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D E C I S I O N
of 15 June 1999

Case Number: T 0344/97 - 3.4.2
Application Number: 90912186.5
Publication Number: 0493397
IPC: G01L 7/08, G01L 9/06

Language of the proceedings: EN

Title of invention:
Pressure transmitter with flame isolating plug

Patentee:
Rosemount Inc.

Opponent:
Endress + Hauser GmbH + Co.

Headword:
-

Relevant legal provisions:
EPC Art. 111(1)

Keyword:
"Right to two instances of jurisdiction - remittal (yes)"

Decisions cited:
-

Catchword:
-



Case Number: T 0344/97 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 15 June 1999

Appellant: Endress + Hauser GmbH + Co.
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79689 Maulburg (DE)

Representative: Morstadt, Volker, Dipl.-Ing.
Endress + Hauser
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Postfach 2222
79574 Weil am Rhein (DE)

Respondent: Rosemount Inc.
(Proprietor of the patent) 12001 Technology Drive
Eden Prairie, MN 55344 (US)

Representative: Cross, Rupert Edward Blount
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27 Furnival Street
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 28 January 1997
rejecting the opposition filed against European
patent No. 0 493 397 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: E. Turrini
Members: M. A. Rayner
B. J. Schachenmann

Summary of Facts and Submissions

- I. The respondent is proprietor of European patent No. 0 493 397 (application No. 90 912 186.5, international publication No. WO 91/04475), granted on 21 December 1994.
- II. One ground upon which the patent was opposed by the appellant (opponent) was lack of inventive step (Articles 100(a) and 56 EPC). The documents listed on the cover page of the patent as granted (D1 to D8) were cited in support of the opposition as were also D9 (DD-A 214 927) and D10 (PTB-Bericht, Hrsg.: H. Steen).
- III. The Opposition Division rejected the opposition and in its decision identified the main feature of the transmitter of claim 1 as granted, which was then at issue, as a passageway or first passageway formed in a plug and having a shape which flame isolates a sensor from a line.
- IV. Notice of appeal against the decision of the opposition division was received. In the statement of grounds, the following documents were cited for the first time as a further state of the art:
- D11a: Brochure of 07.80 "Piezoresistive Sonden DB 16,17,26, 27 A/BZ" with corresponding as mentioned at the bottom of page 5
- D11b: Certificate of compliance PTB No. Ex-80/2142 X with
- Z11a: corresponding drawing No. 960164-0001 A and with

the annex to the examination certificate of the same number including

Z11b: drawing No. 960164-0005 A; Physikalisch-Technische Bundesanstalt, Braunschweig, 30 October 1980.

The above set of documents D11a-Z11b is referred to as D11 by the parties and this reference will also be used for convenience by the board. The appellant submitted that the document set D11 constitutes a single public document regularly given to purchasers on request before the priority date of the present patent.

- V. The appellant argued that the sole feature upon which inventive step was based according to the decision under appeal was known expressis verbis from document set D11. Moreover, in the view of the appellant, it is apparent that the remaining features are nearly, if not identically, derivable from document set D11.
- VI. In reply to the statement of grounds of appeal, the respondent submitted an amended main and an auxiliary request, incorporating into the claim as granted, the features of claim 5 and claims 5, 6 as granted, respectively, and provided arguments including amongst others that nothing could be found in the disclosure of new citation D11 that would lead to a transmitter having the features of claim 5 (or 6) as granted.
- VII. Both the appellant and the respondent requested oral proceedings on an auxiliary basis.
- VIII. The appeal board issued a communication observing that

both parties appeared to accept document set D11 as comprised within the state of the art within the meaning of Article 54(2) EPC. The board also noted that the requests for oral proceedings were made only on an auxiliary basis and thus conditional on a decision adverse to the party making the request being intended or envisaged. The board indicated that a decision to remit the case to the first instance is not adverse to a party so that no oral proceedings before the board needed to be appointed.

Accordingly, the appeal board proposed remitting the case back to the first instance to take document set D11 into account.

- IX. In their respective letters in response, the respondent raised no objection to and the appellant agreed with remittal of the case back to the opposition division.

Reasons for the Decision

1. The appeal is admissible.

2. The newly cited document set D11 is of sufficient relevance to be admitted into the proceedings because for example the second paragraph of section A10.1 in Z11a thereof indicates that the membrane separates the measuring medium from the measuring cell and the measuring cell is disposed behind a flame safe bore. Document set D11 is therefore directly relevant to the main feature identified by the opposition division in the decision under appeal, provided that this document set was indeed available to the public before the priority date which, however, was not denied by the proprietor in

the present proceedings.

3. During the opposition proceedings, the main basis for attacking the validity of the patent for lack of inventive step was based on the combination of teachings from documents D9 and D10. The line of argument first used in the appeal and based on document set D11 has thus to be considered as a fresh line of attack on the patentability of the claimed apparatus, additional to the line of attack based on documents D9 and D10. Moreover, the specific features of claim 1 according to the main request which derive from claim 5 (or in the case of the auxiliary request claims 5, 6) as granted are also fresh in the sense that they were not mentioned in the decision of the first instance under appeal and moreover cannot have been considered at all in relation to document set D11 in the opposition proceedings since document set D11 was not in those proceedings.

4. A document relied upon by an opponent for the first time during the appeal stage, which is sufficiently relevant to be admitted into the opposition proceedings, can in the exercise of the Board's discretion under Article 111(1) EPC occasion a remittal back to the first instance, in particular so as to allow the cases of the parties in relation to the newly cited document to be examined at two levels of jurisdiction and thus not to deprive the parties of one such level of jurisdiction. This action is appropriate in the present case, since as indicated in point 2 above, the newly cited document set D11 is of such relevance.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

P. Martorana

E. Turrini