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**Datasheet for the decision  
of 11 December 2007**

**Case Number:** T 1160/04 - 3.2.07

**Application Number:** 98200066.3

**Publication Number:** 0848108

**IPC:** D21G 1/00

**Language of the proceedings:** EN

**Title of invention:**

Calender for calendering of a paper or of an equivalent web material

**Patentee:**

Metso Paper, Inc.

**Opponent:**

Voith Paper GmbH

**Headword:**

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**Relevant legal provisions:**

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**Relevant legal provisions (EPC 1973):**

EPC Art. 76(1)

**Keyword:**

"Decision on the state of the file"

"Patent as granted based on divisional application extending beyond the content of the earlier (parent) application as originally filed (yes)"

**Decisions cited:**

G 0001/05, T 0284/94, T 0194/84, G 0003/06

**Catchword:**

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Case Number: T 1160/04 - 3.2.07

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.07  
of 11 December 2007

**Appellant:** Metso Paper, Inc.  
(Patent Proprietor) Fabianinkatu 9 A  
SF-00130 Helsinki (FI)

**Representative:** TBK-Patent  
Bavariaring 4-6  
D-80336 München (DE)

**Respondents:** Voith Paper GmbH  
(Opponent) Birkschenweg 5  
D-47803 Krefeld (DE)

**Representative:** Knoblauch, Andreas  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 20 July 2004  
revoking European patent No. 0848108 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** H. Meinders  
**Members:** H. Hahn  
I. Beckedorf

## Summary of Facts and Submissions

- I. The patent proprietor lodged an appeal against the decision of the Opposition Division to revoke European patent No. 0 848 108. It requested that the decision be set aside and the patent be maintained as granted.
- II. An opposition had been filed against the patent as a whole under Article 100(a) EPC on the grounds of lack of novelty and inventive step, and under Article 100(c) EPC for extending beyond the content of the earlier application as originally filed.

The Opposition Division held that the product claim 1 of the patent granted on the divisional application did not contain all the essential features of claim 12 of the parent application (the features 2-4 mentioned under item 2 of the decision had been omitted) so that Article 100(c) EPC was contravened. Auxiliary request 1 had been filed late at the oral proceedings before the Opposition Division and was thus not in accordance with Rule 71a EPC. Furthermore, it was not considered to be *prima facie* allowable since the issues of Articles 100(c) and 123(2) EPC were not clearly resolved and the subject-matter then claimed presumably would lead to a double-patenting problem with the parent patent. Therefore auxiliary request 1 was not admitted by the opposition division.

- III. With a communication dated 28 March 2007 the Board presented its preliminary opinion based on the single request, i.e. maintenance of the patent with claims 1 to 14 as granted.

The Board gave its preliminary opinion that the subject-matter of claim 1 extended beyond the content of the parent application as originally filed and stated among others:

"2.2 Claim 1 of the divisional application as filed comprised the features "a substantially vertical stack of rolls (12,12a) and said rolls (13...22,13a...22a), placed one above the other" which were omitted later in the examination procedure. This fact implies to the Board that the applicant considered these features - at least at the time when filing the divisional application - to be essential.

Furthermore, taking account of the statement at page 16, lines 11 to 15 of the parent application as originally filed, namely that "... the invention may vary within the scope of **the inventive idea defined in the accompanying patent claims**" in combination with its claims 1 and 12 as originally filed, which both define that the rolls are "arranged as a substantially vertical stack of rolls" while the latter additionally defines that the rolls are "placed one above the other" and further considering

a) the statements at page 1, lines 6 to 16 that the invention concerns a method and a calender wherein "the rolls are arranged as a substantially vertical stack of rolls", and that "said rolls are placed one above the other", and that

b) the starting point of the technical problem is represented by the supercalender comprising "a number of rolls which have been arranged one above the other as a stack of rolls" (see page 1, lines 18 and 19) resulting in several drawbacks such as the non-uniform

linear load in the nips and the friction at the guides;  
and

c) that a horizontal positioning of the rolls is highly problematic (see page 4, line 25 to page 5, line 1) and that a stack of rolls divided into two parts solves the problem of incomplete loading only partially, and

d) that the object of the application is defined as the provision of a method and calender wherein the problems arising from the own gravity of the set of rolls of the calender in the distribution of linear loads are avoided and by means of which **all the nips in the set of loads of the supercalender can be loaded adjustably in the desired way** and, if necessary, substantially with the same maximum load (see page 5, lines 11 to 17);  
and

e) that this is achieved by the method and calender in accordance with "the invention which is **mainly** characterized in that ..." (see page 5, line 17 to page 6, line 3)

it seems to be evident that the features related to the "substantially vertical stack of rolls" and "said rolls placed one above the other" represent essential features which are already implied by the starting point, i.e. that a supercalender shall be improved. Said wording "**mainly** characterized" implies that said passages at page 5 do not provide a clear counterpart to the subject-matter of claims 1 and 12. On the other hand said claims are stated at page 16 to correspond to the inventive idea.

Furthermore, it seems that claim 1 of the divisional application as granted does not exclude a calender having two roll stacks while it seems that such an

embodiment was excluded by claim 12 of the parent application due to its combination of features "substantial vertical stack ... placed one above the other ... an external load (...) applied to the upper or lower roll" which thus excluded a plurality of upper and lower rolls.

2.3 Likewise it was considered to be part of the inventive idea of the parent application as specified in its claim 12 (compare also page 5, lines 29 and 30) that "the means of suspension (...) of the intermediate rolls (...) are provided with relief devices (...), by which means, during calendering, the nip loads produced by the masses of the intermediate rolls (...) and of the auxiliary equipment (...) related to them have been relieved substantially completely" whereas according to claim 1 as granted simply the "nip loads produced by the masses of the intermediate rolls and of the auxiliary equipment related to them are relieved". Hence according to claim 1 as granted the relief - at least theoretically, e.g. by using a device creating strong magnetic fields for controlling the position of the rolls (the inner side of the roll mantle is provided with magnets) and thus of the nip loads - can be applied somewhere else than at said means of suspension of the intermediate rolls. However, all embodiments disclosed in the parent application relate to relief devices which are applied to the means of suspension, i.e. to the axles of the rolls (compare figures 4 to 6 and their description, particularly page 12, lines 16 to 20; page 14, lines 10 to 32; page 15, line 11 to page 16, line 6). The statement in the description at page 16, lines 6 to 9 subsequently following the description of such embodiments only

makes clear that generally other sorts of modes of support and modes of relief are also possible but without giving any clear indication to the skilled person as to how this should be done and/or achieved.

However, with respect to the generalisation of an originally disclosed feature it is established case law (see Case Law of the Boards of Appeal of the European Patent Office, 4th edition, 2002, sections III.A.1 and III.A.3, see e.g. decisions T 284/94, OJ EPO 1999, 464; and decision T 194/84, OJ EPO 1990, 59) that replacing a disclosed specific feature in a claim by a more general expression is not allowable under Article 123(2) EPC (or in the present case under Article 76(1) EPC), since the introduction of such a general feature for the first time implicitly incorporates further features in the subject-matter of the application, so that combined with the disclosed features novel subject-matter would be created as compared with the application as originally filed.

2.4 Likewise it was considered to be part of the inventive idea of the parent application that "**the calendering nips have been arranged so that they can be loaded adjustably by means of a load** produced by the variable-crown upper roll or lower roll and/or by means of an external load applied to the upper or lower roll". The appellant's arguments in this context seem not to be acceptable. Firstly, claim 12 of the patent application as originally filed required that said nips had to be arranged in a specific manner, namely so that they can be loaded adjustably by means of a load, which condition is no longer required by claim 1 as granted. This definition may be interpreted such that only

specific arrangements of the nips were suitable for this purpose. Claim 1 as granted, however, is no longer restricted to such an arrangement.

Secondly, if the appellant's arguments that said feature covered all possibilities were actually true then there existed neither a need to delete it from claim 1 nor to have said feature contained as a preferred feature in dependent claim 3 as granted."

The Board then concluded that claim 1 **as granted** did not meet the requirements of Article 76(1) EPC for the features mentioned in points 2.2 to 2.4 above and that consequently, it seemed that the single request of the appellant was not allowable.

IV. With a second communication dated 27 August 2007 and annexed to the summons to oral proceedings the Board referred to its above mentioned provisional opinion with respect to the admissibility of the amendments made to claim 1 during the examination procedure of the divisional application leading to the patent in suit, no amended claims having been filed since.

The Board then remarked that the appeal proceedings will be continued since the questions concerning divisional applications which are relevant to the present case and which were referred to the Enlarged Board of Appeal (i.e. the consolidated case G 1/05; the second case G 3/06 was terminated since all appeals had been withdrawn) have been decided upon and the decision has now been rendered. According to this decision a divisional application may be amended after the application has been filed so as to comply with the



provisions of Article 76(1) EPC, provided always that the amendment complies with the other requirements of the EPC. Furthermore, a divisional application is treated in the same manner and subject to the same requirements as an ordinary application (see G 1/05, particularly points 7 and 9 of the reasons; a copy of the decision was annexed to the communication). The questions referred to the Enlarged Board of Appeal regarding divisional applications having been decided upon (G 1/05, G 1/06) the appeal proceedings would be continued and oral proceedings were arranged.

The parties were given the opportunity to file observations to the communication which should be filed well in advance, i.e. at least one month, before the date of the oral proceedings in order to give sufficient time to the Board to prepare for the oral proceedings.

Finally, the parties were advised to take note of the amended Rules of Procedure of the BoA, in force as of 1 May 2003 and especially of Article 10b.

V. No reaction to the communication of the Board was received from the appellant.

With letter dated 15 October 2007 the respondent informed the Board that it would not attend the oral proceedings.

With letter dated 25 October 2007 the appellant informed the Board that it would also not take part in the oral proceedings and that the request for oral proceedings was withdrawn.

VI. Oral proceedings before the Board were held on 11 December 2007 in the absence of both parties.

- (a) The appellant (patent proprietor) had requested, in the written proceedings, that the decision under appeal be set aside and the patent be maintained as granted.
- (b) The respondent (opponent) had requested, in the written proceedings, that the appeal be dismissed.

At the end of the oral proceedings the Board announced its decision.

VII. Claim 1 as granted reads as follows:

"1. Calender which comprises a frame (11;11a), a variable-crown upper roll (13;13a), a variable-crown lower roll (14;14a), and two or more intermediate rolls (15...22; 15a...22a) fitted between the upper (13a;13a[should correctly read: 13; 13a]) and lower (14;14a) rolls, said upper, lower and intermediate rolls being arranged on the frame (11; 11a) of the calender as a stack of rolls (12; 12a) and being in nip contact with one another to form calendaring nips (N<sub>1</sub>..N<sub>9</sub>) between said rolls, wherein as the intermediate rolls, hard- and soft-faced rolls are used in which the form of the natural deflection line produced by their own gravity is substantially equal and the nip loads produced by the masses of the intermediate rolls and of the auxiliary equipment related to them are relieved."

## Reasons for the Decision

1. The Board interprets the appellant's reply dated 25 October 2007, withdrawing its request for oral proceedings, indicating it would not attend and not furnishing further arguments, as a request for a decision "according to the state of the file".
2. In the communication dated 28 March 2007 to which the Board referred in its second communication accompanying the summons for oral proceedings the Board raised objections under Article 76(1) EPC regarding claim 1 of the patent in suit, granted on the divisional application, explaining why in the Board's opinion the subject-matter claimed therein, i.e. claim 1 of the single request, was held to extend beyond the content of the parent application as originally filed (see point III above).
3. The appellant neither replied in substance to these objections nor did it attend the oral proceedings. Since there has been no attempt by the appellant to refute or overcome the objections raised in the above communication, the Board has no reason to depart from its preliminary opinion expressed therein.

The Board therefore concludes - for the reasons set out in the first communication (see point III above) - that claim 1 as granted is not allowable, as it contravenes the requirements of Article 76(1) EPC.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

A. Wolinski

H. Meinders