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Datasheet for the decision of 9 January 2015

Case Number: T 0576/12 - 3.2.01

Application Number: 05803807.6

Publication Number: 1819539

IPC: B60H1/00, F04D19/00

Language of the proceedings: EN

Title of invention:
A VENTILATING SYSTEM FOR MOTOR VEHICLES

Patent Proprietor:
SPAL Automotive S.r.l.

Opponent:
ebm-papst Mulfingen GmbH & Co. KG

Headword:

Relevant legal provisions:
EPC 1973 Art. 54(1), 54(2), 56, 111(1)
EPC Art. 106(1)
RPBA Art. 12(4), 13(1)

Keyword:

Prohibition of reformatio in peius - (no)
Res judicata - withdrawal of opponent's appeal (no)
Admittance of a document not admitted before the Opposition Division - (yes)
Remittal to the department of first instance - (no)
Novelty - main request (yes)
Inventive step - main request (no)
Auxiliary request 1 already admitted by the Opposition Division - correct exercise of discretion (yes)
Inventive step - auxiliary request 1 (no)

Decisions cited:

G 0007/91, G 0008/91, G 0009/92, G 0004/93, T 0327/92, T 1066/92, T 0167/93, T 0401/95, T 0583/95, T 0100/01, T 0149/02, T 0240/04, T 1690/08, T 1969/08, T 0162/09, T 0996/12

Catchword:

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Case Number: T 0576/12 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 9 January 2015

Appellant: (Patent Proprietor)	SPAL Automotive S.r.l. Via per Carpi, 26/B 42015 Correggio (Reggio Emilia) (IT)
Representative:	Puggioli, Tommaso Bugnion S.p.A. Via di Corticella, 87 40128 Bologna (IT)
Respondent: (Opponent)	ebm-papst Mulfingen GmbH & Co. KG Bachmühle 2 74673 Mulfingen (DE)
Representative:	Peter, Julian Staeger & Sperling Partnerschaftsgesellschaft mbB Sonnenstrasse 19 80331 München (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 29 December 2011 concerning maintenance of the European Patent No. 1819539 in amended form.**

Composition of the Board:

Chairman G. Pricolo
Members: W. Marx
P. Guntz

Summary of Facts and Submissions

I. The appeal from the patent proprietor is directed against the interlocutory decision of the Opposition Division posted on 29 December 2011 to maintain European patent No. 1 819 539 in amended form on the basis of the second auxiliary request filed during the oral proceedings. A further appeal filed by the opponent was withdrawn by letter of 25 April 2012.

II. In its decision the Opposition Division held that the subject-matter of claim 1 as granted did not meet the requirements of Article 54 EPC and that the subject-matter of claim 1 of the first auxiliary request did not meet the requirements of Article 56 EPC, based on documents acknowledged as evidence of public prior use (e.g. technical drawing D5.4). Moreover, document D9 (extract from catalogue "Automotive – BL-DC Ventilatoren, Klimatisierung von Nutzfahrzeugen", ebmpapst, Ausgabe 12/2003) was considered late filed and not admitted into the opposition proceedings.

III. Oral proceedings before the Board took place on 9 January 2015.

The sole appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, in the alternative, be maintained in amended form on the basis of auxiliary request 1, underlying the decision under appeal.

The respondent (opponent) requested that the appeal be dismissed.

As a supplement to document D9, which consists of selected pages from the catalogue, the original catalogue was presented and a complete copy was submitted as document D9'. Both parties requested remittal to the department of first instance for discussion of D9/D9'.

For illustrative purposes, reference was made during oral proceedings to the pictures of an axial fan with reference number W3G300-EQ12-03 according to evidence D5.1 already filed before the Opposition Division.

IV. Claim 1 as granted, broken down into the feature analysis used by the respondent, reads as follows:

1) A ventilating system, especially for motor vehicles air, comprising:
2) a mounting wall (4) delimiting a space (5) for containing the system (1);
3) an axial fan (2) comprising a ring-shaped casing (6) with a cylindrical outside surface (18);
4) a motor (11) mounted on the ring-shaped casing (6);
5) an impeller (12), with vanes (13), coaxial with the axis (X) of the ring-shaped casing (6) and keyed to the output shaft of the motor (11);
6) and a power cable (14) connected to the electric motor and connectable to an electrical power source inside the space (5),
7) wherein the axial fan (2) is mounted on the wall (4) at an air opening (3), in such a way that the impeller (12) faces the inside of the space (5) and the motor (11) faces the outside;
8) the ring-shaped casing (6) comprising means (19) for fastening the cable (14) to its cylindrical outside surface (18)

9) the ventilating system being characterised in that the ring-shaped casing defines a passage (25) for the cable (14) through the mounting wall (4).

Claim 1 according to auxiliary request 1 was amended by adding the feature of granted claim 2 to the characterising portion, which now reads:

"... the ventilating system being characterised in that the ring-shaped casing defines a passage (25) for the cable (14) through the mounting wall (4)and in that the fan (2) has a flange (8) and is fitted in the opening (3) in such a way that it can be extracted, abutting with the flange (8) against the outside surface (9) of the wall (4)."

V. The appellant's arguments, insofar as they are relevant to this decision, can be summarised as follows:

Document D9 should not be admitted into the appeal proceedings due to the prohibition of *reformatio in peius*, as defined in G 9/92 and G 4/93. With regard to the principle of *res judicata*, by withdrawing its appeal the opponent had accepted the decision as being final for all issues negatively affecting its position, including the rejection of document D9 as inadmissible. The contested decision had to be rectified fully or partly in accordance with the appellant's requests, and the patent owner only contested that claim 1 as granted was anticipated by the alleged prior use. Consequently, the appeal proceedings were restricted to exactly what the patent owner had mentioned in its grounds of appeal.

In decisions G 7/91 and G 8/91, the Enlarged Board of Appeal had ruled that appeal proceedings were

terminated, as far as the substantive issues settled by the contested decision were concerned, when the sole appellant withdrew its appeal. Furthermore, the provisions of Article 114 EPC did not allow for continuation of the proceedings once the appeal had been withdrawn, and these principles had also to be applied to the position of the opponent/respondent.

Although the opponent considered document D9 very relevant, it had filed it only shortly before the date of oral proceedings in first-instance proceedings. D9 was merely an extract from a catalogue. The complete catalogue might however provide further information, e.g. with regard to the mounting of the axial fan, that might contradict the respondent's arguments. It was also contested that the date printed on the first page of D9 was linked to the rest of this document and that D9 had been made available to the public. D9 was not relevant because it did not show a ventilating system but only a ventilation unit.

Claim 1 as granted was not directed to a ventilation unit, but to a ventilating system, having (see Figure 1) a mounting wall on which the ring-shaped casing of the ventilation unit was mounted in such a way that a passage for the cable to the inside through the mounting wall was defined. Such a ventilation unit was typically mounted on the roof of buses, having an electrical power supply inside the bus and delivering air from the inside to the outside. Document D9 only disclosed (see page 17) a ventilation unit, comprising fastening means and a passage not suitable for guiding a cable downwards through the mounting wall, but no ventilating system.

Moreover, the ventilation unit shown in D9 could not be mounted as specified by granted claim 1. Document D9' did not show any mounting position of the axial fan, i.e. feature 6) ("a power cable ... connectable to an electrical power source inside the space") and feature 9) ("the ring-shaped casing defines a passage (25) for the cable (14) through the mounting wall (4)") defining together the mounting position of the axial fan were not known. The oblong holes provided on the ring-shaped casing and the groove provided on its upper side for taking an O-ring sealing indicated that the axial fan according to D9/D9' (see page 17) was mounted from below to the roof of a bus and locked in place before being fixed by screws. It was not disclosed in any of the documents that the axial fan was inserted into an opening of the mounting wall (as represented in D5.1 on pages 15 to 18, according to the reading of claim 1). In order to realise such a mounting position, D9' even suggested (see page 19) using an axial fan with opposite direction of air delivery which could be mounted from the top. Moreover (see D9/D9', page 17; see also D5.1, picture 18), due to the elevated seats of the oblong holes in the fastening area, the axial fan would not rest on the peripheral flange when mounted in the air opening. Since the reinforcing ribs were placed adjacent to the oblong holes, there was not sufficient space for placing a screw. However, a concrete proof that the only mounting position was a mounting from below could not be provided.

As could be seen from picture 1 of D5.1 (indicated by reference sign 19), a channel was provided with a nose in D9/D9'. However, the size and shape of the channel were not usable for guiding the cable through the air opening, and the nose was insufficiently dimensioned so that it would break off when trying to insert the

cable. Even with the cable pressed in the channel, it had the tendency to slip out again, so that a defined position of the cable could not be guaranteed. Relative movements, due to vibrations, between the cable and the edge of the air opening caused a cutting effect which destroyed the cable. Secondly, since the nose broke off, the cable was not held in a defined position along the ring-shaped casing. Picture 3 of D5.1 apparently showed the typical mounting position of the cable. Guiding the cable in the same plane in the opposite direction as depicted in picture 3 would conflict with the fastening area, and when guiding the cable first through the channel before bending it sideway, the cable would collide with reinforcing ribs provided in the fastening area. Moreover, due to the missing guidance of the cable at the end of the channel, the cable had the tendency to run very close to the rim of the impeller, which could act as a blade, thus cutting the cable.

D9' showed different ventilation units, e.g. on page 17 a ventilation unit for mounting from below to a roof. If such mounting was not possible, the straight-forward solution for the skilled person was to use the ventilation unit known from page 19 of D9' which could be mounted from the top. The skilled person would not start modifying the unit known from page 17 of D9/D9', because it would require a large amount of non-obvious structural changes, such as enlarging the four small seats in the area of the oblong holes, weakening the reinforcing ribs to create space for screws, and providing a simple guidance for the cable through the mounting wall. The contested patent, in contrast, did not show (see Figure 3) elevated mounting areas with oblong holes.

As regards the additional feature of claim 1 according to auxiliary request 1, the term "abutting" specified a contact between the flange and the mounting wall. There was no motivation for the skilled person to modify the flange of the axial fan known from D9 so that the fan was abutting with the complete flange and not only with the small seats provided in D9 in the area of the oblong holes, i.e. to provide a common plane for the area of the oblong holes and the flange. Contrary to the contested patent (see description and Figure 3), a smooth abutting surface of the flange was not required in D9. A sealing ensured surface pressure around the entire periphery of the flange. Due to the small supporting surface in D9, a high surface pressure was realised with small tightening torque and less risk of shaking free, so the skilled person would not deviate from D9.

VI. The respondent's arguments, relevant to this decision, can be summarised as follows:

The issue of *reformatio in peius* was independent of the question of whether or not to admit document D9 into the proceedings. D9 represented a pre-published publication within the meaning of Article 54(2) EPC, as already argued in opposition proceedings (see letter dated 3 November 2011, page 7, second paragraph), and should be admitted into the appeal proceedings for being highly relevant to the issues of novelty and as closest prior art, in particular because substantiation of the alleged prior use was contested by the appellant. The original catalogue presented in oral proceedings, a coloured copy of which was filed as D9', proved that D9 contained extracted pages from this catalogue printed in December 2003 and distributed before the priority date of the contested patent. The

Opposition Division, deciding on lack of novelty based on the alleged prior use, had not dealt with document D9 in more detail and had made misleading statements with regard to D9.

In comparison to the documents which according to the contested decision provided evidence for the public prior use of an axial fan, document D9 showed further features (e.g. motor, impeller) but had not been discussed in first-instance proceedings with regard to its substance, i.e. novelty of the main request and of auxiliary request 1. Remittal to the department of first instance was thus appropriate on this ground, and additionally on the ground that it would allow introduction of the new grounds for opposition according to Articles 100(b) and 100(c) EPC (see T 1066/92) raised in appeal proceedings.

The explanations given by the appellant on the basis of D5.1 were not applicable to D9 which related to a different unit. D9 showed all features of claim 1 as granted, either explicitly or implicitly, so the requirement of novelty was not met. A power cable connectable to an electric power source was known from D9, and the additional specification of a power source inside the space according to feature 6) had to be considered in conjunction with feature 9). A passage for the cable according to feature 9) was also disclosed in D9, and the arrangement with respect to the mounting wall was implicit. The axial fan had to be mounted somewhere, and the skilled person reading D9 understood feature 9) as representing the only reasonable solution. D9 showed a peripheral flange and, considering that it was exposed to vibrations when mounted in a bus, the skilled person would choose a mounting position where the axial fan was supported on

the mounting wall by the flange and not only by its four fastening extensions. The reinforcing ribs meshed with the mounting wall to prevent rotation of the ventilation unit which contained a rotational part. The cable had to be guided through the mounting wall, and a passage for the cable was provided in D9/D9'. Claim 1 did not define how the cable had to be fastened, bent or guided further. According to claim 1, the cable was connectable to an electrical power source, and by providing further fastening means for the cable, contact with impeller vanes could be prevented. Moreover, by providing a larger cut-out in the mounting wall (see D5.1), the cable guided in the passage was protected. The sealing of the axial fan was irrelevant, and even the contested patent was silent on this. According to the contested patent, the casing (not the fastening means) defined a passage for the cable through the mounting wall.

Assuming that the subject-matter of claim 1 was novel over D9 due to feature 9) of granted claim 1, this distinguishing feature did not contribute to inventive step because the skilled person knew that the axial fan could be mounted in either direction.

It was requested not to admit auxiliary request 1 into the appeal proceedings because it was not convergent with the main request and with the auxiliary request 2 filed in opposition proceedings (see e.g. T 240/04, T 1690/08, T 1969/08, T 162/09). A flange was specified according to auxiliary request 1, whereas the main request related to a passage for the cable which was further specified only in auxiliary request 2.

The fastening means in D9 formed part of the flange, so the additional feature of claim 1 of auxiliary

request 1 was known from D9. Moreover, claim 1 required neither a flange "abutting directly" against the outside surface of the mounting wall, nor an abutment with the entire surface of the flange. Accordingly, the subject-matter of this claim likewise did not involve an inventive step.

Reasons for the Decision

1. Document D9 not admitted in first-instance proceedings

1.1 Scope of the Board's review

Although the respondent/opponent withdrew its appeal, the Board does not agree with the appellant's submission that document D9, which was not admitted by the Opposition Division into the first-instance proceedings, cannot be admitted in appeal proceedings due to the doctrine of prohibition of *reformatio in peius* or the principle of *res judicata*.

According to the established case law of the Boards of Appeal, the doctrine of prohibition of *reformatio in peius* cannot be construed to apply separately to each point or issue decided, or the reasoning leading to the impugned decision (see e.g. T 149/02, headnote; also Case Law of the Boards of Appeal, IV.E.3.1 a)). If an appeal is lodged against an adverse decision of the first instance about the main request, then (see T 401/95, point 2 of the Reasons) "the whole request is before the Board of Appeal and within its jurisdiction (see T 327/92, point 1 of the Reasons; T 583/95, point 2 of the Reasons; neither published in OJ EPO)", and "the Board is empowered to reopen and to decide upon matters which have been an issue before the Opposition Division", i.e. in the present case the

matter of admission of document D9 was open for reconsideration. In fact, the appellant did not recite any case law supporting its interpretation of the doctrine. It is noted that, in the present case, the prohibition of *reformatio in peius* implies that the patentee as the sole appellant cannot be put in a worse situation than if it had not appealed, e.g by obtaining, as a result of the appeal proceedings, claims that are more limited than those maintained in the decision under appeal. As regards the appellant's main request and auxiliary request 1, these were denied by the Opposition Division and thus may well be denied also in appeal proceedings (see also T 401/95, point 2 of the Reasons).

"*Res judicata*" means a matter finally settled by a court of competent jurisdiction (see e.g. for more details the criteria set out in T 167/93, OJ EPO 1997, 229, point 2.5 of the Reasons). In the present case, no court of competent jurisdiction, such as a Board of Appeal in previous appeal proceedings, has ruled on issues of fact related to the present case. Moreover, the appeal filed by the patent proprietor is still pending, i.e. due to the suspensive effect of the appeal under Article 106(1) EPC the decision of the Opposition Division negatively affecting the patent proprietor with respect to the main request and auxiliary request 1 has not become final. Therefore, the principle of *res judicata* does not apply in the present case. The mere fact that the opponent has withdrawn its appeal does not mean that all issues negatively affecting the opponent's position thereby become final. As already pointed out above, if an appeal is lodged against an adverse decision of the first instance about a request, then the whole request is before the Board of Appeal and within its

jurisdiction. In particular, the Board does not agree with the appellant that the appeal proceedings are restricted to what the appellant mentioned in its grounds of appeal. This is also contrary to Article 12(1) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536), according to which the appeal proceedings are based (*inter alia*) on the statement of grounds of appeal and on the written reply of the other party or parties.

Decisions G 7/91 and G 8/91, cited by the appellant and relating to appeal proceedings terminated by the sole appellant withdrawing its appeal, are not applicable in the present case where appeal proceedings are still pending.

1.2 Admission of documents D9 and D9' into the appeal proceedings

Document D9 was filed in the first-instance proceedings in response to a negative preliminary opinion issued by the Opposition Division with regard to evidence for an alleged prior use provided by the opponent. According to the contested decision (see point 2.3), document D9 was considered late-filed and as not providing more relevant information than the documents already in the proceedings, in particular because it did not provide evidence for the prior use or prove the selling of the elements described in D9.

According to the respondent/opponent's letter dated 3 November 2011 (see page 7, second paragraph) as submitted in first-instance proceedings, and also the respondent's reply to the appeal filed by the patent proprietor by letter of 25 September 2012 (see page 4),

document D9 as such was also considered as representing a pre-published publication within the meaning of Article 54(2) EPC 1973. This aspect was not taken into consideration by the department of first instance (see point 2.3 of the contested decision: "Independently from the fact that the document could have been available to the public in due time ..."). According to the contested decision and the minutes of oral proceedings, it was decided not to admit document D9 into the opposition proceedings before the conclusion was reached that the alleged prior use was made available to the public. The general statement in the contested decision with regard to the relevance of document D9 (see point 2.3: "not provide more relevant information as the documents already in the procedure"), in particular in combination with the following reasoning ("In particular, ..., the document D9 cannot be regarded as providing evidence for the prior use ..."), leaves open whether the relevance of document D9 was assessed in comparison with all the prior art documents submitted, or only with respect to the documents providing evidence for the alleged prior use. Moreover, the respondent requested to have D9 admitted into appeal proceedings for being highly relevant, in particular since substantiation of the alleged prior use was contested by the appellant.

Notwithstanding the fact that a Board of Appeal when asked to overrule the way in which a first-instance department has exercised its discretion is limited to determine whether the discretion was not exercised in accordance with the right principles or in an unreasonable way, in the present case the Board cannot exclude that the department of first instance based its decision on false facts, in particular the wrong assumption that document D9 should only prove the

selling of prior used goods and that its relevance was assessed solely in this respect, whereas D9 as such also represented a potential piece of (pre-published) prior art. Under these circumstances, the Board is free to exercise its own discretion whether to admit document D9 or not:

In the Board's judgement, it is apparent at first glance that document D9 shows an axial fan comparable to the one depicted in documents D5.1 and D5.4 relating to the alleged prior use in first-instance proceedings, and is thus prima facie very relevant to the claimed subject-matter. Moreover, presenting the original catalogue from which the pages of D9 were extracted, and filing during oral proceedings a complete copy as document D9', has in the Board's view dispelled any doubts as to the availability of document D9 to the public. In fact, the date printed on the first page of D9 ("Ausgabe 12/2003") is linked to all pages of D9 and apparently proves that D9/D9' was made available to the public before the priority date (30 November 2004) of the contested patent. Under these circumstances, the Board judged it appropriate to admit both D9 and D9' into the appeal proceedings. Reference will be made hereinafter to D9/D9' as if it were a single document, since D9 is anyway an extract of D9'.

2. Non-remittal to the department of first instance

2.1 At the oral proceedings before the Board, after document D9/D9' had been admitted, both parties requested that the case be remitted to the department of first instance. According to Article 111(1) EPC 1973, the Board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that

department for further prosecution. It is established case law (see Case Law of the Boards of Appeal, 7th edition 2013, IV.E.7.6.1) that there is no absolute right to have an issue decided upon by two instances and that e.g. the general interest in bringing the proceedings to a close within an appropriate period of time has to be taken into account.

In the present case, the introduction of document D9/D9' into the appeal proceedings did not substantially change the issues as discussed in first-instance proceedings and did not raise new questions. Document D9/D9' shows an axial fan similar to the one discussed in relation to the alleged prior use in first-instance proceedings. In particular, the technical drawing on page 17 of D9/D9' shows identical information content - at least as far as the features of claim 1 according to both the main request and auxiliary request 1 are concerned - as drawing D5.4 of the prior use discussed in first-instance proceedings.

2.2 The respondent additionally requested that the case be remitted to the department of first instance, as decided in T 1066/92, in order to allow the introduction of new grounds for opposition according to Article 100(b) and (c) EPC 1973. However, decision T 1066/92 cannot be taken as establishing or even advocating any principle that a newly raised ground which a Board of Appeal cannot itself consider should be remitted to the Opposition Division for consideration. Such remittal must remain a matter for the discretion of the Board considering each individual case (see T 100/01, point 37 of the Reasons). Moreover, decision T 1066/92 relates to a case different than the present one, as the decision of the Opposition Division

was a decision *ultra vires* and had to be set aside on this ground solely (see point 2 of the Reasons).

2.3 Under these circumstances and with due consideration to the need for procedural economy, the Board in exercising its discretion conferred by Article 111(1) EPC 1973 decided not to remit the case to the department of first instance, but to take a decision on the merits of the case.

3. Claim 1 as granted (main request)

3.1 For the reasons given above (see point 1.2) the Board is convinced that document D9/D9' is prior art according to Article 54(2) EPC 1973. This was not contested by the appellant during the oral proceedings.

3.2 Document D9/D9' shows (pages 13 and 17) a ventilation unit comprising an axial fan, a motor and an impeller according to features 3) to 5); this was not contested by the parties. Since D9/D9' explicitly mentions (see cover page; also page 5 in D9') that the ventilation units are intended to be used in commercial vehicles, the Board considers that D9/D9', even if a ventilation unit mounted in a vehicle is not explicitly shown, at least implicitly discloses a ventilating system for motor vehicles as specified by feature 1). The Board also finds that a mounting wall delimiting a space for containing the system according to feature 2) is implicitly known from D9/D9' when using axial fans in a vehicle, because the axial fan will be mounted to one of the walls provided by the vehicle's body. This wall would become the "mounting wall" as claimed and, at the same time, also delimit a space for containing the system. As regards feature 6), a power cable connected to the electric motor is disclosed in D9/D9' (page 17).

The further statement that the power cable is "connectable to an electrical power source inside the space" is not a further limitation as such, as long as the mounting position of the axial fan with respect to the mounting wall is left open. In particular, the term "connectable" merely refers to a possible connection to an electrical power source inside the "space" (for containing the system as mentioned in feature 2)), but does not yet require a defined cable routing, in particular one through the mounting wall. So far, the combination of features 1) to 6) does not define in more detail how the axial fan is mounted to a mounting wall, e.g. whether the axial fan is just mounted "to a mounting wall" (e.g. from below to a roof of a bus as argued by the appellant, with the impeller directed downward) or whether its casing is inserted from above into an air opening of the mounting wall, as only later suggested by feature 9). The additional characterisation according to feature 7) that "the axial fan is mounted on the wall **at** an air opening" does not define more specifically its mounting position, i.e. from which side the axial fan is fixed to the mounting wall (e.g. from below to a roof of a bus, or from above into an air opening in the roof, with the impeller directed downward), except for specifying an air opening which again must be implicitly assumed when using the axial fan of D9/D9' in a vehicle. The "space" mentioned in feature 7), which was previously specified in feature 2) as "space for containing the system", has to be understood as the space on that side of the mounting wall which accommodates "the system". As can be derived from the patent specification itself (see Figure 1), it cannot be meant that the complete system has to be on one side or the other of the mounting wall. As can be seen from Figure 1 of the contested patent, the space should at

least accommodate the ring-shaped casing, but not necessarily the flange. Therefore, in both mounting situations of the axial fan mentioned above, the impeller would face the inside of the space and the motor would face the outside, as further specified by feature 7), so this feature cannot be regarded as providing any distinction over D9/D9'. It was not disputed that the ring-shaped casing of the axial fan in D9/D9' comprises means according to feature 8) for fastening the cable to its cylindrical outside surface (see D9/D9': on the left side of the axial fan shown on page 13, or in the lower left bottom area on page 17).

As follows from the foregoing, without taking into consideration feature 9), the combination of features 1) to 8) is disclosed in D9/D9' either explicitly or implicitly. However, the Board considers that D9/D9' does not disclose any mounting position of the axial fan. Only if the axial fan is mounted by inserting it **into** the air opening does it penetrate the mounting wall, and then a "passage for the cable through the mounting wall" according to feature 9) would be required, in order to connect the cable to the electrical power source inside the space as indicated in feature 6).

A "passage for the cable" on the cylindrical outer surface of the ring-shaped casing might be known from D9/D9', as argued by the respondent. But feature 9) specifies further the arrangement of the axial fan with respect to the mounting wall. D9/D9' is completely silent on how to mount the axial fan to the mounting wall, so feature 9) is not known from D9/D9'. It is noted that the appellant's assertion that D9/D9' - due to a groove on the upper side of the ring-shaped casing for taking an O-ring - indicates a specific mounting

position (from below to the roof of a bus, i.e. not in accordance with feature 9)) cannot be followed. Nor can the Board follow the respondent's argument that the skilled person, when reading D9/D9', would implicitly understand that feature 9) represented the only reasonable solution because the axial fan was supported on the mounting wall by the flange. Both parties provided reasonable explanations as to how the axial fan of D9/D9' could be mounted to the roof of a bus, either by fastening it with its motor side (see D9/D9', right drawing on page 17: with its left-side planar surface) to the roof, as argued by the appellant, or by inserting it with the impeller side from above into an air opening of the roof, as argued by the respondent. There is, therefore, no basis for concluding that one of these is the mounting position of the axial fan that the skilled person would consider as clearly and unambiguously disclosed by D9/D9'. Accordingly, the skilled person would consider that D9/D9' leaves open the mounting position of the axial fan.

Thus, the Board concludes that the subject-matter of claim 1 as granted is new over D9/D9' in accordance with Article 54(1) EPC 1973.

3.3 However, for the following reasons, the Board cannot accept the appellant's arguments in support of inventive step:

Starting from document D9/D9' as closest prior art, the mounting position of the axial fan remains undefined, as argued above. The person skilled in the art, when trying to solve the problem of how to mount the axial fan of D9/D9', would recognise in D9/D9' means for fastening the axial fan to a mounting wall comprising an air opening, in particular four portions around the

periphery of the axial fan's flange, each with an oblong hole and a round hole side by side (see page 17 of D9/D9'). A raised surface is provided in the correspondence of each oblong hole (see the picture on page 13 of D9/D9'; the surfaces are raised as seen in a direction perpendicular to the plane of the picture). These raised surfaces are connected with the circumferential outer surface of the ring-shaped casing by reinforcing ribs. As argued by the respondent, the reinforcing ribs are also suitable for preventing any rotation of the axial fan in use when co-operating with corresponding slots in the mounting wall. The Board cannot share the appellant's view that, when placing the axial fan on the mounting wall on said raised surfaces, the reinforcing ribs would not provide sufficient space for placing a screw into the oblong holes, or that significant structural changes would be required in this area (such as enlarging the area of the raised surfaces or weakening the ribs). The skilled person would note that by choosing an appropriate type of screws (e.g. with small head) there would be no need to modify the design according to D9/D9' for mounting the axial fan according to D9/D9' as specified by claim 1. The provision of four raised surfaces around the periphery of the axial fan's flange moreover suggests the use of these surfaces as well-defined seating areas. Therefore, mounting the axial fan known from D9/D9' on the mounting wall such that the casing penetrates the air opening is considered an obvious solution for the skilled person.

Even following the appellant in its assertion that D9/D9' shows a groove on the upper side of the fan's flange for taking an O-ring sealing, indicating a mounting position where the flange side opposite to the side showing the reinforcing ribs is mounted to a

mounting wall, this would only lead to the conclusion that the axial fan might obviously be mounted in either way. The selection of one of two obvious solutions which are both derivable from D9/D9', however, cannot establish inventiveness either. The appellant's argument that D9' shows on pages 17 and 19 two axial fans with opposite directions of air delivery, in order to cover both mounting situations as discussed above, is not convincing. As regards their design in the mounting area, both axial fans are identical, so that the same mounting positions must be assumed. The disclosure in D9' of axial fans with opposite directions of air delivery would be regarded by a skilled person simply as having the purpose of covering the complementary needs of introducing fresh air into and exhausting air from a vehicle's interior.

The appellant contests that the size and shape of the channel or passage provided on the ring-shaped casing in D9/D9', and also the design of the nose for keeping the cable within the channel, are not suitable for guiding the cable through the air opening. The appellant's arguments presented by referring to the pictures in D5.1 do not convince the Board for the following reasons:
Although only two ways of guiding the cable are explicitly shown in D5.1, either (see picture 11) in an axial direction of the fan and supported by the nose, or (picture 3) in a circumferential direction to a dedicated fastening means, the cable could also be guided circumferentially in the opposite direction (to the right in picture 3 of D5.1, and correspondingly in D9/D9'), as agreed by the appellant. However, this would not necessarily conflict with either the fastening area or with the reinforcing ribs, because in this case it would be obvious to have the cable first

guided in the channel/passage and then bent by 90° when reaching the nose, i.e. the cable would not be guided in the same plane as the flange. In such a mounting situation, the nose serves only as a means for re-directing the cable so that forces which might break off the nose, as argued by the appellant, can be avoided. Due to vibrations in a running vehicle, a well-defined position of the cable might not be guaranteed. However, any contact between the cable and the edge of the air opening is avoided when providing an appropriately large cut-out in the air opening. Moreover, by providing further fastening or guiding means within the space containing the ventilating system, interference with the fastening area or the reinforcing ribs could easily be avoided. This would also avoid any cutting effect with the rotating impeller, because then the cable would not be guided in an axial direction along the outer surface of the ring-shaped casing up to the impeller rim.

As a result of the foregoing discussion, the Board finds that, without further modification of the axial fan according to D9/D9, the skilled person would obviously consider mounting the axial fan by inserting it with its impeller side into an air opening. Moreover, the ring-shaped casing of D9/D9' already shows a passage which is suitable for guiding the cable through the mounting wall. Therefore, the skilled person would arrive without the exercise of inventive skill at the subject-matter of claim 1 as granted when looking for a mounting position of the axial fan known from D9/D9' (Article 56 EPC 1973).

4. Claim 1 according to auxiliary request 1

4.1 Admission into the proceedings

The respondent requested that auxiliary request 1 not be admitted into the appeal proceedings. In the present case, however, auxiliary request 1 was filed with the grounds of appeal and corresponds to the first auxiliary request presented during the opposition proceedings, which was considered admissible and novel by the Opposition Division, but rejected for lack of inventive step. There is no issue of admissibility here, since i) the request forms part of the appellant's case (Article 12(2) RPBA) and ii) the provisions of Article 12(4) RPBA for holding a request inadmissible do not apply as the request was presented and admitted in the first-instance proceedings.

In fact, the request of the respondent amounts to a request to overrule the way in which a first-instance department has exercised its discretion pursuant to Rule 71a(1) EPC 1973 (now Rule 116(1) EPC) to admit the first auxiliary request filed during the oral proceedings. According to established case law, a Board of Appeal should only overrule the way in which a first-instance department has exercised its discretion if it comes to the conclusion either that the first-instance department in its decision has not exercised its discretion in accordance with the right principles, or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper limits of its discretion. No arguments to that effect have been submitted by the respondent.

The respondent has referred to the criterion of convergence of the requests. This criterion was not

invoked by the opponent before the Opposition Division; nor is there a legal basis for regarding this criterion as a fundamental one that should have been considered by the Opposition Division when exercising its discretionary power (see e.g. T 996/12, point 6.2 of the Reasons).

4.2 Inventive step

The additional features of claim 1 according to auxiliary request 1 essentially relate to the axial fan having a flange which abuts against the outer surface of the mounting wall when the axial fan is fitted into the air opening. This wording of claim 1 specifies neither that the flange abuts with its entire surface on the mounting wall, nor that the flange abuts directly on the mounting wall.

Therefore, the Board cannot see that further distinguishing features over D9/D9' are provided by claim 1 as amended according to auxiliary request 1. The raised seats provided as radial extensions of the flange of the axial fan according to D9/D9' form part of the flange itself, so the flange of D9/D9' abuts at least partially with its four raised seats against the outer surface of the mounting wall. This possibility falls within the meaning of claim 1. Even assuming that the seats did not form part of the flange, the flange of D9/D9' would abut - via those seats and therefore indirectly - on the mounting wall. This possibility too would fall under the wording of claim 1.

As a consequence, auxiliary request 1 must also fail for lack of inventive step (Article 56 EPC 1973).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

A. Vottner G. Pricolo

Decision electronically authenticated