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**Datasheet for the decision
of 13 May 2009**

Case Number: T 0556/07 - 3.2.07

Application Number: 98941921.3

Publication Number: 1003612

IPC: B05B 7/22

Language of the proceedings: EN

Title of invention:

Twin wire electric arc metalizing device

Patentee:

International Metalizing Corporation

Opponent:

Sulzer Metco OSU GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 56, 113(1), 114(2)
RPBA Art. 13(1)

Relevant legal provisions (EPC 1973):

-

Keyword:

"Admittance of late filed fact (no)"
"Inventive step (no)"

Decisions cited:

-

Catchword:

See points 1.5 to 1.7.



Case Number: T 0556/07 - 3.2.07

D E C I S I O N
of the Technical Board of Appeal 3.2.07
of 13 May 2009

Appellant: International Metalizing Corporation
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NJ 08003 (US)

Representative: Assendelft, Jacobus H.W.
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Respondent: Sulzer Metco OSU GmbH
(Opponent) Weseler Strasse 1
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Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 January 2007
revoking European patent No. 1003612 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: H. Meinders
Members: H.-P. Felgenhauer
E. Dufrasne

Summary of Facts and Submissions

- I. This appeal is against the decision of the opposition division revoking European patent No. 1 003 612.
- II. The appellant (proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or, auxiliarily the patent be maintained in amended form based on the sets of claims 1 to 5 according to the first or the second auxiliary request, filed with the statement setting out the grounds of appeal dated 14 May 2007.

With respect to the first and second auxiliary request the appellant further requested remittal of the case.

The respondent (opponent) requested the appeal to be dismissed.

- III. After the parties had been summoned to oral proceedings for 31 March 2009 the appellant withdrew its auxiliary request for oral proceedings with fax dated 25 March 2009, stating it would not attend them.

Upon cancellation of the oral proceedings with communication of the board (sent by fax on 26 March 2009) the appellant requested with the return fax dated 26 March 2009 a time limit of one month to file further observations.

With communication (sent by fax on 30 March 2009) the parties have been informed that this request of the appellant cannot be allowed.

With fax dated 31 March 2009 the appellant filed final observations with respect to the disclosure of documents D7 and D8.

IV. Claim 1 of the patent in suit according to the main request (maintenance with the claims as granted) reads as follows:

"An electric arc metalizing apparatus comprising a housing unit (1); a wire drive means (5), means for attaching at least two spools of wire (2) within said housing unit (1) such that the wire (10), can be led through said wire drive means (5), a spray gun (31) spatially movable with respect to said housing (1) and connected to said housing (1) by supply cables to supply wire, electrical energy and pressurized gas thereto; connecting means (13) for a source of electrical energy and connecting means (12) for a source of pressurized gas; said wire drive means (5) having at least one drive roller (27) advancing said wire (10) to said spray gun, characterised by said drive roller (27) having a knurled surface engaging the wire (10) and adapted to avoid slippage thereof and removing contaminations like corrosion layers therefrom.".

Claim 1 according to the first auxiliary request reads as follows:

"An electric arc metalizing apparatus comprising a housing unit (1); a wire drive means (5), means for attaching at least two spools of wire (2) within said housing unit (1) such that the wire (10), can be led through said wire drive means (5), a spray gun (31)

spatially movable with respect to said housing (1) and connected to said housing (1) by supply cables to supply wire, electrical energy and pressurized gas thereto; connecting means (13) for a source of electrical energy and connecting means (12) for a source of pressurized gas; said wire drive means (5) having at least one drive roller (27) advancing said wire (10) to said spray gun, characterised by said drive roller (27) having a knurled surface engaging the wire (10) and adapted to avoid slippage thereof and removing contaminations like corrosion layers therefrom, and wherein the housing unit (1) has an access panel (3) opening towards the side, at least partly closing the top side of the housing (1) as well and hingedly connected to the region of the bottom of said housing (1) and closing against flanges of rigid parts of the housing (1).".

Claim 1 according to the second auxiliary request reads as follows:

"An electric arc metalizing apparatus comprising a housing unit (1); a wire drive means (5), means for attaching at least two spools of wire (2) within said housing unit (1) such that the wire (10), can be led through said wire drive means (5), a spray gun (31) spatially movable with respect to said housing (1) and connected to said housing (1) by supply cables to supply wire, electrical energy and pressurized gas thereto; connecting means (13) for a source of electrical energy and connecting means (12) for a source of pressurized gas; said wire drive means (5) having at least one drive roller (27) advancing said wire (10) to said spray gun, characterised by said

drive roller (27) having a knurled surface engaging the wire (10) and adapted to avoid slippage thereof and removing contaminations like corrosion layers therefrom, and wherein the housing unit (1) has an access panel (3) opening towards the side, at least partly closing the top side of the housing (1) as well and hingedly connected to the region of the bottom of said housing (1) and closing against flanges of rigid parts of the housing (1), which flanges run along the top and side edges of the front and back panel and are directed inwards of the housing unit."

V. The following documents, on which the impugned decision is based, are considered in the present decision

D1: US-A-4 720 044 and

concerning an alleged public prior use U2

D6 Detailed view of an electric arc metallizing apparatus type KL with two cleaning/lubrication devices, model 1963

D7 Invoice No. 24168 dated 13.06.95 of OSU Maschinenbau GmbH, Castrop-Rauxel (DE) for two electric arc metallizing apparatuses type G20/2-LD/U2E, article no. 1369908, delivered to Westermann KG Mannheim Kondensatoren (DE)

D8 Spare parts list of OSU Maschinenbau GmbH, type LD/Corr, valid since 01.01.1988 including a drawing of the wire drive means, type LD/Corr

D9 Delivery document of transport company DEURAPID
DANZAS GmbH

D10 Bank Statement of Sparkasse Castrop-Rauxel dated
29.06.95.

Document

D17 Instruction manual concerning SULZER METCO 4R ARC
SPRAY SYSTEM contents, pages 6-1 to 6-4 and 9-6,
9-7, Copyright 1995

has been filed by the respondent with letter dated
26 February 2009.

VI. According to the impugned decision concerning the
alleged public prior use U2, documents D7 - D10 have
been considered as proof for an electric arc
metallizing apparatus of the type G20/2-LD/U2 E having
been unconditionally sold by the opponent to Westermann
KG, this apparatus being provided with wire drive means
of the type LD/Corr having drive rollers with a knurled
surface.

Furthermore, according to the impugned decision, claim
1 according to the main request does not involve an
inventive step starting from document D1 (erroneously
referred to as Do) as closest prior art, and
considering the public prior use U2 as further prior
art. According to the decision this applies likewise
with respect to the claims 1 according to the then
first and second auxiliary request, these requests
being identical to the present first and second
auxiliary requests.

VII. The facts, evidence and arguments essentially relied upon by the appellant can, as far as they are relevant to the present decision, be summarised as follows:

- (a) Concerning the alleged public prior use U2 it is disputed that documents D7 and D8 can be considered as proof for the alleged subject-matter having been made available to the public prior to the priority date.
- (b) Concerning the alleged public prior use a relationship between the invoice according to document D7 and the spare parts list according to D8 has not been proven. Likewise the true contents of documents D7 and D8 and the time and manner of their disclosure are not certain, considering also that documents D6 - D8 are private documents of the opponent.
- (c) Documents D6 - D8 should thus not be allowed into the proceedings, which applies likewise with respect to the late filed documents D9 and D10.
- (d) Even if the alleged public prior use U2 is considered as prior art and the provision of a knurled surface on the drive roller is considered as being obvious to avoid slippage of the wire, the person skilled in the art still would not be led to provide a knurled surface adapted to remove contaminations on the wire like corrosion layers. In this respect it needs to be considered that documents D7 and D8 are silent about the material of the knurled surface. Thus it would be highly

speculative to consider that it is made of a hard metal, which would be required for the knurled surface to be able to remove corrosion layers.

- (e) For the first and second auxiliary requests remittal to the first instance is requested since the opposition division jumped to conclusions. These were based on arguments only presented at the oral proceedings which the appellant did not attend, thus it had had no opportunity to present its opinion and no fair chance to defend its patent, although it had requested to continue the proceedings in writing.
- (f) The assessment of inventive step for the claims 1 of the first and second auxiliary request is wrong, as the panel in the apparatus of D1 is not one opening to the side, but to the front or back, nor does D1 mention anything of closing the access panel against flanges on the housing. The ingress of contamination is avoided by supplying pressurized air to the inside of the apparatus, i.e. different from the invention. The same applies to claim 1 of the second auxiliary request presenting further features of the arrangement of the flanges.

VIII. The facts, evidence and arguments essentially relied upon by the respondent can, as far as they are relevant to the present decision, be summarised as follows:

- (a) Concerning the public prior use U2 further documents D11 - D16 have been submitted since the appellant contests the public prior use according to documents D7 - D10. Furthermore in this respect

taking of evidence by hearing of a witness is offered.

- (b) The disclosure of the patent in suit is insufficient with respect to the feature of claim 1 of all requests claiming that the drive roller has a knurled surface engaging the wire and adapted to avoid slippage thereof and to remove contaminations like corrosion layers therefrom.

- (c) The subject-matter of claim 1 according to the main request differs from the apparatus according to D1, which is considered as constituting the closest prior art, only in that the drive roller has a knurled surface. Provision of a drive roller with a knurled surface is, however, known from the public prior use as evidenced by documents D7, D9 and D10. To improve the apparatus according to D1 with respect to the manner in which the wire is fed, it is obvious for the skilled person to simply utilize the approach adopted in the apparatus of the public prior use U2, namely to replace the drive roller by one having a knurled surface. The effects defined in the claims 1 according to all requests for such a knurled surface, namely to avoid slippage of the wire and to remove contaminations like corrosion layers therefrom, are directly obtained by employing such knurled surfaces. This particularly holds true taking into consideration that neither in the claims of the patent in suit nor in its description a specific knurled surface is referred to in connection with the effects defined for that surface in the claims 1 of all requests.

- (d) The features which the claims 1 according to the first and the second auxiliary requests have in addition to claim 1 according to the main request do not lead to a synergistic effect in combination with the knurled surface of the drive roller, as they relate to the housing.

- (e) Starting from the apparatus according to D1 it is normal design practice for the person skilled in the art to provide an access panel and flanges as defined by the additional features of claims 1 according to the first and the second auxiliary request. This holds true even more considering the apparatus according to D17.

IX. In the annex to the summons for oral proceedings dated 23 December 2008 the board gave its preliminary opinion that no reason for the remittal of the case was apparent, nor that the opposition division's consideration of the alleged prior use U2 as having been proven was flawed and that its examination of inventive step appeared to be correct.

Reasons for the decision

1. *Procedural matters*

1.1 The appellant withdrew its request for oral proceedings with fax dated 25 March 2009, i.e. five days before the date on which the oral proceedings were to be held (31 March 2009).

1.2 In response thereto the board informed the parties with fax dated 26 March 2009, that the oral proceedings were cancelled.

1.3 With return fax dated 26 March 2009 the appellant requested a further time limit of one month for filing observations to respond to the preliminary opinion given in the annex to the summons to oral proceedings dated 23 December 2008.

The board gave, with fax dated 30 March 2009, its opinion that the request could not be allowed since the time limit set in the annex to the summons had expired and indicated that a decision in this case would be issued shortly.

1.4 With a further fax dated 31 March 2009 the appellant filed, what it called, "final observations" stating therein as a new fact that documents D7 and D8 are silent about the material of the knurled surface of the drive roller.

Based on this new fact it is argued that it would be speculative to consider the knurled surface of the drive roller according to D7, D8 to be of hard material, as it is required for this surface to have the effect of removal of corrosion layers. The knurled surface according to documents D7, D8 could even be plastic or rubber, since by using knurled surfaces of such materials slippage can already be avoided.

Consequently, according to these observations, the corrosion layer removing effect of the knurled surface is not disclosed in these documents.

Furthermore the appellant argued that all other documents introduced in support of the teaching of documents D7 and D8 did not add any information concerning the material of the knurled surface. It requested, in case the board was of the opinion that these documents added to the disclosure of documents D7 and D8, remittal of the case to the first instance.

- 1.5 The new fact has been late filed, such that the board has to exercise its discretionary power according to Article 114(2) EPC and Article 13(1) RPBA concerning its admittance.

Since, as shown in the following, this new fact cannot be admitted since it lacks *prima facie* relevance with respect to the examination of inventive step, it need not be decided whether this submission amounts, under the circumstances of the present case, to an abuse of procedure, which would normally have the effect that such submissions are disregarded for that reason alone. Indeed the appellant has neither responded to the submissions of the respondent nor to the preliminary opinion given by the board in its annex to the summons. The appellant only indicated, just before the date set for oral proceedings, that it would not attend and filed these "final" observations only after the oral proceedings had been cancelled.

- 1.6 The new fact concerns the last feature of claim 1 according to the main request, which is also contained in the claims 1 according to the first and the second auxiliary requests.

According to this feature said drive roller has

- (a) a knurled surface engaging the wire and
- (b) adapted to avoid slippage thereof and
- (c) to remove contaminations like corrosion layers therefrom.

The material of the knurled surface is neither defined in claim 1 nor in the remainder of the patent in suit.

This is in line with what is disclosed in the patent in suit, in which it is stated "Knurled drive wheels insure that an improper arc will not develop from e.g. wire slippage or a corrosion layer on the wire." (page 3, lines 34, 35), "The knurled drive wheels remove contaminations like corrosion layers as well, ..." (page 2, lines 46, 47) and "The indent of the drive rollers 27 are knurled for e.g. improved grip." (page 4, lines 30, 31), attributing the two effects b) and c) of the drive roller solely to its knurled surface.

Thus according to the definition of claim 1 and the description of the patent in suit the effects b) and c) obtained with the drive roller have to be considered as being the mere result of the knurled surface of the drive roller engaging the wire, irrespective of e.g. the type of knurling or the material of the knurled surface.

In connection with the appellant's argument that the invention involved a non-obvious "special" knurled surface (see grounds of appeal, page 2, last paragraph) the board had already indicated in the annex to the summons: "With respect to the argument of the appellant that the **knurled surface of the drive roller** according

to claim 1 is a **special** - and thus a not obvious - **one**, at present it appears that claim 1 does not comprise a feature defining a particular type of knurling; cf. also the arguments of the respondent (letter dated 26 September 2007, paragraph 3.1).".

Since, as can be derived from the above, the same reasoning applies with respect to the newly submitted fact, this fact cannot be considered as being *prima facie* more relevant than the facts referred to in the grounds of appeal. Consequently it is not admitted.

For completeness sake the board wishes to add that even if admitted, it would not have affected the outcome of the present proceedings as the same reasons given above concerning its lack of *prima facie* relevance also apply to its cogency.

- 1.7 The request for remittal, as far as it is based on the consideration of the late filed observations of the appellant, cannot be allowed for the same reasons either.

As far as the request for remittal made in the grounds of appeal is concerned (see point VIII e)) which the board interprets as being based on a violation of the right to be heard (Article 113(1) EPC), the board had already stated in the annex to the summons that the proceedings before the opposition division did in no way appear to be tainted by a violation of this right (points 7.3 - 7.7). In particular the withdrawal by the appellant of its request for oral proceedings, with its further request for continuation of the opposition proceedings in writing could have no effect in a case

where the oral proceedings were apparently considered expedient, i.e. held at the instance of the opposition division. By voluntarily staying absent of these oral proceedings the appellant deprived itself also of the opportunity to comment on any arguments presented at those proceedings. As the appellant has not submitted anything further in support of its request, the above opinion of the board still applies, with the result that this request for remittal is also refused.

- 1.8 Concerning the announcement of the respondent made in its letter dated 24 February 2009 that at the oral proceedings before the board a witness would be available for giving evidence on the prior use U2, the board in its communication dated 2 March 2009 indicated with reference to the annex to the summons to oral proceedings, that, in case it applied, it needed to be decided whether a taking of evidence should take place and if so, before the board - possibly in a further oral proceedings - or after remittal before the opposition division.

Since, as can be derived from the following, the board agrees to the finding of the opposition division concerning the alleged public prior use U2 as being proven on the basis of the evidence D6 - D10 presented in the opposition proceedings, there is no need for further evidence to be taken into account in this respect.

2. *Sufficiency of disclosure*

According to the decision under appeal the patent in suit discloses the invention sufficiently clear and complete. The board is, contrary to the view of the respondent, of the opinion that the conclusion arrived at by the opposition division is correct. In view of the fact that the claims 1 according to all requests lack inventive step as will be established in the following this issue need not further be dealt with.

3. *Inventive step - claim 1 according to the main request*

Besides the late filed fact submitted with fax dated 31 March 2009, which, as outlined above, is not admitted, the appellant has not filed any submissions in response to the board's annex to the summons. Thus there is no reason for the board to change its opinion as expressed in that annex in that the impugned decision was correct in its assessment of the prior use U2 as having taken place as argued by the respondent, on the basis of the evidence as filed in the opposition proceedings (cf. point 8) and in its resulting assessment of inventive step on the basis of D1 and the prior use U2 (cf. point 10).

As a consequence, the subject-matter of claim 1 of the main request cannot be considered as involving an inventive step (Article 56 EPC).

4. *Inventive step - claim 1 according to the first and second auxiliary request*

4.1 Concerning the examination of inventive step with regard to the claims 1 according to the first and second auxiliary request the Board indicated in the annex to the summons (cf. point 11) that it appeared to be necessary to examine at first which features could be considered as further distinguishing features over D1 and which effects these features had in combination with the remaining features of claim 1 in question.

4.2 According to the impugned decision Do (correctly: D1) discloses the additional features of the panel and flanges of claim 1 according to the first auxiliary request, such that the subject-matter of claim 1 does not involve an inventive step. The appellant considers these features not to be derivable as claimed from D1 (see point VII f)), the respondent considers them as normal design practice in view of D1 as well as D17 (cf. point VIII e)).

The board is of the opinion that the provision of an access panel has the effect to allow easy access to the spools (patent in suit, page 3, lines 10, 11) and that the flanges provide further protection against the ingress of contaminations (patent, page 3, lines 14 - 16). These features clearly have no synergistic effect with the knurled surface of the drive roller, as also argued by the respondent, thus they can be discussed independently for inventive step.

Considering also the arguments of the respondent, the board is unable to see the conclusion of the opposition division regarding inventive step as being incorrect.

The housing of the apparatus of D1 has flanges against which the access panel closes, and the panel closing the top side of the housing, opening to the front or rear (side) and being hingedly connected to the front panel. According to necessity the skilled person will, as a normal design measure, place the hinge more in the region of the bottom of the housing. The argument of the appellant thus cannot be followed by the board.

4.3 The argument of the appellant that the front panel and the flanges shown in D1 have not the effect of keeping contamination out of the interior of the housing as this is done with an over-pressure inside, cannot help either, as this functional feature is not present in the claims 1 of the first, nor of the second auxiliary request.

4.4 Claim 1 according to the second auxiliary request comprises the additional feature of the flanges running along the top and side edges of the front and back panel and being directed inwards of the housing unit.

In this respect it is stated in the impugned decision that Do (correctly: D1) shows in figures 1 and 2 that the housing has flanges that run along the top and side edges of the front and back panel and are directed inwards of the housing.

Again, also in view of the respondent's arguments, the Board cannot see this assessment and the conclusion

drawn therefrom that the subject-matter of claim 1 of this request is not based on inventive step to be wrong, taking into account the inward flanges shown in figure 2 for the top and sides of the rear panel 70 and the inward side flanges shown on the front panel. Where necessary the skilled person will provide the necessary strengthening of the front panel at the hinge by a flange along its top side, analogous to the flange on the panel shown in D17, figure 6.1, as a routine measure.

- 4.5 For the above reasons, known to the appellant at the latest with the respondent's submission of 26 February 2009 in reply to the Board's annex to the summons, to which no further submissions have been filed in due time, the subject-matter of the claims 1 of the first and the second auxiliary request do not present inventive step (Article 56 EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders