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**Datasheet for the decision
of 14 September 2018**

Case Number: T 0839/14 - 3.2.04

Application Number: 04766691.2

Publication Number: 1664517

IPC: F02M25/00, F04B13/00, F04B17/03

Language of the proceedings: EN

Title of invention:
DOSING PUMP FOR A LIQUID FUEL ADDITIVE

Patent Proprietor:
Plastic Omnium Advanced Innovation and Research

Opponent:
THOMAS MAGNETE GmbH

Headword:

Relevant legal provisions:
EPC Art. 114(2), 100(b), 54, 111(1)

Keyword:

Grounds for opposition - late-filed ground for opposition -
discretion of opposition division
Insufficiency of disclosure (no)
Novelty - (yes)
Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0839/14 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 14 September 2018

Appellant: Plastic Omnium Advanced Innovation and Research
(Patent Proprietor) Rue de Ransbeek, 310
1120 Bruxelles (BE)

Representative: de la Bigne, Guillaume Michel Marie
LLR
11 boulevard de Sébastopol
75001 Paris (FR)

Appellant: THOMAS MAGNETE GmbH
(Opponent) San Fernando 35
57562 Herdorf (DE)

Representative: Sparing, Rolf Klaus
Bonnekamp & Sparing,
Patentanwälte,
Goltsteinstrasse 19
40211 Düsseldorf (DE)

Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
10 February 2014 concerning maintenance of the
European Patent No. 1664517 in amended form.

Composition of the Board:

Chairman A. de Vries
Members: S. Oechsner de Coninck
W. Van der Eijk

Summary of Facts and Submissions

I. The Opponent and the Proprietor both appeal against the opposition division's decision dated 10 February 2014 to maintain the European patent N° 1 664 517 in amended form. The Opponent filed a notice of appeal on 31 March 2014, paying the appeal fee on the same day, and filed the statement of grounds on 20 June 2014. The Proprietor filed a notice of appeal on 17 April 2014, paid the appeal fee the same day, and filed the statement of grounds on 10 June 2014.

II. The opposition was based on the grounds of Article 100(b) and 100(a) EPC in combination with lack of novelty and inventive step. In its written decision the opposition division held that the patent as amended according to auxiliary request complied with the requirements of the EPC, having regard in particular to the following documents that also played a role in the present proceedings:

E13: DE 199 10 920 A1

III. The Appellant-Proprietor requests that the decision under appeal be set aside and the European patent Nr. 1664517 be maintained as granted, or maintained on the basis of one of auxiliary request 1 to 5, with auxiliary request 1 as filed with letter dated 18 October 2013, auxiliary requests 2, 3 and 5 as filed with letter dated 5 September 2018, and auxiliary request 4 filed in first instance proceedings and re-filed in the oral proceedings before the Board.

Remittal to the first instance is requested to deal with the question of inventive step.

IV. The Appellant-Opponent requests that the decision under appeal be set aside and that the European patent No. 1664517 be revoked.

Remittal to the department of first instance is requested to present a complete case on inventive step.

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

"Dosing pump for a liquid additive in the fuel of a heavy fuel engine, said pump comprising a manifold (6), a piston (3), a cylinder (1), a high resolution linear actuator (7) for moving the piston (3) axially in the cylinder (1) and a seal (4) to ensure tightness between the piston (3) and the cylinder (1), characterized in that the seal (4) is a low friction dish seal having at least one portion (F) attached to the piston (3) and moving with it, and in that, when the piston (3) is in its storage/reset position, it pushes the seal (4) up against the manifold (6) at its end-stop."

VI. The Appellant-Proprietor argues as follows:

- The opposition division's decision to hear submissions by Mr Schulz during the oral proceedings represents a procedural violation.
- The division properly exercised its discretion in not admitting the new ground of added subject-matter.
- The location of the dish seal between the piston and the cylindrical wall surrounding it ensures tightness and is therefore sufficiently disclosed.
- In E13 the actuator operates between two end stops, therefore it is not of the high resolution type as required by the wording of claim 1.

VII. The Appellant-Opponent argues as follows:

- The hearing of Mr Schulz during oral proceedings was not based on a wrong exercise of the discretionary power of the opposition division.
- The opposition division made a manifest error in not admitting the ground under Art. 100c) EPC because it is evident that a seal to ensure tightness between the piston and cylinder was not disclosed in relation with the second embodiment.
- As for novelty the skilled person reading the disclosure of E13, immediately recognises that the actuator is of a high resolution type, because its amplitude is accurately adjustable by the electrical current circulating in the actuator's electromagnetic circuit.

Reasons for the Decision

1. The appeal is admissible
2. Oral submissions by an accompanying person

The Appellant-Proprietor formally objects to the decision of the opposition division to hear submissions by Mr Schulz during the oral proceedings. However, Appellant-Proprietor has not presented any specific request in relation to this question. In particular they have not argued that this would represent a procedural violation, much less that it would be substantial in the sense that it had an adverse effect for the Appellant Proprietor that marred the entire procedure, nor is this apparent to the Board. Absent any specific request or substantiating argument, the Board sees no need to decide on the issue.

3. Fresh ground for opposition

- 3.1 The opposition ground under Art 100c) was submitted on the first time on 15 October 2013 one month before the oral proceedings and after the opposition period laid down in Art. 99(1) EPC. Having considered its prima facie relevance, the opposition division decided not to allow this late ground in the proceedings.
- 3.2 It is established case law that if the way in which a department of first instance has exercised its discretion on a procedural matter is challenged in appeal, it is not the function of a Board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, and to decide whether or not it would have exercised such discretion in the same way as the department of first instance. A Board of appeal should only overrule the way in which a department of first instance has exercised its discretion if the Board concludes it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (see Case Law of the Boards of Appeal IV.E.3.6, eighth edition 2016).
- 3.3 The Board observes that in its examination of the prima facie relevance the opposition division identified the basis for these amendments and their validity at first sight, see the detailed explanation in point 19.4 of the impugned decision. The Appellant-Opponent submits that the opposition division made a manifest error because it failed to identify that a seal to ensure tightness between the piston and cylinder was not disclosed in relation with a dish seal, and would in fact be incompatible with the second embodiment. In the Board's view this argument attempts to enter into a full discussion of the merits of the appellant-Opponent's case regarding added subject-matter, rather

than demonstrating that the opposition division made a manifest error in its evaluation of prima facie relevance of the ground. Nor is it apparent to the Board from the opposition division's reasoning that its assessment of prima facie relevance would be manifestly wrong.

- 3.4 From the minutes, page 1, bottom half, and page 2, first paragraph, it appears that the opposition division otherwise heard the parties on prima facie relevance of the new ground before taking its decision. It thus applied the correct criterion (prima facie relevance) and heard the parties. Therefore, the Board concludes that the opposition division correctly exercised its discretionary power by checking at first sight whether this new ground was relevant in that it prejudiced maintenance of the patent as granted. The Board therefore sees no compelling reason to overturn the division's discretionary decision regarding the non admission of a new opposition ground based on Art 100c) EPC filed at a late stage of the opposition procedure.

4. Sufficiency of the disclosure

- 4.1 The Appellant-Opponent does not elaborate further on the question of sufficiency in respect of the following expressions: "low friction dish seal" and "high resolution linear actuator".

With respect to the expression "high resolution linear actuator", the Board notes that the skilled person will understand this term in its normal sense as denoting linear actuators that are positionable (continuously or incrementally) at many positions separated by the given high resolution along a linear path of travel. This

understanding is also in perfect agreement with the explanation given in paragraphs 0011 to 0014 of the patent, according to which "the linear position can be controlled with high resolution" and is realized by an electrical stepper motor "which moves the piston at very small increments to achieve a very high accuracy per single step", or by a rotary electric motor with a gear reduction possibly driving a gear reduction. The values given for accuracy (from 1mm down to 50µm) are relative to the particular use or dosage intended and do not in any way imply that the term is to be understood as anything other than its normal meaning.

With respect to the expression "low friction", the Board notes that paragraph 22 of the patent describes the dish seal to be preferably made of Teflon. Teflon is commonly known, also to the skilled person, as a material that has a low friction coefficient. Therefore the skilled person is able to carry out the claimed invention at least by the provision of a dish seal made of Teflon.

- 4.2 The Appellant-Opponent further submits that the skilled person would not be able to provide the required sealing between the piston and cylinder with the dish seal defined in the characterising portion. The Board is not convinced by this argument. When reading the instruction to ensure tightness between the piston and cylinder in relation to the dish seal defined further down in claim 1, the skilled person, intent on making technical sense of the claim, will draw upon the description and drawings. More particularly, in figure 3 the dish seal is depicted to extend between the top (F) of the piston and the cylinder 1. The skilled person can therefore realise the dish seal accordingly, and will obtain the claimed

tightness between the piston and cylinder even if the dish seal also and mainly ensures tightness between the pumping chamber and the space between the cylinder and piston.

- 4.3 It follows that the ground of opposition based on Article 100 (b) EPC does not prejudice the maintenance of the patent. The Board thus confirms the appealed decision's findings in this respect.
5. Main request - Novelty over E13
- 5.1 E13 (col. 3, lines 35-47; fig.1-5) discloses a magnetic piston pump ("Schwingankerpumpe") comprising a manifold (Ventilkörper 21) against which a membrane 23 is reciprocally moved by a shaft 27. The actuator operates by changing the polarity of electric current to effect a piston stroke (see col 4, lines 27-32; "Hubbewegung"), with the piston positionable at either end position, but not in between. The piston is thus made to "swing" or oscillate from one end position to the other.
- 5.2 The Appellant-Opponent submits that the skilled person reading the disclosure of E13 immediately recognises that the electromagnetic actuation ("Electromagneten" 12) of the piston ("Schwinganker" 27) can be operated in high resolution mode. In particular he would recognize that the amplitude of the movement of the piston, i.e. the length of the piston stroke, is determined by the amount of electric current circulating in the solenoid (Magnetspule 34) and can therefore be accurately controlled to any desired stroke length and thus end position by regulating the amount of current.

- 5.3 The Board is unconvinced by this argument. The skilled person interprets high resolution linear actuator in the context of claim 1, to be an actuator that allows the position of the actuator to be precisely controlled with a given high resolution to be positionable at any position along a linear path, see above. In the context of a dosing pump requiring a particular degree of accuracy, such a position is directly identified by the skilled person to be any intermediate position with the given resolution between both end positions.
- 5.4 Even if the end positions of the piston of E13 might be adjustable with a desired high degree of precision, such a movement in which the piston is positionable at either end of the stroke does not correspond to the movement of a high resolution linear actuator as that term is understood by the skilled person, see above. In particular the piston of E13 is not designed to stop at intermediate positions between the end points; the piston is positionable only at its end points. The piston of E13 is thus not moved by a high resolution linear actuator as required in claim 1 and as that term is to be properly understood. It is thus immaterial that E13 describes the use of an optional adjustable stop means ("mechanischen Anschlag 39") in the embodiment shown in figs 3 and 4 and explained in column 5, lines 53-61, as it merely serves to adjust the end position and thus the length of the stroke; it does not allow the piston to be stopped at positions intermediate the end points. Nor is there any suggestion in E13 that the current level can be varied to continuously vary the piston amplitude or stroke.

- 5.5 Since E13 does not directly and unambiguously disclose a high resolution linear actuator moving the piston, the Board can but conclude that the subject-matter of claim 1 is novel with respect to this prior art according to Art. 54(2) EPC.
6. Remittal
- 6.1 The Board has considered the exercise of the first instance discretionary power not to admit the fresh ground under Art 100c), and has further considered opposition grounds based on Art 100(b) and Art 100a) in relation with Art 54(1) EPC in respect of E13 and has reached the conclusion its subject-matter contained novel features with respect to this disclosure.
- 6.2 The opposition division has neither considered novelty with respect to the other documents brought forward against it, nor did it examine and decide on the ground of inventive step in the light of further citations. At appeal stage neither the Appellant-Opponent nor the Appellant-Proprietor have submitted any argument in relation to these issues. Therefore, as was confirmed at the oral proceedings before the Board, neither the parties nor the Board were in a position to conduct a meaningful discussion of these remaining issues. Indeed at the oral proceedings both parties for this very reason requested remittal.
- 6.3 In view of the above, the Board decided to exercise its discretionary power of the Board under Art 111(1) EPC to remit the case to the department of first instance.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated