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**Datasheet for the decision
of 25 September 2023**

Case Number: T 0246/20 - 3.2.06

Application Number: 09724235.8

Publication Number: 2256318

IPC: F01D25/28, F02C7/20, F23R3/60

Language of the proceedings: EN

Title of invention:

COMBUSTOR TRANSITION PIECE GUIDE JIG AND METHODS OF DETACHING
AND ATTACHING A COMBUSTOR OF A GAS TURBINE

Patent Proprietor:

Mitsubishi Hitachi Power Systems, Ltd.

Opponent:

Ansaldo Energia Switzerland AG

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(2)
RPBA 2020 Art. 13(2)

Keyword:

Grounds for opposition - subject-matter extends beyond content of earlier application (yes)

Amendments - added subject-matter - auxiliary requests 1 to 3 (yes)

Amendment after notification of summons - exceptional circumstances (no)

Decisions cited:

G 0003/89, G 0011/91, G 0002/10

Catchword:



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Case Number: T 0246/20 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 25 September 2023

Appellant: Ansaldo Energia Switzerland AG
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
21 November 2019 concerning maintenance of the
European Patent No. 2256318 in amended form.**

Composition of the Board:

Chairman T. Rosenblatt
Members: M. Hannam
J. Hoppe

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. 2 256 318. It requested that the decision under appeal be set aside and the patent be revoked.
- II. In its reply to the appeal, the respondent (patent proprietor) requested that the appeal be dismissed or, in the alternative, that the patent be maintained according to one of auxiliary requests 1 to 3.
- III. The Board issued a summons to oral proceedings and a subsequent communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA 2020) containing its provisional opinion, in which it indicated *inter alia* that the ground for opposition under Article 100(c) EPC appeared to be prejudicial to maintenance of the patent as granted. It further indicated that the subject-matter of claim 1 of each of auxiliary requests 1 to 3 failed to overcome this objection.
- IV. With letter of 24 July 2023 the respondent filed auxiliary request 4.
- V. Oral proceedings were held before the Board on 25 September 2023 at the end of which the parties' requests were as follows:

The appellant requested that the decision under appeal be set aside and the European patent be revoked.

The respondent requested that the appeal be dismissed

(main request) and the patent be maintained as granted, or as an auxiliary measure, that the patent be maintained in amended form based on one of auxiliary requests 1 to 3, filed with the reply to the grounds of appeal, or based on auxiliary request 4, filed on 24 July 2023.

VI. Claim 1 of the patent as granted (main request) reads as follows:

"A combustor-transition-piece guide jig (50) which is configured to be attached/detached to/from a gas turbine (1) to be used at a time of attaching a combustor (12) to the gas turbine (1) or detaching the combustor (12) from the gas turbine (1) for inspection, replacement or maintenance but not to be present in the gas turbine (1) during combustion operation, wherein the combustor (12) includes a nozzle block (30) for burning, in operation, fuel together with air to generate combustion gas and a combustor transition piece (33) that connects the nozzle block (30) with a turbine (13) of the gas turbine (1) to guide the combustion gas to the turbine (13), and wherein the combustor transition piece (33) includes a combustor-transition-piece guiding part (40) provided on an outer circumference of the combustor transition piece (33), the combustor-transition-piece guide jig (50) comprising:

two rails (51,52) that are configured to be inserted from a combustor attachment port (28) formed in a combustor casing (27) of the gas turbine (1) for attaching the combustor (12) toward inside of the combustor casing (27), to come into contact with the combustor-transition-piece guiding part (40) to support the mass of the combustor transition piece (33), and to guide a movement of the combustor transition piece (33)

along the rails (51,52); and a fixing member (53) that is provided at one end of the rails (51,52) and is adapted to be attached to the combustor attachment port (28) to fix the rails (51,52) to the combustor attachment port (28)."

Claim 1 of auxiliary request 1 reads as for claim 1 of the main request with the following feature appended:

"wherein the rails (51, 52) are a curved structure according to a curved portion of the combustor transition piece (33)".

Claim 1 of auxiliary request 2 reads as for claim 1 of the main request with the addition after '... to guide a movement of the combustor transition piece (33) along the rails (51, 52)' of the feature:

"while the combustor-transition-piece guiding part (40) is put between the two rails (51, 52)".

Claim 1 of auxiliary request 3 reads as for claim 1 of auxiliary request 2 with the following feature appended:

"wherein the rails (51, 52) are a curved structure according to a curved portion of the combustor transition piece (33)".

In claim 1 of auxiliary request 4 the respondent included several features from the description.

VII. The appellant's arguments relevant to the present decision may be summarised as follows:

Main request

The subject-matter of claim 1 extended beyond the content of the application as filed. The inclusion of two rails in claim 1 omitted the further features which were disclosed in combination with this, such as the holding member 54 with a support 56 formed thereon and the fixing member being a plate-like member. Figure 3 was a simplified sketch to illustrate the interaction between the combustor transition piece and the guide jig and did not provide an unambiguous disclosure of the guide jig support being optional. Paragraphs [0034] and [0035] of the application as filed did not provide a generalisation of the disclosure enabling two rails to be included in claim 1 without the further structurally and functionally related features disclosed in combination with the two rails.

Auxiliary requests 1 to 3

The subject-matter of claim 1 of each of these requests failed to overcome the objection with respect to the main request of added subject-matter.

Auxiliary request 4

This should not be admitted. All the objections of added subject-matter had been on file since the beginning of the opposition procedure and no exceptional circumstances justified an amendment being made after the parties had been summoned to oral proceedings. Two years had passed between the entry into force of the new Rules of Procedure and the summons to oral proceedings before the Board during which the respondent failed to file an auxiliary request avoiding the strict application of Article

13(2) RPBA 2020.

VIII. The respondent's arguments may be summarised as follows:

Main request

Claim 1 as filed disclosed the broadest definition of the guide jig, including just a rail and a fixing member i.e. a cantilever support from the combustor attachment port for the guide jig. The other features disclosed in combination with the two rails in the detailed embodiment were thus not essential to the most general abstraction of the invention and were thus simply advantageous features. Figure 3 and paragraph [0024] provided a general disclosure of the invention disclosing the essential interaction between the combustor-transition-piece 33 and the guide jig 50. No mention was made of a holding member 54, a side support 56 or a guide jig support 41 such that this abstraction also applied to a two-rail guide jig. These features were also not indispensable elements in order to solve the problem posed. Paragraph [0035] further disclosed that one or two-rail jigs were possible, yet a lack of further features disclosed in this paragraph showed that the number of rails was functionally not necessarily linked to the other features. The number of rails was thus an isolated issue and the proprietor had chosen two. The disclosure specifically on page 16, lines 12 to 21 and lines 30 to 33 clearly indicated that the number of rails could be either one or two; this could be compared to the disclosure that a corresponding dependent claim would provide. Paragraphs [0029] to [0031] also disclosed an optimisation of the invention which did not include the additional features alleged by the appellant to necessarily be disclosed in

combination with the two-rail embodiment.

Auxiliary requests 1 to 3

The amended claims are further restricted as compared to the granted claims and are supported by the originally filed application documents. Therefore, the claims should be permissible according to Art.123(2) and (3) EPC.

Auxiliary request 4

This request should be admitted. Both the examining division and the opposition division had been wholly positive regarding added subject-matter in claim 1 as granted. The Board's communication had been received relatively late and the amendments were promptly filed in reaction to the preliminary opinion. It was surprising that the Board had concurred with the appellant regarding which features were missing from claim 1. The reply to the grounds of appeal had also been filed shortly after the new Rules of Procedure were adopted such that the interpretation of 'exceptional circumstances' was still fluid.

Reasons for the Decision

1. *Main request*

Article 100(c) EPC

- 1.1 The ground for opposition under Article 100(c) EPC prejudices maintenance of the patent as granted.

- 1.2 In reaching this conclusion, the Board makes reference to Enlarged Board of Appeal decisions G 3/89 and G 11/91 (OJ EPO 1993, 117 and 125) in which it was ruled that any amendment to a European patent application or a European patent relating to the disclosure can, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed. Subsequently in G 2/10 (OJ EPO 2012, 376), this was referred to as the 'gold' standard for assessing any amendment for its compliance with Article 123(2) EPC. The present Board does not see any justification for diverging from the gold standard in the case before it.
- 1.3 As originally filed, claim 1 defined the combustor-transition-piece guide jig as 'comprising a rail' that is inserted from a combustor attachment port. Claim 1 as granted defines the combustor-transition-piece guide jig as 'comprising two rails' that are configured to be inserted from a combustor attachment port.
- 1.4 The only disclosure in the application as filed of a combustor-transition-piece guide rig having two rails is found in the description of the sole detailed embodiment. This is disclosed in detail from paragraphs [0028] to [0034]. In this embodiment, the sole embodiment of the invention, the two rail guide jig is disclosed in functional and structural combination with a number of additional features such as a holding member 54, a fixing member 53, a side support 56, the fixing member being a plate-like member and the jig having two supports, one at the holding member 54 and one at the fixing member 53. The adoption into claim 1

of the feature defining the guide jig to comprise two rails without at least the additional features disclosed in combination in the embodiment is thus an unallowable intermediate generalisation of the original disclosure.

- 1.5 The respondent argued that the most general abstraction of the invention was disclosed in claim 1 as filed which showed that the features allegedly missing from claim 1 were not essential to the invention, in particular not indispensable to solve the problem posed by the invention. This, however, is not the test for what was directly and unambiguously disclosed to the skilled person in the application as filed. Claim 1 as filed defined the combustor-transition-piece guide jig simply to comprise a rail and it is in this generalised context that the claim indeed defines the guide jig without a holding member and a side support. On amending claim 1 to define the guide jig to comprise two rails, the skilled person would see the application as a whole to disclose this in the context of the detailed embodiment which discloses the two rails in combination with at least the additional features identified in point 1.4 above. In the context of the detailed embodiment, these additional features are not disclosed as being simply advantageous (and therefore optional) but rather are an integral part of the guide jig when it comprises two rails. The Board does not accept that the skilled person would see the absence of these additional features in claim 1 as filed as providing a direct and unambiguous disclosure of how the guide jig comprising two rails would be realised; such a conclusion would be tantamount to ignoring how the originally filed application consistently discloses the guide jig comprising two rails, not only in paragraphs [0028] to [0034] but also in the figures 3

to 18 relating to the sole detailed embodiment.

1.6 The respondent's argument that paragraph [0024], despite being part of the two-rail guide jig embodiment, failed to mention a holding member, side support or guide jig support, does not persuade that these features can be omitted when amending originally filed claim 1 to define in granted claim 1 a guide jig comprising two rails. This paragraph indeed fails to mention a holding member 54 or side support 56, as it also fails to mention two rails. The paragraph describes the way in which the combustor-transition-piece guide jig 50 supports the combustor-transition-piece 33 on its guiding parts 40 and guides its movement during attaching or detaching from the combustor casing. A description of the holding member 54 and side support 56 in the context of the attaching and detaching of the combustor-transition-piece 33 is irrelevant. Nonetheless Figure 3, referred to in paragraph [0024] and illustrating the support of the combustor-transition-piece 33 by the guide jig 50, clearly also depicts features (though without reference signs) which are depicted in the same manner as the holding member 54 and the side support 56 in, for example, figures 7, 8, 10A, 13 and 14, relating to the only embodiment of the invention. A disclosure of the guide jig comprising two rails in isolation from the holding member and side support is therefore not directly and unambiguously derivable from paragraph [0024] and Figure 3.

1.7 The respondent's argument that guide jigs comprising both one and two rails were disclosed in the first sentence of paragraph [0035] without any of the 'additional features' does not convince that a guide jig comprising two rails in isolation from the other

features referred to above is thus unambiguously disclosed in the application as a whole. This cited sentence simply indicates that the combustor-transition-piece guide jig 50 is not limited to two rails, provided that at least one rail supports the mass of the combustor transition piece 33. It however allows nothing to be derived regarding which features are, or are not, functionally and structurally disclosed in combination specifically with the two rail guide jig. If anything, the use of reference signs for the guide jig and the combustor transition piece, identical to those used for the sole detailed embodiment, indicates that this disclosure is to be viewed in the light of the sole embodiment in which, as indicated in point 1.4 above, additional features are disclosed in combination with the two rail guide jig.

- 1.8 The respondent's further contention that the absence of the 'additional features' disclosed in combination with the rails in paragraph [0035] showed that the number of rails was functionally not necessarily linked to the additional features can be accepted as far as it goes i.e. that no functional link is explicitly disclosed between the number of rails for supporting the combustor transition piece and the holding member 54 and the side support 56. Yet the holding member 54 and the side support 56 have an unequivocal structural relationship with the two rail embodiment of the guide jig, the holding member being attached to the opposite ends of the two rails to the fixing member, and the side support being formed on the fixing member (see paragraph [0028]) and particularly Figure 8 of the application as filed. The explicit structural relationship of the holding member 54 and the side support 56 with the two rails 51, 52 thus underlines the conclusion that these additional features are

indeed directly and unambiguously disclosed in combination with the guide jig when it comprises two rails.

1.9 Regarding the respondent's argument that paragraphs [0029] to [0031] also disclosed an optimisation of the invention which did not include the additional features alleged by the appellant to necessarily be disclosed in combination with the two-rail embodiment, this is not accepted. Firstly, these paragraphs do indeed disclose at least the holding member 54 in combination with the two rail guide jig (see page 14, lines 13 and 33). However, even if the holding member weren't explicitly disclosed in these paragraphs, these paragraphs are clearly part of the overall description of the sole embodiment of the invention, not least due to the references to Figure 9 and Figures 10-1 and 10-2 in the paragraphs which, according to the 'Brief description of the drawings' on page 6 and 7 of the application as filed, show particular views 'according to the embodiment'. Thus, even in these paragraphs specifically selected by the respondent, the direct and unambiguous disclosure is that the guide jig comprising two rails includes at least the holding member 54, the omission of which in claim 1 leads to its subject-matter lacking basis in the application as filed.

1.10 The respondent's interpretation of the disclosure in paragraph [0035], specifically on page 16, lines 30 to 33, that the number of rails could be either one or two, or of the similar disclosure in paragraph [0034] concerning the number of guide jigs, and that this could be compared to the disclosure that a corresponding dependent claim would provide, is not accepted. Independent claims and the related dependent claims in the application as filed may indeed provide a

disclosure for the subject-matter resulting from the combination of the claims. In the present case, however, the feature concerning the number of rails was not made subject-matter of such a dependent claim when the application was filed. In contrast to this, the indication on page 16, lines 30 to 33 that the number of rails constituting the combustor-transition-piece guide jig is not limited to two, and rather need simply be at least one, is a disclosure made in the context of the sole embodiment disclosed in the application as filed. A basis for a disclosure in a more general context of the description has not been provided by the respondent and the Board on its own motion could also not find such a disclosure. The guide jig comprising two rails may thus not be incorporated into claim 1 as filed in isolation from those features disclosed directly and unambiguously in combination with the two rails in the sole embodiment. As indicated in point 1.4 above, this is found to include at least the holding member 54 and the side support 56.

- 1.11 The respondent's allegation that the holding member 54 and the side support 56 were not indispensable to solve the problem posed is not pertinent to whether the guide jig comprising two rails is disclosed in isolation of these features in the application as filed. As indicated above, such considerations do not correspond to the required standard when assessing amendments for compliance with the requirement of Article 123(2) EPC, or, as in the present case, for assessing whether the ground for opposition pursuant to Article 100(c) EPC prejudices maintenance of the patent (see point 1.2). At least in the present case, the problem which the alleged invention is designed to overcome does not play a role in which features are directly and unambiguously disclosed in combination in the sole detailed

embodiment. With the guide jig comprising two rails being directly and unambiguously disclosed solely in combination with at least the holding member and the side support, the omission of these features from claim 1 results in its subject-matter being an unallowable intermediate generalisation of the application as filed.

1.12 In summary, therefore, the subject-matter of claim 1 is found to lack a direct and unambiguous basis in the application as filed. The ground for opposition under Article 100(c) EPC thus prejudices maintenance of the patent as granted. The respondent's main request is thus not allowable.

2. *Auxiliary request 1*

Article 123(2) EPC

2.1 Compared to claim 1 of the main request, claim 1 of auxiliary request 1 further defines 'wherein the rails (51, 52) are a curved structure according to a curved portion of the combustor transition piece (33)'.
2.2 In its preliminary opinion the Board indicated that the inclusion of this feature in claim 1 seemed not to overcome any of the added subject-matter objections identified by the appellant in respect of claim 1 of the main request, the respondent also not having argued in what way the amendment might overcome these objections.
2.3 To this preliminary opinion the respondent provided no counter arguments and at oral proceedings indicated that it had no arguments to add.

2.4 The Board thus herewith confirms its preliminary opinion that the subject-matter of claim 1 of auxiliary request 1 fails to meet the requirement of Article 123(2) EPC. Therefore, maintenance of the patent in amended form according to this request cannot be allowed.

3. *Auxiliary request 2*

Article 123(2) EPC

3.1 Compared to claim 1 of the main request, claim 1 of auxiliary request 2 further defines that the two rails guide a movement of the combustor-transition-piece along the rails 'while the combustor-transition-piece guiding part (40) is put between the two rails (51, 52) '.

3.2 In its preliminary opinion the Board indicated that this amendment too seemed not to address any of the objections under Article 123(2) EPC raised by the appellant with regard to the main request.

3.3 To this preliminary opinion the respondent provided no counter arguments and at oral proceedings indicated that it had no arguments to add.

3.4 The Board thus herewith confirms its preliminary opinion that the subject-matter of claim 1 of auxiliary request 2 also fails to meet the requirement of Article 123(2) EPC. Maintenance of the patent in amended form according to this request cannot be allowed.

4. *Auxiliary request 3*

Article 123(2) EPC

4.1 Claim 1 of this request combines the amendments made to the respective claim 1 in each of the preceding auxiliary requests.

4.2 In its preliminary opinion the Board indicated that the same conclusion would seemingly be reached to that met for auxiliary requests 1 and 2 and that the subject-matter of claim 1 of auxiliary request 3 would be found not to meet the requirement of Article 123(2) EPC.

4.3 To this preliminary opinion the respondent again provided no counter arguments and at oral proceedings indicated that it had no arguments to add.

4.4 The Board thus herewith confirms its preliminary opinion that the subject-matter of claim 1 of auxiliary request 3 also fails to meet the requirement of Article 123(2) EPC. Maintenance of the patent in amended form according to this request is also not allowable.

5. *Auxiliary request 4*

Admittance (Article 13(2) RPBA 2020)

5.1 According to Article 13(2) RPBA 2020, 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.

- 5.2 Auxiliary request 4 constitutes an amendment to the respondent's case and was filed for the first time with submission of 24 July 2023. This was after notification of the summons to oral proceedings before the Board such that the provisions of Article 13(2) RPBA 2020 applied and exceptional circumstances had to be identified for the request to be taken into account.
- 5.3 The fact that the examining division and the opposition division had been wholly positive regarding added subject-matter in claim 1 as granted does not constitute an exceptional circumstance justifying the late filing of auxiliary request 4. A Board finding differently from an examining or opposition division is not so rare so as to constitute an exceptional circumstance. Indeed, in *inter partes* proceedings, an opposing party has the opportunity to further develop its arguments on appeal, reflecting upon the reasoning provided by the opposition division. That this may result in a Board being persuaded, where the opposition division was not convinced, thus cannot be seen as an exceptional circumstance.
- 5.4 That the Board's communication under Article 15(1) RPBA 2020 had been issued relatively late is also not seen as an exceptional circumstance justifying auxiliary request 4 being taken into account. The precise objections found persuasive by the Board under added subject-matter had been on file at least since the appellant had filed its grounds of appeal. The time to respond to these objections, and to file desired fall-back positions as auxiliary requests, was with the respondent's reply to the grounds of appeal as part of its complete appeal case (see Article 12(3) RPBA 2020). The time at which the Board issued its preliminary opinion on the case is thus of no relevance to when the

respondent's complete appeal case should have been filed. Thus, no exceptional circumstances can be seen in this sequence of events.

- 5.5 That the Board had concurred with the appellant regarding which features were missing from claim 1 can also not be seen as an exceptional circumstance. The appellant had presented its objections and these were found persuasive by the Board. As mentioned above, in *inter partes* proceedings a party must prepare for perhaps not persuading the Board to follow its view in relation to an issue and file appropriate fall-back positions. The Board ultimately disagreeing with a party cannot be seen an exceptional circumstance.
- 5.6 As to the reply to the grounds of appeal having been filed shortly after the new Rules of Procedure were adopted, this is not seen to present exceptional circumstances justifying this request being taken into account. The Board sees the wording in Article 13(2) RPBA 2020 to be amply clear and additional guidance was provided in the explanatory remarks at the time of introduction of the revised Rules of Procedure. When filing its reply seven months after the revised Rules of Procedure came into force, the respondent could and should have been familiar with these.
- 5.7 It is also not accepted that the interpretation of 'exceptional circumstances' differed greatly between different Boards in the first months of the new Rules of Procedure applying. The respondent's reply to the grounds of appeal was filed on 31 July 2020, seven months after their entry into force, and no evidence has been provided of any divergent practice between different Boards even in these early months. In addition, the notification of the summons was served in

May 2022, more than two years after the new Rules of Procedure came into force. The respondent thus had a significant period of time available to it to consider and file further auxiliary requests before the summons was issued, such auxiliary requests then falling under Article 13(1) RPBA 2020 rather than the more limited Article 13(2) RPBA 2020. Use of this opportunity was however not taken.

- 5.8 In summary, therefore, the respondent did not indicate exceptional circumstances which would justify admittance of auxiliary request 4. Consequently, in accordance with Article 13(2) RPBA 2020, auxiliary request 4 is not taken into account.

6. Absent any set of claims meeting the requirements of the EPC, the board acceded to the appellant's request.

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:



D. Grundner

T. Rosenblatt

Decision electronically authenticated