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**Datasheet for the decision
of 27 November 2012**

Case Number: T 0337/11 - 3.2.06

Application Number: 02779878.4

Publication Number: 1425454

IPC: D06B3/28, D06C19/00, F26B13/10

Language of the proceedings: EN

Title of invention:
MACHINE AND METHOD FOR THE CONTINUOUS TREATMENT OF A FABRIC

Patentee:
Coramtex S.r.l.

Opponent:
Biancalani S.R.L.

Relevant legal provisions:
RPBA Art. 13(1)

Keyword:
Late-filed requests - not admissible



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Chambres de recours**

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Case Number: T 0337/11 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 27 November 2012

Appellant:
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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted 25
November 2010 concerning maintenance of the
European Patent No. 1425454 in amended form.**

Composition of the Board:

Chairman: M. Harrison
Members: G. de Crignis
R. Menapace

Summary of Facts and Submissions

- I. By way of its interlocutory decision, the opposition division found that European Patent No. 1 425 454 as amended according to Auxiliary Request 4 met the requirements of the European Patent Convention (EPC).
- II. The appellant/opponent filed an appeal against this decision and referred to documents
- | | |
|---------|--|
| D1 | EP-A-0 341 183 |
| D2 | US-A-5 893 933 |
| D3 | US-A-5 309 613 |
| D4 - D6 | evidence for a prior use |
| D7 | ES-A-2011331 from which priority is claimed in D1. |
- III. The appellant/patent proprietor also filed an appeal but failed to observe the four-month deadline set in Article 108 EPC. Being made aware thereof, the respondent filed a request for re-establishment of rights. Since, in the current proceedings, it was not necessary to consider this issue in order to arrive at a decision on the substantive issues, no further details of the admissibility of the respondent's appeal are relevant.
- IV. In a communication annexed to the summons to oral proceedings, the Board indicated its preliminary view that the requirement of Article 123(2) EPC was not met with regard to the request to maintain the patent in the amended form found allowable by the opposition division.
- V. Oral proceedings were held before the Board on 27 November 2012.

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

The appellant/patent proprietor requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims according to the main request or the first or second auxiliary requests as filed during oral proceedings. The request for re-establishment of rights was explicitly withdrawn.

VI. Claim 1 of the main request reads as follows:

"A machine for the continuous treatment of a fabric, comprising:

- means (7) for supplying the fabric (T);
 - means (9) for extracting the fabric (T);
 - between the supplying means and the extraction means, a section for treatment of the fabric with at least a first tank (1) and a second tank (3), which are positioned in series and between which a pneumatic transfer member (5) is arranged for transferring, via an output of conveying air, the fabric alternately from the first tank (1) to the second tank (3) and vice versa,
 - in front of said transfer member, opposite the first and second tanks (1, 3), two grille structures (15, 17), wherein said pneumatic transfer member (5) is arranged to cause the fabric to strike alternatively against said grille structures (15, 17);
- characterized in that on the opposite side of each grille structure (15, 17), with respect to the pneumatic transfer member (5), a respective suction mouth (19, 21) is arranged, wherein said suction mouths (19, 21), said suction mouths located behind said

grille structures and formed at the end of a U-shaped duct (23) lying in a substantially horizontal plane; and that said pneumatic transfer member is pivotable so as to assume at least two positions depending on the direction of feeding of the fabric through said pivoting transfer member."

The appellant/patent proprietor offered to re-insert the wording "are arranged for suction of the conveying air emerging from said pneumatic transfer member (5)" into claim 1 which wording has been deleted unintentionally. No additional request including such wording in claim 1 was filed.

Independent claim 11 reads:

"Method for the continuous treatment of a fabric, comprising the steps of:

- gradually introducing the fabric (T) into a first tank (1);
- gradually extracting the fabric from a second tank (3), forming a supply of fabric which is transferred pneumatically (5) from said first tank (1) to said second tank (3) and vice versa, undergoing a mechanical treatment;
- pneumatically propelling the fabric (T) alternately against a first or against a second grille structure (15, 17) associated with said first and said second tank (1, 3);

wherein said fabric is propelled by generating an output air current in said pneumatic transfer member (5) acting against a first side of alternatively the first and the second of said grill structures (15, 17); and characterized by generating an intake air current on the second side of said grille structures (15, 17) for suction of the conveying air emerging from said

pneumatic transfer member (5), said intake air current generated by suction mouths (19, 21) located behind said grille structures (15, 17) and formed at the end of a U-shaped duct (23) lying in a substantially horizontal plane."

Claim 1 of auxiliary request 1 reads:

"A method for the continuous treatment of a fabric, by a machine comprising:

- means (7) for supplying the fabric (T);
- means (9) for extracting the fabric (T);
- between the supplying means and the extraction means, a section for treatment of the fabric with at least a first tank (1) and a second tank (3), which are positioned in series and between which a pneumatic transfer member (5) is arranged for transferring, via an output of conveying air, the fabric alternately from the first tank (1) to the second tank (3) and vice versa,
- in front of said transfer member, opposite the first and second tanks (1, 3), two grille structures (15, 17), the fabric being made to strike alternatively against said grille structures by said pneumatic transfer member (5);

characterized in that on the opposite side of each grille structure (15, 17), with respect to the pneumatic transfer member (5), a respective suction mouth (19, 21) is arranged, said mouth sucking in the conveying air emerging from said pneumatic transfer member (5), said suction mouths formed at the ends of a U-shaped duct lying in a substantially horizontal plane and located behind said grille structure and said method comprising the steps of:

- gradually introducing the fabric (T) into a first tank (1);
- gradually extracting the fabric from a second tank (3), forming a supply of fabric which is transferred pneumatically by a pneumatic transfer member (5) from said first tank (1) to said second tank (3) and vice versa, undergoing a mechanical treatment;
- pneumatically propelling the fabric (T) alternately against a first or against a second grille structure (15, 17) associated with said first and said second tank (1, 3);

characterized in that said fabric is propelled by generating an output air current in said pneumatic transfer member (5) acting against a first side of alternatively the first and the second of said grill structures (19, 21) and by generating an intake air current on the second side of said grille structure."

Claim 1 of auxiliary request 2 differs from claim 1 of the first auxiliary request in that the following feature is added:

"wherein respective opening and closing gates (25, 27) are located inside said duct (23) in the vicinity of said suction mouths (19, 21)",

and in that the reference numerals of the grill structure are deleted in the last but one line of the claim set out above for the first auxiliary request.

VII. The arguments of the appellant/opponent may be summarised as follows:

Neither claim 1 nor claim 11 of the main request were allowable. The subject-matter of claims 1 and 11 was amended to include the feature that the suction mouths were formed at the end of a U-shaped duct. Claim 1 was further amended to include the feature related to the

pneumatic transfer member being pivotable. However, such features were only disclosed linked to the embodiment shown in Figure 1, which included further features such as a suction fan and a particular position of the gates for the air. The omission of these features resulted in an intermediate generalisation of the originally filed disclosure (Article 123(2) EPC). Moreover, claim 1 included an altered wording with respect to the pneumatic transfer member which was referred to as being "*arranged to cause the fabric to strike alternatively against said grille structures*" whereas in the version of claim 1 maintained by the opposition division as well as in the granted version of claim 1 the wording was "*the fabric being made to strike ...*". It was not clear what difference in the scope of the claim was provided by such a change of wording and it was also not clear which objection should be overcome by such amendment (Rule 80 EPC). Also the amended wording concerning the suction mouths being "*arranged for suction of the conveying air*" was different from and broader in scope with regard to the wording in originally filed claim 1 which read "*said mouth sucking in the conveying air*" (Article 123(2) EPC).

Moreover, claim 11 included the feature "*by generating an intake air current on the second side of said grille structures (15, 17) for suction of the conveying air emerging from said pneumatic transfer member*". However, in the originally filed description there was only a disclosure (page 7, line 12 and page 8, line 25) for the generation of an air current by the fan. Hence, the wording in claim 11 was not originally disclosed (Article 123(2) EPC) and was also not clear (Article 84 EPC) because a transfer member was not suitable for the

generation of air. No request including such an unclear claim should be admitted.

Concerning claim 1 of the first and second auxiliary requests, the combination of the machine and the method claim led to further clarity objections. Due to the combination there co-existed two characterising portions and it was not clear whether some features were simply redundant or to be considered additionally. Claim 1 of both requests did not include a reference to a pivoting transfer member although the suction mechanism of the machine was disclosed only in combination with such a member (Article 123(2) EPC). Additionally, the generation of air was only disclosed with a fan (page 8, line 25/26) which feature was also omitted in the claim.

VIII. The arguments of the appellant/proprietor may be summarised as follows:

The main request was based on the third auxiliary request submitted with the proprietor's grounds of appeal. As consistently considered by the opposition division, it was not necessary to include further features in claim 1 or in claim 11 of the main request. The wording of claim 1 included the feature concerning the pivoting of the transfer member and the feature concerning the suction mouths being formed at the end of a U-shaped duct. Hence, the subject-matter of the claim was limited and the requirement of Article 123(2) EPC was met. The change of the wording of granted claim 1 *"the fabric being made to strike alternatively against said grille structures by said pneumatic transfer member"* to *"said pneumatic transfer member (5) is arranged to cause the fabric to strike alternatively*

against said grille structures (15, 17)" also represented a limitation of the scope of the claim.

In claim 11, the feature concerning the generation of air was present in the same wording as present in claims 1 and 11 as originally filed and in claim 12 as granted. The skilled person had no problem to understand its meaning. Furthermore, the addition of the feature concerning the location of the suction mouths and the presence of a U-shaped duct included a further limitation to the claim. However, it was not necessary to include further features. In particular, it was not necessary to add the feature concerning the transfer member being pivotable in that such a feature was not originally disclosed with respect to the method. Moreover, the function of pivoting was clear from the description and independent to the other features, which also meant that there was no synergistic effect by any combination of this feature with other features and in particular with the suction. No modifications were necessary irrespective of whether the transfer member would be fixed or pivotably mounted, and in any case the method would work perfectly.

Concerning the first auxiliary request, the sole independent claim was limited to a method, which method was disclosed in the application as filed without the necessity of including a step concerning the pivoting of the pneumatic transfer member. The function of such a feature was clear from the description and it was disclosed as being independent of the other features, which also meant that there was no synergistic effect by any combination of this feature with other features and in particular with the features concerning the suction. Hence, there was no extension of the scope of

protection and no added subject-matter. There were two inventions disclosed in the patent in suit, one invention being directed to the suction of air in relation to the method and another invention directed to the pivoting movement of the transfer member in relation to the machine, which two inventions could be exploited independently of one another. Moreover, no modifications were necessary in a machine irrespective of whether the transfer member would be fixed or pivotably mounted since in any case the method would work perfectly. The redundancies resulting from the combination of the method and the machine claim did not lead to a lack of clarity.

Concerning the second auxiliary request, the addition of the feature concerning the opening and closing gates was based upon the disclosure on page 7, lines 5/6. The group of features disclosed on page 7, lines 3 to 9 included the feature related to the U-shaped duct so that the addition of the feature concerning the opening and closing gates completed the feature which was linked to the function of improved speed of the process. The feature concerning the pivoting of the transfer member as well as the feature concerning the air emerging from the fan were related to a separate group of features and thus to separate embodiments which was clear from the corresponding wording being present in separate paragraphs. Hence, it was not necessary to include these features since otherwise it would have been necessary to include all features which were disclosed in the description into the claim.

Reasons for the Decision

1. Procedural provisions
 - 1.1 Article 12(1)(a) of the Rules of Procedure of the Boards of Appeal (RPBA) states that appeal proceedings are to be based on the notice of appeal and statement of grounds of appeal filed pursuant to Article 108 EPC. Article 12(2) RPBA requires that the statement of grounds of appeal and the reply should contain a party's complete case and set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on.
 - 1.2 All the requests finally maintained by the respondent-proprietor were filed during the oral proceedings, hence after receipt of the Board's communication annexed to the summons to oral proceedings.
 - 1.3 According to Article 13(1) RPBA, it lies within the discretion of the Board to admit any amendment to a party's case after it has filed its grounds of appeal or reply. This Article states that "the discretion shall 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."
 - 1.4 Accordingly, in order to be admitted, any late-filed request should, for procedural economy reasons at least, be *prima facie* allowable, which is not the case for the appellant/proprietor's requests as explained below.

2. *Main request*

2.1 Comparing the subject-matter of claim 1 with that of claim 1 as granted, the following features have been subject to amendment in the form of added (in italics) or deleted (in brackets) wording:

(i) *"wherein said pneumatic transfer member (5) is arranged to cause the fabric ("being made") to strike alternatively against said grille structures (15, 17)";*

(iii) *"said suction mouths located behind said grille structures and formed at the end of a U-shaped duct (23) lying in a substantially horizontal plane";*

(iv) *"and that said pneumatic transfer member is pivotable so as to assume at least two positions depending on the direction of feeding of the fabric through said pivoting transfer member".*

2.2 Concerning added feature (iii), such feature is shown in the machine illustrated in Figure 1 and is referred to in the description of the application as filed on page 7, lines 3 to 5. This passage forms part of the "Detailed description of an embodiment of the invention" which is related to Figures 1 to 3 and hence is related to the transfer member being pivotable (which is discussed as feature (iv) below). There are further features related to this embodiment - contrary to the appellant's view - such as the generation of the air by the fan 29 as shown in Figure 1 and referred to on page 8, line 25/26 of the application as filed or the arrangement depending on the position of the gate 33 concerning the air flow in the duct (page 7, lines 24 to 29 of the application as filed). Hence, the isolated inclusion of one such feature represents an

intermediate generalisation of the disclosed embodiment and accordingly, the requirement of Article 123(2) EPC is not met.

- 2.3 That being, it is immaterial for the purpose of Article 123(2) EPC that the amended version of claim 1 contains other features which limit the scope of the claim. Article 123(2) EPC does not relate to limitation of the scope of a claim or the protection conferred by it, but instead to the subject-matter (of the patent) in view of any amendments, when compared to the content of the application as originally filed.

Likewise, the appellant/patentee's argument that all features "necessary" to define the invention had been included in the claim, does not address the objections made with respect to Article 123(2) EPC, since what the appellant/proprietor itself finds "necessary" to define an invention cannot alter what features are however disclosed in combination in the application as originally filed.

Further, as regards the appellant/proprietor's additional argument that the Board should find in its favour because the opposition division, in the decision under appeal, had found that all necessary features had been included, the Board, in view of its finding under point 2.2 above, cannot concur. As a matter of course the findings of the opposition division cannot be relied upon by an appellant/patentee in the sense that arguments put forward by an appellant/opponent should necessarily not be found persuasive by the Board.

- 2.4 Concerning the addition of feature (iv), this feature was included in claim 1 as originally filed and its deletion had been objected to by the appellant/opponent

and consistently referred to by the Board in its communication annexed to summons. Accordingly, its insertion into claim 1 is a reaction to such objections. However, consistent with the arguments above (point 2.2), such feature cannot be seen isolated from further features related to the disclosure of the specific embodiment from where the feature is taken. Therefore, no clear and unambiguous disclosure is present for the now claimed machine and the requirement of Article 123(2) EPC is not met.

2.5 In view of the fact that in order to be admitted, any late-filed request should, for procedural economy reasons at least, be *prima facie* allowable, which is not the case here, it was not necessary to consider the further objections put forward with regard to claims 1 and 11.

2.6 As regards the re-insertion of the feature (ii): "wherein said suction mouths (19, 21) are arranged for suction of the conveying air emerging from said pneumatic transfer member (5)" (see point VI above) "offered" by the appellant/patent proprietor, it results from the above analysis that such a request would not be in compliance with Article 123(2) EPC in that there are further features lacking which are related to the claimed embodiment.

3. *Auxiliary request 1*

3.1 The subject-matter of the sole independent claim 1 is amended to define a method which includes, in addition to the method features of granted claim 12, the features of the machine of claim 1 of the main request (see point 2 above) with the exception of features (i)

and (ii) being worded as in claim 1 as granted and feature (iv) being omitted.

3.2 No clear and unambiguous disclosure concerning a method for the continuous treatment of a fabric by such a machine is present in the application as originally filed (Article 123(2) EPC). The machine is only ever disclosed as including a pivoting transfer member. Although such feature is absent from claim 1 as found allowable by the opposition division, no disclosure for a machine without such feature in the application as filed has been identified.

3.3 With regard to the respondent's arguments concerning essentiality, in as far as this might be relevant to the question of admissibility of an intermediate generalisation, the Board considers the feature of a pivotable transfer member is anyway essential to the functioning of the machine. With regard to the Figure 1 embodiment, which is the only embodiment disclosed, no alternative or modification of such feature is suggested. Claim 1 is also limited to the embodiment disclosed in Figure 1 by way of the feature of the U-shaped duct located in a horizontal plane (page 7, lines 3 - 5). Such feature is only disclosed in combination with *inter alia* a pivotable transfer member (page 6, line 30, page 7, line 30, Figure 1) and with the provision of an air generating fan (page 8, line 25/26, Figure 1). The embodiment shown in Figure 1 discloses all these features only in combination. Therefore, when omitting one such feature, an inadmissible intermediate generalisation occurs.

3.4 This objection is not overcome by linking the machine features directly to the method features. Such combination cannot "repair" the missing disclosure. The

appellant/proprietor's argument that the essential feature of the method was the sucking action and the claim would be limited to such method are not convincing since the method now includes the machine features for which there is no disclosure without a pivoting transfer member. Thus even though there had originally been no definition in the method claim of a pivoting step of the transfer member, the combination of the method steps with the machine features could only be based upon the machine features as disclosed, and hence to the machine features including a pivoting transfer member.

3.5 Therefore, the subject-matter of claim 1 extends beyond the originally filed disclosure and the requirement of Article 123(2) EPC is not met. Accordingly, this late-filed request is not *prima facie* allowable and was not admitted into proceedings.

4. *Auxiliary request 2*

4.1 The subject-matter of claim 1 of this request is amended with regard to claim 1 of the first auxiliary request in that it additionally includes the feature "wherein respective opening and closing gates (25, 29) are located inside said duct (23) in the vicinity of said suction mouths (19, 21)" at the end of the part of the claim concerning the machine features.

4.2 Accordingly, irrespective of such amendment, such claim does not overcome the objection set out above in that no feature concerning the pivoting transfer member is included. The above arguments made in regard to the first auxiliary request also apply equally to this request and also this late-filed request is not *prima facie* allowable. The Board thus exercised its

discretion not to admit this request into the proceedings.

5. *No requests from the appellant/proprietor in the proceedings*

In view of no request of the appellant/proprietor for maintenance of the patent being admitted into proceedings, the European patent must be revoked. This being the case, the admissibility of the appeal of the proprietor is irrelevant and need not be considered.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated