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**Datasheet for the decision
of 10 September 2024**

Case Number: T 1695/22 - 3.2.05

Application Number: 09804011.6

Publication Number: 2389528

IPC: F16J15/08

Language of the proceedings: EN

Title of invention:

Hydraulic control plate

Patent Proprietor:

REINZ-Dichtungs-GmbH

Opponent:

ElringKlinger AG

Relevant legal provisions:

EPC Art. 56

EPC R. 103(1) (a)

RPBA 2020 Art. 12(3), 12(5)

Keyword:

Admissibility - main request and aux. requests 0 and 1 (no)

Inventive step - auxiliary request 2 (no)

Admittance - auxiliary requests 3 to 8 (no)

Full reimbursement of the appeal fee (no)

Decisions cited:

G 0009/92, G 0004/93



Beschwerdekammern

Boards of Appeal

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Case Number: T 1695/22 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 10 September 2024

Respondent: REINZ-Dichtungs-GmbH
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
12 May 2022 concerning maintenance of the
European Patent No. 2389528 in amended form.**

Composition of the Board:

Chairman P. Lanz
Members: O. Randl
F. Blumer
M. Holz
D. Rogers

Summary of Facts and Submissions

- I. Both the patent proprietor (appellant I) and the opponent (appellant II) filed an appeal against the opposition division's decision on the version in which European patent No. 2 389 528 ("the patent") can be maintained in amended form.
- II. The opposition division decided that the subject-matter of claim 1 as granted and auxiliary request 1 lacked novelty over a prior public use, but that the second auxiliary request complied with the requirements of the EPC.
- III. Of the documents taken into account by the opposition division, only the collection of documents concerning sales of hydraulic control plates starting in October 2007 referred to as "D7" is decisive for the decision on the appeal.
- IV. On 8 July 2024 the board issued a communication pursuant to Article 15(1) RPBA.
- V. By letter received on 15 July 2024, the patent proprietor withdrew its appeal.

Consequently, the opponent is the sole appellant (it will be referred to as "the appellant" in the following) and the principle of prohibition of *reformatio in peius* applies.

- VI. The oral proceedings before the board took place on 10 September 2024. As announced in its letter dated 6 September 2024, the patent proprietor was not represented.

VII. The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked. The appellant also requested that the respondent's auxiliary requests 3 to 8 not be admitted into the proceedings.

The respondent (patent proprietor) had requested in writing that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution (main request), or that the decision under appeal be set aside and that the patent be maintained as granted (auxiliary request 0), or that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims filed with its statement of grounds of appeal as auxiliary requests 1 to 8. Moreover, full reimbursement of the appeal fee was requested.

VIII. Claim 1 of the patent as granted (main request) reads (for claim 1, the feature references used by the board are indicated in square brackets):

"1. [1] Hydraulic control plate (20), comprising
[2] a first gasket layer (30) with first sealing sections (40),
[3] a second gasket layer (34) with second sealing sections (42) and
[4] at least one plane intermediate layer (32) arranged between the gasket layers (30, 34), wherein
[5] the gasket layers (30, 34) are made from a metallic material, and
[6] the sealing sections (40, 42) of said gasket layers (30, 34) comprise beads (46) embossed into the gasket layers (30, 34) which are supported on the intermediate layer (32), and wherein

[7] a part of the course of the beads of the first sealing sections (40) used for sealing a through opening (38) and a part of the course of the corresponding beads (46) of the second sealing sections (42) used for sealing said through opening (38) are offset relative to each other, thereby sealing parts on opposite sides of the control plate (20) which have different geometries."

Claim 1 of auxiliary request 1 differs from claim 1 of the main request on account of the additional feature according to which "[8] at least one of the gasket layers (30, 34) and the at least one intermediate layer (32) are locally connected to each other".

Claim 1 of auxiliary request 2 differs from claim 1 of auxiliary request 1 on account of the additional feature according to which "[9] the at least one intermediate layer (32) has a layer thickness (56) of at least 0.8 mm and at the most 1.8mm".

IX. The relevant submissions by the parties may be summarised as follows:

(a) Alleged prior public use D7

(i) Respondent (patent proprietor)

The opposition division had unduly reversed the burden of proof to the detriment of the patent proprietor. In view of the witness's statement to the contrary, the opposition division could not reasonably conclude that the sale had not been covered by a confidentiality obligation. The conclusion that the general terms and conditions (GTC) applicable to the sales could not contain provisions that obliged the buyer to maintain

secret details regarding a part to be incorporated into a publicly available end product was contrary to what was customary in the industry. Moreover, the opposition division was not competent to base its conclusion on Section 305 et seq. BGB and did not substantiate its argument based on these provisions. As the relevance of Section 305 et seq. BGB had never been invoked in the written proceedings or during the oral proceedings, the opposition division violated the patent proprietor's right to be heard.

(ii) Appellant (opponent)

The patent proprietor's submissions were directed only against the opposition division's decision that the transmission control plates and documents according to documentation D7 were prior art for the patent in suit. The key arguments merely revolved around speculation on the possible content of general terms and conditions for the sales. The opposition division had given detailed reasons for its findings that, according to the very high standard of probability bordering on certainty to be applied, these documents and transmission control plates were accessible to the public before the priority date of the patent in suit. The appellant had provided sufficient evidence that, at least after the start of series deliveries in 2007, neither the supplier ElringKlinger AG nor the customer ZF Friedrichshafen AG had an interest in keeping the transmission control plates confidential. There had been no confidentiality agreement for the transmission control plates between the supplier and the customer, as the supplier regularly sold the transmission control plates to the customer without reservation and the customer presented, offered for sale and also sold transmissions with the transmission control plates to

any third party. Since a single unconditional sale or the mere possibility that any third party might become aware of the technical teaching was sufficient for public accessibility, the transmission control plates were made available to the public in a variety of ways. The patent proprietor's speculations about the possible content of general terms and conditions for the sales were in vain.

(b) Auxiliary request 2: inventive step of the subject-matter of claim 1, starting from the public prior use D7

(i) Appellant (opponent)

The difference between the claimed hydraulic system control plate and the previously known hydraulic system control plates only consisted in a marginally lower layer thickness of the intermediate layer (1.8 mm instead of 1.9 mm) with a deviation of up to 0.3 mm (see document 3/D7, which refers to a thickness deviation with uniform taper over the entire length of max. 0.3 mm). In the contested decision, the problem to be solved with regard to this alleged difference was stated as finding a compromise between the weight and/or the production costs on the one hand and the thickness of the control plate/interlayer on the other hand.

The optimisation of the functional performance of a component as well as its production costs and material savings was a standard routine activity for the skilled person. In addition, as a routine activity, the skilled person had to design the hydraulic system control plate according to external specifications for a specific application and the dimensions of the intermediate

layer were determined according to the external specifications.

The cost pressure in the automotive industry and the common problem of finding a resource-saving solution motivated the skilled person to optimise the state of the art in terms of reducing production costs and saving weight and materials. By saving material, the skilled person always expected the advantage of a lighter component, in this case a lighter hydraulic system control plate, as well as the advantage of cost savings. In addition, on the priority date of the patent in suit, the standard problem for a development engineer was to find solutions for lightweight construction. Therefore, the skilled person had a specific reason and incentive to save material in the previously known hydraulic system control plate in anticipation of the improvement in terms of production costs and the advantage of material savings. This reason related in particular to the intermediate layer of the hydraulic system control plate, as this was considerably thicker and therefore used more material than the sealing layers on both sides. As a routine activity, the skilled person would have checked whether it was possible to make the intermediate layer at least one to a few tenths of a millimetre thinner in order to save material and costs and still have a sufficiently stable intermediate layer. This routine optimisation would have allowed the skilled person to arrive at the hydraulic system control plate according to claim 1 in an obvious manner.

Furthermore, it was established case law of the Boards of Appeal that an inventive step was not required to find a suitable compromise between different parameters, in this case, a compromise between the

weight and the production costs on the one hand and the thickness of the hydraulic system control plate/intermediate layer on the other hand. It was normal for the skilled person to optimise a physical parameter, in this case the thickness of the layer, in such a way that an acceptable compromise was achieved between two opposing effects that depended on this parameter, i.e. to find a compromise for the thickness of the layer, whereby the thickness was to be as great as possible in order for the intermediate layer to be stable and, conversely, the intermediate layer was to be as thin as possible in order to save material and costs.

(ii) Respondent (patent proprietor)

Even in the opponent's opinion, in the present case there was no reason for the skilled person to vary the thickness of the intermediate layer disclosed in the alleged prior use D7, as this thickness was specified for the transmission control plate. The overall specification of a transmission control plate was given by the transmission manufacturer. The skilled person would not have considered changing the thickness of the intermediate layer independently, as the product would otherwise no longer have met the specifications desired by the transmission manufacturer and would therefore no longer have been usable. In order to meet the specifications required by the transmission manufacturer again after changing the thickness of the intermediate plate, all the other layers of the transmission control plate would then also have had to be redesigned in terms of materials, thicknesses, sealing elements, etc. It was only due to the present invention that a low layer thickness of the intermediate layer as defined in claim 1 of auxiliary request 2 had become possible; however, this finding

was neither found in nor suggested by the transmission control plate in prior public use D7. Otherwise, the transmission control plate according to D7 would already have been designed with a reduced layer thickness of the intermediate plate, solely to make material savings. Consequently, the subject-matter of claim 1 was inventive in view of the alleged prior use D7.

(c) Admittance of auxiliary requests 3 to 8

(i) Appellant (opponent)

The patent proprietor merely submitted that auxiliary requests 1 to 8 were those auxiliary requests from the first-instance proceedings which were numbered 1, 2, 30, 31, 76, 78, 82 and 83 respectively. The patent proprietor did not make a further submission on these auxiliary requests 1 to 8 in the statement of grounds of appeal. However, according to the Rules of Procedure of the Boards of Appeal, in addition to the contested decision, the appeal proceedings are based only on the statement of grounds of appeal and the reply, whereby the statement of grounds of appeal "should specify expressly all the requests, facts, objections, arguments and evidence relied on". The Boards of Appeal had explained in their jurisprudence that if a submission was not expressly stated in detail and instead reference was only made to a submission before the first-instance department, this submission could be disregarded. If at all, the patent proprietor merely referred to the numbering of auxiliary requests 1 to 8 as used before before the department of first instance. However, the patent proprietor made no submissions and did not even refer to any submissions made before the first-instance department with regard to the amendments

made to the claims of auxiliary requests 1 to 8 and whether the subject-matter of the claim sets of auxiliary requests 1 to 8 differed from the prior art. Therefore, in the appellant's opinion, auxiliary requests 1 to 8 had been inadmissibly introduced into the appeal proceedings and were therefore not the subject of the appeal proceedings.

(ii) Respondent (patent proprietor)

The respondent did not respond to the appellant's objections to the admittance of its auxiliary requests.

Reasons for the Decision

1. Main request, auxiliary requests 0 and 1

In view of the prohibition of *reformatio in peius* (see point V. above), the patent proprietor as respondent to the opponent's appeal is primarily restricted to defending the contested patent as maintained in accordance with auxiliary request 2 (see decisions G 9/92 and G 4/93 of the Enlarged Board of Appeal). The broader requests for the decision to be set aside and the case to be remitted to the opposition division or for the patent to be maintained as granted or in accordance with auxiliary request 1 are therefore inadmissible.

2. Alleged prior public use D7

In points 19 to 22 of the contested decision, the opposition division examined, among other things, an alleged prior public use for which the collection of

documents D7 was submitted as evidence. It will be referred to as "prior public use D7" in the following.

This alleged prior public use was decisive for the decision under appeal. It concerns the sale of hydraulic control plates by the opponent to ZF Friedrichshafen in October 2007. Ms Annette Baader was heard as a witness during the oral proceedings before the opposition division. Having considered all the evidence on file, the opposition division concluded that the prior use was public, in particular because the delivered items were not subject to a confidentiality obligation.

The respondent contested this finding and referred to Ms Baader's testimony regarding the provisions on confidentiality in the general terms and conditions (GTC) applicable to the sales. As can be seen from pages 29 and 30 of the transcript of the taking of evidence, the witness confirmed that there were such provisions in the GTC but was unable to recall them.

The opposition division referred to this aspect in point 21.5 of the decision under appeal:

"... In any case, it is highly unlikely that the general terms applicable in 2007/2008 contained an encumbrance on the buyer (ZF) to maintain secret the technical details of a supply part purchased from a supplier (the opponent) that is, at the end of the supply chain, to be part of a publicly available truck (thereby obliging to request a preliminary consent from the parts supplier before any public sale). Such severe and unusual limitation of the liberty to freely dispose of a purchased supplier part cannot effectively be

stipulated in general terms and conditions (since buyer and seller are based in Germany, sections 305 et seq. of the German civil code "Bürgerliches Gesetzbuch - BGB" apply). As a result, the opposition division is convinced that the opponent's then general sale and delivery terms cannot affect the assessment of public availability."

The board notes that the parties appear not to have been heard on the content and relevance of Section 305 et seq. BGB, either during the written proceedings or during the oral proceedings before the opposition division. Therefore, the opposition division's decision should not have referred to these provisions, or at least should have made it unmistakably clear that the reference was an *obiter dictum*. As the opposition division did not do this, it appears to indeed have violated the parties' right to be heard. The question of whether this violation can justify a reimbursement of the appeal fee is dealt with in point 5. below.

Regarding the substance of the case, the crucial point in this matter is whether the reference to specific provisions in the GTC in Ms Baader's testimony permits the conclusion that the hydraulic control plates sold and delivered by the opponent to ZF Friedrichshafen in October 2007 were not made available to the public. As already mentioned, the opposition division concluded that, regardless of the exact content of the GTC, it was highly unlikely that the GTC obliged ZF Friedrichshafen to keep secret the technical details of the control plates that were to be mounted into publicly available trucks, and to request the seller's consent before any public sale.

The board endorses the opposition division's view on this matter.

According to the respondent, it is customary in the industry that at least the company selling the end product imposes a confidentiality obligation on all suppliers and sub-suppliers, from which the suppliers and sub-suppliers are only released when the first series end product is placed on the open market. Although this may be true, the question to be answered is whether the company selling the end product was bound to keep the supplier's part confidential. The respondent has not convincingly demonstrated that such a custom existed in the industry.

The fact that relatively little evidence relating to the series production was supplied is not decisive because the evidence provided was sufficient.

The assertion that the appellant deliberately falsified the presentation of the objective facts is unfounded. It is in the nature of adversarial proceedings that the parties involved present their case in the best light. The board is prepared to deal with such biases.

According to the respondent, the witness contradicted the opponent's previous statements that there was no confidentiality agreement. The board notes that the confidentiality agreement, the existence of which was confirmed by the witness, concerns confidential pieces of information (*vertrauliche Informationen*). It is not clear that the witness would have understood that the sold parts as such were concerned. In any case, the discrepancy could be explained by the fact that the GTC contained no specific agreement (such as the declarations mentioned by the witness, see page 7 of

the transcript), but only general provisions regarding confidentiality.

It is mere speculation to put forward the argument that if, as the witness claims, adjustments were common during series production, it would be expected that changes were also made to the product in the following years. It is reasonable to assume that adjustments are more frequent in the initial stages of the industrialisation cycle. It may be true that a manufacturer is reluctant to change the design of an embossed component after the actual start of series production, but there may be circumstances in which such changes must be made nonetheless.

The respondent considers that the most plausible interpretation of repeated deliveries at short intervals in small quantities with changing properties is that series production in the sense of serial production of a finished product intended for free sale did not yet exist; however, this possible explanation is contradicted by the witness, who repeatedly asserted that several items in document D7 referred to series production (see transcript pages 15, 16, 17, etc.).

The board agrees that it would be preferable to have the applicable GTC, which the witness declared to be available; however, these GTCs were not filed, and there may be valid reasons for this. Since the respondent has not convincingly shown that the GTC could be reasonably expected to contain stringent conditions of confidentiality imposed on the buyer with respect to the technical details of the sold product that was to be mounted into publicly available trucks, the absence of the GTC, although regrettable, is not decisive.

In view of the above, the board is satisfied that the alleged public prior use D7 has indeed taken place. It thus forms part of the state of art under Article 54(2) EPC.

3. Auxiliary request 2: inventive step, starting from public prior use D7

3.1 Differences

As can be seen from points 41 and 58 of the decision under appeal, the opposition division concluded that the alleged public prior use D7 anticipated the subject-matter of claim 1 of the patent as granted, i.e. features 1 to 7. The respondent's counter-argument is limited to contesting the public nature of the prior use. As the board endorses the opposition division's conclusion regarding the availability of the object of the sales to the public, the disclosure of features 1 to 7 in the public prior use D7 is established.

The same holds true for feature 8. In points 61 to 64 of the decision under appeal, the opposition division concluded that this feature was disclosed in the public prior use D7 (see drawing 1/D7).

However, the opposition division considered that feature 9, according to which the intermediate layer(s) must have a layer thickness between 0.8 and 1.8 mm, was not disclosed in the prior public use D7. During the oral proceedings before the board, the appellant withdrew its assertion that the feature was disclosed.

Therefore, claim 1 of auxiliary request 2 differs from the control plate in the public prior use on account of feature 9.

3.2 Objective technical problem

The opposition division considered the problem solved by the distinguishing feature to be that of finding a compromise between the weight and/or production costs on the one hand and the strength of the control plate on the other hand (see point 73 of the decision under appeal). The appellant did not object to this formulation, nor does the board see any reason to define a different objective technical problem.

3.3 Obviousness to the skilled person

The appellant argued that the marginally lower thickness of the intermediate layer in claim 1 compared with the thickness of this layer according to prior public use (1.8 mm instead of 1.9 mm) could not justify the presence of an inventive step.

The board agrees. As set out by the appellant, it is part of the routine duties of the skilled person to optimise the functional performance of the component as well as its production costs and material savings. Minor changes to certain parameters such as this thickness can be considered, all the more so because document 3/D7 refers to thickness deviations that may reach 0.3 mm under certain circumstances.

The respondent's counter-argument that the skilled person would not have varied the thickness of the intermediate layer disclosed in the alleged prior use D7 and that otherwise the plate according to the prior use would already have been designed with a reduced layer thickness of the intermediate plate is unpersuasive. When starting from the plate in the

public prior use D7 and trying to optimise it in the context of a different application, the skilled person would not have felt obliged to stick to all the indications given in this context. Moreover, as mentioned above, document 3/D7 itself suggests that the tolerance of 0.1 mm may be exceeded.

3.4 Conclusion

The subject-matter of claim 1 of auxiliary request 2 is not inventive over the prior public use D7 in the sense of Article 56 EPC.

Consequently, it is not possible to maintain the patent on the basis of auxiliary request 2. This request must be dismissed.

It follows that the decision under appeal must be set aside.

4. Admittance of auxiliary requests 3 to 8

The appellant argued that auxiliary requests 3 to 8 were not substantiated in the sense of Article 12(3) RPBA and requested that the board not admit them in application of Article 12(5) RPBA.

The board notes that the patent proprietor merely filed these requests, but did not deal with their content and did not respond to the appellant's objection and request in its reply to the appeal. Thus, the substantiation requirements of Article 12(3) RPBA are not met. The board, exercising its discretion pursuant to Article 12(5) RPBA, therefore decided not to admit auxiliary requests 3 to 8 into the appeal proceedings.

5. Full reimbursement of the appeal fee

As a consequence of the withdrawal of its appeal, the respondent obtained the reimbursement of 50% of the appeal fee according to Rule 103(3)(a) EPC.

At an earlier stage of the appeal proceedings, the respondent (then appellant I) had requested the full reimbursement of its appeal fee because of an alleged substantial procedural violation (see point 2. above).

According to Rule 103(1)(a) EPC,

"[t]he appeal fee shall be reimbursed in full ... where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation, ..."

It follows from the withdrawal of the appeal that the condition for reimbursement of the appeal fee under Rule 103(1) EPC, namely that the appeal is deemed allowable, cannot be fulfilled.

The request for a full refund of the appeal fee cannot be successful for this reason alone.

Therefore, this request cannot be granted.

6. Conclusion

As the respondent's only admissible and admitted request (auxiliary request 2) is not allowable, the patent must be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



D. Hampe

P. Lanz

Decision electronically authenticated