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Datasheet for the decision of 19 October 2018

Case Number: T 0392/16 - 3.2.01

Application Number: 09170104.5

Publication Number: 2163403

IPC: B60C11/00, B60C11/12

Language of the proceedings: EN

Title of invention:
Pneumatic tire

Patent Proprietor:
The Goodyear Tire & Rubber Company

Opponent:
MICHELIN Recherche et Technique S.A.

Headword:

Relevant legal provisions:
EPC Art. 54
RPBA Art. 12(4)

Keyword:
Novelty - main request (yes)
Late-filed facts - admitted (no)

Decisions cited:
G 0009/91, J 0010/12

Catchword:

Europäisches Patentamt
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Beschwerdekammern

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Case Number: T 0392/16 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 19 October 2018

Appellant: (Opponent)	MICHELIN Recherche et Technique S.A. Route Louis Braille 10 1763 Granges-Paccot (CH)
Representative:	Diernaz, Christian Demaure, Yves-Pierre Manufacture Française des Pneumatiques Michelin CBS/CORP/J/PI - F35 - Ladoux 23, place des Carmes-Déchaux 63040 Clermont-Ferrand Cedex 9 (FR)
Respondent: (Patent Proprietor)	The Goodyear Tire & Rubber Company 1144 East Market Street Akron, OH 44316-0001 (US)
Representative:	Kutsch, Bernd Goodyear SA Patent Department Avenue Gordon Smith 7750 Colmar-Berg (LU)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 4 December 2015 rejecting the opposition filed against European patent No. 2163403 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	G. Pricolo
Members:	J. J. de Acha González
	S. Fernández de Córdoba

Summary of Facts and Submissions

I. The appeal of the opponent is directed against the decision of the Opposition Division to reject the opposition.

II. The Opposition Division held inter alia that the subject-matter of claim 1 of the patent as granted was new over US 6 408 911 B1 (**D1**) and involved an inventive step in view of the following combinations of prior art:

- EP 0 818 501 B1 (**D10**) with JP 2001 130 227 A (**D2**),
- EP 1 800 843 A2 (**D3**) with either FR 2 000 207 (**D4**), US 4 478 266 A (**D5**) or US 4 381 810 A1 (**D9**), and
- D10 with either EP 1 935 670 A2 (**D6**) or D3

With the statement of grounds of appeal the appellant filed an English translation of D2, referred to in the following as **D2T**.

III. Oral proceedings were held on 19 October 2018.

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

The respondent (patent proprietor) requested that the appeal be dismissed, as a main request, or, in the alternative, that the patent be maintained in amended form in accordance with one of the first to ninth auxiliary requests as filed with the reply dated 19 July 2016.

IV. Claim 1 of the patent as granted reads as follows:

"A pneumatic tire having a tire tread, the tread (12) comprising one or more circumferential grooves (27, 28, 31) and one or more ground engaging tread elements (20, 22);
the tread (12) having a radially outer surface and a non-skid tread depth as measured from the radially outer surface of the tread and a radially innermost surface of the grooves (27, 28, 31), and one or more grooves (30', 32') located radially inward and below the surface of the tread (12) when the tread (12) is unworn; wherein

(i) the one or more grooves (30', 32') are sunken grooves, or

(ii) the one or more grooves (30', 32') are grooves having a width larger than the width of a sipe (30, 32), wherein a sipe (30, 32) is positioned on the surface of the tread (12) when the tread (12) is unworn and said groove is located radially inward of said sipe (30, 32), said sipe (30, 32) fading into said groove with wear of the tread (12);

the tread (12) comprising a tread base layer (17) comprising a tread base compound, a radially outer tread cap layer (13) comprising a first tread cap compound, and a radially inner tread cap layer (15) comprising a second tread cap compound, **characterized in that**
the radially inner tread cap compound is below the surface of the tread (12) when the tread is unworn, and wherein the intersection of the radially outer tread cap layer (13) and the radially inner tread cap layer (15) is wavy."

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

Document D1 disclosed a tire according to granted claim 1. The subject-matter of claim 1 was thus not new. In particular, the embodiment according to figures 25 and 26 of D1 described a tread comprising a base layer, an outer cap layer and an inner cap layer as claimed. Cap layer 130 corresponded to the claimed outer cap layer and the base layer 126 to the claimed inner cap layer. Both layers of the tread were intended to be worn out like the two cap layers of the claimed tire. The terminology used in the patent and in D1 did not indeed correspond. However, it was not sufficient to only compare the terminology used, but one had to go further and consider the function associated with the terms. The fact that the layer 126 was denoted in D1 as a tread base layer did not necessarily mean that it corresponded to the tread base layer of the patent in suit. The base layer of the tread which supported the two cap layers of the tread was not represented in figure 26, but it was clear that the two cap layers 126 and 130 were supported by the structure of the tire. According to column 11, line 42 et seqq. this structure comprised at least a reinforcement ply, which is not intended to be worn in the tire's life. This reinforcement layer corresponded thus to the base layer of the contested patent.

The inventive step objections filed with the statement of grounds of appeal represented new combinations of documents which had been already filed with the notice of opposition. These new lines of attack amounted to a reaction to the Opposition Division's view during the oral proceedings that D1 did not disclose the three layered tread of claim 1 as granted. As a result, D1

and D4 were seen as relevant starting points for an inventive step analysis. Further, the appeal proceedings was not limited to review the contested decision but its purpose was as well to avail the appellant the possibility to present further objections. The evidence on which the new objections were raised was filed at the earliest stage of the opposition proceedings and the documents were extensively discussed before the Opposition Division. The respondent should not be taken by surprise and should be in a position to refute these new objections.

VI. The counter arguments of the respondent may be summarised as follows:

The subject-matter of claim 1 as granted was new with regard to the tire disclosed in D1. D1 did not at least disclose the claimed three layered structure of the tread. The skilled person in the field of tires knew perfectly the difference between the tread and the carcass of a tire and these two terms referred to different parts of the tire (see e.g. D1 column 20, lines 46-63, column 21, lines 41-43; D2T paragraphs [0073] and [0089]). The terminology was unambiguous as confirmed by the Opposition Division in its decision. According to claim 1 as granted the tread was made of at least three layers; one base layer, a radially inner cap layer and a radially outer cap layer. In the embodiment of figures 25 and 26 of D1 the tread had a cap/base structure comprising only two layers, a tread cap layer 130 and a tread base layer 126 (D1 column 21, lines 41-43). These layers constituted the tread and were disclosed as not being part of the carcass, i.e. the belt ply (D1 column 20, lines 46-63).

The Board should exercise its discretion pursuant to Article 12(4) of the Rules of Procedure of the Boards of Appeal (see Official Journal EPO 2007, 536) and not admit the new lines of attack filed for the first time with the statement of grounds of appeal because the opponent should have put them forward already during the opposition procedure. These new lines of attack constituted new factual reasons together with related arguments, which were based on evidence already on file.

The refutative arguments according to which D1 did not disclose a three layered tread were already present in the reply to the notice of opposition. The subject of the proceedings did not change in the course of the opposition procedure, such that these new lines of attack should have been presented earlier. The new alleged facts were therefore surprising because they had never been defended before. Furthermore, either D1 or D4 were never considered by the appellant during the opposition proceedings as representing suitable starting points for raising an inventive step objection.

These fresh objections ran counter to the purpose of the appeal proceedings which was mainly to revise the contested decision on its merits. The approach of the opponent as regards the question of inventive step was not to use the appeal proceedings to revise the decision of the Opposition Division, but to submit entirely new attacks in the form of new combinations of documents that the Opposition Division did neither consider nor examine.

Reasons for the Decision

1. Main request - Patent as granted - Novelty over D1

1.1 The subject-matter of claim 1 as granted is new in view of D1 (Article 54 EPC).

1.2 D1 does not at least disclose a tread layer comprising a radially inner tread cap layer with a second tread cap compound wherein the intersection of the radially outer tread cap layer and the radially inner tread cap layer is wavy. The tread of the studless pneumatic tires disclosed in D1 employs a single layer (see column 30, lines 34, 38; column 31, lines 6, 9) or at least two rubber layers (column 3, line 51 to column 4, line 6; column 21, lines 41 to 45; figures 25-26, 54-55 and 59-60), which consist of a cap rubber layer and a base rubber layer. Further in the first lines of column 4, and according to claim 1 the tread has at least two rubber layers. Thus there is no explicit disclosure of a tread comprising a tread base layer, a radially outer tread cap layer and a radially inner tread layer.

1.3 The appellant identified the cap layer 130 and the base layer 126 of figures 25 and 26 of D1 as the radially outer tread cap layer and the radially inner tread cap layer of granted claim 1. The tread base layer claimed - not represented in the figures - would be the outermost ply of the carcass, on which lies the base layer 126 of the tread (column 11, lines 42 to 50; column 20, lines 46 to 63).
To back its argument the appellant considered that it was not sufficient to compare the terminology used in D1 with the one used in the patent specification, but one had to go further and consider the function

associated with the terms. Accordingly, the function of the base layer in D1 clearly corresponded to the function of the radially inner tread cap layer because this layer was meant to be worn during usage of the tire. Further, the function of the base layer of the tread was not explained in the patent in suit so that the outer ply of the carcass supporting the tread could be seen as the tread base layer.

1.4 The Board is not persuaded. The skilled person of tires understands without any ambiguity the significance of the terminology used. A base layer of a tread is a base layer and not a cap layer, and it belongs to the tread part of the tire and not to the carcass (see e.g. D1 column 11, lines 42 ff., column 20, lines 46-63, column 21, lines 41-43; D4 page 3, l.20-23; D2T paragraphs [0073] and [0089]; D3 paragraph [0028]; D9, column 1, lines 13-19; paragraph [0019] of the contested patent). The skilled person knows that the carcass of the tire supports its tread. However, the outer layer of the carcass does not belong to the tread and therefore cannot be seen as the tread base layer on which all other layers of the tread are mounted. This would result in an inconsistent terminology used in the field of tires.

2. Admissibility of new objections on inventive step

2.1 During the opposition proceedings the appellant put forward the following inventive step objections to the subject-matter of claim 1 as granted:

- D3 in combination with D4;
- D3 in combination with D5;
- D3 in combination with D9;
- D10 in combination with D6;

- D10 in combination with D3; and
- D10 in combination with D2.

With the statement of grounds of appeal the appellant objected on inventive step only with the following combinations of prior art:

(i) D1 in combination with D4;
(ii) D1 in combination with D2;
(iii) D1 in combination with D4 and D2; and
(iv) D4 in combination with D6.

These objections are based on documents submitted with the notice of opposition. However, their specific combinations were never subject of the opposition proceedings. These objections amount thus to new alleged facts by the appellant (opponent) presented for the first time in the appeal proceedings.

2.2 According to Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA) the Board has the power to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings. The admission of this new factual framework is thus subject to the Board's discretion.

2.3 The appellant justified the submission of the new objections as a reaction to the Opposition Division's view during the oral proceedings that D1 did not disclose the three layered tread of claim 1 as granted. As a result of that assessment D1 and D4 gained relevance so as to be considered the closest prior art for an inventive step reasoning. The appellant also expressed the view that the appeal proceedings was not limited to review the contested decision but its

purpose was also to avail the appellant the possibility to present further objections. The evidence on which the new objections were raised was filed at the earliest stage of the opposition proceedings and had been extensively discussed. The respondent should not be taken by surprise and should be in a position to refute these new lines of attack.

2.4 The Board however could not see any reason in the whole procedure that would justify raising these lines of attack at such a late stage.
The patent was maintained as granted, the evidence was known to the opponent and the conflicting issues for novelty and inventive step had been addressed during the opposition procedure by the parties (see notice of opposition and proprietor's reply from 9 September 2013). In dispute was among others whether D1 disclosed the claimed three layered structure of the tread. The appellant should have considered that the proprietor's view could be shared by the Opposition Division, and should have accordingly formulated all, in its view, relevant objections on inventive step based on the evidence it had submitted. This is analogous to the patent proprietor's situation in which the patent proprietor has to deal with objections raised by the opponent in its notice of opposition which might succeed or not, and files auxiliary requests as fall back positions. Thus, the possibility of using D1 and D4 as suitable closest prior art for the formulation of inventive step attacks could have been identified in response to the arguments submitted by the patent proprietor, and could well have been filed e.g. in advance of the oral proceedings before the Opposition Division.
It is also noted that the primary purpose of the appeal proceedings is the judicial review of the contested

decision and not the continuation of the opposition procedure to allow the appellant to conduct its case anew (see e.g. G9/91, point 18; J10/12, point 15).

Under these circumstances the Board decided to exercise its discretion pursuant to Article 12(4) RPBA not to admit the new lines of attack on inventive step put forward for the first time in the statement of grounds of appeal because they amount to new alleged facts that the appellant should have presented during opposition proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

A. Vottner G. Pricolo

Decision electronically authenticated