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Datasheet for the decision of 26 September 2008

Case Number: T 1513/06 - 3.2.04

Application Number: 00116245.2

Publication Number: 1050673

IPC: F02D 11/10

Language of the proceedings: EN

Title of invention:
Air flow rate control apparatus

Patentee:
Hitachi, Ltd, et al

Opponent:
Siemens Aktiengesellschaft

Headword:
-

Relevant legal provisions:
-

Relevant legal provisions (EPC 1973):
EPC Art. 54(2), 84, 100, 111(1), 114(2), 117(1), 123(2)

Keyword:
"Prior use - public availability (yes) - confidentiality (no)"
"Late-filed materials (admitted)"
"Remittal (yes)"

Decisions cited:
G 0009/91, G 0010/91, T 0818/93, T 0169/83, T 0482/89, T 1002/92, T 0101/87, T 1081/01, T 0830/90, T 0799/91, T 0221/91, T 0267/91, T 0782/92

Catchword:
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Case Number: T 1513/06 **-** 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 26 September 2008

Appellant: (Opponent)
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Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 17 August 2006 concerning maintenance of European patent No. 1050673 in amended form.

Composition of the Board:

Chairman: M. Ceyte
Members: M. Poock
T. Bokor

Summary of Facts and Submissions

I. This is an appeal against the interlocutory decision of the Opposition Division of 17 August 2006 concerning maintenance of European patent No. 1 050 673 in an amended form.

II. Opposition was filed against the patent as a whole and based on the opposition ground mentioned in Article 100(a) EPC 1973 regarding lack of novelty and inventive step in view of, inter alia, two prior uses I and II.

The Opposition Division held that the patent in the form of auxiliary request 1 met the requirements of the European Patent Convention. With regard to the prior uses I and II, it is stated in the decision that without further evidence, their public availability was not sufficiently proven.

Of the documents submitted in the opposition procedure, the following are relevant for this decision:

D9: Drawing "ESB Actuator", 037 133 064, VW;
D10: Letter of VW of 13 January 2004;
D13, 13a Purchase orders 019 4 284809 2, Mercedes-Benz / VDO for throttle valves, 24 January 1994;
D14 Delivery document 934161, Mercedes-Benz / VDO;
D15: Drawing "Umluftstellhybrid C3", X22 133 006, VDO;
D15b: Drawing "Umluftstellhybrid", 408.224/001/001, VDO;

D15d: Drawing "Stellglied ACTUATOR" 408.224/001/001, VDO.

III. The Opponent lodged the appeal on 29 September 2006 and paid the appeal fee simultaneously. The statement of grounds of appeal was received on 19 December 2006.

Of the materials filed in the appeal procedure, the following are relevant for this decision:

LC4: Statutory declaration ("Eidesstattliche Erklärung");
D9a Drawing "Stellglied ACTUATOR", 408.237/111/002, VDO;
D10a: Photos of details of VW-Golf car;
D10b Car registration "Fahrzeugbrief" for VW-Golf;
D10c Service manual for VW-Golf;
D10d Throttle valve;
D21 Timing schedule "Terminplan MB Umluftstellhybrid M111-ML";
D21a Correspondence Mercedes Benz / VDO relating to throttle valve samples;
D24 Photos from the exhibition stand at the IAA 89;
D24a Details from D24;
D25 technical Information "Motormanagement PKW", VDO.

IV. Oral proceedings before the Board were held on 26 September 2008.

V. At the end of the oral proceedings the following requests were present:

The Appellant (Opponent) requested that the decision under appeal be set aside and that the European patent No. 1 050 673 be revoked, auxiliarily that the case be remitted to the department of first instance.

The Respondent (Patent Proprietor) requested that the appeal be dismissed, or auxiliarily - in case any of the public prior uses alleged by the Appellant should be recognised by the Board - that the decision under appeal be set aside and that the case be remitted to the department of first instance for the examination of novelty and inventive step with respect to these public prior uses. It was further requested that the patent be maintained on the basis of the main request or the auxiliary request filed during the oral proceedings, or alternatively on the basis of either one of the auxiliary requests 2a, 3a, 4a, 5a and 6a filed with letter dated 25 August 2008.

VI. Claim 1 of the main request reads as follows:

"An airflow rate control apparatus comprising a throttle valve element (1) driven by a motor (10), a throttle sensor (11) for detecting an opening degree of said throttle valve element (1), and a one-piece cover (17, 20) which is covering the sensor (11) and is attached to a body (2) for accommodating the throttle sensor (11) in a sealed space (S) formed' by the cover (17, 20) and the body (2), characterized in that
- the cover (20; 17) is provided with a plug-type connector (16, 18) on an outer portion thereof and the motor (10) is electrically connected to the external through said connector (18),

- wherein the cover (17, 20) and the plug-type connector (16, 18) are provided as a unit and the electrical connection of the motor (10) is extending through the sealed space to the cover (17, 20)".

In the description and the claims of the auxiliary request 1 it has been specified that the second embodiment shown in figures 2 and 4 to 8 does not fall under the scope of protection of the claims.

VII. The Appellant argued essentially as follows:

(a) The embodiment of figures 2, 4 to 8 does not fall under the terms of claim 1 of the main request because its control unit 17 is not a cover, in particular it is not described in the patent as a cover in the meaning of claim 1.

(b) Some of the amendments made in claim 1 do not have a basis in the originally filed documents.

The amendment of the "connector" to a "plug-type connector" is objected because the term "plug-type connector" is not used in the description b or the claims at all and it could not be seen in the drawings if it is a plug or socket type connector.

The amendment that the plug-type connector is arranged "on an outer portion of the cover" is objected to because in figure 1 it can be seen that only a part of the connector 16 protrudes from the cover 20. Thus it is not arranged on an outer portion of the cover as claimed.

In the embodiment of figure 1, no one-piece cover is present because it consists of a cover 20 and the connector 16. The same applies to the feature that the cover and the plug-type connector "are provided as a unit", because "unit" is a synonym for one-piece cover.

The features that the one-piece cover is attached to a body for accommodating the throttle sensor in a sealed space formed by the cover and the body and that the electrical connection of the motor extends through the sealed space to the cover is disclosed only in connection with the first embodiment shown in figures 1 and 3.

(c) The additional materials relating to the prior uses I and II were filed as soon as possible in reaction to the negative decision of the Opposition Division and within the time limit set in the communication accompanying the summons to the oral proceedings before the Board.

(d) The subject-matter of claim 1 is not patentable in view of prior use I in which a throttle valve according to the materials D9, D9a and D10d was mounted on a car registered on 30 November 1994. Regarding its public availability, particular reference was made to documents D10a, D10b and D10c.

(e) The subject-matter of claim 1 is also not patentable in view of prior uses II. Samples of throttle valves according to documents D15, D15b and D15d were made available to the public by

their delivery to Mercedes Benz (in the following Mercedes) on 2 March 1994 without any obligation to maintain secrecy. With this delivery, VDO has given up any power of control on the exploitation of the samples. Series production throttle valves were made available to the public by their delivery which started on 2 January 1995. The series production delivery implies that no obligation to maintain secrecy existed any more even if it existed before.

(f) It was admitted in the oral proceedings that the prior use III was not more relevant for the present claims than the materials already in the procedure.

VIII. The Respondent argued essentially as follows:

(a) The amendments in claim 1 comply with the requirements of Articles 84 and 123(2) EPC 1973.

The embodiment of figure 2 falls under the terms of claim 1 of the main request because the cover 6 or the control unit 17 represent a cover in the meaning of claim 1. This objection does not apply to auxiliary request 1 in which the second embodiment of figures 2 and 4 to 8 was deleted.

The "plug-type connector" is clearly shown in the drawings and the fact that it is provided in an opening of the cover 20, as can be seen in figure 1, does not exclude that it is also provided on an outer portion of the cover.

(b) The late-filed material concerned more than 8 new acts of the alleged public prior uses I and II. The facts were already available many years ago and no reasons were presented justifying such a late filing. Therefore, it should be considered as an abuse of the procedure and the Board should refrain from examining the potential relevance of these late-filed submissions.

(c) The facts and evidence submitted by the Appellant on the basis of document D10 are not sufficient for meeting the requirements of substantiation of the alleged prior use I. The drawing D9 is clearly marked to be confidential and document D10 does not represent an evidence according to Article 117 EPC.

Moreover, the late filing of valve D10d would have required a decision for taking evidence to give the Patent Proprietor sufficient opportunity and time for a careful inspection thereof.

Even if the alleged public prior uses I were considered to be substantiated, the facts presented are not sufficient to demonstrate that a throttle valve with a part number 037133064 has been made available to the public prior to the priority dates of the present patent. The term "in Serie eingesetzt" in D10 could mean a "production release" (Serienfreigabe) by VW, for example, after successful tests of prototypes, but also the mounting of the throttle valve device to vehicles for series production. Therefore, it cannot be unambiguously concluded from D10 whether cars with

such a throttle valve have in fact been sold by VW to any client.

Regarding valve D10d, it is not clear whether it was the original throttle valve present in the car when it was registered on 30 November 1994 or not.

(d) Prior uses II were not publicly available because both VDO and Mercedes were bound by an obligation to maintain secrecy resulting from the circumstances.

Only a small number of samples have been delivered to Mercedes clearly before the priority date of the patent. However, the delivery of a few samples of a part maker to a car maker is not sufficient to make the respective subject-matter available to the public. In the field of automotive industry, an obligation to maintain secrecy can be assumed when samples of the pre-series development phase have been made available for test purposes. In this highly competitive industry, a part maker and a car maker are both interested in not providing any information to a competitor before series production has started. Accordingly, there is a common interest of the parties for maintaining secrecy as long as a series production has not yet started, so that a tacit secrecy agreement has to be concluded from the circumstances. In this respect, reference was made to decisions T 830/90, T 799/91, T 221/91, T 267/91, T 782/92.

It should be taken into consideration during the evaluation of evidence that document D15 could not

have been the accompanying drawing for the throttle valve devices delivered in March 1994 because it contains amendments made after this filing date. According to document D21a, the delivered throttle valve devices were substantially different from the throttle valve device of document D15.

Document D21 shows a planning and cannot demonstrate that throttle valve devices have in fact been delivered. However, it was accepted in the oral proceedings that throttle valves from the series production were delivered shortly after 2 January 1995, presumably around 4 January 1995.

A witness in the person of a senior development engineer was offered by the Respondent to be heard on the practice of non-disclosure agreements customary in the field of the patent under dispute.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments*

2.1 Main request - Article 84 EPC 1973

2.1.1 Article 84 EPC 1973 stipulates that the claims shall define the matter for which protection is sought, and in particular that they shall be supported by the description.

In the present case, claim 1 requires that a one-piece cover is provided "which is covering the sensor (11) and is attached to a body (2) for accommodating the throttle sensor (11) in a sealed space (S) formed by the cover (17, 20) and the body (2)".

2.1.2 The patent specifies for the second embodiment of figures 2 and 4 to 8 an accelerator cover 6 and a gear cover 5 (see col. 3, l. 19 to 22). Accelerator cover 6 covers the sensor 11 and is attached to the body (2) for accommodating the throttle sensor 11 in a sealed space S formed by the cover 6 and the body 2. However, this cover 6 is not provided with a connector as required by claim 1 because it is provided on the control unit 17.

2.1.3 The Respondent argued that the control unit 17 of the second embodiment represented the cover in the meaning of claim 1. The Board did not share this view.

In the patent specification, parts 5 and 6 are explicitly identified as covers whereas the control unit 17 is only identified as an additional cover means between the body 2 and the cover 6 (see col. 3, l. 24 to 27), i.e. as an intermediate part in the sealed space S. The sealed space is mainly delimited by cover 6 and the body 2 because hole 17a provides a connection between the spaces on both sides of the control unit 17. Thus, in the view of the Board, the control unit 17 as such would not be perceived by the skilled person as a cover in the meaning of claim 1.

Only in combination with cover 6 could the control unit 17 be considered as the cover in the meaning of claim 1. However this understanding would exclude that it is considered as a one-piece cover as required by claim 1. Moreover, in such cover, the connector 18 would not be provided as a unit as required by claim 1, i.e. that the cover and the connector can be demounted from the body without falling apart (see figure 4).

2.1.4 In view of the foregoing, it is concluded that the second embodiment shown in figures 2 and 4 to 8 does not fall under the terms of claim 1. Thus, it is not supported by the description as required by Article 84 EPC 1973. Consequently, the main request is not allowable.

2.2 Auxiliary request 1 - Articles 84 and 123(2) EPC 1973

2.2.1 The description and the claims have been amended to clearly set out that the second embodiment of figures 2 and 4 to 8 does not fall under the terms of claim 1, i.e. under the scope of protection of this claim. Therefore, the foregoing Article 84 objection does not apply any longer.

2.2.2 The amendments in claim 1 objected by the Appellant were made after grant of the patent. Thus, they have to be fully examined as to their compatibility with the requirements of the EPC (e.g. of Article 123(2) EPC), see decision of the Enlarged Board of Appeal G 9/91, OJ EPO 1993, 408.

2.2.3 The added terms "plug-type connector", "one-piece cover" and "as a unit" in claim 1 were not used in the description or the claims as originally filed.

(a) The person skilled in this technical field is considered as a graduated mechanical or electrical engineer who knows plug and socket connectors. They are designed such that a male plug part can be inserted into the matching socket part. Moreover, the description and the claims concern the mechanic arrangement of the various parts of the throttle valve, even if some parts *per se* have clearly an electrical function as well.

Therefore the skilled person reading the patent will interpret the various features of the claims in the first line as mechanical features and understand the term "plug-type connector" in the meaning of the male (mechanical) connector part and not as the female (mechanical) socket part.

(i) The amendment of claims with a feature exclusively shown in the drawings is permissible provided that the structure and the function of such feature is clearly, unmistakably and fully derivable from the drawings by the skilled person, and is not at odds with the other parts of the disclosure (see T 818/93, reasons item 3 (not published in OJ EPO) following T 169/83, OJ EPO 1985, 193).

The housing of the connector 16 is provided with guiding protrusions (see figure 1). The

skilled person mentioned above will thus recognize this housing as the male part of a connector 16 on which the corresponding female part can be plugged on.

(ii) Hence, the structure and the function of the plug-type connector is clearly, unmistakably and fully derivable from the drawings by the skilled person and does not contradict the remaining parts of the original application.

(iii) That the plug-type connector is arranged on an outer portion of the cover also has a basis in the application as filed.

The wording of claim 1 does not require that the connector is exclusively provided on the outer portion of the cover. It requires that the connector as a whole is perceived by the skilled person as being provided on an outer portion, i.e. that a major part of the connector, primarily those functional elements of the connector which establish the connection, is provided on an outer portion of the cover. This can be clearly seen in the drawings of the original application in figure 1.

2.2.4 The structure and function of the features including the terms "one-piece cover" and "as a unit" are also clearly, unmistakably and fully derivable from the drawings by the skilled person. Moreover, no contradiction with the remaining parts of the original application exists.

(a) In the first embodiment shown in figures 1 and 3 of the application as filed originally, spring cover 20 accommodates a sensor 11 in a sealed space S. It is, as can be seen in figure 3, a single piece in which a connector 16 is provided. However, this does not hinder that the spring cover can be considered as a one-piece cover in the meaning of claim 1 because the sealed space S must not be defined exclusively by the cover 20 and the body 2. In fact, it is defined also by other parts, e.g. the gear cover 5 (see application as filed originally, col. 3, l. 43 to 45).

(b) Moreover, as results from figures 1 and 3, spring cover 20 and connector 16 can be demounted from the body 2 without falling apart. Hence, the cover and the connector are provided as a unit as required by claim 1.

2.2.5 These amendments therefore do not contravene the requirements of Articles 84 and 123(2) EPC 1973.

3. *Prior use I*

3.1 Substantiation

3.1.1 If an opponent wishes to rely upon a prior use as being part of the state of the art for the purpose of Article 54(2) EPC and as part of the legal and factual framework within which the substantive examination of the opposition is to be conducted, the notice of opposition must indicate within the opposition period

all the facts which make it possible to determine the date of the prior use, what was used, and the circumstances relating to the prior use (see "Case Law of the Boards of Appeal of the European Patent Office", 5th edition (in the following CLBA), VII.C.4).

The notice of opposition meets these requirements, because document D9 was indicated and discussed therein with regard to what was used and document D10 with regard to the date and circumstances of the prior use I.

3.1.2 In proceedings before the European Patent Office, any kind of document, regardless of its nature, can be relied upon under Article 117(1)(c) EPC. The probative value of any such document, however, depends on the peculiar circumstances of the particular case (see T 482/89, Headnote I; OJ 1992, 646).

Contrary to the Respondent, the Board thus considers document D10 as a means of giving or obtaining evidence falling under the provisions of Article 117(1)(c) EPC 1973.

3.2 Materials LC4, D9a, D10a, D10b, D10c and D10d

3.2.1 In proceedings before the boards of appeal, late-filed facts and evidence should only very exceptionally be admitted into the proceedings, if such new material is prima facie highly relevant in the sense that it can reasonably be expected to change the eventual result and is thus highly likely to prejudice maintenance of the European patent. Also other relevant factors should be taken into account (see T 1002/92, Headnote I; OJ

EPO 1995, 605). The delay is of less importance if the party was reacting to a finding in the contested decision (see T 101/87, not published in OJ EPO).

3.2.2 In the present case, the Board took into account that the filing of the materials LC4, D9a, D10a, D10b, D10c and D10d was a reaction to the finding of the Opposition Division in the decision under appeal that, without further evidence, the public availability of prior use I had not been sufficiently proven. Thus, it was not considered as an abuse of procedure.

The Board considered these materials to be highly relevant for the public availability of prior use I for the reasons set out below (see section 3.3).

3.2.3 Therefore, the Board exercised its discretion under Article 114(2) EPC 1973 accordingly and admitted these materials into the proceedings.

3.2.4 The Respondent had argued that the late filing of valve D10d would have required a decision for taking evidence to give the Patent Proprietor sufficient opportunity and time for a careful inspection thereof. However, firstly, the valve was available at the oral proceedings and the chairman offered the representative of the Patent Proprietor to interrupt the oral proceedings so that he can inspect the valve. No such request was made. Secondly, the facts that demonstrate that it is the original part are easily derivable from the photographs D10a received by the Respondent well before the oral proceedings. Thirdly, the documents already on file described the technical details of the valve. The issue was therefore not so much the

technical details of the valve itself, but rather its public availability.

Thus the Respondent had sufficient opportunity and time for a careful inspection and preparation of this new material.

3.3 Availability to the public

3.3.1 Document D10b demonstrates that a Volkswagen car with the identification number WVWZZZ1HZSW167571 was registered on 30 November 1994. Thus, at least from that date, this car was available to the public.

The VW-Golf shown in document D10a has the same identification number. It is thus the same car. From this car, a throttle valve was demounted and filed as valve D10d. It can be seen on the right hand side on page 3. It is also apparent that it looks used whereas the left one is for its substitution and looks new.

3.3.2 Document D9 is a VW drawing of a throttle valve with the part No. 037 133 064. The corresponding drawing of VDO is document D9a. In view X of document D9a it is shown that the throttle valve has to be provided with the VW part No. 037 133 064, the VDO drawing No. 408.237/111/002, the date of manufacture and the VW trademark.

The valve D10d is provided with exactly these identifications, and in particular that the throttle valve device was manufactured in week 41 in 1994, i.e. prior to the first priority date of this patent. It can be seen on page 3 of document D10a that these

identifications are only present on the throttle valve demounted from the VW-Golf but not on the substitution part. This confirms the statement of the Appellant that only the original throttle valves were provided with these identifications.

Hence, the Board concludes that the demounted throttle valve D10d is the original throttle valve which was present in the car when it was registered on 30 November 1994 and corresponds to documents D9 and D9a.

3.3.3 This conclusion is further confirmed by the following documents:

(a) Documents D10 and LC4 (see page 4, last two paragraphs) confirm that throttle valves with VW part No. 037 133 064 were used in different vehicles of VW from the beginning of October 1994.

Document D10c confirms that the VW-Golf with the identification number WVWZZZ1HZSW167571 was used in public.

(b) The information given in these documents is consistent and gives a conclusive picture how the throttle valve according to documents D9, D9a and D10d was made available to the public.

3.3.4 From the foregoing it follows that a throttle valve device according to documents D9, D9a and D10d was made available to the public prior to the earliest priority date of the patent and thus represents state of the art in the meaning of Article 54(2) EPC 1973.

4. *Prior use II*

4.1 Admissibility of documents D21 and D21a

4.1.1 The Board took into account that the filing of the documents D21 and D21a was a reaction on the finding of the Opposition Division in the decision under appeal that the public availability of prior use II had not been sufficiently proven. Thus, it was not considered as an abuse of procedure.

The Board considered these materials to be highly relevant for the public availability of prior use II for the reasons set out below (see section 4.2).

4.1.2 In view of the principles set out above in section 3.2.1, the Board exercised its discretion under Article 114(2) EPC 1973 accordingly and admitted documents D21 and D21a into the proceedings.

4.2 Availability to the public

4.2.1 The state of the art comprises any information which has been made available to the public (Article 54(2) EPC 1973). It is sufficient that a single member of the public was in a position to gain access to it, provided that he was not bound by an obligation to maintain secrecy at the time when he gained access (see T 1081/01, not published in OJ EPO).

In the present case, the crucial point to be assessed is whether or not Mercedes has to be considered as a

member of the public not bound by an obligation to maintain secrecy.

4.2.2 The Board has no knowledge of an express secrecy agreement. Therefore, it has to be established whether it results from the circumstances that a tacit secrecy agreement existed between VDO and Mercedes.

4.2.3 It is established case law that if at the time of receipt of an information, the recipient was in some special relationship to the donor of the information, he could not be treated as a member of the public, and the information could not be regarded as published for the purposes of Article 54(2) EPC (see T 1081/01, supra, point 8). In this respect the following is observed:

(a) The throttle valve shown in document D15 is a typical product of VDO which produces throttle valves of various kinds for use by the automotive industry (see, for example, the valves for VW: D9 and for Mercedes: D15). In contrast, Mercedes is an example of a typical potential end user of such valves. There is no evidence on file that the throttle valve in question was actually designed by Mercedes and only manufactured by VDO, nor that Mercedes would have any special rights in the technical solutions of the throttle valve, such as a patent or the like. The fact that the underlying technology of throttle valves of the type in suit typically constitute the intellectual property of a part manufacturer is also demonstrated by the parties to the present appeal. Both Appellant and Respondent are part manufacturers and not car manufacturers.

(b) The Board has no information that VDO and Mercedes had concluded a development agreement or entered into any other contractual relations that would indicate either of them having had any particular interest in a secrecy agreement.

(i) As mentioned above, such valves are developed and designed by VDO. The Board recognises that it might be necessary to adapt its dimensions in response to wishes of the end user, or even to individualise the product by using the logo or trademark of the end user. This, however, does not mean that the valves are the result of a technical co-operation between VDO and the end user, i.e. that the valves are a common development.

(ii) Thus, this appeal case is different from those cases of sub-contracting cited by the Respondent. In these cases, a common interest for secrecy was assumed, either because there was a technical co-operation for the common development of a new product (see T 830/90; OJ EPO 1994, 713) or for the manufacture of a product developed by the donor of the order (T 799/91; not published in OJ EPO).

(c) The Board has no reason to doubt that part manufacturers and car manufacturers often impose a secrecy obligation on each other, for example in cases of common development. However, this does

not appear plausible in the present case. Since throttle valves are a typical product of VDO, it cannot be assumed that VDO had an interest in accepting any secrecy obligation with respect to its own products, as it would have prevented it from selling its own product to other car manufacturers. The same argument speaks against the assumption that Mercedes would have been in a special or preferential relationship with VDO in the sense that VDO itself would have intended to sell such throttle valves to Mercedes only.

On the other hand, Mercedes has regularly purchased the sample throttle valves (see documents D13, D13a: "Purchase order"), i.e. paid for them. It is also not plausible that Mercedes would have accepted any restrictions from its own part supplier on how to exploit these valves, such as an obligation to request a preliminary consent from VDO before any public sale of the cars equipped with the valves in question. Moreover, it appears unlikely that it would be in the interest of Mercedes to be dependent on a single supplier for these throttle valves. Rather, it is more likely for Mercedes to have an interest that these valves are known to the public so that they could be ordered freely from other suppliers, and not only from a single source. It is another matter that Mercedes could possibly have required from VDO to keep the **fact of the sale** secret, in order to prevent the leaking of any information to its competitors about the technical parameters of its engines. However, this is not equal to the obligation of keeping secret the existence of the

throttle valve in suit as such, but merely the fact that such throttle valves have been adapted to the engines of Mercedes.

(d) The Board did not hear the witness offered by the Respondent on the practice of non-disclosure agreements customary in the field of the patent under dispute for the following reasons:

Whether a tacit secrecy agreement between parties exists, depends on the peculiar circumstances of the specific case. This witness was not offered to be heard on the specific practice of non-disclosure agreements between Mercedes or VDO, but rather on the general practice of non-disclosure agreements between car manufacturers and part manufacturers. As mentioned above, the Board has no reason to doubt that the car manufacturers do often impose a strict secrecy obligation on their suppliers, provided that they are in a position to do so. However, the witness offered by the Respondent could not know the specific circumstances of the sale in question, and it was also not alleged by the Respondent.

(e) The Board thus concludes that considering the relationship between VDO and Mercedes and also considering the overall technical features of the sold part in question is can not be assumed that a tacit secrecy agreement existed for the delivered throttle valves. In this respect, Mercedes has to be considered as a member of the public.

4.2.4 Throttle valve samples delivered on 2 March 1994

(a) In view of the foregoing, the Board is unable to conclude any restrictions imposed by the delivery of these throttle valves from VDO to Mercedes.

(b) The Respondent referred to "CLBA", I.C.1.8 (f) according to which a product made available for test purposes is to be treated as confidential.

But even if the delivery of these samples was considered for test purposes, the foregoing statement does not apply to the present case. If the possessor of the product is a member of the public, as in case T 221/91 cited by the Respondent or in the present case, the product has to be considered as being available to the public.

(c) The Board thus concludes that the throttle valves delivered on 2 March 1994 were made available to the public.

4.2.5 Series production throttle valves delivered after 2 January 1995

(a) Moreover it is undisputed that the series production throttle valves were received shortly after the planned date of 2 January 1995, e.g. on 4 January 1995. Thus, according to the argumentation of the Respondent that a tacit secrecy agreement can be concluded as long as a series production has not yet started (see letter of 6 November 2007, page 9, paragraph 2, last sentence and paragraph 3, first sentence), a tacit

secrecy agreement cannot be assumed after 4 January 1995.

(b) The Board thus concludes that the series production throttle valves delivered after 2 January 1995 were made available to the public.

4.2.6 These findings are fully consistent with the statements in document LC4.

4.3 The technical content made available to the public

4.3.1 Throttle valve samples delivered on 2 March 1994

(a) Document D14 refers to throttle valves X22 133 006 002. From document D21 it is concluded (see positions 9.1.3 in connection with 9.1.1 and 9.3), that it is the same throttle valve as in documents D15b and D15d but with an OTP processor and without the series circuit board. From the fax of 25 May 1994 in document D21a it follows that the body is made in a rubber-hard plaster-cast form.

(b) In technical drawings, records are normally kept of any amendment on the drawing sheet. In document D15, these can be found in the right bottom corner in which the amendments to the original drawing are identified with the letters a, b, c, and d. The amendments c and d were made after throttle valves were delivered to Mercedes on 2 March 1994. Only the amendments a and b are relevant to the present case because they were made prior to this delivery. However, they relate to added dimension

tolerances of the cover and to a changed position of the return spring in the gear compartment. Thus, they do not relate to features of claim 1 which are relevant in this case.

(c) In view of the foregoing, the Board concludes that the state of the art comprises the throttle valve samples shown in documents D15, D15b and D15d except for the following:

- they were provided with an OTP-processor and not with the series circuit board and the mask programmed processor (see fax of 2 March 1994 in document D21a),
- the body was not made with a series tool but with a rubber-hard plaster-cast form (see fax of 25 May 1994 in document D21a),
- the cover had added dimension tolerances and the position of the return spring in the gear compartment has changed.

4.3.2 Series production throttle valves delivered after 2 January 1995

In view of the foregoing, the Board concludes that the state of the art comprises the series production throttle valves shown in documents D15, D15b, D15d.

5. *Prior use III*

The Appellant has admitted in the oral proceedings that this prior use is not more relevant than the remaining materials on file. Therefore, documents D24, D24a and D25 do not need to be admitted into the proceedings (Article 114(2) EPC 1973).

6. *Remittal to the first instance*

With the finding that the throttle valves mentioned above in sections 3 and 4 were available to the public, the factual framework of the case has been fundamentally altered as compared with the one on which the decision of the Opposition Division rests. Under these circumstances the Board considers it appropriate to make use of its discretionary power under Article 111(1) EPC 1973 and to remit the case to the first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of the first instance for further prosecution.

The Registrar: The Chairman:

G. Magouliotis M. Ceyte