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Datasheet for the decision of 21 May 2026

Case Number: T 0842/24 - 3.3.03

Application Number: 19751764.2

Publication Number: 3613794

IPC: C08J3/12, C08L1/12, A61K8/73, A61K8/02, A61Q1/02

Language of the proceedings: EN

Title of invention:
CELLULOSE ACETATE PARTICLES, COSMETIC COMPOSITION, AND METHOD OF PRODUCING CELLULOSE ACETATE PARTICLES

Patent Proprietor:
Daicel Corporation

Opponent:
Cerdia International GmbH

Relevant legal provisions:
EPC Art. 113(1), 114(2)
EPC R. 103(1)(a), 103(4)(c)
RPBA 2007 Art. 12(4)
RPBA 2020 Art. 11, 12(2), 12(4), 12(6), 13

Keyword:
Sufficiency of disclosure objection submitted in writing and not taken into account by the opposition division while maintaining the patent in amended form -
susbtantial procedural violation (yes)
Reimbursement of appeal fee - equitable by reason of a substantial procedural violation
Evidence and new objection admitted into the proceedings forming the basis for the contested decision are part of the appeal proceedings (yes)
New document submitted on appeal in reply to evidence submitted shortly before the oral proceeding before the opposition division on the basis of which novelty was denied
admitted (yes) - fresh case on novelty
Remittal to the opposition division

Decisions cited:
G 0007/93, G 0004/95, G 0001/21, R 0017/11, T 0640/91, T 1209/05, T 1549/07, T 0467/08, T 1485/08, T 1652/08, T 1253/09, T 1852/11, T 2513/11, T 1568/12, T 1883/12, T 1271/13, T 1690/15, T 1711/16, T 2730/16, T 0776/17, T 0879/18, T 0526/21, T 0989/23

Catchword:
There is no legal basis for reversing in appeal a decision by the opposition division to admit new evidence into the opposition proceedings and thus to retroactively reject in appeal specific facts which had been admitted into the appeal proceedings if that evidence formed the basis of the decision taken on substantive grounds. It cannot be derived from G 7/93 that the criteria stated therein for overruling the way in which a department of first instance has exercised its discretion also apply to the case where evidence was admitted and the decision taken on substantive grounds was based thereon. (see Reasons 4.1 to 4.6)

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Case Number: T 0842/24 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 21 May 2026

Appellant: (Patent Proprietor)	Daicel Corporation 3-1, Ofuka-cho, Kita-ku Osaka-shi Osaka 530-0011 (JP)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Appellant: (Opponent)	Cerdia International GmbH St. Alban-Anlage 58 4052 Basel (CH)
Representative:	Meissner Bolte Partnerschaft mbB Patentanwälte Rechtsanwälte Bahnhofstraße 18 1/2 86150 Augsburg (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted/ electronically transmitted on 7 May 2024 concerning maintenance of the European Patent No. 3613794 in amended fo rm.**

Composition of the Board:

Chairman	D. Semino
Members:	F. Rousseau
	A. Bacchin

Summary of Facts and Submissions

I. The appeal lies from the interlocutory decision of the opposition division according to which European patent No. 3 613 794 as amended according to the claims of the Second Auxiliary Request submitted with letter of 9 March 2023, a description adapted thereto and Drawings Sheets 1 and 2 met the requirements of the EPC. The decision was also based on the patent as granted as a Main Request and the First Auxiliary Request submitted with letter of 9 March 2023.

II. The following items of evidence were submitted, *inter alia*, during the opposition proceedings:

D10: CN 10 29 11 379 A and machine translation thereof (D10a)
D23: Correspondence with Mitani Corporation
D24: Evaluation of surface smoothness
D29: Analysis of the SEM images shown in Figures 1 to 4 of D10 using the WinRoof software
D30: Demonstration of the use of the WinRoof software.

III. The reasons for the contested decision which are relevant to the appeal proceedings can be summarized as follows:

(a) D29 and D30 were admitted into the proceedings.

Main Request and First Auxiliary Request

(b) Taking into account the calculations in D29, the cellulose acetate particles shown in Figure 4 of D10 met the parametric requirements set out in

claim 1 of both the Main Request and the First Auxiliary Request. Those requests were therefore not allowable for lack of novelty over D10.

Second Auxiliary Request

(c) The minimum surface smoothness of the cellulose acetate particles of 90% defined in claim 1 of the Second Auxiliary Request was above the value calculated in D29 for the particles shown in Figure 4 of D10. Therefore, claim 1 of the Second Auxiliary Request met the requirements of Article 54 EPC.

(d) An inventive step was acknowledged, D10 representing the closest prior art.

(e) The fresh ground of opposition under Article 100 (b) EPC was admitted into the proceedings. However, the objection concerning the measurement of the surface smoothness using the "WinROOF" software did not convince.

(f) For these reasons, the claims of the Second Auxiliary Request were found to comply with the requirements of the EPC.

IV. An appeal was filed by both the patent proprietor and the opponent. Both parties filed a statement of grounds of appeal, a rejoinder and a reply to the rejoinder of the other party.

V. With their statement of grounds of appeal, the patent proprietor submitted the following document:

D31: Experimental repeat of Example 4 of D10 and measurement of the surface smoothness of the resultant particles.

VI. The requests of the parties are as follows:

The opponent requests that the case be remitted to the opposition division and the appeal fee be reimbursed, since the objection of lack of sufficiency of disclosure concerning the products of claim 1 obtained without the use of a plasticiser was not dealt with in the contested decision.

Alternatively, the opponent requests that the decision of the opposition division be set aside and that the patent be revoked to the extent it claims subject-matter within the ambit of granted claims 1 to 13.

The patent proprietor requests as their Main Request that the decision of the opposition division be set aside and the opposition be rejected. In the alternative, the patent proprietor requests that the decision under appeal be set aside and the patent be maintained in amended form on the basis, in this order, of one of the First to the Thirteenth Auxiliary Requests, whereby the First to the Seventh and the Eleventh Auxiliary requests were submitted with letter of 9 March 2023, and the Eighth to the Tenth, the Twelfth and the Thirteenth Auxiliary Requests were submitted with letter of 16 February 2024.

VII. In preparation of the oral proceedings, a communication pursuant to Article 15(1) RPBA conveying the Board's provisional opinion was issued. The Board indicated the preliminary view that:

(i) the substantial procedural violation alleged by the opponent concerned all claim requests underlying the contested decision, which claim requests were maintained on appeal. Under these circumstances, the opponent's request to remit the case to the opposition division for examining that objection allegedly omitted in the contested decision took precedence over the opponent's substantive requests,

(ii) the Board was not empowered to review the way the opposition division used its discretion to admit D29 into the proceedings, which document was therefore in the proceedings,

(iii) the Board intended to exercise its discretion pursuant to Article 12(4) RPBA by admitting D31 into the proceedings,

(iv) the assessment of the opponents's lack of novelty objection over the particles shown in Figure 4 of D10 in the light of D29 taking into account the patent proprietor's submissions based on experimental report D31 amounted to a fresh case on novelty,

(v) the failure of the opposition division to give due consideration to the submissions based on D24 concerning the surface smoothness measurement insufficiency objection concerning claim 1 of the Second Auxiliary Request constituted a violation of the right to be heard in contravention of Article 113(1) EPC,

(vi) the Board intended to exercise its discretion pursuant to Article 12(4) RPBA by admitting the reverse engineering argument into the proceedings which argument had been submitted by the patent proprietor

concerning the surface smoothness measurement insufficiency objection,

(vii) the failure of the opposition division to give due consideration to the plasticizer insufficiency objection concerning the subject-matter of claim 1 of the Second Auxiliary Request constituted a substantial violation of the opponent's right to be heard in contravention of Article 113(1) EPC,

(viii) a reimbursement of the appeal fee of the opponent was justified,

(ix) the need to assess novelty of the subject-matter of claim 1 of the Main and First Auxiliary Requests taking into account D31 and the fundamental procedural deficiencies in the first-instance proceedings mentioned in points (v) and (vii) above constituted special reasons within the meaning of Article 11 RPBA justifying remittal to the department that issued the contested decision.

VIII. The opponent and the patent proprietor replied to the Board's communication with letters of 4 May 2026 and 5 May 2026, respectively. With these letters, based on the Board's preliminary opinion expressed in the communication under Article 15(1) RPBA, both parties withdrew their requests for oral proceedings.

IX. Oral proceedings were cancelled and the parties informed accordingly.

X. The parties' arguments, in so far as they are pertinent for the present decision, may be derived from the reasons for the decision below.

Reasons for the Decision

Decision in written proceedings

1. The present decision is taken in written proceedings without holding oral proceedings.

Both the opponent and the patent proprietor withdrew their request for oral proceedings (see point VIII above) on the basis of the Board's preliminary opinion expressed in the communication under Article 15(1) RPBA.

The parties have been informed of the Board's preliminary assessment of the case, in which their whole submissions have been duly taken into consideration and have been given the opportunity to make further submissions (Article 113 EPC).

In view of the fact that the case is ready for decision on the basis of the parties' written submissions, the Board issues this decision in written proceedings in accordance with Article 12(8) RPBA.

Main Request

2. With respect to the Main Request (patent as granted), the contentious points concerning the substantive issues are:

- (i) novelty of the cellulose acetate particles of claim 1 over those shown in Figure 4 of D10 and

- sufficiency of disclosure of the particles of claim 1, for which two separate issues have been addressed by the opponent, namely

(ii) measurement of the surface smoothness using the "WinROOF" software and

(iii) the preparation of the particles without the use of a plasticizer.

Issues (ii) and (iii) are thereafter referred to as the "surface smoothness measurement insufficiency objection" and "plasticizer insufficiency objection", respectively.

3. In order to take a decision on the above substantive issues, it is first necessary to address the following procedural requests:

- the question as to whether D29 and D30, which are used as evidence in the contested decision and the appeal proceedings with respect to objections (i) and (ii), respectively, are to be taken into account in the appeal proceedings

- admittance of D31 submitted by the patent proprietor in relation to objection (i)

- admittance of objection (iii) which was not dealt with in the contested decision.

Status and admittance of D29

4. It is undisputed by the patent proprietor that the decision that claim 1 of the Main Request lacked novelty over the particles shown in Figure 4 of D10 was taken in the light of D29 admitted into the proceedings during the oral proceedings before the opposition

division (statement of grounds of appeal, page 2, point 2.1).

The patent proprietor requests to reverse the opposition division's decision to admit D29. It is the patent proprietor's opinion that a review and evaluation of the way the first instance body used its discretion in this context is possible.

In the opinion of the Board, this is not supported the EPC, the RPBA or the Case Law.

4.1 Evidence submitted by a party can be hold inadmissible and hence disregarded in the appeal proceedings only on the basis of Article 114(2) EPC. Articles 12(4), 12(6) and 13 RPBA regulate the application of Article 114(1) EPC in appeal proceedings. However, once a document was admitted and formed the basis of the decision of the opposition division and therefore became part of the opposition proceedings, it cannot be retroactively excluded from the appeal proceedings pursuant to these provisions of the RPBA concerning admissibility of an amendment to a party's case (Article 12(4) RPBA), admissibility of requests, facts, objections or evidence which were not admitted, should have been submitted, or which were no longer maintained, in the proceedings leading to the decision under appeal (Article 12(6) RPBA) or admissibility of an amendment to a party's appeal case after it has filed its grounds of appeal or reply (Article 13 RPBA).

4.2 Accordingly, there is no legal basis for reversing in appeal a decision by the opposition division to admit new evidence into the opposition proceedings and thus to retroactively reject in appeal specific facts which had been admitted into the appeal proceedings if that

evidence formed the basis of the decision taken on substantive grounds. This aligns with the primary object of the appeal proceedings set out in Article 12(2) RPBA, which is to review the decision under appeal in a judicial manner, and the indication therein, that a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based.

This also corresponds to the situation prior to the entering into force of the current version of the RPBA. For example, decision T 467/08 (Reasons 1.2.2) confirmed that once a document was admitted by the opposition division and therefore became part of the opposition proceedings, it cannot be excluded from the appeal proceedings pursuant to Article 12(4) RPBA 2007.

4.3 The Board is also aware of decision T 989/23, which concerns a case where the Board reversed the decision of the opposition division to admit an auxiliary request into the proceedings. However, in case T 989/23 the opposition division had not taken a decision on the substance of that auxiliary request, as the patent was maintained on the basis of an auxiliary request of higher ranking. Accordingly, the reasoning in points 4.1 and 4.2 above is not in conflict with decision T 989/23 where the auxiliary request admitted at the opposition division's discretion did not form the basis for the decision to maintain the patent in amended form.

4.4 The jurisprudence of the Boards of Appeal regarding the review of the opposition division's discretionary power under Article 114(2) EPC is based on a principle established in decision T 640/91 and G 7/93 (Case Law of the Boards of Appeal, 2025, 11th Edition, IV.C.4.5.2

and V.A.3.4). According to this principle, a board of appeal should only overrule the way in which a department of first instance has exercised its discretion when deciding on a particular case if it concludes that it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way, and has thus exceeded the proper limits of its discretion.

However, it is important to note that this principle was established in the context of reviewing a decision not to admit a requested amendment after issuance of a Rule 51(6) EPC communication (G 7/93, Reasons 2.6 with reference to Reasons 2.5) or not inviting a party to file further observations before issuance of a decision to refuse the application (T 640/91). This principle was also applied by the boards when reviewing discretionary decisions not to take a party's means of defence into account, e.g. documents (Case Law, IV.C. 4.5.2, T 1485/08, T 1652/08, T 1253/09, T 1568/12, T 1883/12, T 1271/13, T 1690/15, T 1711/16).

4.5 The Board is aware that in a few cases this principle has also been invoked in the context of reviewing the opposition division's discretionary decisions to admit documentary evidence on which the reasons for the decisions were based. This has been mainly limited to cases of errors in exercising discretion or procedural errors (Case Law, IV.C.4.5.2, T 1209/05, T 1652/08, T 1852/11, T 2513/11). In other decisions it has been questioned whether submissions admitted and forming the basis for the contested decision (evidence, claim requests) could be at all excluded from the proceedings on appeal even if the opposition division had exceeded the proper limits of its discretion in admitting them (Case Law, V.A.3.4). It is nevertheless noted that in

none of these decisions the circumstances of the case were such as to justify reversal of the discretionary decision.

4.6 In this context, given the procedural asymmetry between situations where evidence is admitted or is not admitted, the Board has strong reservations that the principle established in decisions T 640/91 and G 7/93 is also appropriate for reviewing the discretion exercised in a decision to admit evidence into the proceedings. This is in line with and confirmed by the absence of a legal basis for overturning a decision to admit evidence into the proceedings where the decision is based on that evidence.

In the context of non-admittance, the only way to challenge a substantive decision that does not take that (non-admitted) means of defence into account is to contest the non-admittance thereof. A review by a board of the discretion exercised by the opposition division is also imperative, if it is submitted that the exercise by the opposition division of its discretionary power constituted a substantial procedural violation. For example, the non admittance of a necessary means of defence that has been submitted in a timely manner to a new development in the proceedings would exceed the proper limits of the opposition division's discretion, as it would constitute an infringement of the right to be heard. The same applies where the opposition division does not allow an amended set of claims in response to an opponent's fresh objection (T 879/18, Reasons 3.3 to 3.6).

On the other hand, a review of a decision by the opposition division to admit evidence or a claims

amendment into the proceedings is not a necessary means to safeguard a party's right for a proper defence.

The admittance of a new evidence, even if its filing was not justified, does not lead itself to an unequal treatment of the parties and therefore a procedural violation. Rather it is the absence of a proper opportunity for the opposing party to respond to that new piece of evidence and submissions based thereupon, once it has been admitted, which constitutes a breach of the right to be heard. Indeed, Article 113(1) EPC reflects the principle that for *inter partes* proceedings each party should have a proper opportunity to reply to the case presented by an opposing party (G 4/95, Reasons 10). It is referred to T 776/17 making that distinction (Reasons 26.1 and 26.2).

Furthermore, a decision by the opposition division on substantive issues, based on evidence which has been admitted into the proceedings, can still be challenged in substance, on the ground that this evidence lacks relevance or probative value.

Also on this basis, the Board does not find any reason why a decision to admit an auxiliary request or piece of evidence should be reviewed on appeal if a party requests it, in order to determine whether discretion was exercised appropriately. The board should instead just fully review the appealed decision in substance.

In view of this the Board considers that it cannot be derived from G 7/93 that the criteria stated therein for overruling the way in which a department of first instance has exercised its discretion also apply to the case where evidence was admitted and the decision taken on substantive grounds was based thereon.

4.7 In view of the above, it is concluded that under the present circumstances the Board is not empowered to review the way the opposition division used its discretion to admit D29 into the proceedings. D29 is therefore in the proceedings.

Substantial procedural violation in relation to finding of lack of novelty over Example 4 of D10 in the light of D29

5. The main request was deemed unallowable due to a lack of novelty over Example 4 of D10, which conclusion was based on D29. D29 is a report concerning the processing of the SEM images shown in Figures 1 to 4 of D10 using the "WinROOF"software.

The patent proprietor submits that there was insufficient time to reasonably address, i.e. to familiarize themselves and react to the issues arising from D29, and that this should have been considered by the opposition division when deciding whether to admit D29 (statement of grounds of appeal, page 3, ante-penultimate and penultimate paragraphs of section 2.1.1 and page 4, section 2.1.3). The patent proprietor concludes that the timing of the filing of D29 caused them an unfair disadvantage (statement of grounds of appeal, page 5, section 2.1.6).

As indicated in point 4.5 above, the admittance of a new evidence, even if its filing was not justified, does not in itself result in unequal treatment of the parties. Rather, it is the absence of a proper opportunity for the other party to respond to the new evidence and submissions based thereupon once it has been admitted that leads to unequal treatment of the parties, which is in essence the patent proprietor's

opinion, albeit argued in the context of the admittance of D29.

Therefore, the patent proprietor's submissions raise the question of whether, during the oral proceedings, the opposition division committed a violation of the right to be heard under Article 113 EPC by deciding a lack of novelty of claim 1 of the Main Request based on D29 without giving the patent proprietor more time to react to the filing of that evidence.

5.1 In this regard, it is apparent that the attack of novelty based on the Figure 4 of D10 was raised at the earliest two days before the oral proceedings. Figure 4 of D10 concerns cellulose acetate microspheres according to the method of Example 4 of that document whose particle size is within the range of 5 µm to 50 µm (page 8, paragraph [0046]; the passages of D10 referred to are those of the translation thereof in English D10a).

This corresponds to an additional objection of lack of novelty, as the novelty attack previously submitted concerned different cellulose acetate microspheres particles, namely those shown in Figure 2 of D10 which are obtained according to the method of Example 2 with a particle size of 100 µm (page 8, paragraph [0044]) (notice of opposition, pages 20 and 21, section 4.19; opponent's letter of 15 April 2024, page 3, point 2, second paragraph).

It is also not apparent that the opponent made additional written submissions concerning novelty over D10 between the notice of opposition and the letter of 15 April 2024 sent two days before the oral proceedings.

5.2 The relevant passage of the opponent's letter of 15 April 2024 concerning D10 reads as follows (page 3, starting at the third paragraph) with the translation thereof by the Board provided thereafter:

"*Ergänzend zu unserem Vortrag im Einspruchsschriftsatz unter Randnummer 4.19) überreichen wir in der Anlage die WinROOF- Auswertung der in FIG. 1 bis FIG. 4 des Dokuments D10 gezeigten REM-Aufnahmen der aus diesem Stand der Technik bekannten Celluloseacetat-Mikroperlen.*

Demnach weisen die aus diesem Stand der Technik bekannten Celluloseacetat-Partikel eine mittlere Oberflächenglätte von 89,674 % auf, was eindeutig in den im Merkmal M 1.4 geforderten Bereich fällt.

Bei der WinROOF-Auswertung wurde das PNG-Format für die Bilder ausgewählt, und zwar mit dem WinROOF-Parameter „Automatic Binarization".

Somit ist – wie bereits im Einspruchsschriftsatz dargelegt – auch das Dokument D10 aus neuheitsschädlich anzusehen."

"*In addition to our submissions in the notice of opposition under item 4.19), we present in the attachment the WinROOF analysis of the SEM images shown in Fig. 1 to 4 of document D10, depicting the cellulose acetate micropearls known from this prior art.*

Accordingly, the cellulose acetate particles known from this prior art exhibit an average surface smoothness of 89.674%, which clearly falls within the range required by feature M 1.4.

In the WinROOF analysis, the PNG format was selected for the images, using the WinROOF parameter "Automatic Binarisation".

Thus, as already set out in the notice of opposition, document D10 must also be regarded as detrimental to novelty".

It is even not clear from said letter if the particles shown in Figure 4 of D10 were submitted to be novelty destroying. These submissions concern the median value indicated in the second table on the last page of D29, i.e. most probably the median value corresponding to the particles shown in Figures 1 to 4. Therefore, these submissions could be merely understood as indicating that the surface smoothness of the particles of D10 was generally in accordance with operative claim 1, including those of Figure 2 on the basis of which the opponent had made their novelty attack in the notice of opposition.

5.3 According to the minutes concerning novelty in the light of D10, the opponent referred to the particles shown in Figure 2 (first and third paragraphs of section 2). While the patent proprietor argued that the particles in the pictures of D10 have different sizes and magnifications (second paragraph of section 2 of the minutes), the opponent does not seem to have provided arguments in this respect or to have pointed out to the particular relevance of Figure 4, even in relation to the question of admittance of D29.

5.4 Consequently, having regard to point 36 of the Reasons for the contested decision concerning admittance of D29, the first sentence of which reads "*Document D29 is*

a representation of the Figures shown in D10, whereas specifically Fig. 4 having a magnification of x450 was considered relevant by the Opposition Division", the lack of novelty objection over the particles shown in Figure 4 of D10, if not raised by the opposition division on its own motion, was submitted by the opponent on the day of the oral proceedings.

5.5 Deciding against the patent proprietor on the basis of a new objection raised during the oral proceedings, in the light of an experimental report filed just two days earlier, without postponing or holding second oral proceedings could be regarded as unfair to the patent proprietor. However, it is also noted that the patent proprietor took position on the objection and, most importantly, did not request for oral proceedings to be postponed, or for more time to respond to this separate objection of lack of novelty, even after the opposition division had announced their preliminary opinion that the subject-matter of claim 1 was not novel over Figure 4 of D10 (minutes, section 2, last paragraph). Indeed, neither the minutes of the oral proceedings nor the impugned decision refer to an explicit request by the patent proprietor not to admit document D29 into the proceedings. At point 38 of the reasons for the decision, the opposition division found that the patent proprietor was in a position to interpret without undue burden the calculations made in document D29. This document was discussed and understood by all parties at the oral proceedings and, for this reason, it was admitted into the proceedings. It is therefore not apparent that the opposition division committed a substantial procedural violation by admitting document D29 into the proceedings.

5.6 In view of the foregoing, the Board is of the view that deciding against the patent proprietor that the subject-matter of claim 1 of the main request lacked novelty over the particles of Figure 4 of D10 in the light of D29 without adjourning the oral proceedings did not constitute a fundamental procedural deficiency in the first-instance proceedings.

Admittance of D31

6. The filing of document D31 with the statement of grounds of appeal of the patent proprietor is to be regarded as an amendment to their case within the meaning of Article 12(4) RPBA, whose admittance, which is disputed by the opponent, is at the discretion of the Board. D31 is an experimental report in which Example 4 of D10 was repeated in order to demonstrate that the particles shown in Figure 4 of that document are not in accordance with claim 1 of the Main Request. Its filing constitutes therefore a genuine attempt to address in a timely manner the objection of lack of novelty over the particles shown in Figure 4 of D10 in the light of D29 which was raised for the first time during the oral proceedings before the opposition division. In these circumstances the Board exercises its discretion pursuant to Article 12(4) RPBA by admitting D31 into the proceedings.

Moreover, the assessment of the patent proprietor's submissions based on experimental report D31 when examining the opponent's lack of novelty objection over the particles shown in Figure 4 of D10 in the light of D29 amounts to a fresh case on novelty. This in itself constitutes a special reason within the meaning of Article 11 RPBA justifying to remit the case to the opposition division.

Sufficiency of disclosure

7. The opponent raised two separate objections of lack of sufficiency of disclosure of the subject-matter of claim 1, namely one relating to the measurement of the surface smoothness and one relating to the absence of use of a plasticizer. Both objections are based on a ground of opposition not addressed during the period to file an opposition. The opposition division only dealt with the first objection in the contested decision. Not dealing with the second objection while maintaining the patent in amended form amounts to a substantial procedural violation, as explained in the following.

Surface smoothness measurement insufficiency objection

8. It is undisputed that this objection submitted by the opponent with letter of 16 February 2024, i.e. two months before the oral proceedings, was admitted into the opposition proceedings, albeit erroneously referring to the letter of 13 July 2023 introducing the second objection not dealt with (Reasons 67), and forms the basis for the contested decision (Reasons 70 to 75). The decision is in particular based on D30 admitted into the proceedings (Reasons 71, 72 and 40). The patent proprietor requests the reversal of the first instance decision to admit D30 and that objection into the proceedings. For reasons analogous to those given in points 4.1 to 4.6 above, D30 and the surface smoothness measurement insufficiency objection must be considered to be part of the appeal proceedings. In this respect, it is also referred to decision T 1549/07 (Reasons 2.1, 2.2.5 and headnote) concerning a similar situation in which the Board found that the EPC does not contain provisions allowing the exclusion at the

appeal stage of a ground of opposition which has been introduced and forms the basis for the contested decision. On the contrary, under these circumstances and since the opponent maintained this objection in the grounds of appeal, it is mandatory for the Board to decide on it.

8.1 The submissions of the opponent before the opposition division in respect of the surface smoothness measurement insufficiency objection are to be found in their letters of 16 February 2024 (pages 5 to 9, sections 2.12 to 2.22), 28 March 2024 (page 3, last three paragraphs and page 4) and 15 April 2024 (pages 1 and 2, section 1). The submissions in the first two letters are based on evidence MBO5b and MB06, which correspond to documents D23 and D24, respectively. The opponent's submissions during the oral proceedings were also based on D23 and D24 (minutes, point 6, first paragraph). These submissions are essentially that the surface smoothness value measured for a given particle depends on numerous settings of the "WinROOF" software which according to paragraph [0082] of the specification is to be used for measuring these values.

8.2 The opponent's submissions on appeal concerning the surface smoothness measurement objection of insufficient disclosure are also based on "Anlage MB06", corresponding to D24 (statement of grounds of appeal, pages 14 to 16, section 4.10). These submissions correspond to those made with the opponent's letter of 16 February 2024. As noted by the patent proprietor's submissions in section 4.1 of their letter 10 January 2025, it is, however, not apparent that D24 was admitted into the proceedings by the opposition division, let alone that a discussion on its admittance took place during the oral proceedings. The

Board also does not find any indication in the Reasons for the contested decision that these specific submissions were taken into account.

The failure of the opposition division to give due consideration to these submissions, which seem central to the surface smoothness measurement insufficiency objection concerning claim 1 of the Second Auxiliary Request, constitutes according to the Board a violation of the right to be heard in contravention of Article 113(1) EPC.

8.3 The reasons given in respect of the substance of the surface smoothness measurement insufficiency objection appear to be found in points 71, 72 and 75 of the Reasons.

In point 71 of the Reasons the opposition division indicates that not all necessary settings for measuring the surface smoothness are disclosed in the specification and "*given the view that this parameter can be observed apparently only with a method using a proprietary program normally no uncertainty in how to perform the measurement/calculation should be accepted*".

The opposition division notes in point 72 of the Reasons that information about "*certain settings is indeed missing, such as the choice of a threshold (grayscale), i.e. the binarization mode, the brightness and the choice of the substrate*". Based on D30 the opposition division points out that "*apparently the choice of a threshold (binarization mode) seems to have an important influence on the outcome of the values surface smoothness*".

This is in agreement with the observations in the first and penultimate sentences in point 75 of the Reasons according to which "*an uncertainty in the measurement and evaluation of the parameter surface smoothness is observed*" and "*the facts (D30) and arguments provided may indicate that some doubt as to the exact boundary of the lower value of 80% (or other lower values) surface smoothness exist*".

The opposition division however concludes in point 72 that "*nevertheless, the skilled person familiar with the program WinRoof is able to chose meaningful values using the software and arrive at meaningful results*" without any further explanation.

Upon remittal, it will therefore be appropriate for the opposition division to specify which values or which results are at stake, what would be deemed meaningful, and on the basis of which objective criteria this should be assessed. It might need also to be explained as to why it was not shown that the uncertainty about the boundary of the lower value defined for the surface smoothness would detract a skilled person from providing the claimed cellulose acetate particles at all.

Admittance of reverse engineering argument

9. The patent proprietor submits with their reply to the statement of grounds of appeal (pages 13 and 14, section 4.5.1) that the skilled person carrying out the invention could calibrate the surface smoothness measurement method by reworking the examples and comparative examples of the patent in suit for which surface smoothness values are given (hereafter the reverse engineering argument).

The opponent requests that this argument not be admitted (letter of 10 February 2025, page 29, section G) 3).

The reverse engineering argument is an amendment to the patent proprietor's case within the meaning of Article 12(4) RPBA. This argument constitutes a relevant and direct response to the surface smoothness measurement insufficiency objection raised two months before the oral proceedings and admitted into the proceedings by the opposition division. Its filing became necessary, only once the opponent had filed an appeal and contested again that the measurement of the surface smoothness gave rise to an insufficiency objection. For this reason, the Board exercises its discretion pursuant to Article 12(4) RPBA by admitting the reverse engineering argument into the proceedings.

Plasticizer insufficiency objection

10. While the opponent submits that the plasticizer insufficiency objection was not taken into account by the opposition division, which would constitute a violation of their right to be heard (statement of grounds of appeal, page 3, sections 1.1 to 1.5) justifying a remittal to the opposition division and the reimbursement of the appeal fee (statement of grounds of appeal, page 10, sections 3.17), the patent proprietor brings forward that no procedural violation occurred in this respect, since this objection was not actively maintained in the oral proceedings, i.e. throughout the first instance proceedings (reply to the statement of grounds of appeal, page 2, section 2.1). For the same reason, it is the patent proprietor's

position that this objection cannot be admitted into the appeal proceedings.

10.1 The plasticizer insufficiency objection was raised with letter of 13 July 2023 (pages 19 to 21 sections 5 to 5.12) and addressed again with letter of 16 February 2024 (pages 2 to 4, sections 2.1 to 2.10) in reply to the preliminary opinion of the opposition division. Although this objection was not specifically addressed in the opponent's subsequent letter of 28 March 2024, it is pointed out at the end of it that all the arguments put forward in the written submissions of 16 February 2024 are highly relevant and must therefore be taken into account by the opposition division.

10.2 Accordingly, the patent proprietor's opinion that the plasticizer insufficiency objection was not actively maintained throughout the first instance proceedings can apparently be based solely on the fact that the minutes of the oral proceedings do not indicate that this objection was discussed and therefore not repeated by the opponent. However, the minutes do not indicate either that this objection was withdrawn. In the Board's view, not addressing an objection submitted in writing during the oral proceedings does not necessarily imply that the objection is withdrawn. This is because written submissions form the basis of the EPO proceedings and are complemented where necessary by an opportunity for a party to present and argue its case orally (G 4/95, Reasons 4 (c) and G 1/21, Reasons 40). Parties have the opportunity to repeat or expand upon some of the written submissions they consider necessary for defending their case. However, they are under no obligation to address all written submissions orally.

Referring to section III.B.2.6 of the Case Law in its 10th Edition, corresponding to section III.B.2.7 of the current edition, the patent proprietor submits that the absence of a decision on the plasticizer insufficiency objection cannot be in violation of the right to be heard, since the opponent was given the opportunity to address said objection at the oral proceedings.

The passage of the Case Law referred to by the patent proprietor reads "*The right to present comments enshrined in Art. 113(1) EPC does not need to be exercised in writing but may be satisfied by way of oral proceedings (T 1237/07). This does not mean, however, that it is for the boards to ensure, of their own motion, that all points raised at some point in the proceedings are discussed at the oral proceedings. Rather, it is for the parties to address any point they consider relevant and fear may be overlooked and to insist, if necessary by way of a formal request, that it be discussed (R 17/11). This also applies in oral proceedings before the opposition division (T 7/12).*"

The opponent, however, does not complain that no opportunity was given in the oral proceedings to make submissions in respect of the plasticizer insufficiency objection, i.e. to repeat or refine that objection put in writing, but that this objection was ignored in the contested decision. This passage of the Case Law therefore is not relevant for the opponent's point of view.

10.3 The patent proprietor is of the opinion that decision R 17/11 is relevant, as it would also concern a case where an issue had been raised by an opponent in the written phase of the appeal proceedings, but was not

maintained in the oral proceedings and therefore did not form part of the decision of the Board of Appeal. The present Board, however, notes that the patent proprietor overlooks a fundamental point made by the Enlarged Board in R 17/11. The decision concerns the complaint of a petitioner that they had neither the opportunity nor any reason during the oral proceedings to raise an objection as to the status as prior art of a document used as starting point for assessing inventive step. The Enlarged Board clarified that it is not the task of a Board of Appeal to ensure, of its own motion, that all points raised at any stage of the appeal proceedings are discussed at the oral proceedings, rather it is for the parties to raise any point they consider relevant and which, in their view, might be overlooked. However, if a Board then fails to give a party the opportunity to present its arguments, this may give rise to an objection that the right to be heard under Article 113(1) EPC has been infringed. In that case, the Enlarged Board did not conclude that the absence of argument of the petitioner about the status of that document during the oral proceedings necessarily implied that this point was no longer maintained by the petitioner, but only that the technical Board may have gathered from the discussion on that document, which clearly took place, that this point was no longer maintained (Reasons 19).

10.4 Whether or not an objection is withdrawn or abandoned depends on the particular context underlying the contested decision. T 526/21 cited by the patent proprietor concerns a situation where the discussion during the oral proceedings about the choice of the closest prior art did not concern two further documents on the basis of which additional inventive step attacks had been submitted in writing. In this situation, it

was considered that these attacks had not been maintained, as these two further documents were not any more argued to represent a possible starting point for the assessment of inventive step (Reasons 3.1.2). This situation is similar to case T 2730/16 referred to in T 526/21 (T 2730/16, Reasons 4.2).

In the present case, however, nothing from the debates during the oral proceedings implies that the opponent had not maintained the plasticizer insufficiency objection.

10.5 On that basis, the failure of the opposition division to give due consideration to the plasticizer insufficiency objection which from the opponent's submissions is an essential aspect of the alleged insufficiency disclosure of the subject-matter of claim 1, constitutes a substantial violation of their right to be heard in contravention of Article 113(1) EPC. This procedural violation is a fundamental procedural deficiency in the first-instance proceedings (Case Law, V.A.9.4.4.4a)).

10.6 The Board also takes note of the patent proprietor's request in their letter of 16 February 2024 not to admit that objection (page 4, last paragraph).

In this respect, it is not apparent that the opposition division took a decision on the admittance of the plasticizer insufficiency objection. While point 67 of the Reasons refers to the new ground of opposition under Article 100 (b) EPC making reference to the opponent's submissions of 13 July 2023 in which the plasticizer insufficiency objection is addressed for the first time, the reasons given for admitting the new ground of opposition under Article 100 (b) EPC relate

only to the surface smoothness measurement insufficiency objection, raised by the opponent at a later stage.

Remittal and reimbursement of appeal fee

11. In addition to the need to remit the case to the opposition division to assess novelty taking into account of D31 (see point 6 above), the fundamental procedural deficiencies in the first-instance proceedings mentioned in points 8.2 and 10.5 above constitute a further special reason within the meaning of Article 11 RPBA justifying remittal to the department that issued the contested decision.

A requirement for the reimbursement of the appeal fee by reason of a substantial procedural violation is that such reimbursement is equitable (Rule 103(1) a) EPC). According to established case law, in order to render the reimbursement of the appeal fee equitable, as a rule a causal link must exist between the procedural violation and the decision of the department of first instance that necessitated the filing of an appeal (Case Law, V.A.11.7.1). This is the case here where the opponent had to file an appeal against maintenance of the patent on the basis of the Second Auxiliary Request when not all the pertinent submissions brought forward by them had been taken into account (Case Law, III.B. 2.5.2).

A reimbursement of the appeal fee of the opponent is therefore justified.

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.

3. The appeal fee of the opponent is to be reimbursed. The appeal fee of the patent proprietor is to be reimbursed at 25% in accordance with Rule 103(4)(c) EPC.

The Registrar: The Chairman:

D. Hampe D. Semino

Decision electronically authenticated