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

**Case Number:** T 1616/10 - 3.2.06

**Application Number:** 03747537.3

**Publication Number:** 1500799

**IPC:** F01N3/02, F01N3/28, B01J35/04

**Language of the proceedings:** EN

**Title of invention:**  
HONEYCOMB FILTER FOR CLARIFYING EXHAUST GAS

**Patent Proprietor:**  
IBIDEN CO., LTD.

**Former Opponent:**  
Saint-Gobain Centre de Recherches et d'Etudes Européen

**Relevant legal provisions:**  
RPBA Art. 12(4), 13(1)

**Keyword:**  
Main request and auxiliary request 1: not admitted; claim 1 broader than all requests underlying the appealed decision, requests could have been filed in first instance proceedings (see Reasons 1.6, 1.7 and 2.2 to 2.4).  
Auxiliary request 2: not admitted; no clear and unambiguous disclosure for the added feature.

**Decisions cited:**  
G 0009/91, G 0010/91, T 0144/09



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Case Number: T 1616/10 - 3.2.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.06**  
**of 4 December 2013**

**Appellant:** IBIDEN CO., LTD.  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 11 June 2010  
revoking European patent No. 1500799 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman:** M. Harrison  
**Members:** G. de Crignis  
K. Garnett

## **Summary of Facts and Submissions**

- I. European patent No. 1 500 799 was revoked by the opposition division by way of its decision posted on 11 June 2010.
- II. The opposition division held that the subject-matter of claim 1 according to the main request which was filed during the oral proceedings did not involve an inventive step (Article 56 EPC) when starting from:

D9 WO-A-02/085814 (priority date: 23 April 2001, publication date: 31 October 2002).

The distinguishing features were either well-known or did not result in any unexpected technical effect over the prior art.

The opposition division also found that the subject-matter of claim 1 of auxiliary requests 1, 2, 3 and 6 did not meet the requirement of Article 123(2) EPC and the subject-matter of claim 1 according to auxiliary requests 1 and 7 did not involve an inventive step when using the problem/solution approach starting from D9. Auxiliary requests 4 and 5 were not admitted into the proceedings.

- III. The appellant (patent proprietor) filed an appeal against this decision and paid the appeal fee. A statement setting out the grounds of appeal was received at the European Patent Office together with claims of an amended main request and auxiliary requests 1 to 3. The appellant requested that the decision of the opposition division be set aside and the patent be maintained on the basis of one of these

requests or that the case be remitted to the opposition division for further prosecution.

IV. With its communication annexed to a summons to oral proceedings, the Board referred to Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA) and indicated that in view of the fact that the scope of claim 1 of all the requests was broader than the claims considered by the opposition division, the Board would be the first instance to consider a claim 1 of such scope and that no arguments had been submitted why such requests should be admitted.

V. With letter of 20 November 2013 the appellant filed amended claim requests as main, first and second auxiliary requests.

VI. Oral proceedings were held on 4 December 2013.

The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request, alternatively the first or second auxiliary requests, all as filed with the letter dated 20 November 2013.

Respondent I (opponent I) had by its letter dated 13 March 2012 withdrawn its opposition and did not attend the oral proceedings.

VII. Claim 1 of the main request reads:

"A honeycomb filter for purifying exhaust gases comprising:

a columnar body made of a plurality of porous ceramic honeycomb members assembled with one another through sealing material layers, each of said porous ceramic

honeycomb members comprising a number of through holes, said through holes being in parallel with one another along a length direction with a wall portion interposed therebetween; and  
a sealing material layer formed on the periphery of the columnar body;  
wherein predetermined through holes of said through holes are filled with plugs at one end of said columnar body, while the through holes that have not been filled with said plugs at said one end are filled with plugs at the other end of said columnar body,  
wherein at least a part of said wall portion functions as a filter for collecting particulates, characterized in that  
the porosity of said columnar body is in a range from 20 to 80%, and the porosity of said plug is 90% or less and is 0.25 to 1.5 times as much as the porosity of said columnar body."

Claim 1 of auxiliary request 1 reads:

"A method for removing fine particles from a honeycomb filter for purifying exhaust gases, the honeycomb structure comprising:  
a columnar body made of a plurality of porous ceramic honeycomb members assembled with one another through sealing material layers, each of said porous ceramic honeycomb members comprising a number of through holes, said through holes being in parallel with one another along a length direction with a wall portion interposed therebetween; and a sealing material layer formed on the periphery of the columnar body, wherein predetermined through holes of said through holes are filled with plugs at one end of said columnar body, while the through holes that have not been filled with said plugs at said one end are filled with plugs at the

other end of said columnar body, wherein at least a part of said wall portion functions as a filter for collecting particulates, the porosity of said columnar body is in a range from 20 to 80%, and the porosity of said plug is 90% or less and is 0.25 to 1.5 times as much as the porosity of said columnar body, wherein fine particles that have been collected and accumulated are burned and removed from the honeycomb filter by heating the exhaust gases."

Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 1 in that the following feature is added: "using a heating means placed on the exhaust gas inlet side of the honeycomb filter."

VIII. The arguments of the appellant were essentially the following:

The Board should exercise its discretionary power under Article 12(4) RPBA and admit all the requests into the proceedings.

During opposition proceedings, the appellant had reacted to the negative opinion by the Opposition Division and sought maintenance of the patent in a restricted form, which had led to the loss of a valid priority. At the oral proceedings, the Opposition Division admitted document D9 even though it had been filed after the nine-month opposition period, and then decided that the subject-matter of claim 1 lacked an inventive step when starting from this document.

In the course of the opposition proceedings, the appellant had never abandoned any part of the granted patent.

When entering the appeal procedure, in an attempt to overcome the appealed decision and in order to regain the benefit of the priority date, new main and auxiliary requests had been submitted, which contained a claim 1 which was indeed of broader scope than the one underlying the appealed decision. In consequence, D9 became the state of the art only under Article 54(3) EPC.

There were no new issues introduced by the filing of such requests. The main request was directed fundamentally to the same subject-matter which had been considered by the Opposition Division when it established its preliminary opinion. Under such circumstances, the submission of such a request did not amount to an abuse of procedure. Amended claim requests had been submitted with the grounds of appeal and the current requests were filed in response to the preliminary opinion by the Board, hence, at the earliest possible stage. Claim 1 of the main request was a combination of granted claims and, additionally, it overcame the objection raised by the Board. Hence it could not be considered to be of increased complexity. The subject-matter of claim 1 of auxiliary request 1 was also based on a combination of granted claims. The preliminary opinion of the opposition division was on file and thus it was not necessary to remit the case for procedural efficiency since the opposition division would simply have copied this view into a final decision.

D4 (EP-A-1 142 619) should now be considered as representing the closest prior art. However, when considering the problem to be solved as being related to an improved avoidance of cracks and gaps during the regeneration process, or in other words to provide

improved durability during operation, there was no disclosure in any cited prior art document which would lead the skilled person to consider the porosity in the columns in relation to the porosity in the plugs as being of importance. Therefore, such subject-matter involved an inventive step. D7 (US-A-5 595 581) was the only document which referred to the issue of such porosity but disclosed a completely different structure, as it concerned a method for a blowback mode including two different kinds of plugs. Hence, even when considering the problem to be solved as simply providing an alternative, the skilled person would not consider such teaching.

Concerning auxiliary request 2, the amendments were based on page 30, 1. 9 to 14 and page 31, 1. 3 to 7 of the application as filed, which passages were linked to the embodiment shown in Figure 6. Such filters were usually in a casing and were implicitly surrounded by a holding and sealing material, which details were well-known to the skilled person and there was no need to include such further features into claim 1.

## **Reasons for the Decision**

1. *Non-admittance of the main request*
  - 1.1 The appellant's choice not to maintain any request of a broader scope during the opposition proceedings is of importance in considering the admissibility of this request in the appeal proceedings in accordance with Article 12(4) RPBA. According to Article 12(4) RPBA, the Board can hold inadmissible facts, evidence or



requests which could have been presented or were not admitted in the first instance proceedings. When deciding on this issue, it is relevant to consider why the specific request(s) now on file could have been (or could not have been) presented during the first instance proceedings.

1.2 Together with the statement of the grounds of appeal, a main request and two auxiliary requests were submitted (see point III above). Different to claim 1 of each of these requests, each claim 1 of the main and the seven auxiliary requests underlying the appealed decision included the following additional features (the auxiliary requests including also further features):

- "said porous ceramic honeycomb members are obtainable from a material paste prepared by adding a binder and a dispersant solution to ceramic powder, whereas said plugs are obtainable from a filler paste prepared by adding a lubricant, a solvent, a dispersant and a binder to the ceramic powder that is used for the material paste";
- "said honeycomb filter comprises a catalyst supporting film of 1 g/L or more placed on the surface thereof and a catalyst applied to the preliminarily coated catalyst supporting film,";
- "said porosities of the columnar body and the plug being measured after said catalyst supporting film has been formed on said honeycomb filter";
- the range of the porosity of the plug is further set to "0.3 to 1.2 times as much as the porosity of said columnar body".

Hence, all these claims 1 were far narrower in scope than claim 1 of all current requests.

1.3 Such limitation of the claimed subject-matter was made voluntarily and purposefully for being the subject of examination before the Opposition Division, evidently in order to overcome objections to lack of novelty in view of:

D1 EP-A-1 479 882 and  
D2 EP-A-1 489 277

which had been raised by the Opposition Division in its preliminary opinion sent to the parties prior to oral proceedings.

1.4 In this context, it is relevant to point out that the claims underlying the preliminary opinion of the Opposition Division (submitted with letter of 25 February 2009) included a main request consisting of claims 1 to 6 as granted and a first and second auxiliary request whereby none of these requests included a claim 1 which was limited with regard to the features set out under point 1.2 above. These requests were withdrawn prior to the oral proceedings before the department of first instance and were replaced by the requests underlying the impugned decision.

1.5 By maintaining (at least) one of these requests previously on file during the opposition proceedings, such requests could evidently have been pursued even though a negative preliminary opinion in view of D1 and D2 had been issued. All these requests were of an even broader scope with regard to the ratio of the porosity of the plugs to the porosity of the columnar body (0.15 to 4.0 times) than now claimed (0.25 to 1.5 times) in claim 1 of all the requests in the appeal.

1.6 Due to the limitation of the claimed subject-matter in the opposition proceedings, the priority date (11 April 2002) was no longer valid and D9 became state of the art under Article 54(1) and (2) EPC, and was considered as representing the closest state of the art; the subsequent considerations concerning inventive step led the Opposition Division to the revocation of the patent. No argument against this finding was raised by the appellant (see e.g. item 7 of the impugned decision indicating that the Opposition Division's finding in this respect was agreed by the parties). In the appeal proceedings, the broadening of the scope of claim 1 resulted in the priority date being again valid and D9 thus representing state of the art only under Article 54(3) EPC. Thus, the entire reasoning of the opposition division in regard to inventive step starting from D9 as the closest state of the art was rendered meaningless in the context of the present requests.

1.7 The circumstances of the present case, which demonstrate that a deliberate choice was made by the proprietor not to maintain a sole pre-existing request including a claim 1 of broader scope, but instead to limited the claims to ones having the features mentioned in item 1.2. above, - for whatever reason - are considered by the Board to fit the rationale underlying Article 12(4) RPBA. By doing so, the Opposition Division was prevented from issuing a decision on a request including the broader subject-matter. The primary purpose of an appeal is to provide the opportunity for a final instance review of the decision of the department of first instance, thereby (in *inter partes* proceedings) allowing the losing party to challenge the decision of an opposition division on its merits and to obtain a judicial ruling as to

whether the decision of the opposition division is correct (G 9/91 and G 10/91 - OJ EPO 1993, 408, 420). The appeal proceedings do not have the purpose of starting a new examination of different subject-matter, in particular where such subject-matter involves broadening of claims considered by an opposition division (see also T 0144/09, point 1.14, second paragraph). As a consequence of the foregoing, the Board exercised its discretion under Article 12(4) RPBA not to admit the main request into the proceedings.

- 1.8 Concerning the main request, the fact that the appellant filed, in response to the communication of the Board, a request including a claim 1 intended to overcome the objection raised with regard to Article 123(2) EPC is irrelevant for the decision on admittance in the current case. The feature which was added to meet the Board's objection is not related to the features concerning the broadened scope of claim 1 as set out under point 1.1 above and thus addresses a different issue.
- 1.9 Moreover, the appellant considered that the discretion should 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. However, these criteria apply for the exercise of the discretion according to Article 13(1) RPBA and not to the exercise of the discretion under Article 12(4) RPBA.
- 1.10 Although the appellant argued that the reasoning adopted by the opposition division in its preliminary opinion issued prior to oral proceedings could have been used by the Board in place of the decision under appeal, the Board is not persuaded by this argument.

The issue of an opinion prior to oral proceedings is not a substitute for a decision; it is merely a preliminary opinion which might or might not be upheld as a result of any oral proceedings and any counter arguments of the parties. Also, the claims as considered by the opposition division at that stage are not the same as those before the Board of Appeal.

2. *Non-admittance of auxiliary request 1*

2.1 Claim 1 of this request is a combination of granted claims 6, 1 and 3 with an additional limitation in the ratio of the porosity of the plug to the porosity of the columnar body to 0.25 to 1.5, as well as the addition of the features concerning the sealing materials. Thus the issue with regard of the broadness of the claimed subject-matter in this request corresponds to the issue considered above for the main request.

2.2 The circumstances differ from the circumstances concerning the main request partly in that claim 1 refers to a method. Although two method claims had been in the scope of the granted claims (claims 5 and 6), at no time during opposition proceedings was there a request on file concerning a method as the sole independent claim.

2.3 The Opposition Division's findings in the appealed decision were based exclusively on claim 1 of each request which was related either to the filter or to the use of the filter.

2.4 Accordingly, in addition to the fact that no claim 1 of such broad scope was considered by the Opposition Division, there is also no finding of the Opposition

Division with respect to a method claim. This means that the appellant has completely revised its strategy without any explanation as to why a request including only a method claim as the sole independent claim had not been or could not have been pursued during the opposition proceedings. In consequence of at least this, the Board exercised its discretion under Article 12(4) RPBA not to admit auxiliary request 1 into the proceedings.

3. *Non-admittance of auxiliary request 2*

3.1 According to Article 13(1) RPBA, it lies within the discretion of the Board to allow an appellant to amend its case after the filing of the grounds of appeal and thus to admit such requests into proceedings. This discretion is to 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.

3.2 As a first step, these criteria were considered for the issue of possible admittance of claim 1 of auxiliary request 2, which request was filed in reply to the communication of the Board (i.e. after the appellant had supplied its complete case in accordance with Article 12(2) RPBA) and which thus represents an amendment to the party's case.

3.3 Claim 1 of auxiliary request 2 defines a method and differs from claim 1 of auxiliary request 1 in that the feature:  
"using a heating means placed on the exhaust gas inlet side of the honeycomb filter"  
has been added.

- 3.4 This feature *per se* is disclosed on page 30, lines 9 to 14 and page 31, lines 3 to 7 of the application as filed. However, as is evident from page 30, line 9, these paragraphs refer to the embodiment shown in Figure 6. Figure 6 discloses a structure in which a filter is held in a casing by a holding and sealing material, the heating means being placed in front of the filter between the inlet pipe and the filter. Other features are also disclosed.
- 3.5 The appellant considered a casing as well as a holding and sealing material as being necessarily and implicitly present when using the filter for purifying exhaust gases. Therefore, the appellant argued that these features would be self-evident in such a method and the skilled person would read them into the claim as being present, such that no necessity would arise to include further features in the wording of the claim.
- 3.6 Contrary to the appellant's view, the Board concludes that the heating means is disclosed not only as being placed on the exhaust gas inlet side of the honeycomb filter (as claimed), but in particular placed within the casing and spaced from the inlet pipe and also spaced from the filter. The Board does not accept that these features (at least) are implicitly within the claim as understood by a skilled person.
- 3.7 Accordingly, there is at least *prima facie* no disclosure (Article 123(2) EPC) for the added feature in the general way in which it is claimed, but a disclosure only in relation to its particular position within the filter. Hence, the Board exercised its discretion under Article 13(1) RPBA not to admit auxiliary request 2 into the proceedings.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated