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**Datasheet for the decision
of 27 January 2015**

Case Number: T 1257/12 - 3.2.07
Application Number: 06125142.7
Publication Number: 1795459
IPC: B65D71/00, B65D75/00, B65D85/08
Language of the proceedings: EN

Title of invention:

Support element and system using the same for handling palletless large-size packages containing low density mineral wool slabs, as well as large-size package and manufacturing method for the same

Patent Proprietor:

Paroc Oy Ab

Opponent:

ROCKWOOL INTERNATIONAL A/S

Headword:

Relevant legal provisions:

EPC Art. 56, 123(2)
RPBA Art. 13(1), 13(3)

Keyword:

Inventive step - main request (no)
Late-filed first and second auxiliary requests -admitted (yes)
Inventive step - first auxiliary request (no)
Amendments - second auxiliary request (not allowable)

Decisions cited:

Catchword:



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Case Number: T 1257/12 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 27 January 2015

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(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 5 April 2012
revoking European patent No. 1795459 pursuant to
Article 101(2) EPC.**

Composition of the Board:

Chairman H. Meinders
Members: K. Poalas
I. Beckedorf

Summary of Facts and Submissions

- I. The patent proprietor (appellant) lodged an appeal against the decision of the opposition division revoking European patent No. 1 795 459.
- II. Opposition had been filed against the patent as a whole based on Article 100(a) EPC (lack of novelty and inventive step), on Article 100(b) EPC (insufficient disclosure) and on Article 100(c) EPC (unallowable amendments).
- III. The opposition division found that the grounds for opposition according to Articles 100(b) and 100(c) EPC do not hold against the patent as granted and that *inter alia* the subject-matter of claim 1 of the patent as granted does not involve an inventive step.
- IV. Oral proceedings before the Board took place on 27 January 2015.

The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, alternatively, in amended form on the basis of one of the sets of claims filed as first and second auxiliary requests with letter of 19 December 2014.

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

- V. The following documents of the opposition proceedings are relevant for the present decision:

D1: US 4 535 587

D6: WO 2004/007327 A1

D7: WO 03/060213 A2

D8: US 4 085 562.

VI. Claim 1 according to the **main request** reads as follows:

"A package module (1) which consists of at least two adjacent packets (2), each containing low density mineral wool slabs, wrapped in a cohesive plastic wrapper (3), and at least two appropriately shaped support elements (5), which are made of a strong material, and which are disposed between the packets (2) of the module (1) inside the wrapper (3) such that due to the flexibility of the low density mineral wool slabs contained in the packets (2) the support elements (5) disposed between the packets in question establish lifting holes (4) extending between the packets (2) for receiving lifting and handling elements (12, 15)".

Claim 1 according to the **first auxiliary request** differs from claim 1 according the main request through the additional feature, that the support elements "have a configuration which is substantially trough-shaped".

Claim 1 according to the **second auxiliary request** differs from claim 1 according the main request through the additional feature, that the support elements consist of "a plate (6) and two trough-shaped members (5) mounted on its two opposite edges, each of which is coupled with the plate (6) by the external side of the bottom, respectively".

VII. The appellant's arguments, in so far as they are relevant to the present decision, may be summarised as follows:

Main request

The package module claimed in claim 1 differs from the one known from D1 in that

a) it **consists of** at least two adjacent packets, and at least two support elements only, i.e. without any further additional structural elements,

b) the packets contain low density mineral wool **slabs**, i.e. they contain more than one slab, the latter term to mean "not rolled-up",

c) the support elements are disposed between the packets inside the wrapper,

d) the support elements are disposed such that due to the flexibility of the low density mineral wool slabs contained in the packets the support elements disposed between the packets in question establish lifting holes extending between the packets for receiving lifting and handling elements.

feature a)

The package module known from D1 has additional elements like the binding strips 7 and the end panels 4 with the flanges 5. There is no teaching in D1 that the above-mentioned elements of the package module known from D1 can be left out while maintaining the integrity of the package module.

feature b)

The packets of the package module known from D1 are single rolls and not a plurality of slabs. A slab that is rolled up into a roll is no longer a slab (at least not within the packet). There is nothing in the patent that would suggest that the claimed packets could comprise mineral wool rolls or that the word "slab"

could mean "roll". The "Platten" 11 in D6 when rolled up together cannot be considered as slabs, since they do not have a flat shape.

feature c)

The support elements 2 in D1 are not disposed between the packets inside the wrapper.

feature d)

The intrinsic flexibility of mineral wool is not utilised in D1 in the manner according to the patent in suit since the presence of rolls in the packets gives rise to "natural" lifting holes between the rolls. With packets comprising slabs that is not possible, hence the need for the support elements.

It is clear that due to the fact that the packets referred to in the patent in suit are sealed within the wrapper 3 the corners are rounded, but any space thus provided between the packets 2 in e.g. figure 1a of the patent in suit is negligible and is not large enough to accommodate the fork of a forklift truck, unless the support elements 5 are disposed between the packets 2 of the module 1 inside the wrapper 3. The flexibility of the low density mineral wool slabs contained in the packets 2 allows the support elements 5 to be disposed between the packets in question thus establishing lifting holes extending between the packets 2 for receiving lifting and handling elements 12, 15.

Admissibility of the auxiliary requests

The filing of the auxiliary requests was the appellant's reaction to the Board's preliminary opinion

annexed to the summons to oral proceedings. They were filed more than five weeks before the oral proceedings.

The claims 1 of said auxiliary requests result from the introduction into claim 1 of the patent as granted the features of the respective dependent claims 5 and 6, i.e. of the respective originally filed dependent claim 5 and 6.

The additional features introduced into the claims 1 of said requests are technically simple and they do not put an undue burden on the other party or the Board to cope with these features. Furthermore, the originally filed dependent claims 5 or 6 had already been attacked by the respondent during the opposition proceedings.

Said auxiliary requests therefore do not take the respondent or the Board by surprise and should therefore be admitted into the appeal proceedings.

First auxiliary request - inventive step, Article 56 EPC

According to the additional features of claim 1 of the first auxiliary request the support elements have a configuration which is substantially trough-shaped.

This feature comes from originally filed claim 5.

The technical effect relating to this feature is that it simplifies the insertion and pulling out of the support elements between the packets.

Second auxiliary request - amendments, Article 123(2) EPC

Claim 1 of the second auxiliary request is based on the

combination of claim 1 of the patent as granted with the additional features of originally filed claim 6.

It is true that this claim 6 is dependent on claim 5.

The technical teaching of the additional feature of claim 5 concerns the substantially trough-shaped configuration of the support element, whereas the technical teaching of the additional features of claim 6 concern the presence of two trough-shaped members in the support element. These two technical teachings are thus partially overlapping with each other.

The skilled person has the skill to connect the additional features of originally filed claim 6 with the support element as depicted in figure 1b. He understands that the additional features of said claim 6 can be incorporated on their own, without any need for the additional feature of originally filed claim 5.

VIII. The respondent's arguments, in so far as they are relevant to the present decision, may be summarised as follows:

Main request - inventive step, Article 56 EPC

The expression "wrapped in a cohesive plastic wrapper" in claim 1 allows an interpretation of the wording of said claim such that it refers to the package module and that thus the package module **comprises** also a cohesive plastic wrapper **in addition** to the "at least two adjacent packets" and the "at least two appropriately shaped support elements". This means that the expression "consists of" present in claim 1 need not be understood in the limiting sense as argued by the appellant.

The latter argued that the "consists of" excluded anything other than the "at least two adjacent packets" and the "at least two appropriately shaped support elements" from the claimed package module, thus trying to exclude D1 which required binding strips and the end panels with flanges.

It is self-evident that a slab or plate would still be a slab or plate if rolled up, especially with insulating material, of which deformation can easily be reversed after unrolling.

D1 states in column 5, lines 53 to 61 that its invention may be used for (instead of rolls) "parallelepipedal blocks of plastic foam material, or even applied to packets of thermal insulating material, provided the form of these articles enables the use of the contoured outer panels (...)". Packets of thermal insulating material in the form of packets of stacked mineral wool slabs are thus well-known to the person skilled in the art

According to paragraph [0017] of the patent in suit the slabs, or "thick plates", used according to the invention can have a thickness of 50 mm. A plate with a thickness of 5.0 cm (or more) thus falls within the definition of slab as used in claim 1 of the contested patent. D6 discloses a method for rolling up parallelepiped-shaped elastically compressible mineral wool plates ("Platten") 11. According to an example described in the paragraph bridging pages 3 and 4 of D6 the plates 11 (cut off from strip 3) have a thickness of about 7.5 cm, i.e. the plates 11 are per definition "thick". After being cut off from the strip 3 the plates 11 are rolled up and can then be sold in rolled up form with a compressed thickness of about 5 cm.

Later the plates 11 can be unrolled, whereby the plates again assume a thickness of about 7.5 cm.

A slab according to claim 1 can thus have a thickness allowing it to be easily rolled up into a roll without breakage and without being permanently deformed or affected in its shape when unrolled.

As a consequence the skilled person applying his common technical knowledge would not exclude a rolled up slab such as in D6, separable into a number of discrete slabs when unrolled to be a "packet of slabs" as used in claim 1.

Admissibility of the appellant's auxiliary requests

The appellant's auxiliary requests have been filed at a late stage of the appeal proceedings; they could have been filed either during the opposition proceedings or at least together with the statement of grounds of appeal.

These late filed requests are not clearly allowable and therefore inadmissible, since they do not *prima facie* meet the requirements of Articles 56, 123(2), 83 and 84 EPC, raising thereby multiple new issues.

First auxiliary request - inventive step, Article 56 EPC

The contoured panels of figure 1 of D1 comprise support elements 3, which in shape (V-shaped) are similar to the exemplary support elements 5 of the patent in suit, i.e. they have a substantially trough-shaped configuration.

*Second auxiliary request - amendments, Article 123(2)
EPC*

Originally filed claim 6 was dependent on originally filed claim 5.

In claim 1 of the second auxiliary request the additional feature of originally filed claim 5 is not present. No basis exists in the application as filed for leaving out the additional feature of originally filed claim 5 when introducing the additional features of originally filed claim 6 into claim 1 of the patent as granted.

The additional features of claims 5 and 6 respectively, are clearly not overlapping since claim 5 defines a trough-shaped support element, whereas claim 6 defines a support element consisting of a plate and two trough-shaped members. Claim 6 in conjunction with claim 5 thus defines a(n) (overall) substantially trough-shaped support element, which consists of a plate and two trough-shaped members.

Due to the fact that the feature of the support element having an (overall) configuration which is substantially trough-shaped is missing from claim 1 of the second auxiliary request, said claim does not meet the requirements of Article 123(2) EPC.

Reasons for the Decision

1. *Main request - Inventive step, Article 56 EPC*

1.1 Interpretation of the wording of claim 1, i.e. of the terms "**consisting of**" and "**slab(s)**".

"consisting of"

1.1.1 According to the originally filed claim 7, which served as basis for claim 1 of the patent as granted, the [at least one] **package module** claimed therein "**contains** at least two adjacent packets containing low density mineral wool slabs, each **package module** being **wrapped** in a cohesive plastic wrapper" (emphasis added by the Board).

According to claim 1 of the patent as granted the above-mentioned expression was reformulated so that the **package module** "**consists of** at least two adjacent packets, each containing low density mineral wool slabs, **wrapped** in a cohesive plastic wrapper, and at least two appropriately shaped support elements ..." (emphasis added by the Board).

1.1.2 The appellant argued during the oral proceedings that the above-mentioned expression used in claim 1 of the patent as granted limits the claimed package module in that it is constituted by only two kinds of structural elements, namely **packets** and **support elements**. Nothing other than these components should be present in the wrapper, that's excluding D1's package module, which requires further structural elements.

1.1.3 The Board, following the respondent's argumentation, considers that the additional expression "wrapped in a cohesive plastic wrapper" in claim 1 of the patent as granted allows an interpretation of said claim such that the above-mentioned wrapping condition refers to the package module and that thus the package module comprises also a cohesive plastic wrapper, **in addition** to the "at least two adjacent packets" and the "at least two appropriately shaped support elements". This is in accordance with the originally filed claim 7, see point 1.1.1 above, with the configurations of the figures 1a, 1b, 4 to 6 of the patent in suit and also with paragraph [0024] of the patent in suit stating that the package module according to the present invention **consists of** four **packets** of soft slabs engaged **together with** a plastic wrapper, two **support elements** and the **plastic wrapper**.

1.1.4 Accordingly, the expression "**consists of**" present in claim 1 of the patent as granted is not to be interpreted as limited as argued by the appellant. The result is that a package module comprising further structural elements other than packets and support elements, such as the one of D1, falls under the wording of claim 1 of the patent as granted.

"slab(s)"

1.1.5 The Board cannot follow the appellant's argument that a slab which is rolled up into a roll, as for example one of the rolls 1 of D1 or one of the "plates" 11 in D6 is no longer a slab, since its shape is no longer flat, and that support for this contention was to be found in the cited dictionary references, all indicating that a "slab" should be "flat".

- 1.1.6 The Board remarks in this respect that the above references cannot help much, since the question that has to be answered is one related to the cited prior art: why would a rolled-up slab no longer be a slab?

The Board has recourse to the general technical knowledge of the person skilled in the art as documented for example on page 4, line 2 of D6, according to which rolls provided via rolling-up of slabs or plates ("Platten") are characterised as rolled-up plates ("gerollte Platten"), i.e. rolled-up "slabs" as generally claimed in claim 1. In this respect it is noted that the claim does not refer to a "stack of slabs", or "slabs piled onto each other", etc.

- 1.2 On the basis of the above considerations the Board considers that figure 1 of D1, said last representing undisputedly the closest prior art, shows, in the wording of claim 1, a package module which consists of at least two adjacent packets 1, each containing a (rolled-up) low density mineral wool slab, wrapped in a cohesive plastic wrapper 8, and at least two appropriately shaped support elements 3, which are made of a strong material, and which are disposed between the packets 1 of the module inside the wrapper 8 such that due to the flexibility of the low density mineral wool slabs contained in the packets 1 the support elements 3 being disposed between the packets in question and establishing lifting holes extending between the packets for receiving lifting and handling elements.

- 1.3 Consequently, the package module of claim 1 differs from the one known from D1 in that each of the packets comprises a plurality of slabs and not a single slab as

it is the case with the package module known from D1.

- 1.4 However, the skilled person working in the field of packaging of mineral wool material is aware that packets of mineral wool material may advantageously contain more than one slab, increasing thereby the number of slabs to be packaged and transported via a single package module containing such packets. The slabs can thereby be either in rolled-up or in flat form, see for example D1 proposing in column 5, lines 53 to 55 the use of substantially parallelepipedal blocks of low-density mineral wool; and D6, the paragraph bridging pages 3 and 4 and figure 1; D7, paragraph bridging pages 2 and 3 and figure 1; and D8, column 1, lines 23 to 26 and figure 10. These last three documents propose a roll comprising a plurality of slabs.
- 1.5 For the skilled person seeking thus to increase the number of slabs to be packaged within the package module known from D1 it is obvious to provide these packets with a plurality of mineral wool slabs, still rolled-up, in order to increase the transporting capacity of said known package module. This additional feature does not appear to have any other effect than simply increasing the number of slabs to be packaged and transported via a single package module.
- 1.6 The appellant further argued that the package module claimed in claim 1 differs from the one known in D1 in that
- a) the support elements are disposed between the packets inside the wrapper,
 - b) the flexibility of the low density mineral wool slabs contained in the packets has to play a role, i.e. to establish lifting holes extending between the

packets for receiving lifting and handling elements.

- 1.6.1 The Board derives from figures 1 and 2 and the passage in column 4, lines 18 to 21 of D1 that the recesses 3 of the contoured panel 2, said recesses being the support elements in the sense of claim 1, are disposed between the packets, i.e. the rolls 1 inside the wrapper 8. For this reason also feature a) cannot be considered a differentiating feature over the package module known from D1.
- 1.6.2 Although some empty space would obviously be present between the rolls 1 in figure 1 of D1 already before positioning of the panel 2 with the recesses 3 between the rolls, it is clear from said figure that the associated rolls are compressed to some extent to provide at least part of the lifting holes between the bottom recesses. Similarly, from figure 1a of the patent in suit it is apparent that because of the individual wrapping of the packets 2 some space is also already provided between the packets 2 at both top and bottom before positioning of the support elements 5, see also the chamfered top and bottom edges of the packets 2 along the central vertical axis in figures 4 and 5 of the patent in suit. It is not necessarily **only** the support element which creates the lifting hole extending between said packets.
- 1.6.3 Given the fact that the figures of D1 and the patent in suit are schematic, i.e. not allowing to extract dimensions of the different parts depicted therein, the appellant's argument that the space provided between the packets 2 as depicted in figure 1a of the patent in suit is "negligible", whereas the space provided between the rolls 1 as depicted in figure 1 of D1 is "not negligible", cannot be followed by the Board. In

any case, no such qualification of the lifting holes is present as a feature in claim 1.

For these reasons also feature b) cannot be considered as being a differentiating feature over the package module known from D1.

1.7 Accordingly, the subject-matter of claim 1 does not involve an inventive step over the teaching of D1 in combination with the general technical knowledge in this field, as reflected in documents D1, D6, D7 and D8 (Article 56 EPC).

2. *Admissibility of the appellant's auxiliary requests*

2.1 With its statement setting out the grounds of appeal the appellant requested maintenance of the patent as granted and put forward arguments against the reasoning of the impugned decision.

2.2 With communication of 31 October 2014 the Board summoned the parties to oral proceedings. In its annex to the summons the Board expressed its provisional opinion that the present appeal was to be dismissed.

With its submissions dated 19 December 2014 the appellant filed two auxiliary requests.

2.3 According to Article 13(1) RPBA any amendment to a party's case after it has filed its statement of grounds of appeal or reply may be admitted and considered at the Board's discretion, whereby said discretion shall be exercised in view of *inter alia* the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy. Furthermore, according to Article

13(3) RPBA amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.

- 2.4 In the present case, claim 1 of the first auxiliary request is based on the combination of claims 1 and 5 of the patent as granted, i.e. on the introduction of the feature of the originally filed claim 5 into claim 1 of the patent as granted. Claim 1 of the second auxiliary request is based on the combination of claims 1 and 6 of the patent as granted, i.e. on the introduction of the features of the originally filed claim 6 into claim 1 of the patent as granted. The respondent dealt with the subject-matter of the then dependent claims 5 and 6 in points 6.4 and 6.5 of its notice of opposition.
- 2.5 A reaction consisting of the introduction of the features of the originally filed claims 5 and 6 into claim 1 of the patent as granted cannot take the respondent by surprise, since as stated above the respondent had commented on said additional features in its notice of opposition. The incorporation of these claims, both relating to the form of the support elements - the essential features of the present proceedings - form further limitations, i.e. contribute to a convergent debate. They therefore do not add any complexity to the case and so both the Board and the respondent can deal with it without adjournment of the oral proceedings or remittal to the opposition division.
- 2.6 For the above-mentioned reasons, the Board exercises its discretion under Articles 13(1) and (3) RPBA and

admits the appellant's first and second auxiliary requests into the appeal proceedings.

3. *First auxiliary request - inventive step, Article 56 EPC*

3.1 The additional feature of claim 1 of the first auxiliary request over claim 1 of the main request defines that the support elements "have a configuration which is substantially trough-shaped".

3.2 In figure 1 of D1 the recesses 3 of the contoured panels 2 are depicted as V-shaped, i.e. having a form similar to the V-shaped support elements 5 depicted in figure 2 of the patent in suit. Therefore, said recesses can equally be considered as support elements having a "configuration which is substantially trough-shaped".

Accordingly, the additional feature of claim 1 of the first auxiliary request over claim 1 of the main request is known from D1.

3.3 Given the fact that the subject-matter of claim 1 of the main request has been considered by the Board as not involving an inventive step over D1, see point 1.7 above, the introduction of the above-mentioned additional feature, already known from D1, cannot contribute to inventive step either.

Therefore, the subject matter of claim 1 of the first auxiliary request does not involve an inventive step (Article 56 EPC).

4. *Second auxiliary request - amendments, Article 123(2) EPC*

4.1 According to Article 123(2) EPC the European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as originally filed.

4.2 The amendment in claim 1 of the second auxiliary request consists in the introduction of the additional features of dependent claim 6 of the patent as granted, i.e. of the originally filed dependent claim 6, defining that the support elements consist of "a plate and two trough-shaped members mounted on its two opposite edges, each of which is coupled with the plate by the external side of the bottom, respectively".

4.3 The Board notes that there is no feature in said claim 1 concerning the (overall) configuration of the therein claimed support elements.

4.4 On the other hand, originally filed claim 6 was dependent on the originally filed claim 5, said last defining that the support elements have a substantially trough-shaped configuration. Since it is the configuration of the support element, this can only mean its **overall** configuration. These features of claim 5 have not been taken up into claim 1.

The question therefore is whether there is sufficient original basis in the application as originally filed for the support elements being as claimed in claim 6, without any limitation where it concerns this (overall) configuration of the support elements.

4.5 The appellant argues that the features of claim 6 reflect a further development of the idea incorporated in claim 5, so that an insertion of the features of claim 6 into claim 1 of the second auxiliary request would suffice, i.e. it would render the additional feature of claim 5 redundant.

The respondent argues that present claim 1 now claims an object which is not shown in the figures as originally filed and for which there is no basis, if the overall trough-shape configuration of the support element is not also incorporated in the claim.

4.6 The Board cannot follow said appellant's argument. What counts is what a skilled reader of the application as originally filed would derive therefrom to be the embodiments of the invention.

The first embodiment is clearly that of figure 2; page 3, second paragraph; page 8, first paragraph and claim 5: a trough-shaped support element.

The second embodiment is clearly that of figure 3; page 8, second paragraph; no claim: a V-shaped trough (singular) with two plates having deflected wings, the latter each secured to a respective wing of the V-shaped trough.

The third embodiment is not shown in the figures, but has its basis in the description, page 3, third paragraph and in claim 6 **when dependent on claim 5**.

Indeed, the indicated passage of page 3 states: "... the trough-shaped support element may preferably consist of a plate and two trough-shaped members mounted on its opposite edges, each of which is coupled

with a plate from the external side of the trough-shaped member's bottom".

This concurs completely with a combined reading of claims 5 and 6 as originally filed.

The result is that present claim 1, not including the substantially trough-shaped configuration of the support element, is directed to a support element which has no basis in the application as originally filed.

- 4.7 The appellant argued that figure 3 provided sufficient basis for leaving the substantially trough-shaped configuration out of claim 1.

The Board cannot follow this argument either. The support element of present claim 1 consists of **a** plate and **two** trough-shaped members coupled with said plate. The support element depicted in figure 3 has a **substantially double-Y-shaped configuration** and has not only one but **two** plates coupled to one trough-shaped member. Said figure cannot therefore serve as basis for the amendments of claim 1 of the second auxiliary request.

- 4.8 For the above-mentioned reasons, the Board concludes that claim 1 of the second auxiliary request does not meet the requirements of Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

H. Meinders

Decision electronically authenticated