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D E C I S I O N
of 25 October 2004

Case Number: T 0970/02 - 3.2.6

Application Number: 91919168.4

Publication Number: 0565719

IPC: B23D 59/00

Language of the proceedings: EN

Title of invention:
Sawing machine including a sawdust removing device

Patentee:
AMADA COMPANY, LIMITED

Opponent:
KEURO Besitz GmbH & Co EDV Dienstleistungs KG

Headword:
-

Relevant legal provisions:
EPC Art. 52(1), 54(1), 56, 123(2)(3)

Keyword:
"Disclaimer - no"
"Admissibility of amendments - yes"
"Novelty and inventive step - yes"

Decisions cited:
G 0001/03

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0970/02 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 25 October 2004

Appellant: (Opponent)
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Respondent: (Proprietor of the patent)
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Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 15 July 2002 concerning maintenance of European patent No. 0565719 in amended form.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: G. C. Kadner
J. H. Van Moer

Summary of Facts and Submissions

I. The mention of the grant of European patent No 565 719 in respect of European patent application No 91919168.4 filed on 6 November 1991 was published on 12 July 2000.

II. Notice of opposition was filed on 11 April 2001 by the Appellant (Opponent), based on the grounds of Article 100(a) EPC.

III. By decision announced during oral proceedings on 10 June 2002 and posted on 15 July 2002 the Opposition Division maintained the European patent in amended form.

The Opposition Division was of the opinion that the amendments to claim 1 according to the first auxiliary request were admissible since the introduction of a "negative" feature resulting in the exclusion of certain embodiments did not contravene the requirements of Article 123(2) and (3) EPC. Furthermore the subject-matter of claim 1 was novel with respect to

E3: FR-A-2 637 826

and involved an inventive step.

IV. On 9 September 2002 the Appellant filed a notice of appeal against this decision and paid the appeal fee. The statement of grounds of appeal was received on 15 November 2002.

V. In a communication dated 9 August 2004 the Board expressed the preliminary opinion that the features introduced during opposition proceedings possibly

resulted in a lack of clarity. The Board also questioned whether these features were supported by the application as originally filed. When considering the issue of inventive step the disclosure of E3 should be discussed, taking into account the general knowledge of the skilled person.

VI. Oral proceedings were held on 25 October 2004.

The Appellant requested that the decision under appeal be set aside and that the European patent No 565 719 be revoked.

The Respondent (Patentee) requested that the appeal be dismissed and that the patent be maintained on the basis of claim 1 filed during the oral proceedings.

Claim 1 reads as follows (amendments to the granted version of that claim in *Italics*):

"A sawing machine (1) including *a saw band, a driving wheel (19) and a follower wheel (17) for moving said saw band, and* a device (27) for removing sawdust adhering to said saw band (21) of the sawing machine (1), comprising

a supporting member (35) attached to a saw blade housing (11) in which said saw band (21) is mounted, the supporting member being energized so as to move towards said saw band (21); and

a disc shaped cleaning instrument (37) supported on said supporting member (35), said cleaning

instrument (37) being rotatable for removing sawdust from the saw band (21);

characterized in that the sawing machine further comprises:

a limiting member (67, 73, 73A) *distinct from said wheels* adapted to contact the outer periphery of the disc shaped cleaning instrument (37) during operation of the device for removing sawdust, for stopping the movement of the supporting member (35), the limiting member (67, 73, 73A) being mounted on the housing (11) so that the cleaning instrument (37) overlaps with the *band* (21) to a predetermined degree when the limiting member contacts the outer periphery of the cleaning instrument (37)."

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

The negative feature that the "... limiting member [was] distinct from the wheels 19, 17 ..." was a disclaimer introduced to establish novelty with respect to E3. There was no support for that amendment in the application as originally filed. A disclaimer was not allowable in order to establish novelty if the document concerned was also relevant in respect of inventive step. Therefore the amendments made to claim 1 were not allowable because they involved an inadmissible disclaimer according to the criteria set out in decision G 1/03 of the Enlarged Board of Appeal.

In any case the subject-matter of claim 1 did not involve an inventive step. The skilled person reading document E3 would clearly comprehend that the overlap of the cleaning brush and the teeth of the saw band was preconditional for the function of the device. Since the load of a spring was not constant over its working length or, if the cleaning instrument was moved by a weight, due to the wear of its outer periphery the actuating force was not constant and so a limiting member was necessary. The skilled person would immediately recognize that the side flank of the drive wheel provided such a limiting member. E3 also disclosed that the cleaning device could be positioned at any other place along the saw band. The skilled person following this teaching would therefore provide a limiting member distinct from the drive wheel if a location for the cleaning device was chosen when the drive wheel could not be used as a stop.

Thus the skilled person was led to the claimed solution without the exercise of an inventive step.

VIII. The submissions of the Respondent can be summarised as follows:

The amendment concerning the "... limiting member distinct from the wheels 19, 17 ..." was not a disclaimer within the meaning of decision G 1/03, but was a distinguishing feature disclosed in the application as originally filed. All embodiments of the invention according to Figures 2 to 6 showed limiting members distinct from the drive wheels, and therefore the amendments were clearly supported by the original

disclosure thus meeting the requirements of Article 123(2) EPC.

The subject-matter of claim 1 was inventive when compared with the teachings of E3. When assessing the objective problem underlying that prior art (page 9, lines 5 to 21) the skilled person would clearly understand that the solution consisted in the rotating brush which was loaded towards the saw band by the force of a spring. Certainly a preferred solution was the arrangement at the drive wheel, but by no means was the drive wheel intended to serve as a sole means for adjusting the overlap, therefore in a case where the cleaning instrument was positioned at another position along the saw band, there was no suggestion to add a distinct stop member.

Since any indication towards the invention was lacking, the claimed solution involved an inventive step.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments (Article 123(2) and (3) EPC)*

The Appellant argued that the feature "... limiting member distinct from the wheels 19, 17 ..." was an inadmissible disclaimer when compared with the conditions set out in decision G 1/03. It is true that this "negative" feature was introduced in order to establish novelty with respect to E3, and that this document as closest prior art is also of relevance in

respect of inventive step. However, decision G 1/03 deals with the problem arising from the introduction of a disclaimer if neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed. The Board agrees with the Opposition Division's opinion that it has first to be considered whether the amendment is supported by the disclosure of the original application, and comes to the same conclusion in this respect. According to the A-document (column , lines 53 to 57; figures 2 to 6) the limiting member may have the shape of a plate or a roller mounted on the bracket, and is therefore not only independent but also distinct from the drive wheel 19 or the follower wheel 17. Therefore, since the amendment and the alleged "disclaimer" are clearly supported by the original disclosure the conditions set out in G 1/99 do not apply in the present case.

For these reasons it has to be concluded that amended claim 1 meets the requirements of Article 123(2) EPC and, since the amendments restrict the claim, is also allowable under Article 123(3) EPC.

3. *Novelty*

3.1 E3 discloses a sawing machine including a saw band 15, a driving wheel 14a and a follower wheel 14b for moving said saw band, and a device for removing sawdust adhering to said saw band of the sawing machine comprising a supporting member 27 attached to a saw blade housing 6 in which said saw band is mounted, the supporting member being energized so as to move towards said saw band 15. The device for removing sawdust

comprises a disc shaped cleaning instrument 25 supported on said supporting member 27 being rotatable for removing sawdust from the saw band 15.

3.2 According to the text on page 9 of E3 the brush contacts the drive wheel 14a in the embodiment depicted in figure 5. However, despite this detail of this further improvement of the machine described in E3, in the Board's opinion this disclosure is not suitable to construe a disclosure for a stop member distinct from the driving or follower wheel as now claimed in claim 1 of the amended patent.

What is unambiguously disclosed on page 9 of E3 is that the brush 25 is supported so that it contacts the sawing blade in a biased manner, which means that the biasing force and the properties of the brush and saw blade determine the overlap of the brush with respect to the saw blade. In so far, attention is also drawn to the disclosure of E3 starting just after the description of the embodiment of figure 5, where it is stated that the brush according to this embodiment can be located at any position along the band saw blade (page 9, lines 18 and 19), thereby confirming that generally the blade itself functions as a limiting member for the movement of the brush rather than that the use of a separate stop member is envisaged. Of course when positioning the brush at a point where the saw blade is held by the driving or guiding wheels there is no other possibility than to let it also run against these wheels when contacting the protruding teeth of the saw blade. This, however, is a direct result of the selected location and cannot be seen as a

disclosure or suggestion for the use of a stop member at other positions along the saw blade.

Therefore the subject-matter of claim 1 is distinguished from the sawing machine disclosed there by the feature that the limiting member is distinct from the wheels and that the cleaning instrument overlaps with the saw band to a predetermined degree when the limiting member contacts the outer periphery of the cleaning instrument.

3.3 The further prior art documents cited during the opposition proceedings are more remote from the subject-matter of claim 1 than the sawing machine known from E3, and none of them discloses a machine with all features of claim 1. Consequently the subject-matter of claim 1 meets the requirement of novelty (Article 54(1) EPC).

4. *Inventive step*

4.1 The closest prior art is considered to be represented by E3. Starting from that prior art the problem underlying the patent in suit is to provide a device for removing the sawdust adhering to the saw band of a sawing machine having a cleaning instrument such as a brush for which a suitable overlap with respect to the saw band is always maintained (column 1, lines 5 to 10).

4.2 This technical problem is solved by the means defined in claim 1, particularly in that the limiting member is distinct from the wheels 19, 17 and that the cleaning instrument 37 overlaps with the saw band 21 to a

predetermined degree when the limiting member contacts the outer periphery of the cleaning instrument.

4.3 The general teaching of E3 relates to a band sawing machine having a cleaning instrument in the form of a rotating brush for removing the saw dust from the saw band. In order to compensate the wear of the brush it is biased against the saw band by the force of a spring or weight.

4.4 Contrary to the teaching of E3 as referred to in paragraph 3.2 above, according to the solution claimed in the patent in suit the limiting member is separately mounted at the housing and can have the shape of a plate or a roll which limits the movement of the cleaning element toward the saw band. By this limiting member the overlap of the cleaning element with respect to the saw blade can be separately adjusted so that a suitable overlap is always maintained at any position along the saw blade.

Since the teaching of E3 does not suggest such a distinct limiting member the solution according to claim 1 meets the requirement of inventive step (Article 56 EPC).

4.5 Dependent claims 2 to 5 include further embodiments of the invention and can be maintained together with allowable claim 1 (Article 52(1) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the First Instance with the order to maintain the patent with the following documents:

   – Claim 1 submitted at the oral proceedings

   – Claims 2 to 5 as granted

   – Description columns 1 to 6 submitted at the oral proceedings

   – Figures 1 to 6 as granted

The Registrar: The Chairman:

M. Patin P. Alting van Geusau