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Datasheet for the decision of 13 April 2026

Case Number: T 1471/24 - 3.2.04

Application Number: 16002374.3

Publication Number: 3168466

IPC: F03G6/06, F24S20/20, F24S23/74, F24S30/425, F24S23/70

Language of the proceedings: EN

Title of invention:
SOLAR RAY CONCENTRATION SYSTEM

Applicant:
Otegui Rebollo, Juan Luis
van Leeuw, Christiane

Headword:

Relevant legal provisions:
EPC R. 43(1), 71(3), 71(6), 103(1)(a)
RPBA 2020 Art. 12(8)

Keyword:
Claims - missing two-part form

Decisions cited:
G 0001/24, T 0181/95, T 0723/93, T 0012/03, T 1111/09, T 0683/14, J 0037/89

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 1471/24 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 13 April 2026

Appellant: (Applicant 1)
Otegui Rebollo, Juan Luis
Neubiberger Straße 57
81737 München (DE)

Appellant: (Applicant 2)
van Leeuw, Christiane
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Decision under appeal:
Decision of the Examining Division of the European Patent Office posted/electronically transmitted on 6 November 2024 refusing European patent application No. 16002374.3 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman A. Pieracci
Members: M. Hannam
S. Ruhwinkel

Summary of Facts and Submissions

I. The examining division refused European Patent Application number 16 002 374.3 for failure to meet the requirement of Rule 43(1) EPC. An appeal was filed by the appellant (applicant) against this decision.

II. With its grounds of appeal, the appellant requests that the decision under appeal be set aside and the patent application be granted. It additionally requests that the appeal fee be reimbursed on account of the examining division having committed a substantial procedural violation.

III. The following document is relevant to the present decision:

D1 WO-A-2015/161921

IV. Claim 1 of the appellant's sole request, which is also that on the basis of which the examining division took its decision, reads as follows:

"A solar ray concentration system which comprises a set of various Plano concave shaped mirrors (1.2) which are positioned one on top of each other and are each attached to a tower structure or mast structure (1.6) by the means of a rigid structure (1.5) which comprises an access pipe inside it (1.5), the rotation towards the sun of said Plano concave mirrors (1.2) being actuated by an actuator positioned at the focal point area, where a focal pipe (1.1) projects parallel to said Plano concave mirrors (1.2), hence rotating said mirrors (1.2) about said focal pipe (1.1), while all of said focal pipes (1.1) are connected to a first main

pipe (1.4) which flows into the tower structure (1.6), therefore driving a fluid through said access pipes which connect to said focal pipes (1.1), such that said fluid is then driven down the tower structure or mast structure (1.6) via a second main pipe (1.4) which drives said fluid onto the ground (1.8) and to a heat exchanger, which transfers the heat from said fluid to flowing water in a separate pipe system, which converts said flowing water into steam to drive turbines, which in turn drive generators and produce electricity."

V. The arguments of the appellant relevant to the present decision are discussed in the Reasons for the Decision.

Reasons for the Decision

1. *Decision in writing, Article 12(8) RPBA*

1.1 The present decision is taken without holding oral proceedings.

1.2 In view of the appellant not requesting oral proceedings in either of its notice of appeal or its statement of grounds of appeal to discuss the issues of setting aside the impugned decision and reimbursement of the appeal fee, and since the present case is ready for decision on the basis of the above submissions of the appellant, holding oral proceedings is deemed not to be necessary.

1.3 The present decision is thus issued in written proceedings in accordance with Article 12(8) EPBA.

2. Impugned decision

2.1 Article 97(1) EPC states that an examining division shall decide to grant a European patent application if the European patent application and the invention to which it relates meet the requirements of this Convention, provided that the conditions laid down in the Implementing Regulations are fulfilled. Meeting the conditions of the Implementing Regulations is thus a necessary step for an application to be granted.

2.2 The examining division found that D1 represented the closest prior art to the claimed invention and that the subject-matter of claim 1 was both novel and involved an inventive step over the cited art (see page 5 of the decision). It nonetheless found that the requirements of Rule 43(1) of the Implementing Regulations were not fulfilled since claim 1 was not drafted in the two-part form, despite this being appropriate (see page 4, last paragraph of the impugned decision).

2.3 The Board concurs with the examining division and sees the suggestion as to how the two-part form of claim could be drafted based on D1 as the closest prior art (see page 6 of the impugned decision) to be appropriate.

2.4 It is noted that the purpose of the two-part form of claim is to allow the skilled person to see clearly which features necessary for the definition of the claimed subject-matter are, in combination, part of the prior art. It is established practice before examining divisions not to insist on the two-part form if it is sufficiently clear from the indication of prior art made in the description which features of the claim under examination are known therefrom (see also

Guidelines for Examination, F-IV, 2.3.2). However, this proviso regarding the features known from the prior art, as found by the examining division in point 21.4 of its decision, has not been satisfied in the present application. D1 is indeed acknowledged on page 1 of the description (dated 15 December 2022) yet this acknowledgement fails to identify which specific features of the claim 1 under examination are known from D1. Fundamentally, therefore, in view of the two-part form not having been used in the independent claim, a resultant requirement for the content of the description to include an indication of which features of claim 1 were known from the prior art was not fulfilled.

3. *Arguments of the appellant*

3.1 The appellant argued that the examining division had, in item 21.4 of its decision, omitted to explain or bring any evidence in support of its allegation that page 1 of the description failed to clearly identify which features of claim 1 were known from D1. This is not accepted. The examining division pointed to the acknowledgement of D1 in the description and stated that this acknowledgement failed to explicitly indicate which features of claim 1 were known therefrom. A typical wording used in patent applications to satisfy this explicit indication would be:
"The following features of claim 1 are known from D1", whereupon those features would be listed. In the present case, short of the examining division *verbatim* reciting the D1 acknowledgement, which in itself would not have provided any further explanation or evidence, the Board fails to see how the examining division's objection regarding page 1 of the description failing to clearly identify which features of claim 1 were

known from D1 is lacking.

3.2 The appellant alleged that claim 1 cannot properly be formulated in the two-part form as it is an innovative combination of features. An 'innovative combination of features' in a claim is understood by the Board to mean that the subject-matter of that claim is novel i.e. that the features of the claim considered in combination are not known from a single piece of prior art. It does not dictate whether a claim can be formulated in the two-part form or not. Should the appellant wish to somehow convey through the expression 'an innovative combination of features' that no features of claim 1 were to be found in D1, this is simply incorrect, as shown on page 6 of the impugned decision where those features of claim 1 known from D1 are cited in the first, pre-characterising, part of the claim.

3.3 The appellant referred to T0181/95, Reasons 5, in support of its 'innovative combination of features' argument. As far as the relevance of this decision can be understood with respect to the present case, it states that "if there is no document or other evidence of prior art describing the device according to the preamble of claim 1, the two-part formulation of this claim is not justified because it gives a false picture of the prior art". However, in the present case, as concluded by the examining division on page 6 of its decision, claim 1 can reasonably be formulated in the two-part form with features known from D1 placed in the preamble, features not known therefrom being placed in the characterising portion. The present case is also different from T0723/93 (see Reasons 3) in which the appellant in that case argued that the two-part form was not expedient and the Board accepted a clearly

drafted claim in a one-part form. In the present case, however, the two-part form is indeed expedient as it clearly and concisely identifies which features of claim 1 are known from D1 allowing a more immediate understanding by the reader of which features go beyond D1 and contribute to the invention.

3.4 As to the appellant's argument that the examining division had ignored its submission of 4 November 2017, particularly items 1a to f, which indicated the differences between D1 and the present invention, this is not accepted. It is noted that the referenced section of this submission is introduced with "Concerning novelty, attention of the examining division is drawn to the following", whereafter in points 1a to f the differences between the subject-matter of claim 1 and D1 are identified. This has indeed been acknowledged by the examining division not least in the middle of page 5 of its decision where it finds the subject-matter of claim 1 to be new over D1.

3.5 The appellant further argued that the proposed two-part form was incorrect insofar as D1 discloses a set of various flat mirrors rather than, as proposed by the examining division for inclusion in the preamble of claim 1, merely a set of various mirrors. Herein lies a misunderstanding of the appellant. The preamble of a claim drafted in the two-part form should include those features of the claim known in combination from the prior art (Rule 43(1)(a) EPC). In the present case, a set of various mirrors is indeed known from D1, albeit in D1 the various mirrors of this set are flat. That the mirrors of D1 are flat is however irrelevant; D1 without doubt does disclose a set of various mirrors, such that this feature can be included in the preamble

of a two-part form of claim.

3.6 The appellant's further contention in this regard that the generalisation of 'flat mirrors' of D1 to merely 'mirrors' in the preamble of claim 1 offended Article 123(2) EPC is also based on a misunderstanding of this provision of the EPC. Article 123(2) EPC prohibits a European patent application being amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. How the claimed subject-matter, or even the features included in the preamble of a claim, differs from a prior art document is irrelevant for the consideration of meeting the requirement of Article 123(2) EPC. Similarly, as it is the subject-matter of a claim as a whole which is considered when evaluating compliance with Article 123(2) EPC, novel information derivable alone from the preamble of a claim does not give rise to objections under this article; it is the subject-matter of the claim as a whole for which the prohibition of extension beyond the content of the application as filed applies.

3.7 In point 2 of its grounds, the appellant stated that "The first part of a two-part form, when based on a particular prior document, should contain the essential features of the invention claimed therein to which further essential features of the claim invention are added to constitute the claimed invention". In this the Board essentially agrees with the appellant. It then continues by stating "This cannot be the case here because the essential features of D1, as formulated in claim 1 thereof, are incompatible with the invention formulated in claim 1 of the present application". In this latter statement of the appellant the essential features of D1 are referred to as the reason why the two-part form cannot be used, but this is not a

decisive factor, rather merely including in the preamble of the claim those features known in combination from the prior art is necessary (see Rule 43(1)(a) EPC). The appellant further opined that only some features from Fig. 1 of D1, ignoring the remaining features in claim 1 of D1, were included in the proposed preamble of claim 1 which was thus unsuitable for defining a general combination of features known from the prior art. However, as already cited above, Rule 43(1)(a) EPC requires a statement indicating the designation of the subject-matter of the invention and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, form part of the prior art. Thus, Fig. 1 and claim 1 of D1 including more features than those included in the preamble of claim 1 is not objectionable since the preamble needs only include those features of claim 1 known in combination from the prior art.

3.8 The appellant further opined that the examining division did not comment on the content of the Guidelines, F-IV, 2.3. *Per se*, this is correct. Yet, this passage of the Guidelines states that "applicants are required to follow the above two-part formulation in their independent claim or claims, where, for example, it is clear that their invention resides in a distinct improvement in an old combination of parts or steps". The examining division clearly found this to be the case, in that it proposed, on page 6 of its decision, how claim 1 could indeed be drafted in such a manner. The Guidelines continue in stating, "However, as is indicated by Rule 43, this form need be used only in appropriate cases. The nature of the invention may be such that this form of claim is unsuitable, e.g. because it would give a distorted or misleading picture

of the invention or the prior art". The two-part form proposed by the examining division is not found to be inappropriate; it clearly indicates (in the preamble) which features of claim 1 are known from D1 and also directly specifies in the characterising portion of the claim (see Rule 43(1)(b) EPC) the technical features for which, in combination with the features of the preamble, protection is sought. The examining division's proposal as to how claim 1 could be drafted in the two-part form seems wholly reasonable and the examining division seems to have accurately followed section F-IV, 2.3 of the Guidelines.

3.9 As to the appellant's contention that drafting the claim in the two part form was inappropriate as it made it unclear and lacking in conciseness, this is not accepted.

Having the reference sign (1.2) used both for 'a set of various mirrors' in the preamble and for 'Plano concave mirrors' in the characterising portion of claim 1 would not be seen as presenting a lack of clarity for the skilled reader. Not least on consulting the description and drawings of the application (see the order of G 0001/24) would it become perfectly clear that solely Plano concave mirrors are comprised in the system of the application.

As for a lack of conciseness in claim 1 as a consequence of drafting in the two-part form, this is of minimal extent and is not seen to adversely affect the clarity of claim 1. The appellant contends that the additional words resulting from drafting in the two-part form are unnecessary, yet these are necessary to fulfil the requirement of Rule 43(1) EPC and their inclusion aids an understanding of which features of

claim 1 are known from D1. No lack of conciseness of claim 1 can thus be seen to be introduced by drafting claim 1 in the two-part form.

3.10 The appellant further argued that the scope of the phrase defining "A system which comprises a set of various Plano concave shaped mirrors" is different to that defining "A system which comprises a set of various mirrors ... characterised in that the various mirrors are Plano concave shaped". In support of its argument it referred to the Guidelines F-IV, 4.20 which concerns the difference between the expressions 'comprising' and 'consisting of' such that it seems that the appellant sees the use of the term 'comprising' to be the cause of the different scope.

The Board sees no difference in scope between the two expressions. In the first, the use of the term 'comprises' results in the skilled reader understanding that the claimed system is defined to have, *inter alia*, a set of various Plano concave shaped mirrors, i.e. the system optionally additionally includes, for example, other types of mirror. The second expression defines precisely the same content i.e. a system with, *inter alia*, a set of various mirrors, these various mirrors being Plano concave shaped. The system according to this definition, identically to the first, optionally additionally also includes other types of mirror to the Plano concave shaped mirrors.

This argument is thus unsuited to prove that the two-part form of claim is inappropriate in the present case.

3.11 In summary, therefore, none of the appellant's arguments convince that the examining division was wrong to insist on claim 1 being drafted in the two-part form. Also, having elected not to use the two-part form, the applicant failed to follow the resultant proviso in the Guidelines F-IV, 2.3.2, that the features of claim 1 known from the prior art had to be clearly identified in the description. The appellant's sole request is therefore not allowable.

3.12 Absent an auxiliary request on file, the appeal is to be dismissed.

4. Reimbursement of appeal fee

4.1 Rule 103(1)(a) EPC stipulates as a precondition for reimbursement of the appeal fee that the appeal must be allowable (see also the Case Law of the Boards of Appeal (CLB), 11th Edition, 2025, V.A.11.5). J 37/89 (Reasons for the decision 6) clarified that 'allowable' was understood to mean that the Board of Appeal decided in favour of the appellant, in other words that the Board allowed its requests (see also T 1111/09, Reasons 6). Since, in the present case, the appeal is not allowable, as set out above, this requirement for a reimbursement of the appeal fee under Rule 103(1)(a) EPC is not fulfilled and the request for reimbursement is to be refused already for this reason.

In addition, a further precondition for reimbursement of the appeal fee according to Rule 103(1)(a) EPC is that a substantial procedural violation has taken place, this being an objective deficiency affecting the entire proceedings. It is established case law (see the Case Law of the Boards of Appeal (CLB), 11th Edition, 2025, V.A.11.6.1, for example decision T 0012/03 cited

therein) that such an objective deficiency in the procedure is one in which the rules of procedure have not been applied in the manner prescribed by the Convention, rather than a deficiency of a substantive nature (see for example T 0683/14 also cited in CLB, *supra*, V.A.11.6.1).

4.2 Alleged substantial procedural violations

4.2.1 The appellant pointed to the examining division's first proposed text for claim 1 in the two-part form which accompanied the Rule 71(3) EPC communication of 19 February 2024. It then indicated a change in this proposed text for claim 1 which accompanied the summons to oral proceedings of 11 June 2024. The appellant thus concludes that the examining division tried to impose a claim formulation not in accordance with the EPC with its proposed text for grant accompanying the Rule 71(3) EPC communication, this being a procedural violation. The Board cannot concur with the appellant as it seems to misunderstand the purpose of the Rule 71(3) EPC communication i.e. to "inform the applicant of the text in which it intends to grant" the patent. By way of this communication the applicant is given the opportunity to approve the proposed text (Rule 71(5) EPC) or to suggest amendments to the proposed text / keep the latest text submitted by it (Rule 71(6) EPC). This procedure was correctly followed by the examining division with examination being resumed due to the applicant maintaining its latest text of claim 1. Thus, no text was ever 'imposed' on the applicant; it was free to approve or reject the proposed text for grant in line with Rule 71 EPC, and it indeed chose to reject it. The examining division thus followed exactly the correct procedure and no procedural violation can be

recognised.

4.2.2 The appellant alleged that, in the annex to the summons of 11 June 2024, the examining division failed to consider the applicant's arguments in point 2 of its letter of 8 April 2024, this being a further procedural violation. Point 2 of this letter reads:

"Claim 1 cannot be properly formulated in the two-part form because it is an innovative combination of features. Not an addition of some features to a previous known device. See Rule 43(1 b) EPC. See also T 0181/95 (item 5 of the reasons)."

The appellant seems to consider that the omission in the annex to the summons of a response to precisely this point is a procedural violation. However, it is only in a decision where all arguments of an applicant must be addressed (see Rule 111(2) EPC) such that the lack of a response to this argument in the summons cannot be seen as a procedural violation. Should *arguendo* the objection be considered with respect to the examining division's decision, point 21.2 does explicitly address this argument of the applicant, so no procedural violation can be recognised here either.

4.2.3 The appellant further alleged that the examining division purposefully ignored the content of the applicant's letter of 4 November 2017, in particular points 1a to f, in which the differences between D1 and the present invention were detailed. However, points 1a to f of this submission detail why claim 1 is novel over D1; this was explicitly accepted by the examining division (see page 5 of its decision). Thus no procedural violation can be seen here.

4.2.4 The appellant argued that the examining division ignored the EPC Guidelines, following their own agenda. No specific indication is given here as to which parts of the Guidelines have supposedly been ignored, but in Part I of the appellant's grounds of appeal, several references to the Guidelines are made which can perhaps implicitly be seen as intended here. These are: F-IV, 2.2, 2.3 and E-X, 1.3.3.

The reference to F-IV, 2.2 relates to how the two-part form of claim should be formulated and F-IV, 2.3 relates to instances when the two-part form of claim may be unsuitable. The content of these sections of the Guidelines have however all been addressed above in relation to the correctness of the decision met by the examining division (see for example point 3.8). Thus these sections have not been ignored by the examining division.

The reference to E-X, 1.3.3 relates to the necessity for decisions to be fully reasoned. The examining division however congruently argued why the two-part form of claim 1 was appropriate and why, absent drafting in the two-part form, the application did not meet the requirements of the EPC. The appellant's allegations of its arguments having been ignored by the examining division are also, as detailed in the section 'Arguments of the appellant' above, not accepted. Thus no ignoring of this section of the Guidelines by the examining division can be recognised either.

4.3 In summary, therefore, the appellant has failed to show that the examining division in its decision committed a substantial procedural violation.

4.4 From all of the above it follows that the appeal is not allowable and no substantial procedural violation occurred. Thus in view of neither condition of Rule 103(1)(a) EPC having been met, the appellant's request for reimbursement of its appeal fee is refused.

Order

For these reasons it is decided that:

1. The appeal is dismissed.

2. The request for reimbursement of the appeal fee is refused.

The Registrar: The Chairman:

G. Magouliotis A. Pieracci

Decision electronically authenticated