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**Datasheet for the decision
of 28 May 2009**

Case Number: T 0659/07 - 3.2.04

Application Number: 99941416.2

Publication Number: 1112448

IPC: F03D 11/00

Language of the proceedings: EN

Title of invention:

Lightning protection for wind turbine blade

Patentee:

LM GLASFIBER A/S

Opponent:

Vestas Wind Systems A/S

Headword:

-

Relevant legal provisions (EPC 1973):

EPC Art. 100c), 107, 123(2)

Keyword:

"Patent maintained in amended form in accordance with
auxiliary request"

"Appeal by the patentee"

"No evidence for substantial procedural violations; remittal
to Opposition Division (no)"

"Main and first auxiliary requests - added subject-matter
(yes)"

"Exception to the principle of prohibition of *reformatio in
peius* (no); remittal (no)"

Decisions cited:

G 0009/92, G 0004/93, G 0001/99, T 0169/83, T 0818/93,
T 1178/04

Catchword:

If the patentee is the sole appellant, the patent as maintained by the opposition division in its interlocutory decision cannot be objected to by the Board of Appeal either at the request of the respondent/opponent or *ex officio*, even if the patent as maintained would otherwise have to be revoked on the ground that a feature present in both claim 1 as granted and as maintained amended introduces added subject-matter contrary to Article 123(2) EPC.



Case Number: T 0659/07 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 28 May 2009

Appellant:
(Patent Proprietor)

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Respondent:
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Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
22 February 2007 concerning maintenance of
European patent No. 1112448 in amended form.

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
T. Bokor

Summary of Facts and Submissions

I. In its interlocutory decision posted 22 February 2007, the Opposition Division found that, taking into consideration the amendments made by the patent proprietor, the European patent and the invention to which it relates met the requirements of the EPC. On 20 April 2007 the Appellant (Patentee) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 2 July 2007.

II. The patent was opposed on the grounds based on Article 100(a), (b) and (c) EPC. According to the minutes and the decision, during the oral proceedings before the Opposition Division the Opponent withdrew the grounds for opposition under Article 100(b) EPC, and under Article 100(c) EPC (except for the feature "wall").

III. Following a communication in which the Board of Appeal informed the parties of its preliminary opinion of the procedural issues in the case, oral proceedings took place on 28 May 2009 before the Board of Appeal.

IV. Claim 1 as granted reads as follows:

"1. A wind turbine blade of fibre glass and/or carbon fibre comprising a conventional inner lightning conductor cable (5), characterised in that the blade comprises oblong strips (1,2,3) of carbon fibre-reinforced plastics, and that the inner lightning conductor cable (5) and the oblong strips (1,2,3) at

regular intervals are interconnected by means of conductors (6)."

Claim 1 of the first auxiliary request reads as follows:

"1. A wind turbine blade of fibre glass and/or carbon fibre comprising a conventional inner lightning conductor cable (5), characterised in that the blade comprises oblong strips (1, 2, 3) of carbon fibre-reinforced plastics, and that the inner lightning conductor cable (5) and the oblong strips (1, 2, 3) at regular intervals are interconnected by means of conductors (6), the oblong strips being used as a parallel downconductor."

Claim 1 as held allowable by the Opposition Division in its interlocutory decision reads as follows:

"1. A wind turbine blade of fibre glass and/or carbon fibre comprising a conventional lightning conductor, the blade comprising oblong strips (1,2,3) of carbon fibre-reinforced plastics, and the lightning conductor and the oblong strips (1,2,3) at regular intervals being interconnected by means of conductors (6), characterised in that the lightning conductor is an inner lightning conductor cable (5), and in that the blade further comprises inner reinforcing members (4) of carbon fibre-reinforced plastics which are connected to the lightning conductor cable (5) and at least some of the oblong strips (1)."

V. The Appellant (Patentee) requested that the decision under appeal be set aside and that the patent be

maintained as granted (main request), alternatively that the patent be maintained on the basis of a first auxiliary request filed with the statement of the grounds of appeal dated 2 July 2007 or on the basis of the set of claims held allowable by the Opposition Division also submitted with the statement of the grounds of appeal dated 2 July 2007.

The Respondent requested that the decision under appeal be set aside and that the patent be revoked (main request), alternatively that the decision under appeal be set aside and that the case be remitted to the first instance (first auxiliary request) or that the appeal be dismissed (second auxiliary request). As a procedural issue, he requested that the Proprietor's first auxiliary request should not be admitted into the proceedings.

- VI. The Appellant (Patentee) mainly argued as follows:
The decision under appeal is well reasoned and no substantial procedural violation has occurred during the oral proceedings before the Opposition Division. Since the Opponent did not file an appeal on his own, he is not entitled to challenge the maintenance of the patent as amended in accordance with the interlocutory decision and thus cannot request its revocation. Reference was made to decisions G 9/92 and G 4/93 (OJ EPO 1994, 875) of the Enlarged Board of Appeal. Concerning added subject-matter, he submitted that the feature of the oblong conducting strips being connected to the inner carbon conductor or the inner lightning conductor cable by means of conductors is disclosed in the description as filed. The fact that these

conductors are regularly spaced is derivable from the Figures.

VII. The Respondent (Opponent) contested the arguments of the Appellant and submitted that:

Several instances of substantial procedural violation occurred during the opposition proceedings. Firstly, there are indications that during the oral proceedings the Appellant was coerced by the Opposition Division to withdraw his objection based on Article 123(2) EPC against the feature "at regular intervals". This possible scenario is also supported by the wording of the minutes. Secondly, the decision under appeal is fundamentally flawed for not being reasoned. The decision is possibly wrong in stating that the Opponent withdrew the Article 100(c) EPC objections, and the decision lacks reasoning on the point why the Opposition Division itself did not pursue this issue on its own motion. In this manner, the conclusion that the auxiliary request meets the requirement of the EPC contradicts the reasons for the decision since no comprehensible reasons are given as to why it fulfils the requirements of Article 123(2) EPC with respect to the above cited feature.

These substantial procedural violations create a scenario which is not covered by the *ratio decidendi* of the relevant decisions of the Enlarged Board of Appeal G 9/92 and G 4/93 (*supra*), so that these decisions are not immediately applicable.

Moreover, Claim 1 of the main and first auxiliary requests still comprises the feature "at regular

intervals" which is not disclosed in the application as filed. Therefore the patent is *prima facie* invalid for infringing Article 123(2) EPC to such an extent that the interests of the public should prevail over the principle of "*no reformatio in peius*". That this principle may not apply in certain circumstances, e.g. where a substantial procedural violation has occurred, is clearly illustrated by the fact that G 9/92 and G 4/93 was issued with a minority opinion holding that *ex officio* examination should take priority. Case law of the Boards of Appeal, e.g. decision T 1178/04 of 27 February 2007 (OJ EPO 2008, 80) demonstrates that there are situations where the principle is not applicable.

Therefore, even a revocation of the patent is justified and indeed possible, or at least the requests of the Proprietor must fail.

Reasons for the Decision

1. The appeal is admissible.
2. *Procedural issues*
 - 2.1 Before descending on the substantive merits of the claim requests on file, the Board needs to examine whether the case may require a remittal to the department of first instance as a result of the alleged substantial procedural violations, as requested by the Respondent.
 - 2.2 In this respect, the Board concurs with the Respondent that the principle of the prohibition of *reformatio in*

peius is not an absolute one, as demonstrated by G 1/99 (OJ EPO 2001, 381), see Headnote. A remittal of the case should normally be ordered if the first instance proceedings are tainted with a fundamental deficiency (Article 11 RPBA). A substantial procedural violation may certainly be regarded as a fundamental deficiency justifying a remittal. However, the fact that only the proprietor filed an appeal, changes the picture. This means that the decision under appeal is scrutinized only to the extent that it did NOT allow the maintenance of the patent as requested by the proprietor. Thus it is an open question if a substantial procedural violation by itself is sufficient reason for ordering a remittal against a proprietor who is a sole Appellant, especially in light of the fact that the Opponent invoking the substantial procedural violation was not prevented from recognising this violation and filing an appeal himself. But even that question needs not be answered by the Board in the present case, as the Board sees no *prima facie* case of a substantial procedural violation.

- 2.3 The case of the Respondent that such a violation occurred rests on two separate, but related arguments.
- 2.3.1 The first is the fact that during the oral proceedings before the Opposition Division the Opponent did not or at least did not want to withdraw the opposition grounds under Article 100(c) EPC, in particular objections against the feature "at regular intervals". According to the Respondent, even the minutes of the oral proceedings support the suspicion that the question of the Chairman was rather an encouragement to the representative of the Opponent to withdraw some

parts of his case, and actually not a question for clarifying whether the representative himself intended any withdrawal of the opposition ground at issue.

2.3.2 The relevant passages in the minutes (see point 7) read:
"...Asked by the Chairman, the Opponent confirmed that all the further objections under Art. 100(c) EPC raised in the written procedure, and in particular to the presence of the expression "at regular intervals" in claim 1, were withdrawn. The Opponent also confirmed that Art. 100(b) EPC was withdrawn as ground for opposition... "

2.3.3 When asked by the Board, the representative of the Appellant-Proprietor stated that the minutes properly record and reflect the statements of the parties. The representative of the Respondent admitted that neither he nor the other representatives of the Respondent were actually personally present in the oral proceedings before the Opposition Division, and therefore could not state with certainty that the statements and events appearing from the minutes are indeed incorrect. This is merely presumed from the wording of the minutes and the circumstances. There was also no explanation given why the Opponent did not appeal against the decision, given that the alleged misconstruction of the Opponent's intentions by the Opposition Division should have been recognised at the latest when the minutes and the decision were notified to the Opponent.

2.3.4 The Board holds that given the documentary evidence in the decision under appeal and the minutes, and the statement of the representative of the Appellant on one hand, and the statements of the Respondent on the other

hand, there is no conclusive evidence before the Board that the oral proceedings before the opposition were tainted with a substantial procedural violation. The Board also sees no reason to examine the issue any further on its own, because such a further examination of this question would go beyond the scope of these appeal proceedings.

- 2.3.5 The Respondent's second main argument for a remittal is a contradiction between the order of the decision under appeal and the reasons of the decision, following the principles laid down in decision T 1178/04 of 27 February 2007 (*supra*). In that case the deciding Board held that under certain circumstances the principle of *ex officio* examination takes precedence over the principle of the prohibition of *reformatio in peius*. For example, certain absolute or indispensable procedural pre-conditions ("Absolute, unverzichtbare Verfahrensvoraussetzungen") are always to be examined *ex officio*. The deciding Board of case T 1178/04 takes this statement of principle from the commentary "Patentgesetz mit Europäischem Patentübereinkommen", 7th edition (2005), by Dr Rainer Schulte and others, paragraph 7.6.1, note 72, at page 986 which concerns the appeal procedure under German law. This very same citation also lists specific examples which fall under those absolute or indispensable procedural preconditions which need to be examined *ex officio*, among them the existence of a contradiction between the order and the reasons of the decision under appeal (*loc. cit.* paragraph 8.2.(g), note 77, at page 987. ("Widerspruch zwischen Tenor und Gründen der angefochtene Entscheidung").

2.3.6 However, in the light of the finding that a procedural violation during the first instance proceedings is not conclusively proven, the Board holds that the second argument of the Respondent concerning the insufficient reasoning of the decision under appeal has no merit either. Having established that the opposition grounds under Article 100(c) EPC were withdrawn (except for the feature "wall"), there was no need for the Opposition Division to elaborate this question in more detail in its decision. The feature "wall" was duly examined in the decision; see point 2.1 of the decision. In this manner there is no recognisable contradiction between the order and the reasons of the decision under appeal.

2.3.7 The reasoning why the Opposition Division did not pursue the issue of the "at regular intervals" feature on its own motion need not be particularly lengthy and detailed, given that it is within the discretionary power of the Opposition Division to maintain an opposition ground *ex officio* or not. It is noted that in the present case the opposition as a whole was not withdrawn, only an aspect of an opposition ground was withdrawn. Under such circumstances the Opposition Division could presume that the Opponent wants to concentrate on those grounds and aspects which are more promising for the purpose of having the patent revoked. Certainly it can not be expected from an Opposition Division to oppose a patent even more vigilantly than the Opponent himself would do, at least as long as the Opponent himself does not withdraw the opposition and remains an active party in the proceedings. Under such circumstances any overly active involvement of the Opposition Division on the side of the Opponent could easily be perceived as a bias in favour of the Opponent.

Accordingly, the Board holds that the decision under appeal is sufficiently reasoned and in itself free from contradictions. It is another matter whether the Board would have arrived at the same conclusions given the same facts.

2.3.8 Thus in the absence of a proven procedural violation the Board sees no reason to remit the case to the department of first instance, and is not precluded from deciding on the matter before it.

3. *Appellant's main request*

3.1 Added subject-matter:

3.1.1 With respect to claim 1 as filed (see WO-A-00/14405), claim 1 as granted further specifies that "the inner lightning conductor cable (5) and the oblong strips (1, 2, 3) at regular intervals are interconnected by means of conductors (6)".

3.1.2 A sole passage of the description as filed (page 3, lines 24 to 26) refers to these conductors. This passage reads: "Fig. 2 shows how the oblong conducting strips 1, 2, 3 can be connected to the inner carbon conductor or the inner lightning conductor cable 5 by means of conductors 6." Additionally, Figure 2 shows that the oblong strips are interconnected by the conductors 6 and are connected in turn to the lightning conductor cable 5 by further conductors. Figure 1 shows that several conductors 6 interconnect the walls of the blade and possibly also an unspecified inner part.

Neither the description nor the Figures disclose directly and unambiguously that the interconnecting conductors are placed at regular intervals. According to established case law it is not permissible to take measurements from a schematic Figure. Figure 1 alone cannot provide a basis for claiming that the intervals are regular, all the more as a comparison of the different intervals depicted in Figure 1 shows that they vary significantly (up to 80% variation).

- 3.1.3 The Appellant argued that "regular" can according to circumstances have different meanings and that "at regular intervals" is not to be understood as meaning that the intervals are identical. However, the sole fact that more than one interpretation of the expression "at regular intervals" might be possible shows that this expression cannot directly and unambiguously be derivable, since it has no unambiguous meaning.
- 3.1.4 Furthermore, according to case law (see T 169/83, OJ EPO 1985, 193 and T 818/93) features may only be taken from drawings provided the structure and the function of these features are clearly, unmistakably and fully derivable from the drawings for the skilled person. In the present case, the function of placing the conductors at "regular intervals" is not clearly, unmistakably and fully derivable from Figure 1. The Appellant referred in this respect to the description as filed, see page 5, lines 19 to 22, where it is stated "An efficiently and systematically potential-equalised structure of such a parallel downconductor renders it possible to utilize both its

downconductor function and its reflection-dampening function in relation to the lightning currents." However, this sentence has to be read in the light of the whole passage from which it has been extracted. The passage as a whole refers exclusively to the fibres used to form either a directly active downconductor or a parallel downconductor. This passage does not mention at all the presence of conductors connecting the oblong strips to the lightning conductor cable. Thus, according to this cited passage, equalising the potential of the structure is the function to be achieved by the down conductors and not by the conductors connecting the oblong strips to the inner lightning conductor cable.

Accordingly, the feature "at regular intervals" in granted claim 1 contravenes the requirements of Article 123(2) EPC and therefore, the main request must fail.

4. *Appellant's first auxiliary request*

4.1 Claim 1 of this request also includes the feature that "the inner lightning conductor cable (5) and the oblong strips (1, 2, and 3) at regular intervals are interconnected by means of conductors (6)".

4.2 For the same reasons as explained with respect to the main request, claim 1 of the first auxiliary request does not fulfil the requirements of Article 123(2) EPC and thus, must also fail.

4.3 The Respondent contended in writing that this request should be rejected as late filed. However, since the

provisions of Article 123(2) EPC preclude anyway that this request be granted, the question whether it should be admitted into the proceedings or not is not relevant to the present decision.

5. *Appellant's second auxiliary request*

5.1 The set of claims of this request is identical with the set of claims held allowable by the Opposition Division in its interlocutory decision.

5.2 From a procedural point of view, such a request *per se* may be considered formally inadmissible, given that in respect of this request, the Appellant is not adversely affected by the decision under appeal as required by Article 107 EPC. However, this request is interpreted by the Board as in substance being a request for the dismissal of the appeal, in the sense that the Board should not issue a decision even more adverse to the Appellant, such as a revocation of the patent as requested by the Opponent in the present case.

5.3 Exception to the prohibition of "*reformatio in peius*"

As stated above (see point 2), the Board holds that the Respondent failed to prove that any substantial procedural violation occurred, and therefore the Board needs not to decide if such a violation would have justified an exception to the principle. It remains to be decided if the "manifestly invalid" patent could be revoked, thus creating an exception to the principle, based on the fact that the Board has found that the "regular interval" feature contravenes Article 123(2) EPC.

5.4 It is noted that neither the decisions G 4/93 and G 9/92 (*supra*), nor the cited decision T 1178/04 (*supra*) appear to support such an interpretation. Whether or not this principle should be applied does not depend on the extent to which the claimed subject-matter is patentable or not. It is clear from the reasons of G 4/93 and G 9/92 that when arriving at its answer, the Enlarged Board considered the purely procedural aspects of the appeal proceedings, without considering the - undoubtedly undesirable - consequences of the maintenance of "invalid" patents. The Board sees no reason to deviate from the view expressed in G 4/93 and G 9/92 (*supra*) that it is the appeal of the sole Appellant which determines the extent of the appeal proceedings.

In point 1 of the reasons of G 4/93 the Enlarged Board of Appeal pointed out that the "initial request" of the Appellant determines the extent of the proceedings. This is known as the principle of party disposition ("*ne ultra petita*"). In point 14 of the reasons of the decision G 4/93 which relates specifically to appeals where the patent proprietor is the sole appellant, the Enlarged Board of Appeal considered that if the non-appealing opponent files a request for revocation of the patent, the scope of the appeal is exceeded, so that such a request cannot be examined.

Further as noted by the Enlarged Board of Appeal in decision G 1/99 (*supra*), point 4.1 of the reasons "It is undisputed that decision G 4/93 decided that the principle of the prohibition of *reformatio in peius* should be applied in cases where the patent proprietor is the sole appellant against an interlocutory decision maintaining the patent in amended form. This is clearly

the wording of paragraph 1 of the order. A patent proprietor can therefore not be placed in a worse position than if it had not appealed. This means that the patent as maintained by the Opposition Division in its interlocutory decision cannot be objected to by the Board of Appeal, either at the request of the respondent/opponent or *ex officio*. This is balanced by the option open to the opponent to file a request for the revocation of the maintained patent at the national level."

This makes clear that the maintained patent cannot be objected to *ex officio* by the Board of Appeal.

Moreover, in point 6 of the reasons of decision G 4/93, the Enlarged Board of Appeal said that: "The extent of the power of the Boards of Appeal to decide upon the proper scope of the patent should be considered in conjunction with the effect of withdrawal of the appeal" and added that: "Once the or each appeal has been withdrawn, there is no power to continue the proceedings".

The present Board only adds that it is normally expected from parties to administrative and court proceedings that they cooperate with the other party and the deciding body in all stages of the proceedings, in order to arrive at a decision. Such cooperation is made difficult if a sole Appellant must constantly be prepared to withdraw its appeal, in order to prevent a decision which would put him in a more unfavourable situation than his starting position.

- 5.5 From this it follows that the applicability of the legal principle of the prohibition of *reformatio in peius* depends on the procedural status of a case, and the examination of this procedural status must precede

any examination of the substantive merits of a request. This is also in line with the cited decision T 1178/04 (*supra*), which restricts the necessity of *ex officio* examination to procedural preconditions (see Reasons, points 24 to 26). However, there can be no doubt that the issue raised here, i.e. the invalidity concerns the very substance of a patent and has nothing to do with the procedural preconditions. In this manner there is simply no room to establish to what extent a request or a patent may or may not fulfil the usual substantive criteria, so from a legal point of view there is also no room to establish whether there is any invalidity. In other words, even if this fact should be manifestly apparent for all parties and the Board, the Board can not order any legal consequences thereof. This can best be illustrated by the fact that a patent proprietor is not even required to present a request on appeal which would correspond to the version of the patent as upheld by the first instance. In that case it is perfectly clear that a Board is simply procedurally barred from examining, and even less deciding on that form of the patent. On the other hand, this does not hold for procedural preconditions and such facts, which are apparent from the decision under appeal, and which can be examined even without having to examine the actual substantive requests (i.e. the claim requests) in the appeal.

- 5.6 As explained above, since there is no reason why the above mentioned decisions G 9/92, G 4/93 and G 1/99 (*supra*) should not apply to the present case, the patent as maintained by the Opposition Division in its interlocutory decision cannot be objected to by the Board of Appeal either at the request of the

non-appealing Opponent as a party to the proceedings as of right under Article 107, second sentence, EPC 1973, or *ex officio* even if the patent as maintained would otherwise have to be revoked on the ground that a feature present in both claim 1 as granted and amended claim 1 as maintained introduces added subject-matter contrary to Article 123(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The registrar:

The Chairman:

G. Magouliotis

M. Ceyte