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**Datasheet for the decision
of 30 April 2009**

Case Number: T 1194/07 - 3.2.04

Application Number: 97115016.4

Publication Number: 0828067

IPC: F02D 11/10

Language of the proceedings: EN

Title of invention:

A throttle valve control device for an internal combustion engine

Patentee:

Hitachi, Ltd.

Opponent:

SIEMENS AKTIENGESELLSCHAFT

Headword:

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Relevant legal provisions:

-

Relevant legal provisions (EPC 1973):

EPC R. 55(c), 56(1)

Keyword:

"Admissibility of opposition (no)"

Decisions cited:

G 0009/91, G 0010/91, T 0222/85, T 0002/89, T 0545/91,
T 0621/91, T 0199/92, T 1366/04

Catchword:

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Case Number: T 1194/07 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 30 April 2009

Appellant: SIEMENS AKTIENGESELLSCHAFT
(Opponent) Postfach 22 16 34
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Representative: -

Respondent: Hitachi, Ltd.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 10 July 2007
rejecting the opposition filed against European
patent No. 0828067 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: A. de Vries
C. Heath

Summary of Facts and Submissions

- I. The Appellant (Opponent) lodged an appeal, received 18 July 2007, against the decision of the Opposition Division posted 10 July 2007 to reject the opposition against European Patent Nr. 0 828 067, and simultaneously paid the appeal fee. The statement setting out the grounds was received 15 November 2007.
- II. The opposition was filed with letter of 5 October 2005 received 12 October 2005, against the patent as a whole and on the basis of Article 100(a) in combination with Articles 54 and 56 as opposition grounds.

The Opposition Division held the opposition to be admissible, in particular as it met the requirements of Rule 55(c) EPC 1973. However, it found that the grounds mentioned did not prejudice the maintenance of the patent as granted.

- III. Oral proceedings were duly held before this Board on 30 April 2008.
- IV. Claim 1 as granted reads as follows:
A throttle valve control device for controlling an amount DT intake air of an internal combustion engine, comprising:
- a main body (100) in which an intake air path is formed,
- a throttle shaft (2) which is rotatably supported by the main body (100),
- a throttle valve (1) being disposed in the intake air path and operatively secured to the throttle shaft (2),

- an electric motor (4) for driving the throttle valve (1), which is housed in a motor casing portion of the main body,
- gears (3h, 11, 12) for transmitting a rotating torque of the motor (4) to the throttle shaft (2),
- a sensor (20) for detecting a throttle valve opening,
- a movable member(3) disposed on the throttle shaft (2) and fixed thereto for transmitting a torque of the motor (4),
- a contacting member (5) rotatably disposed on the throttle shaft for coming into contact with said movable member(3) and for stopping at a default stopper (103) provided at a default Position of the throttle valve (1),
- a default spring (7) for acting a force on the throttle valve in an opening direction towards said default position defined by said stopper (103),
- a return spring (6) for acting a force on the throttle valve in a closing direction towards the default position,
- wherein during the movement in the closing direction from the default position, the throttle valve (1) is operably separated from the return spring (6), when the contacting member (5) is stopped by the default stopper (103), and, after the contacting member (5) is stopped, the throttle valve (1) moves against the force caused by the default spring (7) so that only the default spring (7) is active in the range between the full close position and the default position (103) and only the return spring (6) is active between the default position and the full open position, characterized in that

- the contacting member (5) is rotatably supported by a sleeve (3b) which is formed as a unitary body with the movable member (3),
- said movable member (3) comprises a sectional gear (3h) at an outer periphery of a cylindrical portion for transmitting the torque of the electric motor (4) to the throttle shaft (2), wherein the movable member (3) is driven by said electric motor (4) through said gears (3h, 11, 12).

V. The Appellant (Opponent) requests that the decision under appeal be set aside and the patent be revoked in its entirety.

The Respondent (Proprietor) requests, as main request, that the appeal be dismissed and the patent be maintained as granted, or in the alternative, that the patent be maintained in amended form according to one of auxiliary requests 1 to 5 filed with letter of 30 March 2008.

VI. The Appellant argued as follows :

The notice of opposition includes different lines of argumentation, all departing from E1 as closest prior art. E1 itself need not be discussed in detail as it was acknowledged in the specification as forming the basis for the preamble of claim 1.

The first line of attack draws the remaining characterizing features from E2. It identifies the relevant figures and passages where these missing features will be readily identifiable to the skilled person. The number is obviously incorrect: it is not

included on the cover page of the specification as it should do according to the notice. Little effort is necessary to find the correct one.

E3 is offered only as an alternative source for the final characterizing feature and represents a further attack.

The notice also argues inventive step from E1 in combination with the skilled person's common general knowledge.

Each line of attack is presented as an internally consistent, logical chain of reasoning, which is easily recognizable as such to the skilled person without any investigative effort on his part. How individual features correspond precisely to the citations relates rather to the more important question of merit and not to the less critical issue of admissibility.

Only subsequently has the case proven to be rather complex, in particular as E1 has not proven to correspond exactly with the preamble. Initially, however, the relationship of the claimed invention to prior art seemed simple and straightforward in the light of the two-part form. The nature of the differences did then not yet warrant a detailed analysis.

VII. The Respondent argued as follows :

The notice of opposition mentioned lack of novelty but failed to provide any detail in regard of this ground. Only for inventive step did it provide some form of

substantiation. However, in this case it was entirely inadequate for the proprietor to be able to understand the case made against him without investigative effort.

Thus, the notice did not indicate which part of E1 disclosed which features of the preamble of claim 1. For the characterizing features it relied on two documents, one of which, E3, was post-published and thus not part of the prior art under Article 56. The other, E2, was identified with an incorrect number (referring to a document in an irrelevant field); the correct number could only be established after some investigative effort. Nor did the notice present any argument why features from this (correct) citation might be combinable with the subject-matter of E1.

As was clear from the subsequent discussions - involving over 40 pages of submissions from the appellant as opposed to the page and a half of the notice - this was moreover a complex case which merited a much more detailed analysis than that given initially.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is thus admissible. However, it is not allowable for the following reasons.

2. The decisive issue is that of admissibility of the opposition. The relevant provisions governing admissibility of the opposition are those in force on the date of its filing, 12 October 2005, i.e. of the European Patent Convention in its previous 1973 version

before entry into force of the revised text on 13 December 2007. These are Rule 56(1) in conjunction with Article 99(1), Rule 55(c).

This follows from the general legal principle that the competence to perform a procedural act derives from the law in force at the time of performing the procedural act, and that as a consequence any issue of competence must be decided within that legal framework, as explained in T 1366/04 (not published), reasons 1.2.

3. Rule 55(c) EPC 1973 stipulates that the notice of opposition state extent and grounds of opposition as well as indicate "facts, evidence and arguments presented in support of these grounds". As expounded in G 9/91 (OJ 1993, 408) and G 10/91 (OJ 1993, 420), Reasons 6, Rule 55(c) is not a merely formal requirement, but has an important substantive function in establishing the legal and factual framework for the substantive examination of the opposition. This is further underlined by T 222/85 (OJ 1988, 128), reasons 4, stating that the requirement of *indication of facts, evidence and arguments* "is substantive in nature, and calls for reasoning which goes to the merits of the opponent's case". It is "only satisfied if there is sufficient indication of the relevant "facts, evidence and arguments" ..., for the reasoning and merits of the opponent's case to be properly understood by the Opposition Division and the patentee ... on an objective basis, from the point of view of a reasonably skilled man in the art [of the patent]". In subsequent jurisprudence this is interpreted as meaning that the opponent's case should be understood "without further investigation" (cf.

T 2/89 (OJ 1991, 51), reasons 3), or "without undue burden"(cf. T 199/92, reasons 1.2) to the patentee or opposition division. Thus substantiated a notice puts the patentee in a position to fairly react to the grounds raised against the patent, either by rebutting these with concrete counter arguments or formulating amendments addressing the contentious issues.

Consequently, unless the facts of a case are readily recognizable or immediately apparent from the evidence provided, the opponent will need to elucidate the facts by way of reasoning or arguments to satisfy the requirement of Rule 55(c) EPC 1973. This may, for example, mean citing specific passages or parts of a citation and correlating these with claimed features, see e.g. T 545/91 or T 621/91. Where inventive step is at stake, the notice should normally additionally indicate *why* various documents might suggest a lack of inventive step, see e.g. T 222/85, reasons 8.

Finally, as is repeatedly stated in case law, the indication of facts, evidence and arguments need not be conclusive or correct. That is an issue of merit. The Board however emphasizes that the merits of a case can only be assessed in a meaningful manner if the case has been stated fully, by an adequate indication of the relevant facts, evidence and arguments.

4. In the case at hand, the notice of opposition comprises just over two sides with the main body of facts, evidence and arguments appearing on page 2. The evidence is in the form of documents, numbered in the notice as E1 to E7; only E1, E2, E3 and E7 play a further role in the notice. Apart from E2 all pertinent

citations are unambiguously identifiable. The publication number given for E2 does not figure amongst the examination citations as it should according the third paragraph of page 2 of the notice, but can be identified with minimum effort as the second reference cited on the front page of the patent specification, the number of which differs only in the last digit. This is thus of no consequence to the issue of substantiation, as is the notice's subsequent simple reference to E1 for the preamble features without further discussion. In this case, as stated in the notice, page 2, fourth paragraph, the opponent has relied on the specification's acknowledgement in column 2, lines 6 and 7. This is reasonable in the Board's view, as the reader should be able to take such statements in a patent publication regarding the basis for the preamble prior art at face value. Equally unobjectionable is the fact that, though the notice mentions Article 54 as well as Article 56 in conjunction with Article 100(a) as ground, only lack of inventive step is then argued. If properly substantiated this sole ground should satisfy the requirement of Rule 55(c) EPC 1973.

5. The notice is deficient under Rule 55(c) EPC 1973 where key elements linking the further cited prior art to the claim or relating to their validity as evidence, as well as crucial arguments informing the reader *why* the skilled person might have considered combining the features of such prior art with those of E1, are missing in the notice.

- 5.1 For the characterizing part of the claim - the "surplus" over E1 in the words of the notice ("Der

vermeintliche erfinderische Überschuss gegenüber E1 ...", fifth paragraph, second sentence)- it draws on E2 and E3. E2 is referred to in the context of the bearing or support of the contact member features ("hinsichtlich der Lagerung des Kontaktelements"), corresponding to the first of the two characterizing features. E3 is cited against the final feature, see page 2, sixth paragraph ("Der letzte Teil des kennzeichnenden Teiles ...").

At this juncture the Board adds that the citation of E2 and E3 against separate features indicates that E2 and E3 figure together in a single sole attack. This is confirmed by the paragraph bridging pages 2 and 3 : "As in particular both groups of features belong to elementary knowledge ... and are documented by publications E2 and E3 ... the subject-matter of claim 1 lacks inventive step" ("Da insbesondere die beiden Merkmalsgruppen ... zu den elementaren Grundkenntnisse ... gehören und durch die Druckschriften E2 und E3 belegt sind, [beruht] der Gegenstand des Anspruchs 1 nicht auf einer erfinderischen Tätigkeit"). The sentence may not follow logically from the preceding paragraphs (the link between E2 and E3 and elementary knowledge is unexplained), it nevertheless reads as their conclusion.

- 5.2 Echoing the wording of claim 1 (in its German version), the notice singles out particular features in E2: its "Kupplungsglied" is said to be mounted on a sleeve integrally formed on the "Stellglied", the latter then said to be part of a transmission gear and corresponding to the movable member of the claim. The notices cites figures 3 and 4 and column 3, line 25, to

column 4, line 41 as pertinent, but, apart from an introductory paragraph, this corresponds to the entire detailed description of the embodiments, encompassing a number of different embodiments. However short this section of E2 may be, the relationship between the features of the claim is nevertheless not readily recognizable therefrom. It requires some level of investigative effort on the reader, who now carries the burden of identifying the relevant passages, if any, and establishing the exact correspondence with the first characterizing feature and why.

Such correspondence is neither immediately apparent nor trivial. The opponent submits in his notice that the member (13) ("Stellglied") of E2 corresponds in essence to the movable member (3) of the claimed invention ("Das Stellglied 13 ... entspricht im wesentlichen dem beweglichen Element 3") and that the member 9 ("Kupplungsglied") of E2 corresponds to the contacting member (5) of the claim. However, granted claim 1 in its preamble requires firstly that the movable member (3) be disposed on the throttle shaft and "fixed thereto". Member (13) of E2 with which it supposedly corresponds is however not fixed but rotatably mounted on the throttle shaft. Secondly, according to claim 1 the contacting member (5) is "rotatably disposed on the throttle shaft", whereas its supposed counterpart in E2, member (9), is not rotatably disposed but welded on the throttle shaft.

The notice is wholly silent as to why - contrary to simple logic - the member (13) of E2 which is rotatably mounted should be construed as the claimed movable member (3) fixed on the throttle shaft, and the member

(9) of E2 which is fixed on the throttle shaft can be construed as the contacting member (5) of the claim rotatably mounted thereon. There thus is no technically reasoned connection between the two members (3) and (5) of the claim and the two members (13) and (9) disclosed in E2. In the absence of any further substantiation, the skilled reader is unable to understand the conclusion drawn by the opponent in his notice that the latter members may be equated with the members (3) and (5) respectively, which are the subject of the characterizing part of granted claim 1.

5.3 For E3, the notice cites figures 1 to 4, and column 3, line 8, to column 4, line 8, which, again corresponds to the entire detailed description. No further information is provided and it is left to the reader to work out the details of the relationship between this document's content and the final feature of the claim. The statement that it corresponds to the last part of the characterizing part is no more than bold assertion.

Moreover, E3 is an intermediate "P" document (see also the search report), published (on 9 January 1997) between the patent's priority and filing dates (3 September 1996 and 29 August 1997 respectively). It belongs to the state of the art only if the claimed priority is not valid. It is not apparent from the notice that this has been verified. This task is again left to the reader. In as far as he would have found the claimed priority to be valid, so that E3 does not belong to the state of the art, the assertion regarding the final characterizing feature would be wholly unsubstantiated by fact.

- 5.4 Finally, a key element is missing in the notice's chain of logic leading from the prior art to the invention: it is not apparent to the reader from the notice *why* the skilled person would combine their teachings. The mere fact, however well founded, that different pieces of prior art together disclose all the claimed features, and that they therefore belong to the skilled person's "elementary knowledge" (paragraph bridging pages 2 and 3) is entirely inadequate. Any reasoning intending to demonstrate lack of inventive step must do so within the terms of the statutory definition of inventive step given in Article 56 which hinges on the notion of the skilled person. That notion implies a technical evaluation of claimed invention and prior art which goes beyond the mere identification of features in citations. The problem-solution approach adopted by the Boards of Appeal as standard test is the preferred way of doing so, though it is by no means the only way.
- 5.5 The net result of the omission of key facts and elements in the notice's reasoning is that it amounts to little more than speculation or an outline of a possible case against the patent. To determine whether or not a case in fact exists that might prejudice the patent, the reader must first fill in the substantial gaps. He would need to find the relevant features in the citations and carry out the missing technical evaluation himself. The burden of proof will thus have been shifted away from the party contesting the validity of the patent.
6. In the light of the above the Board concludes that the notice of opposition does not include "an indication of facts, evidence and arguments" as required by Rule 55(c)

EPC 1973 to support the grounds raised. As these deficiencies were not also remedied before expiry of the opposition period, the notice of opposition is inadmissible pursuant to Rule 56(1) EPC 1973.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

G. Magouliotis

M. Ceyte