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**Datasheet for the decision
of 4 July 2016**

Case Number: T 2561/11 - 3.2.05

Application Number: 04732855.4

Publication Number: 1789717

IPC: F16L37/56

Language of the proceedings: EN

Title of invention:

Coaxial coupling

Relevant legal provisions:

EPC Art. 123(2)
EPC 1973 Art. 54(1)
EPC R. 99
RPBA Art. 13(1)

Keyword:

Admissibility of appeal 1 (yes)
Admission of a late-filed document (yes)
Remittal to the first instance (no)
Novelty (no; main request, auxiliary requests 1 to 3 and 7)
Inadmissible extension (yes; auxiliary requests 4 to 6)

Decisions cited:

G 0002/98, G 0002/10, G 0001/12, R 0012/09, R 0009/10,
J 0001/92, T 0331/87, T 0284/94, T 0910/03, T 0764/07,
T 0009/08, T 0358/08, T 0183/12, T 0256/13

Catchword:

Meaning of the expression "a request defining the subject of the appeal" in Rule 99(1)(c) EPC (point 2.5 of the reasons)



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2561/11 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 4 July 2016

Appellant 1: HYDRAM
(Opponent) Chemin du Lyonnais
69720 Saint Bonnet de Mure (FR)

Representative: Cabinet Laurent & Charras
Le Contemporain
50 Chemin de la Bruyère
69574 Dardilly Cedex (FR)

Appellant 2: N.V. Holmatro
(Patent Proprietor) Lissenveld 30
4941 VL Raamsdonksveer (NL)

Representative: Adriaan van Kooij
Arnold & Siedsma
Bezuidenhoutseweg 57
2594 AC The Hague (NL)

Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
19 October 2011 concerning maintenance of the
European Patent No. 1789717 in amended form.

Composition of the Board:

Chairman M. Poock
Members: O. Randl
G. Weiss

Summary of Facts and Submissions

I. The appeals of the opponent (appellant 1) and the patent proprietor (appellant 2) both aim at setting aside the interlocutory decision of the opposition division on the amended form in which European patent No. 1 789 717 could be maintained.

The opposition division had in particular considered document D1 (US 3,211,178).

II. In response to the provisional opinion of the board annexed to the summons to oral proceedings, appellant 2 filed a new main request and new auxiliary requests 1 to 3.

III. On 28 April 2016, appellant 1 filed document D4 (WO 82/03439).

IV. The oral proceedings before the board of appeal were held on 4 July 2016. At the beginning of the proceedings the representative of appellant 2 declared that the former main request and former auxiliary requests 1 to 3 were maintained as auxiliary requests 4 to 7.

V. Appellant 2 (patent proprietor) requested that the appeal be dismissed or that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the main or auxiliary requests 1 to 3 filed with letter dated 17 September 2015, or auxiliary requests 4 to 6 filed as main and auxiliary requests 1 and 2 with the statement setting out the grounds of appeal of 17 February 2012 or auxiliary request 7 filed as auxiliary request 3 filed with letter dated 1 November 2012. Furthermore it was

requested that the case be remitted to the department of first instance if document D4 is admitted to the proceedings.

VI. Appellant 1 (opponent) requested that the decision under appeal be set aside and that the European patent be revoked.

VII. Claim 1 of the main request reads:

"Coaxial coupling comprising a female part (5) and a male part (20) which are couplable to each other, the female part and the male part each having an inner passage and a concentric outer passage, wherein the inner passage of the female part is fluidly connected to the inner passage of the male part and the outer passage of the female part is fluidly connected to the outer passage of the male part in the coupled state (C) of the coupling, one of the parts further comprising a by-pass valve (3) that guides the fluid flow internally from the inner passage to the outer passage thereof in a non-coupled state of the coupling, the other part comprising an activator (22) for activating the by-pass valve (3) during coupling of the two parts, characterized in that

the by-pass valve (3) is adapted to guide:

- at a first stage (A) during coupling of the two parts, the fluid flow from the inner passage of the one part to the outer passages of both parts, wherein the outer passages of both parts are connected together; and
- at a second stage (B) during coupling of the two parts, the fluid flow from the inner passage of the one part to the inner passage of the other part, wherein during coupling of the two parts, the first stage (A) occurs prior to the second stage (B)."

Claim 1 of the first auxiliary request differs from claim 1 of the main request by the additional feature:

"and wherein:

at the first stage (A) during coupling, the one part is partially inserted into the other part;

at the second stage (B), the one part is further inserted into the other part; and

at the coupled state (C), the two parts are fully coupled."

and by amendments of the reference signs in brackets.

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request by the additional feature: "wherein at second stage (B) during coupling of both parts, which stage is intermediate to the first (A) and coupled state (C):

- the by-pass valve (3) opens the fluid passage to the inner passage of the other part (20), while the outer passages are connected with each other and with the inner passage of the one part (5), so that all passages are connected to each other".

Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request by the additional feature: "wherein at the first stage (A), a low pressure valve (21) is activated to allow the outer passages of both parts to be fluidly connected".

Claim 1 of the fourth auxiliary request differs from claim 1 of the main request in that "(C)" has been deleted after the first occurrence of "coupled state", in that both references "(B)" have been replaced by references "(C)", and in that "the" has been inserted before "coupling" in the last feature.

Claim 1 of the fifth auxiliary request differs from claim 1 of the fourth auxiliary request by the additional feature "and wherein: at the first stage (A), the one part is partially inserted into the other part; and at the second stage (C), the two parts are fully coupled".

Claim 1 of the sixth auxiliary request differs from claim 1 of the fifth auxiliary request by the additional feature "and wherein: at the first stage (A), a low pressure valve (21) is activated to allow the outer passages of both parts to be fluidly connected."

Claim 1 of the seventh auxiliary request corresponds to claim 1 of the request which the opposition division had found to comply with the requirements of the EPC. It differs from claim 1 of the fifth auxiliary request in that "characterized in that" has been replaced by "wherein", and by the additional feature "wherein at a third stage (B) during coupling of both parts, which stage is intermediate to the first (A) and second stage (C):

- the by-pass valve (3) opens the fluid passage to the inner passage of the other part (20), while the outer passages are connected with each other and with the inner passage of the one part (5), so that all passages are connected to each other".

VIII. Appellant 1 argued as follows:

(a) Admissibility of appeal 1

The appeal is admissible. It is correct that the notice of appeal does not mention the opponent, but the notice

mentions the same file reference as the opposition and the undersigned representative acted on behalf of the opponent in the oral proceedings before the opposition division. The filing of the appeal of appellant 1 has not adversely affected the patent proprietor. G 1/12 has established the possibility of correcting the name of the appellant. Appellant 2 knew very well who had filed the appeal. The error was corrected by letter dated 20 June 2012.

The notice of appeal implicitly contains a request for the revocation of the opposed patent. This was also the original request filed with the opposition.

(b) Admissibility of document D4

The document should be admitted. A competitor informed appellant 1 of the existence of this document on 13 April 2016. The document is highly relevant; it discloses all the features of claim 1.

(c) Remittal to the opposition division

Appellant 1 did not object to a remittal.

(d) Novelty of the main request

The sequence of claim 1 is unambiguously disclosed in the first paragraph of page 9 of document D4. There is a clear disclosure of the connection of the outer passages and of the inner passages via the outer passages. The inner passage is established when the high pressure channel 11 is still connected with the chamber 44 for the return flow, i.e. with the outer passage. The inner passages are connected when the outer passages are also connected.

(e) Novelty of auxiliary requests 1 and 2

The subject-matter of both requests lacks novelty over document D4.

(f) Novelty of auxiliary request 3

There is an unambiguous disclosure of a low-pressure valve 24 in document D4, page 8, lines 18-31. The subject-matter of auxiliary request 3 lacks novelty over document D4.

(g) Auxiliary requests 4 to 6

Claim 1 of the those requests corresponds to an inadmissible intermediate generalisation violating the requirements of Article 123(2) EPC, in particular because the essential stage B has been deleted.

(h) Auxiliary request 7

The subject-matter of this request lacks novelty over document D4.

IX. Appellant 2 argued as follows:

(a) Admissibility of appeal 1

Rule 99 EPC expresses the need for the patent proprietor to know who it is up against. The notice of appeal mentions no other entity than the opponent's representative and the patent proprietor. Contrary to the situation dealt with in decision G 1/12, there is no erroneous reference to a wrong appellant: there is no reference to the appellant at all. The omission of

any mention cannot be equated to a wrong mention. Therefore, there is no element eligible for correction: the repair of an omission does not qualify as a correction of an error. No proof for a genuine error has ever been supplied. There are third parties who started to use the invention, one of whom is known to have supplied appellant 1 with document D4; they could have reasonably employed Mr Vuillermoz, who had proven to be able to be successful to some degree in the preceding opposition proceedings. When the notice of appeal is considered in isolation, there is no justifiable reason on file to assume that the appeal was filed in the name of the former opponent. As a matter of fact, it is not clear at all on behalf of whom the notice of appeal was filed. There are decisions where appeals filed on behalf of the representative himself were found to be inadmissible, such as J 1/92.

The jurisprudence makes a distinction between the position of patent proprietors and opponents: the wrong identification of the opponent cannot be remedied (T 590/94). A transfer of an opposition is not allowed (G 3/97, G 2/04). There are strict conditions about the identity, the transfer, the prohibition of trade in oppositions, and the EPO has a duty to examine *ex officio* (T 1178/04). Decision G 1/12 cannot serve as excuse for such a transfer of opposition. By declaring the notice of appeal admissible because it is deducible on behalf of whom the appeal was formed, the board would go against a whole line of jurisprudence.

The notice of appeal does not define the subject of the appeal either. Decision T 9/08 cited by the board in the annex to the summons does not apply because the case underlying this decision was a simple case of

rejection of the opposition. In the present case the third auxiliary request among four was maintained. It was not clear whether the opponent wanted the patent to be revoked or the fourth auxiliary request to be examined. Also, decision T 9/08 is related to the grounds of appeal rather than the notice of appeal. Therefore, a reference to this decision is inappropriate.

In its preliminary opinion the board is too eager to excuse the deficiencies of the notice of appeal. Its approach deprives Rule 99(1) EPC of its significance.

(b) Admissibility of document D4

The document has been filed too late and should not be admitted to the proceedings. Moreover, appellant 1 has failed to show that document D4 is *prima facie* relevant.

(c) Remittal to the opposition division

If document D4 is admitted, the board should refer the case back to the opposition division; otherwise, appellant 2 would be deprived of assessment of its case in two independent instances, which would violate Article 6 ECHR. A remittal would also give appellant 2 the opportunity to file additional requests.

(d) Novelty of the main request

Document D4 does not disclose the claimed sequence of events. Figure 3 appears to disclose that the apertures 12 are covered by the slide ring 4 before the lower apertures 3 appear in the centre bore of element 28. The description is vague in respect of what

exactly the sealing ring 26 is. The description appears to disclose that the outer passages and the inner passages are simultaneously connected, which is different from the sequence of claim 1. The argument of lack of novelty is based on an alleged location of seal 26, which is not shown in the drawings. Several locations can be imagined. Appellant 1's assumption is retrospect.

(e) Novelty of auxiliary requests 1 and 2

The amendments on which these requests are based aimed at clarifying the subject-matter but do not further distinguish it over the state of the art.

(f) Novelty of auxiliary request 3

Document D4 does not disclose the existence of a low-pressure valve. The sliding ring 4 cannot be the anticipation of two distinct claim features.

(g) Auxiliary requests 4 to 6

The subject-matter of claim 1 of auxiliary requests 4 to 6 complies with the requirements of Article 123 EPC. Intermediate generalisations are not *per se* violations of this provision. The omission of step B is possible because the skilled person would understand that step A in itself achieves the unwanted build-up of pressure.

(h) Auxiliary request 7

This request corresponds to the request that had been found to be allowable by the opposition division. It was introduced in case the board found the appeal of appellant 1 to be admissible.

Reasons for the Decision

1. Applicable law

The application on which the opposed patent is based was filed on 13 May 2004. According to Article 7 of the Act revising the EPC of 29 November 2000 (OJ EPO 2007, Special edition No. 4, 217) and the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000 (OJ EPO 2007, Special edition No. 4, 219), Article 54 EPC 1973 and Articles 101, 106-108, 123(2) EPC apply in the present case. As a consequence, Rule 99 EPC is applicable, according to the principles established in decision J 10/07 (OJ EPO 2008, 567).

2. Admissibility of the appeal of appellant 1

2.1 Legal framework

The provisions governing the admissibility of appeals are Articles 106 to 108 EPC. An appeal can only be admissible if the notice of appeal is filed by a party adversely affected (Article 107 EPC 1973) by an appealable decision (Article 106 EPC), within two months of notification of the decision (Article 108 EPC). Pursuant to Rule 99 EPC the notice of appeal has to contain the name and the address of the appellant (Rule 99(1)(a) EPC), an indication of the decision impugned (Rule 99(1)(b) EPC) and a request defining the subject of the appeal (Rule 99(1)(c) EPC). Non-compliance leads to the appeal being declared inadmissible (Rule 101 EPC).

2.2 Factual situation

In the present case the decision was taken on 4 October 2011 and notified on 19 October 2011. The notice of appeal under consideration was filed on 16 December 2011, i.e. in good time, by Mr Bruno Vuillermoz. The letter head used identifies Mr Vuillermoz as member of the Laurent Charras law firm. The notice of appeal does not mention the name of the appellant. The header states "Appeal after Opposition, European patent No 1 789 717 In the name of: B.V. Holmatro Industrial Equipment ...".

Recours après Opposition
Brevet Européen no. 1 789 717
Au nom de : B.V. HOLMATRO INDUSTRIAL EQUIPMENT
N/Dossier : H20-O-27587

There is no further statement that would allow to directly determine the identity of the appellant. The decision impugned is identified ("la décision de la Division d'Opposition du 19 octobre 2011"). The notice of appeal does not contain any request defining the subject of the appeal other than the statement "we file an appeal against the decision ..." ("... nous formons un recours à l'encontre de la décision ...").

In what follows, the board will examine in detail whether this notice of appeal complies with the requirements of Rule 99(1) EPC.

2.3 Name and address (Rule 99(1)(a) EPC)

The notice of appeal is signed by Bruno Vuillermoz, who is identified as a member of the Laurent Charras law firm, whose address is also given.

Neither Mr Vuillermoz nor the law firm are parties to the opposition proceedings. However, Mr Vuillermoz is the person who was named as the professional representative acting for the opponent in the notice of opposition, to whom all the correspondence for the opponent (i.e. the decision under appeal) was addressed and who represented the opponent during the oral proceedings before the opposition division.

Being a professional representative, Mr Vuillermoz may be expected to be familiar with the provisions governing appeals and in particular with the fact that an appeal filed in his own name would have to be held inadmissible in the present opposition case. Therefore, it appears unlikely that Mr Vuillermoz intended to file an appeal in his own name.

Decision J 1/92 of 15 July 1992 is not relevant because in the case underlying that appeal the representative had expressly stated in the notice of appeal: "The appeal is lodged in my own name ..." (see point IV of the Summary of Facts and Submissions).

The header of the notice of appeal:

Recours après Opposition
Brevet Européen no. 1 789 717
Au nom de : **B.V. HOLMATRO INDUSTRIAL EQUIPMENT**
N/Dossier : H20-O-27587

is open to the interpretation that the appeal was filed in the name of ("au nom de") Holmatro, i.e. the patent proprietor. The expression "au nom de" appears to be more likely to refer to the appeal than to the European patent cited, but the reference given ("H20-O-27587") is the reference of the opponent mentioned in the notice of opposition:

Référence de l'opposant

H20-O-27587

One can of course imagine a situation in which the professional representative who has represented the opponent before the opposition division then takes up the representation of the patent proprietor (possibly in breach of professional rules concerning conflicts of interest) and files an appeal in the latter's name, mistakenly using the reference he used when he represented the opponent. However, such a situation is extremely unlikely to occur (appellant 2 itself spoke of "a silly assumption"); moreover, there is no indication whatsoever in the case file that a change of representative had taken place.

It is also extremely unlikely that Mr Vuillermoz would have filed the appeal on behalf of other competitors of the patent proprietor that had an interest in having the opposed patent revoked. Even if such a third party had approached the representative of appellant 1, the representative would have had to tell that party that an appeal in the third party's or his own name would necessarily be unsuccessful and that the only way to obtain a revocation before the EPO would require an appeal on behalf of the opponent.

The board is unable to discern any evidence for the alleged "trade in opposition" in the documents on file. The fact that another competitor has supplied appellant 1 with document D4 does not establish that appellant 1 is identical to this competitor. It can be in the interest of a company to help a competitor in its attempt to have another competitor's patent, which hinders both of them, revoked.

It should also be noted in the present context that an appeal "on behalf of the patent proprietor" was filed on 22 December 2011, i.e. six days after the notice of appeal under consideration.

Considering all the elements on file, the board is satisfied that a reader willing to understand would have understood, before the end of the time limit for filing an appeal, that the notice of appeal of 16 December 2011 had been filed on behalf of the opponent. There is no reasonable doubt as to the identity of appellant 1.

In its decision G 1/12 (OJ EPO 2014, A114) the Enlarged Board of Appeal has established that an erroneous indication of the name and address of the appellant in the notice of appeal can be corrected under Rule 101(2) EPC.

The present board is of the opinion that the omission of the name of the appellant (or the erroneous indication of the name of the patent proprietor, as the case may be) in the notice of appeal under consideration qualifies as an error, the true intention of Mr Vuillermoz having been to file the appeal on behalf of the opponent.

Incidentally, the board cannot endorse the argument of appellant 1 that decision G 1/12 does not apply to omissions. As a matter of fact, the Enlarged Board has analysed and endorsed the established jurisprudence in point 26 of the reasons for the decision:

"... Deficiencies including the need for substitution of the name of the indicated person by another and omissions regarding the appellant's name or address may be remedied under Rule 101(2), first sentence, EPC by invitation of the board of appeal, even after expiry of the two-month time limit under Article 108 EPC ... However, according to the boards' case law, the correction of the deficiency or the omission is possible only if it "does not reflect a later change of mind as to whom the appellant should be" ... This is the case if "it is possible to derive from the information in the appeal with a sufficient degree of probability, where necessary with the help of other information on file, e.g. as they appear in the impugned decision, by whom the appeal should be considered to have been filed" ..." (underlining by the board)

Appellant 1 has filed the correct name of appellant by letter of 20 June 2012 and its address by letter of 4 August 2015.

Therefore, the board finds the requirement of Rule 99(1)(a) EPC to be fulfilled.

2.4 Indication of the decision impugned (Rule 99(1)(b) EPC)

The notice of appeal refers to the "decision of the opposition division of 19 October 2011". As a matter of fact the opposition division had decided that the

patent could be maintained in amended form on the day of the oral proceedings (4 October 2011). It appears not to have taken any decision regarding this opposition on 19 October 2011. However, as the reasoned written decision has been dispatched in a communication dated 19 October 2011, a reader willing to understand would have understood the notice of appeal to refer to the decision of the opposition division dated 4 October 2011.

2.5 Request defining the subject of appeal (Rule 99(1)(c) EPC)

The notice of appeal of appellant 1 states that the appellant files an appeal "against the decision of the opposition division ...". The critical question is whether this can be considered as "a request defining the subject of appeal" within the meaning of Rule 99(1)(c) EPC.

In this context it has to be borne in mind that the applicable provisions have been amended when the EPC 2000 was drafted:

Rule 64(b) EPC 1973 requires the notice of appeal to contain "a statement identifying the decision which is impugned and the extent to which amendment or cancellation of the decision is requested".

Pursuant to Rule 99(1)(c) EPC [2000] the notice of appeal shall contain "a request defining the subject of appeal"; Rule 99(2) EPC adds that the appellant shall indicate in the statement of grounds of appeal "the reasons for setting aside the decision impugned, or the extent to which it is to be amended ..."

As a consequence, under the EPC 2000, the extent of the requested amendment does not have to be indicated in the notice of appeal any more but can be filed with the statement setting out the grounds of appeal, i.e. at a later stage. Therefore, the question arises what exactly is meant by the "request defining the subject of the appeal" mentioned in Rule 99(1)(c) EPC. What is clear is that it is a request and that this request cannot concern the extent to which amendment of the decision is requested.

In the present case the opposition division had found the subject-matter of the third auxiliary request to comply with the requirements of the EPC. Consequently, it has not examined the subject-matter of the fourth auxiliary request on file. In such a situation the appeal of the opponent could have different purposes. First, the opponent might wish to have the patent revoked rather than maintained in amended form. This is without doubt the most common situation. Secondly, the opponent might have found the fourth auxiliary request before the opposition division acceptable; in that situation the appeal would have the purpose of having the patent maintained with smaller scope.

Appellant 2 considered that in this situation the request defining the subject of the appeal of appellant 1 would be the indication of whether the opponent requested the patent to be revoked or to be maintained according to the fourth auxiliary request on file.

There is some merit in appellant 2's argument that otherwise the requirement of Rule 99(1)(c) EPC would be superfluous. If the requirement is satisfied by the general request that the decision under appeal be set

aside, then it is virtually always satisfied because this request is implicit in the filing of the appeal, the very purpose of which is to have the impugned decision be set aside. In other words, the appeal as such expresses this request and one can hardly imagine an appeal that would not comply with Rule 99(1)(c) EPC if the provision is understood in that way.

This notwithstanding, the board also has to take account of the established jurisprudence. The boards have repeatedly construed the appeal of patent proprietors against a decision to revoke the patent as a request that the decision be set aside in its entirety, even though there had been auxiliary requests before the opposition division (see in particular T 358/08 of 9 July 2009, points 1 to 5 of the reasons). Similarly, in appeals against the rejection of the opposition the appeal of the opponent was construed as a request to set aside the decision under appeal and revoke the patent (see e.g. decision T 9/08 of 1 October 2010, point 1 of the reasons - again, several requests of the patent proprietor were on file; more recent decisions: T 183/12 of 9 August 2013, point 1 of the reasons, and T 256/13 of 2 June 2015, point 1 of the reasons).

As a consequence, the board reaches the conclusion that in the present case the notice of appeal filed by the opponent has to be construed as comprising a request that the decision be set aside in its entirety, and that the requirements of Rule 99(1)(c) EPC are fulfilled.

2.6 Conclusion

The appeal of appellant 1 is admissible.

3. Admissibility of document D4

Document D4 was filed on 28 April 2016, i.e. about nine months after the summons to oral proceedings with an annex, in which the board expressed its provisional opinion that claim 1 of the main request lacked novelty over document D1, and more than six months after the filing of new requests by appellant 2. It cannot be said to be a reaction to a change of the procedural situation and, consequently, it is clearly late-filed. Its admission is governed by Article 13 of the Rules of Procedure of the Boards of Appeal (RPBA) of the EPO (OJ EPO 2016, Supplementary publication, page 41 et seq.).

Appellant 1 has not provided a proper justification of the belated filing of document D4, but its explanation of the circumstances of the discovery of the document is plausible. The board has no reason to believe that the late filing of the document was intentional. Appellant 2 received the document about two months before the oral proceedings. In view of the nature of the document the board considers that appellant 2 could reasonably be expected to deal with this document when preparing for the oral proceedings. Hence, Article 13(3) RPBA cannot be applied. Finally, the board finds document D4 highly relevant, as will become clear in the examination of novelty of the subject-matter of the main request (see point 5.). In view of these findings the board has decided to admit document D4 to the proceedings.

4. Remittal of the case

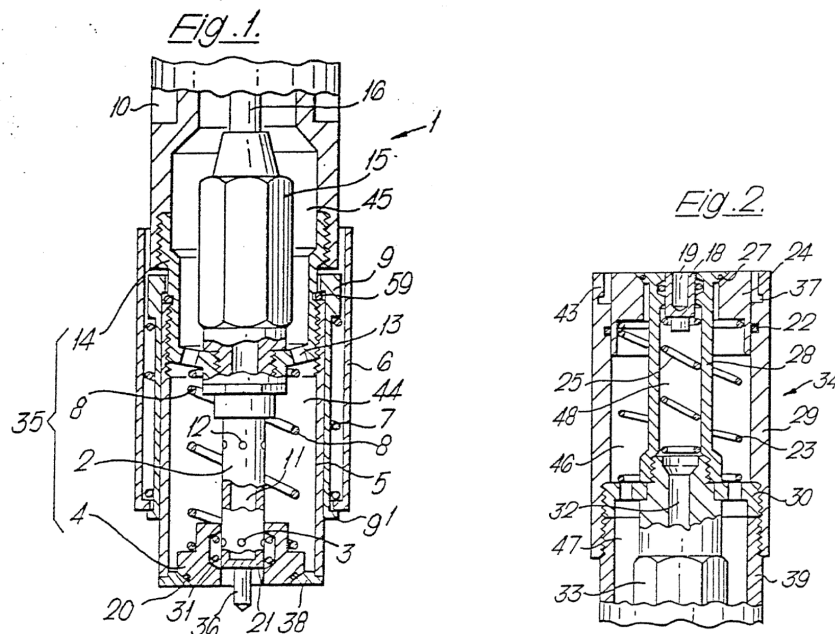
The board has decided not to remit the case to the opposition division. Although document D4 was filed about two months before the oral proceedings, it is clearly late-filed; still, appellant 2 and the board had enough time to deal with the document. Appellant 2 could have reacted to the filing of document D4 by filing additional requests; it could not rely on the assumption that the board would not admit document D4. Yet appellant 2 has not filed any new requests before the board. The responsibility for the missed opportunity for filing new requests, therefore, lies with appellant 2.

The dismissal of the request for remittal does not constitute a violation of Article 6 of the European Convention on Human Rights (ECHR) because this provision does not establish a right to assessment of a case in two independent instances. The EPC does not establish such a right either (see e.g. decisions R 12/09 of 15 January 2010, point 8 of the reasons, R 9/10 of 10 September 2010, point 8 of the reasons, and T 764/07 of 14 May 2009, point 2.2 of the reasons).

5. Main request

5.1 Novelty

Document D4 discloses a coaxial coupling (*cf.* title) comprising a female part ("female portion") 34 (see Figure 2) and a male part ("male portion") 1 (see Figure 1) which are couplable to each other (see Figure 3).



The female part 34 has an inner passage ("inner chamber") 48 and an outer passage ("return flow") 46. The male part 1 also has an inner passage ("high pressure channel") 11 and a concentric outer passage ("forward chamber") 44. As can be seen from Figure 3, the inner passage 48 of the female part 34 is fluidly connected to the inner passage 11 of the male part and the outer passage 46 of the female part 34 is fluidly connected to the outer passage 44 of the male part 1 in the coupled state of the coupling. The male part further comprises a by-pass valve 35 that guides the fluid flow internally from its inner passage 11 to its outer passage 44 (via aperture 12) in a non-coupled state of the coupling (shown in Figure 1). The other part 34 comprises an activator 28 for activating the by-pass valve 35 during coupling of the two parts. The by-pass valve 35 is adapted to guide, at a first stage during coupling of the two parts, the fluid flow from the inner passage of the male part 1 to the outer passages of both parts via apertures 12. The outer passages of both parts are connected together at this

stage (page 8, third paragraph). The by-pass valve 35 is also adapted to guide, at a second stage during coupling of the two parts, the fluid flow from the inner passage of the one part to the inner passage of the other part (page 9, first paragraph). Clearly, the first stage occurs prior to the second stage (the disclosure of the second stage is introduced by the words "during continued introduction", see page 8, line 33).

Therefore, the board has reached the conclusion that the subject-matter of claim 1 is not new over the disclosure of document D4.

The board is not persuaded by appellant 2's argument according to which the location of seal 26 is not unambiguously disclosed. The description in respect of Figure 2 states on page 7, lines 19-21: "A sealing piston 18 is maintained in the forward position as shown in fig. 2 by a pressure spring 25. A seal 26 ensures that no leakage occurs between the inner tube sleeve 28 and the sealing piston 18." When this statement is compared with Figure 2 there is no doubt what the reference 26 refers to, because there is only one seal depicted between the inner tube sleeve 28 and the sealing piston 18.

5.2 Conclusion

The main request cannot be allowed because it does not comply with the requirements of Article 54(1) EPC 1973.

6. Novelty of auxiliary requests 1 and 2

The amendments on which these requests are based aim at clarifying the claimed subject-matter but do not

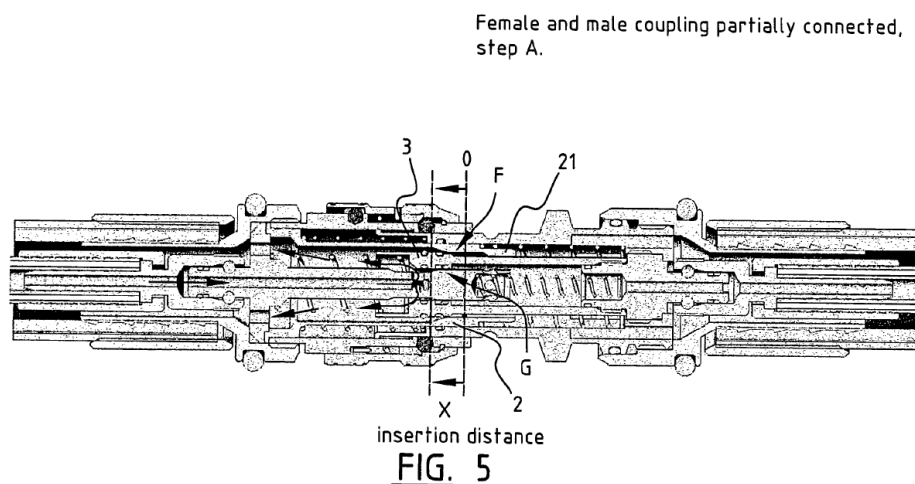
further distinguish it over the state of the art. The subject-matter of claim 1 having been found to lack novelty (see point 5.1), these requests have to be rejected for the same reasons.

7. Auxiliary request 3

7.1 Novelty

The novelty of claim hinges on the additional feature according to which, at the first stage, a low pressure valve is activated to allow the outer passages of both parts to be fluidly connected.

Claim 1 uses reference 21 for the low-pressure valve. Figure 5 of the opposed patent shows this element:



A comparison with the coaxial coupling of document D4 shows that sealing ring 24 disclosed in that document plays exactly the same role as the low-pressure valve 21 of Figure 5 of the opposed patent. Document D4 further discloses that "[w]hen the coupling halves ... are connected together the inner and outer tube sleeve ... of the male portion are introduced into the

respective inner and outer sleeves ... of the female portion and thereby act on the sealing ring 38 of sealing ring 24 of the outer tube sleeve 5 of the male portion which is pushed into the female portion 34. Even after a few tenths of a millimetre displacement of sealing ring 24 a gap is opened between sealing ring 2' and the inner tube sleeve 28, and a connection is formed between the forward chamber of the male portion for the return flow 44 and the forward chamber of the female portion for the return flow 46." (page 8, lines 18-27). Consequently, there can be no doubt that the sealing ring 24 of document D4 constitutes a low-pressure valve within the meaning of claim 1 that is activated to allow the outer passages of both parts to be fluidly connected.

Therefore, the board has reached the conclusion that the subject-matter of claim 1 is not new within the meaning of Article 54(1) EPC 1973 over the disclosure of document D4.

7.2 Conclusion

Auxiliary request 3 cannot be allowed because it does not comply with the requirements of Article 54(1) EPC 1973.

8. Auxiliary request 4

8.1 Admissibility of the amendments

The question before the board is whether the subject-matter of claim 1 is the result of an unallowable "intermediate generalisation" with respect to the teaching of the original application. The core argument of the opposition division was that the passage from

page 5, line 18 to page 6, line 10 of the application as filed disclosed three coupling steps A to C and that by inserting only features related to steps A and C and by omitting features related to step B appellant 1 had derived subject-matter that was not directly and unambiguously disclosed in the original application. Moreover, the features related to step B could not be considered to be inessential (and, therefore, omitted, according to the three-step test defined by decision T 331/87) because they were needed to solve the objective problem (preventing pressure build-up during coupling).

The board is of the opinion that when compliance with Article 123(2) EPC is examined, the examination should be carried out in accordance with the "gold standard" reaffirmed in decision G 2/10 of the Enlarged Board of Appeal (OJ EPO 2012, 376) rather than by using tests that may have proven useful for particular cases but which amount to extrapolations the general validity of which is questionable. It should also be noted that the three-step test according to T 331/87 has been found not to be reconcilable with the findings of the Enlarged Board of Appeal in its opinion G 2/98 (OJ EPO 2001, 413); see T 910/03 of 7 July 2005, point 3.5 of the reasons. According to the "gold standard", amendments are possible only "within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed" (G 2/10, point 4.3 of the reasons). Whether features are "essential" or not is irrelevant in this context.

Thus the question to be answered in the present case is whether the skilled person using his common general

knowledge would derive from the disclosure of the original application that the coaxial coupling may contain a by-pass valve adapted to guide the fluid flow from the inner passage of one part to the outer passages of both parts at a first stage A and from the inner passage of one part to the inner passage of the other part during a subsequent stage C, without there necessarily being the intermediate stage B in which the by-pass valve opens the fluid passage to the inner passage of the other part while the outer passages are connected with each other and with the inner passage of the first part.

First it has to be noted that the application discloses one particular set of connectors. When these particular connectors are being coupled, the connecting process necessarily involves stages A, B and C. In other words, the existence of stage B has a structural counterpart in the only disclosed embodiment; there is no way to connect these connectors without having stage B.

In stage A the fluid flows from the inner passage of one part to the outer passages of both parts. In stage C the inner passages are connected to each other only. Therefore, in the intermediate stage the inner passage of the one part has to be disconnected from the outer passages and to be connected to the inner passage of the other part. The particularity of the disclosed intermediate stage B is that the connection to the inner passage of the other part is established before the connection to the outer passages is severed. There is no disclosure whatsoever of the alternative, i.e. of a device in which the connection to the outer passages is shut before the connection to the other inner passage is established.

Appellant 2 has based its reasoning on the distinction of the technical effects of stages A and B. The application states, with respect to stage A: "Since both return passages are connected together and also still connected to the inner pressure passage, no pressure is build-up (sic) in the coupling system" (page 5, lines 26-29; *cf.* Fig. 5). When stage B is discussed, the application notes: "All passages are connected to each other and again no pressure is build-up (re-sic) in the coupling system." (page 6, lines 2-3; *cf.* Fig. 6; emphasis by the board). According to appellant 2, the use of "again" expresses that "step B achieves its effect apart from step A, and in addition thereto" (Response to appeal 1, page 6, end of fifth paragraph).

The teaching related to stage A could be distinguished from the teaching related to stage B if the original application directly and unambiguously disclosed intermediate stage B to correspond to the solution of a problem than can be distinguished from the problem solved by the features related to the features involving stages A and C (*cf.* in this context T 284/94 of 25 November 1998, point 2.1.3 of the reasons). It is doubtful whether this is the case here, because the invention is presented as a solution to the problem of "unwanted pressure build-up" (page 3, first paragraph). If the connectors are designed such that the connection to the outer passages is shut before the connection to the other inner passage is established, then the unwanted pressure build-up will necessarily occur. In other words, the desired outcome is only obtained if there is no pressure build-up in both stages A and B. It is true that stage A in itself avoids pressure build-up during the initial stage of coupling, as argued by appellant 2, but the overall result would not

be obtained if the pressure build-up occurred in the intermediate stage.

8.2 Conclusion

The intermediate generalisation that has led to claim 1 does not comply with the requirements of Article 123(2) EPC.

Consequently, auxiliary request 4 cannot be allowed.

9. Auxiliary requests 5 and 6

What has been said in respect of the main request (see point 8.1) also applies to auxiliary requests 5 and 6. The intermediate generalisation that has led to claim 1 does not comply with the requirements of Article 123(2) EPC.

Auxiliary requests 5 and 6 cannot be allowed either.

10. Auxiliary request 7

10.1 Novelty

Document D4 discloses a coaxial coupling comprising a female part 34 (see Figure 2) and a male part 1 (see Figure 1) which are couplable to each other (see Figure 3). The female part 34 and the male part 1 each having an inner passage 48 and 11 and a concentric outer passage 46 and 44, respectively. Figure 3 shows that the inner passage 48 of the female part 34 is fluidly connected to the inner passage 11 of the male part 1 and the outer passage 46 of the female part 34 is fluidly connected to the outer passage 44 of the male part 1 in the coupled state of the coupling. The

male part 1 comprises a by-pass valve 35 that guides the fluid flow internally from its inner passage 11 to its outer passage in a non-coupled state of the coupling (Figure 1). The female part comprises an activator 28 for activating the by-pass valve 35 during coupling of the two parts. The by-pass valve 35 is adapted to guide, at a first stage during coupling of the two parts, the fluid flow from the inner passage of the male part 1 to the outer passages of both parts via apertures 12. The outer passages of both parts are connected together at this stage (page 8, third paragraph). The by-pass valve 35 is also adapted to guide, at a second and last stage during coupling of the two parts, the fluid flow from the inner passage of the one part to the inner passage of the other part (see page 8, line 33). Clearly, the first stage occurs prior to the second stage. At the first stage, the male part is partially inserted into the other part (page 8, lines 18 et seq.) and at the second stage (Figure 3), the two parts are fully coupled. There is also an intermediate stage in which the by-pass valve 35 opens the fluid passage to the inner passage of the other part via apertures 3, while the outer passages are connected with each other - through the gap between sealing ring 24 and inner tube sleeve 28 (page 8, lines 24-27) - and with the inner passage of the one part via apertures (until the apertures 12 are covered by the slide ring 4: page 9, lines 9-14), so that all passages are connected to each other.

Therefore, the board has reached the conclusion that the subject-matter of claim 1 is not new within the meaning of Article 54(1) EPC 1973 over the disclosure of document D4.

10.2 Conclusion

Auxiliary request 7 cannot be allowed because it does not comply with the requirements of Article 54(1) EPC 1973.

Order

For these reasons it is decided that:

1. The appeal of appellant 1 is admissible.
2. The decision under appeal is set aside.
3. The patent is revoked.
4. The appeal of appellant 2 is dismissed.

The Registrar:

The Chairman:



L. Malécot-Grob

M. Poock

Decision electronically authenticated