

Public prior use - Still a Gordian knot in opposition proceedings

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This past week I had an interesting hearing at the EPO where an opposition was based, inter alia, on public prior use.

The opposition division heard a number of witnesses on the question whether the features of a specific device had been publicly available. Prior to the hearing, the opponent had to admit that there actually had been a written confidentiality agreement between the manufacturer and the purchaser of the machine who then used it in his plant. Furthermore, he admitted that plant where the machine was erected had been secured by a fence and a security service against intruders. However, the opponent contended that third parties occasionally did have access to the plant and the devices inside the plant, be it as a visitor or as subcontractors of the owner.

The witnesses basically confirmed these allegations, however only on a very general, unspecific level. They could not name any particular person or group of persons who would have had access to the device, and who could have identified the specific features of the claimed invention. Furthermore, the witnesses were not able to testify on the relationship between the owner of the plant and the visitors, or the subcontractors respectively. They could, in particular, not confirm the opponent's allegation that those visitors and subcontractors were not obliged to confidentiality when they were allegedly shown around. The owner of the plant himself was not called as a witness since the opponent preferred to submit only an affidavit of this owner, which could not have been less specific on the questions at issue. Furthermore, the opponent failed to submit an important exhibit to the confidentiality contract which listed part of the know-how that was subject to confidentiality. He claimed that the information in this exhibit itself was confidential and could therefore not be disclosed in the course of the proceedings.

In the end the EPO held that the opponent had not met the requirements for demonstrating the public availability of the invention as claimed. The EPO took particular interest in the fact that the written confidentiality agreement had not been submitted in full. Furthermore, the very general and unspecific manner in which the witnesses reported from visiting groups and subcontractors that they had allegedly seen on the premises clearly worked against the opponent. The witnesses were eventually not able to testify, which specific person or group had access to which features on which date and under which circumstances.

I was happy to see that, on the occasion of this case, the threshold for establishing public prior use was not lowered compared to earlier case law. The allegation of public prior use would be very tricky to counter for the patent owner if there were no clear prerequisites for a substantiated presentation of facts by the opponent. Only with a high threshold for the burden of proof one can prevent that patents are revoked on the basis of made-up stories or mere speculation.

Last but not least I want to mention that the questioning of the witnesses by the legal member of the opposition division was performed on an extremely skilled level. It was good to see that the EPO has personnel that is specifically trained for these purposes.

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