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**D E C I S I O N**  
**of 19 February 2001**

**Case Number:** T 0629/97 - 3.2.3

**Application Number:** 92112331.1

**Publication Number:** 0525562

**IPC:** B05C 17/015, B05B 7/24, B05B 7/12

**Language of the proceedings:** EN

**Title of invention:**  
Device for dispensing fluid and/or semi-fluid products

**Applicant/Patentee:**  
Officine Meccaniche A.N.I. S.p.A.

**Opponent:**  
Deutsche Tecaletmit GmbH

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 111(1)

**Keyword:**  
"Decision re-appeal - exercise of discretion - remittal (yes)"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 0629/97 - 3.2.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.3  
of 19 February 2001

**Appellant:**  
(Opponent)

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**Representative:**

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**Respondent:**  
(Proprietor of the patent)

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**Representative:**

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**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office dated 7 March 1997, posted  
on 10 April 1997, rejecting the opposition filed  
against European patent No. 0 525 562 pursuant to  
Article 102(2) EPC.

**Composition of the Board:**

**Chairman:** C. T. Wilson  
**Members:** F. Brösamle  
J.-P. Seitz

## Summary of Facts and Submissions

I. European patent No. 0 525 562 was granted on 24 May 1995 with claims 1 to 4.

II: Granted claim 1 reads as follows:

"1. Device for dispensing fluid and/or semi-fluid products comprising a tubular body (1) for accommodating a cartridge (2) which contains a product (3) to be dispensed, said tubular body (1) being provided, at the front, with a dispensing nozzle (10) which defines an annular chamber (13) around a product output spout (5), and, at the rear, with a compression chamber (78) which acts on the bottom (6) of said cartridge, said body (1) being associated with a cutoff valve (20) to be connected to a compressed air supply hose (45) which is connected to said annular chamber (13) and to said compression chamber (78), wherein the line (74) which connects said cutoff valve (20) to said compression chamber (78) is provided with a pressure regulator (47) characterized in that it comprises telescopic pusher means (17) which act on the bottom of said cartridge (2), and in that the line (70,) which connects said cutoff valve (20) to said annular chamber (13) is provided with an independent pressure regulator (46)."

III. With decision of 10 April 1997 the opposition decision rejected the opposition of Deutsche Tecalemit GmbH - appellant in the following - since the subject-matter of granted claim 1 was not considered to be obvious in the light of

(D1) DE-U-8 707 725 and

(D2) DE-A-3 607 176.

IV. On 13 June 1997 the appellant lodged an appeal against the above decision of the opposition division paying the appeal fee on the same day and filing the statement of grounds of appeal on 14 August 1997.

The appellant requested to set aside the impugned decision and to revoke the patent inter alia on the basis of

(D3) DE-U-9 011 965 and a public prior use based on Figure 2 of (D3).

V. The proprietor - respondent in the following - requested:

- (a) dismissal of the appeal (**main request**) i.e. maintenance of the patent as granted or
- (b) to maintain the patent on the basis of claim 1 filed with letter of 27 February 1998 (**first auxiliary request**) or
- (c) to maintain the patent on the basis of claim 1 filed with letter of 25 February 1998 (**second auxiliary request**) and
- (d) according to his letter of 25 February 1998 - remark B2, III, - to remit the case to the first instance and for costs to be charged to the appellant in such a case.

VI. Following the board's communication of 20 May 1998 both parties agreed with the remittal of the case to the first instance (without carrying out oral proceedings **before the board**).

VII. The essential arguments of the parties can be summarized as follows:

(a) appellant:

- granted claim 1 is based on an **aggregation** of features, namely that the compression chamber "78" comprises a telescopic pusher means "17" and that the pressure changing element in the line for conveying compressed air is a pressure regulator "46";
- the combination of (D1) and (D2) renders obvious the use of a telescopic pusher means in combination with the precharacterizing features of granted claim 1, whereas the combination of (D3) and the prior use - substantiated by "Anlage 2" comprising evidence (a) to (e) and the offer that the witnesses Mr Eckmann, Brückner and Diener can be heard if felt necessary - renders obvious the use of a pressure regulator in the line for conveying compressed air;

(b) respondent:

- the pressure regulator "46" of granted claim 1 is a means for making the pressure in the annular chamber of compressed air used for atomizing the product to be dispensed

- independent from variations and even from an abrupt increase of the input/supply pressure of compressed air;
- claim 1 as granted has to be seen as a **combination** of features which is moreover not rendered obvious by (D1), (D2) and (D3);
  - in (D1) only a throttle valve "32" is disclosed but not a pressure regulator as claimed; (D2) discloses telescopic pusher means but apart therefrom is irrelevant for the device laid down in granted claim 1; (D3) is restricted to only one pressure reducing valve whereby a telescopic pusher means is not realized so that (D1) to (D3) do not directly lead to the subject-matter of claim 1;
  - the prior use - based on (D3) - was only brought forward after the time-limit for giving notice of opposition so that the provisions of Article 114(2) EPC have to be applied; even if admitted to the proceedings it has to be considered that evidence "Anlage 2(c)" is published **after** the claimed date of priority and that the veracity of the prior use without taking of evidence pursuant to Article 117 EPC is challenged;
  - "Anlage 2(c)" submitted by the appellant only discloses a pressure reducing valve which in contrast to the claimed pressure regulator cannot automatically cope with varying or excess input-pressures so that the alleged prior use should be disregarded by the board;

- if not it should be dealt with in **two instances of the EPO** so that the case should be remitted to the first instance whereby "in such case the respondent will request that the accounted expenses are charged to the appellant".

## Reasons for the Decision

1. The appeal is admissible.

### *Main request*

2. *Nearest prior art*

- 2.1 As set out in the board's communication to the parties the nearest prior art document is (D1) since in (D1) two systems are disclosed, one system "28, 23, 32", for atomising the product to be dispensed and another system "22, 20, 18" for conveying the product to be dispensed (hot melt adhesive in the particular case) to its nozzle. In both systems valves are provided, namely "32" denominated "Drosselventil" (throttle valve) and "20/18" "Reduzierventil" (reducing valve). Granted claim 1 does not make it clear that in the second system a sort of "pressure regulator" (reference sign "46" in the patent in suit) is provided, see throttle valve "32" of (D1). Any throttle valve has to be seen as a pressure changing element.

The two-part form of granted claim 1 does not therefore clearly reflect correctly the contribution of the subject-matter of claim 1 to the art.

- 2.2 What appears to be not known from (D1) is therefore

- (a) that the compression chamber "78" comprises a telescopic pusher means "17" and
- (b) that the pressure changing element in the line for conveying compressed air is a pressure regulator "46".

From the above observations follows that the subject-matter of claim 1 is novel.

2.3 Starting from (D1) the objectively remaining problem to be solved appears to be

- (a) to provide a device which is practical and easy-to handle, see EP-B1-0 525 562, column 2, lines 4 and 5, and
- (b) to make the pressure in the annular chamber of compressed air used for atomising the product to be dispensed independent from variations and even from an abrupt increase of the input/supply pressure of compressed air.

2.4 The Board finds that features (a) and (b) according to above remark 2.2, and the problems according to above remark 2.3, have no **functional interrelationship** with each other so that granted claim 1 is based on an **aggregation of features** without any combinatory effect - contrary to the findings of the respondent.

2.5 The feature (a) of granted claim 1 appears to be rendered obvious by a combination of (D1) and (D2), which latter document is based on telescopic pusher means "5, 6, 9", see in particular Figures 1 and 2 and column 1, lines 52 to 55, wherefrom the problem (a) of



above remark 2.3 and its solution can directly be derived.

- 2.6 With (D3) and an alleged prior use based on its Figure 2 the appellant brought forward - at a late stage - a prior art which could endanger the validity of feature (b) of granted claim 1 according to above remark 2.2.
- 2.7 Since (D3) and its related prior use prima facie are relevant **they are admitted** to the proceedings by applying Article 114(1) EPC.
- 2.8 As already set out by the board in the communication to the parties under remark 9 the case is to be remitted to the first instance **for further prosecution**. This order includes the taking of evidence pursuant to Article 117 EPC to verify whether or not the alleged prior use is to be seen as prior art. It has to be added that both parties agreed with the remittal of the case to the first instance, see appellant's letter of 30 September 1998 and see respondent's letter of 24 March 1999. The legal basis for remittal is Article 111(1) EPC which allows a board to remit a case to the first instance to enable **a new issue** to be dealt with in two instances.
- 2.9 Under these circumstances the board refrains from expressing a final assessment in respect of the issue of the problem and its solution according to above remarks 2.2(b) and 2.3(b) of granted claim 1.
3. Respondent's "request" for an apportionment of costs cannot be followed by the board since it is clearly expressed as an intention ("the respondent ... will

request ..."), rather than an official request. Such a request should be brought **before the first instance** if this is felt to be justified. In Article 104(1) EPC the circumstances under which an apportionment of costs incurred **during taking of evidence or in oral proceedings** can be envisaged are set out.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

A. Counillon

C. T. Wilson