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**Datasheet for the decision
of 13 September 2021**

Case Number: T 0246/17 - 3.4.01

Application Number: 11714662.1

Publication Number: 2545389

IPC: G01R31/12

Language of the proceedings: EN

Title of invention:

INSTRUMENT AND METHOD FOR DETECTING PARTIAL ELECTRICAL
DISCHARGES

Patent Proprietor:

Techimp HQ S.R.L.

Opponent:

Omicron electronics GmbH

Headword:

Partial electrical discharges / Techimp

Relevant legal provisions:

EPC Art. 113(1), 117(1)(a), 111

EPC R. 103(1)(a)

RPBA 2020 Art. 11

Keyword:

Alledged public prior use - witnesses offered but not summoned
Substantial procedural violation (yes)
Remittal to the department of first instance (yes)
Reimbursement of appeal fee - (yes)

Decisions cited:

T 0716/06, T 1363/14, T 0314/18



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Case Number: T 0246/17 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 13 September 2021

Appellant: Omicron electronics GmbH
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 21 November
2016 rejecting the opposition filed against
European patent No. 2545389 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman P. Scriven
Members: A. Medeiros Gaspar
C. Almberg

Summary of Facts and Submissions

I. This appeal is by the opponent, against the decision of the Opposition Division to reject the opposition to the European Patent EP2545389.

II. The patent was opposed on the grounds of lack of novelty and lack of an inventive step.

III. The following documents were submitted as written evidence with the notice of opposition:

- 01 OMICRON mtronix technology, *MPD 600 User Manual*, OMICRON electronics, 2009
- 02 OMICRON mtronix technology, *MPD 600 Partial Discharge Analysis System*, OMICRON, April 2008
- 03 OMICRON electronics GmbH, *Rechnung No. IN09-0972*, 10 March 2009
- 04 International Standard IEC 60270, *High-voltage test techniques - Partial discharge measurements*, 3rd edition, 2000-12
- 05 WO 2007/144789 A2
- 06 WO 2009/013640 A1
- 07 C. BALKON ET AL, *Potential of multispectral PD measurement for differentiation of interfering impulses and multiple PD sources*, Proceedings of the 16th International Symposium on High Voltage Engineering, SAIEE, 2009

- IV. The opponent disputed the novelty of the independent claims on the basis of an alleged public prior use. The anticipation asserted was the offering and selling, before the patent's priority date, of an MPD 600 partial discharge measuring system.
- V. In support, the opponent invoked documents O1 to O3, of which O1 is a user manual, O2 a brochure, and O3 a sales invoice. Both O1 and O2, allegedly, disclosed all features of the independent claims, as well as providing evidence of public prior use.
- VI. In addition, the opponent offered three witnesses (Messrs Steinecke, Daniel, and Platz) to verify the functionality of the MPD 600 measuring system.
- VII. Inventive step of the independent claims was also challenged starting from document O7, in combination with any of O4, O4 and O5, or O6.
- VIII. The proprietor defended its patent against each of the written disclosures. In addition, she questioned:
- (a) the authenticity of O3;
 - (b) the availability to the public of O1 and O2;
 - (c) whether O1 and O2 actually reflect the product indicated in O3;
 - (d) whether the systems on which witness testimony was offered were the same as those of O1, O2 and O3.
- IX. In reply, the opponent submitted further arguments on substantiation of the public prior use, as well as two

further documents in support of the authenticity of invoice O3:

O8a Wiener Zeitung - firmenmonitor.at,
Firmendetails für "Österreichisches
Forschungs- und Prufzentrum Arsenal
Gesellschaft m.b.H. (FM-ID 406143), printed
on 14 January 2016

O8b Wiener Zeitung - firmenmonitor.at,
Firmendetails für "Österreichisches
Forschungs- und Prüfzentrum Arsenal
Gesellschaft m.b.H." - FB Löschung, printed
on 19 January 2016

X. The opponent also insisted on its inventive step attack based on the combination of O7 with O6, and further argued lack of an inventive step in view of the combination of the public prior use with O6.

XI. The Opposition Division:

(a) considered "the allegation of public prior use as adequately proven by the documentary evidence" and, on this basis, could not see any reason to proceed to a witness hearing (point 3.6 of the appealed decision, first sentence);

(b) recalling that the witnesses were offered because they "could prove the described functionality of the MPD 600 measuring apparatus", also considered that the opponent had failed to indicate precisely which factual details were to be proven in any hearing (point 3.6);

(c) found documents O1 and O2 to form part of the state of the art (point 3.7), but not to disclose all the features of the independent claims of the patent (points 4.1 and 4.2); and

(d) found the claims of the patent to entail an inventive step in view of the combination of O7 with the different prior art documents, as well as in view of the combination of O1 with O6 (points 5.1 to 5.4).

XII. On appeal, the opponent (appellant) requested that the decision be set aside and that the patent be revoked. It insisted that the three witnesses be heard, to demonstrate the veracity of its allegation of public prior use.

XIII. The proprietor (respondent) requested that the appeal be dismissed, or that the patent be maintained on the basis of one of two auxiliary requests filed with the reply to the appeal. It insisted on its questioning of the alleged public prior use with regard to, in particular, substantiation, availability, and the link between different elements of evidence; and contested any hearing of witnesses. Moreover, it requested that documents O1 and O2 be disregarded.

XIV. Each party requested that oral proceedings be held, if its principal request was not allowed.

XV. In a communication under Rule 100 (2) EPC, the Board informed the parties of its preliminary view that the

Opposition Division's decision not to hear the witnesses was a fundamental procedural deficiency and that the case should be remitted to the opposition division and the appeal fee be reimbursed.

XVI. The parties were invited to indicate whether, under these circumstances, they maintained their requests for oral proceedings before the Board. They were informed that, if either request was maintained, the only points to be discussed at the oral proceedings would be whether or not the witnesses should be heard, and whether or not the the case should be remitted.

XVII. In response, both parties withdrew their requests for oral proceedings and neither raised any objection to remittal. The opponent requested that the appeal fee be reimbursed.

Reasons for the Decision

1. The opposition division declined to hear the witnesses, recalling they had been offered because they *could prove the described functionality of the MPD 600 measuring apparatus*. The division found that this statement failed to indicate, precisely, which factual details were to be proven in any hearing.
2. The Board agrees with the Opposition Division, and the proprietor, that it is not the function of witness evidence to fill gaps in assertions of fact.

3. However, the Board disagrees as to the facts on which testimony was offered.
4. The witnesses were offered to "confirm the functionality of the MPD 600 measuring system as described above" ("Als Zeugen, welche die oben beschriebene Funktionalität des Messgeräts MPD 600 belegen können, werden angeboten: ...", see page 5 of the notice of opposition, translation and underlining by the Board).
5. "Described above" referred to the immediately preceding text, on pages 3 to 5 of the notice of opposition, where the opponent elaborated on the characteristics of the MPD measuring instrument of O1 and O2, in particular the "PD Scope"/"Small Scope"-Funktion" (page 4) and the "3PARD-Funktion" (pages 4 and 5), which, in the opponent's view, anticipated all features of the independent claims.
6. The opponent was, therefore, adducing clear, sufficient, and relevant facts which, if verified by the witnesses' evidence, would have supported its allegation of public prior use.
7. The opposition division considered the public prior use as adequately proven by the documentary evidence (point 3.6, first sentence). It considered, then, adequately proven that an MPD 600 measuring apparatus, such as the one described in the manual O1 and the brochure O2 was sold as documented by the invoice O3, and hence made available through sale before the priority date of the patent.
8. The Opposition Division came, however, to the conclusion that neither the manual O1, nor the brochure

O2, disclosed some of the features of claim 1 of the patent (point 4.1 of the decision). Concretely, with regards to each of these features, the opposition division did not find unambiguous disclosures of them in the passages of O1 indicated by the opponent.

9. However, the opposition division also did not find that the disclosures of documents O1 and O2 were incompatible with the presence of such features .
10. As the disclosures of documents O1 and O2 leave open whether these features were present in the instrument described, but the instrument was actually made and sold and might itself have disclosed them even though O1 and O2 did not, this was a matter which witness testimony could resolve.
11. A final conclusion on inventive step also requires consideration of the inventive step attack starting from the alleged public prior use. For this reason too, the witnesses should be heard.
12. In view of the above, it cannot be ruled out that hearing the witnesses could, alongside evaluating the documentary evidence, have led to a different assessment of novelty and inventive step and, thus, to a different outcome.
13. The Board views this as a fundamental procedural violation that justifies the setting aside of the decision, in line with previous jurisprudence (see, for example, T 716/06, point 3, T 1363/14, point 2; and T 314/18, points 4 and 6).
14. In view of the primary object of the appeal proceedings to review the appealed decision in a judicial manner,

it would be more appropriate that the witnesses be heard before the Opposition Division.

15. Additionally, given that O1 is the Manual of an MPD 600 system such as the one of the alleged public prior use, and that O7 reports on measurements carried out also with an MPD 600 system, a review, at this stage, of the conclusions reached by the opposition division with regards to the inventive attacks starting from O1 or O7 would be premature.
16. Given the causal relationship between the procedural violation and the necessity to appeal, a reimbursement of the appeal fee is equitable.
17. Altogether, special reasons justifying remittal of the case to the Opposition Division for further prosecution present themselves, along with grounds for reimbursing the appeal fee (Article 111(1) EPC and Rule 103(1) (a) EPC, Article 11 RPBA 2020).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chair:



H. Jenney

P. Scriven

Decision electronically authenticated