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**Datasheet for the decision
of 23 January 2014**

Case Number: T 1574/10 - 3.2.04

Application Number: 02018576.5

Publication Number: 1291506

IPC: F02B63/06, F02B67/06

Language of the proceedings: EN

Title of invention:

Engine

Patent Proprietor:

Kubota Corporation

Opponent:

Deutz Aktiengesellschaft

Headword:

Relevant legal provisions:

EPC Art. 100(a), 54, 56

Keyword:

Novelty - (yes)
Inventive step - (yes)

Decisions cited:

Catchword:



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Case Number: T 1574/10 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 23 January 2014

Appellant: Deutz Aktiengesellschaft
(Opponent) Abt. FR-P, Patente und Marken
51057 Köln (DE)

Respondent: Kubota Corporation
(Patent Proprietor) 2-47, Shikitsuhigashi 1-chome,
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
17 May 2010 concerning maintenance of the
European Patent No. 1291506 in amended form.**

Composition of the Board:

Chairman: A. de Vries
Members: E. Frank
T. Bokor

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division, dated 5 May 2010 and posted on 17 May 2010, to maintain the European patent No. 1 291 506 in amended form according to a new first auxiliary request filed during the oral proceedings.
- II. The appellant (opponent) filed a notice of appeal on 16 July 2010, paying the appeal fee on the same day. The statement of grounds of appeal was submitted on 14 September 2010 together with forty-three numbered annexes ("Anlagen"). In particular, annexe 1 concerns several alleged prior uses together with the offer of witness testimony. Annexes numbered 2 to 41 are documents or brochures, while a final annexe 42 is a copy of the appellant's submissions of the first instance proceedings. Finally, annexe 43 corresponds to late filed document D3 (DE-A-196 12 405) not admitted into the first instance proceedings.
- III. A communication pursuant to Article 15(1) RPBA was issued 14 January 2014 after a summons to attend oral proceedings. The parties were inter alia notified that, during the oral proceedings, the issue of admissibility of appeal and, if the appeal were found admissible, of admissibility of late filed prior art, would also arise.
- IV. The oral proceedings were duly held on 23 January 2014. At the oral proceedings neither party commented further on their written submissions.
- V. The appellant requests that the decision under appeal be set aside and that the patent be revoked.

The respondent requests that the appeal be dismissed, i.e. the patent be maintained in an amended form as held allowable by the opposition division.

VI. The wording of claim 1 as maintained by the opposition division reads as follows:

"An engine comprising a belt transmission device (2) which interlockingly operates a cooling fan (1) and a timing transmission device (4) which interlockingly actuates a fuel injection pump (3), wherein the belt transmission device (2) and a timing transmission device (4) are dividedly arranged at a front end and a rear end of a cylinder block (6), respectively, and a fuel injection pump (3) is disposed on one horizontal side of the cylinder block (6), a generator (8), which serves as a belt tensioner (7) of the belt transmission device (2), being arranged in front of the fuel injection pump and on the same horizontal side of the cylinder block, characterised in that an oil cooler (9) and a starter motor (5) are disposed in the front and rear direction on the said horizontal side of the cylinder block (6), the starter motor (5) being below the fuel injection pump (3), and the oil cooler (9) being below the generator (8); and in that a handle for an oil level gauge (16) is disposed between the starter motor (5) and an oil filter (12) attached to a rear portion of the oil cooler, and an oil supply port (27) is arranged downwards of the fuel injection pump (3) and upwards of an end portion, near the oil level gauge (16) of the starter motor (5)."

VII. The parties submitted the following arguments:

The appellant stated that independent claim 1 of the patent in suit lacked novelty over annexes 1 to 22 and 27, and did not involve an inventive step in the light of any of the annexes 23 to 26, or 28 to 41, and the common technical knowledge of the skilled person. Relevant features of claim 1 were highlighted in yellow in the respective enclosures. Furthermore reference was made to the first instance submissions (annexe 43) concerning the arrangement of attached parts at one side (of the engine). The appellant did not comment on the issues identified in the Board's communication under Article 15(1) RPBA, nor did he wish to comment on where upheld claim 1's characterizing feature of the oil supply port arrangement might be found in the cited annexes.

The respondent argued that throughout the statement of grounds no serious attempt was made to identify those parts that are alleged to correspond to the features of the claim. The parts shown in yellow in, e.g. annexe 2, appeared to correspond only to the features of original claim 1. This applied also to the other annexes. There was no indication whether or where the features of the characterising portion of claim 1 as upheld were present in the annexes, nor was this self-evident. The claimed motor was therefore novel and inventive. Moreover, the grounds of appeal contained only broad generalisations which failed to substantiate the allegations of lack of novelty or lack of inventive step, and which also amounted to an abuse of process.

Reasons for the Decision

1. *Novelty and Inventive Step*

1.1 On page 5 of its decision the opposition division found that claim 1 as maintained specified both the location of the oil gauge and oil supply port. While the oil gauge was approximately in the expected location for any engine, the oil supply was held to be different. Thus, all cited documents showed the usual arrangement with the oil supply on top of the cylinder head cover, so that this had to be considered to be the expected location and any other location then became "unusual". Thus, the opposition division held that such an arrangement of the oil supply port of claim 1, i.e. downwards of a fuel injection pump driven from one side of the engine and upwards from a starter motor driven from the same side, could not be deemed obvious by the skilled person and had to be considered as representing an inventive step. This feature of the oil supply port arrangement was thus critical to the appealed decision's positive finding of inventive step.

1.2 The Board agrees with the respondent's view that the statement of the grounds of appeal is largely constituted of broad generalisations, none of which specifically mention the critical feature of the oil supply port arrangement. The statement of grounds discusses each annexe briefly, stating that the relevant features have been highlighted in yellow ("gelb markiert"). For example:

"MTZ 60 (1999) 10, page 710 (Enclosure 2) shows an engine having the features (marked in yellow) of the independent claim of the patent in suit, such that the

latter lacks novelty." See grounds, page 2, 3rd paragraph:

("MTZ 60 (1999) 10, S 710 (Anlage 2) zeigt einen Motor mit den Merkmalen (gelb markiert) des unabhängigen Streitpatentanspruchs, so dass es diesem an Neuheit mangelt").

"MTZ 59 (1998) 9, pages 544 to 554 (Enclosure 35) represents the developments of the nineties in the field of component part integration, in particular by taking the example of oil circulation. At least since this publication it is evident to the skilled person, that, an oil cooler may also be housed or be attached to any oil filter housing." See grounds, page 7, 2nd paragraph:

("MTZ 59 (1998) 9, S. 544 -554 (Anlage 35) stellt die Entwicklungen der 90er Jahre im Bereich der Bauteilintegration insbesondere am Beispiel des Ölkreislaufs dar. Spätestens seit dieser Veröffentlichung ist dem Fachmann klar, dass in oder an jedem Ölfiltergehäuse auch ein Ölkühler unter- bzw. angebracht werden kann.")

None of these passages, neither that discussing the alleged prior use of annexe 1, see the paragraph bridging pages 1 and 2, nor those discussing the contents of annexes 2 to 42 makes any mention of the feature of an oil supply port arrangement, or where it might be found in the cited documents. The feature is also not apparent to the Board from those parts of these documents that the appellant has highlighted in yellow ("gelb markiert"). When asked by the Board at the oral proceedings to indicate where the feature of the oil supply port arrangement might be found in any of annexed documents the appellant indeed chose not to comment.

From the above, and in particular from the appellant's refusal to comment the Board concludes that the cited documents, annexes 1 to 42, do not disclose the central feature on which the appealed decision hinges.

Finally, annexe 42 is a re-filing of the appellant's first instance written submissions, which focused exclusively on the granted claims. Clearly, these submissions cannot deal with a feature that was first added from the description at the first instance oral proceedings, as is confirmed on closer inspection of these submissions.

It follows immediately from the above that the statement of grounds, in failing to mention this central feature in any of the cited documents or previous submissions, does not address the central reason for the decision's finding of inventive step.

- 1.3 As regards the remaining prior art of the first instance proceedings, no argument has been put forward by the appellant. Indeed the opposition division had already addressed this prior art, see reasons pages 2 to 5, and held that the location of the oil supply port was not obvious for the skilled person in the light of the documents admitted into the procedure. The Board has no reason to take a different view.

- 1.4 The Board therefore concludes that the appeal is manifestly not allowable. The issue of the admissibility of the appeal (on the grounds of insufficient substantiation) and the question whether or not the multiplicity of (irrelevant) documents submitted with the grounds of appeal amount to an abuse of process can be left undecided. The same holds for the question whether or not a formal admission of the

late filed annexes 1 to 43 is justified. With or without them, the appeal must fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

A. de Vries

Decision electronically authenticated