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**D E C I S I O N**  
**of 14 July 2005**

**Case Number:** T 0448/03 - 3.2.04

**Application Number:** 95304475.7

**Publication Number:** 0689857

**IPC:** A62C 35/02

**Language of the proceedings:** EN

**Title of invention:**

Apparatus for impulse fire extinguishing

**Patentee:**

Steur, Frans

**Opponent:**

Wilfried Wieggers

**Headword:**

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**Relevant legal provisions:**

EPC Art. 54, 56, 100(a), 106, 108 third sentence, 114(1),  
123(2)

EPC R. 55(c), 56

**Keyword:**

"Ground of lack of inventive step not substantiated in the  
notice of opposition"

"Fresh ground for opposition (yes)"

**Decisions cited:**

G 0009/91, G 0010/91, G 0001/95, T 0131/01

**Catchword:**

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Case Number: T 0448/03 - 3.2.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.04  
of 14 July 2005

**Appellant I:** Wilfried Wiegers  
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**Appellant II:** Steur, Frans  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
12 February 2003 concerning maintenance of  
European patent No. 0689857 in amended form.

**Composition of the Board:**

**Chairman:** M. Ceyte  
**Members:** C. Scheibling  
P. Petti  
H. Preglau  
M. Vogel

## Summary of Facts and Submissions

I. In its interlocutory decision posted 12 February 2003, the Opposition Division found that, taking into consideration the amendments according to the auxiliary request made by the patent proprietor during opposition proceedings, the European patent and the invention to which it relates, met the requirements of the EPC. On 7 March 2003 Appellant I (opponent) filed an appeal and paid the appeal fee simultaneously. On 14 April 2003 Appellant II (patentee) filed an appeal and paid the appeal fee simultaneously. The statements setting out the grounds of appeal of Appellants I and II were respectively received on 11 and 13 June 2003.

II. Opposition was filed on the grounds based on Article 100(a) (Articles 52(1) and 54) and 100(c) EPC.

III. Claim 1 of the main request (as granted) reads as follows:

"1. Apparatus for ejecting liquid or powdered medium, the apparatus comprising an ejection tube (1) for a liquid or powdered medium (11); a container (2) for a gaseous propellant and a quick action closing element (3, 31, 32) between the container (2) and the ejection tube (1), the ejection tube having an ejection end which is open to atmosphere and an input end for communicating with the propellant container, characterized in that the ejection tube (1) extends into the propellant container (2) that the ejection tube (1) and propellant container (2) are arranged on the same side of the closing element (3, 31, 32) which is mounted in the container (2) so as to close the

ejection tube (1) and isolate the tube from the propellant gas container(2), the apparatus further including means (5) to release the closing element (3, 31, 32) to an open condition in which the ejection tube (1) is subject to the propellant pressure, thereby expelling the medium."

Claim 1 according to the first auxiliary request (as amended during opposition proceedings) reads as follows:

"1. Apparatus for impulse fire extinguishing by ejecting liquid or powdered fire-fighting medium, the apparatus comprising an ejection tube (1) for a liquid or powdered medium (11); a container (2) for a gaseous propellant and a quick action closing element (3, 31, 32) between the container (2) and the ejection tube (1), the ejection tube having an ejection end which is open to atmosphere and an input end for communicating with the propellant container, characterized in that the ejection tube (1) extends into the propellant container (2) that the ejection tube (1) and propellant container (2) are arranged on the same side of the closing element (3, 31, 32) which is mounted in the container (2) so as to close the ejection tube (1) and isolate the tube from the propellant gas container(2), the apparatus further including means (5) to release the closing element (3, 31, 32) to an open condition in which the ejection tube (1) is subject to the propellant pressure, thereby expelling the fire-fighting medium."

IV. The following documents were cited during the appeal proceedings:

D1: EP-A-0 402 425

D2: WO-A-89/09082

V. Oral proceedings took place on 14 July 2005.

Appellant I (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

He mainly argued as follows: With respect to the main request, there is no indication in the whole of the application as originally filed, which was directed to an impulse fire extinguishing apparatus, that said apparatus could be used for something else. Thus, there is no basis in the application as originally filed for claiming an apparatus for ejecting liquid or powdered medium, which is not intended to fight fire.

With respect to the first auxiliary request, the Opposition Division considered that prior public availability of the claimed apparatus was not proven. Thus, the opponent had no possibility to present his lines of argument with respect to lack of novelty or if not successful, with respect to lack of inventive step. Therefore, an objection based on lack of inventive step should not be considered as a fresh ground for opposition.

Appellant II (patentee) mainly argued as follows:

The indication "apparatus for impulse fire extinguishing" has to be interpreted as meaning "apparatus suitable for impulse fire extinguishing" and therefore "impulse fire extinguishing" is not a limiting feature, which is to be considered when assessing novelty. Therefore, the deletion of said feature does not extend the claimed subject-matter of claim 1 as granted.

The notice of opposition neither substantiates nor even refers to the ground for opposition based on Article 56 EPC. Thus, raising this ground for opposition for the first time in the appeal proceedings amounts to introducing a fresh ground for opposition. Such a fresh ground for opposition cannot be introduced without agreement of the patentee, which in the present case is not given.

Appellant II requested that the decision under appeal be set aside and that opposition be rejected (main request), or that the decision be set aside and the patent maintained on the basis of one of the auxiliary requests 1 to 13 as submitted by letter date 14 June 2005.

## **Reasons for the Decision**

### *1. Admissibility of the appeals:*

- 1.1 The appeal of the Appellant II (patentee) meets the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

1.2 The opposition was only based on the ground of lack of novelty having regard to a prior use. In his statement setting out the grounds of appeal, Appellant I (opponent) raises not only the ground of lack of inventive step, but also the ground of lack of novelty having regard to D2. Point 5 of the statement setting out the grounds of appeal concerns a discussion of D2 leading to the conclusion that the subject-matter of claim 1 lacks novelty over this prior art document.

Thus, the statement setting out the grounds of appeal argues that the contested decision was incorrect and also gives the legal and factual reasons why the decision under appeal should be set aside and the appeal be allowed.

Accordingly, the appeal of the Appellant I meets the requirements of Article 108 EPC third sentence. Since it meets the further admissibility criteria set out in Articles 106 to 108 and in Rule 64 EPC, the appeal of Appellant I (opponent) is admissible.

2. *Main request - Article 123(2) EPC:*

2.1 Claim 1 as granted refers to an "apparatus for ejecting liquid or powdered medium, the apparatus comprising an ejection tube (1) for a liquid or powdered medium (11)" whereas claim 1 and the description as originally filed referred to an "apparatus for impulse fire extinguishing, the apparatus comprising an ejection tube for a fire-fighting medium".

According to the case law, "for" has to be interpreted as meaning "suitable for" and thus, is not limiting the

use of the apparatus to exclusively extinguish fire. However, the fact that the apparatus is "suitable for" impulse fire extinguishing, means that the apparatus must be able to do so and thus, apparatuses which would comprise all the claimed features, but would not be suitable for "impulse fire extinguishing", would not fall within the scope of the invention as originally filed. However, claim 1 as granted covers now all apparatuses for ejecting liquid or powdered medium, whether or not said apparatuses are suitable for impulse fire extinguishing.

Moreover, the indication "fire fighting" before "medium" imposes specific requirements to the apparatus to be able to contain these specific types of medium. Without this indication apparatuses only able to contain one special type of a non fire-fighting medium would also fall under the scope of the claim.

Appellant II argued that whether an apparatus is suitable for impulse fire extinguishing is not a limiting feature, and would therefore be disregarded when assessing novelty or inventive step. Consequently, its deletion cannot extend the subject-matter of the claim. Furthermore, he stated that all apparatuses for ejecting liquid or powder and exhibiting all the claimed features were suitable for impulse fire extinguishing.

This point of view is not shared by the Board. Whether or not an apparatus is suitable for a given use or is suitable to contain a specific medium implies specific requirements regarding the material the apparatus is made of and its capacity to contain the volume of



medium which is necessary to achieve the expected effect, which is to extinguish a fire.

Furthermore, in paragraph [0009] of the patent specification it is indicated "The invention is based on the recognition that if the fire fighting material is discharged into the air at high speed, the air resistance might be so great that it breaks down the mass of liquid to drops ... So the speed of discharging the fire fighting material is a crucial question and accordingly the problem to emit high amount of fire fighting material ... is a matter of emitting speed" and column 4, lines 18 to 20 it is indicated "The propellant gas then blows explosion like the charge from the ejection tube in the surrounding space". Thus, it becomes clear that the word "impulse" has been used in the claim to indicate that the medium has to be ejected at very high speed, which is obtained by a high propellant pressure. Therefore, by deleting the word "impulse" the indication that a high propellant pressure is needed has been removed. There is no indication in the application as filed that the expected effect can be obtained with a low propellant pressure, i.e. without "impulse" ejection.

Therefore, claim 1 as granted covers apparatuses which were not covered by claim 1 as filed and therefore, it contravenes the requirements of Article 123(2) EPC.

Thus, the main request of Appellant II is not allowable.

3. *First auxiliary request - Modifications:*
- 3.1 Claim 1 according to the first auxiliary request (as amended during opposition proceedings) differs from claim 1 as originally filed in that "liquid or powdered" has been introduced before "fire-fighting medium" and the feature "that the ejection tube (1) and propellant container (2) are arranged on the same side of the closing element (3, 31, 32)" has been added.
- 3.2 That the medium used to fight fire is a powder or a liquid is disclosed in the description as originally filed page 2, two first lines of the fourth paragraph.
- 3.3 That the ejection tube and propellant container are arranged on the same side of the closing element is disclosed in the Figures of the patent application as originally filed. In this respect, it has to be noted that, although in three out of the four disclosed embodiments, a same single cylinder is used to form the propellant chamber (21) and the equalizing chamber (22), it is clear for a skilled person that, in the meaning of the patent in suit, the propellant container corresponds only to the part of the cylinder which delimits the propellant chamber and that the part of the cylinder delimiting the equalizing chamber is not part of the propellant container.
- 3.4 Furthermore, amended claim 1 further limits the protection conferred with respect to claim 1 as granted.
- 3.5 The feature specifying that the medium used to fight fire is a powder or a liquid, which has been introduced in claim 1, has been deleted in claim 8 accordingly.

3.6 Thus, the modifications made are not objectionable under Article 123(2) and (3) EPC. This point has not been disputed by Appellant I.

4. *First auxiliary request - Novelty:*

4.1 The notice of opposition referred to a lack of novelty of the subject-matter of claim 1 with respect to an alleged prior use.

In his statement setting out the grounds of appeal, Appellant I refers to his submissions before the first instance concerning this alleged public prior use. Since this statement does not indicate why the conclusion drawn by the first instance is contested, the appeal is not substantiated in the meaning of Article 108 EPC as far as the alleged prior use is concerned. Consequently, the alleged prior use is not to be taken into consideration.

4.2 The apparatus of claim 1 differs from that disclosed in D1 by the features stated in the characterising part, in particular by the fact that the ejection tube extends in the propellant container, the ejection tube and the propellant container being arranged on the same side of the closing member.

D2 does not disclose an apparatus of the kind stated in the pre-characterising part of claim 1 having an ejection tube which is open to atmosphere.

4.3 The Board is thus satisfied that novelty of the subject-matter of claim 1 is given with respect to D1 and D2.

5. *First auxiliary request - Inventive step:*

5.1 According to the decision of the Enlarged Board of Appeal G 1/95 (OJ EPO 1996; 615; section 4.3), Article 100(a) EPC simply refers, apart from the general definition of patentable inventions according to Article 52(1) EPC, and the exceptions to patentability according to Article 53 EPC, to a number of definitions according to Articles 52(2) to (4) and 54 to 57 EPC, which specify "invention", "novelty", "inventive step" and "industrial application" which, when used together with Article 52(1) EPC, define specific requirements and therefore form separate grounds for opposition in the sense of separate legal objections or bases for opposition.

Thus, following this decision "novelty" and "inventive step" form two separate grounds for opposition.

5.2 Although Appellant I has crossed the box "inventive step" as a ground for opposition in the opposition form 2300.2 04.93, in his notice of opposition he clearly states (see section 1) "Das Einspruchsvorbringen stützt sich auf die Widerrufungsgründe gemäß Artikel 100(a) EPÜ in Verbindung mit Artikel 52(1) und 54 EPÜ. Zur Begründung bezieht sich das Einspruchsvorbringen auf eine offenkundige Vorbenutzung zu der zwei eidesstattliche Versicherungen überreicht werden".

Furthermore, in the whole of the notice of opposition no reference is made to an objection based on lack of inventive step.

Therefore, the Board comes to the conclusion that the ground of lack of inventive step has not been substantiated and thus not validly raised during the opposition proceedings. Consequently, according to the decision of the Enlarged Board of Appeal G 9/91 (OJ EPO 1993, 408, section 18), if the patentee does not agree to the introduction of a fresh ground for opposition, such a ground may not be dealt with in substance in the decision of the Board of Appeal at all.

- 5.3 Claim 1 according to the first auxiliary request has been modified with respect to claim 1 as granted. Thus, the question arises whether these amendments to claim 1 open the possibility for the opponent to raise all objections which may arise under the EPC including that of lack of inventive step, even if such objection was not substantiated in the notice of opposition and consequently, constitutes a fresh ground for opposition.

In this respect, the decision of the Enlarged Board of Appeal G 9/91 (section 19), confirms that in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, "**such amendments are to be fully examined** as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC)" (emphasis added). Thus, it should only be examined whether the amendments as such comply with the requirements of the EPC. This, in principle excludes Article 56 EPC, in cases where the opposition was

solely based on a novelty objection and where an inventive step objection would be a fresh ground for opposition, since inventiveness must be assessed having regard to the combination of all claimed technical features, the claimed amended features being considered not in isolation but in combination with the claimed unamended features.

In support of this conclusion the following is to be observed: The Enlarged Board of Appeal held in G 10/91 (The Summary of Facts and Submissions and Reasons for the Decision are identical in their wording to the corresponding sections of decision G 9/91, OJ EPO 1993, 408) that an Opposition Division or a Board of Appeal was not obliged to consider all the grounds for opposition referred to in Article 100 EPC going beyond the grounds covered by the statement under Rule 55(c) EPC. Exceptionally, however, the Opposition Division could, in application of Article 114(1) EPC, consider other grounds for opposition, which, prima facie, in whole or in part would seem to prejudice the maintenance of the European patent. In appeal proceedings fresh grounds for opposition may be considered only with the approval of the patentee.

It would not be consistent with the above principles if an amendment to the claim would allow a fresh ground for opposition under Article 100(a) EPC, in particular the ground of lack of inventive step, to be raised for the first time in the appeal proceedings.

It follows from the above that, the ground for opposition based on lack of inventive step is a fresh ground for opposition. Since the patentee did not agree

to the introduction of this fresh ground for opposition, it cannot be dealt with in substance in this decision.

- 5.4 It should additionally be noted that the above findings do not contradict the principles set out in decision T 131/01 (OJ EPO 2003, 423). The Board held in this decision that in a case where a patent has been opposed under Article 100(a) EPC on the grounds of lack of novelty and lack of inventive step having regard to a prior art document, and where the ground of lack of novelty has been substantiated pursuant to Rule 55(c) EPC, a specific substantiation of the ground of lack of inventive step is neither necessary - given that novelty is a prerequisite for determining whether an invention involves an inventive step and such prerequisite is allegedly not satisfied - nor generally possible without contradicting the reasoning presented in support of lack of novelty.

According to the definition given in the above decision G 1/95 the term "fresh ground for opposition" must be interpreted as a ground for opposition which was neither raised and substantiated in the notice of opposition, nor introduced into the proceedings by the opposition division in application of Article 114(1) EPC and in accordance with the principles set out in section 16 of G 10/91 (see point 5.3 above).

Even though in the present case the box in the standard form EPO 2300.2 04.93, indicating that the subject-matter of the European patent lacks an inventive step, has been marked with a cross, point 1 of the notice of opposition makes it clear that the patent has been

opposed only on the ground of lack of novelty. The notice of opposition contains no specific reasoning in support of lack of inventive step, let alone an allegation that the claimed subject-matter lacks an inventive step in view of the cited prior art. Thus, the ground of lack of inventive step is clearly not substantiated in the notice of opposition and consequently, according to the above definition constitutes a fresh ground for opposition, which may not be introduced in the appeal proceedings without the agreement of the patentee.

In the above case T 131/01 the standard form also indicates in the relevant box that the subject-matter of the European patent lacks an inventive step. In support of this allegation it was also submitted that a comparison between the known device discussed in the prior art document and that according to claim 1 revealed no difference and if there were some differences, which could not be seen at this time, these could only be so minor that they would not be able to impart an inventive step to the claimed subject-matter. Accordingly, the notice of opposition does contain a specific substantiation, although brief, in support of lack of inventive step. The Board in the case T 131/01 came to the conclusion that the ground of lack of inventive step was both raised and substantiated in the notice of opposition and consequently, was not a fresh ground for opposition.

5.5 For the above reasons, the first auxiliary request on which the interlocutory decision is based, can be allowed.



**Order**

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

The appeals are dismissed.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte