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**Datasheet for the decision
of 2 August 2012**

Case Number: T 0162/12 - 3.2.07

Application Number: 06828829.9

Publication Number: 1954588

IPC: B65D 71/00, B65D 85/16

Language of the proceedings: EN

Title of invention:

Assembly of stacked rolls or slabs of compressible insulation material

Applicant:

Knauf Insulation SPRL

Headword:

-

Relevant legal provisions:

EPC Art. 54

RPBA Art. 13(1), 12(2), 15(1)

Keyword:

"Novelty (main request): no"

"Admissibility (all auxiliary requests): no" (see points 2.2-2.4)"

Decisions cited:

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Catchword:

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Case Number: T 0162/12 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 2 August 2012

Appellant:
(Applicant)

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted 20 July 2011
refusing European patent application
No. 06828829.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: H. Meinders
Members: K. Poalas
I. Beckedorf

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the Examining Division refusing European patent application 06 828 829.9.
- II. In its decision, the Examining Division held that the subject-matter of claim 1 of the set of claims filed with letter dated 23 March 2010 lacks inventive step over D1 (WO 2004/092039 A1).
- III. In its notice of appeal the appellant requested that the decision of the Examining Division be set aside and that "this applicant be granted on the basis of the claims currently on file" or, alternatively, "on the basis of any auxiliary requests presented during the appeal procedure". Oral proceedings were requested in the event of the applicant's requests not being granted during the written procedure.
- IV. With its communication dated 2 May 2012 the Board summoned the appellant to oral proceedings on 2 August 2012. In the annex to said summons the Board expressed its preliminary opinion concerning the valid set of claims 1 to 15. According to the preliminary opinion of the Board the subject-matter of claims 1, 3 to 10, 12 and 13 lacks novelty over the package known from D1 and the subject-matter of claims 2, 11, 14 and 15 does not involve an inventive step.
- V. With its letter dated 2 July 2012 the appellant filed a main request repeating claims 1 to 15 as filed with said letter dated 23 March 2001. It filed also a 1st and a 2nd auxiliary request. In the 1st auxiliary request the

subject-matter of claim 6 of the main request was incorporated into claims 1 and 11 and the remaining claims were renumbered. In the 2nd auxiliary request claims 1 to 10 of the main request were cancelled and the remaining claims were renumbered. No reasoning concerning the patentability of the claims of the 1st and 2nd auxiliary requests was presented in said letter. In the same letter the appellant requested "a favorable exercise of the Appeal Board's discretion to allow additional auxiliary request during the oral proceedings as a function of the discussions".

VI. During the oral proceedings which took place before the Board on 2 August 2012 the appellant filed (new) auxiliary request 1, renumbered the earlier 1st and 2nd auxiliary requests into auxiliary request 2 and 3 and requested that the decision under appeal be set aside and that a patent be granted on the basis of one of the sets of claims filed as main request with letter of 2 July 2012, as (new) auxiliary request 1 during the oral proceedings, and as (renumbered) auxiliary requests 2 and 3 with letter of 2 July 2012.

VII. The independent claims 1 and 11 of the main request read as follows:

Main request

"1. A stack of rolls (1) or slabs of compressible insulating material (2) comprising a plurality of multipacks (6), each multipack (6) comprising and retaining together a plurality of individually packaged packs (1) of insulating material, characterised in that the stack comprises at least a first and a second group

(7,7') of multipacks with each group comprising a plurality of aligned multipacks, in which the axial direction of one of the groups (7) of multipacks is vertical and the axial direction the other group (7') of multipacks is horizontal".

"11. A stack of individually packaged rolls (1) or packs of slabs of insulating glass fibre or mineral fibre in accordance with any preceding claim and arranged for transportation in which:
the first group (7) of multipacks comprises twelve individually packaged rolls (1) or packs of slabs arranged vertically as a block having three individually packaged rolls (1) or packs of slabs arranged along one side and four individually packaged rolls (1) or packs of slabs arranged along its other side; and
the second group (7') of multipacks comprises sixteen individually packaged rolls (1) or packs of slabs arranged horizontally as a block having four individually packaged rolls (1) or packs of slabs arranged along one side and four individually packaged rolls (1) or packs of slabs arranged along its other side".

The independent claim 1 of the (new) auxiliary request 1 differs from claim 1 of the main request in that it incorporates the additional feature of claim 2 of the main request that

"the first group (7) consists of three aligned multipacks (6) and the second group (7') consists of four aligned multipacks (6)".

The independent claim 10 of the (new) auxiliary request 1 is identical with claim 11 of the main request.

The independent claims 1 and 10 of the auxiliary request 2 differ from claims 1 and 11 of the main request in that they incorporate the additional feature of claim 6 of the main request that "the multipacks (6) forming each group (7,7') of multipacks are bound side by side in a compressed state by means of an enveloping film (8, 8')".

The independent claim 1 of the auxiliary request 3 is identical with claim 11 of the main request.

VIII. The appellant argued essentially as follows:

Main request - Claim 1 - Novelty, Article 54 EPC

D1, see first complete paragraph of page 8, uses on the one hand the term "crosswise" to explain the configuration of figure 5 of D1, i.e. of figure 5B of Annex A filed during the oral proceedings, in which the axes of the rolls in the single module forming the middle layer are arranged transversal with respect to the axes of the rolls in the other modules, and on the other hand D1 uses the term "arranged offset by 90°" to explain a different configuration, i.e. as the one illustrated in figure 5C of Annex A, in which there is no such "crosswise" arrangement. In the latter all axes of the rolls are vertical, the middle layer of modules is however rotated 90° with respect to the other layers of modules below and above it.

This interpretation of the disclosure of the first complete paragraph of page 8 of D1 is also supported by the text of claim 11 of D1 defining that "the modules (5) in the stack are arranged upright but offset relative to each other".

When D1 is read without hindsight knowledge of the present invention it can be seen that there is no teaching or suggestion in D1 to provide an arrangement in which the axial direction of the rolls in one group of multipacks (the group comprising a plurality of aligned multipacks) is vertical and the axial direction of the rolls in the adjacent group of multipacks (also comprising a plurality of aligned multipacks) is horizontal.

The expression "of this kind" in the passage "of course, the large package is not restricted to a crosswise arrangement of this kind", on page 8, lines 13 to 15 is unclear and cannot lead to "crosswise" and "offset by 90°" having identical meaning.

When there is also a second feasible interpretation for the "crosswise" arrangement of the first complete paragraph of page 8 of D1, this is strong evidence that the teaching of said paragraph is at best ambiguous. Said paragraph therefore cannot qualify for a "clear and unambiguous disclosure" of only the "crosswise" arrangement in which the axes of the rolls in the layers in one group are orthogonal to the axes of the rolls in an adjacent group.

The subject-matter of claim 1 is therefore novel over the disclosure of D1.

Admissibility of the (new) auxiliary request 1 and the (renumbered) auxiliary requests 2 and 3

The need for a further limitation of the subject-matter of the claim 1 of the main request became apparent to the appellant only during the oral proceedings.

The amendments in all auxiliary requests established novelty for the subject-matter of claim 1 of said requests.

Only three auxiliary requests have been filed, which is not a too large number.

The auxiliary requests are easy to understand and the Board can deal with them without adjournment of the oral proceedings.

Non-admittance of the auxiliary requests into the appeal proceedings would be a harsh decision against the appellant.

Reasons for the decision

1. *Main request - Claim 1 - Novelty, Article 54 EPC*

1.1 In lines 6 to 11 and 15 to 20 of page 8 of D1 the large package illustrated in figure 5 of D1 is described. Said large package consists of three layers, a bottom, a middle and a top layer, whereby the modules 5 or

adjacent layers (bottom/middle, middle/top) are arranged crosswise, i.e. "with intersecting axes" of their respective rolls. More precisely, the modules of the upper and lower layers are vertically oriented and the modules of the middle layer are horizontally oriented.

- 1.2 The text in lines 11 to 13 of that page, in between the two above mentioned references, states that "[h]igh stability can also be achieved by omitting the crosswise-disposed middle layer and, instead, arranging the top module layer such that it is offset by 90° relative to the bottom layer".

This means to the Board that in order to build a "stable" **two-layers-package** the following steps have to be performed:

- (a) omission of the middle layer,
- (b) arrangement of the top layer "offset by 90°" relative to the bottom layer.

Omission of the middle layer shown in figure 5 of D1 would result in that the upper layer lies on top of the lower layer without any changing of its orientation. The rolls in the modules of both layers would all be vertically oriented.

- 1.3 In order to then perform the above-mentioned step (b) the skilled person has only the following two possibilities for obtaining the 90° offset of the upper layer:

(i) 90° turning over of the upper layer

After such a 90° rotation the upper and the lower layer are arranged crosswise, i.e. "with intersecting axes" of their respective rolls. Such a modus of rotation finds support in the sentence following this passage, which states that "[o]f course, the large package is not restricted to a **crosswise arrangement of this kind;** much rather, the invention is also applicable to modules stacked in other ways".

This means that such a 90° offset relationship in a two-layers-package is also to be seen as a "crosswise arrangement", i.e. with the axes of the rolls in the top layer at 90° with the axes of the rolls in the bottom layer.

The above is further supported by the wording of claim 10 of D1, since said claim, being also valid for a two-layers-package, states that "at least some of the modules are arranged crosswise, i.e. alternately upright and lying flat, with vertical and horizontal orientation of the modules".

(ii) mere 90° rotation of the upper layer around its central vertical axis

After such a rotation both the upper and the lower layer still have their rolls positioned vertically. However, the orientation of the modules (each consisting of 3 rolls next to each other) in the upper and lower layer differs by 90°. This finds support in claim 11 of D1.

1.4 For the Board this passage of D1 thus clearly and unambiguously teaches the skilled person only two concrete and distinct arrangements for a two-layers-package, namely one in which the upper layer has the modules stacked horizontally onto a lower layer of vertically oriented rolls and one in which the upper layer keeps the rolls in the modules vertically oriented, but changes the row direction of these rolls by 90° with respect to the lower layer.

1.5 Since the first arrangement renders the subject-matter of claim 1 not novel the subject-matter of claim 1 does not meet the requirements of Article 54 EPC.

1.6 The Board therefore cannot agree with the appellant when it argues that the offset arrangement of the upper layer "by 90° relative to the bottom layer" as stated in D1 can **only** be understood as the 90° rotation of the whole upper layer about its central vertical axis.

Also, the phrase "of course, the large package is not restricted to a crosswise arrangement of this kind", following directly upon the mention of the "90° offset" orientation (see page 8, lines 13 to 15) is not unclear as argued by the appellant, but simply defines that the 90° offset relationship in a two-layers-package can also be seen as a "crosswise arrangement".

Further, the text of claim 11 of D1 stating that "to increase stacking stability, the modules (5) in the stack are arranged upright but offset relative to each other" cannot support the appellant's position, since claim 11 is a dependent claim referring back *inter alia* to claim 10. It therefore explicitly allows for the

Board's interpretation, since "**the** modules in the stack" as referred to in claim 11 can be those of preceding claim 10.

- 1.7 Finally, the appellant argued that if two possible configurations for a two-layers-package are derivable from figure 5 of D1 and the relevant passages of page 8 of D1, this is evidence that the teaching of D1 is ambiguous in this respect.

The Board considers this in the present situation not to be the case. As explained above, the above-mentioned paragraph of D1 teaches the person skilled in the art clearly and directly only the two above-mentioned distinct package configurations. This has nothing to do with ambiguity.

2. *Admissibility of the auxiliary requests*

2.1 *(New) auxiliary request 1 filed during the oral proceedings*

- 2.1.1 (New) auxiliary request 1 corresponding to the combination of claims 1 and 2 of the main request was not filed until the end of the discussion concerning the patentability of the subject-matter of claim 1 of the main request. The appellant argued that the need for a further limitation of the subject-matter of the claim 1 of the main request became apparent to him only during the oral proceedings and that the amendments in said request establish novelty for the subject-matter of amended claim 1.

2.1.2 According to the established case law of the Boards of Appeal the admission of amended claims submitted for the first time during oral proceedings is subject to a legally relevant excuse for their late filing, see Case Law of the Boards of Appeal, 6th edition, 2010, Chapter VII.E. 16.3.3(a).

2.1.3 In the present case the discussion during the oral proceedings has been essentially limited to the objection raised in the Board's annex to the summons concerning lack of novelty of the subject-matter of claim 1 of the main request, without any new issues coming up which could have left the appellant facing a new situation.

As stated under point 2.1.1 above claim 1 of the (new) auxiliary request 1 corresponds to the combination of claims 1 and 2 of the main request. However, the Board had already expressed in its annex to the summons its preliminary opinion that the subject-matter of claim 2 of the main request did not involve an inventive step, see point 3. The appellant therefore could have filed said auxiliary request, properly supported by arguments (see point 2.3 below), sufficiently in advance for the Board to prepare itself for the oral proceedings. In acting as it did, the appellant kept all its cards to itself whereas the Board with its annex to the summons has laid its cards on the table. That cannot be considered conducive to efficient proceedings.

2.1.4 Thus, there is no legally relevant excuse for the late filing of this auxiliary request, which is therefore not admitted.

2.2 *(Renumbered) auxiliary requests 2 and 3 filed with letter of 2 July 2012 as then 1st and 2nd auxiliary requests*

2.2.1 In its annex to the summons to oral proceedings set for 2 August 2012, sent by virtue of Article 15(1) RPBA the Board specifically raised objections concerning lack of novelty of the subject-matter of claims 1 and 3 to 10 and lack of inventive step of claims 2 and 11 to 15 of the appellant's main request. In this communication the ultimate date for filing submissions was set at one month before the oral proceedings and reference was made to the provisions of Article 13 of the Rules of Procedure of the Boards of Appeal (RPBA). With its letter of 2 July 2012, the appellant filed two auxiliary requests. It only indicated that for the then 1st auxiliary request claim 6 of the main request was incorporated into the independent claims 1 and 10 of the main request and that in the then 2nd auxiliary request the independent claim 11 of the main request became the only independent claim. The request was not accompanied by any reasoning concerning the patentability of the claims of these requests. The appellant did not indicate what the objective of the amendments was nor how said changes responded to the objections raised in the Board's communication.

The (renumbered) auxiliary requests 2 and 3 are therefore to be regarded as not being substantiated.

2.2.2 According to Article 13(1) RPBA it is in the Board's discretion to admit and consider any amendment to a party's case after it has filed its grounds of appeal or reply. 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**.

- 2.2.3 It is exactly with a view to procedural economy that the Board has taken the trouble of giving a detailed preliminary opinion on novelty and inventive step, not only regarding the independent claims, but also the dependent claims and in particular those claims that are now the subject of the subsequently filed auxiliary requests 2 and 3.

Filing such requests without any substantiation, let alone any argumentation taking account of the Board's remarks, does not serve the purpose of procedural efficiency.

Already for these reasons alone the Board does not exercise its discretion in favour of the appellant; the (renumbered) auxiliary requests 2 and 3 are not admitted into the appeal proceedings in accordance with Article 13(1) RPBA.

- 2.3 The Board considers the non-admittance of the appellant's auxiliary requests 2 and 3 into the appeal proceedings not a harsh decision. It makes clear that also the parties have a duty to keep the proceedings efficient, be it *ex-parte* or *inter-partes* proceedings. In their dealings with the Boards of Appeal, the interested circles persistently request the Boards to issue preliminary opinions, in advance of the oral proceedings. If a Board complies with such a wish, like the present Board, it may expect an appropriate

reaction in return, timely submitted and substantiated in advance of the oral proceedings.

Filing such requests "just in time" before the ultimate date mentioned in the annex to the summons, but supplying the substantiation only at the oral proceedings is for this Board equivalent to filing such requests **at** the oral proceedings, and can be treated accordingly. The comparison with a game of cards, as used in point 2.1.3 above, also applies here.

2.4 The Boards also cannot follow the appellant's argument that it was its role to evaluate any reasonable request, whether or not it meets the requirements of the EPC. In the Board's judgment, for an auxiliary request to qualify as a "reasonable request" at this stage of the proceedings requires not only at least some substantiation and clear allowability, but should also comply with procedural efficiency. That is not the case here.

2.5 Finally, the Board wishes to point out that the provisional opinion of the Board in the annex to the summons is not necessarily a sufficient reason for having further requests admitted; the obligation to provide a complete case with the appeal or the reply to the appeal, established by Article 12(2) RPBA, still holds.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders