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**Datasheet for the decision  
of 10 September 2021**

**Case Number:** T 0563/18 - 3.2.06

**Application Number:** 05028189.8

**Publication Number:** 1674668

**IPC:** F01D17/16, F02C6/12

**Language of the proceedings:** EN

**Title of invention:**

Variable geometry turbocharger

**Patent Proprietor:**

TOYOTA JIDOSHA KABUSHIKI KAISHA

**Opponent:**

Mahle International GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 111(1)  
RPBA 2020 Art. 13(1)  
RPBA Art. 12(4)

**Keyword:**

Evidence - prior use - standard of proof

Late-filed document - justification for late filing (yes)

Appeal decision - remittal to the department of first instance  
(yes)

**Decisions cited:**

T 0055/01, T 1505/16

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0563/18 - 3.2.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.06**  
**of 10 September 2021**

**Appellant:** Mahle International GmbH  
(Opponent) Pragstr. 26-46  
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**Representative:** BRP Renaud & Partner mbB  
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**Respondent:** TOYOTA JIDOSHA KABUSHIKI KAISHA  
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**Representative:** TBK  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 4 January 2018  
rejecting the opposition filed against European  
patent No. 1674668 pursuant to Article 101(2)  
EPC.**

**Composition of the Board:**

**Chairman** M. Harrison  
**Members:** M. Hannam  
W. Ungler

## Summary of Facts and Submissions

- I. An appeal was filed by the appellant (opponent) against the decision of the opposition division rejecting the opposition to European patent No. 1 674 668. It requested that the decision under appeal be set aside and the patent be revoked.
- II. In its letter of reply dated 12 September 2018, the respondent (patent proprietor) requested that the appeal be dismissed (main request), that oral proceedings be held (first auxiliary request), that the case be remitted to the opposition division for further prosecution (second auxiliary request), or that the patent be maintained in amended form on the basis of one of the third to twenty-sixth auxiliary requests. Furthermore, the respondent requested that costs for 'at least part of the patentee's costs of the future appeal proceedings as well as of possibly remitted opposition proceedings' be apportioned to the appellant.
- III. The following documents are relevant to the present decision:
- OV 'Beweismaterial VTG Entwässerungsbohrung'  
(Evidence of turbo housing drainage hole)
  - EV1 Affidavit of Mr Kurt Ding;
  - EV2 Affidavit of Mr Abdul Tayara;
  - EV3 Affidavit of Mr Markus Obermanns.
  - A1 Statistische Mitteilungen des Kraftfahrt-Bundesamtes über Neuzulassungen in 2002 (New Vehicle registration data, Germany, 2002)
  - A2 Statistische Mitteilungen des Kraftfahrt-Bundesamtes über Neuzulassungen in 2003 (New Vehicle

registration data, Germany, 2003)

- IV. With letter of 25 June 2019, the appellant filed the following document:

EV4 Report dated 16 January 2019 by TÜV Süd  
Autoservice GmbH

- V. With letter of 25 October 2019, the respondent filed the following document:

Workshop invoice dated 17 June 2016 for turbo service on a Peugeot 807.

- VI. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the admittance of EV1 to EV3 would be discussed at oral proceedings and that an apportionment of costs seemed inappropriate. The Board also stated that, should EV1 to EV3 be admitted, remittal of the case appeared appropriate.

- VII. Oral proceedings by videoconference were held before the Board on 10 September 2021, during which the respondent withdrew its request for apportionment of costs. The final requests of the parties were thus:

The appellant requested that the decision under appeal be set aside and the patent be revoked. Auxiliarily the appellant requested remittal of the case to the opposition division.

The respondent requested that the appeal be dismissed (main request), that oral proceedings be held (first auxiliary request), that the case be remitted to the

opposition division for further prosecution (second auxiliary request), or that the patent be maintained in amended form on the basis of one of the third to twenty-sixth auxiliary requests filed with letter dated 12 September 2018.

VIII. Claim 1 of the main request reads as follows:

"A variable geometry turbocharger (1) including a housing (201), and a link mechanism (202), provided in the housing (201), which drives vanes (42) for controlling a flow of exhaust gas, the housing (201) including a turbine housing (48) and a turbine-housing swirl chamber (5) for supplying the exhaust gas to a turbine (22) and a link chamber (6) that houses the link mechanism (202), characterized in that a communication hole (3), which provides communication between the turbine-housing swirl chamber (5) and the link chamber (6), is formed in a lower portion of the turbine housing (48) and positioned at a lowest portion of the turbine-housing swirl chamber (5) when the variable geometry turbocharger (1) is mounted in a vehicle."

Claim 2 of the main request reads:

"A variable geometry turbocharger (1) including a housing (201), and a link mechanism (202), provided in the housing (201), which drives vanes (42) for controlling a flow of exhaust gas, the housing (201) including a turbine housing (48) and a turbine-housing swirl chamber (5) for supplying the exhaust gas to a turbine (22) and a link chamber (6) that houses the link mechanism (202), characterized in that

a communication hole (3), which provides communication between the turbine-housing swirl chamber (5) and the link chamber (6), is formed in a lower portion of the turbine housing (48) when the variable geometry turbocharger (1) is mounted in a vehicle, and an exhaust turbine chamber (148) that houses the turbine (22) is formed in the housing (201), a shroud (23) that separates the exhaust turbine chamber (148) from the link chamber (6) is further provided, and scavenging holes (4), which provide communication between the exhaust turbine chamber (148) and the link chamber (6), are formed in the shroud (23)."

IX. The appellant's arguments relevant to the present decision may be summarised as follows:

The correct standard of proof to apply with respect to the prior use was the 'balance of probabilities' since the turbocharger was installed on a Golf IV which was a mass-produced and sold article. The respondent thus had potential access to many examples of the vehicle which would allow it to query the prior use OV with more than mere allegations. It was not an unreasonable task, nor was it unreasonably expensive, to source an appropriate vehicle and investigate it to gain evidence to support its allegations.

Documents EV1 to EV3 should be admitted since there was no motivation for these to have been provided before the opposition division. The respondent's suggestion that the turbocharger may have been changed was an unsupported allegation and the opposition division, in its preliminary opinion, gave no indication that this was a problem in its appreciation of the substantiation of the prior use. The turbocharger casing had a date stamp of 2002 which, until the opposition division

announced its decision at oral proceedings, was seen as concrete evidence of its provenance. Only after receiving the surprising adverse decision was the opponent in a position to consider what further evidence might be required to prove the prior use and this was filed as EV1 to EV3 with the grounds of appeal.

As regards EV4, this was filed to prove that the communication hole was located at the lowest point of the swirl chamber. This was first queried in the respondent's reply to the grounds of appeal, and the document was filed in direct response to this. EV4 should thus also be admitted.

If EV1 to EV4 were admitted, remittal of the case to the opposition division for further prosecution was appropriate.

X. The respondent's arguments relevant to the present decision may be summarised as follows:

The appropriate standard of proof to be applied to the substantiation of prior use OV was 'beyond reasonable doubt'. A single turbocharger was the subject of the prior use and the detail relating to this was in the sole control of the opponent. It was unreasonable to expect the proprietor to prove the prior use unsubstantiated through finding, purchasing and investigating the turbocharger of a similar thirteen year old car, even if it was a mass-produced vehicle; this was an undue burden. It was disproportionate for the proprietor to have had to jump through these hoops when the opponent could simply have submitted EV1 during the opposition procedure. As it stood, the mere possibility that the turbocharger had been changed



should suffice for the prior use not to be found proven beyond reasonable doubt.

EV1 to EV3 should not be admitted since these should already have been filed before the opposition division. In its reply to the notice of opposition (see page 3 of its letter of 29 December 2016) the possibility of the turbocharger having been replaced in the prior use OV was argued and in point 3.1.1 of the opposition division's preliminary opinion, the public availability of the prior use OV was clearly a matter to be discussed; the opponent should therefore not have been surprised by the opposition division adopting the view at oral proceedings that the turbocharger of prior use OV could have been changed and not be that originally fitted. Indeed, the proprietor had stated that turbochargers were known to be prone to failure so a thirteen year old car would have a high probability of having had its turbocharger replaced. This was further supported by the workshop invoice which related to the replacement of a turbocharger on a car just nine years old.

Before the opposition division, the patentee had further already questioned Mr Ding's position as a member of the public and, being simply an employee of the appellant, the ability of Mr Kazcorowski to report on the original provenance of the installed turbocharger in the used car. As regards the documents themselves, the affidavit EV1 was clearly only obtainable by the appellant itself and so should have been presented earlier. The affidavit EV2 was similarly easily obtainable by the appellant already after receipt of the proprietor's reply to the opposition in which the turbocharger having possibly been exchanged was first raised. As for EV3, no justification was

given as to why this document was filed so late.

EV4 should also not be admitted since the prior use OV was argued by the appellant to have unambiguously disclosed all features of claims 1 and 2 of the patent as granted. This was not the case and the document EV4 was thus another instance of the opponent retrospectively trying to improve its position.

If EV1 to EV4 were admitted, the case should be remitted to the opposition division for further prosecution.

## **Reasons for the Decision**

### 1. *Standard of proof*

- 1.1 In reaching its decision regarding the prior use OV not being proven, the opposition division used the 'proven beyond reasonable doubt' standard of proof (see last paragraph of point 13 on page 6 of its decision). This standard of proof is generally applied to cases in which the prior use lies fully within the power and knowledge of the opponent. Whilst the specific vehicle of the prior use OV in the present case was indeed within the opponent's control, the turbocharger of the prior use was sold as a component of a Golf IV vehicle which was a mass-produced and sold vehicle in 2003 (see A1 and A2 filed with the notice of opposition and the content of which has not been contested by the respondent). The consequence of the VW Golf IV and thus also the turbocharger being a mass-produced and sold item and an item with a relatively long life span, is that its content was in fact not solely within the power and knowledge of the opponent. The respondent was

in a position to question the prior use OV by way of filing counter evidence, for example through providing an alternative example of the mass-produced turbocharger in order to demonstrate that the appellant had failed to meet the requisite burden of proof. As a result, the appropriate standard of proof to apply to the prior use OV was the 'balance of probabilities'. This finding is in accordance with established case law, see Case Law of the Boards of Appeal III, G. 4.3.2a) and, for example, T1505/16, Reasons 2 and the catchword of decision T55/01.

1.2 The respondent's argument that it was unreasonable to expect it to disprove the prior use through e.g. finding, purchasing and investigating the turbocharger of a similarly old Golf IV, even though it was a mass-produced vehicle, is not accepted. Precisely because this vehicle was mass-produced, and indeed is still to be seen on the roads to this day, is a strong indication that finding such a vehicle, also at rather low cost, and carrying out the required investigation was not an undue burden. Indeed, no evidence has been provided to show that it was an undue burden. This would have enabled the respondent to either support its allegation that the originally fitted turbocharger did not anticipate the claimed subject-matter or to show that this vehicle had a retro-fitted turbocharger, rather than put forward doubts based only on theoretical possibilities. Other ways of obtaining information about the turbocharger fitted to this mass-produced vehicle also seem possible.

1.3 The respondent's suggestion that the appellant could simply have submitted EV1 during the opposition procedure to overcome the allegation of the turbocharger not being original lacks relevance when

determining the correct standard of proof that should be applied. Even taking the argument on its merit, the respondent had the burden of substantiating its allegation that the turbocharger was not original and, being a mass-produced vehicle, it also had the opportunity to justify its allegations with evidence, which it failed to do. Absent any such substantiation, the Board cannot conclude that the appellant had to supply further evidence to assist it in demonstrating that the turbocharger of its prior use OV was indeed the original one.

1.4 In summary, therefore, the appropriate standard of proof for the prior use in the present case was the 'balance of probabilities', not 'beyond reasonable doubt' as used by the opposition division.

2. *Admittance of EV1 to EV3*

2.1 According to Article 12(4) RPBA (2007), the Board has discretion 'to hold inadmissible facts, evidence or requests which could have been presented ... in the first instance proceedings'.

2.1.1 In the present case, EV1 to EV3 were submitted with the appellant's grounds of appeal. The respondent alleges that these could have been presented already before the opposition division.

2.1.2 Since the allegations the respondent made before the opposition division lacked substantiation, the Board cannot see a reason why the appellant - prior to the oral proceedings before the opposition division - should have been required to file further documents in support of its case, unless the opposition division had considered it necessary or otherwise questioned the

date of the turbocharger fitted to the vehicle (which does not appear to be the case - see 2.1.3 below).

- 2.1.3 In this regard, the respondent's argument that it had, already in its reply to the notice of opposition, indicated the possibility of the turbocharger having been replaced in the prior use OV and that this allegation should therefore have been countered with evidence already before the opposition division, is not persuasive. The respondent's argument was a mere unsubstantiated allegation and was also not stated by the opposition division as a potential gap in the substantiation of the prior use OV in its preliminary opinion prior to oral proceedings. Contrary to the respondent's argument, point 3.1.1 of the opposition division's preliminary opinion does not suggest any concern that the prior use lacked evidential support due to the possibility of the turbocharger having been changed or modified at any time after the original supply of the vehicle; rather, explicit reference is made to the characterising portion of claim 1 and whether these features 'were made available to the public'. This can be further understood in point 5.1 where reference is again made to these features in the context of the evidence provided, and this not allowing their unambiguous recognition in the prior use OV. The opposition division thus expressed no concern that the turbocharger of the prior use OV may not be the original such that, prior to the oral proceedings, there was no indication for the appellant to believe that the respondent's mere allegation of the turbocharger theoretically having been changed required the provision of counter evidence, such as presented in EV1 on appeal.

2.1.4 The respondent's argument made during opposition proceedings in its letter of 29 December 2016 that turbochargers were prone to failure such that a thirteen year old car would have a high probability of having had its turbocharger replaced is also unsubstantiated. Whilst it can be accepted that some turbochargers are prone to failure and that with increasing age and use the probability of failure and thus replacement grows, there is no evidence suggesting that the specific turbocharger of the prior use OV had indeed been changed. This, combined with the date stamp of 2002 on the casing of the turbocharger, were all strong indicators for the appellant to believe that there was no need to supply further evidence in this regard prior to the oral proceedings. It is further noted that the workshop invoice submitted with letter of 25 October 2019, whilst indeed relating to repair of a presumably failed turbocharger, at a kilometrage less than that of the prior use OV vehicle, not least relates to a vehicle of a different manufacturer and appears to show that a 'turbo service set' was used. Whether this relates only to the turbocharger internals, rather than the entire turbocharger including its casing may be an issue for the opposition division to consider as this evidence was not presented to it previously.

2.1.5 As to the opposition division's related observation (see the impugned decision, item 13 on page 6) that solely the compressor casing included a date stamp, yet the turbine casing was not so marked, such that it was 'not at all implausible' (again employing a standard of proof of 'beyond all reasonable doubt') that solely the latter had been replaced since the original supply of the car, this relates to an issue upon which the opponent seemingly had no possibility to react. It is

also remarked by the Board that the prior use OV seems to have come from a randomly purchased Golf IV, this vehicle having a turbocharger which is alleged to deprive the subject-matter of claim 1 of novelty. There is as yet no evidence supporting the allegation that the turbocharger could have been replaced at any time after original sale, such that the theoretical possibility of a replacement having occurred remains mere speculation. Furthermore, in that regard the passage in the TÜV Gutachten (EV4), page 3, point 3 stating that the turbocharger with the specific product number has been used by VW at that point in time, appears to support the appellant's case.

2.1.6 Regarding the respondent's reference to the proceedings before the opposition division questioning Mr Ding's position as a member of the public, the evidence for such an allegation is non-existent. Mr Ding is simply the owner of the Golf IV to which the prior used turbocharger was fitted; no evidence of any relationship to the appellant is suggested or derivable from the prior use OV. Similarly, as the author of the prior use OV, Mr Kaczorowski was simply reporting on the findings relating to the prior used turbocharger fitted to the above Golf IV and was not passing judgement on the turbo charger being that originally fitted to the vehicle. However, no argument of the respondent has concretely put into question the provenance of the prior used turbocharger as being anything but that originally fitted to the above Golf IV.

2.1.7 The Board also finds, contrary to the respondent's argument, that there had been no need for EV3 to have been filed before the opposition division. No question had been raised prior to the oral proceedings of the

date stamp on the turbine housing failing to prove the manufacturing date of the entire turbocharger assembly such that the proprietor was justified in expecting the opposition division to accept the evidence at face value. Further, as indicated in the appellant's letter of 25 June 2019 (see page 2, second paragraph), the contact with Mr Obermanns was made purely by chance and so the information in EV3 could not have been provided sooner.

2.1.8 In summary, therefore, nothing can be seen which would have suggested that the filing of EV1 to EV3 by the appellant was necessary prior to the opposition division announcing its decision not to consider OV as a public prior use at the oral proceedings.

2.1.9 The Board thus did not exercise its discretion under Article 12(4) RPBA 2007 to hold EV1 to EV3 inadmissible. EV1 to EV3 are thus in the proceedings.

### 3. *Admittance of EV4*

3.1 According to Article 13(1) RPBA 2020, 'Any amendment to a party's appeal case after it has filed its grounds of appeal ... may be admitted only at the discretion of the Board'. In exercising its discretion, of importance is *inter alia* 'the suitability of the amendment to resolve the issues which were admissibly raised by another party in the appeal proceedings'.

3.2 EV4 was filed by the appellant with letter of 25 June 2019 i.e. after filing its grounds of appeal and its admittance is thus at the discretion of the Board.



3.3 On page 4 of 6 of its letter of response to the appellant's appeal, the respondent questioned the communication hole of the prior use OV truly being positioned at a lowest portion of the turbine housing swirl chamber. It was in order to counter this argument that EV4 was filed by the appellant. With this explicit argument not previously having been made in the opposition proceedings and the opposition division also not having addressed the technical content of prior use OV, there was no prior motivation for the appellant to file EV4. It was filed in direct response to the respondent's allegation and, at least *prima facie*, shows the claimed communication hole being positioned at a lowest portion of the turbine housing swirl chamber when fitted, as defined in claim 1. The Board thus sees EV4 as being in direct response to the newly raised objection regarding the location of the communication hole.

3.4 The Board thus exercised its discretion under Article 13(1) RPBA 2020 to admit EV4 to the proceedings.

4. *Remittal (Article 111(1) EPC)*

4.1 According to Article 111(1) EPC, when deciding on an appeal, the Board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

4.2 In the exercise of such discretion, in the present case an important aspect is firstly that the opposition division applied the incorrect standard of proof when deciding not to consider the alleged prior use OV as having been proven, and also that EV1 to EV4 were not on file before it and may be of relevance for the

consideration of whether the alleged prior use OV has been proven when applying the correct standard, also in the light of any potential counter evidence that may be supplied by the proprietor.

4.3 Remittal has notably been requested by both parties and would allow them both to develop their arguments with respect to the changed factual situation and further provide the parties the opportunity of having an examination of the new evidence before two instances.

4.4 The Board thus avails itself of its power under Article 111(1) EPC to remit the case to the opposition division for further prosecution.

## 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:



D. Grundner

M. Harrison

Decision electronically authenticated