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D E C I S I O N
of 20 March 2001

Case Number: T 0048/98 - 3.3.7

Application Number: 89112899.3

Publication Number: 0358881

IPC: B32B 3/10

Language of the proceedings: EN

Title of invention:
Use of a plastic sheet

Patentee:
I.P.B. N.V.

Opponent:
Kaysersberg Packaging

Headword:
-

Relevant legal provisions:
EPC Art. 113(1); 111(1); 54(2)
EPC R. 67

Keyword:
"Basis of decisions - right to be heard (no)"
"Novelty - after amendment (yes)"
"Decisions re appeals - remittal (yes); reimbursement of
appeal fee (yes)"

Decisions cited:
T 0811/90, T 0125/91, T 0804/94

Catchword:
-



Case Number: T 0048/98 - 3.3.7

D E C I S I O N
of the Technical Board of Appeal 3.3.7
of 20 March 2001

Appellant: Kaysersberg Packaging
(Opponent) 11, Route Industrielle
F-68320 Kunheim (FR)

Representative: David, Daniel
KAYSERSBERG
Service Propriété Industrielle
23 Boulevard Georges Clemenceau
F-92402 Courbevoie Cédex (FR)

Respondent: I.P.B. N.V.
(Proprietor of the patent) Steenovenstraat 30
B-8790 Waregem (BE)

Representative: Leherte, Georges M.L.M., Dr.
K.O.B n.v.
Pres. Kennedypark 31c
B-8500 Kortrijk (BE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 15 October 1997
rejecting the opposition filed against European
patent No. 0 358 881 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: R. E. Teschemacher
Members: R. Young
G. Santavicca

Summary of Facts and Submissions

- I. The mention of the grant of European patent No. 0 358 881, in respect of European patent application No. 89 112 899.3, filed on 14 July 1989 and claiming a BE priority of 31 August 1988 (BE 8800991), was published on 30 August 1995 (Bulletin 95/35). Claim 1 read as follows:

"Use of a plastic sheet comprising two or more parallel films (1,2) connected to each other by parallel partitions (3) which stand on the films, run along one lengthwise direction and bound lengthwise tubes (4) whereas one or more of the films (1,2) is (are) perforated over all or part of its (their) surface, as a sheet allowing through the air humidity but being relatively watertight."

Claims 2 to 4 were dependent claims directed to elaborations of the use of a plastic sheet according to Claim 1. Claim 4 in particular was directed to such use as a packing material.

- II. Notices of opposition were filed, on 30 May 1996, by Opponent I (Kaysersberg Packaging), on the grounds of lack of novelty and lack of inventive step (Article 100(a) EPC); and by Opponent II (Enplast), on the grounds of lack of novelty and lack of inventive step (Article 100(a) EPC), insufficient disclosure (Article 100(b) EPC) and added subject-matter (Article 100(c) EPC), whereby Opponent II but not Opponent I requested oral proceedings.

The oppositions were supported *inter alia* by the documents:

D1: FR-A-2 384 901;

D2: SU-A-1 371 615, considered in the form of a translation into French (D2a); and

D3: FR-A-2 228 607.

III. With a letter received on 16 June 1997, Opponent II withdrew its opposition.

IV. On 28 July 1997, the Opposition Division issued a summons to oral proceedings to be held on 11 December 1997. The summons was accompanied by a Communication of the Opposition Division *inter alia* setting a final date for submissions of one month prior to the date of the oral proceedings.

V. With a decision signed by all three members of the Opposition Division on 8 October 1997, and issued in writing on 15 October 1997, the Opposition Division rejected the remaining opposition, a similarly signed notification, dated 9 October 1997, of cancellation of the oral proceedings having been communicated by fax to Opponent I on 10 October 1997.

According to the decision, the requirements of Article 113(1) EPC had been met in relation to Opponent I (Kaysersberg Packaging), since the latter party had at no stage itself filed a request for oral proceedings. Consequently, Opponent I could not have expected to be able to rely on oral proceedings to present its arguments.

As to the substantive issues, the following findings were made:

- (i) The grounds mentioned in Article 100(b) and (c) did not prejudice maintenance of the patent unamended.

- (ii) Furthermore, as to novelty, whilst D1 complied with all the constructional features of the plastic sheet mentioned in Claim 1, it did not disclose the use of the sheet to which Claim 1 was directed. Thus D1 was not novelty destroying for the subject-matter claimed in the patent in suit. Neither did D2 or D3 disclose such subject-matter, because D2 did not specify the material as being plastic, and D3 related to a process in which the hollow structure was filled with a foam material, without disclosing any use to let through humidity.

- (iii) Finally, as to inventive step, the only prior art qualifying as closest prior art was that described in the patent in suit itself, namely in column 1, lines 24 to 56, from which the subject-matter of both Claims 1 and 4 differed in that one or more of the parallel films in the sheet used was or were perforated. It could be seen, moreover, from the technical results filed during the examination proceedings, that such perforations did give an improvement in air moisture transmissibility. Whilst it might be considered obvious to bring perforations to such prior art, the latter did not itself mention perforations. Furthermore, the uses disclosed in D1 (drainage) were so dissimilar to those in the patent in suit that a skilled person trying to find a solution to the stated problem would not consider D1. Neither would he consider D3, since

it did not relate to air moisture transmissibility. Whilst D2 did disclose a use of some sort of planar material for letting air moisture through while preventing the backflow of liquid water, the teaching required additional facilities, on the holes allowing air humidity to pass through, for preventing such backflow. These additional facilities made the use in applications such as packaging impossible. Hence, the subject-matter of both Claims 1 and 4 involved an inventive step, as did that of dependent Claims 2 and 3.

VI. On 23 December 1997, a Notice of Appeal against the above decision was filed by Opponent I, the prescribed fee being paid on the same day.

In the Statement of Grounds of Appeal, filed on 20 February 1998, the Appellant (Opponent I) argued, in relation to the issue of novelty, in substance as follows:

The decision under appeal had failed to appreciate the full scope of the teaching of D1. Whilst the primary application related to the drainage of soil the scope of the document extended to all applications concerning analogous problems such as when one wished to extract fluid. Whilst the decision under appeal had taken the view that the drainage function according to D1 was different from that according to the patent in suit, nevertheless the latter did nothing more than aim at the function of drainage in a broad sense, that is to say capturing and removing fluid from the area in which the sheet was placed. In the latter connection, when the structure according to D1 was associated with a

wall for drying the latter, it fulfilled exactly the same function, the humidity of the environment being received in the interior of the structure and removed by the canals. Thus, D1 taught not only the general concept of extracting a fluid from an environment but also the particular application in the building industry for collecting environmental humidity. Hence, the subject-matter of Claims 1, 2 and 3 of the patent in suit lacked novelty over the disclosure of D1.

The Appellant further argued that the cancellation, by the Opposition Division, on 10 October 1997, of the oral proceedings set for 11 December 1997, after the parties had been summoned but before the final date for filing observations amounted to a serious procedural violation justifying reimbursement of the appeal fee.

- VII. The Respondent (Patentee) disagreed, in a submission received on 29 May 1998, with the arguments of the Appellant and observed in particular, that the arguments of the Appellant did not go beyond those already presented during the opposition proceedings, which had, however, been thoroughly dealt with in the decision under appeal.
- VIII. Oral proceedings were held before the Board on 20 March 2001. During the oral proceedings, and following a discussion of the novelty of the subject-matter claimed in the patent in suit in the light, in particular, of the disclosure of D1, the Respondent presented, in order to meet the objections made, as sole request, an amended set of Claims 1 to 3, which read as follows:
- "1. Use, for the production of a breathing pack, of a plastic sheet comprising two or more parallel films

(1,2) connected to each other by parallel partitions (3) which stand on the films, run along one lengthwise direction and bound lengthwise tubes (4) whereas one or more of the films (1,2) is (are) perforated over all or part of its (their) surface, the sheet allowing through the air humidity but being relatively watertight.

2. Use according to claim 1, **characterized in that** all films (1,2) are perforated.

3. Use according to claim 1, **characterized in that** all films (1,2) are perforated at the level of the tubes (4)."

IX. The Appellant (Opponent) requested:

- (1) that the decision under appeal be set aside,
- (2) that the patent in suit be revoked, or, in the alternative, that the case be remitted to the first instance for further prosecution on the basis of claims 1 to 3 submitted during the oral proceedings,
- (3) the reimbursement of the appeal fee.

The Respondent (Patentee) requested that the patent be maintained on the basis of the set of Claims 1 to 3 forming the sole request as submitted during the oral proceedings, and a description yet to be adapted.

Reasons for the Decision

1. The appeal is admissible.

2. *Admissibility of amendments*

Claim 1 differs from Claim 1 of the patent as granted by the insertion, after the first word "use", of the phrase "for the production of a breathing pack," together with the consequential syntactical amendment, in the prepenultimate line of the claim, of the phrase "as a sheet allowing..." to read "the sheet allowing...".

Correspondingly, the phrase "use of a plastic sheet according to Claim 1", has been amended, in Claims 2 and 3 as granted, to read "use according to Claim 1" in each case, and Claim 4 as granted has been deleted.

2.1 A basis for the amendment to Claim 1 is to be found at column 2, lines 56 to 58 of the description of the patent in suit as granted, which states that "The sheets considered in the use according to the invention have the advantage that they can be used for the production of a breathing pack.", the corresponding passage being present in the description as originally filed (sentence bridging pages 2 and 3; printed specification, column 2, lines 16 to 18). This statement clearly applies generally to all the claimed embodiments of the plastic sheet.

The amendments to Claims 2 and 3 do no more than provide consistency with the amended wording of claim 1 and conciseness, and are thus equally supported by the original disclosure.

Hence, there is no contravention of Article 123(2) EPC

in the amendments undertaken in the claims.

Nor is there any contravention of Article 123(3) EPC, since the nature of the amendment is to restrict the claim to a particular application.

3. *Novelty*

None of the documents D1, D2 and D3 cited in the proceedings discloses a breathing pack of any kind, let alone one in which a sheet as defined in Claim 1 of the patent in suit has been used. This was not disputed by either of the parties. Consequently, the Board finds that the subject-matter claimed in the patent in suit is novel in the light of the state of the art represented by these documents.

4. *Further prosecution; Remittal*

It is evident that Claim 1 of the patent in suit has been restricted by incorporation of a feature which is not to be found in any of the claims as granted, but which has been taken from the description of the patent in suit. It is also of significance for the further procedure in this case that the emphasis in the proceedings so far has been on an aspect of the subject-matter of the patent in suit (building industry) which has practically nothing to do with packaging. To this extent, the amendment made in Claim 1 during the oral proceedings shifts the focus into a different area. In other words, the Board is effectively confronted with a new case.

In view of the above situation, which could not have been foreseen by the Appellant, the Board finds it

appropriate, in accordance with the relevant request of the Appellant, to make use of its powers under Article 111(1) EPC to refer the matter back to the first instance for further prosecution.

5. *Reimbursement of appeal fee*

The Board further finds it appropriate, under the circumstances of the case (which include the substantial success of the appeal so far) to order reimbursement of the appeal fee.

5.1 The Board cannot accept the Opposition Division's view that the Appellant could not be taken by surprise by the decision under appeal. It is true that the Appellant had not requested oral proceedings and, therefore, the Opposition Division was entitled to cancel the summons. However, the Opposition Division was not entitled to issue its decision without previously informing the parties of the envisaged course of action. The parties are informed by such a summons that they will be heard in oral proceedings. Therefore, once oral proceedings have been arranged, it is legitimate for the parties to expect that oral proceedings will actually take place unless and until they are notified otherwise. Thus, it was the Opposition Division's duty to inform the parties as soon as possible of its change of attitude towards holding oral proceedings after the withdrawal of opposition II (see T 811/90, OJ EPO 1993, 728, headnote I).

5.2 In addition, the parties were informed of the final date for making written submissions in reply to the communication accompanying the summons, this date being

11 November 1997. The Opposition Division's decision had, however, already been given to the EPO postal service on 10 October 1997, the same date on which the Appellant was informed by fax that the oral proceedings were cancelled and the procedure would be continued in writing. The right to be heard is violated if a decision is taken before expiry of a time limit for responding to a communication (T 804/94, dated 10 July 1995, cited in Case Law of the Boards of Appeal, 3d ed 1998, VII.D.15.4.6; T 125/91, dated 3 February 1992, not published in OJ EPO). In fact, the Opposition Division excluded any possibility for the Appellant to react after he had been informed of the cancellation of the oral proceedings.

5.3 Before that notification, from the Appellant's perspective, there was no reason whatsoever for suspecting that the withdrawal of opposition II might cause the Opposition Division to cancel the summons. The opposition had been withdrawn by letter dated 13 June 1997, received in the EPO on 16 June 1997. The summons was issued only thereafter on 28 July 1997. Therefore, the Appellant had reason to believe that the Opposition Division had issued the summons knowing that the only opponent having requested oral proceedings was no longer a party to the proceedings.

5.4 In summary, the course of action taken by the Opposition Division in excluding the Appellant's right to be heard amounts to a substantial procedural violation. Since the Appellant was prevented from submitting his case in first instance proceedings after withdrawal of opposition II, reimbursement of the appeal fee under Rule 67 EPC is considered equitable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of claims 1 to 3 submitted as sole request during the oral proceedings.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

C. Eickhoff

R. E. Teschemacher