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**D E C I S I O N**  
**of 13 October 2003**

**Case Number:** T 0181/02 - 3.2.4

**Application Number:** 96935178.2

**Publication Number:** 0859905

**IPC:** F01M 9/12

**Language of the proceedings:** EN

**Title of invention:**  
Engine Lubrication System

**Patentee:**  
Woodhouse, Timothy Charles, et al

**Opponent:**  
Honda Giken Kogyo Kabushiki Kaisha

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 84  
EPC R. 57a

**Keyword:**

"Admissibility of claims - no"  
"Adaptation of the description to the claims"

**Decisions cited:**

T 0610/95, T 0917/95, T 0223/97, G 0001/84

**Catchword:**

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Case Number: T 0181/02 - 3.2.4

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.4  
of 13 October 2003

**Appellant:** Woodhouse, Timothy Charles  
(Proprietor of the patent) 2 Carrington Hall Road  
Drayton Parslow  
Milton Keynes  
Bucks MK17 0GP (GB)

**Representative:** -

**Respondent:** Honda Giken Kogyo Kabushiki Kaisha  
(Opponent) No. 1-1, Minami-Ayoma 2-chome, Minato-ku  
Tokyo (JP)

**Representative:** Piésold, Alexander J.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 6 December 2001  
revoking European patent No. 0859905 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** C. A. J. Andries  
**Members:** T. Kriner  
M.-B. Tardo-Dino

## Summary of Facts and Submissions

I. The appellant (patent proprietor) lodged an appeal, received at the EPO on 7 February 2002, against the decision of the Opposition Division posted on 6 December 2001 concerning the revocation of the European patent No. 0 859 905. The appeal fee was paid simultaneously and the statement setting out the grounds of appeal was received at the EPO on 2 April 2002.

II. Opposition was filed against the patent as a whole and based on Article 100(a) EPC in conjunction with Articles 52(1), 54(1), 56 EPC and on Article 100(c) EPC in conjunction with Article 123(2) EPC.

In its decision the opposition division held that the subject-matter of claim 1 filed with letter of 22 October 2001 did not involve an inventive step as required by Article 56 EPC.

III. In the annex to the summons to attend oral proceedings, the board indicated that since it was not understandable how the splitting of the single independent claim 1 as granted into two independent claims could be occasioned by a ground for opposition, the corresponding amendments of the granted claims did not appear to be allowable under Rule 57a EPC.

Oral proceedings took place on 13 October 2003.

Although duly summoned, the appellant was not represented at the oral proceedings. In accordance with

the provisions of Rule 71(2) EPC the proceedings were continued without him.

The appellant requested in his written submissions that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 7 filed with letter of 22 October 2001.

The respondent (opponent) requested that the appeal be dismissed.

IV. The present claims comprise two independent claims which read as follows:

Claim 1:

"An internal combustion engine comprising: a crankshaft (1) having a horizontal axis of rotation; an oil sump (3) associated with the crankshaft; a cylinder head (15) above the oil sump; a camshaft mounted on the cylinder head, the camshaft having an axis of rotation located in the same vertical plane as the axis of rotation of the crankshaft; a crankshaft pulley (2) connected to the crankshaft; a camshaft pulley (4) connected to the camshaft; drive means (5) in driving engagement with the crankshaft pulley and with the camshaft pulley whereby in use, rotation of the crankshaft causes corresponding rotation of the camshaft; and means (7) for supplying oil from the sump to the drive means adjacent the crankshaft pulley, characterised in that the oil supply means (7) supplies oil to the drive means (5) at all times when the engine is in operation; guide means (13) are provided on the cylinder head (15) for guiding oil from the region of

the camshaft pulley (4) to areas where lubrication is required; and the drive means (5) is a timing belt adapted to entrain and carry to the cylinder head (15) sufficient oil to lubricate the cylinder head components."

Claim 2:

"An internal combustion engine comprising: a crankshaft (1); an oil sump (3) associated with the crank shaft; a cylinder head (15) above the oil sump; a camshaft mounted on the cylinder head; a crankshaft pulley (2) connected to the crankshaft; a camshaft pulley (4) connected to the camshaft; drive means (5) in driving engagement with the crankshaft pulley and with the camshaft pulley whereby in use, rotation of the crankshaft causes corresponding rotation of the camshaft; and means (7) for supplying oil from the sump to the drive means adjacent the crankshaft pulley, characterised in that the oil supply means (7) supplies oil to the drive means (5) throughout the operating speed range of the engine; guide means (13) are provided on the cylinder head (15) for guiding oil from the region of the camshaft pulley (4) to areas where lubrication is required; the drive means (5) is a timing belt adapted to entrain and carry to the cylinder head (15) sufficient oil to lubricate the cylinder head components; the teeth of the crankshaft pulley (2) and the teeth of the timing belt (5), in the regions approaching the point of meshing of the teeth, run in respective restrictive passages; and means are provided for supplying oil to the restricted passages whereby oil displaced from between the teeth as the

teeth come into mesh is available as a source of oil under pressure."

- V. In support of his request the respondent relied among other things on the following submissions:

The present claim 1 was based on claim 1 as granted but included limiting features. These limitations had been introduced in response to the prior art cited in the opposition. Therefore the amendments to the granted claim 1 leading to the present claim 1 were occasioned by a ground for opposition. The present independent claim 2 on the other hand was a new, additional independent claim, giving a different scope of protection to that of claim 1. If the amendments to claim 1 were occasioned by grounds for opposition, then this left no scope for separate amendments which dealt with the prior art by different limiting features. Therefore the present claims were not allowable under Rule 57a EPC.

## **Reasons for the Decision**

1. The appeal is admissible.
2. *Amendments*
  - 2.1 The claims of the appellant's present request differ from the claims as granted *inter alia*
    - (i) by the limitation of claim 1 of the granted patent to an internal combustion engine wherein

- (a) the crankshaft has a horizontal axis of rotation, and the camshaft has an axis of rotation located in the same vertical plane as the axis of rotation of the crankshaft, and
- (ii) by the introduction of a new additional independent claim, namely claim 2 which includes the features of claims 1 and 7 as granted so that claim 2 in comparison to claim 1 as granted comprises the following additional features:
  - (b) the teeth of the crankshaft pulley and the teeth of the timing belt, in the regions approaching the point of meshing of the teeth, run in respective restrictive passages; and means are provided for supplying oil to the restricted passages whereby oil displaced from between the teeth as the teeth come into mesh is available as a source of oil under pressure.

2.2 Claims 3 to 7 correspond to claims 2 to 6 as granted. The description and the drawings of the patent as granted have not been amended.

### 3. *Admissibility of the amendments*

3.1 According to Rule 57a EPC the claims of a granted patent may be amended, provided that the amendments are occasioned by grounds for opposition specified in Article 100 EPC, even if the respective ground has not been invoked by the opponent.

In the present case the appellant replaced the granted claim 1 by an amended claim 1 which, as a result of the

addition of features (a), refers to a more specific internal combustion engine than that defined by claim 1 as granted. These features (a) did not come from a dependent claim but were taken out of the description and the figures as filed. It is obvious that the amended claim 1 has been filed in order to try to overcome the novelty and inventive step objections brought forward during the opposition proceedings.

Moreover the appellant introduced the additional independent claim 2 which, as a result of the addition of features (b), also refers to a more specific internal combustion engine than that defined by claim 1 as granted. Therefore, also claim 2 can be considered as a claim which has been filed in order to try to overcome the novelty and inventive step objections made by the respondent.

Since each of the present claims 1 and 2 can be considered as having been filed as a reaction to a ground for opposition, the replacement of the granted claim 1 by **either** the present claim 1 **or** the present claim 2 would have been admissible under Rule 57a EPC. However, this finding does not apply in this specific case to the replacement of the single independent claim by two new independent claims.

- 3.2 In a case where a patentee has amended or wants to amend a single independent claim in order to avoid objections based on grounds for opposition (Article 100 EPC), and thereby to avoid the revocation of the patent involved, it is normally sufficient for the patentee to remain with a single independent claim solely by modifying the granted claim once, ie by adding one or



more features to the granted single independent claim. In normal cases such an amendment has to be considered as necessary and appropriate to try to avoid the revocation of the patent involved. Adding a second independent claim is, in normal cases not needed to avoiding the revocation of the patent on the basis of the unmodified or modified granted single independent claim, and furthermore does not contribute anything to avoid the revocation. Such an amendment therefore cannot be considered as being necessary and appropriate to try to avoid the revocation of the patent, or as an attempt to respond to an objection under Article 100 EPC (see T 610/95, section 2.2).

Only in exceptional cases can the replacement of a granted single independent claim by two or more independent claims be occasioned by a ground for opposition, for example in cases where a granted independent claim covers two specific embodiments. In such a case it has already been regarded as admissible under Rule 57a EPC to file two independent claims, each protecting one of these two embodiments (see T 223/97). Such a situation may also arise if two granted dependent claims (eg claims 2 and 3) are linked in parallel to a single independent claim (eg claim 1). Then, of course, the filing of two independent claims (eg including the features of claims 1 and 2, and 1 and 3) may be possible (moreover thereby decreasing the number of claims).

In the present case the board sees no reason why it should require two independent claims to overcome an objection based on Article 100 EPC. Since each of the independent claims 1 and 2 was filed on its own to

overcome an objection in accordance with the grounds for opposition set out in Article 100 EPC, a single independent claim (either claim 1 or claim 2) would have been enough, and there was no necessity to file a second one. Considering the amendments leading to the present claim 1 as necessary and appropriate and therefore admissible under Rule 57a EPC, the amendments leading to present claim 2 (namely the addition of a new independent claim) however are not necessary and not appropriate to safeguard the existence of the patent on the basis of an allowable claim 1. In other words, claim 2 has no influence at all on the patentability of claim 1, so that this amendment (the addition of claim 2) is not admissible under Rule 57a EPC.

Even the appellant himself did not provide any argument that the replacement of claim 1 as granted by two independent claims was occasioned by a ground for opposition, although he was informed of the board's preliminary view and the respondent's arguments with respect to the admissibility of the two independent claims.

- 3.3 Furthermore the replacement of a single independent claim by two or more independent claims during opposition proceedings contradicts the case law of the boards of appeal, according to which the opposition procedure is not designed to be, and is not to be misused as, an extension of the examining procedure (see G 1/84, section 9). Opposition proceedings should therefore not be regarded as an opportunity for the patentee to propose amendments to the text of a patent

for purposes not clearly related to meeting a ground for opposition under Article 100 EPC.

3.4 With respect to the above assessment, the board comes to the conclusion that the amendments leading to the present claims are not admissible under Rule 57a EPC.

4. *Lack of support of the claims by the description*

The appellant's request that the patent be maintained in amended form is based on claims 1 to 7 filed with the letter of 22 October 2001 during the opposition proceedings and on the description and drawings as granted. The granted description is, however, not compatible with the present independent claims 1 and 2, and therefore is not suitable to support the claims as required by Article 84 EPC. Consequently the proceedings were based on documents which, from the beginning, were not suitable for maintaining the patent according to the appellant's request. Furthermore, since the appellant was not represented at the oral proceedings, there was no possibility to adapt the description to the present claims.

As the board has already pointed out in its decision T 917/95, a patentee who filed new claims but no description adapted to these claims before oral proceedings, and who is not represented at the oral proceedings, may not rely on the board postponing its final decision at the end of the oral proceedings, in order to offer the patentee the possibility to adapt the description to the claims.

Therefore, even if the present claims had met the requirements of the EPC, the appellant's request would have been rejected.

**Order**

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

The appeal is dismissed

The Registrar:

The Chairman:

G. Magouliotis

C. Andries