



Case Number: T 0469/00 - 3.2.6

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.6  
of 9 January 2003 correcting the  
Decision of 12 July 2002

**Appellant:**  
(Proprietor of the patent) ISELI & CO. AG  
Maschinenfabrik  
CH-6247 Schotz (CH)

**Representative:**  
Patentanwälte Feldmann & Partner AG  
Kanalstrasse 17  
CH-8152 Glattbrugg (CH)

**Respondent:**  
(Opponent) VOLLMER WERKE Maschinenfabrik GmbH  
Ehinger Strasse 34  
D-88400 Biberach/Riss (DE)

**Representative:**  
Goetz, Rupert, Dipl.-Ing.  
Wuesthoff & Wuesthoff  
Patent- und Rechtsanwälte  
Schweigerstrasse 2  
D-81541 München (DE)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 10 April 2000  
revoking European patent No. 0 334 594 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. Alting van Geusau  
**Members:** G. C. Kadner  
M. B. Tardo-Dino

In application of Rule 89 EPC the Decision of 12 July 2002 is hereby corrected as follows:

In point VII of the Summary of Facts and Submissions on page 4, line 13 and in points 2.3 and 2.4 of the Reasons on page 7, lines 3, 17, 31, 34 and 38, the word "confidentially" is replaced by the word "confidentiality".

The Registrar:

M. Patin



The Chairman:

P. Alting van Geusau



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(D) [ ] No distribution

**D E C I S I O N**  
of 12 July 2002

**Case Number:** T 0469/00 - 3.2.6

**Application Number:** 89302781.3

**Publication Number:** 0334594

**IPC:** B23D 65/00

**Language of the proceedings:** EN

**Title of invention:**  
Tipped tools

**Applicant/Patentee:**  
ISELI & CO. AG

**Opponent:**  
VOLLMER WERKE Maschinenfabrik GmbH

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 52(1), 54(1), 56  
EPC R.67

**Keyword:**  
"Disclosure by means of an offer - yes"  
"Novelty (main request) - no"  
"Inventive step (auxiliary request) - no"

**Decisions cited:**  
T 0782/92, T 0750/94, T 1191/97, T 0830/90, T 0887/90

**Catchword:**  
-



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## Summary of Facts and Submissions

- I. The mention of the grant of European patent No. 0 334 594 in respect of European patent application No. 89302781.3 filed on 21 March 1989 and claiming a British priority from 25 March 1988 was published on 10 August 1994.
- II. Notice of opposition was filed against this patent on the grounds of Article 100(a) EPC (lack of novelty and inventive step).
- III. By decision announced during the oral proceedings on 6 March 2000 and posted on 10 April 2000 the Opposition Division revoked patent No. 0 334 594.

The Opposition Division was of the opinion that neither the claims as granted nor those according to a first and second auxiliary request submitted during the oral proceedings met the requirement of novelty having regard to a prior art disclosure substantiated by:

D16: W&W12, Offer No. 9286 of bars and saw teeth of Stellite 12 PM from the company DELORO dated 16.11.1987

D17: W&W13, Sworn Statement of Mr. Wolf Kehrle dated 19.12.96 ("Eidesstattliche Erklärung")

Concerning the Patentee's submission that D16 was the result of a breach of the confidential commercial relationship between the company DELORO and the Patentee and for this reason should be ignored under the provisions of Article 55 (1)(a) EPC, the Opposition Division was of the opinion that in accordance with office practice the six months period of Article 55(1)(a) EPC was to be calculated back from the actual date of filing of the application, and since the

application of the patent in suit was filed on 21 March 1989 and the offer of the company DELORO (D16) was received by the Opponent on 17 November 1987, earlier than six months preceding the filing date, Article 55(1)(a) EPC did not apply in the present case.

- IV. On 12 May 2000 notice of appeal was lodged against this decision together with payment of the appeal fee.

The statement of grounds of appeal was filed on 9 August 2000.

- V. In a communication dated 10 May 2002 the Board pointed out that with respect to Article 55(1) the calculation of the six months period applied by the Opposition Division had been confirmed by Decision G 0003/98. If the prior art disclosure of D16 would continued to be contested taking of evidence by hearing witnesses would be necessary. If the content of D16 would be considered to belong to the prior art novelty and inventive step would have to be discussed taking further into account:

D1: US-A-3 295 396

- VI. Oral proceedings were held on 12 July 2002. Before the case was discussed with the parties Mr. Wolf Kehrle was heard as witness (Minutes of the hearing on file).

The Appellant (Patentee) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims in accordance with the first auxiliary request filed before the Opposition Division or maintained on the basis of claims 1 and 2 of this request (auxiliary request).

He further requested reimbursement of the appeal fee for reasons of a substantial procedural violation.

The Respondent requested that the appeal be dismissed.

Independent claims 1 and 3 of the main request read as follows:

"1. A method of producing, for use as tips for tools involving teeth having tips of material that is harder than that of the remainder of the tool, a bar or rod of the tip forming material from which individual tip forming lengths are successively removed from the bar or rod following attachment of each tip forming length to a said tool tooth, characterised in that during the production of the rod or bar (18, 23) from Stellite the bar or rod with a trapezoidal cross section is provided with four longitudinally directed surfaces (19, 20, 21, 22; 23, 24, 25, 26) which are so angularly related to each other that on application of the tip forming length of the bar or rod to a tooth to be tipped, the surface (19, 24) forms the front face of the tip, the surface (20, 27) that is opposite to the one face providing the rear face for the tip, whilst the remaining two surfaces (21, 22; 25, 26) provide the side faces or flanks of the tip.

3. A rod or bar from which tips for use with tools involving teeth having tips of material that is harder than that of the remainder of the teeth may be successively removed following attachment of an end of the bar to a tooth to be tipped, characterised in that the rod or bar with a trapezoidal cross section is formed from Stellite and is so preformed during the initial production thereof as to have four longitudinally extending surfaces (19, 20, 21, 22; 24, 25, 26, 27) which when a tip forming length is mounted to a tooth in a predetermined direction with respect to the tool, the surfaces (19, 24) correspond to the front face, the surfaces (20, 27) rear face and the surfaces

(21, 22; 25, 26) side or flank faces of the resulting tips."

VII. In support of its request the Appellant essentially relied upon the following submissions:

The offer according to D16 included different products, saw-teeth made of Stellite being immediately available whereas the bars made of Stellite of trapezoidal cross section required investment by the company Vollmer-Werke to share costs for the production tools. This would clearly indicate that these bars resulted from a joint development. Such a cooperation between two companies implied confidentially. The circumstances of the offer of Stellite bars thus indicated that the relation between both companies was based on the general principle of good faith, and that none of the parties would spread the information to third persons outside the companies Deloro Stellite GmbH and Vollmer-Werke GmbH.

When compared with similar cases decided by the Boards of Appeal, for instance with regard to T 0541/92, T 0073/86, T 0162/87, T 0293/87, T 0750/94, T 0097/91, T 0634/91, T 0830/90, conclusively inherent secrecy in the present case had to be assumed. As also the hearing of the witness did not result in more specific information about the circumstances of the offer according to D16, the information in that offer concerning Stellite bars of trapezoidal cross section had not been publicly available.

In respect of inventive step the prior art documents D1, D2 and D3 did not include any indication which would lead the skilled person to the method according to claim 1. D1 disclosed only teeth of a rectangular cross section which required grinding or setting of the teeth because otherwise the saw blade would get jammed.



The dimensions of the carbide rod of 32/1000 inch (about 0,8 mm) square in cross section used there indicated that the teeth were only coated with the harder material. The dimensions disclosed in D2 did not exceed those of D1, and according to D3 only the tips of the teeth were formed of hard cutting material. No indication was given in any of these documents to use a bar of trapezoidal cross section, and already the costs per weight unit of the Stellite bars offered in D16 would prevent the skilled person from using such an expensive material as claimed in the patent in suit when considering the quantity required in case of the bar of 6 and 5 mm lateral lengths and 4 mm height. Consequently the inventor had to overcome a commercial prejudice. This was confirmed by the general technical development in the field of tipped saw blades because the products of the competitors appeared on the market only several years after the application date of the patent, and not before 1996.

VIII. The submissions of the Respondent are summarised as follows:

The circumstances of the offer D16 confirmed by hearing of the witness indicated that there was no obligation to secrecy. Since under Pos. 1) and Pos. 2) in D16 different products were offered in one document, some of which were Deloro standard products, it was obvious that the offer was part of usual business relations between two companies.

As already indicated by the statement of Mr. Guan Inn Tuck (D11) Stellite bars for tipping the teeth of saw blades were generally known many years before the priority date. This knowledge was also available in the company Vollmer-Werke. Therefore no reason existed why the offer of Stellite bars of trapezoidal cross section

according to D16 should be treated confidentially, neither by the supplier nor by the customer.

### Reasons for the Decision

1. The appeal is admissible.
2. *Alleged prior art in relation to a description of a Stellite bar of trapezoidal cross section in D16*
  - 2.1 Description in D16 of a bar of Stellite of trapezoidal cross section was not contested. It is true that the Stellite bars (Pos. 1) Nr. 2 and 3 were not available at the date of the offer because of costs for tools which were required to produce them. However, the subject-matter disclosed in the form of an offer is clearly derivable from the description as being bars of defined length of trapezoidal cross section with defined dimensions.
  - 2.2 The Appellant stressed that the circumstances of the offer indicated an inherent obligation to secrecy between the supplier and the possible customer. For this reason the information included in D16 could not be seen to be publicly available before the priority date of the patent in suit.

Since the evidence given in the statement of an employee (D17) provided by the Respondent was doubted (as to whether there was an inherent obligation to secrecy about the subject-matter of the offer) the Board considered it appropriate to hear the author of that statement as witness for further clarification of this matter.

- 2.3 After having heard the witness the Board concludes that the circumstances under which the offer (D16) was received do not give any indication of confidentiality.

The fact that the witness could not remember in detail the circumstances as to how the offer was initiated is not detrimental to the credibility of the witness in view of the number of years passed since the date of the offer (see also T 1191/97). The explanations given by the witness according to which offers were usually based on an inquiry and as to how such offers were treated within the company, the Board is convinced that the offer in question did not fall under the category of cases also mentioned by the witness, in which there was a danger that confidential know-how could get outside the company and therefore were to be treated separately. Non-confidentially also follows from the fact that the offer not only comprised trapezoidal Stellite bars under Pos. 1) but also included a round bar and saw teeth under Pos. 2) both items obviously being part of a standard supply program and as such were readily available. Generally, since for parts of a standard supply program public availability has to be supposed, and the fact that the Stellite bars are offered in one line with such standard parts without any indication present in the offer of the bars to be handled in a different manner than the offer of the teeth, the Board is of the opinion that the offer D16 lacks any confidentiality.

- 2.4 The decisions cited by the Appellant in support of its arguments in view of confidentiality of the offer are based on different facts and issues which are not comparable with those of the present case. Generally they concern cases in which an indication of confidentiality was present or in which the evidence in support of a prior use was considered to be insufficient. Therefore they are not applicable in the

present case and consequently cannot lead to a different result.

- 2.5 Summarising, the Board arrived at the conclusion that the prior art disclosure in accordance with Article 54(2) EPC of Stellite bars of trapezoidal cross section by D16 is proven without any gap in the chain of evidence. In particular, any hint is lacking towards an obligation of secrecy on the employees of the Respondent being "third persons" (in contrast to T 0830/90 or T 0887/90).

3. *Main request - Novelty*

In the interlocutory decision of the Opposition Division lack of novelty of the subject-matter of claim 3 according to the main request and the first auxiliary request was concluded with respect to the Stellite bars disclosed in D16 (W+W 12). The present main request corresponds with the first auxiliary request, and therefore the grounds given in the Opposition Division's decision are still valid. The Board does not see any error or inconsistency in these reasons and makes it part of its decision in respect of novelty. Since the subject matter of claim 3 does not meet the requirement of novelty (Article 54(1) EPC) and this claim together with claims 1, 2 and 4 is part of the main request which can only be treated as a whole this request is not allowable (Article 52(1) EPC).

4. *Auxiliary request - Inventive step*

- 4.1 Claim 1 of the auxiliary request is related to a method of producing a bar or rod of tip forming material from which individual tip forming lengths are successively removed from the bar or rod following attachment of each tip forming length to a tool tooth.

The closest prior art is represented by D1 which document discloses a method of tipping teeth of a saw blade and other tools with a material that is harder than the remainder of the tool. Individual tip forming lengths 5 of a carbide rod 6 are successively removed following attachment of each tip forming length to a tool tooth.

Starting from such a known method the object of the patent in suit can be seen in providing a more economically practicable method for use of Stellite rods.

The solution of that technical problem is characterised in that during the production of the rod or bar from Stellite the bar or rod is provided with four longitudinally directed surfaces (19, 20, 21, 22; 23, 24, 25, 26) which are so angularly related to each other that on application of the tip forming length of the bar or rod to a tooth to be tipped, the basis surface (19, 24) of the trapezoid forms the front face of the tip, the opposite surface (20, 27) provides the rear face for the tip, whilst the remaining two surfaces (21, 22; 25, 26) provide the side faces or flanks of the tip. In such a manner grinding of the teeth to bring them in their final shape can considerably be reduced.

- 4.2 When looking for a solution to this problem the skilled person would find in D16 in addition to conventional tip forming materials, by means of simple Stellite tips (Pos. 2) or round bars (Pos. 1), also referred to in the patent in suit as a conventional method for forming tips when using that material (see figures 3 and 4), trapezoidal Stellite bar material. Considering that obviously all the material specified in D16 is intended for use in methods for welding or brazing Stellite tips to saw blades the skilled person would anticipate using

the trapezoidal bars in the method disclosed in D1 and by doing so would immediately arrive at the method of the auxiliary request (Article 56 EPC).

- 4.3 The Appellant argued that the skilled person having the knowledge of D1 would not deviate from the rectangular cross section of the known bars since the teeth would have to be set after being tipped (column 3, line 50 of D1). Even when considering the bars disclosed in D16, applying those bars of trapezoidal cross section of the offered dimensions would be excluded because of cost reasons and resistance against breaking them after being attached to a tooth.

The Board cannot follow this argumentation. According to the introduction of the specification of D1 the method disclosed therein relates especially to metal cutting band saws or blades, which do not successively require setting of the teeth and are merely dressed or shaped as in the conventional manner when for example round bars are used (column 1, line 44; column 3, lines 44 to 51).

- 4.4 The argument that the bars of about 20 mm<sup>2</sup> in cross section could not be broken after attachment cannot lead to a different conclusion because the method of claim 1 is neither limited to include a breaking step nor can it be seen that there is a large difference in cross section when using the conventional round bars of the size disclosed in D16.

Furthermore, the price of the Stellite bars of D16 is not a technical factor which would prevent the skilled person from trying a new technical method if it appears to be useful. When considering the application of bars of trapezoidal cross section in the method according to D1 the skilled person is also aware of the dimensions of the example given there of the carbide rod having a

dimension of thirty-two thousands of an inch (about 0,8 mm) square (column 2, lines 47 to 53). It is clear that the costs of the hard tipping material are essentially dependent on the dimensions of the bars, and that smaller dimensions in the range as used in the example of D1 require lower costs.

5. Summarising, for the above reasons the Board arrives at the conclusion that the subject-matter of claim 1 and claim 3 does not meet the requirements of patentability according to Article 52(1) EPC. Therefore the appeal is not successful.

6. *Request for reimbursement of appeal fee*

In accordance with rule 67 EPC a prerequisite for reimbursement of the appeal fee is that the appeal be allowed. Since this is not the case reimbursement is excluded.

In any case, the objection raised by the Appellant according to which the Opposition Division should have adjourned their decision in respect of the calculation of the six months period of Article 55(1) EPC until the Enlarged Board of Appeal decision was made public does not amount to a procedural violation since no such requirement exists under the EPC.

**Order**

**For these reasons it is decided that:**

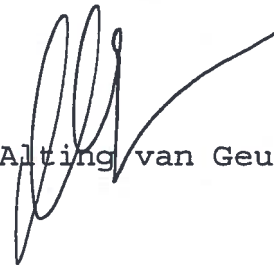
The appeal is dismissed.

The Registrar:



D. Sauter

The Chairman:



P. Alting van Geusau

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