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**Datasheet for the decision  
of 22 October 2014**

**Case Number:** T 0560/11 - 3.2.04

**Application Number:** 03257834.6

**Publication Number:** 1541860

**IPC:** F02M47/02

**Language of the proceedings:** EN

**Title of invention:**

Fuel injector with control valve to control the pressure in the needle control chamber

**Patent Proprietor:**

Delphi Technologies, Inc.

**Opponent:**

Robert Bosch GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2)  
RPBA Art. 12(4), 13(1)

**Keyword:**

reformatio in peius  
Amendments - added subject-matter (yes) -  
intermediate generalisation  
Referral to the Enlarged Board of Appeal - (no)  
Remittal to the department of first instance - (yes)

**Decisions cited:**

G 0001/99, G 0004/93, T 1033/08, T 1843/09

**Catchword:**



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Case Number: T 0560/11 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 22 October 2014**

**Appellant:** Robert Bosch GmbH  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
7 January 2011 concerning maintenance of the  
European Patent No. 1541860 in amended form.**

**Composition of the Board:**

**Chairman** A. de Vries  
**Members:** S. Oechsner de Coninck  
C. Heath

## Summary of Facts and Submissions

I. On 7 March 2011 the Appellant (Opponent) lodged an appeal against the interlocutory decision of the Opposition Division posted 7 January 2011, concerning the maintenance of European patent No. EP-B-1 541 860 in amended form. The appeal fee was paid on the same date and the statement of grounds of appeal was filed on 12 May 2011.

II. Opposition was filed against the patent as a whole and based on Article 100(a) in combination with Articles 52(1) and 54 EPC for lack of novelty, Article 100(a) in combination with Articles 52(1) and 56 EPC for lack of inventive step.

The Opposition Division held that the grounds for opposition mentioned in Article 100 EPC did not prejudice the maintenance of the patent as amended in accordance with the new main request and having regard to the following documents:

D5': WO 01/088365 A1

D8: DE 10131618 A1

D11: DE 10065220 A1

III. In the appeal proceedings the Board considered the following further documents:

D14: DE 10055714 A1

D15: EP 661442 A1

Following a communication in which the Board of Appeal informed the parties of its preliminary opinion of the procedural issues in the case, oral proceedings were held on 22 October 2014.

IV. The Appellant requests that the decision under appeal be set aside and the patent be revoked in its entirety. He also requests that the case be remitted to the department of first instance for further prosecution based on D14 and D15.

The Respondent (Proprietor) requests that the decision under appeal be set aside and that the patent be maintained on the basis of a new main request or alternatively on the basis of the auxiliary requests 1 to 9 all filed with letter of 3 October 2014. He also requests that the case be remitted to the department of first instance for further prosecution based on D14 and D15. In connection with auxiliary requests 5 to 9 he further requests that a question concerning the principle of prohibition of reformatio in peius be referred to the Enlarged Board.

V. The wording of claim 1 of the requests is as follows:

*Main request*

"A fuel injector (10) for use in a fuel system for an internal combustion engine, the fuel injector comprising:

a supply passage (24) for high pressure fuel,  
an injection nozzle (25) including a valve needle (26) which is engageable with a valve needle seating (28) to control fuel delivery from the injector (10), a surface associated with the valve needle being exposed to fuel pressure within a control chamber (42),  
a first restricted flow path (44, 44a) providing flow from the supply passage (24) into the control chamber (42),

a control valve (48) for controlling fuel pressure within the control chamber(42),  
a supplementary flow means (47, 46) providing flow from the supply passage (24) into the control chamber (42) under the control of the control valve (48), so as to allow high pressure fuel to flow between the supply passage (24) and the control chamber (42) when the control valve (28) is moved to prevent communication between the control chamber (42) and a low pressure drain (18), wherein the supplementary flow means (47, 46) includes a second restricted flow path (46, 46a), the fuel injector further comprising means (26a, 58) for breaking communication between the control chamber (42) and the low pressure drain through the second restricted flow path (46, 46a) once the valve needle (26) has moved a predetermined distance away from the valve needle seating (28), thereby to limit the loss of pressurised fuel between the control chamber (42) and the low pressure drain (18) during injection, wherein the control valve is operable to control whether fuel flows through the second restricted flow path (46, 46a) either (i) between the control chamber (42) and the low pressure drain (18) or (ii) between the supply passage (24) and the control chamber (42), and wherein the control valve (48) has a control valve member (52) defining first and second seating surfaces (68, 72) for engagement with a respective one of first and second valve seats (70, 74), the control valve (48) having a first operating position in which the supply passage (24) provides flow into the control chamber (42) through the supplementary flow means (47, 46), and in which first operating position flow from the control chamber (42) into the low pressure drain (18) through the second restricted flow path (46, 46a) is prevented, and wherein the control valve member is pressure balanced.

*Auxiliary request 1* adds to claim 1 of the main request but adds the following final feature: "and wherein the control valve (48) includes an electromagnetic actuator and the control valve member (52) is pressure balanced."

*Auxiliary request 2* adds to claim 1 of the main request the following final feature: "and wherein the control valve member (52) comprises an upper guide region (52a) and a lower region (52c), the diameters of the upper guide region (52a) and the lower region (52c) being substantially equal."

*Auxiliary request 3* adds to claim 1 of the main request the following final feature : "and wherein the first seating surface (68) is of frusto-conical form and the second seating surface (72) is defined by an end surface of the control valve member (52)"

*Auxiliary request 4* adds to claim 1 of auxiliary request 3 the feature added to claim 1 of the 2nd auxiliary request.

*Auxiliary request 5*

"1. A fuel injector (10) for use in a fuel system for an internal combustion engine, the fuel injector comprising:  
a supply passage (24) for high pressure fuel,  
an injection nozzle (25) including a valve needle (26) which is engageable with a valve needle seating (28) to control fuel delivery from the injector (10), a surface associated with the valve needle being exposed to fuel pressure within a control chamber (42),

a first restricted flow path (44, 44a) providing flow from the supply passage (24) into the control chamber (42),  
a control valve (48) for controlling fuel pressure within the control chamber (42), the control valve (28) having a control valve member (52), and  
a supplementary flow means (47, 46) providing flow from the supply passage (24) into the control chamber (42) under the control of the control valve (48), so as to allow high pressure fuel to flow between the supply passage (24) and the control chamber (42) when the control valve (48) is moved to prevent communication between the control chamber (42) and a low pressure drain (18),  
characterised in that the control valve member (52) is pressure balanced."

Claim 1 of the *auxiliary request 6* is as in auxiliary request 5 but with the feature of the control valve amended to read (*italics indicate added text*): "a control valve (48) for controlling the fuel pressure within the control chamber (42) , the control valve *including an electromagnetic actuator and* having a control valve member (52), and".

*Auxiliary request 7*

"1. A fuel injector (10) for use in a fuel system for an internal combustion engine, the fuel injector comprising:  
a supply passage (24) for high pressure fuel,  
an injection nozzle (25) including a valve needle (26) which is engageable with a valve needle seating (28) to control fuel delivery from the injector (10), a surface associated with the valve needle being exposed to fuel pressure within a control chamber (42),



a first restricted flow path (44, 44a) providing flow from the supply passage (24) into the control chamber (42),

a control valve (48) for controlling fuel pressure within the control chamber (42), and

a supplementary flow means (47, 46) providing flow from the supply passage (24) into the control chamber (42) under the control of the control valve (48), so as to allow high pressure fuel to flow between the supply passage (24) and the control chamber (42) when the control valve (48) is moved to prevent communication between the control chamber (42) and a low pressure drain (18),

wherein the supplementary flow means (47, 46) includes a second restricted flow path (46, 46a),

wherein the control valve is operable to control whether fuel flows through the second restricted flow path (46, 46a) either (i) between the control chamber (42) and the low pressure drain (18) or (ii) between the supply passage (24) and the control chamber (42),

wherein the control valve (48) has a control valve member (52) defining first and second seating surfaces (68, 72) for engagement with a respective one of first and second valve seats (70, 74), the control valve (48) having a first operating position in which the supply passage (24) provides flow into the control chamber (42) through the supplementary flow means (47, 46), and in which first operating position flow from the control chamber (42) into the low pressure drain (18) through the second restricted flow path (46, 46a) is prevented, and wherein the control valve member (52) comprises an upper guide region (52a) and a lower region (52c), the diameters of the upper guide region (52a) and the lower region (52c) being substantially equal."

*Auxiliary requests 8 and 9* add to claim 1 of auxiliary request 7 the same final feature added to claim 1 of the auxiliary request 3 and 4 respectively.

VI. The Appellant's arguments are as follows:

- D14 and D15 have been filed as a reaction to the first instance decision finding that D5' and D8 do not give a direct disclosure of breaking communication between the control chamber and the drain. D15 is the only document to expressly address this feature so that it is therefore relevant for assessing inventive step.
- The main and auxiliary requests 1 to 4 filed with the letter of 3 October 2014 are belated and contain several unexpected feature combinations. The auxiliary request 5 to 9 are not only belated but also violate the principle of *reformatio in peius* established in various decisions. This principle of *reformatio in peius* should apply to any proceedings subsequent to a remittal, see decisions **G 4/93** and **T 1843/09**.
- Claim 1 of the main request and auxiliary request 1 is unallowably amended under Article 123(2) EPC in that the feature whereby "the control valve member is pressure balanced" has been added out of its original context, which included at least a specific configuration of upper and lower guide regions and bores in the valve member as well as a specific position of the valve member wherein communication between the supply passage and the low pressure drain is prevented.

This also applies to claim 1 of the auxiliary requests 2 and 4 as the features whereby the control valve member (52) comprises an upper guide region (52a) and a lower region (52c) and of the diameters of the upper guide region (52a) and the lower region (52c) being

substantially equal have also been taken in isolation from the specific embodiment of fig 4.

VII. The Respondent's arguments can be summarized as follows:

- Whereas it is acknowledged that D14 is very relevant, D15 is not more relevant than any of the already present documents D5' or D8. In particular D15 does not disclose a supplementary flow means nor does it disclose a three-way control valve as requested by claim 1.

- Auxiliary requests 5 - 9, which correspond to the main request and auxiliary requests 1 - 4 filed in response to the grounds of appeal, may not be in accordance with the principle of reformatio in peius. However, should the case be remitted to the first instance for further prosecution based on the newly filed document D14, this principle should not apply to the subsequent proceedings before the opposition division as a matter of equity and in line with decision **G 1/99**. It is requested to refer the following corresponding questions to the Enlarged Board of Appeal:

"1. In circumstances in which a highly relevant prior art document is admitted for the first time into appeal proceedings (i.e. late filed) and the opponent is the sole appellant, and in the event that the case has to be remitted to the opposition division because of the new factual framework of the case, is it equitable to the patent proprietor that the principle of prohibition of reformatio in peius applies to the subsequent opposition proceedings even if the opponent as the sole appellant could be, on the face of it, put in worse position than if they had not appealed?

2. Is it relevant that the patent proprietor could not have appealed to the opposition division decision because the main request was allowed?"

- Addressing the issue of unallowable amendments, attention is drawn to passages on pages 16 to 19 of the originally filed description, identical to the published application paragraphs [0051],[0055] and [0057]. In particular the last sentence of paragraph [0051] directly indicates the important effect of pressure balancing and therefore for the fact that "the control valve member is pressure balanced" as in claim 1 of the main request and auxiliary request 1. Likewise paragraphs [0055] and [0057] clearly support the substantially equal diameters of the upper and lower guide regions introduced in claim 1 of the auxiliary requests 2 or 4. These equal diameters represent another expression of the importance of the pressure balanced nature of the control valve member.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Admissibility of the Documents D14 and D15
  - 2.1 The admission into the proceedings of D14 (under Art 114(2) EPC and Art 12(4) RPBA) is not disputed. As also acknowledged by the proprietor, D14 is found to be very relevant with respect to claim 1 maintained in the impugned decision, and the proprietor has indeed amended claims in all requests to take into account the disclosure of D14.
  - 2.2 The admissibility of D15 in the proceedings under Art 114(2) EPC and Art 12(4) RPBA is however challenged by

the respondent because it would not be more relevant than any of the documents D5' or D8 already on file. In particular D15 would not disclose many of the features defined in claim 1.

Contrary to the respondent's opinion the board is of the view that D15 indeed contains direct and unambiguous disclosure of an injector needle closing a flowpath from the metering valve to the tank. This is readily apparent from figure 2 and corresponding passages in the description, column 3, lines 23 to 40, describing how appendix 74 of control rod 8 is arrested against shoulder 73 to cut off communication between conduits 62, 63. Such an explicit teaching is not present either in D5' or in D8 and D15 on the face of it therefore appears more relevant than those two documents when considering the question of inventive step in relation to that feature.

The board does not agree with the submission of the respondent that because several other features of claim 1 do not appear to be disclosed in D15 (though present in D5' and D8) this would render this document less or not prima facie relevant. Prima facie relevance is determined in relation to the question to be decided, and does not apply generally only to the issue of novelty. In this particular case where inventive step is at issue, this is the framework in which the prima facie relevance is to be determined.

- 2.3 Using the discretion afforded it under Article 12(4) RPBA in conjunction with Article 114(2) EPC the Board therefore decided to admit both documents D14 and D15 into the proceedings.

3. Admissibility of the requests:

3.1 The amended claim 1 on which the interlocutory decision of the opposition division is based includes the features of claim 1 as intended for grant (including all amendments proposed in the communication according to Rule 51(4) EPC 1973 and agreed by the then applicant, but due to a publication error not appearing in the English version of claim 1 in the published patent specification). The features derived from the granted claims 2, 4 and 9 are also included in the amended claim 1 as maintained. This subject-matter is further refined in the main request and auxiliary requests 1 to 4.

3.2 Admissibility of auxiliary requests 1 - 4

The main and auxiliary requests 1 to 4 were filed with the letter of 3 October 2014, after oral proceedings before the Board had been arranged, and are based on an amended version of the previous auxiliary requests 2 to 5 filed in response to the grounds of appeal. These previous auxiliary requests 2 to 5 were filed as a reaction to the new relevant evidence (D14 and D15) that was presented for the first time at appeal stage. The pending auxiliary requests 1 to 4 furthermore take into account the preliminary opinion given by the board that the previous requests would contravene the prohibition of *reformatio in peius*. Indeed these requests not only include the originally proposed amendments of the previous auxiliary requests 2 to 5 but also incorporate all the features of the independent claim 1 as found allowable by the opposition division. They therefore overcome the prohibition of *reformatio in peius*.

For this reason the Board believes that these amendments to the previous requests raise no issues that either the board or the other party to the proceedings cannot reasonably be considered to deal with without adjournment, Article 13(3) RPBA. Therefore, the Board decided to admit the main request and auxiliary requests 1 to 4 into the proceedings.

The board cannot agree with the appellant's opinion that these requests are belated and include unexpected combination of features filed shortly before oral proceedings in the sense of Art 13(1) RPBA. Although filed after the time limit set by the board, the amended claims only restore features already present during opposition proceedings and do not contain any further feature not present in the reply to the grounds of appeal, the appellant cannot therefore have been taken by surprise by any of these amendments although being filed after expiry of the one month period before oral proceedings.

### 3.3 Admissibility of auxiliary requests 5 - 9

3.3.1 Auxiliary requests 5 - 9, which correspond to the main request and auxiliary requests 1 - 4 filed in response to the grounds of appeal, include an amended claim 1 that lacks at least the features of the granted claim 9 that were included in claim 1 as held allowable by the opposition division. Therefore, admissibility of these requests is questionable in regard of the fact that they would go against the principle of *reformatio in peius*. That they go against this principle is undisputed between the parties. In other words, allowing one of these requests would put the opponent and sole appellant in a position worse than the one it would be in without the appeal.

3.3.2 The principle of *reformatio in peius* does not derive from an application of general procedural principles under Art. 125 EPC, but from the special nature of appeal proceedings before the EPO, in which the extent of the appeal is determined by the appellant's initial request and a non-appealing party is restricted to defending the result obtained in first instance, see G9/92 (OJ 1994, 875), reasons 1 to 13. In principle a non-appealing party is considered to be satisfied with the results obtained in opposition and may not turn around in the appeal stage and make a request beyond what was originally deemed satisfactory. In the case at issue, the patent proprietor prior to oral proceedings before the Opposition division filed a Main Request that the patent be upheld in amended form, which was then found allowable by the opposition division. The patent proprietor was thus not adversely affected by this decision. This is a scenario comparable to the one underlying decision **G 1/99** of 2 April 2001 (OJ 2001, 381), where the Enlarged Board pointed out the following:

"9....in the present referred case the patent proprietor was not entitled to file an appeal because the claims maintained by the Opposition Division in its interlocutory decision correspond to the main and only request of the patent proprietor. Thus, the patent proprietor was not adversely affected by the decision and, therefore, was not entitled to file an appeal...by requesting in a main and only request the maintenance of the patent in a restricted form, the patent proprietor also indicated that it would not contest the maintenance of the patent as examined and found allowable by the Opposition Division. In such a situation, the patent proprietor is aware that, if the



Opposition Division allows its main request, it will lose the right to file an appeal because that decision will not adversely affect it. As a consequence of the fact that the patent proprietor has indicated that it will not contest the maintenance of the patent in the version accepted by the Opposition Division, it was decided in the first sentence of paragraph 2 of the order of G 4/93, that the patent proprietor is primarily restricted during appeal proceedings to defending the patent as amended in accordance with the interlocutory decision. This means that, if the version of the patent held allowable by the Opposition Division is also held allowable by the Board, then, because the patent proprietor intentionally accepted this version either by making it the basis of its main request before the Opposition Division or by not filing an appeal, the proprietor/respondent may not in principle request another version of the patent during the appeal proceedings, unless this version is a restriction of the maintained version...."

The Board then went on to consider whether the principle of *reformatio in peius* should not apply under certain circumstances:

"12. It results from the case law of the Enlarged Board of Appeal ..., that *reformatio in peius* should be prohibited because it is the principal task of the Boards of Appeal to review the decision under appeal, not to re-examine the case from scratch. This is not in contradiction with the fact that, with respect to the allowability of amendments made during the opposition procedure, the appeal proceedings are not restricted to the legal and factual background of the proceedings before the Opposition Division. Indeed, objections raised in the first instance may be supported by new

facts and new objections may be raised in appeal proceedings with the consequence that the basis on which limitations have been made may still change and it would not be equitable to allow the opponent/appellant or the Board to present new attacks and to deprive the proprietor/respondent of a means of defence. As stated in G 4/93, the proprietor/respondent is primarily limited to defending the version of the patent held allowable by the Opposition Division. However, in particular if the patent cannot be maintained for reasons which were not raised at the first instance, the non-appealing proprietor deserves protection for reasons of equity."

- 3.3.3 It is particularly the last part of this quotation on which the respondent bases its arguments. The reasons of equity mentioned in the decision were further elaborated in two subsequent cases. In the first decision **T 1033/08** of 20 July 2011, point 3 of the reasons states the following:

"G 1/99 only deals with the deletion of a limiting feature added during the opposition procedure. The exception to the principle of prohibition of *reformatio in peius* applies to this situation only (see point 2.3 of the Reasons).

In fact, in order to allow such a deletion which puts the opponent and sole appellant in a worse situation than if he had not appealed, the following conditions must be fulfilled:

A limiting feature introduced during the opposition procedure has to be deleted. The necessity for its deletion must be caused by the appeal. This means that the deletion is necessary and appropriate because it is

related to a ground of opposition and caused by new facts, evidence or arguments put forward by the appellant, or because of a different evaluation of the situation by the board of appeal. Without the deletion, the patent would have to be revoked. It is not possible to overcome the objection by introducing new features which limit the scope of the patent as maintained.

Only if these preconditions are fulfilled, an objection may be overcome by introducing new features which extend the scope of the patent as maintained, but within the limits of Article 123(3) EPC according to the second option of G 1/99.

...

The respondent's argument that the filing of fresh prior art (documents E7 and E8) by the sole appellant at the appeal stage should permit the respondent to retract amendments made by him before the Opposition Division is not accepted by the Board. It is true that G 1/99 (point 12 of the Reasons) states that the non-appealing proprietor deserves protection for reasons of equity when new facts have been introduced in appeal proceedings, and that the patent can exceptionally be amended in a way that offends the principle of prohibition of reformatio in peius. However, this is possible only if a limitation proves impossible (point 15 of the Reasons). In the present case, the appellant's objection based on the above-mentioned new documents, which was raised against the version maintained by the Opposition Division, does not require any limiting amendment of the claims. To deal with new prior art documents, the respondent either has to distinguish from it by argument or by making further restrictions to the claims upheld by the Opposition Division. The respondent may not in principle request another version of the patent during appeal

proceedings, unless this version is a restriction of the maintained version (see G 1/99, Reasons 9.1)."

The second decision, **T 1843/09** of 6 June 2012, deals with a case where, after remittal from a first appeal by the opponent as sole appellant and in which the Board admitted two late filed documents D19 and D23 concerning novelty/inventive step, the opposition division allowed requests that were broader than the claims allowed in the decision that was the subject of the first appeal. The opponent also appealed this second decision as sole appellant arguing that the claim request violated the principle of reformatio in peius. The patent proprietor (in the second appeal) argued the following: "When the decision under appeal was taken, the proceedings did not include D19 and it was on that basis that the proprietor chose not to appeal. He could not be expected to foretell the filing of D23 and the subsequent shift in the substance of the opposition. As in the referring case of G 1/99, the proprietor in good faith defended its patent at first instance and did not appeal in view of the factual and legal situation at the time of the decision of the opposition division. There was no abuse of the proceedings on his side." This gave rise to the Board deciding **T 1843/09** to further clarify the exceptional circumstances in which according to decision **G 1/99** the principle of equity might prevail over the principle of the prohibition of reformatio in peius.

"2.4.4 ...the Enlarged Board made it clear that exceptions from the PRP are to be allowed as a matter of equity in order to protect the non-appealing proprietor against procedural discrimination in circumstances where the PRP would impair the legitimate defence of its patent. That means that exceptions from

the PRP are not limited to the situation specifically dealt with in G 1/99, ie an error of judgment by the opposition division concerning an amendment introduced into the version of the patent as maintained by the decision under appeal. Rather, the equity approach as taken by the Enlarged Board of Appeal covers, beyond an error of judgment by the opposition division, any change of the factual and/or legal basis on which limitations have been made by the proprietor prior to the appeal by the opponent as the sole appellant, provided the proprietor would be prevented by the PRP from adequately defending its patent against new facts and objections introduced into the proceedings at the appeal stage.

2.4.5 Under the circumstances prevailing in the opposition proceedings before the opposition division took its first interlocutory decision on 11 March 2003, it was a perfectly appropriate and legitimate line of defence for the proprietor to file a main request with claims containing the priority-destroying feature (f) in order to cope - successfully, as the opposition division held - with D15, a document which was in the proceedings already, and to ignore D19. As long as this late filed document, even if it represented state of the art within the meaning of Article 54(2) EPC for claims which did not enjoy the (earliest) priority, was not admitted into the proceedings, it could not have any bearing on the decision on the opposition against the patent in dispute. By the same token, in the event that D19 were to be admitted into the proceeding, the proprietor would be entitled to file an auxiliary request from whose claims feature (f) had been deleted so that D19 - a highly relevant document, as it turned out later, when taking into account the corroborating document D23 filed by the opponent in the (first)

appeal proceedings - could not be cited against such a version of the patent in dispute. The filing of an auxiliary request with claims necessarily broader in scope than those according to the main request did not, in the given circumstances, constitute an abuse of the proceedings by the proprietor, in particular not a circumvention of the PRP. It is immaterial in this context that D19 was filed only shortly before the (first) oral proceedings before the opposition division, a fact relied on by the proprietor - point XV(a), above - and as to whether the latter was better placed to judge the relevance of D19, since it was the proprietor's own document, as maintained by the opponent - point XIV(a), above.

2.4.6 Where the filing of broader claims as an auxiliary request would have been a legitimate means of defence in proceedings before the opposition division as department of first instance, it would be inequitable to deprive the proprietor of that means of defence by applying the PRP if in later appeal proceedings the conditions for filing the broader auxiliary/alternative request are eventually met - in the present case following the admission of the highly relevant D19 into the proceedings. Otherwise, the proprietor would be discriminated against and the opponent would benefit from the PRP beyond its purpose in the - certainly rare, but, as the present case demonstrates, not impossible - situation where a limitation of the claims is not the appropriate response to new facts and new objections (as in the present case "owing to the D19/D23 interaction in conjunction with the complex priority situation", as the proprietor put it - point XV (a), above). It is also to be borne in mind that the principle of ne ultra petita as developed in G 4/93 and relied on in G 1/99

is exclusively a matter of the scope of protection sought or (implicitly) no longer sought by the proprietor. This cannot reasonably be the sole relevant criteria for assuming an implied waiver also of the priority right by the non-appealing proprietor where the filing of broader claims was both intended and appropriate to keep the (earliest) priority right in the case of the later admission of a specific intermediate document into the proceedings.

2.4.7 It is true that in the case at hand the opponent's situation was worsened by the deletion of the fatal feature (f), and that it was the proprietor's choice to maintain claims containing the priority-destroying feature (f) as its main request. But arguing, as the opponent did (point XIV, above), that the proprietor is bound by its own decision at that time because it does not deserve protection from itself, is begging the question. The decisive question is whether or not the proprietor deserves protection, as a matter of equity, in view of a later change of the factual basis of the decision on the opposition (a change which in the present case was brought by the opponent by filing the corroborating document D23 in support of its appeal against the first interlocutory decision of the opposition division).

2.4.8 On the other hand, it is not sufficient for granting an exception from the PRP that, as the proprietor argued (point XV, above), it defended its patent in good faith at first instance and did not appeal in view of the factual and legal situation at the time of the decision of the opposition division, and it could not be expected to foretell the filing of D23 and the subsequent shift in the substance of the opposition. All this was not different from the

standard situation where the sole or main request was found to be allowable and the patent can later be defended in appeal proceedings by the standard means of defence, that is by narrowing the protection sought in response to new facts or objections.

2.4.9 The present case is not of that standard type, rather the relevant circumstances were such that the deletion of the critical priority-destroying feature (f) was exceptionally justifiable while also respecting the rule that such an exception should only be construed narrowly (G 1/99, point 15 of the reasons)."

3.3.4 From the above decisions, the Board concludes that a set of claims violating the principle of *reformatio in peius* can exceptionally be admitted in circumstances where otherwise the patent proprietor would be unable to defend its patent "by the standard means of defence, that is by narrowing the protection sought in response to new facts or objections." Case law is therefore flexible enough to allow a Board to very exceptionally deviate from the principle of *reformatio in peius* in appropriate cases, namely where a particular amendment that violates that principle would be the *only* available remedy for the patentee to avoid a revocation of its patent. Or, to cite again decision **T 1843/09**: "2.4.9 Whether at all, to what extent and in what form any such exception may be granted has to be decided along these lines in each individual case with an aim to re-conciliate the adequate protection of the rights and interests of the sole appellant/opponent with the legitimate defence of the patent by the (non-appealing) proprietor."

3.3.5 The respondent further questioned whether the principle of *reformatio in peius* should be applicable at all



where the case was subsequently remitted to the first instance for further prosecution. Also this issue was dealt with in the decision **T 1843/09**, where the Board held as follows:

"2.31 The fact that the proprietor could not (for lack of adverse effect) or did not appeal against a decision of the opposition division cannot be altered later (just like the scope of protection conferred by the patent as granted). The ensuing procedural limitation on the proprietor's liberty to change by way of amendments the scope of protection sought prevails until the final settlement of the opposition case (just like the limitation pursuant to Article 123(3) EPC) and, therefore, also in any proceedings, including further appeal proceedings, subsequent to a remittal under Article 111 EPC. Otherwise the PRP would not serve its purpose, namely to avoid a situation whereby the opponent and sole appellant would be put "in a worse situation than if he had not appealed" (G 1/99, Headnote), or, in procedural terms, whereby the opponent would eventually be adversely affected by its own appeal (G 4/93, point 9 of the reasons: "The aim of an appeal is to eliminate an 'adverse effect' (Article 107, first sentence, EPC).)".

The Board concurs with this interpretation. It adds that it would also not be logical to make the application of the reformatio principle dependent upon the (discretionary) decision of the Board to decide the case on its own motion, in which case following the reasoning of the respondent the principle would apply, or to remit the case to the first instance, in which case it would not.

3.3.6 Applying the above principles to the case at issue, the Board likens the situation to the standard-type

situation as mentioned above: A document (D14) was cited only with the grounds of appeal, which was acknowledged as highly relevant by the respondent-proprietor and to which it reacted by amending the independent claim in all requests. As present auxiliary request 3 clearly indicates, the proprietor's response could very well have consisted of the "standard-type defence", that is, a further narrowing of protection. Filing claims that contravene the principle of *reformatio in peius* was thus not the only possible way of defending the patent. Moreover, document D14 did not steer the case into a completely new direction. Rather, document D14 explicitly showed characteristics that, according to the submissions of the opponent, were implicitly shown already in documents D5 and D8. Had the patent proprietor therefore wished to set up a line of defence against the possibility that on appeal the Board might share the opponent's view, it would have been altogether possible to retain the version of the patent as granted as a main request, and file the claim request as upheld by the opposition division only as an auxiliary request, with the consequence that the patent proprietor also could have appealed against the decision. Finally, given that D14 (and D15) are cited as evidence *in addition* to D5 and D8 already on file, and the arguments based on the latter must still hold, it appears wholly inappropriate and unnecessary to amend the claims by removing one or more of the features added in the main request upheld by the decision under appeal and on which that decision based its positive finding.

3.3.7 It follows from the above that the auxiliary requests 5 to 9 contravene the principle of *reformatio in peius*, and there are no cogent reasons of equity why an exception should be made to that principle in the

present case. For these reasons the Board decided not to admit auxiliary requests 5 - 9 into the proceedings.

3.3.8 Given the fact as apparent from the above that case law has given ample consideration to the principles of equity when applying the rule of *reformatio in peius*, thereby allowing to take into account the specifics of each individual case when deciding on the admissibility of a request contravening this principle, the Board sees no reason why the case should be referred to the Enlarged Board of Appeal. Nor is there a divergence in decisions on this issue, or is there a point of law of fundamental importance that needs to be clarified. The Board therefore decided to refuse the respondent's subsequent request for referral.

4. Added subject-matter

4.1 Main request and auxiliary request 1

4.1.1 In claim 1 of the main request and auxiliary request 1, the final feature: "the control valve member (52) is pressure balanced" is taken from the description, last sentence of paragraph [0051] of the published application. According to established case law (see II.E.1.2 Art 123(2) EPC, seventh edition) the introduction of isolated features from a given context (intermediate generalisation) is justified and allowable under Article 123(2) EPC only in the absence of any clearly recognisable functional or structural relationship among the features of the specific combination.

4.1.2 In the present case the quoted passage, paragraph[0051], refers to the embodiment shown in figure 3 and explains that the substantially equal

upper and lower valve members diameters as well as the upper and lower valve housing diameters achieve the result that the control valve member is pressure balanced (see the paragraph's last sentence). This passage clearly indicates that the pressure balancing is a result of a specific choice of diameters of the valve members and their housing. For the skilled person it is not immediately apparent that he can abstract the pressure balanced nature of the control valve member from the specific context of the figure 3 embodiment which includes a special arrangement of features structurally and functionally correlated, in particular the relationship between the diameters. By merely defining the control valve member to be pressure balanced, the amended claim 1 encompasses other solutions for balancing the valve member such as equal valve guide and seat diameters or even exposed valve member surfaces, where such solutions were not originally disclosed. Therefore the board comes to the conclusion that the added feature "the valve member is pressure balanced" is not directly derivable in isolation or without any structural and functional relationship to at least some other features of the embodiment in figure 3.

- 4.1.3 The respondent also quotes paragraph [0057] and the embodiment of figure 4 to justify the basis of the pressure balance not being specifically related to the particular valve member configuration of figure 3. According to him, the skilled person would understand from this passage that a pressure balance of the valve member is of particular importance in high pressure conditions and therefore to explicitly relate the pressure balanced nature of the valve member to the closed position in the claim is superfluous.

Such an argument does not convince the board. Whereas it may be true that it is more important to obtain a pressure balance under high pressure conditions rather than lower pressure ones, it is left open in the present wording of claim 1 under which conditions pressure balance is to be provided, nor is this indeed disclosed in any way in the application as filed, let alone it or paragraph [0057] in particular might suggest that pressure balancing is an aim in itself that can be achieved independent of a particular configuration.

4.1.4 Hence claim 1 of the main request and auxiliary request 1 is not allowable under article 123(2) EPC, these requests must therefore be refused.

4.2 Auxiliary requests 2 and 4

4.2.1 Amended claim 1 of both these requests adds the feature of *"the diameters of the upper guide region (52a) and the lower region (52c) being substantially equal"*, which is said to derive from description paragraph [0055] of the published application that relates to the embodiment in figure 4. The paragraph in question describes the differences of the figure 4 embodiment with respect to that of figure 3. In particular the lower valve housing 62 of figure 3 is not required and the nozzle control valve member 52 includes only an upper guide region within an upper valve housing bore 60. The equal dimensions of upper and lower regions (the feature added) are then mentioned, as well as an enlarged diameter collar 52b including a frusto-conical seating surface. The passage further reads as follows: "The diameter of the upper seating surface 68 against the upper valve seat 70 is substantially equal to the diameters of the upper guide region 52a and the lower

region 52c." The feature of the equal diameters of the upper guide region and the lower region is thus disclosed there in conjunction with a variety of other features that appear bound together in a close structural and functional relationship. None of these features is given any particular significance. Insofar as the skilled person might attach special significance to the diameters or dimensions, the requirement that the upper valve seat also is provided with the same diameter would appear to play an equally important role. That the skilled person would immediately recognize that the added feature can be abstracted from this context is not apparent to the Board. Therefore, by including only the equal diameters of the upper and lower guide portions in isolation from that context, claim 1 includes not only the specific solution described in paragraph [0055] but also other solutions which are not disclosed. The Board therefore concludes that the thus amended claim 1 is also based on an unallowable intermediate generalisation.

- 4.2.2 According to the respondent, a person skilled in the art would immediately recognise that the equal diameters of the guide regions are related to the fact that that the valve member is indeed pressure balanced. The other specific features of paragraph [0055] and figure 4 do not influence the pressure balance. The importance of the pressure balance can be inferred from paragraph [0057] referring to the different ways in which the valve can be biased.

Such an argumentation fails to convince the board. According to the already quoted passage and the skilled person's understanding thereof, it is not only the equal diameters of the upper and lower regions but also the diameter of the seat in combination with other

features that influence the pressure distribution around the different portions of the valve member in the specific configuration of figure 4 and that give rise to a pressure balance. Nor is it clear that paragraph [0057] refers to pressure balancing where it mentions biasing, in particular as it suggests different diameters to that end.

4.2.3 Therefore, the amendments leading to claim 1 of the auxiliary requests 2 and 4 contravene the requirements of Article 123(2) EPC and thus these requests have to be rejected.

#### 4.3 Auxiliary Request 3

No objections under Article 123(2) EPC have been raised by the appellant opponent against the amendments to claim 1 of this request, nor is it apparent to the Board that they might add subject-matter. In claim 1 of the Auxiliary Request 3, the features from granted claim 8 are added to the features already present in claim 1 as upheld by the opposition division and which was based on a straightforward combination of granted claims 1,2, 4 and 9. Other than redrafting in the two-part form and an addition to claim 1 clarifying the effect by the claimed features these claims correspond to the like numbered claims as originally filed. Claim 1 as amended according to the auxiliary request 3 thus includes a further limitation vis-a-vis claim 1 as granted which has clear basis in the original application as filed and therefore complies with the requirements of article 123(2) and (3) EPC.

5. Remittal

Both parties have requested the remittal of the case under Article 111(1) EPC if D14 and D15 are admitted into the proceedings. As these documents' admission and the nature of the subsequent amendments to claim 1 of auxiliary request 3 present the Board with a factual framework that differs significantly from that upon which the decision under appeal was based, this course of action appears justified.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated