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Aktenzeichen / Case Number / N^o du recours : T 299/88 - 3.3.2

Anmeldenummer / Filing No / N^o de la demande : 81 100 868.9

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 035 133

Bezeichnung der Erfindung: Decorative laminates containing an air-laid web
Title of invention: and method of producing same
Titre de l'invention :

Klassifikation / Classification / Classement : D21H 5/26

ENTSCHEIDUNG / DECISION

vom / of / du 7 May 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Formica Corporation

Einsprechender / Opponent / Opposant :

Hoechst AG (Opponent 01)
Celias Ltd (Opponent 02)

Stichwort / Headword / Référence : Decorative Laminates/FORMICA

EPÜ / EPC / CBE Art. 123(3)

Schlagwort / Keyword / Mot clé : "Extension of protection (main request)"

Leitsatz / Headnote / Sommaire



Case Number : T 299/88 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 7 May 1990

Appellant :
(Proprietor of the patent) Formica Corporation
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Wayne, New Jersey 07470
USA

Representative :
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Respondent :
(Opponent) Hoechst Aktiengesellschaft, Frankfurt(Main)
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Representative :

Decision under appeal : Decision of Opposition Division of the European Patent Office dated 15 March 1988, posted on 6 May 1988, revoking European patent No. 0 035 133 pursuant to Article 102(1) EPC.

Composition of the Board :

Chairman : P. Lançon
Members : R. Schulte
A. Nuss

Summary of Facts and Submissions

- I. European patent No. 035 133 was granted on the basis of European patent application No. 81 100 868.9.
- II. The Respondents (Opponents 01 and 02) filed opposition against the European patent inter alia under Article 100(c) EPC on the grounds that the feature "laminate less than 4.0 mm thick" in Claim 1 of the patent as granted had not been disclosed in the application as filed. The Appellants (patent proprietors) had added this feature to Claim 1 during the grant proceedings so as to delimit the claim vis-à-vis United Kingdom patent specification GB-A-1 052 667.
- III. In proceedings before the Opposition Division the Appellants (patent proprietors) requested in a submission dated 23 June 1986 that the feature "laminate less than 4.0 mm thick" be deleted and that the patent be maintained as thus amended. The feature in question was not limitative since it was clear from other information given that the thickness of the end product was substantially less than 4.0 mm.
- IV. By decision of 15 March 1988, notified on 6 May 1988, the European patent was revoked on the grounds that Claim 1, as filed on 23 June 1986, contained an extension of the protection contravening Article 123(3) EPC.
- V. The proprietors have appealed against this decision, requesting that it be set aside and the European patent maintained with the claims as filed on 23 June 1986 or, in the alternative, as set out in requests 1 to 6, filed on 16 September 1988, with the amendment of 4 August 1989. Alternative request 1 contains main Claim 1 as granted.

The respondents request that the appeal be dismissed.

VI. In a communication of 12 December 1989 the Board pointed out that the deletion of the feature from the claim as granted constituted an extension of the protection conferred because that claim had not related to laminates thicker than 4.0 mm. Now that this feature had been reinstated in Claim 1 in accordance with request 1, the grounds for the contested decision were no longer valid. The case could thus be remitted with this request to the department of first instance for continuation of the proceedings, with a view in particular to examining for compliance with Article 123(2) EPC.

The parties thereupon dropped their requests for oral proceedings; the Appellants, however, pointed out that, with regard to the alternative requests, they were doing so only in case the Board did not intend to decide on the merits of the latter requests.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC. It is admissible.
2. **Main request**

The Opposition Division was right to revoke the European patent with Claim 1 as filed on 23 June 1986 because it infringed Article 123(3) EPC. The patent was granted with the feature "laminate less than 4.0 mm thick". Claim 1 as filed on 23 June 1986 does not contain this feature, and so the protection conferred by the European patent after deletion of this feature extends also to laminates thicker than 4.0 mm. The Board cannot share the Appellants' view that this feature is not limitative. While it may be true that, to a person skilled in the art, the subject-matter of

the patent as granted would primarily indicate laminates less than 4.0 mm thick, the use of thicker laminates for the purposes of the claimed invention is by no means inconceivable. The deletion of this feature accordingly in all claims (e.g. Claim 3 of auxiliary request 1) constitutes an inadmissible extension of the protection conferred within the meaning of Article 123(3) EPC, so that the contested decision revoking the European patent as thus worded was correct. The appeal therefore cannot succeed on the basis of the main request.

3. Alternative requests

Alternative requests 1 and 2 of 16 September 1988, 2 being amended with letter of 4 August 1989, contain Claim 1 as granted, i.e. including once again the feature "laminate less than 4.0 mm thick", the deletion of which led to the patent being revoked pursuant to Article 123(3) EPC. The grounds for revocation on which the contested decision was based are thus no longer valid and opposition proceedings can be resumed. The Board accordingly remits the case to the Opposition Division as provided for in Article 111(1) EPC.

When it resumes the proceedings, the Opposition Division will have to examine whether Claim 1 as formulated in alternative requests 1 and 2 complies with Article 123(2) EPC. The contested decision was unable to settle this question because the Opposition Division could only rule on the basis of the claims as filed on 23 June 1986. As the Opposition Division rightly noted in its communication of 26 October 1987 under II.2.4, the value to be given in the claim for the thickness of the laminate must comply with the requirements of both Article 123(3) and Article 123(2) EPC. This means that the claim may not cover thicknesses in excess of 4.0 mm, as otherwise it would contravene Article 123(3) EPC. Pursuant to Article 123(2) EPC, on the

other hand, the choice of the value to be indicated is not arbitrary but must have sufficient basis in the original disclosure. Consequently, if the Opposition Division concludes that the thickness of 4.0 mm was neither explicitly nor implicitly disclosed in the application as filed it will then have to consider whether a patent may be granted for a thickness of 1.2 mm, mentioned in Example 8, in accordance with one of the alternative requests 3 to 6 and whether such a claim meets the requirements of Articles 52 to 57 EPC and of Article 83 EPC in accordance with the grounds for opposition advanced, namely those of Article 100(a) and (b) EPC and Article 100(c) EPC in relation with the reasoning No. 2 above.

4. For the foregoing reasons the contested decision must be set aside and the case remitted to the Opposition Division for the proceedings to be continued on the basis of alternative requests 1 to 6 with the amendment of 4 August 1989.

Order

For these reasons, it is decided that:

1. The contested decision is set aside.
2. The case is remitted to the Opposition Division for the proceedings to be continued on the basis of alternative requests 1 to 6, filed on 16 September 1988 with the amendment of 4 August 1989.

The Registrar:

The Chairman:

M. Beer

P. Lançon