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**Datasheet for the decision
of 4 October 2010**

Case Number: T 0446/08 - 3.2.05

Application Number: 99109290.9

Publication Number: 0965778

IPC: F16J 15/08

Language of the proceedings: EN

Title of invention:

Metal gasket with two half beads

Patentee:

ISHIKAWA GASKET CO. LTD.

Opponent:

ElringKlinger AG

Headword:

-

Relevant legal provisions:

EPC Art. 54, 56, 114(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Novelty (main request) - no"
"Late-filed documents - not admitted"

Decisions cited:

-

Catchword:

-



Case Number: T 0446/08 - 3.2.05

D E C I S I O N
of the Technical Board of Appeal 3.2.05
of 4 October 2010

Appellant: ElingKlinger AG
(Opponent) Max-Eyth-Str. 2
D-72581 Dettingen/Ems (DE)

Representative: Haecker, Walter
HOEGER, STELLRECHT & PARTNER Patentanwälte
Uhlandstrasse 14 c
D-70182 Stuttgart (DE)

Respondent: ISHIKAWA GASKET CO. LTD.
(Patent Proprietor) 5-5 Toranomom 2-chome
Minato-ku
Tokyo (JP)

Representative: Banzer, Hans-Jörg
Kraus & Weisert
Patent- und Rechtsanwälte
Thomas-Wimmer-Ring 15
D-80539 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 20 December 2007
rejecting the opposition filed against European
patent No. 0965778 pursuant to Article 101(2),
second sentence, EPC.

Composition of the Board:

Chairman: W. Zellhuber
Members: H. Schram
M. J. Vogel

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division posted on 20 December 2007 rejecting its opposition against European patent No. 0 965 778.

The Opposition Division held that the grounds of opposition under Article 100(a) EPC (lack of novelty, Article 54 EPC, and lack of inventive step, Article 56 EPC) did not prejudice the maintenance of the patent as granted.

- II. Oral proceedings were held before the Board of Appeal on 4 October 2010.

- III. The appellant requested that the decision under appeal be set aside and that the patent in suit be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed, or that the patent be maintained on the basis of one of the sets of claims filed as first or second auxiliary request during the oral proceedings.

- IV. Claim 1 of the patent as granted reads as follows:

"1. A metal gasket (G) for an internal combustion engine having bolt holes (Hb, Hb') and a fluid hole (Ho) to be sealed, comprising:

 a main plate (11) for forming the metal gasket,
 a first hole (Hb') for constituting one of the bolt holes,

a second hole (Ho) corresponding to the fluid hole and situated adjacent to the first hole, and

a full bead (13) having a first half bead (13a) and a second half bead (13b) situated outside the first half bead,

said gasket being characterized in that

said first half bead (13a) completely surrounds only the second hole (Ho) and said second half bead (13b) completely surrounds both first and second hole (Hb', Ho) in combination, i.e. surrounding part of the first hole and part of the second hole so that a portion away from the first hole is surrounded by the first and second half beads to securely seal around the second hole."

Claim 1 of the first auxiliary request differs from claim 1 as granted in that the expression "both first and second hole (Hb', Ho)" is replaced by the expression "only the one first hole (Hb') and the second hole (Ho)" and in that the expression "so that a portion away from the first hole is surrounded by the first and second half beads" is replaced by the expression "so that a portion around the second hole, which is away from the first hole, is surrounded by the first and second half beads (13a, 13b)".

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that the feature "wherein said second hole (Ho) is located substantially between the first hole and an outer periphery of the gasket" has been added at the end of the claim.

V. The documents referred to in the appeal proceedings included the following:

B1 Drawing No. 0 03 130 Elring Klinger GmbH, cylinder head gasket having part No. 452.160, last amendment dated 18.02.1997.

B2 15 invoices from Elring Klinger GmbH concerning the sales of a total of 2125 articles with the part No. 452.160 to Daimler Benz AG, Stuttgart, all dated during the period from 4 November 1997 to 21 January 1998

VI. The arguments of the appellant, in writing and during the oral proceedings, can be summarized as follows:

In the period between 4 November 1997 and 21 January 1998, which was before the priority date of the patent in suit, the appellant sold over two thousand cylinder head gaskets with the part No. 452.160 to Daimler Benz AG (see documents B1 and B2) without any secrecy obligation. Said gaskets therefore constituted a public prior use. It was clear from the large numbers of items sold that these gaskets were not sold for test purposes, and were not a joint development of the appellant (the supplier) and Daimler Benz AG (the customer). The bolt hole - fluid hole pairs e - m and e - k met all the requirements of the characterizing part of claim 1 of the patent in suit. Consequently, the subject-matter of claim 1 of the patent in suit lacked novelty over the public prior use.

The auxiliary requests 1 and 2 filed during the oral proceedings before the Board were filed late and should

not be admitted into the appeal proceedings. Any auxiliary requests should have been filed at the earliest possibility, namely in response to the filing of the appeal.

VII. The respondent's arguments, in writing and during the oral proceedings, can be summarized as follows:

The number of metal gaskets with the part No. 452.160 delivered by the appellant to Daimler Benz AG was so low, that it was to be assumed that the metal gaskets were supplied to Daimler Benz AG for test purposes only. There was no evidence that the metal gaskets had actually been used in any motor vehicle sold to a member of the public. Even if this had been the case, it would not have been possible to recognize the individual features of these gaskets without undue burden. The metal gaskets shown in document B1 did not anticipate all the features of claim 1 as granted. A proper construction of claim 1 as granted had to take into account that in the preamble a specific bolt hole - fluid hole pair was singled out, namely a first hole (bolt hole) and an adjacent second hole (fluid hole). The characterizing part of claim 1 required that the second half bead 13b completely surrounded "both first and second hole (Hb', Ho) in combination", ie **only** the one first hole (bolt hole) and the second hole (fluid hole). This feature was not present in the metal gasket according to document B1, wherein further bolt holes were surrounded by the second half bead. In the gasket according to the alleged public prior use the last feature of claim 1 as granted, "i.e. surrounding part of the first hole and part of the second hole so that a portion away from the first hole is surrounded by the

first and second half beads to securely seal around the second hole", was not anticipated either. It followed that claim 1 as granted was new with respect to the alleged public prior use.

The circumstances did not allow an earlier filing of the auxiliary requests. Nevertheless, these requests were merely intended to clarify claim 1 as granted, and, therefore, should be admitted into the appeal proceedings.

Reasons for the Decision

Main request

1. *Objection of lack of novelty, Article 54 EPC*

According to the case law of the boards of appeal of the EPO, a single sale to a single customer not subject to a secrecy agreement suffices to constitute a public prior use. In the present case 2125 cylinder head gaskets No. 452.160 were sold to Daimler-Benz AG before the priority date of the patent in suit. The relatively large number of gaskets sold suggests that they were not intended for test purposes, and were not a joint development of Elring Klinger GmbH (the supplier) and Daimler Benz AG (the customer). The respondent did not file any evidence that the sales had been subject to a secrecy agreement. In the judgment of the Board, the cylinder head gasket No. 452.160 shown in document B1 therefore belongs to the prior art.

Document B1 discloses a metal cylinder head gasket having bolt holes d, e and fluid holes f, g, h, i, k, l, m (water or oil holes). The gasket comprises a bolt hole e ("first hole") and a fluid hole k ("second hole") situated adjacent to one another as shown in the upper left corner of the drawing. It follows from the sections D - D and L - L through said bolt hole e and said fluid hole k, respectively, that the fluid hole k is completely surrounded by a (first, or inner) half bead, which only surrounds said fluid hole k and which is situated inside a (second, or outer) half bead, which completely surrounds both the bolt hole e and the fluid hole k.

Claim 1 as granted is therefore not new with respect to the cylinder head gasket having part No. 452.160 shown in document B1.

It is true that the outer half bead of the gasket with the part No. 452.160 does not surround just one bolt hole and just one fluid hole, since it surrounds in addition to bolt hole e the two bolt holes d located at the left end of the gasket and a second fluid hole l at the bottom end of the gasket, but since this is not excluded by claim 1 as granted (cf. the first sentence of paragraph [0030] of the patent in suit) it cannot lead to a different conclusion.

2. *Admissibility of the auxiliary requests*

2.1 The first and second auxiliary requests were filed by the respondent during the oral proceedings after the discussion of novelty of claim 1 as granted (up to that

time the sole request of the respondent was that the appeal be dismissed).

Claim 1 of the first and second auxiliary requests differ from claim 1 as granted inter alia in that the expression "both first and second hole (Hb', Ho)" is replaced by the expression "**only** the one first hole (Hb') and the second hole (Ho)".

2.2 At the end of the communication attached to the summons to oral proceedings the Board stated the following:

"The attention of the parties is drawn to Articles 12(2) and 13 of the *Rules of Procedure of the Boards of Appeal* (RPBA), OJ EPO 2007, 536 ff. According to the latter, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion.

The criteria for exercise of discretion include whether or not there are good reasons for the late filing and whether or not the amendments and submissions are relevant to a resolution of the issues to be discussed at the oral proceedings. In any case, they should be filed at least one month before the date set for oral proceedings in order to give the Board and the other party sufficient time to prepare for the oral proceedings. The Board may disregard facts or evidence which are not submitted in due time (cf. Article 114(2) EPC and Article 13(3) RPBA)."

The first and second auxiliary requests were filed outside the time limit set by the Board for filing written submissions and/or requests.

Furthermore, in the judgment of the Board, the amendment that the second half bead (13b) completely surrounds, in combination, "**only** the one first hole (Hb') and the second hole (Ho)", shifts the focus to facts not discussed in the appeal proceedings.

The first and second auxiliary requests are therefore not admitted into the appeal proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

D. Meyfarth

W. Zellhuber