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**Datasheet for the decision
of 8 April 2009**

Case Number: T 0235/08 - 3.3.07

Application Number: 99942854.3

Publication Number: 1117865

IPC: D06N 7/00

Language of the proceedings: EN

Title of invention:

Nonwoven backing and carpet comprising same

Patent Proprietors:

Colbond B.V.

Opponents:

Carl Freudenberg KG

Headword:

-

Relevant legal provisions:

EPC Art. 69, 8, 123(2)(3)

EPC R. 80

Relevant legal provisions (EPC 1973):

EPC Art. 83, 84, 100(b), 111(1)

Keyword:

"Amendments - added subject-matter (no)"

"Amendments - extension of scope (no)"

"Amended claims - clarity (yes)"

"Decision re appeals - remittal (yes)"

Decisions cited:

G 0004/92, T 0202/92

Catchword:

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Case Number: T 0235/08 - 3.3.07

D E C I S I O N
of the Technical Board of Appeal 3.3.07
of 8 April 2009

Appellants:
(Patent Proprietors)

Colbond B.V.
Westervoortsedijk 73
6827 AV Arnhem (NL)

Representative:

Oberlein, Gerriet H. R.
CPW GmbH
Kasinostraße 19-21
D-42103 Wuppertal (DE)

Respondents:
(Opponents)

Carl Freudenberg KG
Höhnerweg 2-4
D-69469 Weinheim/Bergstraße (DE)

Representative:

Ripper, Monika Sigrid
Carl Freudenberg KG,
Höhnerweg 2-4
D-69469 Weinheim (DE)

Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 12 December 2007
revoking European patent No. 1117865 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: S. Perryman
Members: G. Santavicca
B. ter Laan

Summary of Facts and Submissions

I. The appeal lies from a decision of the Opposition Division revoking European patent N° 1 117 865 (granted on European application N° 99 942 854.3, which is based on International application number PCT/EP99/05892 having the international publication number WO 00/12800). Claim 1 as originally filed read as follows:

"1. A nonwoven primary carpet backing comprising thermoplastic polymer filaments or fibres bonded by means of a binder polymer, characterised in that the backing comprises at least a distinguishable thermoplastic woven layer, a distinguishable thermoplastic continuous layer, or a distinguishable nonwoven layer also comprising filaments or fibres bonded by means of a binder polymer, which layer reduces the delamination strength of the backing, measured in accordance with DIN 54310, by at least 30% and preferably by at least 50%, with respect to the same backing without the said distinguishable layer."

II. The patent in suit was granted with 9 Claims reading as follows:

"1. A nonwoven primary carpet backing comprising thermoplastic polymer filaments or fibres bonded by means of a binder polymer, characterised in that the backing consists of two or three distinguishable layers, wherein distinguishable indicates that the transition from one layer to the next is essentially not gradual, the distinguishable layer selected from a group consisting of a

distinguishable thermoplastic woven layer, a distinguishable thermoplastic continuous layer, or a distinguishable nonwoven layer also comprising filaments or fibres bonded by means of a binder polymer, wherein the delamination strength of the backing, measured in accordance with DIN 54310 is reduced by at least 30% and preferably by at least 50%, with respect to the same backing without the said distinguishable layers."

"2. The nonwoven backing according to claim 1 wherein each of the said layers comprises thermoplastic polymer filaments or fibres thermally bonded by means of a binder polymer and wherein the concentration and/or the bonding temperature of the binder polymer in the layer which reduces the delamination strength of the backing is at least 20%, preferably at least 30% lower and/or at least 4°C, preferably at least 6°C higher than that of the binder polymer in the other layer or layers."

"3. The nonwoven backing according to any one of the preceding claims wherein the binder polymer in at least one of the layers forms at least part of the outer surface of the filaments or fibres."

"4. The nonwoven backing according to claim 3 wherein filaments or fibres are sheath/core filaments or fibres with the binder polymer forming the sheath."

"5. The nonwoven backing according to any one of the preceding claims wherein the binder polymer in at least one of the layers is selected from the group consisting of polyamide 6, copolyamides, polybutylene terephthalate, copolyesters, polypropylene,

copolypropylene, polyethylene, and mixtures of one or more of these materials."

"6. The nonwoven backing according to any one of the preceding claims wherein the thermoplastic polymer building the filaments or fibres in at least one of the layers is selected from the group consisting of polyester, polyamide 6, polyamide 46, polyamide 66, copolyamides, and copolyesters."

"7. The nonwoven backing according to any one of the preceding claims wherein the linear density of the filaments or fibres is in the range from 1 to 25 dtex, preferably in the range from 5 to 20 dtex."

"8. The nonwoven backing according to any one of the preceding claims having a delamination strength lower than 6 N."

"9. Carpet comprising the nonwoven primary backing according to any one of the preceding claims."

III. The patent was opposed on the grounds that the disclosure was insufficient (Article 100(b) EPC) and the claimed subject-matter lacked novelty and an inventive step (Article 100(a) EPC) having regard to D1 (EP-A-0 677 607) and D2 (EP-B-0 619 849).

IV. The decision under appeal was based on three sets of Claims 1 to 9, identified, respectively, as Main, First and Second Auxiliary Requests, each set of claims being based on an amended Claim 1 submitted during the oral proceedings held on 26 November 2007 as well as on Claims 2 to 9 as granted.

V. The Opposition Division revoked the patent on the basis of reasoning which can be summarised as follows:

- (a) The wording of Claim 1 of the Main Request before it did not clearly define the layout of the "same backing without the said distinguishing layers" (herein after the reference or comparative backing).
- (b) Although Claim 1 of the First Auxiliary Request before it had been limited by specifying that the layer responsible for the reduction of the delamination strength was embedded in the backing,
- (c) and although Claim 1 according to the Second Auxiliary Request before it was further limited by specifying that the backing had two identical outer layers, those limitations concerned the backing itself without providing adequate further definition for the reference backing, so that the lack of clarity objection applied also to them.
- (d) Therefore, the patent was revoked.

VI. With the statement setting out the grounds of appeal, the appellants submitted an amended Claim 1 that, together with Claims 2 to 9 as granted, constituted their Main Request.

In response to a communication dated 19 January 2009 of the Board in preparation for the oral proceedings, the appellants submitted a new Main Request and new First to Sixth Auxiliary Requests, replacing the requests then on file (letter dated 6 March 2009).

VII. In their response to the statement setting out the grounds of appeal, dated 14 August 2008, the respondents objected that the amended claims were not clear and contravened the requirements of Article 123, paragraphs 2 and 3, EPC, as well as not overcoming the grounds of opposition.

In response to the communication of the Board (*supra*), the respondents announced that they would not attend the scheduled oral proceedings and maintained their requests (letter dated 4 March 2009).

VIII. Oral proceedings were held on 8 April 2009, in the absence of the respondents (Rule 115(2) EPC). After discussion of the clarity (Article 84 EPC) and allowability of the amendments (Article 123(2)(3) EPC) of the requests already submitted, the appellants submitted a fresh Main Request made up of six claims, Claim 1 reading as follows (the amendments to Claim 1 as granted are indicated as follows: deletion in strikethrough, addition in bold):

"1. A nonwoven primary carpet backing comprising thermoplastic polymer filaments or fibres bonded by means of a binder polymer, characterised in that the backing consists of ~~two or~~ three distinguishable layers, wherein distinguishable indicates that the transition from one layer to the next is essentially not gradual, ~~the distinguishable layer selected from a group consisting of a distinguishable thermoplastic woven layer, a distinguishable thermoplastic continuous layer,~~ **or wherein one of the distinguishable layers reduces the delamination strength of the backing and is a distinguishable nonwoven layer also comprising**

~~filaments or fibres bonded by means of a binder polymer,~~
wherein the distinguishable layer which reduces the delamination strength of the backing is embedded in the backing as an inner layer between two outer layers and wherein each of the three distinguishable layers comprises thermoplastic polymer filaments or fibres thermally bonded by means of a binder polymer, wherein the concentration of the binder polymer in the layer which reduces the delamination strength of the backing is at least 20% lower and/or the bonding temperature of the binder polymer in the layer which reduces the delamination strength of the backing is at least 4°C higher than that of the binder polymer in the outer layers, wherein the delamination strength of the backing measured in accordance with DIN 54310 is reduced by at least 30% ~~and preferably by at least 50%,~~ with respect to the same backing without the said distinguishable layers **which reduces the delamination strength of the backing, wherein the delamination strength of the backing measured in accordance with DIN 54310 is lower than 6N, wherein the filaments or fibres are sheath/core filaments or fibres with the binder polymer forming the sheath, and wherein the linear density of the filaments or fibres is in the range from 1 to 25 dtex.**"

IX. The appellants essentially argued as follows:

Article 123(2) EPC

- The amended claims were based on the claims and on the description as originally filed, in particular on Claim 1 as filed.

Article 84 EPC

- The expressions in claim 1 as granted which were illogical or which, taken at face value, made no technical sense had been removed or amended, so that the claims were clear.

- In general, both the carpet backing and the reference backing had been more narrowly and clearly defined, e.g. the delamination strength was also defined as absolute value, so that Claim 1 had been restricted and was thus related closely to and was illustrated by the examples in the patent in suit.

- According to the case law, it was not permitted to raise objections under Article 84 EPC against the features of the claims as granted, as had been done by the Opposition Division. Rather, unclear features required to be interpreted by reference to the description, which made clear how the carpet backing was made and compared to what reference backing the delamination strength should be measured.

- In any case, in the claims of the Main Request, the carpet backing had been clearly defined having regard to both its structure and its properties.

- As regards what delamination strength was meant, the delamination was the separation or destruction of the laminated carpet backing per se, not that between backing and carpet, hence the delamination between each of the bonded outer and inner layers

of the backing. This was apparent not only from the different constitution of carpet and reference backings but also from the DIN norm mentioned in the claims, which contained a definition in that sense for the delamination and also a description of how to measure it.

- Furthermore, in the present claims, the alternative woven or continuous layers mentioned in Claim 1 as granted had been removed. Hence, independently from whether or not Claim 84 might be invoked, the claims were in compliance with Article 84 EPC.
- The disclosure of the invention defined in Claim 1 in the patent in suit was sufficient, so that this ground of opposition did not prejudice maintenance of the patent.
- Novelty and inventive step had not been discussed before nor decided by the Opposition Division, so that it was not necessary to argue these issues.

X. The respondents, in writing (as far as their arguments are applicable to the present claims) had essentially maintained that:

- The amended claims were not clear:
 - they contained internal contradictions, so that it was not clear whether the backing was nonwoven;
 - there were indirect limitations, so that it was not clear what layer was responsible for the reduction of what delamination strength;

- the backing was *inter alia* defined by a desideratum, the reduction in delamination strength, defined by comparison with a reference backing, the structure of which was not clearly defined.
 - It was not clear either what delamination of what layer was meant.
 - In summary, not only single features were unclear but also their combination.
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- In view of the lack of clarity, it was also difficult to assess whether or not the claims contained added subject-matter.
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- However, at least the introduction of features that had been generalised from the examples was not allowable. And the definition of a new reference backing inevitably created a new group of carpet backings, so that not only the requirements of Article 123(2) EPC were contravened, but also those of Article 123(3) EPC.
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- Hence, the requests were not admissible.
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- The lack of clarity objected to, in particular the indefiniteness of the alleged invention, also resulted in a lack of reproducibility, so that the disclosure was insufficient.
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- As regards novelty of the claimed subject-matter, if it were clear, it would be taken away by the disclosure of D1.

- As to inventive step, the claimed subject-matter was obvious having regard to D2 or even to D1 as the closest prior art documents.
- Therefore, the patent could not be maintained.

XI. The appellants (patent proprietors) requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the Main Request submitted at the oral proceedings on 8 April 2009.

XII. The respondents (opponents) had requested in writing that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

Main Request

Amendments

2. *Basis for the amendments (Article 123(2) EPC)*

2.1 Compared to Claim 1 as granted (Point V, *supra*), apart from deletions of optional features, Claim 1 according to the Main Request comprises the features of Claims 1, 2 to 4, 7 and 8 as granted and, additionally, the following further amendments, each having a basis in the application as filed as indicated:

- (a) "wherein one of the distinguishable layers reduces the delamination strength of the backing".
Apart from being mentioned in Claim 2 as granted ("in the layer which reduces the delamination strength of the backing"), that feature was part of Claim 1 as filed ("which layer reduces the delamination strength of the backing");
- (b) "wherein the distinguishable layer which reduces the delamination strength of the backing is embedded in the backing as an inner layer between two outer layers". This feature has a basis in Claim 2 as filed as well as on page 4, lines 17-23, both concerning the general "framework" of the invention;
- (c) "same backing ... without the said distinguishable layers which reduces the delamination strength of the backing". This feature has a basis in Claim 1 as filed, wherein the singular "layer" is used, and only the singular makes technical sense (see discussion below).

2.2 Claim 2 has a basis in claim 3 as filed (which corresponds to Claim 2 as granted). Claims 3, 4 and 6 are identical to Claims 6, 7 and 10 as originally filed (corresponding to Claims 5, 6 and 9 as granted). Claim 5 has a basis in the preferred range specified by Claim 8 as filed which corresponds to Claim 7 as granted.

2.3 Therefore, no subject-matter has been added by the amendments made to the claims as granted having regard to the content of the application as filed (Article 123(2) EPC).

3. *Article 123(3) EPC*

3.1 Article 123(3) EPC prohibits amendments to granted claims during opposition proceedings, hence appeal following opposition proceedings, in a such a way as to extend the protection conferred by a European patent.

3.2 Claim 1 as granted states that the backing "consists of two or three distinguishable layers", and also requires that the "delamination strength of the backing ... is reduced by at least 30% with respect to the same backing without the said distinguishable layers." If this wording is taken literally it is impossible to fulfil this requirement because a backing without the distinguishable layers would be non-existent and have zero delamination strength, so that it is impossible to make something having less than zero delamination strength. A literal interpretation is thus ruled out.

3.3 In these circumstances Article 69 EPC and the relevant protocol thereto require that reference be made to the description to understand the intended scope of protection. Whatever wider scope of protection might have been intended by claim 1 as granted, it appears to the Board clear from the description that claim 1 as granted certainly was intended to cover the subject-matter of claim 1 now put forward as this relates closely to the described preferred embodiments. A construction of the scope of claim 1 which does not

include this subject-matter would not be consistent with any reasonable interpretation of the description.

3.4 Attention is particularly drawn to the following passages:

- (a) Paragraph [0007] disclosing that "the distinguishable layer, which on the one hand is responsible for the reduction of the delamination strength ...", thus the presence of such a layer,
- (b) Paragraph [0014], disclosing that "the layer which is responsible for the reduction in delamination strength is embedded as inner layer in the backing which thus comprises three distinguishable layers", thus a generic layout of the distinguishable layer within the framework of the invention,
- (c) Paragraph [0027] disclosing that "although the delamination strength of the backing of the invention is defined relative to the backings which do not contain the (substitutive or additional) distinguishable layer ...", thus disclosing that the reference backing should not contain the distinguishable layer responsible for the reduction of the delamination, either by way of elimination, e.g. it may only contain the outer layers.

3.5 It follows from the above that the amendments do reduce the scope of Claim 1 as granted, in particular to a scope which goes closer to the examples in the patent in suit, so that present Claim 1 does not encompass any "*aliud*", as alleged by the respondents, i.e. any new or foreign reference backings, thus inevitably any new groups of backings.

3.6 Therefore, the amendments are in compliance with Article 123(3) EPC.

4. *Clarity*

4.1 Lack of clarity under Article 84 EPC is not in itself a ground of opposition (Article 100 EPC), but according to the established case law objections on this ground can only be made in the case of claims amended after grant, in so far as the objections relate to lack of clarity introduced by the amendments so made.

4.2 In the view of the Board no lack of clarity has been introduced by the amendments now made. Rather, numerous objections raised by the respondents in the response to the statement setting out the grounds of appeal (Points IV) have been avoided, irrespective of whether these were open at all under Article 84 EPC in opposition proceedings. Thus:

- (a) Since the options "woven and continuous layers" have been cancelled, there is no internal contradiction in describing the backing as "nonwoven".
- (b) As regards the objection that the feature "wherein the delamination strength of the backing, measured in accordance with DIN 54310 is reduced by at least 30% ..." was a mere *desideratum*, by specifying that the layer which reduces the lamination strength is made up of sheath/core filaments or fibres different in a specified way (in the concentration of the binder making the sheath or in the bonding temperature thereof) from the sheath/core filaments

making up the outer layers, technical means for achieving this requirement now appear in the claim.

- (c) The claim now requires that the backing consists of three distinguishable nonwoven layers made of sheath/core filaments or fibres, wherein the layer which reduces the lamination strength is the inner layer embedded between two outer layers. This makes the test for reduction of delamination strength clear. One compares the delamination strength needed to separate the inner layer from one of the outer layers in an article according to the claim, to the strength needed to separate, in a reference backing made up of only the two outer layers laminated together, the one outer layer from the other.

4.3 Therefore, the present claims can be considered to comply with Article 84 EPC.

4.4 The Opposition Division in the decision under appeal refused, under Article 84 EPC, all the requests before it because the respective Claim 1 of each request was not clear, without analysing whether the lack of clarity had been introduced by the amendments to the granted claims. In view of the much more restricted claims on which the Board has been asked to decide, which claims as stated above are considered clear, further discussion of the decision under appeal is not called for in this case.

5. *Insufficiency (Article 100(b) or 83 EPC)*
- 5.1 The type of argument put forward by the respondents, namely that the subject-matter of the claims was so unclear that the skilled person would not know what to do, can in some cases support the ground of opposition of insufficiency, even in the absence of any evidence.
- 5.2 For the reasons explained in Section 4 above, the Board does not consider that there is any lack of clarity in the claims now put forward, and in particular no lack of clarity in relation to the matters discussed in point 4.1 above.
- 5.3 The reference in the claim to measuring the delamination strength of the backing in accordance with DIN 54310 seems to the Board *prima facie* something the skilled person would be able to do. Further the choice of precise lamination conditions, both for an article according to the invention and the two-layer reference backing, seem to the Board *prima facie* to be matters within the competence of the skilled person to choose for himself, even without specific instructions.
- 5.4 The respondents have put forward no evidence that a skilled person has tried to make something falling within any of the claims put forward at various times in these proceedings, but has failed. Against the claims as now worded, the Board considers the ground of insufficiency could only be made out if backed by evidence. As the respondents might yet wish to put forward such evidence in relation to the subject-matter of the claims as now formulated, the Board makes no final decision on this issue.

6. *Procedural matters*

6.1 According to the decision of the Enlarged Board of Appeal G 4/92 (OJ EPC 1994, 149) a party who fails to appear at oral proceedings must have the opportunity, in accordance with Article 113(1) EPC, to comment on new facts and evidence submitted in the proceedings. In accordance with the established case law (see for example decision T 0202/92 of 19 July 1994) this Enlarged Board Decision does not, however, prevent the admission into the proceedings of new claim requests introduced only at the oral proceedings before the Board and a decision thereon, where the amendments made amount to clarifying restrictions made to avoid objections raised in the written proceedings and the amendments are of a nature that the absent opponents might have expected. The amendments made in this case are considered by the Board ones that the Respondents (Opponents) could have expected, and accordingly the absence of the Respondents is no obstacle to admitting the request into the proceedings and making a decision relating thereto.

6.2 The amendments made aim at overcoming a ground of opposition, insufficiency, thus they comply with Rule 80 EPC. They also aim to meet the objections of lack of clarity raised in the decision under appeal, by the respondents and the Board. For the reasons stated above in Sections 2, 3 and 4, the amended claims comply with the requirements of Articles 84, 123(2) and 123(3) EPC. The Board thus exercises its discretion to admit the request into the proceedings.

6.3 The patent is being opposed also on the grounds of insufficiency, lack of novelty and lack of inventive step, on which the decision under appeal is silent. The Board, in the exercise of its discretion under Article 111(1) EPC, consequently considers it appropriate to remit the case to the Opposition Division for further prosecution so that the parties are given the opportunity of arguing the raised grounds of opposition in two instances, if necessary.

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 6 of the Main Request submitted at the oral proceedings on 8 April 2009.

The Registrar:

The Chairman:

S. Fabiani

S. Perryman