

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen

D E C I S I O N
of 4 March 1997

Case Number: T 0223/95 - 3.5.2

Application Number: 87306954.6

Publication Number: 0256780

IPC: H01H 33/66

Language of the proceedings: EN

Title of invention:
Vacuum circuit interrupter

Patentee:
MITSUBISHI DENKI KABUSHIKI KAISHA

Opponent:
Siemens AG

Headword:
-

Relevant legal provisions:
EPC Art. 114(2). 111(1)

Keyword:
"Evidence of common general knowledge in the art introduced on
appeal too relevant to be disregarded"
"Remittal to opposition division"

Decisions cited:
T 0258/84, T 0273/84, G 0010/91

Catchword:
-



Case Number: T 0223/95 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 4 March 1997

Appellant:
(Opponent)

Siemens AG
Postfach 22 16 34
D-80506 München (DE)

Representative:

-

Respondent:
(Proprietor of the patent)

mitsubishi denki kabushiki kaisha
2-3, Marunouchi 2-chome
Chiyoda-Ku
JP-Tokyo 100 (JP)

Representative:

Mounteney, Simon James
Marks & Clerk
57-60 Lincoln Inn Fields
GB-London WC2A 3LS (GB)

Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted
20 February 1995 concerning maintenance of
European patent No. 0 256 780 in amended form.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: R. G. O'Connell
B. J. Schachenmann

Summary of Facts and Submissions

- I. The appellant filed an opposition against European patent No. 0 256 780 and now contests the interlocutory decision of the opposition division that, account being taken of the amendments made during the opposition proceedings, the patent and the invention to which it related met the requirements of the EPC.

The patent as amended before the opposition division has four claims; it has not been amended further on appeal. Claim 1 is worded as follows:

"1. A vacuum circuit interrupter comprising in a vacuum vessel at least a pair of separable stationary electrode and a movable electrode, and a main shield surrounding the electrodes, characterized in that the axial length L of said main shield is greater than T_1 and smaller than $(T_1 + 2T_2 \tan 45^\circ)$, where T_1 is the distance which is the sum of the gap length between said electrodes when said electrodes are separated and the thicknesses of said electrodes, and T_2 is the shortest distance between said main shield and said electrodes."

Claims 2 to 4 are dependent on Claim 1.

- II. The following document cited in support of the opposition remains relevant to the present appeal:

D7: US-A-3 612 795.

With the statement of the grounds of appeal, the appellant filed the following additional documents:

- A1: "Power circuit breaker theory and design", (textbook) first published by Peter Peregrinus Ltd, England 1975, Chapter 8, "Vacuum circuit breakers", by M. P. Reece, pp. 320 to 331; and Revised Edition 1982, pages 14 to 16 and 360 to 371.
- A2: Dissertation "Über den Einfluß der Elektrodengeometrie auf das Ausschaltverhalten von Vakuumschaltern" of the Fakultät für Maschinenbau und Elektrotechnik of the Technical University Carolo-Wilhelmina in Braunschweig, Germany, by Dipl.-Ing. Friedrich-Wilhelm Behrens, list of contents and pp. 1 to 7, 18 to 23, 29 to 31, 65 to 67, Figures 2 to 4 and 22.
- A3: "Experiments on vacuum interrupters in high voltage 72 kV circuits", article in IEEE Transactions on Power Apparatus and Systems, Vol. PAS-99, No. 2, March/April 1980, pp. 658 to 665.
- A4: "Geschichtliche Entwicklung und derzeitiger Stand des Vakuumschalters", article in "Vakuum-Technik", 1965, Year 14, Vol. 1, pp. 21 to 26.
- A5: "Übersicht über die Entwicklung von Vakuumschaltgeräten im IPH", article in "Elektrie" 31, 1977, Vol. 9, pp. 487 to 490.
- A6: US Patent Specification 4 324 960
- A7: US Patent Specification 4 135 071

V. The appellant argued essentially as follows:

The decision under appeal concluded that the subject-matter of Claim 1 of the opposed patent was new and involved an inventive step over D7 essentially because the latter taught only the use of condensation shields having an axial length L of approximately $3t_2$, t_2 being the spacing between the electrodes in the open position of the interrupter. Since the document was silent as regards the thicknesses t_1 , t_3 of the electrodes and the gap T_2 between the electrodes and shield, the opposition division found that the opponent had established only that the skilled person **could** be led to choose a length L falling within the range given in Claim 1, not that he **would** choose such a length; cf impugned decision at points 5b, 5c and 5e. The opponent's assertions to the contrary, based on typical values for t_1 , t_3 and T_2 used in the art of vacuum circuit interrupters were not given credence because he had not supported any of these arguments by means of text books or other publications.

In fact the typical dimensions in question were part of the know-how of the skilled person which was rarely documented in patents although it was of course embodied in products which were commercially available; it was the duty of the opposition division to inform itself about these matters, if necessary by contacting the specialist manufacturers of such interrupters. Nevertheless, in view of the position adopted by the opposition division, the appellant had sought to produce the evidence demanded and had now filed five documents constituting extracts from textbooks and general review articles as well as two patent

specifications. These documents served to underpin the assertions relied on in the first instance proceedings, in particular, that the teaching of D7 regarding shield length L would be interpreted by the skilled person in the light of established practice in the art which included the following typical dimensioning practices:

(a) $T_2 > t_2$

(b) $t_1, t_3 < t_2$ in the case of spiral petal contacts (SPC)

(b₁) hence, in the case of SPC vacuum interrupters, $t_1 + t_2 + t_3 (=T_1) < 3.t_2$.

It was deducible from the above relationships that:

$$T_1 < 3t_2 < T_1 + 2T_2$$

so that the indicated dimensioning practices for SPC interrupters would mean that satisfying the D7 dimensioning rule would automatically result in satisfying the dimensioning rule specified in Claim 1.

VI. The respondent's arguments can be summarised as follows:

The seven new documents A1 to A7 had not been submitted in due time by the opponent; they had been introduced on appeal almost two years after the opposition was originally filed despite the fact that at least some of these documents appeared to have been found in the appellant's own library. Since they were of questionable relevance the board should disregard them pursuant to Article 114(2) EPC.

VII. The appellant requested that the decision under appeal be set aside and that the European patent No. 0 256 780 be revoked in its entirety.

VIII. The respondent requested that the appeal be dismissed (main request). In the event that the board decided not to disregard any of the seven new documents, the respondent requested that the board remit the case to the opposition division for consideration of admissibility of the late filed documents and, if necessary, fresh consideration of the issues of novelty and inventive step in the light of this new prior art, with all costs reasonably incurred during the further prosecution of the opposition before the opposition division, and any appeal therefrom, to be borne by the appellant. The respondent also submitted other auxiliary requests, which, in view of the present decision, need not be recited.

Reasons for the Decision

1. The appeal is admissible.
2. The first issue to be considered in the present appeal is whether the subject-matter of Claim 1 is new and involves an inventive step over D7. Here the board has nothing to add to the reasoning of the opposition division at points 4 and 5 of its decision and for these same reasons finds that the subject-matter of Claim 1 is new and involves an inventive step having regard to D7 and that common general knowledge in the art which could safely be regarded as not requiring documentary or other evidence.

3. As regards the issue of whether the documents A1 to A7, introduced on appeal, should be disregarded, the board notes that the opposition division concluded that the opponent's assertions as to common general knowledge in the art in relation to the customary dimensioning of the electrodes and shield had not been substantiated by the evidence available to the division. In this respect the decision of the opposition division was in accord with the established jurisprudence of the EPO Boards of Appeal whereby alleged common general knowledge in the art must be proved if challenged unless it is accepted as notorious by the division or board concerned. On the basis of a *prima facie* consideration of the seven documents A1 to A7 introduced on appeal the board concludes that there is at least an arguable case that these documents substantiate the opponent's assertions. In this sense, the need for filing documents A1 to A7 arises from the reasoning given in the decision under appeal and these documents are too relevant to be disregarded under Article 114(2) EPC.
4. Regarding the appellant's argument that the opposition division ought either itself have the same level of knowledge as a person skilled in the design of vacuum circuit interrupters, or should take steps of its own motion to establish by investigation - including, if necessary, visits to relevant firms - what that level of knowledge is, the board remarks that such an investigative approach would not be consistent with the character of the post-grant opposition proceedings under the EPC which are in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment, cf opinion G 10/91 (OJ EPO 1993, 420, point 2 of the reasons). It is unrealistic to suppose that the seeking, gathering and selection of evidence can be conducted in an entirely impartial fashion; herein lies an essential distinction between

the functions of the examination divisions and the opposition divisions. For this reason it is the responsibility of the opponent to present to the opposition division the facts, evidence and arguments in support of the grounds on which the opposition is based.

5. In order not to deprive the parties of the opportunity to argue the new situation at two instances, the board considers it appropriate to make use of its powers under Article 111(1) EPC to remit the case to the department of first instance for further prosecution, c.f. decisions T 258/84 (OJ EPO, 1987, 119) and T 273/84 (OJ EPO, 1986, 346). For this reason, the appellant's sole request and the respondent's main request are refused, while the respondent's auxiliary request is granted, subject to a variation on the costs order requested.
6. The board has deliberately refrained from going into the merits of the parties' arguments relating to the interpretation of the newly cited documents A1 to A7 in order not to preempt the consideration of these matters by the department of first instance.
7. Regarding costs, Article 104(1) EPC specifies that:
"Each party to the proceedings shall meet the costs he has incurred unless a decision of an Opposition Division or a Board of Appeal, for reasons of equity, orders, in accordance with the Implementing Regulations, a different apportionment of costs incurred during taking of evidence or in oral proceedings."

As regards equity, in the judgement of the board, the appellant's argument that the opponent was culpable for not producing the documents A1 to A7 sooner, has to be weighed against the difficulty involved in anticipating

precisely which aspects of alleged common general knowledge in the art would be challenged and what proof would meet that challenge. It is in nobody's interest that the procedure be swamped from the beginning with a mass of preemptive proofs on such matters.

In the present case, the board's decision to remit the case immediately to the department of first instance means that the respondent has not incurred any undue cost burden in relation to the present appeal. Accordingly, the board does not see any reason of equity to order a different apportionment of costs in relation to these proceedings.

The question of costs in subsequent proceedings before the opposition division and possible further appeal proceedings is left for consideration by the opposition division and board of appeal concerned.

Order

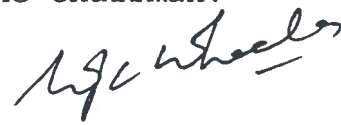
For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The respondent's request for an apportionment of costs is refused.

The Registrar:


E. Görgmaier

The Chairman:


W. J. L. Wheeler