

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen  
(D) [ ] No distribution

**Datasheet for the decision  
of 20 April 2009**

**Case Number:** T 0944/06 - 3.3.05

**Application Number:** 03076805.5

**Publication Number:** 1342886

**IPC:** F01N 3/20

**Language of the proceedings:** EN

**Title of invention:**

Emission control

**Patentee:**

JOHNSON MATTHEY PUBLIC LIMITED COMPANY

**Opponents:**

- 1) Ecocat Oy
- 2) Umicore AG & Co. KG

**Headword:**

Flexible honeycomb catalyst/JOHNSON MATTHEY PLC

**Relevant legal provisions:**

EPC Art. 100(c)

**Keyword:**

"Subject-matter extending beyond content of earlier application as filed"

**Decisions cited:**

-

**Catchword:**

-



Case Number: T 0944/06 - 3.3.05

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.05  
of 20 April 2009

**Appellant:** JOHNSON MATTHEY PUBLIC LIMITED COMPANY  
(Patent Proprietor) 40-42 Hatton Garden  
London EC1N 8EE (GB)

**Representative:** Nunn, Andrew Dominic  
Johnson Matthey Technology Centre  
Blount's Court  
Sonning Common  
Reading  
Berkshire RG4 9NH (GB)

**Respondent 1:** Ecocat Oy  
(Opponent 01) Vihtavuorentie 162  
FI-41331 Vihtavuori (FI)

**Representative:** Teipel, Stephan  
Lederer & Keller  
Patentanwälte  
Prinzregentenstrasse 16  
D-80538 München (DE)

**Respondent 2:** Umicore AG & Co. KG  
(Opponent 02) Rodenbacher Chaussee 4  
D-63457 Hanau-Wolfgang (DE)

**Representative:** Vossius & Partner  
Siebertstraße 4  
D-81675 München (DE)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 4 April 2006  
revoking European patent No. 1342886 pursuant  
to Article 102(1) EPC 1973.

**Composition of the Board:**

**Chairman:** B. Czech  
**Members:** H. Engl  
S. Hoffmann

## Summary of Facts and Submissions

I. This appeal lies against the decision of the Opposition Division to revoke European patent no. 1 342 886. The patent in suit was granted on European patent application no. 03076805.5 filed as a divisional of the earlier European patent application no. 97307691.2.

II. Independent claims 1 and 8 of the patent as granted read as follows (emphasis added by the board):

"1. An emission control system for internal combustion engines which emit carbonaceous soot particles, comprising a first catalyst effective to oxidise NO to NO<sub>2</sub> and a second catalyst, effective at least to oxidise hydrocarbons, carbon monoxide and volatile organic fractions, each catalyst being supported on a honeycomb flow-through monolith comprising a plurality of cells, each defined by a cell wall, whereby soot particles trapped on or within said second catalyst monolith are combusted in the NO<sub>2</sub>-containing gas from said first catalyst, and wherein the first catalyst is supported on a **flexible metal monolith** whereby flexing and/or vibration of the honeycomb cell walls serves to minimise the collection of soot particles thereon."

"8. A process for the purification of exhaust gases from an internal combustion engine which emits carbonaceous soot particles which process comprising the steps of passing said gases over a first catalyst effective to oxidise NO to NO<sub>2</sub> and subsequently passing the gas enriched with NO<sub>2</sub> over

a second catalyst effective at least to oxidise HC, CO and VOF in order to cause combustion of soot particles trapped on or within said oxidation catalyst, which first and second catalysts each being supported on a honeycomb flow-through monolith comprising a plurality of cells, each defined by a cell wall characterised in that the first catalyst is supported on a **flexible metal monolith** whereby flexing and/or vibration of the honeycomb cell walls serves to minimise the collection of soot particles thereon."

- III. The opposition division found that the claim feature "flexible metal monolith" did not introduce subject matter extending beyond the content of the earlier application as filed (Article 100(c) EPC). However, it decided to revoke the patent for lack of novelty having regard to D6: DE 30 12 182 A.
- IV. In its statement of grounds of appeal, the appellant (patent proprietor) only addressed the issue of novelty having regard to D6.
- V. Respondent 2 (opponent 02) maintained in its reply an objection under Article 100(c) EPC already raised in opposition proceedings, namely that a "*flexible metal monolith*" was not disclosed in the earlier application.
- VI. In its reply, respondent 1 (opponent 01) did not address the opposition division's finding concerning the requirements of Article 100(c) EPC.

- VII. In an Annex to a summons for oral proceedings pursuant to Article 15(1) RPBA the board raised *inter alia* objections under Article 100(c) EPC against claims 1 and 8, insofar as they comprised the expression "*flexible metal monolith*" which did not appear to be disclosed in the earlier application as filed.
- VIII. The appellant confirmed in a telefax dated 2 March 2009 that it had not requested oral proceedings. It informed the board that it requested the cancellation of the oral proceedings and the issuance of a written decision. Should oral proceedings be maintained, the appellant would not attend.
- IX. According to the appellant's main argument, document D6 did not disclose a first catalyst monolith designed to be flexible.
- X. The arguments of respondent 2, insofar as they are relevant for the present decision, were:

The claim feature relating to the "*flexible metal monolith*" was not based on the description which only disclosed flexing of the honeycomb cell walls. It referred to arguments already put forward under point 8.1 of its notice of opposition, where it found it inadmissible to base the claimed feature of a flexible **monolith** on a disclosure of flexible **cell walls** of the monolith. On the contrary, the honeycomb cell structure would render the monolith itself inflexible.

XI. Requests

The appellant requests that the decision under appeal be set aside and the patent be upheld as granted.

Respondent 1 requests that the appeal be dismissed.

Respondent 2 requests that the appeal be dismissed.

**Reasons for the Decision**

1. Allowability of claims 1 and 8 - Article 100(c) EPC

1.1 The expression "*flexible metal monolith*" in granted claims 1 and 8 has no **literal** or other unambiguous **explicit** basis in the parent application as originally filed. The only passage of the parent application as filed which actually refers to flexibility of the materials described is on page 22, lines 19 to 23, of the description, where it is said that the "*monolithic support used for the first catalyst is preferably a metal monolith which desirably provides flexing and/or vibration of the honeycomb cell walls for the purpose of displacing any soot particles captured within the monolith. The monolith may be consciously designed to encourage such flexing and/or vibration, possibly using the natural vibration modes of the diesel engine.*"

1.2 However, a metal monolithic honeycomb structure which is flexible is not necessarily to be equated with a metal monolith honeycomb which provides flexing and/or vibration of its cell walls. Whereas the former case implies that the whole body of the metal monolith be

flexible itself, in the latter case only the cell walls of the honeycomb need to be flexible. This was not disputed by the appellant who did not submit arguments on this point. Hence there is also no direct and unambiguous **implicit** disclosure of a "*flexible metal monolith*" in the parent application as originally filed.

1.3 Consequently, claims 1 and 8 as granted contain subject-matter which extends beyond the content of the earlier application as filed. Claims 1 and 8 are therefore objectionable under Article 100(c), second sentence, EPC.

2. The appellant's sole request thus cannot be allowed.

## **Order**

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

The appeal is dismissed.

The Registrar

The Chairman

C. Vodz

B. Czech