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D E C I S I O N
of 14 January 1998

Case Number: T 0850/96 - 3.2.3
Application Number: 89907684.8
Publication Number: 0420918
IPC: B04B 1/20, B04B 9/08

Language of the proceedings: EN

Title of invention:
A decanter centrifuge

Patentee:
Alfa-laval Separation A/S

Opponent:
Deutz AG

Headword:
-

Relevant legal provisions:
EPC Art. 24, 54(2), 99, 99(1), 104(1)
EPC R. 67

Keyword:
"Partiality (no)"
"Novelty - public prior use (yes)"
"Opposition - persons entitled"
"Reimbursement of appeal fee - substantial procedural violation (no)"
"Costs - apportionment - oral proceedings (no)"

Decisions cited:

G 0005/91

Catchword:

-



Case Number: T 0850/96 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 14 January 1998

Appellant: Alva-Laval Separation A/S
(Proprietor of the patent) Maskinvej 5
2860 Søborg (DK)

Representative: Jessen, Ivar Bergishagen
c/o Internationalt Patent-Bureau
Hoeje Taastrup Boulevard 23
2630 Taastrup (DK)

Respondent: Deutz AG
(Opponent) Ottostr. 1
51057 Köln-Porz (DE)

Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 28 June 1996, posted
on 30 July 1996, revoking European patent
No. 0 420 918 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: F. Brösamle
A. Aúz Castro

Summary of Facts and Submissions

I. European patent No. 0 420 918 was granted on 30 December 1992 on the basis of a single claim.

II. This claim reads as follows:

"1. A decanter centrifuge (1) comprising a rotatably journaled bowl (2) and a rotatable screw conveyor (7) journaled in the bowl (2) and of the type in which the conveyor (7) is connected with the bowl (2) through a reduction gear (22) provided with a housing co-rotating with the bowl (2), a driven shaft connected with the screw conveyor (7), and a drive shaft whose number of revolutions determines the relative number of revolutions of the conveyor (7) relative to the bowl (2), characterized in that the reduction gear (22) is rotatably journaled in separate bearings (25, 26), that its housing is connected with the bowl (2) through a flexural but torsionally stiff coupling (28), and in that the driven shaft of the reduction gear and the conveyor (7) are likewise connected through a flexural but torsionally stiff coupling (29)."

III. The opposition filed against the patent by the respondent (opponent) was based on lack of novelty in view of a public prior use of a decanter centrifuge within the meaning of granted claim 1 sold and delivered to OMYA plant in Orgon France in 1970 and resulted in the revocation of the patent in suit in the oral proceedings of 28 June 1996. The written decision

within Article 102(1) EPC was issued on 30 July 1996.

- IV. Against the above decision the patentee - appellant in the following - lodged an appeal on 19 September 1996 paying the appeal fee on the same day and filing the statement of grounds of appeal on 2 December 1996.
- V. The appellant requested to set aside the impugned decision and to maintain European patent No. 0 420 918 as granted and furthermore to reimburse the appeal fee.
- VI. The respondent requested that the appeal be dismissed and that apportionment of the costs incurred in oral proceedings be ordered.
- VII. Following the Board's communication pursuant to Article 11(2) RPBA dated 7 November 1997 in which the Board's provisional opinion about the issues raised by the appellant in his statement of grounds of appeal was given, oral proceedings were held on 14 January 1998 before the Board. With respect to the above requests of the parties essentially the following arguments were brought forward:

(a) appellant:

- the Opposition Division conducted the proceedings with partiality; it is not understood why the respondent got the favourable statement, "that it was difficult for him to research a case that lies around twenty years in the past", whereas the difficulties of the appellant were not

considered at all;

furthermore, in the oral proceedings before the Opposition Division the appellant's representative was handed a copy of the authorization of the respondent's representative only after 12.35 pm, where upon the Opposition Division moved immediately to the verification of the requests without allowing the appellant any time to study the document;

finally, the Opposition Division acted also with partiality with regard to the evidence submitted by the respondent for the alleged prior use: while originally Mr Curdes of the supplier of the reduction gear was named as the witness for verifying the circumstances of the alleged prior use the office accepted statements of another person, namely OMYA'S Mr Chène;

- in his notice of opposition the respondent gave three different addresses. Therefore, his identity was not clear, when filing the opposition; the Opposition Division contributed to the confusion by using still another address for correspondence with the respondent; therefore, the opposition is not admissible;
- furthermore, the signatures on the notice of opposition were not clear and did not indicate the position of the signatories; the fact that

the signatories were professional representatives could not be ascertained from the notice of opposition; if an employee does not identify himself as a professional representative at the beginning of the opposition proceedings, he must file an authorization;

- the Opposition Division committed a substantial procedural violation by neglecting to invoke Rule 101(4) EPC, although the respondent had failed to file authorizations for his employees upon invitation of the Opposition Division within the time limit prescribed;

- the alleged prior use of a decanter centrifuge with the features of granted claim 1 is contested since the respondent could not produce a document showing when the centrifuge was sold to OMYA and under what circumstances; a factory normally is not open to the public so that the knowledge of the alleged prior use was not available for the public; the statements of OMYA'S Mr Chène were produced after the priority date of the claimed invention and have therefore to be disconsidered since they moreover are silent about the sale of the centrifuge and the issue of public access to the alleged prior use.

(b) respondent:

- the identity of the opponent was clear from the

beginning of the opposition proceedings;

- since the signatories of the notice of opposition are professional representatives they did not need to file an authorisation; whether or not the EPO for postal purposes uses an address which is different from the opponent's main address has nothing to do with the admissibility of the opposition;
- the claimed prior use was from the beginning based on the combination of a centrifuge, see (D10) drawing of a "HUMBOLDT WEDAG" solid-bowl centrifuge, type VS, a reduction gear, see drawings (D1) to (D9) of Heinrich Desch KG / DESCH KG / Desch Antriebstechnik, and couplings between the centrifuge and the reduction gear, see (D2), (D8) and (D9) in particular, and see (D13), namely a drawing of "Desch KG" relating to a "Schleudergetriebe ...";
- the user of the centrifuge, namely the French company "OMYA" has assembled the above reduction gear and the above couplings with the (D10) - centrifuge between 4 and 14 February 1971, see (D11), a table of "Desch Antriebstechnik" including "OMYA" as the client, Mr Buson as the client's director and the time indication for the "Montage", namely "v. 4.2.71 - 14.2.71";
- the statements (D12) and (D14) confirm that the centrifuge VS 1 000 x 1 500 was assembled with

the reduction gear/couplings in February 1971 and was in action since then; maintenance/repairing and changing of parts according to (D14) was carried out by "OMYA";

- since "OMYA" was not bound by any arrangements concerning confidentiality the prior use of a decanter centrifuge with all the features of granted claim 1 was public, since "OMYA" was fully aware of the functional advantages of its decanter centrifuge, namely the provision of inner and outer couplings being flexural but torsionally stiff;
- the subject-matter of claim 1 lacks therefore novelty so that the appeal should be dismissed;
- the respondent has indicated all facts with respect to the above prior use within the time-limit for giving notice of opposition including the indication of the witness Mr Curdes; from the fact that the EPO allowed statements of OMYA's Mr Chène into the proceedings it cannot be derived that the EPO was partial since evidence to confirm the facts indicated in due time in the opposition proceedings are open to the discretion of the respondent and not bound by the time-limit for giving notice of opposition;
- appellant's appeal is deemed as an abuse of the appeal proceedings since the issues raised, such as admissibility of the opposition,

authorisations, circumstances of the alleged prior use were clear and already decided upon by the first instance; apportionment of costs incurred in oral proceedings is therefore deemed justified.

Reasons for the Decision

1. The appeal is admissible.

2. *Partiality*

According to Article 24(3) EPC members of a Board of Appeal or of the Enlarged Board of Appeal may be objected to by any party, if suspected of partiality. Although this Article by its wording, applies only to members of the Boards of Appeal and of the Enlarged Board of Appeal, the requirement of impartiality must be considered as a general principle of law according to which nobody should decide a case in respect of which a party may have good reasons to assume partiality. This basic requirement therefore applies also to employees of the departments of the first instance of the EPO taking part in decision making activities affecting the rights of any party (see decision G 5/91 of the Enlarged Board of Appeal, OJ EPO 1992, 617, point 3).

In the present case, however, the Board cannot detect any sign of partiality in the way the Opposition Division conducted the proceedings.

The remark, that "it has surely required the opponent considerable effort to research a case that lies 20 years in the past (1970 versus 1993) and the opponent must be excused to have taken longer to find the relevant documents or even to have waited with the search until it became fully apparent that such document would be important.", was part of the reasoning, why the Opposition Division considered it justified to take the documents into account though they had been filed after the expiry of the time limit for filing an opposition. It is a fact that the farther a prior use dates back in the past, the more difficult it can be to prove it. Whether in this particular case the Opposition Division was mistaken in assuming such difficulties is not a question of partiality.

The further complaint that the appellant's representative was prevented from commenting on the authorization for the respondent's representative because it was handed over to him only just before the requests were verified can also not be followed by the Board. In its communication the Board has already explained that the appellant should have asked to be given the opportunity to comment on the authorization if he had wanted to do so. According to the minutes of the oral proceedings no such request was forwarded. In any case, as also set out in the communication of the Board, for the continuation of the proceedings the authorization was not necessary, the respondent's representative being a professional representative and the Opposition Division not requiring an authorisation because of particular circumstances (decision of the

President of the European Patent Office dated 19 July 1991 on the filing of authorisations Article 1(3), see for further details point below).

Also the admission of evidence originating from Mr Chène, employee of OMYA, by the Opposition Division is not to be criticized as partial. The Opposition Division had to examine the alleged prior use as to its merits and had to evaluate the evidence provided for in that respect. The fact that it took into account two statements of Mr Chène - (D12) and (D14) - because it considered them to be relevant is in accordance with Article 114(1) EPC. As already explained in the communication of the Board, these documents were not even filed late, but partly as reaction to an observation made by the patentee that the notice of opposition did not contain any documents showing the delivery of a specific gear to the customer - (D12), and partly upon specific request of the Opposition Division - (D14).

Partiality can also not be deduced from the fact that the Opposition Division accepted the statements of Mr Chène although in the notice of opposition another person, namely Mr Curdes from Desch Antriebstechnik had been offered as a witness for the proof of the alleged prior use. A party is not obliged to stick to a means of proof indicated at first if in the course of the proceedings specific evidence required can be provided more easily and quicker by another means of proof which the Opposition Division in the exercise of its discretion can accept. Finally the appellant's attention is drawn to the possibility that an objection

on the ground of suspected partiality before the first instance may be disregarded if it has not been raised immediately after the party concerned has become aware of the reason for the objection (decision G 5/91, point 4). This is in the interest of a streamlined economical procedure. In the case under consideration the appellant did not raise this objection in the entire proceedings before the first instance, though the incidents he refers to in his statement of grounds of appeal did not occur at the end of these proceedings.

In this case, however, the Board considered it more appropriate to examine the objections of partiality as to their substance. As they have proved to be not well founded the Board proceeds with the examination of the substantial grounds of appeal.

3. *Admissibility of the opposition*

- 3.1 According to Article 99(1) EPC any person may give notice of opposition to the European patent granted within nine months from the publication of the mention of its grant. By the end of this time limit the opponent must have identified himself as an individual person or entity.

According to Rule 55(a) EPC the notice of opposition shall contain the name and address of the opponent and the state in which his residence or principal place of business is located, in accordance with the provisions of Rule 26, paragraph (2)(c) EPC. In Rule 26(2)(c) EPC it is specified that the names of legal entities shall

be indicated by their official designations and that the addresses shall be indicated in such a way as to satisfy the **customary** requirements for prompt postal delivery; in **any case** they shall comprise all the relevant administrative units including the house number, if any.

The opponent (respondent) started its notice of opposition with the following introductory sentence:
"Hiermit erheben wir, die Klöckner-Humboldt-Deutz Aktiengesellschaft, Nikolaus-August-Otto-Allee 2, 51149 Köln, Bundesrepublik Deutschland, gegen das obengenannte europäische Patent Einspruch ...",

thereby complying with the requirements of Rule 55(a) EPC in connection with Rule 26(2)(c) EPC.

In its communication the Board has explained in detail that the above mentioned requirements being fulfilled the identity of the opponent was clear.

The appellant, however, maintained his view that because in the notice of opposition three addresses, according to him, were given the identity of the opponent was ambiguous and the opposition therefore inadmissible.

It is true that at the top of the notice of opposition, left hand side, there is furthermore printed the address "51057 Köln" without indication of street and house number. As already explained, this latter address is the address for prompt postal delivery as required by Rule 26(2)(c) EPC. By the indication of an

additional address for prompt postal delivery the identity of the opponent is not affected at all.

The so-called third address printed at the top of the notice of opposition, right hand side, "Köln-Porz, Nikolaus-August-Otto-Allee 2" does in substance not differ from the one indicated in the introductory sentence of the notice of opposition. The part of Cologne called Porz is included in the postal number "51149". For the precise indication of the visiting address it makes more sense to nominate, in addition to the street, also the greater unity, namely the district, rather than the postal number which to most people does not convey any useful information.

Therefore, no ambiguity as to the identity of the opponent can be deduced from the indication of the opponent's address in the notice of opposition.

Finally, the appellant maintained his view that the Opposition Division used a fourth address to communicate with the opponent. While the appellant accepted that the opponent cannot be held responsible if the Opposition Division uses an address other than the one indicated by the opponent, he insisted that it was the opponent's responsibility to furnish his address in an unambiguous way, which he had not done, and to advise the EPO if information not furnished by him is published by the EPO. Therefore, clarification of the identity of the opponent was needed.

Apart from the fact that the Opposition Division did **not** use an address other than that provided by the

opponent as also explained in the previous communication, but just added the department "Patent-wesen PR-P" in order to indicate to where **within** the opponent's firm the mail should go, the use of a different address by the Opposition Division would not have affected the identity of the opponent. If he has once disclosed his identity in accordance with the requirements of the European Patent Convention, as in the present case, no subsequent action by the Opposition Division can cast doubt on it.

- 3.2 Furthermore, the appellant objected that the signatures on the notice of opposition were not clear and that the position of the signatories within the opposing company was not indicated.

It is true that the names of the persons signing the notice of opposition were not repeated in block letters or typed.

According to Rule 36(3) EPC all documents, with the exception of annexed documents, filed after filing of the European patent application must be signed. This includes the notice of opposition. The notice from the European Patent Office dated 2 June 1992 concerning the filing of patent applications and other documents, adds in point 3 last sentence that the name and position of the person signing the document must be clear from the signature. According to Rule 36(3) second sentence EPC a document which has not been signed can still be signed within a time limit to be laid down by the office. The same must apply to signatures which are not legible. The fact that a notice of opposition has been filed without signature or with an illegible signature

does not lead immediately to the result that the opposition is deemed not to have been filed. This is, according to Rule 36(3) last half-sentence, only the case if the time limit is not observed.

In the case under consideration, no invitation to remedy the deficiency of illegible signatures was sent to the opponent. Therefore a time limit did not start to run. In all the letters following the notice of opposition the names of the signatories were always typed out. With that, the opponent rectified a possible deficiency on its own initiative.

The second requirement, the position of the signatories, was - contrary to the allegations of the appellant - clearly indicated in the notice of opposition, namely power of attorney for the first signatory, Mr Nau and proxy for the second signatory Mr Christl. By that the opponent indicated that it was not represented by an outside professional representative but acted himself through two employees. The appellant seems to be in error when maintaining his view that the notice of opposition refers neither to employees nor to professional representatives. In its reply to the notice of opposition the appellant himself has identified the abbreviations before the names of the signatories as "per procura" and "in Vollmacht" or "in Vertretung". These terms clearly indicate the position of employees. Being employees they do not appear in the patent register. Only professional representatives who are **not** employees are listed in the patent register.

3.3 In addition the appellant has alleged that the opposition was not admissible because the signatories of the notice of opposition did not file an authorization. According to him an employee must declare with the notice of opposition that he acts as a professional representative. Otherwise he must file an authorization.

This interpretation is erroneous.

According to Article 133(3) EPC natural or legal persons having their residence or principal place of business within the territory of one of the Contracting States may be represented in proceedings by an employee who need not be a professional representative but who must be authorised in accordance with the Implementing Regulations. In Rule 101(1) first and second sentence EPC it is stipulated that representatives shall upon request file a signed authorisation within a period to be specified by the European Patent Office. The President of the European Patent Office shall determine the cases where an authorisation is to be filed. The President has done so by decision of 19 July 1991 (OJ EPO 1991, 489). In Article 3 of this decision it is prescribed that employees who are representing a party under Article 133(3) EPC and who are **not** professional representatives must file a signed authorisation or a reference to a general authorisation already on file. In the case under consideration both signatories of the notice of opposition were professional representatives and thus did not need to file a signed authorisation. Article 1(1) of the above decision stipulates that a professional representative whose name appears on the

list maintained by the European Patent Office and who identifies himself as such shall be required to file a signed authorization only in the circumstances set out in paragraph (2) and (3) below. Contrary to the appellant's allegations no time limit is prescribed as to when such identification must take place. Therefore, it may be done after the filing of the notice of opposition. In view of that it was perfectly legitimate for the signatories of the notice of opposition to reply to the Opposition Division's invitation to file an authorisation by referring the Opposition Division to their being professional representatives. The deficiency had indeed not been the lack of a signed authorisation, but the failure of the signatories of the notice of opposition to identify themselves as professional representatives. The Opposition Division being satisfied with the opponent's reply did not see any reason to invoke paragraph 3 of Article 1 of this decision foreseeing the possibility of requiring an authorisation in particular cases. Therefore, contrary to the appellant's allegations Rule 101(4) EPC prescribing that if the authorization is not filed in due time the procedural steps taken by the representative be deemed not to have been taken, does not apply in the present case, with the consequence that the notice of opposition has to be considered duly filed.

4. *Prior use, novelty*

- 4.1 A centrifuge of KHD Humboldt Wedag AG "VS 1 000 x 1 500" was sold to OMYA in Orgon, France. Details of the centrifuge can be seen from (D10), see headline "type VS". The indication "1 000 x 1 500" for the centrifuge-type is not contradictory to the type-indication "VS" since these figures are merely references to the diameter and the length of the centrifuge in suit.
- 4.2 As can be seen from (D11) OMYA's director, Mr Buson, ordered five reduction gears of the type GM-S71/51-L, which were mounted on the above mentioned centrifuge between 4 and 14 February 1971. It is true that the date of purchase of the centrifuge has not been verified by the respondent, but from (D11) it is clear that OMYA owned such a centrifuge at least in February 1971 i.e. well before the priority date of the patent in suit.
- 4.3 From evidence (D1) to (D9) emanating from the provider of the reduction gear and the flexural but torsionally stiff couplings, namely "Desch", the gear type and the construction of the couplings can be seen in detail.

4.4 While the planetary gear "2" shown in (D10) was cantilever-like mounted, the replacement gear according to (D1) to (D5) was supported on the ground making it necessary to provide for flexural but torsionally stiff couplings according to (D2), (D8), (D9) and (D13). By the provision of the above couplings the resulting decanter centrifuge, namely (D10) plus (D1) to (D5) plus (D2), (D8), (D13) comprises all technical features of granted claim 1 including its advantageous effects on the critical number of revolutions or enabling the increase of the length of the separating space and the separating effect and/or the separating capacity respectively.

4.5 Since "OMYA" was a **client** and as such already constituted the public and since no evidence has been filed in respect of any arrangements with respect to confidentiality between the respondent, the Desch-company and OMYA, the Board is convinced that the fundamentals of the decanter centrifuge according to point 4.4 were made available to the public.

4.6 While it might be difficult or even impossible to get an idea of the **inner** coupling during operation, it has to be borne in mind that a decanter centrifuge has to be regularly maintained including its complete dismounting for inspection or repair or replacement purposes. At least then the construction of the outer **and** inner coupling could easily be seen.

4.7 A further confirmation of the circumstances of the claimed prior use are the declarations of OMYA's Mr Chène, (see (D12) and (D14)), from which it can be

seen that the KHD decanter centrifuge was of the type "VS 1 000 x 1 500", that the gear box from Desch-company was of the type "GM-S71/51L-22824 and that the couplings had curved teeth and coupled the gear box to the centrifuge.

4.8 Since these indications from (D12) and (D14) are consistently in line with respondent's evidence (D1) to (D11) the Board is convinced that the prior use brought forward by the respondent **is proven**.

4.9 Appellant's counterarguments are not convincing for the following reasons:

- the actual date on which the Humboldt Wedag-centrifuge VS was sold to OMYA is not relevant since the further history of **what happened** with the gear of this centrifuge after the sale was clearly proven by the respondent, see for instance (D11) as evidence of **when** the replacement gears were installed;
- it can be left undecided to what extent if any OMYA's premises were publicly accessible before the priority date of the patent in suit since it is believable that OMYA was not bound by an arrangement concerning confidentiality and since OMYA itself has to be seen already as the public to which the technical teaching about the decanter centrifuge with outer/inner couplings being flexural but torsionally stiff was available;
- appellant's request to disconsider all statements

produced by OMYA's Mr Chène has to be rejected; it has to be considered in this context that the respondent clearly has indicated all **facts** of the alleged prior use within the time-limit for giving notice of opposition and that he can prove his facts by whatever evidence he deems best; although a witness was named in opponent's notice of opposition it is possible to bring in evidence from an employee of OMYA, namely Mr Chène, without departing from accepted practice before the Boards.

4.10 Summarizing the above considerations the subject-matter of granted claim 1 lacks novelty with respect to the subject-matter of the prior use brought forward by the respondent so that this claim 1 cannot be maintained, Article 54 and 100(a) EPC.

4.11 The impugned decision of the opposition division can therefore not be set aside.

5. *Reimbursement of the appeal fee*

According to Rule 67 EPC reimbursement of the appeal fees can be requested and shall be ordered where the Board of Appeal deems an appeal to be allowable (first condition), if such reimbursement is equitable (second condition) by reason of a substantial procedural violation (third condition). Only if all three conditions are complied with will the appeal fee be reimbursed by the European Patent Office.

In the present case none of the conditions is

fulfilled, in particular it has to be emphasized that no procedural violation has taken place. The Opposition Division acted in accordance with the provision cited above by not insisting on the filing of authorizations by the signatories of the notice of opposition after they had identified themselves as professional representatives. Therefore, the request of the appellant for reimbursement of the appeal fee must be refused.

6. *Apportionment of costs*

Article 104(1) EPC stipulates that each party to the proceedings shall meet the costs he has incurred. A departure from this principle requires special circumstances. For reasons of equity a different apportionment of costs caused by taking of evidence or by oral proceedings may be ordered. This is the case if costs are culpably incurred owing to improper behaviour or misuse of the proceedings.

In the present case no such improper behaviour has taken place. The appellant merely availed himself of his right to file an appeal, Article 107 EPC, first sentence, and to request oral proceedings, Article 116(1) EPC. According to this provision "oral proceedings shall take place ... at the request of any party to the proceedings". The wording of this provision, which does not contain any restriction, makes it clear that it is a genuine right of any party to request oral proceedings if he considers it necessary. An abuse cannot be based on the fact that the problems to be discussed in oral proceedings had

already been dealt with in the proceedings before the Opposition Division. If a party is of the opinion that a decision of the first instance is wrong he is entitled to file an appeal and to try to convince the Board in oral proceedings that his appeal has to be allowed.

As no abuse can be established in this case, there is no reason for not following the principle that each party meets the costs he has incurred.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request of the appellant for reimbursement of the appeal fee is refused.
3. The request of the respondent for apportionment of costs is refused.

The Registrar:

The Chairman:

N. Maslin

C. T. Wilson