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D E C I S I O N
of 7 June 2005

Case Number: T 1121/01 - 3.2.7

Application Number: 96203023.5

Publication Number: 0776706

IPC: B05B 15/12

Language of the proceedings: EN

Title of invention:

Method and apparatus for making objects for further processing
dust-free

Patentee:

Delta Asset Holdings S.A.

Opponent:

EISENMANN Maschinenbau KG

Intervener:

Ford-Werke GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), (3)

Keyword:

"Main request: extension beyond the content of the application
as filed (yes)"

"Auxiliary requests 1 to 3: extension of the protection
conferred (yes)"

Decisions cited:

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Catchword:

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Case Number: T 1121/01 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 7 June 2005

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 August 2001
revoking European patent No. 0776706 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: K. Poalas
E. Lachacinski

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking European patent No. 0 776 706.
- II. With its intervention filed during the appeal proceedings the intervener questioned the fulfilment of the requirements of Articles 123(2) and (3) EPC (extension beyond the content of the application as filed and extension of the protection conferred).
- III. Oral Proceedings before the Board of Appeal took place on 7 June 2005.
- (a) The appellant requested that the decision under appeal be set aside and the patent be maintained according to the main request filed during the oral proceedings or according to auxiliary requests 1 to 3 filed with letter 6 May 2005.
- (b) The respondent (opponent) and the intervener requested that the appeal be dismissed.
- IV. Claim 1 as granted reads as follows:
- "Method for cleaning objects for further processing, for instance car bodies to be sprayed, wherein the objects to be processed are made dust-free by means of moist air, characterized in that the air stream is directed to the body to be processed by means of nozzles closely arranged to the object to be cleaned."

Claim 1 of the main request reads as follows:

"Method for cleaning car bodies for further processing, for instance car bodies to be sprayed, wherein the car bodies to be processed are made dust-free by means of moist air, characterized in that the air stream is directed to the car body to be processed by means of nozzles closely arranged to the car body to be cleaned."

In claim 1 of the auxiliary requests 1 to 3 the feature of claim 1 as granted that the nozzles are "closely arranged to the car body" is replaced by the feature that the object comes "into the vicinity of the nozzles" (auxiliary request 1) and that "said car bodies being made dust free by having them come into the vicinity of the nozzles" (auxiliary requests 2 and 3).

V. The appellant argued essentially as follows:

V.1 Article 123(2) EPC

The basis for the introduction, during the examination proceedings, of the expression "closely arranged" into claim 1 as granted and of the main request is the expression "arranged as closely as possible" mentioned on page 4, line 28 of the English translation of the application as filed.

It is true that the arrangement of the nozzles "as closely as possible" according to the mentioned passage is referred to as a "preferred embodiment" having the nozzles "arranged for movement in the direction

transversely of the direction of forward movement of the transporting means" (see page 4, lines 24 to 27). However, that passage should be read together with the passage on page 6, lines 19 to 20 of the English translation of the originally filed application, the latter disclosing no reference to a transversal movement of the nozzles and stating that the body comes "into the vicinity of the nozzles". To a skilled person it then becomes clear that the movement of the nozzles itself is not an essential feature for the present invention. Reading the above mentioned passages of the description together he will understand that there has to be a distance between the car body and the nozzles, said distance not only allowing the car body to pass the nozzles without touching them, but also allowing the build-up of an effective air stream.

Therefore, claim 1 of the main request disclosing the feature of a close arrangement of the nozzles to the car body without any reference to a transversal movement of the nozzles does not contravene the requirements of Article 123(2) EPC.

V.2 Article 123(3) EPC

Firstly, the expression "closely arranged" in claim 1 as granted and of the main request, and the expressions "comes into the vicinity" or "having them come into the vicinity of the nozzles" of claim 1 of auxiliary requests 1 to 3 are synonymous expressions.

Secondly, the replacement of the feature of claim 1 as granted that the nozzles are closely arranged to the object to be cleaned by the above mentioned features of

the claims 1 of the auxiliary requests 1 to 3 narrows the scope of protection.

Therefore, claim 1 of the auxiliary requests 1 to 3 does not contravene the requirements of Article 123(3) EPC.

VI. The respondent and the intervener argued essentially as follows:

VI.1 Article 123(2) EPC

The only part of the originally filed application disclosing the expression "closely arranged" is the third complete paragraph on page 4 of that application in its English translation. This paragraph is directed to the "preferred embodiment" having the nozzles "arranged for movement in the direction transversely of the direction of forward movement of the transporting means" (see page 4, lines 24 to 27). A basis for the nozzles to be "closely arranged" without the cleaning method involving a movement of the nozzles transversely to the forward movement of the transporting means, cannot be found in the originally filed application.

Therefore, claim 1 of the main request including the expression "closely arranged" without incorporation of the other features of the preferred embodiment contravenes the requirements of Article 123(2) EPC.

VI.2 Article 123(3) EPC

The expression "closely arranged" in claim 1 as granted, and the expressions "comes into the vicinity" and

"having them come into the vicinity of the nozzles" in claim 1 of the auxiliary requests 1 to 3 are not synonymous expressions. "In the vicinity of" does not necessarily imply a "close arrangement".

Moreover, the replacement of the feature of claim 1 as granted that the nozzles are arranged "closely to the object to be cleaned" by the above mentioned features of the claims 1 of the auxiliary requests 1 to 3 shifts and thereby extends the scope of protection conferred by claim 1 as granted.

Therefore, claim 1 of the auxiliary requests 1 to 3 contravenes the requirements of Article 123(3) EPC.

Reasons for the Decision

1. Amendments in examination - Article 123(2) EPC

1.1 The third complete paragraph of page 6 of the originally filed application (for the purpose of the decision reference is made to its English translation) describes "the operation of the installation according to the alleged invention". Said paragraph defines that the car body "comes into the vicinity of the nozzles" (see page 6, line 19), thereby leaving open whether the nozzles are movable or not. Also no information is given in said paragraph concerning the arrangement of the nozzles with respect to the car body.

In the third complete paragraph on page 4 of the originally filed application it is stated that in the case where the nozzles are "arranged for movement in

the direction transversely of the direction of forward movement of the transporting means" (see page 4, lines 24 to 27), "the nozzles are always arranged as closely as possible to the object for cleaning so that the cleaning is as effective as possible" (see page 4, lines 27 to 29).

- 1.2 On the basis of the two above mentioned paragraphs, the skilled person derives from the originally filed application the following teaching:

The arrangement of the nozzles close to the objects to be cleaned can be derived from the originally filed application only in combination with the feature of transversely movable nozzles. Such nozzles are as "a result always arranged as closely as possible to the object" (see page 4, lines 24 to 29). The close arrangement of the nozzles in respect to the object is thus originally described as a direct consequence of the transversal movability of the nozzles. The passage on page 6, lines 19, 20 of the original application, according to which the object to be cleaned "comes into the vicinity of the nozzles" cannot serve as a basis for this feature as there is a clear distinction between "the object is in the vicinity of the nozzles" and the nozzles are "closely arranged to the object". The former does not necessary imply the latter.

- 1.3 Therefore, claim 1 of the main request involving the expression "closely arranged" without any reference to transversely movable nozzles results in an intermediate generalization of a feature which is not disclosed as such and thus violates the requirements of Article 123(2) EPC.

The main request cannot therefore be allowed.

2. *Amendments of claim 1 as granted - Article 123(3) EPC*

2.1 In the method of claim 1 as granted a specific positioning of the nozzles is claimed, namely that the nozzles are closely arranged to the object to be cleaned.

Such a specific positioning of the nozzles is missing in amended claim 1 of each of the auxiliary requests 1 to 3. Instead, according to these requests a movement in the sense that "the object to be cleaned comes into the vicinity of the nozzles" or "car bodies being made dust-free by having them come into the vicinity of the nozzles" is claimed in said amended claim.

2.2 The Board cannot follow the appellant's arguments concerning Article 123(3) EPC for the following reasons:

The appellant has not put forward any supporting evidence for his contention, that the expressions "closely arranged" (used in claim 1 as granted) and "comes into the vicinity" or "having them come into the vicinity" (used in claim 1 of the auxiliary requests 1 to 3) are synonymous. It therefore has to be considered as unsubstantiated.

To the contrary, the Board considers that in normal language usage "comes into the vicinity" does not necessarily only mean "closely arranged". The appellant's argument that claim 1 of the auxiliary requests 1 to 3 has a narrower scope of protection than claim 1 as granted cannot therefore hold.

2.3 In addition, in the method of claim 1 as granted it is stated that the "air stream is directed to the body to be processed by means of nozzles closely arranged to the object to be cleaned". This defines a **specific, static relationship** between the **nozzles** and the **object** to be cleaned.

In contrast to that, the expression used in claim 1 of the auxiliary requests 1 to 3 that the object to be cleaned comes into the vicinity of the nozzles defines a relative **movement** between the **object** to be cleaned and the **nozzles**.

The specific, static relationship between the nozzles and the object to be cleaned as claimed in claim 1 as granted and the relative movement between the object to be cleaned and the nozzles as claimed in claim 1 of auxiliary requests 1 to 3 are neither comparable nor interchangeable with each other. Accordingly, the appellant's argument that claim 1 of the auxiliary requests 1 to 3 has a narrower scope of protection than claim 1 as granted cannot be accepted.

Since the specific static relationship between the nozzles and the object to be cleaned as claimed in claim 1 as granted is not comprised in the method of claim 1 of the auxiliary requests 1 to 3, the omission of this specific feature causes an extension of the scope of protection.

2.4 For the above mentioned reasons, each one of claims 1 of the auxiliary requests 1 to 3 contravenes the requirements of Article 123(3) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders