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**Datasheet for the decision
of 15 April 2011**

Case Number: T 2285/08 - 3.2.05
Application Number: 99931022.0
Publication Number: 1109657
IPC: B29C 33/76, B29L 22/00,
B29D 22/00
Language of the proceedings: EN

Title of invention:

METHOD FOR PRODUCING CLOSED COMPOSITE STRUCTURES AND MOULDING
APPARATUS TO BE USED BY THE METHOD

Patent Proprietor:

SIEMENS AKTIENGESELLSCHAFT

Opponent:

LM Glasfiber A/S

Headword:

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Relevant legal provisions:

EPC Art. 83, 84, 107, 111(1), 123(2), 123(3)
EPC R. 99(2), 101

Keyword:

Admissibility of the appeal (yes)
Admissibility of the main request (yes)
Sufficiency of disclosure (yes)
Clarity (main request - yes)
Scope of protection extended (main request - no)
Added subject matter (main request - no)

Decisions cited:

T 0386/04

Catchword:

-



Case Number: T2285/08 - 3.2.05

D E C I S I O N
of the Technical Board of Appeal 3.2.05
of 15 April 2011

Appellant: SIEMENS AKTIENGESELLSCHAFT
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Respondent: LM Glasfiber A/S
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 10 October 2008
revoking European patent No. 1109657 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: H. Schram
Members: S. Bridge
E. Lachacinski

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division posted on 10 October 2008 revoking European patent No. 1 109 657 on the grounds of Article 100(c) EPC.
- II. Oral proceedings were held before the Board of Appeal on 15 April 2011.
- III. The appellant requested that the decision under appeal be set aside and that the patent in suit be maintained on the basis of the set of claims filed on 20 January 2009 (main request), or, as an auxiliary measure, that the patent in suit be maintained on the basis of the set of claims filed as auxiliary request 1 on 14 March 2011.

The respondent (opponent) requested that the appeal be dismissed.

- IV. Independent claim 1 according to the main request reads as follows:

"1. Method for producing items of composite material, for example fibre reinforced material such as glass fibre reinforced epoxy or polyester, which items constitute partly closed structures containing cavities (2), which method comprises:

- a) that the reinforcement material such as fibre and/or matrix material, which optionally may be pre-impregnated with moulding material, is placed around a mould core (7, 8) consisting of an outer part (7) of a flexible material and an extractable filling material (8, 10, 11) arranged inside the outer part (7),

- b) that the reinforcement material is moulded with the moulding material,
- c) that the composite material subsequently hardens or cures,
- d) that the extractable filling material (8) of the mould core subsequently is taken out through at least one opening in the flexible outer part of the mould core and further taken out through at least one opening (3) in the item (1) produced,
- e) that the filling material (8, 10, 11) of the mould core is mouldable and that the filling material (8, 10, 11) of the mould core or mould cores comprises a material consisting of parts (10, 11) being substantially smaller in relation to the extension of the moulding core
- f) that the filling material is removed after hardening or curing of the composite material,

characterised in

- that a string (12) or the like is secured to the filling material, and the filling material is pulled out through the opening of the item produced by pulling the string, and
- that the filling material comprises pieces (10), being constituted by an elastically deformable material (11), while the volume of the filling material is reduced to a cross section which is smaller than the opening (3) of the item (1) produced, when the filling material is pulled through the opening of the item produced".

V. The arguments of the appellant in the written and oral proceedings can be summarised as follows:

Admissibility of the appeal

The patent was revoked on the grounds of Article 100(c) EPC, since the Opposition Division held that the amendments to respective claim 1 of the main request and of the first and second auxiliary requests introduced subject-matter extending beyond the contents of the patent application as filed, Article 123(2) EPC.

Granted claims 1 to 13 are replaced by claims 1 to 7 filed with the statement of the grounds of appeal. Replacement claim 1 is based on a combination of granted claim 1 with the second alternative of granted claim 9. The filing of the amended claims obviates the objection under Article 123(2) EPC and therefore deprives the contested decision of its basis. The appeal is therefore admissible.

Admissibility of the main request

In accordance with current case law, the patent proprietor is entitled to claim the full scope of the original disclosure in appeal after revocation. Independently thereof, in the present case, the subject-matter of claim 1 of the main request was already present as independent claim 15 of the then auxiliary request 1 on which, amongst others, the decision of the opposition division is based. Furthermore, the inclusion of subject-matter from granted claim 9 into granted claim 1 further focuses the scope of claim 1 of the main request without introducing completely new subject-matter. The main request is therefore admissible.

Clarity and sufficiency of disclosure

The skilled person is able to understand that "*the volume of the filling material is reduced to a cross section which is smaller than the opening (3)*" does not refer to the filling material as a whole but to the individual parts 11 as they pass through the opening (paragraphs [0032], [0033], [0041] and [0042], patent as published).

Therefore, the subject-matter of claim 1 of the main request not only meets the clarity requirements of Article 84 EPC, but the invention is also disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art in accordance with Article 83 EPC.

Article 123(2) and (3) EPC

Claim 1 of the main request is based on claims 1, 7 and 9 as filed. Furthermore, the skilled person would consider the terms "*parts*" and "*pieces*" to be synonymous in the context of the present patent (see also figure 4 and description page 8, lines 11 to 31 of the application as published).

The additional inclusion of subject-matter from granted claim 9 into granted claim 1 results in a narrower scope of protection.

Therefore, the subject-matter of claim 1 of the main request meets the requirements of Article 123(2) and (3) EPC.

VI. The arguments of the respondent in the written and oral proceedings can be summarised as follows:

Admissibility of the appeal

According to Enlarged Board of Appeal decision G 9/91 the "*purpose of the appeal procedure inter partes is mainly to give the losing party the possibility of challenging the decision of the opposition division on its merits*". However, the grounds of appeal lack sufficient substantiation as to why the contested decision should be erroneous.

Furthermore, the appellant is not adversely affected by the decision as required by Article 107 EPC, since he actively abandoned claims based on claims 1 and 9 as granted instead of obtaining a decision on their allowability.

The appeal is therefore not admissible.

Admissibility of the main request

The appellant pursues as main request a new independent claim which, although based on claims 1 and 9 as granted, extends beyond the requests discussed during the opposition procedure and thus constitutes a violation of Article 123(3) EPC. Filing new requests raising issues never considered by the opposition division is not in accordance with the main purpose of appeal proceedings according to the above quote from Enlarged Board of Appeal decision G 9/91.

Furthermore, the appellant has, during the opposition proceedings, from the beginning only requested that the patent be maintained in amended form. In this context it is noted that the subject-matter of claim 1 of the now main request corresponds to the subject-matter of

requests already presented during the opposition proceedings, (for example, claim 15 of auxiliary claim set 4 filed on 22 August 2008). However, all of these requests were withdrawn by the appellant during the opposition proceedings. In so doing the appellant actively chose not to pursue the allowance of these claims. Accordingly, the appellant is not allowed to appeal the decision and the introduction of the present main request into the appeal procedure is used only as a measure of protracting the procedure and hence constitutes an abuse of procedure which renders it inadmissible as well.

Therefore, the appellant's main request should not be admitted in the appeal proceedings.

Clarity

According to claim 1 (main request), "*the volume of the filling material is reduced to a cross section which is smaller than the opening (3) of the item (1) produced*". It is unclear as to how a person skilled in the art would reduce a three-dimensional volume to a two-dimensional cross-section. Therefore, claim 1 (main request) does not meet the clarity requirement of Article 84 EPC.

Insufficiency of disclosure

In the feature of claim 1 (main request), "*the volume of the filling material is reduced to a cross section which is smaller than the opening (3) of the item (1) produced*", the reduction relates to the total volume of the filling material. This leaves the skilled person in doubt as to how to go about reducing the total volume of the filling material by the required several factors

to a size, where the filling material can be easily removed, and at the same time making the core part strong enough to support a layup procedure in which reinforcement material (e.g. fibre glass) is placed around the mould core as stated in step a) of claim 1 (main request). Alternatively, the filling material would have to be pulled out of the cavity with an unrealistically high pulling force, which cannot be carried out without either breaking the string, stripping the filling material off the string or breaking the shell of the item being manufactured. These arguments apply all the more so for the manufacture of large wind turbine blades as envisaged by the patent in suit.

Therefore, the invention is not disclosed in a manner sufficiently clear and complete to enable it to be carried out by a person skilled in the art (Article 83 EPC).

Added subject matter

Claim 9 as filed does not mention that "*the filling material comprises pieces (10), being constituted by an elastically deformable material (11)*". The inclusion of this feature in claim 1 of the main request introduces new subject-matter in violation of Article 123(2) EPC.

Reasons for the Decision

1. *Admissibility of the appeal*

1.1 The patent in suit was revoked by the decision under appeal. The appellant is therefore adversely affected

by that decision and is entitled to appeal, Article 107 EPC.

The respondent alleged that the appellant had not availed himself of any of the opportunities presented to him during the opposition proceedings to file further requests beyond the then main request and the first and second auxiliary requests and thereby had actively abandoned the subject-matter of claim 1 of the main request filed in appeal. In this sense the appellant was not adversely affected by the contested decision and should not be permitted to seek maintenance of the patent on the basis of subject-matter that had been abandoned.

The Board cannot accept this argumentation for the following reasons. Firstly, the subject-matter of claim 1 of the main request essentially corresponds to that of independent claim 15 of the then auxiliary request 1 which formed, amongst other requests, the basis for the contested decision. Even if there were no corresponding subject-matter claimed before the opposition division, the appellant is entitled to seek maintenance of the patent either as granted, or in a more limited form, provided this would not amount to an abuse of procedure (see decision T 386/04, point 1 of the reasons, not published). Secondly, if a request of the appellant were inadmissible, this legal consequence only concerns that request and does not result in the appeal being rejected as inadmissible.

- 1.2 The respondent submitted that the statement of grounds of appeal lacked sufficient substantiation as to why the contested decision should be erroneous.

However, in the judgment of the Board, the act of filing amended claims which are intended to overcome the objection under Article 123(2) EPC is sufficient to substantiate the appeal. In the present case it was unnecessary to file grounds as to why the decision under appeal was erroneous, since the set of claims on which the decision was based are no longer defended in appeal. The appeal thus complies with Rule 99(2) EPC.

1.3 The appeal also complies with Articles 106 and 108, and with Rule 99, paragraph 1(b) and 1(c) EPC, and is therefore admissible, Rule 101 EPC.

2. *Admissibility of the appellant's main request*

2.1 As already noted above, the subject-matter of claim 1 of the main request generally corresponds to that of independent claim 15 of auxiliary request 1 of the opposition proceedings.

Claim 1 of the main request of the present appeal proceedings concerns an embodiment of the invention in which the filling material is pulled out of the shell by means of a string and is generally based on claims 1 and 9 as granted.

2.2 Therefore, the appellant's main request is admissible.

3. *Interpretation and clarity of claim 1 of the main request, Article 84 EPC*

Claim 1 of the main request corresponds essentially to claim 9 as granted with the proviso that the first alternative mentioned in that claim, i.e. "*preferably said filling material comprises pieces (10) which have a cross section smaller than the opening in the item*

produced, and which pieces are interconnected by the string" has been deleted (underlining added by the Board).

The second alternative of claim 9 as granted, viz. "*alternatively said filling material being constituted by an elastically deformable material (11) and the volume of the filling material is reduced to a cross section being smaller than the opening (3) of the item (1) produced*" concerns parts 11 which have a cross section larger than the opening in the item produced.

Claim 1 of the main request specifies that "*the filling material (8, 10, 11) ... comprises a material consisting of parts (10, 11)*", c.f. feature e). Since parts 10 having a cross section d smaller than the opening b in the item produced are no longer claimed in claim 1 of the main request, the reference number 10 could be deleted in said claim and the expression in the second charactering feature of the claim: "*that the filling material comprises pieces (10), being constituted by an elastically deformable material (11)*" could be replaced by the expression "*that the filling material comprises parts (11), being constituted by an elastically deformable material*".

In the judgement of the Board, the person skilled in the art will readily understand that the last feature of claim 1 of the main request "[*while*] *the volume of the filling material is reduced to a cross section which is smaller than the opening (3) of the item (1) produced when the filling material is pulled through the opening of the item produced*" must be construed to mean that the three-dimensional volume of the single parts 11 is sufficiently deformed and compressed to pass through the two-dimensional cross-section of the

opening in the shell. This interpretation is in conformity with the embodiment of figure 4 (paragraphs [0032] and [0033], patent as published) in which a string is used to pull the filling material out of the shell. As disclosed in column 7, lines 14 to 19, the single parts 11 of the filling material 8 are simultaneously deformed and compressed when they pass out through the opening in the shell.

Therefore, claim 1 of the main request meets the clarity requirements of Article 84 EPC.

4. *Sufficiency of disclosure, Article 83 EPC*

In view of the above interpretation of claim 1 of the main request, the Board has no doubt that the method of claim 1 of the main request is disclosed in the patent in suit in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art so that the requirements of Article 83 EPC are met.

5. *Added subject-matter*

A basis for claim 1 of the main request is the combination of claims 1, 7 and 9 (second alternative) as filed.

Claim 1 of the main request therefore does not introduce subject-matter that extends beyond the content of the application as filed, Article 123(2) EPC.

The respondent has submitted that the expression in the second charactering feature of the claim: "*that the filling material comprises pieces (10)*" was not present in the second alternative of claim 9 as granted and

thus contravened the requirements of Article 123(2) EPC.

The Board cannot accept this. The addition "[*the filling material*] *comprises pieces (10)*" is merely a repetition of the statement in feature e) that "*the filling material (8, 10, 11) ... comprises a material consisting of parts (10, 11)*"

In consequence, the subject-matter of claim 1 of the main request is based on claims 1, 7 and 9 as filed without extending beyond the content of the application as filed so that the requirements of Article 123(2) EPC is met.

6. *Extension of the scope of protection*

Article 123(3) EPC refers to the protection conferred by the European patent as granted. The scope of protection conferred by claim 1 of the main request is narrower than the scope of protection conferred by claim 1 as granted, since the features of claim 9 as granted (second alternative) have been added to claim 1 as granted.

Consequently, the requirements of Article 123(3) EPC have also been met.

The respondent's position that the scope of claim 1 of the main request extends beyond that of the respective claims 1 of the requests discussed during the opposition procedure thereby constituting a violation of Article 123(3) EPC cannot be accepted.

7. *Remittal to the first instance*

The opposition division has not yet had the opportunity to consider the question of whether or not the grounds of opposition under Article 100(a) EPC prejudice the maintenance of the patent according to the main request. It is therefore considered appropriate in accordance with Article 111(1) EPC to remit the case to the first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:

D. Meyfarth

H. Schram