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**Datasheet for the decision
of 17 June 2008**

Case Number: T 0716/06 - 3.2.04

Application Number: 01830178.8

Publication Number: 1249613

IPC: F04D 19/04

Language of the proceedings: EN

Title of invention:

Turbine pump with a stator stage integrated with a spacer ring

Patentee:

VARIAN S.p.A.

Opponent:

Pfeiffer Vacuum GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 100(a), 117

Relevant legal provisions (EPC 1973):

EPC Art. 113(1)

Keyword:

"Alleged public prior use"

"Witness offered but not summoned - substantial procedural violation"

"Remittal (yes)"

Decisions cited:

T 1101/92, T 1198/97, T 0474/04

Catchword:

If a request is made by an opponent to hear a witness on an alleged public prior use and on the disclosure of a certain feature by this prior use, the competent department of the EPO must as a rule grant this request before deciding that the alleged public prior use is neither established nor a novelty destroying state of the art because the feature in question is not found to be disclosed therein.



Case Number: T 0716/06 - 3.2.04

D E C I S I O N
of the Technical Board of Appeal 3.2.04
of 17 June 2008

Appellant: Pfeiffer Vaccum GmbH
(Opponent) Berliner Straße 43
D-35614 Asslar (DE)

Representative: Knefel, Cordula
Patentanwälte Knefel & Knefel
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Respondent: VARIAN S.p.A.
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Representative: Robba, Pierpaolo
Interpatent
Via Caboto 35
I-10129 Torino (IT)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 01 March 2006
rejecting the opposition filed against European
patent No. 1249613 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: M. Ceyte
Members: C. Scheibling
T. Bokor

Summary of Facts and Submissions

I. By its decision posted 1 March 2006 the Opposition Division rejected the opposition. On 2 May 2006 the Appellant (opponent) filed an appeal and paid the appeal fee simultaneously. The statement setting out the grounds of appeal was received on 28 June 2006.

II. The opposition based on Article 100(a) EPC 1973 challenged the European patent on the grounds, inter alia of a novelty destroying public prior use E1 based on the following documents submitted in the notice of opposition:

E1.1: list of construction parts of a turbomolecular pump TMH 261-130

E1.2: drawing PM 063 185 -Z

E1.3: drawing PM 063 180

E1.4: drawing PM 033 198 B

E1.5: invoice 181572, dated 18.05.199

E1.6: notice of revision 7456

E1.7 to E1.10: photos of a pump TMH 261-130, Mod. PM P02 953, serial Nr.12768820

E1.11, E1.12: list of changes made to the drawings

E1.13: invoice to Finnigan Corporation of turbomolecular pumps TMH 261-130

In addition, in the notice of opposition, the opponent offered Mr F. as witness to be heard on this alleged public prior use.

III. The Appellant requested that the decision under appeal be set aside and that the patent be revoked. Oral

proceedings were requested in case the Board did not intend to revoke the patent.

The Respondent (patentee) requested that the appeal be dismissed and that the patent be maintained as granted. Oral proceedings were requested in case the Board intended to revoke the patent.

In its communication dated 13 March 2008, the Board informed the parties that the case was likely to be remitted to the department of first instance and that remittal would be the main issue at the oral proceedings before the Board.

In response to the Board's communication, both Parties withdrew their request for oral proceedings. They did not raise objections to the Board remitting the case to the department of first instance.

Reasons for the Decision

1. The appeal is admissible.
2. The turbine pump defined in claim 1 as granted comprises a stator stage in which the blades overlap so as to make the stage optically opaque in axial direction.

In the drawing E1.4 of the alleged prior use E1 it is mentioned the following: "minimum optically opaque, maximum 0.5 mm at the outer rim".

In his letter of 19 May 2005 the Patentee submitted that a calculation based on the dimensions mentioned on the

drawing E1.4 did not result in an overlap that makes the stator discs optically opaque.

In his letter of 15 September 2005 the Opponent submitted that the stator discs were manufactured in accordance with the indication "optically opaque". The same witness was offered to testify that the manufactured stator discs were in fact optically opaque.

3. In its decision posted 1 March 2006 the Opposition division came to the conclusion that the alleged prior use was not sufficiently substantiated as to the issues what was made available to the public, when and how it was made available. Therefore the alleged prior use was not considered as part of the state of the art in the meaning of Article 54(2) EPC 1973.

The Opposition division has apparently either ignored or overlooked the Opponent's offer to hear the witness named in the notice of opposition on certain details of this alleged prior use. The Opposition division's decision issued without oral proceedings is wholly silent with respect to the Opponent's offer to hear Mr. F. as witness. Thus it can at most be inferred that the Opposition Division might have chosen to disregard the witness because its testimony was not considered to be relevant for the outcome of the decision.

It is true that where oral evidence of a witness is requested by a party the competent department of the EPO should grant this request only if it considers this oral evidence necessary, i.e. when it is required to clarify matters that are decisive for the decision to be taken. This is also reflected in the Guidelines (see Part E, IV.

1.4), which explicitly requires a separate decision by the competent department of the EPO (an order to take evidence), thus implying that in the absence of such a separate decision the witness will not be heard.

There is normally no need for the competent department to hear a witness on an alleged prior use, if it does not evaluate differently the facts and arguments brought forward by the Opponent in support of the claimed prior use. There is also normally no need to hear a witness to testify that an alleged prior use was made available to the public, if this alleged prior use is cited only in support of lack of novelty and the department of the EPO is of the opinion that the alleged prior use is in fact not a novelty destroying state of the art, since establishing availability to the public in that case would have no influence on the decision to be taken.

By contrast, in the present case the Opposition division was of the opinion that not only the claimed public prior use was not established but also this public prior use, even if established, would not be a novelty destroying state of the art, because the feature that the stator disc is optically opaque was not disclosed therein. However, the Opposition division did not consider the Opponent's offer to hear the same witness on these two issues.

In other words, the witness was offered to testify on those facts which specifically concerned the questions of "when and how" and "what" was available to the public, i.e. questions upon which the decision turned.

Evaluating these two issues in combination, i.e. the finding of the non-public character of the prior use, in

combination with the finding that the existence of the feature in question was not proven either, was clearly decisive for the conclusions of the decision under appeal. Therefore the Opposition division should have granted the Opponent's request to hear the offered witness on these two issues before taking a decision thereon.

4. Given that hearing witnesses is one of the means of giving or obtaining evidence according to Article 117 EPC 1973, in ignoring the Opponent's request to hear Mr. F. as witness, even if due to an oversight, the Opposition division has disregarded oral evidence offered on these two issues and thus, infringed the Appellant's right to be heard (Article 113(1) EPC 1973).

This constitutes a substantial procedural violation which in absence of special reasons justifies the remittal of the case to the department of first instance (Article 11 of the Rules of Procedure of the Boards of Appeal) see also T 0474/04, OJ EPO 2006, 129, reasons point 10).

5. As explained above, the key arguments underlying the decision under appeal are directly affected by this substantial procedural violation, thus in the board's judgment there is a strong causal relationship between the procedural violation and the necessity of the appeal. Under such circumstances a reimbursement of the appeal fee is equitable (see also T 1198/97, point 7 of the reasons and T 1101/92, point 5 of the reasons, both cited in the Case Law of the Boards of Appeal, 5th edition, VII.D.15.3.1). This is also illustrated by the fact that the board can not descend on any further

substantive issues of the case until the witness has been heard.

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. Reimbursement of the appeal fee is ordered.

The registrar:

The Chairman:

V. Commare

M. Ceyte