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**Datasheet for the decision  
of 20 July 2006**

**Case Number:** T 0671/03 - 3.2.04

**Application Number:** 95108232.0

**Publication Number:** 0685637

**IPC:** F01N 7/10

**Language of the proceedings:** EN

**Title of invention:**  
Exhaust system for engine

**Applicant:**  
Yamaha Hatsudoki Kabushiki Kaisha

**Opponent:**  
Friedrich Boysen GmbH & Co. KG

**Headword:**

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**Relevant legal provisions:**

EPC Art. 114, 111(1)  
RPBA Art. 10, 11

**Keyword:**

"Late-filed documents - admissibility"  
"Remittal to first instance"  
"Apportionment of costs - yes"

**Decisions cited:**

G 0010/91, T 1002/92, T 1019/92, T 0932/99

**Catchword:**

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Case Number: T 0671/03 - 3.2.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.04  
of 20 July 2006

**Appellant:**  
(Opponent)

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**Respondent:**  
(Patent Proprietor)

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**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office posted 28 March 2003  
rejecting the opposition filed against European  
patent No. 0685637 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** M. Ceyte  
**Members:** M. Poock  
H. Preglau

## Summary of Facts and Submissions

I. This appeal lies from the decision of the opposition division posted 28 March 2003 rejecting the opposition against European patent No. 0 685 637.

II. Claim 1 as granted reads as follows (the board labelled each feature in square brackets):

"1. An internal combustion engine (51) having at least one cylinder bank (55, 56) [feature 1], containing at least four cylinders (58) [feature 2], forming four exhaust ports (86) in an external surface (88) thereof [feature 3], an exhaust manifold (52) affixed to each of said cylinder bank external surfaces (88) [feature 4], each of said exhaust manifolds (52) being comprised of an integral unit [feature 5], comprised of at least two tubular collector sections (94, 95) [feature 6], each collector section having a collector pipe section (96, 97) [feature 7] connected to at least two integral branch sections (98, 99, 101, 102) [feature 8], each of said branch sections being connected to a respective one of said exhaust ports (86) [feature 9], said collector sections (94,95) extending at least in substantial part in parallel relationship to each other [feature 10], characterised by a common collector being attached to the discharge ends of said collector sections (94, 95) [feature 11],and forming a single exhaust gas outlet [feature 12], said branch sections (98, 99, 101, 102) serving said collector sections (94, 95) being associated with cylinders (58) that do not fire more frequently than 270 degrees of crankshaft rotation from each other [feature 13], said branch sections (98, 99, 101, 102)

being disposed at an acute angle to the collector pipe sections (96, 97) [feature 14]."

III. The opposition was filed against the patent in its entirety on the grounds of Article 100(a) EPC. Only the ground that the subject-matter of the claims does not involve an inventive step was substantiated. Feature 13 was regarded as representing common general knowledge for the person skilled in the art.

The following documents were referred to:

D1: US-A-3 043 094;  
D2: US-A-4 050 245;  
D3: DE-A-2 640 713;  
D4: US-A-3 488 944;  
D5: EP-A-0 312 215.

Later, the opponent filed the following documents which relate to two prior uses:

D6-D14: technical drawings of Boysen, filed with letter of 23 January 2003 and received at the EPO on 24 January 2003;  
D15-D15/4: technical drawings of Leistritz, filed with letter of 23 January 2003 and received at the EPO on 24 January 2003;  
D16: declaration of BMW of 20 February 2001 with a sworn statement of Mr R. Diez, filed with letter of 23 January 2003 and received at the EPO on 24 January 2003;  
D16a: affidavit of Mr R. Diez filed with letter of 29 January 2003 and received on 30 January 2003;

D16b: declaration of BMW of 6 February 2003 filed with letter of and received on 12 February 2003.

The opposition division did not admit these documents into the proceedings stating that they were filed more than two years after the expiry of the opposition period and were *prima facie* not so complete as to substantiate the alleged prior use.

Regarding inventive step, the decision stated in particular that the specific firing order described in feature 13 was neither known nor obviously suggested by the available prior art. Therefore the ground raised for opposition did not prejudice the maintenance of the patent as granted.

IV. The opponent (appellant) lodged the notice of appeal on 4 June 2003 and paid the prescribed fee simultaneously. The statement of grounds of appeal was received on 6 August 2003.

With letter of 4 March 2004, received at the EPO on the same day, the appellant filed the following documents:

D17: declaration of BMW of 19 February 2004,  
D18: DE-A-4 006 438,  
D19: DE-A-4 021 563.

V. In a communication, the board indicated its intention to remit the case to the opposition division if the documents filed after the expiry of the opposition period were found to sufficiently substantiate the alleged prior use (D6-D17) and of relevance (D6-D19)

for the outcome of this case to be admitted into the proceedings under Article 114(1) EPC. Moreover, the board's preliminary interpretation of the terms "integral" and "tubular" in the claims was given.

VI. Oral proceedings took place on 20 July 2006 in which the appellant submitted the following document for the interpretation of the term "integral":

D20: Dictionary of Science and Technology, English-German, second revised edition, Elsevier Scientific Publishing Company, 1978, page 622.

The discussion focused mainly on the question of the admissibility of documents D6 to D20, in particular D18 and D19, into the proceedings. The respondent acknowledged that feature 13 was known from document D18.

VII. The appellant's submissions may be summarised as follows:

- The necessity to file documents D6 to D17 only emerged (see appellant's letter of 4 March 2004, page 2, paragraph 2, lines 8 to 16) from the patent proprietor's letter of 18 April 2001 in response to the opposition statement. In this letter it was surprisingly contested that feature 13 represented common general knowledge at the filing date of the patent in suit which was alleged with the opposition statement. To locate documents as proof for this allegation was difficult and time-consuming because they related to prior uses.

- The filing of documents D18 and D19 was necessary to safeguard the rights of the appellant and should be seen as a reaction to the decision of the opposition division to disregard documents D6-D16. Therefore, they should not be considered as being late-filed and, moreover, should be admitted into the proceedings in view of their relevance.
  
- A possible remittal of the case to the opposition division was not objected to.

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

- The piecemeal approach of the appellant in which new facts were presented repeatedly after the expiry of the opposition period amounts to an abuse of the procedure.
  
- Documents D6 to D19 are moreover not relevant. Document D18, in particular, provides a totally different teaching to that of the patent in suit.
  
- If documents D18 or D19 were to be admitted into the proceedings, the case should be remitted to the opposition division.

IX. The appellant (opponent) requested:

- that the decision under appeal be set aside and that the European patent no. EP 0 685 637 be revoked,
- that the materials regarding the public prior uses be admitted,

- that the witness be heard if this is deemed necessary,
- that an expert opinion is obtained if the materials submitted are not considered to be of sufficient relevance,
- and that D18 and D19 be admitted into the proceedings.

The respondent (proprietor) requested:

- that the appeal be dismissed,
- that the materials regarding the public prior uses be disregarded as being late-filed and constituting an abuse of the proceedings,
- that D18 and D19 be disregarded as being late-filed and not relevant,
- that the costs be reimbursed in case of admittance of the late-filed documents and the referral of the case to the first instance.

### **Reasons for the Decision**

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



2. *Admissibility of documents D6 to D20*

2.1 Late documents

All documents D6 to D20 were filed after the expiry of the opposition period, which in this case expired on 29 September 2000.

2.1.1 Documents D6 to D17

According to the appellant, the necessity to provide evidence of common general knowledge only emerged from the patent proprietor's letter of 18 April 2001 in response to the opposition statement. In this letter it was contested that feature 13 represented common general knowledge at the filing date of the patent in suit which was alleged with the opposition statement.

However, documents D6-D16 were only filed on 24 January 2003, thus more than 21 months later. Documents D16a and D16b and D17 were filed even later. It is appreciated that evidence of a prior use is sometimes difficult to obtain. However, in the board's view, these difficulties do not justify such delay in the present case. Consequently, these documents are considered as being late-filed.

Regarding the appellant's request to obtain an expert opinion on the question of what constitutes common general knowledge, the board emphasises that the burden of proof for the alleged lack of patentability lies with the appellant and cannot be dispensed with by requesting the board to obtain an expert opinion. Moreover, following this request would not be

consistent with the character of the post-grant opposition proceedings under the EPC which are in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment, see opinion G 10/91 (OJ EPO 1993, 420, point 2 of the reasons). It is the responsibility of the appellant to present the facts, evidence and arguments in support of the grounds on which the opposition is based.

#### 2.1.2 Documents D18 and D19

The filing of documents D18 and D19 could be seen as a reaction to the decision of the opposition division of 28 March 2003 in which documents D6-D17 were not admitted into the opposition proceedings and where it was stated that the specific firing order of feature 13 is neither known nor obviously suggested by the available prior art.

However, documents D18 and D19 were received at the EPO only on 4 March 2004, i.e. almost one year after the decision was posted, which, in the board's view, is not acceptable in the present case. Therefore, also D18 and D19 have to be considered as late-filed.

2.1.3 Document D20 is a page from a dictionary giving the meaning of "integral". It was filed in response to the board's interpretation of this term. Therefore, it cannot be considered as being late-filed.

2.2 It is established jurisprudence of the boards of appeal that in appeal proceedings new facts, evidence and related arguments which go beyond the indication of the

facts, evidence and arguments presented in the notice of opposition, should only be admitted very exceptionally into the proceedings. The decision to admit such material is at the board's discretion.

An important criterion for deciding on the admissibility of late-filed evidence is if such new material is *prima facie* highly relevant in the sense that it is highly likely to prejudice the maintenance of the European patent in suit (see Case Law of the Boards of Appeal of the European Patent Office, fourth English edition, 2001, VI.F.2, paragraph bridging pages 325, 326 and T 1002/92, OJ EPO 1995, 605). However, other considerations might play a decisive role such as whether the late-filing represents an abuse of the procedure (T 1019/92 of 9 June 1994; not published in OJ EPO, reasons, item 2.2).

#### 2.2.1 Abuse of procedure

The board is not aware of facts indicating that the filing of documents D6 to D19 was deliberately delayed for tactical reasons. Therefore it concludes that the late-filing does not constitute an abuse of procedure. Consequently, documents D6 to D19 cannot be disregarded without considering their relevance.

#### 2.2.2 Relevance of the late-filed documents

##### (a) D18

Contrary to documents D1 to D5, D18 explicitly discloses that the branch sections (in figure 3, the upper, left hand end of the exhaust pipes 1 to 4) which

serve the collector sections (in figure 6, the upper and lower part of the "Sammelzylinder 13" separated by the separator 14) being associated with cylinders that do not fire more frequently than 360° of crankshaft rotation from each other (see column 1, lines 64 to 67; column 3, lines 42 to 48). It should be noted that the term "tubular" in claim 1 does not require a circular cross-section and therefore does not exclude a collector section of rectangular cross section. Thus feature 13 is known from D18.

Moreover, also feature 14 is known from D18. The branch sections are disposed at an acute angle of the collector pipe sections (in figure 3, the lower, horizontal parts of exhaust pipes 1-4; the patent does not define how and where this angle is measured. Thus, any angular position of the branch sections does in fact meet this feature and achieves its purpose, i.e. to provide a large ovally shaped flow connection).

It is immediately apparent that this fresh material might also represent the closest prior art.

The board does not share the respondent's view that D18 provides a totally different teaching to that of the patent in suit. The purpose of the firing order is set out in column 1, lines 64 to 67 as to reduce the counter pressure ("Gegendruck"). Paragraph 0048 of the patent specifies "that the firing order of the cylinders is such that the exhaust pulses from one cylinder will not enter the respective collector section 94 or 95 at a close firing angle from the others so as to reduce interference between the respective cylinders". The term "interference"

describes in this context nothing other than the back pressure: the interference (back pressure) created by the exhaust pulses originating from those cylinders firing into the same collector section should be minimised.

The board therefore concludes that, since the teaching of D18 and the patent with respect to feature 13 is not completely different and since D18 is *prima facie* highly relevant, i.e. it is highly likely to prejudice the maintenance of the European patent, it is admitted into the proceedings pursuant to Article 114(2) EPC.

(b) D19

This document discloses that the collector sections 8, 9 containing the collector pipe sections are connected to two integral branch sections 1 to 4 (features 6 to 8). However, feature 13 is not disclosed in this document either explicitly or implicitly.

In this respect, the appellant referred to column 1, lines 55 to 69 which disclosed a "common firing order". In his view such a "common firing order" is disclosed in D18 as 1-2-4-3 for a four cylinder engine. This would reveal a firing distance of 360° of camshaft rotation between the cylinders serving associated collector sections.

It is appreciated that in this document it is disclosed which cylinder fires into which collector section. Nevertheless, the board disagrees with the appellant's view. The firing distance according to feature 13 cannot be established only from a "common firing order"

because also other firing orders exist, e.g. 1-3-4-2. For establishing the firing order it is necessary to have details about the engine construction, i.e. in which angular position the piston rods are joined with the camshaft or about the firing interval.

Therefore, document D19 is less relevant than the documents filed within the opposition period and also than D18 and would not change the outcome of the proceedings.

Consequently document D19 is not admitted into the proceedings (Article 114(2)EPC).

(c) D6 to D17

The board disagrees with the opposition division in that the documents D6 to D16, D16a, D16b "were prima facie not so complete as to substantiate the alleged prior use". However, - as admitted by the appellant -, they are not more relevant than D18 even when document D17 has been taken into account. Therefore, there is no need to admit documents D6 to D17 into the proceedings (Article 114(2) EPC).

3. Remittal to the first instance

Since document D18 has been admitted into the proceedings, the factual framework of the case has been altered in a fundamental manner as compared with that upon which the decision of the opposition division was based. Under these circumstances, the board considers it appropriate to make use of its discretionary power

under Article 111(1) EPC and to remit the case to the first instance for further prosecution.

4. *Apportionment of costs*

4.1 Article 11a(1)(a) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2003, 89) stipulates that the board may order a party to pay some or all of another party's costs incurred by an amendment pursuant Article 10b RPBA to a party's case as filed pursuant to Article 10a(1) RPBA. According to Article 2 of the decision of the presidium of 28 October 2002 (OJ EPO 2003, 67), Article 11a(1) (a) RPBA only applies to proceedings in which the notice of appeal was received by the EPO after 1 May 2003. Since this appeal was filed on 4 June 2003, it is applicable to the present appeal case.

4.2 The filing of document D18 for the first time in the appeal proceedings has to be considered as an amendment to the appellant's case under Article 10b RPBA. If this document had been filed within the opposition period, it would not have been necessary to discuss its admission into the proceedings during the oral proceedings in the appeal procedure. Thus, the costs for preparing and attending the oral proceedings before the board, which focussed on the discussion of the admission of document D18, could have been avoided.

Therefore, the board considers it to be equitable that the expenses incurred by the respondent in connection with the oral proceedings in the appeal should be borne by the appellant (opponent) (see Case Law of the Boards of Appeal of the European Patent Office, *supra*,

C.12.3(a), page 493 and T 932/99, not published in the OJ EPO).

## **Order**

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

1. The late-filed document D18 is admitted into the proceedings.
2. The decision under appeal is set aside.
3. The case is remitted to the first instance for further prosecution.
4. The appellant has to reimburse the respondent the costs incurred in connection with the oral proceedings before the board and charged by its representative.

The Registrar:

The Chairman:

G. Magouliotis

M. Ceyte