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**Datasheet for the decision  
of 29 June 2020**

**Case Number:** T 1801/17 - 3.2.04

**Application Number:** 08721880.6

**Publication Number:** 2123897

**IPC:** F02M35/10, F02M35/104

**Language of the proceedings:** EN

**Title of invention:**

INTAKE MANIFOLD FOR MULTI-CYLINDER INTERNAL COMBUSTION ENGINE

**Patent Proprietor:**

Honda Motor Co., Ltd.

**Opponent:**

MANN + HUMMEL GmbH

**Headword:**

**Relevant legal provisions:**

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

EPC Art. 84, 123(2), 104(1)

RPBA 2020 Art. 11

**Keyword:**

Late-filed request - admitted (yes) - request could have been filed in first instance proceedings (no) - justification for late filing (yes)

Claims - clarity (yes) - support in the description (yes)

Amendments - allowable (yes)

Late-filed argument - adjournment of oral proceedings would have been required (yes)

Apportionment of costs - (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 1801/17 - 3.2.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.04**  
**of 29 June 2020**

**Appellant:** Honda Motor Co., Ltd.  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 13 June 2017  
revoking European patent No. 2123897 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** W. Van der Eijk  
**Members:** G. Martin Gonzalez  
C. Kujat

## **Summary of Facts and Submissions**

- I. The appellant-proprietor lodged an appeal, received on 11 August 2017, against the decision of the Opposition Division posted on 13 June 2017 revoking European patent No. 2 123 897 pursuant to Article 101(3)(b) EPC, and simultaneously paid the appeal fee. The statement setting out the grounds of appeal was received on 12 October 2017.
- II. Opposition was filed under Article 100(a) EPC based on lack of inventive step and under Article 123(2) based on added subject-matter.

The Opposition Division held that none of the requests before it fulfilled the requirements of Article 123(2) EPC.

- III. The appellant-proprietor filed with letter of 24 May 2019 the following document:

(D14) Affidavit of M Y. TABATA together with a copy of page 614 of KENKYUSHA'S NEW JAPANESE-ENGLISH DICTIONARY, FOURTH EDITION.

- IV. The appellant-proprietor requests that the decision under appeal be set aside and that the European patent No 2 123 897 be maintained in an amended form on the basis of the main request filed on 17 April 2020, or on the basis of auxiliary requests 1-4 filed on 15 February 2019, auxiliary request 4a filed on 17 April 2020, or auxiliary requests 5-8 filed on 15 February 2019. They further request remittal to the Opposition Division for further prosecution.

The respondent-opponent requests that the appeal be dismissed. In case of remittal, they request apportionment of costs of further oral proceedings before the Opposition Division.

V. Oral proceedings were held on 29 June 2020.

VI. Independent claim 1 of the main request reads as follows:

"An intake manifold, for a multiple-cylinder internal combustion engine, having a collective part (10) defining an intake gas distribution chamber (11) with an intake gas inlet (11i), and a branch intake part (20) having a plurality of branch intake passages (22) respectively for carrying an intake gas to combustion chambers, wherein the collective part (10) is built by joining together first and second sections (A and B) respectively defining first and second spaces (11a and 11b) forming the intake gas distribution chamber (11), the first section (A) is integrally provided with a first corner part (31a) and the second section (B) is integrally provided with a second corner part (31b), characterized in that the second section (B) is provided with a guide wall (40) extending in the first and second sections (A and B) so as to cover an inside surface of the first corner part (31a), the branch intake passages (22) are arranged in an arranging direction in which cylinders of the engine are arranged, the collective part (10) has an intake gas inlet (11i) on one end of the arranging direction, and the guide wall (40) is opposed to the intake gas inlet (11i) in said arranging direction, the guide wall (40) has the shape of a plate curved in a circular-arc-like shape and a guide surface (44) for guiding the intake gas, the guide surface (44)

having a maximum curvature smaller than maximum curvatures of the inside surfaces of the first corner part (31a) and the second corner part (31b), and the guide wall (40) and the first corner part (31a) define therebetween a back space (47) communicating with the intake gas distribution chamber (11) through a gap (46) defined between a free end (43) of the guide wall (40) and an inner surface of a wall (15) of the first section (A) which is a bottom wall of the collective part (10)."

VII. The appellant-proprietor argues as follows:

The present main request is admissible. The lack of clarity objection is not admissible since it should have been raised in first instance. The above notwithstanding, the subject-matter of claim 1 is clear. The new objections of added subject-matter put forward by the respondent-opponent during the oral proceedings before the Board are too late and should not be admitted into the proceedings. The subject-matter of claim 1 of the main request fulfils the requirements of Article 123(2) EPC. The case should be remitted to the Opposition Division for the undiscussed issues of novelty and inventive step.

VIII. The respondent-opponent argues as follows:

The present main request is late filed and should not be admitted. The clarity objection was already submitted during opposition proceedings and thus admissible. Claim 1 of the main request is not clear. The submission of further objections based on added subject-matter during the oral proceedings is justified by the developments of the proceedings and thus also admissible. Claim 1 of the main request contains added

subject-matter and consequently contravenes Article 123(2) EPC. The patent proprietor did not attend the oral proceedings before the Opposition Division. Their attendance would have avoided remittal after appeal. Thus in case of remittal, apportionment of costs of further oral proceedings before the Opposition Division would be appropriate.

### **Reasons for the Decision**

1. The appeal is admissible.

2. Background

The invention is concerned with an intake manifold for a multiple-cylinder internal combustion engine with a collective part or gas distribution chamber and a plurality of intake branches leading to the different combustion chambers of the engine, see specification paragraph [0001]. The shape of the collective part determined from the viewpoint of rigidity and molding manufacturing constraints presents internal corners that prejudice the smooth flow of the intake gas and consequently the volumetric efficiency of the engine, see specification paragraphs [0003]-[0004]. The claimed manifold, having one such corner part, is manufactured in two sections and then built by joining the two sections, wherein the second section is provided with a guide wall extending into the first and second sections so as to cover the inside surface of the corner part for guiding the intake gas more smoothly, see specification paragraph [0006].

3. Main request - Admissibility

The respondent-opponent objects to the admissibility of the main request. This issue hinges also on the admissibility of other previously filed requests as follows.

- 3.1 The appellant-proprietor filed an auxiliary request with the statement of grounds. The later filed auxiliary request 4a on 24 May 2019 was based on that auxiliary request, and was amended only to adapt one term of claim 1 to a corrected translation. With letter of 17 April 2020, the appellant-proprietor made that auxiliary request 4a its main request.

As auxiliary request filed with the statement of grounds, its admissibility is at the discretion of the Board under Article 12(4) RPBA. As auxiliary request 4a of 24 May 2019, filed before oral proceedings had been arranged, its admissibility is at the discretion of the Board under Article 13(1) and 12(4) RPBA 2007. As main request filed on 17 April 2020 after arrangement of oral proceedings, its admissibility is subject to the Board's discretion under Article 13(3) RPBA 2007.

- 3.2 Turning to the auxiliary request filed with the statement of grounds: the Opposition Division found in the impugned decision an unallowable intermediate generalisation in the omission of the feature of original description paragraph [0033] that the guide wall has the shape of a plate curved in the shape of a circular arc, see section 2.3. The Board notes that this objection was first raised by the opponent during the oral proceedings before the Opposition Division. It also formed the basis for revoking the contested



patent, see written decision sections 2.3 and AUXILIARY REQUESTS I-VI. The Board considers the filing of the auxiliary request with the statement of grounds, in which the missing feature was added, as a legitimate response.

The respondent-opponent submits that the patent proprietor might have been able to file this request at the end of the oral proceedings before the Opposition Division, had they attended. It would follow that the proprietor could have presented the request in first instance in the sense of Article 12(4) RPBA 2007 but they did not by choosing not to attend the oral proceedings. The Board however notes that there is no legal obligation to attend the oral proceedings. In the present case, the proprietor dealt with all the outstanding objections during the written proceedings, including filing auxiliary requests aimed at overcoming the added subject-matter ones known at the time. This is a legitimate way of defending oneself against an opposition and does not suggest any intention to avoid a ruling on the matter at first instance. By proceeding in this way the proprietor did not forfeit the right to defend itself in appeal against objections that were only raised during oral proceedings.

Under the above circumstances the Board considers the auxiliary request filed with the statement of grounds to be a normal and legitimate reaction of the losing patent proprietor at their first available opportunity, see CLBA V.A.4.11.3.g), and thus admissible under Article 12(4) RPBA 2007.

3.3 As regards auxiliary request 4a of 24 May 2019, amending the above auxiliary request, the Board notes that the respondent-opponent argued in their reply to the appeal against the translation made by the appellant-proprietor from the original Japanese disclosure in paragraph [0033]. As a response, the appellant-proprietor filed the affidavit D14 of translator M. Y. TABATA together with auxiliary request 4a on 24 May 2019 . The new auxiliary request 4a, as compared to the above auxiliary request filed with the statement of grounds, only adapts claim 1 to the corrected translation. The Board thus regards the amendment to be a normal and legitimate reaction to the development of the proceedings.

The request is also prima-facie allowable. The above mentioned translation issue hinged on whether the guide wall was originally claimed to have the shape of a plate curved in the shape of a circular arc (implying constant curvature) or in a circular-arc-like shape (only requiring resemblance and not the constant curvature of an arc of a circle). In the light of the affidavit D14 filed with the new auxiliary request 4a, it is immediately apparent for the skilled person that the latter is the more accurate and thus correct translation. Indeed, it is made clear by D14, that the original Japanese term "enko-jo" may have the two disputed possible translations: the shape of a circular arc or in a circular-arc-like shape, see in this regard the dictionary entry 2. of -jo as suffix, that can be translated as both "-in the form of" or "-like" and that therefore, as also put forward in section 8 of the affidavit D14, the more appropriate one is to be derived from context. As regards context, original figure 3 shows unambiguously different curvatures along

the depicted arc shape, while there is also otherwise no suggestion of any fixed curvature in the description. In this respect, the respondent-opponent has submitted a drawing (see reply to appeal of 15 February 2018, page 3) intended to show that a circle of fixed radius fits exactly onto the shape of the arc of figure 3. It however rather shows the contrary, that the circle does not fit accurately and that therefore the depicted arc has no constant curvature. The Board thus concludes that the skilled person would be in no doubt that the second translation "in a circular-arc-like shape" is the accurate one. Since the auxiliary request 4a filed on 24 May 2019 only amends claim 1 to put this feature in line with the corrected translation, it is prima facie clear that it successfully addresses the translation issue without giving rise to new ones.

Therefore auxiliary request 4a, filed on 24 May 2019, is regarded by the Board as admissible under Article 13(1) RPBA 2007.

3.4 After summons to oral proceedings, the appellant-proprietor merely made auxiliary request 4a their main request on 17 April 2020, to avoid other issues on file only relevant to the then previous higher ranked requests. Otherwise the request is unamended. It therefore has the effect of simplifying the procedure and does not raise any new issue. The new main request is thus considered admissible also under Article 13(3) RPBA 2007 by the Board.

3.5 In view of the above, the Board decided to admit the main request filed on 17 April 2020 into the appeal proceedings.

4. Main request - Clarity

4.1 The respondent-opponent raises a lack of clarity objection against the added term "bottom wall" of claim 1. They argue that it is a relative term and since there are no defined "up" and "down" directions in the claim it is consequently unclear which wall is the bottom, top or side wall and thus which one is the one defined by this feature.

4.2 The Board notes in this respect that though a relative term may be potentially unclear, its use in a claim may be accepted where the skilled person is able to understand its meaning in a given context, cf. Case Law of the Boards of Appeal, 9th edition 2019 (CLBA), II.A. 3.6 penultimate paragraph and the prior art cited therein.

4.3 In the present case, the skilled person knows from their common general knowledge that the orientation of manifolds of the claimed type in use, dictated by the engine architecture, is generally with the longitudinal axis of the collective part extending about horizontally. Absent an explicit determination of up and down directions in the claim, the skilled person who reads the claim with the intent of making technical sense of all its features, would understand the term "bottom" as referring to the regular and most common orientation of the manifold in use. This orientation is also depicted in figure 3 of the patent specification, and leaves the skilled person in no doubt as to what the bottom wall is, namely the horizontal (in figure 3) lowermost wall of the first section A towards which the guide wall extends; and that is located opposite the top aperture formed by the joining edges to section B.

This understanding is also confirmed by paragraphs [0022], [0031] and [0033] of the disclosure, that refer to figure 3 and explicitly describe the bottom wall as first wall 15 of figure 3 at the lowermost part of section A.

4.4 The Board thus concludes that present claim 1 is both clear and supported by the description in accordance with the provisions of Article 84 EPC.

5. Main request - Added subject-matter

5.1 The respondent-opponent submits that the feature "which is a bottom wall of the collective part" does not overcome the added subject-matter objection discussed in section 2.2. of the written decision. The Opposition Division held in section 2.2. for the then main request that the added feature "a gap (46) defined between a free end (43) of the guide wall (40) and an inner surface of a wall (15) of the first section (A)" introduced originally undisclosed subject-matter inasmuch as it did not precise that the gap was formed at the *bottom* free end of the guide wall (only original disclosure), and not for instance at its *side* free end. The Opposition Division was satisfied that the amendment in auxiliary requests 1 and 2 before it, precisising that the wall of the first section "is a bottom wall of the collective part" (as also does the main request before the Board), overcame this objection, see section AUXILIARY REQUEST I-VI on page 9 of the written decision.

5.1.1 The respondent-opponent contests the latter finding, arguing that since it is unclear which "bottom wall" is defined by the present claim formulation (see section 4. Main request - Clarity, above), the new feature

cannot be considered to restrict the scope of the claim and that therefore the added subject-matter objection still holds. They also argue that the use of the indefinite article "a bottom wall" instead of "the bottom wall" in the claim further supports this argument.

- 5.1.2 The Board is not convinced by the respondent-opponent since as explained above the Board is persuaded that the feature "a bottom wall" unambiguously defines the wall located opposite section A's aperture formed by the joining edges to section B, namely the first wall 15 as defined in original paragraph [0034] and thus successfully restricts the claimed feature to its originally disclosed scope. The Board is also convinced that the skilled person would immediately recognise that the use of the indefinite article "a bottom wall" merely corresponds to the common practice in patent claim drafting for the first occurrence of a feature in a claim, not necessarily meaning the existence of a plurality, and that it does not give rise to the ambiguity put forward by the respondent-opponent.
- 5.1.3 The Board thus holds that the positive conclusion of the Opposition Division that the disputed added subject-matter objection is overcome by the present formulation of the claim (as in auxiliary request 2 before the Opposition Division) is correct.
- 5.2 The respondent-opponent raised further added subject-matter objections for the first time during oral proceedings. Their admission is consequently subject to the Board's discretion under Article 13(3) RPBA 2007.

5.2.1 In this regard, a main question to answer is the justification for the late filing of these objections. Additionally, Article 13(3) RPBA also specifically directs the attention to the question whether the Board and the opposing party can reasonably be expected to deal with the newly raised issues in the scheduled oral proceedings.

5.2.2 With respect to justification, the subject-matter of claim 1 corresponds substantially to that of the auxiliary request filed with the statement of grounds. The respondent-opponent had thus ample time to raise any subject-matter objection against it before the oral proceedings. The only amendment to the subject-matter of that auxiliary request is the corrected translation of the term "circular-arc-like shape". However none of the new objections are directed to this feature. The Board can thus but conclude that there is no justification for the late filing of the new objections at this very late stage of the proceedings.

5.2.3 The new objections relate to

- the omission of the feature "for guiding the intake gas more smoothly", present in originally filed claim 1,
- whether the gap defined between the free end of the guide wall and an inner surface of a wall of the first section was originally disclosed as a small gap,
- the feature that the guide wall is integrally formed with the second part and whether this should be incorporated into claim 1, and
- whether the free end of the guide wall extended towards the first wall.

5.2.4 In a prima facie assessment, the Board does not find merit in any of the above objections. Indeed, it appears that the original functional feature that the intake gas is more smoothly guided is implicit in the claimed arc shape of the guiding wall of the present claim with smaller curvature than the corner parts. It also appears implicit in claim 1 of the main request that the gap is small since the required gas guiding function of the guide wall implies covering substantially almost all of the back space to avoid the inner corners. It also appears implicit in how the guide wall is defined by present claim 1, namely provided in the second section and extending into the first section to cover its corner part, that its free end extends towards the first or bottom wall of the first part as originally described. Finally, it is not immediately evident why the feature that the guide wall is integrally formed with the second part should be added to the claim. There is no immediately apparent unallowable intermediate generalisation by not including this feature, nor does it appear that the respondent-opponent has indicated any specific one.

The new objections therefore do not appear to derive from a straightforward analysis but to raise more complex and new issues. In order to give the Board and the other party reasonable and appropriate time to address such issues, adjournment of oral proceedings would have been required. Article 13(3) RPBA 2007 is intended to avoid such adjournment.

5.2.5 In consideration of the above, the Board decided not to admit the newly introduced added subject-matter objections into the proceedings.



5.3 Otherwise the Board is satisfied that the present claim 1 is based on the originally filed independent claim 1 with the further amendments finding their basis as explained by the appellant-proprietor in the statement of grounds section 3, namely in paragraphs [0034], [0036], [0040] and figure 1 of the original description.

5.4 The Board is therefore satisfied that claim 1 of the present main request does not include subject-matter extending beyond the content of the application as filed and thus fulfils the requirements of Article 123(2) EPC.

## 6. Remittal

The main purpose of inter partes appeal proceedings is to give the losing party a possibility to challenge the decision of the Opposition Division on its merits. In the present case, the Opposition Division has left the substantive issues regarding patentability undecided. Under these circumstances, the Board considers it not to be in line with the primary objective of appeal proceedings and an undue burden to decide on these issues without a decision of the Opposition Division. Thus a special reason exists for remittal of the case in the sense of Article 11 RPBA 2020. Both parties also appear to consider remittal as appropriate.

In view of the above, the Board has decided to remit the case for further prosecution on the basis of the main request on file.

7. Request for apportionment of costs

The appellant-opponent requests an award of costs of future oral proceedings before the Opposition Division, in the event that the case is remitted.

7.1 Under Article 104(1) EPC, each party must, as a rule, meet the costs it has incurred, unless reasons of equity justify to order otherwise.

The appellant-opponent submits that the proprietor could have avoided the present remittal by attending the oral proceedings during opposition. The Board however notes that there is no legal obligation to attend the oral proceedings. As regards the other circumstances of the present case, the proprietor dealt with all the outstanding objections during the written proceedings, either by way of argument, amendment or both. The Board does not consider it equitable to impute the fact that the Opposition Division chose (and was within its right to do so) during the oral proceedings to decide the case on the basis of only one of the various issues then on file, to the absence of the proprietor. Whether the Opposition Division would have decided differently in case the proprietor would have attended the oral proceedings is a matter of mere speculation.

The Board does not therefore consider it equitable to order a different apportionment of costs in the present circumstances of the case

7.2 Moreover, as also noted by the Board during the oral proceedings, the appellant-opponent requests an award of costs yet to be incurred in subsequent proceedings, namely of the eventual future oral proceedings before the Opposition Division.

In this regard, the prevailing view in the case law of the Boards of Appeal is that they should not take a decision on the apportionment of future costs because they have no basis for assessing them and lack jurisdiction, see CLBA, III.R.3.1. The present board agrees with that prevailing view.

7.3 In view of the above, the Board decides not to order a different apportionment of costs, Article 104(1) EPC.

## Order

**For these reasons it is decided that:**

1. **The decision under appeal is set aside.**
2. **The case is remitted to the Opposition Division for further prosecution.**

The Registrar:

The Chairman:



G. Magouliotis

W. Van der Eijk

Decision electronically authenticated