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D E C I S I O N
of 5 October 2000

Case Number: T 0102/97 - 3.2.6

Application Number: 91112053.3

Publication Number: 0467372

IPC: B23B 5/06

Language of the proceedings: EN

Title of invention:

Valve seat bushing machining apparatus

Patentee:

UNOVA Industrial Automation Systems, Inc.

Opponent:

GROB-WERKE GMBH & CO. KG

Headword:

-

Relevant legal provisions:

EPC Art. 117(1)

EPC R. 55(c)

Keyword:

"Admissibility of the opposition - yes"

Decisions cited:

T 0328/87, T 0541/92, T 0204/91

Catchword:

-



Case Number: T 0102/97 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 5 October 2000

Appellant: GROBE-WERKE GMBH & CO. KG
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 28 November 1996
rejecting the opposition filed against European
patent No. 0 467 372 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. C. Kadner
M. Tardo-Dino

Summary of Facts and Submissions

- I. The mention of the grant of European patent No. 0 467 372 in respect of European patent application No. 91 112 053.3, filed on 18 July 1991 was published on 19 October 1994.

Claim 1 of the patent reads as follows:

"Apparatus for machining an annular valve seat and associated concentric valve guide of a workpiece (W), with a support (63) for the workpiece, a tool head (16), means (18, 20, ...) supporting said tool head adjacent said workpiece support (63) for rotation on an axis aligned with the valve guide of the supported workpiece and for axial movement toward and away from the supported workpiece (W), a tool slide (24), a cutting tool (14) mounted on said tool slide, guide means (26) mounting said tool slide on said tool head for movement of said tool on a line which intersects said axis of rotation, and first power means (28) for axially rotating said tool head, characterized by a reamer (12) mounted on said tool head (16) coaxially with the axis of rotation of said tool head (16), second power means (64) operative to axially move said tool head (16), third power means (66) operative to move said tool slide (24) along said guide means (26), means (74) operative to axially move said reamer (12) relative to said tool head (16), and control means (80) for coordinating the operation of said second (64) and third (66) power means, and said means to axially move said reamer, to cause said reamer (12) to machine said valve guide and said cutting tool (14) to machine said valve seat."

II. Notice of opposition was filed on the grounds of Article 100(a) EPC on 15 July 1995. In respect of an alleged lack of novelty and inventive step the following documents for substantiation of an alleged prior use concerning an order, a draft of the apparatus for machining the valve seat and the valve guide of a cylinder head and delivery of this apparatus were relied upon:

Attachment 1: Order of the company BMW to the company Ernst Grob GmbH & Co. KG dated 20 June 1989, Order No. 81 61 372

Attachment 2: Technical drawing (draft) No. 3 579 744 dated 11 May 1990 indicating a 4-valve cylinder head and the apparatus for machining the valve seat and the valve guide of this cylinder head ("offer")

Attachment 3: Extract of the draft of Attachment 2 concerning valve seat and valve guide machining apparatus

Attachment 4: Extract of the draft of Attachment 2 concerning valve seat angles

Three witnesses were nominated:

Mr Waldemar Offner, employee of the opponent

Mr Hans Joachim Schlesinger who was the time of the alleged prior use an employee of opponent

Mr Seibold, employee of BMW München

It was further indicated what the witnesses had to ascertain.

III. By a decision posted on 28 November 1996 the Opposition Division rejected the opposition as inadmissible. The Opposition Division was of the opinion that the notice of opposition did not meet the requirements of Rule 55(c) EPC in that the evidence given by the documents was not sufficient to support and substantiate the request of revocation of the patent. It was not clear that "Attachment 1" and "Attachment 2" were related to one another. With reference to the nomination of the witnesses there were neither written declarations nor a complete description of the facts and circumstances concerning their knowledge in connection with the alleged prior use. Therefore the facts and the circumstances of the alleged prior use were insufficiently indicated, and consequently this requirement of Rule 55(c) EPC had not been complied with.

IV. On 27 January 1997 a notice of appeal was lodged against the decision together with payment of the appeal fee.

The statement of grounds of appeal was filed on 27 March 1997.

The Appellant (Opponent) requested that the decision under appeal be set aside and that the European patent 0 467 372 be revoked.

V. In a communication dated 16 June 2000 the Board of Appeal expressed the preliminary opinion that Rule 55(c) EPC did not require a submission of written

statements of nominated witnesses. The Board pointed out that if at least one of the actions of the alleged prior use - the order, the offer, or the delivery - fulfilled the requirements of Rule 55(c) EPC remittal of the case to the first instance was envisaged.

VI. In support of its request the Appellant essentially relied upon the following submissions:

The decision T 328/87 (OJ 1992, 701) indicated what criteria applied when deciding whether an alleged prior use complied with the requirements of Rule 55(c) EPC, in particular which facts and evidence must be presented to be conclusive for the admissibility of an opposition based on an alleged prior use. Taking account of the documents cited in support of the prior used subject-matter, the date, the circumstances of the prior use, and the offer of further specified evidence by witnesses were complete in the sense of this decision, even in respect of the link between "Attachment 1" and "Attachment 2" by the term "M60" found on both documents. The use of such an abbreviation was quite common in the automotive industry. Furthermore the notice of opposition clearly set out the reasons why the subject-matter of claim 1 was considered to lack novelty or inventive step when compared to the subject-matter of the prior use. The Opposition Division had examined the allowability of the opposition instead of the admissibility, and consequently its decision had to be set aside.

VII. The Respondent requested dismissal of the appeal. Its submissions are summarised as follows:

The opposition was based on the alleged prior use by an

offer, an order and a delivery of a valve seat bushing machining apparatus. The documents supplied as evidence (Attachment 2 and Attachment 1) were only interconnected by the term "Zylinderkopf M60". Since such a short term "M60" was not conclusive and might be used for a large group of different components of an automobile, an unambiguous relation between the two documents was missing. Moreover, Attachment 1 did not indicate the ordered technical article, and the date on it did not allow any conclusions as to why the subject of the order was public at that time.

The evaluation of decision T 328/87 (*supra*) by the Appellant was wrong, and none of the facts and evidence submitted with the notice of opposition was sufficient to fulfill all three criteria mentioned in this decision when an alleged prior use was concerned. The facts as to *what* was used *when* and the further *circumstances* of the use were not elaborated to such an extent that the Opposition Division and the Patentee were enabled to form a definitive opinion on at least one ground of opposition raised, without the need to make further investigations. Therefore the requirements of Rule 55(c) EPC were not fulfilled.

The construction of the valve seat bushing machining apparatus shown in Attachment 2, which was allegedly the result of a project cooperation between the company GROB and the company BMW, was neither sufficiently clear to be understood nor was evidence given that this construction existed before the priority date of the patent in suit. Driving means, which were essential parts of the subject matter of the opposed patent, were lacking. According to decision T 541/92 in project cooperations like this the obligation of confidentially

between the partners had to be assumed, and thus the knowledge of the prior use was not publicly available.

Reasons for the Decision

1. The appeal is admissible.
2. *Admissibility of the opposition*
 - 2.1. Since the requirements of Article 99, 100, Rule 55(a) and (b) EPC are fulfilled the remaining question to be considered here is whether the requirements of Rule 55(c) are met, in particular whether at least one of the alleged actions of prior use was submitted in a manner so that a sufficiently clear "indication" of the facts, evidence and arguments presented in support of the lack of novelty or inventive step could be derived from the notice of opposition.
 - 2.2. Considering evidence based on an alleged prior use, in accordance with the case law of the Boards of Appeal the notice of opposition must indicate all the facts which make it possible to determine the date of prior use, what has been used, and the circumstances relating to the prior use in order to decide whether or not the subject of the alleged prior use was publicly available before the priority date of the patent in suit (see also decision T 328/87 referred to by the Opposition Division).

Furthermore, in relation to the concept of "indication" mentioned in Rule 55(c) EPC (see for example T 204/91, point 5) the scope and depth of substantiation of the prior use needs to be such as to enable the patentee

and the Opposition Division to see clearly just what attack was being mounted against the patent, and what evidential support was being adduced for the attack.

2.3. When considering the "indication" provided in the notice of opposition, the Board draws attention to the fact that the allegation of prior use is based on three different actions of a use namely an order ("Bestellung", Attachment 1), an offer ("Angebot", Attachment 2), and a delivery ("Lieferung"). In the absence of any evidence in respect of the object of the order and the delivery in themselves it is not considered conclusive as to exactly *what* was ordered or delivered *when*.

2.4. Considering now in detail whether the information provided in respect of the machine allegedly offered and shown in Attachment 2 meets the conditions indicated in point 2.2. above, the following can be derived from the notice of opposition:

In respect of *what* was the subject-matter of the prior use the Board is of the opinion that it is immediately apparent to the skilled person from the upper drawing in Attachment 2 that an apparatus for machining an annular valve seat and associated concentric valve guide is addressed, which apparatus follows the definition of the apparatus of claim 1 of the patent in suit.

In respect of *when* the prior use took place it is apparent from the information in respect of the text "Entwurf 11.05.90" and "Begutachtung mit Einwand 30.5.90" indicated on Attachment 2 that it was the Appellant's intention to show that Attachment 2 was

given to the company BMW before the priority date of the present patent.

In respect of the *circumstances* of the prior use, thus answering the question how the prior use became public, the Appellant offered evidence by hearing two witnesses, and indicated that these witnesses would confirm the Appellant's submission that the information shown in Attachment 2 was given to the company BMW without any obligation in respect of secrecy (see last four lines on page 2 of the notice of opposition).

- 2.5. The Board does not concur with the Opposition Division's opinion that the Opponent should have supplied written statements of the witnesses together with the notice of opposition. Rule 55(c) EPC stipulates only the requirement to present the facts and evidence within the opposition period which was fulfilled by nominating the witnesses submitting their addresses, and statements to be ascertained by the witnesses.
- 2.6. The respondent further held the view that the drawing (Attachment 2) did not show the apparatus in such a clear manner as to enable the patentee and the Opposition Division to compare it with the subject-matter of claim 1 of the opposed patent without making their own investigations. A skilled person would not consider it to be comparable with the subject-matter of claim 1, because no power means were shown or hinted at. Moreover, the notice "Begutachtung mit Einwand" (Opinion with objection) written on the drawing of Attachment 2 would indicate that the drawing did not show the machine which was actually ordered but possibly modified after that, and so it would be

ambiguous *what* the subject-matter of the alleged prior use was.

However, the Board is of the opinion that, because both the machining tool and a cylinder head are shown on the same drawing (Attachment 2), a skilled person immediately recognizes for what purpose this machine is intended, namely for machining of the valve seat shown in Attachment 4 and a valve guide having a diameter of 7^{H7} of the cylinder head (indicated on Attachment 3). This person knows that the different tools must be driven to be operable, and so he supposes self-evidently that there must be power means to drive the different tools. In this respect coupling parts are shown which indicate the purpose of a connection with power means when the machine is working (see the right end of the apparatus shown in the upper drawing of Attachment 2, "Schnitt A-A", and "Schnitt B-B"). It is also to be noted that in the notice of opposition the witnesses were offered the opportunity to confirm the presence of different power means (page 4, 2nd paragraph to page 5, 1st paragraph). Anyhow, if in the drawing Attachment 2 one or more features in comparison to the subject-matter of claim 1 of the patent are present or obvious to a skilled person or not, is a question of substantiation, and not of "indication" within the meaning of Rule 55(c) EPC.

- 2.7. The Respondent further raised doubts whether the information provided by Attachment 2 of the alleged prior use was publicly available because, according to decision T 541/92, in a project cooperation, which would appear to be the case here confidentiality between the development partners is to be assumed if there is no indication of public availability of the

information, particularly as the drawing Attachment 2 was obviously an original BMW-drawing, and had been submitted to the company GROB.

However, in its notice of opposition the Appellant submitted that there was no obligation of confidentiality between the company GROB and the company BMW, and offered evidence by witnesses to confirm this allegation. Again, the question whether there was indeed no confidentiality obligation concerns a substantive issue, and has not to be considered under the admissibility of the opposition in accordance with Rule 55(c) EPC.

- 2.8. Summarising, as set out in point 2.4. above, the notice of opposition contains sufficient detail, at least as regards the offer for a machine tool shown in Attachment 2, to allow the Patentee and the Opposition Division to understand the basis i.e. the facts and evidence in support of the attack of lack of novelty or inventive step of the subject-matter of claim 1 of the patent in suit. Therefore the requirement of Rule 55(c) EPC is met and consequently the opposition is admissible.

Since substantive examination by the Opposition Division has not yet been carried out, the case has to be remitted to the department of first instance for the substantive examination of the opposition.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau