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Datasheet for the decision of 10 October 2016

Case Number: T 1852/11 - 3.2.05

Application Number: 06010921.2

Publication Number: 1859920

IPC: B29C70/54, B29C70/44

Language of the proceedings: EN

Title of invention:
A method and a device for resin transfer moulding a component comprising at least partly of fibre-reinforced plastic laminate

Patent Proprietor:
Siemens Aktiengesellschaft

Opponent:
Vestas Wind Systems A/S

Headword:

Relevant legal provisions:
EPC 1973 Art. 54(1), 54(2), 114(1), 114(2)

Keyword:
Novelty - main request (no) - auxiliary requests (no)

Decisions cited:
G 0009/91, G 0007/93

Catchword:

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Case Number: T 1852/11 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 10 October 2016

Appellant: (Opponent)	Vestas Wind Systems A/S Alsvej 21 8940 Randers (DK)
Representative:	Jakob Pade Frederiksen Inspicos P/S Kogle Allé 2 2970 Hørsholm (DK)
Respondent: (Patent Proprietor)	Siemens Aktiengesellschaft Wittelsbacherplatz 2 80333 München (DE)
Representative:	Stephan Fritsch Siemens Aktiengesellschaft Postfach 22 16 34 80506 München (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 16 June 2011 concerning maintenance of the European Patent No. 1859920 in amended form.**

Composition of the Board:

Chairman	M. Poock
Members:	P. Lanz
	G. Weiss

Summary of Facts and Submissions

I. The appeal by the opponent (appellant) is against the decision of the opposition division that, taking into account the amendments made by the patent proprietor during the opposition proceedings, European patent EP-B-1 859 920 and the invention to which it relates are found to meet the requirements of the European Patent Convention.

II. During the opposition proceedings, the opponent had raised the grounds for opposition according to Article 100(a), (b) and (c) EPC 1973.

III. Oral proceedings were held before the board of appeal on 10 October 2016 in the absence of the appellant, whose representative had informed the board thereof with its letter dated 29 September 2016.

IV. The appellant had requested in writing that the decision under appeal be set aside and that the European patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed (main request) or that the decision under appeal be set aside and that the case be remitted to the department of first instance on the basis of auxiliary requests 1 or 2 filed with letter dated 21 February 2012.

V. Independent claim 1 of the main request reads as follows:

"A method for casting a component comprising at least partly of fibre-reinforced plastic laminate which comprises the following steps:
- the fibre-reinforcement (1) is arranged in a casting mould (30, 31), wherein
- at least one venting duct (2) is placed inside the fibre-reinforcement,
wherein
- said fibre-reinforcement (1) and said venting duct (2) are at least partly wetted by the plastic (57) during the casting process, in such a way that venting is achieved through said venting duct (2),
characterized in that
- the surface of the venting duct (2) is at least partially made with a semi-permeable membrane that allows the passage of gases but does not allow or only slowly allows the passage of plastics."

VI. Compared with the main request, independent claim 1 of auxiliary request 1 contains the following additional feature:

"- thus trapped air, which arise as air inclusions inside the plastic laminate by the wetting, is vented to the outside of the plastic laminate by the venting duct, the trapped air is sucked into the venting duct by passage through the semi-permeable membrane, while the venting duct fundamentally remains free of plastic material and the venting duct inside the plastic laminate does not stop venting despite being wetted on the outside thus a reduction or elimination of air inclusions is achieved."

VII. Compared with auxiliary request 1, independent claim 1 of auxiliary request 2 comprises the following further addition:

"- the interior of the venting duct facilitates passage of air in the longitudinal direction of the venting duct."

VIII. Reference is made to the following document:

E10: DE 102 53 100 A1.

IX. The arguments presented by the appellant in writing are essentially as follows:

Reference was made to document E10, which disclosed in the embodiment of Figure 1 a method for casting a component, wherein a fibre reinforcement was arranged in a casting mould and a foam core 8 surrounded by a semi-permeable membrane was placed inside the fibre reinforcement. The foam core 8 including the semi-permeable membrane had a longitudinal extension, as could be derived from Figure 2, and served as a channel for venting air out of the cast component. It thus fell under the definition of a duct according to the Merriam-Webster online dictionary. Consequently, document E10 disclosed all the features of claim 1 in combination.

X. The respondent's submissions in writing and during the oral proceedings may be summarised as follows:

Document E10 was admitted by the opposition division although it had been filed only one month before the date of the oral proceedings. It should be considered

as late filed by the board of appeal and not taken into consideration during the appeal proceedings.

Moreover, document E10 could not anticipate the subject-matter of claim 1, in particular the features of the at least one venting duct placed inside the fibre reinforcement and of the venting duct having a surface at least partly made with a semi-permeable membrane that allowed the passage of gases but did not allow the passage of plastics. When contested claim 1 was read in the context of the description, it became clear that the venting ducts were embedded within the plastic laminate. Additionally, according to the Merriam-Webster online dictionary, ducts were of longitudinal extension. None of these features was shown in document E10.

If the board could not follow the main request, a remittal of the case to the opposition division was requested in order to give the respondent the possibility to submit further auxiliary requests.

In the alternative, the novelty of the auxiliary requests on file should be acknowledged. In fact, the wording of the claims of the auxiliary requests made it even clearer that the contested patent was specifically directed to the venting of problematic sections of the moulded part, which required the venting ducts to be embedded within the laminate. The subject-matter of the independent claims of the auxiliary requests was thus new.

Reasons for the Decision

1. Admissibility of document E10

1.1 The respondent requests the board to disregard document E10, which was admitted by the opposition division although it had been filed only one month before the date of the oral proceedings. It should be considered as late filed by the board of appeal and not taken into consideration during the appeal proceedings.

1.2 The opposition division decided to admit document E10 into the proceedings in view of its *prima facie* relevance (cf. impugned decision, Reasons 1.2) and after having heard the parties on this issue during the oral proceedings (cf. minutes, point 6). In view of that, it is not apparent that the opposition division exercised its discretion under Article 114(2) EPC 1973 according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (cf. G 7/93, OJ EPO 1994, 775). Consequently, the admission of document E10 into the opposition proceedings is not to be objected to. This is all the more true in view of the principle of *ex-officio* examination under Article 114(1) EPC 1973. According to this provision, the opposition division examines the facts of its own motion, as an administrative instance and in accordance with the extent of the opposition under Rule 55(c) EPC 1973 (cf. G 9/91, OJ EPO 1993, 408, Reasons 10). In doing so, it is not restricted to the facts, evidence and arguments provided by the parties.

1.3 The board observes that the framework of the European Patent Convention does not provide a legal basis for excluding, at the appeal stage, a prior art document which was correctly admitted into the first-instance proceedings. It has to be emphasised that it is the primary function of an appeal to give the losing party the possibility of having the correctness of the first-instance decision judicially reviewed. In the case at hand, the impugned decision deals, *inter alia*, with the issues of novelty and inventive step in view of prior art document E10. The correctness of these findings cannot be reviewed without taking into consideration the teaching of this document.

For these reasons, document E10 cannot be excluded from the present appeal proceedings.

2. Novelty - main request

2.1 Both parties refer to the following definition of the term "duct" according to the Merriam-Webster online dictionary:

"duct: a pipe, tube, or channel that conveys a substance"

The following novelty assessment is based on this understanding of the term "duct".

2.2 The issue of novelty of the main request primarily hinges on the question of whether or not the foam core surrounded with a semi-permeable membrane can be considered a venting duct. In that respect, reference is made to Figures 1 and 2 in document E10 and the corresponding passages of the description, which indicate that venting of the mould during its filling

with plastics is done via the foam core (cf. E10, paragraphs [0011] and [0022]). The core has a venting channel 12 in its centre and is covered with a semi-permeable membrane that allows the passage of gases but does not allow the passage of plastics. The fibre reinforcement of the laminate is provided on the membrane (cf. E10, paragraph [0027]). Consequently, the foam core including channel 12 and the semi-permeable membrane forms a channel for venting gaseous substances from the fibre reinforcement during the moulding step. As can be deduced from Figure 2 of document E10, the core is of longitudinal extension. Hence, the foam core with channel 12 and the semi-permeable membrane serves the purpose of and is therefore to be considered a venting duct inside the fibre reinforcement, as specified in the wording of contested claim 1.

2.3 The respondent's argument that, when the claim was read in the context of the description, it became clear that the venting ducts were embedded within the plastic laminate is not convincing. According to Article 84 EPC 1973 the claims define the invention for which protection is sought. If, as in the present case, their wording is unambiguous, it is inconsistent with proper claim interpretation to read into a claim a particular meaning of a feature which only appears in the detailed description, and then to rely on this limited understanding of the feature to provide a distinction over the prior art. Rather, the claim features should be given their ordinary meaning as understood by a person skilled in the art. Applying this principle to the case at hand, the contested claim feature worded *"at least one venting duct (2) is placed inside the fibre-reinforcement"* has to be considered as being anticipated by the foam core and the semi-permeable membrane, which, in turn, are covered with a fibre

reinforcement, as disclosed in paragraph [0019] and Figures 1 and 2 of document E10.

The feature of the venting duct placed inside the fibre reinforcement is thus not suitable for establishing novelty of the subject-matter of claim 1 in view of document E10, Article 54(1) and (2) EPC 1973.

3. Request for remittal

3.1 Under Article 111(1) EPC 1973 the board of appeal may either decide on the appeal or remit the case to the department which was responsible for the appealed decision. The board exerts its discretion with respect to a remittal after assessing each case on its merits. Criteria, which are typically taken into account, include the requirement of procedural economy, whether the impugned decision was tainted with a substantial procedural violation, whether substantially amended claims, new facts or evidence were introduced at the appeal stage and whether the parties requested them to be examined at two levels of jurisdiction.

3.2 In the case at hand, there is neither an allegation of a substantial procedural violation nor is it apparent that a fresh case was created by introducing new facts or evidence during the appeal proceedings. Under these circumstances, the board considers it appropriate to decide itself on the appeal. The request for remittal of the case to the department of first instance is thus refused.

4. Novelty - auxiliary requests 1 and 2

The reasons set out above for the main request also apply to auxiliary requests 1 and 2. In particular, the added features

"thus trapped air, which arise as air inclusions inside the plastic laminate by the wetting, is vented to the outside of the plastic laminate by the venting duct, the trapped air is sucked into the venting duct by passage through the semi-permeable membrane, while the venting duct fundamentally remains free of plastic material and the venting duct inside the plastic laminate does not stop venting despite being wetted on the outside thus a reduction or elimination of air inclusions is achieved" and

"the interior of the venting duct facilitates passage of air in the longitudinal direction of the venting duct"

define functions of the venting duct, which are necessarily also achieved by the venting duct known from document E10: it is the very purpose of the foam core 8 covered with the semi-permeable membrane to vent trapped air, which includes air which arises as air inclusions inside the plastic laminate by the wetting, along a longitudinal direction to the outside of the plastic laminate (cf. E10, paragraph [0022] and Figure 2). Document E10 proposes covering the foam core with a semi-permeable membrane in order to keep the core free from plastic material. This prevents the porous core from being clogged. The provision of a semi-permeable membrane thus allows for proper venting despite the

membrane being wetted on the outside (cf. E10, paragraph [0027]).

In view of the above, the subject-matter of claim 1 according to auxiliary requests 1 and 2 is equally not new over document E10, Article 54(1) and (2) EPC 1973.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

D. Meyfarth M. Poock

Decision electronically authenticated