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**D E C I S I O N**  
of 20 February 1996

**Case Number:** T 0184/94 - 3.2.3  
**Application Number:** 84309124.0  
**Publication Number:** 0154094  
**IPC:** E04B 1/74, E04C 2/26

**Language of the proceedings:** EN

**Title of invention:**

Fibrous mat-faced gypsum board and its use in exterior insulation, in finishing systems for buildings and in shaft wall assemblies

**Patentee:**

Georgia - Pacific Corporation

**Opponent:**

Gebr. Knauf Westdeutsche Gipswerke

**Headword:**

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**Relevant legal provisions:**

EPC Art. 114(1), 113

**Keyword:**

"Late filed evidence (prima facie relevant); remittal of the case (yes, examination in two instances)"

**Decisions cited:**

T 0156/84, T 0273/84

**Catchword:**

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Case Number: T 0184/94 - 3.2.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.3  
of 20 February 1996

**Appellant:**  
(Opponent)

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**Representative:**

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**Respondent:**  
(Proprietor of the patent)

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**Representative:**

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**Decision under appeal:**

Interlocutory decision of the Opposition Division  
of the European Patent Office dated 21 September  
1993, posted on 18 November 1993, concerning  
maintenance of European patent No. 0 154 094 in  
amended form.

**Composition of the Board:**

**Chairman:** C. T. Wilson  
**Members:** F. Brösamle  
L. C. Mancini

## Summary of Facts and Submissions

I. In the oral proceedings of 21 September 1993 the Opposition Division upheld European patent No. 0 154 094 in amended form; the written decision within the meaning of Article 106(3) EPC was posted on 18 November 1993.

II. The independent claims upheld with the above decision read as follows:

"1. Gypsum board comprising a set gypsum core sandwiched between two sheets of single-ply porous glass fiber mat consisting exclusively of randomly distributed glass filaments bonded by an adhesive, both of which have an inner surface and an outer surface and a predetermined thickness, the inner surface of both of the mats being adhered directly to the gypsum core by set gypsum of the core penetrating into the thickness of the mats, the viscosity of the slurry used to prepare the core was controlled so that the outer surface of one of the mats is substantially free of set gypsum, with the set gypsum of the core penetrating but part-way into the thickness of the mat having the gypsum-free outer surface."

"9. A process for manufacturing in continuous fashion faced gypsum board of indefinite length comprising:

- (A) forming an aqueous slurry of calcined gypsum;
- (B) continuously feeding the aqueous slurry directly onto an underlying, moving and supported single-ply porous glass mat consisting exclusively of randomly distributed glass filaments bounded by an adhesive;
- (C) forming the deposited slurry into a panel-like shape as it is carried on the moving underlying mat;

(D) applying directly to the top surface of the panel like shape of slurry an overlying single-ply porous glass fiber mat consisting exclusively of randomly distributed glass filaments bonded by an adhesive and having a predetermined thickness; and

(E) maintaining the panel-like shape whilst the calcined gypsum sets to form a set gypsum core having the overlying mat adhered to one surface thereof; and

(F) controlling the viscosity of the slurry at a value such that said slurry penetrates but part-way into the thickness of the overlying mat so that, upon the setting of the calcined gypsum, the outer surface of the overlying mat is substantially free of set gypsum."

"13 An exterior insulation system for a building, including a support surface, insulating material having an inner surface and an outer surface, the inner surface of which is adhered to the support surface by an adhesive material, and an exterior finishing material overlying the outer surface of the insulating material, characterised in that the support surface comprises gypsum board according to any of claims 1 to 9 and the insulating material is substantially free of channels penetrating therethrough and between the inner and outer surfaces."

"17. A method for installing an exterior insulation system in a building comprising affixing thereto gypsum board, affixing insulating material having an inner surface and an outer surface to the gypsum board with an adhesive material, and affixing an exterior finishing material to the insulating material outer surface, characterised in that the gypsum board is gypsum board according to any of

claims 1 to 8 and is affixed such that its substantially gypsum-free outer surface faces away from the building, the insulating material inner surface is adhered to the gypsum-free outer surface of the gypsum board, the insulating material being substantially free of channels penetrating therethrough and between the insulating material inner and gypsum-free outer surfaces."

III. The Opponent - Appellant in the following - lodged an appeal against the above decision on 22 January 1994 paying the appeal fee on the same day. The Statement of Grounds of Appeal was filed on 25 March 1994.

He requests the annulment of the impugned decision and the revocation of the patent; these requests are essentially based on two prior uses of gypsum board, namely

- "Knauf - Fireboard 1982" presented in combination with "CONSTRUCTA Fachmesse des Bauens", Hannover, 3 to 10 February 1982, and
- "Statusseminar", Gelsenkirchen, held on 30 April 1982,

whereby he names the witnesses Dr Neuhauser and Hesterberg and files written statements on oath dated 24 January 1994. Moreover articles from "baustofftechnik 2/82" and from "der baustoffmarkt 1/82" were filed in this context. With letter of 8 February 1995 the brochure "Sonderdruck zum 3. Statusseminar" was filed for further substantiating the prior use in form of the "Statusseminar".

The Appellant moreover cited DE-A-2 755 879, US-A-3 666 581, US-A-4 238 445 and US-A-4 252 568 for proving that controlling of the viscosity of gypsum is known in combination with the production of gypsum boards.

- IV. The Proprietor - Respondent in the following - requests dismissal of the appeal and argues that the alleged prior use was not public in the meaning of Article 54 EPC and did not have the construction of the claimed gypsum board; the Affidavits produced by the Appellant do moreover "not disclose the features crucial for the invention directly and unequivocally" and it is held by the Respondent that these Affidavits were prepared "by parties interested in the outcome" of the appeal.
- V. Following the Board's communication pursuant to Article 110(2) EPC of 11 September 1995 in which the Board expressed its intention to remit the case to the first instance so that the newly introduced evidence could be examined in two instances according to Articles 111(1) and 114(1) EPC, both parties agreed to the remittal of the case to the Opposition Division for further prosecution, whereby the requests for oral proceedings before the Board were not upheld.

#### **Reasons for the Decision**

1. The appeal is admissible.
2. By introducing evidence as set out above in remark III the Appellant has created a completely new situation in respect of the validity of the European patent No. 0 154 094. The Board holds that this new evidence is prima facie so relevant that it has to be admitted to

the proceedings. The Respondent challenged whether the prior uses were public, and whether they disclosed the construction of the claimed gypsum board. These questions can only be decided by closely examining the individual circumstances of the case. It is obvious that it is only in the case that the alleged prior uses are seen directly and unequivocally to disclose the crucial features of the invention that they can be admitted to the proceedings. In this context the relevance of an Affidavit ("Eidesstattliche Erklärung") has also to be examined, especially since the Respondent is worried about the fact that the parties involved in the Affidavits could be "interested in the outcome" (of the appeal proceedings).

3. As already expressed in the Board's communication pursuant to Article 110(2) EPC the examination of the newly filed evidence seen singly **or in combination** with the prior art dealt with in the impugned decision has to be carried out in **two** instances. This can only be achieved by remitting the case to the first instance for further prosecution. The legal basis can be found in Article 111(1) EPC last sentence, (see also such decisions as T 156/84, OJ EPO 1988, 372 and T 273/84, OJ EPO 1986, 346), in which decisions it is made clear that late-filed evidence which is relevant with respect to the validity of the attacked patent has to be admitted to the proceedings. In T 156/84 it is stressed that the principle of examination by the EPO of its own motion (Article 114(1) EPC) takes precedence over the possibility of disregarding facts or evidence not submitted in due time. This follows from the EPO's duty vis-à-vis the public not to grant or maintain patents which it is convinced are not legally valid.

4. Since both parties agreed with the remittal of the case to the first instance the Board decides to avail itself of its power under Article 111(1) EPC in order to remit the case. Contrary to the opinion expressed in Respondent's letter of 11 January 1996 the first instance is not bound to examine **only** the alleged two prior uses ("Knauf - Fireboard" and "Statusseminar") but also - should the prior uses be acknowledged as prior art within the meaning of Article 54(2) EPC - to examine this prior art in combination with the prior art already dealt with in the impugned decision, Article 114(1) EPC.

**Order**

**For these reasons it is decided that:**

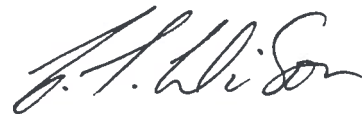
1. The impugned decision is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:



N. Maslin

The Chairman:



C. T. Wilson