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D E C I S I O N
of 4 October 2004

Case Number: T 1110/03 - 3.5.2

Application Number: 92908256.8

Publication Number: 0569556

IPC: H02P 9/00

Language of the proceedings: EN

Title of invention:
Variable speed wind turbine

Patentee:
GENERAL ELECTRIC COMPANY

Opponents:
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II. NEC MICON A/S
III. Flygtekniska Försöksanstalten
IV. ENERCON GmbH
V. Lagerwey Windturbine BV
VI. ALSTOM UK Ltd
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VIII. WEIER Elektromotorenwerke GmbH & Co. KG
IX. Südwind Energiesysteme GmbH
X. Pro + Pro Energiesysteme GmbH & Co. KG

Headword:
-

Relevant legal provisions:
EPC Art. 113(1), 117(1)

Keyword:
"Postpublished documents submitted as evidence of technical prejudice disregarded by opposition division - substantial procedural violation - remittal"
"Computer generated slideshow presentation in oral proceedings - danger of unfairness"

Decisions cited:
T 1122/01

Headnote:

I. When evaluating evidence it is necessary to distinguish between a document which is alleged to be **part of the state of the art** within the meaning of Article 54(2) EPC - in the sense that the document itself is alleged to represent an instance of what has been made available to the public before the priority date of the opposed patent - and a document which is not itself part of the state of the art, but which is submitted as evidence of the state of the art or in substantiation of any other allegation of fact relevant to issues of novelty and inventive step.

II. In the first situation, a document is **direct evidence** of the state of the art; its status as state of the art cannot normally be challenged except on authenticity. In the second situation, a document is also **evidence** albeit **indirect**; it provides a basis for an inference about, eg the state of the art, common general knowledge in the art, issues of interpretation or technical prejudice etc - an inference which is subject to challenge as to its plausibility.

III. Only a document of the first kind can be disregarded on the sole ground that it is postpublished; documents of the second kind do not stand or fall by their publication date even on issues of novelty and inventive step.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1110/03 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 4 October 2004

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 21 August 2003 revoking European patent No. 0569556 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: R. G. O'Connell
B. J. Schachenmann

Summary of Facts and Submissions

I. This is an appeal by the proprietor against the revocation by the opposition division of European patent No. 569 556. The reasons given for the revocation were that the subject-matter of claim 1 of the patent as granted was not new, that claim 1 of the first auxiliary request included an impermissible amendment, and that claims 1 of the remaining four auxiliary requests did not involve an inventive step.

II. The following prior art documents were relied on in the reasoning of the decision under appeal:

P5: A variable speed wind generating system and its test results. Matsuzaka et al.
European Wind Energy Conference and Exhibition, 10-13 July 1989.
(Found in the decision under appeal to be novelty-destroying for claim 1 of the patent as granted).

P20: Doppeltgespeister Drehstromgenerator mit Spannungszwischenkreisumrichter im Rotorkreis für Windkraftanlagen. D. Arsudis, Dissertation. Technische Universität Carolo-Wilhelmina zu Braunschweig. 1989.
(Found in the decision under appeal to be not novelty-destroying for claim 1 of the second auxiliary request).

P13: Power Electronics: Converters, Applications, and Design. N. Mohan. J. Wiley & Sons, Inc. 1989.
(Found, on the basis of a computer generated slideshow presentation of a compilation of

extracts thereof given at the oral proceedings before the opposition division and documented in the minutes thereof, to deprive claims 1 of the second, third, fourth and fifth auxiliary requests of inventive step).

III. The proprietor had filed 15 documents (documented in the decision under appeal under the designations P43 to P57) with his response of 28 September 2000 to the oppositions as evidence that the common general knowledge in the art "up to and past the priority date of the patent" taught away from the invention underlying the patent. Most of these documents had been published after the priority date of the opposed patent. As noted in the decision under appeal at page 11, in a communication dated 12 March 2003 presenting its preliminary opinion in preparation for oral proceedings the opposition division had stated that: "the priority being validly claimed, the documents filed (sic) after the priority date will not be taken into account into for the examination of novelty and inventive step."

IV. The appellant proprietor argued *inter alia* as follows:

The opposition division's refusal to consider documents P43 to P50, P52, P54 and P55, which had been filed and their relevance substantiated in due time, on the sole ground that they were published after the priority date of the opposed patent infringed the proprietor's fundamental rights to free choice of evidence and to be heard, contrary to the requirements of Article 117(1) EPC and Article 113(1) EPC.

In addition the proprietor's right to have oral proceedings conducted fairly was infringed by virtue of the opposition division permitting opponent VI to make an hour long computer generated slideshow presentation containing many very complicated slides at the second day of the oral proceedings. It was not reasonable to expect the proprietor to respond in the framework of oral proceedings to such a detailed and complex 'redaction' based on a hindsight interpretation of P13 which 'redaction' the proprietor was confronted with for the first time in the oral proceedings.

V. Respondent opponent I argued *inter alia* as follows:

The documents published after the priority date could not be used for the purpose of interpreting documents published before the priority date. The strict principle of solely taking documents published before the priority date into account when assessing patentability, except with regard to prior rights, should be adhered to.

VI. Respondent opponent VI argued *inter alia* as follows:

(a) The appellant proprietor sought to use the post-priority date documents to show a technical prejudice. In accordance with established jurisprudence of the EPO Boards of Appeal the prejudice must have existed at the priority date and was normally to be demonstrated by reference to the literature or to encyclopaedias. Any prejudice which might have developed later was irrelevant in assessing inventive step; cf T 341/94, T 531/95, and T 452/96.

(b) The appellant proprietor's allegation that the computer generated slideshow presentation was tantamount to the submission of a document published after the priority date was not sustainable. Everything in the presentation was based directly on the prepublished document P13 which had been introduced into the proceedings at an early stage and the relevant parts of which had already been pointed out in opponent VI's letter dated 30 Sept 1999, including the cross-referencing mentioned in the presentation at oral proceedings before the opposition division. It was inherent in opposition proceedings that interpretation and argument occurred after the priority date of the opposed patent. There was no question of an unfair surprise in the presentation; it was at most a late argument which, according to G 4/92 could always be raised by an opponent. It had not been possible to provide the proprietor with a copy of the computer generated slideshow presentation materials before the oral proceedings as it was not in its final form until shortly before 09:00 on the second day of the proceedings.

VII. Respondent opponents VII and X made submissions on the merits but did not address the procedural issues referred to above. Two opponents (II and IV) withdrew their oppositions during the appeal proceedings. The remaining respondent opponents did not make submissions.

VIII. The appellant proprietor's main request was that the decision under appeal be set aside and the case remitted to the department of first instance.

IX. The respondent opponents requested that the appeal be dismissed. In addition respondent opponent I requested that oral proceedings be appointed in the event that the board was minded to maintain the patent in any form.

Reasons for the Decision

1. The appeal is admissible.

2. *Disregarding of evidence filed in due time*

2.1 In the proceedings culminating in the decision under appeal the opposition division apparently failed to distinguish between a document which is alleged to be **part of the state of the art** within the meaning of Article 54(2) EPC - in the sense that the document itself is alleged to represent an instance of what has been made available to the public before the priority date of the opposed patent - and a document which is not itself part of the state of the art, but which is submitted as evidence of the state of the art or in substantiation of any other allegation of fact relevant to issues of novelty and inventive step. In the first situation, a document is **direct evidence** of the state of the art; its status as state of the art cannot normally be challenged except on authenticity. In the second situation, a document is also **evidence** albeit **indirect**; it provides a basis for an inference about, eg the state of the art, common general knowledge in the art, issues of interpretation or technical prejudice etc - an inference which is, of course, subject to challenge as to its plausibility.

2.2 Only a document of the first kind can be disregarded on the sole ground that it is postpublished, since it is then on its face not what it was alleged to be and hence manifestly irrelevant to the contention it purports to substantiate. Even then the party submitting the document must be given an opportunity to show that the publication date is not what it appears to be, eg by providing convincing evidence of a misprinted date.

2.3 Documents of the second kind do not stand or fall by their publication date even on issues of novelty and inventive step. Thus a dictionary is by definition an account of the meanings of words which existed prior to the publication date of the dictionary - sometimes centuries or even millennia earlier - which could bear on the issue of interpretation and hence novelty. Similarly a technical review article is by definition an account of the common general knowledge in the art prior to its own publication date - which could bear *inter alia* on the issue of enabling disclosure of a prepublished document and hence on the novelty of claimed subject-matter. By the same token the best counter to a contention that an alleged technical prejudice had been overcome significantly earlier than the priority date of a patent application would be the filing of evidence that it persisted long after the priority date - the later the better. Evidence of commercial success attributable to the technical qualities of an invention as a secondary indicator of inventive step also belongs in this inherently *post factum* evidence category.

2.4 Apart from it being illogical to disregard indirect evidence relating to the issues of novelty and inventive step on the sole ground that it was postpublished, it deprives the party of a basic legal procedural right generally recognised in the contracting states and enshrined in the EPC in Article 117(1) EPC and Article 113(1) EPC, viz the right to give evidence in appropriate form, specifically by the production of documents (Article 117(1)(c) EPC, and the right to have that evidence heard. It has been repeatedly emphasised in decisions of the EPO Boards of Appeal that the right to be heard represents a fundamental legal value and that its non-trivial breach constitutes a substantial procedural violation.

2.5 Hence the board judges it appropriate to accede to the appellant proprietor's request that the case be remitted to the opposition division for first instance consideration of the disregarded evidence and the arguments based thereon.

2.6 Since the appellant in the present case was obliged to file this appeal to obtain a legal procedural right, reimbursement of the appeal fee pursuant to Rule 67 EPC is equitable.

3. *Computer generated slideshow presentation in oral proceedings*

3.1 The appellant proprietor has also objected to the manner in which opponent VI was permitted to argue his case at oral proceedings before the opposition division by means of an hour long computer generated slideshow

presentation containing many complex slides. This material is documented in the minutes of the oral proceedings and is referred to in the decision under appeal as having convinced the opposition division that claim 1 of the third auxiliary request before the opposition division did not involve an inventive step.

3.2 In decision T 1122/01 of 6 May 2004 EPO Board of Appeal 3.4.2 observed that a computer generated slideshow presentation is in essence the presentation of written material which, strictly speaking, belongs in the written procedure rather than in oral proceedings; point 2.1 of the decision. The use of visual aids such as simple flipchart sketches or slides, or indeed short films demonstrating the working of a machine, are normally unobjectionable, but the present board concurs with the view expressed in the above-mentioned decision that there is a danger of a degree of unfairness creeping in in the unrestricted use of computer generated slideshow presentations in oral proceedings. The sheer quantity and concentration of visual material can alter the quality of the presentation of an argument in such a way as to depart from the basic purpose of the oral proceedings, viz to give the parties an opportunity to present the main points of their arguments orally. An oral presentation is inherently limited in the rate at which information is presented; in a well-mannered presentation it allows time for information to be absorbed and notes to be made for future reference, both by the parties and the division or board. If it doesn't the chair will intervene to ask the speaker to slow down, especially if simultaneous interpretation is being provided. This

naturally induced pace also creates a pressure on the presenter to concentrate on essential points.

3.3 By contrast, in a presentation of pre-prepared graphic material the balance is subtly shifted in favour of the presenter. Since reading speed is significantly faster than talking speed (as much as ten times faster for trained rapid readers) the net result is that the party on the receiving end has less thinking and note-taking time per unit of information communicated as he will be under psychological pressure not to appear to be a slow reader. The faster pace will tend to be used by the presenter to squeeze in more material. As was pointed out also in the above-mentioned decision this potential unfairness can be mitigated by providing the other parties and the division or board with copies of the material to be presented in good time before the oral proceedings. This takes account of the fact that such material has significant written procedure character and indeed raises the question whether it is then appropriate for it to be rehashed in the oral proceedings. Where simultaneous interpretation is provided it would appear to be well-nigh impossible to accommodate such a computer controlled slideshow presentation.

3.4 Since this case is to be remitted and the appeal fee reimbursed pursuant to the board's findings above, the question of whether a (further) substantial procedural violation was involved in the opposition division permitting the computer generated slideshow presentation in the oral proceedings which led to the decision under appeal can be left open. This board is far from suggesting that such presentations constitute

per se substantial procedural violations. It merely observes that the opposition division needs to be vigilant to ensure that the proceedings do not lose their basic oral character to the unfair detriment of the viewing and listening party. In the present case the remittal will give the appellant proprietor a first instance hearing of his considered response to the computer controlled slideshow presentation based on P13.

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.

3. The appeal fee shall be reimbursed.

The Registrar: The Chairman:

D. Sauter W. J. L. Wheeler