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**Datasheet for the decision
of 16 October 2023**

Case Number: T 2188/22 - 3.2.06

Application Number: 19167415.9

Publication Number: 3542766

IPC: A61F13/532, A61F13/533,
A61F13/15, A61F13/475

Language of the proceedings: EN

Title of invention:

ABSORBENT CORE, ARTICLES COMPRISING SAID CORE, AND METHODS OF
MAKING

Patent Proprietor:

Ontex BV

Opponents:

Essity Hygiene and Health Aktiebolag
Maiwald GmbH
Fippi SpA

Headword:

Relevant legal provisions:

EPC Art. 113(1)
RPBA 2020 Art. 11
EPC R. 103(1)(a)

Keyword:

Remittal to the department of first instance - fundamental deficiency in first instance proceedings (yes)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 2188/22 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 16 October 2023

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 4 August 2022
revoking European patent No. 3542766 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
 W. Ungler

Summary of Facts and Submissions

- I. The appellant (proprietor) filed an appeal against the decision of the opposition division revoking the patent in suit.
- II. With its statement of grounds of appeal, the appellant requested *inter alia* "that the case be remitted to the first instance to discuss Auxiliary Request 3 onwards". In this context it submitted auxiliary requests 3 to 18 (originally filed before the opposition division) and argued that the appellant's right to be heard had been violated since the opposition division had not given the appellant the opportunity to discuss auxiliary requests 3 to 18 during the oral proceedings. It further requested oral proceedings.
- III. Respondent/opponent 1 objected to the admissibility of the appeal and to the alleged procedural violation and argued that the opposition division had exercised its discretion correctly by not admitting the auxiliary requests into the proceedings. It additionally requested oral proceedings.
- IV. Respondent/opponent 2 and respondent/opponent 3 each requested that the appeal be dismissed and auxiliarily requested that oral proceedings be convened.
- V. The parties' arguments, as far as they are relevant for the present decision, are dealt with in detail in the reasons for the decision.
- VI. By communication dated 26 July 2023 the Board informed the parties of its preliminary opinion on the issue of admissibility of the appeal and on the appellant's

request for remittal of the case to the opposition division. In addition, the parties were informed that a decision could be taken in writing, provided that all parties withdrew their requests for oral proceedings.

VII. Thereafter all parties withdrew their requests for oral proceedings and the scheduled oral proceedings were cancelled.

Reasons for the Decision

1. Admissibility of the appeal

1.1 Respondent/opponent 1 submitted that the appellant's requests contained in the statement of grounds of appeal were not clear, so that the appeal was not admissible. However, the Board considers its arguments unconvincing. In the statement of grounds of appeal the appellant requested as its first request in the list of requests that the case be remitted to the opposition division for further prosecution, for the purpose of discussion of "auxiliary request 3 onwards".

"Alternatively" it requested that the decision under appeal be set aside and the patent be maintained as granted, labelled "main request", or on the basis of any of auxiliary requests 1 to 18.

1.2 When interpreting these requests, it must be taken into account that the appellant claims a violation of the right to be heard during the oral proceedings before the opposition division with regard to the then valid auxiliary request 3 (and also to the then valid lower ranking auxiliary requests). Furthermore, it must be borne in mind that this request is also coupled to the request for reimbursement of the appeal fee. This also shows that the alleged procedural violation was causal

for the filing of the appeal. In view of the above and also from the order of the requests mentioned in the statement of grounds of appeal, it is thus clear that this request for remittal is to be understood as the highest ranked request. Moreover, merely using the term "alternatively" in its request formulation has not made the requests unclear. The Board reads this simply to mean that only if remittal is not ordered, the appellant then resorts to the alternative that the set of requests (labelled as "main request" and auxiliary requests 1 to 18) is then examined by the Board in the given order. Thus, in the present case, the Board identifies a clear ranking given to the series of requests, where remittal is the highest ranked request. Then, at least since the request for remittal based on a procedural violation is substantiated (see Reasons below), the appeal is admissible.

2. *Request for remittal of the case to the opposition division due to a procedural violation*

2.1 In the statement of grounds of appeal the appellant requested that the case be remitted to the opposition division for further prosecution, for the purpose of discussing auxiliary requests 3 to 18 resubmitted with the statement of grounds of appeal. This request for remittal is based on an alleged procedural violation by the opposition division. In this respect it argued that the appellant's right to be heard had been violated since the opposition division had not given the appellant the opportunity to discuss auxiliary requests 3 to 18 (cf. Statement of Grounds of Appeal, page 5, paragraphs 2 and 3) during the oral proceedings. In that regard, the appellant argued that auxiliary requests 3 to 7 filed in reply to the oppositions (cf. letter of 21 June 2021) and auxiliary requests 8 to 17

filed with letter of 8 April 2022 had never been withdrawn during the proceedings and should have been dealt with in the oral proceedings before the opposition division.

- 2.2 Auxiliary requests 1 and 2 filed with letter of 21 June 2021 were discussed during the oral proceedings before the opposition division (see page 11 of the impugned decision for auxiliary request 1; and for auxiliary request 2 cf. minutes point 5 and page 11 of the impugned decision). For this reason, the appellant (obviously) requested a remittal of the case only for discussion of auxiliary requests 3 to 18 (auxiliary request 18 being identical to auxiliary request 34 newly filed at oral proceedings). Under point 6 of the impugned decision, the opposition division gave its reasons for not admitting/dealing with auxiliary requests 3 to 17 filed in the written procedure. In particular, it concluded that auxiliary requests 2 to 34 had been filed during the oral proceedings as a replacement for the former auxiliary requests, that these auxiliary requests were withdrawn and that no other request existed apart from auxiliary request 2 filed in the written proceedings. In addition, it was emphasised that the appellant had been informed that only one further auxiliary request would be accepted and that no further auxiliary request existed after auxiliary request 2 had not been admitted into the proceedings. Auxiliary request 2 was to be considered as a newly filed auxiliary request due to its conclusion that auxiliary requests 2 to 34 filed during the oral proceedings had been withdrawn.

- 2.3 The Board disagrees with the opposition division's legal assessment of the appellant's conduct at the oral proceedings. In this context, it should be noted that

the Board relies in particular on the minutes of the oral proceedings for its interpretation of the course of the oral proceedings. According to the minutes of the oral proceedings before the opposition division, the issue of novelty of granted claims 1 and 7 was first discussed and the opposition division concluded that the subject-matter of claim 1 was not new over D4, but that the subject-matter of claim 7 was new. Furthermore, the Chairman informed the parties that the same conclusion appeared to apply also to auxiliary requests 1 and 2 then on file (cf. minutes, point 3.2.4, paragraph 4). Thereafter, the appellant filed auxiliary requests 2 to 34. According to the appellant, this set of requests comprised also the auxiliary requests 2 to 17 filed during the written proceedings. Considering the Annex to the minutes of the oral proceedings, it is clear that auxiliary requests 18 to 33 filed during the oral proceedings were identical to auxiliary requests 2 to 17 filed during the written proceedings. This supports the appellant's submission that the auxiliary requests filed during the written proceedings had not been withdrawn but only renumbered. Thus, the filing of a new set of auxiliary requests in the oral proceedings clearly did not mean that the auxiliary requests filed in writing had been withdrawn in substance. After the filing of the new set of auxiliary requests during the oral proceedings the parties were heard on the issue of admittance of the newly filed auxiliary request 2. The opposition division decided not to admit auxiliary request 2 into the proceedings. Thereafter the appellant stated that it wished to revert to the auxiliary requests submitted in the written procedure (cf. minutes, page 6, para 4). After the parties were heard on the issue of novelty of the subject-matter of claim 1 of auxiliary request 2 filed on 21 June 2021 the opposition division concluded

that auxiliary request 2 lacked novelty. Thereafter the Chairman informed the parties that no further request would be admitted and announced the opposition division's decision revoking the patent (cf. *supra*, page 7, paras 3 and 4 and point 6).

- 2.4 First of all, it should be noted that the appellant stated at the oral proceedings that it wished to revert to the auxiliary requests which had been submitted in the written procedure. By that statement, the appellant defined its auxiliary requests for the further course of the proceedings, i.e. it was clear at that point in time that the appellant wished to pursue auxiliary requests 2 to 17 filed in the written procedure. The issue of admittance of auxiliary request 2 was then apparently discussed with the parties. However, the question of admittance of auxiliary requests 3 to 17 was not discussed. This in itself constitutes a substantial procedural violation, as the appellant's right to be heard was not respected in this regard. The reference in the contested decision to the fact that no further auxiliary requests were made (cf. impugned decision, page 13, penultimate sentence) therefore contradicts the course of the oral proceedings as recorded in the minutes. With regard to the Chairman's statement that only one further request may be filed, it should be noted that it is up to the parties to define their requests. In principle the opposition division cannot prevent the filing of requests, but can only decide on their admittance after having heard the parties on that issue. Furthermore, following the submissions of the appellant, it should be noted that the appellant had not withdrawn its auxiliary requests 2 to 17 filed in the written procedure. By submitting auxiliary requests 2 to 34 at the oral proceedings, the appellant obviously only pursued the goal of ranking

the previous auxiliary requests after the newly submitted auxiliary requests. This follows from the fact that auxiliary requests 18 to 33 submitted at the oral proceedings corresponded to the auxiliary requests 2 to 17 submitted in the written procedure. The fact that the appellant subsequently stated that it wished to revert to its original requests merely meant that it did not wish to pursue the auxiliary requests 2 to 17 newly filed during the oral proceedings. Since the parties were neither heard on the question of admissibility of auxiliary requests 3 to 17 (filed in the written proceedings), nor was the content of those auxiliary requests discussed, the appellant's right to be heard was violated (Article 113(1) EPC). This constitutes a serious procedural deficiency, which justifies the setting aside of the contested decision and the remittal of the case to the opposition division pursuant to Article 11 RPBA and the reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC.

2.5 In view of the facts established above, the main argument of respondent/opponent 1 that the opposition division correctly exercised its discretion on the question of admittance of the auxiliary requests is therefore not valid, as no decision was taken on the admittance of these requests (cf. also page 13 of the impugned decision: "With the rejection of this re-filed auxiliary request 2, no more valid requests were remaining and any further new request such as the re-filing of auxiliary request submitted on 21.06.2021 would therefore be inadmissible."; emphasis by the Board).

2.6 For the sake of completeness, with regard to the question of the admissibility of auxiliary requests 3 to 17, it should be noted that the renumbering of the

auxiliary requests which took place during the oral proceedings before the opposition division is not a sufficient reason for disregarding those requests in the proceedings. Those requests had been filed in due time during the written proceedings and the higher ranking requests additionally filed in the oral proceedings (i.e. auxiliary requests 2 to 17 then on file) were withdrawn immediately after the opposition division had decided not to admit the newly filed auxiliary request 2. Thus, in fact, the substance of any further request had not been discussed before the appellant decided to revert to its original requests. Therefore, the appellant did not file an unreasonable number of requests, nor can the appellant's conduct be considered abusive. In this context, it should also be emphasised that the issue of admittance of requests in opposition proceedings is not subject to the same standards as in appeal proceedings. Since the main purpose of appeal proceedings is to review the first instance decision, the requirements for admittance of further requests filed in the appeal proceedings are generally stricter than in opposition proceedings. The fact that the auxiliary requests filed in the written proceedings were renumbered during the oral proceedings before the opposition division does not mean that these requests are to be regarded as "new" requests as stated under point 6 of the impugned decision. In this context it must be borne in mind that the appellant decided to revert to its "original" auxiliary requests before the substance of any of the newly filed auxiliary requests had been discussed. Under these circumstances, the auxiliary requests filed in the written proceedings cannot be considered as newly filed in the oral proceedings. In view of the above, there is no reason to exclude auxiliary requests 3 to 17 from the proceedings.

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.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated