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**Datasheet for the decision
of 24 May 2022**

Case Number: T 1436/19 - 3.2.01

Application Number: 11746995.7

Publication Number: 2431119

IPC: B23K9/073, B23K9/095, B23K9/10

Language of the proceedings: EN

Title of invention:

ALTERNATING-CURRENT WELDING METHOD AND ALTERNATING-CURRENT
WELDING DEVICE

Patent Proprietor:

Panasonic Intellectual Property Management Co., Ltd.

Opponent:

Fronius International GmbH

Headword:

Relevant legal provisions:

EPC Art. 83, 84, 111, 123(2), 123(3)
EPC R. 139
RPBA 2020 Art. 12(2), 13(2)

Keyword:

Amendment after summons - reordering of the requests - taken into account (no) - late filed objections - taken into account (no)

Amendment after summons - reintroduction of a request previously withdrawn - taken into account (no)

Correction of error - immediately evident that nothing else could have been intended (yes)

Primary object of appeal proceedings to review decision - appeal case directed to requests on which decision was based (no)

Amendments auxiliary requests 1 to 3 - allowable (no) auxiliary request 4 - allowable (yes)

Sufficiency of disclosure - auxiliary request 4 -(yes)

Auxiliary request 4 - clarity (yes)

Remittal to the department of first instance

Remittal - (yes)

Decisions cited:

Catchword:



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Case Number: T 1436/19 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 24 May 2022

Appellant: Panasonic Intellectual Property Management Co., Ltd.
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 13 March 2019 revoking European patent No. 2431119 pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: V. Vinci
 A. Jimenez

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 N. 2 431 119.

In its decision the opposition division held that the patent as granted as well as according to the auxiliary requests 1 to 3 did not meet the requirements of Article 123(2) EPC.

- II. With the communication according to Article 15(1) RPBA dated 26 February 2021 the Board informed the parties of its preliminary assessment of the case.

Oral proceedings pursuant to Article 116 EPC were held before the Board on 24 May 2022 by videoconference.

- III. The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the main request or any of the auxiliary requests 1 to 4 as filed with the statement of grounds of appeal in that order, or that the case be remitted to the opposition division for further prosecution in case patentability was to be discussed.

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

- IV. Claim 1 according to both the main request and the auxiliary request 1 filed with the statement of grounds of appeal corresponds to claim 1 according to the auxiliary request 1 underlying the decision under appeal and reads as follows:

"A method for performing AC arc welding in which a negative polarity-period and a positive-polarity period are alternated during a period at a first AC frequency, wherein during the negative-polarity period a positive control signal is outputted at a low level and a negative control signal is outputted at a high level and during the positive-polarity period a positive control signal is outputted at a high level and a negative control signal is outputted at a low level, the method comprising:

alternating the positive signal of high level and the negative signal of low level with a positive signal of low level and a negative signal of high level at the first frequency,

a detection step for detecting arc interruption during welding and

a control step for, upon detection of the arc interruption in the detection step, reigniting the arc by outputting a high level of the positive control signal or the negative control signal for a second period shorter than a first period corresponding to the first AC frequency."

Claim 1 according to both the auxiliary requests 2 and 3 filed with the statement of grounds of appeal corresponds to claim 1 according to the auxiliary request 3 underlying the decision under appeal and reads as follows:

"A method for performing AC arc welding in which a negative-polarity period and a positive-polarity period are alternated during a period (P1), at a first AC frequency, wherein during the negative-polarity period

a positive control signal is outputted at a low level and a negative control signal is outputted at a high level and during the positive-polarity period a positive control signal is outputted at a high level and a negative control signal is outputted at a low level, the method comprising:

alternating the positive signal of high level and the negative signal of low level with a positive signal of low level and a negative signal of high level at the first frequency,

a detection step for detecting arc interruption during welding; and

a control step for, upon detection of the arc interruption in the detection step, reigniting the arc by outputting a high level of the positive control signal or the negative control signal for a second period shorter than a first period consisting of the negative-polarity period or of the positive polarity period corresponding to the first AC frequency, wherein in the control step, reigniting the arc is performed at a second AC frequency higher than the first AC frequency."

Claim 1 according to the auxiliary request 4 filed with the statement of grounds of appeal reads as follows:

"A method for performing AC arc welding in which a negative-polarity period and a positive-polarity period are alternated during a period (P1), at a first AC frequency, wherein during the negative-polarity period a positive control signal is outputted at a low level and a negative control signal is outputted at a high level and during the positive-polarity period a

positive control signal is outputted at a high level and a negative control signal is outputted at a low level, the method comprising:

alternating the positive signal of high level and the negative signal of low level with a positive signal of low level and a negative signal of high level at the first frequency,

a detection step for upon detection of the arc interruption in the detection step, reigniting the arc by outputting a high level of the positive control signal for a second period shorter than the positive-polarity period corresponding to the first AC frequency, or by outputting an high level of the negative control signal for the second period shorter than the negative-polarity period corresponding to the first AC. frequency, wherein in the control step, reigniting the arc welding-is performed at a second AC frequency higher than the first AC frequency."

Reasons for the Decision

Reordering of the requests filed with the statement of grounds of appeal

1. With the letter dated 08 April 2022 the appellant (patent proprietor) requested to reorder the requests filed with the statement of grounds of appeal by renumbering the former auxiliary request 4 as new main request and the former main request and auxiliary requests 1 to 3 as new auxiliary requests 1 to 4 respectively. The appellant (patent proprietor) justified the proposed reordering by referring to the need for procedural economy in view of the preliminary

opinion of the Board stating that the main request and auxiliary requests 1 to 3 filed with the statement of grounds of appeal were considered to infringe Article 123(2) EPC while the auxiliary request 4 was likely to overcome all the objections raised under Articles 83, 84 and 123(2) EPC by the respondent (opponent), thereby opening the way for a remittal of the case to the department of first instance for further prosecution as requested by the appellant (patent proprietor).

1.1 The respondent (opponent) objected that the reordering proposed by the appellant (patent proprietor) resulted in an amendment to the appellant's (patent proprietor's) appeal case at very a late stage of the appeal proceedings which was not determined by exceptional circumstances justified with cogent reasons as instead required by Article 13(2) RPBA in the version 2020, which applies to the present appeal, and requested not to take it into account. Furthermore, the respondent (opponent) pointed out that the proposed reordering could negatively affect the respondent's (opponent's) position in case of remittal of the appeal to the department of first instance because it would prevent the Board to decide on requests and/or claims underlying the decision under appeal. Finally, the respondent (opponent) observed that in absence of a concomitant withdrawal of the main request and of the auxiliary requests 1 and 3, that was denied by the appellant (patent proprietor), no real positive impact on procedural economy could be achieved.

1.2 After having heard the parties the Board came to the conclusion that the reordering of the requests filed with the statement of grounds of appeal requested by the appellant (patent proprietor) could not be taken into account for the following reasons:

The Board observes that allowing the proposed reordering would force the Board to firstly decide on a fully new main request, i.e. the auxiliary request 4 submitted with the statement of grounds of appeal, not underlying the decision under appeal. This would be contrary to the provisions of Article 12(2) RPBA 2020 stating that, in view of the primary object of the appeal proceedings to review the decision under appeal, a party's appeal case shall be directed, among others, "*.. to requests on which the decision under appeal was based*". In fact, should the Board confirm the preliminary opinion that the new main request meets the requirements of Articles 83, 84 and 123(2) EPC, the proposed reordering of the requests would potentially lead to a situation where the Board would have to remit the case to the department of first instance without having decided on requests/claims underlying the decision under appeal still on file, but only on a new request. This would be contrary to the scope of the appeal proceedings and might be also detrimental to procedural economy as a whole. Furthermore, the Board agrees with the respondent (opponent) that the proposed reordering of the requests clearly results in lack of convergency thereof. Finally, the preliminary positive assessment of the auxiliary request 4 by the Board cannot be seen as an exceptional circumstance in the meaning of Article 13(2) RPBA 2020 justifying a change of the appellant's (patent proprietor's) appeal case, but rather as a foreseeable and thus not unexpected result of the preliminary assessment of the case by the Board taking into account that the amendments introduced clearly address all the issues at stake.

- 1.3 Therefore, for the reasons above, the Board decided that the reordering of the requests constituted an amendment to the appellant's (patent proprietor's)

appeal case that could not be taken into account.

Further amendments to the appellant's (patent proprietor's) appeal case requested during oral proceedings

2. In view of the intention expressed by the Board in the course of the oral proceedings not to consider the requests according to the new order as proposed with the letter dated 08 April 2022, the appellant (patent proprietor) withdrew the main request submitted with the statement of grounds of appeal and maintained the auxiliary requests 1 to 4 in this order, whereby the auxiliary request 1 became the new main request. Following the reaction of the respondent (opponent) that requested not to take this further change to the appellant's (patent proprietor's) appeal case into account under Article 13(2) RPBA, the appellant (patent proprietor) requested to reintroduce the main request filed with the statement of grounds of appeal.

3. However, the reintroduction of a previously withdrawn request, namely the main request filed with the statement of grounds of appeal, constitutes an inadmissible amendment to the appellant's (patent proprietor's) appeal case, that cannot be taken into account under Article 13(2) RPBA 2020 in the absence of any exceptional circumstances. Regarding the auxiliary requests 1 to 4 the Board observes that they were all filed with the statement of grounds of appeal, that they were never withdrawn, and that it could anyway be expected that these requests would be the subject of discussion at the oral proceedings irrespective of the above-mentioned change of the order of the requests. Therefore, the Board does not see any reason not to take them into account as instead requested by the

respondent (opponent).

Auxiliary Request 1

Article 123(2) EPC

4. The auxiliary request 1 does not meet the requirements of Article 123(2) EPC.

4.1 Claim 1 of the auxiliary request 1 corresponds to claim 1 of the auxiliary request 1 underlying the decision under appeal which was dismissed by the opposition division under Article 123(2) EPC. This decision is contested by the appellant (patent proprietor) who essentially argued that, contrary to the interpretation of the opposition division, the first period referred to in the expression "a first period corresponding to the first AC frequency" at the end of claim 1 indicated exclusively either the positive-polarity period or the negative-polarity period at the first AC frequency, but was in no case the total welding period (F1) at the first AC frequency as instead assumed in the decision under appeal. It was thus concluded that the allegedly incorrect interpretation by the opposition division of the expression "*a first period*" led to a wrong assessment of Article 123(2) EPC.

4.2 The arguments of the appellant (patent proprietor) are not convincing for the following reasons:

The Board concurs with the opposition division that it is not unambiguously clear what is meant by the term "*first period*" referred to in the expression "*a first period corresponding to the first AC frequency*" at the end of claim 1 in its technical context. In the Board's view, the opposition division correctly concluded that

such unclear expression expression should be broadly interpreted as covering not only either one of the negative or positive polarity periods, but also the total period during which the negative polarity period and the positive polarity period are alternated at the first AC frequency before extinguishment of the arc occurs, i.e. the period indicated as F1 in the figures. In fact, contrary to the appellant's (patent proprietor's) view, the Board is convinced that the wording of the claim as a whole does not allow the person skilled in the art to exclude this third possibility. In view of this interpretation the claim thus covers, among others, the possibility to have the second period of the control signals associated with the control step shorter than the total period F1 of normal welding in which the first AC frequency is applied. As this teaching cannot be directly and unambiguously derived from the application as filed, the Board confirms the view of the opposition division that the requirements of Article 123(2) EPC are not met by claim 1 of the auxiliary request 1.

4.3 The appellant (patent proprietor) criticised the allegedly different interpretations of the expression at stake adopted by the opposition division regarding the wording of claim 1 as filed and according to the auxiliary requests 1 (see points 11.1.1 and 12. of the contested decision). It was argued that when relying on the allegedly correct interpretation adopted in respect of claim 1 as filed, the reasoning of the opposition division in support of its negative assessment of compliance with Article 123(2) EPC of claim 1 of the auxiliary request 1 was flawed.

4.4 The Board does not agree because, as stressed by the respondent (opponent), the different wording of claim 1

as filed and according to the auxiliary request 1 justifies the broader and different interpretations adopted by the opposition division in respect of claim 1 of the auxiliary request 1. In fact claim 1 as filed, line 3, reads "*at a first AC frequency*" while the corresponding amended wording on line 3 of claim 1 according to the auxiliary request 1 reads "*during a period at a first AC frequency*" (emphasis added by the Board). As convincingly explained by the respondent (opponent) in their reply, the introduction of the expression "*during a period*" changes/broadens the meaning of the term "*a first period*" in the expression "*a first period corresponding to the first AC frequency*" at the end of claim 1 of the auxiliary request 1 in the way indicated by the opposition division, thereby justifying the issue under Article 123(2) EPC discussed above.

4.5 For the reasons above and irrespective of the other issues raised by the respondent (opponent), the auxiliary request 1 is thus not allowable.

4.6 The Board contextually observes that as claim 1 of the auxiliary request 1 is identical to claim 1 of the main request filed with the statement of grounds of appeal, the latter, even if re-admitted, would be unallowable for the same reasons.

Auxiliary Requests 2 and 3

Article 123(2) EPC

4.7 The auxiliary requests 2 and 3 do not meet the requirements of Article 123(2) EPC.

4.8 Claim 1 of both the auxiliary requests 2 and 3 are identical to claim 1 of the auxiliary request 3 underlying the decision under appeal which was dismissed under Article 123(2) EPC. This decision is contested by the appellant (patent proprietor).

4.9 The Board follows the uncontested interpretation of the opposition division that the wording at the end of claim 1 reading:

"a control step for, upon detection of the arc interruption in the detection step, reigniting the arc by outputting a high level of the positive control signal or the negative control signal for a second period shorter than a first period, consisting of the negative-polarity period or the positive polarity period, corresponding to the first AC frequency."
(emphases added by the Board)

results, because of the repetition of the word "or", in four alternatives all covered by the claim, namely:

(a) outputting a high level of the positive control signal for a second period shorter than the positive-polarity period,

(b) outputting a high level of the negative control signal for a second period shorter than the negative-polarity period,

(c) outputting a high level of the negative control signal for a second period shorter than the positive-polarity period,

(d) outputting a high level of the positive control signal for a second period shorter than the negative-

polarity period.

However, while a clear basis for the alternatives (a) and (b) can be found in connection with the description of the second and third embodiments shown in figures 4 and 6 where the claimed proportion between the periods of application of the negative or positive high control signals in the arc reigniting period F2 and the negative or positive polarity periods of the welding step is clearly depicted by showing by dotted lines the respective polarity periods corresponding to the welding step just above the respective high control signals in the control step, the Board shares the view of the opposition division that no direct and unambiguous support, either explicit nor implicit, for the alternatives (c) and (d) can be derived neither from the description (what is not contested), nor from the figures. In this respect the appellant (patent proprietor) argued that the relationship according to the alternatives (c) and (d) is derivable from the representation of the periods at stake in the figures. However, the Board follows the argument of the respondent (opponent) that the person skilled in the art, in absence of any explicit supporting passage in the description, would not be able to directly and unambiguously derive from the figures the information that outputting an high level positive or negative control signals with a second period according to the alternative (c) and (d) is also encompassed by the original application.

- 4.10 The appellant (patent proprietor), further argued that contrary to the assessment of the opposition division, all four alternatives are supported by the broader wording of claim 1 as filed allegedly encompassing all of them. This assertion is not convincing for the

following reasons:

As correctly pointed out by the respondent (opponent), the so called "*gold standard*" is to be applied when assessing compliance of an amendment with Article 123(2) EPC. The Board does not see how the person skilled in the art, on the basis of the formulation of the first 3 lines of claim 1 as filed cited by the appellant (patent proprietor) in combination with its final generic wording reading "*shorter than a first period corresponding to the first AC frequency*" and in absence of any hint in the description, would directly and unambiguously derive all the 4 specific alternatives covered by claim 1 of the auxiliary requests 2 and 3.

- 4.11 For the reasons above and irrespective of the other issues raised by the respondent (opponent), the auxiliary requests 2 and 3 are thus not allowable.

Auxiliary Request 4

Alleged lack of substantiation

5. The opponent (respondent) alleged that the auxiliary request 4 submitted with the statement of grounds of appeal has not been sufficiently substantiated in particular because the passages of the originally filed application supporting the amendments introduced in claim 1 have not been indicated by the appellant (patent proprietor) as required by Rule 137(4) EPC. It was thus requested to disregard the auxiliary request 4.

- 5.1 The Board does not agree:

Firstly, the Board notes that the provisions of Rule 137(4) EPC referred to by the respondent (opponent) apply only to amendments to the European patent application submitted during the examination procedure. Furthermore, the appellant (patent proprietor) has explained in the statement of grounds of appeal why in their view the amendments introduced in claim 1 of the auxiliary request 4 are suitable to overcome the objections which led to the decision under appeal (see page 6, last line onwards of the statement of grounds of appeal), thereby taking also into account the observation of the opposition division regarding compliance with Article 83 EPC. Moreover, the appellant (patent proprietor) has indicated that the amendments relating to the definition of the control step were introduced in order to limit claim 1 at stake to the alternatives (a) and (b) of claim 1 of the third auxiliary request based on the second and third embodiments originally disclosed. Having regard to the replacement of the term "welding" by "reigniting the arc", the basis of this amendment have been indicated in the context of the substantiation of the auxiliary request 1 which contains the same amendment. Therefore, the request of the respondent (opponent) to disregard the auxiliary request 4 because of lack of substantiation is not justified.

Article 123(2) and 123(3) EPC

- 5.2 The auxiliary request 4 meets the requirements of Articles 123(2) and (3) EPC. The following objections have been raised by the respondent (opponent):

Correction under Rule 139 EPC and related objections under Articles 123(2) and (3) EPC

6. A correction in claim 1 as granted was requested during the opposition proceedings by the appellant (patent proprietor) in order to respond to a ground of opposition under Article 100(c) EPC. This correction was considered allowable under Rule 139 EPC by the opposition division in their preliminary opinion. Although this issue was not discussed at the opposition oral proceedings and is not dealt with in the decision under appeal, it was reiterated by the respondent (appellant) in their reply in respect of all requests submitted with the statement of grounds of appeal of the appellant (patent proprietor) and thus also affects the auxiliary request 4 which contains the disputed correction as well.

6.1 At the oral proceedings the parties referred regarding this issue to their written submissions and did not provide any further arguments. Therefore, the Board has no reasons to deviate from its preliminary assessment which is hereby confirmed and reads as follows:

The correction at stake consists in the reversing of the terms "*negative*" and "*positive*" on lines 18 and 19 of claim 1 as granted. The respondent (opponent) maintained that this correction should not have been allowed. Furthermore, it was objected that in absence of the correction, claim 1 of all requests, and thus also of the auxiliary request 4, infringed Article 123(2) EPC. Finally it was argued that the correction should be denied because it resulted in addition in an unallowable shifting of the protection achieved by claim 1 as granted ("*aliud*") infringing Article 123(3) EPC.

6.2 The Board does not agree for the following reasons:

The correction under discussion was requested in order to remove an allegedly blatant error, i.e. the inversion of the terms "negative" and "positive" in claim 1 as granted, lines 18 and 19. The Board shares the view of the appellant (patent proprietor) that the person skilled in the art reading claim 1 in the light of common general knowledge would directly and unambiguously recognize that sending/maintaining an identical control signal during both the positive and negative polarity periods, namely a negative control signal at low level and a positive control signal at high level (see lines 17-22 of claim as granted), does not make any technical sense, and therefore that the passage of claim 1 at stake must contain an error. The Board agrees with the appellant (patent proprietor) that the person skilled in the art looking at the description (see paragraph [0043] of the A-publication) and at the relevant figures immediately realizes that the error lies indeed in the fact that the terms "negative" and "positive" on lines 18 and 19 respectively of the claim have been erroneously inverted, and that nothing else could have been intended than what it is offered by the correction. In fact the correction restores technical sense regarding the control functionality defined in claim 1 while being also in accordance with the control signal polarities and sequence described in paragraph [0043] and depicted in figures 2, 4, 6 and 8 of the patent specification. The Board thus concludes, contrary to the view of the respondent (opponent), that the correction at stake meets the two conditions of the two-step approach which, according to established Case Law of the Boards of Appeal, shall be applied for assessing allowability of a correction in the claims under Rule 139 EPC. The respondent (opponent) argued that as the wording of claim 1 does not specify that

switching of the polarity was achieved by issuing said positive/negative, high/low control signals, it could not be concluded that the correction under discussion is univocally determined by the passage of the description cited above. The Board disagrees because the person skilled in the art, reading the claim as a whole and in view of its technical and functional context, would interpret the term "*control signal*" as meaning an electrical signal which is issued in order to switch the polarity of the AC current and not, as alleged by the respondent, as meaning any generic electrical signal, for example a signal merely suitable for monitoring the actual polarity of the current. In this respect it is further observed that the interpretation of the term "*control signal*" proposed by the respondent (opponent) is not supported by the patent specification. Furthermore, as the text resulting from the correction is fully supported by the originally filed description and is of strictly declaratory nature the objections of the respondent (opponent) under Article 123(2) and (3) EPC respectively are not justified.

Discrepancy between Fig. 2 of the patent as granted and fig. 2 of the original Japanese specification

6.3 With the statement of the grounds of appeal the respondent (opponent) objected to the different references used for indicating the whole period in which the first AC frequency is applied in figure 2 of the English translation of the original Japanese application (and of the contested patent) and in figure 2 of the original Japanese application, i.e. the references F1 and P1 respectively, which in their view results in additional undisclosed information infringing Article 123(2) EPC. No further arguments

were submitted in this respect by the respondent (opponent) during oral proceedings. The Board thus hereby confirms the view expressed in its preliminary opinion that these different references, unlike the respondent's allegation, do not modify the technical content to which they relate, whereby this discrepancy does not result in any new information leading to an infringement of Article 123(2) EPC. The same conclusion applies with the same arguments to the contested use of the reference (P1) in claim 1 of the auxiliary request 4 which was objected under Article 123(2) EPC by the respondent (opponent) with the reason that this reference does not appear in the figures of the originally filed application.

6.4 The respondent (opponent) further argued that there was no basis in the original application directly and unambiguously supporting the replacement of the term "*welding*" of the originally filed claim 2 (now introduced in claim 1 at stake) by the expression "*reigniting the arc*". In particular it was alleged that nowhere in the application as originally filed the expression "*reigniting the arc*" is presented in combination with "*a second AC frequency higher than the first AC frequency*" as now recited at the end of claim 1 of the auxiliary request 4.

6.5 Also this objection is not convincing because from the whole application it can be directly and unambiguously derived that reigniting of the arc is carried out only in the period where the second AC frequency is applied. Therefore, the Board agrees with the appellant (patent proprietor) that in view of the cited passage starting from the last line of page 14 and ending on line 3 of page 15 of the originally filed application as well as of paragraphs [0032], [0045] to [0048] and [0056] of

the A-publication, no new information results from the replacement of the word *"welding"* by the expression *"reigniting of the arc"* in claim 2 as filed and thus in claim 1 according to the auxiliary request 4.

Articles 83 and 84 EPC

7. With their reply to the statement of grounds of appeal of the appellant (patent proprietor), the respondent (opponent) stated that in particular the objections of lack of sufficient disclosure and clarity raised against claim 1 of the auxiliary request 1 were maintained with the same arguments with respect to claim 1 of the auxiliary request 4. At the oral proceedings the respondent (opponent) clarified that these objections concerned the issues raised under Articles 83 and 84 EPC in respect of the expressions *"reigniting the arc at a second AC frequency"*, *"second AC frequency"*, *"control signal"*, said issues also affecting claim 1 of the auxiliary request 4, and referred to their written submission in this respect.

7.1 The Board does not thus see any reason to deviate from its preliminary assessment of these objections which is hereby confirmed and reads as follows:

The Board is convinced that the person skilled in the art is perfectly able to understand on the basis of the whole patent specification and of common general knowledge, what the expressions objected by the respondent (opponent) mean in the context of claim 1 and how to carry out the invention accordingly. In particular there cannot be doubt that the control signals mentioned in claim 1 which are outputted at a first or second AC frequency are indeed electrical signal.

Late filed submissions of the respondent (opponent)

8. With the letter dated 31 March 2022 the respondent (opponent) submitted new objections under Articles 123(2) and 84 EPC and contested the assertion of the Board in the preliminary opinion that the subject-matter of claim 1 of the auxiliary request 4 covered the third and fourth embodiments of the contested patent. The new objections were allegedly justified as reaction to the preliminary positive assessment of the Board regarding compliance of claim 1 of the auxiliary request 4 with Articles 84 and 123(2) EPC. The appellant (patent proprietor) requested to dismiss these new submissions under Article 13(2) RPBA stressing that they were presented 13 months after the preliminary opinion of the Board while the auxiliary request 4 had been already introduced with the statement of grounds of appeal.

8.1 The Board observes that the fact that the preliminary opinion indicated that the auxiliary request 4 was preliminary deemed to overcome all the objections at stake could not justify the submission by the respondent (opponent) of fully new objections which could and should have been presented with the reply to the statement of grounds of appeal of the appellant (patent proprietor) which indeed already comprised the auxiliary request 4 at stake. The Board further observes that the eventuality that a positive preliminary opinion could have been issued in respect of the auxiliary request 4 was a foreseeable and thus not exceptional circumstance in the meaning of Article 13(2) RPBA. In fact nothing prevented the respondent (opponent) to submit the new objections already with their first reply as reaction to the filing of the new

auxiliary request 4 as required by Article 12(3) RPBA which foresees that the reply of a party shall contain the party's complete appeal case. Therefore, for the reasons above, the new submissions of the respondent (opponent) filed with the letter dated 31 March 2022 are not taken into account by the Board.

- 8.2 Having regard the question of which embodiments are covered by claim 1 of the auxiliary request 4, the Board agrees with the respondent (opponent) that due to the fact that claim 1 now requires the mandatory execution of the control step at a second AC frequency, this feature is verified only by the embodiments in figures 1 and 8 which are the only ones where the positive and negative control signals are in fact alternated. This however results in a problem of adaptation of the description to the invention as defined in the claims rather than in a lack of clarity of the subject-matter of claim 1.

Remittal to the department of first instance

9. The Board, in the exercise of the discretion provided by Article 111 EPC, considers it appropriate to remit the case to the department of first instance for further prosecution as requested by the appellant (patent proprietor), "*special reasons*" in the sense of Article 11 RPBA 2020 being that the other grounds for opposition under Article 100(a) EPC in combination with Articles 54 and 56 EPC were not assessed in the decision under appeal. The respondent (opponent) did not object to the remittal of the case to the opposition division.

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 for further prosecution.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated