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**Datasheet for the decision
of 14 January 2025**

Case Number: T 0823/23 - 3.2.03

Application Number: 07859801.8

Publication Number: 2098309

IPC: B21B1/22

Language of the proceedings: EN

Title of invention:

METHOD OF TEMPER ROLLING OF STEEL STRIP AND PROCESS FOR
MANUFACTURING HIGH TENSILE COLD ROLLED STEEL SHEET

Patent Proprietor:

JFE Steel Corporation

Opponents:

SMS group GmbH
ThyssenKrupp Rasselstein GmbH

Headword:

Relevant legal provisions:

RPBA 2020 Art. 12(4), 13(2), 11
EPC Art. 54, 56, 123(2)

Keyword:

Amendment to case - amendment within meaning of Art. 12(4) RPBA 2020 (yes)
Late-filed objection - admitted (no)
Novelty - multiple selection - main request (no) - auxiliary request (yes)
Remittal - special reasons for remittal (no)
Amendments - extension beyond the content of the application as filed (yes)
Inventive step - non-obvious solution
Amendment after summons - exceptional circumstances (no)

Decisions cited:

G 0010/91, T 0937/09, T 0573/12, T 1930/14, T 0022/15,
T 0084/17, T 1042/18, T 1776/18, T 0364/20, T 1088/20,
T 1990/20, T 0446/22, T 0731/22, T 0924/22

Catchword:

When determining whether a submission was admissibly raised in the proceedings leading to the decision under appeal within the meaning of Article 12(4) RPBA, the Board first assesses whether the department of first instance had discretion not to admit that submission. If the department of first instance had discretion, the Board then assesses, in a second step, how a department of first instance, assuming legally correct and reasonable conduct, would have exercised this discretion. This requires the Board to take on the perspective of a department of first instance (Reasons 7.8 - 7.22).



Beschwerdekammern

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Case Number: T 0823/23 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 14 January 2025

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
15 February 2023 concerning maintenance of the
European Patent No. 2098309 in amended form.**

Composition of the Board:

Chairman C. Herberhold
Members: B. Miller
 N. Obrovski

Summary of Facts and Submissions

I. European patent EP 2 098 309 B1 ("the patent") relates to a method for performing temper rolling on a steel strip.

II. Two oppositions were filed against European patent EP 2 098 309 B1, based on the grounds of Article 100(a) EPC together with Articles 54 and 56 EPC.

The opposition division decided to revoke the patent.

The patent proprietor appealed against this first decision.

III. In T 1950/16 the first decision to revoke the patent was set aside and the case was remitted to the opposition division on the basis of then auxiliary request 1, which became the main request in the subsequent further opposition proceedings. The remittal to the department of first instance was based on the finding that the opposition division had not yet decided upon all the issues arising from the ground of opposition pursuant to Article 100(a) EPC, namely novelty with regard to D1 and inventive step starting from D1.

IV. During the subsequent opposition proceedings, the opposition division stated in its written preliminary opinion that it did not intend to admit a new ground of opposition under Article 100(b) EPC concerning auxiliary requests 3 and 4 (see point 6.1 of the communication dated 6 July 2022) and decided that the

patent as amended on the basis of the main request (filed as auxiliary request 1 during the preceding appeal proceedings with the letter dated 15 September 2017) met the requirements of the EPC.

V. Opponent 2 ("the appellant") appealed against this second decision by the opposition division.

VI. Requests

The appellant requested that the decision under appeal be set aside and that the patent be revoked. In terms of procedural requests, the appellant further requested that auxiliary requests 5 to 19 not be admitted.

The patent proprietor ("the respondent") requested that the appeal be dismissed. If the Board were to set aside the decision under appeal, the respondent requested that the case be remitted to the opposition division for further prosecution or, alternatively, that the patent be maintained as amended on the basis of one of auxiliary requests 1 to 19 as filed with the reply to the statement of grounds of appeal.

In terms of procedural requests, the respondent further requested that the following not be admitted:

- all objections under Article 100(b)/83 EPC
- the novelty objection based on paragraph [0046] of D1c
- the inventive-step objection based on example 3 of D1c as submitted during the oral proceedings before the Board

Opponent 1 (party as of right) endorsed the appellant's requests.

VII. Evidence

The following documents were cited during the opposition proceedings and are of particular importance for the present decision:

- D1: JP 2006-007233 A
- D1c: German translation of D1 by Mr Sakurai
- D2: "Handbuch der Fertigungstechnik", Band 2/1 "Umformen", chapter 3.2.3.5 "Nachwalzen", edited by Günter Spur et al., Carl Hanser Verlag München Wien, 1983, ISBN 3-446-12533-7, pages 411-417

VIII. Wording of the requests under consideration

(a) Main request

Claim 1 reads:

"A method for performing temper rolling on a steel strip using a temper rolling mill which includes at least one roll stand (3) having work rolls (2), the center-line averaged roughness Ra of which being in the range of 3.0 to 10.0 μm , the method comprising performing temper rolling at an elongation percentage of 0.1% or more on a steel strip (1) having a yield strength of 490 MPa or more."

(b) Auxiliary request 1

Claim 1 is based on claim 1 of the main request and reads (amendments compared with claim 1 of the main request highlighted in bold by the Board):

"A method for performing temper rolling on a steel strip using a temper rolling mill which includes at least one roll stand (3) having work rolls (2), the center-line averaged roughness Ra of which being in the range of 3.0 to 10.0 μm , the method comprising performing temper rolling at an elongation percentage of 0.1% or more on a steel strip (1) having a yield strength of **340 MPa** or more **and having a tensile strength of 980 MPa or more.**"

(c) Auxiliary request 2

Claim 1 corresponds to claim 1 of auxiliary request 1 but specifies that the steel strip (1) is a "high tensile-strength cold-rolled" steel strip.

(d) Auxiliary request 3

Claim 1 is based on claim 1 of auxiliary request 2 but specifies the following (amendments compared with claim 1 of the main request highlighted in bold by the Board):

"A method for performing temper rolling on a steel strip using a temper rolling mill which includes at least one roll stand (3) having work rolls (2), the center-line averaged roughness Ra of which being in the range of 3.0 to 10.0 μm , the method comprising performing temper rolling at an elongation percentage of 0.1% or more on a steel strip (1) having a yield strength of **340 MPa** or more, **the steel strip (1) having a yield strength of 340 MPa or more is a high tensile-strength cold rolled steel strip having a tensile strength of 980 MPa or more and manufactured by continuous annealing including a quenching treatment and a tempering treatment.**"

(e) The wording of the remaining auxiliary requests is not relevant for this decision.

IX. Oral proceedings were held on 14 January 2025.

X. The appellant's arguments, as far as they are relevant for this decision, can be summarised as follows.

(a) Admittance of the novelty objection

The appellant (then opponent 2) had raised the novelty objection based on paragraph [0046] of D1c in point II.b of the notice of opposition. Moreover, novelty in view of paragraph [0046] of D1 had been discussed during the oral proceedings before the opposition division, as well as in point II.3 of the contested decision. Therefore, the objection was not new and should be discussed in the appeal proceedings.

(b) Main request - novelty

The subject-matter of claim 1 was not novel over the disclosure in paragraph [0046] of D1c. This paragraph unambiguously addressed temper rolling. No multiple selections were required to arrive at the subject-matter of claim 1.

(c) Request for remittal

The appellant had not submitted any reason why the case should be remitted.

(d) Auxiliary requests 1 to 3 - amendments

The amendments to claim 1 extended beyond the subject-matter of the application as filed since a method for temper rolling steel having a tensile strength of 980 MPa or more was not directly and unambiguously derivable from the application.

In view of the disclosure in claim 6 or paragraph [0025] of the application as filed, the amendments resulted in an intermediate generalisation and were not allowable.

(e) Auxiliary request 3 - admittance of the objection regarding sufficiency of disclosure

The invention as defined in claim 1 of auxiliary request 3 was insufficiently disclosed since the patent did not disclose how a steel sheet having the claimed strength could be manufactured and how the required annealing and quenching steps were to be performed. This objection had been raised and maintained during the opposition proceedings and should be admitted in the appeal proceedings.

(f) Auxiliary request 3 - novelty

The subject-matter of claim 1 lacked novelty for the same reasons as claim 1 of the main request. The further features concerning the annealing and quenching steps were known from paragraph [0057] of D1c. Moreover, D1c disclosed that the temper rolling method could be performed for steel strips having a tensile strength of more than 980 MPa; see paragraph [0024] or [0060] of D1c.

(g) Auxiliary request 3 - inventive step

The subject-matter of claim 1 was obvious when starting from example 23 of D1c because the skilled person would use work rolls having a slightly higher surface roughness to provide an alternative temper rolling method. The motivation for this modification was derivable from D1 itself, which already disclosed all the process steps and parameters defined in claim 1.

Moreover, in response to the Board's preliminary opinion as set out in the communication under Article 15(1) RPBA, example 3 of D1c could be considered a starting point for the assessment of inventive step. In line with the disclosure in paragraph [0016] of the patent, the assessment in the contested decision and the Board's preliminary opinion, the objective technical problem could be formulated as how to provide a method for manufacturing a high tensile strength cold-rolled steel sheet which does not place a burden on temper rolling.

The solution to this problem as defined in claim 1 was obvious for the skilled person when considering the physics behind the rolling process, as also confirmed by D2.

XI. The respondent's corresponding arguments can be summarised as follows.

(a) Admittance of the novelty objection

The novelty objection based on paragraph [0046] of D1c had not been raised in the opposition proceedings. The objection was thus new and should not be admitted into the appeal proceedings.

(b) Main request - novelty

The subject-matter of claim 1 was novel over the general disclosure in paragraph [0046] of D1c because it did not address temper rolling but only cold rolling in general. Moreover, multiple selections were required to arrive at the subject-matter of claim 1.

(c) Request for remittal

There were special reasons for remittal because none of auxiliary requests 1-19 had been fully considered for compliance with the requirements of the EPC, and no final decision dealing with all the requirements of the EPC had been handed down at first or second instance in respect of any of these claim requests.

(d) Auxiliary requests 1 to 3 - amendments

Claim 1 of auxiliary requests 1 and 2 was based on claim 1 as originally filed, with the following feature added:

"and having a tensile strength of 980 MPa or more"

This feature was disclosed in claim 6 and in the third paragraph on page 34 of the application as filed.

(e) Auxiliary request 3 - admittance of the objection regarding sufficiency of disclosure

The objection regarding sufficiency of disclosure should not be admitted since it was filed late in the opposition proceedings and therefore had not been admissibly raised. It had not been maintained in those proceedings either. The objection was not *prima facie* relevant since process steps such as annealing and quenching fell within the experimental routine of the skilled person, and obtaining steel sheets with such a high tensile strength was part of the common general knowledge.

(f) Auxiliary request 3 - novelty

The subject-matter of claim 1 was novel over D1c since multiple selections were required to arrive at subject-matter according to claim 1.

(g) Auxiliary request 3 - inventive step

Focusing on temper rolling of high tensile strength steel strips, the skilled person had no reason to start from example 23 of D1 since example 23 did not relate to a steel strip having a high tensile strength of 980 MPa or more.

Starting from example 23 of D1, the skilled person had no reason to expect that increasing the center-line averaged roughness R_a of the work roll of the temper rolling mill to 3.0 to 10.0 μm would make it possible

to reduce the temper rolling load for high tensile strength steel strips.

The line of argument starting from example 3 of D1 had been filed late - only during the oral proceedings before the Board - and should not be admitted into the appeal proceedings. The Board's communication did not raise any new issues but simply indicated that the appellant's reasoning did not appear convincing in view of the reasoning in the contested decision. Therefore, there were no exceptional circumstances which justified the admittance of a completely new line of argument based on the allegedly known underlying physics of the temper rolling process and a new interpretation of D2.

XII. The party as of right did not provide any further arguments beyond those of the appellant.

Reasons for the Decision

1. Admittance of the novelty objection

1.1 The appellant's line of argument concerning novelty is based on paragraph [0046] of D1c (human translation of D1). The novelty objection based on paragraph [0046] of D1 is not new and had already been raised by the appellant (then opponent 2) in point II.b of the notice of opposition. Moreover, novelty in view of paragraph [0046] of D1 had been discussed during the oral proceedings before the opposition division; see minutes of the oral proceedings (page 1 under the heading: "Main request: Novelty"). It is also discussed in point II.3 of the contested decision.

The appellant raised the objection with further reference to paragraph [0058] and the examples. However, the appellant's arguments leave no doubt that the examples and paragraph [0058] were cited *inter alia* in support of the argument that the skilled person would consider working in the area of the ranges disclosed in paragraph [0046] itself, which overlap with the ranges defined in the claims of the main request.

The appellant's argument as presented in the statement of grounds of appeal has therefore merely been refined and given a slightly different focus, in particular by also referring to the human translation D1c, but had in essence already been presented in the opposition proceedings. Moreover, the objection, including the reference to paragraph [0046], seemed to be *prima facie* highly relevant.

In view of the above, the Board took the novelty objection based on paragraph [0046] of D1c on appeal into account.

2. Main request - Article 54 EPC

2.1 D1c discloses a method for temper rolling a steel strip in general terms (paragraph [0046]).

The intended mechanical properties addressed in paragraph [0046] of D1c pertain to the steel strip after temper rolling. However, it becomes clear from the disclosure in paragraph [0015] of D1c that the steel strip already has the high tensile strength of 780 MPa or more before the temper rolling because D1c aims at temper rolling these kinds of high-strength steel strips.

Moreover, it is uncontested that a steel strip having a tensile strength of above 780 MPa inherently has a yield strength of above 490 MPa.

2.1.1 During temper rolling according to D1c, the elongation percentage should not exceed 0.5%. The roll roughness R_a is between 1 and 4 μm (D1c, paragraph [0046]: "Wenn bei einer 0,5% überschreitenden Dehnung ein Dressierwalzen durchgeführt wird"; "wird die Walzenoberflächenrauheit R_a auf 1,0 μm oder darüber gebracht, wenn ein Dressierwalzen durchzuführen ist"; " R_a der Walzenoberfläche bevorzugt auf 4,0 μm begrenzt").

2.1.2 Considering the specific end points for the parameters disclosed in paragraph [0046] of D1c (elongation percentage: 0.5%, surface roughness R_a : 4.0 μm), D1c directly and unambiguously discloses a temper rolling method as defined by claim 1.

2.2 The respondent argued that paragraph [0046] of D1c did not disclose the parameters of temper rolling but only of cold rolling in general.

This argument is not convincing since paragraph [0046] of D1c explicitly refers to temper rolling (highlighting added by the Board):

"wird die Walzenoberflächenrauheit R_a auf 1,0 μm oder darüber gebracht, **wenn ein Dressierwalzen durchzuführen ist**"; " R_a der Walzenoberfläche bevorzugt auf 4,0 μm begrenzt. Übrigens: Wenn die Bedingung für die obige Oberflächenrauheit erfüllt wird, besteht keine Einschränkung bezüglich der Unebenheitsstruktur **der beim Dressierwalzen verwendeten Arbeitswalzen**"

2.3 The respondent further argued that D1c did not disclose the necessary parameters of temper rolling in combination and that several selections within the general disclosure of D1c were required to arrive at the claimed subject-matter.

This argument is not convincing either.

D1c discloses the conditions for temper rolling ("Dressierwalzen") in combination and in the context of the general disclosure in paragraph [0046]. Although D1c indicates that the elongation should not exceed 0.5%, for the skilled person this does not imply a range from 0.0 to 0.5% because some elongation always occurs in temper rolling. Considering the disclosure in paragraph [0046] of D1c in combination with the skilled person's technical understanding, the range for the elongation disclosed in D1c in practice overlaps completely with the range of 0.1% or more defined in claim 1.

It follows that starting from the general disclosure in paragraph [0046] of D1c, the skilled person only needs to select the higher limit of the surface roughness range of the work roll to arrive at the subject-matter of claim 1.

Therefore, a multiple selection (see Case Law of the Boards of Appeal, 10th edition, 2022, chapter I.C. 6.3.3) is not required for the skilled person.

2.4 Even if the Board were to accept the respondent's argument that D1c discloses ranges which only overlap to a certain extent with the subject-matter defined by claim 1, the relevant principles developed by the case law with regard to overlapping ranges have to be

followed; see Case Law of the Boards of Appeal, 10th edition, 2022, chapter I.C.6.3.2.

The examples demonstrate that the skilled person would consider working in the overlapping range between the general disclosure of D1c and the subject-matter defined by claim 1.

For all the examples according to the invention of D1c, the elongation percentage is set between 0.2 and 0.5%.

Although the surface roughness R_a of the work roll for most examples (examples 1 to 20 and 25) is 1.8 μm (see Tables 2 and 3, ninth column), D1c also discloses examples with a far higher surface roughness of 2.9 μm (see e.g. example 23 in Table 3 of D1).

The examples further prove, in columns "YP" (yield point in MPa) and "TS" (tensile strength in MPa), that the yield point is well above 490 MPa for any steel strip having a tensile strength above 780 MPa.

Hence, the examples demonstrate that the information in paragraph [0046] of D1c was not only sufficient to enable the skilled person to put the technical teaching of D1c into practice but also pointed the skilled person towards working in the overlapping ranges.

2.5 In view of the above, the Board concludes that the subject-matter of claim 1 is not novel in view of the disclosure in paragraph [0046] of D1c and does not fulfil the requirements of Article 54 EPC.

3. Request for remittal

Under Article 11 RPBA the Board may remit the case to the department whose decision was appealed if there are special reasons for doing so.

For the main topics to be discussed in light of the contested decision, namely novelty and inventive step in view of D1, the parties are using the same arguments and evidence in relation to both the main request and the auxiliary requests.

Therefore, the Board saw no special reason to remit the case to the department of first instance to discuss the auxiliary requests and denied the respondent's request for remittal.

4. Auxiliary request 1 - Article 123(2) EPC

4.1 Claim 1 of auxiliary request 1 is based on claim 1 as originally filed but with the following feature added:

"and having a tensile strength of 980 MPa or more"

This feature is disclosed in claim 6 (which corresponds to paragraph [0025] of the application), in the sentence bridging pages 32 and 33 of the application as filed (paragraph [0062] of the A1 publication) and in the paragraph bridging pages 45 and 46 of the application as filed (paragraph [0094] of the A1 publication), albeit in combination with further features of the manufacturing process such as an annealing/quenching and tempering treatment. There is thus a functional link between the claimed strength and the aforementioned manufacturing steps.

The tensile strength of 980 MPa is also mentioned in the third paragraph on page 34 (paragraph [0066] of the A1 publication) of the description in relation to Figure 6. However, the results described in relation to Figure 6 have to be considered in the context of the previous paragraphs. Since the explanations regarding Figure 6 do not represent disclosure of an independent embodiment, the steel strip having a tensile strength of 980 MPa referred to on page 34 is the steel strip as described in detail in the sentence bridging pages 32 and 33 of the application (paragraph [0062] of the A1 publication).

- 4.2 The application does not disclose a temper rolling method for a steel strip having a tensile strength of at least 980 MPa and not produced using the method steps of annealing/quenching and tempering.

Therefore, direct and unambiguous disclosure for the combination of features resulting from the amendment to claim 1 of auxiliary request 1 cannot be found in the application as filed.

- 4.3 This assessment is not changed by the various cases cited by the respondent from the Case Law of the Boards of Appeal, 10th edition, 2022, such as G 2/10 referring to the "gold standard" (OJ 2012, 376) and further decisions summarised in chapters II.E.1, II.E.1.3.1 and II.E.1.3.2.

All the cited decisions follow the established principle that while a literal basis for an amendment might not be necessary, an amendment is only allowable within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the

date of filing, from the whole of the application as filed. These decisions affirm that a feature cannot be isolated out of its functional context.

- 4.4 The Board in the case in hand applies and follows the same principle, thus concluding, in view of the disclosure in the application as filed as discussed above, that the amendment to claim 1 of auxiliary request 1 does not fulfil the requirements of Article 123(2) EPC.

5. Auxiliary request 2 - Article 123(2) EPC

Claim 1 of auxiliary request 2 is based on claim 1 of auxiliary request 1 but further specifies that the steel strip is cold-rolled.

However, claim 1 does not specify that the steel strip having a tensile strength of at least 980 MPa has been produced using the method steps of annealing/quenching and tempering.

The same arguments thus apply as for the amendments to claim 1 of auxiliary request 1. The amendments to claim 1 of auxiliary request 2 therefore do not fulfil the requirements of Article 123(2) EPC.

6. Auxiliary request 3 - Article 123(2) EPC

- 6.1 Claim 1 of auxiliary request 3 is based on a combination of claim 1 with the disclosure in the sentence bridging pages 32 and 33 of the application as filed (paragraph [0062] of the A1 publication).

6.2 The respondent argued in general that the same arguments as with auxiliary requests 1 and 2 also applied to the amendments to claim 1.

This argument is not convincing since the alleged generalisation of the feature "having a tensile strength of at least 980 MPa" from the technical context provided by the disclosure in the sentence bridging pages 32 and 33 of the application has been remedied by the further features incorporated into claim 1 of auxiliary request 3.

6.3 The Board therefore concludes that the amendments to claim 1 of auxiliary request 3 fulfil the requirements of Article 123(2) EPC.

7. Admittance of the objection under Article 100(b)/83 EPC in relation to auxiliary request 3

7.1 The ground of opposition under Article 100(b) EPC had not been invoked as a ground of opposition in the notice of opposition.

7.2 In the first appeal proceedings, the Board indicated in section 8.4 of its communication pursuant to Article 15(1) RPBA that an objection under a new ground of opposition cannot be discussed on appeal without the appellant's consent.

7.3 After the case was remitted to the opposition division for further prosecution, the opponent raised an objection under Article 100(b)/83 EPC against auxiliary requests 3 and 4 in its letter dated 21 February 2022. Contrary to the respondent's allegation, there is no indication on file that this objection was not maintained in the opposition proceedings.

- 7.4 In point 6.1 of its communication dated 6 July 2022, the opposition division stated that this fresh ground of opposition could have already been raised against the patent as granted with the notice of opposition. The division indicated its intention not to admit the ground into the opposition proceedings due to a lack of *prima facie* relevance, referring to Article 114(2) EPC. However, this was only a preliminary opinion, and the opposition division did not take a final decision on this issue. Accordingly, the present situation differs from the situation where an opposition division did not admit a fresh ground of opposition, and where the decision not to admit would then be reviewed by the Board as to an error in the exercise of discretion under Article 12(6), first sentence RPBA (as to case law before the entry into force of Article 12(6) RPBA, see T 22/15, Reasons 3.1).
- 7.5 In other words, the objection under Article 100(b)/83 EPC is a "carry-over objection", i.e. an objection which was raised and maintained in the opposition proceedings but which was not decided upon in those proceedings, neither with regard to its admittance nor in substance, due to the allowability of a claim request that ranked higher than the claim request against which the objection under Article 100(b)/83 EPC had been raised.
- 7.6 It usually would have to be determined whether raising the objection under Article 100(b)/83 EPC in the appeal proceedings qualifies as introducing a fresh ground for opposition at the appeal stage as per G 10/91, point 3 of the order and point 18 of the Reasons. Pursuant to G 10/91, a fresh ground of opposition introduced at the appeal stage may be dealt with by a board of appeal

only with the patentee's approval. The patentee has explicitly denied this approval.

- 7.7 Having said this, in the case in hand the applicability of G 10/91 to raising the objection under Article 100(b)/83 EPC in the appeal proceedings can ultimately be left open. Restrictions on new submissions by an opponent pursuant to G 10/91 and a board's discretionary power not to admit late-filed party submissions under Article 114(2) EPC in conjunction with Articles 12 and 13 RPBA are separate from each other and must be applied in a cumulative manner (see T 1042/18, Reasons 4.5). For the following reasons, the objection under Article 100(b)/83 EPC was not admissibly raised in the proceedings leading to the decision under appeal within the meaning of Article 12(4) RPBA, pursuant to which the Board does not admit the objection into the appeal proceedings.
- 7.8 Under Article 12(4) RPBA, 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 may be admitted only at the Board's discretion, unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal. As the objection under Article 100(b)/83 EPC is a "carry-over objection" (see point 7.5), it is not an objection on which the decision under appeal is based within the meaning of Article 12(2) RPBA, so raising this objection in the appeal proceedings does not meet the "requirements in paragraph 2" as per Article 12(4) RPBA. Accordingly, it must be assessed whether this objection was "admissibly raised and maintained in the proceedings leading to the decision under appeal" within the meaning of Article 12(4) RPBA. If the objection was admissibly

raised and maintained, the Board does not have any discretion not to admit it under Article 12(4) RPBA. If, on the other hand, it was not admissibly raised and maintained, raising it in the appeal proceedings constitutes an amendment under Article 12(4) RPBA which may only be admitted at the Board's discretion.

- 7.9 The purpose of this mechanism is to ensure that submissions on which the decision under appeal is **not** based are:
- (i) neither automatically subject to the Board's discretion regarding admittance
 - (ii) nor automatically part of the appeal proceedings simply because they were raised and maintained in the proceedings leading to the decision under appeal (even though they may not have been admitted into those proceedings had it been necessary to take a decision on their admittance)
- 7.10 The RPBA do not define what is meant by a submission being admissibly raised in the proceedings leading to the decision under appeal. Having said this, the ordinary meaning of the term "admissibly" indicates a reference to admittance, and the reference to the "proceedings leading to the decision under appeal" makes it clear that the circumstances of the proceedings leading to the decision under appeal are decisive, as opposed to the circumstances of the appeal proceedings in which the notion of "admissibly raised" as per Article 12(4) RPBA is assessed.
- 7.11 A systematic interpretation also supports an understanding of the term "admissibly" in Article 12(4) RPBA as a reference to admittance into the proceedings. Notably, the phrase "admissibly raised" is also used in Article 13(1), fourth sentence, RPBA, in which

reference is made to the suitability of an amendment to a party's appeal case to resolve issues "admissibly raised by another party in the appeal proceedings". It follows from this that an amendment need not resolve issues which were **not** admissibly raised by another party, e.g. issues which were raised in the written appeal proceedings but which are ultimately - usually at the oral proceedings - not admitted (at which point it is determined that they were not admissibly raised in the first place).

7.12 Hence, in the Board's view, a submission was "admissibly raised [...] **in** the proceedings leading to the decision under appeal" (emphasis by the Board) if that submission would have been admitted **into** those proceedings had a decision on its admittance been taken by the department of first instance. As set out above, the Board considers that this approach reflects the provision's wording, context and purpose.

7.13 Not all party submissions before a department of first instance are submissions the admittance of which is at the department of first instance's discretion. Hence, when determining whether a submission was admissibly raised in the proceedings leading to the decision under appeal within the meaning of Article 12(4) RPBA, the Board first assesses whether the department of first instance had discretion not to admit that submission. If the department of first instance had discretion, the Board then assesses, in a second step, how a department of first instance, assuming legally correct and reasonable conduct, would have exercised that discretion. This requires the Board to take on the perspective of a department of first instance.

- 7.14 When assessing how a department of first instance would have exercised its discretion (assuming legally correct and reasonable conduct), the Board uses the criteria which the department of first instance would have had to apply. The case law of the Boards of Appeal on reviewing the exercise of discretion in examination proceedings (see for example T 937/09, Reasons 3.4 and 3.5, and T 573/12, Reasons 3.3 and 3.4) and opposition proceedings (see for example T 1930/14, Reasons 22, and T 84/17, Reasons 2.2) can provide guidance for assessing how a department of first instance would have exercised its discretion.
- 7.15 A board may also take account of the Guidelines for Examination in the European Patent Office ("the Guidelines") when assessing how a department of first instance would have exercised its discretion. This, in principle, is no different from a board taking account of the Guidelines when reviewing the actual exercise of discretion by a department of first instance in the context of Article 12(6), first sentence (see T 435/21, Reasons 3.1, fifth sentence, and T 1088/20, Reasons 4.3.3) or second sentence (see T 1990/20, Reasons 4.2), RPBA. While the Guidelines are not binding on the Boards of Appeal in view of Article 23(3) EPC, they are - as general instructions pursuant to Article 10(2) (a) EPC - to be taken into account by the departments of first instance. However, the Guidelines do state that they do not constitute legal provisions and that, for the ultimate authority on practice in the EPO, it is necessary to refer firstly to the EPC itself and secondly to the interpretation of the EPC by the Boards of Appeal and the Enlarged Board of Appeal (General Part, section 3, General remarks). Against this background, a board's consideration of the Guidelines when assessing whether a submission was admissibly

raised within the meaning of Article 12(4) RPBA does not appear to cause any issues.

- 7.16 As only the circumstances of the proceedings leading to the decision under appeal matter in the assessment of whether a submission was "admissibly raised" (see point 7.10 above), the version of the Guidelines in force at the relevant time in those proceedings is pertinent for this assessment (see T 446/22, Reasons 3.4, and T 731/22, Reasons 2.2). In opposition proceedings this is usually the version of the Guidelines in force on the date the decision is announced at the oral proceedings. This differs from considering the version of the Guidelines in force at the time the Board takes its decision in the appeal proceedings (see T 364/20, Reasons 7.2.2, and T 924/22, Reasons 4), although there will often not be any relevant differences in terms of the contents. The current and previous versions of the Guidelines are publicly available on the EPO's website.
- 7.17 The assessment of "admissibly raised" according to the principles as set out above is conceptually similar to what was stated in T 364/20, Reasons 7, according to which a board has to decide whether the opposition division "should" have admitted the submission had a decision on its admittance been required.
- 7.18 In the case in hand, the appellant (then opponent 2) did not raise the objection under Article 100(b)/83 EPC in the opposition proceedings until after the Board had remitted the case to the opposition division, i.e. long after the end of the opposition period under Article 99(1) EPC and therefore not in due time within the meaning of Article 114(2) EPC (see T 1776/18, Reasons 4.6.4). Accordingly, the opposition division had discretion not to admit this objection.

7.19 The Guidelines (March 2022 version) state that in deciding whether to admit grounds for opposition not filed in due time, their relevance to the decision, the state of the procedure and the reasons for the belated submission are to be considered, with particular emphasis being placed on *prima facie* relevance (see E-VI, 2). This is in line with what is stated in G 10/91, Reasons 16, in which reference to *prima facie* relevance and Article 114(2) EPC is made.

7.20 Taking these criteria into account, the Board concludes that the objection under Article 100(b)/83 EPC - and fresh ground of opposition - was not admissibly raised in the opposition proceedings, for the following reasons. Since the case had already been remitted to the opposition division once, the procedure was at a very advanced stage when the objection was raised for the first time. There was no good reason for the belated submission either. The subject-matter of claim 1 of auxiliary request 3 corresponds to the subject-matter of claim 5 as granted. Hence, any lack of sufficiency of disclosure would have also been present for the claims as granted and therefore could and should have already been addressed within the opposition period. As to *prima facie* relevance, the opponent had essentially argued in point III.3 of its letter dated 21 February 2022 that the patent did not sufficiently disclose all the necessary details for obtaining a high tensile strength steel strip by continuous annealing including a quenching treatment and a tempering treatment. However, this was a mere allegation, and the opponent did not establish serious doubts substantiated by verifiable facts that the skilled person would face any problems when trying to manufacture commonly known and even commercially

available high tensile strength steel strips. Furthermore, steel treatment steps such as continuous annealing, quenching and tempering are conventional process steps which the skilled person can perform within their experimental routine. Hence, the objection was *prima facie* not relevant in the opposition proceedings.

7.21 For completeness, the Board notes that the opposition division's written preliminary opinion (see point 6.1 of the communication dated 6 July 2022) also considered the objection not to be *prima facie* relevant, essentially for the same reasons as set out in the previous point.

7.22 As the objection under Article 100(b)/83 EPC was not admissibly raised in the opposition proceedings, it constitutes an amendment under Article 12(4) RPBA the admittance of which is at the Board's discretion.

7.23 If a board considers that a submission was not admissibly raised in the opposition proceedings, it will usually not admit that submission into the appeal proceedings, exercising its own discretion under Article 12(4) RPBA. However, as even submissions which were not actually admitted by the opposition division may exceptionally be admitted under Article 12(6), first sentence, RPBA if so justified by the circumstances of the appeal case, this may also be the case for submissions which were not admissibly raised within the meaning of Article 12(4) RPBA.

7.24 In the case in hand, neither the claim requests against which the objection under Article 100(b)/83 EPC was directed nor the line of argument supporting this objection has in any way changed since the objection

was raised for the first time in the opposition proceedings. Consequently, the objection still suffers from a lack of *prima facie* relevance, for the reasons given in point 7.20 above.

7.25 Exercising its discretion under Article 12(4) RPBA, the Board thus decided not to admit the objection under Article 100(b)/83 EPC into the appeal proceedings.

8. Auxiliary request 3 - Article 54 EPC

8.1 Claim 1 requires that a steel strip having a tensile strength of 980 MPa or more is temper rolled in a roll stand with work rolls having a center-line averaged roughness R_a in the range of 3.0 to 10.0 μm .

D1c relates to steel strips having a tensile strength of 780 MPa or more (see paragraph [0015]). According to certain embodiments of D1, the steel strips can have a tensile strength of 980 MPa (see paragraph [0060] of D1c) or even 1023-1045 MPa (see paragraph [0024] of D1c). Moreover, paragraph [0046] of D1c discloses that the work rolls for temper rolling the steel strips can have a center-line averaged roughness R_a in the range of 1.0 to 4.0 μm .

However, D1c does not disclose that for the steel strips having a tensile strength of 980 MPa or more, the work rolls for temper rolling have a center-line averaged roughness R_a of 3.0 μm or more.

Therefore, two selections are required from the various ranges disclosed in D1c to arrive at the subject-matter of claim 1 of auxiliary request 3. First, a steel strip having a tensile strength of 980 MPa or more needs to be selected. Second, the upper limit of the center-line

averaged roughness R_a of the work roll has to be selected to be in the range from 3.0 to 4.0 μm .

No pointer and no teaching can be found in the general part of the specification of D1c which leads to the conclusion that a skilled person considering the disclosure of D1c would undoubtedly and inevitably perform both selections or work within both overlapping ranges at the same time. The examples of D1c even discourage this since all the examples relating to steel strips having a tensile strength of 980 MPa or more (examples 3, 7, 9, 10, 17 and 18) are rolled using work rolls having a center-line averaged roughness R_a of only 1.8 μm .

The subject-matter of claim 1 therefore differs from the disclosure in paragraph [0046] of D1c in that a steel strip having a tensile strength of 980 MPa or more is temper rolled with work rolls having a center-line averaged roughness R_a in the range of 3.0 to 10.0 μm .

- 8.2 The appellant argued that claim 1 lacked novelty since the steel strip discussed by paragraph [0046] could have the required tensile strength, as evidenced by various examples of D1c; see column "YS" of Tables 2 and 3 of D1.

This argument is not convincing.

- 8.2.1 For the assessment of novelty, the content of a document must not be treated as something in the nature of a reservoir from which features pertaining to separate embodiments may permissibly be drawn in order to create artificially a particular embodiment which

would destroy novelty; see Case Law of the Boards of Appeal, 10th edition, 2022, chapter I.C.4.2.

Hence, in the case in hand it is not permitted to combine the embodiment described in the general part of the description with the individual embodiments provided by the examples and cherry pick the required parameters to arrive at the subject-matter of claim 1.

8.3 The Board therefore concludes that the subject-matter of claim 1 is novel over D1 and that auxiliary request 3 fulfils the requirements of Article 54 EPC.

9. Auxiliary request 3 - Article 56 EPC

9.1 The opposition division concluded in point II.4 of the contested decision that the objective technical problem to be solved by the patent was to provide a method for manufacturing a high tensile strength cold-rolled steel sheet which does not place a burden on temper rolling. Furthermore, the subject-matter of claim 1 of the main request was considered not obvious in view of D1c because D1c did not disclose that increasing the center-line averaged roughness R_a of the work roll of the temper rolling mill to 3.0 to 10.0 μm made it possible to reduce the temper rolling load for high tensile strength steel strips.

The Board sees no reason to deviate from this conclusion since the identified objective technical problem is based on the technical effect disclosed in the patent (see in particular paragraphs [0016] and [0097] of the patent and Figure 8), which has not been disputed by the appellant and which is not known from D1c.

9.2 The appellant pointed out that D1c disclosed all the method steps and parameters of claim 1 (hot rolling in paragraph [0038], cold rolling in paragraph [0039], annealing in paragraph [0043], quenching in paragraphs [0044] and [0057], center-line averaged roughness R_a of 1.0 to 4.0 μm in paragraph [0046], tensile strength in Tables 2 and 3, steel compositions C, G, I, J, Q and R of examples 3, 7, 9, 10, 17 and 18). It further argued that starting from example 23 (composition A) it was obvious to increase the center-line roughness R_a from 2.9 to 3 μm or more in order to provide an alternative method of temper rolling high-

strength steel having a tensile strength of 980 MPa or more.

This argument is not convincing.

- 9.2.1 Even if the Board were to accept the appellant's argument that D1 discloses the general method steps of cold/hot rolling, annealing, quenching and tempering, D1 does not provide any pointer that a higher center-line averaged roughness R_a of the work roll of the temper rolling mill makes it possible to reduce the load required for temper rolling high-strength steel having a tensile strength of 980 MPa or more (see paragraph [0019] and Figures 6 and 8 of the patent).

Starting from the examples of D1, the skilled person was not prompted first to select the rolling conditions according to example 23 (used for temper rolling a steel strip having a tensile strength of 881 MPa) when temper rolling a steel strip having an even higher tensile strength of 980 MPa or more, and second to further increase the center-line averaged roughness R_a of the work roll of the temper rolling mill to 3.0 to 10.0 μm in order to reduce the temper rolling load.

- 9.2.2 Focusing on steel strips having a tensile strength of 980 MPa or more, the skilled person would instead focus on examples of D1c in which this kind of steel strip is temper rolled, such as examples 3, 7, 9, 10, 17 and 18 (steel compositions C, G, I, J, Q and R). However, in this case too, neither the examples of D1c nor the general disclosure in paragraph [0046] of D1c provide any motivation to increase the center-line averaged roughness R_a of the work roll of the temper rolling mill from 1.8 μm to 3.0 to 10.0 μm in order to reduce the temper rolling load.

9.2.3 Moreover, D2 does not provide any prompt towards the required modifications of the method according to D1. D2 does not teach that the temper rolling load is dependent on the center-line averaged roughness R_a . Rather, D2 discloses, in the last paragraph on page 414 by reference to Figure 43, different roughness values of re-rolled strips for different strip thicknesses and for different rolling pressures with the corresponding re-rolling degrees as a function of the roll roughness. D2 is silent on the influence of roll roughness on the required rolling load.

9.3 During the oral proceedings before the Board, the appellant for the first time raised an argument starting from example 3 of D1c, focusing on the objective technical problem as set out in point II.4 of the contested decision: "to provide a method for manufacturing a high tensile-strength cold rolled steel sheet which does not place a burden on temper rolling".

The appellant argued that the effect demonstrated in Figure 8 of the patent was easily explained by the physics underlying the rolling process, and so the solution as defined by claim 1 was obvious for the skilled person to solve the problem as set out in the contested decision.

9.4 The Board decided not to admit this late-filed argument, exercising its discretion under Article 13(2) RPBA, for the following reasons.

9.4.1 Article 13(2) RPBA stipulates that any amendment to a party's appeal case made after notification of a communication under Article 15(1) RPBA is, in principle, not to be taken into account unless there

are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

The appellant asserted that the arguments presented in the communication under Article 15(1) RPBA created exceptional circumstances which justified the submission of new arguments.

This is not the case.

- 9.4.2 In its communication under Article 15(1) RPBA, the Board informed the parties of its preliminary view that the formulation of the objective technical problem as set out in point II.4 of the contested decision was correct in light of the arguments presented by the respondent in point 35 of the reply to the statement of grounds of appeal.

Therefore, the Board's communication did not create a new situation for the appellant, so it did not create exceptional circumstances justifying the filing of new arguments.

- 9.4.3 Regarding the subject-matter of claim 1 of auxiliary request 3, which corresponds to the subject-matter of claim 5 as granted, the Board also questioned whether there was any motivation to select example 23 of D1 as the starting point when aiming at a temper rolling method for a steel strip having a tensile strength of 980 MPa or more.

This argument presented by the Board also does not provide justification for providing a new case based on the alleged physics underlying the rolling process.

In point VI.4 (in relation to claim 5 as granted) and point VII.3 (in relation to auxiliary requests 3 and 4 in general) of its statement setting out the grounds of appeal, the appellant had simply relied on the inventive-step attack raised against the main request on the basis of example 23 of D1c without taking into account the additional features added to the wording of claim 1 of auxiliary request 3. The Board's preliminary view that this line of argument was not convincing and that the features added on the basis of claim 5 as granted should be taken into account could not have come as a surprise for the appellant. On the contrary, the appellant could and should already have addressed those features in its statement setting out the grounds of appeal in relation to the corresponding dependent claim 5 as granted, or at the latest in response to the respondent's reply to the statement of grounds of appeal.

- 9.4.4 Even if it were accepted in the appellant's favour that the choice of an alternative example in D1c as the starting point could be an appropriate reaction to the arguments presented in the Board's communication (see point 18.3: the skilled person would start from any of examples 3, 7, 9, 10, 17 and 18 rather than example 23), this does not provide justification for providing a completely new technical argument.

The line of argument presented in point II.4 of the contested decision relates to the disclosure of D1 in general and is not limited by the selection of a specific example as the starting point. Therefore, selecting a specific alternative example from D1c does not justify providing a new argument concerning the technical effect discussed in the patent and why this effect was obvious to the person skilled in the art on

the basis of new technical arguments and alleged general knowledge about basic physics that had never been invoked before.

Nor are exceptional circumstances created merely because the Board in its preliminary opinion did not agree with the appellant's argument on the basis of example 23 and instead took account of the technical effect that was illustrated in Figure 8 of the patent and taken as the basis for the objective technical problem as set out in paragraph [0016] of the patent; this effect had formed the basis for the reasoning regarding inventive step in point II.4 of the contested decision - and for the respondent's arguments throughout the proceedings.

- 9.4.5 The case in hand is aggravated by the fact that the change of argument was not presented in due time, i.e. in response to the respondent's reply to the appeal or at least shortly after the Board's communication dated 29 May 2024, but only at the latest moment during the oral proceedings before the Board on 14 January 2025. The respondent and the Board were thus not given sufficient time to duly evaluate the new technical argument and - in the respondent's case - provide appropriate counterarguments.
- 9.4.6 The appellant further argued that D2, which had already been discussed in the statement of grounds of appeal, also supported the new line of argument.

This argument is not convincing either.

As discussed above, D2 discloses, on page 414 by reference to Figure 43, different roughness values of re-rolled strips for different strip thicknesses and

for different rolling pressures with the corresponding re-rolling degrees as a function of the roll roughness. D2 is silent on the influence of the roll roughness on the required rolling load for a particular elongation percentage ("Dressiergrad") or sheet thickness and therefore does not *prima facie* support the appellant's new argument.

- 9.5 In view of the above, the Board therefore concludes that auxiliary request 3 fulfils the requirements of Article 56 EPC.

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 as amended in the following version:
 - claims 1-15 of auxiliary request 3 filed with the reply, dated 6 November 2023, to the statement of grounds of appeal
 - description pages 2, 5, 7-9 and 13 of the patent specification and pages 3, 4, 6 and 10-12 as filed during the oral proceedings before the Board on 14 January 2025
 - drawings 1-11 of the patent specification

The Registrar:

The Chairman:



C. Spira

C. Herberhold

Decision electronically authenticated