

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 15 April 2024**

Case Number: T 0363/22 - 3.2.07

Application Number: 09831517.9

Publication Number: 2373463

IPC: B27D1/04, B32B21/14, B32B27/20,
C08G12/38

Language of the proceedings: EN

Title of invention:

A METHOD FOR PREPARING A WOOD VENEER PLATE

Patent Proprietors:

Metsäliitto Osuuskunta
Metadynea Austria GmbH

Opponents:

Firma Blomberger Holzindustrie GmbH
UPM-Kymmene Wood Oy

Headword:

Relevant legal provisions:

EPC Art. 100(a), 54, 113(1)
EPC R. 103(1)(a), 115(2)
RPBA 2020 Art. 11, 12(2), 15(3)

Keyword:

Novelty - main request (no)

Reimbursement of appeal fee - equitable by reason of
substantial procedural violation - right to be heard (no)

Remittal - auxiliary requests - special reasons (yes)

Decisions cited:

T 0012/81, T 2350/16

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0363/22 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 15 April 2024

Appellant: UPM-Kymmene Wood Oy
(Opponent 2) Niemenkatu 16
15140 Lahti (FI)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Respondent: Metsäliitto Osuuskunta
(Patent Proprietor 1) PL 10
02020 Metsä (FI)

Respondent: Metadynea Austria GmbH
(Patent Proprietor 2) Hafenstrasse 77
3500 Krems (AT)

Representative: Laine IP Oy
Porkkalankatu 24
00180 Helsinki (FI)

Party as of right: Firma Blomberger Holzindustrie GmbH
(Opponent 1) Königswinkel 2 - 6
32825 Blomberg (DE)

Representative: Brandt, Detlef
BRANDT & NERN PATENTANWÄLTE
Meisenstrasse 96
33607 Bielefeld (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 16 December
2021 rejecting the opposition filed against**

European patent No. 2373463 pursuant to Article
101(2) EPC.

Composition of the Board:

Chairman	A. Cano Palmero
Members:	S. Watson
	R. Cramer

Summary of Facts and Submissions

- I. An appeal was filed by opponent 2 against the decision of the opposition division rejecting the oppositions against European patent No. 2 373 463.
- II. In preparation for oral proceedings, the board gave its preliminary opinion in a communication pursuant to Article 15(1) RPBA, dated 19 October 2023, which took into account opponent 2's statement of grounds of appeal and its submissions of 6 March 2023 as well as the patent proprietors' reply to the appeal.

The patent proprietors responded to the board's communication with letter of 14 February 2024 and opponent 2 with letter of 14 March 2024.

Opponent 1, party as of right, announced that it would not attend oral proceedings before the board with letter of 3 November 2023.

- III. Oral proceedings before the board took place on 15 April 2024.

At the conclusion of the proceedings the decision was announced. Further details of the oral proceedings can be found in the minutes.

- IV. The final requests of the parties are as follows:

for opponent 2 ("appellant"):

- that the decision under appeal be set aside, and
- that the case be remitted to the opposition division for further prosecution, or alternatively,
- that the patent be revoked, and

- that the appeal fee be reimbursed.

for the patent proprietors ("respondents"):

- that the appeal be dismissed (main request);
- or if the decision under appeal is set aside, that the patent be maintained according to one of the sets of claims of auxiliary requests 1 to 14 filed with the reply to the statement of grounds of appeal, or alternatively,
- that the case be remitted to the opposition division for further prosecution.

V. Opponent 1 made no requests or substantive submissions in the appeal proceedings.

VI. The following documents are referred to in this decision:

- D1: GB 1 353 456 A;
- D3: US 2003/201054 A1;
- D8: Bittner, J. and Klotz, L. "Furniere - Sperrholz Schichtholz" 1940, Heft 76, pages 7,9, Heft 77, pages 15,19,40-42;
- D12: US 2005/003147 A1;
- D13: DE 295 16 464 U1;
- D14: US 5,074,946 A;
- D15: WO 99/22918 A1;
- D16: GB 1 283 232 A;
- D17: Juvonen R. and Kariniemi J. "Vaneriteollisuus" *Mekaaninen Metsäteollisuus 1*, 1985, page 114;
- D18: English translation of D17;
- D19: WO 2005/058991 A1;
- D25: Gideon, G., Vick, C. (1999) Adhesive Bonding of Wood Materials, Chap. 9, pp. 9-1 to 9-25, Forest Products Laboratory, Wood handbook -Wood as an engineering material,

Gen.Tech.Rep.FPL-GTR-113, Madison (WI), US
Dept. Agricult. ([https://
www.cedengineering.com/courses/adhesive
-bonding-of-wood materials](https://www.cedengineering.com/courses/adhesive-bonding-of-wood-materials))

- D55: Bittner J. "Furniere - Sperrholz
Schichtholz", Heft 76 1939 Julius Springer
Verlag, Berlin;
- D56: Klotz, L. "Furniere - Sperrholz
Schichtholz", Heft 77 1940 Julius Springer
Verlag, Berlin;
- D62: US 5,234,747 A.

VII. Independent claim 1 as granted (main request) reads as follows:

"A method for preparing a wood veneer plate, in which method, applying resin on not pre-impregnated wood veneer surfaces, piling the wood veneers on top of each other and hot-pressing together for curing the resin, characterised by applying the resin on surfaces which face each other when piled such that the resin is applied on at least 50%, advantageously at least 75%, most advantageously 100% of the surfaces facing each other when piled."

VIII. The wording of the claims of auxiliary requests 1 to 14 is not relevant to this decision so the claims are not reproduced here.

IX. The arguments of the parties relevant for the decision are dealt with in detail in the reasons for the decision.

Reasons for the Decision

1. *Substantial procedural violation*
 - 1.1 The appellant contended that the decision under appeal was insufficiently reasoned with respect to its objections of lack of novelty and lack of inventive step. Its right to be heard had therefore been infringed as fundamental arguments which it presented in opposition proceedings had not been mentioned or considered in the written decision.
 - 1.2 The respondents made no submissions on this issue.
 - 1.3 It is established case law that in order for a party's right to be heard under Article 113(1) EPC to be respected, a party must not only be given the opportunity to present comments on grounds and evidence, but these comments must also be duly considered. It must be clear from the written decision that core arguments raised by the parties were taken into account when the deciding body, in this case the opposition division, made its decision (Case Law of the Boards of Appeal, 10th edition 2022, ("CLB"), III.K.3.4.2).

This means that all decisive considerations in respect of the factual and legal aspects of the case must be discussed in the decision (CLB, III.K.3.4.3), which should consider the essential facts, evidence and arguments in detail with a logical chain of reasoning leading to the conclusion drawn (CLB, III.K.3.4.4a)). In the absence of such a discussion, it cannot be ascertained whether the opposition division duly considered the arguments of the parties or not.

1.3.1 In the present case the decision under appeal sets out which features of claim 1 as granted the opposition division found not to be present in each of documents D1, D3, D8/D55/D56, D12, D13, D14, D15, D16, D17/D18, D19 and D62 (see decision under appeal, II.7).

However, the decision under appeal does not set out the arguments presented by the appellant in the opposition proceedings, nor does it indicate why the opposition division disagreed with these arguments in relation to the alleged distinguishing features of claim 1 as granted, at least for document D12, as set out below.

1.3.2 In section II.7.5 of the decision under appeal, the opposition division found that two selections from two different lists in document D12 needed to be made in order to arrive at the claimed invention, so that the subject-matter of claim 1 was novel over this document.

No mention was made of the argument of the appellant, made in the written opposition proceedings and reiterated at the oral proceedings before the opposition division, that no selection from lists was required and even if it were, that a selection from two short lists of two items does not confer novelty (submissions of 10 August 2018, page 6, second paragraph; minutes of oral proceedings, page 6).

1.3.3 Therefore at least for the objection relating to lack of novelty of the subject-matter of claim 1 as granted with respect to the disclosure of document D12 the decision is insufficiently reasoned as no mention is made of the appellant's arguments and it therefore cannot be determined whether such arguments were duly considered, as required to fulfil Article 113(1) EPC.

1.4 A substantial procedural violation thus occurred in the proceedings leading to the decision under appeal.

2. With respect to the appellant's request for remittal to the opposition division for further prosecution for the main request, Article 11 RPBA does set out that fundamental deficiencies are, as a rule, special reasons for remittal. However, in the present case, as the main request had been decided upon in the decision under appeal and the primary object of the appeal proceedings is to review the decision under appeal (Article 12(2) RPBA), the board exercised its discretion under Article 111(1) EPC and decided on the main request.

3. *Novelty - claim 1 as granted - document D12*

3.1 In the decision under appeal, the opposition division found that document D12 disclosed that the veneers could be either pre-impregnated or not pre-impregnated (see decision under appeal, page 25, fourth complete paragraph).

In addition, D12 disclosed covering the entire area as a continuous coating as a preferred option, so that the skilled person had to choose between continuous or non-continuous coverage (see decision under appeal, page 25, penultimate paragraph).

The opposition division then reasoned that two selections from two different lists needed to be made in order to arrive at the claimed invention, so that the subject-matter of claim 1 was new over the disclosure of document D12 (see decision under appeal, page 25, final paragraph).

- 3.2 The appellant contested this finding and argued that no selections were required to arrive at the claimed invention.

According to the appellant, as D12 disclosed a lack of pre-impregnation as the default position and full resin coverage was singled out as the preferred option, no selections needed to be made.

Additionally, the appellant noted that even if it was considered that selections were needed, the options from which the skilled person would be required to select amounted only to two options for two features so that there were no selections from lists of a certain or some length.

- 3.3 The board agrees with the arguments of the appellant that the subject-matter of claim 1 of the patent as granted is not novel with respect to document D12, for the following reasons.

- 3.3.1 The board does not agree with the opposition division's application of the two list concept to the case at hand.

The board follows the established case law that the two list approach is generally used for mixtures of substances in the chemical field, such as starting substances for an end product, or analogous situations, and the lists must be of some length (see CLB, I.C.6.1 and I.C.6.2.1b), in particular, decision T 2350/16, Reasons 7.2 and T 12/81, Reasons 13).

In the present case there are no lists analogous to lists of alternative substances, and even if the contested features were to be regarded as selections

from lists, each "list" would consist of only two options.

Therefore, the board agrees with the appellant that the two list concept is not appropriate in the present case.

- 3.3.2 It is established case law that all features of a claim must be directly and unambiguously disclosed in a prior art document for lack of novelty to be accepted.

The prior art document must be considered as a whole, taking into account the skilled person's common general knowledge (see CLB, I.C.4.1).

- 3.4 The respondents argued that document D12 did not directly and unambiguously disclose all the features of claim 1 as granted as there was no explicit disclosure of not pre-impregnating veneer surfaces and in addition the features of hot-pressing the veneers and the resin being applied on at least 50% of the veneer surfaces facing each other when piled, were not disclosed together in a single embodiment.

3.5 *Pre-impregnation of veneer surfaces*

- 3.5.1 The opposition division reasoned that in the absence of an explicit disclosure that the veneer surfaces are not pre-impregnated that the skilled person had to select between not pre-impregnated and pre-impregnated veneer surfaces.

- 3.5.2 The board however agrees with the appellant that, when reading the application as a whole, the skilled person would understand that the default position in paragraph [0031] is of no impregnation of the veneer surfaces,

This is due to the absence of any impregnation step in paragraph [0031] together with the optional impregnation steps set out in paragraph [0035].

- 3.5.3 The board does not agree with the respondents' argument that the basic teaching of D12, set out in paragraph [0035], is to pre-impregnate the veneers for increased strength.

In the board's view, paragraph [0035] does not disclose the basic teaching of the document, which is related to orientation of the veneers (see D12, claims). Paragraph [0035] discloses possible treatment modifications to the basic teaching of document D12 which can be applied if desired.

Document D12 discloses in paragraph [0035] that "*[o]ne or more layers of the laminate can be treated to enhance the properties of the finished laminate*". As the treatment of the veneer is presented as an option, the skilled reader understands that the invention in D12 is in general to be carried out on untreated veneers, i.e. not pre-impregnated veneers.

This is further emphasised by the final sentence of paragraph [0035] which suggests that depending on the treatment and laminate product to be produced, the logs, the laminate layers or the finished laminate products may be treated as desired.

The board cannot agree with the respondents' argument that paragraph [0035] discusses solutions to achieve the aim of document D12 of providing a strong laminated wood. Paragraph [0035] sets out possible advantages of treating the logs, laminate layers or the finished laminate, including improved resistance to fire, pests

or environmental factors, or increased strength or stiffness. These advantages are not presented together with the basic teaching of document D12 to improve strength and appearance of the finished laminate through specific orientation of the laminate layers.

The skilled person understands from paragraph [0035] that the options presented in this paragraph give rise to further advantages in addition to the teaching relating to the layer orientation. Therefore as the impregnation options are understood as being advantageous additional features, it is inherent for the skilled person that the basic teaching, as set out in paragraph [0031], which contains no reference at all to impregnation, refers to veneers which have not been pre-impregnated.

3.6 *Glue coverage*

- 3.6.1 Paragraph [0031] of D12 describes that the laminates are prepared by applying glue over the surfaces of wood layers which are arranged such that their grains are aligned parallel and either tight surfaces or loose surfaces are in contact. Paragraph [0031] then discloses that "*[p]referably, both surfaces present at each glue joint will be coated with glue prior to contacting the layers to be joined.*"

Further, in paragraph [0036] of D12 it is confirmed that "*in each instance, the adhesive is preferable applied as a continuous layer covering the entire area over which the laminate layers are in contact*".

The respondents argued that paragraph [0031] did not disclose the area of each surface which was to be

coated with glue and the passage of paragraph [0036] related to a separate embodiment.

The board agrees with the respondents that the content of a document should not be treated as a reservoir where features can be taken from different embodiments and combined to artificially create a particular embodiment.

However, the board notes that if a document has suggested such a combination then this is a direct and unambiguous disclosure (see CLB, I.C.4.2).

In the present case, as the skilled person understands from paragraphs [0031] and [0036] that the preferred method is to coat both surfaces of the veneers with glue as a continuous layer, there is no creation of an artificial, arbitrary combination of features from separate embodiments.

As argued by the appellant, the description of D12 describes the preferred method in general in paragraph [0031] and then indicates in more detail the steps of the method in the further paragraphs [0032] to [0044].

Therefore there is a direct and unambiguous disclosure of the preferred method of document D12 including the feature that the resin is applied on at least 50% of the surfaces facing each other when piled.

3.7 *Hot pressing*

- 3.7.1 The respondents also argued that the feature of hot pressing is found in a separate embodiment to the glue coverage and that the curing may be carried out by hot

or cold pressing or by using radio frequency (RF) treatment.

The board again agrees with the appellant, that paragraph [0031] directly and unambiguously discloses hot-pressing.

The relevant passage of paragraph [0031] reads as follows:

"The assembled laminate structure may be placed in an unheated or heated press. Typically a force of 200-300 PSI is applied for 15 to 20 minutes. This process forces trapped air out of the glue joints and promotes tacking of the layers together. The laminate structure is then heated to 200° F.-280° C. (100° C.-137° C.) while clamped to a pressure of 200-300 PSI for 6-8 minutes, depending on the glue and wood employed. As an alternative to heating, radio frequency (RF) treatment may be used to heat and cure the adhesive."

The reference to an unheated press refers to an initial step for removing air, but is clearly followed by hot pressing. The reference to RF heating is presented as a possible alternative option, rather than the preferred method.

Paragraph [0031] therefore directly and unambiguously discloses, in the preferred general method, coating both veneer surfaces with glue and hot pressing.

3.8 In conclusion, the board does not agree with the respondents' argument that there is no single embodiment showing all features of claim 1, as the

combination is disclosed to the skilled reader directly and unambiguously.

The appellant has therefore convincingly shown that the decision under appeal should be set aside as the subject-matter of claim 1 is not novel with respect to the disclosure of document D12.

As the board came to this conclusion without considering document D25, it was unnecessary to consider and decide on the respondents' request that the appellant's arguments relating to this document not be admitted into the appeal proceedings according to Article 13(1) RPBA.

4. *Request for reimbursement of the appeal fee*

According to Rule 103(1)(a) EPC the appeal fee shall be reimbursed in full if a board deems an appeal allowable and if the reimbursement is equitable by reason of a substantial procedural violation.

As set out above, the board finds that a substantial procedural violation did occur (see point 1. of this decision) and that the appellant's appeal is allowable as claim 1 of the patent as granted is not novel with respect to D12 (see point 3. of this decision).

It is established case law that in order to render a reimbursement of an appeal fee equitable, there must be a causal link between the procedural violation and the necessity of filing an appeal (CLB, V.A.11.7.1).

In the present case, the reimbursement of the appeal fee is equitable as there is a causal link between the filing of the appeal and the procedural violation. The

appellant could not be certain whether or not its arguments had been duly considered, and was not able to determine why such arguments were not convincing for the opposition division, it therefore had no choice but to file an appeal.

5. *Auxiliary requests - remittal for further prosecution*

The appellant and the respondents requested that the case be remitted to the opposition division for further prosecution as none of the auxiliary requests had been considered in the decision under appeal.

Article 11 RPBA sets out that a case should only be remitted if special reasons present themselves for doing so.

The board follows the established case law that Article 11 RPBA has to be read together with Article 12(2) RPBA, which sets out that the primary object of appeal proceedings is to review the decision under appeal in a judicial manner (CLB, V.A.9.2.2a)).

Therefore, the board concludes that special reasons are present and the case should be remitted to the opposition division for further prosecution as requested by the appellant and the respondents, since the decision under appeal did not deal with any of the auxiliary requests. Otherwise, these requests would have to be dealt with for the first time in the appeal proceedings (see CLB, V.A.9.3.5b), which would lead to an undue burden on the appellant, the respondents and the board.

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.
3. The appeal fee paid by opponent 2 is reimbursed.

The Registrar:

The Chairman:



G. Nachtigall

A. Cano Palmero

Decision electronically authenticated