

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairs and Members
- (C) [-] To Chairs
- (D) [X] No distribution

**Datasheet for the decision
of 28 September 2026**

Case Number: T 0377/25 - 3.2.07

Application Number: 15876300.3

Publication Number: 3240655

IPC: B24D3/02, B24D3/06, B24D3/20

Language of the proceedings: EN

Title of invention:

ABRASIVE ARTICLES AND METHODS FOR FORMING SAME

Patent Proprietors:

Saint-Gobain Abrasives, Inc.
Saint-Gobain Abrasifs

Opponents:

Müller-Boré & Partner Patentanwälte PartG mbB
IMERTECH SAS

Headword:

Relevant legal provisions:

EPC Art. 56, 111(1)
RPBA 2020 Art. 11, 12(4), 12(6)

Keyword:

Amendment to case (no)

Inventive step - main request (no) - obvious alternative

Remittal - (yes) - special reasons for remittal

Decisions cited:

T 1968/08, T 2213/21

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0

Case Number: T 0377/25 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 28 September 2026

Appellant 1:

(Opponent 1)

Müller-Boré & Partner
Patentanwälte PartG mbB
Friedenheimer Brücke 21
80639 München (DE)

Representative:

Müller-Boré & Partner
Patentanwälte PartG mbB
Friedenheimer Brücke 21
80639 München (DE)

Appellant 2:

(Opponent 2)

IMERTECH SAS
43 Quai de Grenelle
75015 Paris (FR)

Representative:

Schöllhammer, Gunther
c/o Imertech SAS
43, quai de Grenelle
75015 Paris (FR)

Respondent 1:

(Patent Proprietor 1)

Saint-Gobain Abrasives, Inc.
One New Bond Street
Worcester, MA 01615 (US)

Respondent 2:

(Patent Proprietor 2)

Saint-Gobain Abrasifs
Rue de l'Ambassadeur
78700 Conflans-Sainte-Honorine (FR)

Representative:

Zimmermann & Partner
Patentanwälte mbB
Postfach 330 920
80069 München (DE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted/
electronically transmitted on 30 January 2025
concerning maintenance of the European Patent
No. 3240655 in amended form.

Composition of the Board:

Chair B. Paul
Members: A. Cano Palmero
Y. Podbielski

Summary of Facts and Submissions

- I. Opponents 1 and 2 (appellants 1 and 2, respectively) lodged appeals within the prescribed period and in the prescribed form against the decision of the opposition division to maintain European patent No. 3 240 655 in amended form on the basis of the then main request.
- II. Two oppositions had been filed against the patent in its entirety on the grounds for opposition pursuant to Article 100(a) (novelty and inventive step), 100(b) (sufficiency of disclosure) and 100(c) EPC (added subject-matter).
- III. In order to prepare the oral proceedings scheduled at the parties' requests, the board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA. Patent proprietors 1 and 2 (respondents) replied to this communication with substantive arguments with letter dated 7 May 2025.
- IV. Oral proceedings before the board took place on 28 September 2026.

At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes thereof.

- V. The final requests of the parties are as follows:
- for appellants 1 and 2

that the decision under appeal be set aside
and

that the patent be revoked;

for the respondents

that the appeal be dismissed, *i.e.* that the patent be maintained in the amended form found by the opposition division to meet the requirements of the EPC in accordance with the main request,

or, in the alternative,

that the case be remitted to the opposition division for further prosecution in case that the main request is not considered allowable,

or, in the alternative,

that the patent be maintained in amended form in accordance with any of auxiliary requests 1 to 14 filed during the oppositions proceedings and re-filed with the reply to the statements setting out the grounds of appeal.

VI. The relevant lines of argument of the parties are dealt with in detail in the reasons for the decision.

VII. Independent claim 1 according to the main request reads as follows:

"An abrasive article comprising:

a bonded abrasive body including:

a bond material comprising an organic material; and abrasive particles contained within the bond material, the abrasive particles comprising nanocrystalline alumina having an average crystallite size within a range of 0.01 microns to 0.15 microns."

VIII. Since the wording of independent claim 10 of the main request and that of the claims of auxiliary requests 1

to 14 is not relevant for the present decision, there is no need to reproduce them here.

Reasons for the Decision

1. *Main request - Admittance of the objection of lack of inventive step starting from example 6 of document D7 (US 2009/0098365 A1) as closest prior art, Articles 12(4) and 12(6) RPBA*
- 1.1 The respondents requested not to admit appellant 1's inventive step objection, raised in its statement setting out the grounds of appeal, based on example 6 of document D7 as the closest prior art in combination with the teaching of any of documents
D1 (US 2003/0126803 A1), D2 (US 2003/0110706 A1),
D3 (US 2014/0033617 A1), D4 (US 2013/0337725 A1),
D5 (US 2004/0148870 A1) and D6 (US 2013/0074418 A1).
- 1.1.1 The respondents argued that this objection was brought forward by appellant 1 for the first time during the oral proceedings before the opposition division. Although the respondents requested that the objection not be admitted, the opposition division did not decide on its admittance. Instead, it considered the objection on its merits and found it unconvincing, in favour of the respondents.
- 1.1.2 In addition, the respondents submitted that the opposition division had not expressly referred to example 6 of D7 in its findings. They further argued that, in its statement setting out the grounds of appeal, appellant 1 had relied on an objection raised by appellant 2 in a letter dated 8 November 2024 in response to the opposition division's preliminary opinion. That objection was based on document D11,

which was identical to D7, but referred to the reasoning previously advanced with D14 (**US 5,215,551 A**) as the closest prior art in combination with the teachings of documents D1 to D5 only. The respondents therefore maintained that the original objection relied on by appellant 1 had not been presented clearly and/or substantiated adequately and, consequently, had not been admissibly raised during the opposition proceedings, so that it resulted in an amendment of appellant 1's appeal case that should not be admitted under Article 12(4) RPBA.

1.2 The board disagrees for the following reasons.

1.2.1 Firstly, the board notes that, although points 5.4.3 and 5.4.4 of the reasons for the decision under appeal do not expressly refer to example 6 of D7, the objection starting from that example as the closest prior art was submitted and discussed during the oral proceedings before the opposition division, as recorded in point 2.3.2.1 of the minutes before the opposition division. Since the objection was submitted during the opposition proceedings, its admittance does not fall within the scope of Article 12(6), second sentence, RPBA.

1.2.2 Secondly, the board considers that, notwithstanding the different labelling of the document relied on and the references to arguments submitted in the context of a different inventive step objection, appellant 2 had already admissibly raised the objection starting from example 6 of document D7 during the opposition proceedings in a substantiated manner, at least as regards the combination with the teachings of documents D1 to D5 in its letter of 8 November 2024 (*cf.* points 5.2.2 and 5.4 of this letter), well within in the time

limit according to Rule 116 EPC set by the opposition division in preparation of the oral proceedings. Appellant 1 was therefore in a position to rely on that objection. Since the objection had been admissibly raised and substantiated during the opposition proceedings, its reliance on appeal does not constitute an amendment to appellant 1's appeal case within the meaning of Article 12(4) RPBA. The board consequently has no discretion under that provision not to admit the objection.

- 1.3 In sum, the board concludes that the objection of lack of inventive step of the subject-matter of claim 1 of the main request starting from example 6 of document D7 as the closest prior art in combination with the teaching of any of documents D1 to D5 is part of the appeal proceedings. The respondents' request that this objection not be admitted is refused.
2. *Main request - Inventive step starting from example 6 of document D7 as closest prior art in combination with the teachings of D1 to D5, Article 56 EPC*
- 2.1 Suitability of example 6 of D7 as closest prior art
- 2.1.1 The respondents argued that example 6 of D7 was not a suitable starting point for assessing inventive step. They submitted that this example was purposely directed to an inorganic binder and that D7 concerned abrasive particles rather than abrasive articles. An abrasive article containing an organic binder would therefore constitute a more appropriate starting point. According to the respondents, the improvement in the G-ratio, which was the object of the patent in suit, was attributable not only to the average crystallite size of the alumina comprised in the abrasive particles, but

also to the selected binder. The type of binder had an effect on the release of the abrasive particles during grinding and thereby influenced the performance of the abrasive article.

2.1.2 The board disagrees for the following reasons.

2.1.3 Example 6 of D7 relates specifically to an abrasive disc. It therefore concerns an abrasive article and not merely isolated abrasive particles. Furthermore, this embodiment belongs to the same technical field as the claimed subject-matter and has relevant technical features in common with it. The board therefore sees no reason why example 6 could not constitute a realistic starting point for assessing inventive step.

2.1.4 In addition, the respondents have not convincingly demonstrated that the abrasive disc of example 6 could depart from the purpose or operating principle of D7 by using a different conventional binder.

2.1.5 The board also notes that the case law does not require a document selected as a starting point to correspond to the claimed subject-matter in every respect. In consequence, the board is of the view that example 6 of D7 can be used as closest prior art in the assessment of inventive step.

2.2 Distinguishing features

2.2.1 It is common ground that example 6 of D7 does not itself disclose an abrasive article comprising an organic bond material.

2.2.2 The respondents argued that this example further failed to disclose abrasive particles comprising

nanocrystalline alumina having an average crystallite size within a range of 0.01 microns to 0.15 microns.

- 2.2.3 In particular, the respondents submitted that the abrasive article of example 6 of D7 contained the abrasive grains produced in examples 1 to 3. Those grains were not characterised by their average crystallite size, as required by claim 1 of the main request, but by their average primary particle size. Since these parameters were different and no correlation between them had been established, the values disclosed in examples 1 to 3 could not be regarded as disclosing the average crystallite size specified in claim 1.
- 2.2.4 The respondents further submitted that the abrasive grains of examples 1 to 3 of D7 were only starting materials. There was no certainty that the abrasive grains retained the disclosed size in the finished abrasive article. In this respect, the respondents referred to column 2, lines 5 to 11, of D12 (**US 5,035,723 A**), according to which the crystal size could increase depending on the seeding conditions.
- 2.2.5 Finally, the respondents submitted that the abrasive article of example 6 contained a 30:70 mixture of the sintered grains, graded to F60, and premium white fused alumina, as indicated in paragraph [0089] of D7. While information might be available on the size of the former grains, D7 did not disclose the grain size of the latter, which constituted 70% of the mixture. The average crystallite size of the abrasive grains in the article as a whole could therefore not be derived from D7.

- 2.2.6 The board is not persuaded by these arguments for the following reasons.
- 2.2.7 Claim 1 of the main request defines "abrasive particles comprising nanocrystalline alumina having an average crystallite size" within the specified range. The term "comprising" does not exclude the presence of additional abrasive materials, while the expression "having an average crystallite size" qualifies the nanocrystalline alumina comprised in the abrasive particles (see also Case Law of the Boards of Appeal [CLB], 11th edition, 2026 revision, II.A.6.3). Claim 1 therefore does not require every particle or every component of the abrasive mixture to have the specified crystallite size.
- 2.2.8 Appellants 1 and 2 referred to Table 2 and Examples 1 to 3 of D7, in particular to paragraphs [0074] to [0076], [0078], [0079], [0082], [0083] and [0086]. These passages disclose the abrasive grains used in the abrasion test of example 6, which comprise aluminium having a nanocrystalline structure. The average grain size is between 60 and 70 nm. Since the grains themselves are agglomerates containing these nanocrystalline aluminium crystallites to perform the abrasive function, the board is satisfied that the skilled person would understand the average crystallite size to be of the similar order of magnitude as the grain size itself. It therefore clearly falls within the claimed range.
- 2.2.9 The respondents' assertion that the average primary particle size disclosed in examples 1 to 3 of D7 was not comparable with the claimed average crystallite size as claimed is therefore not convincing to establish that the nanocrystalline alumina comprised in

the abrasive article of example 6 of D7 falls outside the claimed range.

2.2.10 Nor has it been established that the crystallite size changed during the production of the article of example 6 of D7. Document D12, even if considered, indicates at most that crystal growth may occur under certain seeding conditions. The respondents have not shown that those conditions corresponded to the conditions used in D7 or that they necessarily caused the crystallites to grow beyond the upper limit specified in claim 1. This argument therefore remains an allegation.

2.2.11 Finally, the fact that the mixture of example 6 also contained 70% premium white fused alumina is not convincing. Since claim 1 uses the open term "comprising", the presence of an additional abrasive component does not exclude the claimed subject-matter. It is sufficient that the article contains abrasive particles comprising nanocrystalline alumina having the specified average crystallite size. The respondents' argument would instead require the crystallite-size condition to apply to the entire abrasive mixture, for which the wording of claim 1 provides no basis.

2.2.12 In sum, the board concludes that the subject-matter of claim 1 of the main request differs from the known abrasive article of example 6 of D7 solely in that it comprises an organic bond material.

2.3 Technical effect and objective technical problem

2.3.1 The patent neither attributes a particular technical effect to the organic binder as such nor establishes a synergistic interaction between the binder and the average crystallite size of the nanocrystalline

alumina. Instead, the patent attributes the improvement in the G-ratio solely to the nanocrystalline alumina grains and their crystallite size.

- 2.3.2 The respondents did not identify any passage of the patent or any experimental evidence establishing an alleged synergistic interaction between the grains and the binder, which they considered part of common general knowledge. The board is however not convinced by this assertion and regards it as a mere allegation.
- 2.3.3 Since the effect of improving the performance of the abrasive article cannot be causally linked to the selection of an organic binder, the objective technical problem cannot therefore be formulated in those terms. As correctly argued by appellant 1, the board sees that the objective technical problem solved by the distinguishing feature should instead be formulated as to provide an alternative abrasive article.
- 2.4 Obviousness
 - 2.4.1 The respondents argued that, even if example 6 of D7 constituted a suitable starting point and the objective technical problem were merely to provide an alternative abrasive article, D7 gave the skilled person no reason or motivation to replace the inorganic binder of the disclosed abrasive disc with an organic binder. This would require a substantial change to the bond system of the article for which D7 provided no hint or suggestion. Also such a hint was absent in documents D1 to D5.
 - 2.4.2 The board disagrees. As explained above, the binder used in example 6 of D7 is not disclosed as serving a specific technical purpose or as being essential to the

performance of the abrasive article. D7 therefore contains neither an obstacle nor a teaching that would dissuade the skilled person from considering other known binders.

- 2.4.3 In addition the board is not persuaded by the respondents' argument that, in the case at hand, the skilled person is required to have a pointer to combine the teaching of an organic binder of any of documents D1 to D5 with the disc of example 6 of D7. It is established case law of the boards of appeal that in cases where the distinguishing features represented a technically equivalent alternative not linked with any special effect, the skilled person can recognise the alternative solutions concerned without inventive efforts and that a separate pointer is normally not required (see CLB, *supra*, I.D.5 with reference to T 1968/08).
- 2.4.4 In the present case, vitrified, metallic and organic bonds were known alternatives for bonding abrasive particles in abrasive articles. Example 6 of D7 uses an inorganic binder, while D1 to D5 disclose the use of organic binders in abrasive articles. In particular, appellant 1 referred, contrary to the opposition division's finding in point 5.4.2 of the reasons for the decision under appeal, to the specific embodiments disclosed in paragraphs [0145] and [0147] of D1, paragraph [0123] of D2, paragraph [0036] of D3, paragraphs [0080] and [0092] of D4, and paragraphs [0145] and [0152] of D5.
- 2.4.5 Starting from the abrasive disc of example 6 of D7 and faced with the problem of providing an alternative abrasive article using a different bond material, the skilled person would therefore have considered the use

of other known binder systems used in the same technical field, such as organic binders taught by documents D1 to D5, thereby arriving at the subject-matter of claim 1 of the main request in an obvious manner.

- 2.5 Consequently, the board finds that the subject-matter of claim 1 of the main request does not involve an inventive step within the meaning of Article 56 EPC. The appellants have thus demonstrated the incorrectness of the decision under appeal, which is to be set aside.

3. *Remittal of the case to the opposition division, Articles 11 RPBA and 111(1) EPC*

- 3.1 The respondents requested that the case be remitted to the opposition division for further prosecution in case that the main request was considered not allowable.

- 3.2 The board notes that since the opposition division found the main request allowable, the admittance and/or allowability of auxiliary requests 1 to 14 did not form part of the decision under appeal.

- 3.3 Both appellants argued against the respondents' request for remittal.

- 3.3.1 In particular, appellant 1 argued that there was no absolute need to have every matter examined at two instances, and that deciding on the auxiliary requests would not impose an undue burden on the board, since all the objections and arguments relevant to their allowability had already been submitted. It referred to decision T 2213/21.

- 3.3.2 Appellant 2 further argued that remitting the case would be contrary to procedural economy.
- 3.4 The board is aware that, according to Article 11 RPBA, a remittal for further prosecution should only be undertaken exceptionally, when special reasons apply.
- 3.5 The board however decides to remit the case for further prosecution in line with the request of the respondents for the following reasons.
 - 3.5.1 As set out in Article 12(2) RPBA, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner.
 - 3.5.2 Although, as correctly pointed out by appellant 1, there is no absolute right to have every matter examined at two instances, it is established case law that parties should, where possible, be given the opportunity to discuss important elements at two instances (see CLB, *supra*, V.A.9.2.1, second paragraph).
 - 3.5.3 The board takes the position that, in the present case, the burden on the parties and the board to consider and deal with the issues raised regarding the fourteen auxiliary requests, including all objections and reactions to any objections, outweighs any possible detriment to procedural economy and it is therefore justified to prolong the procedure in order to allow all parties the right to fully consider and react to the auxiliary requests and the objections against these requests.
 - 3.5.4 This position is also in line with decision T 2213/21. In that case, the competent board considered that the

absence of a decision of opposition division on the lower-ranking requests constituted special reasons justifying remittal under Article 11 RPBA and ultimately remitted the case to the opposition division for further prosecution.

- 3.5.5 Against this background, after considering all the relevant circumstances of the case at hand, the board comes to the conclusion that the assessment of the auxiliary requests cannot be decided upon without undue burden (cf. OJ EPO 2020, Supplementary publication 2, explanatory notes to Article 11 RPBA, 46, 54).
- 3.6 Consequently, the board is of the view that there are special reasons within the meaning of Article 11, first sentence, RPBA that apply, and that it is appropriate, following the request of the respondents, to remit the present case to the opposition division for further prosecution, in accordance with Article 111(1) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registry:

The Chair:



G. Nachtigall

B. Paul

Decision electronically authenticated