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**Datasheet for the decision
of 22 October 2020**

Case Number: T 0456/17 - 3.2.05

Application Number: 11151960.9

Publication Number: 2361756

IPC: B29D30/06, B29C33/20

Language of the proceedings: EN

Title of invention:

Tire vulcanizer

Patent Proprietor:

Kabushiki Kaisha Kobe Seiko Sho (Kobe Steel, Ltd.)

Opponent:

Harburg-Freudenberger Maschinenbau GmbH

Relevant legal provisions:

EPC Art. 108

EPC R. 99(2), 101(1)

Keyword:

Admissibility of appeal - appeal sufficiently substantiated
(no)

Decisions cited:

T 0220/83, T 0950/99, T 2532/11, T 0767/14



Beschwerdekammern

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Case Number: T 0456/17 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 22 October 2020

Appellant: Harburg-Freudenberger Maschinenbau GmbH
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Respondent: Kabushiki Kaisha Kobe Seiko Sho (Kobe Steel,
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 13 January 2017
rejecting the opposition filed against European
patent No. 2361756 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman P. Lanz
Members: T. Karamanli
O. Randl

Summary of Facts and Submissions

I. The appeal is against the decision of the opposition division posted on 13 January 2017 rejecting the opposition against European patent No. 2 361 756 in accordance with Article 101(2) EPC.

II. Claim 1 of the granted patent reads as follows (the feature references used by the opposition division are given in square brackets):

"1. [a] A tire vulcanizer (1) comprising:
[b] a top mold (11) and a bottom mold (12) for receiving a raw tire (T) horizontally;
[c] a top mold mounting member (20) which retains said top mold (11);
[d] a bottom mold mounting member (30) which retains said bottom mold (12);
[e] a guiding mechanism (40) which guides said top mold mounting member (20) in a vertical direction;
[f] an opening and closing mechanism (50) which moves up and down said top mold mounting member (20) along the vertical direction, and causes said top mold (11) and said bottom mold (12) to be opened and closed by up and down movement of said top mold mounting member (20);
[g] a locking mechanism (60) which secures said top mold (11) and said bottom mold (12) in a closed condition; and a squeezing mechanism (37) which exerts a clamping force between said top mold (11) and said bottom mold (12), wherein
[h] said guiding mechanism (40), said locking mechanism (60), and said opening and closing mechanism (50) are installed separately from each other; and
[i] said locking mechanism (60) comprises:

[j] tie rods (25) disposed alongside said top mold (11), and each having a top end part fixed to said top mold mounting member (20) and a lower end part;
[k] through holes (32a) formed in said bottom mold mounting member (30) for allowing each of said tie rods (25) to pass through each of said through holes (32a);
[l] lock plates (73a, 73b) capable of engaging and disengaging, along a horizontal direction, with a groove (25a) on each tie rod (25) having passed through each through hole (32a), and
[m] lock plate shifting mechanisms (70) each opening and closing said lock plates (73a, 73b) only in the horizontal direction relative to each tie rod (25), characterized in that
[n] said locking mechanism (60) and said squeezing mechanism (37) are installed separately from each other,
[o] that a plurality of grooves (25a) are formed one above the other in the vertical direction on the lower end parts of the tie rods (25), and
[p] that the top mold mounting member (20) is guided by a single guide mechanism (40) and movable by a single opening and closing mechanism (50)."

III. The documents cited in the decision under appeal included the following:

D1: DE 198 17 822 A1
D11: EP 0 459 375 A2
D12: EP 0 529 331 A1

IV. The reasons for the decision under appeal may be summarised as follows:

None of the grounds for opposition under Article 100 EPC prejudiced the maintenance of the granted patent.

The ground for opposition under Article 100(b) EPC had not been validly raised during the opposition proceedings because it had not been substantiated (see point 2 of the reasons for the decision under appeal). Regarding the ground for opposition of lack of novelty (Article 100(a) in combination with Articles 52(1) and 54 EPC), the opposition division found that the subject-matter of granted claim 1 was novel over the disclosure of document D1 since this document did not disclose features h and p of granted claim 1 (see point 3.1 of the reasons for the decision under appeal). With respect to the ground for opposition of lack of inventive step (Article 100(a) in combination with Articles 52(1) and 56 EPC), document D1 in combination with document D4 did not render the subject-matter of granted claim 1 obvious (see point 4.1 of the reasons for the decision under appeal).

Documents D11 and D12 were not admitted into the proceedings in accordance with Article 114(2) EPC because these late-filed documents were considered not to be *prima facie* relevant (see points 3.2 and 4.2 of the reasons for the decision under appeal).

Regarding the alleged public prior use of a tyre vulcanizer during the trade fair "Tire Tech" in 2009 (referred to as "D13"), the opposition division reached the conclusion that the alleged public prior use had been submitted late (one month before the date of the oral proceedings) and had not been sufficiently substantiated (see point 3.3 of the reasons for the decision under appeal). In particular, it was considered impossible to derive from the opponent's submissions where, how and by whom the alleged prior use had been made public. It was also not clear from the alleged circumstances of the prior use what exactly

had been presented (machines or documents) and no information had been given as to the exact date and location of the alleged public prior use. Further, no details had been provided as to whom and under what circumstances the documents and/or machine(s) had been presented. The opposition division also noted that the hearing of a witness could not remedy this incomplete substantiation, witnesses being meant to serve for the corroboration of facts brought forward, not for supplying these facts in place of the opponent.

- V. On 20 February 2017, the opponent (appellant) filed notice of appeal and paid the prescribed appeal fee.
- VI. With its statement of grounds of appeal dated 17 May 2017 and received at the EPO on the same day, the appellant re-filed a copy of document D11 and filed the following documents related to an alleged public prior use in September 2005:

E1: copies of extracts from a machine manual of the opponent's tyre press KHP with reference signs

E2: three concordance lists

E3: a copy of a photograph of an event

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

- VII. The statement of grounds of appeal contained submissions only on the appellant's objections of lack of novelty and lack of inventive step, i.e. the grounds for opposition under Article 100(a) in combination with Articles 54(1) and 56 EPC. The content of the grounds of appeal may be summarised as follows:

(a) Alleged public prior uses

The appellant alleged that, as already submitted in its notice of opposition, the appellant's tyre press KHP Si 52-180 (70/825 00227) had been presented to the public at the appellant's premises on 8 and 9 September 2005, and that various customers, local politicians, employees with their families, friends, neighbours and acquaintances allegedly had unrestricted access to this presentation. The appellant argued that all the features of granted claim 1 and of all granted dependent claims with the exception of the additional features of claim 5 had been made publicly available at this presentation. As evidence, copies of extracts from a machine manual with reference signs (document E1) and a photograph of the public present at the alleged event (document E3) were submitted, and the hearing of a witness was offered.

The appellant further alleged that, after the event, a CD with various video recordings was distributed to various employees, customers and other visitors and that several video sequences show the public at the presentation and the technical details of the tyre press KHP and various other machines. The appellant offered to submit a copy of the CD or to present the CD during oral proceedings, also as evidence for the public availability of the alleged prior presentation.

(b) Novelty

The appellant considered both the documents regarding the tyre press KHP filed in support of the alleged prior public use and document D11 to be highly relevant. It was admitted that none of them disclosed all the features of granted claim 1 but that the

missing features resulted directly from the skilled person's "elementary basic knowledge". The appellant further submitted that, as a consequence, the subject-matter of claim 1 lacked novelty in view of the skilled person's implicit knowledge.

In addition, document D1 was said to "disprove" the novelty of the subject-matter of claim 1 in combination with the skilled person's common general knowledge. In this context, only general reference was made to the appellant's submissions on the relevance and technical content of document D1 that had been presented in the first-instance proceedings.

(c) Inventive step

The appellant argued that in any case the subject-matter of granted claim 1 was rendered obvious by a combination of the documents filed with respect to the allegedly prior used tyre press KHP and the teaching of document D11. As all these documents belonged to the same narrow technical field of tyre presses, the skilled person would combine them. Depending on whether the documents regarding the tyre press KHP or document D11 were chosen as starting point, the skilled person would supplement the missing features from the other document.

The subject-matter of claim 1 was also said to lack inventive step over a combination of document D1 with the documents regarding the tyre press KHP or document D11.

VIII. By its reply dated 13 October 2017, the patent proprietor (respondent) requested, inter alia, that the appeal be rejected as inadmissible. It referred to

decision T 2532/11 and argued that the present appeal was inadmissible because the appellant's statement of grounds of appeal did not contain any reference to the impugned decision, let alone any explanation as to why the decision was wrong and should be set aside.

IX. On 18 November 2019, the board issued a summons to oral proceedings. In a communication under Article 15(1) of the revised Rules of Procedure of the Boards of Appeal, (RPBA 2020, OJ EPO 2019, A63) dated 30 July 2020, the board gave the provisional opinion that all the objections raised in the statement of grounds of appeal seemed to be unsubstantiated and therefore, the appeal appeared to be inadmissible.

X. With its reply dated 22 September 2020, the appellant filed new documents in support of the alleged public prior use in September 2005 and it submitted reasons why, also on the basis of these new documents, the alleged public prior use was novelty-destroying for the subject-matter of claim 1 of the granted patent or of the respondent's auxiliary requests 1 and 2, or at least rendering this subject-matter obvious in view of a combination of the disclosures of the alleged prior use and documents D1 and/or D12.

XI. The board held oral proceedings on 22 October 2020.

Only the admissibility of the appeal was discussed.

(a) The appellant essentially argued as follows.

The appeal was admissible because the grounds of appeal were sufficiently substantiated. In the statement setting out the grounds of appeal, the appellant had dealt with all the grounds of the

contested decision that were essential for the appeal.

In particular, the public availability of the machine presented at the event on 8 and 9 September 2005 had been explained. Likewise, the relevance of this public prior use, both in terms of novelty and inventive step.

The substantiation of the technical features had also taken place in the three annexes to the statement of grounds of appeal. In the three attached concordance lists, the assignment of the features from the documents, the obvious prior use and the features of the granted patent had been compiled. In particular, on the basis of the extract from the machine manual of the opponent's tyre press KHP with reference signs and the technical drawings contained therein, a technical detailing of the prior used machine had been carried out. In order to substantiate the public prior use, the technical meaning of features h), n) and p) and the corresponding reference numbers in the patent were mentioned in the two left-hand columns of the relevant concordance list. In the right-hand column it was stated where these features could be found in the corresponding documents filed in support for the public prior use. Regarding feature h), the technical meaning given was "guiding mechanism", as a corresponding separate arrangement should not actually represent a spatially separate arrangement, but also a functionally independent one. Admittedly, nothing had been submitted on this in the statement of grounds of appeal. Nor had it been argued in the grounds of appeal with regard to feature p) that

there was also a single guiding mechanism and a single opening and closing mechanism in the prior used machine. However, it had been argued in the first-instance proceedings that "single" did not mean that it was a unitary component. With respect to features a) to g) of granted claim 1, nothing had been submitted in the grounds of appeal or concordance lists either, but corresponding submissions had been made at first instance.

The statement of grounds of appeal did indeed not substantiate the objection of lack of novelty raised on the basis of document D11. Regarding the objection of lack of novelty raised in the statement of grounds of appeal on the basis of document D1, a concordance table had been filed in the first-instance proceedings by letter dated 26 November 2015.

With respect to the objection of lack of inventive step, the combination of documents D1 and D11 and the combination of the alleged prior use with document D11 had been dealt with in detail.

(b) The respondent essentially argued as follows.

In application of decision T 2532/11, the appeal was inadmissible, as there was no reference whatsoever to the grounds of the contested decision in the statement of grounds of appeal. With regard to the objection of lack of novelty over document D1, there was only a general reference to the appellant's submissions made in the first-instance proceedings. No submissions were made on the appellant's objection of lack of inventive step. There was no substantiation, as all critical points

were only superficially addressed in the statement of grounds of appeal. The concordance lists were incomplete, as they did not, for example, deal with the functional features of granted claim 1.

The party's final requests were:

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

The respondent requested that the appeal be rejected as inadmissible, or that the appeal be dismissed as unallowable, or that the decision under appeal be set aside and the patent be maintained as amended on the basis of the claims of the first or second auxiliary request filed with its reply dated 13 October 2017. The respondent further requested that the case be remitted to the opposition division for further examination on the basis of the claims of the first or second auxiliary request.

At the end of the oral proceedings the chairman announced the board's decision.

Reasons for the Decision

Admissibility of the appeal

1. In the case in hand, the admissibility of the appeal depends on whether the statement setting out the grounds of appeal complies with the requirements of

Article 108, third sentence, EPC and Rule 99(2) EPC.

2. According to Article 108, third sentence, EPC, a statement of grounds of appeal must be filed within four months of notification of the decision in accordance with the Implementing Regulations. Rule 99(2) EPC requires that, in the statement of grounds of appeal, the appellant indicates "*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.*"

If this requirement is not complied with before the expiry of the four-month period for filing the statement of grounds of appeal according to Article 108, third sentence, EPC, the appeal is to be rejected as inadmissible in accordance with Rule 101(1) EPC.

3. According to established case law, the statement of grounds of appeal must specify the legal or factual reasons on which the case for setting aside the decision is based. The arguments have to be clearly and concisely presented to enable the board and the other party to understand immediately why the decision is alleged to be incorrect, and on what facts the appellant based his arguments, without first having to make investigations of their own (see T 220/83, OJ EPO 1986, 249, and "Case Law of the Boards of Appeal of the European Patent Office" (hereinafter "Case Law"), 9th edition, 2019, V.A.2.6.3 d)). The grounds sufficient for the admissibility of an appeal have to be analysed in detail vis-à-vis the main reasons given for the contested decision.

4. In the case in hand, the opponent filed an appeal against the rejection of its opposition. Statements of grounds of appeal filed by opponents are normally considered to meet the requirements of Article 108, third sentence, EPC and Rule 99(2) EPC if it is adequately substantiated why the contested decision is incorrect on one of the rejected objections or grounds for opposition. That is because, if the decision is indeed wrong on that point, the appeal would then have to be allowed for this reason alone (see also, for example, decisions T 950/99, point 1 of the Reasons and T 767/14, point 1.2 of the Reasons).

Therefore, the question of the admissibility of the present appeal hinges on whether or not it is adequately substantiated in the statement of grounds of appeal why the contested decision is incorrect on one of the rejected objections or grounds for opposition.

5. The appellant asserted that document D1 was novelty-destroying for the subject-matter of claim 1. Hence, the statement of grounds of appeal contains a reference to the impugned decision since, with respect to the ground for opposition under Articles 100(a) and 54(1) EPC (lack of novelty), the opposition division reached the conclusion that document D1 did not disclose features h) and p) (see point 3.1.3 of the reasons for the decision under appeal). However, the appellant did not give any reasons or explanations as to why this conclusion should be wrong and thus the contested decision be set aside. In particular, the statement of grounds of appeal is silent on where features h) and p) were believed to be disclosed in document D1. Instead, with respect to document D1, the appellant referred generally to its submissions made at first instance. However, according to established jurisprudence, a

statement of grounds of appeal referring generally to submissions made at first instance, as a rule, cannot be considered sufficient for the purposes of Article 108, third sentence, EPC and Rule 99(2) EPC (see Case Law, V.A.2.6.4a)). Therefore, the appellant's objection of lack of novelty based on document D1 is not substantiated.

6. With respect to document D11, the appellant did not explicitly raise a novelty objection in the statement of grounds of appeal. However, the submissions in the antepenultimate and penultimate paragraph on page 3 can be understood to mean that the appellant considered the subject-matter of granted claim 1 to lack novelty over document D11.

With respect to the ground for opposition under Articles 100(a) and 54(1) EPC (lack of novelty), the opposition division did not admit document D11 into the proceedings because it found this late-filed document not to be *prima facie* relevant for novelty. It gave detailed reasons for this finding (see points 3.2.3, 3.2.4 and 3.2.6 of the reasons for the decision under appeal). In its statement of grounds of appeal, the appellant did not explain why the decision not to admit document D11 was wrong, and in particular where feature h) was disclosed in this document. No reasons were given why the board should set aside the opposition division's decision not to admit document D11 or admit this document into the appeal proceedings. Furthermore, the appellant admitted at the oral proceedings before the board that the statement of grounds of appeal did not substantiate the objection of lack of novelty raised on the basis of document D11. Consequently, the appellant's novelty objection based on document D11 is

also not substantiated.

7. In the penultimate paragraph of its statement of grounds of appeal, the appellant asserted that the content of document D1 in combination with document D11 rendered the claimed subject-matter obvious without giving any further reasons. Hence, the statement of grounds of appeal contains a further reference to the impugned decision since the opposition division dealt with the ground for opposition under Articles 100(a) and 56 EPC (lack of inventive step) based on the combination of the disclosure of documents D1 and D11 (see section 4.2 of the reasons for the decision under appeal). However, the opposition division did not admit document D11 into the proceedings because it found this late-filed document not to be *prima facie* relevant for inventive step. It gave detailed reasons for this finding (see points 4.2.2 and 4.2.3 of the reasons for the decision under appeal). The appellant, however, did not give any reasons or explanations as to why this conclusion should be wrong and thus the contested decision be set aside. In addition, the objection of lack of inventive step raised in the grounds of appeal is based on a mere assertion. This objection is thus not substantiated.
8. For the sake of completeness, the board notes that the alleged public prior use dealt with by the opposition division and found to be insufficiently substantiated concerns a presentation of documents and/or machines at a trade fair in 2009. This alleged public prior use is not referred to in any of the appellant's submissions in the statement of grounds of appeal and, consequently, is not relevant for the admissibility of the present appeal.

9. In view of the above, none of the grounds in the impugned decision was adequately addressed in the statement of grounds of appeal.

10. In its statement of grounds of appeal, the appellant referred to different alleged public prior uses at the appellant's premises in September 2005. Contrary to the appellant's assertion in the second paragraph of the statement of grounds of appeal, none of these alleged prior uses was mentioned in the notice of opposition. The notice of opposition is completely silent on public prior uses. Nor is there any reference in the first-instance proceedings to alleged public prior uses at the appellant's premises in 2005.

11. The objections based on the alleged public prior presentation at the appellant's premises in September 2005 and the subsequent distribution of CDs containing video recordings of this event are therefore based on alleged public prior uses and documents filed as proof, which are entirely new facts and evidence, albeit based on the same grounds for opposition under Articles 100(a) and 54(1) and 56 EPC (lack of novelty and lack of inventive step), already invoked in the first-instance opposition proceedings. It is the consistent case law of the boards of appeal that an appeal is not to be considered inadmissible merely because it is based on facts or evidence submitted for the first time with the grounds for appeal (see Case Law, V.A.2.6.5a) and b)). The board sees no reason to diverge from this well-established approach. In this context, the board notes that decision T 2532/11, cited by the respondent, does not apply to the present case as it dealt with the question whether newly filed requests could be seen as implicit grounds of appeal.

12. In its statement of grounds of appeal, the appellant alleged that the tyre press KHP Si 52-180 (70/825 00227) had been publicly presented but did not comprehensively indicate the features of that press. Nor did the appellant indicate which technical details of the tyre press KHP and various other machines had been allegedly made available by the CD. The appellant's submissions and supporting documents E1 to E3 are not sufficient for immediately understanding what had allegedly been made available to the public during the presentation of the tyre press KHP at the appellant's premises and by subsequently distributing CDs with video recordings of this event. As the appellant itself acknowledged at the oral proceedings, neither the statement of grounds of appeal nor the concordance lists (document E2) refer, for example, to features a) to g) of granted claim 1. Regarding features h) and p), nothing had been submitted in the statement of grounds of appeal on the technical meaning of these features. Nor had it been argued in the grounds of appeal with regard to feature p) that there was also a single guiding mechanism and a single opening and closing mechanism in the prior used machine. The appellant submitted that it had been argued in the first-instance proceedings that "single" did not mean that it was a unitary component. As explained above, submissions made at first instance cannot be taken into account for the admissibility of the appeal. Furthermore, the appellant did not compare these features with those of any of the granted claims or identify the technical parallels between them.

The present case is also not a straightforward one in which the facts are immediately self-evident to the average skilled person. Additionally, it is not the

task of the board or the respondent to determine, on the basis of the concordance lists and the evidence submitted, which features the allegedly prior used tyre press KHP comprised, to compare these features with those of, for example, granted claim 1 and to identify the technical parallels between them.

13. In view of the above, the alleged public prior uses are not sufficiently substantiated in the statement of grounds of appeal. Consequently, all of the appellant's objections against the granted claims which are based on the alleged public prior uses are also not substantiated in the statement of grounds of appeal.

14. In the reply to the board's communication under Article 15(1) RPBA 2020 dated 22 September 2020 and, therefore, after expiry of the four-month period for filing the statement of grounds according to Article 108, third sentence, EPC, the appellant did not argue as to why the statement of grounds of appeal fulfils the requirements of Article 108, third sentence, EPC and Rule 99(2) EPC. Nor did the appellant provide any arguments as to why any of its objections as raised in the statement of grounds of appeal was substantiated and would address the reasons for the decision under appeal. Instead, the appellant filed new documents in support of the public prior uses, which allegedly took place in September 2005, and it submitted reasons why, also on the basis of these new documents, the alleged public prior use was novelty-destroying for the subject-matter of claim 1 of the granted patent or of the respondent's auxiliary requests 1 and 2, or at least rendering this subject-matter obvious in view of a combination of the disclosures of the alleged prior use and documents D1 and/or D12.

15. In view of Article 113(1) EPC, an appellant's arguments as to why the statement of grounds of appeal was not deficient have to be considered by the board even if they are provided after expiry of the period specified in Article 108, third sentence, EPC. However, if a statement of grounds of appeal does not comply with the requirements of Article 108, third sentence, EPC and Rule 99(2) EPC, any deficiency has to be remedied within the period of four months specified in the afore-mentioned article. Therefore, when deciding on the requirements of these provisions the board does not consider new legal and factual reasons as to why the decision under appeal should be set aside if they are filed after expiry of the period specified in Article 108, third sentence, EPC. As a result, the appellant's submissions and the documents filed with the reply dated 22 September 2020 are not relevant for deciding on the admissibility of the present appeal.

16. The same considerations must apply to the appellant's statements made for the first time at the oral proceedings before the board. Therefore, regarding the novelty objection raised in the statement of grounds of appeal on the basis of document D1, the submission that a concordance table had been submitted in the first-instance proceedings by letter dated 26 November 2015 is also not relevant for deciding on the admissibility of the present appeal. With respect to the alleged public prior uses, the new submissions regarding features h) and p) made at the oral proceedings before the board, cannot be considered for the admissibility of the appeal.

17. For the above reasons, the statement of grounds of appeal, filed in the case in hand, does not satisfy the requirements of Article 108, third sentence, EPC and

Rule 99(2) EPC. The appeal is therefore to be rejected as inadmissible in accordance with Rule 101(1) EPC.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated