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**Datasheet for the decision
of 2 December 2021**

Case Number: T 1137/18 - 3.2.06

Application Number: 11161131.5

Publication Number: 2377979

IPC: D04B9/40

Language of the proceedings: EN

Title of invention:

Apparatus and method for transferring loops from the knitting machine needle

Patent Proprietor:

Da Kong Enterprise Co., Ltd.

Opponent:

LONATI S.P.A.

Headword:

Relevant legal provisions:

EPC Art. 100(a), 100(b), 100(c), 18, 19

EPC R. 99(2), 100(2)

RPBA Art. 12(2), 12(4)

RPBA 2020 Art. 13(2)

Keyword:

Sufficiency of disclosure - main request (yes) - enabling disclosure (yes)

Statement of grounds of appeal - reasons set out clearly and concisely (no)

Amendment after summons - exceptional circumstances (no)

Decisions cited:

G 0001/84

Catchword:



Beschwerdekammern

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Case Number: T 1137/18 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 2 December 2021

Appellant:

(Opponent)

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(Patent Proprietor)

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 23 February
2018 rejecting the opposition filed against
European patent No. 2377979 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman M. Harrison
Members: P. Cipriano
A. Jimenez

Summary of Facts and Submissions

- I. An appeal was filed by the appellant (opponent) against the decision of the opposition division rejecting the opposition to European patent No. 2 377 979. It requested that the decision under appeal be set aside and the patent be revoked.
- II. With its reply, the respondent (patent proprietor) requested that the appeal be dismissed or, in the alternative, that the patent be maintained according to one of auxiliary requests 1 to 5 (first to fifth auxiliary requests) filed therewith.
- III. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the invention as defined in claims 1 and 10 was considered to be disclosed in the contested patent in a manner sufficiently clear and complete for it to be carried out by the skilled person. In addition, the Board stated that in its grounds of appeal no arguments had been given by the appellant as to why the reasoning of the opposition division should be incorrect in regard to the objections made under Articles 100(c) and 100(a) EPC and, as such, the Board had been presented with no reason why the opposition division's analysis and conclusions concerning these grounds of opposition should be incorrect. The Board also invited the appellant (see item 4.1 of its communication) to file any possible objections regarding the auxiliary requests by 2 November 2021.
- IV. With letter dated 2 November 2021 the appellant filed further submissions regarding the grounds for

opposition under Article 100(a), (b) and (c) EPC in addition to its comments regarding the auxiliary requests filed at the invitation of the Board.

V. The following documents, referred to by the parties, are relevant to the present decision:

D1 US 2001/0039816 A1
D5 US 5 487 281
D6 US 5 586 453
D18 WO 2009/112347 A1
D19 US 2 402 200

VI. Oral proceedings were held before the Board on 2 December 2021, during which the respondent withdrew its auxiliary requests.

The final requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested solely that the appeal be dismissed.

VII. Claim 1 of the respondent's request (patent as granted) reads as follows:

"A device comprising a knitting machine and a transfer apparatus (100) for transferring a stocking (4) from the knitting machine to a stitching apparatus to close an open-end of the stocking (4), the knitting machine including a needle (3) extending vertically and axially and having a hook (3b) for forming a loop (41) at the open-end of the stocking (4), and a latch (3a) that is pivotal upward and downward to move to or away from the hook (3b), said transfer apparatus (100) comprising:

a strip member (2) extending horizontally and movable axially upward and downward and radially towards and away from the needle (3), said strip member (2) being capable of contacting the loop (41) on the needle (3) to push the loop (41) toward or away from the hook (3b) of the needle (3); and

a transfer member (1) disposed horizontally above said strip member (2) and movable axially upward and downward and radially toward and away from the needle (3), said transfer member (1) including a tip region (112) for receiving the loop (41) from the hook (3b) of the needle (3) when said strip member (2) pushes the loop (41) to the hook (3b),

wherein said transfer apparatus is configured to:

move said strip member (2) towards the needle (3) to contact the loop (41) on the needle (3) from above and to slide downward the loop (41) from the hook (3b) of the needle (3) until the loop (41) passes the latch (3a);

move said strip member (2) away from the needle (3) after the loop (41) has passed the latch (3a) of the needle (3);

move said strip member (2) toward the needle (3) once again to contact the loop (41) from below and to slide the loop (41) upward and toward the hook (3b);

move said transfer member (1) until said transfer member (1) reaches the hook (3b) and until the hook (3b) extends into said tip region (112); and

further move said strip member (2) upward to push and transfer the loop (41) from the hook (3b) to the transfer member (1)."

Claim 10 reads as follows:

"A method for transferring an open-end of a stocking (4) from a knitting machine to a stitching apparatus by means of a transfer apparatus comprising a strip member (2) and a transfer member (1) disposed horizontally above said strip member (2), the knitting machine including a needle (3), which extends vertically and axially and which has a hook (3b) to form a loop (41) at the open-end of the stocking (4), and a latch (3a) that is pivotal upward and downward to move to or away from the hook (3b), the method comprising:

moving the strip member (2) towards the needle (3) to contact the loop (41) on the needle (3) from above and to slide downward the loop (41) from the hook (3b) of the needle (3) until the loop (41) passes the latch (3a);

moving the strip member (2) away from the needle (3) after the loop (41) has passed the latch (3a) of the needle (3);

moving the strip member (2) toward the needle (3) once again to contact the loop (41) from below and to slide the loop (41) upward and toward the hook (3b);

moving the transfer member (1) disposed above the strip member (2) until the transfer member (1) reaches the hook (3b) and until the hook (3b) extends into a tip region (112) of the transfer member (1); and

moving the strip member (2) further upward to push and transfer the loop (41) from the hook (3b) to the transfer member (1),

wherein each of the strip and transfer members (2, 1) extends radially and horizontally, and is movable axially upward and downward and radially toward and away from the needle (3)."

VIII. The appellant's arguments relevant to the present decision may be summarised as follows:

Main request - Article 100(b) EPC

The patent failed to provide a detailed description of at least one clear and complete way of carrying out the invention.

The description of the patent did not explain how an open-end stocking could be obtained by way of a knitting machine including only one needle and how a stocking could be transferred if a loop was transferred from only one needle to the transfer apparatus, which also comprises a single transfer member and a single strip member.

In addition, the application did not provide a detailed, clear, enabling description of at least one example of a device comprising both a knitting machine and a transfer device, be it with one, two, or more needles, strip and transfer members.

The skilled person should be able to put the invention into practice without undue burden and without having to infer possible constructions of the device. The patent as a whole did not disclose a way to actuate the needles, transfer members and strip members in the way claimed.

It was clear that the language of claim 1 of the patent was not limited to circular knitting machines only. Neither did the patent contain, in addition to the examples, sufficient information to allow the person skilled in the art, using common general knowledge, to perform the invention over the whole scope claimed, including when the knitting machine was a linear

knitting machine, without undue burden and without needing inventive skill.

Admittance of the case put forward under Articles 100(a) and 100(c) EPC

The case put forward for the grounds under Article 100(a) and 100(c) EPC was substantiated as required by Article 12(2) RPBA 2007.

The sections of the grounds of appeal concerning Article 100(a) and 100(c) EPC were not a copy of the presentation before the opposition division. Reference had been made to the corresponding paragraphs of the decision.

The opposition division did not deal with the core of the arguments of the appellant in a convincing way such that the appellant still believed that the grounds put forward during opposition were solid, valid and justified the revocation of the patent. The first examiner in the examination proceedings was the same in the opposition proceedings and had contradicting views, i.e. the examiner stated that all the necessary technical features to carry out the invention were known to the skilled person but argued the contrary when it came to considering novelty and inventive step. If the submissions under Article 100(a) and 100(c) EPC were not taken into account under Article 12(2) RPBA 2007, the appellant's right to be heard would be "overruled".

Should the objections made in the grounds of appeal concerning the grounds under Article 100(a) and 100(c) EPC not be taken into account, the fact that the examiner changed his opinion between the examination

and opposition proceedings and the fact that the opposition division had disregarded the core of the arguments of the appellant constituted exceptional circumstances under Article 13(2) RPBA 2020 that justified the amendment to the appeal case made with the appellant's submission dated 2 December 2021.

IX. The respondent's arguments relevant to the present decision may be summarised as follows:

Article 100(b) EPC

Claims 1 and 10 did not define a single needle, a single transfer member and a single strip member but rather the necessary relationship between a single group formed of a needle, a transfer and a strip member, with this relationship being independent of the number of such groups in the device, i.e. this did not mean that the device does not have further needles, transfer members and strip members.

The patent and the skilled person's general knowledge in the art allowed the skilled person to carry out the movements required by claim 1.

The terms "vertically", "axially" and "radially" should be read as defining the orientation of the needle with respect to the knitting machine. The use of the term "radially" implied a radial direction that did not exist in linear knitting machines and which were therefore excluded by the wording of claim 1.

*Admittance of the case put forward under Articles
100(a) and 100(c) EPC*

With regard to the grounds of lack of novelty and inventive step, the appellant's statement of grounds was substantially identical to the corresponding passages of the notice of opposition and the written submissions dated 30 November 2017 filed in preparation for the oral proceedings.

The only reference to the impugned decision was the subtitle "With reference to paragraph 4 of the Decision of the Opposition Division".

Contrary to Article 12(2) RPBA 2007 the appellant's grounds of appeal thus did not indicate the reasons for setting aside the decision impugned with respect to the ground for opposition under Article 100(a) EPC, as it did not deal with the specific reasons given by the opposition division in a detailed manner at point 4 which covered 8 pages.

Similarly, the appellant's grounds of appeal did not indicate the reasons for setting aside the decision impugned with respect to the ground for opposition under Article 100(c) EPC, as it did not deal with the specific reasons given by the opposition division in a detailed manner at point 3, which covered 5 pages.

The respondent was thus not in a position to give a meaningful response why the decision of the opposition division should be maintained, since the appellant had not indicated the reasons why it should be set aside.

The appellant's submission dated 2 November 2021 regarding Articles 100(a) and (c) EPC constituted an

amendment to the appeal case that included new objections, facts and arguments that should not be taken into account under Article 13(2) RPBA 2020.

Reasons for the Decision

1. Main request - Article 100(b) EPC

1.1 The appellant argued that claim 1 encompassed devices with a single needle, a single strip member and a single transfer member. On the other hand, the description only disclosed a way of carrying out the invention in which a device had a plurality of needles, strip members and transfer members. According to the appellant, the patent therefore did not explain how an open-end stocking could be obtained by way of a knitting machine including only one needle and how a stocking could be transferred if a loop was transferred from only one needle to the transfer apparatus comprising also a single transfer member and a single strip member.

The Board does not find these arguments persuasive. Claim 1 defines a knitting machine "including a needle", "a strip member" and "a transfer member" but this does not limit the number of needles, strip members and transfer members that the machine can have. The claim defines a specific coordinated motion to transfer a loop through the relationship between a needle, a strip member and a transfer member, which are the components necessary to define the invention.

However, the skilled person knows that, in the same way as when forming knitted loops of a stocking, more than

one needle is required, transferring an open end of a stocking requires more than one strip member and one transfer member and that such an embodiment (despite theoretically falling within the scope of the claim) would not make technical sense.

- 1.2 The appellant also argued that the patent as a whole did not disclose a way to actuate the needles, transfer members and strip members in the way claimed, stating instead that they seemed to "float on air". According to the appellant, the patent was silent on any structure, be it related or not, or actuated or not, by elements of the knitting machine and/or transfer apparatus, that supported and could actuate bearings or a cam mechanism (for example of Figure 43), separately or in cooperation, to carry out the movements defined in claim 1. The devices disclosed in D1, D5, D6 and D18 also did not disclose the required structures as their respective needles and transfer mechanisms did not move in the specific way defined in claim 1.

The Board does not accept this argument either and finds that the necessary knowledge to actuate the needles, strip members and transfer members to perform the coordinated motions in axial and radial direction defined in the claims is common general knowledge in the electromechanical field, which would certainly not extend beyond that required to make knitting and transfer apparatuses in the prior art. Whilst it is true that the mechanisms in D1, D5, D6 and D18 do not perform exactly the same motions as in claim 1 or claim 10, these do however show examples of kinematic controls that the skilled person could easily adapt in order to carry out the specific coordinated motion defined in claims 1 and 10 without undue burden. The fact that the knitting machine and the transfer

apparatus both constitute a single device also does not pose problems to the skilled person whose common general knowledge is sufficient to make a knitting machine and a transfer apparatus interact adequately regardless of whether they are made as a single or as cooperating devices. This knowledge does not need to be explicitly repeated in the patent in order for the skilled person to carry out the invention without undue burden. Moreover, apart from merely alleging that the patent did not contain the required details, the appellant was not able to explain which particular knowledge the skilled person would lack. In this regard it is important to note that the claimed invention does not require any particular configurations, any particular speeds or anything else beyond the basic set of movements of the various parts of the device which have to be performed such that the skilled person is free to use whichever means are most appropriate to perform the various movements, noting that each movement is described and shown in detail in the patent. The movements and the positional relationship of the parts can be ascertained simply by following the sequential movements depicted therein.

- 1.3 The appellant further argued that claims 1 and 10 did not exclude a linear knitting machine and that the claim was not restricted to a circular knitting machine referred to in the description at paragraph [0017]. Any vertical needle, even of a linear knitting machine such as the one shown in D19, could move "axially" along its vertical extension, and any strip and transfer member could move "radially towards and away from the needle" as long as it moved "horizontally" (perpendicular) on the vertical extension of a needle and approached it from a (any) surrounding direction that would be radial with respect to the needle, since the needle was a

central axis towards which the strip and transfer member could converge from various "radial" directions.

The Board does not accept this argument. Whilst claims 1 and 10 do not explicitly define circular knitting machines, they define a strip and a transfer member extending horizontally (horizontally *and* radially in claim 10), both movable axially upward and downward and radially towards and away from the needle.

Contrary to the argument of the appellant, the terms "horizontally" and "axially" in claims 1 and 10 are therefore not interchangeable, since, for example, both qualify the extension of the strips and transfer members in claim 10. In fact, the appellant's argument just ignores the wording of the claim and instead equates the terminology "radially towards and away from the needle" with the same terminology where the word "radially" is removed, so as to end up with simply "towards and away from the needle".

Further, paragraph [0017] of the patent states that the invention is applicable to circular knitting machines. Whilst this may indeed not be limiting for the claim, it is also noted that nothing in the description indicates that linear machines should be encompassed. The appellant's reference to page 9, lines 4 to 8 of the application as filed in this regard does not assist the appellant further as this paragraph was amended before grant to exclude linear knitting machines, not least as such would have been incompatible with the wording of the claims.

The definition of an axial direction and a radial direction towards the needles (in addition to an horizontal direction) thus implies that the needles

cannot be arranged linearly but necessarily in a circular (radial) arrangement. A linear knitting machine is therefore excluded by the wording of claims 1 and 10. Claims 1 and 10 certainly do not require the invention to be carried out on a linear knitting machine, nor does the patent as a whole imply that the invention of claims 1 or 10 covers such.

- 1.4 At least for the reasons stated above, the ground for opposition under Article 100(b) EPC does not prejudice maintenance of the patent as granted.

2. Admittance of the case put forward under Articles 100(a) and 100(c) EPC
 - 2.1 With regard to the ground of opposition under Article 100(a) EPC together with the objections of lack of either novelty or inventive step, the appellant's statement of grounds is almost identical to the corresponding passages of the notice of opposition (regarding D1) and the written submissions dated 30 November 2017 (regarding D18) filed in preparation for the oral proceedings before the opposition division.

 - 2.2 The only reference to the impugned decision in the grounds of appeal in this regard was the subtitle "With reference to paragraph 4 of the Decision of the Opposition Division". Whilst the passages in the grounds of appeal were not an exact copy, the addition of this reference in the grounds of appeal alone cannot be considered as concrete reasons for setting aside the decision impugned with respect to the ground for opposition under Article 100(a) EPC, as it does not deal with the specific reasons given by the opposition division in a detailed manner at point 4, spanning over 8 pages.

2.3 The appellant argued that the opposition division did not deal with the core of the arguments of the appellant in a convincing way such that the appellant still believed that the grounds put forward during opposition were both solid and valid, and justified revocation of the patent. According to the appellant, the first examiner in the examination proceedings was the same as in the opposition proceedings but changed his opinion when discussing the matter with the party under the issue of Article 100(b) EPC, where the examiner stated that all the necessary technical features were known to the skilled person but arguing the contrary when it came to novelty and inventive step. If the submissions under Article 100(a) and 100(c) EPC were not taken into account under Article 12(2) RPBA 2007, the right to be heard of the appellant would be thus allegedly overruled.

2.3.1 The Board does not accept these arguments. The opposition division dealt with the arguments of the opponent, dividing these in each of the three grounds under the paragraphs labeled A, B and C and dealing with them under a, b and c, respectively (see for example items (B) and (b) on pages 9 and 10 of the decision). The fact that the appellant was not convinced by the reasoning in the decision of the opposition division does not justify that the latter be ignored. As stipulated under Rule 99(2) EPC, "in the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned". In the present case, the Board finds that this was not achieved by simply repeating the same arguments put forward during the opposition proceedings. This is also established case law of the Boards.

- 2.3.2 The Board is additionally not convinced that keeping the same first examiner in the opposition proceedings as was in the examination proceedings results in a reason not to consider the reasoning of the opposition division. Both the decisions in examination and opposition proceedings (under Article 97 and 101 EPC, respectively) are collective decisions, taken by divisions of at least three members formed according to Articles 18 and 19 EPC such that any argument relating to the personal opinion of one member, which is anyway impossible for the public to know, would be irrelevant.
- 2.3.3 Article 19(2) EPC requires that at least two members of the examining division be replaced, and that the first examiner of the examining division cannot become the chairman of the opposition division. Even if this does not prevent the same examiner from carrying out the primary task of examining in both examination and opposition proceedings, the replacement of two members ensures that the decision of the opposition division is not pre-empted by any previous decision coming from the examination proceedings. Further, the opposition proceedings is a separate *inter partes* proceedings that allows interested parties to present arguments contesting the validity of a patent and is not to be seen as a continuation or extension of the examination procedure (see G 1/84, Reasons 9) such that a change of opinion of a member which has taken part in both proceedings is to be considered a reasonable outcome.

The Board also does not find a contradiction in the fact that the first examiner (on behalf of the opposition division) stated that all the necessary technical features to carry out the invention were known to the skilled person but however found the

claimed subject-matter novel and inventive. As discussed above in item 1.2, the necessary knowledge to actuate the needles, strip members and transfer members to perform the coordinated motions in axial and radial direction defined in the claims is common general knowledge. This does not present a contradiction to the decision of the opposition division that a specific set of particular movements as defined in claims 1 and 10 might be novel or involve an inventive step.

2.3.4 The Board also cannot discern how the right to be heard of the appellant as defined under Article 113 EPC could have been "overruled" since the appellant manifestly had ample opportunity during the opposition proceedings and appeal proceedings to present its comments concerning the requests of the respondent which remained as rejecting the opposition (its main request) and dismissing the appeal, i.e. during both proceedings. The appellant was also extensively heard during the oral proceedings on the issue of compliance with the requirement of Article 12(2) RPBA 2007 of the objections under Article 100(a) and 100(c) EPC.

2.4 Thus, the Board did not take into account the arguments on Article 100(c) EPC submitted by the appellant in the statement of grounds of appeal since these arguments did not meet the requirements under Article 12(2) RPBA 2007 (as stipulated in Article 12(4) RPBA 2007).

2.5 With its letter dated 2 November 2021 the appellant filed further submissions regarding the objections under Articles 100(a) and 100(c) EPC in addition to the comments regarding the auxiliary requests filed in reply to the Board's invitation.

2.6 According to Article 13(2) RPBA 2020, "[a]ny amendment to a party's appeal case made after the expiry of a period specified by the Board in a communication under Rule 100, paragraph 2, EPC or, where such a communication is not issued, after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned".

2.7 The appellant's reply to the communication from the Board is dated 2 November 2021 and thus within the period specified by the Board in item 4.1 of its communication. However, item 4.1 mentioned specifically the objections regarding the auxiliary requests, such that the Board does not find that its communication corresponds to a communication under Rule 100(2) EPC for the objections regarding the main request. Thus, the objections under Article 100(a) and 100(c) EPC regarding the main request were filed after the notification of a summons for oral proceedings was issued and constitute an amendment to the appellant's appeal case for which Article 13(2) RPBA 2020 applies.

2.8 The appellant argued that the opposition division had disregarded core arguments made by the appellant but the Board finds that this does not constitute exceptional circumstances under Article 13(2) RPBA 2020.

On the contrary, the Board finds that the appellant has not brought forward a single example of a specific argument that the opposition division might have overlooked in its reasoning and, even if this had been the case, this would not have been detrimental to the presentation of the appellant's complete case with its

grounds of appeal and constitute exceptional circumstances that would justify the filing of new facts at a late stage of the appeal proceedings.

- 2.9 The objections under Article 100(a) and 100(c) EPC regarding the main request made by the appellant with its letter dated 2 November 2021 are thus not taken into account (Article 13(2) RPBA 2020).
3. In summary, the appellant has not brought forward any admissible objections regarding the grounds for opposition under Article 100(a) and 100(c) EPC and the ground for opposition under Article 100(b) EPC does not prejudice maintenance of the patent as granted.

The appeal must therefore be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated