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D E C I S I O N
of 31 January 1995

Case Number: T 0847/93 - 3.4.2

Application Number: 87906879.9

Publication Number: 0286670

IPC: G01F 1/84

Language of the proceedings: EN

Title of invention:
Density insensitive coriolis mass flow rate meter

Patentee:
MIRCO MOTION INCORPORATED

Opponent:
Krohne MeBtechnik GmbH & Co. KG

Headword:
-

Relevant legal provisions:
EPC Art. 104(1), 108, 111(1), 114(2)
EPC R. 65(1)

Keyword:
"Fresh case, prima facie substantiated; admissibility: yes"
"Remittal to the first instance for determining in particular whether the facts and evidences not submitted in due time are disregarded: yes"
"Apportionment of costs: yes"

Decisions cited:
T 0220/83; T 0563/92; T 0611/90; T 0017/91; T 0101/87

Catchword:
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Case Number: T 0847/93 - 3.4.2

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D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 31 January 1995

Appellant:
(Opponent)

Krohne MeBtechnik GmbH & Co. KG
Ludwig-Krohne-Straße 5
D-4100 Duisburg 1 (DE)

Representative:

Gesthuysen, Hans Dieter, Dipl.-Ing.
Patentanwälte Gesthuysen, von Rohr &
Weidener
Postfach 10 13 33
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Respondent:
(Proprietor of the patent)

MICRO MOTION INCORPORATED
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Colorado 80301 (US)

Representative:

Heunemann, Dieter, Dr.
Vossius & Partner
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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office dated 12 July 1993
rejecting the opposition filed against European
patent No. 0 286 670 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: E. Turrini
Members: M. Chomentowski
B. J. Schachenmann

Summary of Facts and Submissions

- I. Claim 7 of European patent No. 0 286 670, which was granted on the basis of the European patent application No. 87 906 879.9 claiming a priority date of 3 October 1986, has the following text:
- "7. A Coriolis mass flow rate meter comprising at least one flow conduit capable of being driven to oscillate resonantly about an oscillation axis and, in use with flow through the flow conduit, capable of deflection about a deflection axis due to induced Coriolis forces wherein the flow conduit exhibits a different resonant frequency about each of the oscillation and deflection axes, characterised in that the masses and locations of mounting of all attachments to said flow conduit required for operation are selected such that the ratio of the resonant frequencies about the oscillation and deflection axes is, in use, substantially constant for varying fluid densities passing through the flow conduit." Claims 1 and 4 are main method claims and Claims 2, 3, 5 and 6 are dependent claims.
- II. The Appellant (Opponent) filed an opposition against the European patent inter alia on the grounds that the subject-matter of the patent was not patentable within the terms of Articles 52 to 57 EPC.
- III. The opposition was rejected.
- IV. The Appellant (Opponent) lodged an appeal against this decision. In part I of the Statement of Grounds of Appeal, it was only mentioned that, first, for avoiding repetitions, express reference was made to the content of the Notice of Opposition and of the Opponent's further letter of 10 June 1993 during the opposition

procedure, and that, as before, already cited documents were upheld against the patent in dispute. Then, in part II of the Statement of Grounds of Appeal, a pre-published prior art document D9 = article "Digital precision mass flow meter", was cited and copies of documents were filed in this respect; moreover, a public prior use was mentioned in relation to documents D5 = EXAC prospect "Product Bulletin 1101", D6 = EXAC commercial invoice dated 29 January 1985 concerning the sale and shipping of 1 EA EX1200 flowmeter 1100 (serial number 8501s0000a59) to Krohne Meßtechnik GmbH, with further documents concerning this shipping, D7 = copies of photos of the flowmeter of EXAC Corp. delivered by this company and which is still in the Opponent's possession, and D8 = report of experiments made at the Opponent's place on the 8 October 1993 and relating to said EXAC-Coriolis mass rate flow meter. In part III of the Statement of Grounds, the Appellant proposed to show said apparatus. In part IV of the statement, it was mentioned that said apparatus was already in the possession of the Appellant in 1985, and that, in relation to said public prior use, Mr Herbert Christ, Heidenheimer Straße 47, 72760 Reutlingen, F.R.Germany, could be heard as a witness. In part V, the statement contained arguments concerning said public prior use.

- V. During the oral proceedings of 31 January 1995 which had been requested auxiliarily by both parties, the Appellant brought for inspection an EXAC apparatus presented as being the one mentioned in the Statement of Grounds, filed a document comprising a written sworn declaration ("Eidesstattliche Versicherung") dated 28 January 1995 and signed by Mr Herbert Christ, concerning said apparatus, and requested that the patent be revoked if Claim 7 was maintained and, auxiliarily, that the case be remitted to the first instance for

further prosecution. The Respondent (Proprietor of the patent) requested that the appeal be dismissed, and, as a first auxiliary request, that the new facts and alleged evidence presented in the Statement of Grounds of Appeal for the first time be disregarded as being filed too late, as a second auxiliary request, that the case be remitted to the first instance for further prosecution and, in any case, that the Appellant be ordered to pay Patentee's costs.

VI. The Appellant submitted the following arguments in support of his requests: The Statement of Grounds of Appeal concerns a ground of opposition which corresponds to one of the grounds on which the present opposition had been filed; in addition to already cited documents, it refers to prior art which is relevant in view of the sworn declaration of Mr Herbert Christ ("Eidesstattliche Versicherung") and of the documents concerning the purchase by the Appellant, without conditions of confidentiality, of the apparatus shown in the pictures and presented for inspection at the present oral proceedings; said apparatus had been bought for information about the prior art before entering this particular technical field; the apparatus, which has not been modified since then, has weights attached at the same location as in the patent in suit and the results of measurements show that it also provides the same result; there is thus no lack of substantiation or other deficiency of the Statement of Grounds of Appeal and the present appeal is admissible. Since this prior art is relevant, it should not be disregarded, even if it was not submitted in due time, and the patent should be revoked in the extent of its Claim 7 for lack of novelty or of inventive step. Otherwise, it is requested that the case be remitted to the Opposition Division for considering it on the basis of the new prior art. Concerning the question of apportionment of costs, there

are strong mitigating circumstances for the late filing of this objection based on a new prior art, because it was at a meeting of the Boards of directors of the Appellant's company during a discussion of the issue of the decision under appeal that one of the persons participating remembered that an apparatus similar to the one presently claimed had been bought by the company in 1985, and there was no deliberate intention of misusing the appeal procedure. Therefore, the request of apportionment of costs of the Respondent should be rejected.

VII. The Respondent argued substantially as follows in support of his requests: Taking into account the conclusions of, inter alia, T 0220/83, OJ EPO 1986, 249 that grounds for the appeal may not be confined to an assertion that the contested decision is incorrect but should state the legal or factual reasons why the decision should be set aside, the appeal should be rejected as inadmissible due to a lack of substantiated written statement setting out the grounds of appeal. Concerning the new prior art alleged by the Appellant, it concerns prima facie a purchase under conditions of confidentiality between firms in the same technical field; moreover, the Appellant has not established that the shown apparatus had not been modified since then and, in any case, it is derivable from the declaration of Mr Herbert Christ that he was not present at the time of the delivery of the apparatus at Appellant's place, because he entered said company about one year later, and that thus his statements are based on hearsay rather than on own perception. Therefore, this declaration has no value. The late submitted new alleged prior art is based on the own activities of the Appellant and should be disregarded irrespective of his relevance or, in any case, as not relevant. Therefore, the present procedure constitutes a misuse of the appeal proceedings and,

since in particular there are no good reasons for the delay in the provision of the indications concerning said prior use, the Appellant should be ordered to pay the Respondent's costs arising because of this appeal.

Reasons for the Decision

1. *Admissibility of the appeal*

1.1 Regarding the issue of admissibility of the appeal, the Respondent has argued that, taking into account the conclusions of, inter alia, the above-mentioned decision T 0220/83 (see the Headnote), according to which grounds for appeal may not be confined to an assertion that the contested decision is incorrect but should state the legal or factual reasons why the decision should be set aside, or the similar conclusions of the decision T 0563/92, dated 24 February 1993, unpublished, the appeal should be rejected as inadmissible due to a lack of substantiated written statement setting out the grounds of appeal. The following is to be noted in respect of the Respondent's request:

First, all the parts of the statement concern a ground of opposition which corresponds to one of the grounds on which the present opposition had been filed, and there is thus no deficiency of the statement in this respect. Indeed, in part I of the written Statement of Grounds of Appeal, the Appellant only mentions that he refers expressly, for avoiding repetitions, to the Notice of Opposition dated 16 September 1991 and to his letter of 10 June 1993 submitted during the opposition procedure, and that the patent in suit is still objected having regard to cited prior art documents mentioned therein. Thereby, the Appellant only refers to an argumentation

and documents provided during the opposition procedure and does not specify which arguments in the appealed decision are contested. Yet, although the Appellant, confronted with this objection, has not submitted any argument in this respect, it is to be noted that the present Statement of Grounds of Appeal is not restricted to part I and is thus not of the same type as in the cases in the reported decisions, wherein indeed, the statement of grounds of appeal consisted of a statement which was found insufficient. Therefore, since in the present case the Statement of Grounds of Appeal is not restricted to part I, the conclusions of the decisions cited by the Respondent with respect to the question of admissibility cannot be applied directly and the present appeal cannot be found inadmissible on this ground.

Indeed, the Statement of Grounds of Appeal was filed together with documents D5 to D9, D9 being presented as pre-published and D5 to D8 in support of an alleged public prior use, and contained further technical arguments making reference to particular text locations in said documents with respect to the patentability of the subject-matter of the patent in suit. In this respect, it is to be noted that, according to the conclusions of the decision T 611/90, OJ EPO 1993, 50 (see Headnote I and points 1 and 2 of the reasons), cited by the Respondent for other reasons, apart from other deficiencies, an appeal raising a case entirely different from that on which the decision under appeal was based is still admissible if it is based on the same opposition grounds. Therefore, since prima facie the written statement filed by the Appellant is derivable as setting out in a sufficiently substantiated manner the grounds of appeal against the decision under appeal, in particular on the basis of an alleged prior use, and since it refers to the originally submitted ground of

opposition contesting the patentability of the subject-matter of the patent, the appeal is admissible (Art. 108 EPC, last sentence and Rule 65(1) EPC).

2. *Further prosecution*

Since the present appeal has been found admissible, it is necessary to consider whether the appeal is allowable (Art. 110(1) EPC), and thus, whether the subject-matter of the patent is patentable on the basis of the statement setting out the grounds of appeal. However, as mentioned here above the written Statement of Grounds of Appeal is not substantiated having regard to the prior art cited during the opposition procedure and to the reasons given in the decision under appeal; thus, in accordance in particular with the conclusions of the above-mentioned decision T 611/90 (see Headnote II and point 3 of the reasons), cited by the Respondent for other reasons, stating that the appeal procedure should not become a mere continuation of first instance proceedings, it is in the opinion of the Board inappropriate to examine whether said decision was well-founded or not in this respect. As to the further arguments of the Statement of Grounds of Appeal based on prior art which was not in the file at the time of the decision under appeal, the following is to be considered: Since, in particular, the facts and evidence documented by D5 to D8 and the testimony of Mr Herbert Christ offered in the Statement of Grounds of Appeal and filed during the oral proceedings in the form of a written sworn declaration ("Eidesstattliche Versicherung") were not submitted in due time, i.e. during nine months from the publication of the mention of the European patent, as specified in Article 99(1) EPC, the European Patent Office may disregard them in accordance with Article 114(2) EPC.

It is first to be noted that the Respondent has argued that, in accordance with the conclusions of decision T 0017/91 of 26 August 1992, unpublished (see the headnote), an assertion of public prior use submitted after the expiry of the opposition period cannot be deemed to have been submitted in due time irrespective of its potential relevance if said prior use was based on the Opponent's own activities. The facts and evidence not submitted in due time in the present case should in his view be disregarded irrespective of their relevance. However, this argument is not convincing in that said conclusions cannot be applied directly to the present case because the presently asserted prior use was not based on the Opponent's own activities, but rather refers to an apparatus manufactured by a third company and delivered to the Opponent.

It is also to be noted that, according to the decision T 237/89 of 2 May 1991, unpublished (see points 4.4 to 4.4.3), cited by the Respondent, pieces of evidence which had not been submitted in due time, i.e. only together with the Statement of Grounds of appeal, and moreover not in a complete proven form, have been disregarded under Article 114(2) EPC only after concluding that these pieces of evidence were not relevant in that sense that they could not prejudice the maintenance of the patent. Therefore, it will be necessary, to decide whether these facts and evidence which had not been submitted in due time in the sense of Article 114(2) EPC, will be disregarded or not, to also take into account the relevance of the prior art asserted by the Appellant. Both parties have submitted arguments concerning the relevance of said facts and evidences, as well having regard to their availability to the public before the date of the presently claimed priority as with respect to their technical relevance. Both parties have requested auxiliarily that the case be

remitted in accordance with Article 111(1) EPC to the Opposition Division for further prosecution in order to provide them with the possibility of arguing the case before two instances. Therefore, the Board follows the conclusions of the above-mentioned decision T 611/90 (see Headnote II and point 3 of the reasons), that in an appeal raising a case entirely different from that on which the decision under appeal was based, it may, subject to the circumstances of the case, be inappropriate for an Appeal Board to deal itself with its allowability, since the public and the parties' interest in having the proceedings speedily concluded may be overridden by the requirements that appeal proceedings should not become a mere continuation of first instance proceedings. Therefore, the Board considers it justified to agree to the parties' requests to remit the case to the first instance pursuant to Article 111(1) EPC for its decision on the new case raised by the Appellant.

3. *Apportionment of costs*

The Respondent has argued that, in view of the belated facts and alleged evidence presented by the Appellant, the request that the Appellant be ordered to pay the Patentee's costs of the proceedings is justified since there are no good reasons for the delay in the provision of the respective material, and he has cited in this respect in particular the above-mentioned decision T 611/90. Indeed, according to said decision (see Headnote III), in the absence of strong mitigating circumstances for the late filing of a fresh case of an appeal raising a case entirely different from that on which the decision under appeal was based, the late-filing party should bear all the additional costs incurred by his tardiness. However, in the present case, the Appellant has submitted the argument that it was

during a meeting of the Boards of directors of the Appellant's company wherein the issue of the decision under appeal had been discussed that one of the persons participating had remembered that an apparatus similar to the one presently claimed had been bought by the company in 1985, at the time when the company studied already commercialised apparatuses of this type before beginning with the development and production of its own apparatuses; the Appellant's company is a big firm and the patent department was not aware beforehand that the company had such an apparatus. The Board considers that the mitigating circumstances mentioned by the Appellant are acceptable and, therefore, the conclusions of the above-mentioned decision T 611/90 cannot be applied directly to the present case.

However, the present case is similar to the case reported in decision T 101/87 of 25 January 1990, unpublished (see point 6 of the reasons), cited by the Respondent, in that the present Statement of Grounds of Appeal makes no substantiated criticism of the reasons for the decision of the Opposition Division but relies only on new prior art documented in said statement; thus, by introducing arguments and documents which bear little relation to those filed in the original opposition, the Appellant has produced virtually a new opposition at the appeal stage and this cannot be, by definition, the purpose of an appeal. On the one hand, the Appellant had the right to file an appeal against the decision of the Opposition Division and, in the present case, an admissible Statement of Grounds of Appeal has been submitted; moreover, the Appellant's arguments that there were mitigating circumstances for the late filing of new facts and evidences are credible. However, on the other hand, it is also credible that the Respondent has seen his costs increase following the introduction of an entirely fresh case, amounting to a

new opposition, as compared to his costs if the facts and evidences had not been filed at a late stage. Therefore, the Board, after having carefully considered the relevant circumstances of the case, has decided for reasons of equity to order an apportionment of costs so that the Appellant shall pay to the Respondent 50% of the costs which will be incurred by the Respondent in the future oral proceedings and taking of evidence before the Opposition Division and in any subsequent appeal as under Article 104(1) EPC.

Order

For these reasons it is decided that:

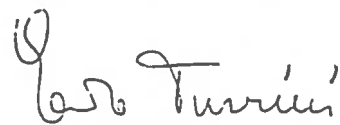
1. The appeal is admissible.
2. The decision of the Opposition Division is set aside
3. The case is remitted to the Opposition Division for further prosecution.
4. The costs shall be apportioned so that the Appellant shall pay to the Respondent 50% of the costs which will be incurred by the Respondent in the future oral proceedings and taking of evidence before the Opposition Division and in any subsequent appeal.

The Registrar:



P. Martorana

The Chairman:



E. Turrini

MCA

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