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Datasheet for the decision of 25 March 2025

Case Number: T 1480/23 - 3.2.05

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Language of the proceedings: EN

Title of invention:
Apparatus and method for three-dimensional printing of continuous fibre composite materials

Patent Proprietor:
MOI COMPOSITES S.r.l.

Opponent:
MATTER IP LTD.

Relevant legal provisions:
EPC Art. 54(1), 111(1)
RPBA 2020 Art. 11, 12(2), 13(2)

Keyword:

Novelty (main request, first auxiliary request: no; second auxiliary request: yes)
Late-filed objection - admitted (yes)
Remittal (yes)

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Case Number: T 1480/23 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 25 March 2025

Appellant: (Patent Proprietor)	MOI COMPOSITES S.r.l. Viale Monte Ceneri, 78 20155 Milano (IT)
Representative:	Palladino, Saverio Massimo Notarbartolo & Gervasi S.p.A. Viale Achille Papa, 30 20149 Milano (IT)
Respondent: (Opponent)	MATTER IP LTD. 130 Old Street London EC1V 9BD (GB)
Representative:	Matter IP Limited c/o Impetus IP Ltd Office One, Ridgecombe Barn Lifton, Devon, PL16 0HD (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 17 May 2023 revoking European patent No. 3377309 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	P. Lanz
Members:	T. Vermeulen
	F. Blumer

Summary of Facts and Submissions

I. The appeal was filed by the patent proprietor against the decision of the opposition division to revoke European patent No. 3 377 309.

II. The opposition had been filed against the patent as a whole on the basis of the grounds for opposition under Article 100(a) together with Article 54(1) EPC (lack of novelty) and Article 56 EPC (lack of inventive step), under Article 100(b) EPC and under Article 100(c) EPC.

III. In the decision under appeal, the opposition division held that the main request and auxiliary requests 1, 2 and 7 to 13 were not allowable because their claims contained added subject-matter. The opposition division cited, inter alia, documents US 2003/0236588 A1 (D1) and WO 2014/153535 (D5) and came the conclusion that the subject-matter of claim 1 according to auxiliary requests 3 to 6 was not novel in view of document D1.

IV. With its statement of grounds of appeal, the appellant filed the following printouts from two online dictionaries, as follows.

- "Made from, made of, made out of, made with" (Cambridge Grammar),
- "made of" (The Free Dictionary),

With letter dated 19 March 2025, the respondent filed the following printout from an online dictionary.

- "made up of" (Thesaurus.com)

With a first letter dated 21 March 2025, the appellant filed a further printout from an online dictionary

- "makeup" (Merriam-Webster)

as well as a printout from an online weblog

- "Confusing verbs - *consist, include, make up, comprise* and *constitute* etc" (Random Idea English, https://random-idea-english.blogspot.com/2013/11/confusing-verbs-consist-include-make-up.html),

and the following article

- N. Petcharat and S. Phoocharoensil, "A Corpus-Based Study of English Synonyms: Appropriate, Proper, and Suitable", LEARN Journal, vol. 10, Issue 2, 2017.

V. In a communication pursuant to Article 15(1) RPBA issued on 31 January 2025, the parties were informed of the board's provisional opinion on the issues of the case.

VI. With a second letter letter dated 21 March 2025, the appellant filed four sets of claims according to its main request and first to third auxiliary requests.

VII. Oral proceedings before the board were held on 25 March 2025.

VIII. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as amended on the basis of the claims of the main request or one of first to third auxiliary requests, all filed by letter dated 21 March 2025. The appellant also requested that the inventive step

objection based on document D1, potentially in combination with document D5, not be admitted into the proceedings and that the case not be remitted to the opposition division.

The respondent (opponent) requested that the appeal be dismissed. The respondent also requested that the inventive step objection based on document D1, potentially in combination with document D5, be admitted into the proceedings and that the case be remitted to the opposition division.

IX. Independent claims 1 and 2 of the appellant's main request on appeal have the following wording (the feature numbering used by the board appears in square brackets):

"1. [**A**] An apparatus for three-dimensional printing of continuous fibre composite materials, comprising: [**B**] a feed head (8) for feeding a compound material (2) of continuous fibre (3), comprising an outlet nozzle (14) for the compound material (2) of continuous fibre (3) to print a three-dimensional object (10); [**C**] means (18) for relative movement between the feed head (8) and the three-dimensional object (10), said means comprising at least one machine (19) having numerically controlled movement along at least three axes; [**C'**] a support surface (22) on which the three-dimensional object (10) is positioned during the printing process; and [**D**] a station (7) for realizing the compound material (2), said station (7) being arranged upstream of the feed head (8) [**E**] and comprising at least one basin (9) [**F**] detached from the feed head (8) [**G**] for containing a resin (6) for immersing at least one continuous fibre (3) during the process of drawing it through the resin (6) contained in said basin (9); [**H**]

the station further comprising a feed line (11) of the continuous fibre (3) for guiding the same fibre (3) from a collection element (4) for collecting the fibre (3), through the basin (9), and to said feed head (8), [**I**] said feed line (11) having a plurality of idler rollers (12) for the fibre (3); [**J**] wherein said numerically controlled machine (19) comprises a motorized arm (20) for supporting said feed head (8) at a respective end portion (21), [**K**] said arm (20) being configured to exert a drawing force on the compound material of continuous fibre leaving the feed head (8) [**K'**] by means of relative movement between the feed head (8) and the support surface (22) and [**L**] wherein said feed head (8) further comprises a polymerization member (15) arranged at the nozzle (14), for polymerizing the compound material (2) leaving said nozzle (14)."

"2. [**M**] A method for three-dimensional printing of continuous fibre composite materials, comprising the steps of: [**N**] realizing a compound material (2) by immersing a continuous fibre (3) in a resin (6) and subsequently feeding the compound material (2) of continuous fibre (3) so as to print a three-dimensional object (10); [**O**] wherein said feeding process is implemented by exerting a drawing force on the compound material (2) by means of relative movement between a respective feed head (8) for feeding the material and a support surface (22) or said three-dimensional object (10), [**P**] and wherein said step of realizing the compound material (2) is implemented during the process of drawing the fibre (3), having the fibre (3) pass through the resin (6) contained in a basin (9) detached from the feed head (8) by guiding the fibre (3) from a collection element (4) for collecting the fibre (3), through the basin (9), and to the feed head (8); [**Q**]

wherein said drawing process comprises the steps of: distributing the compound material (2) leaving the head (8) on the support surface (22); [**R**] polymerizing the compound material (2) on the support surface (22) so as to define an anchoring point (26) for anchoring the compound material (2) of continuous fibre (3) onto said surface (22); [**S**] moving the head (8) with respect to the anchoring point (26) according to a predetermined path defining the object (10) to be printed; and [**T**] simultaneously polymerizing the compound material (2) during the step of moving the head (8) so as to stabilize the material (2) in a solid state."

X. Claim 1 of the first auxiliary request has the same wording as claim 1 of the appellant's main request, except for the following amendment to feature I.

"[**I'**] said feed line (11) ~~having~~ being made up of a plurality of idler rollers (12) for the fibre (3), the idler rollers (12) being mounted idly;"

Claim 2 of the first auxiliary request is identical to claim 2 of the main request.

XI. Claim 1 of the second auxiliary request is identical in wording to claim 2 of the main request. The apparatus claim of the main request was deleted.

XII. The appellant's submissions were essentially as follows.

Main request

From the plain reading of the wording of claim 1, and in particular the phrase "by means of" connecting features K and K', it was clear that the drawing force

exerted on the fibre was completely due to the relative movement between the head and the support. Had anything else been intended, the phrase "aided by" or any similar wording would have been used. The same applied to independent method claim 2 in view of the wording of feature O. Accordingly, a broad reading of the claims to the extent that the extraction of the compound material was not solely due to the drawing action exerted by the moving head was unjustified and wrong. The possibility that another mechanism caused the extraction was thus excluded.

Document D1 did not disclose that towpreg was dispensed solely by the relative movement of the dispensing nozzle with respect to the support surface. The section at the end of paragraph [0078] of document D1 stated, with no possible ambiguity, that the rate at which the impregnated tow was discharged was dictated by the linear speed of the fiber tow on the surface of the roller, which was driven by a motor, and that this linear speed could be adjusted by varying the motor rotational speed. In other words, in document D1 the towpreg was "pushed" rather than pulled out of the nozzle. In this condition, the filament was never under tension and no drawing action could be exerted on the filament by the moving of the dispensing head. This was consistent with paragraph [0073] of document D1 which indicated that the pressure of the resin in cell 80 provided additional dragging force "to assist in 'extruding' the softened towpreg out of the nozzle". The fact that paragraph [0022] of document D1, which was silent on motorised rollers, described a pulling action did not change this conclusion. Similarly to paragraph [0029], it concerned a residual and undesired extraction mechanism described only with reference to periods of the building process when no deposition was

carried out. In contrast, the passages of document D1 describing the "positive" delivery of the filament, i.e. the phases when the filament is delivered from the dispensing head for producing the desired article, always mentioned the necessary use of motor means for pushing the filament. A further consideration was that dispensing the towpreg at a controlled rate, as mentioned in paragraph [0021] of document D1, or at a desired rate, as apparent from Figure 12 of document D1, would not be possible if the dispensing rate were dependent on the speed at which the feed head moved relative to the support surface. Also, rollers 10A, 10B and 16A, 16B of Figure 3 came in pairs which indicated they actually controlled the speed at which the towpreg moved towards the feeding head.

Hence, the subject-matter of claims 1 and 2 of the main request was new over document D1.

First Auxiliary request

By virtue of the amendment to feature I, claim 1 of the first auxiliary request further specified the construction of the apparatus of the main request. The phrase "made up of" was equivalent to "consisting of". Although it was not to be found in dictionaries, both the online Cambridge Grammar and The Free dictionary reported that the phrase "made of" meant that an object or structure was composed of the indicated elements. Reference was also made to the online Merriam-Webster dictionary, to a weblog by Random Idea English, and to an article published in the LEARN Journal.

Therefore, the subject-matter of claims 1 and 2 of the first auxiliary request was new over document D1.

Second auxiliary request

Claim 1 of the second auxiliary request was identical to claim 2 of the main request. Accordingly, the considerations presented in respect of method claim 2 of the main request also applied here. The claimed subject-matter was now restricted to a method. The apparatus of document D1 did not operate according to this method. If during its formation, the towpreg of document D1 was at least in part pushed by elements of the system, then these elements would have had to be turned off before the cutting step described in paragraph [0022]. It was thus inevitable that they also contributed to towpreg being continued to be pulled out. The ability to push wet towpreg depended on its viscosity. Regarding the anchoring point, paragraph [0044] of document D1 did not disclose that the towpreg was polymerised on the support surface. Other solutions could be foreseen to anchor the towpreg of document D1 with respect to the base member.

In sum, features O and R were not disclosed so that the subject-matter of claim 1 of the second auxiliary request was new over document D1.

Request to admit a late-filed inventive step objection and request to remit the case to the opposition division

The new inventive step objection raised by the respondent was not part of the decision under appeal. The respondent could have presented the objection in reaction to the appellant's letter dated 6 June 2024 in which prior-art documents D2 to D17 were discussed. The board's preliminary opinion set out in its communication pursuant to Article 15(1) RPBA was clear

that the subject-matter of claim 1 of the second auxiliary request was new over document D1. Still, the respondent did not raise any inventive step objection in the written appeal proceedings. Feature R of claim 1 of the second auxiliary request had been part of the discussion on novelty of the main request. It had been discussed in the appellant's written submissions. Feature R could thus not be used as a reason to raise an inventive step objection for the first time in the oral proceedings held before the board. The inventive step objection based on document D1, potentially in combination with document D5, should not be admitted into the proceedings and the case should not be remitted to the opposition division.

XIII. The respondent's submissions were essentially as follows.

Main request

The opposition division correctly concluded that the subject-matter of claims 1 and 2 did not exclude embodiments in which additional forces could also be used to extract the compound material, or indeed that motorised rollers could be used in addition to idle rollers. In that regard, document D1 was agreed to disclose an arrangement that could be read onto claim 1, i.e. the movement of the head contributed to pulling the material out of the dispensing nozzle. This point did not appear to be in dispute. However, the appellant's claim construction that the extraction of the compound material was only due to the movement of the head relative to the anchoring point was incorrect. Any such limitation was absent from claim 1 or claim 2. In particular, claim 1 did not include any feature that would bring about the limitation the appellant

commented on when discussing paragraphs [0022] and [0029] of document D1. Terms such as "only", "solely", or the like were not present in the claims. Features K and K' were thus disclosed by document D1.

As a consequence, the subject-matter of claims 1 and 2 of the main request was not new over document D1.

First auxiliary request

The phrase "made up of" in claim 1 of the first auxiliary request did not have a definitive meaning as a term in the art, nor did it have a meaning in the jurisprudence in the same way as, for example, "consisting of" had. Reference was made to the entry "made up of" in Thesaurus.com. In consequence, the claimed subject-matter had not actually been changed by the amendment to feature I. Nevertheless, irrespective of the meaning of "made up of" in claim 1, the subject-matter of claim 1 of the first auxiliary request was not new over document D1 for the same reasons as provided for the main request.

Second auxiliary request

Feature R of claim 1 was disclosed in the second and third sentences of paragraph [0044] of document D1. Depositing towpreg on the base member was analogous to polymerising the compound material on the support surface. The towpreg had to be fixed somewhere to the base member. Otherwise it was not possible to build the layers. This was all the more so considering that paragraph [0064] of the contested patent defined the polymerising step in a very broad manner, including implementing the step upstream of the feed head. A further consideration was that claim 1 of the second

auxiliary request did not specify that the first point of contact had to be an anchoring point. In fact, the entire first layer was formed on the base member. Although Figure 3 of document D1 was a very specific embodiment, it was just one example. The heating elements shown in Figure 4 of document D1 were optional. The skilled person would not regard this example as incompatible with other polymerisation means such as those disclosed in paragraph [0044] of document D1. Regarding feature O of claim 1, this requirement was disclosed by paragraph [0072] of document D1. A further consideration was that it was difficult to push wet fibre through the feed head. The towpreg of document D1 was therefore pulled out of the feed head. This was consistent with the "additional dragging force" mentioned in paragraph [0073] of document D1. Also paragraphs [0022], [0044] and [0029] confirmed that material was pulled out of the nozzle. Even if another element aided in pulling out the towpreg, this did not mean that the prior-art method of document D1 did not disclose feature O, especially since the contested patent also mentioned motorised rollers.

Therefore, the subject-matter of claim 1 of the second auxiliary request was not new over document D1.

Request to admit a late-filed inventive step objection and request to remit the case to the opposition division

It was requested to admit an inventive step objection based on document D1, potentially in combination with document D5, into the appeal proceedings. Furthermore, the case should be remitted to the opposition division for further prosecution. It had been considered procedurally inefficient to address all seventeen

prior-art documents filed in the proceedings before the opposition division in the reply to the statement of grounds of appeal. This was all the more so since these documents had not been discussed in the decision under appeal. Furthermore, the statement of grounds of appeal had not been very detailed. The issue of the anchoring point being a distinguishing feature with respect to document D1 had never been raised in the written appeal proceedings. Raising this aspect in the oral proceedings held before the board was an unexpected turn of events. The inventive step objection was in fact a reaction to circumstances that resulted from an erroneous assessment by the opposition division. Therefore, the case should be remitted to the opposition division.

Reasons for the Decision

1. During the oral proceedings held before the opposition division on 4 April 2023, the appellant filed the claims of auxiliary requests 0b and 0d. These were enclosed with the minutes of the oral proceedings. It follows from page 3 of these minutes that the appellant submitted a further auxiliary request 0c orally and stated that this request "*corresponds to request 0b with claims 2 and 3 deleted*". Auxiliary requests 13 and 16 filed in preparation for the oral proceedings were renumbered to auxiliary requests 0e and 0f, respectively (see pages 6 and 7 of the minutes). At the end of the oral proceedings, all auxiliary requests were renumbered; auxiliary requests 0c, 0d, 0e and 0f became auxiliary requests 3, 4, 5 and 6, respectively (see the table bridging pages 7 and 8 of the minutes and point 1.13 of the Summary of Facts and Submissions of the decision under appeal). It is these four claim

requests which formed the basis of the appellant's requests on appeal, as formulated on page 1 of its statement of grounds of appeal.

2. With letter dated 21 March 2025, the appellant submitted a clean copy of the claim requests, renumbered as main request and first, second and third auxiliary requests, respectively. At the oral proceedings held before the board on 25 March 2025, the respondent confirmed that the newly filed claim requests complied with the claim requests discussed in the written appeal proceedings.

Main request - novelty of claim 1

3. Claim 1 of the main request concerns an apparatus for three-dimensional printing of continuous fibre composite materials (feature A) composed of several elements defined in features B to L. It is not disputed that the apparatus known from document D1 comprises all of features A to J, as is shown by Figure 3. Also the arrangement of a polymerisation member at the nozzle in accordance with feature L is acknowledged by the appellant. The board is satisfied that the heating elements 88 illustrated in Figure 4 and described in paragraph [0077] of document D1 are adapted to polymerise the compound material ("towpreg") leaving the nozzle.

4. The appellant's grievance with the decision under appeal lies exclusively with features K and K' of claim 1. These require that the motorised arm (defined in feature J) is configured to exert a drawing force on the compound material of continuous fibre leaving the feed head (defined in feature B) by means of relative movement between the feed head and the support face

(defined in feature C'). Thus, the question to be answered is whether the arm 32 which supports the nozzle 22 in the embodiment shown in Figure 3 of document D1 (and is motorised according to paragraph [0077]) fulfills this requirement.

5. The opposition division referred to paragraphs [0022] and [0077] of document D1 in support of its conclusion that it does. Paragraph [0022] is part of the general description of document D1. It describes how the prior-art apparatus is operated when transitioning between two layers, as follows.

> "[T]*he towpreg at the last finishing point typically must be cut off so that the towpreg will not continue to be pulled out of the dispensing nozzle*".

This so-called "path interruption" is further elaborated in paragraph [0029] of document D1. Stopping the dispensing operation allows the nozzle to traverse to a new starting point

> "*without having to pull out any additional length of towpreg*".

It follows from these passages that, during normal operation of the apparatus of document D1, compound material is being pulled out from the dispensing nozzle.

6. The mechanism behind the pulling force is not explained in paragraphs [0022] and [0029]. However, it is not decisive in the context of claim 1 of the main request, which defines an *apparatus* - not a *process* - for three-dimensional printing of continuous fibre composite

materials. As long as the apparatus is able to operate in the manner of features K and K', the details of its actual operation are of no relevance. Thus, the fact that paragraphs [0022] and [0029] of document D1 concern a residual and undesired extraction mechanism described only with reference to periods of the building process when deposition is not carried out is in itself not a convincing argument that the apparatus of document D1 would be unsuitable for causing a pulling action on the towpreg by moving the nozzle relative to the support surface.

7. The appellant relies on paragraphs [0073] and [0078] of document D1 to defend its case that the towpreg is pushed out of the dispensing nozzle by means of motorised rollers, not by a relative movement between nozzle and base member. These passages are part of the detailed description of Figure 3 and 4 of document D1. In the board's view, it follows from the figures that, irrespective of the actual operation of the prior-art apparatus, a movement of the nozzle 22 relative to the base member 40 may result in a pulling action on a towpreg that adheres to the layers already deposited. The appellant argues that the motorised rollers would prevent such an operation. The board disagrees. Even though the first sentence of paragraph [0073]

> "*Preferably, selected rollers are equipped with motor means to help drive the movement of the fiber tow.*"

indicates that, in a preferred implementation of the embodiment described in the preceding paragraph [0072], some of the rollers 6, 8, 10A, 10B, 14, 16A, 16B shown in Figure 3 can be equipped with motor means, the construction "to help drive" also implies that the

motorised rollers play a subordinate role in driving the movement of the fibre tow. Another mechanism must thus be responsible for driving the movement of the fibre tow and, ultimately, for dispensing towpreg from the nozzle. It is against this background that the terms "additional dragging force" and "extruding" in the last-but-one sentence of paragraph [0073] must be understood. Moreover, given that paragraph [0072] is explicit that

> "*the fiber tow is pulled through a series of roller means 6, 8, 10A, 10B, 14, 16A, 16B*",

it follows that, also in the preferred implementation of that embodiment according to paragraph [0073], towpreg is pulled, at least to a certain extent, through the rollers and out from the dispensing nozzle. The board finds it fitting to add here that such a motor-assisted solution is not unlike the embodiment proposed by paragraphs [0046] and [0078] of the contested patent. Therefore, the board concludes that equipping some of the rollers with motors does not prevent the towpreg from being pulled out from the nozzle.

8. Further still, from the first sentence of paragraph [0073] of document D1 it can be inferred that the embodiment described by the preceding paragraph [0072] encompasses an implementation in which none of the rollers are equipped with motor means. Contrary to what the appellant alleges, arranging some rollers 10A, 10B and 16A, 16B in pairs does not imply that they have a driving function. There may actually be different reasons for using roller pairs, such as to "*squeeze out the excess resin*" (paragraph [0072]). Now, if towpreg is pulled through each and every of rollers 6, 8, 10A,

10B, 14, 16A, 16B and none of them is motorised, it must be concluded that the apparatus of that particular implementation is not only configured so as to print three-dimensional objects in accordance with features K and K', it actually operates as such.

9. The appellant's case is also based on paragraph [0021] and Figure 12 of document D1, the argument being that the controlled rate or desired rates disclosed in these passages could not be realised if it depended on the speed at which the feed head moved relative to the support surface. This argument is not persuasive. With the prior-art apparatus, the relative movement between the motorised arm and the base member must be controlled in function of the desired geometry of the three-dimensional object. As a consequence, there is no reason to assume that the rate at which towpreg is dispensed from the nozzle could not be controlled accordingly.

10. In sum, the subject-matter of claim 1 of the main request is not new in view of document D1 (Article 54(1) and (2) EPC). The main request is thus not be allowable.

First auxiliary request - novelty of claim 1

11. The opposition division concluded in point 2.7.2 of the reasons for the decision under appeal that the phrase "made up of" which had been added to claim 1 does not exclude that some of the rollers of the feed line are motorised. The appellant counterargues by referring to various dictionary excerpts, an Internet weblog and an article that "made up of" was equivalent to "consisting of" so that, by way of the amendment, the feed line of

the claimed apparatus was only composed of idler rollers.

12. The argument that the amendment of feature I' overcomes the novelty objection with regard to document D1 is unconvincing. As set out in point 8. above, paragraph [0072] of document D1 describes a particular implementation in which the prior-art apparatus has a series of idler rollers 6, 8, 10A, 10B, 14, 16A and 16B through which towpreg is pulled. It is evident from Figure 3 of document D1 that these rollers are arranged between the spools 4 and the nozzle 22 and, together, form the feed line of the prior-art apparatus. Irrespective of the precise meaning of "made up of", also feature I' is disclosed by document D1.

13. Therefore, the subject-matter of claim 1 of the first auxiliary request is not new over document D1 (Article 54(1) and (2) EPC). The first auxiliary request is thus not allowable.

Second auxiliary request - novelty of claim 1

14. Unlike the claims of the main request and the first auxiliary request, the claims of the second auxiliary request only define a *method* for three-dimensional printing.

15. In determining whether claim 1 of the second auxiliary request lacks novelty over document D1, the parties in particular discussed features O and R of claim 1.

16. Similarly to features K and K' of claim 1 of the main request, feature O essentially requires that the compound material of continuous fibre leaves the feed head due to a drawing force exerted on the compound

material by means of relative movement between the feed head and the support surface. As set out in point 8. above, the board is persuaded that the embodiment described by paragraph [0072] of document D1 has an implementation concerning an apparatus that is not only configured but actually operates in a way so as to pull towpreg through each and every of idler rollers 6, 8, 10A, 10B, 14, 16A, 16B by way of a relative movement between the nozzle 22 and the base member 40 shown in Figure 3. Hence, feature O is disclosed by document D1.

17. Regarding feature R, it introduces an anchoring point which is the result of polymerising compound material on the support surface. Paragraph [0072] of document D1 does not mention such an anchoring point. Nor for that matter is it mentioned elsewhere in the detailed description of Figures 3 and 4 of document D1.

18. The appellant refers to paragraph [0044] of document D1 in support of its argument that the towpreg dispensed by the nozzle of the prior-art apparatus is deposited and then solidified onto the base member. However, this paragraph describes a particular embodiment in which a fibre tow impregnated with photo- or ultraviolet-curable resin is cured by exposure to an ultraviolet beam. The embodiment shown in Figures 3 and 4, in contrast, relies on heating elements 88 attached to the nozzle to accomplish the curing step (see also paragraph [0074] of document D1). In the board's view, these are different embodiments. It is thus not permissible to combine the method disclosed by the particular implementation of paragraph [0072] with an aspect of the embodiment of paragraph [0044] for assessing novelty over document D1.

19. Furthermore, the appellant makes a convincing case when pointing out that different solutions exist to anchor a towpreg with respect to a base member. The method described by paragraph [0072] of document D1 does not necessarily follow the solution proposed by feature R, i.e. polymerising the compound material *on* the support surface *so as to* define an anchoring point. The respondent's argument that the polymerising step is defined in a broad manner by the description of the contested patent cannot detract from the straightforward formulation of this requirement. Feature R is thus not directly and unambiguously disclosed in combination with the other claim features.

20. In sum, the subject-matter of claim 1 of the second auxiliary request is new over document D1 (Article 54(1) and (2) EPC). Thus, the decision under appeal is to be set aside.

Admittance of a late-filed inventive step objection

21. At the oral proceedings held before the board, the respondent requested to admit an objection under Article 56 EPC against claim 1 of the second auxiliary request in the appeal proceedings. The objection was based on document D1, potentially in combination with document D5.

22. In the written appeal proceedings, the respondent had mentioned "*issues of inventiveness, and other matters*" in the context of the main request and the first auxiliary request and had made an indirect reference to these issues in the context of the second and third auxiliary requests (see page 4 of the reply to the statement of grounds of appeal: "the comments presented above apply mutatis mutandis"). The specific inventive

step objection raised at the oral proceedings was thus an amendment of the respondent's appeal case which, pursuant to Article 13(2) 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.

23. As justification for this late submission, the respondent submitted that the possibility of feature R being a distinguishing feature with respect to document D1 had never been raised in the written appeal proceedings. The board agrees. Both in its statement of grounds of appeal and in its letter dated 6 June 2024, the appellant had consistently argued that feature O was pivotal in rendering the subject-matter of the independent method claim novel over document D1. Feature R was not mentioned in this context. It was raised for the first time on appeal during the oral proceedings held before the board. The respondent could thus not have foreseen this turn of events before the oral proceedings. These were exceptional circumstances that justified the belated filing of the inventive step objection.

24. In view of the above, the board admitted the inventive step objection based on document D1, potentially in combination with document D5, in the appeal proceedings (Article 13(2) RPBA).

Remittal to the opposition division

25. A case is normally remitted pursuant to Article 111(1) EPC if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided on by the department of first instance. The board may, in the interests of

procedural economy, decide the case even if a decisive issue has not been dealt with by the department of first instance. It is, however, well-recognised that any party should, where possible, be given the opportunity to have the important elements of a case considered by two instances.

26. In the present case, the contested patent was revoked by the opposition division on the basis of added subject-matter and lack of novelty over document D1. The opposition division did not give any reasoning on inventive step of the claimed subject-matter. Document D5 was not discussed in the decision under appeal. In addition, no inventive step objections were raised by the respondent in the written appeal proceedings. An assessment of inventive step on the basis of document D1, potentially in combination with document D5, during the oral proceedings held before the board would have essentially required an examination of several issues for the first time, which constituted an undue burden and ran counter to the very purpose of a judicial review within the meaning of Article 12(2) RPBA.

27. Considering all the relevant circumstances of the case in hand, the board concluded that there were special reasons in the sense of Article 11 RPBA for remitting the case to the opposition division for further prosecution, as requested by the respondent.

28. For the above reasons, the case is to be remitted 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:

N. Schneider P. Lanz

Decision electronically authenticated