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Datasheet for the decision of 18 June 2012

Case Number: T 1964/09 - 3.2.05

Application Number: 98947096.8

Publication Number: 1019649

IPC: F16K37/00

Language of the proceedings: EN

Title of invention:
METHOD OF AND APPARATUS FOR DETERMINISTICALLY OBTAINING MEASUREMENTS OF A PROCESS CONTROL DEVICE PARAMETER WHILE A PROCESS IS OPERATING ON-LINE

Patent Proprietor:
FISHER CONTROLS INTERNATIONAL LLC

Opponent:
ABB Patent GmbH

Headword:

Relevant legal provisions:
EPC 1973 Art. 52(2)

Keyword:
Documents available to the public before date of filing of the European patent application - (yes)
Remittal to the department of first instance for further prosecution (yes)

Decisions cited:

Catchword:

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T1964/09 - 3.2.05

D E C I S I O N
of the Technical Board of Appeal 3.2.05
of 18 June 2012

Appellant: (Opponent)	ABB Patent GmbH Wallstadter Strasse 59 D-68526 Ladenburg (ALLEMAGNE)
Respondent: (Patent Proprietor)	FISHER CONTROLS INTERNATIONAL LLC 8100 West Florissant Avenue St. Louis, MO 63136 (ETATS-UNIS D'AMERIQUE)
Representative:	Bohnenberger, Johannes Meissner, Bolte & Partner GbR Postfach 86 06 24 81633 München (ALLEMAGNE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted 31 July 2009 rejecting the opposition filed against European patent No. 1019649 pursuant to Article 101(2) EPC, second sentence.**

Composition of the Board:

Chairman: M. Poock
Members: S. Bridge
M. J. Vogel

Summary of Facts and Submissions

I. The appellant (opponent) lodged an appeal on 18 September 2009 against the decision dispatched on 31 July 2009 of the opposition division in which the opposition filed against European patent No. 1 019 649 was rejected. The appeal fee was paid simultaneously and the statement setting out the grounds of appeal was received on 2 December 2009.

II. The following documents are referred to in the present decision:

D1: extract from the thesis "*Methoden zur Fehlererkennung an Komponenten im geschlossenen Regelkreis*", R. Deibert, series 8: "*Meß-, Steuerungs- und Regelungstechnik*", number 650, pages I to IX, 1 to 33 and 64 to 115;

D2: conference paper "*Valve diagnostics and automatic tuning*", A.Wallén, in "*Proceedings of the American Control Conference*", June 1997, Albuquerque, New Mexico;

D3: email from Mr. W.Bittner of "*VDI-Verlag GmbH*" concerning the publication date of document D1;

D4: screenshot of a page from the "*IEEE Xplore digital library*" web site concerning the publication date of document D2.

III. The opposition was filed against the patent as a whole based on Article 100(a) EPC (lack of inventive step, Article 56 EPC). The opposition division held that the thesis D1 and the conference paper D2 do not constitute prior art according to Article 54(2) EPC, because there

was insufficient evidence concerning the respective dates at which these documents were allegedly made available to the public. As the only lack of inventive step arguments advanced during these opposition proceedings were based on documents D1 and D2, the opposition division rejected the opposition.

IV. The appellant requested that the decision under appeal be set aside and that the patent in suit be revoked. Oral proceedings were requested as an auxiliary measure.

The respondent (patent proprietor) requested oral proceedings in case the board intended to discuss the patentability of the claims or revoke the patent.

V. In the written procedure, the appellant argued essentially as follows:

Documents D3 and D4 were respectively filed with the grounds of appeal as evidence for documents D1 and D2 having been available to the public before the priority date of the patent in suit. Therefore, documents D1 and D2 constituted prior art according to Article 54(2) EPC. Thus, the decision of the opposition division concerning the lack of evidence concerning the publication of documents D1 and D2 no longer had any basis.

VI. In the written procedure, the respondent argued essentially as follows:

It was assumed the board would satisfy itself as to the particulars of the evidence provided by documents D3 and D4 and that, if the board accepted documents D1 and

D2 as prior published, the case would be remitted to the opposition division.

VII. In an annex to the summons to oral proceedings dated 04 April 2012, the board notified the parties that it was of the provisional opinion that the evidence provided by the appellant appeared to indicate that the documents D1 and D2 were available to the public before the priority date of the patent in suit.

On 15 May 2012, the representative of the respondent informed the board that the respondent would not be represented at the the oral proceedings scheduled for 18 June 2012 and that the respondent expected the board to allow documents D1 and D2 to be considered as prior art and for the case to be remitted to the opposition division to discuss patentability issues.

On 6 June 2012, the representative of the appellant informed the Board that the appellant would not attend the oral proceedings either and that the appellant agreed to the matter being remitted to the first instance with documents D1 and D2 to be considered as prior art.

On 11 June 2012, the board notified the parties by fax that the oral proceedings were cancelled.

Reasons for the Decision

1. The appeal is admissible.

2. In view of the parties' statements in the letters of 15 May 2012 and 6 June 2012, it was not necessary to hold oral proceedings before the board.

3. Publication of documents D1 and D2

3.1 With the email D3, Mr Wolfgang Bittner from the sales management ("*Vertriebsabwicklung Schriftenreihen*") of the editor "*VDI Verlag GmbH*" reports that the thesis D1 was made available to the public on 11 August 1997, i.e. before the priority date of 29 September 1997 of the patent in suit. This evidence was not contested by the respondent.

On the basis of this evidence, the board thus considers that the thesis D1 constitutes prior art in the sense of Article 54(2) EPC 1973 for the patent in suit.

3.2 The screenshot D4 of the page from the "*IEEE Xplore digital library*" web site indicates a publication date of 4-6 June 1997 for conference paper D2. This range of dates is before the priority date of 29 September 1997 of the patent in suit. This evidence was not contested by the respondent.

On the basis of this evidence, the board thus considers that the conference paper D2 constitutes prior art in the sense of Article 54(2) EPC 1973 for the patent in suit.

4. Remittal

As the thesis D1 and the conference paper D2 constitute prior art (Article 54(2) EPC 1973) and as, so far, there was no opportunity for a discussion of the patentability of the claims at first instance, the board considers it appropriate to exercise its discretion under Article 111(1) EPC 1973 and remit the

case to the department of first instance for further prosecution.

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.

The Registrar: The Chairman:

S. Sánchez Chiquero M. Poock

Decision electronically authenticated