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D E C I S I O N
of 15 May 2003

Case Number: T 0784/01 - 3.2.1

Application Number: 95905183.0

Publication Number: 0739467

IPC: F16L 1/10, B25B 27/16

Language of the proceedings: EN

Title of invention:
Apparatus for aligning two members

Applicant:
Future Alignments Limited

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 56, 84, 123(2)
EPC R. 86(3)

Keyword:
"Non appearance at oral proceedings"
"No comments on the objections raised in the Board's
communication under Article 11(2) RPBA"
"Inventive step (no)"
"Amendments (not admissible)"

Decisions cited:
-

Catchword:
-



Case Number: T 0784/01 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 15 May 2003

Appellant: Future Alignments Limited
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 January 2001
refusing European patent application
No. 95 905 183.0 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: S. Crane
Members: M. Ceyte
H. Preglau

Summary of Facts and Submissions

- I. European patent No. 95 905 183.0 based on International application PCT/GB95/00036 and published under No. WO-A-95/18933 was refused by a decision of the Examining Division posted 17 January 2001.

The reason given for the decision was that claim 1 lacked clarity and its subject-matter lacked an inventive step having regard i.a. to the disclosure in:

D4: US-A-3 015 883.

- II. On 15 March 2001 the appellant (applicant) lodged an appeal against this decision and paid the prescribed appeal fee.

In the statement of grounds of appeal filed 25 May 2001, the appellant submitted arguments to overcome the reasons on which the decision under appeal was based and requested that

- (i) the decision under appeal be set aside and a patent be granted on the basis of the sets of claims according to the main request and first to third auxiliary requests enclosed with the grounds of appeal,
- (ii) oral proceedings be held in the event the Board is minded to take any action other than granting a patent on the basis of the main request and,
- (iii) the appeal fee be reimbursed.

Claim 1 of the main request reads as follows:

"1. Apparatus for aligning adjacent ends of two tubular members, the apparatus comprising a first section (51, 62), first coupling means (16, 70) for coupling the first section (51, 62) to one of the members, a second section (52, 67), second coupling means (16, 70) for coupling the second section (52, 67) to the other of the members, and a third coupling means (4, 9, 13, 14, 15, 61, 63, 64, 65, 66) movably coupling the first and second sections (51, 62, 52, 67) together to facilitate relative movement between the first and second sections (51, 62, 52, 67) to align the adjacent ends of the two tubular members, characterised in that the third coupling means (4, 9, 13, 14, 15, 61, 63, 64, 65, 66) comprises a ram device (14, 64) having a piston (14, 64) and a cylinder (14, 61, 63) so as to move the first and second sections (51, 62, 52, 67) relative to each other in a direction substantially perpendicular to the longitudinal axes of the tubular members."

Claim 1 according to the first auxiliary request reads as follows:

"1. Flanged-pipe aligning apparatus for aligning adjacent ends of two flanged pipes, the flanges (27) being adapted to be coupled to each other to connect the pipes in end-to-end relationship, the apparatus comprising a first section (51, 62), first coupling means (16, 70) for coupling the first section (51, 62) to one of the pipes, a second section (52, 67), second coupling means (16, 70) for coupling the second section (52, 67) to the other of the pipes, and a third coupling means (4, 9, 13, 14, 15, 61, 63, 64, 65, 66) movably coupling the first and second sections (51, 62,

52, 67) together to facilitate relative movement between the first and second sections (51, 62, 52, 67) in a direction substantially perpendicular to the longitudinal axes of the pipes to align the adjacent ends of the two pipes, characterised in that the first and second coupling means (16, 70) are slidable relative to the third coupling means (4, 9, 13, 14, 15, 61, 63, 64, 65, 66) to accommodate different widths of flange (27)."

Claim 1 according to the second auxiliary request reads as follows:

"1. Flanged-pipe aligning apparatus for aligning adjacent ends of two flanged pipes, the flanges (27) being adapted to be coupled to each other to connect the pipes in end-to-end relationship, the apparatus comprising a first section (51, 62), first coupling means (16, 70) for coupling the first section (51, 62) to one of the pipes, a second section (52, 67), second coupling means (16, 70) for coupling the second section (52, 67) to the other of the pipes, and a third coupling means (4, 9, 13, 14, 15, 61, 63, 64, 65, 66) movably coupling the first and second sections (51, 62, 52, 67) together to facilitate relative movement between the first and second sections (51, 62, 52, 67) in a direction substantially perpendicular to the longitudinal axes of the pipes to align the adjacent ends of the two pipes, characterised in that the first and second coupling means (15, 70) are movably mounted on the first and second sections (51, 62, 52, 67) to accommodate different widths of flange (27)."

Claim 1 according to the third auxiliary request reads as follows:

"1. Flanged-pipe aligning apparatus for aligning adjacent ends of two flanged pipes, the flanges (27) being adapted to be coupled to each other to connect the pipes in end-to-end relationship, the apparatus comprising a first section (51, 62), first coupling means (16, 70) for coupling the first section (51, 62) to one of the pipes, a second section (52, 67), second coupling means (16, 70) for coupling the second section (52, 67) to the other of the pipes, and a third coupling means (4, 9, 13, 14, 15, 61, 63, 64, 65, 66) movably coupling the first and second sections (51, 62, 52, 67) together to facilitate relative movement between the first and second sections (51, 62, 52, 67) in a direction substantially perpendicular to the longitudinal axes of the pipes to align the adjacent ends of the two flanged pipes, characterised in that the third coupling means (4, 9, 13, 14, 15, 61, 52, 64, 65, 66) permits movement between the first and second sections (51, 62, 52, 67) in a straight line."

III. In a communication pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal (RPBA) dated 28 January 2003, annexed to the summons for oral proceedings, the Board substantiated in detail why the revised sets of claims according to the main request and the first to third auxiliary requests were apparently not allowable. The content of its communication is as follows:

"1. The Board concurs with the Examining Division's opinion that the subject-matter of claim 1 (main request) lacks an inventive step:

It is apparently not contested that the subject-matter of claim 1 differs from the apparatus

known from D4 in that the third coupling means comprises a ram device having a piston and a cylinder.

As rightly stated by the Examining Division, hydraulically operated ram devices are widely used in the state of the art and have well known advantages as sufficient force transmitters, like handling of heavy loads and remote or automatic activation.

Ram devices are clearly part of the basic knowledge of any technician working in this technical field. Thus when a skilled person wants to use a ram device in place of a handle for mechanizing the manually-operated apparatus according to D4, he only needs to apply his basic technical knowledge.

The appellant submitted that the skilled person would not consider modifying the D4 apparatus to add a ram device because he would immediately recognise that the use of a ram device would generally only be required where high forces were necessary.

That submission does not appear to be persuasive since claim 1 is not limited to aligning cumbersome pipes. Thus, starting from D4 the problem to be solved is apparently to mechanize the hand-operated apparatus of D4 so that the pipes to be aligned are not anymore displaced by human power. As already stated it is constant preoccupation of technicians to mechanize hand-operated apparatuses and the overcoming of

drawbacks resulting from the force having to be applied manually must be considered as the normal task of the skilled person.

2. *Auxiliary request 1*

The characterising feature according to which "the first and second coupling means are slidable relative to the third coupling means to accommodate different widths of flange (27)" is not disclosed in the application as originally filed and thus contravenes Article 123(2) EPC.

It is true that in the second embodiment (Figures 4 and 5) the first and second coupling means (clamps 70) are provided with slots into which the first and second sections (wing sections 62, 67) slide and thus are "slidable" relative to the third coupling means. But it is nowhere said that the purpose of such arrangement is to accommodate different widths of flange.

In any event the first embodiment (Figures 1 to 3) does not fall within the scope of the claims: the first and second coupling means are not slidably mounted on the pegs 1, 2 or 11, 12. It is only stated that "one clamp would locate on the pegs 1, 2 on side 52 of the tool and the other clamp would locate on the pegs 11, 12 on side 51 of the tool," see page 5, lines 22 to 25 of the published PCT application.

This inconsistency between the claims and the description leads to doubt concerning the matter for which protection is sought thereby rendering the claims unclear (Article 84 EPC).

3. *Auxiliary request 2*

The above objections of added matter in contravention of Article 123(2) EPC and lack of clarity also apply to amended claim 1 of the auxiliary request 2 stating that "the first and second coupling means (16, 70) are movably mounted on the first and second sections (51, 62, 52, 67) to accommodate different widths of flange (27)."

4. *Auxiliary request 3*

There is also an objection of lack of clarity to claim 1 of the auxiliary request 3:

The flanged-pipe aligning apparatus according to claim 1 is namely characterised in that the third coupling means (4, 9, 13, 14, 15, 61, 63, 64, 65, 66) permits movement between the first and second sections (51, 62, 52, 67) in a straight line.

In the first embodiment, the third coupling means (9, 14) comprising the ram device (14) does not permit movement in **a straight line** between the first and second sections (51, 52) but a **rotation** of the first and second sections (51, 52) about the rotating disc (9).

5. *As to the filing of new amended claims*

In the present case the appellant has had ample time and opportunity i.a. in response to the five communications from the Examining Division, to file amended claims. The Examining Division in exercising its discretion under Rule 86(3) EPC may refuse to allow the filing of new amended claims. The principles by which such discretion is exercised are basically the same in proceedings before the Examining Division and on appeal, see Rule 66 EPC.

The reason for the refusal was that the subject-matter of claim 1 lacks an inventive step. It is clearly within the discretion of the Board of Appeal not to allow the filing of new dependent or independent claims in addition to the existing claims, since these new claims are unable to overcome the objection to patentability which has been raised against the subject-matter of the main claim. It is true that an appellant or applicant has a right to file one or more auxiliary requests in addition to the main request. However only the main claim of these auxiliary requests should be amended in order to overcome the objection to patentability.

In exercising its discretion the present Board has decided not to allow amendments proposing new dependent or independent claims in addition to the claims on which the decision of the Examining Division is based. This means that only amendments to claim 1 will be allowed (with the exception of the necessary adaptation of the dependent claims to the terms of amended claim 1). Thus the present sets of claims

according to the auxiliary requests are also inadmissible for this reason."

- IV. Oral proceedings before the Board were held on 15 May 2003. The appellant albeit duly summoned failed to appear at the oral proceedings without notifying the Board in advance that it would not attend.

Reasons for the Decision

1. The appeal is admissible.
2. In the above cited communication pursuant to Article 11(2) RPBA the Board fully explained, why it was of the opinion that
 - the subject-matter of claim 1 (main request) lacked an inventive step with respect to document D4 and common general knowledge;
 - amended claim 1 according to the first or second auxiliary request was unclear (Article 84 EPC) and contravened Article 123(2), since it contained a feature which was not disclosed in the application as originally filed;
 - amended claim 1 according to the third auxiliary request was unclear (Article 84 EPC).

Furthermore, it was said to be clearly within the Board's discretion not to allow the filing of new dependent claims or independent claims in addition to the claims on which the decision of the Examining Division was based, since the new claims were unable to

overcome the objection of patentability which had been raised against the subject-matter of claim 1. Thus the sets of claims according to the auxiliary requests were also inadmissible for this reason.

3. By not attending the oral proceedings the appellant has not availed himself of the opportunity to reply to the Board's communication pursuant to Article 11(2) RPBA.

Having considered the reasons which were advanced therein and which are unchallenged by the appellant, the Board sees no reason to depart from them. Consequently for the reasons set out in the above communication, the requests of the appellant that the decision be set aside and a patent be granted on the basis of the set of claims according to the main request and first to third auxiliary requests submitted with the grounds of appeal are not allowable. These requests must therefore fail.

4. Rule 67 EPC stipulates as a precondition for reimbursement of the appeal fee that the appeal be allowable. Since this precondition is not met, the unsubstantiated request for reimbursement must also fail.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

S. Fabiani

S. Crane