

Decision of Technical Board of Appeal 3.3.07 dated 30 June 2005

T 474/04 - 3.3.07

(Language of the proceedings)

Composition of the board:

Chairman: R. E. Teschemacher

Members: R. S. Wibergh

B. J. M. Struif

B. L. ter Laan

H. Preglau

Patent proprietor/Appellant: ALTHIN MEDICAL, INC.

Opponent 01/Respondent: B. Braun Melsungen AG

Opponent 02/Respondent: Fresenius Medical Care Deutschland GmbH

Headword: Declaration in lieu of an oath/ALTHIN MEDICAL

Article: 113(1), 117(1) EPC

Rule: 67 EPC

RPBA Art. 10

Keyword: "Declaration in lieu of an oath (eidesstattliche Versicherung)" - "Affirmations made in a declaration contested, witness offered but not summoned - substantial procedural violation" - "Remittal (yes)"

Headnote

If assertions made in an unsworn witness declaration ("eidesstattliche Versicherung") remain contested, as a rule a request from a party to hear the witness must be granted before these assertions are made the basis of a decision against the contesting party.

Summary of facts and submissions

I. This is an appeal against the decision of the opposition division dated 6 February 2004 to revoke European patent No. 0 668 793.

II. The mention of the grant of the patent was published on 5 April 2000. Subsequently the patent was opposed by the two respondents. On 24 June 2002 a first decision to revoke the patent was issued, but since it had been taken by an opposition division in a composition not complying with Article 19(2) EPC it was set aside on appeal (T 838/02 dated 29 January 2003). After remittal of the case, a second decision to the same effect (the decision under appeal) was taken by the opposition division in a different composition.

III. The following documents will be referred to in the present decision:

D12: CMS 08 - Handbuch, Fresenius AG Medizintechnik, 4 ed. 1988

D14: Declaration (eidesstattliche Versicherung) by Mr Spickermann of 27 December 2000 concerning the alleged prior use by Respondent 02 of a haemodialysis machine at the conference EDTA (European Dialysis and Transplant Association) held in Paris from 28 June to 1 July 1992.

IV. The invention concerns a haemodialysis machine having a user/machine interface configured as a touch screen. According to the decision under appeal, the subject-matter of claim 1 of the main request involved an inventive step with respect to all the written prior art. However, the claimed subject-matter was held to be obvious in view of the prior use described in D14 taken in combination with document D12. The same conclusion was drawn for claim 1 as amended in accordance with the auxiliary request. With reference to decision T 674/91 of 30 November 1994 (not published in OJ EPO) the opposition division held that it was not necessary to summon the author of D14 as a witness since his statement was "clear in terms of the scope of the apparatus which was demonstrated to the public" (decision, points 2.1 to 2.3).

V. In the grounds of appeal, the Appellant (Patent Proprietor) requested that the patent be maintained as granted. It was argued that the opposition division had been wrong to decide that the prior use had been properly substantiated. The evidence consisted of some photographs and the declaration D14, but it was impossible to discern from these photographs whether the monitor was a touch screen. Respondent 02 had admitted at the oral proceedings before the opposition division that the exhibited system was not operable. The statements in the declaration were unsupported allegations. There was no indication that the operational characteristics of the touch screen user/machine interface had actually been demonstrated and therefore made available to the public as required by Article 54(2) EPC. In fact, another participant at the conference, Mr Kelly, had not seen such a touch screen user/machine interface and no such device had been demonstrated to him. An affidavit by Mr Kelly was on file. Thus, Respondent 02 had not proved its case up to the hilt. If the Board intended to decide that the disclosure had been properly substantiated, the Appellant requested that Mr Spickermann be summoned to give his evidence orally.

VI. In reply to the grounds of appeal, Respondent 01 requested that the appeal be dismissed and, as an auxiliary request, that oral proceedings be appointed. It was argued that the invention was obvious with respect to the written prior art. An additional piece of written prior art was cited. The alleged prior use was not mentioned.

VII. Respondent 02 in its reply requested that the appeal be dismissed. Both the alleged prior use and the written art were discussed. A further declaration by Mr Spickermann was filed and three new witnesses were indicated. Several new documents were cited, some of which concerned the prior use.

VIII. In a communication dated 3 February 2005, the Board expressed its opinion that the opposition division should have summoned Mr Spickermann as a witness since he was available and his testimony turned out to be important for the decision. In accordance with Article 111(1) EPC, two options were open to the Board. Either the decision would be set aside and the case remitted to the opposition division for further prosecution, including the hearing of any necessary witnesses, or the Board would continue the examination in order to arrive at a final decision without further delay. The parties were invited to comment.

IX. In reply, the Appellant and Respondent 02 requested that the case be remitted to the opposition division. The Appellant submitted that remittal was particularly appropriate in view of the new documents that had been cited by the respondents in the appeal proceedings and had not previously been evaluated by the opposition division.

X. Respondent 01 pointed out that a remittal would mean discussing the case for the third time before the opposition division. This would cause considerable extra costs for the parties although the EPO alone was responsible for the remittals. The opposition division had committed no substantial procedural violation which might justify referring the case back.

XI. In a second communication, dated 15 April 2005, the Board announced and gave reasons for its intention to remit the case to the opposition division. Respondent 01 was given a time limit until 29 April 2005 to indicate whether it maintained its request for oral proceedings as far as this question was concerned.

XII. By letter dated 28 April 2005 Respondent 01 withdrew its request for oral proceedings.

Reasons for the decision

1. The appeal is admissible.

2. The reason for the revocation of the patent-in-suit was that the invention did not involve an inventive step over the prior use evidenced by D14. The written prior art alone did not, in the opposition division's opinion, render the invention obvious. Thus, the probative value of D14 was decisive for the conclusions in the decision under appeal.

3. D14 is an "eidesstattliche Versicherung". This is a declaration made in lieu of an oath, ie unsworn. Its author, Mr Spickermann, is in the employ of Respondent 02. It concerns Respondent 02's alleged demonstration of a haemodialysis machine at a conference which took place in Paris from 28 June to 1 July 1992. Two photos of the apparatus are attached. It is stated that the machine, whose features are enumerated, and the way it worked was shown to any interested person without obligation of confidentiality.

4. The Appellant contests the affirmations made in D14. Already in the proceedings before the opposition division, the Appellant requested that Mr Spickermann be summoned as a witness (letter dated 21 October 2002, p.8), and this request has been repeated in the grounds of appeal. Respondent 02 has all the time been prepared to offer Mr Spickermann as a witness (see eg the minutes of the oral proceedings before the opposition division, p.4). The opposition division did not summon Mr Spickermann since his declaration was "clear in terms of the scope of the apparatus which was demonstrated to the public", pointing out that according to decision T 674/91 (supra) one purpose of a declaration was to avoid having to call the person who had made it.

5. Hence, the patent was revoked on the basis of contested submissions made in declaration D14, in spite of Respondent 02 expressly offering, and the Appellant expressly requesting, that its author be heard.

6. The EPO admits eidesstattliche Versicherungen as possible means for providing evidence (see Case Law of the Boards of Appeal of the EPO, 4th edition, 2001, VI.J.2). However, under German law it is not one of the usual forms of evidence. It is admissible only in particular cases and has a lesser probative value than the usual means. In particular, it has a lesser probative value than a witness testimony. The Federal Patents Court in Germany (Bundespatentgericht) has therefore concluded that if assertions made in an eidesstattliche Versicherung remain contested, a request from a party to hear the witness must be granted (see Bundespatentgericht decision 6 W (pat) 21/89 BPatGE 32,11). The question whether or not the EPO is an authority entitled to accept eidesstattliche Versicherungen, with the effect that a false declaration is considered as a criminal act within the meaning of § 156 of the German Strafgesetzbuch (StGB) appears to have not yet been raised in previous case law. The Board notes that according to § 27(1), first sentence, of the German Verwaltungsverfahrensgesetz (VwVfG) only those public authorities may accept eidesstattliche Versicherungen which are specifically authorised by law to do so. For the purposes of this decision, this aspect does not need to be dealt with in more detail since even a simple declaration can be a means of evidence within the meaning of Article 117(1) EPC.

7. According to the "Guidelines for Examination in the European Patent Office" the opposition divisions of the EPO should follow this approach in general (and indeed even in the case of sworn declarations) since a declaration does not allow the opposition division "to assess the associated or background factors" (Chapter E-IV, 1.2). It is recommended that if "the alleged facts are contested by the other party, the Opposition Division does not generally

base its decision on such a statement, but summons the person making the statement as a witness, if so offered by the party".

8. The approach taken in BPatGE 32, 11 and recommended in the Guidelines (*supra*) is justified since a written declaration can only be taken as it is. There is no possibility of verifying whether or not it reflects what actually happened. In case a witness is heard, there are many approaches how the reliability of his testimony may be scrutinized. These may *inter alia* concern the memory of the witness, the question whether his testimony is based on his own observations or on conclusions drawn by him, or on information from others, the question whether the testimony is corroborated by other means of evidence, the question whether the witness was able to observe what he claims to have observed. They may also concern the witness himself, factors which may indicate that he tells the truth or, on the contrary, that his testimony is based on an error in perception or recollection, or that he is not willing to tell the whole truth and nothing but the truth. Therefore, the offer that the author of a declaration be heard as a witness is a relevant and appropriate offer of evidence which may disprove the content of the declaration.

The principle of free evaluation of evidence applying in the proceedings before the EPO is not a justification for refusing such an offer. Free evaluation of evidence means that there are no firm rules according to which certain types of evidence are, or are not, convincing. It does not mean that the deciding body can choose the evidence which it considers sufficient for finding the truth. Instead, the question whether a fact can be regarded as proven has to be assessed after having taken all the relevant evidence (G 3/97, OJ EPO 1999, 245, Reasons, point 5). To assume that the content of a written declaration cannot be disproved by hearing its author as witness would amount to an anticipated assessment of evidence which actually has not been taken (cf T 927/98 of 9 July 1999, not published in OJ EPO, Reasons, point 2.3.5), unless the deciding body ascertains specific facts justifying such a conclusion under the circumstances of an individual case.

9. The opposition division has referred to decision T 674/91 (*supra*) where it is stated:

"Since one object of such form of evidence is to avoid the hearing as witness of the undersigning person, it seems to be superfluous to confirm the context of these statements by the hearing of the concerned persons, as suggested by the Appellant" (Reasons, point 3.1).

The main questions there were whether a copy of the declaration rather than the original document could be used as evidence, and whether leading questions had possibly been put to the undersigning person. As said in the decision, the *context* of the statements was at issue. The present case is different in that fundamental assertions made in the declaration are contested, the author has been offered as a witness, and the Appellant has consistently demanded that he be heard.

10. The opposition division's decision not to summon Mr Spickermann as a witness although he was available handicapped the Appellant in its defence against what turned out to be the decisive piece of evidence. The Appellant was effectively prevented from having his evidence considered that the prior use had not taken place in the way as alleged by Respondent 02 (see also T 1070/98 of 4 July 2000, not published in OJ EPO, Reasons, point 5). This was all the more inappropriate since the prior use was the Respondent's own and the evidence therefore largely lay "within the power and knowledge of the opponent" (T 472/92, OJ EPO 1998,161). Thus, the opposition division infringed the Appellant's right to be heard (Article 113(1) EPC). This constitutes a substantial procedural violation, something which in the absence of special reasons justifies the remittal of a case to the department of first instance (Article 10 of the Rules of Procedure of the Boards of Appeal, OJ EPO 2003,89).

11. The Appellant and Respondent 02 have agreed to the Board remitting the case to the opposition division. However, Respondent 01 has argued that the opposition division had discretion to decide whether to hear the witness. There was therefore no substantial procedural violation and no reason to remit. Furthermore, a remittal would be unacceptable because of the extra costs to the parties caused by the EPO alone.

12. Respondent 01's irritation over a second remittal on formal grounds may be understandable. However, it is the Appellant who was mainly affected by the substantial procedural violation committed by the opposition division, and

therefore this party's request for remittal deserves particular consideration. The fact that more prior art has been filed on appeal and further witnesses have been offered constitutes an additional reason for the Board not to examine the appeal on its merits. As the Board has handled this case with priority and the opposition division can also be expected to do so, the delay can be kept to a minimum. Thus, the case is remitted to the opposition division for further prosecution.

13. The reimbursement of the appeal fee in accordance with Rule 67 EPC is equitable by reason of the violation of Article 113(1) EPC which has caused the remittal.

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.
3. Reimbursement of the appeal fee is ordered.