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**Datasheet for the decision
of 4 October 2022**

Case Number: T 2587/19 - 3.2.07

Application Number: 11842482.9

Publication Number: 2643104

IPC: B08B7/02, F28G7/00

Language of the proceedings: EN

Title of invention:

IMPACT DEVICE FOR CLEANING OF SURFACES, PARTICULARLY HEAT
DELIVERY SURFACES

Patent Proprietor:

OY Lux AB

Opponent:

Sumitomo SHI FW Energia Oy

Headword:

Relevant legal provisions:

EPC Art. 100(a), 56

RPBA Art. 12(4)

RPBA 2020 Art. 25(2)

Keyword:

Inventive step - (yes)

Late-filed objections - should have been submitted in
opposition proceedings (yes) - admitted (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

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Case Number: T 2587/19 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 4 October 2022

Appellant: Sumitomo SHI FW Energia Oy
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 24 July 2019
rejecting the opposition filed against European
patent No. 2643104 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman I. Beckedorf
Members: A. Cano Palmero
S. Watson

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal within the prescribed period and in the prescribed form against the decision of the opposition division rejecting the opposition against European patent No. 2 643 104 as granted.
- II. The opposition was directed against the patent in its entirety and based on the ground for opposition pursuant to Article 100(a) EPC (lack of inventive step).
- III. In preparation for oral proceedings, scheduled upon the parties' requests, the Board communicated its preliminary assessment of the case by means of a communication pursuant to Article 15(1) RPBA 2020. The Board indicated that the appeal was likely to be dismissed.
- IV. Oral proceedings before the Board took place on 4 October 2022. At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes thereof.
- V. The final requests of the parties are as follows,

for the appellant:

that the decision be set aside and
that the patent be revoked in its entirety;
or alternatively that the case be remitted to the
opposition division for further prosecution.

for the respondent (patent proprietor):

that the appeal be dismissed.

VI. The lines of argument of the parties relevant for the present decision are dealt with in detail in the reasons for the decision. These lines of argument are focused on the following points:

- review of the decision under appeal on the ground of opposition under Articles 100(a) and 56 EPC with regard to the patent as granted;
- admittance under Article 12(4) RPBA 2007 of the objections of lack of novelty and lack of inventive step made for the first time in appeal;
- remittal of the case to the opposition division for further prosecution.

VII. The following **evidence** has been filed during the opposition proceedings and re-filed by the appellant with its statement of grounds of appeal:

D1: WO 2008/071852;

D2: Selkälä, T., Master's Thesis at University of Oulu (accepted 7 November 2007), pages 1, 35-42, 49, 50; with translation "Comparison of operating principles of an impact rapping device" (D2T);

D3: US 5,561,583.

The following document has been filed by the appellant for the first time with its statement of grounds of appeal:

D4: US 4,974,494.

With its letter of 9 June 2020, *i.e.* after the filing of its statement of grounds of appeal, the appellant submitted the following documents:

EVIDENCE-1: opinion of the Finnish Patent Office sent to the Market Court, original in Finnish, with a certified English translation, and

EVIDENCE-2: "Comparison of operating principles of impact rapping device", Master's Thesis of Mr T.Selkälä, dated 5 December 2007 , original in Finnish, with a certified English translation.

VIII. Independent **claim 1** according to the **patent as granted** reads as follows:

"An impact device for cleaning of surfaces, particularly heat delivery surfaces, such as boiler faces, convection packets and heat exchangers, the impact device comprising
an anvil (1, 1');
a body (2, 2') with a first end (3, 3') facing the anvil (1, 1'), and a second end (4, 4') positioned opposite to the first end;
a hammer unit comprising a hammer (5, 5') arranged to be displaceable in the body (2, 2'); and
a spring (6, 6') arranged to receive impact energy from the hammer (5, 5') and to transfer impact energy to the anvil (1, 1'), in which impact device the body (2, 2') is fastened to the anvil (1, 1'), and the impact device comprises means for damping impact force from the anvil (1, 1') to the body (2, 2'), wherein the body (2, 2') is fastened to the anvil (1, 1') by means of at least one elongated suspension element (7, 7a' to 7f') which is fastened to the anvil (1, 1') by a first end (8, 8a', 8e', 8f) of the suspension element (7, 7a' to 7f);

the means for damping impact force from the anvil (1, 1') to the body (2, 2') comprise a spring unit (9, 9a' to 9f) connecting the suspension element (7, 7a' to 7f') to the body flexibly, which allows the body (2, 2') to be displaced relative to the suspension element (7, 7a' to 7f') in the longitudinal direction of the suspension element (7, 7a' to 7f); the hammer device comprises an end facing the anvil (1, 1'); and that the device comprises means (103, 103') for keeping an entity comprising the hammer unit end facing the anvil (1, 1'), the spring (6, 6') and the anvil (1, 1') under compression in a clearance-free manner."

Reasons for the Decision

1. Transitional provisions

The appeal proceedings are governed by the revised version of the Rules of Procedure which came into force on 1 January 2020 (Articles 24 and 25(1) RPBA 2020), with the exception of Article 12(4) to (6) RPBA 2020 instead of which Article 12(4) RPBA 2007 remains applicable (Article 25(2) RPBA 2020).

2. Claim 1 of the patent as granted - inventive step in view of the teaching of D1 as closest prior art in combination with the teaching of D2, Articles 100(a) and 56 EPC

2.1 According to the decision under appeal (see points 2.1 to 2.3 of the reasons) the subject-matter of claim 1 as granted differs from the known impact device of figure 7 of D1 in a flexible connection (by means of a spring unit) connecting the suspension element (which is regarded as bolts A in D1) and the body. In contrast,

in figure 7 of D1, the flexible connections (in the form of cup springs 84) are either connecting one face of the flange of the anvil 16 with the suspension element (bolts A) or the other face of the flange of the anvil 16 with the end face of the body 80. It is undisputed that, at least this feature, is not found in the disclosure of D1.

2.2 The appellant argued that document D2 provided the teaching of changing the fixation bolt direction and thereby suggested the missing distinguishing feature. Starting from the construction known from figure 7 of cited document D1, the skilled person, having as an objective to facilitate assembly and removal of the impact device for cleaning of surfaces, would have combined the flange construction known from figure 24 of document D2 in order to change the fixation direction of the bolts, without the use of any inventive skill and also without hindsight and would thereby have arrived at the subject-matter of claim 1 as granted in an obvious manner.

2.2.1 The appellant further argued in its statement of grounds of appeal, that in view of the similarity of figure 32 of D2 and figure 7 of D1, it would be apparent for the skilled person that *"the person who has been designing the impact device for cleaning of surfaces as in FIG 7 of cited document D1...has considered the requirements for the flange as in FIG 24 of cited document D2. At least the idea thus has been present in the development team from which the invention disclosed as a patent application of cited document D1 resulted"*. It would thus follow, so the appellant, that based on D2, *"the skilled person has already considered the option of changing the fixation bolt direction, which requires extending the flange on*

the anvil and provision of a flange on the cylindrical body" (see statement of grounds of appeal, page 6, final paragraph to page 7, first paragraph).

2.3 The Board is not persuaded by these arguments and is of the view that the subject-matter of claim 1 according to the patent as granted is inventive in view of the teaching of D1 as closest prior art in combination with the teaching of D2.

2.3.1 The Board is firstly not convinced by the argument brought forward by the appellant that, since the development team of D1 was already aware of the teaching of D2 and the option of inverting the bolt direction, this last feature would be obvious for the skilled person starting from D1 as closest prior art.

2.3.2 The Board notes that the requirement of inventive step is directed to the notional person skilled in the art and not to a development team or inventor of a particular piece of prior art. More importantly, the alleged fact that several pieces of prior art originate from the same inventor or development team does not automatically imply that a combination of those different teachings is always obvious. The question to be clarified remains thus, whether having regard to the state of the art, the skilled person would arrive at the subject-matter of the claim in an obvious manner.

2.3.3 This is not the case here, for the following reasons. Even if it were to be accepted that D2 does not exclude a bolt assembly as indicated by the appellant, the skilled person would not consider such a solution starting from D1. As correctly put forward by the opposition division in points 2.4 and 2.5 of the reasons of the decision under appeal, in order to

provide a flange-to-flange connection between the anvil and the body that could allow an inverting of the bolt assembly the skilled person would be faced with making extensive complex modifications which would affect the whole design of the impact device that would likely alter the functionality of the tool. Accordingly, the skilled person, starting from D1, would have no motivation to implement such a flange-to-flange connection as allegedly disclosed in D2 and would therefore arrive at an impact device according to claim 1 as granted only by exercising inventive skill.

3. *Admittance of the new objections in appeal proceedings, Article 12(4) RPBA 2007*

3.1 It is uncontested that the following **objections** against the subject-matter of claim 1 according to the patent as granted were raised for the first time in appeal proceedings:

3.1.1 With the statement of grounds of appeal:

- lack of inventive step in view of D4 in combination with the common general knowledge of the skilled person (point 3.2);
- lack of inventive step in view of the teaching of D2 in combination with the teaching of D1 (point 4);
- lack of inventive step in view of the teaching of D1 in combination with the teaching of D3 (point 5).

3.1.2 With letter of 9 June 2020 (see last paragraph of page 6):

- lack of novelty in view of EVIDENCE-2;

- lack of inventive step in view of EVIDENCE-2 in combination with the common general knowledge of the skilled person;
- lack of inventive step in view of EVIDENCE-2 in combination with the teaching of D4.

- 3.2 These objections, having been filed for the first time with the statement of grounds of appeal or later, are not dealt with in the decision under appeal. Since these objections could and should have been filed in opposition proceedings, their consideration in appeal proceedings is subject to the Board's discretion pursuant to Article 12(4) RPBA 2007, which is applicable in the present case.
- 3.3 When exercising such discretion it is decisive for the Board whether reasons exist which justify the filing of these objections for the first time in appeal proceedings.
- 3.4 The appellant holds that the filing of these new objections at such a late stage, including the filing of new evidence such as D4 or EVIDENCE-2, is justified in view of the opposition division's findings in the decision under appeal, in particular in points 2.10 and 2.11 of the reasons. Furthermore, the appellant stated that it was first aware of the appropriate relevance of document D2 and of the existence of EVIDENCE-2, once an opinion of the Finnish patent office (EVIDENCE-1) had been made available on 3 April 2020. The appellant argued that the "correct" and appropriate version of D2 was indeed EVIDENCE-2.
- 3.5 The Board cannot follow these justifications for the following reasons.

- 3.5.1 In the absence of any amendment to the patent as granted, the Board is of the view that there are generally no obstacles for an opponent to form its complete opposition case, which should include all pertinent evidence and objections, within the prescribed opposition period.
- 3.5.2 In the case of document D4, it is undisputed that this document had already been filed by the appellant itself as a third party observation and had therefore been considered in the examination phase. Consequently, this document and its contents were already known by the appellant before the expiry of the opposition period, so that this evidence and the corresponding objections based thereon could have been filed at that stage. In the case of EVIDENCE-2, the appellant itself conceded that the technical teaching in EVIDENCE-2 is the same as in document D2 (see letter of the appellant of 9 June 2020, point 5). In this light, it cannot be agreed with the appellant that the new objections based on D2 or EVIDENCE-2 could not have been filed during the opposition proceedings.
- 3.5.3 Furthermore, the Board notes that the findings reached by the opposition division in points 2.10 and 2.11 of the decision under appeal had already been presented to the parties in points 2.3 and 2.4 of the preliminary opinion annexed to the summons to attend oral proceedings before the opposition division. It follows that the decision under appeal, contrary to the assumptions of the appellant, does not contain in points 2.10 and 2.11 any surprising and unexpected finding of the opposition division or a shift in the proceedings that could justify the submission of further evidence or objections in appeal proceedings.

3.5.4 The Board thus concludes that the findings of the decision under appeal did not change the particular interpretation or relevance of any piece of prior art. The Board is thus convinced that the appellant, being aware of the prior art and of the preliminary opinion of the opposition division could and should have submitted its pertinent objections during the opposition proceedings.

3.5.5 The Board, considering that the main aim of appeal proceedings is that of reviewing decisions of the administrative departments of the EPO (cf. Article 12(2) RPBA 2020) does not consider it appropriate that the appellant starts a complete fresh case in appeal, thereby avoiding having a decision from the competent EPO department, without a convincing justification for this course of action. Therefore, **none of the objections** listed in points 3.1.1 and 3.1.2 above **are taken into consideration in the proceedings under Article 12(4) RPBA 2007.**

4. *Remittal of the case to the opposition division*

The appellant confirmed at the oral proceedings before the Board that its initial request for remittal for further prosecution was dependent on at least one of its new objections being considered in the appeal proceedings. Since none of these objections are taken into consideration, the request for remittal cannot be allowed.

5. *Conclusions*

5.1 In view of the above, the Board concludes that the appellant has not convincingly demonstrated the incorrectness of the decision under appeal in its

findings that the ground of opposition pursuant to Article 100(a) EPC in combination with Article 56 EPC does not prejudice the maintenance of the patent as granted.

5.2 Furthermore, the request for remittal of the case for further prosecution cannot be allowed, since none of the additional objections submitted by the appellant for the first time in appeal proceedings is taken into account.

5.3 Consequently, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

I. Beckedorf

Decision electronically authenticated