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D E C I S I O N
of 16 February 1995

Case Number: T 1076/93 - 3.4.2
Application Number: 85102210.3
Publication Number: 0157176
IPC: G01B 21/02, G01B 11/02, G01B 5/08
Language of the proceedings: EN

Title of invention:

An apparatus for measuring dimensions, in particular diametral and axial dimensions of parts with rotational symmetry

Patentee:

MARFOSS SOCIETA' PER AZIONI

Opponent:

FAG Kugelfischer George Schäfer & Co.
Hornelwerke GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 54(2) and 56
EPC R. 67 and 68(2)

Keyword:

"Prior use (no)"
"Reimbursement of appeal fee (no)"

Decisions cited:

T 0020/90 of 27 June 1991

Catchword:

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Case Number: T 1076/93 3.4.2

DECISION
of the Technical Board of Appeal 3.4.2
of 16 February 1995

Appellant:
(Proprietor of the patent) MARPOSS SOCIETA' PER AZIONI
Via Saliceto 13
I-40010 Bentivoglio 30 (IT)

Representative:
Miniucchi, Silvio
c/o Marposs S.p.A.
Via Saliceto 13
I-40010 Bentivoglio (Bologna) (IT)

Respondent:
(Opponent) FAG Kugelfischer Georg Schäfer & Co.
Postfach 1260
D-97402 Schweinfurt (DE)

Representative:
Rehmann, Klaus H.
Postfach 13 10
Hauptbahnhofstrasse
D-97403 Schweinfurt (DE)

(Opponent) Hommelwerke GmbH
Alte Tuttlinger Str. 20
D-78056 Villingen-Schwenningen (DE)

Representative:
Leine, Sigurd, Dipl.-Ing.
LEINE & KÖNIG
Patentanwälte
Burckhardtstrasse 1
D-30163 Hannover (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 18 February 1993,
posted on 2 November 1993 revoking European patent
No. 0 157 176 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: M. Chomentowski
M. Lewenton
W. W. Hofmann
B. Schachenmann

Summary of Facts and Submissions

- I. The Appellant is proprietor of the European patent No. 0 157 176, which is based on the European patent application No. 85 102 210.3.
- II. Respondent I (Opponent I) filed an opposition against the European patent on the grounds that the apparatus of the contested patent was not patentable following a public prior use based on an offer by his own firm, i.e. FAG Kugelfischer Georg Schäfer KGaA, to Messerschmitt-Bölkow-Blohm GmbH, i.e. MBB, documented by, in particular, OI.02 = written offer of 10 December 1982 to MBB, OI.03 = written offer of 20 June 1983 to MBB, OI.04 = drawing 00 301 Me 20 800 showing a combined measuring apparatus for measuring funnels, OI.05 = letter of MBB of 27 July 1983 No. 19 306 865 for ordering an apparatus, OI.06, OI.07 and OI.011 = declarations by employees, at least at the relevant time, of MBB and of FAG, and involved in this offer. An opposition had also been filed by Respondent II (Opponent II) on the grounds of lack of patentability having regard to another prior use concerning a sale to Volkswagenwerk Ag (VW).
- III. The patent, in amended form, was revoked. The contract between MBB and FAG filed with letter of Opponent I of 28 February 1992 concerning the order by MBB and comprising the conditions thereof, and OI.015 = the "Pflichtenheft", i.e. the brochure of obligations edited by MBB, had been filed by Opponent I and evidence had been taken by hearing witnesses on the day of the oral proceedings at which the decision was given, i.e. on 18 February 1993, the collection of testimonies T comprising, in addition to testimonies of the above-mentioned employees for Opponent I, testimonies of

two employees of the proprietor. The Opposition Division took the view that it was only necessary that a device be sold and distributed to one member of the public for the prior use to be considered publicly available, and that this was indeed the case as MBB and VW were both held as members of the public and thus the devices referred to by the Opponents were considered to have formed part of the state of the art on the priority date of the patent in question. In this respect, the Opposition Division did not accept the arguments of the proprietor that there was an agreement of confidentiality related to the shown documents and, taking into account in particular the public prior use submitted by Opponent I, arrived at the conclusion that the claimed apparatus was not inventive.

- IV. The Appellant (Proprietor) filed an appeal against this decision and, in particular, requested accelerated proceedings because of pending infringement proceedings.
- V. After the parties had been summoned to oral proceedings, Respondent II declared by letter dated 21 December 1994 that he withdrew his opposition.
- VI. During the oral proceedings of 16 February 1995, the Appellant filed a new set of 8 claims, with the only independent claim, Claim 1, reading as follows: "1. Apparatus for measuring diametral and axial dimensions of parts (38, 75) having rotational symmetry and defining a part geometric axis with a support (37) for the part to be checked, a support structure (1), a system of slides (3, 27, 28) carried by the support structure and including a first slide (3) movable with respect to the support structure (1) and to the support (37) in a first direction substantially parallel to a longitudinal geometric axis of the apparatus and to said part geometric axis of the part arranged on the support

(37) and a second slide (27) movable in a second direction perpendicular to said first direction, transducer means (47, 48) adapted to provide signals responsive to the positions of the slides (3, 27), motor means (10, 24) for displacing the slides, measuring means (30, 31) carried by the system of slides (3, 27, 28), processing means (53, 55, 57-66, 69) adapted to receive the signals of the transducer means (47, 48) and the signals of the measuring means (30, 31) for combining them and programmable control means (43, 54, 56) for automatically controlling the motor means, depending on the type of part to be measured, to displace the first slide (3) and the second slide (27) for the measurement of each part, characterized in that the system of slides (3, 27, 28) comprises a third slide (28) movable by the motor means in said second direction, the second and third slide (27, 28) being carried by the first slide (3), which is carried by the support structure (1), and the measuring means comprise two measuring heads (30, 31) fixed to the second slide (27) and the third slide (28), respectively, each measuring head having a single movable arm (32, 33; 78, 79) with at least a feeler (34, 35; 80, 81) for contacting the part (38; 75) thereby displacing said movable arms, and being adapted to measure both in said first and second direction, the transducer means (47, 48) being adapted to measure the position of the first slide (3) and the mutual position of the second slide (27) and third slide (28), which are always arranged symmetrically with respect to the longitudinal axis of the apparatus and the geometric axis of the part, the feelers (34, 35; 80, 81) of the measuring heads being adapted to be arranged, in measurement conditions, substantially on a plane passing through said longitudinal axis of the apparatus, the processing means (53, 55, 57-66, 69) being adapted to determine the

dimensions of the parts (38, 75) by combining the signals provided by the transducer means (47, 48) and the measuring heads (30, 31)."

VII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims filed in the oral proceedings of 16 February 1995 and the description and drawings as originally filed to be adapted, further, that the appeal fee be reimbursed, and submitted the following arguments in support of his requests: Present Claim 1 defines clearly an apparatus comprising a particular symmetry, and is based on apparatuses disclosed as well in the granted patent as in the original application. The prior use alleged by Respondent I was not public in the sense that it is implicit that in a firm like MBB, which develops and fabricates war equipment, discretion is the common rule; additionally, some of the documents of MBB comprise statements about discretion. In these circumstances, as also derivable from document OI.015, i.e. the "Pflichtenheft" of MBB, it was not necessary to have a specific supplementary agreement of confidentiality, because contractors with MBB can be supposed to consider implicitly that, indeed, confidentiality is the rule. The other prior art documents comprise only some of the relevant features, but they show different types of apparatuses such as comparators and measurement apparatuses, and there is no indication for an obvious combination of their features leading to the invention. The reimbursement of the appeal fees is justified because of procedural violations by the Opposition Division, since the proprietor had not had the opportunity to present his comments and moreover the decision was not sufficiently substantiated.

VIII. Respondent I, the only remaining respondent in the present case, requested that the appeal be dismissed and argued substantially as follows in support of his request: The particular feature of present Claim 1 that the second and third slide (27, 28) are carried by the first slide (3), which is carried by the support structure (1), is not derivable from the text of the original application and is thus formally not allowable. The subject-matter of the patent in suit is not patentable having regard to the public prior use involving FAG and MBB, for which, as also derivable from the relevant documents and the testimonies in T of employees of FAG and MBB having been involved in the ordering of the apparatus, there has been no written agreement of confidentiality and which resulted in the sale by FAG of an apparatus to MBB with, beforehand, communication of an offer together with illustrating documents. In any case, the other prior art documents comprise almost all the features of the apparatus in dispute, which results from an obvious combination of the features of the known devices.

Reasons for the Decision

1. The appeal is admissible.
2. *Allowability of the amendments*

Present Claim 1 is based on the combination of, in particular, the features of the granted Claim 1, of a feature, that the second slide (27) and third slide (28) are always arranged symmetrically with respect to the longitudinal axis of the apparatus and the geometric axis of the part, which is derivable from granted dependent Claim 2, of the feature of granted dependent

Claim 3 that the feelers (34, 35; 80, 81) of the measuring heads are adapted to be arranged, in measurement conditions, substantially on a plane passing through said longitudinal axis of the apparatus, and of further clarifying features, for instance concerning the arrangement of the part (38) to be checked on the support (37) in relation to the longitudinal geometric axis of the apparatus, which are derivable in particular from the drawings. Present Claim 1 is also based on the combination of, in particular, the features of Claim 1, and dependent Claims 2 and 3, all as originally filed, with further features, such as those mentioned here above, especially derivable from the original drawings, which were not amended before grant. It is to be noted that the expression "the feelers (34, 35; 80, 81) of the measuring heads being adapted to be arranged, in measurement conditions, substantially on a plane passing through said longitudinal axis of the apparatus," does not introduce additional subject-matter as compared to the feature of original dependent Claim 3 that the feelers (34, 35; 80, 81) of the measuring heads are arranged, in measurement conditions, substantially on a plane passing through said longitudinal axis of the apparatus, because the present expression contains an indication of implicitly necessary apparatus means and results in the same constructional features of the apparatus as those of the original application in measurement conditions. Respondent I has submitted objections concerning the allowability of the particular feature of present Claim 1 that the second and third slide (27, 28) are carried by the first slide (3), which is carried by the support structure (1); however, this feature is directly and unambiguously derivable from Figures 1 and 2, original and as granted. Therefore, the claims of the European patent concern an apparatus more restricted than the apparatus of granted Claim 1 and thus, the requirement of Article 123(3) EPC that the

claims of the European patent may not be amended during opposition proceedings in such a way as to extend the protection conferred is satisfied. Moreover, the requirement of Article 123(2) EPC that the European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed is also satisfied.

3. *Clarity*

Present Claim 1 defines the apparatus for measuring diametral and axial dimensions of parts having rotational symmetry and defining a part geometric axis, without ambiguity and with the apparatus constructional features necessary for obtaining the results mentioned in the present patent. In particular, present Claim 1 specifies that there is a longitudinal geometric axis of the apparatus, as well as a plane passing therethrough, and that it is in relation thereto that the part to be measured, having a rotational symmetry and a part geometric axis, is arranged on the support (37), and that the respective movements of the slides, measurement heads and feelers are effected. Therefore, present Claim 1 is clear in the sense of Article 84 EPC.

4. *State of the art*

4.1 The crucial question concerning the prior use involving MBB and the own firm of Respondent I, i.e. FAG, is whether the information provided by FAG has been available to the public, or not. In particular, Respondent I has argued that the submission of FAG to MBB, before the present priority date, of an offer, with drawings and explanations, for an apparatus, without mentioned obligation of secrecy, resulted in the sale of said apparatus to the public, whereby MBB in the present case was considered as part of the public. On the

contrary, the Appellant has argued that since MBB is generally known as being a manufacturer of war equipment and in this branch of industry secrecy is generally considered as important, since moreover at least one document of MBB, i.e. OI.015, shows indications concerning secrecy and it is derivable from T (see page 11, second paragraph) that the offers were not shown to third parties, it is to be concluded that there was an unwritten agreement of confidentiality. The Appellant's arguments are credible for the following reasons:

MBB is indeed a known manufacturer of war equipment. It is generally known that at such manufacturers' factories or offices, discretion is the rule. Indeed, it could be accepted that for apparatuses which are seen by the personnel of MBB and its visitors, for instance a coffee machine in the cafeteria, such rule is less severe; however, for apparatuses used during fabrication, wherein any feature of the apparatus can reveal important corresponding features of the product being fabricated, for instance its material or its shape, such a lenient attitude is less credible. In this respect, it is to be noted that, in addition to the discretion due to the specific nature of this branch of industry, OI.015 and, according to T (see page 9, last paragraph to page 10, first paragraph), almost all the papers used by the personnel of MBB comprise an advice about discretion. It is also to be noted that according to the contract of MBB (see page 16) secrecy is stressed; according to said same contract (see page 23, paragraph 17), communication of the manufacturer of the apparatus with MBB is strictly restricted to one specifically named person and, in his absence, to his deputy. The arguments of Respondent I, that the former requirement concerns only the access to the factory ground, and that the latter requirement is for secure

delivery of the mail, are not credible in that they are not understandable without some purpose of restricting the access to information. Indeed, such requirements, which for a factory of, for instance, furniture or cheese would be surprising, are a further indication as derivable from the general statements in the testimonies T (see page 20, first paragraph to page 24, first paragraph) of employees of the Appellant informed of procedures accompanying orders of MBB, that restricted access to information was common rule for a firm like MBB.

Moreover, there is no evidence that MBB has acted in such a way that the machine fabricated and mounted by Respondent I has been made available to third persons before the present priority date. The further arguments of Respondent I that already the offer of FAG with relevant drawings and explanations without a statement of confidentiality, even without any delivery of the apparatus to the client MBB, was already a public disclosure, cannot be accepted for the following reasons: Indeed, as derivable from the written offer of FAG to MBB documented by OI.02, OI.03, OI.04, OI.05, from the declarations OI.06, OI.07 and OI.011 as well as from the testimonies T (see in particular page 3, last paragraph; page 9, last paragraph to page 10, first paragraph; page 17, last paragraph and page 18, first paragraph), there was no written agreement of confidentiality with respect to the ordered apparatus. However, it is derivable from T (see in particular page 11, second paragraph) that at MBB the communication of offers to third persons was in principle not allowed. In this respect, it is to be noted that Respondent I has pointed out a further statement in the same testimony T (see page 11, third paragraph) that it was the Purchasing Department which had issued the rule of restricted communications to third parties, and argued

that this was an indication that this rule was not related to the fabrication of weapons, but was for commercial needs. However, this argument of Respondent I is not convincing in that for ordering said apparatus, i.e. for its purchase, this department was indeed "prima facie" the determining one. It is also to be noted that the letter of Daimler-Benz Aerospace AG dated 10 February 1995 filed by Respondent I at the oral proceedings and specifying that visits to the factories of the firm MBB (now Daimler-Benz Aerospace AG) had always been possible without special conditions and that also other forms were exercised for making available to the public activities of MBB, cannot however be considered as convincing. First, this letter is not directed to the prior art argued in relation to the present case and does not specify whether according to circumstances all areas of the firm were open to visitors or not. Moreover, since for the above-mentioned reasons there is no indication that the apparatus was held available for public inspection and thus the question of the actual delivery at MBB of the ordered apparatus before the present priority date can be left open, the alleged public prior use can be considered as being concerned with the sending of an offer to be studied by the employees of MBB and not with an apparatus exposed in a factory area, and there is no indication in this letter that such offers were available to visitors. Therefore, the Appellant's argument that MBB cannot be considered as part of the public but is implicitly supposed by its contractors to behave as if an agreement of secrecy had been specified, is credible. Therefore, the apparatus mentioned by Respondent I is not prior art in the sense of Article 54(2) EPC.

4.2 It is to be noted that many arguments were submitted for and against the availability to the public of the prior use submitted by Opponent II, then Respondent II. However, this question is no longer relevant for the following reasons: Respondent II has withdrawn his opposition before the oral proceedings of 16 February 1995 wherein the present claims have been filed. Respondent I has declared that he could not comment on said other prior use because it was not his own. During said oral proceedings, the Appellant has pointed out features of said other prior use, such as a greater number of measuring means, which resulted in an apparatus distinguished from the presently claimed apparatus as well in structure as in use. Therefore, since the Appellant's arguments were not contested and the documents and evidence on file contained no teaching directly usable with respect to the features of said other prior use, it is not necessary in these circumstances to determine whether the prior use argued initially by Opponent II, then Respondent II, was public or not.

5. *Novelty*

The novelty of the subject-matter of present Claim 1 has not been contested (Art. 54(1) and (2) EPC).

6. *Inventive step*

An apparatus corresponding to the first part of present Claim 1 is acknowledged, with reference to a document cited in the present patent (see column 2, line 17 to column 3, line 40), as prior art with the following drawbacks: the known apparatus, which has only two slides for two-dimensional measurements, is rather slow, and the positioning of the part is a harshly critical problem; the features of the characterizing portion of

present Claim 1 are intended for solving these problems. The Appellant's argument that, with a third slide, and in particular with the symmetric movement of the slides and the arrangement of the feelers substantially in a specific plane, the above-mentioned problem of the prior art is solved, can be accepted. It is to be noted that formerly presented lines of argumentation contested main claims which differed in many respects from present Claim 1. The only argument that the apparatus of present Claim 1 should be obvious having regard to the prior art is an indication of Respondent I during the oral proceedings of 16 February 1994 pointing out a previously filed analysis of the features of formerly submitted main claims as compared with features derivable from a plurality of prior art documents, such as those of the European search report, however, without substantiated reasoning on the basis of the problem-solution approach generally adopted by the Boards of Appeal. Therefore, since the Appellant's arguments that the combination of features of present Claim 1 can only be collected from a plurality of documents showing different types of apparatuses such as measuring apparatuses and comparators are credible, the subject-matter of present Claim 1 is not obvious with respect to state of the art in the sense of Article 54(2) EPC. Therefore, said subject-matter involves an inventive step in the sense of Article 56 EPC and, thus, present Claim 1 is allowable (Art. 52(1) EPC). Therefore, since Claims 2 to 8 are also allowable as dependent from Claim 1, the patent can be maintained in amended form (Art. 102(3) EPC).

7. *Reimbursement of the appeal fee*

The Appellant has requested reimbursement of the appeal fee on the grounds that the Opposition Division committed at least one substantial procedural violation.

First, the Appellant has argued that the contested decision (see the paragraph bridging pages 10 and 11) refers to infringement proceedings pending between Respondent I and himself, which he had mentioned himself, concerning the same type of apparatus as the apparatus in dispute, and that this was used against some of his arguments concerning the interpretation of the claims using the description and the drawings. However, this argument is not convincing for the following reasons: First, although it may have been inappropriate to mention the pending infringement proceedings in the reasons of the decision, it is however to be noted that it is in particular the Appellant himself who argued first about this question. Moreover, since the decision under appeal is not concerned with the patent as granted and since thus any objected lack of clarity of the amended claims can, if possible, be met by further amendments of the claims by taking into account the description and drawings, the question of the interpretation of the claims, in which context the pending proceedings are mentioned in the decision, was not relevant for a comparison of the alleged prior art and the claimed apparatus, which was the crucial point of said decision, and thus cannot be considered as having been decisive. In this respect, the conclusions of the decision T 20/90 of 27 June 1991 (see point 2 of the reasons) cited by the Appellant, that there has been a substantial procedural violation because prior to the contested decision no reason had been given for holding a particular measure obvious for the person skilled in the art, cannot be applied directly to the present case wherein, as admitted by the Appellant, as well the alleged public prior uses as the pending infringement proceedings were discussed during the oral proceedings before the contested decision. Therefore, the Appellant's argument, that the Opposition Division omitted to apply Article 113(1) EPC in that it

did not check or give the proprietor the opportunity to establish facts relating to both the pending proceedings and the alleged prior use, does not require further consideration as being irrelevant to the impugned decision.

The Appellant has also argued that the contested decision contravened the requirements of Rule 68(2) EPC because it was insufficiently substantiated with regard to the special character of the client of Opponent I, i.e. MBB, and with regard to particular circumstances of the case. However, it is to be noted that further consideration of a case by a Board of appeal may lead to conclusions different from those of an Opposition Division, but Rule 68(2) EPC only requires that the decisions open to appeal shall be reasoned; thus, since in the present case the decision comprises a reasoning specifying the grounds on which the decision is based, it is correct in this respect. Concerning the further arguments of the Appellant that he did not receive important documents from Opponent II and accordingly could not take them into account for his argumentation at the oral proceedings at the first instance, it is to be noted that, although the decision (see page 11, first complete paragraph) contains a statement that Opponent II was also able to illustrate that a device had been previously made available to the public, in view of which the contested Claim 1 was not inventive, the crucial reason on which the decision under appeal was based concerned only the public prior use alleged by Opponent I, so that the late provision of these documents was not directly related to the decision; from the further statement at the same text location of the decision, that the Opposition Division did not consider it necessary to discuss the arguments of Opponent II in detail since it had already been demonstrated that Claim 1 was not inventive, it is additionally derivable

that the indications concerning the public prior use alleged by Opponent II were only an expression of the opinion of the Opposition Division and not the basis for the decision. Thus, also for this reason, there can be seen no substantial procedural violation within the meaning of Rule 67 EPC. Therefore, no reimbursement of the appeal fee in accordance with said rule can be ordered.

Order

For these reasons it is decided that:

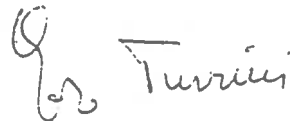
1. The appealed decision is set aside.
2. The case is remitted to the Opposition Division with the order to maintain the patent in amended form: Claims 1 to 8 filed in the oral proceedings of 16 February 1995; description to be adapted; drawings as in the patent specification.
3. The request for reimbursement of the appeal fee is rejected.

The Registrar:



P. Martorana

The Chairman:



E. Turrini

MCH

P. Sch.

HG

