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D E C I S I O N
of 12 September 2001

Case Number: T 0638/01 - 3.5.2

Application Number: 86103508.7

Publication Number: 0388477

IPC: H03K 17/95

Language of the proceedings: EN

Title of invention:
Proximity switch

Patentee:
SQUARE D COMPANY

Former Opponents:
(01) Pepperl + Fuchs GmbH } both oppositions withdrawn
(02) ifm electronic GmbH } during the opposition procedure

Headword:
-

Relevant legal provisions:
EPC Art. 56, 109
EPC R. 67

Keyword:
"Inventive step - (yes)"
"Opposition division bound by decision of board of appeal in examination procedure - (no)"

Decisions cited:
T 0167/93

Catchword:
-

Case Number: T 0638/01 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 12 September 2001

Appellant: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 21 March 2001 revoking European patent No. 0 388 477 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: R. G. O'Connell
B. J. Schachenmann

Summary of Facts and Submissions

I. This is an appeal from the revocation by the opposition division of European patent No. 388 477 - following withdrawal of all oppositions - on the grounds that the subject-matter of the single claim as granted did not involve an inventive step, having regard to:

D1: GB-A-2 011 086

D2: US-A-3 829 962.

The patent had been granted by the examining division pursuant to the order of the present board - in a different composition - made in decision T 317/94 of 11 September 1995 in which the same prior art documents had been considered.

II. The single claim is worded as follows:

"1. A method of making a proximity switch including an induction coil (16), an oscillator (T1, T2) driving the coil, a detector circuit (T3, T4) and a resistor (R10) which is adjusted during manufacture to compensate for tolerances in the coil and other circuit components; characterised by the combination of:
forming said resister [sic](R10) as a resistive layer on a substrate (18);
abrading said layer to adjust said resistor until a desired sensitivity is obtained, said layer being abraded by air-borne abrasive particles blown from a nozzle; and holding the switch at a given distance from

a standard metal target (50) and connecting it to a control circuit (52), with the nozzle being moved automatically across the layer under the control of the control circuit until the proximity switch operates."

III. The appellant's submissions can be summarised as follows:

The evidence submitted by the opponents had been properly disregarded in the decision under appeal, which was explicitly based solely on D1 and D2. The reasoning of the opposition division was wrong for the reasons set out in T 317/94, which was based on essentially the same facts. The distinction on which the opposition division relied to come to a different conclusion, viz the additional arguments filed by the opponents in relation to the skilled person's appreciation of D1 and D2, did not amount to a difference in substance, since they were based on the kind of hindsight which T 317/94 had found unconvincing. A common principle between two systems can only be recognised by the skilled person once both systems exist. In the present case the conceptual similarity that the opposition division saw between the invention underlying the opposed patent and the prior art document D2 was something that was apparent only when the citation and the invention were seen side by side. This was the error of over-generalisation of the prior art teaching which had been explicitly criticised in T 317/94 at point 3.4.

The opponents' unsubstantiated allegations as to the extent to which the person skilled in the art of proximity switches would monitor developments in the field of telecommunication circuits, to which D2 pertained, were traversed by the evidence in the statutory declaration filed in the previous appeal proceedings.

IV. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted.

Reasons for the Decision

1. The appeal is admissible.

2. *Relevance of the earlier decision T 317/94*

2.1 This opposition appeal case has two unusual procedural features in that

(i) the patent was revoked following withdrawal of all oppositions so that there is no respondent in the appeal proceedings and

(ii) the single legal/factual issue on appeal is inventive step of claim 1 over D1 and D2, which was the issue decided in T 317/94 in the examination appeal procedure in favour of the applicant (now appellant proprietor).

2.2 Although the appellant submits that no new information has been presented that was not considered already by the board which decided T 317/94 and that accordingly the present board should come to the same conclusion as in the latter decision, the submission is not that the present board is bound as a matter of law to follow the earlier decision by virtue of the doctrine of *res* *judicata.* For the avoidance of doubt, the present board confirms that this is also its interpretation of the EPC, viz that a decision of a board of appeal on appeal from an examining division has no binding effect in subsequent opposition proceedings, or on appeal therefrom. This appears worth mentioning since the facts of the present appeal would not fall under the *ratio decidendi* of the landmark decision T 167/93 OJ EPO 1997, 229 on this question of law, which turned on the presence of a new and additional party (respondent) and a new claim; loc. cit. at 2.5, 2.6 and 2.12 (penultimate sentence).

2.3 Despite this non-binding character of T 317/94 as far as the present appeal is concerned, it appears expedient nonetheless in examining the appeal to test the cogency of the decision under appeal with reference to the reasoning of the latter decision, since, in effect, the opposition division has assumed the burden of demonstrating, explicitly or implicitly, that T 317/94 reached the wrong conclusion either by failing to take into account relevant facts or arguments, or otherwise. This method of examining the appeal is facilitated by the approach taken by the opposition division in the decision under appeal and the appellant in his statement of grounds of appeal.

3. *The opposition division's different view on inventive step*

3.1 Having regard to new facts and arguments adduced in the opposition proceedings, the opposition division arrived at a result opposite to that of T 317/94. According to points III, 3 and III, 5 of the decision under appeal these new facts and arguments were:

(i) The explanation of the relationship between the sensitivity of a proximity switch and the size and distance of an object to be detected.

(ii) The demonstration that a skilled person would adjust a proximity switch by holding a test target at the desired switching distance and increase or decrease the value of the variable resistor until the switching state changes.

(iii) The contention that the idea disclosed in D2 of controlling an adjustment process for an oscillator circuit by a control loop in which the control signal is the output signal of the circuit itself had not been recognised in T 317/94.

(iv) The allegation that the person skilled in the art of proximity switches would also be aware of any developments in production tools useful for the manufacturing of such switches.

3.2 As to (i) and (ii), the board is unable to understand why the opposition division regarded these as adding anything, given that they correspond closely to the contents of paragraph 14 of the statutory declaration referred to at points II and IV of T 317/94, and thus, as a matter of record, formed part of the technical background information on which the latter decision was based.

3.3 As to (iii), this is the kind of generalised expression of the specific teaching of D2, whereby the trimming of oscillator frequency in a touch tone oscillator for a telephone keypad in response to the measured frequency becomes "controlling an adjustment process for an oscillator circuit in which the control signal is the output signal of the circuit itself", which T 317/94 explicitly disapproved at point 3.4, last sentence, when dealing with the reasons for refusal given at points 7.2 to 7.5 of the decision (of the examining division) under appeal in that case. The contention (iii) is not supported by the facts, as is readily seen by the more careful formulation of the similar point in the decision of the examining division loc. cit. which distinguishes in successive paragraphs between the actual disclosure of D2 and the allegedly obvious generalisation of this disclosure. Hence contention (iii) is on a strict interpretation (ie an allegation of explicit disclosure) unfounded on the face of the document D2, and when interpreted as a telescoped or elliptical contention of implicit disclosure or obviousness it is not a new argument. The present board also judges this contention to be a generalisation based on a comparison with the solution of the present invention, ie an analogy inspired by hindsight.

3.4.1 As to (iv), as a general allegation of fact it is traversed by the statement in paragraph 5 of the statutory declaration referred to at 3.2 above and the present board does not see why it should be given more weight than the latter, given that it is unsubstantiated, although, as a positive allegation, it would have been eminently susceptible of substantiation by evidence.

3.4.2 Furthermore, as a premise for an argument alleging obviousness the allegation (iv) harbours a *petitio principii* in the word 'useful': it presupposes that the person skilled in the art of proximity switches would proleptically recognise the solution to his unformulated (!) problem in the relatively distant technical field of oscillators for telephone instruments. It thus fails to give due weight to the aspect of the transfer between the two fields which was emphasised in the preconclusory paragraph 3.6 of T 317/94, viz that it was necessary both to modify the proximity switch known from the closest prior art D1 and to modify the teaching of D2 in relation to tone generator frequency trimming to effect the transfer. Such a twofold 'consequential' adaption is easily made to appear obvious with the benefit of hindsight, when either of the two steps can be made to appear trivial when the other is taken for granted.

3.5 The view of the present board is that the opposition division has simply made a different judgement call on what were essentially the same facts, evidence and arguments which formed the basis of T 317/94. They were legally empowered to do this under the EPC but the reasons they adduced in their decision for so doing have not persuaded the board in its present composition.

4. In the view of the board the patent as granted and the invention to which it relates meet the requirements of the EPC.

5. *Other procedural considerations*

5.1 As noted at 2.1(i) above, both opponents withdrew their oppositions prior to the taking of the decision under appeal, so that the procedure, in particular the appeal procedure, has become, definitively, an *ex parte* procedure; cf Schulte, *Patentgesetz*, 6th edition, page 980, margin number 5. One consequence of this change of procedural category is that the appeal falls to be considered for interlocutory revision by the opposition division by virtue of the wording of Article 109(1) EPC, second sentence. This is provided for on internal EPO Form 2701, but, in the present case, the form was wrongly filled in and the appeal was consequently sent by the formalities officer acting for the opposition division directly to the EPO Boards of Appeal, bypassing the procedural step prescribed by Article 109(1) EPC, viz consideration for interlocutory revision.

5.2 Since the granting of interlocutory revision in an appropriate case is mandatory (loc. cit. page 979, margin number 2), it follows *a fortiori* that considering a case for interlocutory revision in circumstances where the latter is possible is itself a mandatory procedural step. Since, however, the legislative purpose of Article 109 EPC is overall procedural economy, it would not make sense for the board to remit the case to the department of first instance for performance of this omitted step. In the event the board has allowed the appeal almost within the three month period allowed for consideration of interlocutory revision. Neither does the question of reimbursement of the appeal fee under Rule 67 EPC arise, since this procedural irregularity occurred subsequent to the taking of the decision under appeal and had no bearing on the appellant's need to file the appeal.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is maintained unamended.

The Registrar: The Chairman:

M. Hörnell W. J. L. Wheeler