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**Datasheet for the decision
of 27 June 2022**

Case Number: T 2730/19 - 3.2.04

Application Number: 15762071.7

Publication Number: 3117872

IPC: A62C3/02, B64D1/16, A62C5/02

Language of the proceedings: EN

Title of invention:
FIRE EXTINGUISHING DEVICE FOR IN-AIR USE

Applicant:
Álvarez Montaner, Lluís

Headword:

Relevant legal provisions:
EPC Art. 123(2)
RPBA 2020 Art. 13(2)

Keyword:
Amendments - allowable (no)
Late-filed argument - admitted (no)

Decisions cited:
G 0002/10, T 1748/08, T 0640/91, T 0922/08, T 0197/10

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 2730/19 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 27 June 2022

Appellant: Álvarez Montaner, Lluís
(Applicant) C/ de la Mina 107
08211 Castellar del Vallès (Barcelona) (ES)

Representative: Canela Giménez, Teresa
C/ Girona, 148, 1-2
08037 Barcelona (ES)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 22 May 2019
refusing European patent application No.
15762071.7 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman J. Wright
Members: G. Martin Gonzalez
C. Heath

Summary of Facts and Submissions

- I. The appeal was filed by the appellant (applicant) against the decision of the examining division to refuse the patent application in suit.
- II. The examining division decided not to admit into the proceedings the only request (now auxiliary request 1) that was on file at the time of taking its decision.
- III. Oral proceedings before the Board were duly held on 27 June 2022.
- IV. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the Main Request (claims filed on 7 March 2018), or one of auxiliary Requests 1 (claims filed on 11 February 2019) or 2 (claims of the published application, EP 3 117 872 A1) in the auxiliary that the case be remitted to the examining division on the basis of one of these requests.
- V. Claim 1 of the various requests reads as follows:

Main request: "A FIRE-EXTINGUISHER DEVICE SUITABLE FOR AERIAL USE, CHARACTERISED by the fact that it comprises:

- means that allow the pilot to control the stream of an extinguishing agent over a desired target,
- said fire extinguishing agent is an aerated mixture of foam concentrate and water, or a mixture of fire-retardant and water, or water,
- means to perform said fire extinguishing agent,

- said device (1) has a cylindrical body (6) and an interior cylinder (4), said interior cylinder (4) being open at a top and a bottom thereof,
- a water tank (11) is formed within said device (1) between said cylindrical body (6) and said interior cylinder (4),
- said water tank (11) is accessible through the top of said interior cylinder (4) to facilitate filling of said water tank (11), and
- the internal space of said interior cylinder (4) acts as an expansion chamber (12) during dispersal of the extinguishing agent and as a water inlet when refilling said water tank (11) by immersion; and
- under the pressure supplied by a pump (18), said device (1) has at least one agitation nozzle (14) for ejecting said fire extinguishing agent into said expansion chamber (12) for dispersal of the extinguishing agent through an outlet".

Auxiliary request 1: "A FIRE-EXTINGUISHER DEVICE · SUITABLE FOR AERIAL USE, CHARACTERISED by the fact that it comprises:

- means that allow the pilot to control the opening and discharge, and that uses as the extinguishing material a mixture of fire-inhibiting or fire-retardant substances and water,
- said device (1) has a cylindrical body (6) and an interior cylinder (4), said interior cylinder (4) being open at a top and a bottom thereof,
- a water tank (11) is formed within said device (1) between said cylindrical body (6) and said interior cylinder (4),
- said water tank (11) is accessible through the top of said interior cylinder (4) to facilitate filling of said water tank (11), and

- the internal space of said interior cylinder (4) acts as an expansion chamber (12) during dispersal of the extinguishing agent and as a water inlet when refilling said water tank (11) by immersion; and
- under the pressure supplied by a pump (18), said device (1) has at least one foam jet dispersing nozzle (14) for ejecting said fire extinguishing mixture and foaming-agent into said expansion chamber (12) for dispersal of the extinguishing agent through an outlet".

Auxiliary request 2: "A FIRE-EXTINGUISHER DEVICE FOR AERIAL USE, of the type that uses a receptacle containing the extinguishing agent, with means that allow the pilot to control the opening and discharge, and that uses as the extinguishing material a mixture of fire-inhibiting or fire-retardant substances and water,

CHARACTERISED by the fact that it consists of a bucket (1) with a cylindrical body (6) that is fitted with an interior cylinder (4), which is open at the top and bottom, delimiting a water tank (11) within an exterior annular area, accessible and communicated at the top of the said interior cylinder (4), and internally by means of a cylinder that acts as an expansion chamber (12) during the dispensing of the foam and as the water inlet when refilling by immersion; the said expansion chamber (12) receives a foaming-agent and extinguishing mixture, dispensed and under pressure through a foam jet dispersing nozzle (14)".

VI. In the present decision, reference is made to the following documents:

The published application in English: EP3117872A1

The published application in Spanish: WO2015/136128A1.

VII. The appellant's arguments can be summarised as follows:

The examination proceedings were fundamentally flawed by a substantial procedural violation. The subject matter of claim 1 of auxiliary request 1 does not add subject matter extending beyond the application as originally filed.

Reasons for the Decision

1. The appeal is admissible.

2. Introduction

The applicant relates to a device for the extinguishing of fires, which is suitable for being carried by helicopter and filling with water externally (see published EP application, paragraph [0001]).

3. Alleged substantial procedural violation

3.1 At the oral proceedings before the Board, the appellant-applicant argued for the first time that a substantial procedural violation had been committed by the examining division. On the one hand this arose from a formulation in its decision (reasoning, point 11) that the applicant's letter of 11 February 2019 "completely eludes providing the basis of the amendments according to Rule 137(4) EPC". On the other hand it was due to the division refusing the application without giving the applicant an opportunity to comment and make further amendments or communicating by telephone. Therefore, the appellant considered the case to be fundamentally flawed, warranting its immediate remittal to the examining division.

- 3.2 According to Article 12(2) of the Rules of Procedure of the Boards of Appeal (RPBA) 2007, the statement of grounds of appeal and the reply must set out the parties' complete case. In particular, it must be set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld. Any amendment to a party's appeal case after this is only admitted at the Board's discretion. The Board exercises its discretion in view of, amongst other things, the suitability of the amendment to resolve issues raised by the Board (Article 13(2) RPBA 2020). Where, as in the present case, amendments are made after the Board has issued its communication, the stricter requirements of Article 13(2) RPBA 2020 apply, according to which such amendments shall, in principle not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
- 3.3 In its grounds of appeal, the appellant had argued that the Board should consider its various requests. The alleged substantial procedural violation argued for the first time at the oral proceedings before the Board would, if accepted, result in the immediate remittal of the case (Article 11 RPBA 2020). This new argument therefore constitutes a fundamental amendment to the appellant's case and its admittance is subject to the Board's discretion as explained above.
- 3.4 The only reason given by the appellant for this late amendment was that the representative had only recently been appointed and had a fresh perspective on the case. In accordance with established jurisprudence, see Case Law of the Boards of Appeal, 9th edition, 2019 (CLBA)

V.A.4.8.2 and the cited cases, for example **T1748/08**, reasons point 3, a change in representative usually results from the party's own decision and is generally not an acceptable ground for late filing. This would seem to apply in the present case and the Board sees no special reason for deviating from this principle. For this reason alone, the newly alleged fact (substantial procedural violation) is not admissible.

- 3.5 Moreover, *prima facie*, the Board does not consider that the examining division committed a substantial procedural violation. Such a violation, per definition, must be a procedural one. In this regard, the appellant has cited **T0640/91**. This decision sets out (see point 6.1) that in certain circumstances, there will be a legal obligation upon an examining division to invite further observations from the Applicant before issuing a decision. For example, an examining division should invite further observations from an applicant before issuing a decision based on grounds or evidence on which the applicant had not previously had an opportunity to present its comments (Article 113(1)EPC); and a failure to do so would be a substantial procedural violation within the meaning of Rule 67 EPC.

In the Board's view, the present case is different from that explained above in that the applicant had been invited to comment on the issues of added subject matter, Article 123(2) EPC and to explain a basis for any amendments in accordance with Rule 137(4) EPC in communications prior to the issuing of a decision, see for example the division's communication of 4 June 2018, point 2.5 and the communication of 10 October 2018, sections 2 and 3. That the appellant chose not to pursue its previous requests but to submit

new requests does not change the fact that it had been made aware of the relevant issues and the consequences of non-compliance prior to the examining division's decision being issued.

- 3.6 The appellant found the statement in point 11 of the decision to be untrue, to be offensive and inappropriate. In this regard, the Board considers that the division's choice of wording in arguing why it considered there to be non-compliance with Rule 137(2) EPC in its decision (*completely eludes* [to providing a basis]) is a purely objective statement setting out how it perceived the applicant's written submissions, rather than an attempt to offend, whether or not the statement is true. That the appellant feels offended by the wording or considers it to tarnish its honour has no bearing on the correctness of the underlying procedural steps taken by the division (non admittance of a request). Thus the use of the wording itself does not constitute a procedural violation.
- 3.7 The appellant has also argued that the examination proceedings were incorrect in that the examining division should have telephoned the applicant to explain its position rather than refuse the application.
- 3.7.1 In accordance with established jurisprudence (see CLBA III.C.2.1.3 and IV.B.2.9.1, for example **T300/89** reasons, point 9.3) a telephone conversation is an informal way of communicating with a party. Unlike oral proceedings (which, in the present case were not requested in the examination proceedings), a party has no right to such an informal communication. Rather, it lies at the discretion of the examiner. The appellant is correct in saying that the Examination Guidelines

set out how this discretion is best exercised, giving examples of situations where a telephone conversation would be appropriate. However, whether or not the present case corresponds to such a situation, the procedure for such conversations remains informal in the sense that it is not governed by the EPC, but is merely an additional informal procedure. Therefore, not conducting such a conversation cannot constitute a procedural violation.

3.8 For all these reasons, the Board decided not to admit the applicant's late request for immediate remittal of the case due to an alleged substantial procedural violation.

4. Amissibility of the main request and auxiliary request
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4.1 According to Article 12(4) RPBA (2007), a Board may hold inadmissible requests that could have been filed during first instance proceedings. This applies all the more so to requests which were filed and subsequently withdrawn in the examination proceedings. Such requests manifestly could have been presented in those proceedings for a final decision.

The main purpose of an appeal against a refusal of an application is to give the appellant the opportunity to have the decision reviewed on its merits. Thus, to have reviewed what was decided and not what was not decided. Admitting requests in appeal which the party chose not to present for a decision in examination would be incompatible with this purpose (see Case Law of the Boards of Appeal, 9th edition, 2019 (CLBA), V.A. 4.11.4.c, for example **T0922/08**, reasons 2.1).

4.2 The present second auxiliary request is the application as published. The search examiner identified objections to this original request in its written opinion of 21 August 2017. The request was replaced by the present main request with the applicant's letter dated 7 March 2018. The examining division raised objections against this request in communications dated 4 June 2018 and 10 October 2018. The applicant responded by replacing the request with a new claim set (present auxiliary request 1) with a letter dated 11 February 2019. The appellant-applicant's actions prevented the examining division from issuing a reasoned decision on the merits of what are now the main and second auxiliary requests. In the Board's view, admitting these requests and dealing with them in appeal would mean giving a first ruling on them which would be contrary to the judicial review nature of appeal proceedings.

4.3 For these reasons, the Board decided not to admit the main request and auxiliary request 2 into the proceedings.

4.4 Admittance of auxiliary request 1

4.4.1 Auxiliary request 1 was the only request on file at the end of the examination proceedings. The examining division (see impugned decision section II, points 9 to 13 and section III, point 15) did not admit it into the proceedings.

4.4.2 According to settled jurisprudence of the Boards of appeal (see CLBA I V.C.4.5.2, and the cited decisions, for example **T0640/91**, headnote III and reasons, 6.3) a board of appeal should only overrule the way in which a department of first instance has exercised its discretion if it applied the wrong principles, or

without taking into account the right principles, or in an unreasonable way.

4.4.3 The reasons for the examining division's decision (see impugned decision, section III.15) not to admit the request pertains to the requirement to indicate a basis for amendments under Rule 137(4) EPC. This rule obliges the applicant, when filing any amendments, to identify them and indicate the basis for them in the application as filed. The decision conflates this requirement with certain criteria it applied for the admissibility of amendments laid out in communications of 4 June 2018 section 2.6 and 10 October 2018 section 4, which read as follows: *It is settled case law that the admissibility of amendments depends among other things on:*

- (i) whether they overcome all the outstanding objections;*
- (ii) whether they fulfill the requirements of Article 123(2) EPC;*
- (iii) whether the amended claims converge with or diverge from the subject-matter previously claimed i.e. whether they develop and increasingly limit the subject-matter of the independent claim of a main request in the same direction and/or in the direction of a single inventive idea or whether they entail different lines of development because for instance they each incorporate different features.*

In so far as compliance with Rule 137(4) EPC is concerned, the criterion (i) and (ii) appear to require compliance with Article 123(2) EPC. This appears to be the wrong criterion because presenting an argument for compliance is not the same as meeting the compliance itself (see Guidelines for examination section H.III. 2.1, third paragraph). With regard to the third

criterion (convergence), the applicant only ever had one request on file at a time since it did not pursue the preceding request when filing the next. Therefore, the issue of convergence with a main request is irrelevant.

- 4.4.4 From the above, the Board considers that certain principles applied by the examining division in examining admissibility of the present request were wrong. Moreover, the appellant-applicant provided more detailed reasons in its grounds of appeal than it had in examination as to why it believed this request met the requirements of Article 123(2) EPC. Therefore, the Board decided to admit auxiliary request 1 into the proceedings.
5. Auxiliary request 1, added subject matter, Article 123(2) EPC
- 5.1 In this section, unless stated otherwise, references to the application as originally filed are to the published EP application in English.
- 5.2 In deciding the question of allowability of amendments under Article 123(2) EPC, the Board, following well established practice, must consider whether the amendments in question are directly and unambiguously derivable by the skilled person from the application as filed, using normal reading skills and, where necessary, taking account of their general knowledge. This is the "gold standard" according to which amendments are assessed (see **G 2/10**, reasons 4.3).
- 5.3 Present claim 1 is based on claim 1 as originally filed. However, certain features have been amended.

- 5.4 Feature: - [the] device has a cylindrical body and an interior cylinder [...], *a water tank is formed within said device between said cylindrical body and said interior cylinder*
- 5.4.1 This (water tank) feature is said to be based on the following feature of original claim 1: a bucket (1) with a cylindrical body (6) that is fitted with an interior cylinder (4), which is open at the top and bottom, delimiting a water tank (11) within an exterior annular area.
- 5.4.2 The original claim wording defined an annular area, exterior to the inner cylinder and between the two cylinders. The word annular means ring shaped, and thus the area must be continuous around the inner cylinder. However, in the present wording of the feature this is not necessarily the case. For example, the present feature would cover an arrangement where the [smaller] inner cylinder touched the interior of the outer cylinder at one point, precluding an annular area. Therefore, the feature has been broadened. It is not in dispute that in the original description and drawings there is always an annular area between the inner and outer cylinders, see for example paragraph [0037] and figure 3. Therefore, in its present broad form (without an annular area), the Board considers that there is no direct and unambiguous original disclosure of the feature. Thus, it adds subject matter extending beyond the application as originally filed.
- 5.4.3 In this regard, the appellant-applicant has argued that the word *annular* is redundant in the present feature, that is implicit, since the skilled person would interpret the claim in the light of the description and drawings where they would find that the water tank is

always limited to one formed in an annular space. The Board disagrees with this approach.

In accordance with established jurisprudence, see CLBA II.A.6.3.1, in particular **T0197/10**, headnote and reasons point 2.3, if the claims are worded so clearly and unambiguously as to be understood without difficulty by the person skilled in the art, there is no need to use the description to interpret the claims. In the event of a discrepancy between the claims and the description, the unambiguous claim wording must be interpreted as it would be understood by the person skilled in the art without the help of the description.

In the present case, the Board considers that the *water tank* feature is completely clear, nor has the contrary been argued by the appellant. Therefore, the skilled person would not resort to the description to give it a narrower interpretation (tank within an annular area). Therefore, the appellant-applicant's argument is moot.

- 5.4.4 The appellant has also argued that the word *between* in the feature implies that there is an annular space between the inner and outer cylinders. The Board sees it differently.

The role of the word *between* in the feature is to qualify where the water tank is formed. Considering again the above example of the feature being so broad as to cover a [smaller] inner cylinder that touched an outer cylinder at one point, there would still be a crescent shaped space *between* the cylinders in which the water tank could be formed. However, in this example, the cylinders touch, so there is no *annular* space between the cylinders for the water tank, as was originally disclosed.

- 5.4.5 The wording of the *water tank* feature of the present claim furthermore leaves open whether the interior cylinder *delimits* the water tank, as was the case in the original claim.

The skilled person reads the claim, and indeed the whole application, giving terms their usual meaning. The word *delimits* (see Oxford English dictionary OED online) means "[t]o mark or determine the limits of (something); to mark off, separate, or distinguish (something) from something else". Therefore, contrary to how the appellant has argued, the Board considers that, in the original claim, the inner cylinder defined a limit of the water tank. In the present claim, this is no longer the case, so the feature has been broadened in this respect. For example, according to the present claim, the water tank could be formed anywhere between the inner and outer cylinders so its extent does not need to be limited by the inner cylinder.

Nor do the description and drawings provide a basis for a water tank that is not delimited by the inner cylinder. There, see for example paragraph [0037] with figure 3, the inner cylinder 4 is described and depicted as delimiting the water tank 11.

Therefore, also for this reason, the *water tank* feature adds subject matter extending beyond the application as filed.

- 5.5 Feature: - at least one foam jet dispersing nozzle
- 5.5.1 By defining *at least one [...] nozzle*, the claim covers the possibility of there being more than one nozzle. In

the Board's view, there is no direct and unambiguous disclosure for this in the application as filed.

Original claim 1 defined a *nozzle* in the singular. By the same token, where a nozzle is mentioned in the description of the invention (see paragraphs [0027], [0031], [0037], [0051]) only nozzle in the singular is explicitly disclosed.

- 5.5.2 The appellant-applicant has argued that a plurality of nozzles has a basis in the drawings, in particular figures 2 and 3 which is described in paragraph [0037]. This paragraph explains that a nozzle 14 (singular) has (plural) injectors 15. As seen in figures 2 and 3 it is true that the nozzle 14 appears to be supplied by a single inlet tube 13 and to have three branches, each of which is provided with a respective injector 15. In the Board's view, the nozzle 14 is still a single nozzle albeit one with three branches, irrespective of the fact that the reference 14 points to just one of these branches.

Therefore, from the application as filed, there is no direct and unambiguous disclosure of more than one nozzle.

- 5.5.3 The application was originally filed in Spanish, which is therefore the authentic text, Article 70(2) EPC. The Board comes to the same conclusion when considering the published WO application in Spanish. There, in the description of figure 3 (see page 11, lines 20 to 25 - which appears to correspond to paragraph [0037] of the EP application), it is stated: "[...] donde existen la entrada [...] de espumante (13) que termina esta ultima en una tobera de disgregación (14) del chorro de espumante, en cuyos extremos se colocan unos inyectores

(15)". In this passage, consistent with the EP application, only one nozzle (una tobera) is defined, albeit one having a plurality of ends (extremos) at which injectors are placed. Therefore, also here, the Board does not consider there to be a direct and unambiguous disclosure of a plurality of nozzles.

In this regard the appellant-applicant has argued that the Spanish language is more flexible than English so although only a nozzle (singular) with a plurality of ends is defined, the passage could also be interpreted as referring to a plurality of nozzles.

In the Board's view, however flexible the Spanish language may be in interchanging singulars and plurals, at least the explicit disclosure of a *nozzle* in the singular is not a direct disclosure of a plurality of nozzles (at least one). Moreover, if the passage leaves it open as to whether a single nozzle or a plurality of nozzles is intended as the appellant has argued, it is also not an *unambiguous* disclosure of a plurality of nozzles.

- 5.6 For all these reasons, the Board concludes that claim 1 contains added subject matter that extends beyond the content of the application as filed. Therefore, it does not meet the requirements of Article 123(2) EPC.
6. Since the main request and auxiliary request 2 are not admitted into the proceedings, and the appellant's remaining request, auxiliary request 1, does not meet the requirements of Article 123(2) EPC, the Board must dismiss the appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

J. Wright

Decision electronically authenticated