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**Datasheet for the decision  
of 29 June 2016**

**Case Number:** T 1516/13 - 3.2.01

**Application Number:** 06851632.7

**Publication Number:** 1940680

**IPC:** B64C9/02, B64C7/00

**Language of the proceedings:** EN

**Title of invention:**

SEAL ASSEMBLIES FOR USE WITH DROOPED SPOILERS AND OTHER  
CONTROL SURFACES ON AIRCRAFT

**Patent Proprietor:**

The Boeing Company

**Opponent:**

Airbus Operations Limited(GB) / AIRBUS SAS(FR) /  
Airbus Operations SAS(FR) / Airbus Operations GmbH  
(DE) / Airbus Operations SL(ES)

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2), 123(3), 111(1)

**Keyword:**

Amendments - added subject-matter (main request : yes) -  
broadening of scope of protection (auxiliary request 1 : no)  
Remittal to department of first instance (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 1516/13 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 29 June 2016**

**Appellant:** The Boeing Company  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 29 April 2013  
revoking European patent No. 1940680 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**            G. Pricolo  
**Members:**            C. Narcisi  
                              O. Loizou

## **Summary of Facts and Submissions**

- I. European patent No. 1 940 680 was revoked by the decision of the Opposition Division posted on 29 April 2013. Against this decision an appeal was lodged by the Patentee on 28 June 2013 and the appeal fee was paid at the same time. The statement of grounds of appeal was filed on 29 August 2013.
- II. Oral proceedings were held on 29 June 2016. The Appellant (Patentee) requested that the appealed decision be set aside and that the patent be maintained in amended form on the basis of the set of claims of the main request or, in the alternative on the basis of the set of claims of one of auxiliary requests 1 to 8, all requests filed with letter dated 25 April 2016. The Respondent (Opponent) requested that the appeal be dismissed.
- III. Claim 1 of the main request reads as follows:
- "A seal assembly (140) for use with an aircraft (100), the aircraft (100) having a movable control surface (114) spaced apart from a fixed airfoil portion to define a gap therebetween, the seal assembly (140) comprising:
- a first seal member (342) having a first proximal portion (344) and a first distal portion (346), wherein the first proximal portion (344) is configured to be fixedly attached to the fixed airfoil portion (105) and the first distal portion (346) is configured to be extended outwardly from the fixed airfoil portion (105) toward the movable control surface (114); and
- a second seal member (352) having a second proximal portion (354) and a second distal portion (356), wherein the second proximal portion (354) is configured

to be fixedly attached to the movable control surface (114) and the second distal portion (356) is configured to be extended outwardly from the movable control surface (114) toward the fixed airfoil portion (105), and wherein the second distal portion (356) is configured to movably contact the first distal portion (346) of the first seal member (342) to at least partially cover the gap between the fixed airfoil portion (105) and the movable control surface (114) as the movable control surface (114) moves relative to the fixed airfoil portion (105); characterized in that: the second distal portion (356) of the second seal member (352) is configured to press against the first distal portion (346) of the first seal member (342) and deflect the first seal member (342) as the movable control surface (114) rotates in a first direction, and wherein the second distal portion (356) is configured to separate from the first distal portion (346) when the movable control surface (114) rotates in a second direction opposite to the first direction; and the first distal portion (346) includes an outer-facing first surface (348) and the second distal portion (356) includes an inner-facing second surface (364), and wherein the second surface (364) is configured to slide across the first surface (348) as the movable control surface (114) moves relative to the fixed airfoil portion."

Claim 1 of auxiliary request 1 (previously auxiliary request 3, as renumbered during oral proceedings) differs from claim 1 of the main request in that the wording "is configured to be extended" is everywhere (twice) replaced by the wording "is configured to extend".

IV. The Appellant's submissions may be summarized as follows:

The subject-matter of claim 1 of the main request does not violate Article 123(2) EPC. In effect, the features reading "the first distal portion (346) is configured to be extended outwardly from the fixed airfoil portion (105) toward the movable control surface (114)" (hereinafter designated as feature (i)) and "the second distal portion (356) is configured to be extended outwardly from the movable control surface (114) toward the fixed airfoil portion (105)" (hereinafter designated as feature (ii)) were disclosed in the application as filed (see published patent application, hereinafter designated as EP-A). The wording "is configured to be extended outwardly" (already included in granted claim 1) is in all respects equivalent to the wording "is configured to extend outwardly", previously included in claim 1 of EP-A. No different meaning of feature (i) results from the wording as amended, specifically no relative movement between the "fixed airfoil portion" ("or the first proximal portion") and "the first distal portion" occurs according to this feature (and similarly for the "second distal portion") once the seal is mounted on the aircraft. Moreover, such an interpretation would be completely at odds with the overall disclosure in the description of the patent specification (hereinafter designated as EP-B), which has to be taken into account according to Article 69 EPC.

The subject-matter of claim 1 of auxiliary request 1 does not contravene Article 123(3) EPC. Notably, replacing the wording "is configured to be extended outwardly" (as present in granted claim 1) with the wording "is configured to extend outwardly" (in said

features (i) and (ii)) does not lead to an extended scope of protection. This is a mere consequence of the fact that both wordings have the same meaning, as set out hereinbefore.

V. The Respondent's arguments may be summarized as follows:

The Appellant's main request and auxiliary request 1 should not be admitted to the appeal proceedings. Claim 1 of the main request is based on claim 1 of auxiliary request 5 of the appealed decision, however including further amendments. The Appellant already had an opportunity to file additional requests during opposition proceedings but chose not to do so, therefore pursuant to Article 12(4) RPBA (Rules of Procedure of the Boards of Appeal) no further requests should be admitted during appeal proceedings. Furthermore, in relation to claim 1 of the main request the Appellant completely changed its line of arguments, its contention now being that replacing the original wording "configured to extend outwardly" with the wording "configured to be extended outwardly" (as present in granted claim 1) was intentional and involved no error on the part of the Patentee. As to claim 1 of auxiliary request 1 (identical with claim 1 of said former auxiliary request 5, except for correction of minor typographical errors), no arguments were provided as to why the appealed decision was wrong not to allow this request.

The subject-matter of claim 1 of the main request does not comply with Article 123(2) EPC, for the wording "configured to be extended outwardly" necessarily and unavoidably implies a relative movement between the "first distal portion" of the first seal member and the



"fixed airfoil portion" (or the "first proximal portion" of the first seal member), whilst the original wording of the claim, reading "configured to extend outwardly", solely implies a structural relationship in which the first distal portion protrudes outwardly (and the same holds for the "second distal portion" in feature (ii)). Moreover, these two entirely different meanings give also rise to a completely different scope of protection. Consequently, reverting to the original wording of the claim, as implied by the amendment introduced in claim 1 of auxiliary request 1, necessarily leads to a broader scope of protection infringing Article 123(3) EPC.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The Board held the Appellant's main request to be admissible, however it fails due to non-compliance with Article 123(2) EPC (see hereinafter).
3. The subject-matter of claim 1 of the main request extends beyond the content of the application as filed (EP-A). In the Board's view, said features (i) and (ii), due to the wording "configured to be extended outwardly", may be construed in both the Appellant's and the Respondent's way. In other words, feature (i) (or (ii)) encompasses both interpretations given, i.e. that the "first distal portion" is configured to merely protrude or extend outwardly, or that it is configured to be moved or extended outwardly (by relative movement with respect to the "fixed airfoil portion" or the "first proximal portion"). The Board considers that the wording "configured to be extended outwardly" implies that, when the seal is to be mounted on the aircraft,

the first proximal portion is going to be fixedly attached to the fixed airfoil portion and the first distal portion is going to extend, stretch or otherwise protrude outwardly from the fixed airfoil portion (toward the movable control surface), thus being after mounting in an extended position. This, however, does not necessarily imply a relative motion between the "first proximal portion" and the "first distal portion", for mounting can obviously be performed by translational motion of the entire seal and, contrary to the Respondent's view, said wording does not exclude it. Nevertheless, as stated above, the wording "the first distal portion is configured to be extended outwardly" certainly encompasses the meaning of being "moved or extended outwardly (by relative movement with respect to the "fixed airfoil portion" or the "first proximal portion"), contrary to the Appellant's view. This feature was however undisputedly not disclosed in EP-A. For these reasons it is considered that features (i) and (ii) contravene Article 123(2) EPC.

4. The Board did not see any valid reason not to admit the Appellant's first auxiliary request to the appeal proceedings. In fact, claim 1 of this request is identical with claim 1 of auxiliary request 5 of the appealed decision and the Appellant has provided reasoned arguments (see statement of grounds of appeal, page 9, "Article 123(3) Extension of protection") as to why it considers that the appealed decision was wrong. Therefore, in accord with Article 108, third sentence EPC, and Rule 99(2) EPC, this request was deemed to be admissible.
5. The reinstatement of the wording "configured to extend outwardly" in said features (i) and (ii), according to claim 1 of auxiliary request 1, does not infringe

Article 123(3) EPC. Indeed, given that the Board sees the wording "configured to be extended outwardly" as encompassing both possible alternatives (see point 3 above), this amendment actually leads to a restricted scope of protection, as opposed to granted claim 1.

6. The Board decided, pursuant to Article 111(1) EPC, to remit the case to the first instance department, in order that the issues of novelty and inventive step be discussed in relation to claim 1 of auxiliary request 1. The appealed decision did not decide on these issues, although it included some discussion of the prior art in the paragraph "OBITER DICTA". However, in that paragraph only documents A2 (US-A-4 120 470) and A7 (US-A-2 403 770) were touched upon, whilst the question of novelty of claim 1 of auxiliary request 5 (corresponding to present auxiliary request 1) with respect to A5 (US-A-5 735 485) (see Opponent's objections in letter dated 7 March 2013) was not dealt with in the appealed decision. This objection was however raised again and set out in more detail in appeal proceedings, and likewise the Respondent's line of argument against inventive step was mainly based on A5 (see reply to the statement of grounds of appeal, pages 9,10,11). Moreover, the Opponent did not discuss these objections based on A5 in its written submissions during opposition proceedings and appeal proceedings. Hence, in essence novelty and inventive step were to be discussed for the first time during oral proceedings before the Board. For these reasons the Board considered that it was appropriate to remit the case to the Opposition Division.

## Order

### For these reasons it is decided that:

1. The decision is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of the set of claims of auxiliary request 1 (previously auxiliary request 3), as filed with letter of 25 April 2016.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated