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Datasheet for the decision of 5 March 2026

Case Number: T 0080/24 - 3.2.07

Application Number: 18737712.2

Publication Number: 3630434

IPC: B28D1/00, C04B41/48

Language of the proceedings: EN

Title of invention:
METHOD AND APPARATUS FOR CONSOLIDATING A SLAB OF NATURAL OR ARTIFICIAL STONE MATERIAL

Patent Proprietor:
Toncelli, Luca

Opponent:
ANTOLINI LUIGI & C. S.P.A.

Headword:

Relevant legal provisions:
EPC Art. 56, 100(a), 100(b), 100(c)
RPBA 2020 Art. 11, 12(1)(a), 13(2)

Keyword:
Grounds for opposition - added subject-matter (no) - insufficiency of disclosure (no)
Main request - inventive step - (no)
Auxiliary request - inventive step - (yes)
Remittal - (no)
Basis of proceedings - decision under appeal
Amendment after Article 15(1) RPBA communication - exceptional circumstances (no) - taken into account (no)

Decisions cited:
T 0018/21

Catchword:

Europäisches Patentamt
European Patent Office
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Beschwerdekammern

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Case Number: T 0080/24 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 5 March 2026

Appellant: (Patent Proprietor)	Toncelli, Luca Viale Asiago, 34 36061 Bassano del Grappa (Vicenza) (IT)
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Appellant: (Opponent)	ANTOLINI LUIGI & C. S.P.A. Via Napoleone, 6 Frazione Ponton 37015 Sant'Ambrogio di Valpolicella (VR) (IT)
Representative:	Robba, Pierpaolo Interpatent S.R.L. Via Caboto, 35 10129 Torino (IT)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 15 December 2023 concerning maintenance of the European Patent No. 3630434 in amended form.**

Composition of the Board:

Chairman	G. Patton
Members:	S. Watson
	Y. Podbielski

Summary of Facts and Submissions

I. Appeals were filed by the patent proprietor and the opponent in the prescribed form and within the prescribed time limit against the decision of the opposition division to maintain European patent No. 3 630 434 in amended form according to the then first auxiliary request.

Since each party to the proceedings is both appellant and respondent, they are referred to below, for the sake of clarity, as patent proprietor and opponent.

II. The opposition was directed against the patent as a whole and based on Article 100(a) EPC (lack of inventive step), Article 100(b) EPC (insufficiency of disclosure) and Article 100(c) (unallowable amendments). The opposition division found that the ground for opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted. The first auxiliary request was found to meet the requirements of Articles 56, 83 and 123(3) EPC.

III. The following documents which formed part of the decision under appeal are referred to in this decision:

D1: EP 2 228 185 A2
D2: EP 0 786 325 A1
D3: IT 1 056 388
D3': English translation of D3
D4: WO 2007/042479 A1
D5: WO 2005/030474 A1
D6: WO 03/018310 A1
D7: US 7,850,815 B2.

IV. In preparation for oral proceedings, the board gave its preliminary opinion in a communication pursuant to Article 15(1) RPBA, dated 4 June 2025. The preliminary opinion of the board was that the appeal of the patent proprietor was likely to be dismissed but that the appeal of the opponent could be allowed in part.

The patent proprietor responded to the board's preliminary opinion with written submissions dated 5 August 2025.

V. Initially, the patent proprietor requested that the decision under appeal be set aside and the patent be maintained as granted (main request), or that the patent be maintained in amended form on the basis of one of the sets of claims according to the first to twenty-ninth auxiliary requests filed with the patent proprietor's reply to the appeal of the opponent.

The opponent requested initially that the decision under appeal be set aside and the patent be revoked in its entirety.

VI. Oral proceedings before the board took place on 5 March 2026. At the conclusion of the proceedings the decision was announced.

Further details of the oral proceedings can be found in the minutes.

VII. The final requests of the parties are as follows.

The patent proprietor requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or in amended form on the basis of the set of claims of auxiliary request 13 filed with

the patent proprietor's reply to the appeal of the opponent.

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

VIII. Independent claim 1 of the patent as granted (main request) reads as follows:

"Method for reinforcing a slab of natural or artificial stone material comprising the steps of:
a) sealing the non-visible surface (16) of the slab and, where necessary, the surfaces of the edges (18, 20, 22, 24);
b) positioning the slab (12) on a support surface (26), with the visible surface (14) directed upwards;
c) providing an adhesive bead (28) on the visible surface (14), in the vicinity of the perimetral edge of the slab (12);
d) distributing a resin (30) over the visible surface (14), in the zone bounded by the adhesive bead (28);
e) under vacuum conditions, arranging on top of the slab a sheet (32) of anti-adhesive material and then applying pressure, on the resin by means of a press ram (50);
f) restoring the atmospheric pressure;
g) hardening the resin (30); and
h) finish-machining the slab (12)."

IX. Independent claim 1 of auxiliary request 13 has the following additional features introduced at the end of claim 1 as granted:

"characterized in that the step e) is performed in an impregnation station (42) comprising:

- a bell member (44), movable between a raised position which allows the passage of fluid between an internal zone thereof and the outside, and a lowered position, in contact with a conveying surface (36), where fluid is unable to pass between an internal zone thereof and the outside, and vice versa;
- a vacuum plant, comprising suction ducts (46, 48) which connect the plant to the inside of the bell member (44); and
- a press ram (50) movable vertically with respect to the bell member, the pressing surface thereof being provided with a conformable element (52); and in that the press ram (50) and the conformable element (52) are provided with air flow vents(54) connected to a vacuum-generating plant".

Since the opponent did not raise any objection against independent apparatus claim 15 of auxiliary request 13, its wording is not relevant for the present decision.

X. The arguments of the parties relevant for the decision are dealt with in detail below.

Reasons for the Decision

1. *Added subject-matter - claim 1 as granted - Article 100(c) EPC*

1.1 The opposition division found that the term "where necessary" in feature a) of claim 1 of the patent as granted introduced subject-matter which went beyond the content of the application as originally filed in the Italian language.

The opponent had argued that the correct translation of the Italian word "*eventualmente*" in claim 1 as originally filed was "optionally" or "possibly", but not "where necessary" as argued by the patent proprietor. Neither party submitted certified translations in support of their arguments.

The opposition division reasoned that, even if "where necessary" could, depending on the context, be a correct translation of "*eventualmente*", in the present context it led to the introduction of components of "necessity" and "place" which were not present in the original application. There was no disclosure that the edges might have areas within them which were sealed and other areas which were not sealed. The originally filed application only disclosed that the edges could be either sealed or not sealed (see decision under appeal, point II.13.2).

1.2 The patent proprietor contested the opposition division's findings and argued that claim 1 together with the description on page 4, lines 19 to 21 of the application documents as originally filed in Italian disclosed the feature.

1.3 For the purposes of assessing whether subject-matter extends beyond the application as originally filed, the description, claims and drawings must be taken into account (see Case Law of the Boards of Appeal, 11th edition 2025 ("CLB"), II.E.1.2.1).

1.3.1 In the present case the description, claims and drawings filed in Italian on 18 May 2018 constitute the application documents as originally filed (Article 70(2) EPC).

1.3.2 Feature a) of claim 1 as originally filed reads as follows:

"*a) sigillatura della superficie non in vista (16) della lastra ed eventualmente delle superfici dei bordi (18, 20, 22, 24)*".

This was translated into English (the language of proceedings) as follows in claim 1 of the patent as granted:

"a) sealing the non-visible surface (16) of the slab and, where necessary, the surfaces of the edges (18, 20, 22, 24)"

1.3.3 The originally-filed passage of the description on page 4, lines 19 to 21, referred to by the patent proprietor, reads as follows:
"*Nella presente trattazione, con il termine sigillatura di una superficie si intende la sigillatura di fessure, fori e porosità in modo che attraverso tale superficie sigillata sia impedito il passaggio di fluido e in particolare d'aria*."

This was translated into English as follows (see contested patent, paragraph [0033]):

"In the present description, the expression 'sealing a surface' is understood as meaning sealing cracks, holes and porous zones so that the passage of fluid and in particular air across this surface is prevented."

1.4 The patent proprietor argued that the skilled person, based on their common general knowledge and reading the passage on page 4, lines 19 to 21, of the description as originally filed, understood that sealing a surface

required cracks, holes and porous zones to be sealed, i.e. that the surface was sealed "where necessary" in order to prevent the passage of fluids through the surface.

1.5 The opponent argued claim 1 as originally filed incorporated two possibilities, namely either that all cracks, holes and porous zones of both the non-visible surface and the surfaces of the edges were sealed; or that all the cracks, holes and porous zones of the non-visible surface and none of the cracks, holes and porous zones of the surfaces of the edges were sealed. This was because "*eventualmente*" had to be understood as merely meaning "optionally", i.e. that all cracks, holes and porous zones of the edges were either sealed or not sealed.

According to the opponent, the patent as granted however also included a third possibility that all the cracks, holes and porous zones of the non-visible surface were sealed and some, but not all, of the cracks, holes and porous zones of the surfaces of the edges were sealed. The opponent argued that there was no direct and unambiguous disclosure of the third possibility in the application documents as originally filed.

1.5.1 In the board's view, the skilled person would not understand claim 1 as granted as covering the third possibility as set out by the opponent, where arbitrarily some cracks, holes and porous zones are sealed whilst others are not sealed.

The skilled person would understand "where necessary" as requiring that cracks, holes and porous zones are sealed in order to prevent the passage of fluids

through the surface as expressly stated in the originally filed description, page 4, lines 19 to 21 (see contested patent, paragraph [0033]).

1.5.2 Even if it were assumed for the sake of argument that the translation into English of "*eventualmente*" in claim 1 must be understood as "optionally" (as put forward by the opponent, but disputed by the patent proprietor), claim 1 as originally filed presented a difference between the sealing of the non-visible surface and the edge surfaces, in that the sealing of the edge surfaces was optional, whereas the sealing of the non-visible surface was not optional. The introduction of the term "where necessary" requires that the edge surfaces must be sealed at least where cracks, holes and porous zones are present in order to prevent the passage of fluids through the surface, it is therefore no longer an optional feature, as set out on page 4, lines 19 to 21 of the originally filed description.

1.5.3 The skilled person has therefore not been presented with any new technically relevant information (see CLB, II.E.1.3.2) and directly and unambiguously derives from the application documents as originally filed the feature that the edge surfaces should be sealed where necessary.

2. *Sufficiency of disclosure - patent as granted - Article 100(b) EPC*

2.1 In the decision under appeal, the opposition division found, with respect to then auxiliary request 1, that the invention claimed in claim 1 was sufficiently disclosed for the skilled person to carry it out (see decision under appeal, II.15).

2.2 In its statement of grounds of appeal, the opponent contested this finding.

According to the opponent, it was not clear from feature e) of claim 1 whether pressure had to be applied only to the resin or to both the resin and the bounding perimetral bead. If the skilled person considered the description of the contested patent (paragraphs [0067], [0069] and [0087]; figure 9a) it appeared that the sheet of anti-adhesive material had to exert pressure on the resin, in order to penetrate into cracks, but the sheet was kept apart from the resin by the adhesive perimetral bead.

Further, the skilled person did not know whether the finishing step of feature h) had to be carried out with or without removal of the anti-adhesive sheet or the compressed perimetral bead.

2.3 The board finds neither argument convincing.

2.3.1 As reasoned by the opposition division, feature e) of claim 1 requires that pressure is applied to the resin using a press ram. This method step is described in paragraphs [0087] to [0089] and figures 8 to 9b of the contested patent (see decision under appeal, page 9, first paragraph).

The opponent argued that the perimetral bead kept the press ram from applying pressure according to figure 9a. In the board's view, however, it is within the common general knowledge of the skilled person to operate a press ram so that it compresses the perimetral bead sufficiently to bring the sheet into contact with the resin and apply pressure to the resin.

The opponent has not presented any serious doubts, substantiated by verifiable facts that the skilled person is unable, using their common general knowledge, to carry out this step (see CLB, II.C.9.1).

2.3.2 Regarding the objection that the skilled person did not know whether or not to remove the sheet or the bead before machining, the board notes that claim 1 of the main request requires only that a perimetral bead is applied (feature c)) and forms a zone for the resin (feature d)), and that a sheet is arranged on top of the slab (feature e)). The claim does not set out at which point the bead or sheet are removed. However, this does not lead to a lack of sufficiency. The opponent has not argued or demonstrated, that the skilled person is unable to apply the bead such that it forms a zone for the resin, or to arrange a sheet on top of the slab, as is required by claim 1. The opponent failed also to provide any evidence or convincing arguments that the skilled person would not be able to machine the slab with or without removal of the sheet or the bead.

2.4 The opponent raised a further objection under Article 100(b) EPC in its reply to the patent proprietor's appeal, in relation to the term "where necessary" in feature a) of claim 1 of the patent as granted.

2.4.1 The opponent argued that there was no disclosure in the contested patent relating to which parameters should be taken into account when deciding where it was necessary to seal cracks, holes and porous zones in the surfaces of the slab edges, and that the skilled person was therefore unable to determine where to seal the edge surfaces.

2.4.2 In the board's view this is a clarity objection as the opponent has not shown that the skilled person is unable to seal cracks, holes and porous zones, but argued only that the skilled person could not determine whether sealing, or not sealing, a crack, hole or porous zone fell within the scope of the claim.

As the term "where necessary" was present in claim 1 as granted, this term cannot be examined for clarity as set out in G 3/14.

2.5 The opponent has therefore not convincingly demonstrated that the invention was not sufficiently disclosed (Article 100(b) EPC).

2.6 In light of the above conclusion, it is not necessary to consider the patent proprietor's arguments that the opponent's submissions on this point were not sufficiently substantiated (Article 12(3) RPBA) and included new objections which should not be admitted under Article 12(4) RPBA.

3. *Inventive step - claim 1 as granted - Articles 100(a) with 56 EPC - D1 in combination with D2*

3.1 In the decision under appeal, the opposition division found that the subject-matter of claim 1 of auxiliary request 1 was inventive in view of document D1 with any of documents D2 to D7 (see decision under appeal, II.16.2.1 to II.16.2.2).

3.2 The opponent contested this finding and argued that the subject-matter of claim 1 was obvious in view of document D1 with any of documents D2 to D6.

3.3 *Starting point and distinguishing features*

3.3.1 It appears to be common ground that document D1 is a suitable starting point for assessing whether the subject-matter of claim 1 of the main request is inventive.

3.3.2 It appears also to be common ground between the parties that parts of feature e) of claim 1, namely "*arranging on top of the slab a sheet (32) of anti-adhesive material*" and applying pressure on the resin "*by means of a press ram*" are not disclosed in D1.

3.3.3 It was disputed by the patent proprietor that part of feature a) was disclosed in D1 in combination with feature c). According to the patent proprietor, the embodiments showing sealing of the edge surface (D1, paragraph [0027]) and providing an adhesive bead (D1, paragraph [0028]) were mutually exclusive embodiments.

3.3.4 The opponent argued that there was no indication in document D1 that the two embodiments were mutually exclusive and that the general disclosure in paragraph [0026] set out what was required from the peripheral barrier.

3.3.5 The board came to the conclusion that the two embodiments are not presented as being mutually exclusive. This is in particular because, as argued by the opponent, paragraph [0026], last bullet point, provides a general teaching to the skilled person on how to apply a peripheral containing barrier 19, i.e. "*in such a manner as to avoid the presence of passageways for the resin between said barrier 19 and the surface of slab 11 such barrier is associated with*". This is therefore the only constraint for the

skilled person who would directly and unambiguously derive that the barrier is to be applied on the surface of the slab possibly also on the side surfaces as exemplified in the first embodiment of paragraph [0027]. As a consequence, the first embodiment requires that a tape is applied around the whole edge surface, and not just above the exposed face.

3.3.6 The distinguishing features with respect to D1 are therefore viewed as "*arranging on top of the slab a sheet (32) of anti-adhesive material*" and applying pressure on the resin "*by means of a press ram*".

3.4 *Objective technical problem*

3.4.1 In the decision under appeal, the opposition division considered different objective technical problems to be solved, namely "*increasing the pressure acting on the resin layer in order to improve the penetration of the resin into the cracks of the slab due to the prevailing vacuum conditions*" (see decision under appeal, II.16.2.1, first paragraph); "*finding a more effective solution for applying pressure on the resin*" or "*finding an alternative pressure applying means*" (see decision under appeal, II.16.2.2, first paragraph).

3.4.2 The opponent argued in its statement of grounds of appeal that the objective technical problem should be formulated as "providing an alternative method for applying pressure to the resin" as document D1 already taught that pressure was applied to push the resin infiltration and consequent slab impregnation (see D1, column 6, lines 25 to 30).

3.4.3 The patent proprietor requested in their submissions of 5 August 2025, that this objective technical problem

and its associated arguments not be admitted into the appeal proceedings (Article 12(4) RPBA) as it was an amendment to the opponent's appeal case. According to the patent proprietor, during the opposition proceedings the opponent had acknowledged that applying pressure on the resin by means of a press ram represented an improvement over D1, not merely an alternative.

3.4.4 The board notes that in the decision under appeal, the opposition division referred to a line of argument of the opponent where the objective technical problem was that of "finding an alternative pressure applying means" (see decision under appeal, point II.16.2.2). This is regarded as equivalent to the objective technical problem used by the opponent in its statement of grounds of appeal. As the objective technical problem used by the opponent was therefore present in the decision under appeal it does not constitute an amendment to the opponent's case and forms part of the appeal proceedings (Article 12(1)(a) RPBA).

3.4.5 The patent proprietor disagreed with this formulation and argued that the objective technical problem was to improve penetration of the resin inside the cracks, cavities and pores of the slab, as set out in paragraph [0025] of the contested patent.

However, it has not been demonstrated that the use of the press ram and anti-adhesive sheet in a vacuum as required by claim 1 of the main request, gives any further technical effect beyond what is achieved in D1 through the increase of pressure within the chamber (D1, column 6, lines 25 to 30).

The patent proprietor argued in their submissions of 5 August 2025 that the sheet must form a hermetically sealed pocket with the adhesive bead and the visible surface of the slab, such that no resin could leave this pocket. In addition, the sheet must exert a thrusting force on the resin causing it to be drawn inside the holes and cracks present in the slab, after the vacuum conditions and the pressure from the press ram have been removed. The patent proprietor referred to paragraphs [0088], [0089] and [0092] of the contested patent as support for these functions of the sheet of feature e).

The board however notes that the description cannot be relied on to read into a claim an implicit restrictive feature not suggested by the explicit wording of the claim (see CLB, II.A.6.3.4). Claim 1 requires only that a sheet of anti-adhesive material is arranged on top of the slab. There is no indication in the claim that the sheet must form a hermetically sealed pocket and increasingly force the resin inside the impregnated cracks, nor that the sheet in claim 1 has any purpose other than protecting the press ram and the resin surface from one another. Claim 1 does not indicate that any sealing is required between the sheet and the perimetral bead, nor at which point in the claimed method steps the sheet is to be removed, so that the effects mentioned by the patent proprietor are not necessarily achieved by the features of claim 1 and the objective technical problem is therefore formulated as suggested by the opponent, namely as the provision of an "alternative method for applying pressure to the resin".

Although the opposition division appeared to reason that this objective technical problem contained

pointers to the solution, the board cannot see how the provision of an alternative to the prior art contains any pointers to the solution.

3.5 *Disclosure of D2*

3.5.1 The opponent argued that document D2 disclosed the distinguishing features of feature e) in claim 1 and column 5, lines 13 to 15, and line 48 to column 6, line 13.

3.5.2 The patent proprietor did not dispute this with their reply to the opponent's appeal but at the oral proceedings before the board, the patent proprietor raised the objection that the sheet in D2 was not "anti-adhesive" as required by feature e) of claim 1 as granted. The patent proprietor confirmed that this point had not been raised in writing in the appeal proceedings prior to the oral proceedings before the board.

3.5.3 According 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.

In the present case, the patent proprietor argued that as document D2 was already part of the appeal proceedings, the amendment to their case amounted to a new argument only. The patent proprietor did not argue that any exceptional circumstances were present in the appeal case.

The board decided not to admit the amendment to the patent proprietor's appeal case as no exceptional circumstances were present which would have justified such a late submission. The board did not regard the amendment as merely relating to fine-tuning of an existing line of argument but rather as a new assertion of fact, i.e. what the skilled person would derive from the disclosure of document D2 (see CLB, V.A.4.2.3 o), V.A.4.2.3 n)(i) and V.A.4.2.3 p)).

3.5.4 The board, therefore, concludes that the distinguishing feature of claim 1 as granted (feature e)), is disclosed in document D2.

3.6 *Obviousness*

3.6.1 The patent proprietor argued in their reply to the opponent's appeal that the opponent did not explain how and why the skilled person would have combined document D1 with *inter alia* D2, but repeated its arguments made in the opposition proceedings. According to the proprietor the opponent therefore did not set out clearly why the decision under appeal should be reversed, as required by Article 12(3) RPBA.

The board notes that in the decision under appeal, the opposition division reasoned in relation to documents D2 to D6 that these documents only taught to use a press ram for manufacturing slabs, but not for consolidating them (see decision under appeal, point II.16.2.1, third paragraph).

In its statement of grounds of appeal, page 16, fourth paragraph from the bottom to page 18, first paragraph, the opponent gave arguments relating to this reasoning of the opposition division, in particular, why the

skilled person would understand that the means of applying pressure used for manufacturing slabs would be equally valid for reinforcement of existing slabs.

Therefore the board is of the view that the opponent's arguments fulfil the requirements of Article 12(3) RPBA.

3.6.2 The patent proprietor argued that the skilled person would not have considered document D2 as it was from a different technical field and disclosed a method for compacting a mixture of granulated stone materials and resin to form a slab, rather than a method for consolidating a slab which already existed. Further, the skilled person would not combine the teaching of the two documents as D2 disclosed the use of vibratory compaction and the skilled person would be concerned that this vibration might cause further damage to a pre-existing slab.

3.6.3 The board is not convinced by the patent proprietor's arguments.

Regarding the technical fields of documents D1 and D2, the board agrees with the opponent, that the skilled person would consider the manufacturing of artificial stone slabs, as in D2, to be a neighbouring technical field to that of reinforcing a slab of natural or artificial stone as in claim 1 of the main request and document D1. Both documents D1 and D2 deal with applying pressure to stone material and resin in order to eliminate voids contained within the material.

It is established case law that the state of the art to be considered when assessing inventive step includes relevant art in neighbouring fields (see CLB, I.D.8.2).

Therefore, the skilled person starting from D1 and faced with the above objective technical problem would consider document D2.

3.6.4 Regarding the use of vibratory compaction, claim 1 does not exclude that a vibratory device is used in addition to a press ram. The patent proprietor alleges that vibration might crack the slab or spread the resin rather than allowing it to penetrate, but there is no evidence to suggest that the skilled person, from their common general knowledge, would see this as an inevitable consequence when using the press ram of document D2. The skilled person would therefore not regard the use of vibration in the method of document D2 as preventing the use of this teaching in the method of D1.

The skilled person would view the use of a press ram under vacuum conditions, together with an anti-adhesive sheet, as disclosed in D2, as an obvious alternative method for applying pressure to the resin of the slab of D1.

3.7 As the subject-matter of claim 1 is obvious in view of documents D1 and D2, the main request is not allowable.

3.8 *Request for remittal - Article 11 RPBA*

3.8.1 At the oral proceedings before the board, during the discussion of inventive step, the patent proprietor requested that the case be remitted to the opposition division to enable a full discussion of inventive step.

3.8.2 According to Article 11 RPBA, a board should not remit a case unless special reasons present themselves for doing so.

The aim of Article 11 RPBA is to reduce the likelihood of a "ping-pong" effect between the boards and the opposition divisions which could lead to an undue prolongation of the entire proceedings before the EPO (see CLB, V.A.9.1.2).

3.8.3 In the present case, although an objection of lack of inventive step in view of documents D1 and D2 of the main request was not decided upon in the decision under appeal, the parties had the opportunity to present their complete cases during the written part of the appeal proceedings since the main request (the patent as granted) has always formed part of the proceedings.

The objection was also present and had been decided on in the decision under appeal with respect to the then first auxiliary request and the only difference between the main request and the then first auxiliary request is that feature a) in the main request has the term "where necessary" rather than "optionally" with respect to the sealing of the edge surfaces.

3.8.4 Consideration of the issue of inventive step in view of D1 and D2 for claim 1 of the main request therefore did not place an undue burden on either the parties or the board. By dealing with the issue in the appeal proceedings the inevitable prolongation of the entire proceedings following a remittal was therefore avoided.

4. *Auxiliary request 13 - request not to admit the auxiliary request*

4.1 At the oral proceedings before the board, the opponent requested that auxiliary request 13 not be admitted

into the appeal proceedings due to a belated substantiation of this request.

The opponent argued that auxiliary request 13 had not been substantiated when it was first filed in opposition proceedings as auxiliary request 1 in the patent proprietor's reply of 16 December 2022 to the notice of opposition. The request had also not been substantiated when it was re-filed as auxiliary request 13 with the patent proprietor's reply to the opponent's appeal.

4.2 The opponent confirmed at the oral proceedings before the board that the request not to admit the auxiliary request had not previously been raised. As justification for the lateness of the request, the opponent argued that it had been raised at a late stage for tactical reasons. If it would have requested the non-admittance of auxiliary request 13 immediately after it was filed with the patent proprietor's reply, there would have still been an opportunity for the patent proprietor to then substantiate the request before the notification of the board's communication. For this reason the opponent decided to wait until the oral proceedings to make the request not to admit the auxiliary request.

4.3 The patent proprietor requested that the opponent's request not be admitted into the appeal proceedings as it was late-filed and there were no exceptional circumstances justifying its admittance at such a late stage of the proceedings.

4.4 The board decided not to admit the opponent's request not to admit auxiliary request 13 as the opponent's request was an amendment to its appeal case and no

exceptional circumstances were present (Article 13(2) RPBA).

4.4.1 This board follows the line of case law that a request for non-admittance of another party's submissions raised for the first time at the oral proceedings, can be regarded as an amendment to a party's appeal case (see CLB, V.A.4.2.3 j), in particular T 18/21, Reasons 2.1 to 2.4).

4.4.2 In its statement of grounds of appeal, the opponent referred to the patent proprietor's auxiliary requests and briefly discussed them in substance, without any mention of a lack of substantiation. Although at this point there was no requirement of the opponent to pre-emptively discuss auxiliary requests which had not yet been submitted in the appeal proceedings, as the opponent chose to deal with the auxiliary requests in substance in its statement of grounds of appeal, it could have also dealt with the issues of substantiation and admittance at that point.

In any case, once the auxiliary requests had been re-filed with the patent proprietor's reply to the opponent's appeal, the opponent could and should have raised its objection to their admittance in writing, allowing the patent proprietor to react to the objection, and the board to issue a preliminary opinion on the matter.

4.4.3 It cannot be seen as an exceptional circumstance that the request not to admit the auxiliary request was first made at the oral proceedings before the board for tactical reasons, as the opponent argued. There is a general duty on a party to the proceedings to make its

case as early and completely as possible (CLB, V.A. 4.4.1).

The board therefore exercised its discretion not to admit the request not to admit auxiliary request 13 (Article 13(2) RPBA).

5. *Auxiliary request 13 - claim 1 - inventive step (Article 56 EPC) - D1 and D2*

5.1 The opponent argued that the features introduced into claim 1 of auxiliary request 13 were apparatus features which did not limit the method of claim 1, so that the additional features had no technical effect and the subject-matter of claim 1 was not inventive for the same reasons as for claim 1 of the main request.

5.2 The board however agrees with the patent proprietor that the use of the conformable element and the air flow vents in the method of claim 1 of auxiliary request 13 do have a technical effect. They allow the sheet to be held by the press ram after it is raised (as set out in paragraphs [0081] and [0084] of the contested patent). The objective technical problem to be solved is therefore to reduce the working time. As there is no disclosure of the conformable element or the air flow vents in either document D1 or D2, the skilled person combining the teaching of the two documents does not arrive at the subject-matter of claim 1 of auxiliary request 13 in an obvious manner.

5.3 In view of the above findings it is not necessary to set out here why the board admitted the objection, nor why the board refused the patent proprietor's request for remittal of the case to the opposition division.

6. The opponent raised no further objections to the set of claims of auxiliary request 13.

The patent can be maintained in amended form on the basis of this set of claims.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division with the order to maintain the patent in amended form on the basis of auxiliary request 13 filed with the reply to the appeal of the opponent and a description to be adapted thereto.

The Registrar: The Chairman:

G. Nachtigall G. Patton

Decision electronically authenticated