

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [X] To Chairmen
- (D) [-] No distribution

**Datasheet for the decision
of 16 September 2022**

Case Number: T 0574/17 - 3.2.03

Application Number: 05716494.9

Publication Number: 1743076

IPC: E04B1/86, E04B9/04, E04B9/28,
E04B9/00, D04H1/74

Language of the proceedings: EN

Title of invention:
Acoustic elements and their production

Patent Proprietor:
Rockwool International A/S

Opponent:
SAINT-GOBAIN ISOVER

Headword:

Relevant legal provisions:
EPC Art. 54(2), 84, 100(c)
RPBA Art. 12(4)
RPBA 2020 Art. 13(1), 13(2)

Keyword:

Novelty - (no) - public prior use (yes)
Claims - clarity after amendment (yes)
Grounds for opposition - extension of subject-matter (no)
Late-filed evidence - submitted with the statement of grounds
of appeal - admitted (no)
Amendment to appeal case - exercise of discretion
Amendment after summons - exceptional circumstances (no) -
taken into account (no)

Decisions cited:

T 0055/01, T 0172/17, T 2787/17, T 1767/18, T 0882/17,
T 2117/18, J 0014/19, G 0010/91, G 0004/19

Catchword:

If there is an amendment to the patent in the appeal proceedings which has never been examined before, the Enlarged Board's *obiter dictum* in G 10/91, Reasons 19, is fully respected when only the *prima facie* relevance of an objection under Article 123(2) EPC is considered in the context of assessing whether there are exceptional circumstances under Article 13(2) RPBA 2020 (Reasons 2.3.1-2.3.14).



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0574/17 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 16 September 2022

Appellant: SAINT-GOBAIN ISOVER
(Opponent) 18, avenue d'Alsace
92400 Courbevoie (FR)

Representative: Saint-Gobain Recherche
Département Propriété Industrielle
39 Quai Lucien Lefranc
93300 Aubervilliers (FR)

Respondent: Rockwool International A/S
(Patent Proprietor) Hovedgaden 584
2640 Hedehusene (DK)

Representative: Gill Jennings & Every LLP
The Broadgate Tower
20 Primrose Street
London EC2A 2ES (GB)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 2 January 2017
rejecting the opposition filed against European
patent No. 1743076 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman C. Herberhold
Members: R. Baltanás y Jorge
N. Obrovski
B. Goers
D. Prietzel-Funk

Summary of Facts and Submissions

- I. European patent No. 1 743 076 B1 relates to acoustic elements and their production.
- II. An opposition was filed against the patent, based on Article 100(b), 100(c) and 100(a) EPC together with Articles 54 and 56 EPC.
- III. The appeal lies from the Opposition Division's decision to reject the opposition.

The opponent (hereinafter: the "appellant") filed an appeal against the above-mentioned decision of the Opposition Division.

In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) 2020, the Board indicated its preliminary opinion on the case.

Oral proceedings were held by videoconference (Zoom) on 16 September 2022. The appellant withdrew the ground for opposition based on Article 100(b) EPC during the oral proceedings.

- IV. Requests

At the end of the oral proceedings before the Board, the parties' requests were as follows.

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed and the patent be maintained as granted (main request) or, as an alternative, that the patent be maintained as amended on the basis of auxiliary request 14, filed with the reply to the statement of grounds of appeal. Due to a re-ordering of the claim requests by the respondent, the further auxiliary requests are irrelevant for the present decision.

V. Claim 1 as granted, including the numbering of its features as adopted by the parties, reads as follows (the features objected to for addition of subject-matter have been marked in bold):

- A** *An acoustic element (1) having*
- B** *a flat, sound-receiving, front face (2) which extends in the XY plane and*
- C** *a rear face (3) substantially parallel to the front face, and side edges (4) which extend in the Z direction, the Z direction being the direction between the front face and rear face, and*
- D** *wherein the bonded batt has a density of 70 to 200 kg/m³,*
- E** *characterised in that the element consists predominantly of a bonded batt of airlaid mineral fibres;*
- F** *the fibres which form the front face (2) and at least the front half of the thickness of the batt extend from the front face and have a Z direction component substantially greater than the Z direction component of fibres in airlaid products made by collecting fibres entrained in air by suction through a travelling collector and vertically compressing the collected fibres,*

optionally after cross-lapping the collected fibres;

- G** *the front face (2) of the bonded batt is a cut and abraded face; and*
- H** ***the element has a sound absorption coefficient α_w of at least 0.7.***

VI. Claim 12 as granted reads as follows:

A method of making acoustic elements according to claim 1 comprising collecting mineral fibres and binder entrained in air on a travelling collector (10) and vertically compressing (16, 16) the collected fibres, optionally after cross-lapping (13), to form a web (15''), reorienting the fibres to provide an unbonded batt having a density of 70 to 200 kg/m³, preferably 70 to 140kg/m³, and an increased fibre orientation in the Z direction, curing the binder to form a cured batt, cutting the cured batt in the XY plane into two cut batts (27) at a position in the Z dimension where the fibres have the increased orientation in the Z direction, and smoothing each cut surface by abrasion to produce a flat face (2).

VII. Claim 1 of auxiliary request 14 is based on claim 12 as granted and reads as follows (amendments marked in bold):

*A method of making acoustic elements—~~according to claim 1~~, **each acoustic element having a flat, sound-receiving, front face (2) which extends in***

the XY plane and a rear face (3) substantially parallel to the front face, and side edges (4) which extend in the Z direction, the Z direction being the direction between the front face and rear face,

and wherein the bonded batt has a density of 70 to 200 kg/m³,

wherein the element consists predominantly of a bonded batt of airlaid mineral fibres;

the fibres which form the front face (2) and at least the front half of the thickness of the batt extend from the front face and have a Z direction component substantially greater than the Z direction component of fibres in airlaid products made by collecting fibres entrained in air by suction through a travelling collector and vertically compressing the collected fibres, optionally after cross-lapping the collected fibres;

the front face (2) of the bonded batt is a cut and abraded face;

and the element has a sound absorption coefficient α_w of at least 0.7,

the method comprising collecting mineral fibres and binder entrained in air on a travelling collector (10) and vertically compressing (16, 16) the collected fibres, optionally after cross-lapping (13), to form a web (15''),

reorienting the fibres to provide an unbonded batt having a density of 70 to 200 kg/m³, preferably 70 to 140 kg/m³, and an increased fibre orientation in the Z direction,

curing the binder to form a cured batt,

cutting the cured batt in the XY plane into two cut batts (27) at a position in the Z dimension where

the fibres have the increased orientation in the Z direction,
and *smoothing each cut surface by abrasion to produce a flat face (2);*
and bonding a facing tissue on the flat face (2).

VIII. Claim 1 as originally filed, with its features numbered analogously to the main request, reads as follows:

- A** *An acoustic element (1) having*
- B** *a flat, sound-receiving, front face (2) which extends in the XY plane and*
- H'** *which has a sound absorption coefficient α_w of at least 0.7,*
- C'** *a rear face (3) substantially parallel to the front face, and side edges (4) which extend in the Z direction between the front face and rear faces,*
- E'** *and in which the element consist predominantly of a bonded batt of airlaid mineral fibres, characterised in that*
- D'** *the bonded batt has a density of 70 to 200 kg/m³,*
- F'** *the fibres extending from the front face (2) and at least through the front half of the thickness of the batt have a Z direction component substantially greater than the Z direction component of fibres in airlaid products made by collecting fibres entrained in air by suction through a travelling collector and vertically compressing the collected fibres, optionally after cross-lapping the collected fibres,*
- G'** *and the front face (2) of the bonded batt is a cut and abraded face.*

IX. State of the art

(a) Documents

The following documents were cited, both in the grounds of appeal and during the opposition proceedings, and are relevant for this decision:

- A6: "TABLEAU SYNTHETIQUE Ligne 2 - ANNEE 1995-1997"
- A7: Product specification " TONGA", Eurocoustic Saint-Gobain, 16 December 1996
- A8: Commercial brochure Eurocoustic "Quartette", dated "Octobre 1995"
- A9: Invoice dated 29 September 2003
- A10: Invoice dated 15 June 2004
- A11: Invoice dated 3 November 2003
- A12: Invoice dated 17 September 2004
- A13: CSTB test report No. 28474 dated 14 November 1989; Tests No. 1, 2 and 3
- A14: Commercial brochure Eurocoustic "Tonga Blanc, Les Classiques", dated "Novembre 05"
- A15: Basic product specifications dated 10 October 2000
- A16: Commercial brochure Eurocoustic "ACOUSTICAL COMFORT, AESTHETIC CHOICE", dated "Novembre 1999"
- A17: Commercial Eurocoustic brochure "Acoustic Comfort, Esthetic Choice 2003" for Tonga (A17a) and Quartette (A17b), dated "Avril 2003"
- A18: CSTB test report No. 713-950-0028 dated 7 August 1995; Tests No. 1, 2 and 3
- A19: "RELEVÉ DES PRIX DE VENTE INDUSTRIELS", valid for 1995

- A20: "Observations des Prix de Vente de l'Industrie et des Services aux entreprises", survey to be returned on 11 June 2001
- A21: Declaration by Mr Jean-Michel Bourgoïn, employee of Saint-Gobain Eurocoustic
- A22: Declaration of Mr Maurin, employee of Saint-Gobain Eurocoustic, dated 8 January 2015
- A23: Declaration of Mr Audis (ACMB), who is alleged to be a recipient of the invoice A9
- A24: Declaration of Mr Dewarlez, who is alleged to be a recipient of the invoice A12
- A25: Declaration of Mr Esposito, who is alleged to be a recipient of the invoice A11
- A26: Declaration of Mr Laffond, who is alleged to be a recipient of the invoices A28, A29 and A30
- A27: Invoice dated 5 July 1999
- A28: Invoice dated 1 April 2003
- A29: Invoice dated 17 July 2003
- A30: Invoice dated 16 December 2003

The appellant filed a further document with the statement setting out the grounds of appeal. The appellant used the reference A32 for it, but this was already assigned to a document filed during the opposition proceedings. Therefore the Board will refer to this document as A32a:

A32a: Basic product specifications dated 5 March 2003

Lastly, the appellant filed the following documents with its further submissions of 29 August 2017:

- A33: US 2001/0054777 A1
- A34: Declaration of Mr Bourgoïn concerning document A32a

(b) Alleged public prior use and witnesses

The appellant relied on an alleged public prior use of the product Tonga sold in 2003 and 2004, as supported by the evidence provided in documents A9 to A13, A15, A17, A23 to A26, A28 to A30, A32a and A34, and also by the testimony of the witnesses Mr Maurin and Mr Bourgoïn, who were heard at the oral proceedings before the Opposition Division.

The appellant also relied on an alleged public disclosure by way of visits to the Genouillac factory, as supported by the testimony of the witnesses Mr Maurin and Mr Bourgoïn given before the Opposition Division.

The Opposition Division accepted several corrections to the minutes of the hearing of the witnesses, as requested by the appellant, and issued a corresponding communication and amended minutes on 26 June 2017. The Board considers these to be the authentic minutes of the hearing of the witnesses before the Opposition Division. All references to the witness testimonies are thus based on the corrected version of the minutes.

X. The appellant's arguments can be summarised as follows.

(a) Extension of subject-matter - Article 100(c) EPC

The application as originally filed disclosed, in a technically meaningful interpretation, that the sound absorption coefficient was that of the "naked" bonded batt alone, whereas claim 1 as granted defined a sound absorption coefficient corresponding to the acoustic element as a whole (feature H), i.e. including any

possible lining arranged on it. The disclosure was thus ambiguous, and the subject-matter of claim 1 as granted was not clearly and unambiguously disclosed, contrary to the gold standard established in G 2/10. The amendments thus resulted in an unallowable extension of subject-matter.

Furthermore, the sound absorption coefficient in claim 1 as granted was no longer linked to the front face of the bonded batt, as was the case in the application as originally filed. The addition of feature H thus entailed an unallowable intermediate generalisation.

(b) Admittance of A32a and of the objection based on alleged factory visits - Article 12(4) RPBA 2007

The filing of A32a was a legitimate response to the point in the contested decision concerning the alleged lack of a complete chain of evidence between the produced panels and their being sold. This argument had not been raised before the oral proceedings in the opposition proceedings. In particular, the content of A15 had not been questioned at any point before. A32a was very relevant for the outcome of the case since it provided evidence that Tonga panels had been produced during the period when the proved sales took place. Retrieving A32a had not been easy since the prior use had taken place on the premises of a company that, back then, was different from the appellant even though it was now part of the same business group as the appellant. This explained the late filing of the document.

Furthermore, the Opposition Division did not use its discretion in a correct way when deciding not to admit the objection of prior public availability based on the

visits to the Genouillac factory by interested parties who were not constrained by any non-disclosure agreements. The witnesses had mentioned these when they were heard before the Opposition Division. This objection was likewise very relevant for the outcome of the case.

(c) Admittance of A33 and A34 - Article 13(1) RPBA 2020

A33 was filed in response to point 19.7 of the contested decision. The oral proceedings had been the first occasion where the argument about the crimping ratio required for achieving feature F had been raised.

The cyberattack suffered by the appellant in June 2017 had prevented it from filing A33 and A34 earlier.

In any case, the documents had been filed before the respondent filed its reply to the statement setting out the grounds of appeal, so the respondent had had time to take them into account. A33 and A34 were simple to understand from a technical point of view and very relevant.

(d) Main request, novelty, Tonga prior use - Article 54(2) EPC

Huge quantities of the Tonga acoustic elements had been sold before and after the production method was changed in October 2000, as confirmed by the testimony of the witnesses and demonstrated by the submitted invoices. The witnesses also confirmed that the new production method resulted in all the features of claim 1 (see Mr Bourgoïn's reply bridging pages 10 and 11 of the hearing minutes). The witnesses were unlikely to have

forgotten the basic production steps of a product which had been sold in such huge quantities.

As the Tonga product was uncontestedly a mass-produced product, there was no need to show any correlation between the production of a particular product and its sale using specific invoices in order to prove that it had been distributed and delivered (as established in T 55/01). The evidence which had been provided proved beyond any reasonable doubt that the product had been distributed.

The sound absorption coefficient and the density of the Tonga acoustic elements produced after October 2000 fell within the range defined in features D and H, as derivable from the tests in A13, which were explicitly referred to in A17, page 15. The fact that A17 referred to the test "CSTB n° 28474 **3**" with respect to the 25-mm product was an obvious mistake, since test number 3 of A13 concerned Tonga products of a different thickness from the product mentioned in the relevant passage of A17.

(e) Admittance of late-filed objections against
auxiliary request 14 - Article 13(2) RPBA 2020

The reply to the statement setting out the grounds of appeal had been filed around three years before the entry into force of the new RPBA 2020. Article 13(3) RPBA 2007 was in force at that time and did not oblige the appellant to react promptly to the filing of the auxiliary requests; in any case, the same novelty objections as for the main request applied. As there were no time constraints in the old RPBA similar to those established by current Article 13(2) RPBA 2020, this had to be considered an exceptional circumstance

which justified admitting the objections raised during the oral proceedings.

In any case, claim amendments always had to be examined for compliance with at least Article 123(2) EPC, even by the Board itself of its own motion. The respondent did not indicate the basis for the amendments, contrary to requirements. Furthermore, the novelty objection against claim 1 of the main request applied *mutatis mutandis* against claim 1 of auxiliary request 14.

Claim 11 as originally filed concerned an element - not a method - and did not comprise the features "bonding" and "facing tissue" which have been incorporated in amended claim 1. The disclosure in the description as originally filed did not support the amendments to claim 1 either. The disclosure on page 5, lines 12 *et seq.* was linked to other features, for instance the subdivision of the material. Pages 19 and 20 disclosed a particular embodiment with a thickness of 80 mm where fleece was "applied", not bonded. Lines 25 to 29 of page 17 disclosed another particular embodiment involving "a non-woven or other textile" fed from a roll. Lastly, amended claim 1 defined a facing tissue on a "flat face" instead of the originally disclosed "front face". The claimed subject-matter had thus been extended beyond the disclosure of the application as originally filed.

(f) Clarity - Article 84 EPC

The content of paragraphs [0020], [0039], [0047], [0052], [0053], [0063], [0078] and [0080] of the description was not consistent with amended claim 1, resulting in a lack of clarity. Specifically, the claimed feature "tissue" had a well-defined meaning

which did not correspond to that of a "fleece" or "non-woven" and "textile" materials.

XI. The respondent's arguments can be summarised as follows.

(a) Extension of subject-matter - Article 100(c) EPC

The appellant's arguments were based on an incorrect interpretation of the application. Line 4 of claim 1 as originally filed concerned the front face of the acoustic element, whereas line 12 of that claim made reference to the front face of the bonded batt - the same as both claim 11 and page 3, line 25 as originally filed. The passages on page 1, lines 4 to 12 and from page 3, line 35 to page 4, line 1 as originally filed concerned the sound absorption coefficient of the acoustic element as a whole, as in claim 1 as granted. The skilled person would realise that this interpretation was the only one which made technical sense when reading the first four lines of claim 1 as originally filed. Every time the application as filed mentioned the sound absorption coefficient, it did so in relation to the whole of the acoustic element, which was the natural way of understanding this term for the skilled person. Lastly, under the EPC the reference numerals used in the claim did not restrict the claim.

(b) Admittance of A32a and of the objection based on the alleged factory visits - Article 12(4) RPBA 2007

The appellant knew from the beginning of the opposition proceedings that it had to prove beyond reasonable doubt any alleged public prior use based on evidence to which only it had access. Instead of providing the

necessary supporting evidence in full during the opposition period, the appellant chose to file only a few documents, followed by further submissions every time a new argument was put forward against the alleged public prior use. The filing of A32a continued this strategy. The document could and should have been filed during the opposition proceedings.

Concerning the alleged visits at the Genouillac factory, the Opposition Division had applied the right principles when deciding not to admit this late-filed fact. The appellant did not provide any details about the alleged public availability which could justify its relevance.

(c) Admittance of A33 and A34 - Article 13(1) RPBA 2020

It was unclear why A33 was relevant for the outcome of the proceedings. In any case, the document could and should have been filed during the opposition proceedings.

The alleged cyberattack of June 2017 could not explain why A33 and A34 had not been filed at least with the statement setting out the grounds of appeal in May 2017.

(d) Novelty, Tonga prior use - Article 54(2) EPC

All the evidence was in the appellant's hands in this case. Thus, the correct level of proof to apply was that usually defined as "up to the hilt". The evidence provided by the appellant did not satisfy this requirement, particularly because there was no unbroken chain of evidence between specific Tonga panels produced at the factory and the sales which had been

proved by means of documents A9, A11 and A28 to A30. The brochures of A17 did not prove the sale of any specific product. Since the Tonga product was a mass-produced product, it should not have been difficult for the appellant to retrieve at least one sold product in order to substantiate its allegations regarding the particular features of that product. Similarly, for a product which had allegedly been sold in such high numbers, the appellant could have provided sales figures.

The argument about an alleged error in the numbering of the tests referred to in A17 confirmed the problem with the level of proof in the case as a whole. Furthermore, it could not be assumed that the witnesses would remember correctly every detail about the production of one of the many different products which had been produced under their supervision and under the product name Tonga. They had had to rely on documents, but these were unclear not only about what had been produced but also about when and how it had been produced.

Different production processes had been used over the years for Tonga products, as disclosed in A21, including production in other factories. Under these circumstances it was impossible to establish what had been produced and when it had been sold.

A15 concerned "primitives" for different products, and the specifications for Tonga products were rather sketchy. Moreover, A15 disclosed a crimping rate at a minimum, which could also indicate a zero crimping rate. No direction of cutting was disclosed in A15 either. Lastly, no evidence was available about how the further processing of the primitives affected the

features of the final product which had allegedly been sold.

(e) Admittance of late-filed objections against auxiliary request 14 - Article 13(2) RPBA 2020

The RPBA 2020 had been announced well in advance of their date of entry into force, including the relevant transitional provisions. Thus, it could not come as a surprise that a late-filed objection in the case in hand was to be dealt with as per these provisions. Consequently, there were no exceptional circumstances.

The appellant did not raise any objection against the auxiliary requests filed in 2017 until the day of the oral proceedings. The appellant should have challenged them beforehand, at some point during the last five years.

In addition to being late-filed, the objection based on Article 123(2) EPC was irrelevant. Specifically, the definition of the cut and abraded face to produce a flat face in claim 1 implied that this was the flat face referred to in the next feature of the claim.

Likewise, the novelty objection was irrelevant since the skilled person could not have inferred the required production steps from merely analysing the final product.

(f) Clarity - Article 84 EPC

The description was consistent with the amended claim. The terms "tissue", "fleece", "non-woven" and "textile" were used interchangeably in the description, as had been the case in the application as originally filed.

Some of the contested passages of the description merely described optional features which could be added to the invention, not alternatives outside the scope of the invention as argued by the appellant.

Reasons for the Decision

1. Main request
- 1.1 Extension of subject-matter - Article 100(c) EPC
- 1.1.1 The appellant's reasoning in full was as follows.

From the application as originally filed, the skilled person understood, in a technically meaningful interpretation, that the sound absorption coefficient defined in claim 1 and on page 3, lines 14 to 34 was measured with respect to the "naked" bonded batt alone, without the addition of any lining on it. These passages concerned a sound absorption coefficient in the context of a bonded batt in which the "front face" referred to the cut and abraded face of the bonded batt. The skilled person also understood from the application as filed that the higher sound absorption coefficient disclosed in the paragraph bridging pages 3 and 4 concerned the bonded batt in combination with a lining, which made sense from a technical point of view, as the addition of the layer would increase sound absorption. This was also disclosed in example 1 of the original disclosure, where the sound absorption coefficient was "at least 0.9".

Contrary to the ambiguous original disclosure, claim 1 as granted specifically defined a sound absorption coefficient for the whole of the acoustic element

(feature H), including any lining arranged on the bonded batt.

Moreover, the sound absorption coefficient of claim 1 as granted could be measured with regard to the front or rear face of the bonded batt facing the sound, whereas page 3, lines 14 to 18 and claim 1 as originally filed disclosed that this coefficient was measured with regard to the front face of the bonded batt.

Reference numeral 2 in claim 1 as originally filed and the description made it clear that the term "front face" consistently concerned the front face of the bonded batt throughout the patent application.

- 1.1.2 The appellant's arguments are not persuasive for the following reasons.
- 1.1.3 The application as originally filed discloses that the sound absorption coefficient in claim 1 as originally filed relates to the acoustic element as a whole, which corresponds to the skilled person's usual understanding in the field of acoustic insulations. The skilled person is aware of the fact that the sound absorption coefficient is a parameter which is measured in respect of a whole element by arranging a given surface ("the front face") to face the space in which a sound is propagated. For the skilled person there is thus no ambiguity.

When reading the application as originally filed, the skilled reader would realise that the sound absorption coefficient mentioned on page 1, lines 4 to 12 as originally filed - where the prior art is discussed - corresponds to the sound absorption coefficient of an

acoustic element which is oriented with its front face towards the sound, since it would make no sense for "the front face" to have a sound absorption coefficient of its own.

In the same way, the skilled person clearly and unambiguously understands that claim 1 and page 3, lines 14 to 18 as originally filed disclose that the sound absorption coefficient of feature H'/H (at least 0.7) relates to the acoustic element of the invention. In view of the skilled person's common general knowledge, the fact that it is literally stated that the front face "*has a sound absorption coefficient*" does not change this understanding. The skilled person would realise immediately that the invention defines a sound absorption coefficient of the whole acoustic element to be measured with regard to the "*flat, **sound-receiving**, front face*" (emphasis added).

The passage bridging pages 3 and 4 as originally filed does disclose a sound absorption coefficient higher than that previously disclosed (i.e. feature H). However, this falls within the usual practice when drafting a patent application, where the invention is first disclosed in its more general terms and is then followed by preferred embodiments. The embodiment having a higher sound absorption coefficient is also disclosed immediately after the general disclosure of the invention (page 3, lines 14 to 34) and before any other component of the acoustic element has been introduced. In fact, further components are not introduced as an option until much later and only in the context of the production process of the acoustic element (see page 5, lines 12 to 15). Therefore, the content of the paragraph bridging pages 3 and 4 would not have led the skilled person to conclude that the

previously disclosed sound absorption coefficient (feature H'/H) corresponded to the bonded batt alone.

- 1.1.4 It is true that the front face of the acoustic element and the cut and abraded face of the bonded batt are both referred to as "the front face" in claim 1 and on page 3, lines 14 to 34 as originally filed. However, this slight ambiguity in the wording does not change what the skilled person, using their common general knowledge, clearly and unambiguously understands from the application as a whole.

The skilled person realises that the "flat, **sound-receiving**, front face" in lines 2 and 3 of claim 1 as originally filed (features A and B) has to be the front face of the acoustic element since this passage relates to the acoustic element as a whole. In the same way, the skilled person identifies the "front face **of the bonded batt**" in line 20 of claim 1 (feature G') as the cut and abraded face of the bonded batt. This front face is introduced in line 12 (feature F') as a front face from which fibres extended (i.e. the fibres which were abraded to avoid irregularities in the front face of the bonded batt). The skilled person understands that the use of the same reference numeral for both elements in claim 1 as originally filed is an ambiguity caused by the same term being used for two different features.

- 1.1.5 Concerning the argument about the direction in which the sound absorption coefficient has to be measured with regard to the bonded batt, it is to be noted that since claim 1 as originally filed discloses a sound absorption coefficient **of the acoustic element** (see point 1.1.3 above) in the same way as claim 1 as granted (feature H), there is no discernible difference

in the subject-matter concerning the measurement direction with regard to the bonded batt. Both claims comprise feature B, which specifies that the front face of the acoustic element is the one receiving the sound, i.e. also when measuring the claimed sound absorption coefficient. Moreover, both claims comprise the same bonded batt having a front face, i.e. the face arranged towards the front face of the acoustic element (this is the only interpretation of "front" which makes sense in this context). Thus, there is no discernible difference between claim 1 as originally filed and claim 1 as granted in relation to the possible orientation of the bonded batt when measuring the sound absorption coefficient.

1.1.6 In view of the above, amended feature H (element having a sound absorption coefficient of at least 0.7) does not entail an extension beyond the disclosure of the application as originally filed and does not give rise to an unallowable intermediate generalisation.

1.2 Admittance of A32a and of the objection based on alleged factory visits - Article 12(4) RPBA 2007

1.2.1 A32a

The appellant considered that filing A32a with its statement setting out the grounds of appeal was a legitimate response to the contested decision since the contested decision had been based on arguments concerning the content of A15 that had not been made until the oral proceedings.

This is not persuasive.

The then opponent was aware of the fact that public prior use allegations had to be sufficiently substantiated during the opposition proceedings. This requires the provision of a complete chain of evidence in order to prove that acoustic elements disclosing the features of claim 1 had been made available to the public before the priority date of the contested patent. The appellant only filed documents A6, A7 and A8 within the opposition period. Documents A9, A10, A11, A12 and A13 were filed one year later on 4 August 2014, documents A14 to A22 were filed on 9 January 2015 and documents A23 to A30 were filed on 6 October 2016. The appellant thus provided evidence in multiple batches spread over a long period of time and had several opportunities to complete its case back in the opposition proceedings.

Moreover, the existence of a cut and abraded face of the bonded batt was at the heart of the substantive discussion in the opposition proceedings, and the supporting evidence A15 was a document dated 2000 whereas the sales covered by the bills A9 to A12 were dated at least three years later. Therefore, document A32a, which is intended to overcome this time gap in the reasoning for the alleged public prior use, could and should have been filed during the opposition proceedings.

Neither the alleged difficulty in retrieving document A32a - which was in principle available to the appellant - nor its alleged *prima facie* relevance can justify its late filing. With regard to the alleged *prima facie* relevance, the Board notes that the main criterion under Article 12(4) RPBA 2007 is whether the document in question could and should have been filed in the first-instance proceedings.

The Board thus did not admit document A32a into the appeal proceedings under Article 12(4) RPBA 2007.

1.2.2 Alleged factory visits

The Board does not consider that the Opposition Division exercised its discretion in the wrong way when deciding not to admit the line of attack based on the alleged factory visits.

The opponent presented this line of attack for the first time during the oral proceedings in the opposition proceedings after the hearing of the two witnesses, both of whom had asserted that the factory was open to site visits by interested parties, who were not constrained by any non-disclosure agreements. No further essential details were indicated, such as what exactly was open to the public, or to whom and under which circumstances. This made it impossible for the Opposition Division and the proprietor to prepare themselves and undertake a meaningful substantive assessment of this new line of attack at that point of time, as remarked in point 19.10 of the contested decision.

Thus, the Opposition Division applied the correct principles in the right manner when deciding not to admit the line of attack based on the alleged factory visits. Under these circumstances, the Board has no reason to revise the Opposition Division's discretionary decision (see Case Law of the Boards of Appeal, 10th edition, IV.C.4.5.2).

1.3 Admittance of A33 and A34 - Article 13(1) RPBA 2020

1.3.1 A33

A33 was filed after the statement setting out the grounds of appeal. The appellant's reference to a cyberattack which occurred *after* it had filed the statement setting out the grounds of appeal does not explain why this document could not have been submitted *together with* the statement setting out the grounds of appeal. Furthermore, the document is not *prima facie* relevant in view of the Board's interpretation of feature F (orientation of the fibres in the bonded batt) and the implications of any crimping in that regard (see point 1.4.3(c) below).

In view of the above, A33 was not admitted into the appeal proceedings under Article 13(1) RPBA 2020.

1.3.2 A34

As explained above, the cyberattack suffered by the appellant *after* the filing of its statement setting out the grounds of appeal cannot justify document A34 not being filed *together with* the statement setting out the grounds of appeal.

Furthermore, A34 is only relevant as supplementary evidence for A32a. As A32a is not admitted, A34 alone cannot have any impact on the outcome of the decision.

In view of the above, the Board exercised its discretion not to admit A34 into the appeal proceedings under Article 13(1) RPBA 2020.

1.4 Novelty, Tonga prior use - Article 54(2) EPC

1.4.1 Level of proof

The respondent argued that all the evidence surrounding the alleged prior use was in the appellant's hands in this case. Consequently, the alleged prior use had to be proved beyond reasonable doubt.

The Board agrees that all the available evidence stems from the sphere of the appellant-opponent. Hence, it is decisive **whether or not the Board** - after having assessed all the evidence - **is convinced beyond reasonable doubt** that the alleged public prior use had taken place (Case Law of the Boards of Appeal, 10th edition 2022, III.G.4.3.2(b)).

1.4.2 Sales of the Tonga 25 mm and 40 mm between October 2000 and the priority date

The respondent argued - in line with the contested decision - that the appellant had not demonstrated an unbroken chain of evidence between specific Tonga panels produced at the factory and the sales corresponding to documents A9 to A12. If the Tonga product had been a mass-produced product, the appellant should have been able to retrieve at least one sold product in order to corroborate its allegations. Furthermore, if the Tonga panels had been sold in such large numbers, sales figures could have been provided.

The Board does not consider these arguments persuasive for the following reasons.

First, it is evident from the witness testimonies that "Tonga" elements must be considered a mass-produced

product (see e.g. witness Mr Maurin, page 18, third and fourth paragraphs: "30 ans de Tonga", "si on mettait tous les panneaux de Tonga bout à bout, on pourrait doubler l'équateur", "c'est des millions de m² par an qui sont vendus en France ou à l'étranger").

Second, it is undisputed that the method for producing the Tonga acoustic elements was changed after October 2000 (see minutes of the hearing of Mr Bourgoïn, answer bridging pages 10 and 11; see minutes of the hearing of Mr Maurin, pages 10 and 11).

Third, the Board is convinced that Tonga elements made by the new production method and having a thickness of 25 mm and 40 mm have been sold in large numbers. This is evident from the available invoices A9, A11, A28, A29 and A30 (in combination with the respective supporting declarations A23, A25 and A26), which all show that high numbers of Tonga products of each thickness have been distributed to vendors.

Fourth, the Board is persuaded that these sales of 25 mm and 40 mm Tonga panels took place, at least partly, before the priority date. There is a period of about three and a half years between the modification of the production line of the Tonga panels in October 2000 - which resulted in the production of the 25 mm and 40 mm Tonga panels - and the priority date on 2 April 2004. In view of this long period of time, the large production volume of a facility for making acoustic elements as the Tonga panels and the high sales volumes, it follows that 25 mm and 40 mm Tonga panels must have been sold before the priority date. As stock and production management are subject to financial considerations and constraints, it would be completely unrealistic to assume that *all* Tonga panels

sold before the priority date in 2004 had already been produced before the production method was changed in 2000. This would necessitate a storage period of about three and a half years for a significant number of panels produced under the old method *and* for a significant number of panels produced under the new production method; this is not a reasonable assumption.

Under these circumstances, it is not necessary to prove that a **particular** sale of a **particular** Tonga panel occurred to prove beyond reasonable doubt that 25 mm and 40 mm Tonga panels were sold before the priority date. The Board refers in this respect to the reasoning of decision T 55/01 (point 4.1; see also Case Law of the Boards of Appeal, 10th edition, IV.C.2.2.8(i)), but considers - contrary to the Board in case T 55/01, which relied on the balance of probabilities for its conclusion - that the aforementioned sales have been proved beyond reasonable doubt in the case in hand.

1.4.3 The technical features of 25 mm and 40 mm Tonga panels produced after 2000

(a) Features A (acoustic element), B (flat, sound-receiving, front face), C (rear face and side edges) and E (consisting predominantly of a bonded batt of airlaid mineral fibres)

It is uncontested that Tonga panels produced after October 2000 were acoustic elements (feature A; see e.g. A17, pages 1 to 3) comprising a flat, sound-receiving, front face which extended in the XY plane (feature B; see e.g. A17, page 3, left-hand column, "Sizes"), a rear face substantially parallel to the front face, and side edges which extended in the Z direction, the Z direction being the direction between

the front face and rear face (feature C; see e.g. again A17, page 3, left-hand column, "Sizes"), the elements consisting predominantly of a bonded batt of airlaid mineral fibres (feature E; see minutes of the hearing of Mr Bourgoïn, sentence bridging pages 10 and 11, and also page 11, lines 13 to 19).

Features A, B, C and E were therefore disclosed by the Tonga panels produced after October 2000 and sold before the priority date.

(b) Features D (bonded batt density of 70 to 200 kg/m³) and H (sound absorption coefficient of at least 0.7)

The appellant argued that the sound absorption coefficient of the Tonga products and the density of their bonded batts ("primitives") fell within the ranges defined in features D and H, as derivable from A13, A15 and A17.

The respondent pointed out the alleged error in the numbering of the tests referred to in A17, which allegedly cast doubt on the reliability of the data. Different production processes had been used over the years for Tonga products, as disclosed in A21, including production in other factories. Under these circumstances it was not possible to establish what had been produced and when it had been sold.

The Board agrees with the appellant for the following reasons.

Document A13 is a record of an official test of Tonga products dated 1989 with number 28474 issued by the Centre Scientifique et Technique du Bâtiment (CSTB),

"Laboratoire accrédité par le Réseau National d'Essaies". It contains three tests involving the products Tonga 25 mm, Tonga 40 mm and Tonga 80 mm (see pages 3, 5 and 7, respectively).

According to Mr Maurin's testimony, these tests were carried out by an external entity and involved substantial costs. Thus, they were only repeated in the event of major changes which could have affected the product's performance (see minutes of the hearing of Mr Maurin, page 7, third and fourth paragraphs).

Page 3 of document A17 refers explicitly to these tests, showing the number "CSTB n° 28474 **3**" (emphasis added) concerning the 25 mm Tonga acoustic element (see left-hand column of page 3). The acronym CSTB and the first cipher match what is indicated on the first page of A13. The last number does not match the number of the test involving the Tonga 25 mm in A13 but the number of the test involving the Tonga 80 mm (see A13, page 7).

However, the Board agrees with the appellant that this is an obvious mistake since A17 also shows a reference ("CSTB n° 28474 2") concerning the 40 mm Tonga acoustic element (see left-hand column of page 3), which correctly points to the second test of A13 corresponding to the same product (see page 5 of A13).

Document A15 - a specification dated October 2000 - shows that bonded batts ("primitives") accounting for most of the mass of the 25 mm and 40 mm Tonga acoustic elements had to have a density of 95 kg/m³ (tolerance between 85 and 115) and 80 kg/m³ (tolerance between 70 and 100), respectively. This is in line with the density shown in A13 for the tests on Tonga 25 mm and

Tonga 40 mm: 100 kg/m³ and 80 kg/m³, respectively (see pages 3 and 5: "masse volumique").

The correlation between the density values in A13 (dated 1989) and A15 (dated 2000), the characteristics and the use of the official tests (as mentioned by Mr Maurin), and the explicit reference to the official tests of A13 in A17 (dated 2003) persuade the Board that the basic properties of the 25 mm and 40 mm Tonga acoustic elements did not change from 1989 until 2003, at least as concerns the density and the sound absorption coefficient.

Thus, the Board is convinced that the bonded batts of the 25 mm and 40 mm Tonga acoustic elements produced after October 2000 and sold before the priority date had a density between 70 kg/m³ and 200 kg/m³ (feature D; see A13, pages 3 and 5, "masse volumique", or A15, page 1, "Produit B", "Densité" and page 3, "Produit G", "Densité").

Document A17 further shows that the acoustic elements Tonga 25 mm and Tonga 40 mm offered to the market in 2003 had an absorption coefficient of 0.90 and 0.95, respectively. This falls within the range of feature H.

In view of the above, the 25 mm and 40 mm Tonga acoustic elements produced after October 2000 and sold before the priority date anticipated features D and H.

(c) Features F (fibre orientation at the front face and front half of the batt) and G (cut and abraded front face)

The contested decision states that "*[a]lthough there was no doubt that Mr Bourgoïn provided his testimony in*

frank and honest terms, it was clear to the Opposition Division that he was dependent on his own archive of documents to support his memory". The Board considers this a reliable assessment of the witness' testimony, including as to the credibility of the testimony.

The respondent did not contest the Opposition Division's conclusions in this respect. However, the respondent pointed out that it could not be assumed that Mr Bourgoïn had remembered all the details about the production of Tonga panels as he had had to rely on documentary evidence to prepare for his hearing, even more so because a production facility such as the one where Mr Bourgoïn worked produced a large variety of different products involving many different steps and procedures.

The Board agrees with the respondent that, on the basis of everyday practice and what had been stated by the Opposition Division, Mr Bourgoïn could not have been expected to remember everything up to the finest details about how Tonga acoustic elements had been produced more than ten years before the hearing. However, not all details of the production process are relevant in the context of the case in hand. In the case of the Tonga panels, what matters is whether the introduction of the new production line in October 2000 introduced certain essential changes in the procedure. The Board believes that these essential changes are remembered for longer and more accurately than other details. Changing from an old production line based on producing a panel of a single, defined thickness (see minutes of the hearing of Mr Bourgoïn, page 11, lines 5 to 12) to a new one based on producing a panel of double thickness which had to be cut along its middle plane and abraded (see minutes of the hearing, page 11,

lines 25 to 28) is just such an essential step. Therefore, the Board considers Mr Bourgoïn's testimony to be reliable evidence concerning the presence of the step of cutting (including the direction of cutting) and abrading in the production of Tonga acoustic elements after October 2000.

Similarly, the Board considers that Mr Bourgoïn did indeed remember the crimping step in the production of the Tonga acoustic elements since this step was present in both production lines before and after October 2000 (see minutes of the hearing of Mr Bourgoïn, page 11, lines 7, 8 and 20 to 24).

The respondent argued that crimping a batt of fibres did not necessarily result in feature F since the external layers of the batt are in contact with conveying elements of the production line, which force the fibres at the upper and lower sides to be oriented along the plane of the surface of the acoustic element (i.e. along plane XZ, perpendicular to direction Z).

While this might generally be true, the production method used after October 2000 necessarily resulted in feature F being present in the Tonga acoustic elements. Crimping a batt of fibres involves - at least within the core of the batt - a reorientation of the fibres in the direction between the upper and lower faces of the batt (Z direction) as in feature F (i.e. when compared with a batt of fibres which has not been horizontally compressed at all). The amount of crimping is immaterial in this respect given the broad scope of feature F, which encompasses any degree of reorientation.

The Board does not accept the respondent's argument that the expression "minimum de régulation" for the crimping defined in A15 (see last lines of the tables concerning "Produit B" and "Produit G" on pages 1 and 3, respectively) may encompass the possibility of not carrying out any crimping at all. Firstly, this goes against the interpretation of the wording of A15 in line with its common meaning. The "minimum setting" of a parameter generally implies that this parameter must be present. Secondly, the testimony of the witness Mr Bourgoïn proves to the Board's satisfaction that crimping was always a necessary step in the production of Tonga acoustic elements, both before and after October 2000.

The splitting of the bonded batt after crimping (which results in the presence of reoriented fibres, except for possibly on the upper and lower faces) implies that an external face is created on each of the two resulting bonded batts, where fibres show the claimed orientation.

Since the cut face of each resulting bonded batt was abraded and was the one receiving the veil arranged on the front face of acoustic elements (see minutes of the hearing of Mr Bourgoïn, page 11, lines 25 to 28), features F (orientation of the fibres in the front face and front half of the bonded batt) and G (cut and abraded front face of the bonded batt) were present in the Tonga acoustic elements produced after October 2000 and sold before the priority date. Further processing steps not affecting the structure of the bonded batt (such as bonding a veil onto the cut face) will not change the density of the bonded batt or decrease the sound absorption coefficient of the element.

1.4.4 Conclusion

In view of the above, the subject-matter of claim 1 is not novel over the 25 mm and 40 mm Tonga acoustic elements produced after October 2000 and sold before the priority date (Article 54(2) EPC). It follows that the patent as granted does not comply with the requirements of the EPC, contrary to the Opposition Division's finding. Thus, the decision under appeal has to be set aside.

2. Auxiliary request 14 - admittance of the late-filed objections based on Articles 123(2) and 54 EPC pursuant to Article 13(2) RPBA 2020

2.1 Under Article 13(2) RPBA 2020, any amendment to a party's appeal case made (for example) after notification of a summons to oral proceedings are, in principle, not to be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

2.2 Exceptional circumstances - transitional provisions

2.2.1 The respondent had filed auxiliary request 14 with its reply to the statement setting out the grounds of appeal. The appellant did not raise any objections in the ensuing period. It was not until the oral proceedings before the Board that the appellant for the first time raised two objections against claim 1 of auxiliary request 14, based on Articles 54 EPC and 123(2) EPC, respectively. These objections constitute an amendment to the appellant's appeal case made after notification of the summons to oral proceedings; it is therefore subject to Article 13(2) RPBA 2020.

- 2.2.2 The main argument relied on by the appellant for the admittance of this late amendment to its appeal case was that its appeal had been filed before the date of the entry into force of the RPBA 2020, which amounted to exceptional circumstances within the meaning of Article 13(2) RPBA 2020. In particular, it had to be taken into account that Article 13(3) RPBA 2007 had still been in force at the time auxiliary request 14 was filed, so the appellant had not been obliged to respond at a predetermined point in time in the proceedings - and in particular not before the notification of a summons to oral proceedings.
- 2.2.3 This is not persuasive. Under Article 25(1) RPBA 2020, the revised version of the RPBA shall not only apply to appeals filed after its entry into force on 1 January 2020, but also to any appeal pending on this date. Thus, the RPBA 2020 also apply to the appeal in hand, which was filed in 2017. The transitional provisions set out in Article 25(2) RPBA 2020 only specify exceptions regarding Article 12(4)-(6) RPBA 2020 and Article 12(4) 2007, not regarding Article 13(3) RPBA 2007, on which the appellant relied. As the summons to oral proceedings was not notified before 1 January 2020, Article 25(3) RPBA 2020 is not applicable either. Thus, Article 13(2) RPBA 2020 must be applied to any amendment to a party's appeal case made after the summons to oral proceedings, irrespective of the filing date of the appeal at issue. Since this is true not only for the case in hand but also for each and any comparable appeal proceedings, it does not constitute "an exceptional circumstance". The mere fact that Article 13(3) RPBA 2007, which was applicable at the time the appeal was filed, differs from Article 13(2) RPBA 2020 does not amount to a

cogent reason justifying exceptional circumstances within the meaning of Article 13(2) RPBA 2020 either.

- 2.3 Exceptional circumstances - criteria referred to in Article 13(1) RPBA 2020 - scope of the examination of auxiliary request 14
 - 2.3.1 When applying Article 13(2) RPBA 2020, a board may also rely on the criteria referred to in Article 13(1) RPBA 2020 (T 2117/18, Reasons 2.2.20; see also the explanatory remarks in document CA/3/19, page 43). Relying on criteria referred to in Article 13(1) RPBA 2020 is part of the Board's exercise of discretion under Article 13(2) RPBA 2020. This discretion is inherent to the assessment of whether there are "exceptional circumstances" and is furthermore expressed by the phrase "in principle" (T 172/17, Reasons 5.4).
 - 2.3.2 The criteria referred to in Article 13(1) RPBA 2020 include the suitability of the amendment to resolve the issues raised. In the case in hand, this translates into whether the newly raised objections against auxiliary request 14, namely under Articles 54 and 123(2) EPC, will *prima facie* be successful.
 - 2.3.3 The Board notes that it does not need to assess the *prima facie* relevance of an objection in order to conclude that there are no exceptional circumstances under Article 13(2) RPBA 2020 justifying its admittance into the appeal proceedings (for amended claim requests see T 2787/17, Reasons 4.1.3). Whether it is appropriate to conduct this kind of *prima facie* assessment depends on the specific circumstances of the case.

- 2.3.4 The case at issue is characterised by the fact that the Opposition Division maintained the patent as granted whereas the Board concluded that the patent as granted was not allowable. Auxiliary request 14, i.e. the first auxiliary request to be dealt with thereafter since all preceding auxiliary requests were withdrawn, was filed with the reply to the statement setting out the grounds of appeal and had never before been examined or objected to. In this specific procedural situation, the Board considers it appropriate, for the reasons set out below, to consider the *prima facie* relevance of the two objections, based on Articles 54 and 123(2) EPC, respectively, raised by the appellant for the first time in the oral proceedings before the Board.
- 2.3.5 The appellant argued that both objections (but at least its objection under Article 123(2) EPC) had to be admitted and examined because a board always had to fully examine claim amendments for compliance with Article 123(2) EPC, even of the board's own motion.
- 2.3.6 Although the appellant did not refer to the Enlarged Board's opinion in G 10/91, the Board considers it expedient to address it in this context. In G 10/91, Reasons 19, the Enlarged Board stated that "amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings [...] are to be fully examined as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC)". However, this statement does not mean the Board is obliged to admit the appellant's late-filed objections under Article 13(2) RPBA 2020 and consider them fully.
- 2.3.7 First of all, the Enlarged Board's statement in G 10/91, Reasons 19, does not concern the questions of

law referred to it. This statement is therefore not part of the *ratio decidendi*, i.e. the reasoning for the order given there, but an *obiter dictum* (see G 10/91, Reasons 17). As such, it is an observation made in passing and cannot be expected to have undergone the same level of analysis and scrutiny as statements made in the context of the *ratio decidendi*. In decision G 4/19, Reasons 39-41, the Enlarged Board itself indicated that its *obiter dicta* do not have the same standing as statements which are part of the *ratio decidendi* of its decisions and opinions. Still, the Board considers the Enlarged Board's *obiter dicta* to have strong persuasive value regardless of their legal nature.

- 2.3.8 However, the *obiter dictum* in G 10/91, Reasons 19, cannot be construed as an obligation for the Boards of Appeal to fully examine any claim amendments made in the appeal proceedings in the same way an examining division would. This would be at odds with Article 114(2) EPC (see T 1767/18, Reasons 53.5) and the settled case law under which appeal proceedings were never intended to be the mere continuation of first-instance proceedings (Case Law of the Boards of Appeal, 10th edition, V.A.1.1). Furthermore, the Enlarged Board's statement must be interpreted in the context of the current legal framework, which has changed significantly since that statement was made.
- 2.3.9 In particular, the RPBA in force at the time decision G 10/91 (31 March 1993) was taken did not contain any provisions on late-filed submissions. Provisions in this regard were only introduced with the Rules of Procedure 2003 (OJ EPO 2003, 61) and are now part of the RPBA 2020. Against this background, the Enlarged Board's *obiter dictum* in G 10/91, Reasons 19, cannot be

interpreted as requiring an objection to be examined in full regardless of when it was raised, and regardless of its chances of success (see T 882/17, Reasons 3.18.4).

- 2.3.10 Taking into account Article 114(2) EPC and the RPBA 2020, the Board is of the view that the Enlarged Board's *obiter dictum* in G 10/91, Reasons 19, is in any event fully respected when the *prima facie* relevance of an objection is considered in the context of assessing whether there are exceptional circumstances justifying its admittance pursuant to Article 13(2) RPBA 2020.
- 2.3.11 With regard to the appellant's objection under Article 54 EPC, the Board considered this *prima facie* assessment appropriate because the objection was based on the same prior use which had already been discussed with regard to the main request. Hence, a *prima facie* assessment of this objection to auxiliary request 14 was not detrimental to procedural economy.
- 2.3.12 As to the appellant's objection under Article 123(2) EPC, the Board took account of the rationale underlying Article 105b EPC (limitation or revocation of a European patent) and Rule 95(2) EPC, which were not in force at the time decision G 10/91 was taken. In limitation proceedings, limiting claim amendments must be examined as to their compliance with Articles 84 and 123(2) and (3) EPC, but not with regard to any other requirements. This shows that the EPC puts particular emphasis on these requirements when it comes to limiting claim amendments which have not been examined before. This emphasis is also consistent with the explicit mention of Article 123(2) EPC in G 10/91, Reasons 19. The Board thus considered it appropriate in the case in hand to also assess the *prima facie*

relevance of the appellant's objection under Article 123(2) EPC.

2.3.13 Assessment of the *prima facie* relevance of the objections raised by the appellant during the oral proceedings

(a) Objection based on Article 54 EPC

The appellant argued that the same novelty objections as for the main request applied to claim 1 of auxiliary request 14.

The Board is not persuaded by this argument since claim 1 of auxiliary request 14 is a **method** claim comprising production steps which cannot be inferred from a particular Tonga acoustic element. For example, due to the abrasion step, it cannot be concluded from a single Tonga element that the cured batt **has been cut** in the XY plane into two cut batts to produce the cured batt of the acoustic element, let alone that **each of the two cut surfaces resulting from this step (one of which is on a different element produced in parallel but not necessary available)** has been abraded to produce a flat face. This novelty objection is thus *prima facie* not convincing.

(b) Objection based on Article 123(2) EPC

The appellant argued that the respondent had not indicated the basis for the amendments, contrary to what was required. This is not correct. The respondent identified the origin of the amendments in the reply to the statement setting out the grounds of appeal (see page 11, fourth and fifth paragraphs).

Concerning the substance of the objection, the appellant argued that claim 11 as originally filed concerned an element, not a method, and did not comprise the features "bonding" and "facing tissue" which had been incorporated in amended claim 1. The disclosure in the description as originally filed did not support the amendments to claim 1 either. The disclosure on page 5, lines 12 *et seq.* was linked to other features, for instance the subdivision of the material. Pages 19 and 20 disclosed a particular embodiment with a thickness of 80 mm where fleece was "applied", not bonded. Lines 25 to 29 of page 17 disclosed another particular embodiment involving "a non-woven or other textile" fed from a roll. Lastly, amended claim 1 defined a "facing tissue" on a "flat face" instead of the originally disclosed "front face".

These arguments are not persuasive.

The added feature "and bonding a facing tissue on the flat face" finds an almost literal basis on page 5, lines 12 and 13 as originally filed. This passage concerns the process of making acoustic elements, as in originally filed claim 12, with which it has been combined, and discloses that the facing tissue can be bonded "onto either or both faces", thus encompassing the bonding of the facing tissue onto the flat face (which is the cut and abraded face, as defined in the feature immediately preceding the feature "bonding a facing tissue ...").

The fact that claim 1 does not comprise the subdivision of the cured batt "*to form elements having the desired XY dimensions*" as on page 5, lines 7 to 12 *prima facie* does not result in an unallowable intermediate generalisation since the skilled reader understands

that this feature is technically unrelated to the bonding of the facing tissue.

2.3.14 In conclusion, neither of the two objections against auxiliary request 14 are *prima facie* persuasive. No exceptional circumstances could be ascertained and the Board decided not to admit these objections into the appeal proceedings under Article 13(2) RPBA 2020.

3. Auxiliary request 14 - clarity in the context of the amended description - Article 84 EPC

3.1 The appellant argued that the content of paragraphs [0020], [0039], [0047], [0052], [0053], [0063], [0078] and [0080] of the description was not consistent with amended claim 1, thus resulting in a lack of clarity under Article 84 EPC. The claimed feature "tissue" had a well-defined meaning which did not correspond to that of a "fleece" or "non-woven" and "textile" materials.

The Board disagrees.

3.2 The words "tissue", "web", "fleece", "non-woven" and "textile" are used interchangeably in the patent application, as is clear from the disclosure on page 5, lines 12 to 15 as originally filed, where "tissue" is meant as an equivalent of "web", and "web" is defined as a "non-woven" or "textile" of the types "typically used for facing acoustic elements" (i.e. including fleece as on page 1, line 36 as originally filed). This passage was amended in the description filed during the oral proceedings in order to exclude the embodiment where the facing tissue or web is bonded only onto the rear face of the bonded batt (see amended paragraph [0020]), but the equivalence is nevertheless still clear from the last sentence of the amended paragraph,

which implies that the "facing web" amounts to the "facing tissue" described immediately before.

3.3 Thus, the objection against the use of the words "web", "fleece", "non-woven" and "textile" in paragraphs [0020], [0039], [0053], [0063], [0078] and [0080] is not convincing.

3.4 The appellant also argued that the wording "onto both faces" in amended paragraph [0020] resulted in a lack of clarity.

3.5 However, this is not persuasive since the embodiment where a facing tissue is bonded onto both faces of the bonded batt is merely a particular embodiment of the invention defined in claim 1, where the facing tissue is bonded onto the flat face.

3.6 The appellant also argued that the embodiment of paragraph [0047] resulted in a lack of clarity since it concerned subject-matter outside the scope of the claimed invention.

3.7 The Board cannot find any reason for this since paragraph [0047] merely concerns providing edge slots to improve interconnections in the elements made by the method of the invention. Thus, the content of the paragraph does not concern any embodiment which excludes features of claim 1.

3.8 Lastly, the appellant argued that amended paragraph [0052] resulted in a lack of clarity since Figures 1 and 4, which the paragraph referred to, did not disclose a facing tissue.

3.9 This is not persuasive since Figures 1 and 4 are merely schematic and do not consist of the kind of cross section whereby the skilled reader would expect a feature of this kind to be more explicitly disclosed. The amended description as a whole makes it clear that the acoustic elements made according to the method of the invention must comprise a facing tissue bonded onto the flat face. Thus, the reader understands that Figures 1 and 4 disclose the general external shape of said acoustic elements.

3.10 In view of the above, the objections under Article 84 EPC against the amended description are not convincing.

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 as amended in the following version:
 - claims 1 to 6 of auxiliary request 14 filed with the patent proprietor's reply to the statement of grounds of appeal
 - description paragraphs 1, 14, 19, 20, 39, 41, 46, 47, 51, 52, 53 and 91 as filed during the oral proceedings before the Board, and paragraphs 2 to 13, 15 to 18, 21 to 38, 40, 42 to 45, 48 to 50, 54 to 90, 92 and 93 of the patent specification
 - drawings: Figures 1 to 7 of the patent specification

The Registrar:

The Chairman:



C. Spira

C. Herberhold

Decision electronically authenticated