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**Datasheet for the decision
of 26 October 2016**

Case Number: T 2129/12 - 3.2.05

Application Number: 01125788.8

Publication Number: 1201414

IPC: B29D30/72, B29D30/50

Language of the proceedings: EN

Title of invention:

Method of manufacturing the sidewall of a pneumatic tire

Patent Proprietor:

Sumitomo Rubber Industries, Ltd.

Opponent:

Pirelli Tyre S.p.A.

Headword:

Relevant legal provisions:

EPC 1973 Art. 84, 111(1)
EPC Art. 123(2)
EPC R. 80
RPBA Art. 12(4), 13(1), 13(3)

Keyword:

Main request - submitted with the statement of grounds of appeal (admitted)

Amendments - added subject-matter - main request (yes) - auxiliary request (no)

Claims - clarity - auxiliary request (yes)

Amendment occasioned by ground for opposition - auxiliary request (yes)

Late-filed auxiliary request - amendments after arrangement of oral proceedings (admitted)

Remittal to the department of first instance (yes)

Decisions cited:

G 0010/91

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2129/12 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 26 October 2016

Appellant: Sumitomo Rubber Industries, Ltd.
(Patent Proprietor) 6-9, Wakinohama-cho 3-chome,
Chuo-ku, Kobe-shi
Hyogo-ken (JP)

Representative: Thomas Morgan
Manitz, Finsterwald & Partner GbR
Postfach 31 02 20
80102 München (DE)

Respondent: Pirelli Tyre S.p.A.
(Opponent) Viale Sarca, 222
20126 Milano (IT)

Representative: Claus Thomas Becher
Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 31 July 2012
revoking European patent No. 1201414 pursuant to
Articles 101(2) and (3)(b) EPC.**

Composition of the Board:

Chairman M. Poock
Members: P. Lanz
D. Rogers

Summary of Facts and Submissions

- I. The appeal by the patent proprietor is against the decision of the opposition division to revoke European patent EP-B-1 201 414 on the basis that its subject-matter extended beyond the content of the application as filed.
- II. During the opposition proceedings, the opponent raised the grounds for opposition according to Articles 100(a) (lack of novelty and lack of inventive step) and 100(c) EPC 1973.
- III. Oral proceedings were held before the board of appeal on 26 October 2016.
- IV. The final requests of the appellant were to set aside the decision under appeal and to maintain the patent upon the basis of the Main Request, filed under cover of a letter dated 3 December 2012, or upon the basis of Auxiliary Request IIa, filed under cover of a letter dated 12 October 2016.
- V. The final requests of the respondent (opponent) were to dismiss the appeal and, alternatively, to remit the case to the first instance for further prosecution if any of the appellant's claim requests were found to meet the requirements of Article 123(2) EPC. The respondent also requested that none of the appellant's Main and Auxiliary Requests be admitted into the proceedings.

VI. Independent claim 1 of the main request has the following wording:

"A method of manufacturing a pneumatic tire comprising a plurality of rubber components comprising the steps of:

preparing an unvulcanized rubber tape (T);

winding said unvulcanized rubber tape (T) so that the windings collectively have a predetermined cross sectional shape to make at least one of said plurality of unvulcanized rubber components;

assembling said unvulcanized rubber components to make a green tire;

vulcanizing said green tire, characterized in that two types of unvulcanized rubber tapes (T) which are one of the following combinations:

(1) an unvulcanized pure rubber tape and an unvulcanized rubber tape containing fiber;

(2) an unvulcanized pure rubber tape and an unvulcanized rubber tape containing cord;

(3) an unvulcanized rubber tape containing fiber and an unvulcanized rubber tape containing cord; and

(4) two types of unvulcanized rubber tapes containing fiber are prepared and used for winding said unvulcanized rubber components."

VII. Independent claim 1 of auxiliary request IIa reads as follows:

"A method of manufacturing a pneumatic tire comprising a plurality of rubber components comprising the steps of:

preparing an unvulcanized rubber tape (T);

winding said unvulcanized rubber tape (T) so that the windings collectively have a predetermined cross

sectional shape to make at least one of said plurality of unvulcanized rubber components;
assembling said unvulcanized rubber components to make a green tire;
vulcanizing said green tire, characterized in that two types of unvulcanized rubber tapes (T) are prepared and used for winding an unvulcanized sidewall rubber component, this means that either
(1) an unvulcanized pure rubber tape and an unvulcanized rubber tape containing short fibers, with said short fibers (F) being oriented towards the longitudinal direction of the tape (T); or
(2) an unvulcanized pure rubber tape and an unvulcanized rubber tape containing cord; or
(3) an unvulcanized rubber tape containing short fibers and an unvulcanized rubber tape containing cord, with said short fibers (F) being oriented towards the longitudinal direction of the tape (T); or
(4) two kinds of unvulcanized rubber tapes containing short fibers, wherein said two kinds of rubber tapes containing short fibers include a first kind of fiber containing rubber tape (Trf) comprising said short fibers that are highly oriented towards the longitudinal direction of the tape, and a second kind of fiber containing rubber tape (Trf) comprising said short fibers that are less oriented towards the longitudinal direction of the tape are prepared and used for winding said unvulcanized sidewall rubber component."

VIII. The appellant's submissions may be summarised as follows:

Main request - admissibility

The filing of amended claims as a new main request at the outset of the appeal proceedings should not be held inadmissible under Article 12(4) of the Rules of Procedure of the Boards of Appeal of the European Patent Office (RPBA). Due account had to be taken of the fact that the opposition division did not convey its preliminary opinion on the question of added subject-matter when issuing the summons to attend oral proceedings. It was only during the discussions at the oral proceedings that the opposition division communicated for the first time its view on this issue, however, without then permitting the appellant to file an auxiliary request in response. Hence, the submission of amended claims at the beginning of the appeal proceedings was not late but constituted an immediate reaction to the developments in the final phase of the opposition proceedings. It was thus to be admitted under Article 12(4) RPBA.

Main request - added subject-matter

The feature of the unvulcanised rubber tapes containing fibre had its basis in original claim 10 and on page 14, lines 9 to 11. Moreover, original page 17, lines 20 to 24 disclosed fibre containing rubber in general without any limitation regarding the length and orientation of the fibres.

Auxiliary request IIa

Auxiliary request IIa should be admitted into the proceedings since it was a timely filed and *bona fide* attempt to address the issues discussed in the board's communication. Moreover, the claims were in line with the requirements of Rule 80 EPC and of Articles 84 EPC 1973 and 123(2) EPC. The contested amendments were based on the original description, page 17, third paragraph as well as claims 8, 9 and 10. More particularly, the wording "*this means that*" in claim 1 did not raise any issue under Article 84 EPC 1973 because it clearly defined the four possible options falling under the claim. Also the reference to a "*sidewall rubber component*" was a restriction compared with the main request and not in conflict with the embodiments of Figures 7 and 8. Additionally, in the context of the patent in suit it was clear that the expressions "types" and "kinds" used for the unvulcanised rubber tapes were synonymous. For a skilled person the feature of the oriented short fibres being mixed into the rubber (and not embedded along the length of the tape) was implicitly present in claim 1 and, hence, not a problem under Article 123(2) EPC. By contrast, the exact fibre length was clearly presented as an optional feature and therefore did not need to be included in the wording of the claim. Finally, the deletion of dependent claim 2 was a necessary consequence of the restriction of independent claim 1 and therefore in line with Rule 80 EPC. In summary, auxiliary request IIa overcame all issues raised in the respondent's submissions and in the board's communication.

Remittal to the department of first instance

There were no objections against the respondent's request for a remittal of the case to the opposition division.

- IX. The respondent's submissions were essentially as follows:

Main request - admissibility

The deficiency of added subject-matter, which finally lead to the revocation of the patent, was not only clearly raised in the notice of opposition but also indicated in a bold and underlined passage of the opposition division's communication annexed to the summons for oral proceedings. Despite these hints and the detailed discussion of the contested feature during the oral proceedings, none of the auxiliary requests filed by the appellant before and during the oral proceedings addressed this issue and rectified the deficiency. The appellant was, hence, given several opportunities to amend its case but did not use them. Thus, the newly submitted claims should have been filed during the first instance proceedings. By presenting its full case only at appeal stage for tactical reasons, the appellant either deprived the respondent of the possibility to have all issues considered by two instances or compelled the board to remit the case to the opposition division which unduly prolonged the overall duration of the procedure. In view of the above, the filing of the present main request during the appeal proceedings could not be considered *bona fide*. Moreover, the newly filed claims constituted an amendment to the appellant's case as presented in the

previous proceedings and gave rise to further objections. They were thus not *prima facie* allowable. Finally, by basing its appeal solely on amended claims the appellant failed to explain why the decision under appeal was incorrect. Under these circumstances, the board should exercise its discretion to hold the claims of the main request inadmissible under Article 12(4) RPBA.

Main request - added subject-matter

Claim 1 of the main request went beyond the content of the application as originally filed. This was particularly true for the feature of the unvulcanised rubber tape containing fibres. In that respect, reference was made to Figure 6 and page 14, lines 7 to 11, which presented as a solution according to the invention the use of a fibre containing rubber tape, wherein the fibres were short and had a variable degree of orientation in order to improve the specific performance of the rubber compounds. The appellant, by failing to deal in present claim 1 with the interrelated aspects of the fibres being short and of their orientation, went beyond the disclosure of the invention in the application as filed. This general teaching was not altered by the fact that the paragraph on page 17, lines 20 to 24, which related to a specific embodiment of the sidewall, did not mention the fibre length and was not limited to fibres of variable orientation.

Auxiliary request IIa

Auxiliary request IIa was an amendment of the appellant's appeal case filed only two weeks before the oral proceedings. It was not indicated where the basis

for the amendments could be found and how the dependent claims fitted together with the modified independent claim. As to the substance, the meaning of the wording "*this means that either*" in claim 1 was not clear. Further issues of clarity arose from the list of alternatives (1) to (4), since the possibility of having a combination of two pure rubber tapes was missing, which caused an inconsistency with the description, cf. original application, last paragraph of page 20 and Figure 10. The general reference to a "*sidewall rubber component*" in claim 1 left open which of the various sidewall components shown in Figures 7 and 8 was manufactured. Additionally, in the context of the present case the terminology "*kinds of unvulcanised rubber tapes*" related to the chemical compositions of the rubber compounds (cf. original application, page 1, second paragraph, page 7, last paragraph, page 14, second paragraph). Consequently, amended claim 1 covered the possibility of combining tapes of the same or of different compounds which was contrary to the requirements of Article 123(2) EPC. The omission of the fibres being mixed (and not embedded along the length of the tape) and of their length (cf. original application, page 3, second paragraph, page 15, first paragraph) caused further deficiencies of added subject-matter. Finally, the deletion of dependent claim 2 was not occasioned by a ground for opposition and thus against Rule 80 EPC. In view of its late filing, insufficient justification and the various defects listed above, the claims of auxiliary request IIa had to be held inadmissible under Article 13(1) and (3) RPBA.

Remittal to the department of first instance

If the ground for opposition under Article 100(c) EPC 1973 were overcome, the case should be remitted to the opposition division for further prosecution.

Reasons for the Decision

1. Main request - admissibility

- 1.1 Together with the statement setting out the grounds of appeal, the appellant submitted an amended set of claims as new main request, the admission of which the respondent challenges with reference to Article 12(4) RPBA.
- 1.2 Under Article 12(4) RPBA, a board of appeal has the discretion to refuse the admission of requests which could have been presented (or were not admitted) in the first-instance proceedings. According to the case law of the boards of appeal, a claim request filed with the statement of grounds of appeal should normally not be considered inadmissible if it is an appropriate and immediate reaction to developments in the last phase of the previous proceedings.
- 1.3 From the course of the first-instance proceedings it is not apparent to the board that the appellant had an objective reason to file the claims of the present main request at an earlier stage. In this respect, the respondent makes reference to the opposition division's communication annexed to the summons to attend oral proceedings, in particular to the following paragraphs:

"2 The purpose of the oral proceedings is to clarify the validity of the claimed priorities of the patent in dispute and of document EP-A-1 211 057 (D9) and claimed in the proceeding and to clarify whether the subject-matter of claims 1 to 17 of the patent in dispute meets the requirements of "Amendments" (Articles 123(2) and 100(c) EPC), Novelty (Articles 54 and 100(a) EPC) and "Inventive step" (Articles 56 and 100(a) EPC) with regard to the prior art documents D1 to D12 cited by the Opponent in the notice of opposition dated 08.02.2010 (Fax received 08.02.2010).

2.1 Prior to discussing the issues of "Novelty" and "Inventive Step" the interpretation of the wording of claim 1 will be addressed in particular with regard to the feature "... two **types** of unvulcanized rubber **tapes** comprising a type of rubber tape **containing fiber** or a type of rubber tape **containing cord** are **prepared and used** for winding said unvulcanized rubber **components**" (original emphasis)

The cited passages generally indicate that the opposition division considered it appropriate to establish how the contested claim had to be interpreted before discussing the questions of novelty and inventive step. It does not, however, contain any preliminary conclusions regarding any of the grounds for opposition raised (including the question of added subject-matter). It is also observed that, after having received the above communication and before the oral proceedings, the appellant filed an auxiliary request as a possible fall-back position. Moreover, according to the minutes of the oral proceedings, it was only after having discussed the objection of added subject-matter for almost two hours and a subsequent deliberation of more than one hour that the opposition

division announced that the claims as granted extended beyond the application as originally filed. The appellant reacted by amending the auxiliary request on file, which was admitted by the opposition division, however, without thereby overcoming the deficiency established for the higher ranking request. The submission of a further auxiliary request at an advanced stage of the oral proceedings was not admitted by the division, so that the patent was finally revoked. Under these circumstances, the filing of the present main request at an early stage of the appeal proceedings can be considered a legitimate reaction to the developments in the last phase of the opposition proceedings and to the impugned decision. Moreover, it is not evident that the now submitted request was deliberately held back for tactical considerations. Finally, it is well established that it is the primary purpose of appeal proceedings to provide a judicial review of an administrative decision, however, without being strictly limited thereto (cf. G 10/91, OJ EPO 1993, 410, Reasons 18).

For these reasons, the main request is admitted into the proceedings.

2. *Main request - added subject-matter*

2.1 The parties are in dispute on whether or not a reference to short fibres with a variable degree of orientation is required in the feature of amended claim 1 relating to the unvulcanised rubber tape containing fibre.

2.2 The board observes that the only fibres disclosed in the patent application underlying the contested patent are short fibres (cf. page 3, lines 15 and 16 or page

14, second paragraph), the presence of which allows the degree of fibre orientation to be controlled by changing the thickness of the rubber tape (cf. Figure 6 and page 14, third paragraph), which, in turn, makes it possible to improve the specific performance of the tyre (cf. page 14, second paragraph). In view of that, a skilled person would directly and unambiguously realise that the short fibre feature forms a central and indispensable part of this embodiment of the invention. This understanding is not altered by the fact the length of the fibres is not explicitly mentioned in the penultimate paragraph of page 17.

Consequently, the reference in present claim 1 to fibres in general constitutes an unallowable generalisation of the original disclosure. Claim 1 according to the main request does thus not meet the requirements of Article 123(2) EPC.

3. *Auxiliary request IIa*

3.1 The appellant submitted an amended set of claims as auxiliary request IIa two weeks before the date of the oral proceedings before the board of appeal. The respondent considers the auxiliary request defective regarding the requirements of Rule 80 EPC and of Articles 84 EPC 1973 and 123(2) EPC. On that basis the admissibility of the request is contested with reference to Articles 13(1) and (3) RPBA.

3.2 According to Article 13(1) RPBA, any amendments 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 is 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.

Article 13(3) RPBA additionally requires that amendments sought to be made after oral proceedings have been arranged are not to be admitted if they raise issues the board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.

- 3.3 Auxiliary request IIa is based on the main request and comprises further modifications which relate to objections raised in the respondent's submissions against the main request. The amended features find their basis in the original description, page 17, third paragraph as well as claims 8, 9 and 10.

Regarding the alleged deficiencies put forward by the respondent against the claims of the newly filed auxiliary request IIa, it is noted that the terminology "*short fibre*" is commonly used in the field of fibre-reinforced polymers and has a particular meaning in this context. Therefore, the appellant is not required to explicitly include the specific lengths of the exemplary fibres contained in the description into the present claim wording in order to meet the requirements of Articles 84 EPC 1973 and 123(2) EPC. Similarly, the fact that the fibres in the (extruded) rubber tape are defined in claim 1 as being short and oriented implies for a skilled person in the context of the patent in suit that the fibres are mixed into the rubber.

Regarding the terminology "*two kinds of tapes*", it is observed that the terms "*types*" and "*kinds*" are synonymous in the general linguistic usage. Since the feature in question additionally defines the nature of

the two kinds of tapes (cf. alternative (4) in claim 1), the skilled reader's understanding of the wording "*two kinds of tapes*" in the framework of the contested patent does not cause a lack of clarity or an issue of added subject-matter. Moreover, the formulation "*this means that*" in claim 1 is used to define the four alternatives (1) to (4) covered by the claim. It does not introduce a problem under Article 84 EPC 1973 either.

The same is true for the restriction of the rubber component in the main request to "*sidewall rubber component*" in the auxiliary request, which is not in contradiction with the embodiments of Figures 7 and 8.

Finally, it is uncontested that the latest post-grant amendment of claim 1, which comprises the inclusion of the present alternatives (1) to (4) into the claim, is occasioned by a ground for opposition. The deletion of granted dependent claim 2 is a direct consequence of restricting the independent claim, which is, hence, equally in line with the requirements of Rule 80 EPC.

- 3.4 In view of the above, the board considers that the claims according to auxiliary request IIa meet the requirements of Rule 80 EPC and of Articles 84 EPC 1973 and 123(2) EPC. The amendments, although introduced at an advanced stage of the appeal proceedings, are not detrimental to procedural economy. They neither are overly complex nor did they raise issues which the board or the respondent could not reasonably be expected to deal with without adjournment of the oral proceedings. Therefore, the board considers the filing of auxiliary request IIa a reasonable attempt to address issues which arose in the course of the present appeal proceedings. Consequently, auxiliary request IIa

is admitted into the proceedings under Article 13(1) and (3) RPBA.

4. *Remittal to the department of first instance*

4.1 The respondent requests that the case be remitted to the opposition division for consideration of novelty and inventive step. The appellant does not object to this request.

4.2 Under Article 111(1) EPC 1973 the board of appeal may either decide on the appeal or remit the case to the department which was responsible for the decision appealed. The appropriateness of remittal to the department of first instance is decided by the board on the merits of the particular case. Even if there is no absolute right to have every issue decided upon by two instances, it is the primary function of an appeal to give the losing party the possibility of having the correctness of the first-instance decision judicially reviewed. Further criteria which can also be taken into account when deciding on a remittal include the parties' requests, the general interest that proceedings are brought to a close within an appropriate period of time and whether or not there has been a comprehensive assessment of the case during the first-instance proceedings.

4.3 In view of the fact that the opposition division only ruled on the question of added subject-matter and that it did not consider the further issues of novelty and inventive step, the board finds it appropriate to allow the respondent's uncontested request for a remittal of the case to the department of first instance.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated