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**Datasheet for the decision  
of 16 March 2007**

**Case Number:** T 0826/03 - 3.4.01

**Application Number:** 98923521.3

**Publication Number:** 1012608

**IPC:** G01R 7/00

**Language of the proceedings:** EN

**Title of invention:**

Electronic revenue meter with automatic service sensing

**Applicant:**

Schlumberger Resource Management Services, Inc.

**Opponent:**

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**Headword:**

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**Relevant legal provisions:**

EPC Art. 54, 56

**Keyword:**

"Novelty and inventive step (yes)"

"Insufficient proof as to the date of publication of a  
Canadian application"

**Decisions cited:**

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**Catchword:**

-



Case Number: T 0826/03 - 3.4.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.01  
of 16 March 2007

**Appellant:** Schlumberger Resource Management Services,  
Inc.  
Building 300  
5430 Metric Place  
Norcross  
GA 30092-2550 (US)

**Representative:** Schlieff, Thomas P.  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 28 January 2003  
refusing European application No. 98923521.3  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** B. Schachenmann  
**Members:** H. Wolfrum  
G. Assi

## Summary of Facts and Submissions

I. European patent application 98 923 521.3 (publication No. 1 012 608) corresponding to published international application WO-A-98/53332 was refused by a decision of the examining division dispatched on 28 January 2003, on the ground of lack of inventive step (Articles 52(1) and 56 EPC).

II. The examining division had based its judgement on the prior art documents:

D2: US-A-5 107 203 and

D3: CA-A-2 201 104.

The examining division had considered document D3 to belong to the prior art within the meaning of Article 54(2) EPC, based on a response of 5 December 2002 from the Canadian Intellectual Property Office (CIPO) to a corresponding enquiry by the EPO indicating a laid open date of 26 March 1997, which is well before the priority date of 19 May 1997 claimed by the present application.

III. On 24 March 2003 the applicant lodged an appeal against the decision and paid the prescribed fee. On 22 May 2003 a statement of grounds of appeal was filed by which the appellant requested that the contested decision be set aside and a patent be granted on the basis of the following documents:

**claims:** claims 1 to 12 filed with letter of 12 February 2001 and received on 14 February 2001;

**description:** pages 1, 4, 4bis and 52 filed with letter of 12 February 2001 and received on 14 February 2001;  
pages 2, 3, and 5 to 51 as published;

**drawings:** sheets 1/25 to 25/25 as published.

IV. Independent claim 1 of the appellant's request reads as follows:

*"1. An electronic electricity revenue meter (34) of the type which is used to collect metering data from a customer's site, said electronic revenue meter comprising:*

*(a) electrical system diagnostics package including:*

*(i) a microprocessor (44);*

*(ii) storage memory (45) suitably connected to the microprocessor; (44) and*

*(b) means (24) for storing revenue data representative of the usage of electricity at the location in which said revenue meter is installed;*

*characterized in that said electronic revenue meter is of the type which plugs into a meter socket and in that the electrical system diagnostics package further includes logic (30) for automatically determining the type of electrical system in which the revenue meter is installed."*

Claims 2 to 12 are dependent claims.

V. Pursuant to a communication of the Board dated 1 April 2005 indicating that the Board was inclined to share the examining division's view, the appellant, by letter of 26 August 2005, presented observations and documentary evidence which cast doubt as to whether document D3 had in fact been publicly accessible before the priority date of the present application.

VI. In an attempt to resolve the contradictory evidence on file as regards the publication date of document D3, the Board made another enquiry at CIPO to this effect on 29 March 2006. Although the enquiry was repeated on 8 August 2006, no response was ever received from CIPO.

### **Reasons for the Decision**

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. *Publication date of document D3*
  - 2.1 Document D3 relates to a Canadian national patent application based on an international application (PCT/US96/12053) filed at the USPTO, the corresponding international filing date being 22 July 1996. The international application at the basis of D3 claims a priority of 31 July 1995 from US application 08/509,367. It was not published under the PCT until 29 January 1998 (International publication number WO98/003880).

2.2 D3 itself indicates a publication date "(87) 1997/02/01". During examination the applicant had questioned the correctness of this date.

Nevertheless, the examining division had considered document D3 to belong to the prior art and relied in this respect on clarifying information received upon request from CIPO by an e-mail of 5 December 2002. The e-mail was signed by "Chief of Patent Operations" and enclosed a printout from a CIPO database "TECHSOURCE - PATENT ADMINISTRATION", subsection "Patent Application Data Maintenance", relating to the Canadian patent application no. 2201104 according to D3. This printout carries the date "2002/12/05" and time "08:52:28" and shows the entry "19970326" in the field "Laid Open Date". As explained in said e-mail, this laid open date designated the official date at which the application entered national phase in Canada and thus became available for public inspection.

2.3 In the appeal, the appellant has contested the validity of this information provided by CIPO and argued that, due to specific circumstances in the particular case at issue, the Canadian application according to D3 had not been made public at the date of entry into the national phase (which was 26 March 1997) but only much later, *ie* together with the publication date of the corresponding WO-family document, *ie* on 29 January 1998. According to the appellant, the alleged specific circumstances lay in the fact that initially WIPO did not recognize the priority date claimed in the international application underlying D3, due to an error committed by the USPTO as the receiving office under the PCT. It was only later in 1998 that, upon request of the applicant of D3,

CIPO legitimately recognized the claim to priority in the application according to D3. The appellant has submitted that, until the claim to priority was corrected and the priority date legally recognized by CIPO sometime in 1998, CIPO was obliged by law to maintain confidentiality of the Canadian application, which, as a matter of law, was therefore not available to the public without restriction.

- 2.4 As supporting evidence for its submission, the appellant has produced several documents filed as annexes ("Anlagen") 1 to 5 to its letter of 26 August 2005.

Annex 2 is considered most pertinent by the Board. It concerns an affidavit of a Mr. Thomas Gary O'Neill who identifies himself as senior partner of a Canadian law firm which acted as agents of record in Canada for the application with respect to document D3. Mr. O'Neill explains the problems occurring in application D3 for having the claimed priority date legally recognized. In particular, although the applicant of D3, when entering the application in Canada on 26 March 1997, had claimed, in the Entry Form, priority based on respective US application 08/509,367 of 31 July 1995, this claim to priority was not recognized during the PCT international phase and thus had no legal effect in Canada. Therefore, the relevant filing date for CIPO was the international filing date of 22 July 1996 so that the national application for Canada was not open to public inspection until 18 months after that date, *ie* until 22 January 1998. In this respect, the affidavit makes reference to exhibits "A" and "B" concerning relevant passages of the Canadian patent law

relating to the publication of national applications. Since the priority claim was not legally recognized by CIPPO (which did not happen before sometime in May/June 1998), Canadian patent law had obliged CIPPO to maintain confidentiality of national application D3 until 22 January 1998.

Moreover, the affidavit makes reference, as exhibit "D", to a printout of a screen relating to application D3 of the TECHSOURCE database of CIPPO, subsection "Patent Application Data Maintenance", and, as exhibit "E", to a printout relating to application D3 of the CIPPO website, obtained in August and September 2002, respectively.

Exhibit "D" dated "2002/08/30 - 16:19:03" as well as exhibit "E" dated "09/10/2002 - 02:05:25" mention a laid open date in Canada of application D3 of 29 January 1998. From a comparison with the date of 5 December 2002 of the TECHSOURCE printout relied on by the examining division, the affidavit concludes that sometime between 10 September 2002 and 5 December 2002 the laid open date must have been changed in the CIPPO data system from 29 January 1998 to 26 March 1997 and that, however, at least until 10 September 2002, CIPPO considered that the Canadian application according to D3 was not open to public inspection until the PCT publication date of 29 January 1998.

- 2.5 As regards the publication date of document D3, the Board is thus faced with contradictory evidence. If D3 had been publicly accessible at the earlier date, *ie* from 26 March 1997 onwards, its teaching would belong to the prior art within the meaning of Article 54(2)



EPC, whereas the later date, *ie* 29 January 1998, would altogether disqualify D3 as prior art.

2.6 For an attempt to evaluate the various pieces of evidence on file, it seems reasonable to give the expression "laid open date" used for a data field in the Canadian patent database the normal meaning which it has for other patent systems, like that of the EPO, namely that the content of an application is made publicly available from that date onwards. Moreover, given the facts that, when entering into the national phase in Canada, the applicant of D3 expressly claimed the priority of its earlier US application from 1995, and that more than 18 months had passed from the claimed priority date 31 July 1995, it may well be asked what would in fact have prevented the CIPO to immediately allow public file inspection at the date of entry into the national phase, *ie* from 26 March 1997 onwards.

Furthermore, it seems reasonable to assume that in official databases amendments normally serve the purposes of correcting or supplementing existing entries and that therefore the most recent information should be considered to be the correct one. Thus in the case of the TECHSOURCE database of CIPO, one may indeed wonder what sense it would have made for CIPO to change the entry for the laid open date sometime between September and December 2002 from the later date 29 January 1998 to the earlier date 26 March 1997 if public access to the application had never been possible at the earlier date.

2.7 Nevertheless, the above considerations, however plausible they may appear, are only speculations. In the absence of any additional corroborating evidence, the Board cannot refute with sufficient certainty the appellant's allegation that in the specific case at issue the dispute between the applicant of D3 and the various patent offices concerned as regards the validity of the claimed priority of 31 July 1995 has affected the public access to the content of the application according to D3 and in fact delayed its publication date until 29 January 1998.

As a matter of principle, if an adverse decision of an organ of the EPO is to rely on a certain fact that fact should be proven beyond any reasonable doubt. In the present case, in view of the contradictory evidence on file and in the absence of any further clarifying information on the part of CIPO, it is virtually impossible for the Board to establish with certainty that the public had access to the Canadian application according to document D3 before the priority date claimed by the present application.

2.8 For the above reasons, the Board considers document D3 as not belonging to the prior art within the meaning of Article 54(2) EPC.

3. *Novelty and inventive step (Articles 52(1), 54 and 56 EPC)*

3.1 The examining division had considered D3 to constitute the closest prior art and to disclose an electronic electricity revenue meter from which the subject-matter of claim 1 under consideration differed only in that it

was a meter "of the type which plugs into a meter socket". The examining division further held that a plug-in type connection for an electricity meter was a well known feature in the art as exemplified by D2 so that equipping the meter according to D3 with a plug-in type connector was a matter of simple and obvious choice and even constituted a triviality.

Since document D3 is no longer considered to be part of the prior art, the reasons given for the decision under appeal have become obsolete.

- 3.2 For the sake of completeness the Board notes that novelty of the subject-matter of claim 1 under consideration with respect to the teaching of document D3 was never in dispute and that in fact the content of European patent family member EP 0 862 746 corresponding to D3 and constituting a state of the art according to Article 54(3)(4) EPC does not destroy the novelty of the claimed subject-matter either.

Finally, in the Board's view, none of the further documents of the available prior art discloses or hints at an electronic electricity revenue meter comprising an electrical system diagnostics package which includes logic for automatically determining the type of electrical system in which the revenue meter is installed.

For these reasons, the Board considers the subject-matter of claim 1 to be novel and to involve an inventive step and thus to comply with the requirements of Articles 52(1), 54 and 56 EPC.

4. Moreover, the Board has no reason to doubt that the application documents according to the appellant's request meet the requirements of the EPC.

Therefore, appellant's request on file is considered allowable.

## **Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the examining division with the order to grant a patent on the basis of the following application documents:

**claims:** claims 1 to 12 filed with letter of 12 February 2001 and received on 14 February 2001;

**description:** pages 1, 4, 4bis and 52 filed with letter of 12 February 2001 and received on 14 February 2001;

pages 2, 3, and 5 to 51 as published;

**drawings:** sheets 1/25 to 25/25 as published.

The Registrar:

The Chairman:

R. Schumacher

B. Schachenmann

