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**Datasheet for the decision
of 29 November 2021**

Case Number: T 1361/18 - 3.2.07

Application Number: 10186877.6

Publication Number: 2279797

IPC: B05B7/14, B05B1/26

Language of the proceedings: EN

Title of invention:
NOZZLE WITH INTERNAL FILTER

Patent Proprietor:
Nordson Corporation

Opponent:
Gema Switzerland GmbH

Headword:

Relevant legal provisions:
EPC Art. 100(a), 100(c), 114(1)
RPBA 2020 Art. 13(2), 15(1)

Keyword:

Auxiliary requests - late-filed (no)

Objections raised after summons - exceptional circumstances
(no)

Objections raised after summons - taken into account (no)

Decisions cited:

Catchword:



Beschwerdekammern
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Chambres de recours

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Case Number: T 1361/18 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 29 November 2021

Appellant: Gema Switzerland GmbH
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Representative: Trinks, Ole
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Respondent: Nordson Corporation
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 27 March 2018
rejecting the opposition filed against European
patent No. 2279797 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Pieracci
S. Watson

Summary of Facts and Submissions

I. The opponent (appellant) lodged an appeal in the prescribed form and within the prescribed time limit against the decision of the opposition division to reject the opposition against the European patent No. 2 279 797.

II. The opposition had been filed against the patent as a whole based on the grounds for opposition pursuant to Article 100 (a) and (c) EPC (lack of novelty and inventive step, added subject-matter). The opposition division found that none of the grounds for opposition prejudiced the maintenance of the patent as granted.

III. With the statement setting out the grounds of appeal the appellant requested

that the appealed decision be set aside and
that the patent be revoked.

At the oral proceedings the appellant confirmed these as its final requests.

IV. With the reply to the statement setting out the grounds of appeal the patent proprietor (respondent) requested:

that the appeal be rejected as inadmissible,
or in the alternative,
that the appeal be dismissed,
or in the further alternative,
that when setting the impugned decision aside the
patent be maintained on the basis of the set of
claims according to auxiliary requests 1 to 4 filed
in opposition proceedings with letter of

14 March 2017 and re-filed together with the reply to the statement setting out the grounds of appeal.

V. In preparation for the oral proceedings the Board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA 2020. The Board indicated that the appeal was considered admissible and that claim 1 of the patent as granted appeared to contain subject-matter extending beyond the content of the earlier application. The Board also indicated that it was not considered appropriate to address the auxiliary requests, since such requests did not appear to have been substantiated in detail by the respondent and the appellant had not objected to them.

VI. With letter dated 20 October 2020 the respondent withdrew the request to reject the appeal as inadmissible, the request to dismiss the appeal and to maintain the patent as granted, and the request to maintain the patent in amended form according to the first and second auxiliary requests. The respondent confirmed the request

to maintain the patent in amended form according to the third and the fourth auxiliary requests

and presented further arguments in support of the patentability of those requests.

VII. Oral proceedings before the Board took place on 29 November 2021 at the end of which the decision was announced. For further details of the oral proceedings reference is made to the minutes thereof. The respondent filed a new set of documents according to the third auxiliary request at the oral proceedings

as the basis for the requested maintenance of the patent in amended form.

VIII. The lines of argument of the parties are dealt with in detail in the reasons for the decision.

IX. Claim 1 according to the third auxiliary request reads (the amendments with respect to claim 1 of the patent as granted being highlighted by the Board):

"A nozzle for a powder spray gun, comprising a nozzle body having a flow path for powder along a main flow axis, said nozzle body comprising an outlet (70) that is off axis relative to said main flow axis, a first internal surface (76) and a second internal surface (82), characterized in that said first internal surface (76) comprises a surface at an angle to said main flow axis such that it presents an obstruction which redirects powder from said main flow axis towards said second surface (82) and said second surface (82) directs powder flow to said outlet (70), and in that powder flows through said outlet (70) in a spray pattern along an axis that is parallel to and radially offset from said main flow axis, said outlet (70) being provided by an outlet slot (70)."

X. In view of the decision taken by the Board there is no need to reproduce the claims of the fourth auxiliary request.

Reasons for the Decision

1. Admittance of the third and of the fourth auxiliary requests into the proceedings
- 1.1 The appellant argues that the third and the fourth auxiliary requests filed with the reply to the statement setting out the grounds of appeal were unsubstantiated at the time of filing, as outlined by the Board in its preliminary opinion.
The auxiliary requests have been substantiated only after the preliminary opinion of the Board was issued and they are therefore to be seen as late filed. Since they raise issues of clarity and of added subject-matter they are not *prima facie* allowable and should not be admitted into the proceedings. Furthermore the respondent has not indicated how the auxiliary requests would resolve any of the upstanding issues.
- 1.2 The Board disagrees for the following reasons.
In its preliminary opinion the Board did not indicate that the auxiliary requests were unsubstantiated, but rather that, since they appeared not to have been substantiated in detail and the appellant had not objected to them, it was not considered appropriate to address them (see point 10 of the communication pursuant to Article 15(1) RPBA 2020).
- 1.3 Whether or not the third and fourth auxiliary requests were sufficiently substantiated is to be assessed in particular in view of the relevant procedural stage of their filing. The filing of claim requests needs to be accompanied by arguments to allow the Board and the other party to examine whether the claimed subject-matter has a basis in the application as originally filed, and whether the requests address objections

which have been decided upon in the decision under appeal and which were admissibly raised by the other party, here the appellant.

- 1.4 In the case at hand, the degree of required substantiation by the respondent when filing the auxiliary requests with its reply to the appellant's appeal thus depends on the extent of substantiation of the appellant's objections in the statement of grounds of appeal.
- 1.5 As argued by the respondent, the third and the fourth auxiliary requests address the contested issue of added subject-matter of the patent as granted (see point 2.8 of the statement setting out the grounds of appeal) by introducing into the independent claim the allegedly missing feature that the outlet is provided by an outlet slot. This is immediately apparent from the wording of the independent claim itself and it is indicated in the third and fourth paragraphs of point 1.3 of the reply to the statement setting out the grounds of appeal.
- 1.6 The Board also notes that since the appellant has not admissibly raised any other objection with the statement setting out the grounds of appeal (see points 8 and 9 of the communication pursuant to Article 15(1) RPBA 2020) the respondent, by filing the third and the fourth auxiliary requests, has completely addressed the appellant's case when replying to the statement setting out the grounds of appeal.
- 1.7 The third and the fourth auxiliary requests, therefore, have been sufficiently and timely substantiated in respect to the admissibly raised objections at the time of their filing with the reply to the statement setting

out the grounds of appeal. The arguments of the appellant relying on the fact that the requests have been substantiated only after the communication of the Board thus do not hold.

The third and the fourth auxiliary requests are therefore admissible.

2. Admittance into the proceedings of the objections of clarity and of added subject-matter with regard to the third and to the fourth auxiliary requests

2.1 The appellant argues that claim 1 of the third and of the fourth auxiliary requests is not clear and that added subject-matter is present because of the feature added to claim 1 of the patent as granted that the first internal surface "comprises a surface at an angle to said main flow axis...".

The appellant argues that since the auxiliary requests were not substantiated until the reply of the respondent to the preliminary opinion of the Board, it could have not presented its objections earlier.

2.2 The Board disagrees.

As indicated in point 1 above, the third and the fourth auxiliary requests were timely substantiated in relation to all the issues admissibly raised by the appellant with the statement setting out the grounds of appeal.

It was then up to the appellant to raise any objection it considered appropriate to the amendments introduced by the respondent as soon as it was aware of the respondent's auxiliary requests.

The reasons offered by the appellant for raising its objections only at the oral proceedings are therefore not convincing.

The Board considers that the appellant should have raised its objections in a timely manner, *i.e.* in response to the reply to the statement setting out the grounds of appeal, or at least after the Board indicated in point 10 of the communication pursuant to Article 15(1) RPBA 2020 that the appellant had not objected to the auxiliary requests, or at the latest by replying to the letter of the respondent dated 20 October 2020.

- 2.3 By raising its objections to the third and to the fourth auxiliary requests for the first time at the oral proceedings the appellant has amended its appeal case after notification of the summons to oral proceedings and at the latest possible point in time.

As indicated by the Board in point 12 of the communication pursuant to Article 15(1) RPBA 2020, the admittance of new submissions after notification of a summons to oral proceedings is subject *inter alia* to Article 13(2) RPBA 2020.

Article 13(2) RPBA 2020 states that any "amendment to a party's appeal case made...after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned."

No exceptional circumstances justified by cogent reasons as required by Article 13(2) RPBA 2020 have been presented by the appellant for justifying its

course of action (see point 2.1 and 2.2 above), nor are any exceptional circumstances apparent to the Board.

2.4 The objections of the appellant to the third and to the fourth auxiliary requests are therefore not admitted into the proceedings pursuant to Article 13(2) RPBA 2020.

3. No other patentability objections to the third auxiliary request were raised by the appellant (see page 4, first paragraph, of the minutes of the oral proceedings before the Board).

The appellant argued at the oral proceedings that the Board should examine the patentability of the third and of the fourth auxiliary requests of its own motion pursuant to Article 114(1) EPC.

The Board does not consider this argument valid and notes that it is established case law that the principle, that the EPO must examine the facts of its own motion in proceedings before the administrative departments and divisions of the EPO, does not have the same legal importance in judicial appeal proceedings, in particular in inter partes proceedings, since these are contentious proceedings between parties representing opposite interests, who should be given equally fair treatment.

This established case law is enshrined in the Rules of Procedure of the Boards of Appeal, which the Board applies also in the present case concluding that no admissible objection stands against the patent as amended according to the third and to the fourth auxiliary requests (see point 2 above).

4. Adaptation of the description

During the oral proceedings the respondent filed an amended version of the description which had been adapted to the claims as amended according to the third auxiliary request. The appellant had no objections thereto.

The Board also does not see any reasons to object to the amended description.

5. Conclusions

In summary, in reviewing the decision under appeal, the Board finds that the decision under appeal cannot be upheld since the respondent no longer requests the maintenance of the patent in granted form.

The appellant has not raised any admissible objection against the maintenance of the patent in amended form according to the third auxiliary request, so that the patent shall be maintained in amended form accordingly.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent as amended in the following version:

Description:

Col. 1 - 9 received during oral proceedings of
29 November 2021

Claims:

No. 1 - 10 received during oral proceedings of
29 November 2021

Drawings:

Fig. 1 - 11 received during oral proceedings of
29 November 2021.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated