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**Datasheet for the decision
of 20 May 2011**

Case Number: T 0371/11 - 3.2.06

Application Number: 09010830.9

Publication Number: 2119884

IPC: F01N 3/22

Language of the proceedings: EN

Title of invention:

Four-cycle engine

Applicant:

Yamaha Hatsudoki Kabushiki Kaisha

Opponent:

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Headword:

-

Relevant legal provisions:

EPC Art. 76(1), 123(2)

RPBA Art. 13(1)

EPC R. 63, 137(5)

Relevant legal provisions (EPC 1973):

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Keyword:

"Main request - meets requirements of Article 76(1) and 123(2)
EPC"

"Remittal to examining division for further prosecution"

Decisions cited:

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Catchword:

-

Case Number: T 0371/11 - 3.2.06

DECISION
of the Technical Board of Appeal 3.2.06
of 20 May 2011

Appellant: Yamaha Hatsudoki Kabushiki Kaisha
2500 Shingai
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Representative: Grünecker, Kinkeldey
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 30 July 2010
refusing European patent application
No. 09010830.9 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: M. Harrison
W. Sekretaruk

Summary of Facts and Submissions

- I. The appellant (applicant) filed an appeal against the decision of the examining division dated 30 July 2010 refusing European patent application No. 09010830.9 which is a divisional application of European application No. 04745634.8 (filed as PCT application PCT/JP2004/007924).
- II. An extended European search report was issued with the communication of 16 October 2009 stating that the subject matter of the divisional application did not meet the requirements of Article 76(1) EPC, *inter alia* since the method claims of the application had "not been disclosed in the parent application". The Search Division thus concluded (as per the statement at the top of the declaration under Rule 63 EPC) that the application did "not comply with the provisions of the EPC to such an extent that it (was) not possible to carry out a meaningful search into the state of the art on the basis of all claims."

The following was also stated in the last paragraph of the declaration:

"The applicant's attention is drawn to the fact that a search may be carried out during examination following a declaration of no search under Rule 63 EPC, should the problems which led to the declaration being issued be overcome (see EPC Guideline C-VI, 8.2)."

- III. A communication dated 23 November 2009 was issued by the Receiving Section of the EPO pursuant to Rule 70(2) EPC inviting the applicant to indicate whether it

wished to proceed further with the application. The time limit for the applicant to provide said indication was six months from the stated publication date of the application, namely 18 November 2009.

- IV. In a letter dated 1 December 2009 which was headed "In consideration of the Official Communication dated October 16, 2009", the applicant filed amended claims and requested that the European Search be carried out "in consideration of the respective regulation under EPC".
- V. A communication pursuant to Article 94(3) EPC dated 8 March 2010 was then issued by the EPO, stating that examination was being carried out on the claims filed with letter of 1 December 2009, whereby the requirement of Article 76(1) EPC was not met since the subject-matter of the divisional application extended beyond the content of the earlier application as filed. Objections were raised in this respect against device claims 1 to 3 and method claims 9 and 10.
- VI. The applicant filed a submission dated 26 March 2010 declaring that "in accordance with Rule 70(2) EPC", the application should be further prosecuted.
- VII. With its letter of 17 May 2010, the applicant also filed a response to the communication of 8 March 2010 including amended claims. The examining division subsequently issued its decision of 30 July 2010 refusing the application.

- VIII. In its communication of 16 March 2011 sent subsequent to the issue of a summons to oral proceedings, the Board stated *inter alia* that no disclosure could be found in the application as filed for the subject matter of method claims 9 and 10 and that the requirements of Article 76(1) EPC appeared not to be met. Further objections were also made under Article 76(1) EPC with regard to claim 1.
- IX. With its response of 19 April 2011, the appellant filed auxiliary requests including amended sets of claims.
- X. At the oral proceedings of 20 May 2011, the appellant replaced all its requests by the sole request that the decision under appeal be set aside and a patent be granted on the basis of its new request, dated 20 May 2011.
- XI. The claims of the sole request read as follows:
- "1. A four-cycle engine in which an exhaust pipe (7) is connected to an exhaust port of the engine, and catalysts (9, 10) are disposed in and secondary air is introduced into the exhaust pipe (7), characterized in that a first catalyst (9) is arranged in the exhaust pipe (7), a second catalyst (10) is arranged a predetermined space apart from the first catalyst (9) in the exhaust pipe (7) downstream of the first catalyst (9), and secondary air induction pipe (11) for introducing the secondary air is connected to a part of the exhaust pipe (7) between the first and the second catalysts (9, 10) and to a position where the introduced secondary air also acts on the first

catalyst (9) on an upstream side due to exhaust pulsation.

2. A four-cycle engine according to claim 1, characterized in that a muffler (8) surrounding a part of the exhaust pipe (7) is provided, the first catalyst (9) is disposed upstream of the muffler (8), and the second catalyst (10) is disposed inside the muffler (8).

3. A four-cycle engine according to claim 1, characterized in that a muffler (8) surrounding a part of the exhaust pipe (7) is provided, the first catalyst (9) is disposed upstream of the muffler (8), the second catalyst (10) is disposed inside the muffler (8), and the secondary air induction pipe (11) is connected to a part of the exhaust pipe (7) located upstream of the second catalyst (10) and inside the muffler (8)."

XII. The arguments of the appellant may be summarised as follows:

Claims 1 to 3 of the sole request had the same subject matter as claims 2 to 4 of the parent application as filed. The requirements of Article 76(1) EPC were thus met. The same text was found in paragraphs [0013] to [0015] of the divisional application as filed. All the objections of the examining division had thus been overcome. The claims could now be searched.

Reasons for the Decision

1. *Admittance of the new request - Article 13(1) RPBA*

Claims 1 to 3 of the new request are very similar to the product claims which were on file already in the appeal proceedings and on which the Board had already provided a provisional opinion. The new claims also corresponded directly to claims 2 to 4 as originally filed with the parent PCT application PCT/JP2004/007924 (English translation thereof), which claims were directed to a second aspect of the invention therein.

The new request thus not only removed all method claims, but also overcame the other objections of the examining division and the further objections of the Board under Article 76(1) EPC. Also (see below) the amendments did not give rise to any objection under Article 123(2) EPC.

The consideration of this new request was therefore found to be efficient from a procedural point of view.

The Board thus exercised its discretion under Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) and admitted the new request into proceedings.

2. *Article 76(1) EPC / Article 123(2) EPC*

2.1 Independent claim 1 and dependent claims 2 to 3 of the new request are the same as those filed in the parent PCT application as claims 2 to 4, with the exception of the addition of reference numerals thereto and deletion

of the reference to the other independent claim of the PCT application. The subject-matter of the claims thus does not extend beyond the content of the parent application as filed.

The Board thus concludes that the claims of the new request meet the requirement of Article 76(1) EPC.

- 2.2 In the (divisional) application as filed, the description (four lines from the end of page 3) contains the heading "Disclosure of the Invention". Following this, under the heading [0010] "Means for solving the Problems", in paragraphs [0013], [0014] and [0015], the wording of claims 1 to 3 of the new request is reproduced.

Additionally, the subject matter of claim 1 of the new request is found by the Board to be a limitation of the subject matter of claim 1 of the application as filed.

The amendments to the claims (i.e. by replacing the originally filed claims by amended claims 1 to 3) therefore do not result in subject-matter extending beyond the content of the application as filed. Consequently the requirement of Article 123(2) EPC is also met in this regard.

3. *Remittal of the application - Article 111(1) EPC*

- 3.1 The only objections which led to refusal of the application have been overcome and no further objections to the claims under Article 76(1) EPC or Article 123(2) EPC arise.

Since *inter alia* no search has been carried out, the Board, in exercising its discretion, determines that the case should be remitted back to the examining division for further prosecution.

- 3.2 In this regard, it is observed that no search was performed based on the reasoning of the Search Division that a meaningful search could not have been carried out due to objections under Article 76(1) EPC. Without commenting on whether the approach of the Search Division (in reaching its conclusion that a meaningful search could not be carried out) was correct or not, the Board would add that it can see no barrier to searching claims 1 to 3 of the new request. This would also be in line with the statement made in the last paragraph of the "declaration of no search" under Rule 63 EPC (see item II of the Facts and Submissions *supra*), since the problems which led to the "declaration of no search" being issued have been overcome. Likewise, the subject matter not searched has been replaced (cf. Rule 137(5) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for continuation of the examination proceedings.

The Registrar

The Chairman

M. Patin

P. Alting van Geusau