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Datasheet for the decision of 29 May 2024

Case Number: T 2240/22 - 3.2.04

Application Number: 15788417.2

Publication Number: 3214963

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Language of the proceedings: EN

Title of invention:
SENSING DEVICE, CLOSURE DEVICE COMPRISING SAID SENSING DEVICE AND METHOD FOR MANUFACTURING SAID SENSING DEVICE

Patent Proprietor:
Alpinestars Research S.p.A.

Opponent:
Dainese S.p.A.

Headword:

Relevant legal provisions:
EPC Art. 56, 114(2)
RPBA 2020 Art. 11, 12(2), 12(4), 13(2)

Keyword:
Inventive step - (no)
Late-filed auxiliary requests - admitted (no)

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T 0288/16

Catchword:

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Case Number: T 2240/22 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 29 May 2024

Appellant: (Patent Proprietor)	Alpinestars Research S.p.A. Via Alcide De Gasperi 54 Frazione: Coste 31010 Maser (TV) (IT)
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Appellant: (Opponent)	Dainese S.p.A. Via Louvigny, 35 36064 Colceresa (VI) (IT)
Representative:	Manfrin, Marta Società Italiana Brevetti S.p.A. Stradone San Fermo 21 sc. B 37121 Verona (VR) (IT)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 19 July 2022 concerning maintenance of the European Patent No. 3214963 in amended form.**

Composition of the Board:

Chairman	A. de Vries
Members:	J. Wright
	T. Bokor

Summary of Facts and Submissions

I. An appeal was filed by the opponent against the interlocutory decision of the opposition division finding that, on the basis of the auxiliary request 5bis, the patent in suit met the requirements of the EPC.

The proprietor also appealed, but later withdrew its appeal with letter of 9 April 2024. The opponent is now the sole appellant and the proprietor is respondent.

II. The opposition division decided that the subject-matter of auxiliary request 5bis involved an inventive step.

III. In preparation for oral proceedings, the Board issued a communication setting out its provisional opinion on the relevant matters. Oral proceedings were held on 29 May 2024.

IV. The appellant-opponent requests that the decision under appeal be set aside and that the patent be revoked.

The respondent-proprietor requests that the appeal be dismissed, and thus maintenance of the patent in amended form as upheld in the decision under appeal, auxiliary request 5bis, as its main request. In the alternative, it requests cancellation of the decision under appeal and maintenance of the patent in amended form according to one of auxiliary requests 6bis, 7bis, 8, 5tris, 6tris, 7tris in that order, where the auxiliary request 8 had been filed with letter dated 9 April 2024 and the other requests with its reply to the opponent's appeal dated 11 April 2023.

V. The independent claim 1 of auxiliary request 5bis reads as follows:

"Zip closure device (15) positioned at the opening (13) of a garment (14), a first element (18) of the zip closure device (15) being fixed on a first flap (11) of the opening (13) and a second element (19) of the zip closure device (15) being fixed on a second flap (12) of the opening (13); the first element (18) and the second element (19) of the zip closure device (15) being suitable for being removably joined by means of a fastening element (16);

the zip closure device (15) further comprising a sensing device (10) designed for being applied on the first flap (11) and on the second flap (12) of the opening (13), comprising:

- a triggering element (20) arranged on the first flap (11) of the opening (13) and comprising an activating component (23);

- a switch element (30) arranged on the second flap (12) of the opening (13) and comprising a sensing component (33); the sensing component (33) being designed for emitting an electrical output signal when it is put in a predetermined mutual position with respect to the activating component (23);

characterized in that the triggering element (20) is provided with at least one alignment component (22; 22A, 22B) designed for interacting with a corresponding alignment component (32; 32A, 32B) of the switch element (30) so as to autonomously and automatically put in said predetermined mutual position the activating component (23) and the sensing component

(33) when the first flap (11) is drawn close to the second flap (12), or viceversa;

wherein said at least one alignment component (22; 22A, 22B) of said triggering element (20) and said at least one alignment component (32; 32A, 32B) of said switch element (30) are magnetic components; the mutual position between the activating component (23) and the at least one alignment component (22; 22A, 22B) on the triggering element (20) corresponding to the mutual position between the sensing component (33) and the at least one alignment component (32) on the switch element (30)

and being characterized in that the triggering element (20) and the switch element (30) are positioned on the opposite flaps (11, 12) of the opening (13) at a predetermined position, so that when the fastening element (16) joins a portion of the first element (18), sited in proximity of the switch element (30), with a portion of the second element (19), sited in proximity of the triggering element (20), the sensing device (10) emits a signal that the opening (13) has reached a predetermined closed position".

Claim 1 of auxiliary request 6bis reads as for auxiliary request 5bis except that after the words:

"wherein said at least one alignment component (22; 22A, 22B) [...] corresponding to the mutual position between the sensing component (33) and the at least one alignment component (32) on the switch element (30);" the following wording is added:

"the at least one alignment component (22; 22A, 22B) of the triggering element (20) having shape and dimensions comparable with those of the at least one alignment component (32; 32A, 32B) of the switch element (30) and

wherein said triggering element (20) comprises said activating component (23) and a single alignment component (22); said activating component (23) being positioned along a direction parallel to a longitudinal axis (Y) of said triggering element (20) and said single alignment component (22) being positioned parallel to said activating component (23); or

wherein said triggering element (20) comprises said activating component (23) and two alignment components (22A; 22B) which have a circular shape; said two alignment components (22A; 22B) being positioned on said triggering element (20) so that their centers lie on the longitudinal axis (Y) of said triggering element (20); said centers being spaced apart of a fixed distance (d);"

Claim 1 of auxiliary request 7bis reads as for auxiliary request 6bis except that after the words "and said single alignment component (22) being positioned parallel to said activating component (23);" the following wording is added:

"said single alignment component (22) having a rectangular shape, having a length l and a width w"

and, after the words "said centers being spaced apart of a fixed distance (d)", the following wording is added: "and said activating component (23) having a rectangular shape and being positioned along the longitudinal axis (Y) of said triggering element (20)"

Claim 1 of auxiliary requests 5tris, 6tris and 7tris read as for auxiliary requests 5bis, 6bis and 7bis respectively, except that the opening three words of the claim "Zip closure device" are replaced by the words "Closure device", and at the end of the claim the following wording is added: "the closure device (15) being a zip closure."

Claim 1 of auxiliary request 8 reads as for auxiliary request 5bis except that at the end of the claim, the following wording is added: "; the activating component (23) being a magnetic component and the sensing component (33) being a magnetic proximity sensor, like a reed sensor or a Hall effect sensor or similar sensor".

VI. In the present decision, reference is made to the following documents:

D1: WO 2014/001189 Al
D8: US 7,186,931 B2

VII. The appellant-opponent's arguments can be summarised as follows:

Auxiliary request 5bis should not be admitted into the appeal proceedings.

The subject-matter of claim 1 of auxiliary requests 5bis and 5tris lacks inventive step starting from D1 with D8. In this context, the skilled person would replace D1's reed sensor and actuating magnet by the whole sensor/button of D8's 7th embodiment. The argument was already presented in opposition proceedings, so it should be admitted into the appeal proceedings. The Board should deal with this issue itself rather than remitting the case to the opposition division.

Auxiliary requests 6bis, 7bis, 8, 6tris and 7tris should not be admitted into the proceedings.

VIII. The respondent-proprietor's arguments can be summarised as follows:

Auxiliary request 5bis cannot be excluded from the appeal proceedings. The inventive step argument starting from D1 and completely replacing its reed switch sensing device with a button from D8's 7th embodiment is new in appeal and should not be admitted. If it is admitted, the case should be remitted to the opposition division. In any case, the proposed combination of D1 and D8 does not take away inventive step of claim 1 of auxiliary requests 5bis and 5tris.

The remaining auxiliary requests should be admitted into the proceedings.

Reasons for the Decision

1. The appeal of the opponent is admissible.

2. Background

It is known to provide garments with sensing devices (electrical switches) which detect when an opening in the garment is correctly closed. This can be used, for example, to decide it is safe to inflate an air bag incorporated into the garment (see published patent specification, paragraphs [0001] to [0003]). A suitable switch can be a reed switch (magnetically operated microswitch) positioned on one garment flap and actuated when a magnet on an opposing garment flap is adjacent to it (see published patent specification, paragraph [0006] and figure 1).

The invention aims, amongst other things, to provide a sensing device that produces a reliable signal (see published patent specification, paragraph [0013]). To this end, the patent proposes (see characterising portion of granted claim 1) magnetic alignment components that interact to autonomously and automatically put the activating and sensing components into a predetermined mutual position.

3. Admittance of auxiliary request 5bis

The appellant-opponent challenged the admittance of this request. In its communication (see section 9) the Board commented on this issue as follows:

9.1 The opponent has asked the Board to review the opposition division's decision to admit these auxiliary requests into the opposition proceedings.

9.2 First of all, since the impugned decision is based on this request, it does not [seem] *possible to retroactively excise it from the opposition proceedings. Nor is the legal basis for "un-admitting" such a request in the appeal proceedings apparent to the Board. According to the settled case law, neither Article 114 EPC nor the RPBA foresees this possibility (see CLBA V.A.3.4.4).*

9.3 It may be added that it is also settled jurisprudence of the Boards of appeal (see CLBA V.A.3.4 and the cited decisions, a board of appeal should only overrule the way in which a department of first *instance has exercised its discretion if it concludes that it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way.*

9.4 In the present case, the Board notes that at the oral proceedings, the opposition division changed its position on novelty with respect to D8 embodiment 7, for higher ranked requests, compared to its preliminary opinion in preparation for oral proceedings (see communication dated 26 March 2021, page 6). From the minutes (see top of page 3) - the proprietor requested to file a new request in the light of the changed opinion of the opposition division - this was argued so the Board infers that this was taken into account by the opposition division in exercising its discretion. This appears to be the right approach, see the Guidelines for Examination a the EPO E.VI.2.2.2, last bullet point. Moreover, the division considered the relevance of the request for overcoming this particular objection and this was discussed with the parties.

9.5 This aspect of the decision is also reasoned in the impugned decision (see section II 4.5.1). For these reasons, the Board does not consider that the opposition division exercised its discretion according to the wrong principles, or without taking into account the right principles, or in an unreasonable way, let alone in an arbitrary way as the appellant-opponent has suggested.

At the oral proceedings before the Board, the appellant-opponent referred to its written submissions but made no further comment on the issue. Therefore, the Board confirmed its provisional opinion and decided to admit auxiliary request 5bis into the proceedings.

4. Auxiliary request 5bis, claim 1, admittance of inventive step argument & remittal

4.1 This request was filed for the first time at the oral proceedings before the opposition division after higher ranking requests were found to lack novelty over D8 (see minutes, pages 1 to 3). It combines granted claims 1, 8 and the first alternative feature of granted claim 9, to define a zip closure device with a sensing device. The amendment shifted the focus of the invention from the sensing device on its own of granted claim 1 to a zip closure device at the opening of a garment having such a sensing device. At the oral proceedings before the opposition division, the opponent argued that the combination of D1 with D8, which discloses a sensor/button, took away inventive step of claim 1 (see minutes, top of page 4 and impugned decision, reasons 4.5.2 and 4.5.3).

4.2 The appellant-opponent presented this argument in its grounds of appeal (see section 7.1.2). Replying to this the respondent-proprietor (see its letter of 11 April 2023, page 6) objected that the argument was new in appeal and thus constituted a new case which should not be admitted into the appeal proceedings under Article 12(4) RPBA.

In the Board's view, the argument (replacing the whole of D1's sensor with D8's sensor/button) is not a new argument but one that was admissibly raised in the opposition proceedings. Nor does the Board have any reason to consider that the appellant-opponent did not maintain it at the end of the opposition proceedings.

According to the undisputed minutes of the oral proceedings before the opposition division (see top of page 4), the idea of applying the button of D8 to the zip of D1 was raised by the opponent. That the issue was considered is also born out by the impugned decision (see, reasons, section 4.5.3, 4th paragraph), according to which the proprietor countered this argument. Moreover, although not ideally explained, the decision, section 4.5.3, last paragraph, stating that D8 discloses "no motivation to place part or *the full* button of D8 on a garment of D1 (emphasis added), and further in section 4.5.3.1 stating that that the skilled person *has no motivation in D8 of applying a button to a zipper*, appears to address the disputed argument. Therefore, the Board finds that the disputed argument is one on which the appealed decision was based.

It follows that the respondent-proprietor's objection based on Article 12(4) RPBA (request for non-admittance of the disputed argument because it is new in appeal) is moot. Therefore, the Board decided to admit the disputed argument (replacing D1's sensor with D8's sensor/button device) into the appeal proceedings.

4.3 In the light of the Board's finding that the disputed argument was already in the opposition proceedings, its consideration in appeal requires no more than analysing questions already raised in opposition proceedings, rather than a carrying out a *fundamentally different analysis of the question of inventive step*, as the respondent-proprietor argued in its letter of 9 April 2024 (page 2). Therefore, the respondent-proprietor's argument that such a different analysis would constitute *special reasons* justifying remittal of the case to the opposition division is rejected.

For these reasons, the Board decided not to remit the case to the opposition proceedings but to deal with the issue itself, Article 11 RPBA.

5. Auxiliary request 5bis, inventive step

5.1 D1 discloses a garment with a zip closure positioned on opposite flaps at an opening of the garment and a sensing component. The sensing component is a reed switch 17, actuated by a magnet 18 when the two flaps are brought into a predetermined mutual position due to the correct closure of the [zip] opening 11 (see page 11, line 30 to page 12, first line and figure 10).

5.2 It is common ground that the zip closure device of claim 1 differs from D1 in the feature of alignment components. The magnetic attraction between D1's actuating magnet 18 and associated reed switch would be too weak to play any role in bringing about their mutual alignment. Rather, the magnet merely activates the reed switch when the two approach each other on closing the zip, allowing the reed switch to generate a closure signal.

The Board agrees with the respondent-proprietor that this difference (alignment components) ensures a reliable signal from the reed switch when the flaps are in a predetermined position (cf. published patent specification, paragraphs [0013] and [0014]). In contrast, in D1 the generation of a closure signal depends on how accurately the flaps of the garment (the one having the magnet, the other the reed switch) are juxtaposed on closing the zip, so signalling may not be reliable under all circumstances. Therefore, in the Board's view, the objective technical problem can be formulated as: how to modify the D1's zip closure device to increase its signalling reliability.

5.3 The skilled person would be aware of D8 because it discloses a sensing device (see abstract) that is applicable to wearable items (see column 1, lines 20 to 23 - "cloths [sic],... shoes, etc.", thus garments in general. Given that D8 teaches a button (type) sensing/ fastening device for garments, it will be used (as buttons and studs are) to fasten two flaps of an opening together, thus bringing them into a predetermined relative position to each other and signalling when this is done.

5.4 Referring in particular to D8's 7th embodiment (see column 1, lines 52 to 61 and column 6, lines 22 to column 7, line 6 with figure 13), when first and second button parts 2 and 3 magnetically engage each other, an electrical circuit is made. In other words a signal is generated. In the Board's view, the skilled person would immediately realise that, by magnetically engaging the two button parts to produce a signal - actively locking them together - the signal is more reliably generated than by D1's reed switch where the generation of the signal depends only on of the flaps passively becoming juxtaposed on closing the zip.

5.5 Therefore, faced with the objective technical problem (improving signalling reliability) the skilled person would consider to combine the teachings of D1 and D8, by replacing D1's reed switch/magnet pair with the complete sensor/button of D8's 7th embodiment, as a matter of obviousness.

5.5.1 In reaching this conclusion, the Board is not convinced by the respondent-proprietor's argument that, if the skilled person introduced D8's button onto D1's garment they would do away with the zip since both buttons and zips are closure devices, and thereby the zip will become superfluous. In the Board's view, the two are not mutually exclusive but are ubiquitously used together on garments such as jackets, trousers etc.

5.5.2 Likewise, the Board is not convinced by the respondent-proprietor's argument that the skilled person would refrain from making the proposed combination (D1 with D8, 7th embodiment) because it would result in having wiring leading from the sensor on two flaps rather than just one, making the arrangement complicated. That would be contrary to the teaching of the patent (paragraphs [0005] and [0006]), which sees a different prior art requiring wiring on both flaps of a zip closure as disadvantageous compared to D1's reed switch that requires wiring on only one flap. Reed switches are known from other sensor/buttons of D8, which use a reed switch and provide a reliable signal (see for example D8, column 6, lines 8 to 21 with figure 12), so that the skilled person would use one of these embodiments rather than the 7th embodiment.

5.5.3 In the present case, the skilled person does not have their eye on solving a problem of simplifying wiring, but on improving signalling reliability. Therefore, the fact that the combination considered (with D8's 7th embodiment) would lead to a wire on each flap of a zip closure, whereas the combination of D1 with other embodiments of D8 would require two wires on one flap and none on the other, plays no role. Also, the patent itself is not prior art that may suggest to the skilled person to refrain from certain solutions.

Whether or not it might be also be obvious to combine the teachings of D1 and other embodiments of D8 in solving the problem of improved signalling reliability does not make the combination of D1 and D8, 7th embodiment any less obvious.

5.6 This leaves the question as to whether the resulting combination would be a zip closure in accordance with claim 1. In the Board's view, it would.

5.6.1 Still referring to D8's 7th embodiment (see column 6, line 22 to column 7, line 6 with figure 13), first and second button parts 2 and 3 are designed for application to first and second flaps. In replacing D1's magnet activator and reed switch, the skilled person would apply a first of D8's sensor/button parts 2 on a first flap of D1's zip closure and the second sensor/button part 3 in a corresponding position on its second flap. Thus applied, D8's sensor/button would be able to signal the closed state of the zip closure.

5.6.2 The [first] button part 2 has an electrically conductive ring-shaped plate 71 and the [second] button part 3 a corresponding electrically conductive ring-shaped plate 72A. The two parts act as a switch, so that when they come together, a current can flow from the first ring to the second ring, triggering the sensing of the current and emitting of a signal from the second (via wire 100 to the circuit 4). Thus, the Board considers that the first button part 2 can be considered a *triggering element* of the switch with an activating component (conductive ring 71). Similarly, the second button part 3 can be considered a *switch element*, with a sensing component (conductive ring 72A).

In this regard, the Board is not convinced by the respondent-proprietor's argument that the term *sensing component* in claim 1 defines a switch with two contacts so that D8's ring-shaped plate 72A would not fall under this definition. This is because the term *sensing component* is not limited to switches but is more general, so it means any component that can be used to sense something. Also, the feature *switch element* (of which the sensing element is a part) can mean only one element of a switch, so it does not exclude there being other elements of the same switch elsewhere, such as on another flap. Therefore, contrary to how the respondent-proprietor has argued, the claim does not define a switch with two contacts and all the electrical connections located on one flap.

5.6.3 As explained in D8, column 6, lines 29 to 32, the two button parts engage each other magnetically when they are made to approach each other. When fully engaged, the triggering element's activating component (71) and the switch element's sensing component (72a) touch so that a signal is emitted. This magnetic engagement happens because each button half has a magnetic *alignment component* as the claim requires.

5.6.4 The triggering element 2's alignment component is a recessed magnetic region 73. That of the switch element 3 is a protruding magnetic region 74a. As best envisaged from figure 13, when the two engage magnetically, they interlock or mate as a plug and socket. The electrically conductive surfaces (72A, 71) of the switch and triggering elements are circumferentially arranged with respect to their respective alignment components (74, 73). Consequently, when the magnetic regions interlock, the electrically conductive surfaces are urged together so as to completely overlap and touch. In the Board's view, this complete overlap of the conductive surfaces is *predetermined* by their circumferential arrangement with respect to the "plug and socket" magnetic components. Moreover, because the conductive surfaces touch, they come together at a common or *mutual* position in the longitudinal direction.

5.6.5 Therefore, the switch element emits an output signal when it is put into a predetermined mutual position with respect to the activating component. The fact that in the sensor/button of D8's 7th embodiment the conductive surfaces of the switch element's sensing component 72a and the activating component 71 might be able to touch and emit an output signal in positions other than the predetermined one does not change this disclosure, since the claim only requires that the sensing component emits an output signal when it is in its predetermined position, without excluding that this could happen in other positions.

5.6.6 Moreover, according to D8 (see column 6, lines 39 to 43), the first and second magnetic regions attract each other magnetically *when the first and second button parts are brought close to each other*. It is this that draws the electrically conducting ring shaped plates 71 and 72A together. Whilst closing the zip may only bring the two halves of the button proximate to each other and the user may well need to introduce the protrusion on the switch element 3 into the mouth of the recess on the triggering element, once this is done and the magnetic regions 73, 74 (alignment components) are sufficiently close, their mutual attraction alone will cause the protrusion to move further into the recess, until the activating and sensing components completely overlap and touch. Therefore, they are *autonomously and* *automatically* put into the predetermined position when the flaps are drawn close to each other as claimed. It goes without saying that once conductive surfaces 72A and 71 touch, a circuit is completed and the sensing device as a whole will emit a signal which signifies that the zip opening has been brought into a predetermined closed position as the last feature of claim 1 requires. The Board does not read the indication "autonomously and automatically" as covering every and the entire trajectory of movement of the halves to the exclusion of any manual assistance. Also in the patent a user must first zip up manually to the closure point to bring the two halves close enough together for magnetic attraction to complete alignment.

5.6.7 In the Board's view, D8's 7th embodiment with its sensing/button, also discloses that the the mutual position between the activating component and the alignment component on the triggering element corresponds to the mutual position between the sensing component and the alignment component on the switch element. As has already been explained, the activating component 72A, with its alignment component (magnetic region 74) fits to the sensing component, with its alignment component (magnetic region 73), and thus the activating and sensing component and the two alignment components meet at a mutual position in that they adopt a predetermined position with respect to each other, in the longitudinal direction. It remains that the Board is unable to discover any technically relevant difference in this respect between the button parts of D8 and the magnets in the patent. It is just the magnetic attraction in both which achieves an autonomous and automatic alignment, when the respective parts are sufficiently close.

5.7 From the above it follows that the obvious combination of the teachings of D1 and D8, 7th embodiment (figure 13) would result in a zip closure device as defined in claim 1. The Board concludes that the subject-matter of claim 1 of auxiliary request 5bis lacks inventive step, Article 56 EPC.

The Board reaches this conclusion taking into account any of the respondent proprietor's arguments first made in the context of the grounds of its (now withdrawn) appeal and reiterated in the oral proceedings before the Board in the context of defending the patent as upheld by the division. Contrary to the view of the appellant opponent, the Board sees no legal basis for deeming such arguments to have been withdrawn merely because the corresponding requests were withdrawn.

6. Auxiliary request 5tris, claim 1

Without prejudice to the question of admittance of this request, in the Board's view it merely reformulates auxiliary request 5bis - putting the zip closure at the end rather than the beginning of the claim - without changing the subject-matter claimed. Therefore, the Board's findings for auxiliary request 5bis - lack of inventive step - likewise apply to this request.

7. Auxiliary requests 6bis, 7bis, 6tris, 7tris, admittance

7.1 These auxiliary requests were filed for the first time in appeal with the respondent-proprietor's reply to the opponent's appeal. The Board is unconvinced that these requests could and should have been filed already in the opposition proceedings (so that Article 12(6) RPBA would come into play), because there was no reason for the proprietor to file further auxiliary requests in the opposition proceedings after auxiliary request 5bis was held to be allowable.

7.2 However, these requests are amendments of the respondent proprietor's appeal case in the sense of Article 12(4) RPBA. Article 12(2) RPBA requires that a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based. Article 12(4) RPBA states that any part of a party's appeal case which does not meet the requirements in paragraph 2 is to be regarded as an amendment (which is subject to the Board's discretion, last sentence), unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal. Accordingly, these requests, which are undoubtedly newly filed in appeal and indisputably have not been raised and maintained in the preceding opposition proceedings, are amendments.

7.3 As they are amendments to the respondent proprietor's appeal case their admission is at the discretion of the Board, Article 12(4) RPBA, 1st paragraph, 2nd sentence. The Board exercises its discretion according to the following two paragraphs of Article 12(4) RPBA, that amendments should be identified as such, reasons for their filing and (for claim requests) a basis given; they bring in no additional complexity, are suitable to address the relevant issues, and they meet the need for procedural economy. The latter criteria are similar though not identical to those that the opposition division would have applied if these requests had been filed at the oral proceedings before the division: clear allowability (clearly resolve all relevant issue), convergence and procedural expediency, cf. E-VI.2.2.3. It stands to reason that the non-appealing proprietor should have a fair chance to respond to an appeal against an amended patent that may be successful, but they should also not gain any advantage by waiting to file auxiliary requests in appeal rather than during the opposition oral proceedings. In other words, it should not have a better chance of having auxiliary requests admitted in appeal than in the proceedings leading to the appealed decision.

7.4 Turning again to auxiliary requests 6bis, 7bis, 6tris, 7tris, these are not simple combinations of granted claims (as admitted auxiliary request 5bis is). Rather, they combine granted claims with subject-matter taken from the description and figures of the alternative embodiments of figures 2 and 4 (see proprietor's letter of 11 April 2023, page 13 and the application as published, page 4, lines 9 to 20).

7.5 In the Board's view, such amendments are complex and not suitable for addressing the lack of inventive step, as taking features from specific embodiments of the description raises questions of added subject-matter and would have required additional examination, especially considering that such subject-matter may not have been searched. It is unlikely, that the opposition division would have admitted such requests filed at the very last moment in opposition oral proceedings, as they would have failed the criterion of clear allowability for the same reasons.

This approach is also confirmed by jurisprudence of the Boards of appeal, see for example T 0288/16, reasons 8, in which the Board confirmed that the opposition division had exercised its discretion in a reasonable manner and in accordance with the right principles when deciding not to admit requests incorporating a feature from the description.

7.6 For these reasons, the Board decided not to admit auxiliary requests 6bis, 7bis, 6tris, 7tris into the appeal proceedings, Article 12(4) RPBA with Article 114(2) EPC. The question as to whether the requests had been adequately substantiated can be left undecided.

8. Auxiliary request 8, admittance

8.1 Auxiliary request 8 was filed with letter of 9 April 2024, thus after the Board's communication. It is therefore an amendment to the respondent proprietor's case and its admittance subject to the provisions of Article 13(2) RPBA, according to which any amendment to a parties 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.

8.2 In accordance with established jurisprudence (see CLBA, V.A.4.5.4), exceptional circumstances within the meaning of Article 13(2) RPBA generally concern new or unforeseen developments in the appeal proceedings themselves, such as new objections raised by the board or another party, whereas the normal course of events does not justify late submissions.

8.3 In the present case, the respondent-proprietor argued that the filing was a legitimate response to the Board's preliminary opinion (see its communication, section 11) that auxiliary request 5bis was not allowable, when considering inventive step starting from D1 with D8 whereby the objective technical problem had been newly formulated by the Board. Furthermore, the respondent-proprietor argued the filing was in response to the Board's preliminary opinion (see the communication, section 12.2) that it was inclined not to admit higher ranking auxiliary requests 6bis, 7bis and 6tris, 7tris into the proceedings. In the Board's view, both of these aspects of its preliminary opinion amount to the normal course of events in examining an appeal, rather than constituting exceptional circumstances that might justify the filing of a new request.

8.4 In accordance with the purpose of appeal proceedings, the Board must carry out a judicial review of the impugned decision, in this case including the matter of inventive step of auxiliary request 5bis. In the Board's view, its formulating a different objective technical problem than the one proposed by the parties in this context is neither a new objection nor an unforeseen development in proceedings; it is rather inherent in the assessment the Board must make of the facts, evidence and arguments underlying the decision under appeal when it carries out its judicial review of the case. At most, it is no more than a new detail of an existing objection. It therefore belongs to the normal course of events in carrying out a judicial review of the impugned decision.

8.5 This is all the more true in the present case since, in the impugned decision (see reasons, 4.5.3), the opposition division stated two versions of the objective technical problem, one from the opponent and one from the proprietor, but appears not to have stated which version, if either, it considered to be correct (cf. reasons, 4.5.3.1). Therefore, it is neither surprising that, in reviewing this aspect of the decision the Board should make its own formulation of the objective technical problem nor that this might differ from the one proposed by the parties in their appeal grounds and reply.

8.6 That non-admission of late filed requests could justify the admission of requests filed that are even later is manifestly at odds with the convergent approach adopted by the new rules of procedure. Indeed it would defeat the very purpose of Art 114(2) EPC.

8.7 For these reasons, the Board decided to exercise its discretion by not admitting auxiliary request 8 into the proceedings.

9. As the Board finds the division was wrong to conclude inventive step for auxiliary request 5bis, the decision under appeal must be set aside. Since the Board found auxiliary request 5tris also to lack inventive step and the respondent-proprietor's remaining auxiliary requests were not admitted into the proceedings, the patent must be revoked.

Order

For these reasons it is decided that:

1. **The decision under appal is set aside.**

2. **The patent is revoked.**

The Registrar: The Chairman:

G. Magouliotis A. de Vries

Decision electronically authenticated