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Datasheet for the decision of 12 December 2018

Case Number: T 0526/13 - 3.5.02

Application Number: 03819021.1

Publication Number: 1692752

IPC: H02G13/00, F03D11/00

Language of the proceedings: EN

Title of invention:
Member for potential equalising

Patent Proprietor:
Vestas Wind Systems A/S

Opponent:
LM Wind Power A/S

Relevant legal provisions:
RPBA Art. 12(4)
EPC Art. 123(2), 83, 54(3), 111(1)

Keyword:

Late-filed request - submitted with grounds of appeal was in effect examined by the opposition division
Amendments - allowable (yes)
Sufficiency of disclosure - (yes)
Novelty - (yes)
Appeal decision - remittal to the department of first instance (yes)

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Case Number: T 0526/13 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 12 December 2018

Appellant: (Patent Proprietor)	Vestas Wind Systems A/S Hedeager 42 8200 Aarhus N (DK)
Representative:	Samson & Partner Patentanwälte mbB Widenmayerstraße 6 80538 München (DE)
Respondent: (Opponent)	LM Wind Power A/S Jupitervej 6 6000 Kolding (DK)
Representative:	COPA Copenhagen Patents Rosenørns Allé 1, 2nd floor DK-1970 Frederiksberg C (DK)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 14 December 2012 revoking European patent No. 1692752 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	R. Lord
Members:	G. Flyng
	W. Ungler

Summary of Facts and Submissions

I. The patent proprietor is appealing against the decision of the opposition division revoking the European patent number EP 1 692 752.

II. In the contested decision the opposition division held that the opposition was admissible and that the grounds for opposition invoked, i.e. Articles 100 (a), (b) and (c) EPC, were all substantiated.

Regarding the main request (patent as granted) the opposition division found that claim 1 lacked novelty "a priori". They considered that "according to patent claim 1, said [conducting] member may be for instance an electrically conductive strip - or even more general - a piece of metal" and that these were "well known to the public at the claimed priority date of the patent".

In an additional remark the opposition division held that claim 1 of the main request lacked novelty from **document D7 (US 3 923 421).**

The opposition division held furthermore that the auxiliary request that was filed during oral proceedings on 9 November 2012 was admissible, but that the subject-matter of its claim 1 lacked novelty over **document D2 (EP 1 664 528)** under Article 54(3) EPC.

III. With a letter dated 24 April 2013 containing the statement of grounds of appeal the appellant (patent proprietor) filed:

- a set of claims according to a first auxiliary request (labelled "Annex P5") and

- a set of claims according to a second auxiliary request (labelled "Annex P6").

The respondent (opponent) replied to the appeal with a letter dated 5 September 2013.

With a letter dated 3 September 2015 the appellant responded to the respondent's reply and filed a set of claims according to a third auxiliary request (labelled "Annex P7").

IV. The Board summoned the parties to attend oral proceedings on 12 December 2018. In a communication annexed to the summons the Board set out their preliminary observations on the appeal.

V. Oral proceedings were held on 12 December 2018.

The appellant (patent proprietor) requested finally that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the set of claims filed as first auxiliary request with letter dated 24 April 2013 (**new main request**), auxiliarily that the patent be maintained in amended form on the basis of the second auxiliary request filed with letter dated 24 April 2013, or on the basis of the third auxiliary request filed with letter dated 3 September 2015.

The respondent (opponent) requested finally that the appeal be dismissed, or as an auxiliary request that the case be remitted to the department of first instance if inventive step were to be discussed.

The present decision was given at the oral proceedings.

VI. Claim 1 of the **new main request** (i.e. "Annex P5" to the letter dated 24 April 2013) reads as follows (feature references added by the Board):

"1. A wind turbine blade (8), comprising

A a first conducting member (4),

B a second conducting member (6) and

C a member (2) for potential equalising between the first conducting member (4) and the second conducting member (6), the member (2) for potential equalising comprising

C1 - an electrical conductor (10),

C2 - a first contact part (12)

C2a connected to said first conducting member (4) of said wind turbine blade (8)

C2b for providing a potential equalising connection between said first conducting member (4) and said electrical conductor (10),

C3 - a second contact part (14)

C3a connected to said second conducting member (6) of said wind turbine blade (8)

C3b for providing a potential equalising connection between said second conducting member (6) and said electrical conductor (10),

A1 wherein said first conducting member (4) comprises carbon fibres and

B1 said second conducting member (6) is a lightning conductor

characterised in that

C2c said first contact part (12) is shaped substantially as a ribbon

C2d wherein said first contact part (12) comprises a conducting metal ribbon (20),

C2e wherein conducting metal ribbon (20) is a flexible sheet or a flexible mesh, and

C2f said conducting metal ribbon (20) is oriented substantially orthogonal to the main orientation of the carbon fibres of said first conducting member."

VII. The submissions of the appellant in respect of the new main request may be summarised as follows:

(a) The new main request should not be held inadmissible under Article 12(4) RPBA. During the first-instance oral proceedings, the appellant attempted several times to overcome the objection of lack of novelty (Article 54(3) EPC). Each time they added further features to claim 1 of the auxiliary request and withdrew the previous auxiliary request. The opposition division held that even claim 1 of the final version of the auxiliary request in first-instance lacked novelty, Article 54(3) EPC. This version of claim 1 included all of the features of claim 1 of the new main request now under consideration. Hence, the first-instance decision on the auxiliary request covered all of the features of claim 1 of the new main request.

(b) The subject-matter of claim 1 of the new main request is directly and unambiguously derivable from claims 1, 2, 11, 21 and 22 of the application as filed. Hence, Article 123(2) EPC is not contravened.

(c) The subject-matter of claim 1 of the new main request is sufficiently disclosed, Article 83 EPC.

(d) The subject-matter of claim 1 of the new main request is novel over **document D6 (WO 2005/026538 A1)**. Document D6 does not disclose the features ***C2c*** and ***C2f*** (for references see section VI. above). The feature that the first contact part is "shaped substantially as a ribbon" is to be understood in

the sense that its length is much greater than its width. It is not directly and unambiguously derivable from document D6 that the length of the copper grid 12 or the lowest of the mats 13 is greater than the width, i.e. that they are shaped substantially as a ribbon. Furthermore, it is not directly and unambiguously derivable from document D6 that the carbon fibres have a main orientation longitudinal to the blade or that the first contact part is oriented orthogonal to the main orientation of the carbon fibres.

(e) The case should not be remitted to the opposition division. Inventive step was discussed in the first-instance proceedings.

VIII. The submissions of the respondent in respect of the new main request may be summarised as follows:

(a) The new main request should be held inadmissible under Article 12(4) RPBA. This request was not filed before the department of first instance. Compared to the auxiliary request that was decided upon at first-instance the "contact-enhancing layer" feature has been deleted. A request without this feature in claim 1 was discussed in the first-instance oral proceedings, but this request was withdrawn and the only auxiliary request pursued included the "contact-enhancing layer".

(b) Claim 1 of the new main request, directed to a "wind turbine blade", violates Article 123(2) EPC. From the description it is clear that it is the entire member for potential equalising that has to be oriented orthogonal to the carbon fibres of the spar, not only the metal ribbon of the contact part

(12).

(c) The subject-matter of claim 1 of the new main request is not sufficiently disclosed, Article 83 EPC. The application as filed only discusses unidirectional fibres, cf. page 5, lines 6 to 10 of the application as filed (see WO 2005/50808). Claim 1 refers to a "main orientation of the carbon fibres". The meaning of this is not clear and there is no teaching for the skilled person as to how to implement a turbine blade with carbon fibres in any "main orientation".

(d) The subject-matter of claim 1 of the new main request lacks novelty over document D6 under Article 54(3) EPC. It is evident from the proportions in figures 1, 3 and 5 of D6 and from the statement in the description that "the grid 12 is conveyed across a part of the principal laminate 7 where it is in contact with the not shown electrically conductive fibres" (see D6, page 8, line 30 to page 9, line 2) that the lowest layer of the mats 13 of the electrically conducting means 6 is "shaped substantially as a ribbon". Furthermore, it is evident from figures 1, 3 and 5 of D6 that the electrically conductive means 6 is oriented substantially orthogonally to the spanwise direction of the blade. It would be implicit to the skilled person that the carbon fibres of the principal laminate 7 of D6 would be mainly oriented in the spanwise direction of the blade. Hence, the electrically conductive means 6 of D6 is oriented substantially orthogonally to the main orientation of the carbon fibres in the spanwise direction of the blade.

(e) The question of inventive step was not addressed in the contested decision. To ensure examination before two instances the Board should exercise its discretion to remit the case to the opposition division for further prosecution.

Reasons for the Decision

1. New main request - Admittance

1.1 Article 12(4) RPBA gives the Board the discretionary power to hold inadmissible requests which could have been presented in the first instance proceedings. It allows an infringement of the duty to facilitate the first-instance proceedings to be penalised (cf. Case Law of the Boards of Appeal (CLBA), IV.E.4.3.1, second paragraph).

1.2 When a patent proprietor deliberately chooses not to obtain a decision from the opposition division on a certain request (i.e. claim), allowing them to revert on appeal to that request may go against the need for procedural economy and lead to the request being not admitted (cf. T 1964/12).

1.3 In the present case, however, the Board considers that the actions of the patent proprietor in first-instance did not have the effect of preventing the opposition division from deciding on the substance of the request that was filed on appeal (as first auxiliary request) and is now the new main request.

1.4 The opposition division decided that claim 1 of the final version of the auxiliary request submitted in first-instance lacked novelty, Article 54(3) EPC. In other words, all of its features were considered to be known from the earlier application.

1.5 Given that claim 1 of that auxiliary request includes all of the features of claim 1 of the new main request now under consideration, it is directly derivable that the opposition division would have come to the same conclusion on the present "new main request" had they been faced with it in first-instance. As the appellant put it, the first-instance decision on the auxiliary request covered all of the features of claim 1 of the new main request.

1.6 Hence, allowing the appellant to introduce the new main request on appeal does not in the present case go against the need for procedural economy.

1.7 Accordingly, the Board decided not to exercise its discretion under Article 12(4) RPBA not to admit the new main request into the proceedings (i.e. the new main request was admitted into the proceedings).

2. New main request - Article 123(2) EPC

2.1 As set out below, the subject-matter of claim 1 of the new main request is directly and unambiguously derivable from claims 1, 2, 11, 21 and 22 of the application as filed (see WO 2005/050808 A1):

- Claim 22 as filed was dependent on any of claims 1 to 21 and disclosed a wind turbine blade with first and second conducting members connected respectively to first and second contact parts of a potential equalising (PE) member;
- Claim 1 as filed disclosed that the PE member comprised an electrical conductor and first and second contact parts, that the first contact part was shaped substantially as a ribbon, and that the

first conducting member of the wind turbine blade comprised carbon fibres;

- Claim 2 as filed disclosed that the first contact part comprised a conducting metal ribbon such as a flexible sheet or a flexible mesh;
- Claim 11 as filed disclosed that the second contact part comprised a clamp for connecting to a lightning conductor, implying that the second conducting member of the wind turbine blade, to which the second contact part was connected, was a lightning conductor (which is consistent with the description, see for example page 5, lines 7 to 10); and
- Claim 21 as filed disclosed that the conducting metal ribbon was oriented substantially orthogonal to the main orientation of the carbon fibres of the first conducting member.

2.2 The Board is not convinced by the respondent's argument that it is clear from the description that it is the entire member for potential equalising that has to be oriented orthogonal to the carbon fibres of the spar, not only the metal ribbon of the contact part (12). It would be evident to the skilled reader from the disclosure at page 14, line 35 to page 15, line 6 that to enhance potential equalising only the contact part 12 needs to be arranged orthogonally to the carbon fibres. The arrangement of the rest of the PE member is immaterial for the quality of the contact to the carbon fibres of the first contact member (spar).

2.3 For these reasons the Board came to the conclusion that the new main request meets the requirements of Article 123(2) EPC.

3. New main request - Article 83 EPC

The description as filed makes clear that orientating the conducting metal ribbon (first contact part) orthogonal to the orientation of the carbon fibres of the spar will enhance the potential equalising within the spar substantially compared to a point contact only having contact with a few carbon fibres in the surface of the conducting member (see page 14, line 32 to page 15, line 1). The Board can see no difficulty for the skilled person to apply this principle to any "first conducting member" comprising carbon fibres that have a discernible main orientation. The expressions "substantially orthogonal" and "main orientation" merely express that in practice the carbon fibres need not be perfectly straight and parallel and that the conducting metal ribbon does not need to be perfectly orthogonal to them to achieve the desired effect (see appellant's argument to this effect in the letter dated 3 September 2015, page 6, second paragraph). Furthermore, to achieve the disclosed effect it is not important in which direction the carbon fibres of the turbine blade are oriented, but merely that the conducting metal ribbon is oriented orthogonal to their main orientation. Hence, the Board sees no insufficiency of disclosure and concludes that claim 1 of the new main request meets the requirements of Article 83 EPC.

4. New main request - Article 54(3) EPC

4.1 The opposition division held in the contested decision that claim 1 of the then auxiliary request lacked novelty, Article 54(3) EPC, over document D2 and the respondent initially argued the same for claim 1 of the new main request. For the sake of correctness the Board

notes that document D2 is a European patent, not a European patent application, and hence cannot form part of the state of the art in the sense of Article 54(3) EPC. Document D6, the international application which led to the European patent D2, does form part of the state of the art in accordance with Article 153(5) in conjunction with 54(3) EPC, specifically implementing the principle of it being equivalent to a regular European application (cf. Article 153(2) EPC). Hence, any lack of novelty under Article 54(3) EPC can only be raised with respect to document D6, not document D2. Hence, the Board will refer in the following to the content of document D6.

4.2 In document D6 the copper grid 12 of the electrically conductive means 6 can be considered to be a "first contact part" in the sense of claim 1 of the new main request.

4.3 Regarding the feature ***C2c***, the respondent submits that it is evident from the proportions in figures 1, 3 and 5 of D6 and from the statement in the description that "the grid 12 is conveyed across a part of the principal laminate 7 where it is in contact with the not shown electrically conductive fibres" (see D6, page 8, line 30 to page 9, line 2) that the grid 12 of the electrically conducting means 6 is "shaped substantially as a ribbon".

4.4 The Board is not convinced by this. The Board shares the appellant's view that "shaped substantially as a ribbon" is to be understood in the present context in the sense that the length of the first contact part is much greater than its width. In the Board's view it is not directly and unambiguously derivable from document D6 that the length of the copper grid 12 is greater

than the width. The disclosure that "the grid 12 is conveyed across a part of the principal laminate 7 where it is in contact with the not shown electrically conductive fibres" does not give any indication that the length of the grid 12 is greater than its width. Indeed there is no mention in the description of how wide the electrically conducting means 6 is, or whether it is ribbon-shaped. Only figures 3, 5 and 7 depict the electrically conducting means 6 in such a way that the length and width can be to some extent compared. In the Board's view, however, it is not discernible that the length of the grid 12 of the electrically conducting means 6 is significantly greater than its width, at least not to an extent that the grid 12 can be considered to be shaped substantially as a ribbon.

4.5 In addition to the above, the Board considers that it is not directly and unambiguously derivable from document D6 that the carbon fibres have a main orientation longitudinal to the blade or that the first contact part is oriented orthogonal to the main orientation of the carbon fibres.

4.6 Regarding the feature ***C2f***, the Board concurs with the respondent that it is evident from figures 1, 3 and 5 of D6 that the electrically conductive means 6 is oriented substantially orthogonally to the spanwise direction of the blade. However the Board is not convinced that it would be implicit to the skilled person that the fibres of the principal laminate 7 of D6 would be oriented in the spanwise direction of the blade. The Board is convinced by the appellant's argument that there are various known non-linear arrangements of the carbon fibres in wind turbine blades (for example meshes, weaves, etc.) and that the skilled person would not necessarily assume that there

is a "main orientation of the carbon fibres" in the spanwise direction of the blade. Hence, the Board is not convinced that feature ***C2F*** is directly and unambiguously derivable from document D6.

4.7 For these reasons the Board concludes that the subject-matter of claim 1 of the first auxiliary request is novel over document D6 and hence novel over the prior art in the sense of Article 54(3) EPC.

5. Request for remittal, Article 111(1) EPC

5.1 The question of inventive step was not addressed in the contested decision as the opposition division found that claim 1 of the auxiliary request lacked novelty from the prior art under Article 54(3) EPC.

5.2 During the first-instance oral proceedings the patent proprietor (now appellant) was given an opportunity to file amended requests to deal with that objection, but chose not to (see minutes, paragraph 7). It is thus as a result of the patent proprietor's choice that inventive step was not considered in the first-instance proceedings. Taking this into consideration the Board decided, at the respondent's request, to exercise their discretion to remit the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division for further prosecution.

The Registrar: The Chairman:

U. Bultmann R. Lord

Decision electronically authenticated