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**Datasheet for the decision
of 1 December 2021**

Case Number: T 3120/19 - 3.2.04

Application Number: 10799016.0

Publication Number: 2519740

IPC: F03D9/00

Language of the proceedings: EN

Title of invention:
DIRECT DRIVE WIND TURBINE

Patent Proprietor:
Siemens Gamesa Renewable Energy A/S

Opponent:
ENERCON GmbH

Headword:

Relevant legal provisions:
EPC Art. 113(1), 117(1)
RPBA 2020 Art. 11

Keyword:

Right to be heard - substantial procedural violation (yes)

Evidence - hearing witness

Remittal - fundamental deficiency in first-instance proceedings (yes)

Decisions cited:

T 1175/04, T 0474/04

Catchword:



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Case Number: T 3120/19 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 1 December 2021

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 19 September
2019 rejecting the opposition filed against
European patent No. 2519740 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman A. de Vries
Members: G. Martin Gonzalez
T. Bokor

Summary of Facts and Submissions

- I. The appeal was filed by the appellant-opponent against the decision of the Opposition Division to reject the opposition against the patent in suit.
- II. The Opposition Division decided not to hear the witness Mr. Jepsen, offered in support of the prior use E-66, and that the subject-matter of the claims as granted was novel and involved an inventive step.
- III. In a communication dated 5 August 2021 issued in preparation for oral proceedings the Board set out the reasons why it opined that the Opposition Division should have summoned Mr Jepsen as a witness and why it was inclined to remit the case for further prosecution. The parties were invited to file their comments on the Board's preliminary and non-binding observations. The parties replied on 9 September 2021 and on 13 September 2021, and oral proceedings before the Board were held by videoconference on 1 December 2021.
- IV. The appellant-opponent requests that the decision under appeal be set aside, and that the European patent No. 2519740 be revoked.

The respondent-proprietor requests that the appeal be dismissed, i.e. that the opposition be rejected. Alternatively the decision under appeal should be set aside and the patent be maintained with one of the Auxiliary Requests 1 or 2, filed with the response to the grounds of appeal dated 29 May 2020.

V. Claim 1 of the main request reads as follows:

"Direct drive wind turbine (1), comprising:

- a plurality of blades connected to a hub (6);
- a generator comprising a stator (12) and a rotor (10), the stator (12) being fixed on a nacelle (4) of the wind turbine (1); and
- a rotation sensor having a static element (30; 130; 230; 330) and a moving element (34; 134; 234; 334); wherein the hub (6) is directly connected to the rotor (10),

wherein the static element (30; 130; 230; 330) of the rotation sensor is mounted on a stationary element of the wind turbine, in particular the stator (12), at a distance from the rotation axis (R) of the hub (6) and that the moving element (34; 134; 234; 334) of the rotation sensor is mounted on the rotor (10) at a distance from the rotation axis (R) of the hub (6), characterized in that the moving element (34; 134; 234; 334) of the rotation sensor is formed integrally with the rotor (10)."

VI. In the present decision, reference is made to the following evidence:

- (E1) WO 2010/142759 A1
- (E2) US 7,431,567 B1
- (E5) Technical drawing (Enercon E-66)
- (E6) Statutory declaration (Eidesstattliche Versicherung) of M. Jepsen (Enercon E-66).

VII. The appellant-opponent's arguments can be summarised as follows:

The Opposition Division infringed their fundamental right to be heard, Article 113(1) EPC, by its refusal to summon the witness Mr Jepsen in support of the prior use E-66. The wind turbine of this prior use deprives the claimed wind turbine of novelty.

VIII. The respondent-proprietor's arguments can be summarised as follows:

The Opposition Division did not commit a substantial procedural violation in the present case. The wind turbine described in E5/E6 does not have all the claimed features. The claimed wind turbine is therefore new over E5/E6, whether proven or not. The Opposition Division would have thus reached the same decision. Moreover the prior use was also not sufficiently substantiated within the opposition period and should have been disregarded for this reason. Finally, the Opposition Division was in any case right to conclude that the prior use was not proven without hearing the witness.

Reasons for the Decision

1. The appeal is admissible.
2. The invention relates to a direct drive wind turbine, where the turbine hub is directly connected to the generator rotor. The electric generator thus rotates with the speed of the wind turbine blades and hub. For control purposes the wind turbine comprises a rotation sensor for monitoring the rotation velocity of the hub,

see specification paragraphs [0001], [0004]. The static element of the rotation sensor is mounted on a stationary element of the wind turbine, the generator stator, while the moving element of the sensor is formed integrally with the generator rotor. The moving element location is at a distance from the rotation axis of the hub, see specification paragraph [0008]. The sensor location facilitates wind turbine maintenance, as compared to known sensor locations close to the rotation axis of the hub, see patent specification paragraph [0005] and [0010]. Moreover, due to the distance to the rotation axis, the rotation speed can be measured more accurately, see specification paragraph [0010].

3. The appellant-opponent submits that the Opposition Division infringed their fundamental right to be heard, Article 113(1) EPC, by its refusal to summon the witness Mr. Jepsen.
4. It is well-established in the jurisprudence of the boards of appeal that failure to consider evidence submitted in due time will normally constitute a substantial procedural violation in that it deprives a party of their fundamental right to free choice of evidence and the right to be heard, as enshrined in Articles 117(1) and 113(1) EPC, see Case Law of the Boards of Appeal, 9th Edition 2019 (CLBA), III.G.3.3.
5. The respondent proprietor argues that there has been no substantial procedural violation for several reasons. The claimed wind turbine would be new over E5/E6 (whether proven or not), since the latter does not show all the features of the claimed wind turbine. The Opposition Division would have thus reached the same decision. The prior use was also not sufficiently

substantiated within the opposition period and should have been disregarded for this reason. Finally, the Opposition Division was right to conclude that the prior use was not proven without hearing the witness.

The Board will analyse the above points in turn.

Course of proceedings before the Opposition Division

6. The relevant facts and conclusions of the Opposition Division during the proceedings before it are as follows. With the notice of opposition, the appellant-opponent submitted evidence in support of prior use E-66 and an associated objection of lack of novelty for granted claim 1, see section 2.3 of the notice. Prior use E-66 was substantiated on the basis of a technical drawing E5, a statutory declaration by Mr. Jepsen (E6), and an offer to hear Mr. Jepsen as witness to corroborate the alleged facts of the prior use.

The reasons for rejecting the present opposition was that the claimed invention was new and involved an inventive step over all other pieces of prior art, except prior use E-66. With respect to E-66, the Opposition Division accepted that E6 anticipated the subject-matter of granted claim 1, see section 12 of the impugned decision, last sentence. Thus the probative value of E5/E6 was decisive for the conclusions in the decision under appeal. The Opposition Division however concluded that the prior use as described in E6 was not proven beyond reasonable doubt because of a lack of documentary evidence which could not be remedied by hearing Mr. Jepsen as witness, see impugned decision sections 13.3 and 12.

Novelty relevance of the prior use E-66

7. As regards its technical disclosure, the Board agrees with the conclusions of the Opposition Division that the wind turbine as described in the statutory declaration E6 in reference to drawing E5 anticipates the subject-matter of granted claim 1, see section 12 of the written decision: "...and since the OD accepted that the sworn statement E6 seems to contain all of the features of claim 1,...".

8. The respondent-proprietor contests this opinion.

They argue that E6 does not anticipate a sensor moving element *formed integrally* with the rotor. In the respondent-proprietor's opinion this term means: formed as one piece or as a single piece. They cite in this respect decision **T 1175/04** where that Board stated: "*The expression "integrally formed" has a clear technical meaning... transmitting parts 9, 10, 11 and 12 and the corresponding parts 7b, 8b, 7a and 8a... are made of a single piece or formed into a single piece*".

9. The Board finds differently. E5 is a technical drawing showing a disc rotor ("Scheibenrotor", see caption at the bottom right hand corner) said to be that of an E-66 wind turbine by Mr Jepsen in his declaration, point 5 - indeed E-66 is just legible in the caption. Mr Jepsen in point 5 of his declaration states that the cross-section view A-A in E5 shows a brake disc with indentations that form the sensor moving element. Indeed at the right hand side of the cross-section view such an indented disc is visible. According to Mr Jepsen's statement, point 4, those indentations on the disc act as markers for a sensor to determine the rotational speed ("Drehzahl"). The disc is said there to be firmly connected to the rotor. Indeed in the cross-section the disc is seen to be bolted by a great

many bolts to what appears to be the generator rotor. Such a firm connection of disc and rotor is seen by the Board to correspond to the disc being "formed integrally with the rotor" as required by the claim. Here the Board reads term *integral* in its broad sense as for example defined in the OED as: "Made up of component parts which together constitute a unit". By bolting disc and rotor together the two components for all intents and purposes can be considered to form a unit that moves as one.

10. The same conclusion regarding "formed integrally" holds when reading the feature in the context of the claim wording alone or in the light of the whole patent disclosure. Indeed, according to the pre-characterising portion of the claim, "the moving element ... is *mounted on* the rotor..." (emphasis by the Board). In its normal sense to mount is to attach to a support (see Merriam-Webster). It thus implies the possibility of two different physical components. In the present claim the moving element of the sensor and the rotor are parts of the electric generator.

This view is consistent with the embodiments detailed in the patent, see for example the embodiment of figure 3. In figure 3 the movable element 234 is clearly delineated as an element distinct from the brake disc 50. Corresponding paragraph [0036] states that "brake disc 40 or brake flange 40 may be mounted on the rear rotor flange 38. The movable element 234 may be mounted next to the brake disc 40 or on the rear rotor flange 38", where reference 40 is an obvious error as in the preceding paragraph [0035] 40 is used for the outer stator portion. Here again the expressions used -"mounted on", "mounted next to... or on..." - also imply two parts that are fixed or attached together.

Also other embodiments depict the movable element 34, 134, 334 as a distinct element in the form of a disc that is attached to a rotor part, see figures 1, 2, 4 of the patent specification.

11. The Board therefore concludes that if the evidence E5 and E6 is taken at face value it appears to show all features of claim 1. Thus the prior use, if proven, would be prejudicial to novelty of granted claim 1 and thus highly relevant.

Sufficiency of substantiation of prior use E-66

12. The respondent-proprietor also submitted that the prior use was not sufficiently substantiated. The respondent argues that not all relevant circumstances of the prior use were timely submitted, see Guidelines for Examination in the European Patent Office of November 2018 (GL2018), G.IV.7.2 or CLBA I.C.3.2.4.a) in this regard. The respondent-proprietor argues that E5 and E6 would only describe a sensor that is mounted on a stationary element, without further detail.

The Board is not convinced by this argument. The claim does not specify or restrict the type of sensor or its position. Thus no further detail of the sensor, beyond what is already described in E6, is required to anticipate this feature of the claim. Therefore the question of what has been used in E-66, insofar as material for establishing lack of novelty of the claimed subject-matter, is sufficiently substantiated.

13. The Board has also no difficulty in identifying the other contested circumstances of the prior use in the original submissions, namely in E5/E6 and in section 2.3 of the notice of opposition. The location, that is

the geographical coordinates of the wind turbine in question (easily verifiable using eg. Google maps), the date the turbine was sold (24 June 1997), and to whom (EWE) are explicitly mentioned. The notice of opposition also indicates that there was no confidentiality agreement, which appears quite plausible for this type of sale.

It is another matter whether this information is in itself sufficient to conclusively prove the facts of the prior use. It suffices for the purpose of Rule 76(2)(c) EPC that the facts and evidence are indicated to a degree that allows patentee and opposition division to see clearly what attack was being mounted against the patent, and what evidential support was being adduced for that attack (CLBA, IV.C.2.2.8 a) and in particular the cited T 0204/91). Where prior use relies on a witness, as is in this case, it is enough to name the witness and indicate the alleged facts for which the witness is called, CLBA, IV. 2.2.8 d).

14. The Board therefore concludes that the prior use E-66 has been sufficiently substantiated in the notice of opposition and would be relevant, if proven, for novelty of granted claim 1.

Procedural violation

15. The Opposition Division held that the prior use was not proven beyond reasonable doubt, see impugned decision section 13.3, which is indeed the applicable standard in the present case where the evidence originates from the sphere of the opponent. The Division considered the evidence not persuasive because of the lack of further documentary evidence, given the large number of wind turbines of the prior use type (E66) allegedly sold,

and because of perceived inconsistencies between the representative's explanations at the oral proceedings and the statutory declaration, point 13.3 of the decision. As stated in the decision section 13.3, first paragraph, last sentence: "For this reason there is a fundamental problem with this witness statement reaching the required level of persuasiveness, particularly when the alleged prior use is almost entirely reliant on it, as in the present case". The Opposition Division considered in particular not sufficiently proven that a sensor as described in E6 existed in the prior use or that the serrations depicted in drawing E5 fulfilled the function of a sensor moving element as it was explained in E6.

16. This reasoning contrasts with the approach recommended in the Guidelines for such situations. According to the applicable version of the Guidelines (November 2018), G.IV.7.2 it is recommended that "[I]f the prior use or certain circumstances relating to it are contested, the division will need to take further evidence (e.g. hearing witnesses or performing an inspection) for those facts which are relevant to the case and which cannot yet be considered proven on the basis of the evidence already submitted". It was for this very reason that Mr Jepsen was offered as witness, namely to corroborate the alleged facts stated in E6 and now contested by the proprietor. The Opposition Division should thus have followed the approach in the Guidelines. As explained in **T 0474/04**, reasons 8, this approach is justified since a written statutory declaration can only be taken as it is. In case a witness is heard, there are additional approaches how the reliability of his testimony may be scrutinized that are not available from the evaluation of written evidence alone. These may *inter alia* concern the memory

of the witness, the question whether his testimony is based on his own observations or on conclusions drawn by him, or on information from others, or the question whether the witness was able to observe what he claims to have observed. They may also concern the witness himself, factors which may indicate that he tells the truth or, on the contrary, that his testimony is based on an error in perception or recollection, on hearsay, or that he is not willing to tell the whole truth and nothing but the truth.

17. This information that sheds light on the reliability of the witness and their statements can normally only be elicited by careful examination and cross examination of the witness. This hearing of a witness is decided by the EPO, Rule 117 EPC, and normally takes place at the oral proceedings long after the offer to hear the witness will have been made. By virtue of these facts information elicited by hearing a witness upon a decision of the EPO cannot therefore automatically be considered late filed and thus disregarded under Article 114(2) EPC, contrary to the respondent proprietor's view. Therefore the Opposition Division was wrong to conclude in section 12 of the impugned decision: *"As it was not apparent what specific additional information would be provided by the witness, other than repeating his sworn statement in person, ... , then it was not felt by the OD to serve a useful purpose to hear the witness in person"*. As the appellant opponent correctly observed, such an approach would generally obviate hearing witnesses at all, and parties would then (in cases involving a witness) only rely on sworn statements by the witness under Article 117(1)(g) EPC filed in advance in the notice of opposition.

18. It is for these reasons that if hearing of the witness has been offered or requested on matters that are contested and which are decisive to the outcome of a case such an offer or request to take evidence should normally be taken up.

19. The principle of free evaluation of evidence is only applicable after the evidence has been taken and cannot be used to justify not taking evidence that has been offered, cf. **T 0474/04**, Reasons 8:

"The principle of free evaluation of evidence applying in the proceedings before the EPO is not a justification for refusing such an offer. Free evaluation of evidence means that there are no firm rules according to which certain types of evidence are, or are not, convincing. It does not mean that the deciding body can choose the evidence which it considers sufficient for finding the truth. Instead, the question whether a fact can be regarded as proven has to be assessed after having taken all the relevant evidence (G 3/97, OJ EPO 1999, 245, Reasons, point 5). To assume that the content of a written declaration cannot be disproved by hearing its author as witness would amount to an anticipated assessment of evidence which actually has not been taken (cf T 927/98 of 9 July 1999, not published in OJ EPO, Reasons, point 2.3.5), unless the deciding body ascertains specific facts justifying such a conclusion under the circumstances of an individual case."

20. The Board further notes that even in the context of the very high standard of proof of the present case, namely that of "beyond reasonable doubt", the credibility of witnesses cannot be impugned merely because they had a business relationship with a party. The jurisprudence

of the Boards of Appeal has recognised this principle in many decisions, see CLBA III.G.4.2.1.a) and eg T 162/87, T 627/88, T 124/88, T 482/89 (OJ EPO 1992, 646), and T 363/90.

21. With its refusal to hear the witness Mr. Jepsen the Opposition Division effectively ignored evidence offered by the opponent in support of its case. It thereby infringed their fundamental right to free choice of evidence and the right to be heard, Articles 117(1) Article 113(1) EPC, see CLBA III.G.3.3. For this reason the impugned decision must be set aside.

Remittal

22. Under Article 11 RPBA 2020 the Board may remit the case to the department whose decision was appealed if there are special reasons for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons. A violation of the principle of the right to be heard enshrined in Article 113(1) EPC is considered to be a fundamental deficiency, see CLBA V.7.7.2.a).

For this reason the Board considers it appropriate to remit the case for further prosecution, Article 111(1) EPC. The parties do not object to the remittal.

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:



G. Magouliotis

A. de Vries

Decision electronically authenticated