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D E C I S I O N
of 4 March 1997

Case Number: T 0289/95 - 3.2.1

Application Number: 86201654.0

Publication Number: 0212763

IPC: F16L 17/02

Language of the proceedings: EN

Title of invention:

Means for sealing the gap between two axially displaceable
sealing surfaces

Patentee:

FORSHEDA AB

Opponent:

WOCO Franz-Josef Wolf & Co.

Headword:

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Relevant legal provisions:

EPC Art. 100(c)

Keyword:

"Extension of subject-matter beyond content of earlier (parent)
application (no)"

Decisions cited:

T 0514/88, T 0527/88

Catchword:

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Case Number: T 0289/95 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 4 March 1997

Appellant: FORSHEDA AB
(Proprietor of the patent) S-330 12 Forsheda (SE)

Representative: Linde, Leif
Vernamo Patentbyrå AB
Persegård
S-274 00 Skurup (SE)

Respondent: WOCO Franz-Josef Wolf & Co.
(Opponent) Sprudelallee 19
D-63628 Bad Soden-Salmünster (DE)

Representative: Köster, Hajo, Dr.
Jaeger, Böck & Köster
Patentanwälte
Postfach 16 20
D-82121 Gauting b. München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 31 January 1995
revoking European patent No. 0 212 763 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: F. Gumbel
Members: S. Crane
G. Davies

Summary of Facts and Submissions

- I. European patent No. 0 212 763 was granted on 12 August 1992 on the basis of European patent application No. 86 201 654.0, which was a divisional of European patent application No. 84 902 615.8, published as WO-A-85/00211.

Granted claim 1 reads as follows:

"A gasket having a substantially uniform cross-sectional shape and comprising elastically resilient material for sealing a gap between two elements (9, 14) having sealing surfaces which are substantially uniformly spaced, the gasket comprising a sealing body (2) adapted to be stationary with respect to one of the sealing surfaces during assembly where relative movement of the elements (9, 14) occurs in a direction substantially parallel to the sealing surfaces and transverse to the longitudinal direction of the gasket, and further comprising a hollow jacket (22) defined by a wall having reduced thickness in relation to the sealing body (2) and forming a closed cavity having lubricated surfaces, the hollow jacket (22) being connected with the forward end (A) of the sealing body and being wholly positioned in front of the sealing body in the starting position for the assembly by relative movement of the elements (9, 14), the hollow jacket being adapted at the assembly to roll from the position in front of the sealing body in a manner similar to a caterpillar belt to a position in which the hollow jacket is at least partially

positioned between the sealing body and the opposite sealing surface, **characterized** in that the hollow jacket (22) defines an empty cavity which is adapted to be flattened with two opposite inner surfaces of said wall contacting each other essentially along their entire length during assembly and in the assembled position in which the jacket is at least partially positioned between the sealing body and the opposite sealing surface."

Dependent claim 2 reads as follows:

"A gasket according to claim 1, **characterized** in that the cross-sectional shape of the hollow jacket (22) is adapted to provide that the jacket will be carried along by a sealing surface during assembly."

Further dependent claims 3 to 6 relate to preferred embodiments of the gasket according to claims 1 or 2.

- II. The patent was opposed by the present respondents on the grounds of lack of inventive step (Article 100(a) EPC), insufficiency of disclosure (Article 100(b) EPC) and extension of subject-matter beyond the content of the earlier (parent) application as filed (Article 100(c) EPC).

- III. The Opposition Division revoked the patent with its decision posted on 31 January 1995.

The decision was based solely on considerations relating to Article 100(c) EPC.

IV. An appeal against this decision was filed on 28 March 1995 and the fee for appeal paid one day later.

The statement of grounds of appeal was filed on 31 May 1995.

The appellants (proprietors of the patent) requested that the contested decision be set aside and the patent maintained unamended.

V. In a communication dated 13 March 1996 the Board set out its preliminary views that neither the original objections raised by the respondents under Article 100(c) EPC, nor the reasoning contained in the contested decision were persuasive. The Board therefore indicated that it intended, provided that the auxiliary requests for oral proceedings were withdrawn, to remit the case to the Opposition Division to consider the objections under Articles 100(a) and 100(b) EPC.

With a letter filed on 16 May 1996 the respondents maintained their request for oral proceedings and extended and elaborated their objections under Article 100(c) EPC.

The requested oral proceedings were held on 4 March 1997.

VI. The arguments put forward by the appellants can be summarised as follows:

Independent claim 7 of the originally filed parent

application contained a broad definition in very general terms of a gasket provided with a closed sliding jacket. The description of the application provided a detailed disclosure of a particular embodiment of such a gasket and indications as to how the particular embodiment could be modified. Granted claim 1 fell wholly within the scope of the relevant claim of the parent application and contained only features which could be derived directly and unambiguously from the description and drawings thereof.

It was therefore difficult to see in what way there could have been an inadmissible extension of subject-matter.

Granted claim 2 was indeed broader in its terms than the equivalent dependent claim in the parent application. It stated now however nothing that was not already implicit in claim 1 and was therefore effectively redundant. This was not a ground of opposition.

VII. In support of their request for dismissal of the appeal, the respondents argued substantially as follows:

Claim 7 of the parent application required that both ends of the closed sliding jacket be directly connected to the front edge of the sealing part of the gasket. Nothing else was shown or suggested in the description of the embodiments. Granted claim 1, however embraced constructions in which the jacket was fully closed in

itself and joined via a connecting bridge to the gasket or in which one end of the jacket was joined to the front edge of the sealing part and the other end to a mid-portion of the sealing part. Since neither of these possibilities had been envisaged originally this constituted an inadmissible extension of subject-matter.

It was clear from a consideration of the description of the original Figures 8 to 10 that the inventive concept behind the form of the closed sliding jacket shown there lay in the way the jacket was of increasing thickness from one end to the other. The omission of this essential feature from the combination of other features taken from the description into granted claim 1 therefore also represented an inadmissible extension of subject-matter.

Furthermore, granted claim 1 included three features which found no counterpart in the parent application as originally filed. These were the requirement that the jacket was "flattened with two opposite inner surfaces of the wall contacting each other essentially along their entire length during assembly and in the assembled position", the reference to the jacket rolling on assembly in "a manner similar to a caterpillar belt" and the statement that the jacket is "at least partially" (and not fully) positioned between the sealing body and the opposite sealing surface after assembly.

As for granted claim 2, this had been inadmissibly broadened with respect to claim 8 of the parent application which required that the jacket have a bulge

at its connection point to the sealing part. Claim 2 now covered embodiments in which the jacket had some other special shape other than a bulge, or if it did have a bulge, where this was not adjacent the connection point to the sealing part. Again, this was an inadmissible extension of subject-matter.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is therefore admissible.

2. *The content of the earlier (parent) application as originally filed*

Claim 1 of the parent application is directed to a gasket for sealing for example the gap between a pipe spigot end and a pipe socket. The gasket is essentially of Z-shaped cross-section, with two main ("attachment" and "sliding" or "sealing") parts joined by a diagonally extending connection piece.

Figures 1 to 4 show a gasket of the claimed configuration, how it is mounted on a pipe spigot end and how the gasket behaves when the pipe spigot end is inserted into pipe sockets of various diameters.

Figure 5 illustrates the manufacture of a pipe socket with a gasket of the claimed configuration mounted therein and Figures 6a and 6b show the insertion of a pipe spigot end into such a pipe socket.

In the second full paragraph of page 5 reference is made to the possibility of providing a closed sliding jacket on the gasket to facilitate assembly of the pipe spigot end and the pipe socket. It is indicated that this type of jacket is known from US-A-4 299 399 and in Figures 7a and 7b such a jacket is shown in combination with a gasket of the lamellae type. There then follows an explanation as to how the effective thickness of the gasket can be increased on assembly by having a jacket of increasing thickness towards its forward connection point to the gasket body. It is then stated in the last paragraph of page 5 that a larger increase of thickness can be achieved by a "newly developed embodiment" of the closed sliding jacket, described with reference to Figures 8 to 10.

In Figure 8 the closed sliding jacket is shown in combination with a Z-shaped gasket as illustrated in Figures 6a and 6b. Both ends of the closed sliding jacket are attached, slightly spaced from each other, to the leading or front edge of the sliding part of the gasket. The jacket increases in thickness from one end to the other, the thicker end being radially outermost. The other end is provided with an inward bulge adjacent its point of connection to the sliding part of the gasket. The inner surfaces of the jacket are provided with a suitable lubricant. The insertion of a pipe spigot end into the pipe socket is explained in paragraph 2 of page 6. The pipe spigot end first contacts the bulge of the jacket and then draws the jacket, with its inner surfaces sliding over each other and one of its outer surfaces rolling across the

sliding part of the gasket, in such a way that it forms a double layer between the sliding part and the pipe spigot end. Figures 9 and 10 illustrate the effect of the length of the sliding jacket and the length of the axial movement between the pipe spigot end and the pipe socket on whether the jacket extends axially beyond the sliding part of the gasket after assembly.

Finally, in the penultimate paragraph of page 6 it is stated that

"from the description it will appear that this embodiment of a closed double sliding jacket is especially favourable in the described example, but the invention is not limited thereby, but can be used in connection with any other appropriate gasket structure"

and in the sentence bridging pages 6 and 7 that "for example, there can also be used a closed double sliding jacket in connection with that type of lamellae gasket illustrated in Figure 7, the sliding jacket being attached only to one point of the gasket body, for example in the area 17." (The reference numeral "17" is incorrect since it indicates a reinforcement on the outside of the gasket. Presumably the reference numeral "21" is meant.)

3. *The subject-matter of the present patent*

Figures 1a, 1b and 2 to 4 of the patent correspond to Figures 7a, 7b and 8 to 10 of the parent application, with Figures 1a and 1b being stated to show a prior art arrangement and Figures 2 to 4 embodiments of the invention.

The two-part form of claim 1 (quoted in Section I above) is however not derived from the state of the art shown in Figures 1a and 1b but from WO-A-81/03214, a document found in the search on the divisional application. It is to be noted that the preamble of the claim sets out the basic form of the gasket in very general terms.

4. *The contested decision*

Although the Opposition Division revoked the patent under Article 100(c) EPC the reasoning it used to come to the conclusion that the patent contained subject-matter extending beyond the content of the parent application was essentially different to the objections raised by the respondents in this respect.

In the opinion of the Opposition Division it was possible to identify in the parent application three combinations of features related to a gasket with a sealing body and a hollow jacket. These were the embodiment disclosed in the original claim 6 (a claim dependent on claim 1), the embodiment shown in Figures 8 to 10 and the embodiment shown in Figures 7a and 7b. The kernel of the Opposition Division's

thinking is then summed up in the statement that

"as the original description does not mention or suggest any other embodiments, the main claim must be related to one of these embodiments with all and only their respective features". Since this was found not to be the case it was held that the subject-matter of claim 1 went beyond the content of the parent application as originally filed. It is not clear to the Board why the Opposition Division made no reference in its decision to independent claim 7 of the parent application and refused to consider the penultimate paragraph of page 6, quoted above, and the sentence bridging pages 6 and 7 as constituting a general disclosure that a closed sliding jacket of the type shown in Figures 8 to 10 could be used not only with gaskets having a Z-shaped configuration, but with gaskets of any other appropriate structure. In view of that independent claim and the relevant passages of the description, the Board is convinced that the person skilled in the art would understand the parent application as teaching the use of a closed sliding jacket of the basic form shown in Figures 8 to 10 with any form of gasket of the general type set out in the first part of the preamble of claim 1 of the contested patent. The objection of the Opposition Division in this respect does not therefore hold good.

The Opposition Division also agreed with the objection of the respondents to claim 2 of the contested patent. This objection is dealt with below.

5. *The objections of the respondents under Article 100(c)*

EPC

The objections of the respondents under this head cover the whole spectrum from straightforward addition of features which have no counterpart at all in the parent application via what are often termed "intermediate generalisations" to the concept of "addition by omission". Since the last issue is the one on which the respondents, at least in the oral proceedings before the Board, seemed to place the most weight, it is convenient to deal with it first.

According to the respondents, independent claim 7 of the parent application required that both ends of the closed sliding jacket were directly connected to the front edge of the sealing part of the gasket. Figures 8 to 10 clearly showed such an arrangement, the ends of the jacket being spaced apart by the said front edge, and nothing else was suggested as being possible. Claim 1 of the contested patent on the other hand now covered two arrangements which had not been originally disclosed. In the first of these the ends of the jacket are connected to each other and then via a connection piece of some description to the gasket. That this arrangement was envisaged by the claim was made clear by the reference to the wall of the jacket "forming a closed cavity", i.e. by itself and without the help of part of the gasket. In the second of the arrangements now claimed but not originally disclosed only one end of the jacket is connected to the front end of the gasket and the other is connected to the gasket at a position axially spaced therefrom.

Here, it is necessary to clarify that the question of whether or not a claim in a patent deriving from a divisional application "covers" or "embraces" something which was not specifically disclosed in the parent application is not the proper standard of comparison for determining whether there has been an inadmissible extension of subject-matter. What is required (see T 514/88, OJ EPO 1992, 570 and T 527/88 of 11 December 1990, not published in OJ EPO) is an analysis of whether the subject-matter of the contested patent is directly and unambiguously derivable from, and consistent with, the disclosure in the parent application.

In the opinion of the Board there is nothing in the wording of independent claim 7 of the parent application which requires a direct connection of both ends of the jacket to the front edge of the sealing part of the gasket. Furthermore, there is nothing in the description of Figures 8 to 10 or inherent to the way the jacket is intended to function which could indicate that such a direct connection is necessary. Thus the person skilled in the art would understand that independent claim 7 was intended to embrace not only arrangements where the ends of the jacket are separately connected to the front edge of the sealing part of the gasket, as shown in Figures 8 to 10, but also embodiments where the sliding jacket itself forms a closed cavity and is attached to a single point on the gasket body as suggested in the sentence bridging pages 6 and 7, and accordingly an arrangement, now criticised by the respondents as being added subject-matter, in which the ends of the jacket are

joined together before they are connected to the front edge of the sealing part.

As for the second arrangement (see above) identified by the respondents as being covered by present claim 1 but not originally disclosed it is the opinion of the Board that this arrangement is in fact excluded by the wording of the claim which requires that the jacket be connected with the forward end of the sealing body and "wholly positioned in front of the sealing body in the starting position of the assembly". It cannot be seen how that requirement could be met in the arrangement envisaged by the respondents in which one end of the jacket was attached to the sealing body at a position axially spaced rearwardly of its forward end.

Accordingly, this first objection of the respondents fails.

The second objection to claim 1 particularly relied upon by the respondents at the oral proceedings was the absence from the claim of the feature that the jacket has increasing thickness from one end to the other. The respondents saw this as being an essential feature for the solution of the problem with which the closed sliding jacket as originally described and claimed was involved. That conclusion appears however to be based on a mis-reading of the parent application from which it is clear that the primary advance of the described closed sliding jacket over the known type of jacket shown in Figures 7a and 7b is that it forms a double rather than a single thickness layer between the gasket proper and the part to be sealed against. Particularly

since the use of a jacket wall having increasing thickness has already been discussed in the penultimate paragraph of page 5 with relation to the known type of jacket, it is evident that this is a subsidiary and not an essential feature of the closed sliding jacket shown in Figures 8 to 10.

The second objection of the respondent therefore also fails.

The other objections to claim 1 are more straight-forward. The respondents can find no support in the parent application for the statements that the jacket is "flattened with two opposite inner surfaces of the wall contacting each other essentially along their entire length during assembly and in the assembled position", that the rolls on assembly in "a manner similar to a caterpillar belt" and the jacket is "at least partially" positioned between the sealing body and the opposite sealing surface after assembly. With regard to the first two of these statements it is true that no exactly equivalent form of words can be found in the parent application, but that is not the point. It is the technical content of the statements that counts, not the words themselves. It is unequivocally clear from the description of Figures 8 to 10 of the parent application that the jacket behaves in the way required by these statements. Although the term "caterpillar" is in fact a trade name and thus should not be used in a claim, it has a well-established technical meaning, cf the Shorter Oxford English Dictionary: "Trade name for either of two endless metal belts or treads, one on each side of

a vehicle, which facilitate travelling over very rough ground". As for the third term objected to this has a clear basis in Figures 9 and 10 of the parent application which respectively show the jacket partially and fully positioned between the sealing body of the gasket and the pipe spigot end.

Thus none of these objections can succeed.

Finally, the objection of the respondents against claim 2 of the contested patent needs to be considered. The respondents argue that the parent application disclosed the provision of a bulge in the jacket adjacent its connection point to the forward edge of the sealing part of the gasket as the only possibility of adapting the shape of the jacket so that it "will be carried along by a sealing surface during assembly" as required by claim 2. That claim however made no mention of a bulge or its position and therefore "covered" many other arrangements not originally disclosed. This is true. But it is not the point. What matters is what the claim discloses, not what it covers. The claim is in fact drafted in such broad terms that it says nothing which is not already inherent to the gasket defined in claim 1. This makes the claim effectively redundant, as the appellants have admitted, but any possible objection to this under Article 84 EPC is not a ground of opposition. In view of the above the objection raised against claim 2 under Article 100(c) EPC does not hold good.

6. *Remittal*

The grounds of opposition under Articles 100(a) and (b) EPC have not yet been considered by the Opposition Division. In circumstances such as these it is the general practice of the Boards of Appeal to remit the case to the Opposition Division for further examination and that is the appropriate course of action to take in the present case. Thus, although the contested decision is to be set aside, the Board is not in a position to grant the request of the appellants that the patent be maintained unamended.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar: The Chairman:

S. Fabiani

F. Gumbel