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D E C I S I O N
of 29 November 1994

Case Number: T 0237/92 - 3.2.3

Application Number: 88305150.0

Publication Number: 0300602

IPC: B08B 9/04

Language of the proceedings: EN

Title of invention:
Cleaning pig

Applicant:
Northern Telecom Europe Limited

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 84

Keyword:
"Consistency between claims and description (main request: no;
auxiliary request: yes)"

Decisions cited:
-

Catchword:
-



Case Number: T 0237/92 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 29 November 1994

Appellant:

NORTHERN TELECOM LIMITED
World Trade Center of Montreal,
380 St. Antoine Street West, 8th Floor
Montreal, Quebec H2Y 3Y4 (CA)

Representative:

-

Decision under appeal:

Decision of the Examining Division 2.3.09.113 of
the European Patent Office dated 16 December 1991
refusing European patent application
No. 88 305 150.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: C.T. Wilson
Members: F. Brösamle
L.C. Mancini

Summary of Facts and Submissions

I. European patent application No. 88 305 150.0 filed on 6 June 1988 was refused by the Examining Division by their decision dated 16 December 1991 on the grounds that the embodiment of Figures 1 to 3 does not fall within the wording of Claim 1 of 20 September 1991, received on 24 September 1991, which reads as follows:

"1. A pipeline pig (10) adapted for use in a fluid transportation pipeline having an electrical or other signal transmitting cable or line deployed therein, which pig comprises:

- (a) a central shaft (24);
- (b) a plurality of similar disc-shaped, radial bristle brushes (12, 14) carried transversely at axially-spaced positions on said central shaft (24);
- (c) a plurality of circular, planar diaphragms (18) of a woven fabric material carried transversely on said central shaft (24) and disposed between and spaced from selected brushes (12, 14); and
- (d) means (16, 40, 42) for securing the said brushes (12, 14) and diaphragms (18) on said central shaft (24); and is characterised by;
- (e) a resilient conical member (46, 50) secured on said central shaft (24) at its leading end, said conical member having a peripheral rim portion disposed adjacent to and facing peripheral parts of the foremost brush (12)."

II. On 17 January 1992 the Appellant (Applicant) lodged an appeal against the decision to refuse the application in suit paying the appeal fee in due time. The Statement of Grounds of Appeal was filed on 3 March 1992 in which the Appellant requested (by implication) to set aside the impugned decision and to grant a patent on the basis of the documents underlying the impugned decision (main

request) or on the basis of documents filed with the letter of 28 February 1992, received on 3 March 1992 (auxiliary request).

The Appellant argued that both embodiments of the application in suit - i.e. the embodiment according to Figures 1 to 3 and the embodiment according to Figures 4/5 - fall under the wording of the independent claim, since both embodiments would embrace the possibility of sweeping aside a cable arranged within the fluid transportation pipeline.

Reasons for the Decision

1. The appeal is admissible.
2. *General remarks:*

On page 2, paragraph 2, of the impugned decision it is set out that the set of claims filed with the Appellant's letter of 20 September 1991 forms the basis for the decision and that **a copy of this set is attached to the decision.**

This is, however, not so since the Examining Division's decision on file has attached to it the set of claims filed with the Appellant's letter of 27 September 1990, received on 29 September 1990.

To avoid any doubt it is made clear that the Board's decision is based on the following documents:

(a) main request:

- Claims 1 to 10 from 20 September 1991, received on 24 September 1991;

- pages 1, 2, 3, 3A and 3 B of 27 September 1990, received on 29 September 1990;
- page 4, lines 4 to 38, and pages 5 and 7 as originally filed;
- page 6 from 7 May 1991, received on 14 May 1991;
- Figures 1 to 5 as originally filed.

(b) auxiliary request:

- Claims 1 to 10 of 28 February 1992, received on 3 March 1992;
- page 1 of 27 September 1990, received on 29 September 1990;
- pages 2 to 6 of 28 February 1992, received on 3 March 1992;
- Figures 1 to 3 of 28 February 1992, received on 3 March 1992.

Though the auxiliary request does not comprise any "page 1" it must be assumed from the numbering of the remaining pages as "pages 2 to 6" that the Appellant clearly wished to maintain page 1 filed previously.

3. *Teaching of Claim 1 according to the main and auxiliary request:*

3.1 Claims 1 of the main and of the auxiliary request are identical in their wording so that they can be dealt with together.

3.2 In these Claims 1 it is prescribed, (see characterising clause thereof), that the deflector member be:

- (a) resilient and
- (b) conical.

3.3 The documents as originally filed may be interpreted as containing the teaching that the parts "36, 38" can be "conical", since it is set out on page 2, paragraph 3, thereof that in the presence of a cable or line within the pipeline the "cleaning pig" must be able to pass along that cable or line without destroying the cable or line respectively without being destroyed by the cable or line, and this problem would be solved by cleaning pigs as described in the original application, i.e. with an embodiment according to Figures 1 to 3, "D-form of the leading end of the cleaning pig", or with the embodiment according to Figures 4/5, "generally cone-shaped", see originally filed page 3, last paragraph, and page 4, first paragraph.

3.4 The second precondition that the deflector is (**resilient** cannot, however, be derived from the originally filed documents according to the embodiment pursuant to Figures 1 and 3. This embodiment can therefore not fall under the wording of Claim 1 so that the findings of the Examining Division are correct in that the description, comprising the embodiment according to Figures 1 to 3, is not consistent with the independent Claim 1. The requirements of Article 84 EPC are indeed **not** met.

4. The main request - documents underlying the impugned decision - is therefore not allowable.

5. The auxiliary request, documents filed with the letter of 28 February 1992, including a previously filed page 1, restricts the application to the embodiment according to the original Figures 4 and 5, the contested embodiment according to Figures 1 to 3 being deleted. This request has **not** to be dealt with by the Board since it was obviously not considered fully by the Examining Division, who did however express a positive opinion in

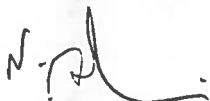
the contested decision in respect of the embodiment according to Figures 4 and 5. The Board therefore thinks it appropriate to use its discretion under Article 111(1) EPC to remit the case to the first instance.

Order

For these reasons it is decided that:

1. The impugned decision is set aside.
2. The main request is rejected.
3. The case is remitted to the first instance for further prosecution on the basis of the auxiliary request according to paragraph 2 above.

The Registrar:



N. Maslin

The Chairman:



C.T. Wilson