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D E C I S I O N
of 25 October 2002

Case Number: T 0631/99 - 3.3.5

Application Number: 93923712.9

Publication Number: 0642476

IPC: C03C 25/02

Language of the proceedings: EN

Title of invention:

Glass fiber binding compositions, process of binding glass fibers, and glass fiber compositions

Patentee:

Schuller International, Inc.

Opponent:

Rockwool International A/S

Headword:

Binding compositions/SCHULLER

Relevant legal provisions:

EPC Art. 123(3)

Keyword:

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Decisions cited:

-

Catchword:

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Case Number: T 0631/99 - 3.3.5

D E C I S I O N
of the Technical Board of Appeal 3.3.5
of 25 October 2002

Appellant: Schuller International, Inc.
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Representative: Grättinger & Partner (GbR)
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Respondent: Rockwool International A/S
(Opponent) Hovedgaden 584, Entrance C
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Representative: Land, Addick Adrianus Gosling
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 22 March 1999
revoking European patent No. 0 642 476 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: R. K. Spangenberg
Members: M. M. Eberhard
J. H. Van Moer

Summary of Facts and Submissions

I. The appeal is from the decision of the opposition division revoking European patent No. 0 642 476. The patent was granted in response to European patent application No. 93 923 712.9 having the international filing date of 17 May 1993. Granted claim 1 has the following wording:

"1. A glass fiber binding composition comprising an effective binding amount of an aqueous compatible furan resin and 20.9 to 99 percent by weight water, the total being 100% by weight."

The decision under appeal was based on two sets of amended claims filed on 24 February 1999, as a main request and an auxiliary request. Claim 1 of the main request reads as follows:

"1. Use of a glass fiber binding composition comprising an effective binding amount of an aqueous compatible furan resin and 15 to 99 percent by weight water, the total being 100% by weight, for preparing, by spraying newly formed glass fibers with said binding composition, a binder-coated glass fiber mat product having a binder solids content of from 1 weight percent to 25 weight percent relative to the weight of said binder-coated glass fiber mat product, and being compressible in thickness by a factor of from 4 to 12, the binder does not fill the interstitial spaces between glass fibers of the glass fiber mat product."

Claim 1 of the auxiliary request differs from claim 1 of the main request only by the introduction of the phrase "the glass fiber mat product having a recovery

of at least 60%" at the end of the claim.

- II. In its decision, the opposition division considered that the claimed subject-matter lacked an inventive step over the disclosure of D1/D2 (ie DE-A-31 26 800; CA 1 200 336 respectively) in combination with the common general knowledge as illustrated in D18 (Fiber glass, J. Gilbert Mohr, William P. Rowe, pages 22-23), or over the combination of D3/D4 (US-A-3 854 998; GB-A-1 296 716) with D18.
- III. In the statement of grounds of appeal, the appellant presented arguments as to why the decision under appeal was not correct in considering that the claimed subject-matter was obvious in view of the disclosure of D1/D2 and D18, on the one hand, or D3/D4 and D18 on the other hand.
- IV. In reply to the statement of grounds of appeal, the respondent expressed doubts about the admissibility of the appeal. He argued in this respect that the appellant had merely reiterated the argumentation already presented during the oral proceedings. He had not presented any arguments as to why the decision should be overturned apart from stating in paragraph 4.1 of the grounds that the statements of the opposition division had to be considered as speculative. The respondent further countered the appellant's comments concerning the issue of inventive step. He requested that the appeal be dismissed and that oral proceedings be held, should the board come to another conclusion. With a letter dated 8 June 2001 the respondent informed the board that he withdrew from participation in the appeal.

- V. In a communication dated 18 July 2002, enclosed with the summons to oral proceedings, the board informed the parties of its provisional opinion that claim 1 of the main request did not appear to meet the requirements of Article 123(3) EPC as it was extended to the use of a binding composition having a water content from 15 to 99 wt%. Doubts were also expressed as to whether or not the feature "the binder does not fill the interstitial spaces between the glass fibres of the glass fibre mat" introduced in claims 1, 14 and 28 of the main request met the requirements of Article 123(2) EPC.
- VI. In a letter dated 15 October 2002 the appellant informed the board that he withdrew his request for oral proceedings and would not attend the oral proceedings. The board cancelled the oral proceedings on 25 October 2002.
- VII. The appellant requested in writing that the decision under appeal be set aside and that the patent be maintained with the claims according to the main request as filed on 24 February 1999, alternatively with the claims according to the auxiliary request filed at the same date. The respondent withdrew its participation from the appeal on 8 June 2001.

Reasons for the Decision

1. The board is satisfied that the appeal is admissible. The statement of grounds of appeal contains, particularly in point 4.1, reasons why the decision under appeal is not correct, namely that the content of the citations D1/D2 was not interpreted correctly by the opposition division. It is further explained why

the documents were not interpreted correctly and what these documents actually disclose.

2. In a communication dated 18 July 2002, the board informed the parties of its provisional opinion that claim 1 of the main request did not meet the requirements of Article 123(3) EPC. The board pointed out in this respect that:

"It is questionable whether claim 1 of the main request meets the requirements of Article 123(3) EPC. Granted claim 1 is directed to a glass fibre binding composition comprising an effective binding amount of an aqueous compatible furan resin and 20.9 to 99 wt% water. Therefore all compositions having a water content of less than 20.9 wt% were excluded. However, the use as defined in amended claim 1 of the main request encompasses using a glass fibre binding composition with a water content of 15 to 99 wt% for preparing a binder-coated glass fibre mat. Therefore the water content of this binding composition may vary in a broader range than the range stated in granted claim 1. It would appear that the protection conferred by the patent has been extended to the use of glass fibre binding compositions having water contents from 15 to <20.9 wt%."

3. The appellant did not present any comments in reply to this objection, withdrew his request for oral proceedings and indicated that he would not attend the oral proceedings. After review of the case and in the absence of comments from the appellant, the board comes to the conclusion that the amendments in claim 1 of the main request do not meet the requirements of Article 123(3) EPC for the reasons given in the said

communication.

4. As already pointed out in the communication dated 18 July 2002, the same objection under Article 123(3) EPC applies likewise to claim 1 of the auxiliary request. Therefore the auxiliary request must also fail for the reasons given above.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

U. Bultmann

R. Spangenberg