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**Datasheet for the decision
of 28 June 2023**

Case Number: T 0476/20 - 3.5.02

Application Number: 10703258.3

Publication Number: 2394339

IPC: H02G3/22, F16L5/00

Language of the proceedings: EN

Title of invention:

A Modularized Pipe or Cable Lead-Through

Patent Proprietor:

Roxtec AB

Opponent:

Hauff-Technik GmbH & Co. KG

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (yes)



Beschwerdekammern

Boards of Appeal

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Case Number: T 0476/20 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 28 June 2023

Appellant: Hauff-Technik GmbH & Co. KG
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
20 December 2019 concerning maintenance of the
European Patent No. 2394339 in amended form.**

Composition of the Board:

Chairman R. Lord
Members: F. Giesen
J. Hoppe

Summary of Facts and Submissions

I. The present appeal by the opponent (appellant) lies from the decision of the opposition division that the European patent No. 2 394 339 as amended according to the auxiliary request IV filed on 3 May 2018 met the requirements of the EPC.

II. The written requests of the parties are as follows:

The appellant (opponent) requests that the decision under appeal be set aside and the patent be revoked.

The respondent (patent proprietor) requests that the appeal be dismissed.

In the statements of grounds of appeal and the reply to the appeal both parties requested oral proceedings.

III. The board issued a communication pursuant to Article 15(1) RPBA 2020 dated 20 January 2023 and informed the parties of its preliminary opinion, in particular that the amendments to claim 1 of the respondent's sole request appeared not to comply with Article 123(2) EPC.

IV. By letter dated 5 April 2023, the respondent withdrew the request for oral proceedings, which were then cancelled.

V. Claim 1 according to the respondent's sole request reads as follows:

- M1 *A compressible module (1) for cable entries or pipe penetrations,*
- M2 *the compressible module having an axial groove for localisation of the cable or pipe,*
- characterized in that*
- M3 *said compressible module (1) in the direction of the cable or pipe, comprises at least two module sections*
- M4 *in the form of compressible submodules (10, 20, 30, 310, 320, 330)*
- M5 *having differing physical properties,*
- M6 *wherein each submodule has an axial groove for localisation of the cable or pipe,*
- M7 *wherein an outermost submodule is a sealing submodule,*
- M8 *wherein the submodules are joined end to end*
- M9 *and wherein at least one of the submodules is provided with at least one peelable layer (2) for adapting to the diameter of a cable or pipe, which at least one peelable layer is placed in a groove of the module.*

The board adopts here the feature labelling proposed by the appellant in the statement of grounds of appeal.

VI. The arguments of the appellant that are relevant for the present decision can be summarised as follows:

The amendments of the patent did not comply with the requirements of Article 123(2) EPC.

The compressibility of the module as a whole according to claim 1 as originally filed and according to original page 2, lines 26 to 29 implied neither the compressibility of each submodule nor of specifically two or more of the submodules. The disclosure of original claim 5 could mean that one submodule is compressible and the other submodule is incompressible, rather than implying that both submodules were compressible, but to different degrees. The original disclosure on pages 6 to 8 only contained a list of possible types of submodules. This was not a direct and unambiguous disclosure of a module with at least two compressible submodules. The passage on original page 8, lines 3 to 9 was concerned with two preferably certified submodules and a further submodule sandwiched between them. While the outer submodules were compressible in view of page 1, lines 10 to 12, the middle submodule could be of non-compressible material. Hence not each of the submodules was necessarily compressible.

VII. The arguments of the respondent that are relevant for the present decision can be summarised as follows:

The amendments of the patent complied with the requirements of Article 123(2) EPC.

Claim 1 as originally filed stated that the module as a whole was compressible and that it comprised at least two submodules. It was thus directly and unambiguously derivable that the module must contain at least one compressible submodule. Furthermore, claim 5 as

originally filed stated that the (different) physical properties of the at least two submodules included compressibility. Hence, original claim 5 disclosed explicitly that the at least two submodules were compressible.

Reasons for the Decision

1. *Admissibility of the Appeal*

The appeal complies with the requirements of Articles 106 to 108 EPC and of Rule 99 EPC. It is therefore admissible.

2. *Decision in the Written Procedure*

This decision can be handed down in the written procedure.

The board informed the parties of its preliminary opinion on the sole request in the communication pursuant to Article 15(1) RPBA 2020, which was based on the parties' arguments. The grounds for this decision are merely a confirmation of the preliminary opinion. Consequently, the parties had a chance to comment on the grounds for this decision.

Furthermore, the respondent withdrew the request for oral proceedings, and the appellant only requested oral proceedings if the board could not accede to their main request in the written procedure.

Handing down this decision in the written procedure therefore respects the requirements of Articles 113 and 116 EPC.

3. *Sole Request - Amendments*

3.1 Claim 1 of the respondent's sole request has been amended so as to contain subject-matter extending beyond the application documents as originally filed, in contravention of Article 123(2) EPC.

3.2 Original claim 1 contained the feature according to which

"said compressible module (1) in the direction of the cable or pipe, comprises at least two module sections in the form of submodules (10, 20, 30, 310, 320, 330) having differing physical properties".

This feature was amended according present features M3 to M5, *i.e.* specifying that the at least two module sections are in the form of compressible submodules.

The essential question to be discussed is whether the application documents as originally filed contain a direct and unambiguous disclosure of a module having at least two compressible submodules.

3.3 The respondent argues that claim 1 as originally filed stated that the module as a whole was compressible and that it comprised at least two submodules, and that it was directly and unambiguously derivable from this that the module must contain at least one compressible submodule. Furthermore, claim 5 as originally filed

stated that the (different) physical properties of the at least two submodules included compressibility, so that according to the respondent, original claim 5 disclosed explicitly that the at least two submodules were compressible.

- 3.4 The board is not convinced by the respondent's argument in this respect.

The appellant is correct in arguing that the compressibility of the module as a whole, as disclosed in claim 1 as originally filed, does not directly and unambiguously imply the compressibility of each submodule, nor of specifically two or more of the submodules. It is conceivable that a module consisting of non-compressible submodules has a compressible coating, such as shown for example in D3 (GB 2 250 996 A), so a compressible module could have no compressible submodules in the sense of claim 1 as originally filed. Furthermore, a single compressible submodule would render the module as a whole compressible. Therefore, even if one were to assume that the compressibility of the entire module implied the compressibility of some of the submodules, all that is derivable from claim 1 as originally filed is that the module comprises at least one, rather than at least two, compressible submodules.

Therefore, claim 1 as originally filed and the sentence on page 2, lines 26 to 29 do not contain a sufficient basis for the amendment.

Moreover, claim 5 states that the physical property in which the least two submodules (of claim 1 to which it refers) differ is compressibility. However, this disclosure could also mean that one submodule is

compressible and the other submodule is incompressible, rather than implying that both submodules were compressible but to different degrees. Therefore, claim 5 is not a direct and unambiguous disclosure of at least two compressible submodules.

Furthermore, the appellant is correct in reasoning that the original disclosure on pages 6 to 8 only contains a list of possible types of submodules. Such a list is not a direct and unambiguous disclosure of a module with at least two compressible submodules. In this respect it is less important, which of the listed submodules could be considered compressible and which not, as the appellant argues, since a list of individual potential submodules does not constitute a direct and unambiguous disclosure of a particular combination of the individual submodules into a module. Rather, the list is a disclosure of all possible permutations and therefore not a direct and unambiguous disclosure of the permutations containing specifically two or more compressible submodules.

Finally, the appellant is correct in concluding that the passage on page 8, lines 3 to 6 is not a sufficient basis for the amendment.

This passage reads:

"In the above examples it is the central submodule which is provided with altered properties. The reason for this is that the foreseen commercial product at the moment is a product where a central submodule having altered properties are [sic] sandwiched between two, submodules, preferably certified submodules".

This passage discloses a sandwich of three submodules (not at least two as claimed) of which the outer ones have identical physical properties (to which claim 1 is not limited). This passage does not contain any information as to the compressibility of the individual submodules. The respondent appears to assume at least *arguendo* and based on page 1, lines 10 to 12 that certified submodules were necessarily compressible. The board is not persuaded that certification can be seen to imply compressibility. But even on this assumption, this passage clearly discloses that the outer submodules are compressible, to which claim 1 is not limited.

The board notes that the original figures also do not represent a suitable original disclosure of the amended subject-matter.

- 3.5 The board therefore concludes that claim 1 of the sole request was amended such that it contains subject-matter extending beyond the application documents as originally filed.

4. *Conclusions*

The respondent's sole request is not allowable. Therefore the board accedes to the appellant's main request.

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:



U. Bultmann

R. Lord

Decision electronically authenticated