

Internal distribution code:

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

**Datasheet for the decision
of 6 October 2015**

Case Number: T 2288/12 - 3.2.03

Application Number: 06425608.4

Publication Number: 1895263

IPC: F42B15/04, F42B19/01

Language of the proceedings: EN

Title of invention:

Torpedo

Patent Proprietor:

Whitehead Alenia Sistemi Subacquei S.p.A.

Opponent:

Atlas Elektronik GmbH

Headword:

Relevant legal provisions:

EPC Art. 113(2), 114(2)
RPBA Art. 12(2), 13(1), 13(3)

Keyword:

Late-filed request - admitted (no)

Decisions cited:

T 1732/10

Catchword:



**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 2288/12 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 6 October 2015

Appellant: Whitehead Alenia Sistemi Subacquei S.p.A.
(Patent Proprietor) Via di Levante, 48
57124 Livorno (IT)

Representative: D'Angelo, Fabio
Studio Torta S.p.A.
Via Viotti, 9
10121 Torino (IT)

Appellant: Atlas Elektronik GmbH
(Opponent) Sebaldsbrücker Heerstrasse 235
D-28305 Bremen (DE)

Representative: Eisenführ Speiser
Patentanwälte Rechtsanwälte PartGmbH
Am Kaffee-Quartier 3
28217 Bremen (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
31 August 2012 concerning maintenance of the
European Patent No. 1895263 in amended form.**

Composition of the Board:

Chairman G. Ashley
Members: V. Bouyssy
I. Beckedorf
C. Donnelly
M. Blasi

Summary of Facts and Submissions

- I. European patent No 1 895 263 (in the following: "the patent") concerns a wire-guided torpedo.
- II. The patent as a whole was opposed on the grounds of Article 100(b) and Article 100(a) EPC for lack of novelty and lack of inventive step in view of two patent publications and the following alleged public prior disclosures of torpedoes:
- a) the exhibition of a DM2A1 torpedo at the Deutsches Marinemuseum Wilhemshaven;
 - b) the exhibition of a DM2A4 torpedo, together with drawings, at the Bundeswehr Technical Centre for Ships and Naval Weapons;
 - c) the sales of SUT torpedoes to Indonesia;
 - d) the sales of DM2A3 torpedoes to Germany and Norway; and
 - e) a power point presentation concerning a DM2A4 torpedo given during a press conference at Atlas Elektronik GmbH.
- III. The Opposition Division decided that
- none of the alleged public prior disclosures was sufficiently proven, so that their subject-matter was not made available to the public before the filing date of the patent (1 September 2006),
 - the patent discloses the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art,
 - the subject-matter of claim 1 as granted and as amended according to the patent proprietor's auxiliary request 1 lacked novelty against D1 and D2, and
 - account being taken of the amendments in the patent proprietor's auxiliary request 2, the

patent and the invention to which it relates met the requirements of the EPC.

IV. This interlocutory decision was appealed by both the patent proprietor (in the following referred to as "the proprietor") and the opponent.

V. The Board issued a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) in preparation of the oral proceedings, indicating to the parties its preliminary opinion of the case.

VI. Oral proceedings before the Board were held on 6 October 2015, for the course of which reference is made to the minutes.

VII. Requests

The proprietor requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the set of claims filed as new main request during the oral proceedings, and that the appeal of the opponent be dismissed.

The opponent requested that the appealed decision be set aside and the patent be revoked, and that the appeal of the patent proprietor be dismissed.

VIII. Claims

Independent claim 1 as amended reads as follows (compared with claim 1 as originally filed and as granted, added features are indicated in bold):

"1. A torpedo (1) comprising :

- a main body (2); and
- a guidance wire (3), in turn comprising a first portion (15) connected to said main body (2) and wound into a hollow coil (13), and a second portion (16) connectable to a launch tube of a naval vessel to allow said main body (2) and said naval vessel to move with respect to each other;

said main body (2) comprising a casing (17) housing said coil (13); and supporting means (18, 28, 77) for maintaining said coil (13) in a predetermined position inside said casing (17);

said supporting means (18, 28, 77) defining with said coil (13) a first chamber (49) inside the coil (13); said first chamber (49) being filled at least partly with a fluid when flooding said launch tube;

said supporting means (18, 28, 77) defining with said casing (17) a second chamber (50) externally surrounding said coil (13);

and characterized by comprising fluidic connecting means (75) interposed between said first chamber (49) and said second chamber (50); said fluidic connecting means (75) permitting circulation of a predetermined flow of said fluid between said first chamber (49) and said second chamber (50) to maintain the pressure gradient between said second chamber (50) and said first chamber (49) below a predetermined value,

wherein said fluidic connecting means (75) are defined by said supporting means (18, 28, 77), said supporting means (18, 28, 77) comprise a first member (77); said first member (77) comprising a first opening (83) connected fluidically to said first chamber (49), and at least one second opening (90) connected fluidically to said second chamber (50); said first opening (83) and said second opening (90) being connected fluidically to each other to permit circulation of said

predetermined flow between said first chamber (49) and said second chamber (50), said first member (77) extends along an axis (A), and in that said second opening (90) is located radially outwards with respect to said first opening (83), said supporting means (18, 28, 77) comprise a second member (28) housed at least partly in said first member (77); said second member (28) comprising a first opening (92) and at least one second opening (91) connected fluidically to each other; said first opening (92) of said second member (28) being located inside said first opening (83) of said first member (77) so as to be connected fluidically to said first chamber (49); said second opening (91) of said second member (28) being connected fluidically to said second opening (90) of said first member (77) so as to be connected fluidically to said second chamber (50), said first opening (92) of said second member (28) is located at a distance from said coil (13), so that said fluid flows between said first and second chamber (49, 50) at a distance from the coil (13), said second opening (91) of said second member (28), and said second opening (90) of said first member (77) are connected fluidically by a toroidal compartment (89) bounded externally by said first member (77) and internally by said second member (28)".

Dependent claims 2 to 6 define preferred embodiments of the torpedo of claim 1.

IX. Cited evidence

In the statements setting out their grounds of appeal, the two parties referred to the following patent publications, which had already been filed in the opposition proceedings and are cited in the decision under appeal:

D1: US 3,148,651 A

D2: US 5,240,351 A

The opponent also referred to the alleged public prior disclosures (a) to (d) mentioned before, to the minutes of the taking of evidence by hearing Messrs Huck, Horn and Rieper, and to the documents that had been filed in the opposition proceedings in support of these prior disclosures. In addition, in support of prior disclosure (a), the opponent requested to hear again Messrs Horn and Rieper, to commission an expert's opinion and to inspect the allegedly exhibited torpedo. In support of prior disclosure (b), the opponent reiterated its offer to hear Messrs Rößler and Tiepold as witnesses.

- X. The written and oral arguments of the parties, insofar as relevant for the present decision, can be summarised as follows:

Proprietor's case:

Although filed during the oral proceedings, the new main request represents a serious and honest attempt to overcome the Board's decision that the combination of features of claims 1, 3 and 4 as granted lacks novelty in view of Figure 5 of D2. There was no reason to file this amendment at an earlier point of time and its late filing was justified by the developments in the oral proceedings before the Board.

Claim 1 as amended corresponds to a combination of claims 1, 3, 4, 5, 7, 8 and 9 as originally filed and as granted, hence does not raise any new issues but just clarifies how the first and second supporting

members should be construed. A discussion about the patentability of this subject-matter could have been expected because it is based on a combination of granted claims.

It cannot be derived from Figure 5 of D2 that the right end of the cylindrical housing that supports coil 92 is a "first member" in the sense of the claim, i.e. a physical identity separate from the supporting means, and that it has a through hole with two side openings. Even if it had, the two openings would not be arranged as shown in Figures 6 and 7 of the patent and would be way too large to guarantee a minimum pressure gradient between the first and second openings.

The additional features taken from dependent claims 5, 7, 8 and 9 are not disclosed in Figure 5 of D2. They enable the assembly of first and second supporting members that is shown in Figures 6 and 7 of the patent. This assembly allows the pressure gradient between the first and second chambers 49 and 50 to be minimised, irrespective of the angular position of the second supporting member 28 relative to the first supporting member 77. Thus, these distinguishing features solve the technical problem of how to provide more flexibility for the mounting of the wire coil in the torpedo, without jeopardising the fluid communication between the chambers. The claimed solution to this problem is neither disclosed nor suggested in D2 and the other cited art.

Opponent's case:

The new main request has not been filed in due time. It could, and should, have been filed as a fallback position with the proprietor's reply to the opponent's

statement setting out the grounds of appeal since the factual situation of the case had not changed during the appeal proceedings. This late-filed amendment should not be admitted into the proceedings because it raises unexpected issues and it is *prima facie* unlikely that it could overcome all objections regarding lack of novelty and lack of inventive step.

The alleged differences between the fluidic connecting means of claim 1 and those shown in Figure 5 of D2 are not mirrored by the wording of claim 1. It neither excludes that the fluidic connecting means, and the first and second openings, equalise the pressure in the two chambers, nor that the first member is an integral member of the supporting means. The scope of claim 1 is clearly not limited to the specific assembly shown in Figures 5 to 7 of the patent. It is apparent that the additional features from claims 3, 4 and 5 as granted are shown in Figure 5 of D2: the right end wall of the coil housing comprises a through hole that is mandatory to guarantee that cable 94 is rapidly and reliably payed out of the housing when launching torpedo 90; this through hole permits fluid to circulate into, and out of, the inner chamber of the coil 92; this right end wall can be seen as a first member in the sense of claim 4, while the side openings of the through hole form first and second openings as required by this claim.

It is not clear how the further features from claims 7 to 9 as granted could support an inventive step in the light of D2 and torpedo DM2A1. There is no mention in the patent of the technical effect of these features, and the technical effect now alleged by the proprietor comes as a complete surprise.

Reasons for the Decision

1. Before turning to the proprietor's main and sole request, it is necessary to recall the history of the case and the proprietor's requests previously filed in the course of the appeal proceedings.
 - 1.1 The proprietor's requests filed with the statement of grounds of appeal were identical to those as considered by the Opposition Division in the decision under appeal. Auxiliary requests 3 to 5 were filed with letter of 1 September 2015.
 - 1.2 At the beginning of the oral proceedings, the proprietor announced that it withdrew its previous main request on file.
 - 1.3 After an extensive discussion of the novelty of auxiliary requests 1 and 2 and the admission of auxiliary requests 3 to 5, the Board came to the conclusions that the subject-matter of claim 1 according to auxiliary requests 1 and 2 lacked novelty in view of the torpedo shown in Figure 5 of D2, for the reasons already set out by the opponent in its grounds of appeal. In addition, auxiliary requests 3 to 5 were not admitted into the proceedings because they had been filed for the first time with the submission dated 1 September 2015, although they could and should have been filed in reply to the opponent's grounds of appeal, and they have not been properly substantiated.
 - 1.4 In reaction to these Board's conclusions, the proprietor withdrew auxiliary requests 1 to 5 and replaced them by a new set of claims as main request, wherein amended claim 1 corresponds to a combination of

claims 1, 3, 4, 5, 7, 8 and 9 as granted and as originally filed.

2. Proprietor's appeal deemed withdrawn

2.1 Claim 1 of the proprietor's main request differs from claim 1 of auxiliary request 2, which was considered to be allowable by the Opposition Division in its interlocutory decision, in that it includes the additional features of dependent claims 5, 7, 8 and 9 as granted. Thus, the proprietor's main request has a more limited scope than the request found allowable in the interlocutory decision under appeal.

2.2 As a consequence of this request, the proprietor's appeal against the interlocutory decision was deemed to have been withdrawn, and the proprietor simply became a respondent requesting the dismissal of the opponent's appeal.

3. Admission of the proprietor's main request

3.1 It is established case law that new requests containing amended claims may exceptionally be admitted into the appeal proceedings (see Case Law of the Boards of Appeal of the EPO, 7th edition, 2013, in the following "CL", IV.E.4.1). Under Article 12(2) RPBA, the statement of grounds of appeal and the reply must contain a party's complete case and should, *inter alia*, specify expressly all the facts, arguments and evidence relied on, in particular all requests (see also CL, IV.E.4.2.1). Under Article 13(1) RPBA, the Boards have discretion to admit and consider any amendment to a party's case after it has filed its grounds of appeal or reply. Article 13(3) RPBA adds that amendments sought to be made after oral proceedings have been

arranged may not be admitted if they raise issues which the Board or the other party cannot reasonably be expected to address without an adjournment of the oral proceedings. In order to be admitted, amended claims filed only shortly before or during the oral proceedings must in general be *prima facie* allowable in the sense that it is immediately apparent to the Board that they overcome all outstanding issues without raising new ones (see also CL, IV.E.4.1.3, 4.2.2 and 4.2.3 a)). Requests that are not self-explanatory become effective only at the date on which they are substantiated (see e.g. T 1732/10, point 1.5 of the reasons).

- 3.2 The filing of the proprietor's main request constituted a substantial amendment of the proprietor's case at the latest possible state of the proceedings.

- 3.3 The Board does not share the proprietor's view that the filing of this request was justified by developments in the appeal proceedings, in particular by the Board's communication under Article 15(1) RPBA dated 11 February 2015 and the Board's conclusion during the oral proceedings that auxiliary requests 1 and 2 lacked novelty in view of Figure 5 of D2. There had been no change in the subject of the proceedings after the filing of the statements of grounds of appeal and the replies thereto. The Board's communication did not raise any new issues; it merely established the factual and legal situation of the case and indicated the preliminary and non-binding opinion of the Board that the proprietor's main and auxiliary requests 1 and 2 lacked novelty over Figure 5 of D2 for the reasons given by the opponent in its statement of grounds of appeal (see points 5.5, 7.1 and 7.2 of the communication).

The fact that the proprietor was unsuccessful in persuading the Board to change its preliminary opinion does not constitute an unexpected development which the proprietor could not have foreseen.

Thus, the Board considers that the filing of this new request as fallback position is belated, as it could and should have been filed with the proprietor's reply to the opponent's statement of appeal grounds, or at the latest in direct response to the Board's communication.

- 3.4 Consequently, it lied within the Board's discretion to admit this late filed request into the proceedings, pursuant to Article 114(2) EPC and Article 13 RPBA.
- 3.5 During the oral proceedings, the proprietor explained why claim 1 had been amended and how the amendments were intended to overcome the objections of lack of novelty and lack of inventive step, as raised by the opponent. In particular, the proprietor submitted that none of the features taken from claims 5 and 7 to 9 is disclosed in the cited prior art, that these features inevitably lead to the assembly of supporting members shown in Figures 6 and 7 of the patent, and that this assembly guarantees a minimum pressure gradient between the first and second chambers irrespective of the angular position of the second supporting member relative to the first supporting member.
- 3.6 Even though the Board and the opponent might have been able to assess the novelty of the claimed torpedo against D1, D2 as well as the allegedly exhibited torpedo DM2A1, they could not reasonably be expected to assess its inventive step without adjournment of the

oral proceedings. Indeed, this would have required, among other things, identification of the technical effect resulting from the features distinguishing claim 1 from the prior art, and assessment of the technical problem solved by these distinguishing features. However, neither the Board nor the opponent was in a position to identify which technical effect is actually attained by the additional limitations of claims 7 to 9. In this respect, it is apparent that claim 1 is not limited to the preferred assembly of first and second supporting members as shown in Figures 6 and 7 of the patent and that, even if it were, the technical effect mentioned by the proprietor is not supported by any teaching in the patent specification or the originally filed application. In particular, there is no indication in either the claims or the description that the second supporting member may assume different angular positions relative to the first supporting member.

3.7 For these reasons the Board decided not to admit the proprietor's main request into the proceedings.

4. Article 113(2) EPC

4.1 After having announced its conclusion not to admit the proprietor's main request into the proceedings, the Board indicated to the proprietor that there was no claim request on file. In response, the proprietor declared that it maintained its non-admitted main request and that it did not wish to file any further request.

4.2 Since there is no text submitted, or agreed, by the proprietor for maintaining the patent in amended form (Article 113(2) EPC), the patent has to be revoked.

5. In light of the above conclusions there is no need for the Board to investigate any further the alleged public prior disclosures of torpedoes.

Order

For these reasons it is decided that:

1. The appeal of the patent proprietor is deemed to be withdrawn.
2. The decision under appeal is set aside.
3. The patent is revoked.

The Registrar:

The Chairman:



P. Martorana

G. Ashley

Decision electronically authenticated