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**D E C I S I O N**  
**of 26 November 2001**

**Case Number:** T 0609/98 - 3.2.5

**Application Number:** 92300009.5

**Publication Number:** 0494729

**IPC:** B29C 63/10

**Language of the proceedings:** EN

**Title of invention:**

Paint roller and method and apparatus of manufacturing a paint roller

**Patentee:**

NEWELL OPERATING COMPANY

**Opponent:**

DEAR S.R.L.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 54, 56, 104(1)

**Keyword:**

"Novelty (yes)"  
"Inventive step (yes)"  
"Different apportionment of costs (no)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0609/98 - 3.2.5

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.5**  
**of 26 November 2001**

**Appellant:**  
(Opponent)

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**Representative:**

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**Respondent:**  
(Proprietor of the patent)

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**Representative:**

Crouch, David John  
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**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted 1 April 1998  
rejecting the opposition filed against European  
patent No. 0 494 729 pursuant to Article 102(2)  
EPC.**

**Composition of the Board:**

**Chairman:** W. Moser  
**Members:** P. E. Michel  
W. R. Zellhuber

## Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the opposition division rejecting the opposition against patent No. 0 494 729.

Opposition was filed against the patent as a whole based on Article 100(a) EPC (lack of novelty).

- II. The appellant requests that the decision under appeal be set aside and that the patent be revoked.

The respondent (patentee) requests that the appeal be dismissed and further requests that oral proceedings be held if the Board considered reversing the decision under appeal.

- III. In a communication dated 4 May 2001, the Board informed the parties of its provisional opinion. In response to the communication, the respondent requested costs to be awarded against the appellant in the absence of any fair refutation by the appellant of the points set out in the communication of the Board.

- IV. The following documents have been referred to in the appeal procedure:

D1: ES-U-283 921

D2: FR-U-2 575 964

D3: Allibert Catalogue

V. The claims of the patent as granted include three independent claims reading as follows:

"1. A paint roller (50) which includes a tubular core (23,24) and a fabric cover (44) on the core, the tubular core being formed of thermoplastic material, and the fabric cover being heat-fused to the core by heat softening (41,42) the upper surface region of the tubular core, characterised in that the tubular core is formed from at least two spirally-wound ply strips (23,24)."

"7. A method of making a paint roller which includes the steps of heating (41,42) the exterior of a continuously-formed core (23,24) while the core (23,24) is being advanced towards a discharge location, and forming a fabric cover on the core by wrapping strip fabric material (44) around the heated (41,42) surface of the tubular core while the core is being advanced whereby a continuous paint roller structure is formed, characterised in that the continuous tubular core is formed by wrapping strip core material (23,24) around a former (11) of decreasing diameter while continuously advancing (33,34) the formed core in a downstream direction."

"18. Apparatus for forming paint rollers, the apparatus including means for forming a continuous tubular core (23,24), means (32) for moving the continuous tubular core in a downstream direction, means for forming a fabric cover (left of 44, Fig. 2) on the continuous tubular core structure as the core structure moves in the downstream direction whereby a continuous paint roller blank is formed,

and means for severing (46) discrete portions of the paint roller blank as the blank continuously moves in a downstream direction, characterised in that the means for forming the continuous tubular core includes means for applying multiple layers (23,24) of strip stock in a spirally-wound wrap-within-a-wrap relationship, the surfaces of the wraps which overlie and butt one another being at an elevated temperature at the time of contact."

VI. The appellant argues essentially as follows:

The subject-matter of the patent in suit lacks novelty in view of the disclosure of documents D1 and D2, which disclose a method of manufacturing a paint roller in which a fabric band is helically wrapped upon a tubular core.

Document D3 discloses the manufacture of barrels or casks by extrusion wrapping, so that it does not involve an inventive step to apply this technique to the manufacture of a paint roller.

The patent should therefore be revoked.

VII. The respondent argues essentially as follows:

Neither document D1 nor document D2 discloses or suggests the paint roller, method or apparatus claimed in the patent in suit.

There is no evidence that the Allibert catalogue, i.e. document D3, was published before the priority date of the patent in suit.

Document D3 relates to the manufacture of large tanks for storage of corrosive chemical liquids in which extruded bands are wound around a mandrel. There is no suggestion that such a method could be applied to the manufacture of tubular cores for paint rollers. It is not obvious to modify the disclosed tanks to form a paint roller.

The subject-matter of the claims is thus new and inventive.

### **Reasons for the decision**

#### 1. *Novelty*

1.1 Both documents D1 and D2 relate to paint rollers in which the core is formed from a plastics tube. There is no suggestion in either of these documents of using a core formed from one or more spirally wound strips.

1.2 Document D3 does not refer to a paint roller.

1.3 The subject-matter of claims 1, 7 and 18 is thus new.

#### 2. *Inventive step*

2.1 The closest prior art is represented by either document D1 or D2. These documents disclose paint rollers in which the core is formed from a plastics tube.

A problem associated with the use of a plastics tube for the core is that, after wrapping the core with pile fabric, it is necessary to cut off the ends of the core blank, thus resulting in waste (see the patent in suit,

column 2, lines 1 to 9).

2.2 According to the invention, this wastage may be avoided by forming the core from spirally-wound strips. Nothing in the cited prior art suggests this solution. Document D3 (regardless of whether or not it can be proved that it was published before the priority date of the patent in suit) relates to forming large tanks for aggressive chemicals. It does not address the problem of wastage of core and pile fabric material during manufacture of paint rollers. Document D3 thus does not provide any indication to the person skilled in the art that the core of a paint roller should be formed from spirally-wound strips.

2.3 The subject-matter of claims 1, 7 and 18 thus involves an inventive step. Claims 2 to 6, 8 to 17 and 19 to 22 are directly or indirectly appendant to claims 1, 7 or 18 and relate to preferred embodiments of the subject-matter of the independent claims. The subject-matter of the dependent claims thus also involves an inventive step.

3. The patent may accordingly be maintained as granted.

4. *Costs*

The respondent requests an award of costs against the appellant in the absence of a fair refutation of the points set out in the official communication of 4 May 2001. In fact, the appellant has not responded to the official communication. However, the absence of such a response did not give rise to any additional costs incurred during taking of evidence or in oral proceedings pursuant to Article 104(1) EPC on the part

of the respondent and does not involve any abuse of the procedure. It is thus equitable that each party should meet the costs he has incurred in accordance with Article 104(1) EPC.

The request for apportionment of costs of the respondent is thus refused.

5. Since the respondent requested oral proceedings only if the Board were to reverse the decision under appeal, oral proceedings could be dispensed with.

## **Order**

### **For these reasons it is decided that:**

1. The appeal is dismissed.
2. The request for apportionment of costs of the respondent is refused.

The Registrar:

The Chairman:

M. Dainese

W. Moser