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**Datasheet for the decision
of 12 January 2018**

Case Number: T 0584/15 - 3.2.07

Application Number: 04810980.5

Publication Number: 1694911

IPC: D21F3/02

Language of the proceedings: EN

Title of invention:

SHOE PRESS BELT HAVING A GROOVED SURFACE

Applicant:

ALBANY INTERNATIONAL CORP.

Headword:

Relevant legal provisions:

EPC Art. 54(1), 123(2)

Keyword:

Amendments - main request, first, second, third and fifth
auxiliary requests - allowable (no)
Novelty - fourth auxiliary request (no)

Decisions cited:

T 1906/11, T 2119/11, T 1704/06

Catchword:



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Case Number: T 0584/15 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 12 January 2018

Appellant: ALBANY INTERNATIONAL CORP.
(Applicant) 1373 Broadway
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Representative: Rossi, Alexandra
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 4 November 2014
refusing European patent application No.
04810980.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman V. Bevilacqua
Members: G. Patton
R. Cramer

Summary of Facts and Submissions

- I. The appellant (applicant) lodged an appeal against the decision of the Examining Division refusing European patent application 04 810 980.5.
- II. In its decision, the Examining Division held that the main request and first, second, third and fifth auxiliary requests did not fulfil the requirements of Article 123(2) EPC and the fourth auxiliary request did not fulfil the requirements of Article 54(1) EPC.
- III. In the statement setting out the grounds of appeal the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request or one of the first to fifth auxiliary requests underlying the impugned decision.
- IV. In its communication pursuant to Article 15(1) RPBA dated 11 August 2017, annexed to the summons for oral proceedings set for 12 January 2018, the board gave its provisional opinion concerning the allowability of the main request and first to fifth auxiliary requests. The corresponding parts of said communication read as follows:

"4. Main request

The issue at stake consists in whether the omission of "continuous" grooves in alternative ii) of claim 1 contravenes the requirements of Article 123(2) EPC.

The board tends to preliminarily concur with the finding on page 4 of the impugned decision concerning the main request.

As a matter of fact, according to the disclosure of the application as originally filed only continuous grooves have a sinusoidal or zigzag form, see claim 15 (sinusoidal) and figure 14, page 15, lines 22 to 27 (zigzag).

Alternative ii) of claim 1 now covers that said grooves can be discontinuous. This however is not directly and unambiguously derivable from the application as originally filed taken as a whole by the skilled person using his common general knowledge.

In particular, the skilled person would be confronted with "additional, technically relevant pieces of information in the amended version" as stated in T 1906/11, not published in OJ EPO, mentioned by the appellant, that said grooves as disclosed in claim 15 or figure 14 could now be discontinuous.

The above is not in contradiction with T 2119/11, not published in OJ EPO, also cited by the appellant, since in order to arrive at the above-mentioned finding the whole disclosure of the application as originally filed is taken into consideration, i.e. not only the claims. In this respect it is noted that claim 14 cannot provide a support for the features of the groove shape (sinusoidal or zigzag) of alternative ii) of claim 1, contrary to the appellant's view. Indeed, the groove shape defined in claim 14 does not disclose said specific shapes which are only mentioned in claim 15 (sinusoidal) or shown in figure 14 (zigzag).

Contrary to the appellant's allegation there is no disclosure, hint or teaching in the application as originally filed suggesting that continuous grooves and discontinuous grooves would be equivalent alternatives

to be equally applied to all embodiments described in the application. On the contrary, a clear distinction is made for each embodiment with respect to whether it concerns continuous or discontinuous grooves. The passages cited by the appellant, page 5, lines 2 to 3 and 15 to 19 only mention the use of continuous or discontinuous grooves in general but not in combination with all the other features of alternative ii) of claim 1.

As a result, the board cannot find fault in the reasoning and finding of the impugned decision in this respect.

5. First auxiliary request

The issue at stake consists in whether grooves which are "discontinuous" and also "formed substantially in a machine direction" as specified in alternative iii) of claim 1 contravene the requirements of Article 123(2) EPC.

The board tends to preliminarily concur with the finding on pages 4 and 5 of the impugned decision concerning the first auxiliary request.

As a matter of fact, on the one hand, original claim 9 in combination with original claim 1 discloses discontinuous grooves of the type of alternative iii) of claim 1, without specifying the direction of said grooves.

On the other hand, lines 4 to 27 of page 16 of the originally filed disclosure refer to the machine direction for continuous grooves, see also figure 22.

The fact that the combination of claims 1 and 9 covers all angular orientation of the grooves does not enable to justify the selection now performed in alternative iii) of claim 1, contrary to the appellant's view. This is all the more true since, as argued by the appellant, the selection of the direction as claimed cannot be justified by a particular technical effect in the application as originally filed so that the skilled person using his common general knowledge would not be able to directly and unambiguously derive alternative iii) of claim 1 therefrom.

Figure 22 cannot be used as support in this respect as it undisputedly concerns continuous grooves.

The passage on page 5, lines 15 to 19, referred to by the appellant, only mentions the use of continuous or discontinuous grooves in general but not in combination with all the other features of alternative iii) of claim 1. It cannot however be a justification for modifying the specific disclosure of the embodiments.

As a result, the board cannot find fault in the reasoning and finding of the impugned decision in this respect.

6. Second and third auxiliary requests

The above reasons given for claim 1 of the first auxiliary request apply mutatis mutandis to alternatives iii) of claims 1 of the second and third auxiliary requests.

7. *Fourth auxiliary request*

The issue at stake consists in whether D3 discloses all the features of the belt of claim 1.

The board tends to preliminarily concur with the finding on pages 5 and 6 of the impugned decision concerning the fourth auxiliary request.

The appellant compares only the disclosure of D3 concerning the art of using the belt 2, whereby the grooves 9 are allegedly positioned on the inner surface of the belt with the intended use of the belt 51 according to the description of the present application. The board notes in this respect that the intended use of the claimed belt, i.e. its orientation when used in the shoe press, is not specified in claim 1. Furthermore, it is not immediately derivable from a belt according to D3 which is the inner and which is the outer surface.

The appellant's argument that the polymer resin material defined in claim 1 would not be compressible, in comparison with that of D3 is not convincing. Such "incompressibility" of the resin layer is not disclosed in the application as originally filed. The appellant's allegation of a link between "the goal of minimizing ingoing nip spray" and "incompressibility" of the resin layer is a new teaching which is not directly and unambiguously derivable from the application as originally filed taken as a whole by the skilled person.

As a result, the board cannot find fault in the reasoning and finding of the impugned decision in this respect.

8. Fifth auxiliary request

The issue at stake consists in whether the fact that it is specified in claim 1 that the grooves are "discontinuous" contravenes the requirements of Article 123(2) EPC.

The board tends to preliminarily concur with the finding on page 6 of the impugned decision concerning the fifth auxiliary request.

As a matter of fact, the disclosure of the application as originally filed concerning this type of grooves only relates to continuous grooves, see page 15, lines 27 to 31 and figure 15.

The board concurs with the appellant that the effect of reducing ingoing nip spray mentioned in claim 1 can be seen as being associated with the shoe press belts disclosed in the application, see for instance page 5, lines 12 to 14, page 15, lines 15 to 22 and claims 14 and 18. However, this does not justify the presence of discontinuous grooves.

As a result, the board cannot find fault in the reasoning and finding of the impugned decision in this respect."

- V. With its submission dated 5 January 2018 the appellant informed the board that it would not be attending the oral proceedings set for 12 January 2018. The appellant made no observations on the content of the board's communication.

VI. Oral proceedings before the board took place as scheduled on 12 January 2018. Since the duly summoned appellant, as announced with its above-mentioned submission did not attend, the oral proceedings were continued without the appellant according to Rule 115(2) EPC and Article 15(3) RPBA.

Reasons for the Decision

1. Although the appellant did not attend the oral proceedings, the principle of the right to be heard pursuant to Article 113(1) EPC is observed since that Article only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity (see the explanatory note to Article 15(3) RPBA cited in T 1704/06, not published in OJ EPO, see also the Case Law of the Boards of Appeal, 8th edition 2016, sections III.B.2.7.3 and IV.E.4.2.6.d)).
2. *Allowability of the main request and first to fifth auxiliary requests*
 - 2.1 Under the sections 4 to 8 of its above-mentioned communication the board stated why it considers that the main request and the first to fifth auxiliary requests are not allowable in view of the non-fulfilment of the requirements of either Article 123(2) or Article 54(1) EPC.
 - 2.2 The above-mentioned preliminary finding of the board has not been commented on nor has it been contested by the appellant during the appeal proceedings, see point V above.

2.3 Under these circumstances, the board - having once again taken into consideration all the relevant aspects concerning said issues - sees no reason to deviate from its above-mentioned finding.

2.4 As a consequence, the main request and the first, second, third and fifth auxiliary requests do not fulfil the requirements of Article 123(2) EPC and the fourth auxiliary request does not fulfil the requirements of Article 54(1) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

V. Bevilacqua

Decision electronically authenticated