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**DECISION**  
of 11 December 2003

**Case Number:** T 0476/01 - 3.2.6

**Application Number:** 95119609.6

**Publication Number:** 0721024

**IPC:** D04H 1/00

**Language of the proceedings:** EN

**Title of invention:**

Laminated biocidal fabric and method and apparatus for making  
the same

**Patentee:**

GENTEX CORPORATION

**Opponents:**

Triosyn corporation  
The Procter & Gamble Company  
FILTERWERK MANN & HUMMEL GMBH

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 83, 123  
EPC R. 68(2)

**Keyword:**

"Amendment - added subject-matter (no)"  
"Disclosure - sufficiency (yes)"  
"Sufficient reasoning (no)"  
"Decision re appeals - remittal (yes)"

**Decisions cited:**

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**Catchword:**



Case Number: T 0476/01 - 3.2.6

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.6  
of 11 December 2003

**Appellant:** GENTEX CORPORATION  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 1 March 2001  
revoking European patent No. 0721024 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. Alting van Geusau  
**Members:** H. Meinders  
M.-B. Tardo-Dino

## **Summary of Facts and Submissions**

- I. European Patent No. 0 721 024, granted on application No. 95 119 609.6, was revoked by the Opposition Division by decision posted on 1 March 2001. It based the revocation on the finding that the subject-matter of claim 1 of the patent as granted as well as of the auxiliary request then on file had been amended such that it contained subject-matter extending beyond the content of the application as originally filed (Article 123(2) EPC).
  
- II. The Appellant (Patentee) both filed a notice of appeal against this decision and paid the appeal fee on 27 April 2001. On 2 July 2001 the grounds of appeal were filed, requesting maintenance of the patent as granted, auxiliarily maintenance of the patent in amended form according to one of 6 auxiliary requests.
  
- III. In a communication dated 6 November 2003, in preparation of the oral proceedings according to Article 11(1) of the Rules of Procedure of the Boards of Appeal, the Board indicated that if a set of claims would meet the requirements of Article 123 and 83 EPC - a ground of opposition also discussed in the decision under appeal - it intended to remit the case to the first instance for further prosecution.
  
- IV. Oral proceedings were held on 11 December 2003, at which the Appellant further modified the requests which it had sent in reply to the communication of the Board. Respondents 01 and 03 (opponents 01 and 03) were absent. They had, however, notified the Board that they would not attend. To the requests filed by the Appellant in

reply to the communication of the Board they had filed no further comments.

- V. The Appellant requested cancellation of the decision under appeal and maintenance of the patent according to either the main (version as granted) or the auxiliary request as filed in the oral proceedings.

The Respondents 01, 02 and 03 requested dismissal of the appeal.

- VI. Claim 1 of the patent according to the **main request** of the Appellant reads:

"A biocidal fabric (10) including in combination  
  
a gas-permeable lower layer (12) of material,  
  
a discontinuous intermediate layer (14) comprising a plurality of evenly distributed biocidal beads (20),  
  
an upper layer (16) of material,  
  
a first layer of hot melt adhesive (18) for adhering the beads (20) to the lower layer (12), and  
  
a second layer of a hot melt adhesive (22) for adhering the beads (20) to the upper layer."

VII. **Claim 1** according to the **auxiliary request** reads as follows:

"A biocidal fabric (10) including in combination  
a gas-permeable lower layer (12) of material,  
a discontinuous intermediate layer (14) of a plurality  
of biocidal beads (20),  
an upper layer (16) of material,  
a first layer of a hot melt adhesive for adhering the  
beads (20) to the lower layer (12), said first layer  
being in the form of a pattern of dots (18), wherein  
the beads (20) are evenly distributed across the  
surface of the adhesive without beads (20) in the area  
of the lower layer (12) not provided with adhesive, and  
a second layer of a hot melt adhesive (22) for adhering  
the beads (20) to the upper layer."

VIII. In support of his requests the Appellant argued essentially as follows:

Main request:

The Opposition Division was of the opinion that the application as originally filed did not provide a basis for the feature of a "discontinuous layer comprising a plurality of evenly distributed biocidal beads". In particular it found that during manufacture the beads might be distributed evenly over the whole substrate, however, this did not mean that in the finished product

this was also the case. With a pattern of adhesive there would exist areas of the substrate without adhesive. Thus at those areas the beads would fall off when turning over the substrate, thus resulting in the beads not being evenly distributed over the substrate.

The conclusion drawn by the Opposition Division was wrong, as the wording of the claim did not require the beads to be evenly distributed over the whole of the surface of the substrate. According to the claim as granted the even distribution of the beads needed only to be present in the areas where there was adhesive. This was derivable from the application as filed.

Auxiliary request:

The amendments to claim 1 as granted were derivable from page 7 and figure 1 of the application documents as originally filed. Amended claim 10 of this request was disclosed on page 8 of these documents.

The invention was sufficiently disclosed for the purposes of Article 83 EPC by the disclosure of the process by which the biocidal fabric was produced. It was not necessary to have the second layer in a registering pattern with that of the first layer, as argued by the Respondent, as this was evident from claim 15 as filed which did not require the second layer of adhesive to be in the form of a pattern, let alone a pattern registering with that of the first layer. The latter was also derivable from claim 11 as granted.

IX. In essence the Respondents argued as follows:

As regards the main request, the argumentation in the decision under appeal was correct. If the lower layer with adhesive and the biocidal beads was turned over to remove excess beads, as originally disclosed, there would be no beads in the areas where there was no adhesive, thus resulting in an arrangement in which the beads were not "evenly distributed" in the usual meaning attributed to this term.

The use of the word "comprising" in claim 1 as granted also constituted an infringement of Article 123(2) EPC as this implied that the discontinuous layer could involve material other than the biocidal beads. Such an arrangement was not originally disclosed. What was originally disclosed was a discontinuous layer of beads of biocidal material (claim 1 as filed).

The patent did not sufficiently disclose the invention, as based on the description of the method of production of the fabric the skilled person could only achieve an even distribution of beads on the areas of the lower layer where there was the first layer pattern of hot melt adhesive, but not where there was no adhesive. Thus an even distribution over the whole of the lower layer, as claim 1 as granted suggested, could not be achieved.

As regards the auxiliary request Respondent 02 was of the opinion that the amendments carried out in claim 1 were only disclosed in the description of the method of production of the biocidal fabric and there only in combination with the first and the second layer of



adhesive being in the form of **dots in registering patterns**. The present amendments amounted to an intermediate generalisation, contrary to Article 123(2) EPC.

Further, without the pattern of dots of adhesive in the first layer being in a **regular** pattern the skilled person could not achieve an even distribution of beads (Article 83 EPC).

### **Reasons for the Decision**

1. The appeal is admissible.
2. *Main request - Article 123(2) EPC*
  - 2.1 As explained by the Board in its communication in preparation for the oral proceedings, claim 1 as granted leaves open the possibility that the first layer of hot melt adhesive is not in a predetermined pattern, but is distributed **evenly** over the gas-permeable lower layer in the form of dots or even in the form of a continuous layer.
  - 2.2 However, having regard to this possibility being enabled by the subject-matter claimed, the feature of the "discontinuous intermediate layer comprising a plurality of evenly distributed biocidal beads" does not comply with Article 123(2) EPC as there is no original disclosure in the method as discussed on pages 6 to 8 of the application as filed as to how such a discontinuous layer of beads is achieved on an evenly

distributed first layer of adhesive dots or a continuous layer of adhesive.

The **only** disclosure of how the beads are applied is that they are **evenly** distributed across the surface of the substrate (see page 7, lines 16 and 17), which, together with the first layer as discussed above, can only result in a **continuous** intermediate layer of beads, contrary to what is claimed.

- 2.3 It could be argued that due to the use of the wording "**comprising** a plurality of evenly distributed biocidal beads" (and not "consisting of") it is envisaged that there is a material present in the intermediate layer, different from the biocidal beads, the former being present in such a way that it has the effect of making the intermediate layer discontinuous.

However, for that arrangement there is clearly no disclosure in the original application documents.

- 2.4 The main request cannot therefore be allowed, as the discontinuous intermediate layer comprising a plurality of evenly distributed biocidal beads has only been disclosed in the original application documents **in combination with** a first layer of hot melt adhesive being in the form of a pattern of **dots**.

The amendment in the examination procedure leading to claim 1 as granted results in only part of this combination of features being included in claim 1 which intermediate generalisation lacks sufficient basis in the application as originally filed. This claim thus

does not comply with the requirements of Article 123(2) EPC. The main request is therefore to be refused.

2.5 Contrary to the decision under appeal the Board is of the opinion that the even distribution of the beads across the surface of the substrate during the process of manufacture of the fabric, where the substrate has a first layer of adhesive applied in a pattern, results in an even distribution of the beads over that pattern of adhesive in the final product, even if the lower layer is reversed to rid it of excess beads. Claim 1 as granted (main request) or according to the auxiliary request does not require the beads to be evenly distributed over the **whole** of the substrate.

3. *Auxiliary request - Amendments (Article 123 EPC)*

3.1 Claim 1 as granted has been amended in that (the reference signs have been left out):

"a discontinuous intermediate layer comprising a plurality of evenly distributed biocidal beads, ....., a first layer of hot melt adhesive for adhering the beads to the lower layer ...,"

has been replaced by:

"a discontinuous intermediate layer **of** a plurality of biocidal beads, ....., a first layer of hot melt adhesive for adhering the beads to the lower layer, **said first layer being in the form of a pattern of dots, wherein the beads are evenly distributed across the surface of the adhesive without beads in the area of the lower layer not provided with adhesive, ...**".

These amendments are derivable from claims 1 and 15, figure 1 and from the method of production of the biocidal fabric as discussed in pages 6, last paragraph, to 8 all as originally filed. They are further in agreement with the statements made by the Respondents in their written submissions.

- 3.2 Respondent 02 argued in addition to these written submissions that claim 1 still did not fulfill the requirements of Article 123(2) EPC in that the method of production only disclosed a final product in which the second layer of hot melt adhesive was in a **pattern registering** with the pattern of the first layer of hot melt adhesive.

The Board cannot concur with this opinion. Claim 15 as originally filed leaves open how the second layer of adhesive is arranged. A continuous second layer of adhesive, for instance, would function properly as the required gas-permeability is in any case guaranteed by the gas-permeable lower layer and the first layer of adhesive being in a pattern of dots.

- 3.3 The amendment of claim 10 lies in the specification that the second layer of hot melt adhesive is in the form of a pattern registering with the first layer pattern, which is disclosed on page 8 as originally filed.

The claims thus fulfill the requirements of Article 123(2) EPC.

3.4 As the amendments further limit the subject-matter of claim 1 as granted, also the requirements of Article 123(3) are fulfilled.

4. *Sufficiency of disclosure (Article 83 EPC) - auxiliary request*

4.1 Claim 1 as amended according to the auxiliary request requires the beads to be evenly distributed across the surface of the adhesive, which is achieved by the distributor roller 56 and the hopper 54 as discussed in the patent in suit, column 4, lines 10 to 14 ("so that the beads are evenly distributes across the surface of the substrate 12"), thus the beads are also evenly distributed over the first layer of adhesive. The patent as granted does not require the first layer of hot melt adhesive to be in a **regular** pattern of dots to achieve this. Column 3, lines 54 to 58 only mentions that the first layer adhesive should be applied in "a pattern of dots", which is the wording of present claim 1.

4.2 The disclosure of the method of producing the claimed biocidal fabric is therefore sufficiently complete for the skilled person to arrive without undue burden at the product claimed in claim 1 and consequently the Board considers that the requirements of Article 83 EPC are fulfilled.

5. *Further procedure*

In its decision under appeal, point 3, the Opposition Division stated the following: "Further, taking into account the written submission [sic] of the parties it

seems that none of the documents would disclose or suggest the subject-matter of an amended claim 1 which is in line with Article 123(2) EPC. Therefore, such an amended claim could be in compliance with Article 54 and 56 EPC".

The Board cannot consider this statement to be a reasoning regarding the question of novelty and inventive step which fulfils the requirements of Rule 68(2) EPC concerning the reasoning necessary for a decision, as the claims of the auxiliary request as submitted in the appeal proceedings were not the subject of the opposition proceedings.

Thus, even though the amendments of the claims meet the objections raised under Article 123(2) EPC in the decision under appeal and the patent fulfils the requirements of Article 83 EPC, the Board considers it necessary to remit the case back to the first instance for further prosecution (Article 111(1) EPC).

In this way the appellant's right to an examination in two instances of these grounds of opposition is guaranteed.

**Order**

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

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

The Registrar:

The Chairman:

M. H. A. Patin

P. Alting van Geusau