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Datasheet for the decision of 19 January 2017

Case Number: T 1349/13 - 3.4.02

Application Number: 00967400.3

Publication Number: 1210580

IPC: G01N21/25, B01D1/00, G01N21/47, G01N21/53

Language of the proceedings: EN

Title of invention:
SPRAY DATA ACQUISITION METHOD

Patent Proprietor:
Proveris Scientific Corporation

Opponent:
OXFORD LASERS LIMITED

Headword:

Relevant legal provisions:
EPC 1973 Art. 54(1)
EPC Art. 123(2)
RPBA Art. 12(2), 13(3)

Keyword:
Novelty - main request (no) , second auxiliary request (no)
Amendments - added subject-matter (yes) , first auxiliary request
Remittal to the department of first instance - (no)
Late-filed auxiliary requests - amendments after arrangement of oral proceedings - adjournment of oral proceedings would have been required (yes) - admitted (no)

Decisions cited:

Catchword:

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Case Number: T 1349/13 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 19 January 2017

Appellant: (Patent Proprietor)	Proveris Scientific Corporation 290 Donald J. Lynch Boulevard Suite 100 Marlborough, MA 01752 (US)
Representative:	Lenzing Gerber Stute PartG von Patentanwälten m.b.B. Postfach 20 05 09 40103 Düsseldorf (DE)
Appellant: (Opponent)	OXFORD LASERS LIMITED Unit 8, Moorbrook Park, Didcot Oxon OX11 7HP (GB)
Representative:	Downing, Michael Philip Downing IP Oak House Oak End Way Gerrards Cross Buckinghamshire SL9 8BR (GB)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 3 April 2013 concerning maintenance of the European Patent No. 1210580 in amended form.**

Composition of the Board:

Chairman	R. Bekkering
Members:	A. Hornung
	B. Müller

Summary of Facts and Submissions

I. Both the opponent and the patentee appealed against the interlocutory decision of the opposition division maintaining European patent No. 1210580 in amended form.

Opposition had been filed against the patent as a whole and based on the grounds of Article 100(a) EPC, together with Articles 54(1) and 56 EPC.

The opposition division had found that the patent as amended according to a second auxiliary request then on file and the invention to which it related met the requirements of the EPC.

II. Oral proceedings before the board were held on 19 January 2017.

The patentee requested that documents D5 and D6 not be admitted into the appeal proceedings, that the decision under appeal be set aside and (in the following order) that:

- the patent be maintained as granted (main request), or that
- the patent be maintained in amended form on the basis of claims 1 to 8 according to the first auxiliary request filed with the statement of grounds of appeal dated 8 August 2013 (corresponding to the first auxiliary request filed with the letter dated 4 December 2012), or that
- the opponent's appeal be dismissed, i.e. that the patent be maintained in amended form as allowed by the opposition division, including claims 1 to 8 according to the second auxiliary request filed with the letter dated 4 December 2012, or that

- the case be remitted to the department of first instance if document D6 was admitted into the proceedings in order to preserve its right to file new auxiliary requests for examination in two instances, or that
- the patent be maintained in amended form on the basis of claims 1 to 8 according to the third auxiliary request filed with the letter dated 19 December 2016, or that
- the patent be maintained in amended form on the basis of claims 1 to 8 according to the fourth auxiliary request filed with the letter dated 19 December 2016.

The opponent requested that the decision of the opposition division be set aside and that the patent be revoked. Furthermore, the opponent requested not to admit the third and fourth auxiliary requests into the proceedings.

III. Claims of the requests

(a) Main request

Independent claim 1 according to the main request reads as follows:

"A method of spray data acquisition comprising:

illuminating with an illumination device (26) an aerosol spray plume along only a first geometric plane that intersects the aerosol spray plume;

acquiring with an imaging device (12) data representative of a first interaction between the illumination and the aerosol spray plume along the first geometric plane;

illuminating with the illumination device (26) the spray plume along only a second geometric plane that intersects the aerosol spray plume, the first and the second geometric planes being substantially orthogonal;

acquiring with the imaging device (12) data representative of a second interaction between the illumination and the aerosol spray plume along the second geometric plane; and

producing image data representative of at least one time-sequential set of images of the spray plume, each of the images being representative of the density characteristic of the spray plume (i) along the selected geometric plane that intersects the spray plume, and (ii) at a predetermined instant in time; and wherein

a first time-sequential set of images corresponds to an axial cross-sectional density characteristic along a first geometric plane substantially normal to a flow direction centerline, and a second time-sequential set of images corresponds to a longitudinal density characteristic along, a second geometric plane substantially parallel to and intersecting the flow direction centerline."

(b) First auxiliary request

Independent claim 1 according to the first auxiliary request differs from claim 1 of the main request in that it comprises the following additional feature:

"and wherein the spray plume is that of an unconstrained spray".

(c) Second auxiliary request

Independent claim 1 according to the second auxiliary request differs from claim 1 of the main request in that it comprises the following additional feature:

"and wherein a spray pump actuator (18) includes an output trigger signal that triggers the imaging device (12) when a spray pump (22) is actuated by the spray pump actuator (18) to create the spray plume".

(d) Third auxiliary request

Independent claim 1 according to the third auxiliary request differs from claim 1 of the second auxiliary request in that the spray pump actuator (18) further includes

"a force control element (19) and a control unit (20), which are programmable so as to control pumping force and duration of the spray pumping".

(e) Fourth auxiliary request

Independent claim 1 according to the fourth auxiliary request differs from claim 1 of the third auxiliary request in that the spray plume to be illuminated is a spray plume "of an inhaler-based drug delivery device".

IV. The following documents relied on in the opposition proceedings will be referred to in the present decision:

- D1: "A Flow Visualization Study of Airless Spray Painting", Gary S. Settles, Proceedings of the 10th Annual Conference on Liquid Atomization and Spray Systems, ILASS-Americas'97, Ottawa, Canada, May 18-21, 1997, pages 145 to 149

- D6: "Observation of High Pressure Fuel Spray with Laser Light Sheet Method", Masahiko Nishida et al., paper presented at the conference "Reducing Emissions from Diesel Combustion (SP-895)", Detroit, Michigan, February 24-28, 1992, pages 9 to 18

Reasons for the Decision

1. Main request

1.1 Construction of the term "spray plume" in claim 1

In the absence of any indication in claim 1 about specific properties or characteristics of a "spray plume", the term "spray plume" must be interpreted broadly. For instance, a "spray plume" may be considered as "a column of one fluid moving through another", as suggested by the patentee in its statement of grounds of appeal.

The patentee argued that the term "spray plume" in claim 1 had to be interpreted more narrowly in the light of the description as filed, page 2, lines 12 to 17, so as to exclude the presence of any obstacle modifying the spray plume characteristics. The board, however, is of the view that the description of the application cannot be used for restricting the scope of a claim, all the more since the description as filed does not contain any explicit definition of a "stray plume" ("Case Law of the Boards of Appeal", 8th edition 2016, chapter II.A.6.3.4).

1.2 Novelty

The claimed subject-matter is anticipated by the disclosure of D1 (Article 54 (1) and (2) EPC 1973).

1.2.1 D1 discloses a method of spray data acquisition comprising:

illuminating with an illumination device an aerosol spray plume along only a first geometric plane that intersects the aerosol spray plume *[see D1, chapter "Experimental Methods", figure 2, where an airless paint spray is illuminated by a laser along a first x-y plane intersecting the airless paint spray; the airless paint spray of D1 can be described as a "column of paint particles moving through air particles", i.e. as a spray plume in the sense as defined in point 1.1 above; in D1, the initial spray plume impinges on a target plate modifying the plume's shape; however, in the absence in claim 1 of any limiting feature of the general expression "spray plume", the spray plume of D1 with a generally modified shape remains a spray plume and, hence, falls under the wording of claim 1]*,

acquiring with an imaging device data representative of a first interaction between the illumination and the aerosol spray plume along the first geometric plane *[see D1, chapter "Experimental Methods", explaining that the measurement results were recorded on a S-VHS videotape]*,

illuminating with the illumination device the spray plume along only a second geometric plane that intersects the aerosol spray plume, the first and the second geometric planes being substantially orthogonal *[see D1, figure 2, where an airless paint spray is illuminated by a laser along a second x-z or y-z plane intersecting the airless paint spray and being orthogonal to the first x-y plane]*,

acquiring with the imaging device data representative of a second interaction between the illumination and the aerosol spray plume along the second geometric plane *[see D1, chapter "Experimental Methods", explaining that the measurement results were recorded on a S-VHS videotape]*, and

producing image data representative of at least one time-sequential set of images of the spray plume, each of the images being representative of the density characteristic of the spray plume (i) along the selected geometric plane that intersects the spray plume, and (ii) at a predetermined instant in time *[see D1, figures 5a, 5b, 6a and 6b showing Planar Laser Scattering (PLS) images with turbulent structures, overspray, toroidal vortex, etc. being representative of the density characteristics of the airless paint spray along a selected plane intersecting the airless paint spray; these images form part of a time-sequential set of images taken by the S-VHS videotape at a standard 30 Hz frame rate (see chapter "Experimental Methods"); each of the images corresponds to a predetermined instant in time in the sense that the S-VHS recording enables each image of the set of images to be identified on a time line with respect to an arbitrary starting time, for instance, with respect to the image of figure 6a, designated as "Startup of spray in the x-y plane"]*, and wherein

a first time-sequential set of images corresponds to an axial cross-sectional density characteristic along a first geometric plane substantially normal to a flow direction centerline *[see D1, figures 6a and 6b, showing two images of the airless paint spray in the normal x-y plane; while the target plate in the measurement set-up of D1 has an effect on the airless paint spray by creating overspray, the paint spray remains a column of a fluid moving through another fluid, i.e. a spray plume]*,

and a second time-sequential set of images corresponds to a longitudinal density characteristic along a second geometric plane substantially parallel to and intersecting the flow direction centerline *[see D1, figures 5a or 5b, showing two images of the airless paint spray in the longitudinal y-z*

and x-z planes, respectively; even though only one single image is shown along each plane, it is implicit that the single image forms part of a time -sequential set of images (images were recorded at a 30 Hz frame rate); while the target plate in the measurement set-up of D1 has an effect on the airless paint spray by creating overspray, the paint spray remains a column of a fluid moving through another fluid, i.e. a spray plume].

It follows that D1 discloses all features of claim 1.

1.2.2 Counter-arguments of the patentee

(a) The patentee contended that a "spray plume" in the sense of the invention was to be interpreted in the light of the description as filed, page 2, lines 12 to 17. There it was stated that the disadvantage of the prior art configuration with respect to the invention was that "the presence of the TLC [Thin-Layer Chromatography] plate [in the prior art configuration] radically alters the natural fluid dynamics of the spray causing it to switch from a free aerosol jet to an impinging jet" and that "particles bounce off the plate, causing artifacts in the pattern that do not exist in an unconstrained spray". Therefore, a "spray plume" in the sense of the invention meant a **free aerosol jet** or an **unconstrained** spray whose shape was neither influenced by the shape data acquisition device nor by any other obstacle. In D1, the airless paint spray of D1 impinged on a target plate which altered the characteristics of the spray in such a way that it could not be considered as being a "spray plume" within the meaning of the invention. Thus, all the features of claim 1 relating to a "spray plume" were novel with respect to D1.

Since the description cannot be used for reading into a claim an implicit restrictive feature not suggested by the explicit wording of the claim (see also the claim construction discussed in point 1.1 above), this argument is not found convincing by the board.

(b) The patentee argued that D1 did not disclose the claimed method step "producing image data representative of at least one time-sequential set of images of the spray plume". In other words, there was no **sequence** of images shown in D1.

The board is not convinced by this argument because, as explained by the opponent during oral proceedings, D1, figure 7, deals inter alia with the phenomenon of spray entrainment which requires examining a time-sequential set of images of the spray plume. For achieving this goal, it is implicit that a sequence of images of the spray plume is recorded on the S-VHS videotape of D1.

(c) The patentee further argued that no time-sequential set of images corresponding to an axial cross-sectional density characteristic along a geometric plane substantially **normal** to a flow direction centerline was produced in D1. Indeed, in D1, the images in the x-y plane, normal to the flow direction centerline of the spray, were taken at a distance of 2.5 cm from the target plate which induced "overspray" and "walljet" upon impingement of the spray. Therefore, the corresponding images with the overspray did not represent a "column" of spray.

While it is true that the images in the orthogonal x-y plane of D1 show the phenomenon of "overspray" and "walljet", the board shares the opponent's view that the resulting airless paint spray is still encompassed

by the general expression "spray plume" of claim 1 in the sense that the column of airless paint spray in D1 is a fluid moving through another fluid, even after it has been deviated and modified by the target plate.

(d) The patentee stated that claim 1 required that each of the images of the time-sequential sets of images is produced at a **predetermined** instant in time. This had to be understood as meaning that, according to the invention, the time at which each image of the spray plume was taken, was not only determinable after it has been taken but that the time was determinable in advance. This feature was novel because D1 did not indicate any time line at all. The origin of time at which the airless paint spray was generated in D1 was unknown. Indeed, in D1, the airless paint spray was released at an arbitrary point in time by actuating a handgun, as shown in figures 2, 5, 6 and 7 of D1.

The board, however, agrees with the opponent that claim 1 does not comprise any features corresponding to the intended limitation of the claim's scope and read into the term "predetermined" by the patentee. In particular, claim 1 does not define a starting instant in time. Moreover, in D1, the S-VHS videotape records a sequence of images at a frame rate of 30 Hz, thereby establishing a time line on which each image corresponds to a predetermined instant in time with respect to a starting point, such as the release of the airless paint spray or the "startup of spray in the x-y plane" shown in figure 6a of D1.

It follows that the counter-arguments of the patentee in favour of novelty of the claimed subject-matter are not found convincing by the board.

2. First auxiliary request

2.1 Article 123(2) EPC

2.1.1 The board notes that the additional feature of claim 1 of the first auxiliary request, i.e. "the spray plume is that of an unconstrained spray", has no explicit basis in the description as originally filed. The board further notes that the only literal basis for the term "unconstrained" can be found on page 2, lines 15 to 17 of the original description, a passage which does not describe the characteristics of the invention itself but the disadvantages of the prior art configuration.

The board further notes that the exact meaning of the term "unconstrained" is not explicitly defined in the application as filed and, therefore, the term requires interpretation. In particular, there is no description of the technical features of an "unconstrained spray plume" in the application as filed. From the passage on page 2, lines 12 to 17 of the original description, in combination with the statement on page 2, lines 25 and 26, it can be deduced that the object of the invention is to provide a method of spray data acquisition in which the measurement set-up does not alter the spray plume characteristics. Under circumstances causing no artifacts in the measured spray pattern the spray plume is referred to as an "unconstrained spray" in the description as originally filed on page 2, lines 15 to 17.

Therefore, the board acknowledges that the application as originally filed comprises a basis for an "unconstrained spray plume" only when interpreted as a spray plume whose pattern is not altered or otherwise influenced by the measurement set-up.

2.1.2 The patentee, however, requested the term "unconstrained" to be construed so as to mean that the spray plume of claim 1 is

(a) neither constrained or influenced by the measuring set-up itself,
(b) nor constrained or influenced by any other obstacle modifying its shape.

According to the patentee, the basis for this interpretation of the expression "unconstrained spray plume" is to be found on page 2, lines 12 to 17, page 5, lines 2 to 7, page 6, lines 3 to 5, page 6, lines 25 to 28 and in the figures 2 and 3, which clearly showed that nothing was in the way of the stray plume. Indeed, these passages of the description disclosed inter alia that "substantially complete geometrical and pattern imaging" was carried out, enabling the study of "complete fluid dynamics of an aerosol spray plume".

2.1.3 While the board shares the patentee's view that the above meaning (a) has a basis in the original application as filed, it is, however, of the view that the meaning (b) has not. The passages cited by the patentee merely disclose that the data acquisition system of the invention is a "non-intrusive system" in the sense that it acquires information of the complete spray plume in the natural environment of use of the spray and without interfering with the spray plume in a way which would alter the spray plume characteristics with respect to those it has in its natural environment of use. Whether the natural environment of use of the spray includes items on the spray path altering the initial spray plume characteristics is not excluded by the passages of the description as originally filed referred to by the patentee: the meaning (b) of the spray plume is not originally disclosed.

It follows that the expression "unconstrained spray plume" construed as requested by the patentee has no basis in the original application documents, contrary to the requirement of Article 123(2) EPC.

3. Second auxiliary request

3.1 Admissibility of D6

Document D6 was filed by the opponent together with its statement of grounds of appeal.

3.1.1 The board is of the view that D6 is to be admitted into the proceedings for the following reasons:

(a) The filing of D6 by the opponent is to be considered as an allowable reaction to the patentee's filing of the present second auxiliary request two months before the first-instance oral proceedings. Indeed, claim 1 of the second auxiliary request was admitted into the proceedings by the opposition division in spite of the amended feature of claim 1 relating to the spray pump actuator including an output trigger signal and having been taken from the description, possibly relating to unsearched subject-matter as objected to by the opponent.

(b) D6 is sufficiently relevant to the case at stake. In particular, figure 1 of D6 and the corresponding description disclose details about how the spray actuator, the illumination source and the camera are connected and/or synchronized.

3.1.2 The patentee argued that D6 was late-filed and was technically not relevant enough to the case at stake. The

filing of the second auxiliary request did not justify the filing of D6 because D6 did not disclose any of the newly claimed features, i.e. D6 did neither disclose a signal that triggered a camera, nor a spray pump actuator, nor a spray pump.

The board does not consider the filing of D6 as being late because the facts of the case were changed substantially by the patentee's filing of the second auxiliary request shortly before the first-instance oral proceedings. It is not reasonable to expect the opponent to file D6 earlier than with the statement of grounds of appeal. Concerning the technical relevance of D6, the board is satisfied that D6 discloses a method of spray data acquisition comprising aspects relating to the synchronization of the spray injector, the laser light source controller and the imaging camera. It is not necessary for D6 to disclose these features explicitly for D6 to be regarded as sufficiently relevant to justify its admittance into the proceedings.

3.2 Remittal to the first instance

During oral proceedings, the patentee reiterated its request, already filed with its letter of 30 December 2013, that the case be remitted to the department of first instance. The reasons for its request were that D6 was only admitted into the proceedings on the day of the oral proceedings before the board of appeal and that, according to the case law of the boards of appeal, it had the right to have its case examined by two instances.

The opponent requested not to remit the case to the department of first instance for the reasons that there was no absolute right to two instances and that the examination of the present application had lasted already more than 17 years.

First of all, the board, referring to the "Case Law of the Boards of Appeal" (8th edition 2016), pages 1170 and 1171, is of the opinion that there is no absolute right of a party to have each issue considered by two instances. In the circumstances of the present case, D6 cannot be considered late-filed but must be seen as an allowable reaction to the admission by the opposition division of the patentee's second auxiliary request into the proceedings (see point 3.1 above). Furthermore, since D6 was filed together with the opponent's statement of grounds of appeal, the patentee had ample opportunity, and even the obligation under Article 12(2) RPBA, to examine D6 and present its complete case with its reply to the statement of grounds of appeal without awaiting the board's decision concerning the admission of D6 into the proceedings. Considering the overall length of the present proceedings, the need for procedural efficiency, the balance of interests of both parties and that of the public and the lack of specific reasons for remittal, the board exercised its discretion in not remitting the case.

3.3 Novelty

The claimed subject-matter is anticipated by the disclosure of D6 (Article 54 (1) and (2) EPC 1973).

3.3.1 D6, with reference to figures 1 to 3 and the corresponding description in chapter "Experimental apparatus and method" on page 10, discloses a method of spray data acquisition as defined in claim 1 of the main request.

This was not contested by the patentee, neither during the oral proceedings, nor in writing, except for the argument filed with the letter of 30 December 2013, that D6 did not disclose a "spray plume". For the reasons corresponding to those given in points 1.1 and 1.2 above, the board is of the

view, however, that D6 discloses a "spray plume" in its broadest meaning. The patentee presented no counter-arguments during oral proceedings. Therefore, the only remaining controversial features were those added to claim 1 of the main request and relating to the spray pump actuator, the spray pump and the trigger signal.

Following the opponent's arguments presented during oral proceedings, the board is of the view that D6 discloses:

- a spray pump *[D6 (title; page 9, left column) discloses the observation of a **high pressure** fuel spray, thereby implicitly disclosing the use of a pump for generating the high pressure; the spray pump in claim 1 is not defined by any concrete structural features of a specific spray pump but merely in broad functional terms therefore encompassing the implicitly disclosed high pressure pump of D6]*

- a spray pump actuator *[D6 discloses the generation of a high pressure fuel spray, thereby implicitly disclosing not only the use of a pump for generating the high pressure but also means for actuating the pump for releasing the spray (see D6, page 10, right column, disclosing the opening of the needle/nozzle of the injector); the spray pump actuator in claim 1 is not defined by any concrete structural features of an actuator but merely in broad functional terms therefore encompassing any means for actuating a pump for creating a spray plume]*

- wherein the spray pump actuator includes an output trigger that triggers the imaging device when a spray pump is actuated by the spray plume actuator to create the spray plume *[the injection duration of D6 is 1.8 to 6.5 ms (page 10, table 1); the camera takes a maximum of*

24 image frames (page 10, left column); the period at which the images are taken is 0.2 ms (figure 2) or 0.1 ms (figure 3); therefore, for images of the spray plume to effectively be taken by the camera during this short duration of time (24 times 0.2 = 4.8 ms or 24 times 0.1 = 2.4 ms), it is implicit that the camera is triggered by a triggering signal generated by the spray pump actuator; this finding is confirmed, on the one hand, by the lines representing connections shown in figure 1 of D6 between the injector, injection controller, laser controller and copper-vapour laser and, on the other hand, by the disclosure on page 10, left column, that "this camera was synchronized with the copper-vapour laser"]

It follows that D6 discloses all features of claim 1.

3.3.2 Counter-arguments of the patentee

(a) The patentee argued that figure 1 of D6 showed only a "fuel supply unit", an "injector" and an "injection controller". None of these devices corresponded to a pump or an actuator. In particular, the "injector" and the "injection controller" could be considered as means for opening and closing a gate or a nozzle for releasing a spray, but they did not represent a pump which provided a spray plume upon actuation. The mere disclosure in D6 of a "container with a nozzle under high pressure" did not imply the presence of a pump.

The board notes that the "high pressure fuel spray" of D6 implies not only a "container with a nozzle under high pressure" but additional means for building up the pressure. These implicitly disclosed additional means, together with the "container with a nozzle under high pressure", form a pump. An explicit disclosure of a pump

is not required in D6 for anticipating the corresponding feature of claim 1. The opponent's suggestion that the spray pump of D6 corresponded to the boxes of figure 1 designated by the terms "fuel supply unit" and "injector", and that the spray pump actuator of D6 corresponded to the boxes of figure 1 designated by the terms "injection controller" and "injector" represents a reasonable identification of the spray pump and the spray pump actuator with the devices disclosed in figure 1 of D6.

(b) The patentee further argued that D6 did not disclose any triggering signal. The lines drawn between certain devices in figure 1 of D6 were not described in D6 as being lines for transmitting a triggering signal to a camera. Moreover, since figures 2 to 4 of D6 showed images of spray plumes which were taken by the camera after a certain time had lapsed since the injection start (e.g. 2.2 ms after injection start in figure 2), it was clear that the camera of D6 was not triggered when the spray pump was actuated to create the spray. If triggered at all, the camera of D6 could well be triggered by other means, such as a detector detecting the opening of the nozzle.

The board notes that claim 1 leaves open the question how the camera is exactly triggered, i.e. none of the mechanical and/or electrical means which intervene for triggering the camera are defined in claim 1. The features of the spray pump and the spray pump actuator are undefined, too, in claim 1. Therefore, any triggering method falls under the wording of claim 1. While the board agrees with the patentee that the lines alone in figure 1 do not disclose a triggering signal, they do support the implicit disclosure of a triggering signal in D6 for the reasons given in point 3.3.1 above.

Concerning the images shown in figures 2 to 4 of D6, the board notes that it is not possible to deduce from them when the camera was actually triggered because the camera records series of up to 24 images and the images shown in figures 2 to 4 represent only an extract of these series.

It follows that the counter-arguments of the patentee in favour of novelty of the claimed subject-matter are not found convincing by the board.

4. Third and fourth auxiliary requests

4.1 Following the opponent's request not to admit the third and fourth auxiliary requests into the proceedings and taking into account the arguments of both parties, the board decides not to admit the third and fourth auxiliary requests into the proceedings under Article 12(2) and 13(3) RPBA for the following reasons:

(a) As a rule of principle, according to Article 12(2) RPBA, the parties must present their complete case at the beginning of the appeal proceedings. D6 was filed by the opponent with its statement of grounds of appeal. The patentee, in its letter of response of 30 December 2013, however, did not file any amendments to its claim requests in order to overcome possible objections based on D6, contrary to the requirements of Article 12(2) RPBA.

(b) The third and fourth auxiliary requests were filed after oral proceedings had been arranged. According to Article 13(3) RPBA, such requests shall not be admitted if they raise issues which the board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings. In the present case, claim 1

was amended by introducing features taken from the description for limiting the claim's scope. Having been taken from the description, it is doubtful whether these features were searched by the EPO. The opponent explained convincingly that it had not had sufficient time to carry out a thorough search concerning the newly added features. Therefore, if the third or fourth auxiliary requests were admitted into the proceedings, an adjournment of the oral proceedings or a remittal of the case to the department of first instance would be necessary. In the board's view, this would be contrary to the wording and the spirit of Article 13(3) RPBA.

(c) No substantial change of the facts of the case occurred since the opponent's filing of D6, which possibly could have justified the filing of the third or fourth auxiliary request only one month before the oral proceedings before the board. In particular, the patentee cannot await the board's preliminary opinion or decision on the admittance of D6 into the proceedings before filing amendments intended to overcome objections based on D6 in case of its admittance. Moreover, except for minor clarifications of the initial arguments which were filed in writing by the opponent together with its statement of grounds of appeal, no substantial change of argumentation concerning the novelty objection in view of D6 was brought forward by the opponent or the board since the opponent's filing of D6.

For the above reasons, the board decides not to admit the third and fourth auxiliary requests into the proceedings.

4.2 Counter-arguments of the patentee

(a) The patentee argued that not admitting the third or fourth auxiliary request into the proceedings while

having admitted D6 into the proceedings would be unfair. Acting this way would not preserve the balance of rights between the patentee and the opponent.

The board is of the view that this argument of balance of rights would presuppose that the patentee would have filed its amendments directly in response to the opponent's statement of grounds comprising D6, within the time limit set by the Office or at least sufficiently early before issuance of the summons to oral proceedings, so that the opponent and the board would have had time to examine the amendments. The patentee, however, did not avail itself of this opportunity, contrary to the requirements defined in Article 12(2) RPBA.

(b) The patentee further argued that, during oral proceedings, the opponent presented new arguments against novelty of claim 1 of the second auxiliary request in view of D6. The patentee learned only during oral proceedings how the opponent and the board exactly interpreted the disclosure of D6. In particular, the opponent amended its initial argumentation of lack of novelty (see the bottom of page 10 of the opponent's statement of grounds) concerning the definition of the "injection controller" of D6. Moreover, the opponent, in its statement of grounds, did not explain at all why D6 anticipated the "spray pump" of claim 1.

The board acknowledges that the debate on novelty of claim 1 of the second auxiliary request with respect to D6 was more extensive during oral proceedings than initially presented in writing in the opponent's statement of grounds. However, the board is of the view that the opponent did not amend its argumentation so extensively as to fundamentally change its case. In

particular, the explanation provided by the opponent for the first time during oral proceedings that the "spray pump" was implicitly disclosed in D6 due to the use of a "high pressure fuel spray" (see the title of D6), cannot be considered to be unexpected so that it would justify admitting new auxiliary requests. The further passages and figures of D6, used by the opponent in its oral argumentation of lack of novelty, remained substantially the same as those used in its written argumentation.

(c) The patentee filed the third and fourth auxiliary requests as soon as it understood that there might be a chance that D6 would be admitted into the proceedings. There was no reason for the patentee to file amendments before knowing that D6 was effectively admitted into the proceedings.

The board does not agree with the patentee's argument because Article 12(2) RPBA requires the parties to present their complete case in their statement of grounds of appeal and in the reply to the other party's statement of grounds. This includes, if the patentee so wishes, the filing of auxiliary requests at this early stage of the appeal proceedings in order for the patentee to be prepared for the situation where documents, such as D6, would be admitted into the proceedings at a later stage.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairman:

M. Kiehl R. Bekkering

Decision electronically authenticated