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D E C I S I O N
of 18 March 1998

Case Number: T 0827/96 - 3.2.1

Application Number: 88202115.7

Publication Number: 0310190

IPC: F16L 59/14

Language of the proceedings: EN

Title of invention:

A heat insulated pipe element, a pipeline of such elements, and a method of laying such a pipeline

Patentee:

i.c. Möller a/s

Opponent:

Brugg Rohrsysteme GmbH
Løgstør Rør A/S

Headword:

-

Relevant legal provisions:

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

Keyword:

"Extension of scope (amended claims - no)"
"Remittal for further prosecution"

Decisions cited:

-

Catchword:

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Boards of Appeal

Chambres de recours

36

Case Number: T 0827/96 - 3.2.1

DECISION
of the Technical Board of Appeal 3.2.1
of 18 March 1998

Appellant: i.c. Möller a/s
(Proprietor of the patent) Trældevej 191
7000 Fredericia (DK)

Representative: Skøtt-Jensen, Knud
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Lemmingvej 225
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Respondent(s): Brugg Rohrsysteme GmbH
(Opponent 01) Adolf-Österheld-Str. 31
31515 Wunstorf (DE)

Representative: -

(Opponent 02) Løgstør Rør A/S
Danmarksvej 11
9670 Løgstør (DK)

Representative: Larsen, Hans Ole
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 11 July 1996
revoking European patent No. 0 310 190 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: F. Gumbel
Members: S. Crane
J.-C. Saisset

Summary of Facts and Submissions

I. European patent No. 0 310 190 was granted on 24 February 1993 on the basis of European patent application No. 88 202 115.7

The granted patent contained three claims which read as follows:

1. "A heat insulated pipe element, particularly for use as a straight pipe element in district heating pipelines, having an inner conductor pipe of annealed copper, a surrounding layer of a heat insulating material, and an outer mantle pipe, preferably of plastic, characterized by the pipe element being of the bonded type, i.e. with the inner conductor pipe being radially and axially stabilized relative to the mantle pipe by intermediate of an insulating material, which is rigid and well adhering to the relevant pipe surfaces."
2. "A pipeline consisting of straight pipe elements" according to claim 1, characterized in that the copper pipes are joined by hard-soldering."
3. "A method of laying out a straight length of a district heating pipeline by joining pipe elements according to claim 1, characterized in that the pipeline is laid out for fixation in the ground in a cold and generally non-prestretched condition."

II. The granted patent was opposed by the present respondents (opponents 01 and 02) on the grounds that its subject-matter lacked novelty and/or inventive step (Article 100(a) EPC) and that the invention was insufficiently disclosed (Article 100(b) EPC).

III. In the course of the opposition proceedings the present appellants (proprietors of the patent) submitted, with a letter dated 23 May 1996, amended claims 1 to 4 according to a main and an auxiliary request after the Opposition Division had raised in communications dated 9 January 1995 and 29 January 1996 various objections under Articles 123(2) and (3) EPC to the terms of the amended claims then on file. After holding oral proceedings on 19 June 1996, which the appellants and opponents 01 did not attend, the Opposition Division issued a written decision, posted on 11 July 1996, revoking the patent. The sole reason given for the revocation was that amended claims 2 and 3 of both the main and the auxiliary request infringed Article 123(3) EPC, in particular by deletion of the requirement that the "pipe elements" of claim 2 and the "length of a district heating pipeline" of claim 3 be "straight".

IV. An appeal against this decision was filed on 11 September 1990 and the fee for appeal paid at the same time.

The statement of grounds of appeal was filed on 11 November 1996. With this statement they submitted a set of claims 1 to 4 labelled "subsidiary claims" on the basis of which they requested maintenance of the patent in amended form. They did not pursue the sets of claims considered by the Opposition Division.

V. Counterstatements to the grounds of appeals were filed by Opponents 01 and 02 with letters dated 13 March 1997 and 12 March 1997 respectively.

Opponents 01 commented that they expected the terms of the claims would be changed in the course of the proceedings so that they would go into the question of conformity with Article 123(3) EPC at the appropriate

time. They reiterated their objections to lack of novelty and inventive step made in the opposition proceedings and requested that the appeal be dismissed.

Opponents 02 restricted themselves in essence to elaborating their objections to lack of novelty and inventive step made in the opposition proceedings. They requested that the patent be revoked "in its full scope" and that if the Board "does not revoke the patent to the full, compare with our request hereon" they requested oral proceedings before the Board.

- VI. In a communication dated 6 November 1997 the Board questioned the appropriateness of the amendments made to claims 2 and 3 of the "subsidiary claims" and added that claim 4 was unallowable, since it had no counterpart in the granted patent.

The Board stated that if the appellants were to submit a formally admissible set of claims in response to the communication then it would remit the case to the Opposition Division for it to consider and decide on the substantive merit of the subject-matter of these claims. Opponents 02 were therefore invited to clarify their auxiliary request for oral proceedings.

- VII. In a letter dated 22 December 1997 opponents 02 stated that they requested oral proceedings "if the patent is not revoked to the full and no matter which authority is prosecuting the case". They also added that they expected to be given an opportunity to comment on the amended claims which would be the basis of the further prosecution of the case.

VIII. With a letter dated 2 December 1997 and received on 5 January 1998 the appellants submitted a set of revised claims 1 to 3 which read as follows:

1. "A heat insulated pipe element used or for use as a straight pipe element in a district heating pipeline, having an inner copper conductor pipe, a surrounding layer of a heat insulating material and an outer mantle pipe, preferably of plastic, characterised by the combination of the inner conductor pipe being of annealed copper and of the pipe element being of the bonded type, i.e. with the inner conductor pipe being radially and axially stabilised relative to the mantle pipe by means of the heat insulating material being rigid and well adhering to the relevant pipe surfaces."

2. "A pipeline consisting of straight pipe elements according to claim 1, characterised in that the copper pipes are laid along a straight line and are joined by hard-soldering."

3. "A method of laying out a straight length of a district heating pipeline by joining pipe elements according to claim 1, characterised in that the pipeline is laid out with a straight configuration for fixation in the ground in a cold and generally non-prestretched condition."

Copies of this letter of the appellants were sent to the respondents on 12 January 1998. They did not file any comments on its content.

Reasons for the Decision

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

2. Present claim 1 corresponds to claim 1 of the main request considered by the Opposition Division. In comparison with granted claim 1 the claimed pipe element is now stated to be "used or for use as" instead of "particularly for use as" a straight pipe element in district heating pipelines. In its decision the Opposition Division held that the amended claim 1 did not infringe the requirements of Articles 123(2) and (3) and the Board sees no reason to disagree with that assessment.

It is also noted that the feature that the inner conductor pipe is of "annealed" copper has been moved from the preamble of the granted claim to the characterising clause of the present claim. Whether that is indeed a more accurate reflection of the state of the art is something that will need to be considered in the course of further examination.

In contrast to claims 2 and 3 considered by the Opposition Division present claims 2 and 3 are clearly based on the equivalent granted claims and incorporate the respective wording *in toto*. In present claim 2 the restriction has been added that the copper pipes "are laid along a straight line" and in claim 3 a similar restriction has been added to the effect that the pipe is laid out "with a straight configuration". The basis for these features can be seen in the sentence bridging pages 1 and 2 of the original application. There are therefore no objections under Articles 123(2) and (3) to the present claims 2 and 3.


3. As stated by the Board in its communication to the parties it is appropriate in the present circumstances, where the Opposition Division has not yet delivered a decision on the substantive issues of novelty and inventive step, to remit the case to it for further prosecution in accordance with Article 111(1) EPC and the established case law of the Boards of Appeal. Since this does not constitute a final decision of the Board on whether the patent should be maintained or revoked and since the opponents will have the opportunity to comment further on the amended set of claims before the first instance, the auxiliary request of opponents 02 for oral proceedings is without effect.

Order

For these reasons it is decided that:

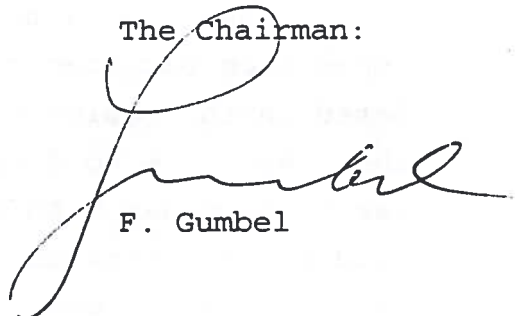
1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel