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**Datasheet for the decision  
of 12 November 2009**

**Case Number:** T 1294/08 - 3.2.06

**Application Number:** 99964840.5

**Publication Number:** 1159091

**IPC:** B21B 1/28

**Language of the proceedings:** EN

**Title of invention:**

Method for manufacturing of strips and rolling mill line

**Patentee:**

Outokumpu Stainless AB

**Opponent:**

UGINE & ALZ FRANCE

**Headword:**

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**Relevant legal provisions:**

EPC Art. 123(2), 83

RPBA Art. 13(1)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Late-filed requests - not admitted because not clearly allowable"

**Decisions cited:**

-

**Catchword:**

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Case Number: T 1294/08 - 3.2.06

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.06  
of 12 November 2009

**Appellant:** Outokumpu Stainless AB  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 20 May 2008  
revoking European patent No. 1159091 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** G. Kadner  
**Members:** G. Pricolo  
K. Garnett

## Summary of Facts and Submissions

I. The appeal is from the decision of the Opposition Division posted on 20 May 2008 revoking European patent No. 1 159 091 on the ground of lack of sufficiency of disclosure (Article 100(b) EPC).

II. The appellant (patent proprietor) filed an appeal, received at the EPO on 7 July 2008, against this decision. Payment of the appeal fee was recorded on 30 June 2008. With the statement setting out the grounds of appeal, received at the EPO on 22 September 2008, the appellant requested that the decision of the Opposition Division be set aside and the patent maintained in amended form according to one of the main, first or second auxiliary requests filed with the grounds of appeal.

III. Oral proceedings, at the end of which the decision of the Board was announced, took place on 12 November 2009.

The appellant withdrew its previous requests and filed new main and auxiliary requests for maintenance of the patent in amended form. It requested that the decision under appeal be set aside and the patent be maintained on the basis of the main, alternatively the auxiliary request, filed during the oral proceedings.

The respondent (opponent) requested that the appeal be dismissed.

IV. Claim 1 according to the main request is identical to claim 1 according to the auxiliary request and reads as follows:

"1. Method for the manufacturing of strips of stainless steel, comprising cold rolling of a strip which in a foregoing process (A) has been manufactured through casting a melt from a cast strip and/or has been hot rolled, characterized in that the cold rolling is performed in a rolling mill line (B), which comprises, in the initial part of the line, at least two initial cold rolling mills (11- 13) in series, after said initial cold rolling mill at least one annealing furnace (18) and at least one pickling section (26,27), and in a terminating part of the line, at least one more cold rolling mill (32), that the cast and/or hot rolled strip, which is dark coloured by oxides on the surfaces of the strip, with the dark coloured oxides remaining on the surfaces of the strip, first after decoiling is cold rolled in at least one of said initial cold rolling mills (11-13) so that the thickness of the strip is reduced totally 10 - 75 %, that the strip then is annealed and pickled in said annealing and pickling stations and descaled between annealing and pickling and is cold rolled in said at least some more cold rolling mill (32) so that its thickness is reduced by 2 - 20 % with four-high rolling mill, that the strip then is fed once more in the same direction through the same rolling mill line (B), wherein the strip is rolled again in at least one of said initial cold rolling mills (11-13) so that the strip consecutively is cold rolled in at least one of said more cold rolling mills (32) and in at least one of said initial cold rolling mills (11-13), comprising cold rolling in at least three cold rolling mills without intermediate annealing, reducing the thickness by totally 30 - 75 % before the strip is again annealed, descaled and pickled and that the strip is skin-pass

rolled with two-high rolling mill about 0,5 % as it passes through said terminating cold rolling mill (32) for the second time."

- V. The appellant's arguments concerning the admissibility of the main and auxiliary requests may be summarised as follows:

Claim 1 was modified over claim 1 of the previous requests by specifying that the cold rolling mill in the terminating part of the line was a four-high rolling mill for providing a thickness reduction by 2 - 20% and a two-high rolling mill for skin-pass rolling. The application as filed disclosed that the terminating part of the line could include a plurality of cold rolling mills and that the terminating cold rolling mill could be either a four-high mill for reducing the thickness of the strip or a two-high mill for skin-pass rolling. It was therefore clear for the skilled person that the step of reducing the thickness of the strip by 2 - 20% in the terminating part of the line as the strip was passed for the first time through the line was performed with a four-high mill and the step of skin-pass rolling in the terminating part of the line as the strip was passed for the second time through the line was performed with a two-high mill.

- VI. The respondent submitted that the requests should not be admitted into the proceedings in particular because the amendments made to claim 1 were not allowable under Article 123(2) EPC. The application as filed disclosed that the terminating cold rolling mill could be either a four-high mill or a two-high mill. However, there was no disclosure in the application as filed of a line in

which both a four-high mill and a two-high mill were provided in combination in the terminating part of the line, and in which the four-high mill was used for thickness reduction as the strip was passed for the first time through the line and the two-high mill for skin-pass rolling as the strip was passed for the second time through the line.

### **Reasons for the Decision**

1. The appeal is admissible.
  
2. During the oral proceedings, in the course of the discussion in respect of the requests filed with the grounds of appeal, the appellant submitted that the line in accordance with the invention comprised a single terminating cold rolling mill, which was used for thickness-reduction rolling and also skin-pass rolling. This single cold rolling mill was configured to be operated as a four-high rolling mill for thickness-reduction rolling and as a two-high rolling mill for skin-pass rolling. After deliberation, the Board issued a negative opinion concerning sufficiency of disclosure. The Board explained that such a single cold rolling mill was not disclosed in the patent in suit and the skilled person would have to exercise inventive skills to arrive at this solution. The oral proceedings were then interrupted as requested by the appellant. After resumption of the oral proceedings, the appellant filed the amended main and auxiliary requests under consideration.

3. The requests filed at the oral proceedings represent an amendment to the appellant's case as set out in the statement of grounds of appeal, which pursuant to Article 13(1) of the Rules of Procedure of the Boards of Appeal ("RPBA") may be admitted and considered at the Board's discretion. Article 13(1) RPBA makes clear that in exercising that discretion, the Board must consider a range of factors including inter alia the need for procedural economy. Admitting late requests that are not clearly allowable, for example because they do not immediately overcome existing objections or give rise to fresh issues that seriously appear to prejudice their allowability, would adversely affect procedural economy.

3.1 As compared to claim 1 of the requests filed with the grounds of appeal, claim 1 according to the main and auxiliary requests has been amended by adding the expressions: "with four high rolling mill" and "with two-high rolling mill". By way of these amendments claim 1 defines that the step of reducing the thickness of the strip by 2 - 20 % when the strip passes through the terminating cold rolling mill (32) for the first time is carried out with a *four-high rolling mill* and that the step of skin-pass rolling at about 0,5 % when the strip passes through the terminating cold rolling mill (32) for the second time is carried out with a *two-high rolling mill*.

3.2 The Board agrees with the appellant that the application as filed discloses that the line may be terminated by a plurality of cold rolling mills (see in particular page 12, line 36). The application as filed, in the final paragraph of page 7 referred to by the

appellant, also discloses that the terminating cold rolling mill consists either of a four high-mill allowing rolling with reductions by up to 15 to 20% or of a two-high mill intended only for skin-pass rolling. This latter passage, however, exclusively discloses two alternative configurations for the terminating cold rolling mill. There is no clear an unambiguous disclosure, either in this paragraph or in the remaining parts of the patent in suit, of combining a four-high mill and a two-high mill in a same terminating cold rolling mill, and using the former when the strip passes through the terminating cold rolling mill for the first time and the latter when the strip passes through the terminating cold rolling mill for the second time, as required by present claim 1. Therefore, claim 1 according to the main and auxiliary request introduces subject-matter extending beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

- 3.3 The Board also notes that with the amendments made to claim 1 the appellant's case in support of sufficiency of disclosure (Article 83 EPC) takes a different direction from that set out in the grounds of appeal (see page 2: *"It is thus obvious that the EP patent 1159091 will contain enough information to allow the skilled person to build the line according to the patent with only one rolling mill fulfilling both functions, cold reduction and skin-pass rolling"*), and also maintained during the oral proceedings (see point 2 above), according to which a single terminating cold rolling mill performs both cold reduction and skin-pass rolling. In the absence of any specific instructions in the patent in suit, it appears that the



skilled person would have to exercise inventive skills also to arrive at the solution claimed in which two different cold rolling mills are used in a same terminating part of the line in an alternating fashion. Accordingly, the amendments made do also not to appear to remove the lack of compliance with Article 83 EPC.

- 3.4 None of the appellant's requests being clearly allowable, the Board exercised its discretion under Article 13(1) RPBA not to admit the main and auxiliary requests into the proceedings.
4. In the absence of any admissible request submitted, the appeal has to be dismissed.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

M. Patin

G. Kadner