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**Datasheet for the decision  
of 4 March 2013**

**Case Number:** T 1351/10 - 3.2.01

**Application Number:** 05425150.9

**Publication Number:** 1700723

**IPC:** B60H 1/00

**Language of the proceedings:** EN

**Title of invention:**

Air treatment assembly for vehicles with an improved gasket  
for the fireproof wall

**Patent Proprietor:**

DENSO THERMAL SYSTEMS S.p.A.

**Opponent:**

Behr GmbH & Co. KG

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 123(2)  
RPBA Art. 12(4), 13(1)

**Keyword:**

"Admission into proceedings (Main Request; First Auxiliary  
Request, Third Auxiliary Request and Fourth Auxiliary Request)  
- (no) "

"Amendment extends beyond the content of application as filed  
(Second Auxiliary Request) - (yes) "

**Decisions cited:**

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**Catchword:**

A change of professional representative is not an objective excuse for not filing appropriate requests along with the statement of grounds of appeal, and in particular for not maintaining the main request underlying the decision under appeal. In fact, this rather presupposes a deliberate choice by the appellant. In any case, a change of representative at the time of filing the statement of grounds of appeal certainly cannot justify the filing of the main request only one month before the date of oral proceedings before the board (cf. point 2 of the Reasons).



Case Number: T 1351/10 - 3.2.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.01  
of 4 March 2013

**Appellant:** DENSO THERMAL SYSTEMS S.p.A.  
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**Respondent:** Behr GmbH & Co. KG  
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**Representative:** Grauel, Andreas  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 29 April 2010  
revoking European patent No. 1700723 pursuant  
to Article 101(3) (b) EPC.

**Composition of the Board:**

**Chairman:** G. Pricolo  
**Members:** H. Geuss  
T. Karamanli

## **Summary of Facts and Submissions**

- I. The appeal of the patent proprietor is directed against the decision of the opposition division, posted on 29 April 2010, concerning the revocation of European patent No. 1700723.
- II. The opposition division held that claim 1 of the main request then on file was not inventive with respect to the documents EP 1512614 A1 (D4) and DE 8236581 U1 (D7). The first auxiliary request, filed by the patent proprietor during the oral proceedings before the opposition division, was not admitted into the proceedings.
- III. Oral proceedings were held before the board of appeal on 4 March 2013.

The appellant (patent proprietor) submitted that the fourth auxiliary request, which corresponds to the main request in the opposition proceedings and which was filed with letter of 4 February 2013, becomes its main request, and that the fifth auxiliary request, filed with letter of 4 February 2013, becomes its fourth auxiliary request. It re-filed them accordingly during the oral proceedings. The appellant also withdrew its third auxiliary request, filed with its statement of grounds of appeal on 6 August 2010, and filed a new third auxiliary request during the oral proceedings.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims according to the main request filed in the oral proceedings of 4 March 2013, or of the first or second

auxiliary request, filed with letter of 6 August 2010, or of the third or fourth auxiliary request, filed in the oral proceedings of 4 March 2013.

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

IV. Claim 1 of the **main request** reads as follows:

Air treatment assembly for vehicles comprising:

- an outer case (12) made of rigid plastic material,
- a heat exchanger for heating and an evaporator (20) housed in the outer case (12) and provided with respective tubes (24, 26) for the entry and the exit of the respective heat exchange fluids extending outside the case (12), and
- - a sealing element (28) situated outside the case (12) and provided with a body made of elastomeric material (32) provided with openings (36, 52) for the passage of said tubes (24, 26), the sealing element (28) being destined to be mounted at an opening (18) in a wall (14) which separates the engine compartment from the passenger compartment of the vehicle, wherein said sealing element (28) comprises a reinforcing member (30) made of rigid plastic material whereon said body of elastomeric material is over-moulded,

characterized in that said reinforcing member (30) has a substantially annular shape, and wherein said body made of elastomeric material (32) has an outer annular groove (38) to be engaged by an edge of the opening (18) of said wall (14).

V. Claim 1 of the **first auxiliary request** reads as follows:

Air treatment assembly for vehicles comprising:

- an outer case (12) made of rigid plastic material,
- a heat exchanger for heating and an evaporator (20) housed in the outer case (12) and provided with respective tubes (24, 26) for the entry and the exit of the respective heat exchange fluids extending outside the case (12), and
- a sealing element (28) situated outside the case (12) and provided with a body made of elastomeric material (32) provided with openings (36, 52) for the passage of said tubes (24, 26), the sealing element (28) being destined to be mounted at an opening (18) in a wall (14) which separates the engine compartment from the passenger compartment of the vehicle, wherein said sealing element (28) comprises a reinforcing member (30) made of rigid plastic material whereon said body of elastomeric material is over-moulded, said reinforcing member (30) having a substantially annular shape, characterized in that said body made of elastomeric material (32) has an outer annular groove (38) to be engaged by an edge of the opening (18) of said wall (14), wherein in a radial direction said reinforcing member (30) is positioned outwardly with respect to said annular groove (38).

VI. Claim 1 of the **second auxiliary request** reads as follows:

Air treatment assembly for vehicles comprising:

- an outer case (12) made of rigid plastic material,
- a heat exchanger for heating and an evaporator (20) housed in the outer case (12) and provided with respective tubes (24, 26) for the entry and the exit of the respective heat exchange fluids extending outside the case (12), and

- a sealing element (28) situated outside the case (12) and provided with a body made of elastomeric material (32) provided with openings (36, 52) for the passage of said tubes (24, 26), the sealing element (28) being destined to be mounted at an opening (18) in a wall (14) which separates the engine compartment from the passenger compartment of the vehicle, wherein said sealing element (28) comprises a reinforcing member (30) made of rigid plastic material whereon said body of elastomeric material is over-moulded, said reinforcing member (30) having a substantially annular shape,

characterized in that said body made of elastomeric material (32) has an outer annular groove (38) to be engaged by an edge of the opening (18) of said wall (14), wherein in a radial direction said reinforcing member (30) is positioned outwardly with respect to said annular groove (38),

said body made of elastomeric material (32) further comprising a lip (40) adjacent to said annular groove (38) and extending over an axial side of said reinforcing member (30), which lip (40) in use presses against a portion of said wall (14).

VII. Claim 1 of the **third auxiliary request** reads as follows:

Air treatment assembly for vehicles comprising:

- an outer case (12) made of rigid plastic material,
- a heat exchanger for heating and an evaporator (20) housed in the outer case (12) and provided with respective tubes (24, 26) for the entry and the exit of the respective heat exchange fluids extending outside the case (12), and
- a sealing element (28) situated outside the case (12) and provided with a body made of elastomeric material

(32) provided with openings (36, 52) for the passage of said tubes (24, 26), the sealing element (28) being destined to be mounted at an opening (18) in a wall (14) which separates the engine compartment from the passenger compartment of the vehicle, wherein said sealing element (28) comprises a reinforcing member (30) made of rigid plastic material whereon said body of elastomeric material is over-moulded, said reinforcing member (30) having a substantially annular shape,  
the assembly comprising a layer of sound-proofing material (16) to be provided on the surface of said wall (14) which is orientated toward the passenger compartment,  
said body made of elastomeric material (32) having an outer annular groove (38) to be engaged by an edge of the opening (18) of said wall (14),  
said body made of elastomeric material (32) further comprising a lip (40) adjacent to said annular groove (38), which lip (40) in use presses against a portion of said wall (14) that is not covered by the layer of sound-proofing material (16),  
and a radial lip (58) extending beyond said reinforcing member (30), which radial lip (58) in use bears against a layer of sound-proofing material (16) provided on the surface of said side wall (14) oriented towards the passenger compartment.

VIII. Claim 1 of the **fourth auxiliary request** reads as follows:

Air treatment assembly for vehicles comprising:

- an outer case (12) made of rigid plastic material,
- a heat exchanger for heating and an evaporator (20) housed in the outer case (12) and provided with respective tubes (24, 26) for the entry and the exit



- of the respective heat exchange fluids extending outside the case (12), and
- a sealing element (28) situated outside the case (12) and provided with a body made of elastomeric material (32) provided with openings (36, 52) for the passage of said tubes (24, 26), the sealing element (28) being destined to be mounted at an opening (18) in a wall (14) which separates the engine compartment from the passenger compartment of the vehicle, wherein said sealing element (28) comprises a reinforcing member (30) made of rigid plastic material whereon said body of elastomeric material is over-moulded, characterized in that wall (14) on its surface oriented towards the passenger compartment is provided with a layer of sound-proofing material (16), said reinforcing member (30) having a substantially annular shape, and said body made of elastomeric material (32) has an outer annular groove (38) to be engaged by an edge of the opening (18) of said wall (14); said body (32) further comprising a lip (40) adjacent to said annular groove (38) which in use presses against a portion of said wall (14) oriented towards the passenger compartment of the vehicle that is not covered by the layer of sound-proofing material (16), said body of elastomeric material (32) also having a radial lip (58) which extends beyond said member (30) made of rigid plastic material, said radial lip (58) bearing in use against an inner surface of the layer of sound-proofing material (16).

IX. The appellant's submissions may be summarized as follows:

The **main request**, filed during the oral proceedings, was identical to the fourth auxiliary request as filed on

4 February 2013 and was based on the main request, filed in the first-instance opposition proceedings. In the present case the representative was changed in August 2010, a few days before expiry of the time limit for filing the statement of grounds of appeal. In August no employees were accessible in the company. Therefore it was necessary to resort to what the representative's predecessor had prepared. Due to these time constraints it was not possible to review the case carefully and to submit correct requests in due time. However the main request should be admitted into the proceedings.

With respect to substantive aspects, claim 1 of the main request was based on claims 1, 2 and 6 as granted. Therefore, the subject-matter which had to be discussed in view of this claim had been in the proceedings from the very beginning. As a result, the respondent could not be surprised by this request.

At the oral proceedings before the opposition division, the appellant had been surprised by the opinion of the opposition division that claim 1 of the main request was not allowable, which was contrary to the preliminary opinion of the opposition division as set out in the annex to the summons to oral proceedings. Consequently, the **first auxiliary request** had duly been filed at the oral proceedings before the opposition division. The opposition division did not admit this request because the amendment, consisting in adding a feature taken from the drawings, was not prima facie allowable. Although the opposition division applied the correct criterion in exercising its discretion, it came to a wrong conclusion because the feature added was clearly and unambiguously disclosed in the originally filed figures. Accordingly,

claim 1 of the first auxiliary request fulfilled the requirements of Articles 84 and 123(2) EPC and was prima facie allowable. Thus, the first auxiliary request should be admitted into the proceedings.

Claim 1 of the **second auxiliary request** contained the added features "the body made of elastomeric material further comprising a lip [...] which lip in use presses against the wall" and "wherein in a radial direction said reinforcing member (30) is positioned outwardly with respect to said annular groove". These features were disclosed in the figures of the application as originally filed. Figures 2 and 3 showed the groove and the reinforcing member in two different views. With respect to the lip (40), figures 2 and 3 were erroneous, since they did not show the lip. Moreover, the lips were provided on the entire circumference of the sealing. It was therefore clear that the claimed relationship between the reinforcing member and the groove extended all over the entire circumference of the sealing element.

The **third auxiliary request** should be admitted into the proceedings. This request was based on the third auxiliary request as filed with the statement of grounds of appeal and claim 1 was amended in order to overcome the objections regarding the feature "wherein in a radial direction said reinforcing member (30) is positioned outwardly with respect to said annular groove" by deleting the latter. The subject-matter of claim 1 was similar to the subject-matter which had already been discussed in the proceedings so far. Consequently the respondent could have been prepared for this situation. The same applied to **the fourth auxiliary**

**request**, which corresponded to the fifth auxiliary request as filed with letter of 4 February 2013.

X. The respondent replied to these arguments as follows:

The **main request**, which corresponded to the fourth auxiliary request filed on 4 February 2013, should not be admitted into the proceedings since it was late filed. There was no reason why this request was not filed earlier. The main request was identical to the main request filed in the first-instance opposition proceedings and it would be normal practice to defend this request in appeal proceedings by including it in the appellant's case as set out in the statement of grounds of appeal. Since this was not done, it had to be assumed that the appellant no longer had an interest in this request. Therefore the filing of this request at a later stage was surprising. Furthermore, the request was filed without any reason being given why the opposition division had erred in its decision that the subject-matter of claim 1 did not involve an inventive step.

The **first auxiliary request** had not been admitted by the opposition division during the oral proceedings since claim 1 was held to be clearly not allowable. The opposition division had correctly exercised its discretion and there was no reason for admitting this request at this stage of the proceedings, especially since the subject-matter of claim 1 contravened Article 123(2) EPC. The feature "wherein in a radial direction said reinforcing member (30) is positioned outwardly with respect to said annular groove" was not clearly and unambiguously disclosed in the application documents as originally filed. In particular, it could not be derived that this feature applied for the whole

circumference of the sealing element, since the figures showed specific views only. Moreover, figures 2 and 3 did not show the lip 40, although it would have to be present according to the claim and the description. This proved that no information could be derived clearly and unambiguously from the figures.

The **second auxiliary request** should likewise not be admitted into the proceedings. The above-mentioned feature "wherein in a radial direction said reinforcing member (30) is positioned outwardly with respect to said annular groove", which was not originally disclosed, was also part of claim 1. Therefore this request too, was not allowable under Article 123(2) EPC.

Nor should the **third auxiliary request** be admitted into the proceedings. Claim 1 of the third auxiliary request contained subject-matter, for example the layer of sound-proofing material and the relationship between the lips and the sound-proofing material, which would have to be considered for the first time in the whole proceedings. These features came from the description and the figures and were never presented as essential for the invention. In this context a further search would be necessary.

Claim 1 of the **fourth auxiliary request** included said features added to claim 1 of the third auxiliary request and, accordingly, the fourth auxiliary request should not be admitted into the proceedings for the same reasons.

## Reasons for the Decision

1. The appeal is admissible.
2. The **main request** under consideration was filed as the appellant's fourth auxiliary request with letter of 4 February 2013, i.e. one month before the oral proceedings before the board. It is identical to the main request underlying the decision of the opposition division (see point II above).
  - 2.1 According to Article 13(1) RPBA (Rules of Procedure of the Boards of Appeal, OJ EPO 2007, 536 ff.) 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 discretion shall be exercised in view of *inter alia* the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy.
  - 2.2 The appellant argued that in August 2010, some days before the end of the time limit for filing the statement of grounds of appeal, the professional representative in this case was changed. It was not possible at that time to review the case carefully and to submit correct requests. Use had to be made of what the representative's predecessor had prepared.
  - 2.3 However, a change of professional representative is not an objective excuse for not filing appropriate requests along with the statement of grounds of appeal, and in particular for not maintaining the main request underlying the decision under appeal. In fact, this rather presupposes a deliberate choice by the appellant. In any case, a change of representative at the time of filing the statement of grounds of appeal certainly cannot justify the filing of the main request only one

month before the date of oral proceedings before the board.

- 2.4 Moreover, in its letter dated 4 February 2013, the appellant only stated with regard to the fourth auxiliary request: "It is requested that the patent be maintained in amended form with the same claim 1 submitted during the opposition procedure with letter of December 18, 2008 of the previous patent representative, and with dependent claims 2-5 of the patent as granted".

No arguments in support of the inventiveness of the subject-matter of claim 1 - which would challenge the decision of the opposition division in respect of the main request - were given.

- 2.5 In the board's view it would not serve the purpose of procedural economy in these appeal proceedings to allow the appellant to defend its main request underlying the decision under appeal for the first time in oral proceedings before the board. Moreover it would go against the principle of fair proceedings to admit the main request into the proceedings, since the appellant's conduct led the respondent to believe that the main request underlying the decision of the opposition proceedings would no longer be the subject of discussion, and, also due to the lack of any written arguments in support of the fourth auxiliary request in the appellant's letter of 4 February 2013, the respondent might well have been surprised by the appellant's arguments.

- 2.6 Thus, the board, exercising its discretion under Article 13(1) RPBA, did not admit the main request into the proceedings.

3. The **first auxiliary request** is not admitted into the proceedings pursuant to Article 12(4) RPBA.

The first auxiliary request, filed with the statement of grounds of appeal, is identical to the first auxiliary request which was filed during the oral proceedings before the opposition division and which was not admitted by the opposition division.

- 3.1 According to Article 12(4) RPBA, the board has the power to hold inadmissible facts, evidence or requests, which could have been presented or were not admitted in the first instance proceedings.
- 3.2 The opposition division exercised its discretion under Article 114(2) EPC and did not admit the first auxiliary request into the proceedings. The opposition division stated in its decision that the feature which had been added in claim 1 of the first auxiliary request with respect to claim 1 of the main request was only taken from the drawings and furthermore, that no technical effect of this feature was disclosed in the opposed patent.

Regarding the review of first instance discretionary decisions, it is established jurisprudence of the boards of appeal that if "the way in which a department of first instance has exercised its discretion on a procedural matter is challenged in an appeal, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, and to decide whether or not it would have exercised such discretion in the same way as the department of first instance. A board of appeal should only overrule the way in which a department of first instance has exercised its



discretion if the board concludes it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way" (Case Law of the Boards of Appeal, 6th edition, 2010, VII.E.6.6).

3.3 The appellant did not challenge the correctness of the criteria applied by the opposition division when exercising its discretion. Nevertheless the appellant argued that the features added in claim 1 of the first auxiliary request support the inventive idea of the contested invention.

3.4 In the board's view, the opposition division applied the correct criteria in exercising its discretion not to admit the first auxiliary request into the proceedings. In particular, one of the criteria applied takes into account the fact that features for an amendment of a claim, filed during oral proceedings, come from the drawings and not from a (dependent) claim. This criterion is consistent with the established jurisprudence of the boards of appeal. Accordingly, the opposition division exercised its discretion according to the right principles and in a reasonable way. Thus the board sees no reason to overrule the way in which the opposition division exercised its discretion.

4. The **second auxiliary request**, filed with the statement of grounds of appeal, is not considered inadmissible under Article 12(4) RPBA.

The respondent requested that the second auxiliary request should not be admitted into the proceedings on the grounds that it could have been filed in the first-instance proceedings and that it was clearly not allowable for lack of compliance with Article 123(2) EPC.

The board however agrees with the appellant that the amendments, consisting in including in claim 1 further details of the allegedly inventive feature (sealing element), represents a restriction of the claimed subject-matter. Since it still rests on the alleged inventive concept underlying the patent in suit, it does not result in the introduction of new aspects into the discussion on inventive step. Therefore, the second auxiliary request constituted an appropriate attempt by the patent proprietor to defend its patent at the time of filing the statement of grounds of appeal.

Accordingly, the respondent's request not to admit the second auxiliary request was rejected.

5. However, the appellant's request fails for lack of compliance with the requirements of Article 123(2) EPC.

5.1 As admitted by the appellant, the feature "wherein in a radial direction said reinforcing member (30) is positioned outwardly with respect to said annular groove" is taken from the figures. Since the sealing element according to the contested invention is apparently not rotation-symmetrical (cf. figures 1 and 4), it is *per se* not possible to derive clearly and unambiguously the information concerning the whole circumference of the sealing element from the two-dimensional drawing of figure 5. Therefore, even having regard to figures 2 and 3, showing the groove and the reinforcing member in different views in which the feature under consideration is fulfilled, no clear and unambiguous conclusion can be reached in respect of whether this feature is fulfilled over the whole circumference of the sealing element. Since claim 1 is to be understood as referring to the whole circumference - this also being the appellant's intention - it is

concluded that claim 1 relates to subject-matter which is not clearly and unambiguously derivable from the disclosure of the application as originally filed.

6. Claim 1 of the **third auxiliary request** as filed during the oral proceedings is based on claim 1 of the third auxiliary request as filed with the statement of grounds of appeal and has been amended in view of the contested feature "*that the reinforcement member is positioned outwardly with respect to the annular groove*".

6.1 With respect to claim 1 of the second auxiliary request, claim 1 contains the following additional features:

- the assembly comprising a layer of sound-proofing material (16) to be provided on the surface of said wall (14) which is oriented toward the passenger compartment;
- the lip (40) in use presses against a portion of the wall that is not covered by the layer of sound-proofing material (16);
- a radial lip (58) extending beyond said reinforcing member (30), which radial lip (58) in use bears against a layer of sound-proofing material (16) provided on the surface of said side wall (14) oriented towards the passenger compartment.

6.2 The third auxiliary request was not admitted into the proceedings under Article 13(1) RPBA.

6.3 The appellant argued that the third auxiliary request should be admitted into the proceedings because the claims and their subject-matter were not so different from those already discussed.

The board does not accept this argument. The features of the sound-proofing material and the combination of the two kinds of lips (40, 58) - one of them (58), when in

use, bearing against this layer of sound-proofing material, the other one bearing against the wall which is not covered by the layer of sound-proofing material - apparently relate to an aspect of the alleged invention which is different from and seemingly unrelated to the invention as presented in the granted patent, which is mainly related to the aspect of mounting the sealing element in the firewall of the vehicle. In the patent as granted the focus is in particular on the features annular groove (38), reinforcing member (30) and body (32). The aspect of sound-proofing is not recited in any dependent claim, nor did it previously play any role in the proceedings.

Consequently, the board holds that the limitation introduced into claim 1 of the third auxiliary request would shift the discussion in a different and unexpected direction, thereby raising new issues. Thus, exercising its discretion under Article 13(1) RPBA, the board did not admit the third auxiliary request into the proceedings.

- 6.4 Claim 1 of the **fourth auxiliary request**, filed with letter of 4 February 2013, also includes, as does claim 1 according to the third auxiliary request, additional features relating to the sound-proofing aspect - by referring to the layer of sound-proofing material and the relationship between this layer and the lip (40) and the radial lip (58), respectively.

Thus, for the same reasons as explained for the third auxiliary request, the fourth auxiliary request was not admitted into the proceedings either.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

A. Vottner

G. Pricolo