

Internal distribution code:

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

**Datasheet for the decision
of 9 July 2025**

Case Number: T 0863/23 - 3.3.03

Application Number: 16745715.9

Publication Number: 3328901

IPC: C08B37/00, C08L5/00, A23L29/25,
A23L2/52

Language of the proceedings: EN

Title of invention:
GUM ARABIC FROM ACACIA SEYAL

Patent Proprietor:
Döhler GmbH

Opponents:
ADM WILD Europe GmbH & Co. KG
FRKelly

Relevant legal provisions:
EPC Art. 123(2), 84, 111(1)

Keyword:

Amendments - extension beyond the content of the application as filed (yes)

Product-by-process feature - clarity of the claimed product (no)

New auxiliary request submitted with statement of grounds of appeal - admitted (yes)

New auxiliary request submitted after notification of a communication under Art 15(1) RPBA - mere deletion of claims - admitted (yes)

Decisions cited:

G 0002/10, G 0003/14, G 0001/16, T 2920/18, T 2295/19



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 0863/23 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 9 July 2025

Appellant: Döhler GmbH
(Patent Proprietor) Riedstrasse 7-9
64295 Darmstadt (DE)

Representative: dompatent von Kreisler Selting Werner -
Partnerschaft von Patent- und Rechtsanwälten mbB
Deichmannhaus am Dom
Bahnhofsvorplatz 1
50667 Köln (DE)

Respondent 1: ADM WILD Europe GmbH & Co. KG
(Opponent 1) Rudolf-Wild-Straße 107-115
69214 Eppelheim (DE)

Representative: Grünecker Patent- und Rechtsanwälte
PartG mbB
Leopoldstraße 4
80802 München (DE)

Respondent 2: FRKelly
(Opponent 2) 27 Clyde Road
Ballsbridge
D04 F838 Dublin (IE)

Representative: Bird & Bird Società tra Avvocati S.r.l.
Via Porlezza, 12
20123 Milano (IT)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
3 March 2023 concerning maintenance of the
European Patent No. 3328901 in amended form.**

Composition of the Board:

| | |
|-----------------|---------------|
| Chairman | D. Semino |
| Members: | F. Rousseau |
| | L. Basterreix |

Summary of Facts and Submissions

- I. The appeal lies from the interlocutory decision of the opposition division according to which European patent No. 3 328 901 as amended according to the claims of auxiliary request V submitted during the oral proceedings on 7 February 2023 and a description adapted thereto met the requirements of the EPC. The decision was also based on a main request submitted with letter of 4 November 2020, auxiliary requests I to III submitted with letter of 7 December 2022 and an auxiliary request IV also submitted during the oral proceedings.
- II. As far as relevant to the present case, the following conclusions were reached in the decision under appeal:
- (a) Claims 5, 8 and 11 of the main request did not meet the requirements of Article 123(2) EPC.
 - (b) Claim 1 of auxiliary request IV submitted during the oral proceedings was a product-by-process claim which did not meet *prima facie* the requirements of Article 84 EPC. It was therefore not admitted into the proceedings.
 - (c) The claims of auxiliary request V and the adapted description thereto met the requirements of the EPC.
- III. The patent proprietor (appellant) filed an appeal against the above decision.

- IV. Together with the statement of grounds of appeal the appellant filed three sets of claims as auxiliary requests IV to VI.
- V. Opponent 2 (respondent 2) reply to the statement of grounds of appeal of the appellant. Opponent 1 (respondent 1) did not file written submissions concerning the substance of the case.
- VI. The parties were summoned to oral proceedings and a communication pursuant to Article 15(1) RPBA was then issued by the Board.
- VII. With letter of 13 June 2025 the appellant filed an additional set of claims as auxiliary request IVa.
- VIII. Oral proceedings were held on 9 July 2025 in the presence of all parties.
- IX. The final requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request submitted with letter of 4 November 2020, alternatively, in this order, on the basis of auxiliary request IV submitted with the statement of grounds of appeal, auxiliary request IVa submitted with letter of 13 June 2025, auxiliary requests I to III submitted with letter of 7 December 2022 or auxiliary request V and VI submitted with the statement of grounds of appeal.

Respondents 1 and 2 requested that the appeal be dismissed.

X. The claims relevant to the present decision read as follows:

Main request (submitted with letter of 4 November 2020)

Claims 5, 8 and 11 which read:

"5. A process for improving gum arabic comprising the steps of

- providing gum arabic
- preparing a dispersion of gum arabic
- adding a phenol source selected from bark, polyphenols and gallic acid, wherein the improved gum arabic has improved emulsification performance.

8. A composition comprising

- gum arabic
- an added phenol source selected from bark, polyphenols and gallic acid, wherein the ratio (w/w) of gum arabic:phenol source is 100:1 to 100:5.

11. A method for improving gum arabic of *acacia senegal* comprising the step of:

- combining gum arabic of *acacia seyal* with gum arabic of *acacia senegal*, wherein the improved gum arabic has improved emulsification performance."

Auxiliary request IV (submitted with the statement of grounds of appeal)

"8. A composition comprising

- gum arabic

- an added phenol source selected from bark,
polyphenols and gallic acid,

obtainable by a process comprising the steps of

- providing gum arabic
- preparing a dispersion of gum arabic
- adding a phenol source selected from bark,
polyphenols and gallic acid,
wherein the ratio (w/w) of gum arabic:phenol source is
100:1 to 100:5."

Auxiliary request IVa (submitted with letter of 13 June 2025)

The claims of auxiliary request IVa correspond to those of the main request and auxiliary request IV in which claims 8 to 10 have been deleted and the numbering of the remaining claims, as well as the reference therein to other claims, has been adapted accordingly.

XI. The parties' arguments, in so far as they are pertinent for the present decision, may be derived from the reasons for the decision below. They were directed to the following issues:

(a) The question whether claims 5, 8 and 11 of the main request extended beyond the content of the application as filed.

(b) Admittance of auxiliary requests IV and the question whether its claim 8 met the requirements of clarity.

(c) Admittance of auxiliary request IVa and remittal to the opposition division for further prosecution.

Reasons for the Decision

Main request

Article 123 (2) EPC

1. In accordance with the established Case Law of the Boards of Appeal of the EPO, the relevant question to be decided in assessing whether the subject-matter of an amended claim extends beyond the content of the application as filed, is whether after the amendment the skilled person is presented with new technical information (see G 2/10, point 4.5.1 of the Reasons and Case Law of the Boards of Appeal of the EPO, 11th edition 2025, hereafter Case Law, II.E.1.3.1). In other words, the above mentioned amendment is only allowable if the skilled person would derive the resulting claimed subject-matter directly and unambiguously, using common general knowledge and seen objectively and relative to the filing date, from the whole of the documents of the application as filed. This test referred to as the "gold standard" was confirmed in the context of disclosed disclaimers in decision G 1/16 (points 17 and 18 of the Reasons).

Whether new technical information results from an amendment requires a technical assessment of the overall technical circumstances of the individual case under consideration, taking into account the nature and extent of the disclosure in the application as filed.

Claims 5 and 11

2. Claims 5 and 11 of the main request correspond to claims 5 and 11 of the application as filed, respectively, in which the feature "*wherein the improved gum arabic has improved emulsification performance*" has been inserted.

The opposition division decided that this feature was not disclosed in the context of claims 5 and 11 as filed. In the opposition division's opinion the only disclosure thereof in the application as originally filed was in claim 1, which however concerned a totally different context as regards the particular type of starting material and the different physical steps undergone by said starting material (appealed decision, page 7, second, third and fourth full paragraphs and page 8, penultimate paragraph). The appellant's argument that the improvement of emulsification performance was addressed in the presentation of the background art and in the experimental part of the application as filed did not convince. Those passages were not linked to the subject-matter of claims 5 and 11 as filed in a direct and unambiguous manner and the properties achieved in the examples for a specific combination of features could not be applied to any embodiments falling under the scope of claims 5 and 11 (appealed decision, page 10, two last paragraphs and first paragraph of page 11). The subject-matter of claims 5 and 11 was therefore seen as an unallowable intermediate generalisation.

- 2.1 Having regard to the principles recalled in point 1 above, the key question is whether taking into account common general knowledge and the whole of the documents of the application as filed, the skilled person would objectively consider that the wording "for improving gum arabic" present in claims 5 and 11 as filed

directly and unambiguously refers to an improvement of the emulsification performance of gum arabic.

In this regard, taking into account the whole content of the application as filed means considering not only the features of its claims 5 and 11, but the context of the invention defined by each of these claims, as depicted in the description. It possibly includes even if not expressly stated as such, the description of the technical problem and its solution, or any advantageous effects of the invention with reference to the background art indicated in the description whose purpose is to understand the invention (Rule 42(1)(b) and (c) EPC).

- 2.2 In the case at stake, the field of the invention is defined on page 1, lines 1-2 to relate to gum arabic, methods of improving the properties of gum arabic and uses of gum arabic.

The next section "Background of the invention" describes the meaning of the term gum arabic (acacia gum), its origin, its principal species (*Acacia senegal* and *Acacia seyal*) and their use as emulsifier.

It reports on the scientific literature concerning the components of *Acacia senegal* and *Acacia seyal*, in particular their three major components (arabinogalactan-protein (AGP), arabinogalactan (AG), and glycoprotein (GP)) and the role of some of these components in the emulsifying ability of gum arabic (passage starting with the second paragraph on page 1 and ending on page 3, antepenultimate paragraph).

The first paragraph on page 4, which is to be read in the light of the two last paragraphs of page 3, makes

it clear that there is an inconsistency in the emulsification performance of gum arabic in general. It is reported to be partially due to variation in the proportion of said three major components, which originates from the natural variability of these components in the source of gum arabic.

The rest of the section "Background of the invention" reports on physical or chemical treatments of gum arabic to achieve higher emulsifying abilities, as detailed in the patent literature. According to the paragraph bridging pages 4 and 5, higher emulsifying ability is expressed in the form of smaller oil droplet diameters in gum arabic stabilized oil-in-water emulsions.

To sum up, the only properties of gum arabic that are addressed in the section "Background of the invention" concern its emulsification performance.

2.3 The next section of the application as filed concerns the summary of the invention (pages 5 to 7). The various embodiments described in this summary essentially correspond to those defined in the claimed invention. According to the first paragraph of this section, *"it is one object of the invention to provide methods to prepare preparations of arabic gum from acacia seyal preferably preparations having improved properties"*. The only use described for the compositions of the present invention in this part of the application is for making emulsions (page 7, third to sixth paragraphs).

2.4 The application as filed describes in the second paragraph of page 11 how the emulsification performance of the emulsions prepared in the examples is evaluated.

The first sentence of that paragraph reads as follows:
"Emulsification: The emulsification performance of the various acacia seyal samples as well as acacia senegal and mixes thereof were evaluated in a typical oil-in-water emulsion as described below." According to the test method the initial droplet size is measured immediately after preparing the emulsions and the droplet size is measured again after storing the emulsions at ambient temperature and at 60°C (accelerated stress test) for 3 and 7 days.

This is in line with the description of the examples, in which the performance of the gum arabic samples prepared was tested by measuring the droplet size for fresh emulsion and in an accelerated test (see Example 1, pages 11 to 14 and Figures 2 to 5; Example 2, page 16, first paragraph and Figure 7; Example 3, page 17, first full paragraph and Figure 9; Example 4, page 18, first full paragraph, paragraph bridging pages 18 and 19, page 20, first paragraph and Figures 10a to 10c, 12a and 12b; Example 5, paragraph bridging pages 22 and 23 and Figure 13; Example 6, page 24, first and second paragraphs and Figures 14 and 15).

Accordingly, the application as filed does not only disclose in a direct and unambiguous manner that the purpose of the invention is to improve the "emulsification performance" of gum arabic, but also that both the ability to form the initial emulsion and its stability fall under the term "emulsification performance".

- 2.5 Furthermore, in these examples, the improvement in emulsification performance is correlated with:
- the tannin content (gallic acid equivalent) present in acacia seyal gum (Example 1),

- the increase in total tannin content obtained by addition of acacia seyal ground bark (as a source of tannin, more specifically hydrolysable tannin) to an acacia seyal gum solution, which is associated with an increase of the molecular weight of the whole gum (Example 2), or the increase of the total polyphenol content obtained by addition of extract from olive leaf as another source of polyphenol, also associated with an increase of the molecular weight of the whole gum (Example 2),
- the addition of acacia seyal bark as a source of soluble tannin (hydrolysable tannin) which is the source of polyphenolic compounds or of gallic acid (which is also a polyphenolic compound), also associated with an increase of the molecular weight of the whole gum (Examples 3 and 4).

This means that the components added as a phenol source in accordance with claim 5 are the ones which lead to an improvement in emulsification performance in the examples of the application as filed. In the Board's view, this confirms the implicit disclosure that the term "improving" in claim 5 of the application as filed refers to an improvement in the emulsification performance.

2.6 Regarding Examples 5 and 6, these examples concern various combinations of gum arabic of acacia seyal with gum arabic of acacia senegal whose emulsification performance is reported. On that basis, the skilled person also finds confirmation in the experimental part of the application as filed, that the term "improving" in claim 11 of the application as filed, concerning the combined use of gum arabic of acacia seyal and gum arabic of acacia senegal, also refers to an improvement in emulsification performance.

2.7 Consequently, the insertion into claims 5 and 11 of the application as filed of the feature "*wherein the improved gum arabic has improved emulsification performance*" does not result in the skilled person being presented with new technical information.

2.8 The respondent 2 brought forward at the oral proceedings that the term "emulsification performance" as used in the application as filed would only relate to the ability to form the emulsion, the emulsion stability constituting an additional property of the gum arabic which should be improved. Moreover, the present invention would also aim at improving the Gardner colour. As a consequence, the improvement addressed in claims 5 and 11 of the application as filed was not directly and unambiguously disclosed to concern the ability of gum arabic to form the emulsion.

This, in the opinion of respondent 2, would be illustrated in the passages of the application as filed specifically addressing the formation of the initial emulsion (page 3, first full paragraph; page 16, first paragraph; page 24, paragraph preceding Example 7), the improvement of the colour Gardner index (page 5 and Table 5 on page 21), and the stability performance (page 13, first full paragraph).

This is not convincing.

The objection of respondent 2 is based on the underlying argument that the term "emulsification performance", as used in operative claims 5 and 11, is ambiguous and requires interpretation. It is, however, uncontested that in view of the ruling of G 3/14 operative claims 5 and 11, which correspond to granted

claims 5 and 11, cannot be objected for a lack of clarity of that term.

The appellant, however, does not seek to amend the term "emulsification performance" to overcome a clarity objection by specifying the meaning to be attributed to that term. In other words, that term has not been replaced by a different definition whose basis in the application as filed has to be assessed. The question to be answered is rather whether the insertion into claims 5 and 11 of the application as filed of the feature "*wherein the improved gum arabic has improved emulsification performance*" results in new technical information, which the Board answers in the negative, having regard in particular to the disclosure in the second paragraph of page 11 of the application as filed (see point 2.4 above).

Furthermore, even if the term "*emulsification performance*" needed to be construed, the Board would not come to a different conclusion for the following reasons:

As already indicated above the first sentence in the second paragraph of page 11 described that the property tested in the examples is the emulsification performance of the various acacia seyal samples as well as acacia senegal and mixes thereof which includes both aspects of the ability to form the emulsion and its stability, which is assessed by measuring the size of the droplet in the initial emulsion and after accelerated storage (see point 2.4 above).

Moreover, as pointed out by the appellant, it is evident for the skilled reader that the ultimate objective of the present invention is to obtain

stability of the gum arabic based emulsion, which is illustrated in the first full paragraph of page 3 referred to by respondent 2 in which it is stated that "*Senegal type gives high levels of functionality in formation and stability of emulsions and micro-encapsulation of flavours, and plays a very important role in the food and beverage industries*". This however requires in a first step the ability to form the emulsion. In other words, if the emulsification ability is poor, it is necessary true that the performance of the formed emulsion after storage is unsatisfactory. Accordingly, both aspects must be understood to fall under the term "emulsification performance" used in the application as filed.

2.9 As to the colour Gardner Index, it is described in the application as filed as an alternative to the tannin content (application as filed, page 5, 7th paragraph of the summary of the invention), which tannin content represents the "total phenols" and more accurately the "gallic acid equivalents" as gallic acid (application as filed, page 10, 4th paragraph). The colour Gardner Index is therefore not a property of the gum arabic to be improved by the process of claim 5 or the method of claim 11, but an expression of the amount of "total phenols" defined in term of "gallic acid equivalents".

2.10 In the reasons for the contested decision, the opposition division referred to the concept of intermediate generalisations, quoting section H-V 3.2.1 of the Guidelines for Examination at the EPO (hereafter Guidelines). However, the present case does not concern an intermediate generalisation. As shown above, the sole improvement addressed in the application as filed concerns the "emulsification performance". The issue at stake is not the isolation of a feature disclosed in

separate embodiments and the generalisation of its use with other features, as the opposition seems to have considered, but rather a specification of the term "improving" in claims 5 and 11, for which no other alternative emerges from the whole of the application as filed.

- 2.11 In view of the foregoing, the Board concludes that the subject-matter of claims 5 and 11 does not extend beyond the content of the application as filed. The requirements of Article 123(2) EPC are therefore complied with.

Claim 8

3. Claim 8 of the main request corresponds to claim 8 as filed, in which the feature "wherein the ratio (w/w) of gum arabic:phenol source is 100:1 to 100:5" has been inserted.

This feature is to be found in both claim 7 (dependent on process claim 5) and the fifth paragraph on page 6 of the application as filed. In both instances, it is disclosed in the context of a process for improving gum arabic comprising the steps of providing gum Arabic, preparing a dispersion of gum arabic and adding a phenol source.

The appellant merely argues that claim 8 as filed defines a product that is prepared by the method of claim 5, providing thereby a direct correlation between the features of these claims.

This is not convincing, as claim 8 does not refer to the process of claim 5 or recites all the process steps defined in said claim.

Claims 5 and 8 have in common the features that define the constituents gum arabic and a source of phenol selected from bark, polyphenols and gallic acid. However, these features of claim 5 are defined in the context of preparing a dispersion of gum arabic, whereby this limitation is not part of claim 8 as filed as the composition of claim 8 is not limited to a dispersion.

In view of that, the application as filed does not generally describe a composition comprising gum arabic and an added phenol source selected from bark, polyphenols and gallic acid, wherein the ratio (w/w) of gum arabic:phenol source is 100:1 to 100:5.

While it can be agreed with the appellant that such dispersions will be usually dried to obtain a product in its usual commercial form, the application as filed does not describe an additional step of drying the emulsion after its preparation or a dry product having the ratio (w/w) of gum arabic:phenol source in the range of 100:1 to 100:5. A dispersion is not a mere process operating condition which is no longer seen on the obtained product. It requires a distribution of particles of one material in a continuous phase of another material.

Therefore, the Board has no ground to overturn the decision of the opposition division according to which the subject-matter of claim 8 of the main request extends beyond the content of the application as filed.

On that basis, the main request, which comprises subject-matter that does not comply with the requirements of Article 123(2) EPC is not allowable.

Auxiliary request IV

Admittance

4. Auxiliary request IV is a new auxiliary request submitted with the statement of grounds of appeal which is therefore to be regarded as an amendment to the appellant's case within the meaning of Article 12(4) RPBA. Its admittance which is contested by respondent 2 is subject to the discretionary power of the Board in accordance with Article 12, paragraphs (4) to (6) RPBA.

Regarding the reasons for submitting that request in the appeal proceedings, the appellant drew attention to a change of opinion by the opposition division following the written preliminary opinion sent in preparation for the oral proceedings. It was acknowledged in this opinion that claim 8 of the main request met the requirements of Article 123(2) EPC.

While the members of an opposition division are free to change their minds at any point in the procedure, including during oral proceedings, as long as the requirements of Article 113(1) EPC are fulfilled, it is apparent that this change of opinion was prompted by a new objection raised for the first time about two months before the oral proceedings (see respondent 1's letter of 1 December 2022, page 3, second to sixth full paragraphs; respondent 2's letter of 7 December 2022, page 2, three last paragraphs).

In this regard, the claim request in question was filed in direct reply to the notices of opposition, but the respondents waited for more than two years to raise

this objection, providing no justification for its lateness.

Taking into account that the filing of this new auxiliary request IV constitutes a *bona fide* answer to counter the objection pursuant to Article 123(2) EPC against claim 8 of the main request, the Board takes the view that auxiliary request IV filed at the outset of the appeal proceedings in order to reply to a change of subject of the proceedings shortly before the oral proceedings should as a matter of fairness be admitted into the proceedings (Articles 12(4) and 12(6) RPBA).

In these circumstances, the question whether auxiliary request IV can overcome the objection raised under Article 123(2) EPC against the main request, or the objection for lack of clarity seemingly raised by the opposition division against claim 8 of the former auxiliary request IV is not a procedural, but a substantive matter, that must be dealt with separately from its admittance.

Article 84 EPC - claim 8

5. It is common ground that the subject-matter defined by claim 8 of auxiliary request IV was not part of the claims as granted. This claim corresponds to claim 8 as granted in which the following feature has been introduced:

"obtainable by a process comprising the steps of
- providing gum arabic
- preparing a dispersion of gum arabic
- adding a phenol source selected from bark, polyphenols and gallic acid, wherein the ratio (w/w) of gum arabic:phenol source is 100:1 to 100:5".

5.1 Accordingly, following the ruling of G 3/14, claim 8 of auxiliary request IV can be examined for compliance with the requirements of Article 84 EPC to the extent that the alleged non-compliance is the result of the aforementioned amendment.

Since the product of claim 8 is, at least partly, defined by a process for its production with said feature, claim 1 is a so-called product-by-process claim. In this regard, a product-by-process claim must fulfil the clarity requirement of Article 84 EPC, as must any other type of claim. Therefore, the subject-matter of that claim must be defined so that the public is not left in any doubt as to which subject-matter is covered and which is not (Case Law, II.A 1.1).

5.2 Concerning clarity of said product-by-process claim, whose wording is essentially the same as that of claim 1 of auxiliary request IV underlying the contested decision, the opposition division concluded that the requirements of clarity were not fulfilled for this seemingly identical claim, as the skilled person was not able to determine which identifiable and unambiguous technical features were imparted to the product by the process by which it is defined (see section bridging pages 19 and 20 of the decision). The opposition division also pointed out, referring to section F-IV, 4.12.1 of the Guidelines, that the burden of proof for an allegedly distinguishing "product-by-process" feature lies with the applicant, in this case the appellant (see decision, first part of page 19).

In relation to auxiliary request IV, the appellant merely stated that *"It appears that a slight rewording and maintaining process claim 5 would also address the*

objections to claim 8. Because of the product-by-process language, the features of process claim 7 are even more 'directly and unambiguously' linked to the composition claim" (statement of grounds of appeal, page 8, third paragraph). The appellant therefore only addressed the requirements of Article 123(2) EPC and not those of Article 84 EPC, the latter of which the opposition division found not to be complied with in view of the "product-by-process" feature.

The Board has no reason to have a different opinion, since this process feature does not impart a clear definition of the amount of polyphenols comprised in the composition. This is because gum arabic comprises polyphenols present in tannin, the content of which is subject to natural variations (application as filed, Example 1, page 13, last paragraph). Moreover, the definition of the process feature in operative claim 8 is openly defined, so that such a broad definition of a process cannot impart identifiable and unambiguous technical features to the composition defined in claim 8.

- 5.3 In view of the foregoing, the Board concludes that claim 8 of auxiliary request IV lacks clarity, contrary to the requirements set out in Article 84 EPC.

Auxiliary request IVa

Admittance

6. The admittance of auxiliary request IVa which was submitted after notification of the Board's communication under Article 15 (1) is subject to the provisions of Article 13(2) RPBA. Pursuant to Article 13(2) RPBA, any amendment to a party's appeal case made

after notification of a communication under Article 15 (1) RPBA, shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

- 6.1 The amendments comprised in auxiliary request IVa consist in the deletion in both auxiliary request IV and the main request of claims 8 to 10, whereby the numbering of the remaining claims and the reference therein to other claims has been adapted accordingly.

Consequently, the deletion of these claims 8 to 10 overcome the objections according to which claim 8 of the main request extends beyond the content of the application as filed and claim 8 of auxiliary request IV lacks clarity, without giving rise to any new issues, since the other claims of these requests remain unamended.

This, in the Board's opinion, constitutes cogent reasons justifying exceptional circumstances in the sense of Article 13(2) RPBA 2020 (Case Law, V.A.4.5.4 j), see e.g T 2295/19, Reasons 3.4.1 to 3.4.14 and T 2920/18, Reasons 3.1 to 3.16).

- 6.2 Respondent 2 was of the opinion that auxiliary request IVa should not be admitted, since it would result in the case being remitted to the opposition division for further prosecution, which would be detrimental to procedural economy. Moreover, it could be seen at first glance that the subject-matter defined in its claim 1 lacked novelty over each of D1 to D4, meaning that the filing of auxiliary request IVa did not simplify the case.

This is not convincing. The need for remitting the case to the first instance would not be caused by the amendment with respect to the main request, corresponding to the main request underlying the contested decision, or to auxiliary request IV, but by the absence of substantive examination before the opposition division of the subject-matter of claims 1 to 8 defined in auxiliary request IVa. This, despite the fact that these claims were already part of the main request, forming the basis for the contested decision, and the substantive issues in the present case had already been raised by the respondents before the opposition division.

In the Board's opinion, the appellant should not be penalized by the course of action in opposition proceedings, in which not all issues raised by the respondents were dealt with, let alone any of the issues concerning independent claim 1 for which no formal objections had been raised.

Moreover, the Board fails to see a manifest lack of novelty on the basis of the submissions in appeal of respondent 2, who in this respect only generically referred to multiple submissions in opposition (see rejoinder of respondent 2, page 6, section "Novelty - Art. 54 and 100(a) EPC").

6.3 Auxiliary request IVa is thus taken into account.

Remittal

7. The sole remaining objections to be decided in respect of auxiliary request IVa concern the grounds for opposition of lack of novelty and lack of an inventive step against present claims 1 to 8, corresponding to

claims 1 to 8 of the main request underlying the contested decision.

Whereas the appellant requested that the case be remitted to the opposition division if auxiliary request IVa was found to meet the requirements of Articles 123(2) and 84 EPC, respondent 2 requested that novelty of auxiliary request IVa be discussed on appeal before remittal to the opposition division was ordered.

In their reply to the statement of grounds of appeal, respondent 2 reiterated the objections regarding novelty and inventive step that had previously been raised before the opposition division, referring generally to the written submissions before the opposition division or to the latter's preliminary opinion sent in preparation for the oral proceedings.

However, the opposition division did not decide on these submissions, in particular the objection regarding novelty of the subject-matter of claim 1 over D1 to D4 (see point 6.2 above), nor were they debated at the oral proceedings.

This is seen by the Board to constitute "special reasons" within the meaning of Article 11 RPBA to remit the case for further prosecution to the department whose decision was appealed.

Accordingly, exercising its discretion under Article 111(1), second sentence, EPC, the Board decides to remit the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



D. Hampe

D. Semino

Decision electronically authenticated