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D E C I S I O N
of 25 July 1995

Case Number: T 0684/92 - 3.2.1

Application Number: 86402654.7

Publication Number: 0230804

IPC: F16J 15/08

Language of the proceedings: EN

Title of invention:
Metallic gasket

Patentee:
NIHON METAL GASKET KABUSHIKI KAISHA

Opponent:
Ishikawa Gasket Co. Ltd.
REINZ-Dichtungs-GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 54, 105, 111(1)

Keyword:
"Novelty (yes)"
"Admissibility of intervention during appeal proceedings"
"Remittal to the Opposition Division for consideration of
inventive step not yet examined before"

Decisions cited:
T 0026/88, T 0611/90, G 0001/94

Catchword:



Case Number: T 0684/92 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 25 July 1995

Appellant:
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Intervener:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 1 June 1992 revoking
European patent No. 0 230 804 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: F. Gumbel
Members: M. Ceyte
J.-C. de Preter

Summary of Facts and Submissions

- I. The Appellant is Proprietor of European patent No. 0 230 804 (application No. 86 402 654.7).
- II. The patent was opposed by the Respondent on the grounds that its subject-matter was not patentable.

As state of the art, the Respondent referred *inter alia* to

D5: GB-A-1 549 200

D8: US-A-4 468 044

- III. By its decision posted on 1 June 1992, the Opposition Division revoked the European patent arguing that the subject-matter of Claim 1 lacked novelty in view of documents D5 or D8.
- IV. An appeal against the decision was filed on 23 July 1992, with the appeal fee being paid at the same time.

The Statement of Grounds of Appeal was filed on 24 September 1992 together with a new set of Claims 1 to 13, followed by further proposals for amendments.

- V. On 17 January 1994 a third party (Intervener) lodged a Notice of Intervention under Article 105 and paid the prescribed opposition fee.

The Notice of Intervention was based on a suit for infringement filed by the Patentee's licensee on 4 October 1993 against the Intervener and handed over to him on 22 October 1993.

The Notice of Intervention referred especially to:

D11: US-A-2 397 597.

The Intervener argued that the claimed subject-matter was not novel over the disclosure of this document.

VI. In a first communication dated 19 July 1993 the Board expressed the view that the main issue to be decided in this appeal was the question of novelty. Once this issue being settled, the Board was inclined to remit the case to the Opposition Division for consideration of inventive step which had not yet been examined by the Opposition Division.

In a second and a third communication the Board expressed doubts about the novelty of the then claimed subject-matter vis-à-vis documents D8 and D11, respectively. In reply to the third communication, the Appellant filed on 5 October 1994 a new amended Claim 1 which reads as follows:

"1. A metallic gasket comprising a laminated structure of plates being provided with a combustion chamber hole (12), said structure having a flat elastic metal base plate (8, 38) provided with one bead (16, 36) adjacent to its edge portion (8a, 38a) surrounding said combustion chamber hole (12), a flat compensation plate (4), a compensating means (20) extending around said combustion chamber hole (12), thicker in wall thickness than the other portion when the metallic gasket is fastened, being formed by folding back the edge (4a) of said compensating plate (4) adjacent to said combustion chamber hole (12) in a direction opposite to said hole (12), and a flat intermediate plate (6),

characterized in that
the intermediate plate (6, 34) which is placed
between said base plate (8, 38) and said compensating
plate (4) is laminated onto said compensating plate (4),
said compensating means (20) comprises the
compensating plate (4), the folded edge thereof (4a) and
the edge portion (8a, 38a) of said base plate (8, 38),
said folded edge (4a) being folded back onto said
compensating plate (4) or said intermediate plate (6,
34),
said base plate (8, 38) is an outer plate, said
edge portion (8a, 38a) being free, and
said bead (16, 36) of said base plate (8, 38) is
disposed outside of the compensating means (20)."

VII. The Appellant requested that the contested decision be
set aside and that the European patent be maintained on
the basis of the following documents:

- Claim 1 filed on 5 October 1994 and Claims 2 to 7
filed on 17 September 1993;
- Description: amended columns 1 to 8 filed on
22 January 1994, column 3 being to be completed by
the Insert 1 filed on 5 October 1994;
- Drawings: Figures 1 to 5 of the patent
specification.

VIII. The novelty of Claim 1 was apparently no longer
questioned by the Respondent and the Intervener. They
submitted that even if the claimed subject-matter could
be considered novel, it would not involve an inventive
step in the light of the cited documents.

IX. The Respondent and the Intervener requested that the appeal be dismissed and the European patent be revoked in its entirety.

They further requested oral proceedings should it not be intended to fully dismiss the appeal or to remit the file to the Opposition Division for further consideration of inventive step.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64 EPC and is therefore admissible.
2. According to the recent decision of the Enlarged Board of Appeal G 1/94 OJ 1994, 787, the intervention of the assumed infringer under Article 105 EPC is generally admissible during pending appeal proceedings. Since the notice of intervention was given within three months of the date on which the infringement proceedings were instituted and the opposition fee was paid in due time, the formal requirements under Article 105 EPC are also met. Hence, the intervention is admissible.
3. *Formal matters*
 - 3.1 There are no formal objection under Article 123(2) to the current version of Claim 1 since it is adequately supported by the original disclosure, especially by the embodiments of Figures 1, 2 and Figures 3 to 5, respectively.

The claimed feature that the edge portion of the base plate is free, that is without being clamped, is clearly and fully derivable from the drawings, particularly from Figures 2, 4 and 5.

The further feature that the folded edge is folded back onto the compensating plate is supported by the embodiment of Figure 4 which, contrary to the Intervener's view, belongs to the claimed invention since the embodiment clearly encompasses all the features of Claim 1 as at present drafted.

Present Claim 1 contains all the features of granted Claim 1 so that the requirements of Article 123(3) EPC are also met.

- 3.2 Claim 1 has been formulated so as to state in its prior art portion all those features of the claimed subject-matter which in combination are known from document D8. The reason for the revocation was that the subject-matter of Claim 1 then on file lacked novelty with respect inter alia to this prior art document which may be considered to represent the closest prior art. Claim 1 thus meets the formal provisions of Rule 29(1) EPC.

4. *Novelty*

Novelty of Claim 1 as at present drafted is no longer questioned by the Respondent or the Intervener.

In the appeal proceedings, the question of novelty was considered in view of the prior art documents D5, D8 and D11.

Document D8, considering particularly Figures 2 and 4 and page 5, lines 3 to 43 discloses a metallic gasket comprising a laminated structure of plates provided with a combustion chamber hole (4), said structure having:

- a flat elastic metal base plate (10, 12) provided with one bead adjacent to its edge portion surrounding said combustion chamber hole (4),
- a flat compensating plate (14),
- a compensating means formed around said combustion chamber hole (4) by folding back the edge of the compensating plate (14),
- said compensating means being formed thicker than the other portion when the metallic gasket is fastened, and
- a flat intermediate plate (3).

The metallic gasket differs from the device of document D8 by the features stated in the characterising part of Claim 1. In particular, the flat metallic base plate (10, 12) of document D8 is not an outer plate and its edge portion around the chamber hole is not free, since this edge portion is covered by the folded edge of the compensating plate; furthermore, the bead of the flat elastic metal base plate is not disposed, as claimed, outside of the compensating means.

It follows that the subject-matter of Claim 1 is novel over document D8.

The subject-matter of Claim 1 is also novel with respect to document D5. This follows inter alia from the fact that the base plate (4) or (5) of document D5 is not provided with a free edge portion surrounding the combustion chamber hole.

The gasket according to document D11 does not i.a. comprise a flat elastic metal base having one bead and a free edge portion surrounding the combustion chamber hole, a flat compensating plate and a flat intermediate plate.

Novelty over the other documents of the proceedings was not disputed by the parties and is acknowledged by the Board.

Accordingly the Board comes to the conclusion that the subject-matter of present Claim 1 is novel over the opposed prior art documents.

5. The Opposition Division issued a decision upon lack of novelty and left the issue of inventive step undecided. As stated in the decision T 26/88 (OJ EPO 1991, 30, point 12) "the essential function of an appeal is to consider whether the decision which has been issued by a first instance department is correct on its merits - see in particular Article 106(1) EPC".

Thus, in such a case, according to the established jurisprudence of the Boards of Appeal, the case is normally remitted in the exercise of the Board's discretion under Article 111(1) EPC to the first instance for consideration of the undecided issue(s).

It is true that in exercising their discretionary powers the Boards of Appeal need to take into account the public's as well as the parties' common interest that

opposition proceedings should be speedily conducted and should avoid remittal insofar as it is reasonably possible. However, if as in the present case a substantive issue has not yet been examined, treatment of this issue by the Board would mean that it continues the examination of the opposition. This is clearly not the task of a Board of Appeal (see decision T 611/90 OJ EPO 1993, 50, point 3 of the reasons) and would deprive the parties' right to have this issue examined by two instances, if necessary.

In their reply to the Board's first communication setting out that the Board was likely to remit the case, none of the parties has actually opposed the Board's intention. The Respondent as well the Intervener have requested oral proceedings only in the event that it was not intended to remit the file to the Opposition Division for further consideration of inventive step.

Under these circumstances and in the exercise of its discretion under Article 111(1) the Board remits the case to the Opposition Division for further decision on the issue of inventive step.

Order

For these reasons it is decided that:

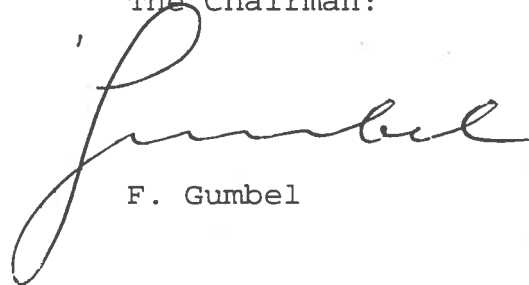
1. The Opposition Division's decision is set aside.
2. The case is remitted to the Opposition Division for further prosecution.

The Registrar:



S. Fabiani

The Chairman:



F. Gumbel

