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D E C I S I O N
of 26 May 2004

Case Number: T 0382/02 - 3.2.6

Application Number: 95900223.9

Publication Number: 0728233

IPC: D02G 1/18

Language of the proceedings: EN

Title of invention:
Method for making thread

Patentee:
J. & P. Coats, Limited

Opponent:
Amann & Söhne GmbH & Co.

Headword:

-

Relevant legal provisions:

EPC Art. 54
RPBA Art. 11(1)

Keyword:

"Novelty (no)"
"Postponement of the proceedings (no)"

Decisions cited:

G 0006/95

Catchword:

-



Case Number: T 0382/02 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 26 May 2004

Appellant: J. & P. Coats, Limited
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Representative: McNeight, David Leslie
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Respondent: Amann & Söhne GmbH & Co.
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Representative: Lau-Loskill, Philipp, Dipl.-Phys.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 21 February 2002
revoking European patent No. 0728233 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: H. Meinders
J. H. Van Moer

Summary of Facts and Submissions

I. European patent No. 0 728 233 was revoked by decision of the Opposition Division sent to the parties on 21 February 2002. According to this decision the subject-matter of claim 1 as amended in the opposition proceedings was not novel taking account of:

D1: EP-A-0 367 938.

In the opposition proceedings reference was also made to:

D6: EP-A-0 057 583,

a document mentioned in the patent in suit.

II. An appeal was filed by the patentee on 15 April 2002 with payment of the appeal fee on that same date. The statement of grounds of appeal was filed on 13 June 2002.

III. In a communication in preparation of oral proceedings sent by fax to the parties on 5 May 2004 the Board addressed a number of points to be discussed during the oral proceedings, in particular the acceptability of the amendments and the alleged differences vis-à-vis the subject-matter disclosed in D1.

IV. Oral proceedings were held on 26 May 2004.

The final requests of the Appellant were to postpone the proceedings and to maintain the patent in amended form as submitted in the oral proceedings.

The Respondent requested to dismiss the request for postponement of the oral proceedings as well as the appeal itself and to revoke the patent.

- V. Claim 1 as filed in the oral proceedings reads as follows:

"A method for making a thread comprising:

feeding at least two drawn, continuous filament starting threads (18, 19), of which at least one is a multifilament thread, together to an intermingling device (21) to form a single bulked thread of which the filaments of the starting threads are intermingled and looped, and applying a bulk-reducing treatment to the bulked thread characterised in that the bulk-reducing treatment comprises a treatment under tension without the thread being heated, said bulk-reducing treatment essentially reducing the size of the filament loops so that the thread becomes an essentially unbulked thread, whilst retaining its intermingled structure".

- VI. The appellant argued essentially as follows:

The Representative had only returned from holidays three days prior to the oral proceedings and only then had had the possibility to read the communication of the Board sent on 5 May 2004. With this communication the representative had not reckoned as, contrary to normal practice, it had not been sent with the summons to the oral proceedings sent on 12 March 2004. This was also evidenced by the letter of the Respondent dated 18 March 2004, inquiring whether the Board intended to

issue such a communication. The provisional opinion of the Board had led to a further submission of the Respondent dated 11 May 2004, also found only on return of the representative's holidays, for the translation of which - as it was in the German language - there had not been sufficient time. This last submission provided further reasoning which needed to be discussed with his client.

The process according to the patent in suit had resulted from the realisation by the Appellant that the bulk reduction achieved in D6 by heat treatment could also be arrived at by a treatment under tension. Both the process according to the patent and the process according to D6 resulted in the filament loops produced in the thread by the intermingling device to be contracted into knots lying within the thread, forming bud like projections. This was explicitly mentioned in D6 (page 6, lines 34, 35 and page 7, lines 22 to 24). It was not explicitly mentioned in claim 1 nor in the patent in suit, but was derivable from column 4, lines 9 to 15 of the patent in suit, which referred to "essentially unbulked thread, whilst retaining its intermingled structure". It also followed from the reference in the patent in suit to the method of D6 which could be modified (column 1, lines 24 to 31) or of which certain features could be applied (column 1, lines 48 to 54). The latter references meant that the invention of the patent in suit was intended to produce the same thread.

For the process according to D1, to the contrary, it was explicitly mentioned in D1 that the loops should **not** be contracted into knots because the loops were

needed to entrain air (column 8, lines 2 to 16). Thus the thread resulting from the process of D1 could not be an "essentially unbulked thread" as claimed in claim 1.

Further, the mention in D1 that the loops were reduced in size from 20% up to 95% meant that some were reduced up to this high percentage, but that others were not at all reduced, thus one could not speak of an "essentially unbulked thread". Also a thread which, according to the photo disclosed in D1, had an effective diameter of 1 mm or more (thus more than three times its core diameter) could not be considered an "essentially unbulked thread".

Finally, if the process discussed in D1 would be novelty destroying for the subject-matter of claim 1, it would also fall within the scope of the patent granted to the Appellant on the application D6, which surely the Respondent would not wish to be established, being the applicant of D1.

VII. The respondent brought forward the following:

The request for postponement of the proceedings should be refused as the appellant had had ample time to consider the Respondent's arguments dated 28 October 2002 in reply to his appeal. The submission dated 11 May 2004 did not raise any new points compared with the Board's communication, thus could not provide a reason for postponement.

The disclosure of D1 should be taken on its own; it was evident from this document that there was a

considerable reduction in loop size, up to 95%, which constituted the claimed "bulk-reducing treatment" and resulted in fulfilling the claimed requirement of "essentially reducing the size of the filament loops so that the thread becomes an essentially unbulked thread whilst retaining its intermingled structure". The wording of claim 1 nor of the description of the patent in suit gave an indication of loops in the filaments being tightened into knots lying within the thread, as suggested by the Appellant.

Also, the reference to D6 could not help as it related only to modifying the method of production of the thread, not to the resulting thread itself. In particular it did not point at the specific feature of the loops being tightened into knots lying within the thread and forming bud-like projections.

Reasons for the Decision

1. The appeal is admissible.
2. *Request for postponement of the proceedings*
 - 2.1 According to G 6/95 (OJ EPO 1996, 649, Point 5 of the Reasons) Rule 71a(1) EPC does not apply to the Boards of Appeal and the Boards continue to have a discretion as to whether or not to send a communication when a summons to oral proceedings is issued as provided in Article 11(2) RPBA then in force (essentially present Article 11(1) RPBA in the version approved by the Administrative Council on 12 December 2002, OJ EPO 2003, 61).

The present Board considers that this discretion not only extends to **whether**, but also to **when** such a communication is sent out, as long as sufficient opportunity to be heard is given to the parties prior to a decision being taken.

The communication setting out the provisional opinion of the Board as well as the points to be discussed in the oral proceedings set for 26 May was sent for the sake of expedience by fax to the parties on 5 May 2004, i.e. three weeks in advance of the oral proceedings. In view of the issues addressed in this communication, which in fact were based on the submissions of the Appellant in the statement of grounds of appeal and the Respondent's reply thereto, the Board considers this period largely sufficient for the parties to prepare themselves properly for these oral proceedings. Judged against this background also the three days available to the representative between his return from holidays and the date of the oral proceedings are considered by the Board as sufficient for preparation of the case for the coming oral proceedings.

- 2.2 Further, the fact that this communication was received during the representative's holidays or that he only gained knowledge of its contents upon return of his holidays cannot provide a legitimate reason for postponement of the oral proceedings, as the Board considers it the representative's duty to ensure proper treatment - in his absence - of any submissions in the cases he is responsible for.

This applies also to the letter of the Respondent dated 11 May 2004, sent to the EPO by telefax on 12 May 2004 and forwarded by telefax by the EPO that same day to the Appellant. The Board considers that in the present case the two weeks up to the oral proceedings largely sufficed for the translation and treatment of this submission in the German language.

- 2.3 In any case, the arguments raised in that submission have not played a role in the oral proceedings nor in the present decision, as conceded by the Appellant, who during the oral proceedings explicitly declared that he had had sufficient opportunity to address all the relevant issues.

In the absence of a valid reason the request for postponement of the proceedings is to be refused.

3. *Amendments (Article 123 EPC)*

Claim 1 as granted has been amended in that the following feature has been added: "said bulk-reducing treatment essentially reducing the size of the filament loops so that the thread becomes an essentially unbulked thread, whilst retaining its intermingled structure".

These amendments are derivable from page 6, second paragraph of the original application documents and further limit its subject-matter. Thus the requirements of Article 123 EPC are fulfilled. No further formal objections have been raised in these appeal proceedings and the Board has ascertained that the present wording of claim 1 is formally in order.

4. *Novelty (Article 54 EPC)*

4.1 The parties and the Board agree that the discussion on the novelty of the subject-matter of claim 1 centres on the question whether the process of D1 "essentially reduces the size of the filament loops so that the thread becomes an essentially unbulked thread, whilst retaining its intermingled structure" as claimed in claim 1, the remaining features of the process of that claim being known from D1.

4.2 The Appellant argued that an "essentially unbulked thread retaining its intermingled structure" in the context of present claim 1 and the patent in suit should be considered a thread which was first bulked, but of which the loops have later been tightened up to form bud-like knots within the thread.

However, in the patent in suit the Board is unable to find a disclosure of a thread with such specific features. The description nor the claims nor the single figure disclose anything in the form of tightened-up knots nor of bud-like projections within the thread.

There is only the mention in column 4, lines 7 to 22 that the unbulked thread is the result of the treatment under tension of a bulked thread without it being heated, which treatment essentially reduces the size of the filament loops so that the thread becomes an essentially unbulked thread, whilst retaining its intermingled structure. Thus, according to this definition as contained in the patent itself, the "essential" reduction in size of the filament loops of

a previously bulked thread qualifies this thread as an "essentially unbulked thread".

- 4.3 However, in D1, column 7, line 51 - column 8, line 37 there is disclosed a method for making a thread with the steps as mentioned in the pre-characterising part of claim 1, wherein the thread is subjected to a treatment under tension without the thread being heated. The result is that the diameter of the loops which were formed in the intermingling device is reduced from 20% up to 95%.

In the opinion of the Board, such a reduction in diameter is to be seen as an "essential reduction" in size of the filament loops as claimed in claim 1. Further, the thread has loops in the filaments which cross each other (column 7, lines 56, 57), of which the size is reduced by the tension treatment. If the thread maintains its intermingled structure while the size of the filament loops according to the method of claim 1 of the patent in suit is reduced by a tension treatment (no further details are provided in the patent in suit how this intermingled structure is actually maintained) the same must apply for the tension treatment as disclosed in D1.

The result of the process disclosed in the indicated passages of D1 will therefore be an "essentially unbulked thread retaining its intermingled structure" as mentioned in claim 1 of the patent in suit.

The subject-matter of claim 1 is therefore not novel over that disclosed in D1.

4.4 The assertion that the effective diameter of the final thread as produced by the process according to D1 was 1 mm or larger and therefore disqualified such a thread from being an "essentially unbulked thread" as claimed in claim 1, cannot convince the Board either, as the patent in suit does not define the thread produced by the claimed method in any quantitative manner enabling a distinction between threads which are "essentially unbulked" and which are not, on the basis of their effective diameter.

4.5 The references in the patent in suit to D6 cannot help either in attributing to the thread produced according to the process of claim 1 the feature of the filament loops having been tightened into bud-like knots within the thread, as this would have required a specific reference to those parts of the disclosure of D6 which mention this feature. However, such a specific indication cannot be found in the patent in suit.

Further, the available references to D6 are not in the sense that it is mentioned as the closest prior art, which, to the contrary is specifically indicated as being US-A-4 319 447. The first reference only relates at the most to a method to eliminate the bulkiness of an intermingled textured yarn (column 1, lines 21 to 23), nothing being said about the actual technical features of the thread resulting from such a method. The second reference to D6 (column 1, lines 48 to 54) concerns the intermingling device disclosed in D6 which can be used for bulking the thread or the fact that one or more of the starting yarns could be overdrawn, hot drawn, cold drawn, continuously or separately drawn.

The Board cannot see how these references should lead to the specific conclusion that the resulting thread has loops tightened into bud-like knots lying within the yarn, as suggested by the Appellant.

Finally, the argument of the Appellant that if D1 would provide a disclosure of a method for making a thread which was novelty destroying for the method as claimed in claim 1, that same method would unfortunately for the Respondent fall within the scope of the patent granted on application D6 to the Appellant, cannot hold either.

The patent granted on application D6 is not the subject of these appeal proceedings.

The determination of what subject-matter falls within the scope of the patent granted on application D6 is the sole competence of a national court in proceedings concerning that patent and depends on the interpretation of its claims pursuant to Article 69 EPC by that court.

Thus this issue need not be considered by the present Board.

In view of the above conclusions, the appeal is to be dismissed.

Order

For these reasons it is decided that:

1. The request for postponement of the oral proceedings is refused.
2. The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

P. Alting van Geusau