examine whether there are exceptional circumstances essentially correspond to those set out above for assessing whether the legal and factual framework of the appeal case has changed such that the respective findings (see point 3.2 above) are referred to. Additional specific arguments of the proprietor are addressed here below.

According to decision T 1800/21, relied on by the proprietor, one important aspect for assessing whether exceptional circumstances applied was whether the late-filed request raised new issues and whether the objections on file were unambiguously overcome such that it could be immediately recognised that the patent could be maintained based on the new request (T 1800/21, reasons 3.4.3 and 3.4.6; see also T 1836/22, reasons 1 and 2).

In the present case, it is apparent from neither the parties' submissions nor the preliminary opinion of the Board that all the remaining objections on file are overcome by the new auxiliary requests *1quater* to *4quater*. Rather, the various remaining objections of the opponent under Articles 54 and 56 EPC would need to be discussed in the oral proceedings for the specific features in the remaining claim 1 without the outcome being predictable from the preliminary opinion of the Board or from the previous discussions during the oral proceedings.

Hence, the Board is not deviating from the findings in decision T 1800/21, in which it was found that exceptional circumstances applied due to the new request *prima facie* overcoming the remaining objections on which a preliminary opinion had already been given (T 1800/21, reasons 3.4.8). Moreover, in that decision

the Board held that both the deleted claims and the remaining claims had already been fully discussed in writing by the parties.

Similarly in decision T 2295/19, the remaining claims had been discussed in detail ("eingehend", reasons 3.4.14) by the parties and the remaining method claims had already been addressed in the Board's communication under Article 15(1) RPBA.

These two decisions thus differ from the present case in which the objection of novelty and inventive step was not addressed in the communication pursuant to Article 15(1) RPBA because it was not essential to the preliminary opinion of the Board. Therefore, the present conclusion does not deviate from the principles set out in T 1800/21 and T 2295/19.

3.4 *Conclusion*

Therefore, irrespective of which approach is applied, new auxiliary requests *1quater* to *4quater* represent an amendment of the proprietor's appeal case which has not been justified by exceptional circumstances.

The Board thus exercised its discretion according to Article 13(2) RPBA not to take auxiliary requests *1quater* to *4quater* into account.

4. *Referral to the Enlarged Board of Appeal*

4.1 The proprietor requested to have the following questions referred to the Enlarged Board of Appeal:

"1. Is a new auxiliary request filed by the patent proprietor after the statement of grounds of appeal

or the statement of defence to the appeal to be regarded as an amendment to the grounds of appeal subject to Article 13 RPBA if the new auxiliary request differs from a request contained in the file only in the deletion of one or more claims?

2. If the answer to 1) is in the negative, in the specific case where the request consists of the deletion of an independent claim relating to an aspect of the invention to be protected and, if any, the dependent claims, is such request an amendment of appeal subject to Article 13 RPBA?

3. If the questions under 1) and 2) are answered in the affirmative, which criteria are relevant to judge whether exception[al] circumstances within the meaning of Article 13(2) EPC [RPBA] exist?"

- 4.2 The Board concludes, that in the present case a referral of questions 1) to 3) to the Enlarged Board of Appeal is not required under Article 112(1)a) EPC. The request of the proprietor was therefore refused.
- 4.3 Specifically regarding questions 1) and 2), a referral is required neither to ensure uniform application of the law nor in view of a point of law of fundamental importance.
- 4.3.1 The proprietor has not cited decisions that considered the deletion of one or more claims *per se* not to be an amendment. The Board is also not aware of any. Rather, also according to the more lenient approach, of importance is whether the deletion of claims would result in a change of the legal and factual framework of the appeal, in particular whether the subject or focus of the proceedings would shift and whether new

issues would need to be assessed (T 532/20, reasons 9.6).

- 4.3.2 As set out above, in the present case, auxiliary requests 1*quater* to 4*quater* differ from higher ranking requests through the deletion of the previous independent claim 1 resulting in an amendment of the proprietor's appeal case because the assessment of the new requests would change the legal and factual framework of the appeal (see point 3.2 above). Therefore any divergence in the case law is not relevant for the outcome of the present case.
- 4.3.3 A referral is also not required in view of decisions T 1800/21 and T 2295/19, which were referred to by the proprietor, because the Board does not challenge the potential relevance of the criteria applied in those cases. However, despite accepting a catalogue of possible criteria, applying and balancing the criteria always depends on the specific circumstances of the case and the impact of any respective criterion on the merits of the case. In this respect, the importance of one criterion might outweigh the others (R 16/09, reasons 2.2.4; T 1533/15, reasons 7.2). Already for this reason, the application of the same legal principles and criteria may lead to different results in different cases without indicating an inconsistent application of the law or a point of law of fundamental importance that would require a referral to the Enlarged Board of Appeal. For this reason also the Board in T 532/20 (reasons 10.4) concluded that a referral for a question concerning whether the deletion of claims was to be regarded as an amendment of the appeal case was not required.

- 4.3.4 Moreover, it needs to be emphasised that granting discretionary power to a judicial body implies that multiple legally correct outcomes are possible. Accordingly, if the discretionary decisions are divergent this does not as such give rise to the need for a referral.
- 4.4 A referral of question 3) is also not required.
- 4.4.1 With respect to the specific criteria which might be relevant for establishing whether exceptional circumstances apply, a referral is not required for the reasons already set out for questions 1) and 2).
- 4.4.2 To decide what can *per se* be considered as exceptional circumstances according to Article 13(2) RPBA, some Boards have only taken new developments in the proceedings into account while others are more lenient (see points 3.3.2 to 3.2.4 above). However, in the present case this does not have an impact on the outcome as, irrespective of the approach followed, exceptional circumstances that could justify the admittance of auxiliary requests *1quater* to *4quater* cannot be identified. Therefore this divergence in the case law is also not relevant for the Board's conclusion.
5. For these reasons the Board cannot accede to any of the proprietor's requests.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for referral to the Enlarged Board of Appeal is refused.

The Registrar:

The Chairman:



D. Grundner

M. Dorfstätter

Decision electronically authenticated