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**Datasheet for the decision
of 21 March 2017**

Case Number: T 1199/13 - 3.2.06

Application Number: 06821742.1

Publication Number: 1951998

IPC: F01N13/16, F01N13/20

Language of the proceedings: EN

Title of invention:

DISCHARGE EXHAUST MUFFLER TIP FOR VEHICLE ENGINES

Patent Proprietor:

Pbl. di Bonera Gianluigi & C. S.N.C.

Opponent:

Tenneco GmbH

Headword:

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Amendments - added subject-matter (yes) - main request and
auxiliary request

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1199/13 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 21 March 2017

Appellant: Pbl. di Bonera Gianluigi & C. S.N.C.
(Patent Proprietor) Via S. Antonio 74 Fraz. Termine
25065 Lumezzane Pieve (IT)

Representative: Chimini, Francesco
Jacobacci & Partners S.p.A.
Piazza della Vittoria 11
25122 Brescia (IT)

Respondent: Tenneco GmbH
(Opponent) Luitpoldstrasse 83
67480 Edenkoben (DE)

Representative: Thews, Karl
STT Sozietät Thews & Thews
Patentanwälte
Augustaanlage 32
68165 Mannheim (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 14 March 2013
revoking European patent No. 1951998 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. An appeal was filed by the appellant (proprietor) against the decision of the opposition division revoking European Patent No. 1 951 998 in which it found that the subject-matter of claim 1 according to the sole request did not meet the requirement of Article 123(2) EPC.
- II. With its grounds of appeal, the appellant requested that the patent be maintained according to a main request or in the alternative according to a first auxiliary request.
- III. In its letter of response, the respondent (opponent) requested that the appeal be dismissed. It argued *inter alia* that the subject-matter of claim 1 contravened Article 123(2) EPC.
- IV. With letter of 30 June 2014 the appellant refuted the respondent's arguments.
- V. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated that the subject-matter of claim 1 of both the main request and auxiliary request 1 appeared not to meet the requirement of Article 123(2) EPC *inter alia* since the converging and overlapping walls did not unambiguously result in a closed chamber.
- VI. With letter of 16 February 2017 the appellant indicated that it would not attend the scheduled oral proceedings.

- VII. With letter of 7 March 2017 the respondent indicated that it did not intend to be present at the oral proceedings.
- VIII. Oral proceedings were held before the Board on 21 March 2017 in the absence of the appellant as had previously been notified in writing. The respondent however, despite its letter of 7 March 2017, did attend indicating that, with the appellant not having withdrawn its request for oral proceedings, it wished to cover the eventuality of the appellant attending.

Based on its written submissions, the appellant's requests were that the decision under appeal be set aside and the patent be maintained according to a main request or in the alternative according to a first auxiliary request both as filed on 24 July 2013 with its grounds of appeal.

The respondent requested dismissal of the appeal.

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

"Discharge tip for mufflers of vehicle engines, comprising a body substantially in one piece of stainless steel, providing an external wall (12) and an internal wall (13) without discontinuity between them and defining a longitudinal central passage (15) which extends from an inlet (16) to an outlet (17) ends, wherein the external and internal walls (12, 13) of said body join through a fitting area (18) at the outlet end (17) and on the inlet end (16) of the longitudinal passage (15) converge and overlap for a length (19) to form between them a closed annular chamber or hollow space (14);
characterized in that

said length is provided with radial holes (20) for screwing anchoring screws into said holes."

- X. Claim 1 of auxiliary request 1 reads as per the preamble of claim 1 of the main request, with the following features appended after the expression 'characterized in that':

"between fitting area (18) and length (19), said external and internal walls (12, 13) are mutually parallel, an end part of the tip at the outlet end (18) being flared."

- XI. The appellant's arguments may be summarised as follows:

The subject-matter of claim 1 of both the main request and auxiliary request 1 met the requirement of Article 123(2) EPC. Figures 1 and 3 of the patent showed the annular chamber to be closed, as indeed the opposition division found in its decision.

- XII. The respondent's arguments may be summarised as follows:

The subject-matter of claim 1 failed to meet the requirement of Article 123(2) EPC. It could not be directly and unambiguously derived from the application as filed, not even from the Figures, that the annular chamber was closed. The walls converging and overlapping did not imply that they formed a closed annular chamber since, for example, the presence of an expansion gap was possible.

Reasons for the Decision

The respondent did not present any new argument during oral proceedings such that the decision is based solely on facts and arguments already on file in the written submissions.

1. *Main request*

1.1 *Article 123(2) EPC*

The subject-matter of claim 1 does not meet the requirement of Article 123(2) EPC.

1.1.1 Claim 1 includes the feature that the external and internal walls 'converge and overlap for a length to form between them a closed annular chamber or hollow chamber'. That the annular chamber is 'closed' is not directly and unambiguously derivable from the application as filed.

1.1.2 As correctly identified in the opposition division's decision (see page 4, paragraph 4), the closed nature of the annular chamber is not explicitly disclosed in the application as filed. The Board however finds, contrary to the opposition division, that Figures 1 and 3 fail to directly and unambiguously disclose the annular chamber to be closed; nothing is mentioned in the description regarding the claimed annular chamber being closed, nor can the skilled person derive as much from the Figures of the application as filed since these fail to detail any features which would enable such a conclusion to be drawn. As also argued by the respondent, merely because the external and internal walls converge and overlap does not mean that the

annular chamber formed between them is closed.

1.1.3 The appellant's sole argument in defence of the feature 'closed' annular chamber was with reference, in its letter of 30 June 2014, to paragraphs 4 and 5 of the opposition division's decision. However, as found in 1.1.2 above, the Figures of the application fail to provide a direct and unambiguous basis for the annular chamber being closed.

1.1.4 It is further noted that, in its preliminary opinion (Item 2.1.1), the Board specifically identified the closed nature of the annular chamber as lacking an unambiguous basis in the application as filed. To this preliminary opinion the appellant provided no counter-arguments. The Board thus sees no reason to amend its preliminary opinion in this respect and confirms the same herewith.

1.1.5 The subject-matter of claim 1 thus contravenes Article 123(2) EPC. The main request is therefore not allowable.

2. *Auxiliary request 1*

2.1 *Article 123(2) EPC*

2.1.1 Claim 1 of this request (similarly to claim 1 of the main request) includes the feature found to lack a direct and unambiguous basis in the application as filed, specifically that the external and internal walls 'converge and overlap for a length to form between them a closed annular chamber or hollow space'. In its preliminary opinion (item 4.1) the Board specifically identified that the objection to this feature in the main request applied also to claim 1 of

auxiliary request 1. To this objection in the preliminary opinion the appellant has again provided no counter-argument. The Board thus sees no reason to amend its preliminary opinion in this respect.

2.1.2 The subject-matter of claim 1 thus contravenes Article 123(2) EPC. Auxiliary request 1 is therefore not allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated