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**Datasheet for the decision
of 27 September 2021**

Case Number: T 1165/19 - 3.3.05

Application Number: 09752519.0

Publication Number: 2346590

IPC: B01D39/16

Language of the proceedings: EN

Title of invention:
MULTI-PHASE FILTER MEDIUM

Patent Proprietor:
HOLLINGSWORTH & VOSE COMPANY

Opponent:
Ahlstrom Filtration LLC

Headword:
Multiphase filter/Holingsworth

Relevant legal provisions:
RPBA Art. 12(4)
RPBA 2020 Art. 13(1), 13(2)
EPC Art. 123(2), 83, 84, 54
EPC R. 139

Keyword:

Late-filed evidence - submitted with the statement of grounds of appeal
Amendment after summons - exceptional circumstances (no)
Amendments - allowable (yes)
Sufficiency of disclosure - (yes)
Claims - lack of clarity no ground for opposition
Novelty - public prior use - burden of proof
Correction of error - (yes) - immediately evident that nothing else could have been intended (no)

Decisions cited:

G 0001/12, G 0003/14, T 1577/19, T 0995/18, T 0952/92

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

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Case Number: T 1165/19 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 27 September 2021

Appellant: HOLLINGSWORTH & VOSE COMPANY
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 February
2019 revoking European patent No. 2346590
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman E. Bendl
Members: G. Glod
S. Fernández de Córdoba

Summary of Facts and Submissions

I. The appeal of the patent proprietor (appellant) lies from the opposition division's decision revoking European patent EP 2 346 590 B1.

II. The following documents cited in the decision are of relevance here:

- D1: US 4 661 255 A
- D2: US 6 139 883 A
- D3: EP 1 325 979 A1
- D4: US 4 033 881 A
- D5: US 2 928 765 A
- D6: US 3 158 532 A
- D7: US 2006/0144532 A1
- D9: Affidavit by Kent Williamson of 9 May 2017
- D9a: Exhibits 1 to 8 of document D9
- D19: Affidavit of Chris Reitmeyer of 24 January 2018
- D20: Affidavit by Kent Williamson of 30 January 2018
- D23: I.M. Hutten, Handbook of non-woven filter media, March 2007, excerpt
- D24: Palas[®] Aerosoltechnologie, Modularer Filter Test Rig-2000
- D25: Palas[®] Prüfstand MFP 1000/2000

III. With the statement of grounds of appeal the appellant submitted the following documents, among others:

- D30: T. C. Dickenson, Filters and Filtration Handbook, 4th edition, 1997, pages 925 and 926
- D31: Declaration Mike Malloy of 20 June 2019

IV. With the reply the respondent (opponent) submitted the following documents:

D9a2: Less redacted version of D9a
D34: Affidavit of Gary Blevins of 23 October 2019
D35: Exhibits 10a-d and 11
D36: Affidavit of Kent Williamson of 6 November 2019

V. In the communication pursuant to Article 15(1) RPBA 2020, the board was of the preliminary opinion that the requirements of Articles 123(2) and (3), 84 and 83 were fulfilled and that a public prior use of an article according to claim 1 had not been convincingly shown.

VI. In response thereto, the respondent provided a submission on 3 August 2021 including the following documents:

D37: Revised Exhibits 1b, 2b, 5b to 7b, and 10b and previously filed Exhibits 3b, 4b and 11b
D38: Affidavit of C. Reitmeyer/SGS Integrated Paper Services Inc of 22 July 2021

VII. Oral proceedings took place on 27 September 2021.

VIII. Independent claim 1 of the main request is as follows:

*"1. An article, comprising:
a first phase comprising a first plurality of fibers and a second plurality of fibers different from the first plurality of fibers; a second phase comprising a third plurality of fibers and a fourth plurality of fibers different from the third plurality of fibers, the third plurality of fibers being the same as or different from the first or second plurality of fibers and the fourth plurality of fibers being the same as or different from the first or second plurality of fibers;*

and a transition phase between the first and second phases, wherein the transition phase comprises at least a portion of each of the first, second, third and fourth pluralities of fibers which are intermingled with each other, wherein the air permeability of the first plurality of fibers is higher than the air permeability of the second plurality of fibers, and the air permeability of the third plurality of fibers is higher than the air permeability of the fourth plurality of fibers, wherein the air permeability is determined using a handsheet produced exclusively by such fibers and having a basis weight of 100 g/m² according to the standard ISO 9237, wherein each of the first, second, third and fourth pluralities of fibers are made from an organic polymeric material, wherein a weight ratio of the first and second pluralities of fibers is from about 50:50 to about 90:10, and a weight ratio of the third and fourth pluralities of fibers is from about 10:90 to about 50:50, wherein the basis weight ratio of the first phase to the second phase is from 30:70 to 70:30, and wherein the first and second phases form a wet laid structure that is configured as a filter medium."

Claims 2 to 14 directly or indirectly relate to claim 1.

IX. The appellant's arguments, insofar as relevant to the decision, can be summarised as follows:

Rule 139 EPC

It was apparent from the grounds of appeal that the claims filed with the grounds of appeal were not the

correct ones and that they should be replaced by the requests underlying the decision under appeal.

It was furthermore evident that the dust concentration of 200 mg/cm³ in paragraph [0082] was erroneous. The skilled person knew that the only possible correction was 200 mg/m³, as evidenced by D23 to D25 and D30.

Late-filed documents

Documents D9a2 and D34 to D38 should not be admitted into the proceedings. It was the respondent's duty to present its complete case before the opposition division. There were no reasons to provide additional information during the appeal.

Articles 123(2) and 84 EPC

The requirements of these articles were met.

Article 54 EPC

The four alleged prior uses had not been proven to the required standard. In particular, it was not known which product had allegedly been made available. Therefore it could not be verified whether all the features of claim 1, such as for example the transition phase, were present and whether the product could be made by the skilled person. If the board acknowledged prior use, questions were to be referred to the Enlarged Board of Appeal.

- X. The respondent's arguments, insofar as relevant to the decision, can be summarised as follows:

Article 13(1) RPBA 2020

The appellant's requests were not filed until after the summons to oral proceedings. These requests represented an amendment to the appeal case. They were not filed as soon as possible after the alleged clerical error could be recognised. There was no obvious error and Rule 139 EPC did not therefore apply. The requests led to a new objection under Article 123(2) EPC.

Article 13(2) RPBA 2020

Documents D37 and D38 were filed in response to the communication pursuant to Article 15(1) RPBA, which contained new issues. There was no reason to file these exhibits earlier. They did not lead to an amendment of the appeal case.

Article 123(2) EPC

The expression "wet-laid structure", which had to refer to an additional structural feature, was not disclosed in the application as filed. In addition, claim 1 no longer required the article to be configured as a filter medium as was originally disclosed. Furthermore, claim 1 contained a combination of features that was not directly and unambiguously derivable from the application as filed. Several selections had to be made in order to arrive at the claimed subject-matter.

Article 84 EPC

It was not clear where the transition phase started or ended.

Article 83 EPC

The patent did not disclose any method for determining the feature "intermingled". In addition, information was lacking on how to measure the air permeability. The weight ratio between the phases could not be determined if they were identical.

Article 54 EPC

It was beyond doubt that the products 5FW-3, 9P-84, 9FW-1 and 10FW-1 had been made available to the public. It was sufficient to provide the information about all the patented features in order to demonstrate that the prior-use products fall under the terms of the contested claims. Documents D19 and D20 demonstrated that the products can be analysed and reproduced.

If it is accepted under Article 83 EPC that intermingled fibres are obtained by a wet-laid process, then it is evident that such intermingled fibres are also present in the products 5FW-3, 9P-84, 9FW-1 and 10FW-1. As confirmed in D9 (point 4), these products were made using a wet-laid process, which led to the intermingled fibres.

Article 112(1) (a) EPC

The following question was to be referred to the Enlarged Board of Appeal if the board deviated from established case law as illustrated in T 952/92:

"When relying on public prior use of a product made available to the public, is it necessary for the party arguing lack of novelty of a claim in view of this

product to show features going beyond the features claimed?"

- XI. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request or, alternatively, on the basis of one of auxiliary requests 1 to 7, all requests having been submitted on 20 April 2021. In addition, a referral was requested.

The respondent (opponent) requested that the appeal be dismissed. In addition, a referral was requested.

Reasons for the Decision

1. Article 12(4) RPBA 2007

The statement of grounds of appeal was filed in 2019 and the reply thereto was filed in due time. Therefore Article 12(4) RPBA 2007 applies (see Article 25(2) RPBA 2020). The respondent submitted documents D9a2 and D34 to D36 with the reply to the appeal. The appellant considered that those documents should have been filed before the opposition division.

The board sees no reason to hold the documents inadmissible, since they are considered to be a fair reaction to document D31 submitted with the statement of grounds of appeal. They are intended to support the evidence that the products 5FW-3, 9P-84, 9FW-1 and 10FW-1 were made available to the public. That had been questioned by the appellant, who relied on D31 in this context.

Therefore, D9a2 and D34 to D36 are part of the appeal proceedings.

2. Article 13(1) and (2) RPBA 2020

Article 13(1) and (2) RPBA 2020 applies (see Article 25(3) RPBA 2020 and T 1577/19, Reasons 2).

According to Article 13(1) RPBA 2020, any amendment to a party's appeal case after it has filed its grounds of appeal may be admitted only at the discretion of the board. According to Article 13(2) RPBA 2020, any amendment to a party's appeal case made after notification of a summons to oral proceedings is not generally to be taken into account unless there are exceptional circumstances which have been justified with cogent reasons by the party concerned.

2.1 The main request was only submitted on 20 April 2021, which was after notification of the summons to oral proceedings. In the present case the main request is not an amendment of the appellant's case, but a correction of an obvious error in accordance with Rule 139 EPC.

Rule 139 EPC applies to any document filed with the EPO and it also applies to appeals (G 01/12, Reasons 35). It is obvious from the statement of grounds of appeal that an error concerning the requests must have occurred. On page 2 (lines 1 and 2) of the statement of grounds of appeal, the appellant refers to the correspondence of the requests that were on file at the end of the first-instance proceedings and those that should be part of the appeal proceedings. It is immediately apparent that the main request should correspond to the auxiliary request 1 underlying the

impugned decision. In that context it is understood that the requests of the first-instance proceedings and those on appeal are supposed to be identical except for the names given to them. Consequently, the requests submitted with the grounds of appeal cannot be the correct ones. In view of the whole content of the statement of grounds of appeal it is also apparent that the main request on appeal must be the first auxiliary request underlying the impugned decision. This is particularly evident from point 3.1 of the statement of grounds of appeal, which indicates that the request was found to meet the requirements of Articles 123, 84 and 83 EPC. This would not apply for the main request filed with the statement of grounds of appeal. Indeed, the aforementioned main request was withdrawn during oral proceedings, as it was found not to meet the requirements of Article 123(3) EPC.

One of the principles established with respect to Rule 139 EPC is that the request for correction must be filed without delay (G 01/12, Reasons 37). In the present case the correct requests were not filed until seventeen months after the reply to the appeal and seven months after the summons to oral proceedings. However, since no time limit was set for the appellant, the phrase "without delay" can only mean that the correction should be filed as soon as it was noticed by the appellant. As the appellant indicated that it did this, its compliance with the above-mentioned principle is accepted.

Consequently, the correction of the main request is accepted and the main request is part of the proceedings.

2.2 D37 and D38 were filed in response to the board's communication pursuant to Article 15(1) RPBA 2020. They constitute a change to the respondent's case, since they contain additional information regarding the prior use of 9P-84 that was not previously available. In particular, they were filed with the intention of showing the complete composition of 9P-84 and proving the analysability of such material.

There are no exceptional circumstances that would justify the filing of these documents at such a late stage of the proceedings. The communication pursuant to Article 15(1) RPBA 2020 is not an invitation to make further submissions (T 995/18, Reasons 1.4). The communication did not raise any new issues, but merely gave the preliminary opinion of the board based on the parties' submissions. Notably, the problem relating to the "what", the analysability and the reverse engineering of the allegedly sold products was part of the statement of grounds of appeal (page 6, 3.1.2, and page 14, upper part). Therefore, these documents are not taken into account.

3. Article 123(2) EPC

The requirements of Article 123(2) EPC are considered to be met for the following reasons:

3.1 The expression "*wherein the first and second phases form a wet laid structure that is configured as a filter medium*" is directly and unambiguously derivable from the passage cited by the opposition division (page 3, lines 23 to 30). That passage explains that a wet-laid process is used for the first and second phases and results in one of the articles described previously in the description. Several passages indicate that the

article is configured as a filter medium (page 1, line 22; page 2, lines 5 and 24; page 3, lines 6 and 20). The skilled person understands therefrom that the wet-laid process leads to a wet-laid structure that is configured as a filter medium. It is implicit that the overall article has to be configured as a filter medium if the first and second phases form a filter medium. Although the wording may possibly allow for the presence of layers not configured as a filter medium, a skilled person making sense out of the wording of the claim will understand that the overall article has also to be configured as a filter medium.

- 3.2 Claim 1 relates to a wet-laid structure, which implies a wet-laid process. The transition phase and its definition are based on page 14, lines 6 to 8, specifying that a transition phase with intermingled fibres is present when a wet-laid process is used. The reference on page 16, lines 17 to 19, cited by the appellant, does not appear to relate to a wet-laid process.

The specification of the determination of the air permeability is based on page 7, lines 29 to 32, which generally describes how the air permeability should be determined.

The feature "*wherein each of the first, second, third and fourth pluralities of fibers are made from an organic polymeric material*" is directly and unambiguously derivable from page 5, lines 15 and 16. The skilled person would recognise that this is the most common option, since it is also in line with the examples. Therefore, a selection from several lists cannot be recognised for this feature.

The weight ratio indication "*wherein a weight ratio of the first and second pluralities of fibers is from about 50:50 to about 90:10, and a weight ratio of the third and fourth pluralities of fibers is from about 10:90 to about 50:50*" is based on page 4, lines 5 to 8, where these ratios are the most general ranges. A special selection or combination of ranges is therefore not required.

In the present case, the inclusion of the features from different parts of the description does not lead to a singling-out of a specific embodiment that was not originally disclosed. Instead, it leads only to the specification of features through the general teaching of the description.

- 3.3 The correction already present in paragraph [0082], $[(1-[C/C0])*100\%]$, is acceptable. Indeed, the skilled person understands that the number "100" must be wrong in view of its indication as a percentage while the only reasonable correction appears to be the replacement of "100" by "1".
- 3.4 The correction of the dust concentration (200 mg/cm³ to 200 mg/m³) in paragraph [0082], requested under point 2.2 of the grounds of appeal, is not allowable.

Although it is accepted that such a high concentration of dust is unreasonable and therefore erroneous, it is not evident to the skilled reader what the correction should be. D23 gives a concentration per m³, but it is expressed as particles/volume rather than weight/volume. D24 and D25 do not disclose 200 mg/m³. D30 discloses concentration as mg/m³. The skilled person would possibly deduce therefrom that the most likely unit is mg/m³, but would not know whether the value of

200 needs correction as well. Therefore, it cannot be accepted that it is immediately apparent that nothing other than what is proposed as the correction was meant.

4. Article 123(3) EPC

The respondent's objection was not maintained for the main request. The board cannot recognise any reasons to take a different stance.

5. Article 84 EPC

The amendment made in claim 1 further restricts the transition phase, which was already present in claim 1 as granted. The alleged clarity objection equally applies to claim 1 as granted and is not occasioned by the amendment made. Therefore, it is not open to debate (G 3/14, Reasons 81).

6. Article 83 EPC

The board is not convinced by the respondent's arguments for the following reasons:

As indicated in the impugned decision (Reasons 10.2.1), the patent contains examples that allow the defined article to be produced. Paragraph [0069] of the patent sets out how the different fibres can be intermingled. There is no evidence that this would not be possible for the skilled person if the same type of fibres within the meaning of the theoretical illustrations on page 15 of the respondent's reply were used.

The opposition division explained in point 10.2.2 of the impugned decision why the determination of the air

permeability does not lead to a problem concerning sufficiency of disclosure. There is no evidence that this conclusion is wrong and that different test methods would not lead to the same relative result when comparing different fibres.

As already indicated in the impugned decision (point 10.2.4), there appears to be no reason why the skilled person would be unable to determine the amount of the phases to be used when preparing the article according to claim 1. Even if the respondent's rather theoretical interpretation of claim 1 (illustrations on page 15 of the reply to the grounds of appeal) were followed, the skilled person still knew how to determine weight ratios and to adapt the amount of fibres to be used. Again, evidence to the contrary is lacking.

7. Article 54 EPC

The opposition division concluded that product 9P-84 anticipated the novelty of the subject-matter of claim 1 pursuant to Article 54(2) EPC. The board does not agree with this conclusion for the following reasons:

In the present case the information regarding the prior use lies completely with the respondent. Therefore, it is the respondent's duty to prove the prior use beyond reasonable doubt (Case Law of the Boards of Appeal of the EPO, 9th edition, 2019, I.C.3.5.2 b)). It is established case law that the following has to be clarified in order to determine whether an invention has been made available to the public by prior use: (i) when the prior use occurred, (ii) what was made available to the public through that use, and (iii) the

circumstances of the use, i.e. where, how and by whom the subject-matter was made public through that use (Case Law of the Boards of Appeal of the EPO, 9th edition, 2019, I.C.3.2.4 a)).

The respondent relied on T 952/92 for its argument that a complete analysis of the prior-use product was not required. It argued on that basis that it was sufficient to provide the information about all the patented features in order to demonstrate that the prior-use products fall under the terms of the contested claims. According to T 952/92 (Reasons 4), the question to be answered was: *"Has the Opponent established that Supersolve could have been analyzed before the priority date of the opposed patent, using known analytical techniques which were available for use by a skilled person at that time, so as to inform such skilled person that the composition of Supersolve was in accordance with the invention claimed in the opposed patent?"* Adapting this question to the present case by replacing "Supersolve" by 5FW-3, 9P-84, 9FW-1 or 10FW-1, the board finds that the answer is negative for the following reasons:

One of the requirements of claim 1 is that the article is to comprise a transition phase between the first and second phases, wherein the transition phase comprises at least a portion of each of the first, second, third and fourth pluralities of fibres which are intermingled with each other. Documents D9a and D9a2 provide information about ingredients used in the process for making the filters 5FW-3, 9P-84, 9FW-1 or 10FW-1, but do not give any information about the final product (except for its name). In point 4c of D9 it is stated that, as a result of the manufacturing process, some fibres from the top phase intermingle with some fibres

from the bottom phase. It is not stated that the four pluralities of fibres are intermingled with each other. D19 and D20 provide general information about the possibility of analysing and reproducing two-phase media from publicly available filters. However, they are completely silent as regards the structure of the interface. Thus, details about the interface of 5FW-3, 9P-84, 9FW-1 or 10FW-1 are lacking and it cannot be established beyond reasonable doubt that the composition of these filters was in accordance with the invention claimed in the opposed patent.

The argument that a wet-laid process would necessarily lead to intermingled fibres cannot be accepted since the exact composition of the filters is not known. There is no evidence that such an interface would always be formed by a wet-laid process independently of the process conditions and the whole composition of the filter.

This conclusion is not contradictory to the board's conclusion under Article 83 EPC. Indeed, the skilled person knows how to execute a wet-laid process to obtain intermingled fibres based on the teaching of the patent. However, it is not proven that any wet-laid process will lead to intermingled fibres in all cases.

Therefore, the board concludes that a public prior use of an article according to claim 1 has not been shown beyond reasonable doubt.

8. Article 112(1) (a) EPC:

The appellant requested a referral in the event of the prior use being recognised. Since that is not the case, its request is not considered.

The respondent was of the opinion that the board did not follow established case law as illustrated in T 952/92. Therefore a referral was necessary.

As is evident from point 7 above, the board does not deviate from said decision. In fact, it even uses a question contained therein to establish that the prior use has not been shown beyond reasonable doubt.

It is established case law that a question for which referral is requested must be relevant for deciding the case in question (Case Law of the Boards of Appeal of the EPO, 9th edition, 2019, V.B.2.3.3). This clearly does not apply here, as the board has been able to reach a conclusion without the need for a referral (see point 7 above). In addition, contrary to the respondent's point of view, there is no conflicting case law.

Therefore, there is no need to refer questions to the Enlarged Board of Appeal.

9. Article 11 RPBA 2020

Novelty and inventive step with respect to the cited prior-art documents D1 to D7 have not been part of the appealed decision. In view of the primary objective of appeal proceedings to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020) and in view of both parties' requests for a remittal, special reasons exist to remit the case to the opposition division (Article 11 RPBA 2020).

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 for further prosecution.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated