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Datasheet for the decision of 7 February 2008

Case Number: T 1276/05 - 3.2.07

Application Number: 91304558.9

Publication Number: 0461770

IPC: B67D 5/06

Language of the proceedings: EN

Title of invention:
Liquid delivery system with vapour and liquid recovering means

Patentee:
Marconi Commerce Systems Inc.

Opponents:
DRESSER WAYNE AB
Scheidt & Bachmann GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
EPC Art. 108

Keyword:
"Appeal admissible - yes"
"Added subject-matter - yes"

Decisions cited:
T 0123/85, T 0331/89, T 0528/93

Catchword:
Reasons, point 1.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1276/05 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 7 February 2008

Appellant: (Patent Proprietor)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 9 August 2005 revoking European patent No. 0461770 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: H. Meinders
Members: P. O'Reilly
I. Beckedorf

Summary of Facts and Submissions

I. Opposition was filed against European patent No. 0 461 770 as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step), Article 100(b) EPC (insufficiency of disclosure) and Article 100(c) EPC (added subject-matter).

The opposition division decided to revoke the patent. It held that the subject-matter of claim 1, amended according to each of the main and the auxiliary request, did not comply with Article 123(2) EPC. It did not admit a request of the proprietor to maintain the patent as granted.

II. The appellant (patent proprietor) filed an appeal against that decision.

III. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted.

Respondent I (opponent I) requested that the appeal be dismissed.

Respondent II (opponent II) made no request during the appeal proceedings.

IV. Oral proceedings were held before the Board on 7 February 2008. After being duly summoned respondent II indicated with letter of 14 December 2007 that it would not attend the oral proceedings.

V. The independent claim for the Contracting States ES and DK of the patent as granted reads as follows:

"1. A liquid delivery system comprising: liquid delivery means (32, 30, 14, 6) having a volumetric flow; flow measuring means (24, 28) for generating an electrical signal representative of the volumetric flow of the liquid delivery means; vapour recovery means (36, 44) for sucking vapour at a first end and ejecting it at a second end; and control means (34) for controlling the vapour recovery means in response to the electrical signal, characterised in that the liquid delivery system comprises means for deriving the volumetric flow of the vapour recovery means, the volumetric flow of the vapour recovery means being controlled by the control means such that the vapour recovery means has a desired volumetric flow."

The independent claim for the Contracting States FR, GB and SE of the patent as granted reads as follows:

"1. A liquid delivery system for dispensing liquid into a closed tank, the system comprising: liquid delivery means (32, 30, 14, 6) having a volumetric flow; flow measuring means (24, 28) for generating an electrical signal representative of the volumetric flow of the liquid delivery means; vapour recovery means (10, 18, 36, 44, 40) for sucking vapour at a first end arranged to be placed in the region of an opening in the tank and ejecting it at a second end, the vapour recovery means including pump means (36, 44); and control means (34) for controlling the vapour recovery means in response to the electrical signal, characterised in that the liquid delivery system

comprises means for deriving the volumetric flow of the vapour recovery means and in that the control means (34) controls the vapour recovery means (36, 44) in response to the electrical signal to cause the rate at which vapour is recovered by the vapour recovery means to be substantially equal to the rate at which it is expected that vapour will be emanating from the tank thereby enabling substantially all the vapour to be recovered."

The independent claim for the Contracting State DE of the patent as granted reads as follows:

"1. A liquid delivery system comprising: liquid delivery means (32, 30, 14, 6) having a volumetric flow; flow measuring means (24, 28) for generating a first electrical signal representative of the volumetric flow of the liquid delivery means; vapour recovery means (10, 18, 36, 44, 40) for sucking vapour at a first end and ejecting it at a second end, the vapour recovery means including pump means (36, 44) and control means for controlling the vapour recovery means in response to the first electrical signal; characterised in that the system further comprises: means for deriving a second electrical signal indicative of the volumetric flow of the vapour in the vapour recovery means; means for deriving from the first electrical signal a third electrical signal indicative of the volumetric flow of the vapour recovery means under given conditions; and control means for comparing the second and third signals and controlling the pump means such as to increase the volumetric flow of the vapour recovery means if the comparison indicates that the volumetric flow of the vapour recovery means is less than the flow under the given conditions, and to decrease the volumetric flow of

said vapour recovery means if the comparison indicates that the volumetric flow of the vapour recovery means is greater than the flow under the given conditions."

VI. The arguments of the appellant may be summarised as follows:

(i) The appeal is admissible. The opposition division revoked the patent because it considered that the amendments in claim 1 made during the opposition proceedings did not comply with Article 123(2) EPC. By reverting to the patent as granted as the only request the appellant has overcome the grounds for the decision of the opposition division. In such a situation it was not necessary for the appellant to discuss the grounds of the decision since they were no longer relevant as a result of the reversion to the patent as granted as the sole request.

The fact that during the opposition proceedings the proprietor filed a main request that was narrower in scope than the patent as granted does not mean that in doing so subject-matter was abandoned. The proprietor was entitled at any point in the proceedings to return to subject-matter that had not been abandoned.

(ii) The patent as granted complies with Article 123(2) EPC.

With respect to claim 1 for the Contracting States ES and DK, when compared to claim 1 as originally filed, the claim includes the feature that the

volumetric flow of the vapour recovery means is controlled by the control means such that the vapour recovery means has a desired volumetric flow. This feature is disclosed in the application as originally filed. In particular reference is made to the "desired flow" on page 3, lines 1 and 2, and lines 7 to 11.

(iii) With respect to claim 1 for the Contracting States FR, GB and SE the claim, when compared to claim 1 as originally filed, includes the feature that the control means controls the vapour recovery means in response to the electrical signal to cause the rate at which vapour is recovered by the vapour recovery means to be substantially equal to the rate at which it is expected that vapour will be emanating from the tank. Support for the amendment can be found in particular on page 3, lines 21 to 25 and page 7, last line to page 8, line 20 in the application as originally filed. The feature has essentially the same meaning as the feature of the claim 1 for ES and DK that the vapour recovery means has a desired volumetric flow.

(iv) With respect to claim 1 for the Contracting State DE the claim, when compared to claim 1 as originally filed, includes the feature that there are means for deriving from the first electrical signal a third electrical signal indicative of the volumetric flow of the vapour recovery means under given conditions. This feature is disclosed in the application as originally filed in the paragraph bridging pages 2 and 3. In that paragraph it is indicated that "The microprocessor then

determines … an electrical signal that can be applied to the vapour recovery means so as to make it have the desired volumetric flow". This is the third electrical signal and it is derived from the first electrical signal. This is further supported by lines 21 to 25 of page 3 of the application as originally filed.

VII. The arguments of respondent I may be summarised as follows:

(i) The appeal is not admissible. In its appeal grounds the appellant did not challenge the appealed decision on its merit but rather just filed amended claims without any explanation as to why the appealed decision was wrong or why the appeal could be based on a version of the patent already abandoned during the opposition proceedings. For this reason alone the appeal is not admissible.

The appeal is also not admissible because it is based on an inadmissible request. The request filed with the appeal is for the patent to be maintained as granted. However, that version of the patent was already abandoned during the opposition proceedings when the appellant filed a main request which was limited compared to the patent as granted. The fact that the appellant later in the opposition proceedings filed an auxiliary request to maintain the patent as granted does not mean that such a request was admissible. The opposition division correctly refused during the oral proceedings to allow the

appellant to make the maintenance of the patent as granted its main request. Moreover, the opposition division had explained that the patent as granted had serious deficiencies so that it would be an abuse of the procedure to allow the appellant to return to the patent as granted as a request. This view is supported in particular by decisions T 331/89 (not published in OJ EPO) and T 528/93 (not published in OJ EPO).

(ii) The patent as granted does not comply with Article 123(2) EPC.

With respect to claim 1 for the Contracting States ES and DK the claim includes the feature that the volumetric flow of the vapour recovery means is controlled by the control means such that the vapour recovery means has a desired volumetric flow. This feature was not disclosed in this form in the application as originally filed. The feature allows that the volumetric flow may be chosen without reference to anything else, i.e. any desired flow. In the application as originally filed there were two embodiments of the invention: one in which the flow in the vapour recovery means was the same as the flow in the delivery means; and one in which a particular flow in the vapour recovery means was attained based on a nominal value X. The disputed feature has a much broader meaning than either of these two embodiments.

(iii) With respect to claim 1 for the Contracting States FR, GB and SE the claim includes the feature that the control means controls the vapour recovery

means in response to the electrical signal to cause the rate at which vapour is recovered by the vapour recovery means to be substantially equal to the rate at which it is expected that vapour will be emanating from the tank thereby enabling substantially all the vapour to be recovered. This feature was not disclosed in this form in the application as originally filed. The parts of the application as originally filed which have been referred to by the appellant do not support the amendment.

(iv) With respect to claim 1 for the Contracting State DE the claim includes the feature that there are means for deriving from the first electrical signal a third electrical signal indicative of the volumetric flow of the vapour recovery means under given conditions. There is no disclosure in the application as originally filed that the third signal is derived from the first electrical signal. The third electrical signal corresponds to the signal X in the second embodiment which is not disclosed to be derived from the first electrical signal which is derived from the fuel delivery means.

VIII. Respondent II made no substantive submission.

Reasons for the Decision

1. *Admissibility of the appeal (Article 108 EPC 1973)*

1.1 Respondent I presented a two-pronged attack on the admissibility of the appeal. For the first part it contended that the appellant did not explain why the contested decision was wrong and why it was allowable to revert back to a form of claim which had been effectively withdrawn during the opposition proceedings, i.e. the patent as granted. For the second part the appeal was not admissible since it was based on a request corresponding to a form of the patent which had already been abandoned during the opposition proceedings. In the following these two attacks will be considered separately.

1.2 The opposition division in its decision reasoning explained why the patent as amended in accordance with the main and first auxiliary requests of the appellant did not meet the requirements of the EPC in that the amendments made during the opposition proceedings to the claims of these requests did not conform to Article 123(2) EPC.

The appeal grounds comprise a request that the claims as granted should be maintained. The appellant pointed out that the opposition division had considered during the written part of the opposition proceedings that these claims complied with Article 123(2) EPC. Comments were also made by the opposition division with respect to Articles 100(a) and (b) EPC though without any detail. A technical explanation of the content of the patent description was also given.

When faced with a decision by an opposition division that the amendments made during the opposition proceedings were not allowable under Article 123(2) EPC an appellant has three choices: it can disagree with the finding of the opposition division and argue why the finding was wrong; it can accept that the finding was correct and file further amendments to overcome the finding; or it can accept that the finding was correct and withdraw the amendments made during the opposition proceedings and revert to the patent as granted. The appellant in the present case chose the latter course. Since the appellant accepted, or at least did not want to contest, the finding of the opposition division it had no need to challenge the merits of the decision. It was also not necessary for the appellant to explain why the amendments overcome the decision grounds since as explained above the decision was based on the amendments made to the patent as granted so that it is self-evident that the withdrawal of those amendments overcomes the grounds for the decision without requiring any further explanation. The argument of respondent I that the appellant should have explained why it was entitled to revert to the claims as granted as a basis for its appeal presupposes that the appellant actually recognised that this might not be allowable. Since the Board has reached the conclusion (see below) that this is allowable it would be unreasonable for the appellant to have been expected to deal with this point.

The Board notes that the lack of a need for explanation is based on the specific situation of the present case wherein - unusually - the offered amendments self-evidently overcome the grounds for the decision.

1.3 Respondent I further argued against the admittance of the main request on the basis that the proprietor had abandoned the subject-matter of this request during the opposition proceedings.

With letter of 17 September 2002 the proprietor had filed a "primary request" which included amendments to the claims of the patent as granted as well as eight auxiliary requests. With letter of 7 May 2003 the opponent raised grounds under Article 84 EPC and Article 123(2) EPC against some of the amendments made to the claims of the primary request. With letter of 22 March 2004 the proprietor filed a new primary request and a first auxiliary request, the latter being directed to the patent as granted. Oral proceedings before the opposition division took place about a year after receipt of this letter.

At the start of the oral proceedings before the opposition division the proprietor requested to change the order of its main and first auxiliary requests so as to make maintenance of the patent as granted the main request. This request for a change in the order of the requests was refused by the opposition division as late filed. After refusal of the main request the proprietor was told by the opposition division that it was prepared to consider at least one auxiliary request which implied that it might consider only one request. The proprietor thereupon filed an auxiliary request which involved further amended claims. This auxiliary request was not allowed in view of Article 123(2) EPC. The proprietor thereupon requested maintenance of the patent as granted

as a second auxiliary request. The opposition division decided not to admit this request.

From the above facts the Board concludes that for approximately eight years of the opposition proceedings, which lasted about nine and a half years, the proprietor maintained a request to the patent as granted and that it attempted to have this request considered by the opposition division during the oral proceedings. The Board does not accept the argument of respondent I that the appellant abandoned permanently this request when it filed a set of requests which did not include this request. It is clear that during opposition proceedings when a request is filed with amended claims there is the possibility that the amendments to these claims do not comply with Article 123(2) EPC. The proprietor must have the opportunity to overcome such an objection, whereby a return to the patent as granted always overcomes this objection.

If subject-matter was expressly abandoned then a question could arise as to whether a return to such subject-matter is possible. This question does not arise in the present case since there has been no indication of any abandonment of subject-matter. The Board does not agree with the thesis of respondent I that filing a limited main request automatically excludes returning during the opposition proceedings to a broader request.

The Board can see no abuse of procedure by the appellant in introducing the request with its appeal since it had attempted without success to have the request considered by the opposition division. In this respect the efforts of the appellant have been hampered by the opposition

division indicating that that it would consider "at least one auxiliary request" (see point 5 or the minutes), i.e. with an implication that it might be more than one. However, when the appellant wished to have the patent as granted considered as a second auxiliary request this request was refused by the opposition division. It is clear therefore that there has been no abuse of the procedure by the appellant.

Respondent I drew the Board's attention in particular to T 331/89 (*supra*) and T 528/93 (*supra*). T 331/89 (*supra*) deals with a situation in an appeal proceedings where a proprietor during the appeal proceedings filed main requests which were narrower than the patent as granted. The deciding board citing T 123/85 (OJ EPO 1989, 336) saw no reason why a proprietor should not return to an earlier broader version of the claims including the patent as granted during the proceedings (see point 3.1 of the decision grounds). The deciding board saw, however, a procedural abuse when the request was filed as late as the oral proceedings and from its content was not immediately allowable (see point 3.2 of the decision grounds). This decision does not therefore support the argument of respondent I since in the present case the request in question was filed at the earliest possible occasion in the appeal procedure, namely with the appeal grounds. T 528/93 (*supra*) deals with the case of a proprietor as respondent after the patent had been maintained in amended form who attempted to broaden an independent claim 9 during the subsequent appeal proceedings. Since that case dealt with the proprietor as respondent it is clearly not relevant.

1.3 The Board therefore decided that the appeal is admissible.

2. *Article 100(c) EPC (ES, DK)*

2.1 There are a number of matters arising in this respect concerning claim 1 of the claims granted for these states. However, it is sufficient for the present decision to concentrate on the feature of the claim whereby "the volumetric flow of the vapour recovery means being controlled by the control means such that the vapour recovery means has a **desired volumetric flow**" (emphasis added by the Board). This feature was not contained in claim 1 as originally filed which instead specified: "making the volumetric flow of the vapour recovery means substantially proportional to the volumetric flow of the liquid delivery means".

In the application as originally filed there is a reference on page 3, lines 1 and 2 to an "electrical signal that can be applied to the vapor recovery means so as to make it have a desired volumetric flow". This reference, however, is made in the context of an explanation of the functioning of a microprocessor which forms the control means. The microprocessor determines the parameters of the signal to be sent to the recovery means, e.g. the drive pulse rate, which results in a particular volumetric flow which has been determined by the microprocessor. In this context the word "desired" means that flow rate which is determined by the microprocessor as being appropriate based on the fuel delivery rate. It is not a disclosure of an indeterminate "desired" rate.

There is a further reference on page 3, lines 10 and 11 of the application as originally filed to "so as to cause the recovery pump to have the desired volumetric flow rate". Also in this case it is the required repetition rate of the drive pulses for the motor which are being supplied so as to cause the pump to operate at the rate that has been determined by the microprocessor. This reference is mirrored in claims 4 and 6 as originally filed which specify that the control means are "responsive to said indicator pulses to provide drive pulses at a desired repetition rate to a motor of the vapour recovery means". The desired repetition rate is clearly the rate that is determined by the control means to ensure that the motor turns at a predetermined speed.

In none of the above cited references in the application as originally filed is there any indication that there is simply "a desired volumetric flow" which may be chosen without reference to any other variable.

The Board concludes therefore that this feature of claim 1 of the set of claims for the above mentioned Contracting States has no basis in the application as filed so that its inclusion in the patent as granted does not conform with Article 123(2) EPC.

3. *Article 100(c) EPC (FR, GB and SE)*

3.1 Claim 1 of the set of claims as granted for the above Contracting States contains the feature that "the control means (34) controls the vapour recovery means (36, 44) in response to the electrical signal to cause the rate at which vapour is recovered by the vapour

recovery means to be substantially equal to **the rate at which it is expected that vapour will be emanating** from the tank thereby enabling substantially all the vapour to be recovered" (emphasis added by the Board).

The appellant referred in particular to page 3, lines 21 to 25 and page 7, last line to page 8, line 20 in the description as originally filed as supporting the amendment. In this respect the appellant also indicated that the meaning of this feature was essentially the same as the meaning of the feature of claim 1 for the Contracting States ES and DK which is discussed above, i.e. the feature specifying "a desired volumetric flow" which has already been considered by the Board to be an unallowable amendment.

In the passage on page 3, lines 21 to 25 reference is made to comparing the volumetric flow rate with the "normally expected" rate and to making an adjustment. No indication is given as to what constitutes this "normally expected" rate nor how in system control terms, this would be established in respect of the vapour emanating from the tank. According to the disputed feature "vapour is recovered by the vapour recovery means to be substantially equal to the rate at which it is expected that vapour will be emanating from the tank". This definition cannot be considered to be the same as the "normally expected" rate since the "normally expected" rate lacks any form of definition. Therefore this passage cannot provide a basis for the disputed feature.

The passage on pages 7 and 8 merely explains how the vapour recovery volumetric rate may be set equal to the

fluid delivery volumetric rate, which clearly cannot provide a basis for the disputed feature.

The Board concludes therefore that this feature of claim 1 of the set of claims for the above mentioned Contracting States has no basis in the application as filed so that its inclusion in the patent as granted does not conform with Article 123(2) EPC.

4. *Article 100(c) EPC (DE)*

4.1 Claim 1 of the set of claims as granted for the above mentioned Contracting State includes the feature that there are "means for **deriving from the first electrical signal** a third electrical signal indicative of the volumetric flow of the vapour recovery means under given conditions" (emphasis added by the Board). This feature is based on claim 9 as originally filed wherein there is reference to "means for **providing** a third electrical signal indicative of the volumetric flow of the vapour recovery means under given conditions" (emphasis added by the Board). This third electrical signal is then in accordance with the claim compared to a second electrical signal indicative of the volumetric flow of vapour in the vapour recovery means, i.e. the actual flow is compared with the flow under given conditions. It must therefore be considered whether there is a basis elsewhere in the application as filed for the amendment.

According to the paragraph bridging pages 3 and 4 of the description as originally filed there is a signal for the hydraulic pressure at the inlet side of the pump of the vapour recovery means. This pressure under "average conditions" will have a "desired nominal value". It is

then explained how pressure deviations from this nominal value can be corrected by varying the flow rate in the recovery means and that this is done by the recovery means responding to signals from the microprocessor which forms the control means.

This part of the description is reflected in the description of the embodiments where it is explained on page 9, lines 9 to 19 that "with any given design" the pressure P at the inlet of the vapour recovery pump will have a nominal value X. Then in the passage bridging pages 9 and 10 it is explained that if the pressure P is less than X the recovery pump is running too fast and must be slowed down. In the following two paragraphs it is explained that if the pressure P is more than X then the recovery pump is running too slow and must be speeded up.

In the above parts of the description it is clear that the value X is the third electrical signal that is referred to in claim 9 as originally filed wherein it is specified that the signal is provided. The application as originally filed is silent has to how this value is obtained. The value P corresponds to the second electrical signal.

The disclosure in the application as filed can hence be summarised as there is a third electrical signal provided which under average conditions has a desired nominal value with any given design. This disclosure not only does not support the wording of claim 1 as granted that the third electrical signal is derived from the first electrical signal, but actually contradicts it since the first electrical signal depends upon the rate

of delivering liquid which is a variable having no nominal value.

The appellant suggested that the signal which is sent by the control means, i.e. microprocessor, to the recovery pump is the third electrical signal. The Board cannot agree with the appellant in this respect. Claim 9 as originally filed clearly states that after a comparison of the second and third electrical signals the control means increases or decreases the volumetric flow of the vapour recovery means. The control means in practice will do this by producing a fourth electrical signal which is sent the vapour recovery means which in the case of the embodiment would be a change in the rate at which pulses are sent to the pump. The suggestion of the appellant that this fourth electrical signal is in fact the third signal is clearly contradictory to claim 9 as originally filed which indicates that the third electrical signal partakes in the comparison used to produce the signal to be sent to the vapour recovery means.

In any case, even following the reasoning of the appellant, that signal is not "indicative of the volumetric flow of the vapour recovery means under given conditions" as presently claimed. The amount of deviation of P from the value X does not enter into the control system.

The Board concludes therefore that this feature of claim 1 of the set of claims for the above mentioned Contracting State has no basis in the application as filed so that its inclusion in the patent as granted does not conform with Article 123(2) EPC.

Order

For these reasons it is decided that:

1. The appeal is admissible.

2. The appeal is dismissed.

The Registrar: The Chairman:

G. Nachtigall H. Meinders