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**Datasheet for the decision  
of 23 June 2016**

**Case Number:** T 0356/14 - 3.3.06

**Application Number:** 06781505.0

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**IPC:** B01J35/04, B01D53/94,  
B01J23/58, B01J23/63,  
B01J37/02, F01N3/10

**Language of the proceedings:** EN

**Title of invention:**  
EXHAUST GAS PURIFYING CATALYST

**Applicant:**  
Cataler Corporation

**Headword:**  
Exhaust gas purifying catalyst/CATALER

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

**Keyword:**  
Late filed claim requests - change of subject-matter -  
admitted (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
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Case Number: T 0356/14 - 3.3.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.06**  
**of 23 June 2016**

**Appellant:** Cataler Corporation  
(Applicant) 7800, Chihama  
Kakegawa-shi  
Shizuoka 437-1492 (JP)

**Representative:** Goddar, Heinz J.  
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**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 14 August 2013 refusing European patent application No. 06781505.0 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** P. Ammendola  
**Members:** E. Bendl  
S. Fernández de Córdoba

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the examining division to refuse the European patent application 06 781 505.0, published as EP 1 911 517 A1.
- II. In the appealed decision the examining division concluded, *inter alia*, that the wording of claim 1 of the then only pending claim request was not clear, that the subject-matter of this claim went beyond the original disclosure and was also not novel with regard to, among other documents, D7 (EP 1 916 031 A1), state of the art relevant in accordance with Articles 52(1) and 54(3) EPC.
- III. With its statement of grounds of appeal the appellant submitted three sets of claims. It argued that these amended claim requests met the requirements of Articles 123(2), 84, 54 and 56 EPC.
- IV. In preparation of oral proceedings the board expressed its preliminary opinion concerning the sets of claims on file and raised a series of objections, among them lack of novelty.
- V. With letter of 9 June 2016 the appellant submitted three further sets of claims as main request and auxiliary requests 1 and 2 in order to replace the claim requests already on file. Comments as to the substance of the objections raised were not presented.
- VI. Claim 1, the only independent claim of the main request, reads as follows:

"1. An exhaust gas purifying catalyst comprising:

*a catalyst substrate; and*

*a catalyst coating layer containing a noble metal and a refractory inorganic oxide, and formed on the catalyst substrate,*

*wherein the catalyst coating layer includes an upstream portion located upstream and a downstream portion located downstream of the upstream portion in a flow direction of an exhaust gas,*

*wherein the upstream portion has a layered structure including an upstream portion inside layer and an upstream portion outside layer, and*

*wherein the upstream portion inside layer contains a cerium-zirconium composite oxide in which a relative proportion of  $CeO_2$  is 50 to 95 wt%, as the refractory inorganic oxide, and the upstream portion outside layer and the downstream portion contain a cerium-zirconium composite oxide in which a relative proportion of  $ZrO_2$  is 50 to 95 wt%, as the refractory inorganic oxide."*

The wording of claim 1 of the first auxiliary request differs from the wording of claim 1 in the additional feature "*wherein the upstream portion outside layer, the upstream portion inside layer, and the downstream portion contain Al*" appended at the end of the claim.

VII. Oral proceedings took place on 23 June 2016. In the course of the proceedings the appellant withdrew its second auxiliary request. The issues discussed were the admissibility of both remaining claim requests in

particular in view of the question whether the claimed subject-matter was novel vis-à-vis D7.

VIII. The appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the main request or the first auxiliary request, both submitted with letter of 9 June 2016.

IX. The arguments of the appellant, as far as relevant to the present decision, were as follows:

- The wording of claim 1 of the main request corresponded to claim 1 as originally filed.
- As to whether this claim appeared clearly allowable in view of Article 54 EPC, the appellant conceded that the features of claim 1 were also to be found in D7 and, thus, that this citation anticipated the subject-matter of claim 1 of the main request.
- Also the additional feature distinguishing claim 1 of the first auxiliary request from claim 1 of the main request could be found in D7; the disclosure of this document therefore also destroyed novelty of the subject-matter of the first auxiliary request.

## **Reasons for the Decision**

### *Admissibility of the requests*

1. The main and first auxiliary request on file contain, in comparison to the sets of claims filed with the grounds of appeal, deletions of features which were before *inter alia* considered by the appellant to be essential for creating novelty over the prior art disclosures and even for overcoming difficulties of the

prior art (see the grounds of appeal dated 13 December 2013, page 9, first and second paragraph, page 10). This means a significant amendment to the appellant's case in comparison to the reasons brought forward in the said grounds. The amended sets of claims at issue were filed on 9 June 2016, i.e. two weeks prior to the oral proceedings before the board and were not accompanied by explanations as to the reasons for this change of argumentation.

2. Therefore, having regard to the requirements of Article 13(1) RPBA it is at the board's discretion to decide on the admissibility of the two claim requests at issue.

#### Main request

3. Claim 1, the only independent claim of the main request is, apart from the insertion of the passage "[located downstream] *of the upstream portion*", i.e. a minor clarification, identical to claim 1 as originally filed.
4. In contrast thereto, claim 1 of the only request discussed in the decision under appeal was not only based on claim 1 as originally filed, but contained in addition two further features. Thus, the ambit of this claim was more narrow than of claim 1 as originally filed, respectively of claim 1 of the present main request.
5. However, with regard to claim 1 of this more narrow claim request, the minutes of the oral proceedings before the examining division contain the following statement of the applicant/appellant referring to document D7: "*The applicant acknowledged the raised objections and he added that he can file an auxiliary*

*request in order to overcome the formal issues, **but not the novelty objection.***" (minutes, page 1, bottom of the page; emphasis added by the board).

6. Thus, as the ambit of claim 1 of the main request on file is broader than of claim 1 discussed in the impugned decision, the appellant's concession that the subject-matter of claim 1 lacks novelty vis-à-vis D7 must apply to claim 1 of the present main request *mutatis mutandis*.
7. In addition, also in the oral proceedings before the board the appellant conceded that D7 destroyed novelty of claim 1 of the main request.
8. Given these considerations the late filed main request is *prima facie* not suitable to remove all the objections raised by the board, but it, on the contrary, raises new issues due to the omission of features which were before considered by the appellant necessary to distinguish from prior art disclosures.
9. Therefore the board decided not to admit this request into the proceedings in accordance with Article 13(1) RPBA.

#### First auxiliary request

10. As stated *supra*, the wording of claim 1 of the first auxiliary request differs from the wording of claim 1 of the main request in the presence of A1 in the upstream inside and outside layers and the downstream portion.
11. In the discussion it was also admitted by the appellant that this feature was present in D7 in a novelty-



destroying manner. The considerations *supra* with regard to novelty apply *mutatis mutandis*.

12. Since the first auxiliary request is also *prima facie* not suitable to overcome the objections raised by the examining division/the board and raises further questions, the first auxiliary request is also not admitted into the proceedings in accordance with Article 13(1) RPBA.

### **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



D. Magliano

P. Ammendola

Decision electronically authenticated