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**Datasheet for the decision
of 29 January 2020**

Case Number: T 0101/17 - 3.2.04

Application Number: 10171437.6

Publication Number: 2255713

IPC: A47L13/20, A47L13/16, A47L13/24

Language of the proceedings: EN

Title of invention:
Cleaning element and cleaning tool

Patent Proprietor:
Unicharm Corporation

Opponent:
Carl Freudenberg KG

Headword:

Relevant legal provisions:
EPC Art. 54, 104(1)
RPBA Art. 12(4)

Keyword:
Novelty - (yes)
Apportionment of costs - (no)

Decisions cited:

T 0162/09, T 1848/12

Catchword:

Reasons 4 and 5



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Case Number: T 0101/17 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 29 January 2020

Appellant: Unicharm Corporation
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 November
2016 revoking European patent No. 2255713
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman A. de Vries
Members: J. Wright
C. Heath

Summary of Facts and Submissions

I. The appeal was filed by the appellant (patent proprietor) against the decision of the opposition division to revoke the patent in suit (hereinafter "the patent").

During the opposition proceedings, the opponent had raised the grounds for opposition under Article 100(a) EPC for lack of novelty.

II. The opposition division decided that the subject-matter of claim 1 as granted was not novel, so revoked the patent.

III. Oral proceedings were held before the Board on 29 January 2020.

IV. The appellant-proprietor requests that the decision under appeal be set aside and that the patent be maintained as granted (Main Request), or on the basis of one of Auxiliary Requests 1 - 5, filed with the grounds of appeal, or on the basis of Auxiliary Requests 1A, 1B, 1C or 1D all filed with letter dated 19 December 2019, further, remittal to the first instance should any of the requests be found novel and not to contain added subject matter.

The respondent requests dismissal of the appeal and apportionment of costs.

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

"A cleaning element (110), comprising:
a fiber assembly (111b) comprising a plurality of fibers extending in a predetermined direction,

a sheet-type nonwoven fabric (111a, 112) disposed on the fiber assembly,
a first fusion bonded part (113) extending in a direction crossing said predetermined direction to fusion bond the fiber assembly (111b) and the nonwoven fabric (111a, 112), and
a plurality of second fusion bonded parts (114, 116) formed discontinuously in a direction crossing said predetermined direction, the second fusion bonded parts (114, 116) respectively fusion bonding the fiber assembly (111b) and the nonwoven fabric (111a, 112) characterized in that,
the fiber assembly includes (111b) a first fiber extending part (118a) and a second fiber extending part (118b), the first fiber extending part (118a) having fibers which extend from one end at the first fusion bonded part (113) to the other free end on an end of the cleaning element (110) in said predetermined direction, and the second fiber extending part (118b) having fibers which extend from one end at the second fusion bonded parts (114, 116) to the other free end on the end of the cleaning element (110) in said predetermined direction and the second fusion bonded parts (114, 116) have a fiber extending length (d4) shorter than a fiber extending length (d5) of the first fiber extending part".

VI. In the present decision, reference is made to the following document:

D3 : US7243391 B2

VII. The appellant-proprietor's arguments can be summarised as follows:

The subject matter of claim 1 is new with respect to D3.

The auxiliary requests should be admitted into the proceedings.

It is fair that the respondent-opponent should bear its own costs.

VIII. The respondent-opponent's arguments can be summarised as follows:

The arrangement shown in D3, figure 6, takes away novelty of claim 1 of the main request.

None of the auxiliary requests should be admitted into the proceedings.

For reasons of equity, the Board should order a different apportionment of costs against the appellant-opponent.

Reasons for the Decision

1. The appeal is admissible.
2. Background

The invention relates to cleaning tool having a sheet type cleaning element (see published patent specification, paragraph [0001]). The cleaning element according to the invention includes a fibre assembly, a non-woven [sheet] fabric, a first fusion bonding part and a plurality of second fusion bonded parts (see published patent specification, paragraph [0006]).

3. Main request, claim 1, novelty with respect to D3

3.1 D3 (see abstract, column 9 line 18 to column 10, line 26 and figure 6) discloses a cleaning element. The cleaning element comprises a fibre assembly (fibre bundle layers 3, 4 and 6) comprising a plurality of fibres extending in a predetermined direction (see double headed arrow MD in figure 6 with column 4, lines 36 to 46). A sheet-type non-woven fabric 5 (having strips 17) is disposed on the fibre assembly.

It is not disputed that D3 discloses a first fusion bonded part (see column 9, lines 39 to 41 with column 7, lines 34 to 37 - the all-layer bonding line 7). This first bonded part extends in a direction crossing said predetermined direction (MD) to fusion bond the fibre assembly and the non-woven fabric.

It is likewise not contested that D3 discloses a plurality of second fusion bonded parts (see column 9, lines 44 to 52 and sentence bridging columns 6 and 7 - joining portions 18) formed in a direction crossing the predetermined direction. These second fusion bonded parts fusion bond the fibre assembly 6 and the non-woven fabric 5.

3.2 Contrary to how the appellant-opponent has argued, the Board is of the opinion that these second fusion bonds (18) are formed discontinuously as the claim requires.

Figure 6 shows that on each side of the central bonding line 7, two of the strips 17 have linear bonds 18. The strips either side of these have no such lines 18 so these are not bonded. Therefore, the second fusion bonds 18 are formed discontinuously. This also follows from comparison of the portions 18 to the all-layer

bonding line 7 in figure 6, which is shown as continuing the entire length of layers shown whereas the joining portions 18 clearly do not. This corresponds to the situation shown in figure 4 of the patent : central bond 113 extends the entire length of the sheets, whereas bonded parts 114 do not.

- 3.3 The Board also considers that D3 discloses first and second fibre extending parts as claimed.
- 3.3.1 Claim 1 defines the first and second fibre extending parts to be portions having fibres extending between the first and second fusion bonding parts respectively and free ends on the end of the cleaning element. The arrangement of figure 6 likewise has such extending parts.
- 3.3.2 The fibre layer 6 is joined at the all layer joining line 7. Some of these fibres (namely those under strips 17 which have no bonding line 18, for example the front most strip in figure 6) extend as free fibres to the end side of the cleaning element. In the Board's view, such fibres are part of the first fibre extending part as claimed.
- 3.3.3 The strips 17 that have a bonding line 18 overlie fibres that extend from the bonding lines 18 to the end of the cleaning element. These fibres are thus second fibre extending parts in accordance with the claim.
- 3.3.4 Moreover, the fibre extending length of the second fibre extending parts, which start at the bond line 18 mid-way along the strips 17, is shorter than the fibre extending lengths of the first fibre extending parts, because the latter start right in the centre of the cleaning element at the bond line 7.

- 3.3.5 With respect to these features, the appellant-proprietor has argued that, because all fibres of the layer 6 run between the all-layer bonding line 7 and the end of the cleaning element, whether or not they pass through a bonding line 18, all fibres have the same length, so D3 does not disclose the claimed ratio of fibre extending length portions. The Board disagrees.
- 3.3.6 The fibre extending lengths can but be the same as the lengths of the respective fibre extending parts themselves. Therefore, how far a given fibre might continue beyond a fibre extending part is irrelevant. As is manifestly clear from figure 6, second fibre bonding parts that start at a bond line 18 are shorter than the first fibre bonding parts that start at the bonding line 7 and continue without interruption to the end of the cleaning element.
- 3.3.7 Lastly, the Board considers that D3 (as shown in figure 6) discloses all the fibre extending parts to have a free end on the end of the cleaning element as claimed. Figure 6 shows the free ends of the fibre layer 6 to be aligned with the ends of the strips 17 of the non-woven sheet 5. In other words, both form the free end of the cleaning element and all the fibres end at the end of the cleaning element.
- 3.3.8 In this respect, the appellant-proprietor has cited column 10, lines 6 to 15 and argued that the fibres do not extend to the end of the cleaning element because the layer 5 with strips 17 extends further. The Board disagrees.

In the Board's view, the passage does not explain that the strips should extend beyond the fibre layers, in other words where they should end. Rather, it defines where the strips should start in terms of preferable starting points for the cut lines 16 that separate the strips. In any case, at most these are only preferable alternatives to what is actually shown in figure 6 (where all fibres and strips extend to the end of the cleaning element).

3.4 For all these reasons, D3 discloses all the features of claim 1.

3.5 The Board concludes that the subject matter of claim 1 of the main request lacks novelty. Therefore the main request must fail.

4. Admissibility of the auxiliary requests

4.1 The appellant-proprietor has filed a total of nine auxiliary requests whose admissibility is contested by the respondent. Although Auxiliary Requests 1 - 5 were filed with the grounds of appeal and thus at the earliest stage of the appeal proceedings, the respondent argued that all requests could and should have been filed at the stage of opposition and their admissibility should therefore be refused under Art. 12(4) RPBA 2007 (reworded as Art. 12(6) second alternative RPBA 2020). Art. 12(4) RPBA 2007 expresses and codifies the principle that each party should submit all facts, evidence, arguments and requests that appear relevant as early as possible so as ensure a fair, speedy and efficient procedure (e.g. decision **T 162/09** of 12 September 2012, point 7 of the reasons).

4.2 The Board acknowledges that in almost any circumstances, a request could have been presented earlier, and the correct question to ask should thus be whether a request not only could, but should have been presented earlier, as was held in decision **T 1848/12** of 16 December 2016:

"1.2.2 The board considers that appeal proceedings, which are largely determined by the factual and legal scope of the preceding proceedings, are not about bringing an entirely fresh case to the board. This means that an appellant is not at liberty to bring about the shifting of its case to the appeal proceedings as it pleases, and so compel the board either to give a first ruling on the critical issues or to remit the case to the opposition division. Conceding such freedom to an appellant would run counter to orderly and efficient opposition-appeal proceedings. In effect, it would allow a kind of "forum shopping" which would jeopardise the proper distribution of functions between the departments of first instance and the boards of appeal and would be unacceptable for procedural economy generally (G 9/91, OJ EPO 1993, 408, Reasons 6; T 1705/07 of 10 June 2010, not published in OJ EPO, Reasons 8.4; T 1067/08 of 10 February 2011, not published in OJ EPO, Reasons 7.1 to 7.2).

1.2.3 This is reflected in Article 12(4) RPBA, which states that:

"Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2)" (emphasis added by the board).

1.2.4 The present board realises that everything "could" have been presented earlier and therefore applies the more lenient "should have been presented".

4.3 In light of the foregoing approach that the Board endorses, it might be a convenient moment to take a look at the course of opposition proceedings in this case.

Already the notice of opposition alleged a lack of novelty of the patent as granted over document D3. In its annex to the summons to oral proceedings, the opposition took the provisional view that "the subject matter of independent claim 1 of the patent-in-suit lacks novelty also over D3", amongst other documents that it also saw as novelty destroying. The decision under appeal confirmed the finding that "the subject matter of claim 1 is not novel over D3". When the opposition division came to this conclusion during oral proceedings, the protocol notes that "the chairman gave the opportunity to the patent proprietor to file further requests. The patent proprietor confirmed that it did not wish to file any further request." It was only at the stage of appeal that the appellant-proprietor decided to file requests meant to overcome a potential lack of novelty of the patent as granted, and requested that, should the Board find any of these requests novel and compliant with Art. 123(2) EPC, it remit the case to the department of first instance for further examination of inventive step issues.

4.4 The earliest opportunity for the appellant-proprietor to submit an auxiliary request to remedy a potential lack of novelty would have been in response to the opposition, then again in response to the summons to oral proceedings (that were issued more than half a

year prior to oral proceedings), and finally during oral proceedings. The appellant-proprietor has taken none of these opportunities and rather decided to create a fallback position only in the subsequent tier of proceedings, namely on appeal, with the express request to remit the case should the Board find any of the newly filed requests novel.

4.5 In the case at issue, the Board notes that the objection of lack of novelty over document D3 had been in the procedure already since the filing of the opposition, and had been addressed by the opposition division in its preliminary opinion just as in its decision in no uncertain terms. And just as the framework of facts and arguments of the novelty objection has remained unchanged throughout the opposition proceedings, the appellant-proprietor has been equally consistent in restricting its case to defending the patent as granted without providing any fallback positions by filing auxiliary requests. A patentee is perfectly entitled to do so where it relies solely on the view that the opponent has not proven its case. However, if the circumstances are unchanged and the patentee only in the appeal phase changes track and files auxiliary requests that are meant to address what it deliberately chose not to address in first instance, then by so doing it effectively forces the Board to either decide for the first time what should have been decided in first instance, or to delay proceedings by a remittal that could very well have been avoided by a timely filing of auxiliary requests.

4.6 While it can be left open at which occasion it would have been incumbent to file an auxiliary request meant to address the novelty objection (in response to the opposition, in response to the preliminary opinion of

the opposition division or when invited to do so a the oral hearing), the appellant-proprietor took none of these opportunities and for reasons of equity in appeal is restricted to defending the patent in unamended form. In this regard, no decision is required regarding the respondent's further arguments that the auxiliary requests are not convergent and ill-reasoned.

4.7 For the above reasons, the Board decided not to admit any of the auxiliary requests filed in appeal.

5. Apportionment of costs

5.1 Art. 104 (1) EPC which also applies to subsequent proceedings in appeal makes it a principle that "each party to the opposition proceedings shall bear the costs it has incurred". The respondent has however requested a different apportionment of costs for the reason that the filing of auxiliary requests on the stage of appeal amounted to an abuse of procedure.

5.2 The respondent submitted that although the auxiliary requests were found inadmissible, it had nonetheless been necessary to prepare for the scenario that they would be admitted and to subsequently address them content-wise. This took the representative a total of 35 hours. Such time and expense could have been avoided had the appellant-proprietor refrained from filing these requests and restricted its case to a defence of the claims as granted (as would have been the proper thing to do in the circumstances).

5.3 The Board sees no reason for calling the factual basis of these submissions into question. However, it appears that even in such circumstances, case law of the Boards of Appeal does not support a different apportionment of

costs, see the above cited decision **T 1848/12**, point 2 of the reasons:

"2. Apportionment of costs

2.1 Appellant I requests apportionment of costs for the fact that it had to review and consider documents D15 to D28, irrespective of their (non-)admission into the present proceedings. It considers that these documents should have been filed in due time during the opposition proceedings.

2.2 The board cannot grant this request. Preparations for discussing the admission of late-filed documents into the proceedings during the opposition-appeal proceedings and, if they are admitted, preparations for discussing their relevance in respect of the patentability of the claimed subject-matter are part of the normal work that can be expected of any party to the proceedings and/or its representative in opposition-appeal proceedings.

2.3 Therefore, appellant I's request for apportionment of costs is refused (Article 104(1) EPC)."

- 5.4 The Board concurs with this approach as an application of the above-mentioned principle that each party bears its own costs. The Board further observes that in order to establish any causal link between the respondent's expenses and the appellant-proprietor's behaviour, the respondent would have to show that it was particularly the *belated* filing of requests that caused the expense rather than the filing of requests as such. As it was the appellant's argument that the filing of the auxiliary requests in appeal (rather than at the stage of opposition) was abusive and improper, a comparison between timely and belated filing of the requests would be necessary in order to establish causality of damage in the form of attorney's fees.

- 5.5 However the Board fails to see what additional expenses the respondent had incurred by preparing for a discussion of these requests at the stage of appeal rather than at the stage of opposition, other than for the additional discussion on the admissibility of these requests (which might have been unnecessary had they been filed in a timely manner). As a discussion on the admissibility of requests is a not uncommon occurrence in proceedings in general, this can hardly be credited with separately identifiable expenses. It is at least at this hurdle that the respondent's case fails and the request for a different apportionment of costs has to be refused.
6. The appellant-proprietor's main request is not allowable and its remaining requests have not been admitted into the proceedings. Therefore, the Board must dismiss the appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated