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**Datasheet for the decision
of 14 July 2021**

Case Number: T 1292/17 - 3.2.06

Application Number: 08828117.5

Publication Number: 2184458

IPC: F01N3/28, F01N3/20, F01N3/021,
B01D53/94, F01N13/18

Language of the proceedings: EN

Title of invention:
EXHAUST EMISSION CONTROL DEVICE

Patent Proprietor:
Hino Motors Ltd.

Opponents:
Tenneco GmbH
ROUSE IP LIMITED

Headword:

Relevant legal provisions:
EPC Art. 56, 123(2)
EPC R. 80
RPBA 2020 Art. 11

Keyword:

Inventive step - main request (no)

Amendment occasioned by ground for opposition - (no)

Amendments - intermediate generalisation (yes)

Remittal - (no)

Decisions cited:

T 1688/08, T 0426/88

Catchword:



Beschwerdekammern

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Chambres de recours

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Case Number: T 1292/17 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 14 July 2021

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 27 March 2017
rejecting the opposition filed against European
patent No. 2184458 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman	M. Harrison
Members:	M. Dorfstätter
	W. Ungler

Summary of Facts and Submissions

- I. Appeals were filed by the appellants (both opponents) against the decision of the opposition division to reject the oppositions to European patent No. 2 184 458. They requested that the decision be set aside and the patent be revoked.
- II. In its letter of response the respondent (patent proprietor) requested as a main request that the appeals be dismissed or, failing this, that the case be remitted to the opposition division for discussion of its auxiliary requests 1 to 5 which had been filed originally during the opposition proceedings.
- III. The following documents, relevant to the present decision, were referred to by the parties:
- | | |
|-----|-------------------|
| D14 | WO 2006/087541 A1 |
| D3 | JP 2004-108221 |
- IV. The Board issued a summons to oral proceedings, in reply to which the respondent stated that it would not attend the oral proceedings.
- V. The Board further issued a communication containing its provisional opinion, in which it indicated *inter alia* that the subject matter of claim 1 of the main request lacked inventive step. The Board also explained that before considering possible remittal of the case, it would first have to be discussed whether any of the auxiliary requests fulfilled the requirements - at least - of Rule 80 EPC and Article 123(2) EPC, and that it considered none of the auxiliary requests as meeting

these requirements. The Board set a limit of one month prior to the oral proceedings for any submissions of the parties to be filed. Additionally, the Board stated that if no further submissions were received, the oral proceedings would probably be cancelled and a decision issued in writing.

VI. No response from the respondent was received after the Board's communication.

VII. The oral proceedings were duly cancelled.

VIII. Claim 1 of the main request (claim 1 of the patent as granted) reads as follows (including the feature-by-feature analysis adopted in opposition proceedings and taken over on appeal):

1a "An exhaust emission control device
1b wherein a particulate filter (5) and a
selective reduction catalyst (6) arranged
downstream of said particulate filter (5) and
capable of selectively reacting NO_x with
ammonia even in the presence of oxygen
1c are housed by casings (7, 8), respectively,
1d and arranged side by side such that inlet ends
of the particulate filter (5) and the
selective reduction catalyst (6) are oriented
to one and the same direction,
1e an S-shaped communication passage (9) being
provided for introduction of the exhaust gas
from an outlet end of the particulate filter
(5) to the inlet end of the adjacent selective
reduction catalyst (6) through antithetical
turnabout, and
1f urea water being addible intermediately of
said communication passage (9),

- 1g the casings (7, 8) for the particulate filter (5) and selective reduction catalyst (6) are integrally restrained by rigid restraining members (13; 14) characterized in that
- 1h the casings (6, 8) for the particulate filter (5) and selective reduction catalyst (6) are individually restrained at a plurality of axial points on the casings (7, 8) by the restraining members (14),
- 1i said respective restraining members (14) being connected together by connecting members (16) for integral restraint."

Claim 2 of the main request reads as follows:

"An exhaust emission control device as claimed in claim 1, characterized in that the communication passage (9) is also restrained together by the restraining members (13; 14)."

Claim 1 of auxiliary request 1 reads as for claim 1 of the main request, with the following feature appended:

"and fitted to an outer surface of a vehicle frame (17)."

Claim 1 of auxiliary request 2 reads as for claim 1 of the main request, with the following feature appended:

"said restraining members (14) being comprised of brackets extending sideway of the particulate filter (5) and the selective reduction catalyst (6) and fitted to an outer surface of a vehicle frame (17)."

Auxiliary requests 1 and 2 include a dependent claim 2, which reads as follows:

"An exhaust emission control device as claimed in claim 1, characterized in that the particulate filter (5) and the selective reduction catalyst (6) are fixed to lower surfaces of said restraining members (14)."

Claim 1 of auxiliary request 3 reads as for claim 1 of the main request with the following features appended:

"said restraining members (14) being comprised of brackets extending sideway of the particulate filter (5) and the selective reduction catalyst (6) and fitted to an outer surface of a vehicle frame (17), wherein the particulate filter (5) and the selective reduction catalyst (6) are fixed to lower surfaces of said restraining members (14)."

Claim 1 of auxiliary request 4 reads as for claim 1 of the main request with Feature 1i being substituted by the following features:

"said respective restraining members (14) being connected together and integrally restrained by connecting members (16) extending axially of the particulate filter (5) and selective reduction catalyst (6),
said restraining members (14) being comprised of brackets extending sideway of the particulate filter (5) and the selective reduction catalyst (6),
one end of said restraining members (14) being downwardly curved in the form of letter L, which part is fitted to an outer side surface of a vehicle frame (17) so as to serve also as support member for the exhaust emission control device,

wherein upper portions of flanges of the particulate filter (5) and the selective reduction catalyst (6) are fixed to lower surfaces of said restraining members (14) through fixture tools (15)."

Claim 1 of auxiliary request 5 reads as for claim 1 of the main request with Feature 1i being substituted by the following features:

"said respective restraining members (14) being connected together and integrally restrained by connecting members (16) extending axially of the particulate filter (5) and selective reduction catalyst (6),
said restraining members (14) being comprised of brackets having a U-shaped cross section and extending sideway of the particulate filter (5) and the selective reduction catalyst (6),
one end of said restraining members (14) being downwardly curved in the form of letter L, which part is fitted to an outer side surface of a vehicle frame (17) so as to serve also as support member for the exhaust emission control device,
wherein upper portions of flanges of the particulate filter (5) and the selective reduction catalyst (6) are fixed to lower surfaces of said restraining members (14) through fixture tools (15) with L-shaped cross section, which fixture tools (15) are mounted on a bottom of said U-shaped restraining members (14) through fastening bolts and lower ends of the fixture tools (15) are overlapped with upper portions of the flanges of the particulate filter (5) and the selective reduction catalyst (6) and are bolted together by flange-connecting bolts at the respective overlapped portions."

IX. The appellants' arguments may be summarised as follows:

The subject-matter of claim 1 of the main request lacked novelty vis-à-vis D14. It furthermore lacked inventive step when starting from the embodiment of Figure 7 in D14 as the closest prior art. The skilled person made use of their general knowledge or was guided to the invention by the mounting structure presented in D3.

Claim 2 of the first and second auxiliary requests was not an amendment which overcame a ground of opposition. The filing of this amended dependent claim was not admissible.

The claims of all auxiliary requests defined subject-matter extending beyond the content of the application as filed.

X. The respondent's arguments may be summarised as follows:

The subject-matter of claim 1 of the main request was novel and involved an inventive step. It was not permissible to combine separate items belonging to different embodiments described in one and the same document. Features 1f, 1h and 1i were not disclosed in D14. Feature 1f was to be understood such that urea water is added to the exhaust gas in the communication passage. According to Article 69(1) EPC the description and the drawings should be used to interpret the claims. The claim language had to be interpreted from the point of view of the skilled person who did not need to be an English native speaker. The skilled person was not prompted to the combination of features of claim 1 as granted by the sole disclosure of D14,

nor was that combination suggested by the other cited documents, including D3.

Reasons for the Decision

Main request

1. Novelty - Article 54 EPC
 - 1.1 Although not by itself decisive since the the patent cannot be maintained due to a lack of inventive step, novelty is dealt with here in order to establish the distinguishing features over the Figure 7 embodiment in D14.
 - 1.2 The subject-matter of claim 1 of the main request is novel (Article 54 EPC). Whilst Features 1a to 1g are present in the embodiment of Figure 7 in D14, neither Feature 1h nor Feature 1i are disclosed. In the following, reference is only made to the contested features, i.e. features 1f, 1g, 1h and 1i.
 - 1.3 Feature 1f

As already indicated in the Board's communication (see item 2.1), the terminology 'urea water being addible' does not limit the claimed subject-matter to any particular means for adding an aqueous urea solution. The term 'addible' in this context is to be interpreted as 'suitable to be added'. The interpretation of terms in this manner is also long standing case law of the Boards of Appeal. Additionally, it is neither clearly stated in the claim in which form (liquid or gaseous) the urea water shall be suitable to be added, nor to what (the exhaust gas or the communication passage or

the device as a whole) it is addible. There is therefore no need to adopt a narrow interpretation of Feature 1f to mean a specific adding location or a specific form. Consequently it merely defines the suitability to add an aqueous solution of urea (Feature 1f.a) at some point along the communication passage (Feature 1f.b).

The respondent's argument that 'addible' in Feature 1f means that urea water is actually added to the communication passage because this is what is described in the embodiment starting in paragraph [0022] is not persuasive. The Board interprets the claim in its broadest technically meaningful sense. The description of a specific embodiment cannot alter the understanding of such a general feature in the claim.

The respondent's further argument that Article 69(1) EPC should be applied and the description and drawings be used to interpret the claims is not accepted. Above all, Article 69(1) EPC is concerned with the scope of protection conferred by a claim and thus not with the delimitation of the invention from the prior art. If a term used in a claim has a clear technical meaning, the description should not be used to interpret such a term in a different and indeed more limited way. This is also well established case law of the Boards of Appeal (see Case Law Book of the Boards of Appeal, 9th edition 2019, II.A.6.3 as also referred to by the respondent in its reply, but particularly sections 6.3.1, 6.3.2 and 6.3.4 thereof).

The respondent's further argument that the skilled person is not necessarily an English native speaker does not alter the Board's conclusion. When interpreting the term 'addible' in Feature 1f, it is

determined what the claim of the contested patent defines as the invention, always in the sense as understood by a person skilled in the art. In interpreting the claim, the Board has also done so at the same time using the broadest technically meaningful sense as would be understood by a skilled person. Again, a skilled person has no reason to consult preferred embodiments to find a more limited meaning for the claim, when a broader interpretation is equally meaningful. The Board also sees no reason why the interpretation of the term 'addible' as explained above (which is in line with long standing practice of the Boards of Appeal) must be viewed differently by a skilled person who is not an English native speaker, since a skilled person must also read terms with the breadth that they imply. In general it is noted that interpretation of claims is to be done on an objective basis and cannot be made dependent on the language knowledge of an individual reader. The decisions T1688/08 and T426/88 referred to generally by the respondent do not contradict the Board's conclusion.

Further in its communication, the Board noted that urea is fed (added) in liquid form ('urea water') to the device 1 of D14, which forms part of the communication passage in the embodiment of Figure 7 (referred to as 'device 27' there). This was also submitted by appellant/opponent 2 (see its grounds of appeal, page 6, last paragraph).

The Board thus noted in its communication that it considered Feature 1f as being present in the embodiment of Figure 7 in D14.

1.4 Feature 1g

As also indicated in its communication (see item 2.2), the respondent had acknowledged that the particulate filter 26 and the SCR catalyst 28 in Figure 7 of D14 had somehow to be fixed in the common housing (see the paragraph bridging pages 24 and 25 in its reply to the appeals). The Board further indicated that it also regarded it as implicit that the components were 'integrally restrained' by some form of 'rigid restraining members', such that a skilled person would understand Feature 1g to be present in the embodiment of Figure 7 of D14.

1.5 Feature 1h

In view of Feature 1h, the Board indicated in its communication that it did not consider it as being directly and unambiguously derivable from D14 which and how many restraining members were provided in the embodiment of Figure 7. If the walls were interpreted to be acting as restraining members, the SCR catalyst and the particulate filter would then seemingly not necessarily be restrained at a plurality of axial points. If some other form of restraining members were to have been used, it could only have been speculated how many of these a skilled person would have provided. The Board thus considered that Feature 1h was neither explicitly nor implicitly disclosed in the Figure 7 embodiment of D14.

1.6 Feature 1i

In item 2.4 of its communication, the Board had further indicated that it followed the argument of appellant/opponent 2 that the housing with its several walls

could constitute a plurality of connecting members (as argued in its grounds of appeal, starting at page 9, item B.7). However, with the form of the restraining members being unknown the Board considered it not to have been derivable that the walls connected them. The Board thus considered that also Feature 1i was neither explicitly nor implicitly disclosed in the Figure 7 embodiment of D14.

1.7 With no reply having been received after its communication, the Board has no reason to deviate from its provisional opinion, which is herewith confirmed.

2. Remittal to discuss inventive step

The request of appellant 2 to remit the case to the opposition division for discussion of inventive step if the Board concluded that the subject-matter of claim 1 was novel, is refused.

Article 11 RPBA 2020 stipulates that the Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so.

The opposition division dealt with both grounds for opposition of novelty and inventive step in its decision. That the Board arrives at other distinguishing features than the opposition division does not constitute "special reasons" in the meaning of Article 11 RPBA 2020, at least not in the present case. The Board thus considers it appropriate that the question as to whether the subject-matter of claim 1 of the main request involves an inventive step is dealt with in the present appeal proceedings even when considering the different conclusion reached as regards

the features of claim 1 differentiating it over the Fig. 7 embodiment of D14.

3. Inventive step - Article 56 EPC
 - 3.1 The subject-matter of claim 1 of the main request does not involve an inventive step (Article 56 EPC).
 - 3.2 As discussed above under novelty (see Reasons 1.2), the subject-matter of claim 1 differs from the Figure 7 embodiment of D14 by Features 1h and 1i.
 - 3.3 As also indicated in the Board's communication (see item 3.1), these two features are both directed to the mounting structure. There is thus no need to formulate separate partial problems when applying the problem-solution approach. Starting from the embodiment of Figure 7 in D14, the objective technical problem that is solved by Features 1h and 1i is therefore the provision of a suitable mounting structure for the particulate filter and the SCR catalyst.
 - 3.4 In its communication, the Board also indicated that the skilled person would refer to D3 which shows how to provide such a mounting structure with an SCR catalyst and DPF arranged side-by-side (as is the case both in D14 and D3 - see D3, Figure 2). The Board also stated that it was considered obvious to transfer the mounting structure from D3 to the embodiment of Figure 7 in D14 to solve the stated problem, thereby arriving at the subject-matter of claim 1 without involving an inventive step.
 - 3.5 With no reply having been received after its communication, the Board has no reason to deviate from its provisional opinion, which is herewith confirmed.

Auxiliary requests

4. Remittal of the case to the opposition division

The respondent's request to remit the case to the opposition division for discussion of the auxiliary requests is refused.

In its communication, the Board stated (see item 5) that before remittal of the case based on any of the auxiliary requests could be considered, it would first have to be discussed whether any such request fulfils the requirements - at least - of Rule 80 EPC and Article 123(2) EPC. The Board stated that it considered the requirements of this Rule and Article as not being met and gave reasons for this opinion.

No counter-arguments were received. The Board has thus, again, no reason to deviate from its provisional opinion, which is confirmed herewith (see also the reasons below), noting moreover that the respondent had given no supporting arguments for any of its auxiliary requests nor indeed any substantiation of these requests at all. As the patent cannot be maintained in any of the requested forms on this basis alone, remittal would serve no purpose.

5. Auxiliary requests 1 and 2 - Rule 80 EPC

5.1 In auxiliary requests 1 and 2, claim 2 as granted was amended in that its characterising portion was deleted and a different feature (not related to the one deleted) added. The amendment of claim 2 compared to the main request thus amounts to the addition of an entirely different dependent claim.

- 5.2 In its reply on page 7, item 2.4.1, appellant 1 objected that the filing of claim 2 in the first and second auxiliary requests was not based on the opposition proceedings and that the filing of additional claims was inadmissible. In its communication, the Board indicated that it considered this objection as being based on Rule 80 EPC (see the communication of the Board, item 5) and that it agreed with the objection.
- 5.3 Rule 80 EPC stipulates that the claims of a granted patent may be amended, provided that these amendments are occasioned by a ground for opposition.
- 5.4 Adding new dependent claim 2 in auxiliary requests 1 and 2 is not directed to overcoming a ground for opposition with regard to claim 1 of the main request, as such an addition does not change the claimed subject-matter in its broadest scope, which is defined in independent claim 1. If the respondent intended to overcome an objection in view of dependent claim 2 as granted (which is anyway not apparent from the written submissions in the opposition proceedings), it would have been sufficient (i.e. as an appropriate and necessary amendment) to submit a request with claim 2 deleted.
- 5.5 As also already mentioned in the Board's communication (see item 5.1), this amendment in auxiliary requests 1 and 2 is thus not occasioned by a ground for opposition contrary to the requirement of Rule 80 EPC. This is also well established case law of the Boards of Appeal (see Case Law Book of the Boards of Appeal, 9th edition 2019, IV.C.5.1.5 a). These requests are therefore not allowable, at least for this reason.

6. Article 123(2) EPC

6.1 Claim 1 of each of auxiliary requests 2, 3, 4 and 5 defines subject-matter extending beyond the content of the application as filed. They thus do not fulfil the requirement of Article 123(2) EPC.

6.2 In view of auxiliary requests 2, 3, 4 and 5, the Board stated in its communication (see item 5.2) that it considered the requirement of Article 123(2) EPC as not being fulfilled. It explained that the introduced features had seemingly been taken from the detailed description of the embodiments. As an example, the Board referred to the restraining members being defined as an undefined number of brackets in claim 1 of these requests, whilst these were only disclosed in the application as filed as a pair of brackets. The Board indicated that it considered the subject-matter of the respective claims to constitute an inadmissible intermediate generalisation of the embodiment(s) described in the application as filed and thus to be subject-matter extending beyond the content of the application as filed, contrary to Article 123(2) EPC.

6.3 No counter-arguments were received. The Board has thus no reason to deviate from its provisional opinion and confirms same herewith.

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. Grundner

M. Harrison

Decision electronically authenticated