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**Datasheet for the decision  
of 4 September 2007**

**Case Number:** T 1735/06 - 3.2.06

**Application Number:** 99964841.3

**Publication Number:** 1150784

**IPC:** B21B 1/28

**Language of the proceedings:** EN

**Title of invention:**

Method for manufacturing of strips of stainless steel and  
integrated rolling mill line

**Patentee:**

Outokumpu Stainless AB

**Opponent:**

UGINE & ALZ FRANCE

**Headword:**

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**Relevant legal provisions:**

EPC Art. 84, 123(2)

**Keyword:**

"Admissibility of amendments - no"

**Decisions cited:**

-

**Catchword:**

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Case Number: T 1735/06 - 3.2.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.06  
of 4 September 2007

**Appellant:** Outokumpu Stainless AB  
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**Representative:** Aarnio, Hannu Aatto Aulis  
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**Respondent:** UGINE & ALZ FRANCE  
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**Representative:** Neyret, Daniel Jean Marie  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Office posted 7 August 2006 revoking  
European Patent No. 1150784 pursuant to Article  
102(1) EPC.

**Composition of the Board:**

**Chairman:** P. Alting Van Geusau  
**Members:** G. Kadner  
K. Garnett

## Summary of Facts and Submissions

- I. The mention of grant of European patent No. 1 150 784 in respect of European patent application No. 99964841.3 filed as an international application on 8 December 1999 and claiming two Swedish priorities, from 18 December 1998 and 5 October 1999 respectively, was published on 28 July 2004 with 12 claims. Granted claim 1 has the following wording:

"Method for the manufacturing of strips of stainless steel, comprising cold rolling of a strip which in a foregoing process has been manufactured through casting a melt to form a cast strip and/or has been hot rolled and wherein the cast and/or hot rolled strip, which is dark coloured by oxides on the surface of the strips, remaining from the foregoing manufacturing of the said cast and/or hot rolled strip, is cold rolled in one or more consecutive cold rolling passes (11-13) reducing the strip thickness by 10-75 % and crackling the oxide scales, i.e. so that cracks are produced in the oxide scales, and wherein the strip then is annealed in a furnace (18) having a furnace atmosphere obtainable by heating the furnace by means of burners which consume a liquid or gaseous fuel which is combusted by means of a gas which contains at least 85 vol-% oxygen and not more than 10 vol-% nitrogen, whereafter the strip is cooled and pickled."

- II. Notice of opposition was filed against this patent with a request for revocation based on the grounds of Article 100(a) EPC.

By decision posted on 7 August 2006, the Opposition Division revoked the European patent on the grounds that the subject-matter of the independent claims of the main request and four auxiliary requests lacked an inventive step. During the opposition proceedings the following documents were of particular relevance:

D1: EP-A-0 738 781  
D2: EP-A-0 837 147  
D3: WO-A-95/24 509  
O1: US-A-3 776 784  
O2: EP-A-0 664 340  
O3: EP-A-0 695 808

III. Notice of appeal was filed against this decision by the Appellant (Patentee) on 12 October 2006 together with payment of the appeal fee. With the grounds of appeal, received at the EPO on 13 December 2005, the Appellant filed a new set of claims.

IV. In a communication dated 22 June 2007 accompanying the summons to oral proceedings the Board expressed the view that the combination of features claimed in the independent claims did not appear to solve the technical problem underlying the patent.

V. With letter dated 19 July 2007 the Appellant filed six new sets of claims in accordance with a main and five auxiliary requests.

VI. Oral proceedings were held on 4 September 2007.

The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the

basis of the main request filed during the oral proceedings.

The Respondent (Opponent) requested that the appeal be dismissed.

Independent claim 1 reads as follows:

"Method for the manufacturing of strips of stainless steel, comprising cold rolling of a strip which in a foregoing process has been manufactured through casting a melt to form a cast strip and/or has been hot rolled and wherein the cast and/or hot rolled strip, which is dark coloured by oxides on the surface of the strips, remaining from the foregoing manufacturing of the said cast and/or hot rolled strip, is cold rolled in one or more consecutive cold rolling passes (11-13) reducing the strip thickness by 10-75 % and crackling the oxide scales, i.e. so that cracks are produced in the oxide scales, and wherein the strip then is annealed in a furnace (18) at a temperature of 1050 - 1200 °C during such a long period of time that the strip is through-heated and re-crystallized without at the same time oxidising the surfaces, heating the furnace by means of burners which consume a liquid or gaseous fuel which is combusted by means of a gas which contains at least 85 vol-% oxygen and not more than 10 vol-% nitrogen and achieving the furnace atmosphere containing max. 10 vol-% oxygen, the main part of the furnace atmosphere consisting of carbon dioxide, steam and minor amount of nitrogen, said furnace atmosphere achieving to facilitate descaling after annealing and that the strip after annealing is cooled and subjected to descaling in at least one descaling unit (24), in which the strip is

bent a plurality of times in different directions about rolls, at the same time as the strip is cold-stretched so that it is permanently elongated, causing the scales to break prior to pickling the strip, and after descaling the strip is pickled."

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

The amendments made to claim 1 were clearly disclosed in the application as originally filed (page 3, lines 10 to 23, corresponding to the patent specification, page 3, lines 11 to 19), read together with the original claim 3 (corresponding to granted claim 3). In particular the composition of the furnace atmosphere was now incorporated into claim 1, this furnace atmosphere preventing the cracks in the surface of the stainless steel strip from being eliminated or healed up. The treatment necessary to achieve this desired effect was clearly defined by the features of original claim 3 in that the annealing time and temperature were required to be such that the strip was through-heated and re-crystallized.

VIII. The arguments of the Respondent can be summarized as follows:

Claim 1 violated Article 84 and 123(2) EPC. The claimed method was not clear in that only the main part of the furnace atmosphere was defined and not the whole content of the gases in the composition.

The introduction of the feature "furnace atmosphere achieving to facilitate descaling after annealing" was a

clear violation of Article 123(2) EPC because this relationship was not disclosed in the original claims or description. What was disclosed in the original application was "initial crackling shall be possible to be utilized efficiently in order to facilitate later descaling" (page 3, lines 10,11).

## **Reasons for the Decision**

### *1. Admissibility of appeal*

In the notice of appeal it was said that the Appellant "... thus makes an appeal against the decision to revoke the [patent] in order to at least amend the decision so that a patent will be granted in a form of the amended claims."

The Respondent contested the admissibility of the appeal because it did not contain a statement identifying the extent to which amendment or cancellation of the decision was requested, as required by Rule 64(b) EPC.

In the light of the case law of the Boards of Appeal, the Board comes to the conclusion that the appeal is admissible. Where a patent has been revoked, to then speak in terms of "amendment" of the decision is meaningless: cancellation or reversal of the decision as a whole is all that can be ordered in such a case. Construed objectively in the light of what has taken place, this is how a notice of appeal which requests amendment of the decision will normally be construed (see T 89/85, T 407/02 and T 1075/02, none reported in EPO OJ). Further, Rule 64(b) EPC does not require an

Appellant whose patent has been revoked to specify in the notice of appeal the form in which he seeks maintenance of the patent. This is a matter for the grounds of appeal (T 89/85, T 49/99, T 407/02, T 1075/02, none reported in EPO OJ).

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

2.1 New claim 1 was amended by the incorporation of the term:

"... said furnace atmosphere achieving to facilitate descaling after annealing". According to the Appellant's argument, support for the disclosure of that amendment was to be found in the application as filed (page 3, lines 10 to 17) and in the patent specification (page 3, lines 11 to 16).

2.2 The sentences concerned read:

"In order that the said initial crackling shall be possible to be utilised efficiently in order to facilitate later descaling and pickling it is desirable that it as far as possible is not eliminated in connection with the annealing, i.e. so that fissures or cracks in the oxide layers do not heal up at the annealing. This desirable effect is to a considerable degree achieved therein that the strips are annealed in the specific atmosphere of the annealing furnace, which contains max 10 vol-% oxygen, preferably max 6 vol-% oxygen, while the main part consists of carbon dioxide, steam and a minor amount of nitrogen, which substantially emanates from air that possibly may leak in."



- 2.3 The term "said initial crackling shall be possible to be utilised efficiently in order to facilitate later descaling" indicates clearly that the later descaling which is thereby facilitated depends on this initial crackling of the oxide scales produced during the cold rolling. According to the newly introduced wording, however, facilitation of the descaling is no longer caused by the initial crackling. Now, "said furnace atmosphere achieving to facilitate descaling after annealing" causes this facilitating of the annealing whereby "this desirable effect is to considerable degree achieved therein that the strips are annealed in the specific atmosphere of the annealing furnace". No explanation whatsoever is given for the meaning of the "considerable degree" so far as concerns other effects which may influence the descaling step.
- 2.4 This change of "crackling" to "furnace atmosphere" as the substantial cause leads to a violation of Article 123(2) EPC because the newly claimed relationship of the step of facilitating descaling after annealing included in the method of claim 1 is not disclosed in the application as originally filed. Therefore claim 1 contains subject-matter which extends beyond the content of the application as filed.
- 2.5 Furthermore, since the "furnace atmosphere" is only "to a considerable degree" responsible for the desired effect, and not all the necessary means for achieving it are present in claim 1, it is not clear within the meaning of Article 84 EPC.
3. For the above reasons the single request presented in the oral proceedings is not admissible and in the

absence of any further request the patent cannot therefore be maintained.

**Order**

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

1. The appeal is dismissed.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau