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D E C I S I O N
of 5 August 1998

Case Number: T 0803/96 - 3.4.2

Application Number: 89100607.4

Publication Number: 0378711

IPC: C25D 17/12

Language of the proceedings: EN

Title of invention:

A profile for electrolytic treatment and a method for manufacturing the same

Patentee:

Outokumpu OY

Opponent:

Holl & Cie GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 54 and 56

EPC R. 60(2)

Keyword:

"Continuation of the proceedings after withdrawal of the opposition (yes)"

"Novelty (yes)"

"Inventive step (yes)"

Decisions cited:

T 0958/92

Catchword:

-



Case Number: T 0803/96 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 5 August 1998

Appellant: Outokumpu OY
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Representative: Zipse + Habersack
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Respondent: Holl & Cie GmbH
(Opponent) Giessenerstr.15
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Representative: Schneck, Herbert, Dipl.-Phys., Dr.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 26 June 1996
revoking European patent No. 0 378 711 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: E. Turrini
Members: M. Chomentowski
M. Lewenton

Summary of Facts and Submissions

- I. The appellant is proprietor of the European patent No. 0 378 711, which was granted with one main claim and three dependent claims 2 to 4 on the basis of the European patent application No. 89 100 607.4 citing EP-A-0 048 794.
- II. An opposition was filed on the grounds that the subject-matter of the opposed patent lacked novelty or at least an inventive step having regard to the above-mentioned EP-A-0 048 794, to new cited prior art documents comprising inter alia DE-B-103 459, and to a prior public use based on the content of a letter of the patent proprietor (appellant) mentioning no need for confidentiality and addressed, before the date of filing relevant to the opposed European patent, to the opponent (respondent).
- III. During opposition proceedings, claim 1 was amended to read as follows:
- "1. A method for manufacturing an essentially ball-shaped anode piece suited for an electroplating bath, characterised in that the anode piece (4) composed of some anode material is separated from an object (1) essentially longer than the diameter of the anode piece (4) to be produced, essentially simultaneously with the forming of the anode piece, whereby the working of the anode piece is carried out by one-stage rolling."
- The European patent, with this amended claim 1, was revoked.

The Opposition Division found that the amendments resulting in the submitted claim 1 were admissible and that the subject-matter of this claim was novel, but reasoned substantially as follows with respect to inventive step:

The acknowledgment of an inventive step must be based on the question as to whether the claimed method is obvious in view of the cited state of the art, as well as on unexpected technical effects and/or advantages of said method, e.g. based on particular properties of the article produced by the method. In this connection, relevant to the question of obviousness is primarily the disclosure of DE-B-103 459 concerning the production of ball-shaped objects from steel bars in a multi-step process, although a multi-step process is not necessarily required. In fact, this document also teaches that the number of rolling steps to produce a ball-shaped object is dictated by the desired final dimensions of the object, i.e. a multiplicity of rolling steps is required for ball-shaped objects of relatively large dimensions (see e.g. the paragraph bridging pages 1 and 2).

This teaching can be regarded as implying that if, conversely, it is intended to produce ball-shaped objects of relatively small dimensions, then a one-stage rolling step as specified in the submitted claim 1 would be a measure that the skilled person aware of the teaching of DE-B-103 459 would be induced to adopt without the exercise of inventive ingenuity, i.e. he would use thinner bars or softer materials to produce ball-shaped anodes of relatively small dimensions.

As far as the alleged advantages and/or properties of the ball-shaped anode pieces produced with the claimed method were concerned, such as e.g. the absence of a

passivation layer or others which may derive from a change in the crystal lattice of the anode material, the proprietor had failed to substantiate, for instance in terms of tests or comparison data, any differences that the present ball-shaped anodes might possibly show when compared with ball-shaped anodes of the same material produced according to the known multi-step methods, i.e. the proprietor has failed to prove that only by the present method it would be possible to avoid the formation of passivation layers during the working of the anode material into the ball-shaped objects, which is the problem underlying the claimed invention.

Therefore, the claimed process was considered as lacking an inventive step.

IV. The patent proprietor lodged an appeal against this decision. He requested that the decision under appeal be set aside and that a patent be maintained on the basis of a main request or of an auxiliary request consisting of claim 1 having formed the basis for the impugned decision. Moreover, the appellant auxiliarily requested, inter alia, that the appeal fee be reimbursed because of a substantial procedural violation. With a subsequent letter, the appellant filed an auxiliary request for oral proceedings.

V. The respondent (opponent) declared by a letter dated 18 September 1997 that he withdrew the opposition.

Beforehand, he had submitted arguments, in particular against appellant's auxiliary request, which concerned the obviousness of the claimed method either by taking into account the "rolling" technology known from the

prior public use or by making use of the method of DE-B-103 459 for making anode balls as those known from EP-A-0 048 794. Moreover, the relevance of the comparative measurements provided by the appellant was denied.

VI. In a communication dated 24 April 1998, the Board of appeal informed the appellant that only the auxiliary request, with the text having formed the basis for the impugned decision, seemed to involve an inventive step. Moreover, it was stressed that, pursuant to Rule 67 EPC, the question of reimbursement of appeal fees could be treated only if the appeal was deemed allowable. The appellant was asked to specify if he wished to be heard before any possible negative decision concerning his main request and/or his request of reimbursement of appeal fees.

VII. With letter dated 1 July 1998, the appellant declared that he is requesting to maintain the patent in amended form with claim 1 of his former auxiliary request and with claims 2 to 4 as granted, and that the request of reimbursement of appeal fees is not further maintained.

VIII. In his letters, the appellant argued as follows in support of his requests:

The crucial question is whether the specific feature of the simultaneous separating of the anode pieces and their forming as ball-shaped pieces by one-step rolling was known or made obvious by the state of the art. EP-A-0 048 794 represents the closest prior art in that, contrary to the other prior art documents, it is concerned with the manufacture of anode pieces. However, the anode pieces produced in the known method are separated from the wire and then the separated pieces are submitted to mechanical treatment to form them as balls. Thus, the anode pieces are not separated

from an object such as a wire essentially simultaneously with the forming of the anode pieces. Moreover, in this document, the working of the anode pieces is carried out for instance by pressing, and not by one-stage rolling. The present invention intends to separate the anode pieces and form them, i.e. work them, in one step and not in two steps, as in the known method.

Another method for manufacturing essentially ball-shaped pieces is known from DE-B-103 459 but, contrary to methods such as that of EP-A-0 048 794, it is not specified as being for manufacturing anode pieces suited for an electroplating bath, so that the skilled person would not take it into account because the problem addressed to is in any case different. The information derivable from the prior public use alleged by the respondent is insufficient and thus not significant enough in the present context. Therefore, starting from the method known from EP-A-0 048 794, the skilled person found no specific incentive for using one-stage rolling.

Results of comparative measurements, filed with the statement of grounds, show the advantages, having respect to their function as anode, obtained with the balls made by the presently claimed method as compared to the heavily forged balls of EP-A-0 048 794 which in particular have a passivation layer. These results are relevant to the present invention and to the method of EP-A-0 048 794, respectively, as can be confirmed by the person responsible for these measurements, if necessary. Therefore, the claimed method involves an inventive step.

Reasons for the Decision

1. The appeal is admissible.
2. *Procedural matters*

According to the decision T 958/92 of 18 December 1995, unpublished, reported in the "Special Edition of Official Journal 1997 - Case law" of the European Patent Office, page 112, point 3.2, second paragraph, in cases in which the respondent was the opponent and withdrew his opposition during the appeal proceedings, the Opposition Division's decision was not examined "as a matter of course", but as a result of the appeal, i.e. on the basis of the "request" by the appellant for the contested decision to be revoked.

In the present case, the respondent (opponent) having declared by letter dated 18 September 1997, i.e. during the appeal proceedings, that he withdrew the opposition, and the appellant having requested, inter alia, that the contested decision be set aside, the procedure expressed in the decision T 958/92 can be followed (Rule 60(2) EPC).

3. *Admissibility of the amendments and clarity*

Present claim 1 had formed the basis for the impugned decision and the Board agrees to the findings in said decision insofar as the admissibility of the amendments and the clarity of the claim had not been objected (Articles 123(3), 123(2) and 84 EPC).

4. *Patentability*

- 4.1 As convincingly argued by the appellant, the crucial question is whether the specific feature of the simultaneous separating of the anode pieces and their forming as ball-shaped pieces by one-step rolling was known or made obvious by the state of the art.
- 4.2 The Board is satisfied that the subject-matter of present claim 1 is new in the sense of Article 54 EPC, and this has not been contested either.
- 4.3 A method for manufacturing a profile for electrolytic treatment, i.e. suited for an electroplating bath, is known from EP-A-0 048 794 (see in particular page 1, line 23 to page 2, line 1, more in particular page 1, line 35 to page 2, line 1; claim 2); the profile is composed of some anode material which is separated from a wire-shaped object ("Abschnittsstücken von Kupferdrähten"), i.e. an object essentially longer than the diameter of the anode piece to be produced. Moreover, the method produces an essentially ball-shaped anode piece.

However, contrary to the presently claimed method, the anode piece produced in the known method is separated from the wire and then the separated piece is submitted to mechanical treatment to form it as a ball; thus, the anode piece is not separated from an object such as a wire essentially simultaneously with the forming of the anode piece. Moreover, in EP-A-0 048 794, the working of the anode piece is specified as being carried out for instance by pressing, and not by one-stage rolling, as in present claim 1.

- 4.4 As convincingly argued by the appellant, EP-A-0 048 794 represents the closest prior art in that, contrary to the other prior art documents, it is concerned with the manufacture of anode pieces.

It is derivable from the patent in suit (see column 1, line 54 to column 2, line 1 and column 2, lines 25 to 34) that an object of the invention can be seen in separating the anode pieces and forming them, i.e. working them, in one step and not in two steps, as in the method of EP-A-0 048 794.

Incidentally, it is to be noted that the appellant has provided with the statement of grounds of appeal results of comparative measurements on the basis of balls made according to the method in suit and to the method of EP-A-0 048 794, respectively. The arguments of the appellant, in particular against objections of the respondent about the relevance of said measurements, are convincing and have not been refuted by the respondent, who afterwards has withdrawn his opposition.

- 4.5 A method for manufacturing an essentially ball-shaped piece is otherwise known from DE-B-103 459 (see the whole document, and in particular the claim); a plurality of ball-shaped pieces ("Metallkugeln") are made by this method, which uses pairs of rollers and which is derivable as including indeed a step of separating said ball-shaped piece from an elongated object ("Werkstückstange"), i.e. from an object essentially longer than the diameter of the piece to be produced. However, contrary to the presently claimed method, this known method is not specified as being for manufacturing an anode piece suited for an

electroplating bath. Moreover, in DE-B-103 459, there is no mention of one-stage rolling for forming the ball-shaped pieces; on the contrary, a plurality of successive facing pair of rollers ("durch die Anwendung mehrerer hinter einander angeordneter Walzenpaare (b)") is mentioned. The passage bridging pages 1 and 2 of DE-B-103 459 indicates that it is **necessary to increase the number of successive pairs of rollers** when using an elongated object having a more important transversal dimension for fabricating bigger ball-shaped pieces, because **each pair of rollers can cut only 2 to 3 mm into the elongated object** and the last pair of rollers is intended only for completely separating and round-shaping the pieces. In the impugned decision, it was derived from this passage a teaching that, reasonably, this could imply that if, conversely, it was intended to produce ball-shaped objects of relatively small dimensions, then resorting to a one-stage rolling step would be a measure which the skilled person aware of the teaching of this document would be induced to adopt without exercise of inventive ingenuity, i.e. he would use thinner bars or softer materials to produce ball-shaped anodes of relatively small dimensions. This reasoning can however not be accepted: there is in DE-B-103 459 no indication whatsoever about the use of only one pair of rollers for forming the ball-shaped pieces or about decreasing the number of pairs of facing rollers. Incidentally, the last pair of facing rollers is mentioned as doing the complete separation and some forming of the balls ("zum vollständigen Abschneiden und zur Rundung der Kugeln"). However, this concerns the last pair of facing rollers, applied to an object which has already been submitted to the action of the preceding pairs of rollers, so that the elongated object which is submitted to this last pair of rollers is not identical with the object, i.e. a wire, from which anode pieces are made in EP-A-0 048 794 (see claim 2). Therefore, the arguments

of the respondent are not convincing with respect to incentives for using one-stage rolling by taking into account DE-B-103 459 for making anode balls as those known from EP-A-0 048 794.

4.6 The impugned decision can be followed insofar as it does not contain any reference to the alleged prior public use. Indeed, the specific feature mentioned above of the simultaneous separating of the anode pieces and their forming as ball-shaped pieces by one-step rolling is not made obvious by the mere information that "rolling" is used for manufacturing anode balls.

4.7 Therefore, the subject-matter of claim 1 involves an inventive step in the sense of Article 56 EPC and, consequently, the claim is allowable (Article 56 and 52(1) EPC). Therefore, the patent can be maintained in amended form according to appellant's present request (Article 102(3) EPC).

5. Since appellant's present main request is allowable, it is not necessary to take into account his auxiliary request for oral proceedings.

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 with the order to maintain the patent in amended form with the following patent documents:

Description: columns 1 to 3 of the European patent as granted;

Claims: No. 1 filed during the oral proceedings of 30 April 1996 (see item 2 of the minutes) in the opposition procedure and cited in the impugned decision of the Opposition Division, in the passage bridging pages 2 and 3;

Nos. 2 to 4 of the European patent as granted;

Drawings: Sheet 1 of the European patent as granted.

The Registrar:

The Chairman:

E. Görgmaier

E. Turrini