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**D E C I S I O N**  
**of 9 September 2003**

**Case Number:** T 0212/01 - 3.2.7

**Application Number:** 90907246.4

**Publication Number:** 0473633

**IPC:** D21F 1/00

**Language of the proceedings:** EN

**Title of invention:**  
Paper machine felts

**Patentee:**  
ALBANY INTERNATIONAL CORP.

**Opponent:**  
Hoechst Trevira GmbH & Co. KG

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 54

**Keyword:**  
"Novelty (no)"

**Decisions cited:**  
T 0305/87, T 0867/93, T 0161/82, T 0651/91, T 0077/97

**Catchword:**  
-



Case Number: T 0212/01 - 3.2.7

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.7  
of 9 September 2003

**Appellant:** ALBANY INTERNATIONAL CORP.  
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**Representative:** Humphreys, Ceris Anne  
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**Respondent:** Hoechst Trevira GmbH & Co. KG  
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**Representative:** Luderschmidt, Schüler & Partner GbR  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 5 December 2000  
revoking European patent No. 0473633 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** A. Burkhart  
**Members:** K. Poalas  
C. Holtz

## Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking the European patent No. 0 473 633.

Opposition was filed against the patent as a whole based on Article 100(a) EPC (lack of novelty and inventive step) and Article 100(b) EPC (lack of enabling disclosure).

The Opposition Division found that the subject-matter of claim 1 as granted lacked novelty with respect to the disclosure of document

D2: DE 1 710 620 B in combination with document

D3: Béla von Falkai, "Synthesefasern"; Verlag Chemie (1981), S. 448-451.

- II. The appellant requested that the decision under appeal be set aside and the patent be maintained as granted (main request), or that the patent be maintained in amended form on the basis of sets of claims, filed as first to fifth auxiliary requests with letter of 8 August 2003.

- III. The respondent (opponent) requested the dismissal of the appeal.

- IV. Oral proceedings took place on 9 September 2003 without the participation of the duly summoned respondent, who had informed the Board with letter dated 6 May 2003

that he waived his right to participate in the scheduled oral proceedings.

V. Independent claim 1 as granted reads as follows:

"An article of paper machine clothing suitable for use in the forming, pressing or drying sections of a paper making machine which article includes a fibre structure characterised in that the fibres of said structure comprise a polyester material having a hindered carboxyl group, and in that said fibres have a melting point greater than 260°C."

VI. With respect to the novelty of the subject-matter of claim 1 as granted the appellant in the written and oral proceedings argued essentially as follows:

Nowhere in D2 is there a detailed example of a paper machine clothing (PMC) suitable for use in the forming, pressing or drying sections of a paper making machine.

Given that there are a variety of materials (column 3, lines 30 to 56) and a variety of end products (column 4, lines 29 to 31) in document D2, the features of claim 1 of the patent in suit cannot be inferred directly and unambiguously from it, and comprise therefore a novel selection.

A number of polymers mentioned in document D2, cf. polyvinylchloride, column 3, lines 47 to 48, are known to be unsuitable for use in PMC fabrics. Hence, the passage in document D2, column 3, lines 30 to 56 is clearly not suggesting that the polymers mentioned therein would all be suitable for use in PMC fabrics.

Document D2 does not contain any suggestion that the paper screen mentioned later in the document should be made from any particular polymer mentioned earlier.

According to decision T 305/87, when considering the content of one single document in isolation, the said content must not be treated as a reservoir from which it would be permissible to draw features pertaining to separate embodiments in order to create artificially a particular embodiment which would destroy novelty, unless the document itself suggests such a combination of features.

In decision T 867/93, it is confirmed that for a novelty attack to succeed a positive suggestion to combine two features mentioned separately from each other in a document is required.

Any anticipation of the subject-matter of claim 1 of the contested patent by document D2 is clearly accidental in nature, and in such a case, according to T 161/82, a particularly careful comparison has to be made between what could fairly be considered to fall within the wording of the claim and what was shown in the prior art document.

The person skilled in the art reading document D2 is faced with four possibilities:

polyethyleneterephthalate [PET] and paper screens,  
poly-(1,4-dimethylolcyclohexaneterephthalate)[PCTA] and  
paper screens,  
PET and conveyor belt,  
PCTA and conveyor belts.

None of the above combinations is disclosed as such in document D2. Therefore, the teaching of document D2 does not amount to a direct and unambiguous disclosure of a paper screen made from PCTA. In decision T 651/91 it is confirmed that even when a generic disclosure leaves a choice of only two alternatives, the generic disclosure does not take away the novelty of a specific example falling within that disclosure.

In decision T 77/97 claims to two specific compounds were denied the right to priority although the priority document contained a claim containing a formula covering just four compounds of which the two claimed compounds were members.

VII. With respect to the novelty of the subject-matter of claim 1 of the main request the respondent referred to its argumentation before the opposition division and the grounds given in the decision of the opposition division, which can be summarised as follows:

The term "Papiersiebe" in column 4, line 29 of document D2 is translated as paper making clothing or wire or fabric. A paper making clothing, in contrast to a paper making felt, of course includes a fibre structure. Therefore, in document D2 an article of paper machine clothing suitable for use in the forming, pressing or drying sections of a paper making machine which article includes a fibre structure is directly and unambiguously disclosed (column 1, lines 43 to 51 and column 4, lines 26 to 39).

Document D2 discloses the production of wires or monofilaments (column 1, lines 43 to 58) which are suitable for the production of a paper making clothing, conveyor belts or other articles, whereby papermaking clothing is put in the first place (column 4, lines 26 to 31). Furthermore, papermaking clothing is further discussed with respect to deficiencies caused by faulty filaments (column 4, lines 32 to 36).

In document D2 two polyesters are highlighted by the use of the term "bevorzugt" (preferred), namely polyethyleneterephthalate and poly-(1,4-dimethylolcyclohexaneterephthalate), the last one corresponding to the polyester used in the contested patent. This is a clear hint for the skilled person that these two polyesters are well suited for making filaments or fibres and after that for making papermaking clothing from the filaments. Poly-(1,4-dimethylolcyclohexaneterephthalate) has a hindered carboxyl group and a melting point greater than 260°C (see also document D3, page 450, Table 2, 6th row).

Therefore, the person skilled in the art infers directly and unambiguously from document D2 the subject-matter defined in claim 1 of the contested patent.

## Reasons for the Decision

### 1. *Main Request*

#### 1.1 Claim 1

The paper making screen, i.e. "Papiersieb" according to column 4, line 29 of document D2, is a paper machine clothing made of filaments suitable for use in the forming, pressing or drying sections of a paper making machine, as also argued by the appellant. Therefore, in the present case the terms paper making screen and paper machine clothing can be used interchangeably.

Document D2 discloses to the person skilled in the field of papermaking that, for the production of a paper machine screen, filaments treated according to the method described in document D2 should be used (column 4, lines 26 to 29), said filaments being uniformly round monofilaments (column 1, lines 43 to 60) made of synthetic linear high-polymers and especially of polyesters (column 2, lines 62 to 66) which can be further processed to fabrics (column 1, lines 58 to 60).

According to document D2 (column 3, lines 40 to 42) the preferred polyesters to be treated by the method and the machine described in document D2 are polyethylene-terephthalate and poly-(1,4-dimethylolcyclohexaneterephthalate).

Poly-(1,4-dimethylolcyclohexaneterephthalate) is a polyester having a "hindered carboxyl group", namely a cyclohexane moiety, in the meaning of the patent in



suit, see page 2, line 55 to page 3, line 7, and a melting point lying between 285°C and 295°C, see document D3, page 450, Table 2, 6th row.

Therefore, the person skilled in the field of papermaking screens derives from the disclosure of document D2 directly and unambiguously the subject-matter defined in claim 1 of the contested patent, namely an article of paper machine clothing suitable for use in the forming, pressing or drying sections of a paper making machine which article includes a fibre structure having fibres made of poly-(1,4-dimethylolcyclohexaneterephthalate), i.e. of a polyester material having a hindered carboxyl group, said fibres having a melting point greater than 260°C.

The Board cannot agree to the arguments presented by the appellant for the following reasons:

Document D2, column 4, lines 34 to 39 is directed to the deficiencies caused by the use of non-uniformly round filaments in the production of paper making screens. In order to overcome such deficiencies document D2, column 4, lines 26 to 29 teaches that paper making screens should be produced using filaments being treated according to the process described in document D2. Although in column 3, lines 46 to 53 of document D2 it is stated that also other synthetic linear high polymers than polyesters can be treated according to the process described in document D2, it is obvious from the passages column 2, lines 61 to 66 and column 3, lines 30 to 42 of document D2 that linear polyesters and especially polyethyleneterephthalate and poly-(1,4-dimethylolcyclohexaneterephthalate) are

recommended for optimising the results of the method described in document D2, and thus overcoming the problems occurring in the manufacturing of paper making screens. Therefore, the person skilled in the field of paper making derives from document D2 directly and unambiguously the information to use filaments of poly-(1,4-dimethylolcyclohexaneterephthalate) in order to produce paper making screens without the deficiencies mentioned in column 4, lines 34 to 39.

For the novelty test of the subject-matter of claim 1 of the patent in suit in comparison with the disclosure of document D2 it is irrelevant whether also end products other than paper making screens, i.e. conveyor belts, can be made using poly-(1,4-dimethylolcyclohexaneterephthalate) or whether also materials supposedly unsuitable for producing paper making screens, like PVC, are also mentioned as being treatable by the method disclosed in document D2. It is evident from column 3, lines 41 to 42 and column 4, lines 26 to 29 of document D2 that said document proposes as preferred material for achieving optimal uniformly round filaments for paper making screens without the deficiencies mentioned in column 4, lines 34 to 39, the specific polyester poly-(1,4-dimethylolcyclohexaneterephthalate). Therefore, a paper machine clothing made out of filaments of poly-(1,4-dimethylolcyclohexaneterephthalate) is clearly known from document D2.

As regards decisions T 305/87, T 867/93, T 161/82, T 651/91 and T 77/97 relied on by the appellant, the Board observes that the first two cases concern the combination of different features with each other, said

features belonging to separate embodiments in a single prior art document, in the third case it was found that by a possible accidental anticipation a particularly careful comparison has to be made between what could fairly be considered to fall within the wording of the claim and what was shown in the prior art document, in the fourth case it was found that even when a generic disclosure leaves a choice of only two alternatives, the generic disclosure does not take away the novelty of a specific example falling within that disclosure and in the fifth case the priority right was denied to claims having two specific compounds although the priority document contained a claim containing a formula covering just four compounds of which the two claimed compounds were members.

In the judgment of the Board none of these decisions applies to the present case or supports the appellant's case. Document D2 proposing a specific material, i.e. poly-(1,4-dimethylolcyclohexaneterephthalate) and a specific end product, i.e. paper making screen, neither describes separate embodiments disclosing different features as is the case in the first and second board of appeal cases mentioned above, nor discloses a generic disclosure or formula as is the case in the fourth and fifth decisions mentioned above. Moreover, a paper making screen made of poly-(1,4-dimethylolcyclohexaneterephthalate) as disclosed in document D2 is not an accidental anticipation since document D2 addresses explicitly the problem of the quality improvement of a paper making screen, see column 4, lines 34 to 39.

Therefore, the subject-matter of claim 1 is not novel and thus does not fulfil the requirements of Article 54 EPC.

2. *Auxiliary Requests*

None of the claims of the auxiliary requests has been examined by the opposition division.

In accordance with Article 111(1) EPC, the Board therefore considers it appropriate to remit the case to the first instance for further examination so as to give the appellant the possibility to argue his case before two instances.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The main request of the appellant is refused.
3. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

D. Spigarelli

A. Burkhart