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**Datasheet for the decision
of 13 July 2018**

Case Number: T 2279/13 - 3.2.04

Application Number: 03739294.1

Publication Number: 1521540

IPC: A47J27/21, A47J27/00, F24C5/10

Language of the proceedings: EN

Title of invention:
HEATING VESSEL

Patent Proprietor:
Jetboil, Inc.

Opponent:
Primus AB

Headword:

Relevant legal provisions:
EPC Art. 123(2), 104(1)
RPBA Art. 13(1), 13(3)

Keyword:

Late-filed request - admitted (yes)

Amendments - extension beyond the content of the application
as filed (yes)

Apportionment of costs - (no)

Decisions cited:

G 0009/92, G 0001/99

Catchword:



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Case Number: T 2279/13 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 13 July 2018

Appellant: Primus AB
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
29 August 2013 concerning maintenance of the
European Patent No. 1521540 in amended form.**

Composition of the Board:

Chairman A. de Vries
Members: G. Martin Gonzalez
T. Bokor

Summary of Facts and Submissions

I. The appellant-opponent lodged an appeal, received on 4 November 2013, against the interlocutory decision of the Opposition Division of the European Patent Office posted on 29 August 2013 concerning maintenance of the European Patent No. 1 521 540 in amended form, and simultaneously paid the fee for appeal. The statement setting out the grounds of appeal was received on 8 January 2014.

II. Opposition was filed against the patent as a whole and based on Article 100(a) EPC (lack of novelty and inventive step), Article 100(b) EPC (insufficiency of disclosure) and Article 100(c) EPC (unallowable extension of subject-matter).

The Opposition Division held that the patent according to the then valid auxiliary request 1 met the requirements of the Convention.

III. Oral proceedings before the Board were held on 13 July 2018.

IV. The appellant-opponent requests that the decision under appeal be set aside, and that the European patent No. 1 521 540 be revoked. He further requests apportionment of costs under Article 104(1) EPC.

The respondent-proprietor requests that the decision under appeal be set aside and the patent be maintained in an amended form on the basis of the main request, or in the alternative, on the basis of any of the First to Fifth auxiliary requests, all filed with letter dated 12 June 2018.

V. The wording of claim 1 reads as follows:

(a) Main request

" A system for heating a substance, the system comprising:

a vessel (100) having enclosed sides, a thermally conductive bottom end (114) and a top end (115) forming an opening for the introduction and extraction of the substance, the bottom end (114) having an external bottom side (116) having a central area (118) for receiving heat;

a series of integrally connected, thermally conductive protrusions (160; 1100) comprising a continuous piece of material fixedly secured to, extending continuously around a peripheral region of said external bottom side (116), and extending from the vessel external bottom side so as to define with the central area a cavity with a first diameter;

a heater (130) comprising a heat source (302) having a heat outlet header in the form of a burner head disposed below said cavity, and with a heat outlet at a fixed distance from said external bottom side and having a fuel intake port configured to couple to a fuel source, the heat outlet header configured to deliver heat to the cavity said burner head being generally round in shape and having a second diameter that is less than said first diameter,

wherein said protrusions extend from the external bottom side to a distance about equal to said fixed distance;

a top housing having a top rim coupled circumferentially to the external bottom side and encasing the protrusions, the housing having a series of exhaust vents formed therein and having a bottom rim;

a bottom housing configured to couple to the bottom rim and substantially encasing the heat source, the bottom housing having a set of air inlet vents formed therein, wherein a gas flow path is formed from the air inlet vents to the exhaust vents via the heat outlet."

(b) First auxiliary request

Claim 1 is as in main request but inserts the following text (underscored):

"...a series of integrally, thermally conductive protrusions (160; 1100) comprising a single continuous piece of material formed in a circular fin arrangement and fixedly secured to, extending continuously around..."

(c) Second auxiliary request

Claim 1 is as in the first auxiliary request with the addition of the following features at the end of claim 1 of the first auxiliary request (underscored):

"...the air inlet vents to the exhaust vents via the heat outlet, and
wherein said protrusions (1100) are formed by undulations in a protrusion piece, the undulations being distributed about the cavity having a cavity axis and forming the protrusion piece into a ring of the protrusions, which extends substantially parallel to the cavity axis, and a series of connecting segments (1112) between adjacent protrusions."

(d) Third auxiliary request

Claim 1 is as in second auxiliary request but inserts the following text at the end of the claim (underscored):

"...between adjacent protrusions;
wherein the undulations allow alternate connecting segments to provide a substantial planar area for attachment to the vessel."

(e) Fourth auxiliary request

Claim 1 as in third auxiliary request but inserts the following text (underscored):

"...a series of integrally connected, thermally conductive protrusions (160; 1100) comprising a single continuous piece of material formed in a circular fin arrangement and fixedly secured to, extending continuously around a peripheral region of said external bottom side (116), and extending from the vessel external bottom side so as to define with the central area a cavity with a first diameter, wherein the protrusions are coupled circumferentially about the central area;..."

(f) Fifth auxiliary request

Claim 1 as in fourth auxiliary request but inserts the following text (underscored):

"...a heater (130) comprising a heat source (302) having a heat outlet header in the form of a burner head disposed below said cavity, and with a heat outlet at a fixed distance from said external bottom side and having a fuel intake port configured to couple to a fuel source, the fixed distance being about equal to the distance extended by the protrusions, the heat outlet header configured to deliver heat to the cavity said burner head being generally round in shape and

having a second diameter that is less than said first diameter,..."

VI. The appellant-opponent argued as follows:

All final requests of 12 June 2018 are late filed and should not be admitted. Claim 1 of all requests contains subject-matter that extends beyond the contents of the originally filed application documents. Unforeseeable substantial amendments filed during the oral proceedings before the Opposition Division have caused very protracted oral proceedings and the need for a subsequent stage of written proceedings to amend the description associated with unnecessary attorney fees. These could have been avoided if the patentee would have filed his requests, amended claims and amended description in due time. Thus the request for apportionment of costs is justified.

VII. The respondent-proprietor argued as follows:

The new requests of 12 June 2018 only address, and resolve, issues in the communication of the Board in preparation for the oral proceedings and are therefore admissible. Clear and immediate basis for all claims of the main and the auxiliary requests can be found in the originally filed application documents. The behaviour of the patentee during opposition proceedings is within the limits of a normal defence of his patent and does not constitute an abuse of proceedings. Imposing costs of the appellant-opponent on the respondent-proprietor is not justified.

Reasons for the Decision

1. The appeal is admissible.

2. Background

The claimed invention is concerned with a system for heating liquids, essentially a highly efficient camping cooker, see main embodiment, figure 1. The system comprises a vessel 100 and a heater 130 with a heat source/burner head 302 configured to deliver heat to the external bottom side of the vessel. Vessel and heat source can be decoupled to facilitate storage and transport, especially in the case of portable systems. Since the user of portable systems must also carry the fuel, high heat exchange efficiency is desirable to reduce carrying weight. According to the claimed invention a series of protrusions (fins) 160 extend from the external bottom side 116 of the vessel whilst the heat outlet of the burner head 302 is required to be disposed at a fixed position with respect to the heat transfer elements of the vessel, namely the fins and the bottom side of the vessel. A highly efficient heat exchanger with an effective position of the flame is thereby achieved, wherein the flame is encircled by the fins. As a consequence a large majority of the heat is transferred to the external bottom side of the vessel either directly or indirectly through the fins, avoiding heat losses, see paragraphs [001]-[0015], [0044] and [0046] of the patent specification.

3. Admissibility of main request

The respondent-proprietor filed with letter dated 12 June 2018, one month before the oral proceedings, a new main request. The admission of such a request is at the discretion of the Board, Article 13 RPBA.

The appellant-opponent contested during the oral proceedings the admissibility of the new main request.

The reasons advanced by the appellant-opponent are that this request does not address all the issues already raised for the previous requests on file and is thus not clearly allowable as is normally required for late filed requests and that it furthermore violates the principle of *reformatio in peius*, while the exception to this principle as expounded in **G 1/99** (OJ 2001, 381) is not applicable in the present case.

In the Board's view *prima facie* allowability has to be understood in the context of the procedural economy criteria cited in Article 13(1) and 13(3) RPBA. Article 13(3) RPBA specifically directs the attention to the question whether the treatment of the issues raised by an amendment can reasonably be expected from the opposing party (or the Board) still in the oral proceedings. In the present case, it is immediately apparent that the new claim 1 successfully removes by way of amendment before commencement of the oral proceedings several of the issues raised by the appellant-opponent himself and by the communication of the Board of 17 May 2018 without at the same time raising any new one. It therefore clearly helps the procedure move forward by removing outstanding issues which no longer need to be discussed thus shortening the oral proceedings, rather than requiring adjournment. New claim 1 is additionally further restricted in scope vis-a-vis the upheld claim 1 and thus does not put the opponent and sole appellant in a worse situation. Thus the principle of the prohibition of the *reformatio in peius*, as set out in G 9/92 (OJ 1994, 875) is not violated. As it is clear from this decision, a non-appealing patent proprietor is not barred from making any amendments at all, as a question of principle: Amendments "may be rejected as inadmissible by the Board of Appeal if they are neither

appropriate nor necessary", see Headnote, Point 2. While it is true that the present case is not one comparable to the case considered in G 1/99 (*supra*), it does not follow from this fact that the respondent proprietor cannot make any amendments whatsoever.

For the above reasons the Board decided to admit the new main request into the proceedings.

4. Added subject-matter - Article 123(2) EPC

4.1 The appellant-opponent contests the conclusions of the Opposition Division in respect of the feature of upheld claim 1 that the "heat outlet header in the form of a burner head [is] disposed *below* [the] cavity" defined by thermally conductive protrusions (reasons 3.2). The protrusions are disposed around a peripheral region of the vessel external bottom side and define the referred cavity together with the external bottom side. The conclusions of the Opposition Division also holds for the same feature of claim 1 of the new main request.

In the originally filed documents there is no explicit mention or literal basis for the particular new claimed location of the burner head *below* the cavity or the protrusions. Thus the question whether a burner head located below the cavity defined by the protrusions is otherwise originally directly and unambiguously disclosed, or not, requires detailed consideration.

4.2 As noted by the Opposition Division, the objected feature of claim 1 not only recites that the burner head (or heat outlet - new main request) is located below the cavity defined by the protrusions but also that it is disposed at a "fixed distance" from the external bottom side of the vessel, which according to

the impugned decision must be read in combination with the further feature of the claim that the protrusions extend from the external bottom side to a distance about equal to said fixed distance, paragraph [0012]. The finding of the appealed decision is based entirely on the conclusion that the term "about equal" in paragraph [0012] would encompass a range of values for the extension of the protrusions that includes positions above and below the fixed distance of the heat outlet, so that the totality of the now claimed features essentially define that the term "below" must be construed as meaning "just below" the cavity. Thus in the opinion of the Opposition Division the feature "about equal" and the express statement in the description that the head can be "below" the cavity would provide a clear and unambiguous basis for the feature below the cavity now expressly claimed, as is also put forward by the respondent-proprietor.

4.3 The appellant-opponent however contends that, contrary to the findings of the Opposition Division, there is no literal or express original disclosure for a heat outlet (or burner head) being disposed "below" the cavity, whether just below or generally below. He also submits that there is no direct and unambiguous disclosure of the feature either as such or in specific combination with the other features of the new claim. The location below the cavity would be in the opinion of the appellant-opponent furthermore contrary to the teachings of the original disclosure that indicate preference for a location within the cavity rather than below.

4.4 Through the introduction of further features of originally filed claim 1, claim 1 of the main request is now restricted to the embodiment of figures 1-5

having a top housing with a top rim circumferentially coupled to the external bottom side of the vessel. According to the relevant description of this embodiment in respect of the relative position between burner head and fins or protrusions for this embodiment, paragraph [0043] of the published application, the burner head is "disposed *within* the inner circumference of ring of fins 160" and "the inner diameter of the fins 160 is made sufficiently large is [sic] *encircle* the burner 302...", which means that the burner head extends above the lower end of the protrusions or fixed distance as it is within or encircled within the cavity. It is also recited in that paragraph that in this configuration the flame is encircled by the fins, with the result that high heat transfer is achieved. Furthermore, in figure 3, the only figure that shows the position of the burner with respect to the cavity, the burner head and the heat outlet, consistently with the above referred paragraph [0043] of the description, extend clearly into the cavity, i.e. clearly above the lower limit of the cavity defined by the protrusions. Thus in the Board's understanding the skilled person when reading the range of values *about equal or less*, also recited in original paragraph [0043], in the context of that particular embodiment would interpret it as excluding positions of the burner head or heat outlet below or just below the the cavity, as this embodiment only describes a burner head that is clearly positioned within the cavity. The Board thus considers that the skilled person cannot directly and unambiguously derive from the originally filed documents the specific combination of features of valid claim 1 with a burner head positioned below the cavity defined by the protrusions.

4.5 It is true that original claim 1, see also paragraph 12 of the description of the published application, already specified that the protrusions extended from the external bottom side by a distance "about equal or greater than the fixed distance" of the heat outlet of the heat source, which would encompass a range of positions of the heat outlet within to just below the protrusions, as held by the contested decision. Claim 1 of the main request is now limited exclusively to embodiments with the burner head located at a position which may be qualified as just below the lower limit of the cavity (but under no circumstances level with or above it). The claim thus effectively claims a new range of values "below the cavity" that excludes the burner head being situated at an "equal" distance, i.e. at the lower cavity limit. However, this specific range including locations below the cavity but excluding the lower limit of the cavity ("equal" distance), is not described either implicitly or explicitly in the originally filed documents. Therefore the new wording adds a restriction to the subject-matter of claim 1 in the form of a feature that is not directly and unambiguously derivable from the original documents.

4.6 The respondent-proprietor contends in this context that figures 6b and 12 show embodiments with the heat outlet below the cavity. Firstly, those figures correspond to embodiments no longer falling under the scope of the new claims, as here no top housing is provided which is coupled circumferentially to the bottom side and encasing the protrusions. Even so, because of the perspective view chosen, either from the front right (figure 6b) or directly in front (figure 12) but in both cases from a vantage point looking down on the respective heater/cookers it cannot be conclusively established that burner 632 as heater outlet (figure

6b) is indeed located below the lower limit of the protrusions 660. For example, a line drawn in the plane of the cross-section and connecting the lower edges of the protrusions would appear to intersect the top of the burner at the cross-section plane. The further contentions of the respondent-proprietor about the technical teachings in original paragraph [0097] regarding heat flow from the burner that would be horizontal or unimpeded by the protrusions are based on the assumption that figure 12 shows a heat outlet below the cavity. As the Board considers this not to be the case, these submissions are therefore clearly not relevant.

4.7 The Board consequently holds that, contrary to the provisions of Article 123(2) EPC, the subject-matter of claim 1 according to the main request extends beyond the contents of the application as filed, because the feature that the heat outlet header in the form of a burner head is *below* a cavity defined by thermally conductive protrusions is not directly and unambiguously derivable by the skilled person from the originally filed application documents.

5. Auxiliary requests 1-5

All auxiliary requests 1-5 contain the above contested feature that the burner head is positioned *below* the cavity defined by thermally conductive protrusions. Consequently, without prejudice to the question of their formal admissibility, these requests are clearly not allowable due to lack of compliance with the provisions of Article 123(2) EPC for the same reasons as the main request as expounded above.

6. Apportionment of costs

The appellant-opponent contests the decision of the Opposition Division not to order a different apportionment of costs in the sense of Article 104 EPC, see section 9 of the impugned decision.

Under Article 104(1) EPC, each party must, as a rule, meet the costs it has incurred, unless reasons of equity justify to order otherwise.

6.1 The appellant-opponent submits that oral proceedings before the Opposition Division were very protracted due to the failure of the proprietor to timely file complete sets of auxiliary requests. Therefore substantial further amendments to the claims had to be filed during the oral proceedings, which in turn required the opponent to spend most of his time to analyse the late filed amendments without being able to consider the description. This occasioned additional written proceedings to adapt the description, which again caused unnecessary attorney fees.

6.2 In the present case, although the complete set of claims was filed during the oral proceedings before the Opposition Division, claim 1 as upheld is substantially based on claim 1 according to auxiliary request 4 previously filed on 4 October 2011 by the deadline set by the Opposition Division. The substantial part of the subject-matter that is the object of the main discussions, in particular that of claim 1, was therefore filed four months before the date of the first instance oral proceedings, which in the Board's view allows enough time for proper preparation.

It is also not unusual that, depending on the complexity of the case, for example as in the present case where there are several objections such as added subject-matter, clarity, novelty and inventive step for claim 1 raised against various requests and also requiring amendments to the dependent claims, final adaptation of the description is left for subsequent written proceedings if this is not feasible within the limited time available for oral proceedings.

Whether or not all issues can be dealt with and decided in an oral proceedings depends not only on the conduct of the parties but also on how the opposition division conducts the proceedings. While a cooperative attitude is certainly always expected from the parties to the proceedings, it is first of all the duty of the competent department of the EPO to make sure that only such amendments are admitted which can reasonably be dealt with by the other party at the given procedural stage. It appears to the Board that in the present case, if the objectionable late requests might have caused excessive effort and cost on the part of the opponent (though the Board is not convinced that this is so as explained above), then this could have been avoided by the Opposition Division, for example by using its discretion as outlined in the Guidelines for Examination (in the version of 2013 applicable at the time) E-V 2.2 and H-II, 2.7.1. It does not appear equitable to the Board that the respondent proprietor should bear the costs for a possible omission or misjudgement on the part of the Opposition Division.

The Board is thus in the present case unable to clearly attribute the cause of the allegedly excessive duration of the oral proceedings mainly to the amendments filed during the oral proceedings by the proprietor to such

an extent to constitute an abuse of procedure that might justify a different apportionment of costs for reasons of equity.

Furthermore, in the absence of a clear indication, the Board is generally reluctant to interfere with the conclusions of an opposition division, which was a direct witness to the parties' behaviour and is consequently in a better position to judge it.

6.3 In view of the above, the Board sees no reasons to deviate from the decision of the Opposition Division not to order a different apportionment of costs.

Order

For these reasons it is decided that:

- 1. The decision under appeal is set aside.**
- 2. The patent is revoked.**

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated