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D E C I S I O N
of 11 September 2002

Case Number: T 0860/01 - 3.5.2

Application Number: 95103302.6

Publication Number: 0677829

IPC: G08B 17/00

Language of the proceedings: EN

Title of invention:

Fire alarm system

Patentee:

Nohmi Bosai Kogyo Kabushiki Kaisha

Opponent:

Caradon Esser GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 113(1), 117(1), 117(3),
EPC R. 55(c), 67, 72(1)

Keyword:

"Publication by demonstration explanation, offer for sale and sale"
"Proffered witness testimony considered unnecessary"
"Substantial procedural violation - (no)"
"Correct appreciation of legal and factual basis of opponent's case - (no)"
"Remittal - (yes)"

Decisions cited:

T 0142/97, T 0472/92, T 0241/99

Catchword:

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Case Number: T 0860/01 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 11 September 2002

Appellant: Caradon Esser GmbH
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Respondent: Nohmi Bosai Kogyo Kabushiki Kaisha
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Representative: Held, Thomas, Dr.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 3 July 2001
rejecting the opposition filed against European
patent No. 0 677 829 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: R. G. O'Connell
Members: M. Ruggiu
B. J. Schachenmann

Summary of Facts and Submissions

- I. This appeal is against the rejection of the opposition to European patent No. 677 829.
- II. The patent, which contains eleven claims, has not been amended. For the purposes of examining this appeal only claims 1 to 3 need to be considered; these read as follows:

"1. A fire detector (1) comprising:

a physical quantity detecting means (30, 31, 40, 41, 42) for detecting the physical quantity of a fire phenomenon, and
a receiving circuit (50) for receiving a physical quantity output from said detecting means having at least two determination values for the output level of said physical quantity detecting means (30, 31, 40, 41, 42) for detecting a fire,

characterized by:

a first determination value setting means (22) for setting a first determination value (Vu1) of said physical quantity detecting means,
a second determination value setting means (22) for setting a second determination value (Vu2) of said physical quantity detecting means having a larger deviation from the normal level of the output level than said first determination value (Vu1),
a first determination time setting means (22) for setting a first determination time (T1),
a second determination time setting means (22) for

setting a second determination time (T2) which is shorter than said first determination time (T1), and
a determining means (10) for determining that said physical quantity detecting means (30, 31, 40, 41, 42) is faulty if it is detected that the deviation of the output level of said physical quantity detecting means is larger than said first determination value (Vu1) for said first determination time (T1),
and for determining that said physical quantity detecting means (30, 31, 40, 41, 42) is faulty if it is detected that the deviation of the output level of said physical quantity detecting means is larger than said second determination value (Vu2) for said second determination time (T2).

2. A fire detector (1) according to claim 1, characterized in that

a false alarm warning is issued if it is detected that the output level of said physical quantity detecting means (30, 31, 40, 41, 42) is continuously larger than a first upper determination value (Vu1) for said first determination time (T1) or longer, or if it is detected that the output level of said physical quantity detecting means (30, 31, 40, 41, 42) is continuously larger than a second upper determination value (Vu2) for said second determination time (T2) or longer.

3. A fire detector (1) according to claim 1, characterized in that

a false alarm warning is issued if it is detected that the mean value of the output level of said physical quantity detecting means (30, 31, 40, 41, 42) is larger than a first upper determination value (Vu1) in said first determination time (T1), or if it is detected that the mean value of the output level of said physical quantity detecting means (30, 31, 40, 41, 42) is larger than a second determination value (Vu2) in said second determination time (T2)."

III. In the notice of opposition the opponent (now appellant) had requested revocation of the patent in its entirety on the grounds that the subject-matters of the claims of the patent were not new and did not involve an inventive step having regard to the description, advertisement and sale of fire detectors referred to as 3-D and 4-D and having the series designation 9100 and 9200.

IV. The following documents were cited in the notice of opposition as evidence to support the allegation that a fire-detector falling within the wording of the claims of the patent had been made available to the public before the priority date of the patent:

D1: Brochure "Multisensortechnik" published by the appellant opponent, undated;

D1a: Covering letter relating to D1, dated 14 July 1993 from appellant opponent to AEG Luxembourg S.a.r.l.;

D1b: Letter dated 26 July 1993 from the appellant opponent to Verlag Moderne Industrie AG;

- D1c: Letter dated 24 August 1993 to the appellant opponent from Ingenieur Beratung Baden Baden, acknowledging receipt of the brochure D1;
- D2: Extracts from the product catalogue of the appellant entitled "Brandmeldeanlagen", page 130, dated 1992/1993 and from the catalogue entitled "Brandmeldetechnik", pages 130, 131, dated 1993;
- D3: Extracts from the operating instructions for the alarm software 91 GRAF, from version 2.0, of the appellant opponent, dated April 1997;
- D4: Extracts from the operating instructions for the alarm software 92 GRAF, from version 2.0, of the appellant opponent, undated;
- D5: EEPROM address occupancy tables for fire alarm series 9100 and 9200 of the appellant opponent, undated.

In addition the notice of opposition named two witnesses to testify as to the technical functioning, as well as to the demonstration, explanation, offer for sale, and sale of the above-mentioned fire detectors and associated software to third parties without any obligation of confidentiality before the priority date of the patent.

- V. At oral proceedings on 21 June 2001 the opposition division rejected the opposition without hearing the proffered witness testimony, considering it irrelevant.
- VI. Oral proceedings were held before the board on 11 September 2002.

VII. The appellant opponent argued essentially as follows:

Substantial procedural violation - failure to call witnesses

The notice of opposition fully met the requirement as to sufficient indication of evidence and hence the decision of the opposition division to dispense with the proffered witness testimony was an abuse of discretion. The situation was on all fours with that referred to in decision T 142/97 (OJ EPO 2000, 358) at point 2.3. The notice of opposition included (section III) a feature analysis of claim 1 which had not been disputed and specified (section IV) how these features were implemented in the 3-D and 4-D fire detectors of the 9100 and 9200 series. In particular it indicated in the sentence bridging pages 5 and 6 that feature a7 of this analysis was implemented by means of a signal processor which declared a fault condition when the moving average of the physical quantity lay outside the range defined by maximum and minimum values.

In the paragraph bridging pages 4 and 5 it was indicated that fire detectors implementing the features of claim 1 were sold without any obligation of confidentiality to builders, operators and installation firms in the field of fire detection, explained to the staff of these firms in the course of training, and put into use by these purchasers. In this way the fire detectors were made available to the public.

Furthermore it was indicated at page 5 that the two witnesses named in section IX B of EPA Form 2300, which was part of the original notice of opposition, could

testify as to the technical functioning as well as to the demonstration, explanation, offer for sale, and sale of the above-mentioned fire detectors and associated software to third parties without any obligation of confidentiality before the priority date of the patent.

Point 2.1 of the decision under appeal showed that the opposition division had misunderstood the opponent's use of the documents D3 and D4. It had not been part of the opponent's case that these documents disclosed all the features of a fire detector which, if the documents concerned had been published before the priority date of the opposed patent, would have rendered the subject-matter of the patent old or obvious; rather they constituted corroborative evidence that an anticipating fire detector had been made available to the public, the exact working of which could be explained by the witnesses offered. Hence the opposition division's conclusion that the witness testimony could be dispensed with was based on a false premise.

Furthermore, the bald observation in the decision under appeal: "The opposition division notes that both of the witnesses are in the employ of the opponent or his successor in title." created the strong impression that this fact played a part in the opposition division's decision not to summon the witnesses. This was an improper consideration - effectively discounting credibility of the witnesses without hearing them - in an appropriate exercise of discretion and hence also constituted a substantial procedural violation.

VIII. The respondent proprietor argued essentially as follows:

The opposition division had acted within its discretion in not summoning the witnesses. In the decision under appeal at point 2.1 it was made clear that the opposition division had taken into account that which, on the opponent's own indication, the witnesses could be expected to say, ie a confirmation that the fire detector allegedly made available to the public before the priority date worked as specified in documents D1 to D5.

In particular, the opposition division, in arriving at its conclusion that the subject-matter of claim 1 of the opposed patent was new and inventive, had accepted the opponent's allegation of fact that a fire detector employing a smoothing filter to produce an eight-hour average whose level was monitored to detect excursions outside predetermined maximum and minimum values was prior art. What the opposition division had not accepted was the opponent's interpretative conclusion that such prior art was novelty-destroying for the claim. The opposition division's reasoning in this respect was correct, as could be seen from the different responses to a spike in the monitored physical quantity in a filter-based system as compared to a time-out based system as claimed in claim 1. In the latter a spike causes the timer, ie the "determination time", to be reset to zero whereas in the former a spike of sufficiently short duration would have little or no effect. Hence the appellant opponent's contention that a filter-implementation was a "black box" implementation of the functional language of claim 1 was not tenable.

In answer to a question from the board at oral proceedings the respondent proprietor conceded that

implementations involving generation and detection of mean-values featured in the embodiments described in the opposed patent and were the subject of dependent claim 3.

- IX. The appellant opponent requested that the decision under appeal be set aside, that the case be remitted to the opposition division and that the appeal fee be reimbursed.
- X. The respondent proprietor requested that the appeal be dismissed and that the patent be maintained.

Reasons for the Decision

- 1. The appeal is admissible.
- 2. The main issue in this appeal is whether the opposition division's conclusion that it could decide the opposition without hearing the offered witness testimony was well-founded (Article 113(1) EPC, Article 117(1) EPC, Article 117(3) EPC, Rule 72(1) EPC).
- 3. The board understands from the decision under appeal that the opposition division's conclusion that the witness evidence was irrelevant was based on the premise that the role of the witnesses would be to testify:
 - (i) that a fire detector having the features of documents D3 to D5 had been made available to the public and

(ii) that this fire detector determined that the physical quantity detecting means was faulty by detecting that the mean value of the output level of said physical quantity detecting means exceeded a threshold value.

In the view taken by the opposition division, documents D3 to D5 did not contain all the features of the fire detector as specified in claim 1 of the opposed patent and, in addition, a fault condition determination based on detection of a mean value exceeding a threshold was not an implementation of the claim. Hence, as the opposition division saw it, no purpose would be served by having these allegations substantiated by testimony.

4. In the judgement of the board, the opposition division's reasoning was legally **valid** in the sense that the truth of the premise would have justified the conclusion. In this respect the board agrees with the division that it has an inherent discretion under Article 117(3) EPC not to hear witness testimony which it has good reasons to regard as irrelevant. As the board understands the decision T 142/97 invoked by the appellant opponent, the latter decision confirms this view by pointing out that such testimony may not normally be disregarded without examining its relevance. It would, in the board's view, go too far to say that an offered witness must always be heard to examine this relevance; such a procedural rule would invite abuse. It is rather the case that a person offering witness testimony must provide an indication of the facts to be proved by the evidence sufficient to enable the relevance to be assessed without hearing the witness. This is part of the admissibility requirement of Rule 55(c) EPC (see decision T 241/99 of 6 December

2001 of this board (in a different composition) at point 4.3) and is, in the view of the board, a continuing procedural requirement in the evolving debate. In the oral proceedings before the board the appellant opponent accepted this view of the law, contending that he had met this requirement in that he had provided an indication of the facts sufficient to demonstrate the relevance of the witness testimony.

5. The opposition division's reasoning was, however, **unsound** in the sense that the premise was false, being based on an apparent misunderstanding of the opponent's case. Firstly, the opponent had not contended that documents D3 to D5 themselves contained all features of claim 1; they were submitted as corroborative evidence that the opponent had indeed an arguable case which would be substantiated in detail by the witness testimony. Secondly, the opposition division appears not to have fully appreciated the import of the opponent's submission in his letter of 31 August 2000, at point 4, in which he explained, *inter alia*, that the implementation (by an averaging process over a fixed period of eight hours) of the claim features was not contended to be subsumable under the literal wording of the claim (which specifies predetermined levels exceeded for (selectable) predetermined times). This letter referred to the original notice of opposition "to avoid repetition". The latter, in fact, pointed out at section V that dependent claim 3 specified detection of a mean value which was nothing other than the moving average employed in the opponent's fire detector as (allegedly) made available to the public. Thus the opponent's contention in section IV of the notice of opposition that all features of claim 1, including, in particular, features "a7" and "a8" in the opponent's

feature analysis, were implemented in the 3-D and 4-D fire detectors of the 9100 and 9200 series was to be understood in the same sense that dependent claim 3 was directed to particular embodiments of the invention specified in claim 1.

6. The respondent proprietor admits that a narrow literal interpretation of claim 1 would not be consistent with the references in the dependent claims and the description of embodiments to the detection of mean values exceeding threshold values as indicators of fault conditions. The board also has reservations about the interpretation of claim 1 offered by the respondent proprietor in oral proceedings in terms of a persistence check which is reset to zero by a signal spike.
7. The board considers it appropriate therefore to accede to the appellant opponent's request that the case be remitted to the opposition division for further prosecution. For the avoidance of doubt, the board emphasises that it wishes neither to preempt nor to prejudice the opposition division's conclusion as to the relevance of the offered witness testimony in the light of the clarification of the opponent's case which has emerged from this appeal and having regard to the proper construction of claim 1 in the light of the reference to detection of "mean value" in dependent claims and the described embodiments.
8. *Request for reimbursement of appeal fee (Rule 67 EPC)*
 - 8.1 Since, in the judgement of the board, the opposition division's decision not to hear the witnesses was based on a wrong appreciation of the facts in the case rather

than any violation of a procedural rule or principle no substantial procedural violation within the meaning of Rule 67 EPC was involved and hence the question of reimbursing the appeal fee does not arise.

- 8.2 The appellant opponent also submits that the observation in the reasoning in the decision under appeal that the offered witnesses were employees of the appellant constituted a substantial procedural violation insofar as it suggested that the opposition division, in deciding not to hear the witnesses had given weight to a factor which should not have entered into their consideration at all. The board interprets this admittedly somewhat enigmatic observation differently; it understands the opposition division to be alluding to the asymmetry consideration referred to in decision T 472/92 (OJ EPO 1998, 161), ie the fact that - as is typical when prior public use is alleged - the witness evidence lay within the power and knowledge of the opponent, so that it was reasonable to set a high standard in requiring an adequately detailed indication of facts, evidence and arguments presented in support of the opposition ground of lack of inventive step, so as to enable the proprietor to prepare a response and to enable the opposition division to assess the relevance of the witness testimony offered.

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. Sauter

R. G. O'Connell