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Chambres de recours
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Aktenzeichen

File Number

Numéro du dossier

T 0789189 -321

In der Anlage erhalten Sie

eine Kopie des Berichtigungsbeschlusses

ein korrigiertes Vorblatt (Form 3030)

einen Leitsatz / Orientierungssatz (Form 3030)

Please find enclosed

a copy of the decision correcting errors

a corrected covering page (Form 3030)

a headnote / catchword (Form 3030)

Veuillez trouver en annexe

une copie de la décision rectifiant des erreurs

une page de garde (Form 3030) corrigée

un sommaire / une phrase vedette (Form 3030)

Anmeldung Nr. / Patent Nr.:

(soweit nicht aus der Anlage ersichtlich)

Application No. / Patent No.:

82 300 821.4

(if not apparent from enclosure)

Demande n° / Brevet n°:

(si le n° n'apparaît pas sur l'annexe)

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| A | X | B | | C | |
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File Number: T 789/89 - 3.2.1

Application No.: 82 300 821.4

Publication No.: 0 059 558

Title of invention: Improvements in or relating to relief valves for sanitation systems or the like

Classification: F16K 24/06, E03C 1/10, F16K 15/06, F16K 15/14

DECISION
of 11 January 1993

Applicant: McALPINE & COMPANY LIMITED

Opponent: AB Sjöbo Bruk

Headword:

EPC Articles 52; 56; 107, second sentence

Keyword: "Inventive step (yes)"- "Parties to appeal - withdrawal of opposition - substantive issues costs"

Headnote

The Respondent to an appeal and former Opponent, who withdraws his opposition" ceases to be a party to appeal proceedings as far as the substantive issues (re: existence and scope of the patent right) are concerned. However this leaves his party status unaffected insofar as the question of apportionment of costs under Article 104 EPC is at issue (see point 2).

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|---|---|---|--|---|--|
| A | X | B | | C | |
|---|---|---|--|---|--|

File Number: T 789/89 - 3.2.1
Application No.: 82 300 821.4
Publication No.: 0 059 558
Title of invention: Improvements in or relating to relief valves for
sanitation systems or the like

Classification: F16K 24/06, E03C 1/10, F16K 15/06, F16K 15/14

D E C I S I O N
of 11 January 1993

Applicant: McALPINE & COMPANY LIMITED
Opponent: AB Sjöbo Bruk

Headword:

EPC Articles 52; 56; 107, second sentence

Keyword: "Discontinuance of opposition in appeal proceedings (declaration by
Respondent and former Opponent); effect on party-status concerning
substantive issues and non-substantive issues (cost
apportionment)";
"Inventive step (yes)"

Headnote

Headnote follows



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Boards of Appeal

Chambres de recours

Case Number : T 789/89 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 11 January 1993

Appellant :
(Proprietor of the patent)

McALPINE & COMPANY LIMITED
Kelvin Avenue
Hillington
Glasgow G52 4LF (GB)

Representative :

McCallum, William Potter et al.
MARKS & CLERK
19 Royal Exchange Square
Glasgow G1 3AE (GB)

Decision under appeal :

Decision of the Opposition Division of the
European Patent Office dated 9 October 1989
revoking European patent No. 0 059 558 pursuant
to Article 102(1) EPC.

Composition of the Board :

Chairman : F. Gumbel
Members : F.J. Pröls
W.M. Schar

Summary of Facts and Submissions

- I. European patent No. 0 059 558 was granted on 29 July 1987 on the basis of European patent application No. 82 300 821.4, filed on 17 February 1982.
- II. The patent was opposed on the ground that its subject-matter lacked novelty and inventive step (Articles 100(a), 54 and 56 EPC). The Opposition was based on:
- D1: US-A-3 973 588
D2: US-A-3 403 696.
- III. The Opposition Division revoked the patent by decision of 9 October 1989 for lack of novelty in view of document D1.
- IV. The Appellant lodged an appeal against this decision on 6 December 1989 and paid the appeal fee in due time. The Statement of Grounds of Appeal was received on 7 February 1990.
- V. In communications dated 13 February 1992 and 16 September 1992 pursuant to Article 110(2) EPC the Board raised objections against the amended documents (as filed by the Appellant) on the grounds of Article 84 and Rules 27(1)(c) and 29(1)(a) EPC. As concerns substantial requirements, such as novelty and inventive step, the Board further cited the documents:
- D3: GB-A-2 029 937 and
D4: US-A-3 605 132

which are mentioned in the specification of the patent in suit and on its cover page, respectively.

VI. The Appellant requested the maintenance of the patent in amended form on the basis of an amended Claim 1, received 29 September 1992, Claims 2 to 10 as granted, the granted description partly replaced by pages 2, 2a received 29 September 1992 and the drawings as granted and argued that the documents as amended defined a patentable invention.

Claim 1 reads as follows:

"A negative pressure relief valve for admitting air into a system in response to a pressure reduction therein so as to relieve said pressure reduction comprising a valve body (3,21) defining a valve chamber (5,22) therein; an air inlet (9,10 and 26) interconnecting the valve chamber (5,22) and the exterior of the valve body (3,21) and defining a continuous valve seat (11,25) within the valve chamber (5,22); at least one aperture (8,24) connected to the valve chamber (5,22); a flexible, substantially air impermeable valve element (12) normally disposed in engagement with the continuous valve seat (11,25) to prevent inflow of air to the valve chamber (5,22) through the air inlet (9,10 and 26); a valve element support member (15) carrying the valve element (12); guide means (16,17) for assisting the valve element (12) into effective sealing engagement with the valve seat (11,25) when the pressure drop in the system has been relieved, the aperture (8,24) being adapted to interconnect the valve chamber (5,22) with the system into which the valve is to be fitted and the valve being adapted to admit air into the system via sequentially the air inlet (9,10 and 26), the valve chamber (5, 22) and then the aperture (8,24) so as to relieve a pressure drop in the system; characterised in that the valve element (12) is freely flexible at its area of engagement with the valve seat (11,25) and the valve element support member

(15), during sealing engagement of the valve element (12) with the valve seat (11,25), extends over the area of engagement of the valve element (12) with the valve seat (11,25) but is spaced therefrom to permit free flexibility of the valve element (12)."

Dependent Claims 2 to 10 relate to preferred features of the valve according to Claim 1.

VII. By letter dated 17 January 1992 (received on 21 January 1992), the former Respondent declared that he had decided to discontinue the opposition.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is, therefore, admissible.
2. Discontinuance of opposition
 - 2.1 The Respondent's declaration made in the course of the appeal proceedings that he has decided to "discontinue the opposition" clearly indicates that he wants to cease his opposition. Thus this declaration is to be interpreted in the sense that the opposition has been withdrawn.
 - 2.2 Such a declaration has no immediate procedural significance (see: T 629/90, point 2.2., OJ 1992, 654) in the sense that contrary to the situation where an appeal is withdrawn (see G 7/91 of 5 November 1992), appeal proceedings remain pending. In contrast to proceedings where the matter in dispute is at the sole disposal of the parties, it follows from the nature of patent proceedings under the EPC that the organs of the EPO have to take into

account the public interest (see G 7/91 points 7 to 10). The declaration in question was made after the decision by the Opposition Division was pronounced and after the appeal was validly filed. The appeal has suspensive effect (Article 106(1) EPC). This means that, although the contested decision is binding on the Opposition Division, it is not yet otherwise in legal force. The opposition proceedings as such came to an end with the final decision taken by the Opposition Division (see G 4/91 of 3 November 1992).

Hence the declaration in question cannot have any retroactive effect on the opposition proceedings concluded by the (here contested) final decision of the Opposition Division.

- 2.3 However, the question arises as to what extent such a declaration affects the party's status in the pending proceedings before the Board of Appeal.

The declaration of discontinuance of opposition is to be understood as withdrawal of all requests and counter-requests pending and the withdrawal from appeal proceedings. Thus it is clear that the Respondent intends to end his status as a party to the proceedings as far as the substantive issues concerning the existence and the scope of a patent right are concerned.

According to Article 107 EPC, second sentence, any party to the opposition proceedings shall be a party to the appeal proceedings as of right. Does this mean that a Respondent and former Opponent is not allowed to cease being a party to appeal proceedings?

In order to ascertain the meaning of Article 107, second sentence the Board applies the rules of interpretation

according to Articles 31 and 32 of the Vienna Convention on the Law of Treaties, concluded on 23 May 1969 (see OJ EPO 1984, 192), as set out in G 5/83, points 1 to 6 (OJ EPO 1985, 64). Under Article 31 of the Vienna Convention a treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to terms of the treaty in their context and in the light of its object and purpose (Article 31(1) Vienna Convention).

The ordinary meaning of Article 107 does not provide an answer. The sentence in question states who becomes a party to the appeal proceedings. It does not contain a statement concerning the discontinuance or ceasing of being a party to these proceedings. In particular it does not say that ceasing to be a party is excluded.

The context is formed here by the provisions of the EPC and by related rules and treaties. Nothing concerning discontinuance of opposition can be found there. Only Rule 60(2) contains a statement concerning discontinuance (withdrawal) of opposition. But it refers to the proceedings before the Opposition Division and according to the decision of the Enlarged Board of Appeal in G 7/91 of 5 November 1992 does not apply to appeal proceedings (see also point 2.2 above).

Article 125 EPC reads: In the absence of procedural provisions in this Convention, the European Patent Office shall take into account the principles of procedural law generally recognised in the Contracting States.

It is a principle of procedural law often recognised in the Contracting States that a party, which is free to start or to enter proceedings, may declare also discontinuance of proceedings and thus cease to be a party to further proceedings, sometimes subject to approval of

the other party and leave of the Court. And it is a generally recognised principle of procedural law of the Contracting States that main or substantive issues may be dealt with separately from subsidiary or non-substantive issues such as e.g. cost questions.

Object and Purpose: The question whether a party is free to cease being a party relates to the status of parties in inter-partes appeal proceedings following an opposition against the grant of a patent. In particular it concerns here the status of the Opponent and later Respondent. It thus concerns the party who is not the Proprietor of a European patent but the one who considers himself to be affected by a patent. Such a party is as free as anybody else (Article 99(1) EPC) to file an opposition or not. Once he has filed an opposition the case is dealt with not only in the party's interests but also in the public interest (see point 2.2. above). In order to see whether this allows a positive conclusion recourse may also be had to supplementary means of interpretation such as preparatory work if the meaning of a provision remains unclear (ambiguous or obscure) after the application of Article 31 of the Vienna Convention (Art. 32 Vienna Convention). The Preparatory Documents of the Munich Diplomatic Conference 1973, M/54, page 114, contained a draft version of Article 106 which read: "Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings as of right, with the exception of those who have abandoned that right" (emphasis added).

This article forms the basis of today's Article 107 EPC but the last part of the second sentence -"with the exception of those who have abandoned that right" -was dropped. The reason given for proposing this amendment was the following:

"It was considered that parties to proceedings resulting in a decision against which an appeal is filed continue to be parties to the appeal proceedings "ipso iure" and that this principle must be retained to avoid difficulties particularly where the appeals body amends the decision of the lower instance and such amendment also relates to the division of costs between parties..

The words which it is proposed to delete could be interpreted as a departure from this principle. This was not the intention; the intention was to make it clear that although the parties to the proceedings before the lower instance are recognised as parties to the appeal proceedings, this does not mean that persons not wishing to take an active part in the latter proceedings will be forced to do so: this is however clear without any express provision being necessary."

(See Comments on the preparatory documents of the Munich Diplomatic Conference 1973, M/14, page 92).

In addition to the question of costs the view was also expressed that an Opponent should not be allowed to withdraw from participation in the appeal proceedings following the revocation of a patent because the decision of the first instance was not final for him either and could be changed by the Boards of Appeal. Such a party could take the view that the final decision of the Boards of Appeal had no effect on him because he had withdrawn from the proceedings. (see Comments on the Munich Diplomatic Conference 1973, M/PR/I, pages 52/53, No. 434, 443).

The latter view however cannot be followed by the Board because the legal nature of a patent is such that it grants an "absolute" or "real" right ("in rem"), having

effect on any person of the public ("erga omnes"), for which reason the right conferred by a patent is sometimes referred to as "intellectual property". Moreover the final decision of the Board of Appeal of the EPO which maintains or revokes a patent on appeal is not taken in the parties' interests alone but includes also the taking into account of the public interest (see: point 2.2 above). It therefore has effect on any person notwithstanding whether they participated in opposition or appeal proceedings or not (see: Article 64 EPC).

It follows from the above that no party was intended to be forced to participate actively in appeal proceedings and that the abandonment of the right to be a party was originally provided for. The only reason for dropping the half-sentence referring to abandonment was to provide a legal basis for the possible liability of such a party for costs. Thus it cannot have been the intention of the Contracting States to forbid an abandonment of the said right as such. Otherwise and if they had wished to underline the party status as an obligation, they would have had reason to clearly say so.

- 2.4 Under the EPC each party to the proceedings shall on principle meet all the cost he has incurred (see Singer R., Europäisches Patentübereinkommen, Article 104 point 2, page 419).

According to Article 104(1) EPC this principle may be departed from in Opposition and Appeal proceedings. Thus it must have been these costs which were meant in the above cited preparatory work concerning Article 107 EPC.

Article 104(1) EPC reads: "Each party to the proceedings shall meet the costs he has incurred unless a decision of an Opposition Division or a Board of Appeal, for reasons

of equity, orders, in accordance with the implementing Regulations, a different apportionment of costs incurred during taking of evidence or in oral proceedings."

Thus Article 104(1) EPC and not Article 107 EPC provides the legal basis for the liability concerning costs. It follows from Article 104(1) EPC that any party remains a party to the proceedings as long as he can come into consideration for a liability with regard to costs incurred during the proceedings and as long as these have not been finally decided upon.

Under Article 104(1)(2)(3) EPC distinct rules are provided regarding apportionment and fixing of the amount of costs and regarding the enforcement of this decision in the Contracting States. Rule 63 EPC also deals with the cost issue and states that apportionment of costs shall be dealt with in the decision on the opposition. This applies also to the decision on the appeal (Rule 66(1) and (2)h EPC). Article 106(5) EPC and Article 11 of the Rules Relating to Fees provide for an appeal against a decision fixing the amount of costs. Further provisions concerning costs are stated in Article 106(4) EPC and Rule 74 EPC. That makes it clear that apportionment of costs is a specific and distinct issue in opposition and appeal proceedings under the EPC (see also T 154/90, OJ 1992/09; T 117/86, OJ 1989,401; T 85/84). It is therefore not necessary to force a party to remain a party to the proceedings if costs are not at issue.

2.5. This conclusion is supported by two more general considerations:

The only aspects which could lead to a restriction of a party's rights in the present procedure are the interests of the other parties and the public (see: point 2.2

above). If as in the present case the other party (the Proprietor of the patent) or parties were duly informed about the Respondent's discontinuance declaration and did not object, the Board can see no reason why the defence of the public interest should necessitate forbidding the Respondent (Opponent) to cease being a party to the proceedings as far as the substantive issues are concerned because the Respondent could not be obliged to further participation with this regard even if the Board would find that necessary later on.

Moreover, taking into account the fact that an Appellant is allowed to bring proceedings to an end by withdrawing his appeal and this not only on his behalf but also on behalf of all other parties involved (see G 7/91), it would be unjustified to restrict the Respondent's rights more than the rights of the Appellant by forbidding the Respondent to cease his participation in proceedings and with respect to the substantive issues alone.

2.6 In the light of the above a Respondent who discontinues his opposition ceases to be a party to appeal proceedings as far as the substantive issues are concerned. On the other hand his party status remains unaffected by his declaration insofar as the question of apportionment of costs under Article 104 EPC is at issue. As found in point 2.3 (last paragraph) above that corresponds to the purpose of Article 107, second sentence, EPC (see also: Schulte R., Patentgesetz, §73, 29, point 1.5, paragraph 3).

2.7 In the present case the question of an apportionment of costs has not arisen. The Respondent has therefore ceased to be a party to the proceedings and shall therefore no longer be mentioned as a party.

However, had such a question of apportionment of costs arisen here, the former Respondent would have had the right to be heard on this issue and he would have had to be named as a party in the final decision.

2.8 The Opposition Division in their contested decision revoked the patent. The legal interest of the Appellant (the Proprietor of the patent) in a reversal of that decision remains intact, notwithstanding the declaration mentioned above. Hence, the Board has to evaluate the merits of the case and to issue a decision. In doing so the Board applies the law of the Convention of its own motion taking into account all the facts on file (T 629/90, point 2.2, OJ 1992, 654).

3. Allowability of the amended documents

3.1 Present Claim 1 contains the features of originally filed Claim 1 completed by features taken from the text of original Claims 4 and 5 and further functional features set out in the description and the drawings as filed.

There is therefore no objection to present Claim 1 under Article 123(2) EPC.

3.2 Claim 1 also meets the provisions of Article 123(3) EPC, since it contains all features of granted Claim 1 together with the restrictions that

(a) the relief valve now is referred to a negative pressure relieve valve for admitting air into a system in response to a pressure reduction therein so as to relieve the pressure reduction, and

(b) further functional features have been included, more clearly defining the basic construction of the valve.

4. State of the art and delimitation of Claim 1 (Rule 29(1a) EPC), novelty

4.1 Current Claim 1 is delimited over the negative pressure relief valve according to document D3 as mentioned in the preamble of the description of the patent in suit.

This document describes a valve in which a valve chamber communicates with a pipe through an annular inlet defined by inner and outer concentric valve seats. The annular inlet opening is closeable by an elastomeric valve element extending across the inlet to engage both valve seats. The valve element is normally biased into engagement with the inner and outer concentric valve seats to assist in preventing inflow of air from the inlet opening into the valve chamber. If there is a pressure reduction within the pipe, then the valve element is displaced from the concentric valve seats to permit air to pass from the exterior of the relief valve into the valve chamber to eliminate the partial vacuum.

The valve according to present Claim 1 is distinguished from the prior art valve shown in document D3 by the features defined in the characterising part of Claim 1. This prior art valve has two annular valve seats and a flexible valve element (18) which at its area of engagement with the inner annular valve seat (6) is directly supported by a valve element support member (hub 17) (and therefore is not flexible in this area) and which at its area of engagement with the outer valve seat (7) is not supported by the support member the outer edge of which has a smaller diameter than the outer valve seat.

Contrary to this known valve the valve according to Claim 1 of the patent in suit provides only one annular valve seat (11,25) to prevent inflow of the air to the valve chamber (5,22) in co-operation with a freely flexible valve element and the valve element support member (15), during sealing engagement of the valve element (12) with the valve seat (11,25); extends over the area of engagement of the valve element (12) with the valve seat (11,25) but is spaced therefrom to permit free flexibility of the valve element (12).

- 4.2 Documents D2 and D4 disclose single seat negative pressure relief valves which differ in their basic construction from the valve of Claim 1.

Document D2 shows a relief valve having a flexible valve element (valve bead cap 21) which opens and closes several passages (18) in a single disc seat (18). However, there is no displaceable valve element support carrying the valve element.

The valve element according to document D4 (Figure 6) provides a peripheral valve seat portion (84) containing an annular slot (82) therein which renders this portion more flexible. There is also no displaceable support member carrying the valve element.

- 4.3 Document D1 describes an excess pressure relief valve (positive pressure valve) for a diving apparatus which is manually or automatically actuated.

It shows, contrary to the patent in suit, a relief valve which releases excess pressure from inside a system, such as a diver's helmet. The valve may also be manually operated from either the outside or the inside by an operating knob (19) or (18) respectively. During normal

operation of the valve (Figure 1) diaphragm (13) is held against valve seat (14) by a spring (11). When there is excess pressure in the helmet (Figure 2) the diaphragm moves away from the seat and releases air in the direction shown by the arrows. Figure 3 shows the situation where there is unintentional operation of knob (18) when there is no excess pressure inside the helmet. In this case, although the pressure disc (12) is moved upwards, the diaphragm (13) remains in sealing engagement with the valve seat due to the excess pressure outside the helmet, so that no water is allowed to accidentally enter the helmet. Hence, contrary to the valve of Claim 1 the known valve releases air when there is excess pressure in the system. Furthermore, in the closed position of the valve as shown in Figure 1 of document D1, the flexible diaphragm (13) is in intimate contact with the support member (12) and in Figure 2 where the open position of the valve is shown, the flexible diaphragm is again in intimate contact with the support member (12). Figure 3 of document D1 relates to the specific condition of the valve when the outside water pressure is higher than the inside air pressure and holds the diaphragm (13) against the valve seat whilst the support member (12) is manually forced away from the diaphragm by an unintentional pushing of the inner actuation knob or a pulling of the knob portion (19) from outside. Thus, the spacing between the diaphragm and its support member is not normally present in the valve construction (or due to operation by fluid pressures) but arises purely due to mechanical operation of the knob (18,19).

- 4.4 Furthermore, none of the documents D1, D2 and D4 discloses a relief valve with a valve body defining a valve chamber which on the one hand comprises an air inlet with means for controlling inflow of air to the valve chamber in the form of a flexible valve element and on the other hand

provides at least one aperture interconnecting the valve chamber with the system into which the valve is to be fitted. Thus these documents do not disclose all features of the precharacterising part of Claim 1 of the patent in suit.

4.5 From the foregoing it immediately follows that Claim 1 fulfills the requirements of Rule 29(1a) EPC and that its subject-matter is novel over the available prior art.

5. Inventive step

5.1 Starting from the disadvantages of the prior art valve according to document D3, i.e. the relatively complex construction with inner and outer concentric valve seats and the difficulty of achieving an adequate seal at the inner and outer concentric seats over an extended period of time as a consequence of the elastomeric valve member tending to become distorted, the object of the patent in suit is to provide an improved construction of relief valve which only requires a single seat for an elastomeric valve element and which will consequently retain its sealing efficiency over an extended period (column 1, lines 38 to 42 of the description of the patent in suit).

The Board is satisfied that the valve specified in Claim 1 of the patent in suit provides a solution to the above-mentioned problem.

5.2 The negative pressure relief valves according to the documents D2 and D4 certainly also comprise only one seat for the valve element as does the claimed subject-matter. For the rest, however, the teaching of these documents (see points 4.2 and 4.4 above) would lead to a solution different from that defined in Claim 1 of the patent in suit, since combining the basic construction of the valve

according to the nearest prior art document D3 with a one seat valve element according to D2 or D4 would clearly not lead to a valve with the features set out in the characterising part of Claim 1 of the patent in suit.

5.3 Even if document D1 which contrary to the invention concerns an excess pressure valve would have been considered by the skilled person in context with improving a negative pressure valve for admitting air into a system (in response to a pressure reduction therein so as to relieve the pressure reduction), a respectively modified valve would still contain a valve member which is in close contact with its support member (as shown in Figures 1 and 2 of document D1). The spaced condition of valve element and support member as represented in Figure 3 which normally does not arise during automatic functioning of the valve (as set out in detail under point 4.3 above) bears no relation with the problem to be solved by the present invention and, consequently, cannot give a suggestion to the solution as claimed.

5.4 Accordingly, the Board comes to the conclusion that the subject-matter of present Claim 1 cannot be derived in an obvious manner from the state of the art and therefore involves an inventive step as required by Articles 52(1) and 56 EPC.

This claim, together with its dependent Claims 2 to 10 relating to preferred embodiments of the valve according to Claim 1 and the amended description can therefore form the basis for maintenance of the patent in amended form.

Order

For these reasons, it is decided that:

1. The contested decision is set aside.
2. The case is remitted to the first instance with the order to maintain the patent on the basis of the following documents:

Claim 1, received on 29 September 1992, Claims 2 to 10 as granted;

Description as granted whereby the text in column 1, line 43 to column 2, line 22 including the first words "is retained and sealed by an" on line 22 is replaced by the text on pages 2, 2a, received on 29 September 1992;

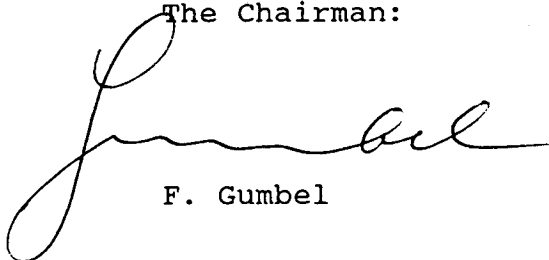
Drawings (Figures 1 to 4) as granted.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel

