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D E C I S I O N
of 12 March 2004

Case Number: T 0264/03 - 3.2.4

Application Number: 96301257.0

Publication Number: 0730822

IPC: A01G 25/02

Language of the proceedings: EN

Title of invention:
In-line retention drip emitter

Patentee:
DRIP IRRIGATION SYSTEMS, LTD.

Opponents:
Hydroplan Engineering Ltd.
Netafim "Drip Irrigation" (C.S.) Ltd.

Headword:
-

Relevant legal provisions:
EPC Art. 100(a), 113(1), 123(2)
EPC R. 67, 72(1)

Keyword:
"Novelty - main request - third and fourth auxiliary requests (yes)"
"Inventive step - main request - third and fourth auxiliary requests (no)"
"Added subject-matter - first and second auxiliary requests (yes)"

Decisions cited:
T 1067/97

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0264/03 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 12 March 2004

Appellant: (Proprietor of the patent)
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Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 13 December 2002 concerning maintenance of European patent No. 0730822 in amended form.

Composition of the Board:

Chairman: C. A. J. Andries
Members: C. D. A. Scheibling
M. K. S. Aúz Castro
M. G. Hatherly
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. By its decision dated 13 December 2002 the Opposition Division issued an interlocutory decision maintaining the patent in an amended form on the basis of the fifth auxiliary request. On 24 February 2003 the appellant (patentee) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 23 April 2003.

II. The patent had been opposed on the grounds based on Article 100(a) EPC (Articles 54 and 56 EPC).

III. Oral proceedings took place on 12 March 2004.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or according to one of the first, second or third auxiliary requests (respectively corresponding to auxiliary requests 5D, 5E and 5F filed with letter of 1 March 2004) or according to a fourth auxiliary request filed in the oral proceedings. Furthermore, the appellant requested the reimbursement of the appeal fee.

The party as of right II (opponent II) who had also filed an appeal withdrew its appeal on 22 April 2003 and its opposition on 9 July 2003. On the latter date also party as of right I (opponent I) withdrew its opposition. None of the parties as of right attended the oral proceedings.

IV. Claim 1 of the main request reads as follows:

"1. An in-line retention drip irrigation emitter comprising:
means defining a flow-limiting passageway (22) having an inlet end for receiving pressurized fluid from an irrigation pipe (52) and an outlet end for conducting fluid to a pipe outlet opening characterised in that it comprises first valve means (72) responsive to fluid pressure in the pipe for closing the passageway when the fluid pressure in the pipe is below a minimum pressure and for opening the passageway when the fluid pressure in the pipe is above the minimum pressure and thereby preventing the draining of water from within the pipe when the pipe fluid is at a pressure less than the minimum pressure."

Claim 1 of the first auxiliary request reads:

"1. An in-line retention drip irrigation emitter comprising:
means defining a flow-limiting passageway (22) having an inlet end for receiving pressurized fluid from an irrigation pipe (52) and an outlet end for conducting fluid to a pipe outlet opening characterized in that it comprises first valve means (72) responsive to fluid pressure in the pipe for closing the passageway when the fluid pressure in the pipe is below a minimum pressure and for opening the passageway when the fluid pressure in the pipe is above the minimum pressure, and thereby preventing the draining of water from within the pipe when the pipe fluid is at a pressure less than the minimum pressure; wherein the valve means includes a first valve chamber interposed the pipe interior and

the passageway inlet end, the valve chamber having a first inlet and a first outlet, the first inlet being in fluid communication with the pipe interior and the first outlet being in fluid communication with the passageway inlet end, a first valve seat surrounding the first inlet, and a flexible membrane biased toward the valve seat; wherein the emitter further comprises a sleeve being a cylindrical length of said irrigation pipe of circular cross-section and has at least a partially cylindrical body intimately received in and enclosed by the sleeve and the first outlet is spaced from the first inlet along the cylindrical axis of the sleeve."

Claim 1 of the second auxiliary request reads:

"1. An in-line retention drip irrigation emitter comprising:
means defining a flow-limiting passageway (22) having an inlet end for receiving pressurized fluid from an irrigation pipe (52) and an outlet end for conducting fluid to a pipe outlet opening characterized in that it comprises first valve means (72) responsive to fluid pressure in the pipe for closing the passageway when the fluid pressure in the pipe is below a minimum pressure and for opening the passageway when the fluid pressure in the pipe is above the minimum pressure, and thereby preventing the draining of water from within the pipe when the pipe fluid is at a pressure less than the minimum pressure; wherein the valve means includes a first valve chamber interposed the pipe interior and the passageway inlet end, the valve chamber having a first inlet and a first outlet, the first inlet being in fluid communication with the pipe interior and the

first outlet being in fluid communication with the passageway inlet end, a first valve seat surrounding the first inlet, and a flexible membrane biased toward the valve seat; wherein the emitter further comprises a sleeve being a cylindrical length of said irrigation pipe of circular cross-section and at least a partially cylindrical body being intimately received in and enclosed by the sleeve such that the first outlet is spaced from the first inlet along the cylindrical axis of the sleeve, the at least partially cylindrical body having an outer surface in physical contact with an inner surface of the sleeve with an outlet passageway being formed between the body outer surface and the sleeve inner surface."

Claim 1 of the third auxiliary request reads:

"1. An in-line retention drip irrigation emitter comprising:
means defining a flow-limiting passageway (22) having an inlet end for receiving pressurized fluid from an irrigation pipe (52) and an outlet end for conducting fluid to a pipe outlet opening characterized in that it comprises first valve means (72) responsive to fluid pressure in the pipe for closing the passageway when the fluid pressure in the pipe is below a minimum pressure and for opening the passageway when the fluid pressure in the pipe is above the minimum pressure, and thereby preventing the draining of water from within the pipe when the pipe fluid is at a pressure less than the minimum pressure; wherein the valve means includes a first valve chamber interposed the pipe interior and the passageway inlet end, the valve chamber having a first inlet and a first outlet, the first inlet being

in fluid communication with the pipe interior and the first outlet being in fluid communication with the passageway inlet end, a first valve seat surrounding the first inlet, and a flexible membrane biased toward the valve seat; wherein the emitter further comprises a sleeve being a cylindrical length of said irrigation pipe of circular cross-section and at least a partially cylindrical body being intimately received in the sleeve and having an outer surface in physical contact with an inner surface of the sleeve; the passageway being formed between the body outer surface and the sleeve inner surface, wherein the first outlet is spaced from the first inlet along the cylindrical axis of the sleeve."

Claim 1 of the fourth auxiliary request reads:

"1. An in-line retention drip irrigation emitter comprising:
means defining a flow-limiting passageway (22) having an inlet end for receiving pressurized fluid from an irrigation pipe (52) and an outlet end for conducting fluid to a pipe outlet opening characterized in that it comprises first valve means (72) responsive to fluid pressure in the pipe for closing the passageway when the fluid pressure in the pipe is below a minimum pressure and for opening the passageway when the fluid pressure in the pipe is above the minimum pressure, and thereby preventing the draining of water from within the pipe when the pipe fluid is at a pressure less than the minimum pressure; wherein the valve means includes a first valve chamber interposed the pipe interior and the passageway inlet end, the valve chamber having a first inlet and a first outlet, the first inlet being

in fluid communication with the pipe interior and the first outlet being in fluid communication with the passageway inlet end, a first valve seat surrounding the first inlet, and a flexible membrane biased toward the valve seat; wherein the emitter further comprises a sleeve being a cylindrical length of said irrigation pipe of circular cross-section and a cylindrical or partially cylindrical body being intimately received in the sleeve and having an outer surface in physical contact with an inner surface of the sleeve; the passageway being formed between the body outer surface and the sleeve inner surface, wherein the first outlet is spaced from the first inlet in an axial direction in line with the first inlet."

V. The following documents played a role in the appeal proceedings:

D1: FR-A-2 614 557

D3: -1- Hydroplan's drawing of 16 mm In-line Rectangular Dripper - Assembly
-2- Extract from Netafim's Catalogue of 1991
-3- Extracts from Netafim's Desk Diaries of 87/88 and 88/89

D7: US-A-5 111 996

VI. The appellant essentially argued that a skilled person would not have contemplated applying the teaching of D1 to a drip emitter as disclosed in D7 because the constructional difficulties would have deterred him, since there was no reasonable expectation of success.

The appellant further considered that the Opposition Division committed a procedural violation in allowing the ground of prior use to be proceeded with and thus contravened Rules 57 and 72 EPC.
The appellant argued that, with respect to the public prior use allegation, the requirements of Rule 55(c) EPC were not met during the nine month opposition period and that therefore the alleged ground for opposition should have been rejected.

Reasons for the Decision

1. The appeal is admissible.

2. *Interpretation of claims*

2.1 According to the description of the patent in suit, column 5, lines 12, 13 and 25, 26, an emitter, being a workable entity, comprises an outer member such as a sleeve and an inner member formed as an insert. Thus, the outer member which contributes in forming the flow-limiting passageway is part of the emitter, since otherwise no workable entity would exist.

This has been confirmed by the appellant (patentee) who indicated that in his view "emitter" refers to a "ready to be used" implement.

2.2 During the opposition procedure, the term "in-line emitter" was interpreted to cover emitters enclosed within the irrigation pipe as well as emitters forming a separate part and positioned in line with the irrigation pipe, in-between two pipe sections.

2.3 The Board does not share this view. The Board considers that each claim should be read giving the words the meaning and scope which they normally have in the relevant art, **unless** the description gives the words a special meaning, by an explicit definition.

2.4 In the present case, the specification of the patent in suit indicates in column 1, paragraph 0006 what type of emitter can be considered to be an in-line emitter. This passage unambiguously defines an in-line emitter as being enclosed within the irrigation pipe, typically having an outer surface forming a labyrinth with the pipe interior wall surface.

2.5 Thus, within the meaning of the patent in suit, an in-line emitter is a constructional element which is fully enclosed by the irrigation pipe.

2.6 In order to support the broad definition of the term "in-line emitter" given in the opposition proceedings, reference was made to the passage in column 5, lines 15 to 18 of the patent in suit that reads: "Sleeve 50 could also be inserted in an irrigation pipe. It may also be a member formed in or attached to a portion of a pipe and does not need to be a complete sleeve, depending on how the emitter is designed". However, said passage does not refer to the way the emitter is positioned with respect to the pipe but indicates that the sleeve (outer member) is not compulsorily a portion of the irrigation pipe, but can be a separate part to be inserted within the irrigation pipe (see line 15). Therefore, this passage is not in contradiction with

the passage, paragraph 0006, of column 1 of the description referred to above.

3. *Novelty of claim 1 of the main request*

3.1 Public prior use

3.1.1 In order to prove the alleged public prior use, one of the parties as of right provided documents D3-1 to D3-3 and evidence was given by Mr Mehoudar during oral proceedings before the Opposition Division.

3.1.2 However, apart from what will be discussed below considering the alleged procedural violation in respect of this issue, the Board has come to the conclusion that the oral testimony of Mr Mehoudar, although it is not questioned, is not precise enough to establish that the emitters offered in D3-2 or D3-3 have been manufactured according to the drawing D3-1, to establish that they implement the features of claim 1 of the patent in suit and to establish when precisely and to whom at least one delivery of such emitters has taken place.

3.1.3 Therefore, the public prior use of an emitter manufactured in accordance with D3-1 is not unequivocally established.
Moreover, contrary to the Opposition Division's assessment, the Board has come to the conclusion that the emitter shown in D3-1 is not an in-line emitter within the meaning of the patent in suit (see section 2.5 above).

3.2 Other documents

None of the cited state of the art documents discloses in combination all of the features of claim 1 of the patent in suit. Indeed no objection, based on these documents, was raised against novelty.
Thus, claim 1 of the main request is considered to be novel.

4. *Main request - Inventive step*

4.1 Closest prior art document

D7 is considered to be the closest prior art document.

D7 (Figures 2, 3 and 10) discloses an in-line drip irrigation emitter comprising means defining a flow-limiting passageway (22) having an inlet end for receiving pressurized fluid from an irrigation pipe (52) and an outlet end for conducting fluid to a pipe outlet opening.

4.2 The subject-matter of claim 1 of the main request differs from that of D7 in that the emitter is a **retention** emitter which comprises first valve means responsive to fluid pressure in the pipe for closing the passageway when the fluid pressure in the pipe is below a minimum pressure and for opening the passageway when the fluid pressure in the pipe is above the minimum pressure and thereby preventing the draining of water from within the pipe when the pipe fluid is at a pressure less than the minimum pressure.

4.3 Thus, the problem to be solved by the invention is to provide an improved in-line emitter that prevents the drainage of the irrigation pipe when the water in the irrigation pipe is at low pressure, i.e. when water pressure is turned off (see patent specification, column 2, lines 16 to 19).

4.4 D1 discloses an on-line drip emitter. The object of D1 is to prevent the drainage of the irrigation pipe when the water in the irrigation pipe is at low pressure. In order to solve said problem, D1 teaches a skilled person to use a non-return valve.
In fact, from D1 (page 2, lines 8 to 10 and 34 to 36; Figure 1) there is known an on-line retention emitter which comprises first valve means (14, 20) responsive to fluid pressure in the pipe (via passageway 26) for closing the passageway (26) when the fluid pressure in the pipe is below a minimum pressure and for opening the passageway (26) when the fluid pressure in the pipe is above the minimum pressure and thereby preventing the draining of water from within the pipe when the pipe fluid is at a pressure less than the minimum pressure.

4.5 Therefore, it is obvious for a person skilled in the art in order to retain the water in an irrigation pipe equipped with emitters according to D7, when water is at low pressure, to provide said emitters with a check-valve as disclosed in D1, and thus to arrive at an in-line drip irrigation emitter according to claim 1 of the main request.

Therefore, the subject-matter of claim 1 of the main request does not involve an inventive step.

Consequently, the main request is not allowable.

4.6 The appellant argued that a skilled person would have refrained from using a check-valve as disclosed in D1 in an in-line drip emitter as known from D7, since there was little space to build a check-valve into D7 and since huge constructional problems were to be expected.

However, the Board notes that claim 1 according to the main request does not indicate how to solve said constructional, space linked problems. Claim 1 according to the main request solely teaches a skilled person to provide a check-valve and not how to build it into the emitter. Claim 1 does not exclude having the check-valve mounted in series with (externally of) the body of the emitter insert, thus avoiding the problems linked to a radially built-in construction.

5. *First and second auxiliary requests*

5.1 Amendments

5.1.1 Claim 1 of the first auxiliary request differs from claim 1 as originally filed in that:

-a- it further comprises the features of claim 2 as originally filed,

and the following additional features:

-b- "wherein the emitter further comprises a sleeve being a cylindrical length of said irrigation pipe

of circular cross-section and has at least a partially cylindrical body intimately received in and enclosed by the sleeve",

-c- "the first outlet is spaced from the first inlet along the cylindrical axis of the sleeve."

5.1.2 Claim 1 of the second auxiliary request differs from claim 1 as originally filed in that it further comprises the additional features (a), (b) and (c) listed above and the following feature:

-d- "the at least partially cylindrical body having an outer surface in physical contact with an inner surface of the sleeve with an outlet passageway being formed between the body outer surface and the sleeve inner surface."

5.1.3 Modification (a) is not objectionable under Article 123 EPC.

The appellant argued that modifications (b) were based on the passages of the description as originally filed, page 2, lines 33 and 34; page 5, lines 41 and 42 and on Figure 3, whereas modifications (c) and (d) were based on Figure 3 and partially on claim 9 as originally filed.

5.1.4 The Board however considers that the objects of claims 1 according to the first and second auxiliary requests constitute so called "intermediate generalisations".

This results from the fact that the Figures of an application as originally filed only disclose specific embodiments and that taking a feature disclosed with respect to a specific embodiment and combining it with other features of the original subject-matter can result in embodiments not disclosed or not even contemplated by the application as originally filed.

If a claim is to be restricted using a preferred embodiment, then it is not admissible under Article 123(2) EPC to extract isolated features from a set of features which had originally been disclosed in combination for that embodiment (see T 1067/97, see section 2.1.3).

In the present case, the in-line retention drip irrigation emitters according to claims 1 of the first and the second auxiliary requests comprise a flow-limiting passageway, a body and a sleeve. Although in the embodiment according to Figures 2 to 5 these three elements are in a specific technical relationship (the sleeve forming a side-wall of the flow-limiting passageway), claims 1 of the first and second auxiliary requests do not disclose that a relationship exists between the flow-limiting passageway on the one hand and the body and the sleeve on the other hand.

The fact that claim 1 of the second auxiliary request additionally indicates that an outlet passageway is formed between the body outer surface and the sleeve inner surface only defines the relationship existing between the outlet of the passageway, the body and the sleeve but not the relationship existing between the passageway itself, the body and the sleeve.

5.2 Thus, claims 1 of the first and second auxiliary requests are objectionable under Article 123(2) EPC and consequently the first and second auxiliary requests are not allowable.

6. *Third and fourth auxiliary requests*

6.1 Amendments

6.1.1 Claim 1 of the third auxiliary request differs from claim 1 as originally filed in that it further comprises the features of claims 2 and 9 as originally filed,
as well as the following feature: "wherein the first outlet is spaced from the first inlet along the cylindrical axis of the sleeve."

6.1.2 According to the appellant, "along the cylindrical axis of the sleeve" has to be understood as meaning "in an axial direction".

6.1.3 Claim 1 of the fourth auxiliary request differs from claim 1 as originally filed in that it further comprises the features of claim 2 and 9 as originally filed,
as well as the following feature: "wherein the first outlet is spaced from the first inlet in an axial direction in line with the first inlet."

6.1.4 With respect to these amendments, the Board considers that the requirements of Article 123 EPC are met.

6.2 Novelty

None of the cited state of the art documents discloses in combination all of the features of claim 1 of either the third or the fourth auxiliary requests.

Thus, claims 1 of the third and fourth auxiliary requests are considered to be novel.

6.3 Closest prior art document

D7 is considered to be the closest prior art document.

D7 (Figures 2, 3 and 10) discloses an in-line drip irrigation emitter comprising means defining a flow-limiting passageway (22) having an inlet end for receiving pressurized fluid from an irrigation pipe (52) and an outlet end for conducting fluid to a pipe outlet opening wherein the emitter further comprises a sleeve being a cylindrical length of said irrigation pipe of circular cross-section and at least a cylindrical body being intimately received in the sleeve and having an outer surface in physical contact with an inner surface of the sleeve; the passageway being formed between the body outer surface and the sleeve inner surface.

6.4 Inventive step

6.4.1 The subject-matter of claim 1 of the third auxiliary request differs from that of D7 in that the emitter is a retention emitter which comprises first valve means responsive to fluid pressure in the pipe for closing the passageway when the fluid pressure in the pipe is

below a minimum pressure and for opening the passageway when the fluid pressure in the pipe is above the minimum pressure and thereby preventing the draining of water from within the pipe when the pipe fluid is at a pressure less than the minimum pressure, wherein the valve means includes a first valve chamber interposed the pipe interior and the passageway inlet end, the valve chamber having a first inlet and a first outlet, the first inlet being in fluid communication with the pipe interior and the first outlet being in fluid communication with the passageway inlet end, a first valve seat surrounding the first inlet, and a flexible membrane biased toward the valve seat; wherein the first outlet is spaced from the first inlet along the cylindrical axis of the sleeve.

6.4.2 The subject-matter of claim 1 of the fourth auxiliary request differs from that of D7 in that the emitter is a retention emitter which comprises first valve means responsive to fluid pressure in the pipe for closing the passageway when the fluid pressure in the pipe is below a minimum pressure and for opening the passageway when the fluid pressure in the pipe is above the minimum pressure and thereby preventing the draining of water from within the pipe when the pipe fluid is at a pressure less than the minimum pressure, wherein the valve means includes a first valve chamber interposed the pipe interior and the passageway inlet end, the valve chamber having a first inlet and a first outlet, the first inlet being in fluid communication with the pipe interior and the first outlet being in fluid communication with the passageway inlet end, a first valve seat surrounding the first inlet, and a flexible membrane biased toward the valve seat; wherein the

first outlet is spaced from the first inlet in an axial direction in line with the first inlet.

6.4.3 Thus, the problem to be solved by the invention according to the third and fourth auxiliary requests is to provide an improved in-line emitter that prevents the drainage of the irrigation pipe when the water in the irrigation pipe is at low pressure (see patent specification, column 2, lines 16 to 19).

6.4.4 D1 discloses an on-line drip irrigation emitter. The object of D1 is to prevent the drainage of an irrigation pipe when the water in the irrigation pipe is at low pressure. In order to solve said problem, D1 teaches a skilled person to use a non-return valve.

In fact, from D1 (page 2, lines 8 to 10 and 34 to 36; Figure 1) there is known an on-line retention emitter which comprises first valve means (14, 20) responsive to fluid pressure in the pipe (via passageway 26) for closing the passageway (26) when the fluid pressure in the pipe is below a minimum pressure and for opening the passageway (26) when the fluid pressure in the pipe is above the minimum pressure and thereby preventing the draining of water from within the pipe when the pipe fluid is at a pressure less than the minimum pressure.

6.4.5 Therefore, it is obvious for a person skilled in the art, in order to retain the water in an irrigation pipe equipped with emitters according to D7, to provide said emitters with a check-valve as disclosed in D1 which solves said water retention problem.

Since there are only a limited number of possibilities for a skilled person to build a check-valve into D7, said possibilities being to build it into D7 upstream of the passageway inlet or downstream of the passageway outlet, in a radial or in an axial direction, to select one between such a limited number of options is merely a matter of design convenience and does not involve an inventive step.
Moreover, since two points (first inlet / first outlet) are always in line with each other, the feature according to which the first outlet is in line with the first inlet cannot involve an inventive step either.

Therefore, the subject-matter of the third and fourth auxiliary requests does not involve an inventive step.

Consequently, the third and fourth auxiliary requests are not allowable.

6.5 With respect to inventive step the appellant put forward essentially the same arguments as for the main request. Additionally he mentioned that having the first outlet spaced from the first inlet in an axial direction is a prerequisite constructional disposition allowing for the space necessary to build the check-valve into the emitter body.
However, said feature solely provides a skilled person with information on how the check-valve is positioned with respect to the axial direction. Since, as indicated in section 6.4.5 above, there are essentially two possible options for a skilled person in this respect, which are to arrange the check-valve either in the axial or in the radial direction, selecting one

direction instead of the other cannot involve an inventive step.

7. *Reimbursement of the appeal fee*

7.1 According to Rule 67 EPC, reimbursement of the appeal fee can only be ordered if the Board of Appeal deems the appeal to be allowable. Since this is not the case here, reimbursement of the appeal fee has to be refused.

7.2 However, the Board deems it appropriate to make the following points with respect to the taking of evidence by the Opposition Division.

7.2.1 Pursuant to Rule 72(1) EPC the European Patent Office shall make a decision where it considers it necessary to hear the oral evidence of parties, witnesses or experts, setting out the investigation which it intends to carry out as well as the relevant facts to be proved.

7.2.2 No such decision results from the minutes of the oral proceedings before the Opposition Division. The sentence: "Chairman announces that the Opposition Division (OD) will take evidence from Mr. Mehoudar on the Public Prior Use of his products" cannot qualify as a formal decision pursuant to Rule 72(1) EPC, in particular because the relevant facts to be proven are not indicated.

7.2.3 The testimony of a witness is a means of proof which is intended to **confirm** certain allegations of a party, but it is not meant to reveal for the first time facts not previously alleged by a party. In that case the hearing of a witness would be turned more into a means of

examination or investigation rather than a means of proof. In the case under consideration, the subject-matter on which the evidence was taken, "Public Prior Use of his products", was open ended and without any link to the allegations of the party as of right II.

7.2.4 Thus, the taking of evidence as performed by the Opposition Division contravened Rule 72(1) EPC as well as Article 113(1) EPC because it lessened the right of the patentee to be heard since the latter ran the risk of being surprised by the statements of the witness due to the fact that the subject-matter of the evidence was not limited to precise submissions of opponent II. Therefore, the Opposition Division committed a substantial procedural violation. Since however the procedural violation did not influence the final decision of the board the question of remittal to the first instance did not arise.

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:

G. Magouliotis C. Andries