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**Datasheet for the decision  
of 20 February 2020**

**Case Number:** T 0072/16 - 3.2.05

**Application Number:** 09749542.8

**Publication Number:** 2293920

**IPC:** B29C53/56, F16L59/02, F16L59/14

**Language of the proceedings:** EN

**Title of invention:**  
Pipe section and method for its production

**Patent Proprietor:**  
Rockwool International A/S

**Opponent:**  
SAINT-GOBAIN ISOVER

**Relevant legal provisions:**  
EPC Art. 54(2)

**Keyword:**  
Public availability of prior use proven (no)  
Public prior use - (at least) implicit obligation to maintain  
secrecy (yes)



**Beschwerdekammern**

**Boards of Appeal**

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**Case Number: T 0072/16 - 3.2.05**

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.05**  
**of 20 February 2020**

**Appellant:** SAINT-GOBAIN ISOVER  
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**Respondent:** Rockwool International A/S  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
16 October 2015 concerning maintenance of the  
European Patent No. 2293920 in amended form.**

**Composition of the Board:**

**Chairman** M. Poock  
**Members:** O. Randl  
C. Brandt  
T. Vermeulen  
T. Karamanli

## **Summary of Facts and Submissions**

- I. The opponent filed an appeal against the decision of the opposition division on the amended form in which European patent No. 2 293 920 ("the patent") can be maintained.

The opposition division admitted the following evidence in support of an alleged prior use:

- D11: Demonstration video of Aspen Aerogels Inc.;
- D11a: Signed declaration by Mr Mark Krajewski;  
dated 7 October 2013
- D12: Signed declaration by Mr Mark Krajewski;  
dated 30 October 2014
- D13: Product Assembly Specification of Aspen  
dated 22 November 2004
- D14: Bill of Lading from Shipco Transport  
dated 27 January 2005.

The opposition division also heard a witness (Mr Mark Krajewski). The minutes of the taking of evidence by hearing the witness will be referred to as document "MMK" in what follows.

- II. The oral proceedings before the board were held on 20 February 2020.
- III. The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed (main request), or that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the sets of

claims filed as first and second auxiliary requests in response to the statement of grounds of appeal by letter of 13 July 2016.

IV. In the decision under appeal the opposition division evaluated the evidence related to the alleged public prior use as follows:

"[2.2.1] Mr. Krajewski's testimony was free of contradictions. He acknowledged gaps in his memory, which is natural after more than 10 years. He was nevertheless able to recite the events around the manufacture of the pipe section from his own immediate experience. He was part of the team manufacturing the 48 pipe sections later shipped to Technip, France according to D14, and he was the videographer of D11. The opposition division therefore considered his testimony to be credible.

[2.2.2] On the basis of the evidence on file and the testimony of the witness, the opposition division arrived at the conclusion that Aspen Aerogels, Inc. shipped 48 pipe sections manufactured as shown in D11 to Technip, France on 27.01.2005 and that Technip France received and used them without being bound by confidentiality. Although Mr. Krajewski did not see the pipe sections arriving in France he convincingly explained that the 48 pieces mentioned in D14 were the very first batch in a large number of shipments of pipe sections to follow. As no complaints were received and the first shipment was the trigger for many more, the opposition division is convinced that Technip, France received the first batch and approved of it. Mr. Krajewski also explained that these 48 parts were produced from 4 mats of aerogel fibres. These mats were cut at a length of about 1.80 m or 1.90 m from a roll

of aerogel fibre with a width of 1.50 m. The first mat had a Tyvek cover pre-laminated on one side and was then wound transversally - with the Tyvek cover on the inside - around a mandrel that was the size of the flow line of the pipe to be insulated. The other mats followed one after the other so that they did not overlap, the space between them not exceeding 5 mm, with adhesive in between the different layers, until the parts reached the desired thickness. The outer mat was again pre-laminated with Tyvek on the outside. The untrimmed part of ca. 1.80 m/1.90 m was then cut to 1.75 m and released from the mandrel with a cut allowing a shiplap joint that was thermally efficient. The cut edges were then covered in Tyvek.

[2.2.3] Mr. Krajewski stated that he was not aware of any confidentiality obligation on the side of Technip, France. He pointed out that Aspen Aerogel, Inc. was bound by confidentiality vis-a-vis Technip, when his team visited the Technip off-shore engineering group. It was aimed at the non-disclosure of new technologies the Aspen team would see or learn about while visiting Technip on its off-shore site, but it was not reciprocal. Mr. Krajewski's recollection of this particular NDA clearly shows that it is usual in the business for personnel involved in production to have to sign or at least be made aware of any confidentiality obligation. As Mr. Krajewski was not aware of such an express obligation of confidentiality, the opposition division is convinced that such an express obligation did not exist. Mr. Krajewski also repeatedly stated that it was Aspen Aerogel, Inc.'s aim to sell their aerogel mats and that it was important for Aspen Aerogel, Inc. to promote their capability of adding value to deep water pipe projects. Therefore,

the opposition division does not see any indication for an implicit confidentiality agreement.

[2.2.4] The opposition division is further convinced that Technip, France had the possibility and means to observe and analyse the structure and material of the pipe sections in detail and deduce from the product its method of manufacture. From the structure of the parts the skilled person could infer that the aerogel mats had been rolled on a mandrel. The orientation of the transversal edges of the aerogel mat and the empty internal space of the pipe section meant that the mats had been spirally wound around a mandrel. Mr. Krajewski testified that the pipe sections were completely covered in Tyvek. However, he also explained that the pipe sections are cut if a shorter piece is needed for the insulation of a piece of pipe. He also explained that a person could feel with its fingers that the pipe section, after it was trimmed (or cut to insulate a short piece of pipe), was made of different layers with adhesive in between."

V. The parties' submissions in respect of the question of the public availability of the alleged prior use were as follows:

(a) Respondent

The alleged public prior use was not adequately proven.

The alleged prior use boils down to the appellant's allegation that Aspen Aerogels sold a product to Technip France, the latter not being bound by any duty of confidentiality, such that that sale could be considered a disclosure to the public. However, it is plain from the evidence and the witness testimony that

Technip was not a mere customer. The evidence shows that Aspen and Technip were engaged as partners with each other in a product development project, which was clearly considered by the parties as commercially sensitive and confidential. That being the case, neither of the parties was a member of the public.

The evidence relating to the alleged public prior use came in two tranches. First, video D11 and the supporting declaration D11a were filed. When the opposition division indicated that it was not convinced, documents D12, D13 and D14 were filed. They were then further supplemented by the witness testimony.

Declaration D11a explains that the video D11 was produced prior to 31 December 2004 and that thousands of elements were sold to a European customer (i.e. Technip) prior to the priority date. Video D11 is the earliest piece of evidence for anyone being in possession of the product.

On page 9 of document MMK it is stated that the contact between Aspen and Technip was established in summer or fall 2004 by a gentleman running a Technip facility in Angola.

It is clear from the first page of D13 that this document is the fruit of a collaborative effort of Aspen and Technip in developing a product. It establishes that Technip was not a simple customer or a third party, but a partner in a development programme. It can be seen that the first draft was written in October 2004, i.e. before the date of the video. Both partners made comments and suggestions to develop the product. The drafting of the document was

not finished before July 2005. On the very last page of document D13 there are various approval signatures. All are dated late July 2005. On the first page of D13 (top left hand corner) there is a box "Technip Vendor Document Review" and the name Cédric Descusse of Technip with the date 26 August 2005. It appears that the document was finally approved at the end of August 2005 by Technip.

It is not actually known which information has flown in which direction between the two partners in the period between summer 2004 and August 2005, i.e. who contributed what.

On page 2 of document D13, there is a clear statement:

**THIS DOCUMENT CONTAINS CONFIDENTIAL INFORMATION. Its use is restricted to employees with a need to know and third parties with a need to know and who have signed a non-disclosure agreement.**

Thus, the content of the document was not merely confidential vis-à-vis the public, but even vis-à-vis the employees of the partners. This suggests a high level of commercial sensitivity. It does not support the idea that any party agreed to any part of the document being made available to the public.

It should also be noted that document D13 is the final version and that the confidentiality statement is still there. This expresses an ongoing requirement of confidentiality.

In declaration D12 the witness also acknowledges that document D13 was confidential.

The process demonstrated in video D11 is rudimentary at best. It does not indicate a mature technology. That is



entirely consistent with the timescale of the development programme.

On page 40 of document MMK the witness states that the video and document D13 were developed simultaneously, and that the video served as an explanatory complement to the specifications expressed in the document. In view of the confidentiality requirements in document D13 and the fact that document D13 and video D11 were intended to be distributed together, the same obligation of confidentiality applies to both.

Document D14 bears the date of 27 January 2005, i.e. a moment right in the middle of the development programme, seven months prior to the final sign-off of the specifications. It relates to a shipment of Aerogel panels to Technip France. So at the time of the shipment the development programme was not yet completed. It is clear from page 1 of document D13 that there were several revisions after the date of that shipment. Thus, the product was not a commercial product that Technip had just bought from Aspen. Rather, it was a development product, a prototype supplied in the course of an ongoing collaboration between these two parties. This is made plain by the witness himself on pages 14 and 15 of document MMK; the parts were manufactured by his own group, not by subcontractors. The parts are referred to as "prototype machine" and said to have been produced "just to see that is was a viable option". Clearly, the delivery was not the supply of a commercial product for the end use.

According to the jurisprudence of the boards of appeal, this type of programme is regarded to be implicitly confidential by nature. But the witness even goes beyond that to say that there were contractual

arrangements in place, including a non-disclosure agreement (NDA). When asked about the role of confidentiality, the witness declared (see page 18 of document MMK) :

You know, I don't know there was any confidentiality around the shipment, honestly I know we had an NDA in place with Technip but more, I think it was more focused on, you know, when we are over at their off-shore engineering group, if we see new technologies being developed, we are not to disclose the information we learn while visiting or interfacing with them. As far as the shipment of product I am not aware of any, you know, any restrictions around what could be done, you know, what they could or couldn't do with those panels.

The NDA was not made available. It is not surprising that the witness, an engineer, not an IP specialist, was not aware of all the confidentiality requirements binding the other party, as also stated in document D12. This is also consistent with his declarations on his role in the project (see page 11 of document MMK). Being an engineer, the witness would not have cared about the obligations for the other party to the agreement. Moreover, his statement on page 19 of document MKK (that he did not know whether there were NDAs in place with all the subcontractors) is not supported by the confidentiality statement in document D13. The witness's recollection is not persuasive in this respect when compared to the evidence on file.

If Technip had been a mere customer, the existence of an NDA is unaccounted for. People buying commercial products off the shelf do not usually sign an NDA. Rather, the NDA suggests a degree of commercial sensitivity and confidentiality.

In fact, there is no evidence that the product existed at all outside the development programme.

All the elements on file point to at least an implied understanding of confidentiality between Aspen and Technip as partners in a project, and the express confidentiality provisions in document D13 would be entirely frustrated if this were not true. As partners in a project, neither Aspen nor Technip can fairly be regarded as members of the public. Information flow between two partners in a project does not make the contents of the exchange available to the public. The existence of the NDA suggests a significant likelihood that the requirement of confidentiality would not be implied but express. The omission of the NDA from the proceedings leaves a big doubt in that regard. The suggestion that the NDA was asymmetric would seem very strange. There is no evidence for it except the inability of the witness to recall. That is not enough to turn the balance of probability in favour of the appellant.

There is no evidence whatsoever in respect of products delivered by Aspen to other customers after the expiration of the NDA. If there were such sales, it is not known what exactly was sold or disclosed in this context. The witness testimony in this respect is entirely uncorroborated.

If the appellant was capable of providing bills of lading for the prototypes, they should have been able to provide such documents also for the alleged subsequent sales of 18000 parts, establishing what was sent to whom and when. There is no such evidence at all covering the period following the sign-off date of document D13.

Beyond that, Technip was a partner to the development programme and, as such, not a member of the public.

Even then, supplying them could not amount to a disclosure to the public, no matter how much was supplied: Technip was internal to the project.

(b) Appellant

It can be assumed that the prior use started as a common project in 2004 and that 48 pipe elements were delivered as some sort of prototype to check whether a certain number could be given in a given amount of time. However, there were thousands of elements delivered before the priority date of the patent ("18000 plus": see page 14 of document MMK). These cannot be prototypes. They were put to service on oil rigs to insulate deep-water oil pipes and could be inspected by many people belonging to the public (safety controls etc.). So the development phase was followed by commercial deliveries of the product that were not covered by confidentiality agreements.

The NDA agreement acknowledged by the witness on page 18 of document MMK was binding on Aspen and not on Technip.

As explained on page 40 of document MMK, the video D11 is a clear demonstration of how the product was manufactured. There was a lapse of three years between the final version of the specifications and the priority date of the patent. The witness also stated that there were other customers. There is no good reason why Aspen would not have shown the video to them, considering that they were not bound by a confidentiality agreement any longer.

The appellant was not able to provide more information on Aspen's sales because Aspen is a third party and the

appellant had not full access to their archives.  
The appellant shared all the information they were able to obtain.

### **Reasons for the Decision**

1. The appeal is admissible.
  
2. In the present proceedings, Article 12(2) of the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020, OJ EPO 2019, A63), which entered into force on 1 January 2020 (Article 24 RPBA 2020), applies in accordance with 25(1) RPBA 2020. According to Article 12(2) RPBA 2020 it is the primary object of the appeal proceedings to review the decision under appeal in a judicial manner. In the decision under appeal the opposition division found that the alleged public prior use had been sufficiently proven and that the patent could be maintained on the basis of the then second auxiliary request. In particular, the alleged prior use has been seen as the only suitable closest prior art regarding the assessment of inventive step. Since apart from objections based on the alleged prior uses there were no further objections against inventive step with regard to the main request and the auxiliary requests underlying the appeal proceedings, the decisive issue in the present case is whether any of the alleged public prior uses has been sufficiently proven.
  
3. In their appeal the appellant/opponent agreed to the opposition division's finding that the prior use formed the closest prior art. However, they asserted that claims 1 and 10 of auxiliary request 2 on the basis of which the patent was maintained did not involve an inventive step. Even though the appellant did not raise

any objection in this respect, according to the established case law of the Boards of Appeal the principle of prohibition of *reformatio in peius* does not apply separately to each point decided. Rather, the whole request is before the board of appeal and within its jurisdiction, and the board is empowered to reopen and to decide upon matters which have been an issue before the opposition division, like the alleged prior use in the present appeal case (cf. Case Law of the Boards of Appeal, 9th edition, 2019, V.A.3.1.1).

4. In accordance with the jurisprudence of the boards of appeal (Case Law of the Boards of Appeal, 9th edition, 2019, I.C.3.2.4 a)), in order to decide whether an alleged prior use is comprised in the state of the art it is necessary to establish the date on which the alleged prior use occurred, exactly what was used and the circumstances relating to the use by which it was made available to the public. The opposition division arrived at the conclusion that on the basis of the evidence on file and the testimony of the witness, Mr. Krajewski, Aspen Aerogels, Inc. (hereinafter: Aspen) shipped 48 pipe sections manufactured as shown in the video D11 to Technip France (hereinafter: Technip) on 27 January 2005 and that Technip received and used them without being bound by confidentiality. According to the testimony, Aspen was bound by confidentiality, but it was not reciprocal. The opposition division was convinced that neither an express confidentiality agreement nor an implicit obligation of confidentiality existed.
  
5. The board does not question the opposition division's conclusion insofar as Aspen shipped 48 pipe sections manufactured as shown in the video D11 to Technip on 27 January 2005 and that Technip received and used

them. This statement appears also not to be contested by the respondent/proprietor. However, the board considers that, during the oral proceedings before it, the respondent has convincingly demonstrated on the basis of documents D12, D13, D14 and the testimony of Mr. Krajewski, that said sale and shipment of 48 panels on 27 January 2005 was carried out under an explicit non-disclosure-agreement binding both Aspen and Technip or that there was at least an implicit confidentiality agreement, and that this has not been disproved by the appellant.

6. As set out in the board's communication of 29 October 2019 sent as annex to the summons to oral proceedings the board is still of the opinion that there is no reason to apply a **standard of proof** stricter than that of "**balance of probabilities**". According to the established jurisprudence of the boards of appeal, the stricter standard of "beyond reasonable doubt" should be applied when all the evidence in support of the alleged prior public use lies within the power and knowledge of the opponent, while the patent proprietor has barely any or no access to it at all (see "Case Law of the Boards of Appeals of the European Patent Office", 9th edition, 2019, III.G. 4.3.2 b)). However, neither has it been established in the present case that all the evidence for the alleged prior use lies within the power and knowledge of the appellant, nor is there any evidence before the board that Aspen is a company belonging to a group the opponent is part of or any indication of similar circumstances that would justify that Aspen be assimilated to the appellant.
7. Regarding the **burden of proof** in case of an alleged prior use by the sale and delivery of products, the

opponent has to present facts and proof that these products, as in the case at issue the 48 pipe sections, have been sold and handed over to the buyer and thus have been made available to the public. It is the board's view, and in accordance with principles well-established in the case law of the majority of the Contracting States, that a single sale is sufficient to render the article sold available to the public within the meaning of Article 54(2) EPC, provided the buyer is not bound by an obligation to maintain secrecy. According to the contested decision of the opposition division Aspen Aerogels sold a product (48 pipe sections) to Technip France, the latter not being bound by any duty of confidentiality, such that that the sale could be considered a disclosure to the public. However, in the case at issue, as already mentioned (see point 5. above) and explained in more detail below, the board has come to the conclusion that the respondent has convincingly demonstrated during the oral proceedings before the board, that on the basis of documents D12, D13, D14 and the witness testimony Technip was not a mere customer. Rather, Aspen and Technip were engaged as partners in a product development project and their collaboration was governed by an at least implicit confidentiality agreement. In the board's view the appellant has failed to demonstrate that no confidentiality agreement existed (cf. also T 2037/18 of 16 October 2019, point 12 of the reasons).

8. The board concurs with the respondent's submission during the oral proceedings that it is comprehensible and credible from D13, D14 and the testimony of Mr. Krajewski that as far as the shipment of the 48 pre-formed panels on 27 January 2005 from Aspen to Technip is concerned, this was not a sale and delivery of a



commercially available end product which has thus become publicly available. Rather, the evidence shows that this shipment of 48 panels was part of a product development project ("Dalia Project") between Aspen and Technip as partners. Hence, in this regard Technip cannot be regarded as mere customer and neither of the partners as a member of the public.

9. As stated on page 9 of document MMK and on the first page of D13, which is a document displaying the collaborative effort of Aspen and Technip in developing the panels, the contact between Aspen and Technip was established in summer or fall 2004. It can be derived from D13 that the first draft was written in October 2004. Both partners made comments and suggestions to develop the product. The drafting of the document was not finished before July 2005. On the very last page of document D13 there are various approval signatures all dated late July 2005. It appears that the document was finally approved at the end of August 2005 by Technip.
10. Document D14 relates to the shipment of 48 pre-formed Aerogel panels to Technip and bears the date of 27 January 2005, i.e. a point in time right in the middle of the development programme, seven months prior to the final sign-off of the specifications. So at the time of the shipment of the 48 panels in January 2005 the development programme was not yet completed and it is clear from the first page of document D13 that there were several revisions after the date of that shipment.
11. Thus, the product was not a commercial product that Technip had just bought from Aspen as a customer or third party. Rather, it was a development product, a prototype supplied in the course of an ongoing

collaboration programme between these two partners. This is corroborated by the testimony of Mr. Krajewski, as can be seen on pages 14, 15 and 17 of document MMK (all underlines added by the board). Asked about the bill of lading D14, the witness explained that "those parts we manufactured for the programme ... and delivered to Technip France" (page 14). He continued, that "we had built the prototype machine" .... and these panels were produced "just to see that it was a viable option" (page 15). Furthermore, asked how the business relationship with Technip continued the witness said "... after this first shipment, we won the project and delivered the project in its entirety ...", and in answering another question: "and then from that point on started manufacturing in an industrial scale and delivering parts" (page 17). All this makes it clear, that the delivery of the 48 panels as documented in D14 was not the supply of a commercial product for the end use, but rather part of the ongoing development project.

12. According to the jurisprudence of the boards of appeal, such a relationship between two companies which contracted to develop and deliver prototypes and products for test purposes cannot be treated as equivalent to that between a dealer and a customer and in these cases an obligation to maintain secrecy applied (T 1847/12, "Case Law of the Boards of Appeals of the European Patent Office", 9th edition, 2019, I.C. 3.4.7 and 3.4.4). Taking into account all the facts and circumstances as mentioned above, which are contested by neither party, the board does not have any doubts that in accordance with the normal practice in those cases there has been at least an implicit duty of confidentiality on both companies involved. There being at least an implicit understanding of confidentiality

between Aspen and Technip as partners in a project, both companies cannot fairly be regarded as members of the public.

13. Moreover, there appears to be not so much an implicit but rather an express confidentiality agreement governing the co-operation between Aspen and Technip to develop pipe sections or pre-formed panels. Document D13, second page, contains the clear statement:

**THIS DOCUMENT CONTAINS CONFIDENTIAL INFORMATION. Its use is restricted to employees with a need to know and third parties with a need to know and who have signed a non-disclosure agreement.**

Thus, the content of the document was not merely confidential vis-à-vis the public, but even vis-à-vis the employees of the partners. Even if Technip was to be regarded as third party it would have had to sign a non-disclosure agreement. This clause does not support the appellant's contention that any party agreed to any part of the document being made available to the public. It is also noted that document D13 is the final version still containing the confidentiality statement, which expresses an ongoing requirement of confidentiality. In declaration D12 (point 2.) the witness also acknowledges that document D13 was confidential.

14. The board considers that these facts and the supporting evidence which the respondent referred to in his submissions during the oral proceedings sufficiently prove that, in the present case, the buyer was bound by an obligation to maintain secrecy. Thus, the board is of the opinion that the burden of proof has shifted to the appellant to establish that there was no confidentiality agreement. The appellant has however not presented any arguments or evidence which might

objectively cast doubt on the existence of a confidentiality agreement. As far as the appellant refers to the testimony on page 18 of document MMK this statement of the witness is not suitable to disprove the existence of a confidentiality agreement in view of the given facts and documentary evidence on file. The witness declared (see page 18 of document MMK):

You know, I don't know there was any confidentiality around the shipment, honestly I know we had an NDA in place with Technip but more, I think it was more focused on, you know, when we are over at their off-shore engineering group, if we see new technologies being developed, we are not to disclose the information we learn while visiting or interfacing with them. As far as the shipment of product I am not aware of any, you know, any restrictions around what could be done, you know, what they could or couldn't do with those panels.

15. First of all, the board does not doubt the witness's credibility or whether the testimony corresponds to the witness's true recollection. However, the probative value of the statements concerning the existence of a NDA (pages 18 and 19 of MKK) is not persuasive in this respect when compared to the evidence on file, in particular with regard to the confidentiality clause in D13, page 2. Equally, the suggestion that the NDA was asymmetric, i.e. only binding on Aspen but not on Technip appears not to be probable and from experience rather contrary to the situation in comparable co-operation projects, and furthermore not supported by any further evidence. It is not surprising that the witness, an engineer, not an IP specialist, was not aware of all the confidentiality requirements binding the other party, as also stated in document D12. This is also consistent with his declarations on his role in the project (see page 11 of document MMK). Furthermore, the appellant did not provide any evidence in support of its allegation that the panels delivered according to D14 were put to service on oil rigs to insulate

deep-water oil pipes and could be inspected by many people belonging to the public. Since there is no counter-evidence on file that such confidentiality agreement was actually not in place in the case at issue the appellant has not discharged its burden of proof in this respect.

16. Regarding the video D11 the board in the annex to the summons of 29 October 2019 (point 4.4.2) already pointed out that the presentation of video D11 to potential subcontractors and their workers as such did not constitute state of the art under Article 54(2) EPC, because subcontractors may be considered to be bound by an implicit non-disclosure agreement and, therefore, do not qualify as members of the public within the meaning of Article 54(2) EPC. This assessment is corroborated by the witness. As can be seen on page 40 of document MMK the witness stated that the video D11 and document D13 were developed simultaneously, and that the video served as an explanatory complement to the specifications expressed in document D13. In view of the confidentiality requirements in document D13 and the fact that document D13 and video D11 were intended to be distributed together, the same obligation of confidentiality applies to both. The appellant has not provided any evidence that the video D11 has been presented to persons not being bound by a confidentiality agreement. The appellant's mere allegation that there is no good reason why Aspen would not have shown the video to other customers is certainly not appropriate to be acknowledged as such evidence.
17. During the oral proceedings before the board the appellant for the first time argued that there were thousands of pipe sections delivered before the

priority date of the patent and put to service on oil rigs to insulate deep-water oil pipes, which could be inspected by many people belonging to the public not covered by confidentiality agreements. This allegation is based on the statement of the witness (see page 14 of document MMK) that "we manufactured 18 000 plus" of the parts. In this respect the board first of all points out that a party who wishes to adduce witness evidence should indicate what factual details it wishes to prove by this means. The function of a witness is to corroborate what has been alleged and not to fill in the gaps in facts. Additional clarifications provided by a witness to close a potential gap in the documentary evidence on file cannot be considered per se new facts.

18. Apart from this fundamental deficiency in the appellant's submission there is no evidence whatsoever in respect of products delivered by Aspen to Technip or other customers after the expiration of the non-disclosure agreement. Considering that the appellant was capable of providing bills of lading for the prototypes, they should have been able to provide such documents also for the subsequent sales of 18000 parts, establishing what was sent to whom and when. There is however no such evidence at all covering the period following the sign-off date of document D13.
  
19. As far as the appellant explained during the oral proceedings before the board that they were not able to provide more information on Aspen's sales because Aspen is a third party and the appellant had not full access to their archives, the board cannot accept this as a valid argument or a justified excuse for not providing facts and evidence supporting their appeal. The factual inability of an appellant for whatever reasons to

submit appropriate and sufficient facts, arguments and evidence for the substantiation of the appeal lies exclusively in the sphere of influence and responsibility of the appellant and cannot be taken into account to the detriment of the respondent.

20. The board therefore concludes that none of the alleged public prior uses has been proven by the appellant, so that none of them forms part of the prior art within the meaning of Article 54(2) EPC. The substance of the objections of lack of inventive step based on the prior use does not therefore need to be addressed.

## Order

### For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Schneider

M. Poock

Decision electronically authenticated