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**Datasheet for the decision
of 18 August 2020**

Case Number: T 0650/17 - 3.2.06

Application Number: 03751268.8

Publication Number: 1537296

IPC: F01D5/08, F02C7/18, F01D11/02

Language of the proceedings: EN

Title of invention:
GAS TURBINE SEALING AIR SUPPLY SYSTEM

Patent Proprietor:
MITSUBISHI HEAVY INDUSTRIES, LTD.

Opponent:
Siemens Aktiengesellschaft

Headword:

Relevant legal provisions:
EPC Art. 100(c), 123(2), 113(1), 111(1)
RPBA Art. 13(1)

Keyword:

Substantial procedural violation - (no)

Reimbursement of appeal fee - (no)

Remittal to the department of first instance - (no)

Amendments - added subject-matter (yes)

Decisions cited:

G 0002/10

Catchword:



Beschwerdekammern

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Case Number: T 0650/17 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 18 August 2020

Appellant: Siemens Aktiengesellschaft
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Respondent: MITSUBISHI HEAVY INDUSTRIES, LTD.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 18 January 2017
rejecting the opposition filed against European
patent No. 1537296 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
W. Ungler

Summary of Facts and Submissions

- I. An appeal was filed by the appellant (opponent) against the decision of the opposition division rejecting the opposition to European patent No. 1 537 296. The appellant requested that the decision under appeal be set aside, the case be remitted to the opposition division for further prosecution and the appeal fee be reimbursed due to the opposition division having committed a procedural violation. As an auxiliary measure, it requested that the patent be revoked.
- II. The respondent (patent proprietor) requested that the appeal be dismissed.
- III. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the opposition division appeared not to have violated the appellant's right to be heard and that the ground for opposition under Article 100(c) EPC appeared to prejudice maintenance of the patent as granted.
- IV. With letter dated 17 June 2020, the appellant presented further arguments in support of its view that its right to be heard had not been respected by the opposition division.
- V. With letter dated 20 July 2020 the respondent argued afresh that the subject-matter of claim 1 did not extend beyond the content of the application as filed. It further filed auxiliary requests 1 and 2, indicating that auxiliary request 2 effectively comprised two auxiliary requests, the first including deletion of claim 2 of the main request and the second including

deletion of claim 2 of auxiliary request 1.

VI. Oral proceedings were held before the Board on 18 August 2020. The requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and the case be remitted to the opposition division, auxiliarily that the decision under appeal be set aside and the patent be revoked. Furthermore, it requested that the appeal fee be reimbursed.

The respondent requested that the appeal be dismissed (main request), auxiliarily that the patent be maintained in amended form on the basis of the first or second auxiliary request filed with letter dated 20 July 2020 (see point V. above).

VII. Claim 1 of the main request (claim 1 as granted) reads as follows:

"A gas turbine comprising:
a plurality of stationary blades (31) disposed in a circle on an interior side of a casing;
a plurality of moving blades (33) disposed in a circle on a side of a rotor disk (32) adjacent to these stationary blades (31);
a seal disk (34) coaxially connected to the upstream side of the rotor disk (32);
a first tangential on board injection (TOBI) nozzle (39) arranged to supply bleed air (F1) taken up to the seal disk (34) as swirling flow which rotates in the same direction as the seal disk (34);
a sealing air supply flow path (50) that communicates with a discharge port of the first TOBI nozzle (39) for supplying sealing air (S) to a space between the

stationary blades (31) and the moving blades (33);
a disk hole (34a) provided in the seal disk (34) for
flowing the swirling flow from the first TOBI nozzle
(39); and
a sealing air bypass flow path (55) provided for
supplying the sealing air (S) to the sealing air supply
flow path (50) by bypassing a section of the sealing
air supply flow path (50) between the first TOBI nozzle
(39) and the disk hole (34a);
characterized in that
a second TOBI nozzle (43) is provided on an upstream
side of the sealing air bypass flow path (55) and
arranged so as to take up a portion of the bleed air
(F1) and eject the bleed air (F1) into the sealing air
supply flow path (50) to form a swirling flow,
thereby controlling a rate of flow of the sealing air
(S) passing through the swirling flow and directing it
toward the sealing air bypass flow path (55)."

Claim 1 of each of auxiliary requests 1 and 2 reads as
for claim 1 of the main request except for the final
feature of the preamble which reads as follows:

"a sealing air bypass flow path (55) provided for
supplying the sealing air (S) to the sealing air supply
flow path (50) by bypassing a section of the sealing
air supply flow path (50) which is the flow path
between the first TOBI nozzle (39) and the disk hole
(34a)".

VIII. The arguments of the appellant (opponent) relevant to
the present decision may be summarised as follows:

Right to be heard

With the proprietor having failed to provide its reply

to the opposition despite multiple requests for time limit extensions, the opponent requested (with letter of 17 November 2014) a decision according to the state of the file and withdrew its request for oral proceedings before the opposition division. With letter of 12 January 2015 the proprietor's reply to the opposition was filed, which the opponent (with letter of 25 February 2015) requested not to be admitted or, as an auxiliary measure, that an interlocutory decision be issued on the admittance of the proprietor's reply. The opposition division then issued its decision rejecting the opposition rather than a decision in accordance with the opponent's requests on admittance. In admitting the proprietor's reply and not indicating this prior to its final decision, the opposition division had not proceeded fairly; the opponent had been deprived of an opportunity to comment on the proprietor's letter of 12 January 2015, and its right to be heard had thus been violated.

Article 100(c) EPC

The subject-matter of claim 1 of the main request extended beyond the content of the application as filed. The term 'vehicle' in claim 1 as filed was not 'non-essential' as argued by the respondent. The references on page 1 and page 12 of the filed application to gas turbines were not related just to power stations. For example, armoured tanks were also powered by gas turbines, such that the overall teaching of the application as filed was unambiguously for a gas turbine in a vehicle. Likewise, the use of the gas turbine connected to a generator on page 12 could simply relate to the powering of ancillary systems in a vehicle.

The same objections also applied to claim 1 of the auxiliary requests.

- IX. The arguments of the respondent (proprietor) relevant to the present decision may be summarised as follows:

Article 100(c) EPC

Deletion of the term 'vehicle' from claim 1 of the main request found basis in the application as filed. The sections 'Background Art' on page 1 and 'Industrial Applicability' on page 12 each disclosed the gas turbine in connection with other applications not directed to the blades being on an interior side of a vehicle. The term 'vehicle' was also an unnecessary limitation in the claim as it was not essential to the operation of the sealing and bleed air systems forming the heart of the invention. It was thus acceptable to remove it from the claim as originally filed. The term 'vehicle' was notably also a mistranslation from the Japanese language priority application, and would be understood by a skilled person as clearly erroneous in the context of the claim.

Auxiliary requests

The same arguments were relevant to claim 1 of each auxiliary request which also omitted the term 'vehicle' from the respective claim 1.

Reasons for the Decision

1. *Right to be heard - Article 113(1) EPC*
- 1.1 The appellant's right to be heard was respected in the proceedings before the opposition division such that no procedural violation can be recognised by the Board.
 - 1.1.1 With letter of 17 November 2014, the appellant withdrew its request for oral proceedings before the opposition division. In doing so, the appellant effectively elected to forego its ultimate opportunity to comment on any subsequent submissions of the other party. Despite indicating that it reserved the right to request oral proceedings afresh, the appellant notably failed to do so.
 - 1.1.2 The appellant's argument that the opposition division had proceeded unfairly in not providing an interlocutory decision on the admittance of the respondent's reply to the opposition, due to its request to have such a decision before filing any response, is not accepted. There is no right for any such communication or interlocutory decision, as requested by the appellant, on the admittance of a party's submission separate from the final decision. Indeed, the Board also holds, for the same reasons, that the appellant had no legitimate expectation of a request of this nature eliciting an interlocutory decision, dealing with the admittance of the proprietor's letter of reply to the opposition, prior to the final decision on the case.
 - 1.1.3 As regards the appellant's argument that it had been deprived of the opportunity to comment on the proprietor's letter of 12 January 2015, the Board finds

quite the contrary to be the case. In its letter of 25 February 2015, the appellant solely requested an interlocutory decision on the admittance of the proprietor's letter to be taken, and thereby choosing not to respond in substance to the substantive issues at stake raised in the proprietor's letter of reply to the opposition. It is also noted that a period of almost two years passed between this letter of the respondent and the issuing of the opposition division's final decision, which is viewed as a more than appropriate length of time for the appellant to have filed a considered response to the substantive issues of the case. Indeed, the appellant could easily have safeguarded its position by renewing its request for oral proceedings but instead tried to dictate a different course of action by the opposition division without however any legal basis for doing so.

- 1.1.4 The Board thus concludes that the appellant's right to be heard was duly respected before the opposition division (Article 113(1) EPC).

2. *Request for remittal and request for refund of the appeal fee*
 - 2.1 With its right to be heard having been respected (as explained above), the Board also finds no procedural violation to have been committed by the opposition division. No additional reason was identified by the appellant as to why the case should be remitted to the opposition division or the appeal fee be refunded, apart from the alleged infringement of the right to be heard. The Board also cannot identify of its own motion any reason to remit the case for further prosecution, in particular since the objections raised by the opponent relevant to the outcome of the appeal have all

been dealt with by the opposition division in its decision. The Board thus finds a valid reason neither for remitting the case to the opposition division for further prosecution (Article 111(1) EPC) nor for reimbursement of the appeal fee (Rule 103(1)(a) EPC).

3. *Main request*

3.1 *Article 100(c) EPC*

The ground for opposition under Article 100(c) EPC prejudices maintenance of the patent as granted since the subject-matter of claim 1 extends beyond the content of the application as filed.

3.1.1 As originally filed, the first feature of claim 1 reads: "A gas turbine comprising:
a plurality of stationary blades (31) disposed in a circle on an interior side of a vehicle".

In claim 1 as granted, the limitation to the stationary blades being disposed on an interior side of a vehicle was deleted, the word 'vehicle' being replaced with 'casing'. In the application as filed there is no basis for removing the originally claimed limitation that the stationary blades are disposed in a circle 'on an interior side of a vehicle'.

3.1.2 The term 'vehicle' is repeatedly and consistently used throughout the application in describing the disposition of the stationary blades of the gas turbine (see for example PCT publication of the application page 2, lines 2 to 3; page 3, last line; page 6, lines 4 to 5 and line 14). On reading the application as filed, therefore, the skilled person would recognise that the gas turbine is intended to be disposed on an

interior side of a vehicle, as indeed also defined in claim 1 as filed.

3.1.3 The respondent's argument that the application as filed is directed to other applications for gas turbines is not accepted. Whilst the two passages referred to by the respondent (page 1, 'Background Art'; page 12, 'Industrial Applicability') do not explicitly mention the term 'vehicle', the first passage relates to prior art arrangements to which the application as filed is not directed (indeed the first paragraph of page 1 entitled 'Technical Field' is drafted to be broader than the cited background art) and the second concentrates on the sealing air arrangements of the invention such that neither can be considered to disclose to the skilled person, in view of the disclosure in the application as a whole, a gas turbine without the limitation of the vehicle.

3.1.4 The respondent's reference to the 'three-point test' for deleting a feature from an originally filed claim is also not persuasive. In this regard, the test for an amendment to be allowable under Article 123(2) EPC is for the resultant subject-matter to be directly and unambiguously derivable, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application as filed. This is often referred to as the 'Gold Standard' (see G2/10, Reasons 4.3). The Board sees the three-point test simply as an aid in assessing the allowability of amendments, not as a substitute for the Gold Standard.

In the present case, the deletion of the term 'vehicle' from claim 1 is only permissible if, applying the Gold Standard, there is a direct and unambiguous basis for a

claim lacking this feature in the application as originally filed. As held in point 3.1.2 above, there is no such basis, the whole of the application as filed disclosing the gas turbine only in combination with a vehicle.

- 3.1.5 The argument that the term 'vehicle' was a non-essential feature for the claimed invention is not accepted. As to whether a feature is essential or not is irrelevant when considering the Gold Standard for allowability of an amendment i.e. whether the resultant subject-matter claimed has a direct and unambiguous basis in the application as filed. As found in points 3.1.2 and 3.1.4 above, the omission of the term 'vehicle' from claim 1 lacks such a basis, the skilled person finding an unambiguous disclosure of a gas turbine solely in combination with a vehicle when considering the whole of the application as filed.
- 3.1.6 The respondent's contention that the term 'vehicle' in claim 1 as filed did not make sense such that the skilled person would understand the drafter's intention as being 'casing' is also not accepted. As found above, a gas turbine disposed in a vehicle (and thus the stationary blades of the turbine also being disposed on an interior side of a vehicle) makes technical sense for a gas turbine powered vehicle, and indeed the overall teaching of the application as filed is just this. The skilled person would thus not see the word 'vehicle' in claim 1 as erroneous.
- 3.1.7 The respondent's argument regarding the term 'vehicle' being a mistranslation of the Japanese term used in the priority application does not justify a correction of the term 'vehicle' to be carried out for several reasons. Firstly, no request for a correction under

Rule 139 EPC of the term 'vehicle' was made before the examining division, nor has a request for correction been made since grant of the patent (leaving aside the issue of whether such a request could anyway be validly made during the appeal proceedings after the patent has been granted). Furthermore, any such correction would require the term 'vehicle' to be regarded by the skilled person as an obvious error in the sense that it is immediately evident that nothing else would have been intended to that which is offered as the correction (cf. Case Law of the Boards of Appeal, 9th edition, II.E.4, page 530 onwards). However, as indicated under point 3.1.6 above, the term 'vehicle' would not even be regarded as erroneous. Secondly, the priority application was anyway filed in the English language (as US 10/238651) such that an incorrect translation from that document cannot be understood to be the reason for the unintended term to be present in the application as filed before the EPO. It is also noted that, even if a translation from the priority application had been necessary, a translation error from a priority application is not a basis to correct the application documents, at least not at that stage of the procedure (cf. Rule 56(3) EPC).

- 3.1.8 It thus follows that the deletion of the term 'vehicle' from claim 1 as filed extends the subject-matter of claim 1 beyond the content of the application as filed.
- 3.1.9 At least for this reason, the ground for opposition under Article 100(c) EPC is prejudicial to maintenance of the patent as granted. The main request is therefore not allowable.

4. *Auxiliary requests - Admittance Article 13(1) RPBA*

4.1 Having been filed with letter of 20 July 2020, the admittance of the auxiliary requests is at the discretion of the Board under Article 13(1) RPBA 2007 and 2020. In exercising its discretion, the Board *inter alia* considers whether a newly filed request *prima facie* overcomes objections raised against foregoing requests.

4.2 In the present case the respective claim 1 of each of the auxiliary requests on file suffers from the same deficiency, albeit under Article 123(2) EPC, as claim 1 of the main request. The respondent stated in the oral proceedings that it had no further arguments in defence of these requests beyond those already presented with respect to claim 1 of the main request. Nor can the Board see anything that would alter its conclusion as compared to the main request.

4.3 The subject-matter of claim 1 of each of the auxiliary requests therefore *prima facie* fails to meet the requirement of Article 123(2) EPC. The Board thus exercised its discretion not to admit the auxiliary requests into the proceedings (Article 13(1) RPBA).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated