Internal distribution code:

(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

Datasheet for the decision of 24 June 2025

Case Number: T 0540/23 - 3.4.02

Application Number: 14772541.0

Publication Number: 3044568

IPC: G01N21/3563, A61M5/31, G01N21/84, G01N21/90

Language of the proceedings: EN

Title of invention:
RAPID, NON-DESTRUCTIVE, SELECTIVE INFRARED SPECTROMETRY ANALYSIS OF ORGANIC COATINGS ON MOLDED ARTICLES

Patent Proprietor:
SiO2 Medical Products, Inc.

Opponent:
Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V.

Headword:

Relevant legal provisions:
EPC Art. 56, 123(2)
RPBA 2020 Art. 13(2)

Keyword:
Inventive step - main request (no) - auxiliary requests (no)
Amendments - allowable (no)
Amendment after summons - taken into account (no)

Decisions cited:
G 0010/91

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0

Case Number: T 0540/23 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 24 June 2025

Appellant: (Patent Proprietor)	SiO2 Medical Products, Inc. 350 Enterprise Drive Auburn, AL 36832 (US)
Representative:	Maiwald GmbH Elisenhof Elisenstraße 3 80335 München (DE)
Appellant: (Opponent)	Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. Hansastrasse 27c 80686 München (DE)
Representative:	WSL Patentanwälte Partnerschaft mbB Kaiser-Friedrich-Ring 98 65185 Wiesbaden (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 17 January 2023 concerning maintenance of the European Patent No. 3044568 in amended form.**

Composition of the Board:

Chairman	R. Bekkering
Members:	C. Kallinger
	B. Müller

Summary of Facts and Submissions

I. In the decision under appeal the opposition division came to the conclusion that the patent as amended according to auxiliary request 2 fulfilled the requirements of the EPC.

II. The opponent lodged an appeal and requested to set aside the decision and to revoke the patent in its entirety.

III. The patent proprietor lodged an appeal and requested to set aside the decision, i.e. that the opposition be rejected and the patent be maintained as granted (main request).
As an auxiliary measure, the patent proprietor initially requested to maintain the patent in amended form based on the claims according to:
- auxiliary request 1, filed with a letter dated 3 November 2021;
- auxiliary request 2a, filed as auxiliary request 3 with a letter dated 13 September 2022;
- auxiliary request 2 as filed during the oral proceedings before the opposition division on 18 November 2022;
- auxiliary requests 3 to 15 as filed with a letter dated 13 September 2022.

IV. The board summoned to oral proceedings and, in a communication pursuant to Article 15(1) RPBA, set out its preliminary, non-binding views on certain aspects of the case.

V. Oral proceedings took place on 24 June 2025. During the oral proceedings the patent proprietor withdrew auxiliary request 3 and filed auxiliary request 16.

VI. The parties' final requests were as follows:

The opponent requested that the decision under appeal be set aside and the patent be revoked.

The patent proprietor requested that the decision under appeal be set aside and the opposition be rejected (i.e. the patent be maintained as granted) (main request) or that the patent be maintained in amended form based on the claims according to

- auxiliary request 1, filed with a letter dated 3 November 2021;
- auxiliary request 2a, filed as auxiliary request 3 with a letter dated 13 September 2022;
- auxiliary request 2 as filed during the oral proceedings before the opposition division on 18 November 2022 (i.e. the opponent's appeal be dismissed);
- auxiliary requests 4 to 15 as filed with a letter dated 13 September 2022.
- auxiliary requests 16 as filed during the oral proceedings before the board.

VII. In this decision, reference will be made to the following documents:

D1 US 8 067 070 62

D2 WO 2013/071138 A1

D5 US 2010/0298738 A1

D13 V.P. Tolstoy et al.: "Handbook of Infrared Spectroscopy of Ultrathin Films", John Wiley & Sons, Inc., Hoboken, New Jersey, USA, 2003,

pages v to xxiv, Introduction, pages 79 to 139, 362 to 369, 416 to 439 and 669 to 690

VIII. Claim 1 of the patent as granted reads as follows (feature numbering as used by the parties added by the board):

1 *A non-destructive method of detecting whether a coating or deposit is present on or near a first surface of an article,*
the method comprising:

2 *• impinging infrared light on said first surface;*

3 *• collecting at least a portion of the infrared light reflected by on the first surface; and*

4 *• measuring the response output of the collected infrared light;*
the method further comprising:

4.1 *I. when the said coating or deposit being examined for the presence is a coating or deposit of SiO_xC_y or SiN_xC_y, where x is from about 0.5 to about 2.4 and y is from about 0.6 to about 3,*

4.1.1 *the said infrared light impinged onto at least said first surface and the said response output measured has a wave number in one or more of (a) at least a portion of a range between 950 and 1230 cm^{-1} and (b) at least a portion of a range between 1230 and 1300 cm^{-1}, the measured response output being indicative of the coating or deposit of SiO_xC_y or SiN_xC_y;*

4.2 *II. when the said coating or deposit being examined for the presence is a coating or deposit of SiO_x, where x is from about 1.5 to about 2.9,*

4.2.1 *the said infrared light impinged onto at least said first surface and the said response output measured has a wave number in at least a portion of a range from about 1060 to about 1080 cm^{-1}, the measured response output being indicative of a coating or deposit of SiO_x;*

4.3 *III. when the said coating or deposit being examined for the presence is (a) a coating or deposit of SiO_xC_y or SiN_xC_y, where x is from about 0.5 to about 2.4 and y is from about 0.6 to about 3 and*

4.3.1 *(b) a coating or deposit of SiO_x, where x is from about 1.5 to about 2.9,*

4.3.2 *the said infrared light impinged onto at least said first surface and the said response output measured has a wave number in one or more of (a) at least a portion of a range between 950 and 1230 cm^{-1} and (b) at least a portion of a range between 1230 and 1300 cm^{-1}, the measured response output being indicative of the coating or deposit of SiO_xC_y or SiN_xC_y, and*

4.3.3 *a wave number in at least a portion of the range from about 1060 to about 1080 cm^{-1} to indicate a coating or deposit of SiO_x;*

the method further comprising:

5 *• wherein the said coating or deposit is present on or near an inner surface of a container comprising a lumen,*

5.1 *the interior surface comprising said first surface and defining at least a portion of the lumen, and an opening, and*

5.2 *in which impinging infrared light is carried out by passing the light through the opening to the interior surface.*

Reasons for the Decision

1. Main request - Inventive step

The main request concerns the patent as granted.

1.1 Document D5 as closest prior art

1.1.1 Document D5 relates to a vessel coating and inspection (see title, abstract and paragraph [0003]) and therefore has the same aim as the method for detecting a coating on a surface as defined in feature 1.

Document D5 (see paragraphs [0182], [0673] or [0713]) also discloses that optical inspection of the coating can be carried out by impinging light on the surface, and collecting and measuring light reflected from the surface carrying the coating. In particular, document D5 (see paragraphs [0690] and [0692]) discloses using infrared light. Therefore, the optical detection as defined in features 2, 3 and 4 is disclosed in document D5. With respect to the choice of infrared light in these features, the board refers to the discussion below (see 1.3).

Document D5 discloses SiO_x coatings where x is in the range of 1.5 to about 2.9 (see paragraph [0022] and claim 314), thus exactly the coating as defined in feature 4.2.

Document D5 (see title, abstract, paragraphs [0182], [0405], [0673] or [0681] and Figure 10) discloses that the coating is present on an inner surface of a container comprising a lumen (vessel 80) with an opening (opening 82) and that the inner surface

(interior surface 88) defines at least a portion of the lumen. Therefore, features 5 and 5.1 are disclosed in document D5.

Accordingly, document D5 discloses features 1, 2, 3, 4, 4.2, 5 and 5.1 of alternative II of claim 1.

1.1.2 Arguments from the opposition division and the patent proprietor

The opposition division and the patent proprietor argued that the problem-solution approach required to start from a precise embodiment and did not allow to pick features from different embodiments. As document D5 was a long document comprising *"long lists of possible alternatives for irradiation, detection, processing, coatings, etc."*, the alleged general teaching of document D5 was constructed by picking selectively and in an isolating manner different paragraphs throughout the long document D5. In conclusion, the general teaching of document D5 as presented by the opponent was to be disregarded. Therefore, in document D5 only the two alternative embodiments appeared to provide an adequate starting point: the use of reflection measurement (see paragraph [0669] or the use of IR light in transmission mode (see Figure 10).

The patent proprietor further argued that document D5 was not a suitable starting point as it did not disclose a method of detecting whether a coating or deposit was present on a surface (feature 1) but was concerned with the inspection of a coating for defects.

The board is not convinced by these arguments for the following reasons:

The board agrees with the opposition division that document D5 is directed at the same purpose as the invention as it is directed at a system for coating and inspection of a vessel (see title and paragraph [0003] and it discloses to this end (see sections VI. "Vessel inspection" , VI.A "Post-Coating inspection" and paragraph [0680]) inspecting the coating for defects. An inspection for defects includes the detection whether coating is present on a surface (feature 1).

However, the board does not agree with the opposition division and the patent proprietor that the problem-solution approach needs to start from a precise embodiment and that document D5 provides only two alternative embodiments (the use of reflection measurement as described in paragraph [0669] and the use of infrared light in transmission mode as shown in Figure 10) as adequate starting points for the problem solution approach.

The disclosure of document D5 is not restricted to the specific embodiments and the individual sections of document D5 must not be considered in isolation from the others but must be seen in their overall context. Therefore, document D5 discloses with respect to the optical vessel inspection not only specific embodiments, but also all variants that are directly and unambiguously disclosed, account being taken of a skilled person's common general knowledge at the publication date of the cited document.

The board therefore agrees with the opponent that document D5 discloses an optical detection method with features 1, 2, 3, 4, 4.2 (relating to alternative II.), 5 and 5.1. The combination of these features is not a result of selectively cherry picking features

throughout different embodiments of D5 because the cited passages all relate to the disclosure of the vessel inspection (section VI. of document D5), in particular by means of an optical inspection device (as e.g. shown in Figures 10 and 11 and referred to multiple times in paragraphs [0665] to [0730]).
With respect to the argument of *"long lists of possible alternatives for irradiation, detection, processing, coatings, etc."*, the board notes the following:

Irradiation
Document D5 (see paragraphs [0690] and [0691]) already suggests using an optical detection using infrared light. In addition, document D5 explicitly discloses the use of SiO_x coatings (see paragraph [0022] and claim 314). The question, which wave numbers can be used in the optical detection for the SiO_x coatings will become relevant when assessing inventive step.

Detection
As discussed above, document D5 discloses a vessel inspection by optical means in order to inspect the inner surface of a coated vessel. For this optical inspection, document D5 (see paragraphs [0673] and [0713]) discloses a measurement in reflection as an alternative to a detection in transmission. The feature reflection is therefore not one among a long list of equal alternatives but only one out of two explicitly disclosed optical set-ups.

Processing
The above discussed features do not relate to processing and the board cannot see a choice out of a long list of processing alternatives.

Coatings

Document D5 (see paragraph [0022]) discloses an SiO_x vessel coating as a particular example but not as one coating among a long list of equal alternatives.

In conclusion the board is of the opinion that document D5 discloses an optical detection method with the optical set-up of features 1, 2, 3, 4, 5, and 5.1 for detecting the presence of SiO_x coatings as defined in feature 4.2 of claim 1.

1.2 Differences and problems to be solved

Document D5 does not disclose

(a) the characteristic wave numbers for the SiO_x coating (feature 4.2.1) and
(b) that the light passes through the opening to the interior surface (feature 5.2).

The board agrees with the opposition division (see decision, point 30.2.4.1) and the opponent (see letter dated 30 May 2023, pages 14 and 16) that the problems associated with the differences (a) and (b) are as follows:

(a) Provide precise measurement of the presence of an SiO_x coating.
(b) Provide an alternative and simplified optical set-up.

1.3 Obvious solution: alternative II

The board agrees with the opposition division (see decision, point 30.2.3.2 and 30.2.4.2) and the opponent (see statement of grounds dated 30 May 2023, pages 14

and 16) that the two objective technical problems associated with the above identified differences (a) and (b) are independent and that their solutions do not involve an inventive step.

1.3.1 Problem (a)

The claimed wave numbers for the detection of SiO_x coatings are known to the skilled person from its common general knowledge. This is e.g. documented by document D13 (see page 417: strongest absorption near 1080 cm^{-1}, and Figure 5.1 on page 418: absorption peak around 1070 cm^{-1}). The choice of infrared light with wave numbers in the range of about 1060 cm^{-1} to about 1080 cm^{-1} to provide a precise measurement of the presence of an SiO_x coating does therefore not involve an inventive step.

The patent proprietor argued that document D13 was late filed and should not have been admitted into the procedure by the opposition division.
In addition, document D13 disclosed numerous different wavelengths and there was no hint for the skilled person to use exactly the one referred to by the opponent.

The board is not convinced by these arguments for the following reasons:

The opposition division admitted document D13 into the proceedings as proof of common general knowledge. The board cannot conclude that the opposition division, by admitting document D13, did not exercise its discretion in accordance with the right principles or that it exercised its discretion in an unreasonable way.

Therefore, the board sees no reason to overrule this discretionary decision.

Document D13, a *"Handbook of infrared spectroscopy of ultrathin films"* (see title), is considered to document the common general knowledge in this field and discloses (see chapter 5.1. "Thermal SiO_2 layers", Figure 5.1) that such films have a peak in their absorption spectra at around 1070 cm^{-1}, i.e. exactly in the claimed range from about 1060 cm^{-1} to about 1080 cm^{-1}.
Based on this common general knowledge, the skilled person would therefore choose a wavelength in the claimed range without the need for an inventive step.

1.3.2 Problem (b)

The patent proprietor argued that the setup of feature 5.2 of claim 1 was not merely an alternative to the setup used in document D5 because many setups were possible. Indeed the patent disclosed (see paragraphs [0099] to [0104]) several examples in which the infrared light passed through the opening to the interior surface and, in contrast to that, other examples (see paragraphs [0105] to [0108]) in which this was not the case. The effect of the claimed setup was a reduced risk of damage to or contamination of the interior of the vessel and a faster testing.

The board is not convinced by this line of argument for the following reasons:

Passing the light through the opening is merely a straightforward alternative to providing the light source within the vessel. The board agrees with the opponent that passing the light through the opening is

one of the most simple setups which the person would consider without an inventive step being involved. Even the patent does not associate any unexpected or surprising effects with this setup, but, on the contrary, presents various alternatives for the optical setup as equal alternatives (see paragraphs [0099] to [0108] and Figures 6 to 10).

Passing the light to be reflected through the opening of the vessel (feature 5.2) does therefore not involve an inventive step.

1.3.3 Lack of inventive step

In conclusion, the board is of the opinion that alternative II (features 4.2 and 4.2.1) of claim 1 does not involve an inventive step in view of document D5 and the common general knowledge as, inter alia, documented by document D13.

1.4 Obvious solution: alternatives I and III of claim 1

The features 4.1, with the corresponding feature 4.1.1, and 4.3, with the corresponding features 4.3.1, 4.3.2 and 4.3.3, concern the alternative coatings SiO_xC_y and SiN_xC_y.

Document D5 already discloses $SiO_xC_yH_z$ coatings, where x is from about 0.5 to 2.4 and y is from about 0.6 to 3 (see paragraphs [0132], [0415] and claim 460). According to the patent (see paragraphs [0038] to [0040]), this is equivalent to SiO_xC_y. Therefore, the alternative SiO_xC_y in features 4.1 and 4.3 is also disclosed in document D5.

The wave numbers for the detection of the alternative SiO_xC_y are known from document D1 (see column 3, lines 48 to 65, column 6, lines 28 to 39 and Figure 4 and 5).

SiO_xC_y and SiN_xC_y coatings and their respective wave numbers are known from document D2 (see paragraphs [0027], [0041], [0042] and [0177]).

Therefore, and for the reasons discussed above for SiO_x coatings, the board agrees with the opponent (see statement of grounds of appeal, section VI.4) that these alternatives also do not involve an inventive step.

2. Auxiliary request 1

2.1 Amendments

The claims of auxiliary request 1 were filed with a letter dated 3 November 2021.

In comparison to claim 1 of the main request, in feature 5 the term *"container"* has been replaced by *"article"*.

2.2 Inventive step (Article 56 EPC)

As the term *"article"* is more general than the term *"container"*, the board is of the opinion that, for the same reasons as set out above for the main request, the subject-matter of claim 1 of auxiliary request 1 lacks an inventive step in view of document D5 and the common general knowledge as, inter alia, documented by document D13.

3. Auxiliary request 2a

3.1 Amendments

The claims of auxiliary request 2a were filed as auxiliary request 3 with a letter dated 13 September 2022.

In comparison to claim 1 of the main request, the features 1, 3 and 5 of claim 1 of auxiliary request 2a have been amended as follows (amendments marked by the board)

1 *A non-destructive method of detecting whether a coating or deposit is present on or near a first surface of an article comprising a container, the method comprising*

3 *• collecting at least a portion of the infrared light reflected by ~~on~~ the first surface; and*

5 *• wherein the said coating or deposit is present on or near an inner surface of ~~a~~ the container comprising a lumen,*

3.2 Inventive step (Article 56 EPC)

As document D5 also discloses that the article on which the coating is present is a container (see e.g. title and abstract: *"vessel"*), the board is of the opinion that, for the same reasons as set out above for the main request, the subject-matter of claim 1 of auxiliary request 2a lacks an inventive step in view of document D5 and the common general knowledge as, inter alia, documented by document D13.

4. Auxiliary request 2 - Inventive step

The opposition division decided to maintain the patent in amended form based on the claims of auxiliary request 2.

In comparison to claim 1 of the main request, the features 1 and 5 of claim 1 of auxiliary request 2 have been amended as follows (amendments marked by the board)

1 *A non-destructive method of detecting whether a coating or deposit is present on or near a first surface of an article comprising a container, the method comprising*

5 • *wherein the said coating or deposit is present on or near an inner surface of ~~a~~ the container comprising a lumen,*

4.1 Inventive step (Article 100(a) and 56 EPC)

As document D5 also discloses that the article on which the coating is present is a container (see e.g. title and abstract: *"vessel"*), the board is of the opinion that, for the same reasons as set out above for the main request, the subject-matter of claim 1 of auxiliary request 2 lacks an inventive step in view of document D5 and the common general knowledge as, inter alia, documented by document D13.

5. Auxiliary requests 4 to 15 - Inventive step

These requests had been filed during the first-instance opposition proceedings with a letter dated

13 September 2022 but were not subject of the decision under appeal.

The patent proprietor presented arguments in favour of these requests by reference to its letter dated 13 September 2022.

In comparison to the patent as granted, auxiliary requests 4 to 15 contain one or more of the following amendments in the features of claim 1:

(i) in feature 1: *"A non-destructive method of detecting whether a coating or deposit is present on or near a first surface of an article, wherein the article includes or is a prefilled container";*

(ii) in feature 1: "*A non-destructive method of detecting whether a coating or deposit is present on or near a first surface of an article comprising a container";*

(iii) in feature 5: "*wherein the said coating or deposit is present on or near an inner surface of ~~a container~~ an article comprising a lumen";*

(iv) in feature 5: *"wherein the said coating or deposit is present on or near an inner surface of ~~a~~ the container comprising a lumen, the interior surface ~~comprising~~ being said first surface";*

(v) in feature 1: "A non-destructive method of detecting whether a coating or deposit is present on or near a first surface of~~an article~~ a disposable thermoplastic medical article";

(vi) in features 1 and 2: *"A non-destructive method of detecting whether a coating or*

deposit is present on or near a ~~first~~ cylindrical surface of an article the method comprising:
- impinging infrared light on said first cylindrical surface;";
In addition, also in features 2, 3, 4.1.1, 4.2.1, 4.3.2 and 5.1 the feature "first surface" was replaced by "cylindrical surface";

(vii) in feature 1: "*A non-destructive method of detecting whether a coating or deposit of SiO_xC_y or SiN_xC_y, where x is from about 0.5 to about 2.4 and y is from about 0.6 to about 3 and/or a coating or deposit of SiO_x, where x is from about 1.5 to about 2.9, is present on or near a first surface of an article".*

With respect to these amendments the board came to the following conclusions:

5.2 Added subject-matter - Article 123(2) EPC

Amendment (i)

The patent proprietor argued that the feature *"prefilled"* was disclosed literally in the application as filed (see paragraphs [00100] and [00101]).

The board is not convinced by this argument for the following reason:
Although the application as filed discloses *"prefilled"* in several instances (e.g. paragraphs [0004], [0005], [0072] and [00100] to [0102]), it neither discloses that the claimed detection method is carried out on prefilled containers nor how this could be realised.

As a consequence, claim 1 of auxiliary requests 5, 8, 11 and 14 including amendment (i) comprises subject-matter which extends beyond the content of the application as filed and, therefore, does not meet the requirements of Article 123(2) EPC.

5.3 Lack of inventive step - Article 56 EPC

Amendments (ii) to (vii)

The patent proprietor argued that document D5 disclosed a disposable thermoplastic medical article only for the specific embodiment described in paragraph [0056] and did not explain how to perform the claimed detection of a coating on a cylindrical surface.

The board is not convinced by this argument for the following reasons:

Document D5 (see e.g. paragraphs [0056] to [[0059]: *"coated syringe barrel [...] advantageously made of thermoplastic material" with a "barrier layer of* SiO_x*"*) discloses that the article on which the SiO_x coating is present is a disposable thermoplastic medical article comprising a container with an interior cylindrical surface. As the general aim of document D5 is the inspection of this layer (see discussion of the main request above), the added features are already known from document D5.

As a consequence, the subject-matter of claim 1 of auxiliary requests 4, 6, 7, 9, 10, 12, 13 and 15, for the same reasons as discussed above for the main request, does not involve an inventive step in view of

document D5 as closest prior art and the common general knowledge as, inter alia, documented by document D13.

5.4 Admission of late filed submissions with respect to auxiliary requests 4 to 15

The patent proprietor objected that the opponent had never filed any arguments with respect to the auxiliary requests 4 to 15. The submissions on these points were made for the first time during the oral proceedings. Therefore, these submissions should not be admitted.

The opponent answered that the oral proceedings before the board were the first opportunity to comment in the wake of the board's communication pursuant to Article 15(1) RPBA, in the following referred to as "the board's communication".

The board notes that in case of amendments of the claims of a patent in the course of first-instance opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (see G 10/91, point 19).

The board did this in its communication and nothing discussed in the oral proceedings extended beyond what had been laid out in the appeal proceedings, including the contents of the board's communication.

Therefore, the board sees no reasons not to admit the submissions made by the opponent during the oral proceedings.

6. Auxiliary request 16 - Admission

The patent proprietor filed this request for the first time during the oral proceedings before the board.

6.1 Amendments

Claim 1 of this request is a combination of independent claim 1 and dependent claim 3 of auxiliary request 2. Thus, claim 1 of auxiliary request 2 was amended by adding the following feature:

"... in which the article comprises a first coating or deposit of SiOxCy or SiNxCy, where x is from about 0.5 to about 2.4 and y is from about 0.6 to about 3, and a second coating or deposit of SiOxCy or SiNxCy, where x is from about 0.5 to about 2.4 and y is from about 0.6 to about 3, and wherein detecting the presence of at least one of the first coating or deposit and the second coating or deposit comprises measuring the response output of the collected infrared light at an infrared spectroscopy peak in one or more of (a) at least a portion of a range between 950 and 1230 cm-1 and (b) at least a portion of a range between 1230 and 1300 cm-1, the measured response output being indicative of at least one of the first coating or deposit of SiO_xC_y or SiN_xC_y and the second coating or deposit of SiO_xC_y or SiN_xC_y."

6.2 The opponent requested not to admit auxiliary request 16 according to Article 13(2) RPBA.
It argued that the patent proprietor became aware of the reasons why the higher ranking auxiliary requests were not allowable with the receipt of the board's communication. Therefore, any amendments should have

been filed in preparation of the oral proceedings, but not only during the oral proceedings.

Admittance of this auxiliary request at this late stage would require a postponement of the oral proceedings.

In addition, the amendments could not contribute to an inventive step, since the added feature was redundant in relation to alternative III of claim 1 of auxiliary request 2.

6.3 The patent proprietor argued that during the first-instance opposition proceedings only Article 123(2)EPC had been an issue and that it had only three months' time after receipt of the board's communication to file amended auxiliary requests. This was particularly challenging, as the patent proprietor was difficult to reach.

In addition, claim 1 of this request combined only claims that were already present in the patent as granted. Therefore, it was possible to deal with this request also at this late stage of the proceedings.

Finally, claim 1 now defined a double coating whereas document D5 only disclosed a single coating of SiO_xC_y or SiN_xC_y. Although the two layers were of the same material, they were nevertheless two distinct layers. As document D5 did not disclose such a double layer coating, the subject-matter of claim 1 was clearly inventive.

6.4 The board is not convinced by the patent proprietor's arguments for the following reasons:

The board's communication was sufficient to inform the patent proprietor of the objections against all auxiliary requests then on file. It was then up to the patent proprietor to consider, at the earliest opportunity, whether it was necessary to amend the patent. The appellant chose to address the objections by filing amended claims according to a further auxiliary request only during the oral proceedings before the board.

The representative's argument that the patent proprietor was difficult to reach is not convincing either, as this is not considered to be a new or unforeseen development in the appeal proceedings themselves.

Therefore, the board does not acknowledge exceptional circumstances which have been justified by cogent reasons.

As a consequence, auxiliary request 16 is not taken into account (Article 13(2) RPBA).

7. Conclusion - Article 101 EPC

The ground for opposition under Article 100(a) in conjunction with Article 56 EPC prejudices the maintenance of the patent as granted (Article 101(2) EPC).
Taking into consideration the amendments made by the proprietor of the European patent according to the above discussed auxiliary requests 1 to 15, the patent and the invention to which it relates do not meet the requirements of the EPC (Article 101(3)(b) EPC).

Furthermore, the remaining auxiliary request 16 was not admitted to the proceedings.

Therefore, the patent has to be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

K. Boelicke R. Bekkering

Decision electronically authenticated