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**Datasheet for the decision
of 31 March 2011**

Case Number: T 0282/09 - 3.3.09

Application Number: 01116774.9

Publication Number: 1153736

IPC: B32B 3/24

Language of the proceedings: EN

Title of invention:

A process for the manufacture of a decorative laminate

Patentee:

Pergo (Europe) AB

Opponent:

Siempelkamp Maschinen- und Anlagenbau GmbH & Co. KG

Headword:

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Relevant legal provisions:

EPC Art. 54, 123(3)

RPBA Art. 13(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Art. 123(3) - No, main request and auxiliary requests 1-5"

"Novelty - No, auxiliary request 4"

"Auxiliary request 5, not admitted, late filed"

Decisions cited:

T 0401/95, G 0002/88

Catchword:

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Case Number: T 0282/09 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 31 March 2011

Appellant: Pergo (Europe) AB
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 November 2008
revoking European patent No. 1153736 pursuant
to Article 101(2) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: J. Jardón Álvarez
K. Garnett

Summary of Facts and Submissions

I. European patent No. 1 153 736 was granted in respect of European patent application No. 01116774.9, which was filed in the name of Pergo (Europe) AB on 25 February 1997 as a divisional application of the earlier European patent application 97906378.1. The mention of grant was published on 26 May 2004 in Bulletin 2004/22. The patent was granted with 5 claims, claim 1 reading as follows:

"1. A structured matrix in the form of a structure foil or a press plate for the manufacture of a decorative thermosetting laminate (21), which laminate (21) includes a decor paper in the form of a web or a sheet (11 and 1 respectively), provided with a decor pattern having pattern sections with different directions, **characterised in that** the matrix (12 and 2 respectively), is provided with a number of surface-structure sections being structurally independent from each other and coinciding at least mainly but preferably completely with corresponding decor sections of the decor paper (1, 11) of the decorative thermosetting laminate (21), which décor paper (1, 11) has positioning means (3) such as colour dots, holes, code lines, indentations or the like, that said positioning means (3) are placed in a predetermined relation to the direction variations of the décor pattern and that these positioning means (3) in the décor paper (1, 11) are used for properly positioning the matrix toward the décor paper (1, 11) thereby achieving above desired match between the décor pattern and the surface structure."

Claims 2 to 5 were dependent claims.

- II. A notice of opposition was filed against the patent by Siempelkamp Maschinen- und Anlagenbau GmbH & Co. KG on 23 February 2005. The opponent requested revocation of the patent in its entirety, reference being made to Articles 100(a) and (c) EPC.

The documents cited during the opposition proceedings included the following:

E4: US 3 373 068 A;

E5: DE 32 19 508 A1

- III. By its decision announced orally on 30 September 2008 and issued in writing on 17 November 2008, the opposition division revoked the patent.

The opposition division acknowledged that the subject-matter of the granted patent did not extend beyond the content of the parent application (Article 100(c) EPC) and was novel (Article 54 EPC), but revoked the patent because the claimed subject-matter lacked inventive step having regard to the teaching of documents E4 and E5. The opposition division came to the same conclusion as regards the subject-matter of the auxiliary request, which was based on a combination of granted claims 1 and 2.

- IV. On 19 January 2009 the patent proprietor (appellant) filed an appeal against the decision of the opposition division and paid the prescribed fee on the same day. With the statement setting out the grounds of appeal

filed on 27 March 2009, the appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, in the alternative, that the patent be maintained on the basis of one of the auxiliary requests 1 to 5 filed with the statement of grounds.

- V. The opponent (respondent) filed its reply by letter dated 24 July 2009 and requested that the appeal be dismissed.
- VI. On 25 November 2010 the board dispatched a summons to attend oral proceedings scheduled to take place on 31 March 2011. In the annexed communication the board expressed its preliminary view that the claims of the main request appeared to fulfil the requirements of Article 100(c) EPC but not those of Articles 54 or 56 EPC.
- VII. With letter dated 28 February 2011 the appellant filed further submissions and a new main request. It also filed six new auxiliary requests based on its previous requests.
- VIII. On 31 March 2011 oral proceedings were held before the Board. In the course of the oral proceedings, the respondent withdrew its previous auxiliary requests 5 and 6 and filed an amended auxiliary request 5.

Claim 1 of the main request reads as follows:

"1. A use of a structured matrix in the form of a structure foil or a press plate in the manufacture of a decorative thermosetting laminate (21),

which laminate (21) includes a decor paper in the form of a web or a sheet (11 and 1 respectively), provided with a decor pattern having pattern sections with different directions, wherein

the matrix (12 and 2 respectively), is provided with a number of surface-structure sections being structurally independent from each other and coinciding at least mainly but preferably completely with corresponding decor sections of the decor paper (1, 11) of the decorative thermosetting laminate (21),

which décor paper (1, 11) has positioning means (3) such as colour dots, holes, code lines, indentations or the like,

said positioning means (3) are placed in a predetermined relation to the direction variations of the décor pattern and that these positioning means (3) in the décor paper (1, 11) are used for properly positioning the matrix toward the décor paper (1, 11) thereby achieving above desired match between the décor pattern and the surface structure and thereby getting a decor surface with a surface structure, the different directions of which corresponds with the directions of the different pattern sections of the decor pattern."

Claims 1 of auxiliary requests 1 to 3 are, like the main request, directed to "A use of a structured matrix in the form of a structure or a press plate in (auxiliary request 1)/for (auxiliary requests 2 and 3) the manufacture of a decorative thermosetting laminate". They define the positioning means of the main request in a more precise form.

The claims of auxiliary request 4 are the claims of the granted patent (see above point I).

Claim 1 of auxiliary request 5 is based on claim 1 of auxiliary request 4 but with the following further feature taken from granted claim 4 at the end:

"that a tolerance area is used on the matrix in the demarcation between two adjacent, of each other independent, surfaced structure sections, which tolerance area consists of a 1 to 20 mm wide, preferably 3 to 10 mm wide, field without any structure".

IX. The arguments presented by the appellant in its written submissions and at the oral proceedings, insofar as they are relevant for the present decision, may be summarized as follows:

- The amendment of the granted claims directed to "a structured matrix" to claims directed to the "use of a structured matrix" was not open to objection under Article 123(3) EPC, as the granted patent claiming a matrix conferred absolute protection for all its uses.
- The subject-matter of the claims was novel over E4. This document did not disclose a decor pattern having pattern sections with different directions and a matrix having a number of surface-structure sections being structurally independent from each other as now claimed. E4 actually disclosed a single section corresponding to a simulated mosaic tile, for which moreover no direction was specified.

Additionally E4 did not disclose any explicit positioning means.

- Auxiliary request 5 was based on a combination of granted claims 1 and 4 and should be admitted into the proceedings. This request was filed during the oral proceedings as a direct reaction to the finding of the board that the subject-matter of auxiliary request 4 was not novel.
- X. The arguments of the respondent may be summarised as follows:
- The subject-matter of the claims reformulated as "use claims" was not clear (Article 84 EPC), essentially because the claims included features which did not relate to the matrix.
 - The subject-matter of the granted claims extended beyond the content of the application as originally filed, since a structured matrix was only disclosed in the original application in combination with a process for the preparation of a laminate.
 - The claimed structured matrix was defined by features of the process for preparing a laminate or by features of the obtained laminate. These features should be ignored when considering novelty and inventive step of the claims. The only features of claim 1 concerning the matrix were already disclosed in the prior art documents E4 and E5.
- XI. The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis

of the main request, alternatively the first to fourth auxiliary requests, all filed with the letter dated 28 February 2011, alternatively on the basis of the fifth auxiliary request filed during the oral proceedings.

The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

MAIN REQUEST

2. *Amendments (Article 123 EPC)*

- 2.1 The patent as granted comprised a sole independent product claim directed to a structured matrix in the form of a structure foil or press plate (see point I above), together with dependent claims directed to preferred embodiments of the structured matrix of claim 1. The claims of the main request as amended now comprise only use claims, which have replaced the product claims. These use claims, namely independent claim 1 and dependent claims 2 to 5, are directed to the "use of a structured matrix ... in the manufacture of a decorative thermosetting laminate".

- 2.2 In the present case, product claim 1 of the patent in suit as granted, i.e. before amendment to the use claims, confers absolute protection to the claimed matrix, that is to say, for the particular matrix and for all its uses.

2.3 However, according to EPO practice (see, for instance decision T 401/95 of 28 January 1999, not published in the OJ EPO, point 4.3.2 of the reasons) a claim directed to "the use of a physical entity to produce a product" is to be considered as a process claim comprising physical steps for producing the product using the physical entity, with the consequence that this type of use claim is a process claim within the meaning of Article 64(2) EPC. Pursuant to that article of the EPC, the product, insofar as it is directly obtained by that process, is also protected. Hence, the product, when obtained by that process for producing the product, is within the scope of protection conferred by that type of use claim (see decision G 2/88, OJ EPO 1990, 93, point 5.1 of the reasons).

In the present case, use claim 1 comprises the physical step of manufacturing a decorative thermosetting laminate. Thus, use claim 1 confers protection on the claimed use of the particular structured matrix and, additionally, pursuant to Article 64(2) EPC, to the decorative thermosetting laminate obtained by the manufacturing process.

2.4 When comparing the protection conferred by the granted claims (see point 2.2) with the protection conferred by the amended claims (point 2.3), it is clear that the protection conferred after amendment extends beyond that conferred before, contrary to the requirements of Article 123(3) EPC, because the decorative thermosetting laminate obtained using the structured matrix was not protected before the amendment of the

claims, but is now protected as a result of the amendment.

- 2.5 Consequently, the change of category from the product claim as granted to the use claim as amended, in the present case, extends the protection conferred. The subject-matter of claim 1 of the main request thus offends against Article 123(3) EPC and the main request is not allowable.

AUXILIARY REQUESTS 1-3

3. *Amendments (Article 123 EPC)*

- 3.1 The subject-matter of claims 1 of auxiliary requests 1 to 3 is, like the subject-matter of claim 1 of the main request, directed to the "use of a structured matrix ... in/for the manufacture of a decorative thermosetting laminate".

- 3.2 Under these circumstances, the reasoning in relation to the main request applies *mutatis mutandis* to the subject-matter of the claims of auxiliary requests 1 to 3, which are therefore also not allowable (Article 123(3) EPC).

AUXILIARY REQUEST 4

4. *Amendments (Article 123 EPC)*

- 4.1 The claims of the auxiliary request 4 are the claims of the granted patent. They had been objected to by the respondent because, in its opinion, the structured matrix was disclosed in the application as originally

filed only in combination with a process for the manufacture of a decorative laminate.

4.2 The claimed matrix is undisputedly disclosed in the application as originally filed for its use in the process of manufacture of a laminate. Moreover, it is also disclosed in the application as originally filed that the matrix is provided with a structure pattern (see page 3, first full paragraph of WO 97/31775) and that the matrix is, after the pressing, separated from the laminate obtained (see page 2, lines 15 - 17 of WO 97/31775 and the explanation of the figures).

4.3 The matrix is thus disclosed in the application as originally filed as an embodiment independently of its use in the lamination process. The subject-matter of the claims of the auxiliary request 4 thus fulfils the requirements of Article 123(2) EPC. As no amendment to the granted claims has been made in this request, the claims also fulfil the requirements of Article 123(3) EPC.

5. *Novelty (Article 54 EPC)*

5.1 The subject-matter of claim 1 of auxiliary request 4 is directed to a structured matrix showing the following features:

- (a) a structured matrix in the form of a structure foil or a press plate for the manufacture of a decorative thermosetting laminate (21),
- (b) which laminate (21) includes a decor paper in the form of a web or a sheet (11 and 1 respectively),
- (c) provided with a decor pattern

(d) having pattern sections with different directions,

characterised in that

(e) the matrix (12 and 2 respectively) is provided with a number of surface-structure sections being structurally independent from each other,

(f) and coinciding at least mainly but preferably completely with corresponding decor sections of the decor paper (1, 11) of the decorative thermosetting laminate (21),

(g) which décor paper (1, 11) has positioning means (3) such as colour dots, holes, code lines, indentations or the like,

(h) that said positioning means (3) are placed in a predetermined relation to the direction variations of the décor pattern

(i) and that these positioning means (3) in the décor paper (1, 11) are used for properly positioning the matrix toward the décor paper (1, 11)

(j) thereby achieving above desired match between the décor pattern and the surface structure.

5.2 According to EPO practice a claim to a substance for a particular use should be construed as meaning a substance which is in fact suitable for the stated use.

5.3 Thus, in feature (a) of Claim 1 the expression "for the manufacture of a decorative thermosetting laminate" is to be interpreted as indicating the intended use of the matrix and not as a limiting feature. The subject-matter of Claim 1 is directed to a product, the structured matrix *per se*, that is to say, the structured foil 2 in Figure 1 or the structured foil

web 12 in Figure 2 used for the preparation of the laminate but not being a part of the laminate because after the pressing it is separated from the laminate obtained (see column 2, lines 34-37).

5.4 It follows from the above that features of the laminate or of the lamination process do not limit the scope of the claim. The features which define the claimed structured matrix are therefore only features (a) and (e). Additionally feature (f), which indicates that the surface-structure sections coincide with corresponding decor sections of the decor paper, implies that the same decor pattern of the paper is present in the matrix, thus defining a further feature of the matrix, namely that the sections have different directions.

5.5 The novelty of this claim has been contested by the respondent having regard to the disclosures of E4 and E5.

5.5.1 Document E4 is concerned with a process for producing decorative laminates which have surfaces on which an embossed design is positioned (column 1, lines 14-16). The laminate is produced between press plates and consists of a core material which is covered by a printed decorative sheet carrying a suitable design such as a wood grain and which can, in turn, be covered by an overlay sheet. On top of the laminate a release sheet (4 in figure 1, corresponding to the structured matrix in the wording of the patent) having an embossed design compatible with the design of the decorative print sheet is placed. After assembling the laminate the release sheet is peeled from the laminate structure

(see claim 1 and the paragraph bridging columns 3 and 4; see also figure 1).

In example 10 of E4 this process is used for the preparation of a laminate having a simulated mosaic tile pattern. In this example the release sheet has a printed design of exactly the same configuration as the binder simulated on the non-raised print sheet, that is to say, a simulated mosaic tile with the appearance of a binding agent printed between the individual irregular chips in the simulated mosaic tile (column 6, lines 56-62).

5.5.2 The release sheet 4 of example 10 is indisputably a structured matrix in the form of a structure foil (feature (a) of claim 1). It is also provided with a number of surface-structure sections being structurally independent from each other (feature (e) of claim 1) because the mosaic pattern presents "individual **irregular** chips" (emphasis by the board), this irregular form necessarily resulting in sections which are structurally independent from each other. Finally, the mosaic structure of the release sheet has sections in different directions in order to provide said mosaic structure (feature (f) of claim 1). In fact every such tile pattern will have different sections which are structurally independent of each other since, whether the tile pattern is regular or irregular, the tiles on the one hand and the cemented gaps between the tiles on the other will be structurally (as opposed to spatially) independent in the sense of the claim. In the case where the tile pattern is regular, then at least the cemented gaps will constitute sections in different directions in the above sense.

Thus, E4 discloses all the features of the subject-matter of claim 1 of auxiliary request 4.

5.5.3 The appellant did not dispute that by interpreting E4 as explained above the disclosure of E4 would anticipate the subject-matter of claim 1, but argued that this interpretation is not correct. In its opinion, it would be quite clear to the skilled person that the process described by E4 was directed to the production of individual simulated mosaic tiles, the "whole" mosaic tile being "one surface-structure section" within the meaning of the patent. On the contrary, the subject-matter of claim 1 was directed to a matrix provided with a number of surface structure sections being structurally independent of each other, as represented for instance in figure 1 of the patent (see the foil sheet 2).

5.5.4 The board cannot accept this argument of the respondent. The wording used in the claim "surface-structure sections being structurally independent from each other" is vague and as such has to be interpreted in a broad way. The interpretation of the appellant that the structure of the mosaic of E4 should represent one surface structure section is only one possible interpretation. An equally acceptable interpretation is the respondent's interpretation, namely that the different small parts of the mosaic of the tile represent several sections within the meaning of claim 1, those sections not being interrelated and therefore independent from each other and having different directions.

There is also nothing in the specification supporting the appellant's approach. The Figure 1 embodiment is only one example of the decor pattern (see also [0014]), and the possibility of other structures is left open.

- 5.6 For these reasons the subject-matter of claim 1 of auxiliary request 4 is anticipated by E4 and is therefore not novel (Article 54 EPC).

AUXILIARY REQUEST 5

6. *Admissibility*

- 6.1 The appellant filed this request towards the end of the oral proceedings, after the board had deliberated on the allowability of the auxiliary request 4, that is to say, at the very last moment. The appellant justified the late filing as resulting from the board's decision on the previous requests. Further, in its opinion the respondent should have been in a position to deal with the new subject-matter because the amendment made was merely a combination of granted claims 1 and 4.

- 6.2 According to Article 13(1) of the Rules of Procedure of the Boards of Appeal any amendment to a party's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion. The discretion has to be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. Auxiliary requests filed at the end of the oral proceedings are admitted into the appeal proceedings only under exceptional circumstances.

6.3 In the present case the board decided not to admit auxiliary request 5 into the proceedings because it raised new issues which had not been dealt with in the opposition and/or appeal proceedings. Essentially the amendment made to the claims shifts the subject-matter of the claims to the presence of a "tolerance area on the matrix in the demarcation between two adjacent structure sections", a feature which had not been discussed at all during the appeal proceedings.

The appellant was aware of the concerns of the board in relation to the claims directed to a structured matrix. In particular, the board had stated in its preliminary opinion that, concerning novelty and inventive step, it tended to agree with the arguments of the respondent, that is to say, that the subject-matter of the claims of the then main request was not allowable (points 5.1 and 5.2 of the annex to the summons to oral proceedings). Thus the appellant was aware of the negative preliminary opinion of the board and had the opportunity to file amended claims in order to define the claimed matrix in a more precise way.

It is finally to be noted that the amendment to the claims was not a reaction to matters which had been raised for the first time in the discussion which took place during the oral proceedings.

6.4 In summary, there are no exceptional circumstances justifying the late filing of auxiliary request 5 and consequently the board exercised its discretion not to admit it into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

G. Röhn

W. Sieber