

Internal distribution code:

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

D E C I S I O N
of 13 July 2004

Case Number: T 0226/02 - 3.2.7

Application Number: 95920648.3

Publication Number: 0760799

IPC: B65H 55/04

Language of the proceedings: EN

Title of invention:
Spandex supply package

Patentee:
DU PONT-TORAY COMPANY, LTD.

Opponent:
Bayer Faser GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 54, 56, 102
EPC R. 88, 89, 57a

Keyword:

"Prior use - not proven"
"Novelty - yes"
"Inventive step - yes"
"Late-filed documents - some not admitted for lack of
relevancy - some not admitted without examination of relevancy
- some admitted"
"Decision of Examining Division corrected by Opposition
Division - not allowed as ultra vires - correction of patent
not allowed where opposition is to be rejected"

Decisions cited:

T 0472/92

Catchword:

-



Case Number: T 0226/02 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 13 July 2004

Appellant: Bayer Faser GmbH
(Opponent) D-41538 Dormagen (DE)

Representative: Hansen, Bernd, Dr. Dipl.-Chem.
Hoffman Eitle,
Patent- und Rechtsanwälte
Postfach 81 04 20
D-81904 München (DE)

Respondent: DU PONT-TORAY COMPANY, LTD.
(Proprietor of the patent) 5-6, Nihonbashi-Honcho 1-chome
Chuo-ku
Tokyo 103-0023 (JP)

Representative: Woodman, Derek
Frank B. Dehn & Co.
European Patent Attorneys
179 Queen Victoria Street
London EC4V 4EL (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 7 December 2001
rejecting the opposition filed against European
patent No. 0760799 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: A. Burkhart
Members: P. A. O'Reilly
E. Lachachinski

Summary of Facts and Submissions

- I. The appellant (opponent) filed an appeal against the decision of the Opposition Division to reject the opposition against the European Patent No. 0 760 799.
- II. Opposition was filed against the patent as a whole and based on Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(b) (insufficiency).

The Opposition Division rejected the opposition and corrected the decision to grant patent pursuant to Rule 89 EPC.

The most relevant prior art documents for the present decision are:

D1: Package relaxation test result for product number FN4001

D2: Production run protocol

D3: Printouts of sales invoices and freight lists

D4: Graph showing of the results of document D5

D5: Package relaxation test result for product number FN7875

D7: Product brochure dated July 1994

D10: Product brochure dated October 1983

D12: Invoice

D13: Invoice

D14: Freight order

D15: Printout of production run protocol

D16: Dictionary extract defining spandex

D17: Test protocol

D18: Test result

D19: Test result

D20: Test result

D21: Test result

D22: Affidavit

EA-1:Product brochure dated November 1987

EA-2:Printout of customer delivery information

EA-3:Printout of customer delivery information

III. The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the appeal be set aside and the patent be maintained as granted.

IV. The independent claims of the patent as granted read as follows:

"1. A spandex supply package (10) formed by winding spandex (12) obtained directly from a dry-spinning process onto a cylindrical core (14) characterized by a maximum percent package relaxation value and a minimum percent package relaxation value that differ by no more than 2 percentage points, the percent package relaxation value, %R, in any segment of length along the wound-up spandex of the supply package being calculated by the equation

$$\%R = 100(L_r/L_s)$$

where, in any segment of yarn unwound from the package, L_s is the stretched length that the unwound segment had while it was still wound in the package and L_r is the difference between the stretched length L_s and the relaxed length of the unwound segment, and %R, L_r and L_s are measure by the package relaxation value test described in the description."

"3. A process for making a spandex supply package (10), the process including the steps of dry spinning the spandex, forwarding the spandex from an exit of a dry-spinning shaft via feed rolls to a windup on a cylindrical core (14) to form the spandex supply package (10), characterized in that the spandex (12) is wound at a speed that is varied in multiple stages from the start of the winding of the supply package to the completion of the winding of the package, the winding speed in each stage, S_x , being pre-set at a speed that is determined from the corresponding percent package

relaxation value, R_o , measured in a corresponding stage of a package of the same spandex that was wound up at a constant speed, S_o , and the desired percent package relaxation value, R_x , in accordance with the equation

$$S_x = S_o(100 - R_o)/(100 - R_x)."$$

V. The appellant argued in written and oral submissions essentially as follows:

- (i) The ground of insufficiency is no longer pursued.
- (ii) The documents D15 to D22 and EA-1 to EA-3 were produced in response to the provisional opinion given by the Board. A provisional opinion only then makes sense when a party can react to the opinion. The documents are relevant. The documents should therefore be admitted into the proceedings.
- (iii) It is only intended to pursue the prior use indicated under the production number FN7875. Supply packages of this production number were offered for sale as evidenced by document D3. Document D3 only refers to sectional beams but cylindrical cheeses were also offered for sale as evidenced by document EA-1 which specifically refers both to sectional beams and to cylindrical cheeses as being offered for sale for type V500 Dorlastan. This is the material of FN7875. It would make no sense not to offer these products for sale.

The essential properties of the cylindrical cheeses do not change with time. Although document EA-1 recommends usage within six months this is because the adhesion of the fibres may increase with time making unwinding difficult. Document EA-1 recommends certain storage conditions and the leftover cheeses were kept under those conditions. The change in the adhesion has no effect on the package relaxation values. The property relevant to the package relaxation values is governed by hydrogen bonding. These bonds are formed in a time of less than seconds so there is no later change. In a situation where the appellant has to later prove the properties of a product at an earlier date it is not possible to prove this absolutely as it can always be argued that the products have changed. So it would not be possible to prove the contrary. A lower standard of proof should therefore be accepted.

The test results as set out in document D5 show that the leftover cylindrical cheeses of production number FN7875 do indeed have the properties set out in claim 1 of the application.

- (iv) In the absence of the prior use being recognised as belonging to the state of the art the appellant raises no grounds under lack of novelty or lack of inventive step.
- (v) The appellant has no comment regarding the request for correction.

VI. The respondent argued in written and oral submissions essentially as follows:

- (i) None of the documents filed in the appeal procedure should be admitted into the proceedings. The appellant has adopted a piecemeal approach to filing the evidence. This is not acceptable where the evidence is in the hands of the appellant. The evidence filed shortly before the oral proceedings should not be admitted irrespective of its relevance, particularly as some of the evidence relates to a new prior use. If this later evidence is admitted then a remittal to the first instance with an award of costs would be appropriate.

- (ii) The documentary evidence of the appellant only proves the sales of sectional beams but not sales of supply packages. A supply package as set out in claim 1 only has one free end whereas a sectional beam has a large number of free ends as is indeed indicated in document D3. There is no proof that supply packages of the production number FN7855 were sold or offered for sale.

The properties of the supply packages will have changed over time. Document EA-1 indicates that the packages should not be kept more than six months and should be kept in certain conditions. The tested packages were kept for eight years before testing and the conditions in which they were kept are not known. It is not just the properties dependant upon the hydrogen bonds which are relevant to the package relaxation value. The adhesive property of the fibres, which is known to

change over months, is also very relevant to the package relaxation value and would lead to changes in this value. Also, there would be stress relaxation with time. The tests have not been carried out on any sold packages, only on unsold packages, so the properties of the sold packages are not known. It is up to the appellant to prove the prior use up to the hilt.

(iii) The respondent considers that the subject-matter of the independent claims is novel and involves an inventive step.

(iv) A correction under Rule 88 EPC would have been preferred but the respondent understands the problems surrounding the acceptance of this request and therefore does not pursue this request.

Reasons for the Decision

1. Availability of the prior use to the public

1.1 The prior use is based on evidence that: a particular product was sold or offered for sale; that the properties of the product had not changed during the time between its production and the date of later testing; and that the results of the tests show that the product took away the novelty of claim 1.

1.2 The product was identified under the production number FN7875 which was based on Dorlastan V500 which was a spandex product produced by the appellant. The

appellant has produced invoices to the effect that this product was sold as sectional beams to at least two independent companies (see document D3). The respondent has not particularly disputed this point. A sectional beam will, from its nature, have a very large number of free fibre ends. In the document D3 this number was given as 1,320 or 1,360. However, the product which was the subject of later tests in document D5 was a so-called cylindrical cheese (term used in literature of the appellant) or supply package (term used in the patent in suit). Such a package would have only one free end as shown by the fact that the claims state that the package was obtained directly from a dry spinning process and this also is consistent with the description of the patent.

There is thus no direct evidence that a supply package, i.e. having one free end, belonging to the production number FN7875 was sold or offered for sale. The appellant has argued that cylindrical cheeses would have been sold and that document EA-1 shows that Dorlastan was offered both as cylindrical cheeses and sectional beams for the product V500. Although document EA-1 makes a general statement about products offered for sale it naturally does not make any specific statement about the availability for sale of product number FN7875 as a cylindrical cheese. Also, the argument that such a production run would automatically be offered as a cylindrical cheese cannot be followed by the Board. It is quite possible that the whole of the production run FN7875 was sold as sectional beams. Even if all the production run was not sold as sectional beams it could also be that the quantity that was left over was too small to be offered for sale

since wholesale sales are normally in reasonably large quantities. There is thus no concrete reason to conclude that the production run FN7875 undoubtedly was offered for sale as cylindrical cheeses. For this reason alone the allegation of prior use must fail.

- 1.3 The Board has also examined whether the prior use could have disclosed the features of claim 1. The production of FN7875 was in 1991. No date has been given for the test on the leftover package though logically it would have been performed in the period for opposition, i.e. between August 1998 and May 1999. The tests involved examining a leftover package to see if its properties were the same as those set out in claim 1. The question naturally arises as to whether the relevant properties of this package eight years later were representative of its properties at its production date. The appellant argued that the relevant properties change rapidly in the days just after production but thereafter do not change much. The appellant conceded that there were other non-relevant properties which did continue to change for a matter of months after the production. The respondent on the other hand argued that these other properties were in fact relevant and that they changed with time. According to document EA-1 (section 7) Dorlastan is not recommended to be used after six months from production. Document EA-1 also recommends certain storage conditions including temperature and humidity limits. The appellant argues that this has nothing to do with the properties relevant to the prior use and these were kept to. The appellant has not however timely produced any evidence to this effect.

Both parties have produced arguments regarding the effects of time on the properties of the supply packages, though the only evidence admitted into the proceedings is document EA-1. Where a technical question arises and both parties produce essentially non-verifiable arguments the Board has no choice but to rely on the only evidence admitted in the proceedings which in this case is document EA-1. This document as already mentioned above specifically indicates that there are changes with time and in dependence on storage conditions. The Board therefore concludes that even if a supply package from production run FN7875 were proven to have been sold the properties of these packages have not been shown to be the same in 1998/9 as they were in 1991. This conclusion is reached without considering the further question as to whether leftover packages may be considered as having the same properties as those packages that might have been sold.

1.4 The appellant has argued that in a case like the present they are put in the impossible situation of having to prove that something is the same now as it was in 1991. However, it was open to the appellant to attempt to obtain independent expert evidence as to the aging properties of this type of product. In the same manner was it was open to the respondent to obtain independent counter evidence on this point.

1.5 Even if the leftover packages were considered to have been available to the public and to be representative of the product at the date of a possible sale the validity of the test results must still be considered. The tests first of all depend upon the existence of leftover packages for which no evidence was timely

offered. Independent testing for instance might have been able establish an approximate age for the leftover packages. No indication of the test procedures was timely given. All that was presented in due time was a statement that leftover packages existed and a table of results as to their properties. This is clearly insufficient to establish the probity of the test results. The present case corresponds to that of the often cited decision T 472/92. This Board supports that decision. The whole of the evidence, both as to the existence of sales, the existence of leftover packages and the properties of those packages lay in the hands of the appellant. The appellant should therefore have presented as much independent evidence as possible, i.e. documentary evidence of the existence of the leftover package, and tests of the age and properties of the leftover packages performed by an independent institute. The dangers of accepting evidence uncritically from a party are shown in the evidence that the appellant supplied which was based on a later reproduction of the earlier products. This evidence was subsequently withdrawn by the appellant when the appellant realised that the composition of the reproduced product did not correspond to the composition of the original. The Board does not imply that the appellant attempted to mislead since the subsequent voluntary withdrawal indicates the contrary, but this shows that even honest attempts may produce false results due to undetected errors.

- 1.6 The appellant thus failed to prove a sale, failed to prove that the properties of the later tested product were the same as those of the alleged sale and failed to show that the test results were valid. The alleged

prior use is thus not proven and it does not belong to the prior art pursuant to Article 54(2) EPC.

2. *Novelty*

2.1 The appellant was unable to present any arguments as to novelty in the absence of the alleged prior use being considered part of the state of the art.

2.2 Therefore, the subject-matter of claims 1 and 3 of the main request is novel in the sense of Article 54 EPC.

3. *Inventive step*

3.1 The appellant was unable to present any arguments as to inventive step in the absence of the alleged prior use being considered part of the state of the art.

3.2 Therefore, the subject-matter of claims 1 and 3 of the main request involves an inventive step in the sense of Article 56 EPC.

4. *Documents and requests to hear witness filed during the appeal proceedings*

4.1 The appellant filed documents D12 to D14 along with the grounds of appeal. Furthermore, in a submission filed one month before the oral proceedings before the Board the appellant filed documents D15 to D22 and EA-1 to EA-3 and requested four witnesses to be heard. The respondent objected to the admission of these documents and the hearing of the witnesses. With respect to the admission of the documents the Board would note that at the beginning of the oral proceedings before the Board

the appellant indicated his intention to pursue only the prior use identified under the production number FN7875.

- 4.2 Document D12 does not have a clear link to FN7875 and is just a freight document to send goods to another company. This company in fact belongs to the appellant. The document has no obvious relevance to the prior use of FN7875. Documents D13 and D14 concern another alleged prior use - FN7367 - which is no longer pursued by the appellant. These documents are thus also not relevant and hence not admitted.

Document D15 is a printout from the records of the appellant which is intended to show that the supply packages were spun direct from the dry-spinning process. The document merely lists the values of a number of parameters. Moreover, the document is an internal document of the appellant which could have been produced earlier in the proceedings. The production of the document at a late stage in the proceedings is not acceptable. The document is thus not admitted into the proceedings.

Document D16 is a dictionary extract which is intended to show the meaning of a term used in the patent in suit and thus is an indication of the scope of the claims of the patent in suit. The document raises no new issues and merely supports existing arguments. The Board therefore admits the document.

Documents D17 to D21 concern newly performed tests on a leftover package of FN7875. These documents raise new issues and could possibly lead to the respondent

needing to carry out counter tests. This in turn could lead to a new oral proceedings and/or possibly a remittal to the first instance. The Board therefore considers that the documents may not be admitted at this late stage of the proceedings irrespective of their relevance.

Document D22 is an affidavit of an employee of the appellant. Although the document is intended to support the sale of a supply package under the production number FN7875 the signatory is only able to make general statements about what usually occurred and does not make specific statements concerning FN7875. The Board considers therefore that the document is not relevant and does not admit the document.

Document EA-1 is a product information brochure which is another version of the documents D7 and D10 which were filed with the opposition grounds, though EA-1 is dated nearer to the alleged prior use FN7875. The content of documents D7 and D10 has already been used by the respondent in his defence. Document EA-1 does not raise any new issues but rather ensures that both parties are dealing with more accurate product information when dealing with the alleged prior use FN7875. The Board therefore admits this document.

Documents EA-2 and EA-3 are internal documents of the appellant and concern the sales of a further type of supply package. The documents thus essentially concern a new alleged prior use. The same considerations therefore apply to these documents as to documents D15 and D17 to D21. The documents are therefore not admitted into the proceedings.

In conclusion, the Board admits only documents D16 and EA-1 into the proceedings.

4.3 The witnesses were offered to support the evidence filed in documents D15 and D17 to D21. Since this evidence is not admitted into the proceedings it is not necessary to hear the witnesses.

4.4 With respect the filing of documents D15 to D22 and EA-1 to EA-3 just one month before the oral proceedings the appellant explained that these were filed in response to the opinion of the Board, issued with the summons to the oral proceedings, that the existing evidence did not show what was sold. The Board would note that the provisional opinion of the Board does not require a response, nor is it intended to incite the filing of further evidence. The Board assumes when issuing the opinion that all available evidence has been filed and merely gives its provisional opinion to allow an orderly conduct of the oral proceedings. The argument of the appellant in this respect cannot be accepted

5. *Decision of the Opposition Division regarding Rule 89 EPC*

5.1 During opposition proceedings the respondent had requested a correction to the description of the patent as granted under Rule 88 EPC. At the oral proceeding before the Opposition Division the correction was apparently not discussed and the Chairman delivered the oral decision that the opposition was rejected. The tenor of the written decision, which was signed by the

members of the Opposition Division, was that the opposition was rejected. The written grounds for the decision included a section at the end under the rubric "Decision". In this section it was indicated that the opposition was rejected and that the description of the patent was amended according to Rule 89 EPC.

The Board considers however that the Opposition Division acted *ultra vires* in taking a decision under Rule 89 EPC to correct a decision of the Examining Division. Only the body which took a decision is entitled to correct that decision to the form which the body had intended the decision should take. Thus, only the Examining Division was entitled to correct its own decision. Moreover, there is no reason to believe that the decision taken by the Examining Division did not correspond to what the Examining Division intended. The fact that the proprietor later discovered errors in the patent documents does not mean that the decision taken by the Examining Division was not the decision which it intended to take.

- 5.2 The Board considered the possibility of a correction under Rule 88 EPC as this is what the respondent originally requested. However, Article 102 EPC allows only three possibilities for the outcome of an opposition proceedings. Either the patent is revoked, the opposition is rejected, or the patent is maintained amended. In the present case only maintenance in amended form came into consideration in order to allow the correction. Following Rule 57a EPC amendments are only allowed if they are occasioned by a ground of opposition. This is not the case here so that the correction in the form of an amendment is not allowable.

The Board is also aware that for a correction under Rule 88 EPC there must be for a mistake made in a document filed at the EPO. The filed document would therefore need to be identified. Since the granted patent is based on a text approved by the applicant it is not immediately apparent that a filed document containing an error can be identified and that the correction of the error in the document would lead to a change in the form of the granted patent. Because the present case one where the opposition is rejected this point does not need to be addressed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is maintained as granted.

The Registrar:

The Chairman:

G. Nachtigall

A. Burkhart