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**Datasheet for the decision  
of 2 September 2025**

**Case Number:** T 0114/23 - 3.3.05

**Application Number:** 12810414.8

**Publication Number:** 2790814

**IPC:** B01D53/94, B01J23/44,  
B01J35/00, B01J37/02, F01N3/10

**Language of the proceedings:** EN

**Title of invention:**  
AUTOMOTIVE CATALYTIC AFTERTREATMENT SYSTEM

**Patent Proprietor:**  
Johnson Matthey Public Limited Company

**Opponent:**  
Umicore AG & Co. KG

**Headword:**  
Catalytic aftertreatment system/JOHNSON MATTHEY

**Relevant legal provisions:**  
EPC Art. 123(2)  
RPBA 2020 Art. 12(4), 12(6)

**Keyword:**  
Amendment to case - amended main request admitted (no) -  
should have been submitted in first-instance proceedings (yes)

**Decisions cited:**

T 0878/21

**Catchword:**



**Beschwerdekammern**

**Boards of Appeal**

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Case Number: T 0114/23 - 3.3.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.05**  
**of 2 September 2025**

**Appellant:** Johnson Matthey Public Limited Company  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 4 January 2023  
revoking European patent No. 2790814 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairwoman** S. Besselmann  
**Members:** T. Burkhardt  
O. Loizou

## Summary of Facts and Submissions

- I. The patent proprietor's (appellant's) appeal lies from the opposition division's decision to revoke European patent No. 2 790 814 B1.
- II. The opposition division came to the conclusion that the claim requests either did not meet the requirements of Article 123(2) EPC (the then pending main request and auxiliary requests 1 to 22) or shared this deficiency on a *prima facie* basis and was not considered for this reason (the then pending auxiliary request 23).
- III. At the appeal stage, the board issued a preliminary opinion under Article 15(1) RPBA indicating *inter alia* that auxiliary request 4, at that time, would likely be disregarded and that the appeal would likely be dismissed.
- IV. With its submission dated 8 July 2025, the appellant made auxiliary request 4 its new main request, and withdrew the remaining claim requests.
- V. Broken down into features, independent claim 1 of the (sole) main request reads as follows:
  - (1) A catalytic aftertreatment system for a diesel engine exhaust gas, said system comprising:
    - (1.1) a diesel oxidation catalyst (DOC)
      - (1.1.1) having a diameter of from 4 to 15 inches (101.6 to 381.0 mm)

- (1.1.2) and a length of from 2.5 to 10 inches (63.5 to 254.0 mm); and
- (1.2) an aftertreatment device located downstream of the diesel oxidation catalyst (DOC), which aftertreatment device requires periodic heat treatment, and
- (1.3) means to generate a temperature increase within the aftertreatment device, wherein the aftertreatment device is
  - (1.3.1) a soot filter or
  - (1.3.2) a catalyst unit for selective catalytic reduction (SCR);
- (1.4) said diesel oxidation catalyst (DOC) comprising a catalyst composition supported on a substrate unit, and
  - (1.4.1) having an upstream zone and a remainder, wherein
    - (1.4.2) the catalyst composition comprises a mixture of platinum (Pt) and palladium (Pd), or an alloy of Pt and Pd, and
      - (1.4.2.1) has a concentration of platinum (Pt) in the upstream zone that is greater than the concentration of platinum (Pt) in the remainder of the diesel oxidation catalyst (DOC); wherein
        - (1.4.2.2) the length of the upstream zone is from 0.5 to 1.5 inches (12.7 to 38.1 mm) and
        - (1.4.2.3) is of higher oxidation activity for hydrocarbons (HC) than the remainder of the diesel oxidation catalyst (DOC); wherein
      - (1.4.3) the diesel oxidation catalyst has a weight ratio of Pt to Pd in both the upstream zone and in the remainder of the diesel oxidation catalyst (DOC) of 1:3 to 5:1; and

(1.4.4) wherein the substrate unit is a flow-through monolith.

VI. The arguments put forward by the appellant during the appeal proceedings, where relevant to the present decision, can be summarised as follows.

The main request was a response to the decision under appeal and met the requirements of Article 123(2) EPC on a *prima facie* basis. The main request was hence to be considered in the appeal proceedings.

VII. The opponent's (respondent's) arguments at the appeal stage are reflected in the reasons below.

VIII. The appellant requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request (submitted as auxiliary request 4 with the grounds of appeal).

The respondent requested that the appeal be dismissed.

## **Reasons for the Decision**

1. Main request: admission

The current main request was first submitted with the grounds of appeal as auxiliary request 4. It has not been disputed that this request is an amendment to the appeal case within the meaning of Article 12(4) RPBA.

For the reasons set out below, the board finds that the filing of this request is not a response to new

surprising elements found by the appellant only in the decision. This request could and should have already been filed at the opposition stage. Moreover, it does not overcome the objection under Article 123(2) EPC on a *prima facie* basis.

The board hence exercises its discretion and does not admit the new request (Article 12(4) and (6) RPBA).

1.1 In its decision, the opposition division concluded *inter alia* that there was no pointer in the application as filed to combine the ranges of:

- the diameter of the diesel oxidation catalyst (DOC) (feature 1.1.1),
- the DOC length (feature 1.1.2),
- the length of the DOC upstream zone (feature 1.4.2.2), and
- the Pt to Pd weight ratio (feature 1.4.3)

in the various claim requests on file at that time (see for example points II.13.3, II.14, II.15.3 (and II.15.5), II.16.3 (and II.16.5), II.17.4 (and II.17.5), II.18 and II.20.1 of the decision).

1.2 In the appellant's opinion, the submission of the current main request was a response to the decision under appeal. It argued that the criticality of feature 1.4.3 (weight ratio of Pt to Pd) in combination with the other features of claim 1 in view of Article 123(2) EPC only became apparent in the decision (e.g. in point II.13.3). Feature 1.4.3 had never been explicitly mentioned before. There thus had not been enough guidance by the opposition division in this regard.

This is not convincing. As early as in the notice of opposition (see for example point 4 on page 4), the respondent had indicated that the patent as granted

violated Article 123(2) EPC because of the combination of features relating to the diameter and the length of the diesel oxidation catalyst (DOC), and the length of the DOC upstream zone. While feature 1.4.3 had not been explicitly mentioned, attention had already been drawn to the fact that the *combination* of features of claim 1 was problematic.

Similarly, in its summons to oral proceedings with regard to the patent as granted, the opposition division addressed the question of the presence of a pointer to the claimed combination of DOC diameter, DOC length and length of the DOC upstream zone, albeit without mentioning feature 1.4.3 (see, for example, point 2 of the chapter dealing with the main request at that time). Moreover, when dealing with the 12 auxiliary requests on file at that time (see point 3 on page 7 of the summons) it addressed the general problem of combining "different [parameter] ranges with each other and with further features". Consequently, the essence of the objection had already been communicated to the parties before the oral proceedings at the opposition stage.

In response to these summons, the appellant submitted nine additional auxiliary requests before the oral proceedings at the opposition stage (resulting in 21 auxiliary requests in total). In all these auxiliary requests, the appellant implemented various permutations of the endpoints of the ranges relating to the DOC length and diameter, as well as of the length of the DOC upstream zone. In all these permutations, endpoints were taken from the description as filed (in particular from the last four paragraphs on page 8 as filed).

When the opposition division announced that none of the requests met the requirements of Article 123(2), the appellant filed two additional auxiliary requests (auxiliary requests 22 and 23 then on file), again with other permutations of the endpoints of the ranges relating to the DOC length and diameter, as well as of the length of the DOC upstream zone. The opposition division considered that auxiliary request 22 also violated Article 123(2) EPC, and that auxiliary request 23, in which claim 1 was identical to claim 1 of auxiliary request 22, did not meet the requirements of Article 123(2) EPC on a *prima facie* basis. This request was therefore disregarded.

Importantly, the discussion of the main request and auxiliary requests at the oral proceedings in view of the requirements of Article 123(2) EPC involved "several rounds of discussion" or "discussion rounds" (see points 5 and 6 of the minutes), and also specifically addressed feature 1.4.3 as part of the combination of the features of claim 1 (see the end of point II.13.2 and the first paragraph of point II.13.3 of the decision, which relate to statements made by the appellant). It is thus clear that the appellant was able to take this into consideration when filing new requests during the oral proceedings. It is not apparent why the appellant would have needed further details to respond to the objection under Article 123(2) EPC, even more so as the essence of the objection had not been changed by the additional reference to feature 1.4.3. An objection was not raised to this feature as such, and even the current main request, which allegedly could not have been filed earlier (filed as auxiliary request 4 with the statement of grounds of appeal), does not include any amendment to feature 1.4.3.

Under these circumstances, the submission of the current new main request cannot be justified by any new elements in the decision under appeal.

1.3 In addition, the current main request could and should already have been filed at the opposition stage (Article 12(6) RPBA).

The appellant argued that the current main request was not a change in strategy but merely "fine tuning".

This is not convincing. The following table summarises the above-mentioned permutations of the parameter ranges in the requests underlying the decision under appeal.

Requests underlying the impugned decision:	DOC length	DOC diameter	length of DOC upstream zone
Main request and auxiliary requests 1 to 3	2.5-15"	2.5-15"	0.5-1.75"
Auxiliary requests 4 to 6, 16 and 19	2.5-4"	2.5-15"	0.75-1.25"
Auxiliary requests 7 to 9, 17 and 20	2.5-5"	2.5-15"	0.75-1.25"
Auxiliary requests 10 to 12 and 18	2.5-4"	2.5-15"	0.75-1"
Auxiliary requests 13-15 and 21	2.5-5"	2.5-15"	0.75-1"
Auxiliary requests 22 and 23	2.5-10"	4-15"	0.5-1.75"

In spite of the high number of auxiliary requests on file at the oral proceedings in opposition, none of

them combined the parameter ranges of claims as filed, although this would have been an obvious possibility in the case in hand when trying to overcome the objection under Article 123(2) EPC.

Claim 1 of the current main request is directed to the ranges of the DOC length, DOC diameter and of the length of the DOC upstream zone as defined in dependent claims 2 and 4; see the table below.

	DOC length	DOC diameter	length of DOC upstream zone
Current main request	2.5-10"	4-15"	0.5- <b>1.5</b> "
corresponding to claim as filed	claim 4	claim 4	claim 2

By contrast, none of the requests underlying the decision under appeal required the upper limit of the length of the DOC upstream zone of 1.5 inches of claim 2 as filed, even though they contained several amendments to this feature, as indicated.

Dealing with this new main request for the first time during the appeal proceedings would contravene the primary object of the appeal proceedings, which is to review the decision under appeal in a judicial manner (Article 12(2) RPBA).

In view of the high number of auxiliary requests filed at the opposition stage and the number of permutations made in these requests, a valid reason cannot be found for why the current main request had not already been submitted before the opposition division.

Under these circumstances, admitting this request would therefore permit the unacceptable practice of "forum shopping" between the departments of first instance and the boards of appeal, and would be detrimental to procedural economy, in particular if the case was then to be remitted to the opposition division (see, for example, T 878/21, point 4.9 of the Reasons).

- 1.4 In the appellant's view, the main request met the requirements of Article 123(2) EPC on a *prima facie* basis.
- 1.4.1 This is not convincing either. Several selections in the application as filed are necessary to arrive at claim 1, without there being a pointer to this specific combination.

In addition to claim 1 as filed, claim 1 of the current main request is based on the following passages of the application as filed, as explained by the appellant:

- claim 2: length of the DOC upstream zone (feature 1.4.2.2)
- claim 4: DOC length and diameter (features 1.1.2 and 1.1.1)
- claim 5: the catalyst composition is a mixture of Pt and Pd, or an alloy of them (feature 1.4.2)
- claim 6: weight ratio of Pt to Pd (feature 1.4.3)
- claims 8 and 9: the aftertreatment device is a soot filter or a unit for selective catalytic reduction (features 1.3.1 and 1.3.2)
- page 9, lines 14-16: catalyst composition supported on a substrate unit (feature 1.4)
- page 10, lines 11 to 12: greater Pt concentration in the upstream zone of the DOC (feature 1.4.2.1)

- page 10, lines 32 to 33: substrate unit is a flow-through monolith (feature 1.4.4)

It is readily apparent from these explanations that claim 1 combines the subject-matter of a significant number of dependent claims as well as passages from the description as filed.

- 1.4.2 However, feature 1.4.2.1, which has been taken from the description as filed, is not disclosed in the application as originally filed *in combination* with the other features of claim 1, for example not in combination with feature 1.4.3.

The appellant argued that feature 1.4.2.1 was not selected from different possibilities, but in fact constituted the only possibility for further specifying the higher oxidation activity for hydrocarbons (HC) in the DOC upstream zone required by claim 1 as filed.

This view cannot be shared. As the respondent noted, a higher Pt concentration in the upstream zone of the DOC is not sufficient to achieve higher HC oxidation activity in the DOC upstream zone. More generally, platinum group metals (PGM) are active in a DOC (as indicated even by the application as filed on page 1, lines 27 to 32). For instance, Pd, another PGM which is an essential component of the claimed catalyst, is also active in oxidising HC; however, claim 1 does not mention anything regarding the amount of Pd, and in fact the amount of PGM, in the DOC upstream zone and in the remainder, respectively. Consequently, the addition of feature 1.4.2.1 on its own cannot specify the higher HC oxidation activity in the upstream zone, and even less so can it be the *only* option for doing so.

Under these circumstances, instead of choosing feature 1.4.2.1, the appellant could alternatively have chosen another feature relating to the catalyst composition, such as:

- the total amount of PGM in the DOC (page 9, lines 23 to 26 of the application as originally filed),
- the amount of PGM in the upstream zone (page 10, lines 1 to 3; claim 7),
- the Pt/Pd ratio in the upstream zone (page 10, lines 16 to 22), and/or
- the concentration of palladium (page 10, lines 13 to 14).

- 1.4.3 The appellant moreover argued that example "DOC 3" was a pointer to the specific combination of features of claim 1.

This is not persuasive. For example, regarding the length of the upstream zone of the DOC, the appellant chose to insert the subject-matter of claim 2 as filed ("0.5 to 1.5 inches"), not that of claim 3 as filed ("1 inch"); however, as noted by the respondent, 1 inch was also the length in example "DOC 3", the only example possibly falling under the wording of claim 1. Moreover, example "DOC 3" does not point specifically to feature 1.4.2.1 either. It instead points to the PGM loading, as in claim 7 as filed, for example, because it illustrates a certain higher PGM loading in the upstream zone.

- 1.4.4 Under these circumstances, the current main request does not meet the requirements of Article 123(2) on a *prima facie* basis.

1.5 In the light of all of the above, the current main request is not admitted into the appeal proceedings (Article 12(4) and (6) RPBA).

## Order

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

The appeal is dismissed.

The Registrar:

The Chairwoman:



A. Wille

S. Besselmann

Decision electronically authenticated