Europäisches Patentamt
Beschwerdekammern

European Patent Office
Boards of Appeal

Office européen des brevets
Chambres de recours

Case Number: T 130 / 83

T169

DECISION

of the Technical Board of Appeal 3.3.1

of 5 July 1984

Appellant: Redland Technology Limited
Redland House
Reigate
Surrey
England

Representative: Stuart David Mayes
Boult, Wade & Tenannt
27 Furnival Street
London EC4A 1PQ

Decision under appeal: Decision of Examining Division 028 of the European Patent Office dated 3 March 1983 refusing European patent application No 80301710.2 pursuant to Article 97(1) EPC

Composition of the Board:
Chairman: D. Cadman
Member: K. Jahn
Member: P. Ford

Summary of Facts and Submissions

I. European patent application No. 80 301 710.2, filed on 22.05.1980, published on 10.12.1980 (publication No. 0 020 102), claiming a priority of 10.12.1980, based upon a British application was refused by decision of the Examining Division 028 of the European Patent Office, dated 03.03.1983 on the basis of 22 claims of which claim 1 reads as follows:

"A dough moulding composition for moulding artificial slate products for use in construction and comprising an inorganic mineral filler, mineral or plastics fibres and resin characterised in that the resin is phenolic resin mixture comprising at least 10% by weight of the composition and consisting of a resole resin in liquid form and a novolak resin, the resole resin comprising at least 40% by weight of the resin mixture".

II. The refusal was on the grounds that the subject-matter of claim 1 did not involve a inventive step in view of 6 documents more elaborated in the decision.

III. Belatedly, i.e. on 20 May 1983, the appellants lodged an appeal against the decision of 3 March 1983, with payment of the fee, followed by a Statement of Grounds of the Appeal on 12 July 1983. On their request for restitutio in integrum, the appellants were restored in their rights by the decision of the Board dated 8 May 1984.

IV. In a communication from the Board dated 20 December 1983 the Board expressed its preliminary view on the questions of novelty and inventive step. In their response

received on 29 February 1984 the appellants submitted a revised set of 9 claims, now directed to a method of manufacturing a building product, of which claim 1 has the following wording:

"A method of manufacturing a building product for outdoor use as an artificial slate wherein finely divided inorganic mineral filler, synthetic thermosetting resin and fibrous material are mixed together and pressed and cured to form a product characterised in that a dough moulding composition comprising from 55 to 89.5% by weight of inorganic mineral filler, 0.5 to 15% by weight of glass fibres and 10 to 30% by weight of a phenolic resin mixture consisting of 40 to 60% of a resole resin in liquid form and 60 to 40% of a novalak resin in solid form is formed by mixing together the filler fibres and resins for a time sufficient to give a resultant composition having a dough like consistency and thereafter the composition is pressed in a mould at a mould pressure of from 0.34 to 4.27 MN/m^2 to form a cured product, said product being characterised by a water absorption after 24 hours of less than 1% by weight."

Viewed from the "Petrarch" product disclosed in GB-A-1 156 205 (3), the use of phenolic resins as claimed was not an obvious choice having regard to their known unreliable durability. A statement in support of this by Professor J.E. Bailey of Surrey University was presented. In this statement, an article was cited which is considered to teach away from the use of phenolic resins in building products.

The appellants apparently request that the decision under appeal be set aside and the patent be granted on the basis of the claims and the description filed on 29 February 1984.

Reasons for the Decision

1. The appeal complies with Articles 106-108 and Rule 64 EPC. It is therefore admissible.

2. In view of the order below to remit the case to the first instance the question of admissibility of the presently effective version of the claims can be left in abeyance.

3. The impugned decision was based mainly on claims to dough moulding compositions for artificial slate products. In the course of appeal proceedings these claims were dropped and claims to a method of manufacturing a building product were filed the scope of which were restricted to outdoor use as an artificial slate. For this envisaged purpose, the improvement in weathering performance as put forward by the applicant right from the beginning (cf. page 2 line 18 to page 3 line 17 in connection with page 8 line 16 to page 9 line 17) appears to become crucial. The Examining Division has not yet examined whether a method according to Claim 1 in its present version is patentable.

4. In addition, the appellant introduced a new document, namely the article "Phenolic laminating resins for most reinforced plastics production techniques" published in March 1980 in "Reinforced Plastics" on pages 76 to 78. It is concerned with easily processable resol-type pheno-

lics which impart to the building products prepared therefrom by hot press moulding a good mechanical performance and an excellent fire resistance. In view of this prior art, document (3) can no longer be considered as representing the closest state of the art. Therefore, a new assessment of inventive step should be carried out on the basis of the new document. For this purpose the question to be asked first should be what has actually been achieved by the application as claimed vis-a-vis this prior art. If the applicant claims, for example, advantages in durability, evidence in support ought to be produced. Such and, of course, further questions fall first of all within the competence of the first instance.

In this connection the Board is bound to say, without entering into the particularities of the case, that the citation in conjunction of as many as 6 documents goes far beyond what can be regarded as a reasonable approach in denying inventive step of a patent application.

5. In cases where claims have been changed substantially and a new state of the art has emerged, the appreciation of which is crucialin relation to what is claimed, it appears appropriate to remit the case to the first instance in order to ensure proper examination without loss of instance.

6. In its further examination, the Examining Division should also consider whether the generalisation of the term roofing tile (cf. page 10) to building product for outdoor use as an artificial state is admissible in view of the common known use of synthetic resin material for building products for both internal and external use

(see page 1 paragraph 2). Further questions to be answered are the admissibility of the term "finely divided" inorganic mineral filler and of the correction of the upper end of its range in claim 1. Moreover, it should be considered whether in particular the temperatures disclosed in combination with a definite range of pressure (see claims 19 and 20 as filed) can be simply deleted without offending against Article 123(2) EPC. It may also be questioned whether the term "platen" temperature in claim 3 is correct (see claim 19 as filed).

Order

For these reasons,

it is decided that:

1. The decision of the Examining Division of the European Patent Office is set aside.

2. The case is remitted to the Examining Division for further prosecution on the basis of the claims filed on 29 February 1984.

J. Ilbe

D. Cadman

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