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**Datasheet for the decision
of 13 February 2019**

Case Number: T 0336/16 - 3.2.08

Application Number: 05712985.0

Publication Number: 1711677

IPC: E06B3/673

Language of the proceedings: EN

Title of invention:

A METHOD FOR FORMING AN INSULATING GLAZING UNIT

Patent Proprietor:

Edgetech I.G., Inc.

Opponent:

LISEC Austria GmbH

Headword:

Relevant legal provisions:

EPC Art. 87(1), 54(2)

Keyword:

Priority - basis in priority document (no)
Novelty - (no)

Decisions cited:

G 0002/98, T 1852/13

Catchword:



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Case Number: T 0336/16 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 13 February 2019

Appellant: LISEC Austria GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 27 November
2015 rejecting the opposition filed against
European patent No. 1711677 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: M. Foulger
Y. Podbielski

Summary of Facts and Submissions

- I. With the decision posted on 27 November 2015, the opposition division rejected the opposition against European patent no. 1 711 677. They found that the priority was validly claimed and that the grounds of opposition under Articles 100(a) and (c) did not prejudice the maintenance of the patent as granted.
- II. The appellant (opponent) filed an appeal against this decision.
- III. Oral proceedings took place before the Board on 13 February 2019.
- IV. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed and that the patent be maintained as granted (main request), or in the alternative that the patent be maintained in amended form according to the first auxiliary request filed with the letter dated 29 August 2016, or according to the second auxiliary request filed during the oral proceedings.

- V. a) Main request

Claim 1 reads as follows:

"A method of applying a spacer to a glass sheet while forming an insulating glazing unit (6); the method comprising the steps of:

(A) providing a spacer body (10) in a storage container (24) wherein the spacer body (10) includes a pair of adhesive-carrying sides adapted to be connected to inner surfaces of two glass sheets (22) of the

insulating glazing unit (6);
(B) removing the spacer body (10) from the storage container (24);
(C) applying a sealant (18) to the spacer body (10) to form a sealant-laden spacer body after step (B);
(D) adhesively connecting one of the adhesive-carrying sides of the sealant-laden spacer body (10) to a first sheet of glass (22); and
(E) forming a spacer frame from the sealant-laden spacer body (10) after step (C) and while applying the sealant-laden spacer body (10) to the glass sheet (22); wherein the method is free of the step of manually handling the sealant-laden spacer body (10) after step (C)."

b) First auxiliary request

Claim 1 reads (changes with respect to the main request underlined):

"A method of applying a spacer to a glass sheet while forming an insulating glazing unit (6); the method comprising the steps of:

(A) providing a spacer body (10) in a storage container (24) wherein the spacer body (10) includes a pair of adhesive-carrying opposing sides adapted to be connected to inner surfaces of two glass sheets (22) of the insulating glazing unit (6), wherein the adhesive-carrying opposing sides carry a pressure-sensitive adhesive;

(B) removing the spacer body (10) from the storage container (24);

(C) applying a sealant (18) to the spacer body (10) to form a sealant-laden spacer body after step (B);

(D) adhesively connecting one of the adhesive-carrying sides of the sealant-laden spacer body (10) to a first sheet of glass (22); and

(E) forming a spacer frame from the sealant-laden spacer body (10) after step (C) and while applying the sealant-laden spacer body (10) to the glass sheet (22); wherein the method is free of the step of manually handling the sealant-laden spacer body (10) after step (C),
further comprising the step of attaching a second sheet of glass to the sealant-laden spacer body, further comprising the step of providing the spacer body in the form of a flexible, desiccant-carrying, foam-based material."

b) Second auxiliary request

Feature (C) is amended to read as follows:

"(C) applying a sealant (18) to notches on the opposing sides of the spacer body (10) to form a sealant-laden spacer body after step (B);"

VI. The following documents relating to an alleged public prior use (in the following "E8") are referred to in this decision:

E8-2: DWM Door & Window Maker Magazine, Vol. 6, Issue 2, March 2005, "glasstec 2004"

E8-4: "Eidesstattliche Erklärung", Herbert Schimek

E8-5: "Eidesstattliche Erklärung", Manfred Lesiak

VII. The appellant argued essentially as follows:

a) Main request

i) Priority

The invention claimed was not the same as that disclosed in the earlier application from which

priority was claimed. Thus, the claimed priority was not valid and the patent was only entitled to the filing date of 4 February 2005.

In the earlier application, dependent claim 17 was the only disclosure of the feature that the method is free of the step of manually handling the sealant-laden spacer body after step (C). The passage in the earlier application, p. 7, l. 18 - 20, on the other hand, did not clearly and unambiguously disclose that the spacer was not manually handled after step (C). Claim 17 was directly dependent on independent claim 15 and this was regarded as the only possible basis for the invention of the current claim 1.

Claim 15 of the earlier application contained several features which were no longer included in the current claim 1, including that of the pressure sensitive adhesive being attached to the spacer body and that the sealant was applied to opposed locations on opposite sides of the spacer. These two features were, moreover, consistently presented as being part of the inventive embodiment. There was no basis for omitting these features from the claimed method.

Hence, the current claim 1, without these features, related to a different invention and the priority was not valid.

ii) Novelty

As the priority was not valid, the prior use E8 was comprised in the state of the art. All features of claim 1 were disclosed in this prior use and consequently the subject-matter of claim 1 was not new.

b) First auxiliary request

i) Priority

The above objection relating to the sealant being applied to opposing sides of the spacer also applied to this request. The priority was not validly claimed.

ii) Novelty

The prior use E8 also disclosed all features of claim 1 of this request.

c) Second auxiliary request

i) Admission into the proceedings

This request was filed at a very late stage in the proceedings, i.e. during the oral proceedings and hence should not be admitted.

ii) Priority

The feature whereby a sealant was applied to notches on the opposing sides of the spacer body to form a sealant-laden spacer body after step (B), had been added. The earlier application only mentioned corner notches. The drawings also only showed corner notches. Thus the teaching of the earlier application had been generalised such that the current claim 1 concerned a different invention from that of the earlier application. The priority was therefore not valid.

iii) Novelty

The prior use E8 also disclosed all features of claim 1

of this request.

VIII. The respondent argued essentially as follows:

a) Main request

i) Priority

The claimed priority was valid. The claimed invention was based on claim 1 of the earlier application whereby the feature, that the method was free of the step of manually handling the sealant-laden spacer body after step (C), was derivable from p. 7, l. 16 - 22. Through "the use of automated equipment" it was clear that no manual handling took place. Since these passages did not disclose that the sealant was applied on opposite sides of the spacer there was no need to include this feature in the claim.

It may be that, in the earlier application, "adhesive" was presented as "pressure sensitive adhesive" but applying the three-point test for deletion of a feature led to the conclusion that the change to "adhesive" was admissible. The adhesive being pressure sensitive was not described as being essential for the invention, nor would the person skilled in the art recognise that the feature of "pressure sensitive" was essential to resolve the problem to be solved, nor would the person skilled in the art recognise that the removal of this feature required modification of other features to compensate.

Thus, the currently claimed invention was the same as that disclosed in the earlier application.

ii) Novelty

As the priority was valid the prior use was not comprised in the state of the art.

b) First auxiliary request

i) Priority

This request overcame the objection that only "pressure sensitive adhesive" was disclosed. The priority was validly claimed.

ii) Novelty

As the priority was valid the prior use was not comprised in the state of the art.

c) Second auxiliary request

i) Admission into the proceedings

This request was submitted as a reaction to the course of the proceedings and should thus be admitted into the proceedings.

ii) Priority

This request overcame the objections that the features "pressure sensitive adhesive" and the sealant being applied to opposing sides of the spacer were inadmissibly omitted. The priority was validly claimed.

In the earlier application, the expression "corner notch" merely meant a notch with a corner. Thus, the

earlier application was never limited to notches at the corner. Consequently, there had been no generalisation of the feature "corner notch" because every notch had a corner. The priority was therefore validly claimed.

iii) Novelty

As the priority was valid the prior use was not comprised in the state of the art.

Reasons for the Decision

1. Introduction

The patent is based on international application number PCT/US2005/003759 filed on 4 February 2005 and which claims the priority of US 60/541,552 filed on 4 February 2004.

The alleged public prior use E8 took place on 9 - 13 November 2004 at the glass industry trade show "glasstec" (see E8-2, E8-4 and E8-5). Thus it is only comprised in the state of the art under Article 54(2) EPC if the priority is not validly claimed.

2. Main request

2.1 Priority

2.1.1 G 2/98, EPO OJ 2001, 413, sets out the standard that is to be used when assessing whether an invention relates to "the same invention" as an earlier application as required by Article 87(1) EPC. According to Point 9 of the Reasons of G 2/98, "priority of a previous application in respect of a claim in a European patent

application in accordance with Article 88 EPC is to be acknowledged only if the person skilled in the art can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole."

2.1.2 The presently claimed method is "free of the step of manually handling the sealant-laden spacer body after step (C)". The description of the earlier application, p. 7, l. 18 - 20, cannot however provide a basis for this feature. Although this passage mentions the use of automated equipment, it does not explicitly indicate what happens after the sealant is applied at step C. Indeed, it is conceivable that after application of the sealant, the spacer is manually loaded into the automated application equipment.

2.1.3 Thus, the Board considers that claim 17 of the earlier application provides the only possible basis for this feature.

Claim 17 of the earlier application is however dependent on claim 15 which comprises features which are not included in the claimed invention of the patent. These features include "pressure sensitive adhesive" and that the sealant is applied "to two opposed locations on opposite sides of the spacer body".

2.1.4 The adhesive referred to in the earlier application is consistently presented as being a "pressure sensitive adhesive", see p. 5, l. 17 and claims 15 and 18. The person skilled in the art would not recognise that anything other than this was intended. In particular, claim 1 of the earlier application does not provide a basis for generalising "pressure sensitive adhesive" to

"adhesive" because it does not mention adhesive at all.

The argument that the "three point test" (cf. Guidelines, 2018, Part H, V-3.1) for omitting a feature could be used to justify this generalisation is not persuasive. According to recent jurisprudence of the Boards of Appeal it has been questioned to what extent this test is useful (see for example T1852/13, point 2.2 of the reasons). Moreover, whilst there is no specific statement that being pressure sensitive is essential to the invention, there is also no indication that anything else could be used. On the contrary, in the context of a spacer which is applied without the need for manually handling, the person skilled in the art would consider a pressure sensitive adhesive to be necessary for the claimed invention.

Therefore, the generalisation of "pressure sensitive adhesive" to "adhesive" is not directly and unambiguously derivable from the earlier application.

Unlike claim 15 of the earlier application, present claim 1 does not include the feature that the sealant is applied to two opposed locations on opposite sides of the spacer body before connecting it to the glass sheet. This feature is not only present in claim 15, which with claim 17 is the sole possible basis for the present claim 1, but is also consistently presented throughout the earlier application, see p. 5, l. 18, Figs. 2, 3, 7, 8.

Given that the point of the claimed method is to provide an insulated glazing unit, it is clear that the sealant must be applied to both sides of the spacer body before connecting it to the glass sheet. Hence, the person skilled in the art would not consider that

this feature could be removed from claim 15 without making other changes to compensate. Thus the omission of this feature is not directly and unambiguously derivable from the earlier application.

2.1.5 Hence, the priority of the claimed invention is not valid (Article 87(1) EPC).

2.2 Novelty

As the priority is not valid, the alleged public prior use whose availability to the public has not been disputed, is comprised in the state of the art according to Article 54(2) EPC.

It is undisputed that the prior use discloses:

A method of applying a spacer to a glass sheet while forming an insulating glazing unit; the method comprising the steps of:

- (A) providing a spacer body in a storage container wherein the spacer body includes a pair of adhesive-carrying sides adapted to be connected to inner surfaces of two glass sheets of the insulating glazing unit (see E8-4, 3rd para and E8-5, 3rd para);
- (B) removing the spacer body from the storage container (E8-5, 4th para.);
- (C) applying a sealant (Butyl - E8-5) to the spacer body to form a sealant-laden spacer body after step (B) (see E8-5, 3rd para.);
- (D) adhesively connecting one of the adhesive-carrying sides of the sealant-laden spacer body to a first sheet of glass; and
- (E) forming a spacer frame from the sealant-laden spacer body after step (C) and while applying the sealant-laden spacer body to the glass sheet; wherein

the method is free of the step of manually handling the sealant-laden spacer body after step (C) (see E8-4 and E8-5, final paragraphs).

Thus, as the prior use E8 is part of the state of the art according to Article 54(2) EPC, the subject-matter of claim 1 is not new.

3. First auxiliary request

3.1 Priority

Claim 1 of this request includes the feature of the pressure sensitive adhesive but not that the sealant is applied to two opposed locations on opposite sides of the spacer body. Thus for the reasons set out above for the main request, the priority of this request is not valid and the public prior use E8 comprises part of the state of the art according to Article 54(2) EPC.

3.2 Novelty

It is common ground that the prior use disclosed all features of claim 1.

Hence, the subject-matter of claim 1 is not new.

4. Second auxiliary request

4.1 Admission into the proceedings

Although only filed during the oral proceedings before the Board, this request was a reaction to developments during the oral proceedings. The Board therefore admitted this request into the proceedings.

4.2 Priority

Claim 1 of this request states that the sealant is applied to "notches" on opposite sides of the spacer. However only "corner notches" 16 are disclosed in the earlier application (p. 5, l. 18) which are shown in the figures as notches in the corners of the spacer (Figs. 2 and 3).

Since a notch typically has at least one corner, the term "corner notch" in the earlier application can, contrary to the respondent's view, only refer to notches located in the corner of the spacer. This feature has been omitted without a clear and unambiguous basis.

Hence, the claimed priority is not valid and the public prior use E8 is state of the art according to Article 54(2) EPC.

4.3 Novelty

It is common ground that the prior use disclosed all features of claim 1. Hence, the subject-matter of claim 1 is not new.

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:



I. Aperribay

M. Alvazzi Delfrate

Decision electronically authenticated