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**Datasheet for the decision  
of 19 January 2022**

**Case Number:** T 1188/18 - 3.2.01

**Application Number:** 07843052.7

**Publication Number:** 2081724

**IPC:** B23K9/10

**Language of the proceedings:** EN

**Title of invention:**

METHOD AND APPARATUS FOR WIRELESS REMOTE CONTROL COMMUNICATION  
OF A WELDER

**Patent Proprietor:**

Illinois Tool Works Inc.

**Opponent:**

Fronius International GmbH

**Headword:**

**Relevant legal provisions:**

EPC Art. 52(1), 54, 56, 123(2)  
RPBA 2020 Art. 13(2)

**Keyword:**

Novelty - main request (no) - auxiliary request (yes)

Inventive step - auxiliary request (yes)

Amendments - extension beyond the content of the application  
as filed (no)

Amendment after summons - exceptional circumstances (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 1188/18 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 19 January 2022**

**Appellant:** Illinois Tool Works Inc.  
(Patent Proprietor) 155 Harlem Avenue  
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**Representative:** HGF  
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**Respondent:** Fronius International GmbH  
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**Representative:** SONN Patentanwälte OG  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 12 March 2018  
revoking European patent No. 2081724 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** V. Vinci  
S. Fernández de Córdoba

## **Summary of Facts and Submissions**

- I. The appeal filed by the appellant (patent proprietor) is directed against the decision of the opposition division to revoke the European patent No. EP 2 081 724.

In its decision the opposition division held that the subject-matter of claim 1 as granted complied with the provisions of Article 123(2) EPC, but that the ground for opposition under Article 100(a) in combination with Article 54 EPC was prejudicial to the maintenance of the patent as granted. Furthermore, the opposition division found that the subject-matter of claim 1 according to the auxiliary request 1 did not meet the novelty requirements set forth in Articles 52(1) and 54 EPC and that the subject-matter of claim 1 of the auxiliary requests 2 to 5 did not involve an inventive step in the meaning of Articles 52(1) and 56 EPC. Novelty and inventive step of the main request and of auxiliary requests were assessed in view of the following state of the art:

E5 : EP 0895 826 A2

E6 : DE 20 2006 009 014 U1

E9 : US 6,103,994 A

- II. With a communication under Article 15(1) RPBA dated 09 April 2020, the Board informed the parties of its preliminary, non binding assessment of the appeals, the text of said communication reading as follows:

*"1. To assist the parties in preparing oral proceedings, attention is drawn to the following preliminary and non-binding opinion of the Board as set*

out herein below.

**REQUESTS**

2. The Patent Proprietor (Appellant) requests that the decision of the opposition division be set aside and that the European patent be maintained as granted (main request), or as auxiliary measure, according to one of the auxiliary requests 1 to 5 underlying the decision under appeal.

2.1 The Opponent (Respondent) requests that the appeal be dismissed.

3. In this communication the numbering of the cited documents and the labelling of the features of independent claim 1 (features 1.1 to 1.8) adopted in the decision under appeal are adhered to.

3.1 The following points will be discussed at the oral proceedings. In this respect, the attention of the parties is drawn to the following preliminary conclusions.

**MAIN REQUEST**

Article 123(2) EPC

4. The Board concurs with the opposition division that the omission of the following expression included in the original claim 6 "to store the wireless control" in claim 1 as granted (based on claim 1 as filed in which, among others, features from original claims 6 and 7 have been introduced) does not result in an unallowable generalisation which is contrary to Article 123(2) EPC.

4.1 The arguments of the Opponent cannot be followed because, as correctly stated by the opposition division, the statement of claim 1 as granted "the wireless control panel (50) is configured as a removable front panel transceiver configured to connect and detach from the docking port" implicitly defines the functionality of the docking port to store the wireless control. It follows that no unallowable generalisation arises as no essential information is missing with respect to the combination of the originally filed claims on which claim 1 as granted is based.

#### Novelty

5. The Patent Proprietor contests the assessment of the controversial features 1.3, 1.4 and 1.6 of claim 1 as granted by the opposition division, that concluded that these features are all disclosed in E5 in combination with the other features of the claim.

#### Feature 1.3

5.1 The Board concurs with the opposition division and with the Opponent that the features 1.3 in the present formulation "a plurality of dedicated weld parameter selectors configured to control welding parameters of a specific welding-type" does not imply the limitation that each selector controls just one and well defined welding parameter. What is claimed is simply that certain relevant welding parameters are assigned to the selectors. The argument of the Patent Proprietor that since E5 is silent as to the use of the selectors they could have been provided to adjust "anything" and hence not necessarily welding parameters, is not convincing. In fact, the person skilled in the art, in view of the

fact that the selectors of E5 are associated with the control panel of a welding system, would directly and unambiguously derive that these selectors are provided in order to control parameters which are somehow related to the welding process to be carried out, namely parameters falling within the very broad definition "welding parameters of a specific welding-type" used in claim 1 as granted.

Feature 1.4

5.2 The Patent Proprietor argues that since the feature 1.4 implies the feature 1.3 this feature is not disclosed in E5 either. However, as the Board considers the feature 1.3 to be disclosed in E5 (see point 5.1 above), this argument is void.

Feature 1.6

5.3 In this respect, the Board shares the interpretation given by the opposition division of paragraphs [0014] and [0015] of E5. In fact, according to an embodiment disclosed therein, 2 sets of cooperating contacts are provided on both the removable control panel (5) and the power source (housing 1) (see paragraph [0014], column 3, lines 39-47 and paragraph [0015], "zusätzlich Kontakte für ein Nachladen des Energiespeisen ..."), whereby the second set is used for charging the battery of the removable control panel. Although the Patent Proprietor is correct in asserting that E5 does not explicitly disclose the purpose of the first set of contacts, the Board concurs with the opposition division and with the Opponent that the person skilled in the art would implicitly derive that this second set of contacts is used for transmitting the control signals when the the control

panel is secured to the housing 1. Firstly, in view of the technical content of claim 1, no different use for said first set of contacts is imaginable. Furthermore, the interpretation of the opposition division and of the Opponent is supported by the passage on column 3, lines 47-50 of E5 teaching that when the removable control panel is secured to the power source (housing (1)) the wireless transmission is deactivated. From this information it can be directly and unambiguously deduced that, in this configuration, the wireless transmission is deactivated and not longer required because the transmission of the welding control signals between the control panel and the power source of the welding system is taken over by said first set of cooperating contacts while the second set of contacts provides for the recharging of the battery of the control panel.

5.4 In view of the above, the Board does not preliminarily see any reason for deviating from the conclusion of the opposition division in the decision under appeal that the subject-matter claim 1 of the main request is not novel (Articles 52(1) and 54 EPC) at least with respect to E5.

5.5 The main request thus appears to be not allowable.

#### **AUXILIARY REQUESTS**

6. The Board notes that the auxiliary requests 1 to 5 correspond to the auxiliary requests 1 to 5 underlying the decision under appeal.

#### **Auxiliary request 1**



Novelty

6.1 In claim 1 of this request the partial feature of claim 6 as filed which was omitted in claim 1 of the main request (see point 4. above) has been reintroduced. As correctly pointed out by the opposition division and explained above, this amendment does not further limit the scope of the protection afforded by the independent claim 1 with respect to claim 1 of the main request. The Patent Proprietor defends this request only by referring to the arguments put forward with respect to the main request in order to overcome the objection of lack of novelty raised by the opposition division. Therefore, the same conclusions with the same arguments presented with respect to the main request apply (see 5. to 5.4 above). It follows that claim 1 of the auxiliary request 1 is not novel either (Article 52(1) and 54 EPC).

**Auxiliary Request 2**

Novelty

6.2 Claim 1 is based on a combination of claims 1 and 5 of the main request and thus of the patent as granted.

6.3 The Board concurs with the opposition division and with the Patent Proprietor that the added features (in the following labelled 1.7) that:

"the plurality of welding parameters includes current, voltage, inductance and pulse commands"

clearly states that all 4 mentioned welding parameters are assigned to and regulated by the controller. As

neither E5 nor the other cited documents discloses this feature in combination with the remaining features of claim 1 of the auxiliary request 2, the subject-matter of claim 1 is novel in the meaning of Articles 52(1) and 54 EPC, as correctly concluded by the opposition division. The Board notes that novelty of the auxiliary request 2 is not objected by the Opponent in the reply to the statement of the grounds of appeal of the Patent Proprietor.

#### Inventive Step

6.4 The Board observes that there is agreement on the choice of E5 as the document representing the closest prior art. The Patent Proprietor contests the definition of the technical problem given by the opposition division and argues that the technical problem has to be seen in modifying the known welding system in order to efficiently control the whole welding parameters from a remote location. The Board cannot agree with the Patent Proprietor because the technical problem mentioned above is already solved by the system of E5. The Board is rather of the opinion that the definition of the objective technical problem provided by the opposition division, namely the selection of suitable welding parameters to be assigned to the control panel, is the correct one.

6.5 In the light of this objective technical problem, the Board does not see any reason why the person skilled in the art, seeking for suitable welding control parameters, would be discouraged from assigning the parameters suggested in E9 to the weld parameter selectors of the control panel of E5. The arguments of Patent Proprietor that the person skilled in the art would not be motivated to increase the limited number

*of functions provided on the control panel of E5 and to assign the 4 welding parameters now defined in claim 1 to respective dedicated selectors is not convincing because no inventive step would be required for adapting the remote control to the required number of parameters to be controlled.*

*6.6 It follows that the Board shares the conclusion of the opposition division that the subject-matter of claim 1 of the auxiliary request 2 does not meet the requirements of Article 52(1) and 56 EPC in respect of inventive step.*

### **Auxiliary Request 3**

*6.7 This auxiliary request is a combination of the auxiliary request 1 and 2 and therefore, the subject-matter of claim 1 is novel, what is not in discussion.*

#### **Inventive Step**

*The Board concurs with the decision of the opposition division that claim 1 does not meet the requirements of Article 52(1) and 56 EPC for the same reasons raised with respect to the auxiliary request 2. The Patent Proprietor has defended the auxiliary request 3 only by generally referring to the arguments presented with respect to the auxiliary requests 1 and 2, whereby these arguments are not convincing for the reasons indicated above.*

### **Auxiliary Request 4**

*6.8 This request corresponds to the auxiliary request 2, whereby the features of dependent claim 3 (in the following labelled 1.8) have been introduced in claim 1*

and dependent claim 2 has been deleted. Novelty is not contested.

Inventive Step

6.9 The Patent Proprietor contests the choice of the opposition division in the decision under appeal to consider E9 as the closest prior art.

6.10 Regardless of this controversial issue, the Board cannot share the conclusion of the opposition division that starting from E9 and in view of E6 it would be obvious to arrive to the welding system of claim 1.

6.11 The Board agrees with the view of the Patent Proprietor that the skilled person, reading the claim in the light of its technical context which does have an electronic character (transmission of control signals), would understand the term "docking port" in the meaning indicated by the Oxford English Dictionary cited by the Patent Proprietor, namely "a point at which signals enter or leave a data-transmission system" and not in the more general and "mechanical" meaning indicated by the opposition division, namely an opening. This interpretation is confirmed by the wording of claim 1 "to connect to and detach from the docking port for controlling welding operation when secured to the power source and wirelessly when removed from the power source" which implicitly requires that an electrical connection between the control panel and the power source must be provided in order to transmit the control signals when the control panel is secured to (or docked in) the power source. The interpretation of the opposition division is not convincing because it disregards the technical context in which the claim will be read by a person skilled in the art.

*Furthermore, the opposition division relies on a artificial interpretation of the expression "to connect to and detach from" used in claim 1, said expression being compared to the alternative expression "to connect to and disconnect from". In this respect, the Board considers the use of the term "connect" as an indication that an electrical contact take place, whereby the term "detach" used in claim 1 (instead of "disconnect") does not necessary exclude that an electrical contact is provided, as instead asserted by the opposition division.*

*6.12 In view of the above, even by assuming that document E9 would disclose the feature 1.8 (what is questionable) and that it would be obvious for a person skilled in the art to combine E9 with E6, this combination will not result in the combination of features of claim 1 of the auxiliary request 4 because the features relating to the docking port with the functionality according to features 1.6 of the claim would still be missing.*

*6.13 The arguments of the Opponent are restricted to a discussion of the technical content of different prior art documents (E3, E7 and E9) in order to prove that it is well known in the state of the art to provide a welding system with dedicated selectors for selecting different welding methods and the associated welding parameters. Neither a clear indication of which document should represent the closest prior art nor a structurate, logic chain of reasoning why the person skilled in the art starting from a selected closet prior art would arrive without inventive step to the subject-matter of claim 1 is provided. For this reasons the arguments of the Opponent are not convincing.*

6.14 The Board observes that the opposition division, in the decision under appeal, also concluded that the subject-matter of claim 1 of the auxiliary request 4 does involve an inventive step with respect to the combination of E5 + E9 and of E9 + E5, and that the opponent did not contest these conclusions.

6.15 Under these circumstances and contrary to the conclusion of the opposition division in the appealed decision, the Board expresses the preliminary opinion that the subject-matter of claim 1 of the auxiliary request 4 involves an inventive step in the meaning of Articles 52(1) and 56 EPC.

Therefore, the auxiliary request 4 appears to be allowable.

#### **PRELIMINARY CONCLUSIONS**

7. The review of the decision under appeal and the assessment of the parties' submissions have led the Board to the conclusion that the auxiliary request 4 meets the requirements of the EPC.

7.1 However it is again emphasized that this is a preliminary assessment that is intended merely as guidance to the parties and is made without prejudice of the board final decision.

#### **FURTHER PROCEDURE**

8. The issues presented in this communication will be discussed with the parties at the oral proceedings.

8.1 The Board draws the attention of the parties to the

*fact that the admission of new submissions, such as further requests, facts and evidence, is subject to the provisions of Art. 13 RPBA 2020 and is therefore at the discretion of the Board."*

III. Oral proceedings pursuant to Article 116 EPC were held before the Board on 19 January 2022 by videoconference with the consent of the parties.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the European patent be maintained as granted (main request), or as auxiliary measure, that the patent be maintained in amended form according to one of the auxiliary requests 1 to 5 underlying the decision under appeal.

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

IV. Independent claim 1 as granted according to the main request reads as follows (labelling of the features according to decision under appeal):

1.1 *"A welding-type system (10) comprising:*

1.2 *a power source (12) having a controller (13) to regulate welding operation;*

*and, a welding torch (16) connected to the power source (12);*

1.3 *a wireless control panel (50) having thereon a plurality of dedicated weld parameter selectors (64,66) configured to control welding parameters of a specific welding-type system,*

1.4 the wireless control panel (50) being configured to wirelessly couple to the welding-type system and to remotely transmit signals to control operation of the welding-type system responsive to adjustment of the dedicated weld parameter selectors (64,66),

1.5 wherein the controller (13) is configured to include a control transceiver to communicate with the wireless control panel (50) and receive the signals to allow the controller (13) to regulate at least one of the plurality of welding parameters in response thereto,

characterised in that

1.6 the welding-type system (10) comprises a docking port (38) located on the power source (12), and the wireless control panel (50) is configured as a removable front panel transceiver configured to connect to and detach from the docking port (38) for controlling welding operation when secured to the power source (12) and wirelessly when removed from the power source (12)."

Independent claim 1 according to the auxiliary request 1 corresponds to claim 1 as granted, wherein feature 1.6 has been modified as follows (amendment underlined):

1.6 "the welding-type system (10) comprises a docking port (38) located on the power source (12) to store the wireless control, and the wireless control panel (50) is configured as a removable front panel transceiver configured to connect to and detach from the docking port (38) for controlling welding operation both when



*secured to the power source (12) and wirelessly when removed from the power source (12)."*

Independent claim 1 according to the auxiliary request 2 corresponds to claim 1 as granted and includes the additional feature labelled 1.7 that:

*1.7 "the plurality of welding parameters includes current, voltage, inductance, and pulse commands."*

Independent claim 1 according to the auxiliary request 3 corresponds to claim 1 according to the auxiliary request 2 and includes the same amendment in feature 1.6 as claim 1 of the auxiliary request 1.

Independent claim 1 of the auxiliary request 4 corresponds to claim 1 according to the auxiliary request 2 and includes the further limitation labelled 1.8 that:

*1.8 "the wireless control panel (50) includes a process mode selector (60,62) and wherein the process mode selector (60,62) is configured to allow an operator to select a desired welding process, the desired welding process having operational set points associated therewith for at least one of the plurality of welding parameters."*

## Reasons for the Decision

### MAIN REQUEST: PATENT AS GRANTED

#### Article 123(2) EPC

1. The main request meets the requirements of Article 123(2) EPC as correctly stated by the opposition division in the decision under appeal.
- 1.1 At the oral proceedings the parties referred in this respect to their respective written submissions and did not add any further arguments in support of their view. The Board does not thus see any reason to deviate from the assessment provided under points 4. and 4.1 of its preliminary opinion (see above point I. of "*Facts and Submission*") which is thus hereby confirmed and also applies, with the same reasons, to all the auxiliary requests at stake.

#### Novelty: Articles 52(1) and 54 EPC

2. The subject-matter of independent claim 1 of the main request lacks novelty in view of document E5 in the meaning of Articles 52(1) and 54 EPC as correctly stated by the opposition division in the decision under appeal.
- 2.1 At the oral proceedings the parties referred also in this respect to their respective written submissions and did not add any further arguments in support of their view. The Board does not thus see any reason to deviate from the assessment provided under points 5. to 5.5 of its preliminary opinion which is hereby confirmed.

2.2 The main request is thus not allowable.

**AUXILIARY REQUESTS 1 to 3**

3. The subject-matter of independent claim 1 of the auxiliary request 1 lacks novelty in view of E5 in the meaning of Articles 52(1) and 54 EPC, and the subject-matter of claim 1 of the auxiliary requests 2 and 3 lacks inventive step in view of E5 and E9 in combination in the meaning of Articles 52(1) and 56 EPC as correctly stated by the opposition division in the decision under appeal.

4. At the oral proceedings the parties referred regarding the assessment of novelty or inventive step of the subject-matter of claim 1 of the auxiliary requests 1 to 3 to their respective written submissions and did not essentially add any further argument in support of their view. The Board does not thus see any reason to deviate from the assessment of these requests provided under points 6. to 6.7 of its preliminary opinion which is hereby confirmed.

4.1 The auxiliary requests 1 to 3 are thus not allowable.

**Auxiliary request 4**

5. Contrary to the assessment of the opposition division in the decision under appeal, the Board concludes that the subject-matter of claim 1 according to the auxiliary request 4 involves an inventive step over the prior art in the meaning of Articles 52(1) and 56 EPC.

Admissibility of the submissions of the respondent (opponent) dated 02 December 2021

- 5.1 Following the preliminary opinion provided by the Board with the communication under Article 15(1) RPBA, the respondent (opponent) submitted new arguments in support of their allegation that the subject-matter of claim 1 of the auxiliary request 4 did not involve an inventive step in view of the combination of document E5 with E9 and in reverse. At the oral proceedings the appellant (patent proprietor) requested to disregard these submissions under Article 13(2) RPBA version 2020 which indeed applies to the present case.
- 5.2 The respondent (opponent) argued that they did not have any reason to present these further submissions with their reply to the statement of the grounds of appeal of the appellant (patent proprietor) because the opposition division had already considered the subject-matter of claim 1 of the auxiliary request 4 obvious in view of the combination of E9 with E6, whereby only after receiving the preliminary opinion of the Board reversing the opposition division's assessment, it became apparent that these submissions were required in order to strengthen the respondent's position regarding the alleged lack of inventive step. Furthermore, it was observed that the combination E5 with E9 was already discussed both during the opposition proceedings in regards to the auxiliary request 4, and in the reply to the statement of the grounds of appeal of the appellant (patent proprietor) in regards to the auxiliary request 2.
- 5.3 The arguments presented by the respondent (opponent) in support of the admittance of the submissions filed on 02 December 2021 are not convincing for the following

reasons:

The Board firstly observes that the opposition division under points 6.3.1 and 6.4 of the decision under appeal stated that neither of the combination E5 with E9 or E9 with E5 rendered obvious the subject-matter of claim 1 of the auxiliary request 4 filed in the first instance which is identical with the auxiliary request 4 at stake. Therefore, the Board would have expected and considered it appropriate to contest this conclusion in the reply to the statement of the grounds of appeal of the appellant (patent proprietor). In fact the respondent (opponent) should have considered the possibility that the Board could have reversed the first instance negative assessment of inventive step of the subject-matter of claim 1 at stake in view of E9 in combination with E6 which was also contested by the appellant (patent proprietor) with the appeal (see page 3 and 4 of the statement of the grounds of appeal). Furthermore, the Board considers that a time interval of 20 months between the preliminary opinion of the Board and these further submissions of the respondent (opponent) is not justified even taking the COVID-19 pandemic restrictions alleged by the respondent (opponent) into account. Finally, the Board considers that the admittance of these new lines of attack and of the respective arguments in support thereof would open a fully new discussion at a very late stage of the appeal proceedings that is clearly detrimental to procedural economy.

5.4 In view of the above and as no exceptional circumstances justified by cogent reason legitimate in the Board's view the admittance of the submissions dated 02 December 2021, they are disregarded under Article 13(2) RPBA in the version 2020 which applies to

the present case.

5.5 In view of the above, inventiveness of the subject-matter of the claim 1 of the auxiliary request 4 is assessed in this decision only taking into consideration the combination of documents E9 and E6 and the arguments presented in this regard under point 6.5 of the decision under appeal, in the statement of the grounds of appeal of the appellant (patent proprietor), in the reply of the respondent (opponent) and at the oral proceedings.

5.6 The arguments submitted by the respondent (opponent) with the reply to the statement of the grounds of appeal of the appellant (patent proprietor) regarding the alleged lack of inventive step of the subject-matter of claim 1 of the auxiliary request 4 have been considered not convincing by the Board for the reasons given under point 6.13 of its preliminary opinion. This preliminary assessment was not contested at the oral proceedings by the respondent (opponent) which merely reiterated that, contrary to the view of the appellant (patent proprietor), feature 1.8 of claim 1 was directly and unambiguously disclosed in E9 and that the combination of this state of the art with document E6 rendered obvious the subject-matter of claim 1 at stake. Otherwise reference was made to the above mentioned written submissions.

5.7 Regardless of the disputed disclosure of feature 1.8 in document E9 and taking into account that no further arguments have been submitted by the respondent (appellant) in reaction to the preliminary opinion of the Board, in particular regarding the view that no docking port in the meaning implied by the technical context of claim 1 was disclosed in document E6, the

Board does not see any reason to deviate from the reasoning and the conclusion given under points 6.9 to 6.12 of its preliminary opinion, thereby confirming that, contrary to the assessment of the opposition division, the subject-matter of claim 1 of the auxiliary request 4 is not rendered obvious in the meaning of Articles 52(1) and 56 EPC by the combination of document E9 with document E6.

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent in the following version:
  - Claims 1 to 3 of auxiliary request 4 filed with the letter dated 24 December 2019;
  - Description: columns 1 to 4 and 7 to 9 of the patent specification; columns 5 and 6 as filed during the oral proceedings;
  - Figures 1 to 3 of the patent specification.

The Registrar:

The Chairman:



A. Voyé

G. Pricolo

Decision electronically authenticated