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**Datasheet for the decision
of 3 December 2014**

Case Number: T 0014/11 - 3.2.05

Application Number: 99500249.0

Publication Number: 1031778

IPC: F16K31/60

Language of the proceedings: EN

Title of invention:

Actuator fitting for a valve

Patent Proprietor:

Genebre, S.A.

Opponents:

Sferaco
Transworld Steel Enterprise Co.,Ltd

Headword:

Relevant legal provisions:

EPC 1973 Art. 54

Keyword:

Catalogue made available to the public before the priority
date of the patent - yes
Novelty - (no)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 0014/11 - 3.2.05

**D E C I S I O N
of Technical Board of Appeal 3.2.05
of 3 December 2014**

Appellant: Genebre, S.A.
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Decision under appeal: **Decision of the opposition division of the
European Patent Office posted on 9 December 2010
revoking European patent No. 1031778 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman	M. Poock
Members:	H. Schram
	G. Weiss
	S. Bridge
	M. J. Vogel

Summary of Facts and Submissions

- I. On 29 December 2010 the appellant (patent proprietor) lodged an appeal against the decision of the opposition division, posted on 9 December 2010, by which European patent No. 1 031 778 was revoked. The statement setting out the grounds of appeal was filed on 6 April 2010.

The opposition division held that the catalogue "Ball valve from Mars, Series 88" (document E1), was considered as state of the art under Article 54(2) EPC 1973 and that the subject-matter of claim 1 as granted was not new with respect to that document, Article 54 EPC 1973.

Claim 1 of the patent as granted reads as follows:

"A valve (1) whose control spindle (5) is apt to be directly actuated by means of a handle (8) or through an actuator (9) being fitted to it, characterised in that the neck (4) of the body (3) of the valve (1) is provided around its opening (13) with an amply dimensioned flat (14) having radially provided oblong holes (15) for the passage of the screws (18) being provided to fasten the actuator (9)."

- II. Oral proceedings were held before the board of appeal on 3 December 2014. The respective representatives of respondent II (opponent 01) and respondent I (opponent 02) had informed the board on 8 September 2014 and on 29 October 2014, respectively, that they would not attend the oral proceedings.
- III. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted.

Respondent I requested that the appeal be dismissed.

Respondent II did not file any substantive submission or request.

IV. The documents referred to in the appeal proceedings included the following:

A2 Recordings of the taking of evidence of hearing witnesses in the oral proceedings before the opposition division of the EPO on 22 June 2010, denoted as Annex 2;

E1 *Ball valve from Mars, Series 88, direct-mount, three-piece ball valves*, Mars Valve Co., Ltd. (TW), consisting of a front page, pages 1 and 2, and a back page (henceforth referred to as page 3);

P1' Marked-up picture of booth Nr. 615 of Mars Valve Co., Ltd. at the Valve World Exhibition with the indication '98 11 19;

P2' Marked-up picture of booth Nr. 615 of Mars Valve Co., Ltd. at the Valve World Exhibition with the indication '98 11 19;

P1 Printouts of the internet site www.marsvalve.com containing the brochure *Series 88, direct-mount, high performance, 3-piece heavy duty ball valves*, Mars Valve Co., Ltd., front page, back page with the indication MARS88-2000.03-2.0 at the bottom; said brochure is henceforth referred to as the Series 88 valve catalogue of March 2000;

P2 CN 232302 Y;

P3 DE 299 02 532 U1;

P4 US 5,954,088;

P5 Letter dated 18 May 1999 of Southwest Research
Institute, San Antonio, Texas (US).

V. The arguments of the appellant, in writing and during
the oral proceedings, can be summarized as follows:

Document E1 contained several inconsistencies and discrepancies. First, the measures X1 and X2 indicated on page 3 of document E1 (see Dimensions) were not identified in the drawings shown at the top of said page 3. These measures were however identified in the drawings of the Series 88 valve catalogue of March 2000 (cf. document P1). Second, on page 2, the size ranges were given as $\frac{1}{2}$ "-3" (full bore) and $\frac{1}{2}$ "-4" (reduced bore) at the top of said page (see also the two drawings in exploded view), whereas on page 3, left corner at the bottom, the size range included $\frac{1}{4}$ " and $\frac{3}{8}$ ", ie outside the ranges indicated on page 2. Third, on page 3, at the top in the middle, the model 88-10 was denoted as "Threaded End", whereas the same model was denoted as "Screwed End" at the bottom of said page. Fourth, at the top of page 2 on the left, the seat materials were given as "PFTE, R-PTFE, Graphite ... & et.", whereas at the bottom of page 3 on the right the list of seat materials did not include graphite. Document E1 referred to the design specification API 607 (top of page 2, right column, line 7). However, document P5 showed that the valve models "Series 83/88" having a size of $\frac{1}{2}$ " and class 600 were tested and certified in May 1999. Whilst the

inconsistencies and discrepancies by themselves threw doubt whether the alleged printing date, September 1998, was the true printing date, it followed from the fact that the Series 88 valves were certified in May 1999, that document E1 was definitely printed after said date. Lastly, none of the patent documents P2 to P4 mentioned on the front page (below the drawing on the left side) of the Series 88 valve catalogue of March 2000 described a fixation with oblong holes. Surprisingly, these patents were not mentioned in document E1.

The witnesses that were heard in the oral proceedings before the opposition division all had an economic interest in the outcome of the case, since they, or the companies they work or worked for, still sold Series 88 valves from Mars. For this reason alone their testimonies were not credible. Another reason that the witnesses were not credible was, that between the date of the taking of evidence, 22 June 2010, and the day on which they allegedly received a copy of document E1, November 1998, elapsed more 11½ years. Summarizing, document E1 did not exist in 1998 and was not made available to the public before the priority date of the patent in suit.

VI. The arguments of respondent I, in writing, can be summarized as follows:

Document E1 had not been manipulated. The number 9809, which was part of the indication MARS88-9809-2.0 at the bottom of page 3 of said document, stood for the printing date, ie September 1998. This document was given to visitors of the Valve World 98 Conference that took place in The Hague two months later than said printing date, namely from 16 to 18 November 1998. The

conference was held before the priority date of the patent. The indication "API 607" under the heading "Design Specifications" merely meant that the design of Series 88 valves was based on the API 607 standard. From the fact that the fire test for Series 88 valves according to API 607 standard mentioned in document E1 was conducted after its publication date, namely in 1999, it could not be concluded that document E1 did not exist in 1998 or that it was manipulated. The patents documents P2 to P4 focussed on direct mounting aspects and not on the shape of the mounting holes. The mere fact that these documents did not disclose oblong mounting holes did not allow the conclusion that respondent I manipulated document E1 or was not aware of oblong mounting holes when document E1 was published. The mere fact that the parameters X1 and X2 of the dimensions chart on page 3 of document E1 were not defined or identified in the above drawings did not justify the conclusion that document E1 did not exist in 1998 or that it was manipulated.

Strong evidence had been provided in the form of inter alia three witnesses who were heard in the oral proceedings before the opposition division (cf document A2), proving beyond any reasonable doubt that document E1 was made available to the public before the priority date of the patent in suit. Since it only had been challenged that document E1 formed state of the art, it had to be concluded that the subject-matter of claim 1 was not new.

Reasons for the Decision

1. The appeal is admissible.

2. It has not been contested by the appellant that document E1, if it were made available to the public before the priority date of the patent, 23 February 1999, is novelty destroying for the subject-matter of claim 1 of the patent in suit.

3. *Authenticity of document E1*

3.1 In this section it is investigated, whether document E1 must be regarded as non-authentic on the basis of the submissions of the appellant alone, whereby the evidence resulting from the taking of evidence of hearing witnesses in the oral proceedings before the opposition division is postponed to the next section.

3.2 The inconsistencies and discrepancies found by the appellant in document E1 are insufficient to warrant the conclusion that document E1 has been manipulated or falsified. The presence of inconsistencies in a document is normally no convincing proof that said document is forgery, since it can be argued that if it were forged, the fraud would have tried to manipulate it in such a way no one can easily tell that it is forged.

The omission of the dimensions X1 and X2 in the drawing on page 3, left upper corner, may be just that, an inadvertent omission. The same can be said about the size dimensions and the seat material, ie the sizes $\frac{1}{4}$ " and $\frac{3}{8}$ " and the seat material graphite may have been inadvertently omitted on pages 2 and 3, respectively. It may be noticed that the size ranges given on page 2 $\frac{1}{2}$ "-3" and $\frac{1}{2}$ "-4" include the sizes $2\frac{1}{2}$ " - 4", of which it is stated that they will be available soon (see page 3, below the dimensions table). With respect to the terms "threaded end" and "screwed end" used on page 3 to

denote the ball valve 88-10, the board judges that the two terms are used as synonyms.

3.3 With respect to the indication "API 607" under the heading "Design Specifications" on page 2 of document E1, the board judges that this means, since said document does not state expressis verbis that the Series 88 valves passed the performance requirements of said standards, that said valves are designed in a way that they are compliant with the then current version of the American Petroleum Institute (API) Fire Test Standard "API 607", ie the fourth edition published in May 1993.

3.4 The Chinese and United States patents (documents P2 and P4) and the German utility model (document P3) mentioned in the Series 88 valve catalogue of March 2000 (cf document P1) all belong to the same patent family. Documents P2 and P4 have a filing date of 23 February 1998 and 17 July 1998, respectively, and were published after the alleged publication date of document E1. This might explain why these patents were not mentioned in document E1 having an alleged printing date of September 1998. It may be noticed that document P3 was filed on 24 June 1999, ie after document E1 was allegedly published. If document P3 would have been cited in document E1 this would have been proof that document E1 was not printed in September 1998.

The US-patent (document P4) is assigned to respondent I. The object of this patent is to provide a ball valve which can be connected securely to a valve control device (actuator) without using a connecting bracket (see P4, column 1, lines 45 to 47). This patent does not disclose a fixation having oblong mounting holes extending in a radial direction. Whilst the shape of

the mounting holes of the flat support end 422 shown in figure 3 is circular, this is not mentioned in the patent specification. The shape of the mounting holes was obviously not of interest to the applicants of document P4. From the fact that applicants of documents P3 and P4 did not mention oblong mounting holes in said documents, and did not separately file patent applications for it, it cannot be concluded that they were at the time of filing unaware of the advantages of such design (namely, to fit adaptors with different diameters onto the valve), since they may have believed that said design was known in the art, or considered the provision of oblong mounting as a simple constructional measure which comes within the scope of the person skilled in the art.

- 3.5 Documents P1' and P2' are marked-up pictures taken at the Valve World 98 Exhibition of booth Nr. 615 of Mars Valve Co., Ltd., showing on the left-side wall what looks like the front page of document E1 (indicated by red arrows with the text "Series 88 brochure"). These pictures provide some evidence that document E1, at least the front page thereof, existed in September 1998.
- 3.6 In view of the above, the board comes to the conclusion that on the basis of the submissions of the appellant alone, there is insufficient evidence that document E1 is not authentic.
4. *Does document E1 form part of the state of the art?*
- 4.1 Articles 54(2) EPC and 54(3) EPC 1973 provide that the state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before

the date of filing of the European patent application and in addition the content of European patent applications as filed, which were filed prior to said date of filing and which were published on or after that date.

- 4.2 During the oral proceedings before the opposition division three witnesses were heard.

The first witness, in 1998 a sales director and subsequently the managing director of the UK operations of a Swiss manufacturer of ball valves, stated that he was given a brochure (document E1) at the Valve World exhibition on 17 November 1998 when he visited the Mars stand, see Annex 2, page 3, paragraphs 10 and 14. The first witness gave as reason why he had remembered this, that a subsidiary of his firm had introduced in 1997 a pneumatic actuator with an ISO mounting and that his firm was looking for a valve onto which that actuator could be directly mounted, see Annex 2, page 3, last two paragraphs. When asked by the opposition division (see Annex 2, page 3, lines 3 to 6) whether he had any personal or economic interest in the outcome of today's proceedings that could influence the way he testified, the witness answered: "No, other than the fact that we sell Mars ball valves that are manufactured by Transworld Steel".

The second witness, since 1980 the owner and managing director of a Norwegian family company (until a holding company owned by the family took over the firm), whose main business is selling valves, stated that his sales director visited the Valve World exhibition in 1998 and brought back the catalogue (document E1), see Annex 2, page 20, fourth paragraph from the bottom. The second witness gave as reason why he had remembered this, that

he had noticed a sticker on page 2 of document E1 on the text "bottom entry blow out proof system", see Annex 2, page 21, fourth paragraph from the bottom, page 22, first two paragraphs, and page 23, paragraphs 7 and 8. When asked by the opposition division (see Annex 2, page 17, last 7 lines): "And do you have any personal or economic interest in the outcome of today's proceedings? We are talking about a patent and whether it will be upheld or not", the witness answered "Absolutely not".

The third witness, in 1998 working as a sales manager and developer of new products for a Belgium firm in several countries, stated that his firm and Mars both had a booth at the Valve World of 1998 and that after the exhibition he had sent a fax dated 26 November 1998 to Mars asking for detailed documentation and prices of Series 88 valves, see Annex 2, page 33, second paragraph and page 34, third paragraph. He added "So it must have been either prior to the exhibition ... or during the exhibition" (that he received the Mars brochure (document E1)). When asked "And how come that you still have one?", he answered "When I founded the company in 1999 I made my personal catalogue and as a relic I kept that catalogue ...". When asked by the opposition division (see Annex 2, page 31, lines 3 to 21) "Have you any personal or economic interest in the outcome of today's proceeding, whether this patent will be maintained or it will be revoked or whatever the outcome is, the patent of Genebre?" answered: "As I, we do not buy any valves from Genebre at this point in time. We do buy the Mars series and we distribute those. It would create me, let's say, a technical problem to adjust it. But financially it wouldn't make a big difference to us. There are two lines of these products, one is what we call direct mount, the one in

question, but it also exists as an indirect mount. So we can easily switch over, we even have both of them in the programme. So it doesn't mean very much to me".

- 4.3 The appellant has submitted that since all three witnesses sold Series 88 valves from Mars, they had an economic interest in the outcome of the case and their testimonies were therefore not credible.

The first witness started to work for Mars Valve UK in 2000 and was company director of that firm when he was heard by the opposition division on 22 June 2010. He stated that he had no economic interest in the opposition case against the patent in suit, "other than the fact that we sell Mars ball valves that are manufactured by Transworld Steel". Arguably, if the opposition would finally have been rejected by the EPO, it cannot be excluded that the patent proprietor would envisage infringement proceedings against Mars Valve Co., Ltd. TW and Mars Valve UK (see letter of the appellant dated 18 November 2013) and that this would have an impact on sales.

The testimonies of witnesses should be evaluated as a whole, not in isolation, unless the testimonies contradict one another. In the present case the board is convinced that the second witness did not have a personal or economic interest in the outcome of the opposition proceedings that would disqualify him as a witness. The board is also convinced that this witness received a copy of document E1 before the priority date of the patent in suit. Despite the long interval between the taking of evidence and the Valve World exhibition of 1998, the second witness had remembered that page 2 of document E1 had a sticker for correcting a printing mistake (which, incidentally, adds further

proof of the authenticity of document E1). The board considers the testimonies of the first and second witness as corroborative evidence.

4.4 Summarizing, the board comes to the conclusion that document E1 was made available to the public before the priority dated of the patent in suit.

5. In view of point 2 and the conclusion in point 4.4, the patent must be revoked.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated