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**Datasheet for the decision
of 13 December 2016**

Case Number: T 0084/12 - 3.2.06

Application Number: 02787646.5

Publication Number: 1448828

IPC: D04H1/70, D04H13/00, D04H1/00,
E04B1/78

Language of the proceedings: EN

Title of invention:
MINERAL FIBRE BATTS

Patent Proprietor:
Rockwool International A/S

Opponent:
SAINT-GOBAIN ISOVER

Headword:

Relevant legal provisions:
EPC Art. 54, 56, 111(1)

Keyword:

Novelty - (yes)

Inventive step - auxiliary request 2 (no) - auxiliary request
4 (yes)

Appeal decision - remittal to the department of first instance
(no)

Decisions cited:

Catchword:



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Case Number: T 0084/12 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 13 December 2016

Appellant: Rockwool International A/S
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Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
14 November 2011 concerning maintenance of the
European Patent No. 1448828 in amended form.

Composition of the Board:

Chairman M. Harrison
Members: T. Rosenblatt
E. Kossonakou

Summary of Facts and Submissions

- I. The patent proprietor and the opponent each filed an appeal against the interlocutory decision of the opposition division in which it found that European patent No. 1 448 828 in an amended form met the requirements of the EPC.
- II. Since both parties appealed the interlocutory decision they are referred to hereafter as the patent proprietor and opponent respectively.
- III. In its decision the opposition division held *inter alia* that the main request, comprising an independent method claim 1, independent product claims 5 and 11 and an independent use claim 8, did not comply with Rule 80 EPC. Auxiliary requests 1 and 2 were found to contravene Article 123(2) EPC. Auxiliary request 3, which was directed only to the subject-matter corresponding to that of the independent method claim 1 and its dependent claims of the main request, was found allowable.
- IV. Together with its appeal grounds the proprietor submitted six claim sets as a main request and five auxiliary requests. Its main request and auxiliary request 1 corresponded to those underlying the impugned decision. Auxiliary request 5 corresponded to auxiliary request 3 found allowable by the opposition division. The independent use claim of the main request was also included, without any amendment, in auxiliary requests 1 to 3 and constituted the sole independent claim of auxiliary request 4. Two further auxiliary requests 6 and 7 were submitted in reply to the opponent's appeal grounds.

- V. In its letter dated 26 July 2012 the opponent replied to the proprietor's appeal grounds. The opponent also raised a novelty objection in regard to the subject-matter of independent use claim 8 of the main request based on D5.
- VI. With its letter of 20 November 2012 the proprietor submitted an amended main request and amended auxiliary requests 1 to 7 in which, in particular, a clarity objection raised by the opponent against dependent use claim 10 of the main request and of the corresponding claim in the respective auxiliary requests was addressed.
- VII. The parties were summoned to oral proceedings before the Board.
- VIII. With its letter of 22 July 2016 the opponent announced that it would not attend the oral proceedings before the Board. The opponent additionally requested that the case be remitted to the opposition division for discussion of the opposition grounds if the Board would come to a different conclusion than the opposition division in regard to the allowability of the amendments in the main request under Rule 80 EPC.
- IX. In a communication dated 10 November 2016 sent in preparation for the oral proceedings, the Board noted it preliminarily found the conclusion reached by the opposition division under Rule 80 EPC to be correct. The Board stated, *inter alia* that the subject-matter of claims 5, 8 and 11 would need to be considered with respect to the requirements of Articles 54 and 56 EPC. The Board also noted that there was no absolute right for the parties to have all issues decided at two instances, that the issues to be decided did not appear

to involve any further complex fact finding and that the parties had already discussed the issues of novelty and inventive step in their written submissions. In regard to the opponent's announcement that it would not be represented at the oral proceedings before the Board, the Board stated that this would not necessarily lead to a remittal of the case to the opposition division for a decision on the issues under Articles 54 and 56 EPC and that the Board might take a decision based only on the written submissions of the opponent. The Board further noted that the opponent had raised novelty objections to the subject-matter of claims 5, 8 and 11 of the main request in view of D5, which had been refuted by the proprietor and that the proprietor's arguments appeared convincing.

- X. With its letter of 28 November 2016, the opponent submitted further comments in regard to the subject-matter of independent claims 1, 5 and 11 of the main request together with comments to the corresponding claims of auxiliary requests 1, 2, 6 and 7. Concerning the question of remittal, no additional comments in regard to the Board's preliminary opinion were given.

- XI. Oral proceedings before the Board took place on 13 December 2016 in the absence of the opponent. During the oral proceedings the proprietor withdrew its main request and auxiliary requests 1 and 3.

- XII. The patent proprietor requested that the decision under appeal be set aside and the patent be maintained on the basis of auxiliary request 2 or auxiliary request 4 (both submitted with the letter of 20 November 2012).

- XIII. The opponent requested in writing that the decision under appeal be set aside and that the patent be

revoked, subsidiarily - in case the amendment to claim 8 of the main request were found conform to Rule 80 EPC or if the product or use of the product were to be discussed - that the case be remitted to the opposition division for further prosecution.

XIV. The following documents have been referred to by the parties:

- D1: WO-A-02/096756, corresponding to
EP-A-1 390 262,
- D2: DE 32 03 622 C2,
- D3: WO-A-94/19555,
- D4: EP-A-1 026 301,
- D5: WO-A-88/00265.

XV. Independent claims 1 and 8 of auxiliary request 2 have the following wording:

"1. A method of making a batt having a softened outer surface comprising making a batt having first and second major surfaces and comprising a bonded mineral fibre network bonded by a cured bonding agent, and then subjecting the bonded network to post-cure compression by mechanically compressing the second major surface of the batt depthwise by passing the bonded and cured batt through a nip defining a depth of 20 to 90% of the thickness of the cured batt, and in which the compression is applied by passing the bonded and cured batt through a nip between a surface which supports the first major surface of the batt and compression means for temporarily compressing the batt at the second major surface.

8. Use of a batt as insulation fitted against an irregular surface wherein the batt is a mineral fibre batt which has first and second major surfaces and

which comprises a bonded mineral fibre network which is bonded by a cured bonding agent and which has an inner portion and an outer portion wherein the second surface of the batt is provided by the outer surface of the outer portion and wherein the outer portion has a depth of at least 5mm and has reduced stiffness due to post-cure compression of the bonded network in the outer portion and wherein the second face is compressed against the irregular surface and the soft outer portion absorbs the irregularities without causing the irregularities to be manifested in the first surface.

Although auxiliary request 2 contained two further independent claims, these are of no relevance for the present decision.

XVI. The wording of the sole independent claim 1 of auxiliary request 4 is identical to that of claim 8 of auxiliary request 2.

XVII. The arguments of the opponent may be summarised as follows.

The arguments concerning claims 1 and 8 of the main request applied equally to the corresponding claims of auxiliary requests 2 and 4.

The subject-matter of claim 1 of the main request lacked novelty in view of D1 and D4. Claim 1 did not require that the nip comprised rolls. Figure 2 of D1 anyway disclosed such rolls. Moreover Figure 2 and Figure 3, relating to an alternative embodiment, in combination with Figure 4 disclosed compression of the batt up to 50 or 60 % of its thickness. Figure 1 of D4 disclosed a batt undergoing strong compression of

approximately 50 %, which fell in the broad range defined in claim 1.

The subject-matter of claim 1 lacked inventive step starting from D1, Figure 2, or D4, Figure 1, as the closest prior art when taking into account common general knowledge of a skilled person. Considering the nip depth range defined in claim 1 as constituting the single distinguishing feature, and since the effects achieved by this feature are the same in D4 and in the patent in suit, the problem to be solved would merely be to provide an alternative to the methods therein. The compression range was already hinted at by D4, disclosing compression values around 40 to 60 %.

The subject-matter of claim 8 of the main request (corresponding to claim 1 of auxiliary request 4) lacked novelty in regard to D5 which disclosed mineral fiber panels having a density between 20 and 180 kg/m³, for example 83 kg/m³ (see page 7, lines 10-16 and 20). According to D5, the thickness of its higher density portion was 30 % of the panel's total thickness. Such panels commonly had a thickness between 1 and 10 cm. A high density portion of a 10 cm panel according to D5 thus had a thickness of 33 mm. Moreover, in use, the harder layer of the batt would be exposed to the exterior (see page 1, lines 20 to 24), whereas the softer layer would come to lie against a wall, thus implicitly absorbing its surface irregularities.

The product and use claims were not examined in the oral proceedings before the opposition division. Since the arguments concerning the patentability of the product claims and of the use claims were based on documents which were different from those considered in

regard to the method claims, the case should be remitted to the opposition division.

XVIII. The arguments of the patent proprietor may be summarised as follows.

Neither D1 nor D4 disclosed a nip depth range of 20 to 90 % of the thickness of the cured batt.

D1 constituted prior art according to Article 54(3) EPC and could thus not be considered for examining the requirement of Article 56 EPC.

In addition to the missing disclosure of the nip depth range as defined in claim 1, D4 also did not concern the making of a batt as defined in claim 1. Instead, the method of Fig. 1 produced a rolled-up web. Nothing in D4 gave a hint to the skilled person to make batts, let alone by passing them through a nip with a depth of 20 to 90 % of the batt's original thickness. The effect of the nip depth range was amply described in the patent, whereas D4 was silent on the effects achieved by the compression. The purpose of the nip compression in D4 was entirely different.

The subject-matter of claim 8 of the main request, corresponding to claim 1 of auxiliary request 4, was neither known nor rendered obvious by D2, D3 and/or D4. D5 did not disclose an outer portion with reduced stiffness where the outer portion had a depth of at least 5 mm. According to D5, compression of the outer portion, which increased its density, took place before curing. When cured, that denser outer portion had increased density. D5 also did not disclose fitting the batt against an irregular surface as required by

the use claim. No objections on inventive step against the use claim had been submitted.

Reasons for the Decision

1. The opponent, who had been duly summoned to the oral proceedings, decided not to attend the oral proceedings. According to Rule 115(2) EPC the proceedings were continued without the opponent. Furthermore and according to Rule 15(3) of the Rules of Procedure of the Boards of Appeal, the Board is not obliged to delay its decision under such circumstances. The opponent is treated as relying only on its written case.

Auxiliary request 2

2. Article 54 EPC

The subject-matter of claim 1 is new in view of D1 and D4 since the feature of claim 1 "a nip defining a depth of 20 to 90 % of the thickness of the cured batt" is not directly and unambiguously derivable from either of these documents. Although the opponent argued to the contrary, these arguments are not dealt with here since (as explained *infra*) the subject-matter of claim 1 lacks an inventive step.

3. Article 56 EPC

The subject-matter of claim 1 does not involve an inventive step for the following reasons.

3.1 Figure 1 of D4 can be considered to represent the closest prior art to the subject-matter of claim 1. It discloses an arrangement for making a batt and thereby implicitly also a corresponding method. A bonded fibre web or batt 3 is passed through a nip formed by a roller 11 and a conveyor band 4. This was not disputed by the proprietor.

3.2 In the oral proceedings, the proprietor disputed however, for the first time, that the prior art method concerned the making of "batts", alleging that the expression "batts" within the meaning of the patent essentially related to smaller length sections such as individual panels, contrary to the rolls of a continuous fibre web obtained by the method of D4. However, the proprietor did not indicate anywhere in the patent which would provide support for its view that the term "batt" as used in claim 1 should be given this limited interpretation. The Board notes, to the contrary, that the length of a batt is not defined in the patent, nor is there any evidence to suggest that a batt according to claim 1 must in some way have a length similar to a panel or, in some undefined way, be different (e.g. shorter) than a web.

The proprietor also argued that the first surface of the batt produced according to Figure 1 of D4 also exhibited reduced stiffness due to the deflection of the fibre web immediately prior to its rolling-up. However, claim 1 does not exclude a further softening of the "first surface", such that this argument lacks relevance with respect to the wording of the claim.

3.3 Consequently the subject-matter of claim 1 is distinguished over the method known from Figure 1 of D4 only by the specific range for the depth of the nip

formed by roller 11 and conveyor band 4 in relation to the thickness of the batt.

3.4 The problem to be solved, as formulated by the proprietor, is to provide a method of making batts having a particular soft surface structure on a second surface whereas the first surface is not softened. This however cannot be accepted as an objective problem.

3.4.1 The effect achieved by the compression of the batt in D4 is to break the structure of the bonded fibre batt within a certain depth of the surface portion passing under the roller 11 (see D4, column 13, lines 7-11) so as to increase the elasticity of the thus treated surface portion. Increasing the elasticity of the batt at the treated surface is synonymous to reducing its stiffness. Hence, the same underlying effect as in the patent is obtained. No further particular technical effect can be attributed to the broad range of compression defined by the relative nip depth of claim 1. Any intended additional effects or advantages, such as a better fitting of such batts on walls presenting surface irregularities or a necessary non-softened other surface, are not reflected by corresponding features in claim 1.

3.4.2 Since from the schematic drawing of Figure 1 of D4 no particular value of the relative nip depth or intended compression ratio can be derived, also the problem suggested by the opponent, i.e. to provide a simple alternative method to the method of D4, cannot be considered an objective one.

3.5 Starting from the method disclosed in Figure 1 of D4, the Board finds that an objective problem can be seen merely in providing a method of making a batt with an

appropriate or suitable compression of one of its surfaces to achieve the required breaking up and increased elasticity of the surface.

- 3.6 The solution defined by claim 1 is obvious for the skilled person. In order to carry out the method disclosed in Figure 1 of D4, the skilled person has to consider how to appropriately set the nip depth. Figure 1 and also Figures 2 and 6 schematically display a significant amount of compression of the batt (as also argued by the opponent). There is on the other hand no disclosure in D4 which would suggest that compression of the cured batt should be limited to a very shallow surface region, or in other words that the "nip depth" (i.e. the distance between the components constituting the nip) should be restricted to be almost as large as the thickness of the cured batt, i.e. over 90% of its thickness. In this regard, merely for clarification, the Board notes that the claim does not define a 90% compression in the nip, but a compression with a nip of a certain percentage depth of the batt. When considering a significant amount of compression to be suitable, as already explained above, the skilled person would therefore be guided to work with nip depths smaller than 90% of the batt's thickness (i.e. compressing the batt by 10% or more), and therefore within the claimed broad range, without exercising an inventive step. The requirement of Article 56 EPC is therefore not met.
4. The patent can thus not be maintained with the claims according to auxiliary request 2.

Auxiliary request 4

5. Opponent's request for remittal
- 5.1 Claim 1 of auxiliary request 4 corresponds literally to claim 8 of the former main request (and of auxiliary request 2), which main request was withdrawn during the oral proceedings.
- 5.2 According to Article 111(1) EPC, second sentence, the Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.
- 5.3 The Board accepts the opponent's argument that the requirements of Articles 54 and 56 EPC had not been discussed before the department of first instance in regard to the subject-matter of claim 1 of the present request. However, when exercising its discretion, the Board does not find it appropriate to remit the case to the opposition division for the following reasons.
- 5.4 As stated in its communication, the Board considers that there is no absolute right for the parties deriving from the above cited provision to have each objection decided upon in two instances. Rather Article 111(1) EPC confers discretionary power to the Boards of Appeal, under due consideration of all circumstances of the case, whether or not to remit the case to the department of first instance.
- 5.5 In its appeal grounds the proprietor argued that the subject-matter of *inter alia* the use claim 8, now claim 1, was neither known nor rendered obvious by D2, D3

and/or D4. This argument was not refuted by the opponent.

5.6 Furthermore, the Board considered in its communication that the issues of novelty and inventive step in regard to the subject-matter of independent claims 5, 8 and 11 of the former main request did not appear to involve any further complex fact finding. This consideration has not been contested by the opponent in its reply to the Board's preliminary opinion. In fact, the opponent in its letter of 26 July 2012 had raised novelty objections against all of these claims, which it maintained at least against claims 5 and 11 of the withdrawn main request in its letter of 28 November 2016. The opponent also contested that claim 1 of auxiliary request 4 involved an inventive step (last page of its letter of 26 July 2012), without nevertheless giving any reason in this respect. There is also no reason stated or apparent to the Board why it would have been necessary to consider further "very different prior art", as stated in the opponent's letter of 29 September 2016. No indication has been given as to what different prior art, besides D5, might have to be considered nor for which reason such different prior art could not have been presented and dealt with in the proceedings before the Board.

5.7 Despite the Board's announcement in its communication that, in the absence of the opponent at the oral proceedings, it may take a decision based on only the opponent's written submissions, the opponent did not raise any further objection in regard to the subject-matter of present claim 1. In its subsequent letter of 28 November 2016 the opponent also did not submit any comments in respect of the Board's preliminary opinion not to follow the opponent's arguments on novelty based

on D5 - in particular not in view of the subject-matter of present claim 1 (former claim 8). Also, whereas the opponent raised new objections under Article 56 EPC against the other independent claims 5 and 11 formerly attacked with D5, it did not raise any reasoned objection under Article 56 EPC against present claim 1. In the absence of any specific objection, the Board can find no reason as to why a remittal of the case to the department of first instance would be appropriate.

- 5.8 Although the opponent also requested that the case be remitted if the claims were found to conform to Rule 80 EPC, this objection was in fact substantiated in respect of the plurality of independent claims in particular requests. This was also addressed in the Board's communication. Since however auxiliary request 4 only contains a single independent claim, the opponent's objection made against other requests is moot.

In as far as the requirement of Rule 80 EPC *per se* is concerned, the claims of auxiliary request 4 are simply a longhand (i.e. non-abbreviated) version of dependent claim 9 as granted, whereby all other granted claims have been deleted. The limitation of the granted claims to only these claims is therefore a response to a ground of opposition raised against the granted claims by means of deletion of other claims. Remittal on this basis would also therefore not be appropriate, since the opponent has always been confronted with these claims and has had ample opportunity to raise its objections.

- 5.9 The opponent's request for remittal is therefore rejected.

6. Articles 84 and 123 EPC

The single independent claim 1 is based on granted use claim 9 incorporating explicitly the features of granted product claim 6 to which granted claim 9 referred. Objections regarding the requirements of Articles 123 and 84 EPC against the present claims have not been raised by the opponent and the Board is also satisfied that these requirements are met.

7. Article 54 EPC

7.1 The opponent argued that the subject-matter of use claim 8 of the (now withdrawn) main request lacked novelty in view of D5. Claim 1 of auxiliary request 4 is identical to claim 8 of the withdrawn main request so that the same objection applies.

7.2 The opponent's objection was refuted by the proprietor in its letter of 20 November 2012 (see lower half of page 3 to upper half of page 4). As mentioned above, the preliminary opinion of the Board on this issue, according to which the proprietor's arguments appeared convincing, was not addressed by the opponent in the letter of 29 November 2016. In the absence of any further argument on novelty in regard to the subject-matter of the use claim, the Board has no reason to change its preliminary opinion which is hereby confirmed, as explained below.

7.3 The mineral fibre batt produced according to D5, in particular according to the Example disclosed on page 7, comprises no outer portion on one of its surfaces with reduced stiffness due to post-cure compression of the bonded network. Whilst the batt according to D5 indeed comprises a compressed portion, curing and thus

bonding of that portion and the entire batt are carried out only after its compression step (cf. D5, page 7, lines 19-27). The resulting product thus has a high density portion on one surface due to pre-cure compression, but no reduced stiffness portion due to post-cure compression. Further, the presence of an outer portion (i.e. the softened portion) with a depth of at least 5 mm as defined in claim 1 is also not unambiguously disclosed. The subject-matter of claim 1 is thus novel at least for these reasons.

8. Article 56 EPC

The opponent did not raise any objection during the appeal proceedings in regard to inventive step against the subject-matter of the use claim (i.e. claim 1 of this request). The written submissions made when filing the opposition and during the opposition proceedings are only very generally referred to in the opponent's appeal grounds (see page 6, item 4) without any express mention of the facts, arguments and evidence relied upon; they thus do not form part of the opponent's case in the appeal proceedings (see Article 12(2) and (4) of the Rules of Procedure of the Boards of Appeal) and therefore do not require further consideration by the Board. The Board also cannot find *prima facie* that the subject-matter of claim 1 of auxiliary request 4 would be rendered obvious by the prior art referred to by the opponent. The Board thus concludes that the requirement of Article 56 EPC is met.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in amended form with claims 1 to 3 of the fourth auxiliary request and a description to be adapted thereto.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated