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D E C I S I O N
of 8 August 2001

Case Number: T 0458/98 - 3.2.3

Application Number: 89870134.7

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Language of the proceedings: EN

Title of invention:
Use of a masking means and masking means

Patentee:
Silvestre, Jean

Opponents:
OI: Beiersdorf AG
OII: Vosschemie GmbH
OIII: Ormantine International Ltd.

Headword:
-

Relevant legal provisions:
EPC Art. 54

Keyword:
"Novelty (no)"

Decisions cited:
-

Catchword:
-



Case Number: T 0458/98 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 8 August 2001

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Decision under appeal: Decision of the Opposition Division of the European Patent Office dated 10 February 1998, posted on 10 March 1998, revoking European patent No. 0 365 510 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: F. Brösamle
J.-P. Seitz

Summary of Facts and Submissions

I. In the oral proceedings of 10 February 1998 the opposition division revoked European patent No. 0 365 510 pursuant to Article 102(1) EPC, whereby the written decision was posted on 10 March 1998.

II. The independent claims 1 and 10 of European patent No. 0 365 510 read as follows:

"1. Use of an elongate compressible and bendable foam cushion that is resistant to surface treatment for masking at least a part of a surface to be treated, said cushion being removably applied on said part of said surface to be treated and removed after finishing said treatment."

and

"10. A masking means for masking at least a part of a surface to be treated, wherein said masking means is made of a material that is resistant to the surface treatment and adapted to be removably applied to said part of said surface to be treated, characterised in that said masking means comprises an elongate compressible and bendable foam cushion."

III. In its decision the opposition division came to the result that in the light of

(D5) JP-U-158470 and its English translation

the subject-matter of granted claims 1 and 10 is not novel.

IV. Against the above decision of the opposition division the patentee - appellant in the following - lodged an appeal on 6 May 1998 paying the appeal fee on the same day. The statement of grounds of appeal was filed on 8 July 1998.

He requests to set aside the impugned decision and to maintain the patent as granted.

V. Opponents I and II - respondents I and II in the following - request to dismiss the appeal. Opponent III has been silent in the appeal proceedings.

VI. The arguments of the parties in support of their above requests essentially can be summarised as follows:

(a) appellant

- (D5) is not a novelty-destroying document with respect to the subject-matter of claims 1 and 10; (D5) is clearly restricted to the combination of a panel "b" and the boundary element "3"; the boundary element in (D5) acts as a barrier preventing paint penetration and has the function to block the gap between neighbouring elements and has not the function of masking;
- (D5) does not disclose the use of the foam element "3" without the panel "b" in that masking is carried out by panel "b" and paint penetration by the foam element "3"; only by hindsight could a skilled person interpret (D5) as a novelty-destroying anticipation;

- the boundary line "X" of (D5) has to be determined before the boundary element is applied so that line "X" defines the boundary line and the element "3" as such;
- (D5) is silent about the "bendable properties" and the "compressibility" of the used boundary element and it is not mentioned that the boundary element closely conforms to the surface to which it is applied; notch "3b" is provided for absorbing any force exerted on the boundary element and would not be necessary if it had sufficient compressibility;
- summarising, from (D5) not all features of claims 1 and 10 can be derived.

(b) respondents I and II (see letters of 11 and 18 January 1999):

- (D5) teaches to apply the boundary layer "3" along a line "X" and thereafter to position a cover "b"; the boundary layer in (D5) acts as a barrier against paint penetration as set out in EP-B1-0 365 510 in column 6, lines 18 ff, and Figures 3/4, so that the claimed use according to claim 1 is known;
- the boundary layer known from (D5) has a double function, namely to cover an area with its adhesive layer and to act with its foamed body as a barrier, blocking any available gap between structural elements;
- with respect to Figure 3A of (D5) it is evident

that "3" covers an area along the line "X" whereas element "b" is an additional cover element; it is not the result of an *ex post facto* analysis that the claimed and known boundary element achieves the same effects since in (D5) a foamed article is disclosed which is elongate, compressible and bendable, which article is in addition resistant to surface treatment and to be used for masking at least a part of a surface to be treated and which is removable after finishing the surface treatment;

- it has to be observed that (D5) is a novelty-destroying prior art since the appellant failed to indicate that claims 1 and 10 are distinguished from (D5) by any specific feature since the embodiments of EP-B1-0 365 510 and of (D5) are identical and since only in granted claim 14 is the form of the boundary layer specified as being substantially cylindrical but not in the independent claims 1 and 10 to be considered.

Reasons for the Decision

1. The appeal is admissible.
2. The crucial issue to be decided is novelty. Since granted claims 1 and 10 are closely related and contain the same technical features they can be dealt with simultaneously in the following.
3. From (D5) and its English translation filed at the oral

proceedings dated 10 February 1998 an elongate foam cushion "3" is known, see page 1, claim 1 and page 2, lines 31 to 34, which cushion is resistant to surface treatment. For a skilled person it is obvious that the foam of polyethylene resin offers properties as "compressible" and "bendable", see in particular claim 2 of (D5) where the nature of the foam is specified within a wide range and see Figure 3A and its line "X" on which the boundary layer has to be applied. For any skilled person it is clear that a line "X" as shown can only be covered by an elongate article which is compressible and bendable since the inner radius of any bend requires compressibility of the boundary layer and since the **three dimensional** object "a" to be coated requires bendability of the boundary layer to be applied; otherwise it would not be possible to apply the boundary layer to the shown object to be treated according to (D5). It has to be added that the bendability and compressibility of the boundary layer disclosed in (D5) can be **enhanced** by a notch "3b", see Figure 5 and page 3, line 39 to page 4, line 3, if required i.e. if a substantial lateral movement of neighboured structural elements (door/frame) is to be mastered.

4. Whether or not the word "masking" is used in the English translation of (D5) is irrelevant; what counts is the technical information derivable from this document for a person skilled in the art. Applying a boundary layer "3" along a line "X" to an object "a" to be treated **prior to the treatment** means **masking** of an area which should not be surface treated whether disclosed in these exact terms or not. Appellant's contrary findings are therefore not to be followed by the Board since identical technical features must

produce identical effects irrespective of the wording used in EP-B1-0 365 510 and in (D5). These findings are moreover supported by identical structural configurations according to Figures 4 in EP-B1-0 365 510 and (D5), namely the arrangement of a boundary element covered with an adhesion element between a fixed and a movable structural element in that the elongate boundary element acts simultaneously as a **masking means** and a **barrier** against penetration of paint/dust...

5. Neither claim 1 nor claim 10 exclude by their wording the existence of a cover as disclosed in (D5) in case of large areas to be masked; the known cover "b" has therefore to be seen as a means for covering larger areas in the sense of masking so that in (D5) the combination of a boundary element and a cover achieves an **extra effect** without, however, teaching away from what is claimed in claims 1 and 10 of EP-B1-0 365 510. Appellant's argument that (D5) can only be considered to disclose the subject-matter of claims 1 and 10 by hindsight is therefore not supported by the facts.

In his statement of grounds of appeal the appellant dealt with line "X" of Figure 5 of (D5) and the application of the boundary element. It is observed that claims 1 and 10 are not restricted to any geometric line to be masked/covered, rather to the use of an elongate, compressible and bendable foam cushion and a masking means.

The board is convinced that the known foamed boundary element is able to be applied closely to any surface to be masked due its bendability and compressibility whether mentioned expressis verbis in (D5) or not since

again identical technical features must produce identical technical effects. The known notch "3b" is not a replacement feature for compressibility and bendability of the boundary element but is rather intended to achieve an extra effect so that this known feature again does not teach away from the subject-matter of claims 1 and 10. Since claims 1 and 10 are not restricted to a specific form of the boundary element, for instance being substantially cylindrical, this feature cannot serve as a distinguishing feature with respect to (D5).

6. Summarizing the above considerations, (D5) is novelty-destroying prior art to the subject-matter of granted claims 1 and 10 so that appellant's findings to the contrary have to be rejected. Granted claims 1 and 10 not defining novel subject-matter they are not valid and the patent in suit cannot be maintained on that basis.

7. With a letter dated 19 July 2001 respondent II filed an English and German translation of (D5) to facilitate the understanding of (D5). The board's findings are, however, not based on these translations, Article 113(1) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Counillon

C. T. Wilson