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**Datasheet for the decision
of 16 March 2023**

Case Number: T 1239/19 - 3.2.06

Application Number: 13728264.6

Publication Number: 2748358

IPC: D01D1/10, B29C47/42, B29C47/76,
C08J11/04, D01F6/42

Language of the proceedings: EN

Title of invention:
METHOD FOR MANUFACTURING BULKED CONTINUOUS FILAMENTS

Patent Proprietor:
Aladdin Manufacturing Corporation

Opponent:
Gneuß GmbH

Headword:

Relevant legal provisions:
EPC Art. 54, 111(1)
RPBA 2020 Art. 11

Keyword:

Novelty - main request (yes)

Remittal to the department of first instance

Remittal - special reasons for remitting the case - (yes)

Decisions cited:

Catchword:



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Case Number: T 1239/19 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 16 March 2023

Appellant: Aladdin Manufacturing Corporation
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 26 February
2019 revoking European patent No. 2748358
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Harrison
Members: P. Cipriano
W. Ungler
M. Hannam
D. Prietzel-Funk

Summary of Facts and Submissions

- I. An appeal was filed by the appellant (patent proprietor) against the decision of the opposition division revoking European Patent No. 2 748 358. The appellant requested that the decision under appeal be set aside and the patent be maintained as granted or, in the alternative, on the basis of an auxiliary request.
- II. With letter of 10 July 2019 the respondent (opponent) withdrew its opposition with the consequence that it was no longer a party to the appeal proceedings.
- III. The following documents, referred to by the appellant, are relevant to the present decision:
- D1 DE 197 22 278 A1
- D2 PowerPoint handout of a presentation titled "Innovative Aufbereitungs-lösungen für PET mit uneingeschränkter FDA - Lebensmittelzulassung" from GNEUSS KUNSTOFFTECHNIK GmbH
- D3 "MRS extrusion technology offers new options in PET", PLASTICS ADDITIVES AND COMPOUNDING, ELSEVIER SCIENCE, OXFORD, GB, vol. 11, no. 2, 1 March 2009 (2009-03-01), pages 24-26
- D4 WO 03/033240 A1
- D5 US 2010/152311 A1
- IV. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the subject-matter of claim 1 of the main request was considered to be novel over D2 and that, at least *prima facie*, the teaching of D1 when combined with D2 would

cause the skilled person to arrive at the subject-matter of claim 1 without exercising an inventive step. Further, the Board alluded to the possibility of remittal.

- V. With letter dated 9 February 2023, the appellant filed a new auxiliary request replacing its previous one.
- VI. With letter dated 20 February 2023, the appellant filed a new main request that the oral proceedings scheduled for 9 March 2023 be cancelled, that the Board issue a decision confirming the novelty of claim 1 as granted in view of D2, that the decision under appeal be set aside and that the case be remitted to the department of first instance for further examination of the compliance of the claims of the patent as granted with the remaining relevant provisions of the EPC as well as auxiliary requests A to G, which replaced the previously filed auxiliary request.
- VII. Claim 1 of the main request (claim 1 as granted) reads as follows:
"A method of manufacturing bulked continuous carpet filament, said method comprising:
(A) providing a multi-screw extruder (420) that comprises:
(i) a first satellite screw extruder (425A-H), said first satellite screw extruder (425A-H) comprising a first satellite screw that is mounted to rotate about a central axis of said first satellite screw;
(ii) a second satellite screw extruder (425A-H), said second satellite screw extruder (425A-H) comprising a second satellite screw that is mounted to rotate about a central axis of said second satellite screw; and

(iii) a pressure regulation system that is adapted to maintain a pressure within said first and second satellite screw extruders (425A-H) below 1.8 millibars;

(B) using said pressure regulation system to reduce a pressure within said first and second satellite screw extruders (425A-H) to below about 1.8 millibars;

(C) while maintaining said pressure within said first and second satellite screw extruders (425A-H) below 1.8 millibars, passing a melt comprising recycled polymer through said multi-screw extruder (420) so that: (1) a first portion of said melt passes through said first satellite screw extruder (425A-H), and (2) a second portion of said melt passes through said second satellite screw extruder (425A-H); and

(D) after said step of passing said melt of recycled polymer through said multi-screw extruder, forming said recycled polymer into bulked continuous carpet filament."

VIII. The appellant's arguments relevant to the present decision may be summarised as follows:

Main request - novelty

D2 did not disclose a method for the production of carpet BCF (bulked continuous filaments) at all. Instead it only disclosed a MRS device with general suggestions for the recycling of PET, as evident from certain slides. Slide 35 showed a process flowchart, while slide 36 only incidentally mentioned BCF.

Features A(iii), (B) and (C) were not disclosed. Although slide 21 disclosed a pump capable of operating between 1-5 mbar and a hypothetical possibility of operating within the claimed range (i.e. since the lowest pressure 1 mbar, is below 1.8 mbar), this was not disclosed for use in the production of carpet BCF. D2 also did not disclose a pressure regulation of the Roots pump for the production of BCF.

Request for remittal

The combination of D1 with D2 had not been raised previously in either the opposition proceedings or the appeal proceedings. Given the short time available before the scheduled oral proceedings and to ensure compliance with Article 113(1) EPC, the case should be remitted.

Reasons for the Decision

1. Main request - novelty
- 1.1 The opposition division considered that D2 disclosed a method of manufacturing bulked continuous carpet filament (see slide 36, where "PET BCF Teppichgarn" is explicitly disclosed), which comprised all the features of claim 1. In particular, the opposition division considered that D2 disclosed the features

A(iii) and (B) in slide 28, concerning the pressure regulation, and slide 21 which discloses that a pump generating vacuum of 1-5 mbar can be used, and feature

(C) in the titles "PET recycling" of slides 10-12, 18-20, 24-25, 29-31 and 36.

1.2 In items 1.2 to 1.6 of its preliminary opinion, the Board stated the following:

"The Board considers that D2 discloses a "method of manufacturing bulked continuous carpet filament", even if no specific method of such production is disclosed. It is evident from slide 36 for a skilled person that the machine may be used for this purpose and it is therefore considered to be implicit that a method (generally) of producing BCF, using the MRS, is therefore known.

Nevertheless, in agreement with the appellant, the Board can see no disclosure of the actual type of pump which is (necessarily) used when making BCF, nor which pressures would then necessarily be present, even if a Roots pump were to be used, noting that this might for example supply any pressure between 1 and 5 mbar, e.g. a constant 5 mbar if it were indeed used for making BCF.

Feature (B) thus appears not to be disclosed in D2 as a step in a method for manufacturing BCF.

Likewise, since it is not known which steps and systems are used to control pressure specifically when making BCF, feature A(iii) relating to the adaptation for maintaining the pressure below 1.8 mbar is also not disclosed in D2 (albeit a system of pressure regulation *per se* is considered to be present inevitably in such a process), nor the first part of feature (C) in regard to maintaining the pressure below 1.8 mbar.

The remaining features of the claim are however considered to be known."

- 1.3 The Board sees no reason to deviate from its preliminary opinion which is hereby confirmed. The subject-matter of claim 1 is thus novel over D2.
2. Request for remittal to the opposition division
 - 2.1 The appellant requested the case be remitted to the department of first instance for further examination.
 - 2.2 Under Article 111(1) EPC the Board of Appeal may either decide on the appeal or remit the case to the department which was responsible for the decision appealed. Under Article 11 RPBA 2020 the Board may remit the case to the department whose decision was appealed if there are special reasons for doing so.
 - 2.3 In the present case, the opposition division reasoned that D2 was prejudicial to the novelty of the subject-matter of claim 1 of the main request and *inter alia* disclosed features (A)iii), (B) and (C). That conclusion was however incorrect, for the reasons stated above in point 1.
 - 2.4 This circumstance also entirely changes the assessment of the various inventive step attacks on file involving D2, specifically with regard to the combination of D2 with common general knowledge, D3 to D5 and the combination of the teaching of D5 with D2. Attacks against novelty and inventive step involving D1 were also made by the (then) opponent. The appellant also discussed inventive step with regard to these documents in its grounds of appeal.

2.5 In its decision, the opposition division had further concluded that the subject-matter of claim 1 of a lower ranking request (i.e. a claim including all the features of claim 1 as granted) lacked an inventive step starting from D5 (see item 8 of the impugned decision). The Board notes, however, that the opposition division concluded that D5 also did not disclose feature (A)iii), i.e. that the pressure regulation system of D5 is adapted to maintain a pressure within said first and second screw extruders to below 1.8 millibars (see the second and sixth paragraphs of page 22 of the decision under appeal). As stated above this is also the preliminary opinion of the Board (see items 3.1 and 3.1.1 of the preliminary opinion). Yet, the opposition division went on to conclude that since D2 (in its view) did disclose this feature, an inventive step was lacking. As explained above, this was incorrect since the process and the process parameters used in D2 for making the BCF mentioned on slide 36 are simply not disclosed, not even implicitly.

2.6 The Board also stated in its provisional opinion that none of the documents D3 to D5 disclosed a pressure regulation method including the step of maintaining the pressure below 1.8 millibars (see item 2.4 of the preliminary opinion).

In this context, the Board nevertheless stated in item 2.3 of its preliminary opinion, that at least *prima facie*, the teaching of D1 combined with D2 would seemingly cause the skilled person to arrive at the subject-matter of claim 1 without exercising an inventive step.

- 2.7 However the Board's preliminary opinion was made on a *prima facie* basis since the appellant had, up to that point in time, had no need to present any arguments thereon in its defence. Due to the Board's finding on novelty as regards D2, differing fundamentally to the conclusion reached by the opposition division on several features of claim 1, the legal and factual framework of the appeal has changed significantly and to an extent such that the Board would be conducting an examination of several issues itself for the first time, and with arguments thereon in fact needing to be presented by the appellant at relatively short notice. Given the particular scenario before it, the Board concludes that such an examination would rather run counter to the purpose of the appeal proceedings.
- 2.8 The appellant also argued that this change of the framework indeed required further time in order to have the opportunity to develop its case and present further comments.
- 2.9 Under these circumstances, the Board considers that remittal is justified, not least since it gives the appellant the opportunity to fully develop its arguments in this regard. Thus a special reason exists for remittal of the case.
- 2.10 The case is thus to be remitted to the opposition division 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. Grundner

M. Harrison

Decision electronically authenticated