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**Datasheet for the decision  
of 23 January 2024**

**Case Number:** T 1129/22 - 3.3.05

**Application Number:** 15728541.2

**Publication Number:** 3164524

**IPC:** C22C21/00, C22C21/02

**Language of the proceedings:** EN

**Title of invention:**

ALUMINIUM ALLOY FOR USE IN THE BUILDING INDUSTRY

**Patent Proprietor:**

Novelis Koblenz GmbH

**Opponents:**

C-TEC CONSTELLIUM TECHNOLOGY CENTER /  
CONSTELLIUM NEUF-BRISACH

**Headword:**

Aluminium sheet/Novelis

**Relevant legal provisions:**

RPBA 2020 Art. 12(6)

EPC Art. 54

**Keyword:**

Late-filed facts - should have been submitted in first-  
instance proceedings (no) - admitted (yes)

Novelty over public prior use - main request (no) - auxiliary  
request (yes)

**Decisions cited:**

T 0450/13, T 0472/92

**Catchword:**



**Beschwerdekammern**  
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**Chambres de recours**

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Case Number: T 1129/22 - 3.3.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.05**  
**of 23 January 2024**

**Appellants:**

(Opponents)

C-TEC CONSTELLIUM TECHNOLOGY CENTER /  
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**Representative:**

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**Respondent:**

(Patent Proprietor)

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**Representative:**

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**Decision under appeal:**

**Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
7 March 2022 concerning maintenance of the  
European Patent No. 3164524 in amended form.**

**Composition of the Board:**

**Chairman**            E. Bendl  
**Members:**            S. Besselmann  
                             P. Guntz

## Summary of Facts and Submissions

I. The joint opponents' (appellants') appeal in this case is against the opposition division's interlocutory decision according to which European patent EP 3 164 524 B1 in amended form on the basis of the then main request met the requirements of the EPC.

II. The patent in suit concerns an aluminium alloy for use in the building industry.

III. Claim 1 of the main request relates to a rolled aluminium alloy sheet product and reads as follows:

*"A rolled aluminium alloy sheet product for outdoor use in the building industry, wherein the aluminium alloy has the following composition, in wt. %:*

<i>Si</i>	<i>1.10 - 1.6</i>
<i>Mg</i>	<i>0.20 - 0.40</i>
<i>Mn</i>	<i>0.6 - 1.6</i>
<i>Cu</i>	<i>0.10 - 0.6</i>
<i>Fe</i>	<i>0.05 - 0.7</i>
<i>Ti</i>	<i>0.05 - 0.20</i>
<i>Zn</i>	<i>up to 0.4,</i>

*others and unavoidable impurities, each 0.05% max, total 0.25%, balance aluminium."*

IV. Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the range for Mg has been amended to 0.25 - 0.40 wt.%. Claims 2-12 relate to preferred embodiments of the rolled sheet product. Claims 13-14 relate to the use of an aluminium alloy according to one of the preceding claims.

V. The following documents are of relevance here, all relating to alleged public prior use D8:

- D8a purchase order  
(bordereau de commande N° 005961)
- D8b second page of an invoice of 26 August 2010  
(facture correspondant à la commande 005961, colis N° 1405088)
- D8c inspection certificate of 26 August 2010  
(certificat de réception et avis d'expédition, colis N° 1405088)
- D8d shipping advice (bon de livraison correspondant à la commande N° 005961, colis N° 1405088)
- D8e summary about Miralu, printout from the internet  
<https://www.clubgier.com/miralu/adherent-0122.html>
- D8f project of Miralu finalised at the end of 2013, printout from the internet  
<https://www.miralu.fr/projets/chi-villeneuve-saint-georges/>

VI. The opposition division found, in particular, that the alleged public prior use D8 had not been proven up to the hilt.

VII. With their statement of grounds of appeal, the appellants reiterated their objections of lack of novelty in view of prior use D8, and submitted documents D11-D13 as further proof:

- D11 bank statement dated 10 September 2010  
extracted from SAP system
- D12 contract between ALCAN RHENALU and MIRALU

D13 bank transfer order dated 9 September 2010  
referencing an invoice number F471898

They additionally provided pages 18-21 of a decision of an opposition division in another case (D14, European patent application number 11 181 780.5).

- VIII. The patent proprietor (respondent) defended the patent in suit in the form found to be allowable by the opposition division and additionally on the basis of the auxiliary request filed before the opposition division.
- IX. In their reply to the board's communication pursuant to Article 15(1) RPBA 2020, the appellants explicitly agreed with the board's preliminary opinion concerning auxiliary request 1, i.e. that the patent could be maintained on the basis of auxiliary request 1.
- X. The appellants' essential arguments, where relevant to the present decision, can be summarised as follows.

Documents D11-D14 should be admitted into the proceedings. D14 was a previous decision of an opposition division in a similar case. D11-D13 constituted a reaction to the impugned decision and could not have been filed earlier. The appellants had the justified expectation that these documents would not be needed, and retrieving them took time and a third party had to be contacted.

The subject-matter of claim 1 was not novel in view of public prior use D8, further corroborated by D11-D13.

There was no objection against auxiliary request 1.

XI. The respondent's essential arguments, where relevant to the present decision, can be summarised as follows.

Documents D11-D14 should not be admitted into the proceedings. D14 was irrelevant and D11-D13 should have been filed earlier. The appellants had to expect that the opposition division's provisional opinion might change. There had been sufficient time to provide further evidence during the opposition stage. Appeal proceedings were not a means of continuing the first-instance proceedings, as had been found in T 450/13 (Reasons 3.3).

D8 alone did not prove the public prior use up to the hilt. D8 was therefore irrelevant to the question of novelty of the main request.

XII. The appellants (opponents) requested that the decision under appeal be set aside and that the patent in the form as maintained by the opposition division (present main request) be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed (main request, filed on 2 December 2020), alternatively that the patent be maintained in amended form on the basis of auxiliary request 1 filed with the opposition division on 2 December 2020.



## **Reasons for the Decision**

### **Main request**

1. Consideration of D11-D14
  - 1.1 Documents D11-D14 were filed with the statement of grounds of appeal.
  - 1.2 The respondent was of the opinion that D14, which was a decision of another opposition division in another case, should not be taken into consideration because it was not relevant and it concerned first-instance proceedings.

However, D14 was not cited to substantiate an objection, but merely served as evidence as to the level of proof required for an alleged prior use - and in particular for the alleged delivery of a product to a third party - in another opposition case, to justify the appellants' expectations in this regard. It thus concerns the question of whether D11-D13 should have been filed with the opposition division, which question did not arise until the time of filing of these documents. D14 is therefore taken into consideration.

- 1.3 Documents D11-D13 were filed in response to the opposition division's finding in the impugned decision that the then available documents did not prove up to the hilt that Miralu had indeed received the material intended for shipment, because there was neither a confirmation of receipt nor an incoming material inspection analysis by Miralu, and nor was there any proof of payment (point II.4.3 of the impugned decision). It was found to be convincingly proven that

ALCAN (now Constellium) intended and prepared to ship the aluminium sheet shown in D8c (ibid.).

- 1.4 It can be readily seen that D11-D13, which comprise payment details (D11, D13) and a sales contract (D12), are relevant to the question of whether the coil of aluminium sheet was actually received by the third party (Miralu), i.e. these documents are relevant to address the issues which led to the decision under appeal.

It is also clear that the public prior use D8 - if proven - would be highly relevant to the question of novelty.

- 1.5 According to the respondent, D11-D13 should have been filed earlier, namely when the dispute arose as to whether the alleged public prior use D8 had been sufficiently proven. The respondent had already argued, in response to the notice of opposition, that there had been no proof of actual delivery because neither an acknowledgement of receipt nor a bank statement had been presented. Further according to the respondent, it had been a reasonable possibility and should have been expected that the opposition division's provisional opinion might change during the oral proceedings.

The respondent also submitted that the appellants had had sufficient time to provide further evidence. D11 and D12 were already in the appellants' possession, D11 being an excerpt from their own SAP system and D12 being a sales contract. According to the respondent, these documents should have been filed in response to the respondent's reply to the notice of opposition or, at the latest, in reply to the respondent's submission

made two months before the oral proceedings before the opposition division.

1.6 These arguments are not convincing. While it would have been desirable if the appellants had filed D11-D13 with the opposition division, the appellants provided convincing explanations as to why these documents were only provided with the statement of grounds of appeal.

1.6.1 The opposition division's finding during the oral proceedings that a further element was even required in order to complete the chain of evidence - as established by the opposition division in the oral proceedings - constituted a deviation from its provisional opinion. It is, of course, the nature of a *provisional* opinion that it is not binding and may change during the oral proceedings, meaning that a party should generally prepare its case accordingly. In the present case, however, the appellants had the reasonable expectation that they had filed sufficient evidence with the opposition division to prove the delivery of the coil of aluminium sheet (a 4000-kg item) to the client - with D8d showing that the intended delivery had been prepared, a lorry number assigned and an expected delivery date (the following day) indicated - and that no additional proof of receipt would be needed.

The opposition division's provisional opinion was quite specific on this particular point, stating that the available evidence "*can be considered sufficient evidence that the shipment actually took place*" (item II.2.3.2 of the communication dated 29 March 2021). While this point was subsequently contested by the respondent (letter of 13 December 2021), no new arguments were put forward in this regard. The

provisional opinion was in line with another opposition division's decision in a previous case as to the required level of proof to establish the delivery of a product to a third party (D14). Furthermore, the actual date of receipt is irrelevant in the present case, in which the prior use took place more than four years before the priority date of the patent in suit.

In the present case, it can therefore be accepted that the opponents were objectively surprised by the opposition division's change of opinion during the oral proceedings.

- 1.6.2 Further according to the appellants' explanations, these further documents lay within a third party's (the client's) sphere and filing them required the client's cooperation. Moreover, retrieving payment information for a sale dating back more than 10 years took time.

The board has no reason to doubt that providing these further documents was difficult and time-consuming. The observation that D11 was in fact an excerpt from the appellants' own SAP system and was thus accessible to the appellants themselves does not change this view. It could not be directly accessed due to changes in the electronic system, as indicated by the appellants. Moreover, and more importantly, filing only D11 would have left open questions because the transferred amount was not the same as the amount quoted on the invoice. Further evidence was thus required to explain the discrepancy, and that evidence was provided in the form of D12 (sales contract), which showed the applicable discount rate. It is credible that D12 could not be accessed easily because it had to be retrieved from a paper archive, as submitted by the appellants. Furthermore, D12 contained confidential information,

which also touched upon matters of the client's interests. D13 is clearly a document originating from the third party (Miralu) and was thus not in the appellants' possession.

1.7 In this case, the newly filed documents D11-D13 concern a single element of the - in the opposition division's opinion - otherwise complete chain of evidence relating to alleged public prior use D8, namely whether the intended and prepared shipment had in fact been completed with the receipt of the aluminium sheet by the third party (Miralu). This case is not, therefore, comparable to the situation underlying T 450/13 (Reasons 3.3), cited by the respondent. T 450/13 related to a case where an alleged public prior use, which had been mentioned but was not pursued at the opposition stage, was substantiated for the first time with new evidence in the appeal proceedings (ibid.).

1.8 The appellants provided D11-D13 at the earliest possible moment during the appeal proceedings, namely with their statement of grounds of appeal.

These documents do not present the patent proprietor or the board with an unexpected situation or a fresh objection. They merely complement the available evidence by showing that the delivery of the coil of aluminium sheet was in fact concluded as intended, i.e. that there was no disruption to the normal course of events to be expected based on the other documents D8a-D8d on file.

1.9 In view of the situation as a whole, namely the appellants' justified expectation that the further documents D11-D13 would not have been needed, the greater obstacles associated with retrieving them and

the fact that they merely complement an existing objection, as well as their suitability for providing the single missing element required to complete the chain of proof, the "should have been submitted" criterion pursuant to Article 12(6) RPBA 2020 does not apply in this case.

2. Novelty in view of D8

2.1 The opposition division found that the bundle of documents D8 constituted convincing evidence that ALCAN (now Constellium) intended and prepared to ship the aluminium sheet shown in D8c (point II.4.3 of the impugned decision). This conclusion was not contested by the respondent.

However, the opposition division decided that the shipment advice (D8d) did not prove up to the hilt that Miralu had indeed received the material, because there was neither a confirmation of receipt nor an incoming material inspection analysis by Miralu, and nor was there any proof of payment.

2.2 The supplementary evidence D11 to D13 constitutes proof of payment. D11 shows that the amount of EUR 59 030.58 was paid on 10 September 2010 in respect of invoice D8b (number 2100471898) and another invoice number 2100471897. D13 shows a transfer order dated 9 September 2010 for the same amount, referencing an invoice number F471898, i.e. having the same last digits, and additionally invoice number F471897. D12 is a contract between one of the appellants, Alcan Rhenalu Neuf Brisach (now Constellium Neuf Brisach) and Miralu, which shows that the amount paid corresponds to the amount on invoice D8b (number 2100471898) and the other

invoice number 2100471897 with the agreed discount rate.

- 2.3 The evidence of the alleged sale of the coil of aluminium sheet by Alcan Rhenalu (now Constellium) to Miralu lies within the appellants' sphere, and is outside of the respondent's sphere. Therefore, the alleged public prior use needs to be proven beyond reasonable doubt (Case Law of the Boards of Appeal of the EPO, 10th edn., 2022, III.G.4.3.2.b; T 472/92, Reasons 3.1). In this case, there was the clear intent to ship the aluminium coil shown in inspection certificate D8c to Miralu, as shown by the purchase order D8a, the invoice D8b and the shipping advice D8d, and shipping preparations had been completed, with the lorry number and the container number being assigned (D8d). The delivery was intended for the following day.

In the light of the available evidence as a whole, including D11 to D13, there can be no reasonable doubt that the sale of the aluminium sheet shown in D8c was actually completed with the delivery of the product as intended.

- 2.4 In summary, it can be concluded that the public prior use took place.
- 2.5 The chemical composition of the aluminium sheet analysed in D8c falls within the scope of claim 1. This was not contested.
- 2.6 The subject-matter of claim 1 thus lacks novelty in view of the public prior use D8.

**Auxiliary request 1**

3. Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the lower limit of the Mg-content range has been amended to 0.25 wt.%, based on claim 8 as granted.
  
4. Novelty
  - 4.1 The subject-matter of claim 1 of auxiliary request 1 differs from D8 in that the Mg-content is higher (0.25 - 0.40 wt% in claim 1 versus 0.22 wt.% in D8c) and is therefore novel. This was not contested by the appellants.
  - 4.2 The same conclusion applies to claims 2-12 and use claims 13-14, which all directly or indirectly refer back to the aluminium alloy of claim 1.
  
5. The appellants had no objections against the auxiliary request.



## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended form on the basis of the auxiliary request 1 as filed with the opposition division on 2 December 2020 and a description to be adapted.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated