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**Datasheet for the decision
of 21 June 2017**

Case Number: T 1638/12 - 3.5.02

Application Number: 01952690.4

Publication Number: 1312099

IPC: H01H47/00

Language of the proceedings: EN

Title of invention:
Self-powered switching device

Patent Proprietor:
Boyd, Clark Davis
Face, Bradbury R.

Opponent:
EnOcean GmbH

Relevant legal provisions:
EPC Art. 54(3)
RPBA Art. 13(1), 13(3)

Keyword:
Late-filed document - admitted (yes)
Novelty - (no)



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Case Number: T 1638/12 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 21 June 2017

Appellant: EnOcean GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 4 May 2012
rejecting the opposition filed against European
patent No. 1312099 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman R. Lord
Members: M. Léouffre
 R. Cramer

Summary of Facts and Submissions

- I. On 25 June 2012 the opponent appealed against the decision of the opposition division to reject the opposition filed against the European Patent No. EP 1 312 099. The opposition had been based on the ground under Article 100(a) EPC in combination with Article 52(1), 54 and 56 EPC.
- II. The patent proprietors did not file any substantive response to the appeal.
- III. On 20 April 2017, in response to the summons to oral proceedings, the appellant submitted a new document WO 02/42873 A2 (E7) together with the published application document WO 02/07178 A1 (E8) which led to the contested patent, and argued, *inter alia*, that the priority of the contested patent was not valid and that claim 1 was not novel having regard to E7, which was prior art under Article 54(3) EPC.
- IV. With a fax dated 24 May 2017 the patent proprietors (respondents) informed the board that they would not attend the oral proceedings.
- V. On 21 June 2017 oral proceedings were held before the board.
- VI. The appellant requested that the decision under appeal be set aside and the European patent be revoked.
- VII. The respondents had requested in writing that the late filed document E7 not be admitted into the proceedings and that the appeal be dismissed.

VIII. Claim 1 of the patent as granted reads as follows:

"A self-powered switching device comprising:
a flextensional transducer (12), said flextensional transducer (12) comprising;
a first electroactive member (67) having opposing first and second electroded major faces;
said first opposing major face (12a) being substantially convex and said second opposing major face (12c) being substantially concave;
a prestress layer (64) bonded to said second major face (12c) of said first electroactive member (67);
said prestress layer (64) applying a compressive force to said electroactive member (67);
wherein said flextensional transducer (12) is adapted to deform from a first position to a second position upon application of a force to said flextensional transducer;
and wherein upon said deformation to said second position, said flextensional transducer (12) is adapted to generate a first voltage potential between said first electroded major face (12a) and said second electroded major face (12c);
a first conductor (14) electrically connected to said first electroded major face (12a) of said first electroactive member (67);
a second conductor (14) electrically connected to said second electroded major face (12c) of said first electroactive member (67);
signal transmission means electrically connected to said first and second conductors (14), said signal transmission means being adapted to generate a first signal in response to said first voltage potential;
wherein said signal transmission means comprises a radio frequency generator subcircuit (50); a voltage regulator (U1) having an input side and an output side;

said input side of said voltage regulator (U1) being electrically connected to said first and second conductors (14);
said output side of said voltage regulator (U1) being electrically connected to said signal transmission means;
a diode (D1) having an anode and a cathode connected in parallel with said flextensional transducer (12);
said cathode of said diode (D1) being electrically connected to said first conductor (14) and said input side of said voltage regulator (U1);
said anode of said diode (D1) being electrically connected to said second conductor (14) and said input side of said voltage regulator (U1);
whereby said diode (D1) is connected in parallel with first (12a) and second (12c) electroded major faces of said first electroactive member (67); and
a switch (90) having a first position and a second position;
said switch (90) being in communication with said signal transmission means;
said switch (90) being adapted to change from said first position to said second position in response to said first signal;
said switch (90) being adapted to change from said second position to said first position in response to said first signal."

IX. The appellant's arguments in so far as they are relevant for the present decision are as follows:

The Opposition Division had confirmed that the right to priority claimed by the opposed patent was not valid for the subject-matter of claim 1. This finding had not been challenged by the patent proprietors. Thus, the effective date for the subject-matter claimed in claim

1 of the opposed patent was the filing date of the application, i.e. 13 July 2001.

The international application E7, which had been published after the effective date of claim 1 of the patent in suit, had a priority date of 21 November 2000. It entered the European phase on 26 June 2003 and resulted in the grant of the European patent EP 1 346 270. Thus, document E7 was relevant for the question of novelty under Article 54(3) EPC in combination with Rule 165 EPC.

Granted claim 1 corresponded to a combination of the original claims 1, 4, 5 and 6 of document E8.

By comparing these claims with the combination of claims 1, 3 and 4 in document E7, it became immediately evident that these claims used virtually identical language, with the only difference relating to the wording of the feature of claim 1 of E8 (page 21, line 26) "said switch being in communication with said signal transmission means". This feature had been replaced by lines 23-28 and line 31 on page 29 of document E7, i.e. the first radio frequency generator sub-circuit was connected to an antenna, the system further having signal reception means for receiving a first signal transmitted by said first signal transmission means, said signal reception means being adapted to generate a second signal in response to the said first signal transmitted by said signal transmission means, and said switch being in communication with said signal reception means.

These features of E7 inevitably implied that the switch was also in communication with the signal transmission means (since the signal reception means was in turn in

communication with the (first) signal transmission means).

This was immediately evident when comparing the embodiments of figures 6 and 7 of E7 and E8 and the patent in suit which were substantially identical. In particular, the description passage from page 14, line 5 to page 16, line 11 of document E8 relating to figures 6 and 7 (and included in paragraphs [0048] to [0052] of the opposed patent) was identically reproduced in document E7, page 17, lines 1 to 25, page 19, lines 4 to 31, and page 20, lines 6 to 23 (with further disclosure between these sections).

It was, thus, immediately evident that the disclosure of document E7 was novelty-destroying for the subject-matter claimed in claim 1 of the opposed patent. E7 was a publication by the applicants and proprietors of the opposed patent, such that the content of E7 was not a surprise for the proprietors. The highly relevant document E7 had therefore to be admitted into the procedure.

- X. The respondents did not file any substantive argument and solely requested that the late-filed document E7 not be admitted into the proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Absence of a party from oral proceedings*

Following Article 15(3) RPBA the board shall not be obliged to delay any step including its decision, by

reason of the absence of a party duly summoned, in the present case the respondents/proprietors.

3. *Admission of document E7 into the proceedings*

3.1 According to the appellant and the opposition division (see item 3.1 of the contested decision) the priority date of the patent in suit is not valid.

Indeed the following features of claim 1 of the contested patent are not disclosed in the priority document US 09/615234 filed on 13 July 2000 and made available under the Patent Cooperation Treaty:

- "a first electroactive member having opposing first and second electroded major faces; said first opposing major face being substantially convex and said second opposing major face being substantially concave" (features referenced 1.1.1 by the opposition division in item 3 of the contested decision)
- "a prestress layer bonded to said second major face (12c) of said first electroactive member; said prestress layer applying a compressive force to said electroactive member" (features 1.1.2).

This finding was not challenged by the proprietors. Hence, the board considers the effective filing date of the contested patent as being the 13 July 2001.

3.2 Document E7 is an international patent application which was filed on 21 November 2001, claiming a US-priority of 21 November 2000. The respondents did not question the validity of the priority claimed in E7. Consequently document E7 is considered as valid prior art in the sense of Article 54(3) EPC.

3.3 Under Article 13(1) RPBA any amendment to a party's case after it has filed its statement of grounds of appeal or reply may be admitted and considered at the board's discretion. Article 13(3) RPBA adds that amendments to a party's case sought to be made after oral proceedings have been arranged may not be admitted "if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings".

Document E7 was introduced on 20 April 2017, i.e. after the oral proceedings had been arranged. Document E7 relates to the same subject-matter as the contested patent, namely a self-powered trainable switching network incorporating a self-powered switching device. E7 is also a patent application owned by the proprietors of the contested patent which should thus be known to them. The proprietors were therefore not taken by surprise, and, had they been represented at the oral proceedings, should not have had any difficulty in dealing with this *prima facie* highly relevant document without adjournment of the oral proceedings.

Hence, in the present case Article 13(3) RPBA does not preclude the board from admitting document E7 into the proceedings. Thus, the board exercising its discretionary power decided to admit document E7 into the proceedings.

4. *Novelty (Article 54(3) EPC)*

The wording of claim 1 of the contested patent differs from the wording of claim 4 (as a claim dependent on claims 3 and 1) of document E7, by the features:

"said signal transmission means being adapted to generate a first signal in response to said first voltage potential;"

"said switch (90) being in communication with said signal transmission means;" and

"said switch (90) being adapted to change from said first position to said second position in response to said first signal".

In claim 1 of E7 the corresponding features are:

"signal reception means for receiving a first signal transmitted by said first signal transmission means;"

"said reception means being adapted to generate a second second signal in response to said first signal transmitted by said signal transmission means;" and

"said switch being in communication with said signal reception means, said switch being adapted to change between said first position and said second position in response to said second signal".

According to paragraph [0047] of the contested patent "The pulse of electrical energy is transmitted from the actuator via the electrical wires 14 connected to each face 12a and 12c of the actuator 12 to a switch or relay 90", whereby the actuator and the transmitted pulse correspond to the transducer and the first signal mentioned in claim 1 of the contested patent. The transmission means of the contested patent comprises a radio frequency generator 50, a transmitter antenna 60 and a receiver antenna 70 (see figure 6). Thus, in the contested patent, as in E7 which also recites the above passage (see page 17, lines 1 and 2), the switch 90 is adapted to change from a first position to a second position in response to the first signal, which is emitted by the radio frequency generator 50 and its

transmitter antenna 60, and received (as a second signal) by the reception means constituted by the reception antenna 70 before being forwarded to the switch 90 (see figure 6 of the contested patent). The subject-matter of claim 1 is therefore not novel having regard to the disclosure of E7.

5. The opposition ground under Article 100(a) EPC in combination with Article 54 EPC therefore prejudices the maintenance of the patent as granted, so that the board has to accede to the request of the appellant to revoke the patent.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated