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**Datasheet for the decision
of 14 May 2009**

Case Number: T 0625/07 - 3.2.05

Application Number: 00101614.6

Publication Number: 1033511

IPC: F16J 15/12

Language of the proceedings: EN

Title of invention:

Gasket with compressible sealing member and hard support layer

Patentee:

ISHIKAWA GASKET CO. LTD.

Opponent:

ElringKlinger AG

Headword:

-

Relevant legal provisions:

EPC Art. 54, 111(1)

EPC R. 80

Keyword:

"Novelty (main request, no; second auxiliary request, yes)"

"Amendments occasioned by a ground of opposition (first
auxiliary request, no)"

"Remittal to department of first instance (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0625/07 - 3.2.05

D E C I S I O N
of the Technical Board of Appeal 3.2.05
of 14 May 2009

Appellant:
(Patent Proprietor)

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Respondent:
(Opponent)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 13 February 2007
revoking European patent No. 1033511 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: W. Zellhuber
Members: P. Michel
M. J. Vogel
W. Widmeier
E. Lachacinski

Summary of Facts and Submissions

- I. The appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division revoking European Patent No. 1 033 511.
- II. The patent in suit was revoked by the Opposition Division on the grounds that the subject-matter of claim 1 of a main and an auxiliary request is not new.
- III. Oral proceedings were held before the Board of Appeal on 14 May 2009.

The appellant requested that the decision under appeal be set aside and, as a main request, that the patent in suit be maintained as granted; or, as an auxiliary measure, that the patent in suit be maintained on the basis of either claims 1 to 8 or claims 1 to 3 filed as first and second auxiliary requests, respectively, on 9 April 2009.

The respondent (opponent) requested that the appeal be dismissed.

- IV. Claim 1 of the main request of the appellant reads as follows:

"1. A gasket (A, B), comprising:
a gasket member (A10, B10) having a first hole (Hf) to be sealed and a plurality of second holes (Hb) for allowing bolts to pass therethrough,
a compressible sealing member (A11, B11, B11') disposed on at least one side of the gasket member to completely surround the first hole adjacent thereto, and

a hard coating (A12, B12, B12') disposed on at least said one side of the gasket member and having compressibility less than that of the compressible sealing member, said hard coating (A12, B12, B12') surrounding the second holes (Hb) independently from the compressible sealing member (A11, B11, B11'), said gasket (A, B) being **characterized in that** said hard coating (A12, B12, B12') is spaced from the compressible sealing member (A11, B11, B11') with a gap therebetween, and is formed continuously to surround the compressible sealing member (A11, B11, B11')."

Claim 1 of the first and second auxiliary requests reads as follows:

1. A gasket (A, B), comprising:
a gasket member (A10, B10) having a first hole (Hf) to be sealed and a plurality of second holes (Hb) for allowing bolts to pass therethrough,
a compressible sealing member (A11, B11, B11') disposed on at least one side of the gasket member to completely surround the first hole adjacent thereto, and
a hard coating (A12, B12, B12') disposed on at least said one side of the gasket member and having compressibility less than that of the compressible sealing member, said hard coating (A12, B12, B12') surrounding the second holes (Hb) independently from the compressible sealing member (A11, B11, B11'),
wherein said hard coating (A12, B12, B12') is spaced from the compressible sealing member (A11, B11, B11') with a gap therebetween, and is formed continuously to completely surround the compressible sealing member (A11, B11, B11')
characterized in that

said compressible sealing member (A11, B11, B11') is made of a material selected from the group consisting of silicone rubber, polyurethane rubber and fluorine rubber, and said hard coating (A12, B12, B12') is a synthetic resin selected from the group consisting of epoxy resin, phenol resin, silicone resin, polyimide resin and fluorine resin."

V. The following documents in connection with an allegation of a public prior use are referred to in this decision:

- E1: Drawing No. 0 17 603 with revisions 1 to 9
- E2: Invoice No. 744482, dated 09.01.98
- E3: Invoice No. 773027, dated 08.06.98
- E4: Invoice No. 522069, dated 09.11.93
- E5: Invoice No. 524457, dated 30.11.93
- E6: Invoice No. 524546, dated 30.11.93
- E7: Invoice No. 535715, dated 15.03.94
- E8: Invoice No. 535801, dated 16.03.94
- E9: Invoice No. 533981, dated 02.03.94
- E10: Invoice No. 538144, dated 06.04.94
- E11: Drawing No. 0 17 603 with revisions 1 to 3
- E18: Invoice No. 801885, dated 09.11.98
- E19: Invoice No. 803091, dated 16.11.98
- E20: Invoice No. 803098, dated 16.11.98

In addition, the following documents are also referred to:

- D1: EP-A-0 807 773
- D3: US-A-3,794,333
- D4: EP-A-0 852 309

VI. The appellant argued substantially as follows in the written and oral procedure:

The public availability of the Elring gasket has not been proved beyond reasonable doubt. The sales to PSA were confidential.

Even if publicly available, the Elring gasket is not novelty destroying for the subject-matter of claim 1 of the main request. As shown in documents E1 and E11, the material FW 522 V is not disposed on at least one side of the gasket member, but is interposed between two portions of a flanged metal sheet element as shown in section A-B. The gasket member itself and not the compressible material thus acts as the sealing member.

The gasket does not include a hard coating, that is, a layer which is applied by a coating procedure and adhered to a substrate over at least an extended portion of the entire contact area between the coating and the substrate. The metal rim 5 of document E11 is only secured to the metal sheet of the gasket by clinching at a number of discrete points.

The subject-matter of claim 1 of the main request is thus new.

The new dependant claims of the first auxiliary request represent features of the invention which are important to the appellant as fallback positions.

It would be appropriate to remit the case to the first instance for consideration of the question of inventive

step in order to give the appellant the opportunity of arguing the matter at two instances.

VII. The respondent argued substantially as follows in the written and oral procedure:

Before the priority date of the patent in suit, gaskets having the Elring part number 900.001, and shown in documents E1 and E11, intended for a four cylinder motor of the type TU D3 of the manufacturer PSA, were publicly used.

Documents E2 to E10 prove that approximately 20,000 gaskets of the type shown in Documents E1 and E11 were sold. Such a quantity indicates that the gaskets were intended for the series production of vehicles.

Documents E18 to E20 relate to sales to dealers in spare parts for the repair of vehicles. There can thus be no doubt that the gaskets were publicly used.

The gasket shown in documents E1 and E11 has all the features of claim 1 of the main request.

In particular, the arrangement of the compressible sealing member shown in document E11 (section A-B) satisfies the requirement that the compressible sealing member is disposed on at least one side of the gasket member.

In addition, the metallic overlay (labeled 5 in section J-K of document E11), constitutes a "hard coating". A coating is a covering layer and not necessarily a layer which is adhered to a substrate over at least an extended portion of the entire contact area. It is not

relevant how the coating is secured to the gasket member. Rather, the function of the coating, as described in paragraph [0013] of the patent in suit, is significant.

The subject-matter of claim 1 of the main request is thus not new in view of the public prior use.

Reasons for the Decision

1. Alleged Public Prior Use

It is alleged by the respondent that a public prior use of a cylinder head gasket as shown in documents E1 and E11 occurred by virtue of sales of the gasket to Peugeot. This allegation is supported by invoices filed as documents E2 to E10 in conjunction with the testimony of Mr Griesinger before the opposition division. In this connection, the board is able to agree with the summary of the evidence contained in points 2.2, 3.1 and 3.2 of the decision of the opposition division.

It is alleged on behalf of the appellant that the sales of the "Elring gasket" referred to in documents E2 to E10 were made in the context of an obligation to maintain secrecy. However, the number of gaskets sold indicates a normal commercial transaction which was not made under a seal of confidentiality, involving the sale of a component intended to be mounted in vehicles manufactured for general sale. In addition, documents E18 to E20 relate to sales to dealers in spare parts,

thus indicating that the gaskets sold to Peugeot were mounted in vehicles which were generally sold.

The gasket shown in documents E1 and E11 thus forms part of the state of the art. Whilst the drawings have been subject to a number of revisions, these are not significant in terms of the subject-matter of the patent in suit.

2. *Main Request*

Novelty

The appellant has argued that the sealing member shown in section A-B of document E11 is not disposed on at least one side of the gasket member as required by claim 1 of the patent in suit, but is interposed between two portions of the gasket member. The drawing, however, shows that the sealing member is, in fact, disposed on one side of the gasket member, with a portion of the gasket member crimped around it. As indicated on section A-B, the member undergoes compression in use (from 1.70 to 1.90 mm) and is not entirely enclosed by the gasket member. It is noted that the claim does not specify how the sealing member is secured to the gasket member.

The appellant has further argued that the metal rim 5 as shown in section J-K of document E11 does not constitute a "coating" as required by claim 1 of the patent in suit. The function of the hard coating is to prevent excessive compression of the compressible sealing member as stated in paragraph [0013] of the patent in suit. This is also the function of the metal

layer 5 shown in section J-K of documents E1 and E11. As regards the method by which the layer is secured to the gasket member, it is noted that, in use, the gasket is under compression as is not subject to significant transverse forces. The manner in which it is secured to the gasket member is thus not significant to its function and is not specified in claim 1. The term "coating" as used in claim 1 should thus be construed as including a layer secured to the gasket member.

The subject-matter of claim 1 is therefore not new.

3. *First Auxiliary Request*

Amendments

According to Rule 80 EPC, amendments in opposition proceedings may only be made if they are occasioned by a ground of opposition. The introduction of new dependant claims cannot meet any of the grounds of opposition specified in Article 100 EPC. Thus, the introduction of new dependent claims 5 to 8 does not comply with the requirements of Rule 80 EPC and the first auxiliary request is not allowable.

4. *Second Auxiliary Request*

4.1 Novelty

4.1.1 The hard coating of the Elring gasket is made of metal. The public prior use of this gasket thus does not disclose a gasket having a hard coating which is a synthetic resin selected from the group consisting of

epoxy resin, phenol resin, silicone resin, polyimide resin and fluorine resin.

- 4.1.2 Document D1 discloses a gasket in which a relatively hard elastic member (2) is disposed adjacent a relatively soft elastic member (3). There is no disclosure of a gasket in which a hard coating is spaced from a compressible sealing member with a gap therebetween.
- 4.1.3 Document D3 discloses a gasket in which the hard coating is arranged in discrete segments (32a). There is no disclosure of a gasket in which a hard coating is formed continuously to completely surround a compressible sealing member.
- 4.1.4 Document D4 discloses a gasket in which a sealing member has a relatively hard portion (A11b, B11, D11) and a relatively soft portion (A11a, B11a, D11a) formed therein. There is no disclosure of a gasket in which a hard coating is spaced from a compressible sealing member with a gap therebetween.
- 4.1.5 Thus, the prior art does not disclose a gasket having all the features of claim 1 according to the second auxiliary request and the subject-matter of the claim is hence new.
5. The opposition division has not had the opportunity of considering the issue of inventive step. In order to enable this issue to be considered at two instances, the Board considers it to be appropriate to exercise their discretion to remit the case to the department of

first instance for further prosecution in accordance with Article 111(1) EPC.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

D. Meyfarth

W. Zellhuber