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Datasheet for the decision of 8 March 2019

Case Number: T 1349/14 - 3.4.02

Application Number: 07839039.0

Publication Number: 2074385

IPC: G01F1/60, G01F25/00

Language of the proceedings: EN

Title of invention:
MAGNETIC FLOWMETER WITH VERIFICATION

Patent Proprietor:
Rosemount Inc.

Opponents:
Endress+Hauser (Deutschland) AG+Co.KG/
Endress+Hauser Flowtec AG

Headword:

Relevant legal provisions:
EPC 1973 Art. 100(c), 100(a), 54(1), 56, 111(1), 113(1), 116
RPBA Art. 12(4), 13(1)

Keyword:
Novelty - main request (no)
Late-filed auxiliary request - request could have been filed in first instance proceedings (yes) - admitted (yes)
Amendments - extension beyond the content of the application as filed (no)
Late-filed objection - admitted (yes)
Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 1349/14 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 8 March 2019

Appellant: (Patent Proprietor)	Rosemount Inc. 6021 Innovation Boulevard Shakopee, MN 55379 (US)
Representative:	Vossius & Partner Patentanwälte Rechtsanwälte mbB Siebertstrasse 3 81675 München (DE)
Respondents: (Opponents)	Endress+Hauser (Deutschland) AG+Co.KG/ Endress+Hauser Flowtec AG Colmarer Strasse 6/Kägenstrasse 7 79576/4153 Weil am Rhein/Reinach CH (DE)
Representative:	ENDRESS+HAUSER (DEUTSCHLAND) AG+CO. KG PATSERVE Colmarer Strasse 6 79576 Weil Am Rhein (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 25 April 2014 revoking European patent No. 2074385 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	R. Bekkering
Members:	H. von Gronau
	T. Karamanli

Summary of Facts and Submissions

I. The appeal of the patent proprietor is directed against the decision of the opposition division to revoke the European patent No. 2074385 pursuant to Article 101(2), first sentence, EPC.

II. With its notice of opposition, the opponents submitted the following documents:

D1: US 6 611 775 B1,
D2: DE 103 56 007 B3,
D3: WO 2006/051337 A1,
D4: US 6 014 902 A,
D5: US 6 697 742 B1,
D6: DE 10 2006 006 152 A1.

The opponents opposed the patent on the following grounds:

(a) the subject-matter of the patent extended beyond the content of the application as filed (Article 100(c) EPC),
(b) the subject-matter of claim 1 was not inventive in view of document D1 or D2 combined with document D3 or D4 (Articles 100(a) and 56 EPC),
(c) the subject-matter of claim 10 was not new in view of document D5 (Articles 100(a) and 54(1) EPC), and
(d) the subject-matter of claim 10 was not inventive in view of document D6 combined with document D3 or D4 (Articles 100(a) and 56 EPC).

The opponents requested that oral proceedings be held if the opposition division intended to reject the opposition.

III. In its reply to the notice of opposition, the patent proprietor argued that none of the raised grounds for opposition prejudiced the maintenance of the granted patent and it requested that the opposition be rejected. It did not request oral proceedings.

IV. By a letter dated 10 April 2013, the opponents filed a further document (D7: DE 101 34 672 C1) and submitted further arguments with respect to the grounds for opposition under Article 100(c) EPC and under Articles 100(a) and 56 EPC.

V. By a reply dated 7 March 2014, the patent proprietor maintained its request and responded to the opponents' arguments. It also argued that document D7 was late-filed and should therefore not be admitted into the proceedings.

VI. The opposition division issued its decision without holding oral proceedings. The opposition division found that the subject-matter of the opposed patent did not extend beyond the content of the application as filed. However, the patent was revoked on the ground that the subject-matter of granted independent claim 10 was not new in view of the disclosure of document D5.

The opposition division also found that the opponents' arguments with respect to the inventiveness of the subject-matter of granted claim 1 were not persuasive. It also considered that, in view of the lack of novelty of the subject-matter of granted claim 10, there was no necessity for the opposition division to further examine of its own motion the question of novelty and inventive step of the subject-matter of granted claim 1.

VII. With its statement setting out the grounds of appeal, the patent proprietor (appellant) requested that the decision of the opposition division be set aside and the patent be maintained as granted (main request). As an auxiliary measure, it requested that the patent be maintained as amended on the basis of the claims according to a new auxiliary request 1 filed with the grounds of appeal, in which, in comparison to the claims of the main request, claim 10 had been deleted.

VIII. In its reply, the respondents (opponents) requested that the appeal be dismissed. They argued that the subject-matter of granted claim 10 was not new in view of document D5 and they submitted that new auxiliary request 1 should not be admitted into the appeal proceedings, since it could have been filed in the first-instance proceedings. In addition, they referred to their submissions filed in the first-instance proceedings in respect of the raised grounds for opposition under Article 100(c) EPC and, with respect to claim 1, under Article 100(a) EPC.

IX. By letter dated 27 October 2015, the appellant filed claims according to a new auxiliary request 2, in which independent claims 1 and 10 comprised additional features taken from paragraph [0008] of the description of the granted patent, and it presented further arguments.

X. As an auxiliary measure both parties requested to hold oral proceedings.

XI. In a communication annexed to the summons to oral proceedings, the board expressed its provisional opinion that inter alia the subject-matter of independent claim 10 of the main request was not new in

view of document D5 and that the board would have to decide on the admissibility of the appellant's auxiliary requests. In case the board admitted auxiliary request 1, it would be discussed whether the subject-matter of granted independent claim 1 extended beyond the content of the application as filed and whether it was new and involved an inventive step.

XII. By a reply dated 6 February 2019 to the board's communication, the appellant submitted that the subject-matter of granted independent claim 10 was new in view of document D5, that the subject-matter of granted claim 1 fulfilled the requirements of Article 123(2) EPC and was new and involved an inventive step in view of document D5, that auxiliary request 1 was filed in response to the contested decision with the grounds of appeal and, since there was no preliminary opinion provided by the opposition division, auxiliary request 1 could not have been filed earlier, and that both auxiliary requests should be admitted into the appeal proceedings.

XIII. Oral proceedings took place on 8 March 2019.

With respect to auxiliary request 1, the respondents raised in the oral proceedings an objection under Article 100(c) EPC. They also referred to their written submissions in the first-instance proceedings and raised an objection under Articles 100(a) and 54(1) EPC, i.e. that the subject-matter of claim 1 was not new with respect to document D5, and further objections under Articles 100(a) and 56 EPC, i.e. that the subject-matter of claim 1 was not inventive with respect to document D1 combined with document D5, document D5 combined with document D1, or document D1 combined with document D4 or document D3.

The parties' final requests were as follows:

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the opposition be rejected (main request) or, in the alternative, that the patent be maintained as amended on the basis of the claims according to auxiliary request 1 filed with the statement of grounds of appeal, or, if the respondents' objection of lack of novelty against claim 1 with respect to document D5 was admitted into the appeal proceedings, that the case be remitted to the department of first instance for further prosecution (auxiliary request 1a), or that the patent be maintained as amended on the basis of the claims according to auxiliary request 2 filed by letter dated 27 October 2015.

The respondents (opponents) requested that the appeal be dismissed (main request) or as an auxiliary request, if the appellant's auxiliary request 1 was admitted into the appeal proceedings, that the decision under appeal be set aside and that the case be remitted to the department of first instance for examination of novelty and inventive step.

At the end of the oral proceedings the chairman of the board announced the decision.

XIV. Claim 10 as granted reads as follows:

"A method for verifying operation of a magnetic flowmeter (20), comprising:

storing a plurality of nominal parameter values in a non-volatile memory during manufacture of the

flowmeter;
electrically coupling to a magnetic flowtube (22) arranged to receive a flow of process fluid, the flowtube (22) coupled to a flow of process fluid, the magnetic flowtube (22) including a drive coil (26) and at least one sense electrode (30, 32);
measuring a plurality of parameters of the magnetic flowtube (22);
retrieving the stored nominal parameter values from the non-volatile memory of the flowtube; and
providing a verification output based upon a comparison of the measured parameters of the magnetic flowtube and the stored nominal parameter values."

XV. Claim 1 of auxiliary request 1 filed with the grounds of appeal reads as follows:

"A magnetic flowmeter (20), comprising:
a magnetic flowtube (22) arranged to receive a flow of process fluid, the magnetic flowtube (22) including a drive coil (26) and at least one sense electrode (30; 32);
measurement circuitry (154) coupled to the flowtube (22) configured to provide a drive signal to the drive coil (26) and measure flow (21) of process fluid through the flowtube (22) based upon an output from the at least one sense electrode (30, 32);
a memory (204) configured to contain a plurality of stored values (222) related to nominal parameters of the flowtube placed in the memory (204) during manufacture of the flowmeter; and
verification circuitry (200) arranged to measure a plurality of parameters of the magnetic flowtube (22) and responsively provide a verification output (210) related to operation of the magnetic flowmeter (20) based upon a comparison of the plurality of measured

parameters and the plurality of stored values, characterized in that the memory (204) is a non volatile memory."

Reasons for the Decision

1. Main request - subject-matter of granted claim 10 - ground for opposition under Article 100(a) EPC 1973 in combination with Article 54(1) EPC 1973 (lack of novelty)

1.1 The opposition division was of the opinion that the method of independent claim 10 was not new with respect to document D5.

1.2 The respondents agreed with the finding in the decision under appeal and argued in particular that, according to the wording of claim 10, the non-volatile memory did not have to be part of the flowmeter. Otherwise, however, this feature was already disclosed in document D5, in that the non-volatile memory described therein could also be an integral part of the flowmeter (cf. column 5, lines 45-49, and column 4, lines 1-5). In the oral proceedings, the respondents argued that it was clear from these passages that all computing capabilities including the non-volatile memory were integrated into the transmitter of the flowmeter to perform the verification of the flowmeter and the skilled reader understood that the non-volatile memory was not limited to the floppy disk when integrating the computing functionality into the flowmeter.

1.3 The appellant argued that the nominal data in document D5 were not stored in a non-volatile memory during the manufacture of the flowmeter (cf. point 3.1.1 of the

grounds of appeal, point 1.2 of the letter dated 27 October 2015). The appellant also put forward that document D5 did not disclose the non-volatile memory forming part of the flowmeter (cf. point 3.1.2 on pages 5 and 6 of the grounds of appeal, point 1.1 of the letter dated 27 October 2015).

During the oral proceedings the appellant emphasized that a non-volatile memory was normally not part of the flowtube and document D5 did also not disclose a non-volatile memory as part of the flowtube that contained parameters of the flow tube placed in the memory during manufacture. D5 disclosed that the necessary test circuitry including the computing capability equivalent to the PC 22 was integrated into the transmitter 18 (see column 5, lines 45-49), but for testing the transmitter 18 was disconnected (see column 4, lines 8-11). Thus document D5 did not provide a teaching of a non-volatile memory which was part of the flowmeter. The floppy disk described in column 4, lines 1-5, was an external memory which could not be integrated into the transmitter. Therefore, the flowmeter did not contain a non-volatile memory.

1.4 The board agrees with the opinion of the opposition division. Document D5 discloses a method for verifying operation of a magnetic flowmeter (cf. title), comprising:
storing a plurality of nominal parameter values in a non-volatile memory (the data is stored "for example on a floppy-disk") during manufacture of the flowmeter (see column 4, lines 1-7, and column 5, lines 45-49);
electrically coupling to a magnetic flowtube arranged to receive a flow of process fluid, the flowtube coupled to a flow of process fluid, the magnetic

flowtube including a drive coil 12, 14 and at least one sense electrode 16 (cf. column 3, lines 47-67);
measuring a plurality of parameters of the magnetic flowtube (cf. column 4, lines 26-32; claim 1, "measuring at least two electrical parameters");
retrieving the stored nominal parameter values from the non-volatile memory of the flowtube (see claim 1, the step of "comparing the measured parameters to stored parameters" includes necessarily that the stored parameters are retrieved beforehand; see column 5, lines 45-49, the necessary test circuitry including computing capability equivalent to the PC 22 being integrated into the transmitter of the flowmeter, this includes also a suitable non-volatile memory; column 4, lines 8 to 11, for testing the transmitter is disconnected from remote equipment to which it normally supplies its output, but it is not disconnected from the flowtube); and
providing a verification output based upon a comparison of the measured parameters of the magnetic flowtube and the stored nominal parameter values (cf. claim 1, "determining whether the calibration of the flowmeter is accurate").

Thus, all features of independent claim 10 are known from document D5.

1.5 It follows from the above that the ground for opposition under Article 100(a) EPC 1973 in combination with Article 54(1) EPC 1973 prejudices the maintenance of the patent as granted.

2. Auxiliary request 1 - Admission (Article 12(4) RPBA)

2.1 Article 12(4) RPBA empowers the boards of appeal to hold inadmissible requests which could have been

presented by the patent proprietor in first-instance proceedings. Thus, the boards of appeal, whose primary function is to review the decisions of the departments of first instance, have the discretion not to admit requests into the appeal proceedings which were not submitted during the first-instance proceedings (see Case Law of the Boards of Appeal of the EPO, 8th edition 2016, IV.E.4.3.2.c)).

2.2 With the grounds of appeal the appellant amended its patent as granted for the first time, i.e. it filed claims 1-9 of auxiliary request 1. In comparison to the claims of the patent as granted (present main request), the only amendment is the deletion of granted independent method claim 10.

2.3 The respondents requested that auxiliary request 1 not be admitted into the appeal proceedings. The notice of opposition already indicated the ground for opposition of lack of novelty and the reasons why the subject-matter of claim 10 of the granted patent could not be regarded as new. Therefore, auxiliary request 1 could and should have been filed in reply to the notice of opposition, i.e. during the first-instance proceedings. By failing to do so and in the absence of a request for oral proceedings by the patent proprietor in the first-instance proceedings, there was no reason for the opposition division to hold oral proceedings. Consequently, the respondents had been prevented from making oral submissions at oral proceedings before the opposition division with respect to auxiliary request 1 and had therefore been deprived of their right to be heard.

2.4 The appellant argued that auxiliary request 1 was filed with the grounds of appeal in response to the first

opinion issued by the opposition division on novelty of the subject-matter of granted claim 10, namely the finding in the decision under appeal. Since, prior to that decision, no preliminary opinion had been provided by the opposition division and no oral proceedings had taken place before the opposition division, the patent proprietor did not have any indication in the course of the first-instance proceedings that the subject-matter of claim 10 might be considered to lack novelty. Hence, auxiliary request 1 could not have been filed earlier than with the statement of grounds of appeal and was therefore not late-filed. Furthermore, the amendment consisted only of the deletion of a single granted independent claim and it thus reduced the complexity of the case. In addition, the opposition division had also dealt with claim 1 in the decision under appeal.

2.5 The board is of the opinion that, in view of the contents of the notice of opposition and the opponents' further letter, the appellant could and should have filed auxiliary request 1 in the first-instance opposition proceedings, either with its reply to the notice of opposition or with its further letter of reply. The board does not accept the appellant's argument that it could not have presented auxiliary request 1 in the first-instance proceedings because no preliminary opinion had been issued by the opposition division and no oral proceedings had taken place prior to the decision under appeal. The decision under appeal does not contain any objection against the granted patent which goes beyond the objections raised by the respondents in the first-instance proceedings. Hence, the appellant was aware of all objections raised against its patent prior to the decision under appeal and, therefore, it could and should have submitted further requests in reaction to these objections.

Moreover, the appellant could not have expected oral proceedings before the opposition division because it had not filed a request for oral proceedings and, therefore, the opposition division could issue a revocation decision on the basis of the objections raised by the opponents without holding oral proceedings.

2.6 It follows from the above that the board had the discretion under Article 12(4) RPBA not to admit auxiliary request 1 into the appeal proceedings.

2.7 The board, in exercising this discretion, took the circumstances of the present case into account.

First, the claims of auxiliary request 1 correspond to granted claims 1 to 9, i.e. they remained unchanged. Further, the opposition division already expressed an opinion on some aspects with respect to the patentability of the subject-matter of independent claim 1 in the appealed decision. Auxiliary request 1 therefore does not constitute an entirely fresh case.

In addition, the board does not accept that the respondents had a right to make oral submissions with respect to claim 1 at oral proceedings before the opposition division and that they had been deprived of this right to be heard because of the appellant's failure to file auxiliary request 1 during the first-instance proceedings. The procedure before the EPO is in principle, with the exception of oral proceedings under Article 116 EPC 1973, a written procedure. The right to present comments enshrined in Article 113(1) EPC 1973 may therefore be exercised in writing. However, the right to oral proceedings regulated by Article 116(1) EPC 1973 forms a substantial part of the

right to be heard pursuant to Article 113(1) EPC 1973. This means that Article 113(1) EPC 1973 cannot be interpreted in a way that a party's right to be heard is already satisfied if a party, having requested oral proceedings according to Article 116(1) EPC 1973, has had the opportunity to present its arguments in writing. However, only non-compliance with a party's request for oral proceedings deprives the party of its right to be heard pursuant to Article 113(1) EPC 1973. In the present case, the respondents had requested oral proceedings before the opposition division before an adverse decision was issued. This means that they had requested the opportunity to present their comments in oral proceedings only if the opposition division did not decide in their favour. Since the opposition division revoked the patent, the decision under appeal was in favour of the respondents and could therefore be issued without holding oral proceedings. Therefore, the respondents' right to present their comments enshrined in Article 113(1) EPC 1973 had not been violated. Consequently, although the appellant could and should have filed auxiliary request 1 in the first-instance proceedings, the failure to do so did not deprive the respondents of their right to be heard enshrined in Article 113(1) EPC 1973.

2.8 In view of the above, the board, exercising its discretion under Article 12(4) RPBA, decided to admit auxiliary request 1 into the appeal proceedings.

3. Auxiliary request 1 - claim 1 - extension beyond the content of the application as filed - ground for opposition under Article 100(c) EPC 1973

3.1 The respondents argued that independent claim 1 defined a non-volatile memory configured to contain a plurality

of stored values related to nominal parameters of the flowtube placed in the memory during manufacture of the flowmeter, which feature was not originally disclosed. In originally filed claim 1 only "a stored value related to a nominal parameter of the flowtube" was disclosed. Originally filed dependent claim 10 referred to a plurality of nominal parameters, but these were not disclosed to be stored during manufacture of the flowmeter. In the sentence bridging pages 8 and 9 of the original description it was only disclosed that the parameter could be stored during manufacturing of the flowmeter.

3.2 The appellant referred to claim 10 as originally filed, where it was disclosed to store a plurality of nominal parameter values in the memory, and to page 7, lines 17-22, of the originally filed application documents, where it was disclosed that not only a value could be placed into the non-volatile memory before shipping but multiple values might be stored in the memory to verify the flowtube calibration. Page 5, lines 13-17, disclosed that the nominal parameter value might be a specific value or a range of values. Therefore a person skilled in the art would directly and unambiguously derive from the application as filed that the present invention might store, in a non-volatile memory, a plurality of values which were placed into the memory before shipping.

3.3 The board concurs with the appellant that it is directly and unambiguously derivable from the application documents as originally filed that the present invention may store, in a non-volatile memory, a plurality of values which are placed into the memory during manufacture of the flowmeter.

The subject-matter of independent claim 1 therefore does not extend beyond the content of the application as filed.

4. Auxiliary request 1 - claim 1 - inventive step - ground for opposition under Article 100(a) EPC 1973 in combination with Article 56 EPC 1973 with respect to document D1 combined with document D4 or document D3

4.1 Admission of the respondents' objections of lack of inventive step with respect to document D1 combined with document D4 or document D3

4.1.1 In the oral proceedings, the respondents raised, for the first time in the appeal proceedings, objections of lack of inventive step starting from document D1 in combination with document D4 or document D3. In their reply to the grounds of appeal, the respondents have only pointed out in very general terms that, with regard to auxiliary request 1, the patent also had to be revoked because of the grounds for opposition raised during opposition proceedings, in particular with respect to the patentability of claim 1 under Article 100(a) EPC.

4.1.2 The appellant submitted that, in the course of the appeal proceedings, the objections of lack of inventive step were introduced only in the oral proceedings before the board and that they were thus late-filed.

4.1.3 According to Article 13(1) RPBA, new objections, which a respondent raises after its reply to the grounds of appeal, are considered an amendment to its case. Admission of such objections is at the discretion of the board pursuant to Article 13 RPBA. The boards of appeal must exercise this discretion in view of, inter

alia, the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy (Article 13(1) RPBA).

The respondents' mere reference to their written submissions in the first-instance proceedings in their reply is not a sufficient substantiation of their objections and thus cannot be taken into consideration pursuant to Article 12(2),(4) RPBA. The respondents' objections of lack of inventive step with respect to document D1 combined with document D4 or document D3, which they raised and substantiated at the oral proceedings, are thus an amendment to their case.

The board notes that these objections have been presented at a very late stage in the appeal proceedings. The board is, however, of the opinion that these objections are not complex, because similar objections and the corresponding documents had already been presented in the first-instance proceedings and were dealt with in the decision under appeal. Thus, the appellant and the board are considered to be able to deal with these objections even at such a late stage of the appeal proceedings.

The board, exercising its discretion under Article 13(1) RPBA, therefore decided to admit the objections with respect to lack of inventive step in view of documents D1 combined with D4 or D3 into the appeal proceedings.

4.2 Inventive step with respect to document D1 combined with document D4 or document D3

4.2.1 In the oral proceedings before the board, the respondents referred to document D1 as the closest

prior-art document and argued that it disclosed a flowtube with a diagnostic circuit that received diagnostic potentials from the first and second electrodes of the flow tube and compared the absolute value of the diagnostic potentials to a stored reference to indicate electrode leakage (see document D1, claim 13). The two diagnostic potentials were added, but the sum still contained the two potentials when it was compared to the reference. Document D1 showed in Figure 10 a ROM or EPROM memory (see column 7, lines 40 to 42) and it was clear that not only the algorithm but also the reference value was stored in this memory. For a person skilled in the art having in mind the problem to improve the used method it was evident that it could also use two reference values if it wanted to improve the verification method.
Document D1 did not disclose when exactly the reference values were stored but this was not a feature of the flowtube and its memory. In order to obtain the reference values, the person skilled in the art would consult document D4 which also disclosed a magnetic flowmeter. In column 4, lines 14-16, it was disclosed that the flowmeter was calibrated before the flowmeter was shipped and in column 4, lines 53-56, the person skilled in the art learned that the required reference values could be stored in the processor. Thus it was evident to store the required reference values for the calibration during manufacture of the flowmeter.
The person skilled in the art would also consult document D3 which disclosed in particular on page 12, lines 8 to 10, that the initial parameters of the flowmeter were stored at manufacture as a "fingerprint". This fingerprint comprised diverse parameters corresponding to nominal parameters. Document D3 also gave an incentive to include further parameters as could be seen from the introductory

portion on page 2, line 33 to page 3, line 12. Therefore, it was obvious to store in the memory of document D1 the nominal parameters of the flowtube in the memory during manufacture.

4.2.2 The appellant was of the opinion that the time of storing the values represented a feature of the flowmeter, because it could be verified, when the flowmeter was bought from the manufacturer, that it contained already the required parameter values. Document D1 did not disclose to store the parameter values in the EPROM memory. In column 7, lines 40 to 42, it was only disclosed to store the algorithm in the EPROM. Document D1 also did not disclose to store values during the manufacture step. It did not disclose either to compare measured parameters with stored values, because the flowmeter of document D1 realized a different verification concept. As disclosed in the abstract and column 4, lines 47 to 50, the measured electrode potentials of opposite polarity were summed or added together so that the result was normally close to zero. Therefore, a comparison to reference values was not necessary and the sum was only compared to a threshold value to indicate a defect when the difference between the two electrode potentials became too large. Therefore, in the memory, nominal parameters of the flowtube were not stored, but only one threshold level.

Furthermore, the person skilled in the art would not combine documents D1 and D4. Document D4 did not store nominal values but a technician regulated a variable resistance to calibrate the flowmeter before shipping (see column 4, lines 14 to 16). Document D4 did not teach either to compare parameters for verification. Furthermore, document D4 did not give the person skilled in the art an incentive to deviate from the

specific concept of document D1 to subtract the diagnostic potentials and thus eliminate certain effects common to both electrodes.
With respect to document D3 it was only disclosed when the fingerprint was taken, but not when the data was placed in the memory of the flowtube. Document D3 allowed to determine a voltage generated due to current distribution within the flowtube when a test current was passing and to generate an output signal, if the voltage generated was outside a predetermined range (see claim 1), but it provided no incentive for the skilled person to change the basic concept disclosed in document D1 and to arrive at the claimed solution.

4.2.3 The board is however of the opinion, that the respondents' objections with respect to lack of inventive step of the subject-matter of claim 1 are not convincing. Document D1 is considered to be the closest prior art document and it discloses a particular method to verify electrode leakage. It sums first and second diagnostic potentials of opposite polarity between first and second electrodes. When the electrode circuit is free of leakage, the flow induced on each electrode tends to be balanced or equal, but of opposite polarity, so that the sum tends to be near zero under normal operating conditions without leakage. When there is a leakage, however, it is found that the diagnostic potentials tend to be imbalanced. The value of the imbalance is compared to a reference to indicate leakage for larger values of imbalance. This method does not need nominal parameters of the flowtube that are compared with the measured parameters.
Faced with the objective technical problem to improve the verification of the flowtube disclosed in document D1, the person skilled in the art does not find in

documents D3 and D4 an incentive to deviate from the disclosed verification process and circuitry.
Document D4 discloses a calibration method of the flowmeter circuitry with different fluids to define and store appropriate resistance value in the processor of the flowmeter. An automatic recalibration process can determine a new resistance value when the electrodes become partially fouled. This document does not provide an incentive to modify the leakage detection disclosed in document D1 by using instead pre-stored nominal parameters.
Document D3 discloses an electromagnetic flowmeter calibration verification device that allows to determine a voltage generated due to the current distribution within the flowtube when a test current is passing and to generate an output signal, if the voltage generated is outside a predetermined range. This document does not disclose how the fingerprint taken at manufacture is used to identify changes and to identify causes thereof. This disclosure does not either provide an incentive to modify the leakage detection disclosed in document D1 and to use pre-stored nominal parameters therefor.

Therefore, the subject-matter of claim 1 involves an inventive step in view of document D1 as closest prior-art document in combination with documents D4 or D3.

5. Auxiliary request 1 - claim 1 - admission of lack of novelty objection in view of document D5 (Article 13(1) RPBA)

5.1 In the oral proceedings before the board the respondents raised for the first time a lack of novelty objection based on document D5 against the subject-matter of claim 1. The respondents argued that document

D5 had been already in the appeal proceedings and that it had been regarded as novelty-destroying for the subject-matter of independent claim 10 of the main request. Therefore, document D5 was prima facie extremely relevant also for the corresponding apparatus claim 1 of auxiliary request 1. Auxiliary request 1 was filed only in the appeal proceedings and only with the admission of this request into the appeal proceedings did the attack on novelty based on document D5 become relevant.

5.2 The appellant argued that claim 1 of the present request was identical to granted claim 1 and, since the respondents had presented document D5 against granted claim 10 in the first-instance proceedings, they could and should have raised the present objection against granted claim 1 much earlier. Therefore, this new objection against claim 1 should not be admitted at this late stage of the appeal proceedings. The appellant requested remittal to the department of first instance if the board admitted this objection.

5.3 The board considers the lack of novelty objection on the basis of document D5 against the subject-matter of independent apparatus claim 1 highly relevant, because the board considers this document to be novelty-destroying for corresponding independent method claim 10 of the main request.

In exercising its discretion under Article 13(1) RPBA, the board therefore decided to admit this objection into the appeal proceedings.

6. Remittal of the case to the department of first instance (Article 111(1) EPC 1973)

6.1 The respondents requested that the case be remitted to the department of first instance if auxiliary request 1 was admitted into the appeal proceedings, because claim 1 of auxiliary request 1 had not been dealt with in the first-instance opposition proceedings and the respondents had therefore had no opportunity to present corresponding arguments in oral proceedings before the opposition division.

6.2 The appellant requested the remittal of the case to the department of first instance only if a new lack of novelty objection with respect to document D5 against the subject-matter of claim 1 of auxiliary request 1 was raised and admitted into the appeal proceedings. The appellant requested that the respondents' objections with respect to documents D1 to D4, which had already been raised against claim 1 of the main request in the grounds for opposition and dealt with by the opposition division, be dealt with first.

6.3 Under Article 111(1) EPC 1973 the boards of appeal may either decide on the appeal or remit the case to the department which was responsible for the decision appealed. There is no absolute right to have every issue decided at two instances; it is the primary function of an appeal to give the losing party an opportunity to obtain judicial review of whether the decision being appealed was correct. Other factors to be taken into account when deciding on a remittal include the parties' requests, the general interest in bringing proceedings to a close within a reasonable period of time and whether or not the case was comprehensively assessed during the proceedings before the opposition division.

6.4 In the oral proceedings the board addressed the fact that independent claim 1 of auxiliary request 1 was identical to claim 1 of the main request and that the respondents also had to be prepared to present arguments in the oral proceedings against the subject-matter of that claim in case the board came to another conclusion to that of the opposition division with respect to independent claim 10 of the present main request.

The board further notes that the opposition division had expressed an opinion on the patentability of the subject-matter of granted claim 1, which is identical to claim 1 of auxiliary request 1, in view of documents D1 to D4 (see point 3.2 of the reasons of the contested decision), but that an attack on novelty against claim 1 based on document D5 has not been raised previously or dealt with in the first-instance proceedings.

In addition, the board sees no reason to go beyond its primary task of examining the contested decision.

6.5 In view of the above, the board refuses the respondents' request for an immediate remittal of the case to the opposition division after the admission of auxiliary request 1, i.e. without examining any of the objections raised by the respondents against claim 1 of auxiliary request 1. The board considers it appropriate to have examined the objections of lack of inventive step with respect to document D1 combined with document D4 or document D3 against claim 1 of auxiliary request 1, which the board admitted into the appeal proceedings, because these objections have been dealt with in the decision under appeal. However, after the admission of the objection of lack of novelty in

respect of the subject-matter of claim 1 of auxiliary request 1 in view of document D5, the board considers it appropriate that the objection on the basis of document D5 should first be examined by the opposition division. Therefore, the board grants the appellant's request for remittal of the case to the opposition division for further prosecution.

For avoidance of doubt, the board points out that it has not decided on the admission of the raised inventive step objections on the basis of documents D1 and D5 or documents D5 and D1 against claim 1 of auxiliary request 1. Moreover, the board sees no reason to take a decision on auxiliary request 2.

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.

The Registrar: The Chairman:

M. Kiehl R. Bekkering

Decision electronically authenticated