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D E C I S I O N
of 9 December 2004

Case Number: T 1147/03 - 3.2.6

Application Number: 94118012.7

Publication Number: 0654316

IPC: B23B 27/04

Language of the proceedings: EN

Title of invention:
Clamping device for a cutting insert

Patentee:
ISCAR LTD.

Opponents:
Ceratizit Austria GmbH
CERATIZIT Deutschland GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 56, 108
Legal Advice 6/91 rev.

Keyword:
"Admissibility appeal (yes) - valid payment by other party"
"Inventive step (yes)"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1147/03 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 9 December 2004

Appellant I: (Proprietor of the patent)
ISCAR LTD.
P.O. Box 11
Migdal Tefen 24959 (IL)

Representative:
VOSSIUS & PARTNER
Siebertstrasse 4
D-81675 München (DE)

Appellant II: (Opponent II)
CERATITZIT Deutschland GmbH
Hans-Böckler-Strasse 10
D-40764 Langenfeld (DE)

Representative:
Lohnert, Wolfgang, Dr.
Plansee Tizit GmbH
Recht/Patent
AT-6600 Reutte (AT)

Party as of right: (Opponent I)
Ceratizit Austria GmbH
AT-6600 Reutte/Tirol (AT)

Representative:
Lohnert, Wolfgang, Dr.
Plansee Tizit GmbH
Recht/Patent
AT-6600 Reutte (AT)

Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 26 August 2003 concerning maintenance of European patent No. 0654316 in amended form.

Composition of the Board:

Chairman: H. Meinders
Members: G. Pricolo
M. J. Vogel

Summary of Facts and Submissions

I. With decision dated 26 August 2003, the Opposition Division maintained European patent No. 0 654 316 in amended form.

It considered that the subject-matter of claim 1 as granted did not involve inventive step. The subject-matter of claim 1 according to the auxiliary request, however, fulfilled the requirements of novelty and inventive step. Relevant for the present decision are the following documents discussed in the opposition proceedings:

E1: US-A-0 402 400 and

E12: GB-A-1 379 637.

II. Against this decision an appeal was filed by Plansee Tizit GmbH (Appellant II, referred to as Opponent II in the decision under appeal) with letter dated 23 September 2003, accompanied by a fee payment sheet (EPO Form 1010), both received on 26 September 2003 and bearing the same date stamp with number "29". The fee payment sheet refers to "Ceratizit Austria Aktiengesellschaft" (mentioned Opponent I in the decision under appeal) as effecting the payment, the application number 94118012.7 and the patent number (0654316) of the patent in suit, as well as the amount of 1020 Euros mentioned next to "Beschwerdegebühr" (appeal fee). The credit note of the "Österreichische Postsparkasse" to the EPO mentions "Ceratizit Austria Aktiengesellschaft" as effecting the payment of 1020 Euros and bears the reference: "EP94118012.7".

The statement of grounds of appeal was filed by Appellant II with fax dated 19 December 2003. The cover sheet accompanying the statement of grounds of appeal bears the letterhead "Plansee Hochleistungswerkstoffe" and is signed for "Plansee Aktiengesellschaft", "Patentabteilung": "i.A. Brigitte Unterkofler".

The statement itself mentions Opponent II as appellant and is signed by Mr Lohnert as professional representative.

III. A further fee payment sheet (EPO Form 1010) was received by the EPO, mentioning also "Ceratizit Austria Aktiengesellschaft" as the debtor, the application number 94118012.7 and the patent number (0654316) of the patent in suit, as well as an amount of 1020 Euros mentioned next to "Beschwerdegebühr" (appeal fee). This sheet bears a date stamp with number "75" of 25 September 2003.

IV. With letter dated 3 November 2003, received that same date, the Patentee (Appellant I) filed an appeal, paying the appeal fee that same date. The statement of grounds for that appeal was received by the EPO on 23 December 2003.

V. With communications dated 15 January 2004, 20 February 2004 and 16 September 2004 the Board addressed the issues of the admissibility of the appeal of Appellant II and of novelty and inventive step of the subject-matter of claim 1 as granted as well as of claim 1 as maintained by the Opposition Division.

With its communication dated 16 September 2004 the Board gave as its preliminary opinion that on the basis of the above facts the appeal of Opponent II appeared to be admissible. Further, its preliminary opinion on inventive step was given.

With letter of 6 May 2004 Appellant II notified the EPO of the change of name from "Plansee Tizit GmbH" to "Ceratizit Deutschland GmbH".

VI. Oral proceedings were held on 9 December 2004.

Appellant I requested that the decision under appeal be set aside and that the patent be maintained on the basis of:

claims 1-9, filed during the oral proceedings,

description, columns 1 and 2 as filed during the oral proceedings, columns 3 and 4 as granted,

drawings, figures 1-8 as granted.

Appellant II requested that the decision under appeal be set aside and that the patent be revoked.

VII. Claim 1 of Appellant I's request has the following wording:

"A metal cutting tool assembly comprising a rigid holder blade (1)

an insert retaining slot (9) formed in a leading end of the holder blade (1) and defined between a resiliently

displaceable clamping jaw (3) formed integrally with said holder blade (1) and rigid base jaw (4) forming part of the holder blade (1);
spaced apart displacement and supporting surfaces (14, 15) wherein the displacement surface (14) is formed in said clamping jaw (3) and the supporting surface (15) is formed in or on said holder blade (1);
said clamping jaw (3) having a leading portion and a trailing portion about which it is resiliently displaceable relative to said base jaw (4),
and a slot opening key (21, 33, 41)
characterized in that
a first throughgoing aperture is formed completely in said clamping jaw leading portion having an aperture rim constituting said displacement surface (14), and said displacement surface (14) is spaced apart from said retaining slot (9); and
the assembly further comprises the slot opening key (21, 33, 41) having a pair of spaced apart projecting prongs (24a, 24b; 34a, 34b; 42a, 42b) adapted to engage said surfaces (14, 15) at least one of said prongs being displaceable with respect to said holder blade (1) so as to resiliently displace said clamping jaw (3) outwardly with respect to said base jaw (4) into an opening position for insertion or removal of an insert (7)."

VIII. In support of its requests Appellant I argued essentially as follows:

The appeal of Opponent II was not admissible, as no appeal fee had been paid; the appeal of Opponent I was not admissible as no written notice of appeal nor a statement of grounds of appeal had been filed. The

payment of an appeal fee by Opponent I could not be unambiguously attributed to the appeal filed by Opponent II.

Inventive step was the only issue to be discussed; closest prior art was clearly E12 and not E1, the latter relating to a wood cutting assembly as opposed to the metal cutting assembly of claim 1. In fact, it was clear for a skilled person that due to the arrangement of the inserts, in particular their wedge and their cutting angles the cutting tool assembly of E1 was not suitable as a metal cutting assembly.

Starting from E12, the difference between the assembly of claim 1 and the assembly shown in E12 lay in the displacement surface being the rim of a throughgoing aperture formed completely in the clamping jaw leading portion as well as the slot opening key having a pair of spaced apart prongs adapted to engage the displacement- as well as the supporting surface to displace the clamping jaw outwardly.

E1 could not provide the skilled person with the teaching that the displacement surface should be formed by the rim of such an aperture as the displacement surface in the assembly of E1 was a hole or a socket formed in the contiguous edges of the slot, thus not an aperture lying completely in the clamping jaw. The "hole" and the "socket" referred to in E1 were synonyms for one and the same thing, namely the notches in the contiguous edges of the slot. In any case, E1 did not provide an indication to arrange such a "hole" in the clamping jaw **leading portion.**

IX. In support of its requests Appellant II argued essentially as follows:

E1 should be considered closest prior art for the assembly of claim 1 because the cutting assembly it related to could be used to cut metal, even in 1889, as copper - a soft metal easily cut with a circular saw - was available at that time.

Its reference to "holes" or "sockets" in the contiguous edges of the clamping jaw and the rigid base jaw meant that for receiving one of the two prongs of the slot opening key there were either sockets on both edges of the slot, as shown in figure 2, or there was a hole **in** the clamping jaw, not necessarily shown. Drawings were merely exemplary and should not be seen as depicting the only embodiment of the invention of E1. The location of the hole would naturally be in the leading portion, to have the best effect.

Thus only the holders not being separate from the circular saw body, but forming part thereof, would be the distinguishing feature. However, this was trivial in the light of the available prior art.

Starting from E12 the skilled person would apply the above teaching of E1, notably the two-prong slot opening key and the hole arranged completely in the clamping jaw leading portion, as indicated above.

Reasons for the Decision

1. *Admissibility of the appeals*

The appeal of the Patentee (Appellant I) is admissible.

1.1 Taking account of the date stamp of 26 September 2003, with the number "29", on both the notice of appeal and the payment sheet (EPO Form 1010) filed by Opponent II in respect of the patent in suit, its appeal is filed within the applicable time limit.

The appeal identifies the decision which is impugned and the extent to which amendment or cancellation of the decision is requested.

The actual payment of the appeal fee indicated in this payment sheet, in view of the mention of the application number of the patent in suit on the payment sheet as well as in the credit note of the EPO's bank in Austria for the amount of 1020 Euros of the appeal fee, can in the present case therefore only be attributed to the appeal filed by Opponent II.

The fact that the debtor for the payment of the appeal fee is mentioned as "Ceratizit Austria Aktiengesellschaft", which was Opponent I in the opposition proceedings, has no influence on the above conclusion, as the EPC does not require parties to proceedings to pay the relevant fees **themselves**. Any natural or legal person can pay fees for any party in proceedings before the EPO (see Legal Advice LA 6/91 rev. (OJ EPO 1991, 573), point 1).

The appeal of Appellant II is therefore deemed filed (Article 108 EPC).

1.2 With the payment sheet date stamped 25 September 2003, with the number "75" and mentioning Opponent I, no notice of appeal has been filed, thus there is no other appeal in existence to which the above mentioned payment could have been attributed by the EPO.

1.3 The statement of grounds to the appeal of Appellant II has been filed in due time (Article 108 EPC). The fact that the cover letter of the faxed statement of grounds of appeal bears a company name in its letterhead as well as a further company name for which it is signed, both being different from Appellant II's company name, has no influence on the above conclusion: the latter bears the name of Appellant II, at its start and at the end and is signed by the same professional representative as filed the appeal and represented both opponents in the opposition proceedings.

1.4 The appeal of Appellant II is therefore admissible.

2. *Amendments (Article 123 EPC)*

2.1 Claim 1 as granted was amended in that (in brackets the basis in the application as filed):

- insert receiving slot was changed into insert retaining slot (page 4, lines 13-28; page 5, line 20; page 6, line 4),

- the displacement surface is formed in the clamping jaw (page 6, lines 7-9, claim 1),

– the supporting surface is formed in or on the holder blade (page 6, lines 7-9, claim 1),

– the displacement surface is constituted by the rim of a throughgoing aperture formed completely in the clamping jaw leading portion (claim 3; page 6, line 8; page 7, lines 18-21; figures 3 and 4).

2.2 According to claim 3 as granted, when dependent on claim 1 as granted, the displacement surface could be formed **in or on** the clamping jaw leading portion. According to present claim 1 the displacement surface is formed **in** the clamping jaw leading portion. This is a limitation to only one of two possibilities, thus the amendment complies with Article 123(3) EPC.

The added features further limit the subject-matter of claim 1, thus the requirements of Article 123(3) EPC are met.

2.3 The further amendments to the claims concern the correction of typographical errors and the correct reference to higher order claims (Article 84 EPC). The amendments to the description relate to the acknowledgement of the prior art E12 and E1 for the purposes of Rule 27(1)(b) EPC.

The patent as amended thus complies with the requirements of Articles 84 and 123 as well as Rule 27 EPC.

3. *Inventive step – claim 1 (Article 56 EPC).*

3.1 Closest prior art - E12

For the Board, E12 is the closest prior art for discussing inventive step of the metal cutting tool assembly of claim 1 as it relates to a metal cutting tool assembly (see page 1, lines 13 and 14) comprising a rigid holder blade 10, 20 with an insert retaining slot formed in a leading end of the holder blade. The insert retaining slot is defined between a resiliently displaceable clamping jaw formed integrally with said holder blade and a rigid base jaw forming part of the holder blade. There are spaced apart displacement and supporting surfaces 16, 23; 12, 22 wherein the displacement surface 16, 23 is formed in said clamping jaw (the clamping jaw on the circular saw shown and discussed in E12 has no reference number) and the supporting surface 12, 22 is formed in or on said holder blade. The clamping jaw has a leading portion and a trailing portion about which it is resiliently displaceable relative to said base jaw. The assembly further comprises a slot opening key 19.

Thus E12 discloses all features of the preamble of the metal cutting tool assembly of claim 1.

3.2 Closest prior art - E1

Appellant II argued that E1 should be considered closest prior art, as it disclosed the same features as contained in the preamble of claim 1, namely a circular saw assembly having cutting inserts, each in a retaining slot formed in a leading end of a holder

blade, with a slot opening key to open a resiliently displaceable clamping jaw formed integrally with the holder blade. The insert retaining slot was formed between the clamping jaw and a rigid base jaw also forming part of the holder blade. Of the preamble of claim 1 only the feature of the cutting assembly being capable of cutting metal ("metal cutting tool assembly") was not explicitly mentioned in E1. This assembly was however, capable of cutting metal.

At the priority date of the patent in suit all circular saw blades on the market were universal blades, i.e. capable of cutting metal as well as wood. The skilled person would read E1 within that context and conclude that the circular saw blade as discussed in E1 could also be used for both materials.

Soft materials like copper were on the market in 1889 and could be sawn with the circular saw blade of E1.

3.2.1 In selecting the closest prior art, the first consideration is that it must be directed to the same purpose or effect as the invention. In this respect the Board cannot share Appellant II's opinion, as the circular saw blade of E1 does not relate to a metal cutting assembly, i.e. an assembly capable of cutting metal, because the cutting angle of the inserts is too large and the wedge angle of the inserts is too small to be able to cut metals properly.

In the decision under appeal, point 3.2 of the reasons, the opposition division states that the skilled person would consider the teaching of E1 to also apply to metal cutting. However, it has not given reasons why

this should be the case, particularly in view of the above mentioned features which are clearly disclosed in E1 and are typical for wood cutting inserts.

This statement is therefore a mere allegation.

3.2.2 Further, the support the inserts find in the circular saw cannot be considered strong enough to withstand the forces acting on the insert when cutting metal.

For the comparison of the subject-matter of claim 1 with the prior art the geometry of the clamping jaw should not be seen on its own, also its arrangement in the circular saw blade should be taken into account. In that respect the arrangement of the cutting insert as shown in E12 cannot be compared with that of the cutting insert shown in E1, contrary to what the Opposition Division states in the decision under appeal (point 3.2 of the reasons).

In that respect, at the priority date of the patent in suit, the circular saw blade disclosed in E1 would not be considered anything other than a circular saw only capable of cutting wood. This is derivable from the fact that the angle at which the inserts are arranged in the holders of the circular saw blade are designed such that the inserts can withstand the high centrifugal forces resulting from the high rotational speeds necessary to cut wood. Further, the chip gullets are typical for wood cutting, where a considerable amount of material is cut per teeth.

Therefore the fact that at the priority date commercially available saw blades were universal, i.e. could be used for metal as well as wood, is irrelevant in the present case, as the blade shown in E1 is not such a universal blade, but a wood cutting blade.

3.2.3 The argument that copper, a soft material, was available on the market in 1889 and could have been sawn with the circular saw disclosed in E1, is also not supported by the Board. The small wedge angle of the cutting insert would result in the teeth becoming easily wedged in the soft copper material, thus the skilled person would not contemplate using such a circular saw for cutting copper.

3.3 Problem to be solved

The disadvantage of metal cutting tool assemblies as disclosed in E12 is that the slot opening key turns in the apertures forming the displacement- and the supporting surface, resulting in wear or damage of the opening key and/or the aperture. Further, the key may come into contact with the insert, with the same risk of wear and/or damage. This problem is also mentioned in the patent in suit, column 1, lines 26-30 and 39-43.

3.4 Solution

This problem is solved by the following features of the metal cutting assembly of claim 1:

– the displacement surface is the rim of a throughgoing aperture formed completely in the

clamping jaw leading portion and is spaced apart from the insert retaining slot,

– the slot opening key has a pair of spaced apart projecting prongs, adapted to engage the displacement surface and the supporting surface, so as to resiliently displace the clamping jaw outwardly to free or introduce an insert.

3.5 Obviousness

Appellant II argued that the arrangement as shown in E1, with a slot opening key with two pins, one insertable in an aperture in the circular saw blade itself and the other in an aperture formed in the displaceable clamping jaw, would render the claimed arrangement obvious to the skilled person.

In fact, E1, page 1, lines 61-65, mentioned the displacement surface (aperture e') in the clamping jaw as being a "hole or socket", meaning that it could also be a throughgoing aperture arranged completely in the clamping jaw leading portion, as claimed.

"Socket" and "hole" were not synonyms for one and the same thing, but instead the "socket" was the displacement surface in the contiguous edge, the "hole", however, was meant to be an alternative to the "socket" and could only be an aperture foreseen entirely in the clamping jaw. To have its best effect, it had to be in the clamping jaw leading portion. The drawings were merely schematic and should therefore not be construed as limiting the subject-matter as discussed in the

description to only a hole or a socket in the contiguous edges of the slot.

If, however, the "hole" and the "socket" were to be seen as synonyms for a notch **in the contiguous edges** of the slot, this aspect should not be construed in a too limited manner, but should be seen as a general indication of a "zone" of the spring limb, not just the edges of the slot. Thus, a hole, completely in the clamping jaw, would be obvious.

3.5.1 The Board is not convinced by this argument. E1 mentions these "holes or sockets" clearly as being made "in the contiguous edges of the spring limbs" (the clamping jaws), thus the "holes" and the "sockets" are to be considered synonyms for the notches formed on both sides of the slot separating the rigid base jaw and the resiliently displaceable clamping jaw (e), as shown in figure 2 of E1.

3.5.2 The Board also cannot see why the specific term "edge" in E1 should be interpreted by the skilled person as meaning something entirely different, such as a "zone". E1 does not provide a basis for such an interpretation.

3.5.3 Even if one were to assume that the "holes" and the "sockets" were not to be read as synonyms, but that a "hole" should be provided in each clamping jaw of the holder blades discussed in E1, it is not derivable from E1 nor from E12 that it should be in the clamping jaw **leading portion**. The arrangements shown in E1 and E12 have insufficient material available in the clamping jaw leading portion to provide such a hole.

3.5.4 The "holes or sockets" as discussed in E1 cannot therefore provide the skilled person with an indication to provide a **throughgoing aperture formed completely** in the clamping jaw **leading portion**, as presently claimed in claim 1.

None of the other documents on file provide such an indication either.

In view of the above mentioned reasons, the other distinguishing feature of claim 1 over the arrangement of E12, relating to the slot opening key itself, needs no further discussion.

3.6 Hence, the Board comes to the conclusion that the subject-matter of claim 1 of this request cannot be derived in an obvious manner from the prior art and accordingly involves an inventive step (Article 56 EPC).

The subject-matter of claims 2-9 relate to preferred embodiments of the cutting assembly of claim 1, thus their subject-matter also is novel and involves inventive step.

The patent can therefore be maintained according to the request of Appellant I.

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 on the basis of the following documents:

   Claims 1-9 as filed during the oral proceedings,

   Description, columns 1 to 2 (page 2) as filed during the oral proceedings, columns 3 to 5 (pages 3 and 4) as granted,

   Drawings, figures 1 to 8 as granted.

The Registrar: The Chairman:

M. Patin H. Meinders