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**Datasheet for the decision  
of 14 November 2019**

**Case Number:** T 1447/15 - 3.5.03

**Application Number:** 01927551.0

**Publication Number:** 1290515

**IPC:** G05B19/4099

**Language of the proceedings:** EN

**Title of invention:**

METHOD FOR THE DESIGNING OF TOOLS

**Patent Proprietor:**

Autoform Engineering GmbH

**Opponents:**

DYNAmore Gesellschaft für FEM  
Ingenieurdienstleistungen mbH  
Bayerische Motoren Werke Aktiengesellschaft

**Headword:**

Method for designing an addendum/AUTOFORM

**Relevant legal provisions:**

EPC Art. 123(2), 123(3)

**Keyword:**

Added subject-matter (no)

Extension of protection (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**

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Case Number: T 1447/15 - 3.5.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.03**  
**of 14 November 2019**

**Appellant:** Autoform Engineering GmbH  
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**Representative:** IPrime Rentsch Kaelin AG  
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**Respondent:** DYNAmore Gesellschaft für FEM  
(Opponent 1) Ingenieurdienstleistungen mbH  
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**Representative:** Tönhardt, Marion  
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**Respondent:** Bayerische Motoren Werke Aktiengesellschaft  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 9 June 2015  
revoking European patent No. 1290515 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**            R. Winkelhofer  
**Members:**         T. Snell  
                         K. Schenkel

## **Summary of Facts and Submissions**

- I. This appeal was lodged by the proprietor against the decision of the opposition division revoking European patent No. EP 1 290 515. The decision was principally based on the ground for opposition pursuant to Article 100(c) EPC, in view of non-compliance with Article 123(2) EPC. Non-compliance with Article 123(3) EPC was invoked for certain auxiliary requests.
  
- II. Oppositions were originally filed by opponents OP1 and OP2, now respondents, based on the grounds for opposition pursuant to Articles 100(a), (b) and (c) EPC. Opponent OP1 comprised in fact joint opponents OP1-1 (DYNAmore Gesellschaft für FEM Ingenieurdienstleistungen mbH) and OP1-2 (Engineering Technology Associates, Inc). In the course of the opposition proceedings, OP1-2 declared its withdrawal from further participation therein ("Herewith it is declared that Engineering Technology Associates, Inc. will no longer participate in the opposition procedure ... so that DYNAmore Gesellschaft für FEM Ingenieurdienstleistungen mbH will act as a sole opponent"; see the submissions of 17 and 19 November 2014, further clarified by the submission of 24 November 2014 that "Engineering Technology Associates, Inc. has ceased to belong to the group of common opponents and is therefore no longer entitled to participate in the proceedings").
  
- III. The board gave a preliminary opinion on the case in a written communication. Oral proceedings were held on 14 November 2019, at which the appellant and respondent OP2 were represented.
  
- IV. The appellant (patent proprietor) requests as a main request that the decision under appeal be set aside and

that the patent be maintained in amended form in accordance with auxiliary request III submitted with the statement of grounds of appeal.

Alternatively, the appellant requests that the decision under appeal be set aside and that the patent be maintained as granted, i.e. that the oppositions be rejected.

Alternatively, the appellant requests that the decision under appeal be set aside and that the patent be maintained in amended form in accordance with one of auxiliary requests II and IV to X submitted with the statement of grounds of appeal.

Alternatively, the appellant requests that the decision under appeal be set aside and that the patent be maintained in amended form in accordance with one of auxiliary requests XI and XII submitted on 14 October 2019 in response to the board's preliminary opinion.

Respondent OP2 requests that the appeal be dismissed.

Respondent OP1 requests that the appeal be rejected as inadmissible, or, alternatively, that the appeal be dismissed.

V. Claim 1 of the main request (submitted as "auxiliary request III") reads as follows:

"Method for the creation of addendums (4) of tools for sheet metal formed parts (2) characterized in that initial directions (31) of sectional profiles (10) on the edge of a component (3,8) are determined by adapting the direction of the sectional profile to the

course of the component geometry, and adjusting said initial directions to avoid disadvantageous overlapping of sectional profiles, sectional profiles (10) having such initial directions (31) and being distanced from one another are arranged along the edge of the component (3,8), and that an addendum (4) is created by connecting the sectional profiles (10)."

### **Reasons for the Decision**

#### *1. Admissibility of the appeal*

1.1 Respondent OP1 argues that the appeal is inadmissible as it is not sufficiently substantiated. In this respect, there is said to be no mention of the right to priority in the statement of grounds of appeal, and only a cursory mention of novelty and inventive step.

1.2 However, since these matters were not considered or decided on in the impugned decision, there was no need for the appellant to address them in order to explain why the decision under appeal should be amended (cf. Article 12(2) of the Rules of Procedure of the Boards of Appeal). Furthermore, the appellant provides a reasoned case in the statement of grounds of appeal that a substantial procedural violation occurred, which would in itself be sufficient to substantiate an admissible appeal (NB: this allegation was later withdrawn).

1.3 The appeal is therefore admissible.

#### *2. Main request - claim 1 - Article 123(2) EPC*

- 2.1 The references below are to the description and drawings of the patent specification, since there is no difference with respect to the description and drawings as originally filed in respect of all the matters discussed here.
- 2.2 The essential test for compliance with Article 123(2) EPC is that an amendment must be directly and unambiguously derivable from the application documents as filed, taking into account matter implicit to a person skilled in the art. The essential point is that the skilled person may not be presented with new technical information as a result of the amendments.
- 2.3 The patent concerns the field of sheet metal forming, and in particular a method for designing an "addendum", which is an edge zone which abuts the component and which is designed to improve the sheet metal properties of the component after it is pressed out. The addendum is created from "sectional profiles" which start out from the component edge. As stated in the description, "The directions, in which the sectional profiles are applied away from the component edge ..., decisively determine the generated addendum surfaces" (cf. col. 2, lines 37-41 of the description).
- 2.4 The features of claim 1 at issue with respect to compliance with Article 123(2) EPC are the following:
- (a) initial directions (31) of sectional profiles (10) on the edge of a component (3,8) are determined by adapting the direction of the sectional profile to the course of the component geometry, and
  - (b) adjusting said initial directions to avoid disadvantageous overlapping of sectional profiles.



- 2.5 Respondent OP2 argues that there is no basis for feature (a) at all, and, in respect of feature (b), that the term "if necessary" [adjustments of the initial directions are possible ...] has been left out.

The board finds these objections to be unconvincing, for the following reasons.

- 2.6 Re (a): This very generally worded feature essentially expresses no more than that the initial directions of sectional profiles have some (but otherwise not precisely defined) relationship to the course of the component geometry. It is actually implicit to the skilled person that an addendum is a continuation of the component, so that sectional profile directions must generally be adapted to the course of the component geometry. That notwithstanding, in paragraph [0008] of the description, it is stated that the method involves first preparing the component geometry and, later, determining sectional profile directions. In paragraph [0010], it is stated that the method "makes it possible, starting out from the geometry of a component, to as rapidly as possible establish an ... addendum". Further, in accordance with claim 1 as filed, the directions to be determined are "initial directions". Finally, in paragraph [0013], it is stated that "The horizontal directions of the sectional profiles as a rule determine how a geometric detail of the component (feature), which extends to the edge of the component, affects the addendum" and "geometrical details in the component geometry and their branches in the addendum in essence have the same direction". The skilled reader would understand implicitly from these passages that the sectional profile initial directions of the addendum are generally adapted to the course of

the component geometry. This is further corroborated by all the specific examples given in paragraphs [0014] and [0037] - [0039] (cf. Figs. 5 and 10-12).

2.7 Re (b): In paragraph [0014] it is stated: "If necessary adjustments of the initial directions are possible, e.g. to avoid disadvantageous overlapping of sectional profiles in concave areas". The term "if necessary" here means that the feature is optional. A claim which comprises a feature described originally as optional does not present the skilled person with new information. Furthermore, although this statement is presented in this paragraph in connection with preferred ways of determining the initial directions (i.e. either they are determined in such a manner that they point in the direction of the minimum geometrical change in a defined, fictitious edge zone of the component, or in correlation with the flow-direction of the material), the skilled person would immediately understand, in view of its basic simplicity, that the concept of adjusting initial directions to avoid overlapping can be applied generally, and not just to one of these preferred options or only to avoid disadvantageous overlapping of sectional profiles in concave areas.

2.8 Claim 1 is therefore judged to comply with Article 123(2) EPC.

3. *Main request - claim 1 - Article 123(3) EPC*

3.1 The relevant feature of claim 1 as granted reads as follows:

"... initial directions (31) of sectional profiles (10) on the edge of a component (3, 8) are determined by

adapting the direction of the sectional profile to the course of the component geometry, avoiding overlapping of the sectional profiles ...".

3.2 The opposition division considered that claim 1 infringes Article 123(3) EPC because the alleged temporal order inherent in claim 1 as granted (which the board understands to mean that the determination of the initial directions and the avoidance of overlapping are required by claim 1 to be part of the same temporal step), is omitted and replaced by a sequence of two steps, thus shifting the scope of protection. Respondent OP2 agreed, and in this respect referred to the French and German translations of granted claim 1, which allegedly give support for interpreting claim 1 as forcibly defining a single phase ("zwingend gleichzeitig"). Respondent OP2 further argued that claim 1 now embraces embodiments which are not possible with claim 1 as granted.

3.3 However, these objections are unconvincing. Firstly, the French and German translations of claim 1 are not relevant since the text in the language of the proceedings determines the scope of protection (Article 70(1) EPC). Secondly, linguistically, claim 1 as granted does not require that the determining of the initial directions and the avoiding of overlapping are forcibly part of the same temporal phase. Furthermore, the skilled reader, when determining the scope of protection of claim 1 as granted, would conclude that the feature "adapting the direction of the sectional profile to the course of the component geometry, avoiding overlapping of the sectional profiles" must be construed broadly in the sense that, in the context of the disclosure as a whole, it includes directions which both conform exactly to the course of the component

geometry as well as those which differ somewhat therefrom (e.g. as a result of an adjustment). In this respect, interpreting "adapting" to mean "conforming exactly" would artificially restrict granted claim 1 to a very small number of embodiments in which it is possible to exactly follow the course of the component geometry and at the same time avoid overlapping (e.g. a straight edged component with initial directions at 90° to the edge). It follows that a two step process which starts out from initial directions adapted to the course of component geometry followed by adjustments to avoid overlapping is both embraced by, and narrower in scope, than claim 1 as granted.

Consequently, claim 1 complies with Article 123(3) EPC.

4. *Main request - Articles 83 and 84 EPC*

The board indicated in its preliminary opinion that it did not see any reason to object on the grounds of either Articles 83 or 84 EPC. The respondents did not contest the board's opinion. However, as issues with respect to compliance with Articles 83 and/or 84 EPC sometimes arise out of the discussion on novelty and/or inventive step, this matter is finally left to be decided by the opposition division.

5. *Remittal*

As claim 1 of the main request complies with Articles 123(2) and (3) EPC, the case is remitted to the opposition division for examination of the grounds for opposition pursuant to Article 100(a) EPC (Article 111(1) EPC).

6. *Party status of opponent OP1-2*

The appellant still seems to consider the status of opponent OP1-2 unclear and wishes this to be resolved by the board. However, as the appellant has formally withdrawn allegations of a procedural violation resulting from this issue, a formal position on the matter lies outside the scope of the appeal proceedings. It rests with the opposition division to take further clarifying action, if deemed necessary, and if the appellant continued to doubt that OP1-2 has ceased to be a joint member of OP1, despite the seemingly unambiguous and consistent written declarations of 17, 19 and 24 November 2014.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



N. Michaleczek

R. Winkelhofer

Decision electronically authenticated