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D E C I S I O N
of 13 November 2001

Case Number: T 0472/00 - 3.2.1

Application Number: 92905063.1

Publication Number: 0571481

IPC: F16C 33/12

Language of the proceedings: EN

Title of invention:
Bearings

Patentee:
DANA CORPORATION

Opponent:
Miba Gleitlager Aktiengesellschaft
GLYCO-METALL-WERKE Glyco B.V. & Co. KG
KS Gleitlager GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 111(2), 123(2)

Keyword:
"Addition of subject-matter (no, after amendment)"
"Remittal for further examination"

Decisions cited:
T 0301/87

Catchword:
-



Case Number: T 0472/00 -3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 13 November 2001

Appellant: DANA CORPORATION
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 16 March 2000
revoking European patent No. 0 571 481 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: F. Gumbel
Members: S. Crane
G. Weiss

Summary of Facts and Submissions

- I. European patent No. 0 571 481 was granted on 26 March 1997 on the basis of European patent application No. 92 905 063.1.
- II. The granted patent was opposed by the present respondents (opponents 01 to 03) on the grounds that its subject-matter lacked novelty and/or inventive step (Article 100(a) EPC).

At the oral proceedings before the Opposition Division the appellants (proprietors of the patent) submitted a set of claims according to a sole request for maintenance of the patent in amended form.

Claim 1 read as follows:

"Use for plain bearings of a composite material comprising bearing material on which is deposited an overlay coating, the overlay coating comprising a soft metal matrix which has dispersed therein a second phase of a hard, non-metallic material, said hard, non-metallic material having a Vickers hardness (H_v) of at least 300, the bulk of said overlay coating being constituted by the soft metal matrix, whereby the ability to embed dirt particles is not adversely affected, the composite bearing material being characterised in that the overlay coating is deposited by co-electro deposition and the matrix is lead-based and in that the hard, non-metallic material is alpha-alumina."

The Opposition Division held that this claim infringed Article 123(2) EPC and accordingly revoked the patent.

The written decision with reasons was posted on 16 March 2000. In this decision it was stated in particular that there was no basis in the original disclosure for the use of alpha-alumina as the hard non-metallic material in combination with any other lead-based matrix apart from the specific lead-10% tin matrix disclosed in Example 1.

III. A notice of appeal against this decision was filed on 11 May 2000 and the fee for appeal paid at the same time. The statement of grounds of appeal was filed on 5 July 2000. With this statement the appellants submitted sets of claims according to a main and three auxiliary requests for maintenance of the patent in amended form.

All three respondents made a respective substantive reply to the statement of grounds of appeal. They requested that the appeal be dismissed, with oral proceedings requested as an auxiliary measure.

With a letter received on 30 April 2001 the appellants replaced the previous requests with a new main request and new first to third auxiliary requests.

Claim 1 of the new main request reads as follows:

"Use for plain bearings of a composite material comprising bearing material on which is deposited an overlay coating, the overlay coating comprising a soft metal matrix which has dispersed therein a second phase of a hard, non-metallic material, said hard, non-metallic material having a Vickers hardness (H_v) of at least 300, the bulk of said overlay coating being constituted by the soft metal matrix, the composite

material being characterised in that the matrix of the soft metal overlay coating is selected from the group consisting of: tin-based; lead-based; and, cadmium-based metals, in that the hard second phase particles consist of alumina and in that said soft metal and said hard particles are deposited by electro-codeposition and whereby the ability to embed dirt particles is not adversely affected."

- IV. In a communication posted on 7 June 2001 the Board indicated its preliminary view that claim 1 according to the new main request met the requirements of Articles 123(2) and (3) EPC. In the circumstances it was therefore appropriate to remit the case to the Opposition Division for completion of substantive examination.

In response to this communication the appellants as well as each of the respondents withdrew their respective request for oral proceedings.

Reasons for the Decision

1. The appeal complies with the formal requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is therefore admissible.

2. Claim 1 of the present main request comprises in essence a combination of the features of claims 1, 3 and 8 of the original application together with the restriction to alumina as the hard second phase selected from the list of substances given in original claim 4, alumina being the preferred substance used in Example 1. These claims of the original application

correspond in substance to the same numbered claims of the granted patent. The Board is therefore satisfied that claim 1 of the main request meets the requirements of Articles 123(2) and (3) EPC. Dependent claims 2 to 6 correspond respectively to granted claims 2, 5 to 7 and 10, suitably adapted to the terms of claim 1.

As a consequence of the limitation of claim 1 it is implicit that Example 2 of the patent specification is to be deleted.

3. In their replies to the statement of grounds of appeal two of the respondents have questioned the clarity of the term "tin-based; lead-based; and cadmium-based metals". However, in the opinion of the Board this term is one which the person skilled in the art would have no difficulty in understanding, as evidenced for example by the documents submitted by the appellants with their letter filed on 26 April 2001. In any case, the Board notes that lack of clarity is not a ground of opposition and given that the term involved appears in granted claim 3, from which it has merely been incorporated into the new claim 1, this topic is one which in its view is not open to discussion, cf decision T 301/87 (OJ EPO 1990, 335).

4. In order to allow the parties fully to develop their arguments before two instances on the substantive merits of the claimed subject-matter, the Board makes use of its power under Article 111(2) EPC to remit the case to the Opposition Division for further examination.

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 examination.

The Registrar:

The Chairman:

S. Fabiani

F. Gumbel