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**Datasheet for the decision
of 18 December 2025**

Case Number: T 1296/23 - 3.5.06

Application Number: 14864703.5

Publication Number: 3071273

IPC: A61M11/04, A61M15/06,
A24F40/00, G16H40/63

Language of the proceedings: EN

Title of invention:

DEVICE, METHOD AND SYSTEM FOR LOGGING SMOKING DATA

Patent Proprietor:

Fontem Ventures B.V.

Opponent:

Nicoventures Trading Limited

Headword:

Puff count/FONTEM

Relevant legal provisions:

EPC Art. 100(c), 100(a), 123(2), 54, 56, 113(1)

RPBA 2020 Art. 12, 13

EPC R. 106

Keyword:

Inventive step - (no)

Amendment to case - admitted (no)

Decisions cited:

T 1309/16, T 1943/16, R 0016/13

Catchword:

Requests filed during the first-instance proceedings on which the department of first instance took no decision are not automatically part of the appeal proceedings.



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Case Number: T 1296/23 - 3.5.06

D E C I S I O N
of Technical Board of Appeal 3.5.06
of 18 December 2025

Appellant: Nicoventures Trading Limited
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
3 April 2023 concerning maintenance of the
European Patent No. 3071273 in amended form.**

Composition of the Board:

Chairman M. Müller
Members: G. Zucka
B. Müller

Summary of Facts and Submissions

- I. The appeal is against the interlocutory decision by the opposition division, dispatched with reasons on 3 April 2023, to maintain the patent with application number 14864703.5 in amended form on the basis of auxiliary request 2.
- II. The following documents cited during the first instance proceedings are referred to in the present decision:

D2: US 2012/048266 A1;
D4: US 2004/031497 A1.
- III. A notice of appeal was received on 9 June 2023, the appeal fee being paid on the same day. A statement of grounds of appeal was received on 11 August 2023.
- IV. The appellant (opponent, Nicoventures Trading Limited) requested that the decision under appeal be set aside and the patent be revoked.
- V. The respondent (proprietor, Fontem Ventures B.V.) filed a response on 7 December 2023. It made no express requests but, as it countered the appellant's arguments why the patent as maintained according to the appealed interlocutory decision did not comply with the EPC, the board took the respondent to request that the appeal be dismissed and the patent thus be maintained on the basis of the claims of "auxiliary request 2" filed with the proprietor's letter dated 23 December 2022.
- VI. On 5 June 2025, the board issued a summons to oral proceedings, with an annex setting out its preliminary opinion.

VII. After discussion of auxiliary request 2 at the oral proceedings before the board, the respondent declared that its request was that

- the appeal be dismissed, in the alternative
- the patent be maintained on the basis of the claims according to auxiliary requests 3 to 9, all filed with the letter dated 23 December 2022 or
- the case be remitted to the Opposition Division for further prosecution.

VIII. The appellant confirmed its request that the decision under appeal be set aside and the patent be revoked.

IX. Claim 1 of the patent as maintained by the interlocutory decision of the opposition division reads as follows:

"A method of logging smoking data, the method comprising:

 sending a first signal indicating that a puff has been initiated;

 receiving the first signal that a puff has been initiated by a data logging device;

 storing a first time incident in a memory by the data logging device;

 sending a second signal indicating that the puff has stopped;

 storing a second time incident in the memory by the data logging device; and

 determining a puff duration using the first time incident and the second time incident,

characterized in that the steps are repeated at least one time, and further comprising the data logging device storing a puff count value in the memory, wherein the puff count value tracks the number of puffs

that have been taken on a particular battery or a device since the device has been manufactured, the number of puffs that have been taken on a particular battery since the last recharging, the number of puffs that have been taken since a new cartomizer has been connected to the battery."

- X. The wording of other claims is not relevant for the present decision.
- XI. At the end of the oral proceedings, the chairman announced the board's decision.

Reasons for the Decision

1. The patent

The patent relates to logging of smoking data (title). The patent's description does not mention any specific advantage of the particular logging method of claim 1 as compared to the prior art.

2. Insufficiency of disclosure

As set out in the summons to the oral proceedings before the board (point 11), the appellant, in its statement of grounds of appeal, had raised an objection of insufficiency of disclosure (Article 100(b) and 83 EPC).

The board does not consider it necessary to address that objection, as it is of the opinion that it was not

decisive for the outcome of the first-instance proceedings.

3. *Infringement of opponent's right to be heard;
Article 113(1) EPC*

3.1 The appellant submits (statement of grounds of appeal, paragraph spanning pages 29 and 30) that the reasoning of the appealed decision on inventive step is based on a (presumed) difference between the subject-matter of claim 1 and the disclosure of D2 which the opposition division had not presented during the oral proceedings, viz. that a number of puffs that have been taken since a particular event occurred is tracked (cf. the characterising part of claim 1). The appellant submits that its right to be heard was thereby infringed (Article 113(1) EPC).

3.2 The board points out that Article 113(1) EPC requires that the decisions of the European Patent Office (in the present case the appealed decision of the opposition division) may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. "Grounds or evidence" under Article 113(1) EPC are to be understood as meaning the essential legal and factual reasoning on which the decision is based. (See for instance R 16/13, reasons 3.3, and other decisions as cited in the "Case Law of the Boards of Appeal" of the EPO, 11th edition 2025, III.B.2.4.2).

The EPC, however, does not require that the opposition division announces its reason in advance of its decision. The EPC only requires that the parties had an opportunity to present their comments on all pertinent grounds or evidence that were placed on the table, be

it by the division or by a party (in this case by the proprietor).

- 3.3 According to the minutes of the oral proceedings before the opposition division (page 7, last paragraph), the proprietor (confusingly designated "OP") argued that with the device of D2 it would not be possible to measure the number of puffs since the device has been manufactured.

Further, in the proprietor's letter received on 23 December 2022 (paragraph spanning pages 9 and 10), it had set forth the fact that D2 did not disclose that the puff count value tracks the number of puffs that had been taken on a particular battery since the device had been manufactured, the number of puffs that had been taken on a particular battery since the last recharging, or the number of puffs that had been taken since a new cartomiser had been connected to the battery.

It therefore transpires that the asserted fact according to which the feature mentioned under 3.1 above is not disclosed by D2 was presented during the opposition proceedings and that the opponent had an opportunity to comment on this argument.

The board has, furthermore, no reason to assume that the opposition division did not consider any facts or arguments which the opponent may have provided to support the view that D2 does disclose the given feature. It is noted in this regard that the reasons for the appealed decision (point 27, second paragraph, last sentence) mention the opponent's submission "that the feature of the data logging device storing a puff count value tracking the number of puffs that have been

taken on a particular device since the device has been manufactured is disclosed in paragraph [0040]".

This indicates that the opponent presented during the oral proceedings a fact which can be considered to run counter to the proprietor's submission and that the opposition division took this asserted fact into account.

For this reason, the board wrote in its provisional opinion in the annex to the summons, which the appellant did not challenge in its response or during the oral proceedings, that the opponent's right to be heard has not been infringed.

The board now affirms this opinion.

4. *Admittance of facts and evidence based on the disclosure of document D4*
- 4.1 The opposition division decided not to admit the facts and evidence introduced by the opponent aiming to prove lack of novelty of the subject-matter of claim 1 of auxiliary request 2 in view of D4 (reasons for the appealed decision, point 22). It is implicit from the appealed decision that the non-admittance is based on Article 114(2) and Rule 116(1) EPC, following which late-filed facts or evidence may be disregarded by the opposition division.
- 4.2 The appellant submits that the non-admittance amounts to a substantial procedural violation warranting remittal to the opposition division and refund of the appeal fee (statement of grounds of appeal, paragraph before middle of page 11).

4.3 The board firstly observes that the opponent had, in its notice of opposition (page 18, second paragraph), introduced D4 only to demonstrate that it discloses in paragraph [0055] something which was considered common general knowledge, viz. the calculation of the length of a time interval by taking the difference between a first and a second time.

The reference by the opponent during the oral proceedings before the opposition division to passages in D4, most of which were not mentioned in the notice of opposition, amounts to a reference to new evidence to support a new allegation of fact, viz. that the document discloses all the features of claim 1. It therefore constitutes new facts and evidence, not a new argument, even if some passages in D4 had already been cited before. In this respect, it is noted that the appellant made reference to several decisions (statement of grounds of appeal, pages 11 to 14) only to establish why new arguments "are admissible at any time in the proceedings", i.e. should always be admitted.

4.4 Secondly, the opposition division indeed had discretion to disregard the submissions based on the new paragraphs of D4, and thus the new "attack". The board sees no reason why it should object to the exercise of this discretion, given that the opposition division considered the evidence not to be *prima facie* relevant for assessing the novelty of the claimed subject-matter (reasons for the appealed decision, page 9, first full paragraph).

4.5 The board from its side therefore sees no reason to overrule the opposition division and admit the citation of other passages from D4 into the appeal proceedings than those passages which had already been cited in the

notice of opposition, viz. paragraphs [0010] and [0055].

The board adds that the document *prima facie* at least does not disclose the feature of claim 1 according to which "the puff count value tracks the number of puffs that have been taken on a particular battery or a device since the device has been manufactured, the number of puffs that have been taken on a particular battery since the last recharging, [or] the number of puffs that have been taken since a new cartomizer has been connected to the battery".

Prima facie, D4 does not mention a battery or a cartomiser and nothing in the document suggests that, with the disclosed method, the manufacturing time of some "device" could somehow be taken into account: Even if a cigarette could be considered a "device", the measurement unit in D4 only has knowledge of the moment when the cigarette is placed in the holder, not of the moment when the cigarette was manufactured.

- 4.6 In keeping with the above finding, in the present decision the teaching of D4 is only taken into account insofar as the document discloses, in a context of collecting smoking data, the determination of a puff duration as a difference between two time incidents.
- 4.7 Consequently, the board finds no substantial procedural violation having taken place in the proceedings before the opposition division.
5. *Added subject-matter; Article 123(2) EPC*
- 5.1 The appellant submits (statement of grounds of appeal, page 2) that claims 1, 2 and 4 of auxiliary request 2

(i.e. of the patent as maintained in amended form in the interlocutory decision of the opposition division, where claims 1 to 9 correspond to the claims with the same numbers in the patent as granted) contain added subject-matter.

5.2 As regards claim 1, the board agrees with the assessment in the appealed decision (reasons 19) that it finds a basis in originally filed claim 8, claim 9 as dependent on claim 8, and the penultimate sentence in the original description paragraph [0066].

5.2.1 The appellant submits (statement of grounds of appeal, page 5, first two full paragraphs) that the wording "In one embodiment, the data logging device can increment a puff count value after each puff is recorded" in said paragraph [0066] implies that the paragraph only discloses that a puff count value is incremented after the puff has stopped.

The board does not agree. Rather, it points out that the wording cited by the appellant explicitly refers to one specific embodiment, which is covered by original claim 10. The higher-ranking claims are broader, which means that they do not comprise that embodiment. Hence, in general a puff count value increment (or storage) does not necessarily take place after a puff is recorded. Further, the statement in the penultimate sentence of [0066] that the puff count value tracks a number of puffs implies that the value is stored.

5.2.2 The board considers that, for the reader, said penultimate sentence "In various embodiments the puff count value can track the number of puffs that have been taken on a particular battery or device since the device has been manufactured, the number of puffs that

have been taken on a particular battery since the last recharging, the number of puffs that have been taken since a new cartomizer has been connected to the battery, or the number of puffs that have occurred since other events have taken place" is equivalent to the following:

In various embodiments the puff count value can track

- (a) the number of puffs that have been taken on a particular battery **since the battery has been manufactured, or**
- (b) **the number of puffs that have been taken on a particular** device since the device has been manufactured, **or**
- (c) the number of puffs that have been taken on a particular battery since the last recharging, **or**
- (d) the number of puffs that have been taken since a new cartomizer has been connected to the battery, or
- (e) the number of puffs that have occurred since other events have taken place.

This understanding, firstly, regarding list element (a), follows from the realisation by the skilled person that both par. [0066] and claim 1 use an incorrect wording: it should be evident that only the manufacturing time of the battery and not of the device can be used as a starting point for the number of puffs that have been taken on a particular battery. It is noted that the appellant also reads the feature in this manner (statement of grounds of appeal, page 8, first full paragraph).

Such understanding, secondly, follows from the generally accepted convention that the "or" before the last item in a list implies the presence of an "or"

between each of the elements of the list. In the present case, the "or" after list element (d) implies the presence of the "or" inserted in bold after list elements (b) and (c).

Following this convention, the insertion of the features of said sentence, leaving out alternative (e), into claim 1 should have produced the following wording:

"[...] the puff count value tracks the number of puffs that have been taken on a particular battery or a device since (respectively the battery or) the device has been manufactured, the number of puffs that have been taken on a particular battery since the last recharging, or the number of puffs that have been taken since a new cartomizer has been connected to the battery."

By leaving out this last "or", the proprietor introduced confusion in the wording of the claim. The board does not agree with the respondent's apparent position (letter received on 23 May 2024, page 4, third paragraph) that it would be an acceptable practice for an "or" that is intended to connect all elements in a list to be placed between any two elements of a list, let alone within a combined element, viz. (a)+(b).

However, contrary to what is submitted by the appellant (statement of grounds of appeal, pages 5 to 9), the board considers this to be an issue of clarity and not of added subject-matter. The skilled person will, after noticing that the claim contains a grammatical error, not come to a different conclusion than that the wording effectively says what it should have said as indicated above, if only because the wording "storing a

puff count value [...], wherein the puff count value tracks the number" (singular) implies that only one value representing one number of puffs is kept in memory.

5.2.3 The board, therefore, said in its provisional opinion in the annex to the summons, which was not challenged by the appellant in its response or during the oral proceedings, that claim 1 does not contain added subject-matter (Articles 100(c) and 123(2) EPC).

5.3 According to what the applicant stated in its letter received on 7 May 2018 (page 2, second paragraph), claim 2 should be based on originally filed claim 12.

Original claim 12 depended on original claim 11, which depended on original claim 10, which depended on original claim 8. None of those original claims disclose the device being a cartomiser; original claim 12 merely stated that "the defined event comprises a manufacture date of a cartomizer". In addition, original claim 10 required that a puff count value be incremented in memory after the puff has stopped, which feature has not been taken over in new claim 2, neither explicitly nor by virtue of its reference to claim 1.

Original claim 12, therefore, does not provide a basis for the new claim 2.

The board, however, accepts the respondent's argument (response to the statement of grounds of appeal, page 7, last paragraph) that the original description (paragraphs [0037] and [0042]) discloses a cartomiser as a component of an electronic cigarette for which smoking data is logged, hence as a possible instance of

the "device" on which a number of puffs have been taken in claim 1.

The board further considers that storing a puff count value tracking a number of puffs in memory amounts to the same as incrementing the puff count value in memory: Storing an updated value after the number of puffs has increased means that the stored value is somehow incremented, even without an increment operation building on a previous value being explicitly mentioned (cf. statement of grounds of appeal, page 4, paragraph before the middle of the page).

To give an example, assuming a variable *PuffCount* has at some moment the value 3, an increment of that value is not only achieved by the addition operation $PuffCount = PuffCount + n$. It is equally possible simply to assign the new incremented puff count value (which may have been determined by any means, even by a manual count) to the variable *PuffCount*, i.e. by the assignment $PuffCount = 4$, for instance.

The board therefore said in its provisional opinion in the annex to the summons, which was not challenged by the appellant in its response or during the oral proceedings, that claim 2 did not contain added subject-matter (Article 123(2) EPC).

- 5.4 The board is of the opinion that the original description [0066], last sentence, viz. "In yet other embodiments, the total duration of time that puffs have been taken can be tracked, recorded, and used by the data logging device", provides a basis for claim 4.

Contrary to what is submitted by the appellant (statement of grounds of appeal, paragraphs spanning

pages 10 and 11), the board holds that this sentence should be read together with the rest of the paragraph, as describing a feature that may be combined with other optional features mentioned in the paragraph, in particular in the preceding sentence, since tracking a duration of puffs does not exclude tracking their number.

The board therefore said in its provisional opinion in the annex to the summons, which was not challenged by the appellant in its response or during the oral proceedings, that claim 4 did not contain added subject-matter (Article 123(2) EPC).

5.5 The board affirms its preliminary opinions set out in points 5.2, 5.3 and 5.4 above. As a consequence, it cannot find added subject-matter in claim 1, which therefore complies with Article 123(2) EPC.

6. *Novelty over D2; Article 54 EPC*

6.1 D2 discloses a system for logging smoking data (description [0018]: inhalation device with a cartridge containing e.g. nicotine; the inhalation device can monitor an amount of substance delivered to a user).

6.2 In D2, the duration of puffs is determined for each puff, i.e. this process is repeated at least one time (see e.g. par. [0040]).

6.3 It is understood that such duration can only be determined if it is known when a puff starts and when it ends. This implies that first information needs to be sent and received to indicate the moment (the time incident) when a puff has been initiated and second

information to indicate the moment when the puff has stopped.

The board holds that the term "signal" in claim 1 needs to be interpreted broadly as "information", also because the patent itself (par. [0072]) refers to "logical signals [which] can comprise sets of 1s and 0s", i.e. binary information.

6.4 In D2, the puff count value is stored in memory (*ibid.*: "counter 242").

6.5 The respondent submits (e.g. in its response dated 7 December 2023, page 15) that D2 does not disclose a "cartomizer" but merely a cartridge that works with a separate atomiser.

The board, however, considers it to be generally accepted that for a device to be called a "cartomizer" (the term being a portmanteau of "**car**tridge" and "**atom**izer"), it is sufficient that it comprises a combination of a cartridge and an atomiser into a single unit. Such single units 114 and 116 are visible in figure 1 of D2. Following par. [0021] and [0022], those units can include a release device (118 or 120, respectively), which can include an atomiser. They correspond, therefore, to the definition of a "cartomizer".

6.6 The term "new" in claim 1 has no well-defined technical meaning. The description also sheds no more light than the claim on what might have been the intended meaning.

In the absence of a more precise definition of the term "new", the board considers that connecting a "new" cartomiser to a battery in the context of claim 1 means

nothing more than that some (unspecific) cartomiser is "newly connected" to the battery. In that sense, the "full cartridge" referred to in D2 (par. [0035]) may rightfully be said to correspond to the new cartomiser of claim 1. The claim language does not require that the "new" cartridge is a newly manufactured cartridge or one bought full in a shop as the respondent submitted.

Par. [0035] in D2, therefore, discloses the tracking of the number of puffs taken on a new cartomiser since it has been connected to the battery (power source 122).

6.7 D2 does not disclose that the first and the second time incidents are stored in a memory by the data logging device or used to determine a puff duration.

6.8 The subject-matter of claim 1 is, therefore, novel over the disclosure of D2 (Article 54 EPC).

7. *Inventive step over D2 and D4; Article 56 EPC*

7.1 As set out under 6.7 above, the board holds that D2 does not disclose the features of claim 1 according to which the first and the second time incidents are stored in a memory by the data logging device or used to determine a puff duration.

7.2 D2 discloses the use of a timer (248) to measure the duration of puffs (see pars [0037] and [0040], but provides no further detail on this measurement.

7.3 During the oral proceedings before the board, the respondent expressed the view that this difference between the subject-matter of claim 1 and the disclosure of D2 solved the objective technical problem

of achieving a more flexible and granular possibility of data logging.

The board, however, agrees with the point made by the appellant during the oral proceedings that it is not apparent in which technical sense the method of claim 1 achieves a more flexible and granular possibility of data logging. Instead, it adopts the appellant's position that the objective technical problem is how to implement the measurement of a duration by means of a timer as disclosed in D2.

- 7.4 The skilled person who wants to implement the teaching of D2 and who happens not to know how to measure a duration by means of a timer, will consult the prior art. Contrary to what the respondent argued during the oral proceedings, the board holds that this person would not only consult documents with the exact same setting as D2. Instead, they would look at any document, also in neighbouring technical fields, which provides a solution to the given problem. They could, for instance, consult D4, which is also concerned with the measurement of smoking-related data, including the measurement of puff durations.

The skilled person would only consult the part of D4 that relates to the measurement of puff durations as such, and make abstraction of the particular, viz. clinical, context in which such measurement takes place in that document, contrary to what the respondent argued during the oral proceedings. Notably, the solution of the problem at stake is not affected by the size or complexity of the device in question or whether it is used in a consumer appliance or a medical device.

7.5 D4 teaches (see par. [0055]) that a puff duration is determined by calculating the difference between the start and the end time of the puff. The board considers that it is well-known that any computer-implemented measurement of a difference between two values requires at least a temporary storage in memory of both values.

D4, therefore, discloses the determination of puff durations using the difference between a first and a second time incident, and implicitly discloses storing both time incidents in memory.

7.6 For this reason, the skilled person who implements the method disclosed in D2 by using the teaching of D4 regarding the determination of puff durations will arrive at the subject-matter of claim 1 without the need for an inventive step.

7.7 The board observes *obiter* that one may arrive at the same conclusion on the basis of the teaching of D2 alone. Indeed, as observed by the appellant in the statement of grounds of appeal (page 27, penultimate paragraph), there are only two possibilities to determine the duration of something that is defined by a start and an end point by using a timer:

- there is a T_{start} and a T_{end} and the duration is the difference; or
- the timer is reset at each occasion and there is just a T_{end} , which is used as the duration.

The assumption made in the reasoning starting on said page 27 that in D2 a single timer is used for determining puff durations and to keep track of the time period (five minutes) for which the total puff duration needs to be determined (see D2, par. [0041])

would be open for discussion. Nevertheless, assuming that this were not the case, it can at least be said that the skilled person would naturally consider simplifying the design of the arrangement of D2. One straightforward way of achieving this would be to use a single timer for both purposes.

That timer should then run continuously for said five-minute time period, i.e. it must not be reset for the determination of the puff durations. Instead, both the start and the end time of a puff should be noted, i.e. stored in memory, and the difference between both will give the duration of that puff.

The skilled person would thereby arrive at the subject-matter of claim 1 on the basis of the disclosure of D2 alone.

7.8 The board, therefore, holds that the subject-matter of claim 1 as maintained by the appealed interlocutory decision is not inventive (Article 56 EPC).

8. *Auxiliary requests of the respondent*

8.1 In its response received on 7 December 2023 (and in fact also in its subsequent letters received on 23 May 2024 and 15 January 2025), the respondent provided counter-arguments to the appellant's arguments, which all related to the patent as maintained by the appealed interlocutory decision, viz. according to auxiliary request 2 received during the opposition proceedings on 23 December 2022. They did not, however, make any express request. In particular, they did not make an auxiliary request to maintain the patent on the basis of any of auxiliary requests 3 to 9

received during the opposition proceedings on 23 December 2022.

- 8.2 The board has an obligation to review the decision under appeal (Article 12(2) RPBA 2020; see also T 1309/16, Reasons 2.1 and T 1943/16, Reasons 2.2). In the case at hand, the decision under review is the interlocutory decision of the opposition division to maintain the patent on the basis of auxiliary request 2.

This obligation, however, does not extend to auxiliary requests 3 to 9, which are not amongst the requests on which the decision under appeal was based (Article 12(2) RPBA), as the opposition division took no decision on those requests. That some of these requests might have been "admissibly raised" within the meaning of Article 12(4) RPBA is immaterial in this regard unless they had also been expressly maintained on appeal.

- 8.3 In its summons to the oral proceedings (point 2.2), the board interpreted the respondent as making the (single) request that the appeal be dismissed. In other words, that the patent be maintained on the basis of auxiliary request 2, which corresponds to the interlocutory decision under appeal.

- 8.4 If the respondent disagreed with the board's finding that it had only one request, i.e. if it were of the opinion that the board should have stated that auxiliary requests 3 to 9 were also part of the appeal proceedings, they had every opportunity to make this known in a reply to the board's summons sufficiently in

advance of the oral proceedings (which was scheduled 1/2 year after the sending of the summons).

In the board's view, the absence of such an objection (before the oral proceedings before the board) may be considered as a silent acknowledgment that, when filing its response to the appeal (and in fact at any time before the oral proceedings took place), the respondent only requested maintenance of the patent on the basis of auxiliary request 2.

8.5 Auxiliary requests 3 to 9 were at the very least not expressly part of the reply to the statement of grounds of appeal and therefore not amongst the requests defining the respondent's case according to Article 12(3) RPBA.

8.6 In spite of this, during the oral proceedings before the board, the respondent submitted that, contrary to the understanding which the board had expressed in its summons, the respondent themselves considered that auxiliary requests 3 to 9 were part of the appeal proceedings, given that they were mentioned in the decision under appeal (point 7 of the "Summary of Facts and Submissions") and were also referred to by the appellant in its letter received on 28 March 2024 (point 2.1.2.1).

8.7 The board, however, holds that although the proprietor's auxiliary requests 3 to 9 are mentioned under point 7 of the "Summary of Facts and Submissions" of the decision under appeal, they do not form part of the basis for that decision in the meaning of Articles 12(1)(a) and 12(2) RPBA, as is apparent from point 9 of said Summary and as is confirmed by the

absence of reasons given in the decision in respect of those requests.

8.8 As regards the respondent's submission that auxiliary requests 3 to 9 were mentioned in the letter from the appellant received on 28 March 2024, the board notes that the requests were merely mentioned in a passage in that letter recapitulating what had been discussed during the first-instance proceedings, as requests which existed at that time. Nothing in that passage indicates that the appellant would have understood that said requests were also part of the appeal proceedings.

8.9 It follows that auxiliary requests 3 to 9 were made for the first time in the oral proceedings before the board. They therefore constitute an amendment under Article 13(2) RPBA which shall only be taken into account if exceptional circumstances exist, which the respondent should justify with cogent reasons.

The board considers that the explanation given by the respondent that, up until the oral proceedings held before the board, it had believed that the requests were (automatically, necessarily or implicitly) part of the appeal proceedings (see 8.6 above), does not identify exceptional circumstances.

8.10 Further, the absence of reasons in favour of auxiliary requests 3 to 9 is consistent with the understanding that those requests were not specifically maintained, among other things, because Article 12(3) RPBA makes such reasons an obligatory part of the respondent's case.

8.11 The board considers that the re-introduction of said requests and any reasons relating to such requests at

such a late stage of the appeal proceedings would contravene the principle of procedural economy, if only because their admittance would have required either a postponement of the oral proceedings or a remittal to the department of first instance. The appellant noted in that respect that they did not consider the requests to be *prima facie* allowable and would have raised a number of objections against them already during the opposition proceedings, in particular on the issues of clarity and inventive step, if the opposition division had not allowed auxiliary request 2 and the discussion had turned to the lower ranking requests.

8.12 The board decides, therefore, not to take into account auxiliary requests 3 to 9 in the appeal proceedings (Article 13(2) RPBA).

9. *Request for remittal*

The respondent requested at the end of the oral proceedings to remit the case to the opposition division. However, given that the board considers that the patent should not be maintained on the basis of auxiliary request 2 and that it does not admit auxiliary requests 3 to 9, there would be no request for the opposition division to decide about. The request for remittal, therefore, has no purpose and is refused.

10. *Objection in respect of procedural defect; Rule 106 EPC - Right to be heard; Article 113(1) EPC*

10.1 At the end of the oral proceedings before the board, the respondent requested that the following declaration in the German language be included *verbatim* in the minutes of the oral proceedings:

"Wir gehen davon aus, dass diese Hilfsanträge 3 bis 9 bereits Teil des Beschwerdeverfahrens sind wegen
- zum einen der Entscheidung der 1. Instanz, welche diese Anträge aufführt, und
- zum anderen wegen der Einlassung der Gegenseite mit Schriftsatz vom 28. März 2024, Seite 7, unter Punkt 2.1.2.1."

The following is an English translation of this declaration by the Board:

"We assume that these auxiliary requests 3 to 9 are already part of the appeal proceedings because of
- firstly, the decision of the department of first instance, which lists these requests, and
- secondly, the opposing party's letter of 28 March 2024, page 7, under point 2.1.2.1."

10.2 In connection therewith, the respondent raised the following objection in the German language pursuant to Rule 106 EPC, which is reproduced *verbatim*:

"Durch die Nichtzulassung der Hilfsanträge 3 bis 9, von denen wir überzeugt sind, dass sie im Verfahren sind, wurde unser rechtliches Gehör verletzt."

The following is an English translation by the Board of this objection:

"By not admitting auxiliary requests 3 to 9, which we are convinced are in the proceedings, our right to be heard was violated."

10.3 The board dismisses the objection under Rule 106 EPC in view of the reasons which it provided under 8. above.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The respondent's objection pursuant to Rule 106 is dismissed.
3. The patent is revoked.

The Registrar:

The Chairman:



L. Stridde

M. Müller

Decision electronically authenticated