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D E C I S I O N
of 13 September 2000

Case Number: T 0109/99 - 3.2.1

Application Number: 91830516.0

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Language of the proceedings: EN

Title of invention:
Stopper device for gas tubes

Patentee:
Ravetti, Roberto

Opponent:
F.I.EL. S.p.A/Nardiello, Bruno

Headword:
-

Relevant legal provisions:
EPC Art. 100(c), 106
EPC R. 55(c), 64(b)

Keyword:
"Admissibility of appeals (patentee's, no; opponent's, yes)
"Admissibility of opposition (yes)"
"Addition of subject-matter (yes)"

Decisions cited:
G 0010/91, T 0169/83, T 0222/85, T 0073/88, T 0925/91,
T 0986/93

Catchword:
-



Case Number: T 0109/99 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 13 September 2000

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 30 November 1998
rejecting the opposition filed against European
patent No. 0 488 966 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: F. Gumbel
Members: S. Crane
J. Willems

Summary of Facts and Submissions

- I. European patent No. 0 488 966 was granted on 11 October 1995 on the basis of European patent application No. 91 830 516.0.

Claim 1 of the granted patent reads as follows:

"A device for temporarily blocking gas pipes, including:

- a cup-shaped body (12) for mounting on a sleeve (M) which is welded to the pipe (T) at right angle in correspondence of a through-hole (F) provided in the pipe (T),
- a rod (18) which is slidably sealingly and centrally in a hole (14) in an end wall (12a) of the cup-shaped body (12) and has an angled obturating end (18a) including a flange (20, 26) arranged in a plane and associated with a circular seal (28) of elastomeric material which has an outside diameter substantially corresponding to the inside diameter of the pipe (T), the rod (18) being able to assume a first position, in which its angled end (18a) is housed in the cup-shaped body (12), and a second position, in which the rod (18) is arranged with its axis and the axis of the pipe (T) being in a common plane and its angled obturating end (18a) is inserted in the pipe (T) like a plug, and
- operating means (32, 30, 38, 20, 22) for expanding the seal (28) radially against the wall of the pipe (T) when the angled end (18a) of the rod (18)

is in its second position,
characterised in that

- the obturating end (18a) is fixed to the rod (18) so that the axis of the rod (18) forms a predetermined acute angle with respect to the plane of the flange (20, 26) of the obturating end (18a),
- and in that the cup-shaped body (12) is so shaped that, when the rod (18) is in its second position, the rod (18) abuts simultaneously at opposite locations with respect to its axis, in correspondence of the hole (14) in the end wall (12a) of the cup-shaped body (12) and against an edge of the through-hole (F) provided in the pipe (T),
- so that the axis of the rod (18) forms with the axis of the pipe (T) a substantially complementary angle with respect to said acute angle, whereby the flange (20, 26) of the obturating end (18a) positions by itself at right angle with respect to axis of the pipe (T)."

Dependent claims 2 to 8 relate to preferred embodiments of the device according to claim 1.

II. An opposition against the granted patent was filed on the ground that its subject-matter lacked inventive step (Article 100(a) EPC), the opponents requesting that the patent be accordingly revoked in its entirety.

As prior art the opponents relied upon the following documents:

- (D1) US-A-4 202 377
- (D2) Drawing 8-101 of T.D. Williamson S.A. dated 22 September 1960, together with a written declaration of the same company;
- (D3) A brochure of T.D. Williamson S.A. inserted in a catalogue of Premabergo Italiana S.p.A., more specifically Bulletins Nos. 603.0 and 604.0 dated 1 January 1980 and Bulletin No. 605.0 dated 1 October 1981;
- (D4) A brochure of T.D. Williamson S.A. inserted in a catalogue of Premabergo Italiana S.p.A. dated 27 November 1989, more specifically pages 6 and 7;
- (D5) Brochure "FORTAMP" of LA.MEC di Guasti & C.S.N.C together with a technical drawing and invoices concerning the sale of equipment in July 1990.

In the course of the opposition proceedings the opponents also subsequently raised the objection that granted claim 1 contained subject-matter extending beyond the content of the original application (Article 100(c) EPC).

III. With its decision posted on 30 November 1998 the Opposition Division rejected the opposition and maintained the patent in unamended form. The opposition was held to be admissible but to fail on the merits. As for the belatedly raised ground of opposition under Article 100(c) EPC this was held to be not *prima facie* relevant and was thus disregarded under Article 114(2) EPC.

IV. The opponents filed a notice of appeal against this decision on 27 January 1999 and paid the fee for appeal on 29 January 1999. The statement of grounds of appeal was filed on 29 March 1999.

On 29 January 1999 the patentee also filed a notice of appeal against the decision and paid the fee for appeal. He requested that the decision be set aside insofar as it held the opposition to be admissible. The corresponding statement of grounds was filed on 1 April 1999.

VI. On 31 March 2000 the Board issued a communication according to Article 11(2) RPBA.

It stated its preliminary view that the appeal of the patentee was inadmissible but indicated that his objections as to the admissibility of the opposition could be pursued within the framework of the appeal of the opponents. As to the admissibility of the latter the Board indicated that in its preliminary view the requirements of Rule 64(b) EPC had been met; it invited the opponents to correct the defect under Rule 64(a) EPC (their address had not been stated in the notice of appeal) within a four-month time limit, as provided for by Rule 65(2) EPC. (This was done by letter of 25 July 2000.)

The Board also stated that with respect to the belated objections under Article 100(c) EPC it would be guided by the principles set out in decision T 986/93 (OJ EPO 1996, 215). As to the underlying question of when it was possible to incorporate into a claim features allegedly derivable solely from a drawing reference was made to the decision T 169/83 (OJ EPO 1985, 193).

VII. In response to this communication the patentee submitted on 11 August 2000 an amended version of claim 1 according to an auxiliary request which reads as follows:

"A device for temporarily blocking gas pipes, including:

a cup-shaped body (12) for mounting on a sleeve (M) through a connector (R), the sleeve (M) being welded to the pipe (T) at right angle in correspondence of a through-hole (F) provided in the pipe (T),

- a rod (18) which is slidably sealingly and centrally in a hole (14) in an end wall (12a) of the cup-shaped body (12) and has an angled obturating end (18a) including a flange (20, 26) arranged in a plane and associated with a circular seal (28) of elastomeric material which has an outside diameter substantially corresponding to the inside diameter of the pipe (T), the rod (18) being able to assume a first position, in which its angled end (18a) is housed in the cup-shaped body (12), and a second position, in which the rod (18) is arranged with its axis and the axis of the pipe (T) being in a common plane and its angled obturating end (18a) is inserted in the pipe (T) like a plug, and
- operating means (32, 30, 38, 20, 22) for expanding the seal (28) radially against the wall of the pipe (T) when the angled end (18a) of the rod (18) is in its second position, characterised in that
- the obturating end (18a) is fixed to the rod (18)

so that the axis of the rod (18) forms a predetermined acute angle with respect to the plane of the flange (20, 26) of the obturating end (18a),

- and in that the cup-shaped body (12) is so shaped to have a length transverse to the axis of the pipe which, in combination with the lengths of the said connector (R) and sleeve (M), is such that, when the rod (18) is in its second position, the rod (18) abuts simultaneously at opposite locations with respect to its axis, in correspondence of the hole (14) in the end wall (12a) of the cup-shaped body (12) and against the edge of the through hole (F) provided in the pipe (T),
- so that the axis of the rod (18) forms with the axis of the pipe (T) a substantially complementary angle with respect to said acute angle, whereby the flange (20, 26) of the obturating end (18a) positions by itself at right angle with respect to the axis of the pipe (T)."

VIII. Oral proceedings were held on 13 September 2000.

The opponents requested that the decision under appeal be set aside and the patent revoked in its entirety.

The patentee requested that the appeal of the opponents be rejected as inadmissible or dismissed as unfounded and the patent be maintained unamended or in the alternative in amended form with claim 1 according to the auxiliary request filed on 11 August 2000. He also requested that if the Board were to come to a different

conclusion to the Opposition Division as to the *prima facie* relevance of the objection under Article 100(c) EPC then it should remit the case to allow the Opposition Division to consider the issue fully.

IX. The arguments put forward by the opponents in support of their appeal were essentially as follows:

In the circumstances the only sensible interpretation of the statements made in the notice of appeal was that the opponents sought to have the decision under appeal set aside and the patent revoked in its entirety. The requirements of Rule 64(b) EPC were therefore met.

As for the notice of opposition there could be no doubt here that what was being argued was that the subject-matter of granted claim 1 lacked inventive step having regard to the state of the art known from documents D1 to D5, whereby document D1 represents the prior art on which the preamble of the claim was based, as acknowledged in the patent specification, and the characterising features could all be readily derived from the pipe stopping devices shown in documents D2 to D5. In view of the simplicity of the devices involved, detailed explanations going beyond those found in the notice of opposition were not necessary.

The statements in the characterising clause of claim 1 to the effect that the correct positioning of the flange within the pipe was obtained by an appropriate angular disposition of the rod carrying the flange, with the former engaging the edge of the through-hole in the pipe, found no proper basis in the original application; indeed they were flatly contradicted by what was actually disclosed there. In particular, it

was specifically stated with respect to the first embodiment that correct positioning of the flange was obtained by the provision of a special element on the rod with an inclined end face for engaging the upper outside surface of the cup-shaped body. Furthermore, in the second embodiment shown in Figure 5 the rod was not shown as engaging the edge of the through-hole, even though the flange was correctly positioned within the pipe. The granted claim 1 therefore offended against Article 100(c) EPC; since corresponding features appeared in claim 1 according to the auxiliary request, the same applied to this too.

X. In reply the patentee argued as follows:

Rule 64(b) EPC made it incumbent upon an appellant to identify the extent to which amendment or cancellation of the contested decision was sought. Having regard to the fact that the decision had come to a variety of conclusions on different issues, at least one of them in favour of the opponents (admissibility of the opposition), then it was illogical for them now to argue that the notice of appeal should be implicitly understood as requesting the setting aside of the decision in its entirety. Since this basic formal requirement had not been met the appeal was inadmissible.

As stated for example in decision T 222/85 (OJ EPO 1988, 128) the requirement of Rule 55(c) EPC calls for a proper reasoning of the merits of the opponents' case. The mere listing of documents from which the features of the claimed subject-matter could allegedly be derived without any clear guidance how these documents were supposed to form the basis for an

argument of obviousness did not allow for a proper understanding of the case by the patentee and the Opposition Division and was insufficient. This was the situation with regard to the notice of opposition in the present case. Moreover, there was no indication of what parts of the documents D2 to D5, which totalled together about 40 pages, were of particular interest, thus placing an unfair burden on the patentee and the Opposition Division and effectively transferring the job of constructing a case against the patent onto them. The opposition should therefore be rejected as inadmissible with the consequence that the appeal be dismissed.

The Opposition Division had come to the proper conclusion with regard to the *prima facie* relevance of the belatedly raised ground of opposition under Article 100(c) EPC and there was no good reason why the Board should interfere with the discretionary decision to disregard this objection under Article 114(2) EPC. In any case, the contested requirements stated in the characterising clause of granted claim 1 were clearly and unmistakably derivable for the person skilled in the art from Figure 3 of the original application where the geometric conditions involved were plainly recognisable. The fact that in the preferred embodiment involved there were also additional means for ensuring correct positioning of the flange could not detract from the technical reality portrayed in Figure 3 of the drawings. Nor could the fact that in Figure 5 of the drawings the rod was shown slightly spaced from the edge of the through-hole; since the pressure in the pipe would in practice always act to engage the rod with the edge of the through-hole, the person skilled in the art would recognise that Figure 5 portrayed a

situation in which the pipe stopping device had not yet reached its final operative position. That conclusion was supported by the fact that in Figure 5 the seal could be seen as not being fully radially expanded.

If the Board were to come to the conclusion that the objection under Article 100(c) EPC was not to be disregarded than the appropriate action would be to remit the case to the Opposition Division to enable the issue involved to be examined thoroughly before two instances.

Reasons for the Decision

1. The only outstanding question with regard to the admissibility of the opponents' appeal is whether the requirement of Rule 64(b) EPC has been met that the notice of appeal shall contain a statement identifying the decision which is impugned "and the extent to which amendment or cancellation of the decision is requested".

The only relevant statement in the notice of appeal is that "the decision dated 30.11.1998 to reject the opposition under caption is hereby appealed from and by virtue and under the provisions of Art. 106-108 EPC". Having regard to the facts that the opposition was directed against the granted patent in its entirety and that the opposition was rejected and the patent maintained unamended, the Board can see no genuine room for doubt that the statement quoted above has to be understood as meaning that the opponents were implicitly requesting to have the contested decision set aside and the patent revoked in its entirety, cf.

decision T 925/91 (OJ EPO 1995, 469, point 1.1). Since it is the result of the decision which is ultimately being challenged, not the individual aspects of the reasoning which led to that result, there was no requirement for the opponents to identify those aspects with which they agreed and to separate them out of the scope of the appeal.

2. Having regard to the fact that the decision of the Opposition Division under consideration was to reject the opposition and hence maintain the patent as granted, this decision cannot be seen as one adversely affecting the patentee in the sense of Article 107 EPC, notwithstanding the fact that the Opposition Division did not accept the arguments of the patentee dealing with the admissibility of the opposition. The appeal of the patentee against this decision, which seeks to have the opposition declared inadmissible, is therefore itself inadmissible, cf decision T 73/88 (OJ EPO 1992, 557).

3. The Board has no difficulty in agreeing with the contention of the patentee, amply supported by the case law on which he relies, that a notice of opposition which consists of little more than of a list of prior art documents from which various features of the claimed invention are allegedly known and which is effectively nothing more than an attempt to open up a general re-examination of the patent does not meet the requirements of Rule 55(c) EPC. But that is by no means a fair description of the notice of opposition in the present case.

Starting from document D1, which is stated in the patent specification to form the basis for the preamble

of granted claim 1 and accordingly did not need to be discussed in detail, it is argued in the sections "Prior art", "Discussion" and "Conclusions" of the notice of opposition that the features set out in the characterising clause of the claim were either known from or inherent to the use of the pipe stopping devices disclosed in documents D2 to D5 and that it was obvious to apply these features to a device as disclosed in document D1, with the result that the subject-matter of the claim lacked inventive step. It is true that some of the argumentation involved is somewhat sketchy and not fully developed, its import however is unmistakeable. Certainly, the patentee himself appears to have had no difficulty in understanding what the case of the opponents was as evidenced by his full reply of 11 December 1996 to the notice of opposition in which he argues for the inventive step of the claimed subject-matter in the light of the cited prior art and in which there is no suggestion that the notice of opposition was inadmissible.

Furthermore, the argument of the patentee that the opponents had placed an unfair burden on him and the Opposition Division by not identifying which parts of extensive documents they were relying on does not stand up to closer examination. In fact, with respect to both documents D3 and D4, the only ones which can be said to be of any significant length, the notice of opposition clearly indicates which pages are the ones considered particularly relevant i.e. Bulletin Nos. 603.0, 604.0 and 605.0 of document D3 and pages 6 and 7 of document D4.

Accordingly the Board comes to the conclusion that the

notice of opposition complies with the requirements of Rule 55(1) EPC, and with the other formal requirements for filing an opposition not being at issue, is admissible.

4. In response to the objection raised by the Examining Division that the subject-matter of claim 1 as originally filed lacked novelty with respect to document D1 the claim was amended to specify in its characterising clause features which were effective to ensure that in the operative pipe-blocking, ie "second" position of the device, the flange of the obturating end would be positioned at right angles to the axis of the pipe. Paraphrasing the characterising clause somewhat for the sake of the better understanding, the features involved are that the obturating end is fixed to the rod with its flange arranged at a predetermined acute angle to the axis of the rod; in the operative position of the device the rod is disposed at an angle determined by it abutting the central hole in the end wall of the cup-shaped body and the edge of the through-hole in the pipe, this angle being determined by the "shape" (more properly length) of the cup-shaped body in relation to other parameters, for example length of the sleeve, diameter of the through hole and diameter of the rod (this relationship is not specifically stated in the claim, but is implicit); the angle of the rod with respect to the axis of the cup-shaped body and the sleeve, which is perpendicular to the axis of the pipe, substantially corresponds to the acute angle between the axis of the rod and the plane of the flange or in other words - in the terms of the claim - the axis of the rod forms with the axis of the pipe a substantially complementary angle with respect to that acute angle.

The issue as to whether this combination of features had been adequately disclosed in the original application was first raised by the opponents in their letter filed on 13 October 1997, ie more than two years after the date of grant of the patent. At that stage oral proceedings before the Opposition Division had not yet been appointed; these were finally held on 9 November 1998. At the oral proceedings the issue of the objection under Article 100(c) EPC was discussed and after deliberation the Opposition Division announced that it would not consider this ground of opposition as it was *prima facie* not relevant. As explained briefly in the statement of reasons in the written decision the Opposition Division was of the opinion that the features in question could be seen in Figure 3 and that this figure was not in contradiction to Figure 5.

In its decision T 986/93 (*supra*) the Board dealt with the question, having regard to the findings of the Enlarged Board of appeal in opinion G 10/91 (OJ EPO 1993, 420) of the extent to which it could and should examine a ground of opposition which had been belatedly raised before the Opposition Division and which had been disregarded by the latter under Article 114(2) EPC. In that decision the Board held that it should only interfere with the decision of the Opposition Division in this respect if it was satisfied that there were indeed, *prima facie*, clear reasons for believing that the new ground of opposition was highly relevant to the extent that it would in whole or part prejudice maintenance of the patent, so that the Opposition Division had exercised its discretion incorrectly.

Applying these principles to the present case it is

readily apparent from a comparison of granted claim 1 with the terms of the original application that the characterising clause of the claim contains features which have no verbal counterpart whatsoever in the description and claims as originally filed. Now, as established in decision T 169/83 (supra), although it is in principle permissible to incorporate into a claim a feature only found in the drawings of the original application, this feature must be clearly, unmistakably and fully derivable from the drawings in terms of structure and function by the person skilled in the art and so relatable by him to the content of the description as a whole to be manifestly part of the invention. In the present case the facts that in the embodiment of Figure 3 a special element is provided for achieving the correct orientation of the flange, which is the alleged function of the features specified in the characterising clause of granted claim 1, and that in the embodiment of Figure 5 the condition resulting from these features is not met, both of which were pointed to by the opponents at the oral proceedings before the Opposition Division, give rise, *prima facie*, to considerable doubt as to whether the requirements set out in decision T 169/83 (supra) are met. The proper course of action for the Opposition Division would therefore have been for it to proceed to a full examination of the objection under Article 100(c) EPC, as the Board will now do.

In this context the Board cannot see that any constructive purpose would be served by remitting the case at this juncture to the first instance in order to allow it fully to consider the merits of all the arguments concerning the alleged addition of subject-matter. To do so would merely unnecessarily prolong the

procedure. The request of the patentee in this respect is therefore refused.

It is not in dispute that in the operative position of the device as shown in Figure 3 the position of the rod with respect to the through-hole in the pipe and the position of the flange within the pipe are as set out in the characterising clause of granted claim with the consequence that the geometric condition stated there - the requirement for the two angles involved to be "complemental", ie to add up to 90° , is also given. However, as already indicated above, this in itself cannot represent a sufficient basis for the incorporation of the relevant features into that claim. What is required in this respect is that the person skilled in the art will clearly and unmistakably recognise from Figure 3, in the context of the description as a whole, that the arrangement illustrated there is the deliberate result of technical considerations involving the relative dimensions of the elements of the device, as explained in more detail above, intended to ensure the correct orientation of the flange of the obturating end of the device when it is in its operative position.

The Board cannot see how this would be the case given that the embodiment of Figure 3 is provided with other means specifically intended for achieving this function. These means are constituted by a tubular element fixably disposed on the rod and having an inclined end face which in the operative position of the device engages the end wall of the cup-shaped body enabling "the rod to be positioned at an optimal inclination...to the axis of the cup-shaped body and the flange to be arranged perpendicular to the axis of the pipe", cf. column 3, lines 12 to 20 of the published A-document. Thus if the contention of the patentee as to what the person skilled in the art would understand from Figure 3 were to be accepted then that person would have to assume that means specifically disclosed for obtaining proper orientation of the flange were redundant. In the opinion of the Board this is not a realistic appraisal of how persons skilled in the art approach the technical information they are presented with.

Another factor which would certainly not encourage the person skilled in the art to see in what is illustrated in Figure 3 a technical teaching involving the abutment of the rod with the edge of the through-hole in the pipe and the consequences that might be involved for the proper orientation of the flange is the fact that in Figure 5 there is no such abutment. Taking into consideration that the embodiments illustrated in Figures 3 and 5 are in general terms quite similar then it would have been expected that the abutment of the rod with the edge of the through-hole would also be shown there if it were of any importance, especially as in this embodiment the tubular element on the rod discussed above is not present. For the Board the

argument of the patentee that the person skilled in the art would recognise the device in Figure 5 as being at an intermediate rather than its final operative position has no clear objective basis and is unconvincing. In the circumstances the Board can see no reason why the draftsman would have chosen such a form of portrayal as it would serve no purpose. Furthermore, the Board is not convinced by the contention of the patentee that in practice the pressure in the pipeline would always be effective to move the rod into a position in which it abutted the edge of the through-hole in the pipe since the force on the rod tending to move it in this direction and the forces resisting such movement are dependent on several indeterminate factors.

The Board therefore comes to the conclusion that the subject-matter of granted claim 1 extends beyond the content of the original application in contravention of Article 100(c) EPC.

5. As for claim 1 according to the auxiliary request this merely includes some clarifying amendments, added in response to a comment by the Board in its communication of 31 March 2000, which amendments have no bearing on the central issue of added subject-matter discussed above.

Order

For these reasons it is decided that:

1. The appeal of the patentee is rejected as inadmissible.
2. The decision under appeal is set aside.
3. The patent is revoked.

The Registrar:

The Chairman:

S. Fabiani

F. Gumbel