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**Datasheet for the decision
of 30 June 2015**

Case Number: T 1073/11 - 3.2.06

Application Number: 06025959.5

Publication Number: 1803908

IPC: F01N3/28

Language of the proceedings: EN

Title of invention:

Holding seal member for exhaust gas purifying body and method
for manufacturing the holding seal member

Patent Proprietor:

Ibiden Co., Ltd.

Opponent:

3M Innovative Properties Company

Relevant legal provisions:

RPBA Art. 13(1)
EPC Art. 123(2), 84

Keyword:

Late-filed requests - clearly allowable (no)



**Beschwerdekammern
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Chambres de recours**

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Case Number: T 1073/11 - 3.2.06

**D E C I S I O N
of Technical Board of Appeal 3.2.06
of 30 June 2015**

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
3 March 2011 concerning maintenance of the
European Patent No. 1803908 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: G. de Crignis
E. Kossonakou

Summary of Facts and Submissions

- I. By way of its interlocutory decision, the opposition division found that European Patent No. 1 803 908 as amended according to the main request of the patent proprietor met the requirements of the European Patent Convention (EPC).
- II. The appellant (opponent) filed an appeal against this decision and requested revocation of the patent.
- III. With its reply to the appeal, the respondent (patent proprietor) filed a main request and first to fifth auxiliary requests.
- IV. By way of its letter of 30 March 2012, the appellant provided its comments on these requests. In its letter of response dated 1 June 2012, the respondent filed amended sets of claims of the third to fifth auxiliary requests.
- V. In a communication annexed to the summons to oral proceedings, the Board indicated its preliminary view that discussion with regard to the requirements of Article 123(2) EPC and Article 84 EPC would be necessary before proceeding to the issues of novelty and inventive step.
- VI. Following the communication of the Board, the respondent filed an amended main request and amended first to fifth auxiliary requests. Additionally a version A of all requests was announced in which a clarity objection was addressed. Moreover, with regard to an objection concerning lack of disclosure, a version B for auxiliary requests 2 to 5 was announced. With the intention of overcoming another objection

concerning lack of disclosure, versions C and D were submitted for some of the requests.

VII. Oral proceedings were held before the Board on 30 June 2015, during which the respondent replaced all its previous requests with amended requests.

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims according to the main request or the first or second auxiliary requests, all as filed during oral proceedings at 16:20 hrs.

Claim 1 according to the main request reads:

"A method of assembling an exhaust gas purifier, characterized by:
conveying an inorganic fiber sheet (14) impregnated with organic binder to a position under a liquid ejection device (13), in this state the inorganic fiber sheet (14) being positioned in correspondence with a cut-out position (S) so that holding seal members (14a) to be cut out face an ink ejecting position of the liquid ejection device (13), an ink composition (15) then being ejected from an ejection head (13a) onto the surface of the inorganic fiber sheet (14) to perform printing of inner or outer side distinguishing marks on the inorganic fiber sheet (14),
cutting the inorganic fiber sheet (14) so as to obtain a plurality of inorganic fiber holding seal members (14a) each having one of the inner or outer side distinguishing marks printed thereon;

wrapping one of the sheet-like inorganic fiber holding seal members around an exhaust gas purifying body (21) for holding the exhaust gas purifying body (21) and preventing leakage of exhaust gas; wherein an engagement between a tongue holder (14b) and a tongue (14c) of the holding member (14a) is formed, and press-fitting the exhaust gas purifying body (21) around which the holding seal member (14a) is wrapped into a cylindrical metal shell (23)."

Claim 1 of auxiliary request 1 reads:

"A method of assembling an exhaust gas purifier, characterized by:
printing inner or outer side distinguishing marks on an inorganic fiber sheet (14) impregnated with binder, cutting the inorganic fiber sheet (14) so as to obtain a plurality of inorganic fiber holding seal members (14a), each having one of the inner or outer side distinguishing marks printed thereon, wrapping one of the sheet-like inorganic fiber holding seal members around an exhaust gas purifying body (21) for holding the exhaust gas purifying body (21) and preventing leakage of exhaust gas, wherein an engagement between a tongue holder (14b) and a tongue (14c) of the holding seal member (14a) is formed; and press-fitting the exhaust gas purifying body (21) around which the holding seal member (14a) is wrapped into a cylindrical metal shell (23), wherein each holding seal member (14a) is formed as follows:
the inorganic fiber sheet (14) impregnated with binder is first mounted on a conveying table 12, the inorganic fiber sheet 14 is then conveyed to a position under a liquid ejection device (13) (printing position), in this state, the inorganic fiber sheet (14) is

positioned in correspondence with a cut-out position (S) so that the holding seal members (14a) expected to be cut out face the ink ejecting position of the liquid ejection device (13), an ink composition (15) is then ejected from the liquid ejection head (13a) onto the surface of the inorganic fiber sheet (14) to perform printing, which is performed in accordance with the inner or outer side distinguishing mark input to a control device in advance, the control device moves the conveying table (12) in a X direction and controls the ejection of the ink composition (15) from the liquid ejection head (13a), the printing process for the inorganic fiber sheet (14) is controlled in the following manner: printing is performed from the leading holding seal members (14a) in the first, fifth, and ninth rows from an edge (left side with respect to conveying direction X) in the movement direction of the conveying table 12, after the printing process is performed on each of three holding seal members 14a in the first, fifth, and ninth rows, the liquid ejection device 13 is moved in a direction (Y) perpendicular to the conveying direction (X) for an amount corresponding to one row so that the head holding seal members (14a) in the second, sixth, and tenth rows is position immediately under the liquid ejection head (13a), and similar printing is subsequently performed in a repeated manner so that each holding seal member in the inorganic fiber sheet (41) undergoes the printing process."

Claim 1 of auxiliary request 2 differs from claim 1 of the first auxiliary request in that the following feature is added before the wrapping step:

"the inorganic fiber mat (14) being arranged at a cut-out position (S) and then cut using a punching blade to

manufacture a plurality of holding seal members (14a) having a predetermined shape, a tongue (14c) and a tongue holder (14b) for receiving at least one part of the tongue (14c) being formed on opposite ends of each holding seal member (14a), at least part of the tongue (14c) being received in and contacted with the tongue holder 14b when the holding seal member (14a) is wrapped around the exhaust gas purifying body (21), preventing a linear gap extending in the axial direction of the shell (23) from forming, so that leakage of the exhaust gas is prevented, the tolerable circumferential dimension of the exhaust gas purifying body (21) that can be wrapped by the holding seal member 14 increasing by an amount corresponding to the dimension of the tongue 14c and the tongue holder 14b, rims (14d) and the holding seal members (14a) are cut out from each sheet of the inorganic fiber mat (14) with the punching blade, the printing apparatus (11) performing printing on the inorganic fiber mat (14) at a printing position corresponding to the expected cutting position of each holding seal member 14a".

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

None of the requests should be admitted into the proceedings. All objections had already been brought forward with the grounds of appeal and therefore there was no reason to react so late. The Board had been very clear at the start of oral proceedings as to the nature of the objections it saw provisionally remaining in the requests on file. The oral proceedings was not a workshop where the proprietor could argue its case on a number of requests, attempting to fix individual problems with various claims each time the Board concluded that a certain requirement was not met.

The subject-matter of claim 1 of the main request had been amended to refer to a method of assembling an exhaust gas purifier with specific further features. However, concerning the assembling method, the corresponding description referred to a fiber "mat" which was mounted on a conveying table, whereas claim 1 referred generally to "conveying an inorganic fibre sheet" and was not limited to conveying a mat, nor that this was conveyed on a conveying table whereas for the assembling method, such a feature represented an essential (and limiting) feature. Hence, the claimed wording contained subject-matter extending beyond the disclosure as originally filed. The requirement of Article 123(2) EPC was thus not met.

With regard to claim 1 of the first and second auxiliary requests, the wording of this claim included features in brackets such that it was not clear whether these features limited the claim or not. Also, the wording of the claim included further the feature of the ink composition being ejected from the liquid ejection head onto the surface of the inorganic fiber sheet "to perform printing". This feature was not clear in respect of whether it represented a duplication of the printing step referred to earlier, on line 3 of claim 1, or whether it referred to another distinguishing mark being printed which was also possible. At least for these reasons claim 1 lacked clarity (Article 84 EPC).

Additionally, the auxiliary requests were divergent with regard to the main request. For example, the main request identified the binder as being an organic binder whereas in the auxiliary requests the binder was not specified. Also, this matter had already been

pointed out by the Board before the requests had been finalised.

IX. The arguments of the respondent may be summarised as follows:

Although filed during the oral proceedings, the requests should be admitted. Only during the discussion at the oral proceedings could the objections be fully understood in such a way that appropriate amendments could be made. The respondent was merely reacting in a coherent way by overcoming any reason for non-allowance or non-admittance of particular requests which was found to exist.

Claim 1 of the main request included a conveying step. The corresponding wording was based on the method disclosed on page 13, line 7 to 18. Although this wording referred to a fiber mat, it was not necessary to define the fiber sheet in that way because the skilled person understood that a sheet was also a mat. The two terms were used interchangeably. It was also not necessary to refer to the conveying table since this feature was not essential to assembling a gas purifier and thus did not have to be included in the claim.

Claim 1 of auxiliary requests 1 and 2 was limited to the manufacturing operation as set out on page 13, line 4 to page 14, line 15. Claim 1 of auxiliary request 2 further included the feature based on page 9, lines 8 to page 10, line 3, in order to further define the cutting action. The skilled person understood that only one printing step was performed in order to provide the distinguishing marks on the fiber sheet. Hence, there was no ambiguity concerning whether one or two printing

steps were present. It would be clear from the description that only one printing step was used, so that the claim would only be read this way. The method reflected the four assembling steps (printing, cutting, wrapping and press-fitting) which were the only ones which were relevant, and the features in brackets had to be considered in their meaning similar to reference numbers and this was how they were used in the description.

Reasons for the Decision

1. Admittance of the main request

1.1 The current main request was filed during the oral proceedings at 16:20h, hence at a very late stage in the proceedings, after discussion of a series of (replacement) requests on which the Board had concluded that they were either not admissible or not allowable under Article 123(2) EPC (see the minutes of oral proceedings). According to Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA), it lies within the discretion of the Board to admit any amendment to a party's case after it has filed its grounds of appeal or reply. In order to be admitted at such a late stage of proceedings, a request should normally be clearly allowable at least in the sense that it overcomes the objections raised and does not give rise to new objections, which is however the case for claim 1 of the main request as set out below.

1.2 Claim 1 has been amended to include the method step of "conveying an inorganic fiber sheet ... to a position under a liquid ejection device...".

1.3 With regard to the requirement of Article 123(2) EPC, the basis for this amendment was indicated by the respondent as being on page 13, lines 7 to 13. This paragraph starts with the wording: "The inorganic fiber mat 14 impregnated with the binder is first mounted on the conveying table 12. The inorganic fiber mat 14 is then conveyed to a position under the liquid ejection device 13 (printing position)."

Accordingly, this paragraph concerns an operation based upon a mat mounted on a conveying table. Additionally, the movement of conveying is disclosed in relation to the inorganic fiber mat mounted on the table relative to the printer.

1.4 Claim 1 neither specifies a mat (which according to the disclosure on page 5, lines 19 to 21 is to be cut out from a sheet, to be flat and rectangular and as having an even thickness, and thus is evidently not used synonymously with the term "sheet" as had been argued by the respondent) nor a conveying table to which this mat is then affixed. Accordingly, a sheet of any form as well as a conveying belt would also be in the scope of the claim. There is however no basis for such method steps. Thus, by way of the amendment chosen, the subject-matter of claim 1 at least *prima facie* extends beyond the content of the application as filed contrary to the requirement of Article 123(2) EPC.

1.5 Accordingly, at least for this reason, the claim is not clearly allowable and it is not necessary to consider

the further objections made against it. The Board thus exercised its discretion under Article 13(1) RPBA not to admit the main request into the proceedings.

2. *Admittance of auxiliary requests 1 and 2*

2.1 Auxiliary requests 1 and 2 were filed during the oral proceedings. Accordingly, as already set out above (point 1.1), it lies within the discretion of the Board to admit them (Article 13(1) RPBA).

2.2 The wording of claim 1 of both of these requests includes features in brackets ("printing position", "left side with respect to conveying direction X") and it is not clear whether these features limit the respective claim 1 or not. The respondent argued that these features should be considered with a meaning similar to that of reference numbers and that the bracketed expression had been written so in the description. However this argument cannot be accepted, since these features are not simply reference numbers but have a technical meaning which relates to the specific embodiment shown in the Figures. It thus remains unclear whether they are limiting for the subject-matter of the claim and, if so, to what extent. Merely because features are placed within brackets does not mean that they are necessarily limiting; in the present case the features are related to indications of a positional arrangement which leaves their purpose in the claim open to doubt. Indeed, it is precisely due to the fact that the relevant passages have been largely copied from the description and put into the respective claims that the problem arises, since the bracketed expressions are used in the description as part of the disclosure therein being understood in relation to the

Figures which are being explained in that part of the text.

- 2.3 Further, the wording of claim 1 of both requests also includes the feature of the ink composition being ejected from the liquid ejection head onto the surface of the inorganic fiber sheet "to perform printing" at lines 28/29 of claim 1. This feature is not clear in the context of the claim, in terms of whether it represents a duplication of the printing step referred to in line 3 of claim 1 or whether it refers to another distinguishing mark being printed.
- 2.4 The respondent argued that a skilled person would, if in doubt, consult the description and the matter would then be resolved and thus the claim could only be read such that it was the same printing step but merely defined in more detail. However, the Board does not accept this, because the claim should be clear by itself without having to consult the description and establish, whether or not more than one printing step is being referred to (even if this were clearly shown to be the case in the description).
- 2.5 Hence, claim 1 of each of auxiliary requests 1 and 2 at least *prima facie* lacks clarity (Article 84 EPC) such that the Board exercised its discretion under Article 13(1) RPBA not to admit auxiliary requests 1 and 2 into the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated