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**Datasheet for the decision  
of 12 September 2024**

**Case Number:** T 1311/21 - 3.4.02

**Application Number:** 15167970.1

**Publication Number:** 2950075

**IPC:** G07C5/08

**Language of the proceedings:** EN

**Title of invention:**

ON-ROAD RUNNING TEST APPARATUS

**Patent Proprietor:**

HORIBA, Ltd.

**Opponent:**

AVL LIST GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 54(1), 54(2), 111(1), 123(2)

EPC R. 76(2)(c)

RPBA 2020 Art. 11, 12(4), 12(6), 13(2)

**Keyword:**

Amendment to case - complexity of amendment (main request: yes; first auxiliary request: no) - suitability of amendment to address issues (main request: no; first auxiliary request: yes)  
Late-filed request - should have been submitted in first-instance proceedings (first auxiliary request: no)  
Novelty - public prior use - standard of proof - public prior use - obligation to maintain secrecy  
Remittal - special reasons for remittal (yes)

**Decisions cited:**

T 0960/15, T 1634/17, T 1138/20

**Catchword:**

1. Where the opposition division decides at the same time on several objections of added subject-matter, resulting in the filing of a single amended request overcoming all objections during the first-instance proceedings, Article 12(6) RPBA does not prevent the board from admitting a new request overcoming only some of the objections raised during first-instance proceedings (see reasons 2.1.2).

2. The two standards of proof appearing in the jurisprudence of the boards of appeal - "balance of probabilities" and "beyond reasonable doubt" - may well be used as a yardstick in straightforward cases. However, this binary approach to proof standards can turn out to be overly formalistic and simplistic. If the evidence whose public availability prior to the priority date of the patent is at issue is neither within the sphere of control of the opponent nor within a neutral sphere of control to which both parties have access, neither standard of proof is exclusively applicable; rather, what matters is the deciding body's conviction on the occurrence of an alleged fact, taking into account the particular circumstances of the case and the relevant evidence before it (see Reasons 3.2.1).



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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Case Number: T 1311/21 - 3.4.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.4.02**  
**of 12 September 2024**

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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
14 June 2021 concerning maintenance of the  
European Patent No. 2950075 in amended form.**

**Composition of the Board:**

**Chairman** R. Bekkering  
**Members:** A. Hornung  
C. Almberg

## **Summary of Facts and Submissions**

I. Both the opponent and the patentee appealed against the interlocutory decision of the opposition division maintaining European patent No. 2950075 in amended form.

Opposition had been filed against the patent as a whole and based on the grounds for opposition under Article 100(a) EPC, together with Articles 54(1) and 56 EPC, and Article 100(c) EPC.

The opposition division found that the patent as amended according to a third auxiliary request then on file and the invention to which it related met the requirements of the EPC.

II. Oral proceedings before the board were held on 12 September 2024.

III. The parties' final requests were as follows:

The patentee's main request was that the appealed decision be set aside and that the patent be maintained based on the claims of a main request, first filed with the statement of grounds of appeal.

In the alternative, the patentee requested that the patent be maintained based on the claims of one of

- auxiliary request IV, first filed with the statement of grounds of appeal, and in this decision referred to as the "first auxiliary request",

- auxiliary request X, found not allowable in the appealed decision (then labelled as "auxiliary request 2"), refiled with the statement of grounds of appeal, and in this decision referred to as the "second auxiliary request",

- the request found allowable in the appealed decision (then labelled as "auxiliary request 3"), and in this decision referred to as the "third auxiliary request",
- auxiliary requests XI, XII, XIII, and XIV, all first filed with the reply to the opponent's appeal, i.e. with letter of 4 March 2022, and
- auxiliary requests XIa, and XIIIa, both first filed with letter of 12 August 2024.

The opponent requested that the appealed decision be set aside and that the patent be revoked.

IV. The opponent's written submissions are designated O1 to O3 as follows:

- O1: statement of grounds of appeal,
- O2: letter dated 7 March 2022,
- O3: letter dated 2 August 2024.

The patentee's written submissions are designated P1 to P4 as follows:

- P1: statement of grounds of appeal,
- P2: letter dated 4 March 2022,
- P3: letter dated 8 July 2022,
- P4: letter dated 12 August 2024.

V. The following documents, all of which, with the exception of E6f, were relied on in the first-instance opposition proceedings, are referred to in the present decision:

- E6: Exploration Guide, AVL M.O.V.E System Control 2013, v2.5, March 2013, AT3732D, Rev. 02,
- E6b and E6bb: Purchase order, dated 28 November 2013,
- E6c and E6cc: Delivery Note, dated 6 December 2013,
- E6e: Slide of power point presentation showing the revision history of E6,
- E6f: Notarised protocol, dated 7 October 2021,

E7: Semtech-DS, User Manual, Revision 1.07, June 9, 2006;  
E7a: Clear Skies News, Sensors, Inc., July 2005,  
E7b: Statement from Sensors, Inc, August 2019,  
E7c: Screenshot (2021), Website of Sensors, Inc, 2006,  
E7d: Clear Skies News, Sensors, Inc., February 2007  
E7e: Clear Skies News, Sensors, Inc., June 2008,  
E7f: Clear Skies News, Sensors, Inc., February 2010,  
E7g: Clear Skies News, Sensors, Inc., May 2010,  
E7h: Clear Skies News, Sensors, Inc., August 2010,  
E7i: Screenshot (2021), Website of Sensors, Inc.,  
E7j: SAE paper, 2009-01-0940,  
E7k: Screenshot (2021), Website Chemical & Engineering  
News,  
E8: AVL General Terms and Conditions, AT5690E, October  
2018, refiled as "Annex 2" with letter P4.

VI. Independent claim 1 according to the patentee's main request reads as follows (the features of claim 1 of the present main request are preceded by a numbering based on a numbering as defined in O2, page 11):

**"1A** An on-road running exhaust gas test apparatus (100) for a vehicle (V) comprising:

**1B** an information processing unit (20) that is connected to a display (22); and

**1C** the information processing unit (20) comprising a running data acquisition part configured to sequentially acquire actual running data of the vehicle (V) under execution of a running exhaust gas test on a road by a driver; and

**1D** the information processing unit (20) further comprising a tendency data output part (24)

**1E** configured to sequentially produce and output tendency data indicating a tendency as to whether or not the running test is valid, based on the actual running data during the running exhaust gas test,

**1F** the tendency data output part (24) configured to comparably output the tendency data and a predetermined condition for validating the test on the display, wherein

**1F1** in the case where a running mode of the running exhaust gas test is defined by one or more predetermined running mode definition parameters and the running mode satisfies the predetermined condition, the running exhaust gas test is determined to be valid;

**1G** the tendency data output part (24) is configured to output as the tendency data at least one of:

**1G1** a speed distribution in the running exhaust gas test;

**1G2** a first two-dimensional amount of a rotational speed of an engine and an engine torque in the running exhaust gas test;

**1G3** a second two-dimensional amount of an emission amount of a component contained in the exhaust gas and a vehicle speed in the running exhaust gas test".

VII. First auxiliary request (i.e. the request first filed as auxiliary request IV with the patentee's statement of grounds of appeal)

Independent claim 1 of the first auxiliary request differs from claim 1 of the main request in that it comprises the

following additional feature **1F2** immediately after feature **1F1**:

**1F2** "the tendency data output part (24) is configured to sequentially obtain values of the one or more running mode definition parameters based on the actual running data and to sequentially output the values of the running mode definition parameters as the tendency data";

and in that feature **1G** of claim 1 of the main request is replaced by the following feature **1GG**:

**1GG** "as the running mode definition parameters is used at least one of"

VIII. Second auxiliary request (i.e. the request found not allowable in the appealed decision (then labelled as "auxiliary request 2"), and refiled as auxiliary request X with the patentee's statement of grounds of appeal)

Independent claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that it comprises the following additional feature **1AA** immediately after feature **1A**:

**1AA** "an exhaust gas analyzing device (10) mountable to the vehicle (V) and configured to analyze exhaust gas of the vehicle (V);"

and in that feature **1B** of claim 1 of the first auxiliary request is replaced by the following feature **1BB**:

**1BB** "an information processing unit (20) that is communicatively connected to the exhaust gas analyzing device (10) and is connected to a display (22); and".



- IX. Third auxiliary request (i.e. the request found allowable in the appealed decision (then labelled as "auxiliary request 3"))

Independent claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that feature **1G1** of claim 1 of the second auxiliary request is replaced by the following feature **1G11**:

**1G11** "a speed distribution in the running exhaust gas test indicating running time ratios or running distance ratios in a low speed area, a middle speed area, and a high speed area, and as a predetermined condition predetermined ranges for the running time ratios or the running distance ratios;"

## **Reasons for the Decision**

1. Main request - admittance

As requested by the opponent (see e.g. O2, point 2.1), the board exercises its discretion under Article 12(4) RPBA in not admitting the main request into the appeal proceedings.

- 1.1 According to Article 12(2) RPBA, a party's appeal case, in view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, has to be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based.

- 1.2 Claim 1 of the present main request, first filed with the statement of grounds of appeal, has been amended with

respect to claim 1 of the main request underlying the appealed decision, i.e. claim 1 as granted, by addition of only some of the features of claim 2 as originally filed. Moreover, claim 1 of the present main request differs from claim 1 of auxiliary requests 1 to 3 underlying the appealed decision in that a certain number of the features of claim 1 of auxiliary requests 1 to 3 are missing. In particular, claim 1 of each request underlying the appealed decision comprised *all* the features of claim 2 as originally filed. Therefore, claim 1 of the present main request is not identical to any claim 1 underlying the appealed decision, and any examination of this request would go beyond the primary object of these proceedings to review the appealed decision (cf. Article 12(2) RPBA). The present main request is thus to be regarded as an amendment which "may be admitted only at the discretion of the Board" (Article 12(4), first and second sentences, RPBA).

1.3 According to Article 12(4), fifth sentence, RPBA, the board "shall exercise its discretion in view of, inter alia, the complexity of the amendment, the suitability of the amendment to address the issues which led to the decision under appeal, and the need for procedural economy".

1.3.1 Complexity of the amendment

In case the present main request were admitted into the proceedings, the board would be confronted with new issues which were not decided upon during the first-instance proceedings. In particular, it would have to be discussed for the first time in appeal proceedings whether adding only the features of the first paragraph of claim 2 as originally filed (i.e. feature **1F1**) into claim 1 as granted

defines subject-matter which does not extend beyond the content of the application as filed (Article 123(2) EPC).

Moreover, if this question were answered in the affirmative, the further questions of whether claim 1 is clear (Article 84 EPC) and whether the subject-matter of present claim 1 is new and inventive over the prior art (Articles 54(1) and 56 EPC) would arise for the first time only in the appeal proceedings.

Concerning the issue of clarity, as argued by the opponent during oral proceedings, it would appear that present claim 1 is unclear because it comprises two distinct validity criteria of the running exhaust gas test: feature **1E** defines a validity criterion based on a tendency data, whereas feature **1F1** defines a validity criterion based on running mode definition parameters. Only the omitted features of the second paragraph of claim 2 as originally filed (i.e. feature **1F2**) clarify that the running mode definition parameters actually correspond to the tendency data. The patentee counter-argued that feature **1E** merely indicates a *tendency* to whether the test is valid, whereas feature **1F1** defines whether the test is valid. Nevertheless, the board, without taking a final decision on the matter, considers that there is an ambiguity in the validity test.

Therefore, as discussed during oral proceedings and contrary to the patentee's written submission (see P3, page 2, last paragraph), admitting the present main request into the proceedings would raise new issues and thereby unduly increase the complexity of the case.

- 1.3.2 Suitability of the amendment to address the issues which led to the decision under appeal

- (a) Adding only the features of the first paragraph of claim 2 as originally filed (i.e. feature **1F1**) into claim 1 as granted does not seem to be suitable to overcome the objection at stake under Article 123(2) EPC. Indeed, as argued by the opponent during oral proceedings before the board, feature **1F1** defines a running mode defined by running mode definition parameters. However, the running mode definition parameters are only defined by the omitted features of the second paragraph of claim 2 as originally filed (i.e. feature **1F2**). Therefore, feature **1F1** seems to be inextricably linked to feature **1F2**. The omission in present claim 1 of feature **1F2** appears to violate the requirement of Article 123(2) EPC.
- (b) The patentee argued that the objection of added subject-matter related to feature **1F** raised by the opposition division in point 2.3.2 of the appealed decision was overcome by adding only feature **1F1** to claim 1 as granted. Feature **1F2** could be omitted because the validity of the test is fully defined in feature **1F1** alone. Basis for separating the features of claim 2 as originally filed (i.e. features **1F1** and **1F2**) was to be found in paragraph [0011] of the description of the patent application as originally filed. Indeed, the second part of this paragraph [0011] (i.e. feature **1F2**) was introduced by the expression "In this configuration, in the case where", meaning that it was optional in the sense that it only made the validity criterion even more reliable than it was already defined in the first part of paragraph [0011] (i.e. feature **1F1**). Feature **1F2** only provided further details of feature **1F1** but was not inextricably linked to feature **1F1**.

(c) The board is not convinced by the patentee's arguments. As submitted by the opponent during oral proceedings before the board, the expression in paragraph [0011] "In this configuration, in the case where" does not introduce an optional feature. As explained in point (a) above, feature **1F2** seems to be required to define the running mode definition parameters mentioned in feature **1F1**.

1.3.3 For the reasons provided in points 1.3.1 and 1.3.2 above, the board is of the opinion that the amendments of claim 1 would unduly increase the complexity of the examination of the patent and are, *prima facie*, not suitable to address the objection of added subject-matter at stake. Therefore, it exercises its discretion under Article 12(4) RPBA in not admitting the main request into the appeal proceedings.

2. First auxiliary request

2.1 Admittance

The board exercises its discretion under Article 12(4) and (6) RPBA in admitting the first auxiliary request into the appeal proceedings for the following reasons:

2.1.1 Present claim 1 differs from claim 1 as granted (i.e. claim 1 of the main request underlying the appealed decision) by the addition of features **1F1** and **1F2** and the replacement of feature **1G** by feature **1GG**. These amendments are present in claim 1 of auxiliary requests 1 to 3 underlying the appealed decision. They were introduced by the patentee during the first-instance proceedings in order to overcome an objection of added subject-matter against claim 1 as granted with respect to feature **1F**.

Present claim 1 differs from claim 1 of auxiliary request 1 underlying the appealed decision in that it does not comprise feature **1AA** and in that feature **1B** is not replaced by feature **1BB**.

Since the discussion on whether the amendments **1F1**, **1F2** and **1GG** extend beyond the content of the application as filed (Article 123(2) EPC) has already taken place in the first-instance proceedings and since it has not been under dispute in the first-instance proceedings that the omitted features **1AA** and **1BB** were not relevant for the question of novelty and inventive step, the amendments of present claim 1 do not introduce new issues and do not increase the complexity of the examination of the patent. Moreover, for the reasons set out in point 2.2 below, the amendments of claim 1 are not only suitable to address, but actually overcome the objections of added subject-matter then at stake against feature **1F**.

It follows that in the board's view in the present case there is no reason not to admit the amendments of present claim 1 into the appeal proceedings under Article 12(4) RPBA.

2.1.2 Present claim 1 comprises all the amendments required by the opposition division to overcome its objection of added subject-matter against feature **1F** of the main request then on file, but omits all the amendments required by the opposition division to overcome its objection of added subject-matter against features **1A** and **1B** (see the appealed decision point 2.3.1 and 2.3.2, respectively). As argued by the patentee, "in the present case the Opposition Division decided on all objections under Art. 123(2) EPC at once. This would have made filing of requests that were already decided not to comply with Art. 123(2) EPC a violation of the rules of procedural

efficiency" (P1, page 17, first paragraph). It follows that the patentee *could* have filed present claim 1 during the first-instance proceedings, but not *should* have done so because such a filing would have been pointless in view of the fact that the opposition division had already decided that such a claim 1 infringed the requirements of Article 123(2) EPC.

In the absence of a compelling reason for the patentee to file present claim 1 during the first-instance proceedings, there is no reason for the board not to admit the amendments of present claim 1 into the proceedings under Article 12(6), second sentence, RPBA.

## 2.2 Amendments

Claim 1 contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

### 2.2.1 Feature **1A**

(a) During examination proceedings, the "on-road running test apparatus" of claim 1 as originally filed has been amended to an "on-road running *exhaust gas* test apparatus" (feature **1A**), implying that the test apparatus of present claim 1 is suitable to perform an exhaust gas test. As submitted by the opponent (O3, page 2, third paragraph), it is clear from the patent application as originally filed that in order for an "on-road running exhaust gas test apparatus" as defined in present claim 1 to be capable of performing a running exhaust gas test on a road, it must comprise an exhaust gas analysing device, as also explicitly stated in paragraph [0016] of the description as originally filed: "... this on-road running test

apparatus 100 is provided with a vehicle-mounted exhaust gas analyzing device 10 ...".

Since feature **1A** lacks an exhaust gas analysing device, the board is of the opinion that feature **1A** represents an unallowable intermediate generalisation and, therefore, contravenes the requirement of Article 123(2) EPC.

- (b) During oral proceedings before the board, the patentee argued that claim 5 as originally filed referred to an amount of CO<sub>2</sub> emission. From that, the skilled person would understand that claim 1 as originally filed necessarily comprised an exhaust gas analysing device for providing said amount of CO<sub>2</sub> emission. Hence, since claim 1 as originally filed comprised already implicitly an exhaust gas analysing device, the addition of the expression "exhaust gas" in feature **1A** of present claim 1 did not require the explicit addition of an exhaust gas analysing device.

Therefore, in the patentee's view, feature **1A** did not infringe the requirement of Article 123(2) EPC.

- (c) The patentee's argument is not convincing. The board fails to see how the mere use of an amount of CO<sub>2</sub> emission as a running mode definition parameter, as defined in claim 5 as originally filed, would imply the presence of an exhaust gas analysing device in present claim 1. Nor did the patentee elaborate on this general statement of implication.

#### 2.2.2 Feature **1B**

- (a) During examination proceedings, an "information processing unit (20) that is connected to a display



(22)" (feature **1B**) has been added to claim 1 as originally filed.

As submitted by the opponent (O3, page 2, last paragraph), the information processing unit is disclosed in paragraph [0016] and in figures 1 and 2 of the patent application as originally filed only in connection with an exhaust gas analysing device: "... this on-road running test apparatus 100 is provided with a vehicle-mounted exhaust gas analyzing device 10 and an information processing unit 20 that is communicatively connected to the exhaust gas analyzing device 10". The information processing unit and the exhaust gas analyzing device are therefore inextricably linked together in an on-road running exhaust gas test apparatus. Nowhere in the patent application is it disclosed that an information processing unit may be comprised in an on-road running exhaust gas test apparatus without being connected to an exhaust gas analyzing device.

Since this connection is omitted in feature **1B**, also feature **1B** represents an unallowable intermediate generalisation, contrary to the requirement of Article 123(2) EPC.

- (b) The patentee argued that the basis for the information processing unit of feature **1B** was not paragraph [0016] of the description as originally filed but claim 1 as originally filed. Indeed, "since original claim 1 only refers to functions that are according to the description carried out by the information processing unit [...], all that a test apparatus as claimed needs are functions to be carried out by an information processing unit. The originally claimed test apparatus can therefore very well be equated with an information

processing unit" (P1, page 2, fourth paragraph). In order to confirm that the originally claimed test apparatus could be equated to an information processing unit, the patentee, during oral proceedings before the board, further referred to originally filed claim 6 and paragraphs [0019] and [0020] of the description. Since the information processing unit was already implicitly included in original claim 1, the explicit addition of the information processing unit did not actually add any further technical feature to the claim.

Therefore, an information processing unit not being connected to an exhaust gas analyzing device (i.e. feature **1B**) was clearly and unambiguously derivable from claim 1 as originally filed.

- (c) The board is not convinced by the patentee's arguments. As stated in the appealed decision, point 2.3.1, page 15, penultimate paragraph, "[o]riginal claim 1 cannot be considered as the sole basis for the introduction of the term 'information processing unit' because the subject-matter of original claim 1 is not directed to a processing unit but to a test apparatus". The expression "test apparatus" infers that the apparatus has technical structural features for testing, whereas the expression "information processing unit" infers that the unit is a processing means not necessarily comprising such technical structural features for testing. As further explained in the appealed decision, point 2.3.1, page 15, last paragraph, "[t]here is no passage in the description which discloses an on-road running test apparatus only made of an information processing unit, i.e. without an exhaust gas analysing device". On the contrary, the description as originally filed, paragraph [0016],

explicitly discloses that the information processing unit is indeed connected to an exhaust gas analysing device.

Notwithstanding the above reasoning why feature **1B** is not compliant with Article 123(2) EPC, it is to be noted that present claim 1 defines not a general "on-road running test apparatus" but a more specific "on-road running exhaust gas test apparatus", which requires the presence of an exhaust gas analysing device (see point 2.2.1 above). Since there is no basis in the application as originally filed for an apparatus comprising both an exhaust gas analysing device and an information processing unit which are not connected, feature **1B** is an unallowable intermediate generalisation also for this reason.

2.2.3 For the reasons provided in points 2.2.1 and 2.2.2 above claim 1 contravenes the requirement of Article 123(2) EPC.

### 3. Second auxiliary request

3.1 Admittance of documents E7c to E7k and compliance with Rule 76(2)(c) EPC

Documents E7c to E7k filed after the nine-month opposition period were not erroneously admitted into the proceedings by the opposition division. The objection of lack of novelty, which was raised in the notice of opposition and based on the user manual E7, complied with the substantiation requirements of Rule 76(2)(c) EPC.

3.1.1 In the notice of opposition, the opponent raised *inter alia* an objection of lack of novelty against the subject-matter of granted claim 1 on the basis of a user manual, described in document E7. During the nine-month opposition

period for filing the notice of opposition, in addition to an argumentation why E7 would anticipate the subject-matter of granted claim 1, documents E7, E7a and E7b were filed by the opponent. As explained in the appealed decision, point 4.4.3, the opposition division considered that on the basis of these documents alone, the requirements of Rule 76(2)(c) EPC were fulfilled, namely substantiation by the provision of an indication of the facts and evidence in support of the objection of lack of novelty in view of E7. Whereas the opposition division by the time of the summons to oral proceedings had been of the negative preliminary opinion that "there are not enough evidence to show that E7 was made available to the public before the priority date of the patent in suit", the subsequently filed documents E7c to E7k were at oral proceedings "considered to be evidence complementing the opponent's statements and evidence E7a, E7b" and therefore admitted into the proceedings as not late filed.

- 3.1.2 The opposition division's decision to admit documents E7c to E7k, filed outside the opposition period, was a discretionary decision. It is settled jurisprudence of the Boards of Appeal (see Case Law of the Boards of Appeal, 10th edition 2022, "CLBA", Section V.A.3.4.1 b), and, for example, the decision in T 960/15, Reasons 1 to 9, in particular 3) that the board should only overrule such a discretionary decision if it concludes that the department that took it applied the wrong principles, took no account of the right principles, or exercised its discretion in an unreasonable way, thus exceeding the proper limits of its discretion. From the contested decision, point 4.4.3, the board cannot recognise any such erroneous exercise of discretion.

As an initial observation, the board fully understands the sequence of assessments made by the opposition division as

they arrived at the discretionary decision to admit documents E7c to E7k. First, the opposition division decided whether the arguments and evidence filed with the notice of opposition met the substantiation requirements of Rule 76(2)(c) EPC with respect to the objection of lack of novelty based on E7. Then they recalled their preliminary opinion on the evidential merits of E7, E7a and E7b filed with the notice of opposition. Lastly, after thus having informed the opponent that the alleged public availability of E7 was not sufficiently proven by the evidence filed with the notice of opposition, they assessed whether the subsequently filed documents E7c to E7k were to be admitted on the basis of whether those documents were suitable to supplement on the missing information on the alleged public availability of E7; as they answered the latter question in the affirmative, they effectively, simply, and reasonably applied the established principle of *prima facie* relevance. The board has no objection to this.

3.1.3 The patentee argued that document E7a referred to a user manual Semtech-D, while E7 referred to a different user manual Semtech-DS, that document E7b was not a valid piece of evidence, and that "there was therefore no sufficient information under which circumstances document E7 should have become public. The requirements of Rule 76(2)(c) EPC were therefore not fulfilled for the alleged public prior use of E7" (P1, page 7, fourth paragraph; see further arguments in P3, page 4, point 2.1). Documents E7c to E7k "provide a totally different line of argumentation regarding the circumstances of use" (P3, page 4, last paragraph).

3.1.4 The board cannot agree to the patentee's argumentation.

Whether the opposition division was correct in deciding that the arguments and evidence filed with the notice of opposition met the requirements of Rule 76(2)(c) EPC with respect to the objection of lack of novelty based on E7, effectively a matter pertaining to the admissibility of the opposition (cf. Rule 77 EPC), does not call into question whether the opposition division exercised its discretion to admit E7c to E7k erroneously. Therefore, even if the opposition division had erred in deciding that the requirements of Rule 76(2)(c) EPC were fulfilled, a matter that is also not subject of the board's review, such an error would not mean that it exercised its discretion to admit documents E7c to E7k erroneously.

3.1.5 Therefore, the board sees no reason to overturn the opposition division's decision to admit E7c to E7k.

3.1.6 Notwithstanding the fact that the opposition division properly exercised its discretion to admit E7c to E7k, the board agrees with the opposition division and the opponent that the arguments and the evidence filed with the notice of opposition did indeed comply with the requirement of Rule 76(2)(c) EPC to indicate the facts and evidence in support of the objection of lack of novelty in respect of E7. More precisely, as submitted by the opponent (O2, page 5, penultimate paragraph), paragraph 4.1.1 of the notice of opposition contained the necessary and sufficient indication that a SEMTECH-DS and the associated user manual had been made publicly available through the sale of the SEMTECH-DS Analyser since at least 2005. These indications, based only on document E7, were sufficient for the opponent's case to be properly understood in the sense that they allow evaluating whether the allegations of the opponent, if they are taken as proven constitute a proper attack on the patent. In contrast, the examination of whether the allegations are true is a question of

evidence that is part of the examination of the effective public availability of E7.

### 3.2 Public availability of the user manual E7

Document E7 forms part of the state of the art under Article 54(2) EPC.

#### 3.2.1 Standard of proof

In the present case, neither of the two standards of proof "balance of probabilities" and "beyond reasonable doubt" is to be applied exclusively and without further reflection.

##### (a) Opposition division

"[A]ccording to the principle of balance of probabilities, the opposition division considers that the manual guide E7 was made available to the public prior to the priority date of the Patent in suit" (appealed decision, page 27, second paragraph).

##### (b) Opponent

The opponent stated that "the standard of proof to be applied here is the weighing of probability, i.e. on the basis that one submission of facts is more likely to be correct than the other" (translated from German; O2, page 6, fourth paragraph).

##### (c) Patentee

The patentee is of the opinion that "balancing of probabilities is not the correct standard of proof" (P4, page 2, third but last paragraph) and that

"a strict standard of proof must be applied: the Opponent has to prove [sic] public availability of E7 up to the hilt" (P4, page 3, last paragraph) for the following reasons (P4, point 2):

- (i) E7 is a user manual written by the company Sensors, Inc. for the product SEMTECH-DS sold by Sensors, Inc.
- (ii) Document E7b is a "tailor-made" document from the CEO of Sensors, Inc. This showed that Sensors, Inc. actively supported the opponent.
- (iii) No source that distributes user manual E7 could be found, in particular it could not be retrieved from the internet by the patentee.
- (iv) Certain documents referred to by the patentee (see P4, points 2.4 and 2.5) prove that there was a business relationship at least from 2005 to 2007 between the opponent and Sensors, Inc., including the transfer of distribution rights of SEMTECH products from Sensors, Inc. to the opponent. This was not disputed by the opponent during oral proceedings.

Since there was "an imbalance regarding the possibilities to obtain evidence in favor or against the alleged public prior use" and "due to the business relations between the Opponent and Sensors, Inc. during the alleged prior use, evidence for the distribution of products by Sensors, Inc. must be considered to fall within the domain of the Opponent" (O4, page 3, last paragraph).

(d) Board



- (i) When both parties have access to the evidence relating to the alleged prior use, the well-known jurisprudence of the boards of appeal is that the boards examine the allegation of prior use by applying the standard of proof of "balance of probabilities", whereas in case that the evidence lies within the sphere of the opponent in the sense that the proprietor has barely any or no access to the evidence the stricter standard of proof "beyond reasonable doubt" (also called "up to the hilt") is applied (CLBA, Sections III.G.4.3.2 a and b).
  
- (ii) However, in certain cases, such as the present one, this binary approach to proof standards can turn out to be overly formalistic and simplistic. On the one hand, since E7 originates not from the opponent but from a third party, it cannot simply be said that the evidence "lies within the sphere of the opponent". Hence, the higher standard of proof "beyond reasonable doubt" is not to be applied without further thought. On the other hand, the arguments put forward by the patentee (see point 3.2.1 (c) above) show that there is an imbalance between the parties in the access to E7 and thus the possibility to establish whether E7 is part of the prior art, so that it can also not simply be said that both parties had access to this evidence. Hence, the lower standard of proof "balance of probabilities" is also not to be applied without further thought. Already based on these basic considerations, neither standard

appears to be suitable for application. The question then arises how to assess the evidence on the public availability of E7.

- (iii) Actually, while the board concurs with the patentee that the evidence on the question of whether E7 is part of the prior art is not in a neutral sphere of control, *inter alia* due to the undisputed business relationship between the opponent and Sensors, Inc., the board is of the opinion that the patentee did have opportunities to search for counter-evidence. In particular, as discussed during oral proceedings, the patentee could have directly contacted not only Sensors, Inc., but also the purchaser of SEMTECH-DS explicitly mentioned in document E7d, namely "The Texas Transportation Institute", whose contact details were even given in E7d, or searched for any other purchaser.
- (iv) Since the user manual E7 whose public availability prior to the priority date of the patent is at issue is neither within the sphere of control of the opponent nor within a neutral sphere of control to which both parties have access, the board is of the opinion that neither standard of proof is applicable.
- (v) In fact, the board in decision T 1138/20, Reasons 1.2.1, "considers that making a distinction between the above-mentioned standards [i.e. standard of proof 'beyond reasonable doubt', and standard of proof of 'balance of probabilities'] is neither

necessary nor mandated by case law" and recites specific decisions, such as that in T 1634/17, in support of its view. In the latter decision, Reasons 19, the competent board considers that "[t]here is no need to take a stand on the question which standard of proof to apply", but "[w]hat is decisive is that, in view of the evidence before the first instance department or the board in an individual case, the deciding body is persuaded that a particular [...] disclosure has taken place [...] or not".

- (vi) The present board agrees with the conclusions reached in the above-mentioned decisions. It therefore considers that, while the two standards of proof appearing in the jurisprudence of the boards of appeal may well be used as a yardstick in straightforward cases, what matters, in plain language and as concluded in T 1138/20, Reasons 1.2.1, is the deciding body's conviction on the occurrence of an alleged fact, taking into account the particular circumstances of the case and the relevant evidence before it.
  
- (vii) For the above reasons, the dispute between the parties about which exact standard of proof is to be applied to the present situation can be left undecided.

### 3.2.2 Assessment of evidence

The board is convinced that, in view of the evidence E7 and E7d, the user manual E7 was made publicly available

before the priority date of the patent, i.e. 19 May 2014, for the following reasons:

- (a) According to E7d, page 1, left column, Sensors, Inc. delivered the 100th SEMTECH unit to Natural Resources Canada in January 2007. The photo of the unit below this announcement shows a SEMTECH-DS unit. A SEMTECH-DS unit was acquired by The Texas Transportation Institute in June 2006 (E7d, page 4). As explained by the opposition division, "it is normal practice to provide the manual guide of a device together with the delivery of the device to the client having purchased the device" (appealed decision, page 26, penultimate paragraph). Moreover, the board concurs with the opposition division that "there is no reason to believe that buying a [SEMTECH DS] unit would not give you the right to understand how the unit works and to access to the manual guide" without being constrained with a confidentiality clause (appealed decision, page 26, last paragraph).
  
- (b) The patentee's arguments that it was not sufficiently proven that E7 had actually been made available to the public prior to the priority date of the patent are not found convincing by the board:
  - (i) The patentee argued during oral proceedings that, according to E7 itself, i.e. the revised user manual E7, Revision 1.07, a copy of which is in the case, was introduced only on 9 June 2006 and that, according to E7d, The Texas Transportation Institute "acquired" a SEMTECH-DS in "June 2006". Therefore, it was only *possible* that the manual E7 was actually delivered to The Texas Transportation Institute, but it was not proven beyond

reasonable doubt. See also patentee's written arguments (P1, point 2.2).

The board is not convinced by this argument. Firstly, "acquired", when used in E7d on The Texas Transportation Institute's purchase of SEMTECH-DS, must be understood as "delivered", not "ordered". Otherwise, it would not make sense that the Institute had completed four successful research projects involving the SEMTECH-DS since "acquiring" that unit (E7d, page 4, first paragraph). Furthermore, since the board has no reason to doubt the correctness of the "Revision History" of E7 (E7, second page), and since there were more days left in that month after 9 June 2006 than days preceding that date, it is more likely than not that the manual E7 did accompany the delivery of SEMTECH-DS to The Texas Transportation Institute in June 2006. In any case, it is highly unlikely that Sensors, Inc. would have provided the opponent with a version of the user manual which was never delivered to a purchaser having bought a SEMTECH-DS. Therefore, if the user manual E7 was, for any reason, still not provided to The Texas Transportation Institute, it was nonetheless highly likely that it was delivered to another purchaser of SEMTECH-DS.

- (ii) The patentee contended that it was not able to retrieve E7 in any internet archive. This casts doubt on the existence of E7.

The board is of the opinion that the mere fact that the patentee was unable to retrieve the

document from the internet is not a sufficient reason to seriously question the existence of E7. On the basis of everyday life experience, it is very unlikely that such an elaborate user manual as E7 would be compiled, printed, and regularly revised without being used.

### 3.3 Novelty

The subject-matter of claim 1 is not novel in view of document E7 (Article 54(1) EPC).

3.3.1 Features **1E**, **1F**, **1F1**, **1F2** and **1G1** are the only features of claim 1 whose disclosure in E7 the patentee disputes (P1, point 3.1, pages 9 and 10; P3, point I.2, pages 4 to 7; P4, point 3). However, the board considers that features **1E**, **1F**, **1F1**, **1F2** and **1G1** also lack novelty over E7. The reasons are as follows:

#### (a) Feature **1E**

As explained by the opponent, in figure 8.73 of E7, a dot represents the instantaneously measured and actual speed of the vehicle. This speed corresponds to the tendency data defined in feature **1E** in the sense that the actual speed indicates a tendency as to whether or not the gas test is valid, based on the actual running data during the test. Indeed, if the actual speed at a certain point in time is far from the target speed, the actual speed could be seen as an indication that the final running exhaust gas test could be invalid.

It is to be noted that claim 1 leaves completely undefined the exact technical meaning of the expressions "tendency" and "test is valid". At one point in time, a large discrepancy between the actual

speed and the target speed provides tendency data indicating that the test may be invalid, and at a later point in time, a small discrepancy between the actual speed and the target speed provides a tendency data indicating that the test may be valid. By interpreting the terms "tendency" and "test is valid" in a broad manner, the above described situation is covered by the functional feature **1E**. Therefore, feature **1E** is disclosed in E7.

(b) Feature **1F**

As stated in the appealed decision, point 4.5.1, "Fig. 8.73 which shows a curve indicating the target speed over time together with a dot indicating the actual vehicle speed at a given time [...] corresponds to a predetermined condition". By displaying in figure 8.73 both the target speed and the actual speed, the tendency data (i.e. the actual speed) and the predetermined condition (i.e. the target speed) are comparably output and are suitable for validating the test on the display, as defined in feature **1F**. Therefore, feature **1F** is disclosed in E7.

(c) Features **1F1**, **1F2**, **1G1**

As argued by the opponent during the first-instance proceedings, "according to a broad interpretation of the term 'speed distribution', the evolution of the vehicle speed over time shown in Fig. 8.73 can be regarded as a speed distribution" (appealed decision, point 4.5.1).

Nothing in the functional definition of the test apparatus of claim 1 contradicts the interpretation that the "running mode definition parameters", i.e.

the "speed distribution" defined in feature **1G1**, corresponds to a series of consecutive measured speed data points, shown one after the other in figure 8.73 of E7. Indeed, a "speed distribution" has the broad meaning of "speed spreading" or "speed variation". In particular, a "speed distribution" as such does not require, for example, a specific representation on a display of a plurality of speed data points in a histogram, nor a two-dimensional distribution function showing the number of speed data points as a function of speed values. The wording of claim 1 does not define a technical feature of the test apparatus which excludes that only a single speed data point of the speed distribution is displayed at a time.

By displaying in figure 8.73 of E7 both the target speed (i.e. the predetermined condition) and the actual speed (i.e. the running mode definition parameters corresponding to the tendency data), the running exhaust gas test may be determined to be valid in case that the actual speed satisfies a predetermined condition of closeness to the target speed.

Therefore, features **1F1**, **1F2**, **1G1** are disclosed in E7.

3.3.2 The patentee's arguments in favour of novelty are not found convincing.

(a) The patentee argued that E7 only discloses "whether the vehicle speed is at the moment sufficiently close to a target speed. Whether or not this will be also sufficient to ensure that a test is valid is unknown from E7. (...) Accordingly, the background color of E7 cannot be understood as tendency data as claimed" (P1,



point II.3.1, pages 9 and 10). See also P3, point I. 2.4, page 6.

The board cannot agree with the patentee's view essentially because claim 1 does not comprise any definition of what is meant by validating a test. In particular, claim 1 does not exclude that the test is validated at each point in time when an actual speed is measured. Claim 1 does not define that a test is validated only on the basis of a certain number of speed data points. Moreover, it is to be noted that feature **1E** merely defines indicating a *tendency* as to whether the test is valid and that feature **1F** merely defines outputting data *suitable for* validating the test.

It is further to be noted that it is not relevant that "the background color of E7 cannot be understood as tendency data as claimed", as submitted by the patentee, but only as a visual support for indicating whether an actual speed is too far away from the target speed. In fact, the tendency data defined in claim 1 corresponds to the actual speed data points.

- (b) In view of features **1F2**, **1G** and **1G1**, the patentee contended that "the tendency data [of claim 1] are constituted by values (plural) of a speed distribution" (P4, point 3.1; emphasis in original). In the patentee's view, this excluded that only a single speed data point of the speed distribution is displayed at a time.

The board cannot follow the patentee's argument. In E7, the tendency data is also constituted by a plurality of values of actual speed that form a speed distribution over time. The claim does not define that

the plurality of values of actual speed must be displayed simultaneously.

- (c) In view of feature **1F2**, the patentee put forward that "the values of the running mode definition parameters, i.e. the values of the speed distribution, are obtained based on the actual running data. [...] [T]his would mean that the actual speed (as value of the speed distribution) is obtained based on the actual speed. Apparently, such a definition would seem pointless to a skilled person" (P4, point 3.2). Similarly, the patentee argued that due to the wording "based on", the feature **1E** also required a change between tendency data and the actual running data.

The board is not convinced by the patentee's argument. The wording used in feature **1F2** "obtain values of [...] parameters based on the actual running data" comprises the possibility that the values of the parameters are equal to the actual running data. As stated by the opponent during oral proceedings and contrary to the patentee's view, the wording "based on" of feature **1E** is so broad that it does not imply any change or transformation between the tendency data and the actual running data.

#### 4. Third auxiliary request

##### 4.1 Amendments

Claim 1 does not introduce subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

- 4.1.1 During oral proceedings before the board and in writing (O1, point 1.1; O3, pages 4 and 5), the opponent objected to feature **1G11** under Article 123(2) EPC.

In the opponent's view (O3, page 4, last paragraph, and page 5, first paragraph), paragraphs [0025] to [0027] of the description as originally filed described an embodiment "where each of the running mode definition parameters are within a predetermined range" (see paragraph [0026]). Paragraph [0027] defined a predetermined range for each running mode definition parameter that must be met for the test to be valid, i.e. a plurality of parameters and a plurality of predetermined conditions are defined in the embodiment of paragraphs [0025] to [0027]. However, contrary to paragraph [0027], claim 1 did not define that in case of a plurality of running mode definition parameters (i.e. features **1G1**, **1G2** and **1G3**), all parameters must fulfil a corresponding predetermined condition (O3, page 5, third paragraph). Actually, claim 1 only defined a predetermined condition for the parameter defined in feature **1G1**. This represented an unallowable intermediate generalization (O3, page 5, fourth paragraph) and, therefore, added subject-matter.

- 4.1.2 The patentee submitted that the opponent's argumentation concerning an objection under Article 123(2) EPC, filed with its letter O3 of 2 August 2024, was filed for the first time in the opposition proceedings and therefore should not be admitted for being late-filed.

The question of whether or not to admit the opponent's argumentation, filed with letter O3 of 2 August 2024 and reiterated during oral proceedings before the board, can be left undecided as the opponent's objection is not found convincing by the board anyway.

As argued by the patentee, the feature **1G11** has been added to claim 1 of the third auxiliary request in order to clarify the meaning of the speed distribution mentioned in feature **1G1**. The board sees no reason why this clarification of the meaning of the speed distribution should not be generally valid, irrespective of any particular embodiment described in the patent application as originally filed. Extracting this definition of the speed distribution is therefore not equivalent to the extraction of a feature inextricably linked to other features of a particular embodiment. As further pointed out by the patentee, a basis for a plurality of running mode definition parameters in combination with a single predetermined condition is formally to be found in the combination of originally filed claim 2 and originally filed claims 3 to 5. Hence, no unallowable intermediate generalisation occurred.

Concerning the basis for the feature **1G11** as such, the board agrees with the patentee that "page 7, lines 1 to 5 give[s] alone sufficient support for the amendment [concerning the speed distribution indicating running time ratios], since here reference is made to the running time ratio as well as to predetermined ranges for the respective speed areas" (P2, page 5, fourth paragraph). Moreover, "[t]hat these ratios are compared to predetermined ranges to validate the test is also already indicated on page 7, lines 1 to 5" (P2, page 4, third paragraph). As further submitted by the patentee, "applying the replacement of paragraph 49 to the disclosure of paragraph 27 will lead to the claimed speed distribution that is based on running distance ratios" (P2, page 6, fourth paragraph).

For the reasons given above, the board comes to the conclusion that claim 1 complies with the requirement of Article 123(2) EPC.

#### 4.2 Public availability of the document E6

Document E6 forms part of the state of the art under Article 54(2) EPC.

##### 4.2.1 Standard of proof

It is undisputed between the parties that the standard of proof to be applied for assessing the public availability of E6 prior to the priority date of the patent is "beyond reasonable doubt".

##### 4.2.2 Admittance of document E6f

Document E6f is admitted into the proceedings (Article 12 RPBA).

(a) During the oral proceedings before the opposition division, held on 11 March 2021, the opponent filed document E6e, i.e. a revision history of E6, in order to show that the revision number 2 ("Rev. 02", written on the cover page of E6), was the revision number valid on 6 December 2013 (see E6c), i.e. on the date on which the handbook E6 had been delivered to the customer (see appealed decision, point 5.4.1). This issue of the revision number of E6 was raised for the first time by the patentee in its letter of 8 March 2021, point 7, i.e. three days before the date the oral proceedings were held.

The patentee requested that E6e not be admitted in the procedure "as it was late-filed and as it could and

should have been filed earlier since the opponent must prove beyond any doubt that E6 was made available to the public" (appealed decision, point 5.4.2).

"The opposition division considered that E6e was admissible because it was [...] prima facie relevant for proving whether the revision number 2 of the software handbook had been [...] delivered to [the customer] Daimler or not" (appealed decision, point 5.4.3).

- (b) As a starting point, the board considers that the issue of which revision number of E6 had been the valid one on the date of delivery of the AVL test apparatus was raised by the patentee for the first time on 8 March 2021, i.e. only three days before the oral proceedings. This short period of time had hindered the opponent to file all the necessary evidence during the first-instance proceedings.

Moreover, the evidence which the opponent managed to file within this short period of time of three days (i.e. document E6e) was actually admitted into the proceedings by the opposition division. E6f, in turn, merely supplements E6e, essentially by addressing the opposition division's concerns about E6e as they were laid out in the appealed decision in an effort to overcome them (page 34, last paragraph). Of course, learning about these concerns at the oral proceedings (see minutes, point 153) did not allow any production of evidence like E6f; its submission with the statement of grounds of appeal was the realistic occasion.

The board is thus not of the view that E6f should have been submitted during the opposition proceedings (cf. Article 12(6), second paragraph, RPBA).

Moreover, the submission of E6f suitably addresses the opposition division's concerns about E6e. As it is supplementary in nature, still only depending on the facts of E6e that were already in the proceedings, E6f brings no further complexity to the case, and its consideration is not detrimental to procedural economy (see Article 12(4), fifth sentence, RPBA).

(c) Re patentee's arguments for not admitting E6f into the proceedings:

- (i) The patentee argued that "it is the duty of the Opponent to present sufficient evidence right from start" (P2, page 7, penultimate paragraph). The opponent could, and should, have provided with the notice of opposition all the evidence necessary to prove that the specific manual E6, AT3732D, Rev. 02, was actually delivered to a customer. The fact that the evidence filed with the notice of opposition was insufficient (according to the opposition division's decision) could not be used as an excuse for filing supplementary evidence only during appeal proceedings.

The board is not convinced by the patentee's argument. The allegation of public prior use of document E6, as filed with the notice of opposition, was considered sufficiently substantiated under Rule 76(2)(c) EPC by the opposition division. The fact that the opposition division found, at a later stage of

their examination, that the evidence filed with the notice of opposition was not sufficient to prove beyond reasonable doubt the alleged prior use of E6 does not mean that further evidence may not be admitted. On the contrary, the opposition division admitted E6e, even though it was filed only during the oral proceedings. Also therefore, the board sees no compelling reason why the opponent should have filed E6f during the opposition period.

- (ii) The patentee submitted that the fact that the issue related to the revision number of E6 was brought up by the patentee only three days before the oral proceedings "was caused by delay on the side of the Opponent" (P2, page 9, third paragraph).

The board does not agree with the patentee's argument because the issue relating to the revision number of E6, which is based on documents E6 and E6c filed with the notice of opposition, could already have been raised by the patentee in response to the notice of opposition.

In addition, in its examination of the course of the various procedural steps taken by the parties, the board did not find any undue delay on the part of the opponent. In particular, contrary to what the patentee seemed to imply (see P2, point 3.2.c), the opponent was not obliged to reply to the patentee's objection concerning the ambivalent



designations AT3708D and AT3732D of E6 within a certain time limit.

#### 4.2.3 Admittance of Annex 2

Annex 2 filed with patentee's letter of 12 August 2024 is not to be taken into account (Article 13(2) RPBA).

- (a) Annex 2 filed with patentee's letter P4 consists of the "General Terms and Conditions" of AVL List GmbH, Graz - Austria, AT5690E, October 2018. It was first filed during first-instance proceedings, namely with the patentee's letter of 8 March 2021, three days before the first-instance oral proceedings. It was intended to show that the handbook E6 was delivered by the opponent AVL List GmbH to the customer Daimler AG under a non-disclosure agreement.

According to point 147 in the minutes of the oral proceedings before the opposition division, "[t]he document concerning the Terms & Conditions of AVL List GmbH of October 2013 is not admitted into the proceedings, as it is prima facie of no relevance". The board notes that the referral to "October 2013" is an obvious error in the minutes of the opposition division, as the footnote of the document in question states "October 2018". It is further to be noted that the decision of the opposition division does not mention at all the "AVL General Terms and Conditions" in the Reasons for the Decision, but only in the Summary of Facts and Submissions, without dealing with the issue of its admission into the proceedings (appealed decision, Summary of Facts and Submissions, point 8), contrary to the statement in the minutes of the opposition division. As a consequence, it is not

possible for the board to fully assess the admittance of Annex 2 under Article 12(6), first sentence, RPBA.

- (b) According to Article 13(2) RPBA, "[a]ny amendment to a party's appeal case made after [...] notification of a communication under Article 15, paragraph 1, shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned". The board is unable to see any such exceptional circumstances justifying filing Annex 2 only in response of the board's communication annexed to the summons to oral proceedings. In fact, it could and should have been filed by the patentee at least as early as possible in the appeal proceedings, namely with its statement of grounds of appeal.

The patentee did not provide any arguments, either in writing or orally at the oral proceedings, explaining why the document in Annex 2 was only filed after the board's communication pursuant to Article 15(1) RPBA. Since the board does also not see any exceptional circumstances justifying the late filing of the document in Annex 2, it is not to be taken into account under Article 13(2) RPBA.

- (c) Irrespective of admittance of Annex 2, the board agrees with the opponent's statement made during the oral proceedings before the board that the document in Annex 2, in view of the footnote "AT5690E, October 2018", does not constitute convincing evidence that a non-disclosure agreement existed between AVL List GmbH and Daimler AG at the time of the delivery of the handbook E6 on 6 December 2013.

#### 4.2.4 Assessment of evidence

(a) The board is convinced beyond reasonable doubt that E6 forms part of the prior art under Article 54(2) EPC for the following reasons:

(i) E6 is a handbook for a software with the title "AVL M.O.V.E System Control 2013". In the headnote of E6 are mentioned the date "März 2013", the reference "AT3732D" and the revision number "Rev. 02". In the delivery note E6c, page 2, the handbook E6 is identified as item "01.30.12" and described as "M.O.V.E SYSTEM CONTROL SOFTWARE, UG DOCU, AT3732D". According to E6cc, the handbook E6 was delivered to Daimler AG on 6 December 2013. While the actual version of the handbook E6 is not mentioned in the delivery note E6c, this missing information is to be found in E6e, the veracity and context of which is certified in E6f. In fact, as explained by the opponent during oral proceedings, according to E6e in conjunction with E6f, page A14, the version 02 of E6 was valid (in German in E6f: "gültig ab") from 8 March 2013 to 09 December 2013, i.e. on the date of the delivery of E6 to Daimler AG. It follows that there is no doubt that a handbook E6, version Rev. 2, was delivered to Daimler AG before the priority date of the patent.

(ii) Moreover, the AVL M.O.V.E. system described in E6 is not a product that was produced for just one customer, but for many. E6 is a user manual intended to be delivered to all purchasers of an AVL M.O.V.E system and, as a user manual, only describes how to use a

product already purchased by the customer. There is no presumption recognised in the jurisprudence for the existence of a non-disclosure agreement when it comes to the delivery of goods to one of many other end customers. On the contrary, the sale of a product to one of many other end customers, who generally wishes to dispose of the product freely (e.g., as the opponent stated during oral proceedings, the product will be used by an uncontrolled and unlimited number of employees of the customer), is considered to be a typical case of an unrestricted disclosure to the public.

- (iii) Therefore, documents E6, E6c, E6cc, E6e and E6f form a complete chain of evidence on the basis of which the board is convinced beyond reasonable doubt that document E6 was delivered without any non-disclosure agreement to Daimler AG by AVL List GmbH on 6 December 2013.

(b) Patentee's counter-arguments

- (i) During oral proceedings, the patentee submitted that E6e was just a list of revision dates of E6 generated on 7 October 2021. From this document alone it could not be inferred what was the actual situation at the time of the delivery of the handbook E6 to Daimler AG.

The board is unable to follow the patentee's objection. The list in E6e was generated by the opponent's general software tool for managing the company's operational processes.

There is no reason that the revision history in E6e does not accurately reflect the situation that existed in the past, especially on the date of delivery. In particular in view of the certification in E6f, page 14.

- (ii) E6e did not provide any concrete information about the actual delivery itself of E6 to Daimler AG on 6 December 2013. There was only the opponent's allegation that the date in the "gültig ab" column was the date from which the version of E6 indicated in the "RevStd" column was to be delivered to customers. The delivery note E6c did not state the actual revision number of the handbook E6 actually supplied, but only the product number AT3732D which was the same for all revision numbers. Therefore, it could well be that a handbook with another revision number than revision number 2 was delivered to Daimler AG on 6 December 2013.

As explained by the opponent during oral proceedings, E6e in conjunction with E6f, page A14, unequivocally shows a unique assignment of the revision number and the validity date of the handbook E6. Contrary to the patentee's speculation that a version other than the one indicated in the revision history could have been delivered to Daimler AG on 6 December 2013, the board sees no reason to believe that a handbook was delivered by AVL that would have been invalid under AVL's procedural rules.

- (iii) During oral proceedings, the patentee reiterated the arguments it had already

submitted in writing (P2, point 3.6; P4, point 5.1), according to which document E6 had only been distributed as part of a confidentiality agreement, since delivery note E6c referred to AVL's General Terms and Conditions. The patentee referred to paragraphs 10.2 and 2.3 of the AVL General Terms and Conditions from which it had to be concluded that E6 must not be disclosed to third parties. "[I]n order to proof [sic] that document E6 is prior art that does not fall under a non-disclosure obligation that prevents public availability after sale, the Opponent should have provided the General Terms and Conditions to which it is referred in document E6c. [...] Not having provided the general terms and conditions mentioned in E6c must be considered a missing link in the attempt to proof [sic] public availability of E6 up to the hilt" (P4, page 9, first and second paragraphs).

The board is not convinced by the patentee's arguments:

- While the production and distribution of the handbook E6 is not aimed at the entire population, it is, however, in fact aimed at a wide range of industrial and technical companies and organisations. Under this circumstance, there is no rationale for marketing a product under confidentiality obligations. Doing so would be impractical and even almost impossible to enforce.
  
- Moreover, in relation to the reference in E6c to AVL's General Terms and Conditions applying to the delivery of products

described in E6c (over nine pages), including product E6, the board agrees with the opponent's submission during oral proceedings that this kind of general indication is typically included in purchase documents between companies, but generally without having a concrete, legally enforceable effect. An automatically enforceable confidentiality clause for a handbook would be unrealistic from an industrial point of view. In case that a legally binding non-disclosure agreement is to be entered into between two companies, it is typically done so deliberately by way of a dedicated written document, the terms of which have been negotiated between the two companies in advance and then signed by both parties. In this context, the opponent referred to E6b (and E6bb) and the clause indicated therein according to which Daimler AG's own general purchasing conditions are applicable to the products purchased by Daimler AG (E6bb, first page, first sentence), including the purchased handbook E6. As noted by the opponent, the two conditions neutralise each other in the likely event of contradictions between them.

4.2.5 For the reasons given in points 4.2.1 to 4.2.4 above, the board comes to the conclusion that document E6 forms part of the prior art under Article 54(2) EPC.

5. Remittal of the case

The board decides to make use of its discretion under Article 111(1) EPC and Article 11 RPBA in remitting the case to the opposition division for further prosecution.

5.1 The opposition division, following the decision that document E6 was not publicly available prior to the priority date of the patent (appealed decision, point 5.4), stated that "[t]he opponent has not put forward any objections under Art. 54 and 56 EPC regarding auxiliary request 3" (appealed decision, point 5.5). Therefore, it decided to maintain the patent in amended form on the basis of claim 1 of the auxiliary request 3 then on file (identical to claim 1 of present auxiliary request 3).

5.2 For the reasons provided in point 4.2.4 above, the board comes to the conclusion that document E6 forms part of A54(2) EPC. Consequently, the decision of the opposition division must be set aside and the relevance of document E6 to the question of whether the patent can be maintained must be assessed. This represents a fresh case which the board considers not compatible with the primary object of the appeal proceedings to review the decision under appeal in a judicial manner (Article 12(2) RPBA).

5.3 The patentee submitted that it wanted the case not to be remitted to the opposition primarily to avoid further delays and costs associated with a final decision. The board considers that these reasons do not outweigh the fact that the board would have to decide for the first time whether document E6 anticipates or renders obvious the subject-matter of claim 1.

The opponent agreed to the remittal to the opposition division.



## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of the first instance for further prosecution.

The Registrar:

The Chairman:



L. Gabor

R. Bekkering

Decision electronically authenticated