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**Datasheet for the decision
of 1 March 2022**

Case Number: T 2497/18 - 3.2.01

Application Number: 07809990.0

Publication Number: 2094426

IPC: B23K9/095, B23K9/10

Language of the proceedings: EN

Title of invention:
WELDING JOB SEQUENCER

Patent Proprietor:
Lincoln Global, Inc.

Opponent:
Fronius International GmbH

Headword:

Relevant legal provisions:
EPC Art. 113(1), 52(1), 56
RPBA Art. 12(4)
EPC R. 103(1)(a)

Keyword:

Right to be heard - proceedings before opposition division -
substantial procedural violation (no)

Inventive step - main request (no)

Late-filed facts - admitted (no) - request could have been
filed in first instance proceedings (yes)

Reimbursement of appeal fee - (no)

Decisions cited:

T 0936/19

Catchword:



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Case Number: T 2497/18 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 1 March 2022

Appellant: Lincoln Global, Inc.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 3 August 2018
revoking European patent No. 2094426 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: V. Vinci
O. Loizou

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 2 094 426.

In its decision the opposition division held, among others, that the ground for opposition under Article 100(a) EPC in combination with Article 56 EPC was prejudicial to the maintenance of the patent as granted. The opposition division referred to document:

D2: EP 1 078 707 81 B1

With a communication pursuant to Rule 100(2) EPC dated 17 November 2020 the Board informed the parties of its preliminary, non binding assessment of the appeal.

Oral proceedings pursuant to Article 116 EPC were held before the Board on 01 March 2022 by videoconference.

- II. The appellant (patent proprietor) requested that the decision under appeal be set aside, that the appeal fee be reimbursed and that the case be remitted to the first instance for continuation of the opposition proceedings. Furthermore the appellant requested that the patent be maintained as granted (main request) or alternatively that the patent be maintained in amended form on the basis of one of the auxiliary requests 1 to 5 filed with the statement of the grounds of appeal. The respondent (opponent) requested that the appeal be dismissed.

III. Claim 1 as granted reads as follows:

"A method of welding in a semi automatic work-cell, comprising automatically selecting welding schedules for use by an operator in the semi-automatic welding work cell, each welding schedule to be used for a particular welding operation, characterized by automatically selecting a sequence of welding operations for use by the operator in the semi-automatic welding work cell, and automatically indicating the selected sequence of welding operations to the operator in the semi-automatic welding work cell, the operator creating a final welded part upon following the indicated sequence of welding operations."

Reasons for the Decision

Alleged substantial procedural violation

1. The appellant (patent proprietor) asserted that the reasoning provided by the opposition division in the decision under appeal in support of the contested negative assessment of the inventive step of the subject-matter of claim 1 as granted was based on the assumption that a traditional welding process in which all the steps defined in claim 1 were carried out manually by an operator (rather than automatically) belonged to common general knowledge documented by paragraph [0003] of document D2. The appellant (patent proprietor) objected that said passage of document D2 was ever mentioned in the notice of opposition of the respondent (opponent) which only cited paragraph [0005] of D2 in a different technical context, namely the

automation of the selection of the welding sequence according to the orientation of the welding clamps (see page 25 of the notice of opposition). It was thus alleged that the inventive step attack on which the negative assessment of inventive step was based was raised "*ex officio*" by the opposition division and for the first time with the decision under appeal, whereby the appellant (patent proprietor) did not have any opportunity to comment on this new and decisive line of arguments before receiving the contested decision. The appellant (patent proprietor) concluded that under these circumstances the opposition proceedings were affected by a substantial violation of the appellant's right to be heard pursuant to Article 113(1) EPC justifying the requested remittal of the case to the first instance and the reimbursement of the appeal fee pursuant to Rule 103(1) (a) EPC.

- 1.1 Furthermore, the appellant (patent proprietor) argued that, contrary to the preliminary view of the Board, the reference to document D2 in the contested decision could not be considered as merely exemplary and thus somehow redundant, but rather mandatorily required in order to duly back-up the assessment of common general knowledge on which the whole reasoning of the opposition division was based. Moreover, the appellant (patent proprietor) contested the view of the respondent (opponent) that the traditional welding process referred to by the opposition division in the decision under appeal as representing common general knowledge was in fact the same as the one described on pages 20 and 21 of the notice of opposition.
- 1.2 The Board does not follow the view of the appellant (patent proprietor) for the following reasons:

The Board considers that the arguments provided by the opposition division in support of the finding of lack of inventive step of the subject-matter of claim 1 substantially corresponds to the arguments provided by the opponent (respondent) in this respect on pages 20 and 21 of the notice of opposition. In fact, as convincingly argued by the respondent (opponent) and contrary to the appellant (patent proprietor)'s view, the reference to paragraph [0003] of document D2 on page 5 of the decision under appeal is clearly presented by the opposition division as a mere example of a *"traditional welding process according to which a welder consults a list of welding schedules, selects the appropriate schedule and sets the welding device in accordance with the selected schedule"*. It follows that the exemplary reference to D2, as such, does not add any additional and decisive argument to the reasoning of the contested decision which would still stand even in absence of the reference to D2. In this respect the Board also concurs with the opponent (respondent) that the sequence of steps (a) to (d) identified on pages 20 and 21 of the notice of opposition as representing a traditional manual welding method, in the substance corresponds to the manual execution of all the steps of claim 1 as granted, and this in spite of the fact that according to the opposition letter these steps are executed by a supervisor and a welding machine operator while, according to the contested decision they are all possibly carried out by the operator only. Therefore the Board is convinced that the common general knowledge referred to by the opposition division in its decision was already put forward in the notice of opposition. In view of the above, as there is nothing in the decision under appeal going beyond the facts and arguments provided in the notice of opposition regarding lack of inventive step, the Board concludes

that all the reasons for revoking the opposed patent were known to the appellant (patent proprietor) long time before receiving the impugned decision. This rules out the alleged substantial procedural violation of the right to be heard.

1.3 During the appeal oral proceedings, the appellant (patent proprietor) argued for the first time that the decision of the opposition division not to grant an extension of the time limit set with the communication according to Rule 79(1) EPC "*de facto*" deprived the appellant (patent proprietor) of the opportunity to react to the notice of opposition and hence to defend the patent by filing suitable arguments and/or requests. In the appellant (patent proprietor)'s view this circumstance also amounted to a violation of the appellant's right to be heard in the meaning of Article 113(1) EPC.

1.4 Also this late filed argument, regardless of the question of its admissibility in the appeal proceedings, is void:

As correctly pointed out by the respondent (opponent), a decision of the opposition division not to grant an extension of the time limit previously set with the communication according to Rule 79(1) EPC by no way legally prevents the party concerned from filing observations and/or auxiliary requests also after expiry of the set time limit, whereby the admissibility of late filed submissions is subjected to the discretion of the opposition division which may decide notwithstanding the late filing to consider them. For example and in spite of the refusal of an extension of the time limit, a request for oral proceedings could have been filed at any time before the notification of

the contested decision. Therefore, also regarding this argument, the appellant (patent proprietor) was not deprived of their right to be heard. On the contrary they chose, as their prerogative, not to defend the patent in the first instance proceedings.

- 1.5 For the reasons given above the Board concludes that no substantial procedural violation amounting to a violation of the appellant (patent proprietor)'s right to be heard in the meaning of Article 113(1) EPC occurred during the opposition proceedings, whereby the request to remit the case to the first instance and to reimburse the appeal fee is not justified and hereby dismissed.

Main Request: Patent as granted

Inventive Step: Articles 52(1) and 56 EPC

2. The subject-matter of claim 1 as granted lacks inventive step in the meaning of Articles 52(1) and 56 EPC as correctly decided by the opposition division.
 - 2.1 The appellant (patent proprietor) contested for the first time during the oral proceedings before the Board the opponent's assertion on alleged common general knowledge (see pages 20 and 21 of the notice of opposition, in particular manual steps (a) to (d) described therein) which was taken up with a different wording by the opposition division in its inventive step attack as starting point for the method according to the contested patent, with the argument that such an alleged common general knowledge was not backed-up by any piece of evidence. It was additionally argued that neither the alleged common general knowledge mentioned by the respondent (opponent) on pages 20 and 21 of

notice of opposition nor paragraph [0003] of document D2 cited "*ex officio*" by the opposition division disclosed the step of manually selecting a welding schedule and of a welding operation sequence in combination with the step of indicating the selected sequence to the operator in the meaning of claim 1 as granted as asserted by the opposition division and by the respondent (opponent). The appellant (patent proprietor) also criticized that the opposition division, when coming to its conclusion, failed to duly consider that the step of automatically indicating the correct sequence of operations achieved indeed the relevant technical effect that a welding operator would simply have to follow through an automatically displayed sequence of operations, thereby minimizing the risk of erroneously mixing up or forgetting welding steps or schedule settings and achieving high-quality and reliable welding results. The appellant (patent proprietor) concluded that in view of this technical effect the subject-matter of claim 1 went beyond the mere and obvious automation of a known sequence of manual steps alleged by the opposition division and therefore was not rendered obvious by the available prior art.

2.2 The arguments submitted by the appellant (patent proprietor) regarding lack of inventive step are not convincing for the following reasons:

The Board is convinced that, in the present case, there was no need to provide any written evidence to substantiate the opposition division's assertion that it belongs to common general knowledge that, in order to manufacture a welded part, a person skilled in the art must first select the appropriate weld schedules from all welding schedules available on the machine,

than determine the correct welding operation sequence to be applied, and finally set the welding machine such that the welding sequence is performed. In this context it is irrelevant whether all these steps are carried out by a same person or by different persons, as they are anyway carried out manually. The Board notes that the appellant did not contest that this was common general knowledge during the opposition proceedings (as no reply was filed, see point 1. above) and that the allegation to the contrary made during the oral proceedings before the Board was completely unsubstantiated. In fact, the appellant failed to give any explanation in support of the allegation that the mentioned sequence of manual steps would be an unconventional one (e.g. by indicating other possible sequences of manual steps which would be conventional). In the present case it is not sufficient for the appellant to merely contest that the mentioned sequence of manual steps belongs to common general knowledge to shift the burden of proof to the respondent (opponent). In view of the triviality of the sequence of manual steps, the appellant (patent proprietor)'s allegation that the sequence of manual steps does not belong to common general knowledge is not plausible and as such requires substantiation. Furthermore, contrary to the view of the appellant (patent proprietor), the Board does not see any difference in substance between the manual execution of all the steps defined in claim 1 and the sequence of manual steps indicated by the respondent (opponent) on pages 20 and 21 of the notice of opposition as representing common general knowledge (see in particular steps (a) to (c)). Therefore, the Board concludes that the assessment of common general knowledge from which the opposition division developed its inventive step attack is correct and technically plausible even in absence of a specific support

document.

- 2.3 In view of the above the Board confirms the view of the opposition division that the method according to claim 1 as granted only differs from common general knowledge in that all the steps are executed automatically, whereby the mere automation of functions/activities previously performed by human beings is in line with general developing trend of technology and, as such, does not involve an inventive step over the prior art, and this regardless of the disputed question of whether any particular technical effect can be associated to the subject-matter of claim 1.

Auxiliary requests 1 to 5

Admissibility

3. The auxiliary requests 1 to 5 have been submitted for the first time with the statement of the grounds of appeal of the appellant (patent proprietor) without any explanation as to why they have not been filed during the opposition proceedings. The respondent (opponent) requested not to admit these auxiliary requests under Article 12(4) RPBA in the version 2007 which still applies to the present appeal.
- 3.1 For the first time at the oral proceedings the appellant (patent proprietor) justified the filing of the auxiliary requests 1 to 5 with the refusal of the opposition division to grant an extension of the time limit set with the communication according to Rule 79(1) EPC for filing observation in respect of the notice of opposition. In the appellant (patent proprietor)'s view this circumstance prevented the submission of any comments to the attacks presented

with the notice of opposition or auxiliary requests in the assumption that they would have not been considered anyway.

- 3.2 These justifications provided by the appellant (patent proprietor) are not convincing:

As explained under point 1.4 above and regardless of the question of the admissibility of this late filed argument, the refusal to grant an extension of the time limit set with the communication according to Rule 79(1) EPC did not preclude in any way the possibility of filing comments and/or requests in response to the notice of opposition at any time. In this context the Board notes that the appellant (patent proprietor) had a period of about 6 months between the refusal of the request for an extension of the time limit and the notification of the contested decision to react to the notice of opposition but decided not to do so.

- 3.3 Furthermore, the reasons for revocation of the patent at stake were known to the appellant (patent proprietor) well before the notification of the the contested decision, namely since the notification of the notice of opposition. Therefore, in accordance with the reasoning of decision T 936/19 which analogously applies to the present appeal as it deals with similar issues (see in particular points 2. to 16.), the Board exercises its discretion provided by Article 12(4) RPBA 2007 and decides not to admit the auxiliary requests 1 to 5 into the appeal proceedings because they could, and should, have been submitted during the first instance proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated