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**Datasheet for the decision  
of 26 September 2006**

**Case Number:** T 1380/04 - 3.2.06

**Application Number:** 97122316.9

**Publication Number:** 0849381

**IPC:** D01G 1/00

**Language of the proceedings:** EN

**Title of invention:**

Improved chopper for cutting fiber continuously, and method

**Applicant:**

Johns Manville International, Inc.

**Opponent:**

SAINT GOBAIN VETROTEX FRANCE SA

**Headword:**

Glass fiber chopper apparatus and method

**Relevant legal provisions:**

EPC Art. 54, 56, 84, 123(2)/(3)

**Keyword:**

"Main request - amendment to overcome clarity problem;  
inadmissible due to principle of prohibition of reformatio in  
peius"

"First auxiliary request - clarity (yes); novelty (yes)"

"Introduction of new document into proceedings"

"Prior use allegation - late filed without sufficient  
justification"

"Remittal to first instance"

**Decisions cited:**

G 0001/99

**Catchword:**

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Case Number: T 1380/04 - 3.2.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.06  
of 26 September 2006

**Appellant:** SAINT GOBAIN VETROTEX FRANCE SA  
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**Representative:** Colombier, Christian  
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**Respondent:** Johns Manville International, Inc.  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
14 October 2004 concerning maintenance of  
European patent No. 0849381 in amended form.

**Composition of the Board:**

**Chairman:** P. Alting van Geusau  
**Members:** M. Harrison  
W. Sekretaruk

## Summary of Facts and Submissions

- I. In the opposition division's interlocutory decision dated 14 October 2004, European patent EP-B-0 849 381 (based on application 97122316.9) as amended was found to meet the requirements of the European Patent Convention.

Claim 1 of the patent in its amended form read as follows:

"An apparatus for chopping fiber strands into short lengths comprising a three dimensional frame (50) having three or more sides, a chopper assembly connected to said frame including a blade roll (40) and a backup roll (36) being located adjacent one side of said frame, characterized in that a second chopper assembly comprising a second blade roll (40A) and a second backup roll (36A) is connected to said frame (50) located adjacent another side of said frame; said frame (50) being rotatable to move said first chopper assembly out of an operating position and into a non-operating position while moving said second chopper assembly out of a non-operating position and into said operating position."

- II. The opponent (appellant) filed an appeal against this decision, requesting revocation of the patent in its entirety.

The following documents were filed for the first time with the appeal grounds:

D15: US 5 525 052

D16: US 2 404 146

D17: US 1 478 052

D18: Document entitled "PRICE OFFER No 01992"

D19: Telex from F. Hubert

D20: Purchase Order Number 127523 from Certain Teed Corporation,

whereby D18 to D20 relate to an alleged public prior use.

- III. The respondent (proprietor) requested dismissal of the appeal. Additionally the respondent requested that D15, D16 and D17 as well as the alleged public prior use based on D18 to D20 not be admitted into proceedings and that, if any of these were admitted, the case be remitted to the opposition division for further examination.
- IV. Together with its summons to oral proceedings, the Board issued a communication containing its provisional opinion. The opinion indicated *inter alia* that the alleged prior use was late-filed and did not seem to meet the standard of evidence required to demonstrate a *prima facie* case of public prior use. Also as regard claim 1 and claim 11, the clarity of the terminology "into short lengths", added during first instance opposition proceedings, was questioned. It was further noted that the document D16 might have further relevance to the matter of inventive step compared to documents already in the proceedings.
- V. In its reply dated 15 August 2006, the respondent filed a new main request and four auxiliary requests.

Independent claim 1 of the main request differed from claim 1 considered allowable by the opposition division only in that the terminology "into short lengths" was removed.

VI. During oral proceedings before the Board, the respondent filed a replacement first auxiliary request, containing amended independent claims 1 and 11, which read as follows:

"1. A chopper apparatus for chopping glass fiber strands into short lengths comprising a three dimensional frame (50) having three or more sides, a chopper assembly connected to said frame including a blade roll (40) and a backup roll (36) being located adjacent one side of said frame, characterized in that a second chopper assembly comprising a second blade roll (40A) and a second backup roll (36A) is connected to said frame (50) located adjacent another side of said frame; said frame (50) being rotatable to move said first chopper assembly out of an operating position and into a non-operating position while moving said second chopper assembly out of a non-operating position and into said operating position.

11. A method of making chopped fiber by chopping glass fiber strands into short lengths using a chopper that must be shut down periodically for repair comprising the following steps:

- Pulling strands of glass fiber into a first chopper assembly comprising a blade roll (40) and a backup roll (36), said chopper assembly being connected to a three-dimensional rotatable frame at one side thereof;
- stopping the chopping;

- rotating said frame so as to move said first chopper assembly out of the operating position into a non-operating position while moving a second chopper assembly connected to said frame adjacent a second side thereof out of a non-operating position into the operating position;
  - starting chopping by feeding glass fiber strands into a nip between the backup roll (36A) and the blade roll (40A) of said second chopper assembly."
- VII. During oral proceedings, the respondent requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request as filed with the letter of 15 August 2006, or on the basis of the first auxiliary request as filed during the oral proceedings or, failing this, on the basis of one of the second to fourth auxiliary requests filed with the letter of 15 August 2006. Additionally, the respondent maintained its previous requests related to the non-admittance of documents D15 to D20 and the request for remittal if any of these documents was introduced into proceedings.
- VIII. Concerning the main request, the Board stated that the amendment made in claim 1 appeared not to be admissible due to the status of the proprietor only as a respondent and because the amendment appeared to be contrary to the prohibition of *reformatio in peius*, due to a limitation having been removed compared to the wording of claim 1 considered allowable in the interlocutory decision.

IX. The appellant's arguments may be summarised as follows:

Concerning the first auxiliary request, claim 1 lacked novelty with respect to document D1 (US 4 327 620):

D1 disclosed a chopper apparatus for "chopping glass fiber strands into short lengths", because the apparatus was evidently suitable for chopping glass fiber strands. Thus, the arbors 26, 28 (fitted-up with cutters) which together formed a cutter assembly thereby constituted a chopper assembly including a blade roll and a backup roll, where each of the fitted-up arbors could be regarded as being both a backup roll and a blade roll since the blades on one fitted-up arbor acted against a backup surface formed on the other fitted-up arbour. Also the assembly was suitable to chop glass fibre strands if introduced sideways, thus resulting in fibres of short length. Likewise, although a second fitted-up arbor assembly was not shown as such in the drawings, it was evident from e.g. column 1, lines 37 to 42 that this was present. A frame 14 was also provided and, as shown in the drawings, this was rotatable so that one fitted-up arbor assembly assumed the operating position of the other.

Additionally, the term "chop" did not technically differ from the term "cut" and the cutting operation in the patent disclosed only cutting anyway. Thus the definition of a "chopper" assembly in claim 1 was no different to the cutter assembly of D1.

Furthermore claim 1 lacked novelty over the public prior use of a machine according to D18 to D20.

Although the appellant had been aware of the public prior use during opposition proceedings before the first instance, it had been decided to wait until the appeal proceedings to file the requisite documents to demonstrate this public prior use as a separate item. Although additional documents such as technical drawings were available to further support the public prior use, these had not been filed yet as the respondent should anyway have been aware of the public prior use from other proceedings and thus the documents should not be required.

The evidence presented in support of public prior use was *prima facie* highly relevant as could be seen even from e.g. D18 which listed a "double head" cutting assembly with left and right cutting assemblies, and from the indication that "each cutting assembly" had a "swivel base". On this basis, any skilled person would immediately understand the machine structure as corresponding to that defined in claim 1. Since the company "Hardy and Pollet" on the head of document D18 was a third party, the public nature of the machine and its structural details were available to the public as the third party clearly would know how the machine was constructed. The documents were moreover from 1987, already some 10 years before the patent application was filed.

Claim 1 additionally lacked inventive step starting from the closest prior art disclosed in Figure 1 of the opposed patent, which concerned a chopper apparatus as defined in the preamble of claim 1. The problem to be solved, starting from this prior art, was to avoid losses in production when repairing or replacing



cutting tools. The objective problem was therefore not specific to a machine for chopping glass fiber strands but was a general problem faced by a skilled person involved with all machining tasks, not least in general cutting machinery. Since claim 1 was not limited to "identical" chopper assemblies on either side of the frame, the technical problem to be solved could be limited to being the problem of replacing one cutting tool with an identical cutting tool for the purpose of repair; the problem solved concerned replacing one cutting tool by another for the purpose of providing another, possibly different, cutting operation. It was also well known in the art of glass fibre cutting that different fibre lengths were required and cutting assemblies having a different blade pitch were thus used to replace the existing cutters, and this occurred often.

The solution to this technical problem was found in e.g. D1 which, although relating to a slitting apparatus as such, was relevant because a slitting apparatus was a cutting machine and it was constructed to replace one set of cutters and arbors by another set of cutters and arbors. D1 did not state that the cutters fitted to the arbors were different. Column 1, lines 26 to 31 merely indicated that newly assembled cutters were "provided".

D16 was introduced due to the finding by the opposition division in its decision that the prior art documents only related to changing tools for "different" operations, even though claim 1 was not limited to an identical chopper assembly for thereby performing the "same operation". Also, D16 addressed directly the

problem to be solved since one of its purposes was to reduce losses in production time while repairing or replacing a worn tool. The technical solution in D16 paralleled the technical solution in the claim since it operated by swivelling one cutting tool on a frame around an axis from an operating position to a non-operating position while a replacement, identical cutting tool on another side of the frame was swivelled into position. The skilled person wishing to solve the objective problem underlying claim 1 of the opposed patent would look in the field of cutting tools also for other cutting purposes, and would find D16 because the same problem and solution were addressed. The document was thus *prima facie* highly relevant to the objection of lack of inventive step and should therefore be admitted into the proceedings.

In relation to inventive step it was further to be noted that D11 ("The Manufacturing Technology of Continuous Glass Fibers" in Glass Science and Technology 6, by K.L. Loewenstein, Elsevier 1983) was evidence showing that it was also known to the skilled person that the idea of replacing one tool with another during manufacturing operations was solved by swivelling one assembly around an axis to replace another assembly. It was further notable that D11 was in the field of glass fibre chopping machines, albeit in another part of the same machine.

- X. The respondent's arguments may be summarised as follows: Claim 1 of the main request met the requirements of Article 84 EPC because the terminology "into short lengths" had been removed. The appellant was not put in a worse position than if it had not appealed, because

the claim's scope and meaning remained unaltered compared to the version of claim 1 considered allowable by the opposition division, despite the terminology having been deleted since the terminology did not represent a real limitation. Further, the proprietor had agreed to the amendment, which was proposed by the opposition division itself, only because the scope and meaning of the claim remained essentially unaltered.

Claim 1 of the first auxiliary request was limited to a chopper apparatus for glass fiber strands. In this particular technical field, the terms "chopper assembly", "blade roll" and "backup roll" had well understood technical meanings which were distinct from the slitters of D1. A "backup roll" had no blades, so there was no backup roll in D1, as also confirmed by the description in column 3, lines 54 to 57, where it was stated that a recoiler was responsible for pulling the material through the cutter/arbor assembly, proving that the cutting occurred between two opposed cutter blades and not between a cutter blade and a backup roll. Furthermore, the movement of the apparatus defined in the characterizing part of claim 1 was different to the movement in D1. Claim 1 was thus novel over D1.

The evidence D18 to D20 offered in support of public prior use by the appellant was deficient for several reasons, not least because the manner in which the final machine might be assembled was entirely unknown. Very little information at all could be gleaned from the documents D18 to D20 and the appellant's arguments related to mere speculation. The evidence was therefore insufficient to show *prima facie* a highly relevant case

of public prior use. Also, D18 to D20 were late-filed; the information was available to the appellant far earlier and it was also mentioned during the oral proceedings before the opposition division, such that its consideration should be ruled out even on this ground alone.

In regard to inventive step, it was agreed that the closest prior art was that shown in Figure 1 and the corresponding description of the opposed patent.

The technical problem to be solved by the invention was specific to the art of glass fiber manufacture. The problem stated in the patent itself was the true technical problem since it related to replacement or repair of a worn or damaged chopper assembly in glass fibre manufacture. A broader problem such as the repair of a cutting tool in a way which avoided production losses, or replacement of one cutter by another different cutter, would be artificial problems facing a skilled person, because in the art of glass fiber manufacture the machines run for long periods of time, continuously producing the same length fibres. Because of this, reduction of down-time when replacing/repairing of the chopper assemblies was the true problem with which fibre manufacturers were faced, and this problem occurred several times per day. Change of tooling size/type, e.g. to allow different fibre lengths to be produced, occurred very rarely compared to the frequency with which chopper assemblies had to be repaired or replaced by the same type of chopper assembly. And, where such a case occurred, the time losses as a consequence of this change in the production line both upstream and downstream of the

chopper assembly, such as change of a fiber packaging machine, or a fiber treatment apparatus, were far greater than the time loss required to repair/replace a chopper assembly. This meant that the time required for changing the chopper assembly itself was no longer an important factor. Thus, although claim 1 did not define that the chopper assemblies were identical, the only realistic problem was one related to reducing down times during repair or replacement of one chopper assembly in a glass fibre chopping apparatus. It was to be noted additionally that in fibre chopping production lines, if different lengths of fibres were required often, as alleged by the appellant, there would be different production lines of fibre choppers producing different lengths of fibres, so that no changing of size of chopper blade rolls on one machine was normally required.

D1 was not relevant to the question of inventive step since it concerned a different type of tool, not a chopper assembly which had to be repaired or replaced often. There was no backup roll in D1 in the technical sense of claim 1 and the D1 device operated entirely differently to the chopper apparatus defined in claim 1.

D16 was not *prima facie* sufficiently relevant for it to be admitted into proceedings. It was in a non-related technical field of slotting operations performed on piston rings. D16 was an old document, from 1944, and glass fibers had been produced by chopping machines for a very long time. The problem existing in the glass fibre chopping field was thus a long-standing problem and the existence of D16 for this length of time was

extra evidence showing that it had given no suggestion of an application for improvement in a glass fiber chopper assembly.

"Slotting" and "chopping" were unrelated forms of cutting and, even when consulting D16, it could be readily seen that it concerned a device where only the cutting tool itself (i.e. the set of saws) was moved into and out of operation, but not any backup roll. To the extent that anything in D16 could be deemed equivalent to a "backup" roll surface for the saws, any such surface was itself not moved at the same time as the cutting tool, nor by the same means. Since claim 1 defined the movement of both parts of the chopper assembly into, and out of, an operating position, D16 could not (even if admitted into proceedings) give a lead towards the solution as claimed. Furthermore, in as far as a similar problem existed in the technical field of D16 compared to the objective problem faced in the glass fiber production art, such a problem was buried in the text of D16 to the extent that a skilled person would not immediately have recognised its relevance, due not least to the title and method of operation. The focus of D16 was not on the same problem underlying the invention in the opposed patent and the reference to such a problem in D16 was, anyway, relatively brief. The extraction of this problem could thus only result from a hindsight analysis. D16 was therefore late-filed and not sufficiently relevant to show a *prima facie* highly relevant case of lack of inventive step and therefore should not be admitted. Even if admitted, D16 would not lead the skilled person to the solution in claim 1.

## Reasons for the Decision

### 1. *Main request*

1.1 Claim 1 of the main request differs from claim 1 found allowable in the interlocutory decision only in that the terminology "into short lengths" has been removed. The removal of this terminology however gives the result that claim 1 becomes broader, since a limitation has been removed.

1.2 The fact that the terminology "into short lengths" had been introduced at the suggestion of the opposition division (as noted in the minutes of oral proceedings) does not change the fact that approval of the amendment was the responsibility of the proprietor.

1.3 The respondent's argument that removal of the terminology "into short lengths" would anyway not disadvantage the appellant because the terminology was not a real limitation which changed the meaning or scope of the claim, is found by the Board to be unconvincing since this terminology has technical significance, even if the term "short" is imprecise. Thus, allowing removal of the terminology "into short lengths" would mean that the legal position of the appellant would be made worse, contrary to the prohibition of *reformatio in peius*. Moreover, removal of this terminology is not required since amendments are available which could be introduced to limit the scope of the patent as maintained and thus overcome any deficiency due to a lack of clarity (see decision G 1/99, in particular item 15).

1.4 The removal of the terminology "into short lengths" thus constitutes an inadmissible amendment. The main request is therefore not allowable.

2. *First auxiliary request - amendments*

2.1 *Clarity, Article 84 EPC*

The re-insertion of the wording "into short lengths" into claim 1 overcomes the objection to the inadmissible amendment present in the main request. Furthermore, the amendment of the wording in claim 1 to specify that the apparatus is a "chopper apparatus" for chopping "glass fiber strands" clarifies that the apparatus is of a specific type where the terminology "into short lengths" has a clear technical meaning. The same reasoning applies to claim 11.

The clarity requirement of Article 84 EPC is therefore met.

2.2 *Article 123(2)/(3) EPC*

The amendments introduced in the first auxiliary request are within the content of the application as originally filed (see e.g. page 1, lines 4 to 18). The requirements of Article 123(2) EPC are thus fulfilled.

Additionally, the scope of protection provided by the claims is limited compared to the granted patent so that the requirements of Article 123(3) are also fulfilled.



3. *Alleged prior use based on D18 to D20*

3.1 The documents D18 to D20 concerning an alleged public prior use were filed for the first time with the grounds of appeal. They were however, as stated by the appellant, available during the opposition first instance proceedings. No acceptable reason has been put forward which would justify why the appellant did not file the documents during the first instance proceedings. The Board therefore judges that the documents are late-filed without sufficient justification to allow them into the appeal proceedings.

3.2 Furthermore, in terms of whether documents D18 to D20 present a *prima facie* highly relevant case of public prior use, it is noted the opponent alleges that D18 represents a list of components of a machine which when assembled has a structure with all the features of claim 1. The respondent disputes this. The Board concurs with the respondent in this regard since, beyond a mere list of parts for a double head cutting assembly, there is no information in D18 as to how the parts might be fitted together. For instance, although a swivel base is mentioned, it cannot be determined from the documents on file how such a swivel base might structurally interact with the left hand and/or right hand cutting assemblies, if at all. D19 and D20 fail to resolve this deficiency. Thus, even at the outset, the Board concludes that a skilled person could not deduce from the parts listed in D18 that these relate to an apparatus corresponding to that defined in claim 1.

The appellant's allegation that a third party "Hardy and Pollet" was involved and thus would know how the

parts would be assembled, is also not convincing since no evidence has been filed supporting such an allegation.

- 3.3 The Board therefore concludes that the evidence D18 to D20 has been filed late and without sufficient justification to allow its admittance at this late stage. Further, based on the evidence provided, it also does not constitute a *prima facie* highly relevant case of public prior use for the present proceedings.

The alleged public prior use based on D18 to D20 is thus not admitted into the proceedings.

4. *First auxiliary request - Novelty*

- 4.1 Due to the amendments present in claim 1, its subject matter defines an apparatus which is technically specific to glass fibre production. The arbors fitted-up with cutters in D1 do not together form a "chopper assembly" which is suitable for glass fiber production comprising a "blade roll" and a "backup roll", as these latter elements are structural elements having a specific technical meaning in the field concerned. Likewise the additional elements "second chopper assembly", "second blade roll" and "second backup roll" (as defined in the characterizing portion of claim 1) are not disclosed in D1.

- 4.2 The characterizing portion of claim 1 defines the structure of the chopping apparatus in such terms that the frame is rotatable to move the first chopper assembly out of an operating position and into a non-operating position while moving the second chopper

assembly out of a non-operating position and into the operating position of the first. This is not the case in D1 since its structure is such that the first set of fitted-up arbors 26, 28 are initially moved to a non-operative position by a linear movement of the bearing housing 14 away from bearing housing 12 thus detaching one end of the fitted-up arbors therefrom. Only then, in a non-operational position, can a rotation be performed to an intermediate position. After this rotation, the second set of fitted-up arbors must then be moved linearly in order to arrive in the operating position where the end of the arbors are located in the bearing housing 12 thus permitting the slitters to operate again (see e.g. column 3, line 64 to column 4, line 15).

4.3 Apart from D1, no further prior art in the proceedings has been cited against the novelty of claim 1. The subject matter of claim 1 is therefore found by the Board to be novel with respect to the cited prior art (Article 54(1) EPC).

4.4 No prior art in the proceedings has been cited against the novelty of claim 11, and thus the subject matter of claim 11 is also found by the Board to be novel (Article 54(1) EPC).

5. *Inventive step*

5.1 In regard to the subject matter of claim 1, the Board concurs with the parties that the closest prior art for consideration of inventive step is the prior art apparatus disclosed in Figure 1 of the opposed patent.

This apparatus discloses all the features defined in the preamble of claim 1.

5.2 The features in the characterizing portion of claim 1 define *inter alia* a second chopper assembly comprising a second blade roll and a second backup roll. Nothing in claim 1 however limits the apparatus in a way such that the second chopper assembly must be substantially the same as the first chopper assembly. Thus, the second chopper assembly may be a different chopper assembly providing chopped fibre of a different length.

5.3 Starting from the closest prior art, which already discloses a chopper apparatus for cutting glass fiber strands into short lengths, the technical problem to be solved must be formulated objectively with respect to the prior art, but at the same time based on the features which are defined in claim 1. Thus, although the respondent states that the problem which occurs most often in this technical field is the down-time due to replacement or repair of a chopper assembly, often several times a day, so that glass fibres of the same length continue to be produced after the apparatus is restarted each time, the features in claim 1 are not limited to providing a chopper assembly which would necessarily continue the "same" operation. Thus, the objective problem to be solved must be formulated more generally than proposed by the respondent. Namely, starting from the closest prior art, the Board concludes that the technical problem to be solved is objectively formulated as being the avoidance of production losses due to down-time when a cutting tool is to be repaired or replaced. The replacement in this regard, due to the features currently defined in

claim 1, allows replacement not only by an identical tool but alternatively by a second cutting tool of the same general type which can perform a further, possibly different, cutting operation.

5.4 The respondent's contention that such a problem would be artificial is not accepted, as the claim is not limited to the first and second chopper assemblies producing substantially identical length chopped fibers. The scope of the claim indeed encompasses a first chopper assembly which can produce chopped strands which are a different length to those produced by the second chopper assembly.

5.5 D1 relates to replacement of one cutter assembly by another for changing from one slitting operation to another (see e.g. column 1, lines 9 to 13 and lines 26 to 31). The fact that the cutter assemblies are not chopper assemblies as understood in the field of glass fibre production is not relevant for the issue of inventive step. Nevertheless, as claim 1 also defines the structure of the frame 50 in terms of its movement of one assembly out of an operating position by rotation which causes the other assembly to be moved into an operating position, the Board concludes that the series of linear movements of the cutting assemblies required in D1 to disengage these from a bearing block 12 required for operation, in addition to the rotation of the frame 14 about its rotational axis, would thus not lead the skilled person to the subject matter of claim 1 unless inventive step were used.

5.6 D11 shows that a replacement of one tool by another is known in the art of glass fiber production, but this does not lead the skilled person by itself any closer to the subject matter of claim 1, because the problem to be solved in D11 (see pages 192 to 196) concerns automatic winders having collets which become full and need to be replaced by another collet, rather than being concerned with repair or replacement of cutting tools.

5.7 Thus the subject matter of claim 1 involves an inventive step with respect to the combination of the closest prior art with D1 and/or D11.

5.8 For the same reasons as apply to claim 1, the subject matter of claim 11 also involves an inventive step with respect to the combination of the closest prior art together with D1 and/or D11.

6. *Admittance of D16*

6.1 D16 was filed for the first time with the grounds of appeal. However in the interlocutory decision (item 2, relating to inventive step) the opposition division states that the references cited by the opponent (appellant) were restricted to changing tools for "different operations". Thus the filing of document D16 with the appeal grounds is regarded as being a justifiable reaction to the decision of the opposition division.

This factor alone however is not sufficient to allow admittance of the document into proceedings. The document also needs to be *prima facie* more relevant than those already in proceedings.

D16 is judged by the Board as more relevant than D1, since D16 explicitly deals with the same objective technical problem underlying the invention (see e.g. column 1, lines 24 to 36) and also provides a solution (see column 4, lines 51 to 63) involving the structure of the apparatus in terms of its movement as defined in the characterizing portion of claim 1.

D16 also appears *prima facie* more relevant to the inventive step of at least claim 1 than any other document already in proceedings.

The respondent's argument that D16 is not in a related technical field is not accepted by the Board; D16 is concerned with cutting machinery which is a related technical field. Moreover, the technical problem to be solved is not specific to glass fiber strand production, but is more generally related to avoiding production losses due to down-times in cutting machinery applications. A skilled person in the field of cutting technology would thus be expected to consult documents concerning other types of cutting machinery when trying to solve the objective problem.

The further argument that D16 is so old that it would not be considered, especially in the light of the long standing problem that existed in the art of glass fibre production, is also not accepted by the Board as being a reason not to admit D16 into proceedings. The

existence of a long-standing problem has firstly not been proven by the respondent, but more importantly the problem to which the respondent refers is not an objective problem in light of the features defined in claim 1. Furthermore, the age of a document by itself does not override the fact that the document deals with the same objective problem.

The Board does not agree with the respondent's arguments that the skilled person would not consider D16 due to the problem being allegedly buried in the text and mentioned only briefly. The problem is stated in D16 explicitly in terms of being "another feature and object and purpose" of the invention (see column 1, lines 24 to 31). Thus it is not a technical problem which the skilled person needs to deduce in some way by combining different parts of a document, but rather is an explicit and direct disclosure. The brevity of the disclosure is also not regarded as being a relevant factor, as a skilled person equally considers both long and short passages in a prior art reference.

The respondent's argument that D16 does not disclose a rotatable frame supporting a backup surface in addition to supporting the cutter, does not detract from the fact that D16 is *prima facie* highly relevant to inventive step as it deals with the same problem and also with the same type of cutters (i.e. each is a set of saws) arranged on a frame whereby the apparatus has a structure such that a rotation of the frame allows the second cutter unit to replace the first in an operating position. Thus, the respondent's argument is one which would only need to be examined when determining whether inventive step is present, moreover



in light of the objective problem to be solved by the features defined in claim 1 and claim 11 respectively.

The Board therefore concludes that D16 is sufficiently relevant to the question of inventive step that its further consideration is required. D16 is thus introduced into proceedings.

7. *Request for remittal*

Concerning the request of the respondent to remit the case back to the first instance, the Board concludes that the respondent is faced with a new case concerning a document which is *prima facie* more relevant to inventive step of the claims than other documents already in proceedings. Remittal back to the first instance is therefore justified so as to allow the respondent to receive a reasoned decision taking D16 into account.

8. *D15 and D17*

Since D16 is introduced into proceedings and the case is to be remitted, the respondent's request regarding remittal has been met and thus the potential relevance of D15 and D17 is not a matter requiring further consideration by the Board.

**Order**

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

1. The decision under appeal is set aside.
2. The alleged prior use based on documents D18, D19 and D20 is not admitted into the proceedings.
3. The case is remitted to the first instance for continuation of the opposition proceedings.

The Registrar:

The Chairman:

M. Patin

P. Alting Van Geusau