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**Datasheet for the decision
of 11 June 2018**

Case Number: T 2361/15 - 3.2.05

Application Number: 10008169.4

Publication Number: 2284422

IPC: F16J1/09

Language of the proceedings: EN

Title of invention:

Piston for engine having stable behavior of piston ring

Patent Proprietor:

Doosan Infracore Co., Ltd.

Opponent:

MAHLE International GmbH

Relevant legal provisions:

EPC Art. 110

EPC R. 101(1)

RPBA Art. 12(4), 13(1), 13(3)

Keyword:

Admissibility of the appeal - yes

Admittance of a new alleged public prior use in appeal - no

Admittance of amendments to the appellant's case after it has
filed its grounds of appeal - no



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Case Number: T 2361/15 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 11 June 2018

Appellant: MAHLE International GmbH
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Decision under appeal: **Decision of the opposition division of the
European Patent Office posted on 23 October 2015
rejecting the opposition filed against European
patent No. 2284422 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman	P. Lanz
Members:	H. Schram
	J. Geschwind

Summary of Facts and Submissions

- I. On 17 December 2015 the appellant (opponent) lodged an appeal against the decision of the opposition division, posted on 23 October 2015, by which its opposition against European patent No. 2 284 422 was rejected. The statement of grounds was received on 25 February 2016.

The opposition had been filed against the patent as a whole on the basis of Article 100(a) EPC (lack of novelty, Article 54 EPC, lack of inventive step, Article 56 EPC) and Article 100(b) EPC (insufficiency of disclosure, Article 83 EPC).

- II. The appeal was solely based on an alleged public prior use by the appellant itself filed for the first time with the statement of grounds.

As evidence for the alleged public prior use the following documents were filed by the appellant to corroborate its allegation that the subject-matter of claim 1 as granted lacked novelty with respect to the alleged public prior use:

E4: Drawing No. 3010-20000716-063 of Mahle GmbH, version No. 02 / 087893 / 14.02.05, Casting or raw product No. 131MT005+1B01;

E5: Printout of 68 deliveries of Material "0499852200" designated "131MT005+1B01 20000716-063 Kol-nackt" to customer "Volvo Powertrain Sweden AB" in the period from 1 March 2005 to 20 February 2006.

- III. In a communication dated 6 March 2018 pursuant to Article 15(1) of the Rules of Procedure of the Boards

of Appeal (RPBA) annexed to the summons to attend oral proceedings, the board stated the following:

"6. Admittance of documents E4 and E5

6.1 It lies in the discretion of the board to refuse facts, evidence or requests which are presented for the first time in appeal or were not admitted in the first instance proceedings and which would therefore constitute a fresh case, cf Article 12(4) Rules of Procedure of the Boards of Appeal (RPBA).

6.2 The boards have set strict standards for the admissibility of late-filed evidence of public prior use by the opponent itself, with no good reason given for the delay (see Case Law of the Boards of Appeal of the EPO, 8th edition 2016, IV.C.1.3.17, pages 955 to 957).

In the present case the appellant filed document E4 concerning Drawing No. 3010-20000716-063 of Mahle GmbH and document E5 concerning deliveries of material "0499852200" to a customer in the period from 1 March 2005 to 20 February 2006. The appellant gave no reasons why these documents were not filed earlier, that is with the notice of opposition, since it appears undisputed that these documents were available to the appellant when the opposition was filed.

The board is therefore currently not inclined to admit the documents E4 and E5 into the appeal proceedings (cf Article 12(4) RPBA), irrespective of its potential relevance.

7. It would thus seem that the appeal is likely to be dismissed.”

The board further stated (see point 5 of said communication) that the fact that the appellant decided to make its case on the basis of a new alleged public prior use was not per se an issue of admissibility of the appeal, but rather an issue of allowability of the appeal and that the appeal of the appellant appeared to be admissible, cf Rule 101(1) EPC.

- IV. In a letter dated 7 May 2018 in response to the communication of the board, the appellant gave reasons why the alleged public prior use was not filed within the time limit for filing the opposition and requested - in case the board would not admit said prior use into the proceedings - that the patent be revoked on the ground of lack of inventive step with respect to prior art documents DE 10 2007 057840 (E1) and DE 2 026 272 (E2) cited in the opposition proceedings.
- V. Oral proceedings were held before the board of appeal on 11 June 2018.
- VI. The appellant requested that the decision under appeal be set aside and that the patent be revoked in its entirety.

The respondent (patent proprietor) requested that the appeal be rejected as inadmissible or be dismissed (main request), or alternatively that the decision under appeal be set aside and that the patent be maintained upon the basis of any one of the auxiliary requests 1 to 4, filed under cover of a letter dated 12 July 2016.

VII. Claim 1 of the main request (claim 1 as granted) reads as follows:

"A piston for an engine having a stable behavior of a piston ring, the piston comprising:

an upper ring(102), a middle ring(112), and an oil ring(122), which are provided at an outer circumferential portion; and

a ring-shaped groove(140) formed between the upper ring(102) and the middle ring(112), characterized in that the ring-shaped groove(140) has a deep portion which has a concave shape so as to oil staying in the ring-shaped groove(140) to be uniformly smoothly flowed, a first gap(145a) having a shape of a straight line is formed between a liner(150) of a cylinder and an area from the ring-shaped groove(140) to the middle ring(112), and the first gap(145a) is larger than a gap between the liner(150) of the cylinder and an area from a portion provided with the upper ring(102) to the ring-shaped groove(140), and

a second gap(145b) having a shape of a straight line is further formed from the middle ring(112) to the oil ring(122), and the second gap(145b) is larger than the gap between the liner(150) of the cylinder and the area from the portion provided with the upper ring(102) to the ring-shaped groove(140)."

VIII. The arguments of the appellant, in writing and during the oral proceedings, can be summarized as follows:

Admissibility of the appeal and admittance of the documents filed as evidence of the alleged prior use

The statement setting out the grounds of appeal indicated the reasons for setting aside the decision impugned as follows. After filing the notice of appeal,

the appellant had found a novelty destroying public prior use of a piston. The prior use piston shown in document E4, a technical drawing of the appellant, was delivered before 12 August 2009, the earliest priority date of the patent in suit, to the customer Volvo Powertrain Sweden AB and showed all the features F1.0 to F1.7 of the granted claim 1 of the patent in suit (see the denotation of the features in Summary of Facts and Submissions, point 11, of the decision under appeal). Document E5 was a printout of 68 deliveries to said customer, showing that the deliveries were made in the period from 1 March 2005 to 20 February 2006.

For the accordance of the data of document E5 with the relevant electronically stored data of the appellant, as well as for the correctness of the comments to document E5, Mr. Luca Rederer was named as a witness. For the veracity of the previously presented facts and for the fact that all deliveries mentioned in document E5 took place under no confidentiality agreement, Mr Gerhard Berr was named as a witness.

The respondent wrongly asserted that the appeal was inadmissible, merely on the ground that it was solely based on a new public prior use that was not subject of the preceding opposition proceedings. Although the board may exercise its discretion under Article 12(4) RPBA "to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings", this did not automatically imply that the appeal was inadmissible.

Reasons for the late submission of the public prior use

The new objection of lack of novelty on account of a public prior use was introduced for the first time in

the appeal proceedings, since the notice of opposition had been drafted under time pressure and the prior art documents filed with the notice of opposition were regarded as sufficiently powerful. The issue of prior public use came up only when – against all expectations – novelty and inventive step of the claimed subject-matter in the patent in suit were acknowledged with respect to the cited prior art documents.

During the opposition proceedings it was initially thought that the public prior use was hard to prove, because the delivery and sales data were typically kept only seven years and then deleted. The technical drawing E4 dated back to 2005, so it was assumed that said drawing was destroyed in the year 2012. When preparing the opposition in 2013 it was therefore assumed that in-house data regarding deliveries of the piston were no longer available. Only when the decision of the opposition division was issued, which was negative for the appellant, the public prior use was examined again. It was found that the sales records in accordance with document E5 had not been deleted and that the public prior use could be claimed. This was done promptly with the grounds of appeal. Document E5 showed that in total 59.470 pistons had been delivered to Volvo Powertrain Sweden AB in the period from 1 March 2005 to 20 February 2006. This large number proved that said pistons were used in engines for the serial-production of trucks.

It followed not only that the appeal was admissible but also that the alleged prior use was highly relevant, in the sense that it destroyed the novelty of claim 1 of the main request, and should therefore be admitted in the appeal proceedings.

Admittance of submissions regarding lack of inventive step after oral proceedings have been arranged

Since the board indicated in its communication of 6 March 2018 that it did not intend to consider the documents E4 and E5, the ground for opposition under Article 100(a) EPC in combination with Article 56 EPC (lack of inventive step) before the opposition division was reconsidered. It was found that the reasons given in the decision under appeal for finding that the subject-matter of claim 1 involved an inventive step (see pages 6 to 8) were wrong.

IX. The arguments of the respondent, in writing and during the oral proceedings, can be summarized as follows:

Non-admissibility of the appeal and admittance of the documents filed as evidence of the alleged prior use

According to Article 12(2) RPBA, the statement of grounds of appeal shall contain the appellant's complete case. They shall set out clearly and concisely the reasons why it was requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on. The statement of grounds of appeal filed by the appellant did not comply with this requirement. The mere offer of a witness's statement could not be considered to be sufficient in this regard.

Furthermore, Article 12(4) RPBA provided that the board could hold inadmissible facts, evidence and requests which could have been presented in the first-instance proceedings.

Neither in the notice of appeal nor in the statement of grounds, the appellant explicitly disputed any

reasoning of the first instance decision, but exclusively challenged the decision under appeal - for the first time - on the basis of an alleged novelty destroying public prior use. The grounds of appeal were therefore solely based on a new public prior use which had not been part of the first instance proceedings.

It was established case law of the Boards of Appeal of the EPO that the statement of grounds should specify the legal or factual reasons on which the case for setting aside the decision was based. The statement of grounds, however, did not contain such reasons.

The new facts and arguments were submitted too late, had not sufficiently been substantiated and were not "prima facie" relevant, and should therefore not be admitted. Moreover, the appellant failed to provide any explanation for the late filing of the new facts. In cases where all evidence in support of an alleged public prior use lies within the power and knowledge of the appellant, the facts and arguments supplied by the appellant had to be "beyond reasonable doubt", which criterion was not fulfilled in the present case.

The appellant provided for the first time two new documents E4 and E5. These documents had apparently never been published. The appellant also offered testimonies by two employees of the appellant to confirm the authenticity and content of these documents. However, the appellant did not provide sufficient details as to the competence of the witnesses and the potential testimonies with respect to the public use. Document E4 failed to show all the features of claim 1 as granted, in particular the second gap, which was formed from the middle ring to the oil ring, having a straight line. It also remained

totally unclear whether the piston shown in document E4 has actually been used publicly in combination with any rings. Document E5 referred to "Kol-nackt" (nacked piston) implying that the pistons did not have upper rings, middle rings and/or oil rings.

In summary, documents E4 and E5 were filed too late, and these documents as well as the offered testimonies failed to sufficiently substantiate the alleged novelty destroying prior public use. Since no further reasons were indicated in the grounds of appeal, the appeal was not admissible and/or was to be dismissed and the documents E4 and E5 filed as evidence of the alleged prior use should not be admitted.

Admittance of submissions regarding lack of inventive step after oral proceedings have been arranged

The submissions of the appellant with respect to lack of inventive step filed with letter of 7 May 2018 should have been filed with the statement of grounds. These late-filed submissions should not be admitted into the appeal proceedings.

Reasons for the Decision

1. *Admissibility of the appeal, Article 110 and Rule 101(1) EPC*
- 1.1 Rule 101(1) EPC ("Rejection of the appeal as inadmissible") stipulates that "If the appeal does not comply with Articles 106 to 108, Rule 97 or Rule 99, paragraph 1(b) or (c) or paragraph 2, the Board of Appeal shall reject it as inadmissible, unless any

deficiency has been remedied before the relevant period under Article 108 has expired”.

Since the appeal concerns a decision of the opposition division (cf Article 106(1) EPC), is filed within the time limit specified in Article 108 EPC, first and second sentence, and since the time limit for filing the statement of grounds appeal specified in Article 108 EPC, third sentence, is also met, the appeal complies with Articles 106 and 108 EPC.

Under Article 107 EPC, any party to proceedings adversely affected by a decision may appeal. A party is adversely affected if the decision does not accede to its main request or to auxiliary requests preceding the allowed auxiliary request. In the present case the appellant's main request in the opposition proceedings was that the patent be revoked. The appellant was thus adversely affected by the decision under appeal, by which its opposition against European patent No. 2 284 422 was rejected.

- 1.2 The notice of appeal contains the name and the address of the appellant (cf Rule 99(1)(a) EPC), an indication of the decision impugned (cf Rule 99(1)(b) EPC), and a request defining the subject of the appeal (cf Rule 99(1)(c) EPC).
- 1.3 Rule 99(2) EPC provides that “In the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based”.

The appeal of the appellant is solely based on an alleged public prior use filed for the first time with its statement of grounds.

In the present case the statement of grounds admittedly does not address the reasons given in the contested decision for rejecting the opposition, since the appellant has introduced a fresh case concerning the same ground for opposition (Article 100(a) EPC in combination with Article 54 EPC).

The respondent has submitted that according to the case law of the Boards of Appeal the statement of grounds should specify the legal or factual reasons on which the case for setting aside the decision was based and that the statement of grounds of the appellant did not contain such reasons, thereby suggesting that the statement of grounds contravenes the requirements of Rule 99(2) EPC.

Bringing a fresh case in appeal does not automatically imply that the statement of grounds does not "indicate the reasons for setting aside the decision impugned". It is a sufficient condition that the statement of grounds of appeal enables the board to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases its arguments.

In the judgment of the board, the statement of grounds meets this condition.

It follows that the statement of grounds of the appellant meets the requirements of Rule 99(2) EPC.

1.4 The appeal of the appellant is therefore admissible, cf Rule 101(1) EPC.

2. *Admittance of documents E4 and E5 relating to the alleged public prior use*

2.1 It lies in the discretion of the board to refuse facts, evidence or requests which are presented for the first time in appeal or were not admitted in the first instance proceedings and which would therefore constitute a fresh case, cf Article 12(4) RPBA.

2.2 The boards have set strict standards for the admissibility of late-filed evidence of public prior use by the opponent itself, see Case Law of the Boards of Appeal of the EPO, 8th edition 2016, IV.C.1.3.17, page 955ff.

The present appeal is solely based on an alleged public prior use filed for the first time in appeal. The evidence of the alleged public prior use, documents E4 and E5, were filed with the statements of grounds of appeal on 25 February 2016, ie outside the time limit for filing the notice of opposition. Said documents are thus late-filed.

The alleged public prior use concerns a prior use by the appellant itself. In addition to searching for prior art in patent literature, fairness and the duty of procedural economy demand also conducting an in-house search within the opposition period. The reasons given by the appellant for not conducting an in-house search within the opposition period, namely time pressure in drafting the notice of opposition, assuming that the prior art documents found filed were sufficiently relevant to have the patent revoked, assuming that document E4 had been deleted in the year 2012, could not convince the board that it was not

possible to conduct an in-house search within the opposition period.

Taking into account that documents E4 and E5 concern an alleged public prior use by the appellant itself, lead the board to the finding that these documents could (and should) have been presented in the first instance proceedings.

2.3 The documents E4 and E5 are hence not admitted into the appeal proceedings (cf Article 12(4) RPBA), irrespective of their potential relevance. This also applies to the submissions of the appellant relating to the alleged public prior use.

3. *Admittance of the submissions of the appellant with respect to lack of inventive step*

3.1 With letter dated 7 May 2018, ie more than two years after it had filed its grounds of appeal and about a month before the oral proceedings before the board, the appellant filed for the first time in appeal submissions with respect to the ground for opposition of lack of inventive step under Article 100(a) EPC in conjunction with Article 56 EPC, in particular in view of a combination of documents E1 and E2.

Since the opposition was *inter alia* rejected on the ground that the subject-matter of claim 1 as granted involved an inventive step with regard to documents E1 and E2, it is not apparent why this issue was not taken up in the statement setting out the of grounds of appeal. In fact, Article 12(2) RPBA stipulates that the statement of grounds of appeal shall contain the appellant's complete case.

3.2 The inventive step objection based on documents E1 and E2 must thus be regarded as an amendment to the appellant's case within the meaning of Article 13(1) RPBA. According to this Article, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the board's discretion. However, according to Article 13(3) RPBA amendments to a party's case shall not be admitted after oral proceedings have been arranged if they raise issues which the board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings (emphasis added).

3.3 In the case at hand, the submissions of the appellant with respect to a lack of inventive step were put forward at a late stage of the appeal proceedings and shift the focus to facts not previously mentioned in these proceedings. Under the present circumstances, fairness and economy of the procedure speak against the admission of the new submissions. Contrary to the appellant's view, they cannot be justified as a legitimate reaction to the board's communication since the late filing of documents E4 and E5 was already criticised in the respondent's reply to the appeal.

Moreover, the amendments to the appellant's case after oral proceedings had been arranged raise issues which the board and the respondent cannot reasonably be expected to deal with without adjournment of the oral proceedings.

3.4 The submissions of the appellant with respect to lack of inventive step in view of documents E1 and E2 are therefore not admitted into the appeal proceedings, cf Article 13(1) and (3) RPBA.

4. Since neither the documents relating to the alleged public prior use nor the submissions of the appellant with respect to lack of inventive step were admitted, it follows therefore that the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



S. Fabiani

P. Lanz

Decision electronically authenticated