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D E C I S I O N
of 7 May 2002

Case Number: T 0375/00 - 3.2.7

Application Number: 88304472.9

Publication Number: 0292246

IPC: B27G 13/08

Language of the proceedings: EN

Title of invention:

Wood working tool

Patentee:

ARBORTECH INDUSTRIES PTY LTD.

Opponent:

Firma Reiling GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 56, 69(1), 84, 112(1)(a), 113(1), 117(1), 123(2) and
123(3)

EPC R. 67, 68(2) and 72(1)

Keyword:

"Referral to Enlarged Board of Appeal (refused)"

"Request to appoint expert (refused)"

"Violation of right to be heard (no)"

"Reimbursement of appeal fee (no)"

"Inventive step (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0375/00 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 7 May 2002

Appellant: Firma Reiling GmbH
(Opponent) Remchinger Str. 4
D-75197 Königsbach-Stein (DE)

Representative: Leitner, Waldemar, Dr. techn.
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Respondent: ARBORTECH INDUSTRIES PTY LTD
(Proprietor of the patent) 50 Westchester Street
Malaga
Western Australia (AU)

Representative: Butler, Lance
Barker Brettell
10-12 Priests Bridge
London SW15 5JE (GB)

Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 14 February
2000 concerning maintenance of European patent
No. 0 292 246 in amended form.

Composition of the Board:

Chairman: A. Burkhart
Members: P. A. O'Reilly
E. Lachacinski

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division to maintain amended the European patent No. 0 292 246.

Opposition had been filed against the patent as a whole based on Article 100(a) EPC (lack of inventive step).

The Opposition Division held that the ground of opposition according to Article 100(a) EPC did not prejudice the maintenance of the patent as amended.

- II. The Opposition Division referred to the following documents:

D1: US-A-3 425 467

D2: GB-A-856 276

D3: US-A-2 884 031

D4: Brochure concerning Sandvik cutter

D5: DE-C-824 257

D6: DE-C-286 152

D7: DE-C-286 734

D8: DE-C-301 957

D9: DE-C-302 102

In addition they referred to a cutter produced and sold

by Sandvik and hereinafter referred to as the "Sandvik cutter" prior use

III. In his grounds of appeal the appellant further referred to the following documents:

D10: DD-C-20 418

D11: FR-A-1 332 584

IV. On 7 May 2002 oral proceedings took place before the Board of Appeal.

The appellant requested that the decision be set aside and the patent revoked. In addition, the appellant requested that two witnesses be heard, that experts be heard, that a number of questions be sent to the Enlarged Board of Appeal, that the case be remitted to the first instance because of a procedural violation, and that the appeal fee be reimbursed.

The respondent (patent proprietor) requested that the appeal be dismissed.

V. With regards to the questions to be sent to the Enlarged Board of Appeal a first set of two questions concerned the right to be heard and Rule 68(2) EPC. The questions were essentially worded as follows:

1. Does a change of problem by an Opposition Division without warning contravene a party's right to be heard?
2. Does it offend against Rule 68(2) EPC when the Opposition Division does not explain in its

decision why it changed the problem?

A second set of questions concerned the hearing of experts under Article 117(1)(e) EPC. They were essentially worded as follows:

1. Is expert evidence in the sense of Article 117(1)(e) EPC to be understood as evidence provided by the parties or is it exclusively expert evidence commissioned by the European Patent Office?
2. Is it the duty of the parties to opposition proceedings themselves to inform the European Patent Office of the name of an expert without being previously invited to do so in accordance with Rule 72(1) EPC?

A third set of questions concerned an alleged requirement for instances of the European Patent Office to examine evidence under Articles 113 and 117 EPC. They were essentially worded as follows:

1. Is an organ of the European Patent Office required to convince itself of the relevance of offered evidence before it accepts or rejects the evidence?
2. Under which circumstances can an examination as to the relevance of evidence be dispensed with?
3. Does the refusal of an Opposition Division to consider timely presented evidence contravene the rights of a party to choose its means of evidence and its right to be heard?

VI. The single independent claim of the request maintained by the Opposition Division reads as follows:

"1. A rotary cutter adapted to be mounted on a spindle of a rotary hand tool, said cutter comprising in combination a circular rigid member (3) adapted for mounting coaxially on the tool spindle to rotate therewith; a plurality of spaced cutting teeth (7) arranged in a single row about the periphery of the member (3), integral therewith, each said cutting tooth (7) having a transverse cutting edge (8) extending in a direction transverse to the plane of tooth rotation to perform cutting in response to movement of the rotating cutter in a direction radially of the plane of tooth rotation, and each cutting tooth (7) having a radial cutting edge (9) extending in a direction generally radial to the plane of tooth rotation to perform cutting in response to movement of the rotating cutter in the direction normal to the plane of tooth rotation, the transverse cutting edges (8) of successive cutting teeth (7) projecting alternately towards opposite sides at the periphery of said rigid member (3) and wherein each cutting tooth (7) is relieved rearward of the respective transverse and radial cutting edges (8,9) and there are provided, integral with and arranged in a single row together with said teeth (7) about the periphery of the rigid member (3), a plurality of rigid depth control projections (12), one located in advance of each cutting tooth (7) in respect to the direction of tooth rotation, the radial extent of each projection (12) being less than that of the transverse cutting edge (8) it precedes, whereby the difference therebetween in radial extent limits the depth of cut of said transverse cutting edge (8), each said projection (12) having a portion (15) thereof spaced in

the direction normal to the plane of tooth rotation, from the radial cutting edge (9) it precedes, whereby the extent of said spacing controls the depth of cut of said radial cutting edge (9),

characterised in that

(a) the depth control projections (12) which precede the respective teeth are offset alternately with respect to one another in the direction normal to the plane of tooth rotation and (b) the rigid member (3) is of re-entrant dish shape, whereby the cutter may effectively cut simultaneously both in the direction radially of the plane of tooth rotation and in the direction normal to said plane of tooth rotation, with cutting depth being controlled in both cutting directions so that the tool is adapted for use in the wasting and shaping of wood to produce a simple or compounded curved surface."

VII. The appellant essentially argued in written and oral proceedings as follows:

The scope of the claims under Articles 84 and 69(1) EPC depends upon the technical problem to be solved. The technical problem on which the Opposition Division based their decision is different to the problem stated in the patent as granted. Moreover, this new technical problem is incorrect and not covered by the original disclosure. This leads to a lack of clarity. Also, the feature that the rotary cutter is "adapted to be mounted" on a spindle is not clear. It is not clear to which extent the cutter is adapted to be mounted on a spindle.

The amendments to claim 1 do not conform with Article 123(2) EPC. The technical problem used by the

Opposition Division is not supported in the description and therefore offends against Article 123(2) EPC.

The amendments to claim 1 extend the scope of protection and thus do not comply with Article 123(3) EPC. The amendment of claim 1 to change the wording "A rotary cutter to be mounted" to "A rotary cutter adapted to be mounted" extends the scope of protection since the latter expression is broader. In particular, the expression could include rotary cutters not provided with a central hole for fitting on the spindle. Also, the change of problem by the Opposition Division in their decision extends the scope of protection. The problem to be solved by the invention is used by courts to determine the extent of protection in accordance with Article 69(1) EPC and hence the change extends the scope of protection.

The Opposition Division has violated the right to be heard of the appellant under Article 113(1) EPC since the problem to be solved as set out in the their decision was not mentioned beforehand. Moreover, the Division did not consider the evidence offered by the appellant in the form of witnesses and experts. A party has a free choice of the offered evidence which it chooses and the refusal of the Division to consider the evidence violated the appellant's right to be heard.

The decision of the Opposition Division contravenes Rule 68(2) EPC since the Division have not justified in the grounds for their decision why the problem on which the invention is based was changed by the Division in their decision. Also, the decision does not explain why evidence offered by the appellant was ignored.

In view of the serious violations of the appellant's right to be heard a reimbursement of the appeal fee pursuant to Rule 67 EPC is appropriate.

The subject-matter of claim 1 is obvious. The Sandvik cutter discloses all the features of the preamble of claim 1. In addition, it discloses the feature a) of claim 1. Feature b) of claim 1 has no combinatorial effect with feature a), forming no more than an aggregation therewith. Moreover, feature b) is known in the state of the art, in particular from documents D6, D7 and D8 wherein the feature ensures that the attaching means for the tool do not project. Documents D10 and D11 are introduced into the proceedings in order to demonstrate that cutting tools having transversal and radial cutting edges and depth control projections are known to the person skilled in the art.

VIII. The respondent essentially argued in written and oral proceedings as follows:

The Sandvik cutter, whilst disclosing many features of claim 1 is not an appropriate starting point for a skilled person as it is not a carving tool. The Sandvik cutter does not disclose feature a) of claim 1 as is evident by inspection of the cutter. Feature b) of claim 1 improves the control and stability as it renders the cutter more rigid. The documents D10 and D11 introduced by the appellant do not bring anything more as the existence of depth limiters having the same shape as their respective teeth is already acknowledged in the patent in suit. Documents D10 and D11 concern teeth for chain saws. There is no hint that the teaching of these documents could be applied to a carving tool.

The word "adapted" as introduced into claim 1 is a clarification which has no effect on the scope of the claim. There is therefore no offence against Articles 84 or 123(2)(3) EPC.

The new objective problem used by the Opposition Division is based on the original disclosure, see in particular, column 1, lines 3 to 27, column 2, lines 12 to column 3, line 4. The new problem is hence consistent with the originally file specification. There is therefore no conflict with Articles 84 or 113(1), or Rule 68(2) EPC. The change is therefore allowable.

Reasons for the Decision

1. *Procedural matters*

1.1 Request to hear witnesses

The appellant requested that a witness, Mr. Buchholz, should be heard. Mr. Buchholz would testify that chain saws had been used for carving and that they had depth limiters which were offset alternatively. However, the respondent had already admitted that chain saws are used for wood carving (see column 1, lines 6 to 9 of the patent in suit). Also, teeth for chain saw with depth limiters which are alternately offset are known from document D11. It was not therefore necessary to hear this witness.

The appellant also requested that a witness, Mr. Dußler, should be heard. Mr. Dußler would discuss the Sandvik cutter. The cutter however could be considered

without Mr. Dußler and no indication was given of any contribution that Mr. Dußler could make to the proceedings. It was not therefore necessary to hear this witness.

1.2 Requests for expert evidence

1.2.1 The expert Professor Ettel

The appellant requested that this expert be called to show that the depth limiters of the Sandvik cutter were offset alternately. However, the depth limiters of the Sandvik cutter were investigated visually and tactilely by the Board. The Board came to the conclusion that there was no doubt whatsoever that the depth limiters were not offset at all and hence not offset alternately. Given this clear situation the offered expert could do nothing but confirm these facts. The appellant gave no indication as to how the expert could show something different. It was not therefore necessary for this expert to be heard.

1.2.2 Unnamed experts

The appellant 'offered' as evidence expert opinion on a number of matters. The appellant wished that the Board should find and appoint an expert in accordance with Article 117(1)(e) EPC who would support aspects of the case of the appellant. In general, the expert was expected to testify to matters concerning the cited documents and prior used cutter. The matters concerned technical interpretation of documents and consideration of how the Sandvik cutter could work. In the opinion of the Board an expert is only then necessary when the Board does not consider itself in a position to decide

upon a matter without technical assistance. As the Board includes two technically qualified members such cases will be rare and will only occur in special circumstances. Such special circumstances do not occur in the present case which is a relatively simple mechanical case. Moreover, it was open to the appellant for himself to actively find the necessary evidence. The appellant has not done this. If the Board were to be active in seeking experts to help the case of a party then the Board could be open to an accusation of not acting impartially. It is therefore neither necessary nor desirable for the Board to obtain the evidence of an expert in this case.

1.3 Questions for the Enlarged Board of Appeal

The appellant requested that a number of questions be sent to the Enlarged Board of Appeal (see point V above). The first set of questions concerning the change of problem do not concern any question of requiring the uniform application of the law or an important point of law as indicated in Article 112(1)(a) EPC. Moreover, the decision of the Board depends upon the facts of the case under consideration and therefore does not require an opinion of the Enlarged Board of Appeal. The second set of questions concerning the calling of experts do not need to be sent the Enlarged Board of Appeal as the answers to these questions would not affect the outcome of the present case. As indicated above, the opinion of the experts was not required to decide the case. The third set of questions concerning the examination of evidence offered by a party also do not need to be sent the Enlarged Board of Appeal as the answers to these questions also would not affect the outcome of the

present case as indicated above.

1.4 Right to be heard - change of problem

The appellant considered his right to be heard to be violated on the basis that the problem mentioned by the Opposition Division in their decision was different to that discussed in the preceding proceedings. It may first be noted that the objective problem would appear to be part of the arguments rather than grounds as specified under Article 113(1). Moreover, the grounds of the decision (see paragraph 6.7 of grounds) indicated that the essential reason why, in the opinion of the Opposition Division, the subject-matter of claim 1 involved an inventive step was that the combination of distinguishing features was "without example in the prior art". Since the appellant had ample opportunity to convince the Opposition Division that the distinguishing features of claim 1 were obvious to the skilled person and had failed to do so, a violation of his right to be heard can not be ascertained.

1.5 Right to be heard - witnesses and experts not called

According to the minutes of the oral proceedings before the Opposition Division the appellant requested revocation of the patent for lack of inventive step and also infringement of Articles 123(3) and 84. The appellant at that point did not maintain his request for the hearing of witnesses. His previous written requests must be considered to be no longer standing at that point. In the oral proceedings the only reference by the appellant to an expert was to prove that the Sandvik cutter has a radial cutting edge. This feature

however is in the preamble of claim 1 making expert evidence superfluous. Thus, when the decision was taken at the end of the oral proceedings the only request for hearing a witness related to proving the presence of a feature which was in the preamble of claim 1. A violation of the appellant's right to be heard cannot be ascertained by the Board in this respect.

1.6 Contravention by the Opposition Division of Rule 68(2) EPC

Rule 68(2) EPC requires that decisions shall be reasoned. The reasons allow a party affected to become aware of why a decision was taken in a particular direction. The party is then able to consider whether, in view of the reasons, the decision is correct. An explanation of why a change was made in the problem is not essential to a party wishing to understand why a decision was taken in a particular direction. Such an explanation would appear to be more a statement of the evolution of the thinking of the Division. With regards to the failure of the decision to mention the witnesses or experts that were offered it has already been explained above that at the time that the decision was taken relevant witnesses and experts were no longer offered. The one expert which was mentioned in the minutes of the oral proceedings would have only confirmed a feature in the preamble of claim 1. Hence, there was no reason to mention the witnesses or experts in the written decision. The Board cannot therefore identify any contravention of Rule 68(2) EPC by the Opposition Division.

1.7 Request for reimbursement of the appeal fee

Since the appeal is not deemed allowable the appeal fee may not be reimbursed following from Rule 67 EPC.

2. *Article 84*

The clarity of claim 1 has been attacked with respect to the expression "adapted to be mounted" at the start of the claim in the wording: "A rotary cutter adapted to be mounted on a spindle". This expression is conventionally understood to mean 'capable of being mounted', i.e. having those features which allow the cutter to be mounted on a spindle. The Board concurs with the conventional understanding. The Board cannot follow the argument of the appellant that the amount of adaption is unclear. The amount of adaption is that which is sufficient to allow the cutter to be mounted on a spindle.

The Board is unable to follow the arguments of the appellant with regards to the effect of Article 84 EPC on the change of problem. There has been no change of problem in the description of the patent. Therefore Article 84 EPC, even when considered in the light of Article 69(1) EPC, cannot be affected since Article 69(1) EPC together with its protocol refers only the claims, description and drawings. It does not refer to a decision of an instance of the European Patent Office.

3. *Article 123(2) EPC*

The Board cannot agree with the arguments of the appellant that the change of problem in the decision of the Opposition Division contravenes Article 123(2) EPC. This article is directed to amendments in the European

patent application or European patent. In the present case, the change of problem in the decision is not however an amendment of the patent since nothing in the content of the patent specification has changed.

4. *Article 123(3) EPC*

The Board cannot follow the arguments of the appellant that the amendment from "A rotary cutter to be mounted" to "A rotary cutter adapted to be mounted" extends the scope of protection. As already indicated above the expression "A rotary cutter adapted to be mounted on a spindle" is conventionally understood to mean capable of being mounted. The same meaning is conventionally given to the expression "A rotary cutter to be mounted". In the opinion of the Board no difference in meaning can be seen in these expressions. As the two expressions have the same meaning there can be no extension of the extent of protection.

Also, the change of problem in the decision of the Opposition Division cannot lead to an extension in the scope of protection. As already indicated with respect to Article 84 EPC, Article 69(1) and its protocol refer only to the claims, description and drawings. There is therefore no basis in the Convention for a change in the extent of protection based on a change of problem in a decision of an instance of the European Patent Office.

5. *Inventive step*

5.1 Closest prior art

The closest prior art is considered by the Board to be

a chain saw as previously used for rough carving of wood. This is acknowledged in the patent and was also considered by the appellant in the oral proceedings to be the closest prior art. The preamble of claim 1 is based on the features disclosed in the Sandvik cutter. However, the Sandvik cutter is a rotating blade which is intended for cutting through the stems of bushes and trees. As such the cutter cuts a groove through the stem. The Sandvik cutter, due to its blade-like form and small teeth on the periphery, is unsuitable for even rough carving of wood and hence does not provide a plausible starting point for the skilled person.

5.2 Problem to be solved

The problem to be solved is to provide a carving tool that can perform part of the removal of wood usually done with a chain saw and/or chisel, see column 1, lines 24 to 27 of the patent as granted.

5.3 Solution to the problem

The problem is solved by a rotary cutter having the features of claim 1. This problem is particularly solved by the provision of teeth having radial cutting edges in addition to transverse cutting edges, the radial cutting edges being alternately offset in a direction normal to the rotation plane, depth control projections which precede the cutting teeth and have a portion which is offset normal to the rotation plane to control the depth of cut of the radial edges with the offsetting also being alternate, and by the cutter having a re-entrant dish-shape. This combination of features allows the rotary cutter to cut in a transverse direction. Also, due to its re-entrant dish

shape the attachment means for the cutter to a spindle carrying the cutter may be protected and the cutter may be used to work curved forms of sculpture which is essential to function as a carving tool. The re-entrant dish shape strengthens the cutter in the direction normal to the rotation plane thus making the device more suitable for transverse carving.

5.4 The solution to the problem is not obvious for the following reasons.

A skilled person considering the known chain saw or chisel and wishing to solve the problem would not consider the Sandvik cutter. The cutter, both from the instructions on the accompanying leaflet and from its form, is clearly only intended and suitable for cutting directly through bushes and small tree trunks. The blade of the cutter is thin and the teeth are small. The teeth are offset normal to the rotation plane but only to a small extent sufficient to create a groove which will not produce friction on the blade as the blade goes deeper into the groove. There are depth limiters. The depth limiters function to limit the depth of cut in the radial direction. The depth limiters would also limit the depth of cut in the direction normal to the rotation plane in as much as the small offset normal to the rotation plane can produce any cutting action in this direction.

In the opinion of the Board the depth limiters of the Sandvik cutter are clearly not offset in a direction normal to the rotation plane. This is easily confirmed visually and tactilely. Also a photograph of the blade in the document D4 indicates from the visible shading

that there is no offsetting. The insistence of the appellant of maintaining an opinion to the contrary and his claim that an expert witness could support this view are not credible.

Thus, even if the skilled person did consider the Sandvik cutter he would still be a long way from the invention as claimed. The Sandvik cutter not only lacks alternately offset depth limiters, it is also not re-entrant dish shaped. The skilled person would not consider altering the shape of the Sandvik cutter since then it would cease to function. If the cutter had any shape other than flat it would be unable to cut a groove through a stem of a bush or tree. Hence, the skilled would not wish to change the shape of the Sandvik cutter.

The appellant has referred to documents D5 to D9 as examples of cutters with re-entrant dish shapes. However, those documents disclose cutters for milling machines. Their dish shape provides a radially exterior surface having cutting surfaces therein and the shape of the exterior surfaces determining the shape of the cut made in wood pieces applied to this exterior surfaces. They are used, for instance, in producing beading. The skilled person would have no indication from these documents that a re-entrant dish shape can be useful in a tool for carving wood to any desired shape, as opposed to a shape determined by the shape of the cutting tool.

The appellant has also referred to documents D10 and D11 as examples of tools having alternately offset depth limiters. The Board first notes that both these documents refer to teeth for chain saws which are not

rigid members for mounting on a spindle as in the patent in suit. The Board is of the opinion that at least in document D11 there are disclosed depth limiters which are alternately offset in the manner specified in claim 1. These are visible in Figures 16 to 23. However, the Board considers that the skilled person would not derive from document D11 a teaching to provide this form of teeth in a rotary cutter capable of carving. The purpose of the radial cutting edges and their respective depth limiters in D11 is to define the sides of a groove being cut in wood. This is visible in Figure 7. The skilled person would therefore find no teaching to help him solve the problem of providing a carving tool which must be able to work on curved surfaces.

The appellant has based his arguments starting from the Sandvik cutter. However, also starting from the Sandvik cutter the Board is of the opinion that the subject-matter of claim 1 involves an inventive step. The argument of the appellant that the Sandvik cutter also discloses the feature a) of claim 1 concerning the depth limiters being offset alternately cannot be followed by the Board for the reasons already stated above. Also, the argument of the appellant that the skilled person would provide the Sandvik cutter with a re-entrant dish shape to protect the attachment means to the spindle cannot be followed. As already explained above the change in shape of the Sandvik cutter would mean that it can no longer function as a cutter. The thin shape of the cutter makes it only suitable for cutting grooves and the shape change would make this function impossible. There is no reason for the skilled person to alter the Sandvik cutter in such a way that it would no longer fulfill its intended use.

The further argument of the appellant that there is no combinatorial effect of the features a) and b) of claim 1 cannot be followed by the Board. Feature a) is necessary to allow safe cutting normal to the plane of rotation of the rotary cutter. Feature b) provides a strengthening in this normal direction and hence provides a clear combinatorial effect in addition to the fact that both feature combine to solve the problem of providing a carving tool.

Therefore, the subject-matter of claim 1 involves an inventive step in the sense of Article 56 EPC.

Order

For these reasons it is decided that:

The Appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

A. Burkhart