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**Datasheet for the decision  
of 26 June 2013**

**Case Number:** T 1961/09 - 3.2.06

**Application Number:** 03812253.7

**Publication Number:** 1572407

**IPC:** B23C5/22

**Language of the proceedings:** EN

**Title of invention:**

TANGENTIAL CUTTING INSERT AND MILLING CUTTER

**Patent Proprietor:**

Iscar Ltd.

**Opponents:**

Kennametal Inc.  
Sandvik Intellectual Property AB  
PALBIT S.A.

**Relevant legal provisions:**

EPC 1973 Art. 54(2)  
EPC Art. 84, 105, 112(1)  
EPC 1973 R. 64(a), 65(2)  
EPC R. 41(2)(c), 99(1), 101(2), 139

**Keyword:**

Admissibility of appeal - notice of appeal - name and address  
of appellant - after remedy of deficiencies  
Novelty - main request (no)  
Late-filed auxiliary requests - change of subject-matter -  
adjournment of oral proceedings would have been required (yes)  
Intervention of the assumed infringer - admissible (yes)

**Decisions cited:**

G 0001/12, T 0445/08, T 0097/98

**Catchword:**

1. Where there is objectively a deficiency in the notice of appeal indicating a genuine error as regards the identity of the appellant and there is objective evidence in the file indicating with a sufficient degree of probability who the appellant should be, then the notice of appeal may be corrected under Rule 101(2) EPC (see point 1.9 of the Reasons). The reference to the Enlarged Board in G 0001/12 by the Board in T 0445/08 does not bring into doubt the jurisdiction to correct an error in the notice of appeal in circumstances such as those in T 0097/98 (see point 1.14 of the Reasons).

2. While an intervention under Article 105 EPC shortly before oral proceedings in an appeal, raising new issues, will normally require the oral proceedings to be adjourned if not the remittal of the case altogether (G 0001/94), the oral proceedings may be continued if and so far as this can be done without unfairness to the other parties, in particular the proprietor (see points 2.2. and 2.3 of the Reasons).



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Case Number: T 1961/09 - 3.2.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.06**  
**of 26 June 2013**

**Appellant:**  
(Patent Proprietor)

Iscar Ltd.  
P.O. Box 11  
24959 Tefen (IL)

**Representative:**

Vossius & Partner  
Siebertstrasse 4  
81675 München (DE)

**Appellant:**  
(Opponent 1)

Kennametal Inc.  
PO Box 231  
Latrobe, PA 15650-0231 (US)

**Representative:**

Sties, Jochen  
Prinz & Partner  
Rundfunkplatz 2  
80335 München (DE)

**Party as of right:**  
(Opponent 2)

Sandvik Intellectual Property AB  
811 81 Sandviken (SE)

**Representative:**

Lieke, Winfried  
WSL Patentanwälte  
Kaiser-Friedrich-Ring 98  
65185 Wiesbaden (DE)

**Party as of right:**  
(Opponent 3)

PALBIT S.A.  
Rua das Tílias  
Branca, Albergaraia-a-Velha  
3854-908 PALHAL (PT)

**Representative:**

Ferreira, Maria Silvina  
Clarke, Modet & Co.  
Rua Castilho, 50-9°  
1269-163 Lisboa (PT)

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
22 July 2009 concerning maintenance of the  
European Patent No. 1572407 in amended form.

**Composition of the Board:**

**Chairman:** M. Harrison  
**Members:** G. Kadner  
K. Garnett

## **Summary of Facts and Submissions**

- I. The mention of grant of European patent No. 1 572 407 to ISCAR Ltd ("the proprietor") was published on 3 January 2007.
- II. Two notices of opposition, in which revocation of the patent on the grounds of Article 100(a) EPC was requested, were filed against the granted patent. The first was filed in the name of Kennametal Inc., PO Box 231, Latrobe, PA 15650-0231, U.S.A. For simplicity the Board will hereafter refer to Opponent I (later Appellant II) as either "the opponent" or "Kennametal Inc". On 1 April 2009 the opposition of Opponent II was withdrawn.
- III. On 2 June 2009 third party observations were filed in which the opponents' grounds for revocation of the patent were supported.
- IV. By way of its decision given at the end of oral proceedings on 2 July 2009 and posted on 22 July 2009, the opposition division found that the patent in an amended form according to the proprietor's first auxiliary request met the requirements of the EPC.
- V. On 1 October 2009 notices of appeal were filed against this decision by the proprietor (Appellant I) and by a party identified as "Opponent I: Kennametal Technologies GmbH". For the present the Board will refer to this latter appellant as Appellant II and to Kennametal Technologies GmbH as "Kennametal Technologies". The respective appeal fees were paid on the same day. The respective grounds of appeal were filed on 1 December 2009. The proprietor requested maintenance of the patent as granted. It also filed

auxiliary requests 1 to 7, auxiliary 1 corresponding to the form found allowable by the opposition division. Appellant II requested revocation of the patent.

- VI. In its communication dated 31 July 2012 the Board expressed its preliminary opinion that the subject-matter of claim 1 of the main request seemed to lack novelty when compared with the disclosure of D1. As regards the first auxiliary request, the Board noted that an objection had been raised concerning lack of clarity of the term "generally straight". The amendments to claim 1 according to the second and third auxiliary requests possibly resulted in an inadmissible intermediate generalisation. The subject-matter of claim 1 of the fourth auxiliary request again did not appear novel when compared with D1. In relation to claim 1 according to the fifth to seventh auxiliary requests, Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA) was mentioned, it also being noted that claim 1 of the respective requests appeared not to converge with respect to claim 1 of the preceding requests.
- VII. On 18 September 2012 a further third party observation was filed supporting the grounds for revocation of the patent.
- VIII. With letter dated 24 September 2012 the proprietor filed new auxiliary requests 1 to 6 which were based on former auxiliary requests 1 to 7, former auxiliary request 4 being deleted.
- IX. In response to a query from the Board on 23 October 2012 regarding Appellant II's notice of appeal, the Office received a facsimile from Prinz & Partner later

that day stating, with obvious reference to Appellant II's notice of appeal:

"The indication of the party filing the appeal as indicated in the Notice of Appeal of 1 October 2009 is herewith corrected, with reference to Rule 101(2) EPC, as follows:

Appellant:

Kennametal Inc., PO Box 231, Latrobe, PA 15650-0231, USA"

- X. Oral proceedings were held on 24 October 2012, during which the status of the opponent as appellant was discussed, in particular whether Appellant II's notice of appeal had been filed by Kennametal Inc or Kennametal Technologies GmbH and whether the notice of appeal should be corrected. During the oral proceedings the opponent filed *inter alia* a copy of an email dated 1 October 2009 from Mr L. Meenan, counsel acting on behalf of Kennametal Inc, in which he gave instructions to Prinz & Partner to file an appeal. At the opponent's request the proceedings were ordered to be continued in writing and directions were given for the filing of further evidence on this issue.
- XI. On 21 November 2012 the opponent filed evidence in the form of nineteen Exhibits including a Statutory Declaration of the opponent's representative in support of its request for correction of the notice of appeal.
- XII. With its letter dated 3 January 2013 in response to the opponent's submission the proprietor argued against the allowability of the correction of the notice of appeal.
- XIII. With its letter dated 25 January 2013 the opponent presented further arguments in support of its

submission that the name Kennametal Technologies had been used in the notice of appeal due to an obvious error and on 22 May 2013, in response to a communication from the Board, it filed two further Statutory Declarations to substantiate its submission.

- XIV. In its letter dated 24 May 2013 the proprietor again argued against the allowability of any correction, and filed evidence showing that Kennametal Technologies had acted in other opposition cases as opponent in its own name.
- XV. On 20 June 2013 notice of intervention was filed on behalf of Palbit S.A. (hereafter: "the intervener"). The intervention was based on proceedings which it had instituted against the proprietor in the Portuguese national courts for a declaration of non-infringement following receipt of a cease-and-desist request from the proprietor. Copies were filed *inter alia* of the cease-and-desist request, the filed request for a declaratory judgement and the official notification of the filed lawsuit (dated 9 April 2013) as well as a translation of the latter documents into English.
- XVI. On 26 June 2013 the adjourned oral proceedings were continued.
- XVII. The following prior art documents played a role:
- D1: WO-A-03/074218  
D5: US-B-6 238 146  
Exhibit 1: Photo of a milling cutter with cutting insert  
Exhibit 2: Photo of a milling cutter with cutting insert  
Exhibit 3: Photo of a milling cutter and a workpiece



Exhibit 4: Photo of a workpiece.

XVIII. The opening requests of the proprietor and the opponent included requests relating to the admissibility of the opponent's appeal and the correction of the notice of appeal filed by Appellant II. Thus the opening requests of the proprietor included requests that:

(i) The appeal of the opponent be dismissed as inadmissible;

(ii) If the Board of Appeal was not minded to dismiss the appeal of the opponent as inadmissible, a question be referred to the Enlarged Board of Appeal, alternatively the proceedings be adjourned to await the decision of the Enlarged Board of Appeal in G 1/12.

The opening requests of the opponent included requests that:

(i) The notice of appeal filed by Appellant II be corrected to indicate Kennametal Inc as Opponent I (and appellant);

(ii) Alternatively, the proceedings be stayed to await the decision of the Enlarged Board of Appeal in G 1/12.

For reasons given later in this decision, during the course of the oral proceedings:

(a) the opponent's request for correction of Appellant II's notice of appeal to indicate Kennametal Inc as Opponent I (and appellant) was granted; and

(b) the proprietor's corresponding requests to reject the opponent's appeal as inadmissible or to await the

outcome of the Enlarged Board's decision in G 1/12 or to refer a question to the Enlarged Board were all refused (see also the minutes of the oral proceedings).

XIX. In the course of the oral proceedings, the Board also decided that the intervention by the intervener was admissible. The Board also heard submissions on how the proceedings should be continued, or whether an adjournment was required, given the very late stage at which the intervention had occurred and given the new issues raised by the intervener. In the event, as a first step, the Board decided that the proceedings should be continued with a discussion of novelty of the subject-matter of claim 1 of the proprietor's main request in relation to D1, in respect of which the intervener had agreed not to make any submissions. After the issue of novelty had been discussed, the Board indicated its conclusion that the subject-matter of claim 1 of the main request was not novel over D1. When it then came to a discussion of the proprietor's auxiliary requests for maintenance of the patent, the proprietor requested that the case be remitted to the Opposition Division so that it could have a proper opportunity to deal with the intervener's objections. In the course of the discussion of this request, the intervener stated that it was willing to withdraw all its clarity objections to the proprietor's auxiliary requests if this overcame any obstacle to the proceedings being continued with a discussion of the opponent's clarity objections to these requests. After deliberation, the Board refused the proprietor's request for remittal at that stage and announced that the proceedings would be continued with a discussion of the opponent's clarity objections to the proprietor's auxiliary requests (see also the minutes of the oral proceedings).

XX. After the opponent's clarity objections to the proprietor's first auxiliary request had been discussed, the chairman indicated the Board's conclusion that the request did not satisfy the requirement of Article 84 EPC and that the same objection appeared to apply to the other auxiliary requests. In response, the proprietor ultimately filed the new Auxiliary Request 1 which became part of its final requests.

XXI. The final requests of the proprietor were that:

- (1) The decision under appeal be set aside and the patent be maintained as granted;
- (2) The appeal of the opponent be dismissed as inadmissible;
- (3) If the Board of appeal was not minded to dismiss the appeal of the opponent as inadmissible, a question be referred to the Enlarged Board of Appeal, alternatively the proceedings be adjourned to await the decision of the Enlarged Board of Appeal in G 1/12;
- (4) Alternatively, the decision under appeal be set aside and the patent be maintained on the basis of Auxiliary Request 1 filed during the oral proceedings at approximately 5:25 pm, as amended by the insertion of "direction of" before the word "rotation" in the final part of claim 1 (this request will be referred to further in this decision as the "final" auxiliary request 1);
- (5) Alternatively, the decision under appeal be set aside and the patent be maintained on the basis of one of the Auxiliary Requests 2 to 6 as filed with its letter dated 24 September 2012, amended such that the feature (1) was omitted from Auxiliary

Requests 2 to 5 and the feature (n) was omitted from Auxiliary Request 6.

The question which the proprietor requested to be referred to the Enlarged Board of Appeal reads:

"If the answer to question 1, 3, or 4 referred to the Enlarged Board of Appeal by T 445/08 (G 1/12) is yes, does the point of time at which the error occurred have any influence, particularly if it did not occur at the time of lodging the appeal, and more particularly, if it occurred way back in the first instance, and if so, what is the influence?"

XXII. The final requests of the opponent were simply that the decision under appeal be set aside and the patent be revoked.

XXIII. The final requests of the intervener were that the decision under appeal be set aside and the patent be revoked.

XXIV. Claim 1 of the main request (patent as granted) reads as follows (broken into a feature analysis adopted by the parties):

- "(a) A tangential cutting insert (10), for use in a milling cutter (80), comprising:
- (b) two identical opposing end surfaces (12) of a generally rectangular shape in an end view of the cutting insert (10),
- (c) a peripheral side surface (14) extending between the two opposing end surfaces (12),

- (c1) the peripheral side surface (14) comprising two identical opposing major side surfaces (18) of a generally parallelogrammatic shape,
- (c2) two opposing minor side surfaces (16) and
- (c3) corner side surfaces (22) located between adjacent major and minor side surfaces (18, 16); and
- (d) a peripheral edge (40) formed at the intersection of each end surface (12) and the peripheral side surface (14), two sections of each peripheral edge (40) constituting cutting edges (52);
- (e) each cutting edge (52) comprising a major cutting edge (54) formed by the intersection of a given major side surface (18) with a given end surface (12);
- (f) each end surface (12) having four corners (24, 26) and being provided with an abutment member (28) having an abutment surface (30);

characterized in that

- (g) the four corners (24, 26) of the end surface comprise two diagonally opposed lowered corners (26) and two diagonally opposed raised corners (24),
- (h) the lowered corners (26) being closer to a median plane M of the cutting insert (10) than the raised corners (24);
- (i) wherein, in each cross section of the cutting insert (10) taken in a plane parallel to a minor plane P1 of the cutting insert (10), the abutment surface (30) of a particular end surface (12) is closer to the median plane M than a leading section (54') of one of the major cutting edges (54) of the particular end surface (12)."

XXV. Claim 1 according to the final auxiliary request 1 is based on claim 12 as granted and reads:

"A milling cutter (80) comprising:

at least one cutting insert (10) comprising

- (b) two identical opposing end surfaces (12) of a generally rectangular shape in an end view of the cutting insert (10),
- (c) a peripheral side surface (14) extending between the two opposing end surfaces (12),
- (c1) the peripheral side surface (14) comprising two identical opposing major side surfaces (18) of a generally parallelogrammatic shape,
- (c2) two opposing minor side surfaces (16) and
- (c3) corner side surfaces (22) located between adjacent major and minor side surfaces (18, 16) and
- (d) a peripheral edge (40) formed at the intersection of each end surface (12) and the peripheral side surface (14), two sections of each peripheral edge (40) constituting cutting edges (52),
- (e) each cutting edge (52) comprising a major cutting edge (54) formed by the intersection of a given major surface (18) with a given end surface (12),
- (f) each end surface (12) having four corners (24, 26) and being provided with an abutment member (28) having an abutment surface (30),

wherein

- (g) the four corners (24, 26) of the end surface comprise:
  - two diagonally opposed lowered corners (26) and
  - two diagonally opposed raised corners (24),
- (h) the lowered corners (26) being closer to a median plane M of the cutting insert (10) than the raised corners (24),
- (i) wherein, in each cross section of the cutting insert (10) taken in a plane parallel to a minor plane P1 of the cutting insert (10), the abutment surface (30) of the particular end surface (12) is closer to the median plane M than a leading

section (54') of one of the major cutting edges (54) of the particular end surface (12), and wherein for a given direction of rotation of the milling cutter each main cutting edge has a positive axial rake angle when mounted as an operative cutting edge in the milling cutter; and a cutter body (82) having at least one insert pocket (84) in which the at least one cutting insert (10) is retained, the at least one insert pocket (84) comprising adjacent side and rear walls (88, 90) generally transverse to a base (92), the rear wall (90) being generally convex; the sidewall (88) being provided with an axial location surface (94) that abuts a given minor side surface (16) of the at least one cutting insert (10) at a given axial abutment region (96); the rear wall (90) being provided with two protruding tangential location surfaces (98, 100), located on either side of a central region (102) of the rear wall (90), a first of the two tangential location surfaces (98, 100) abuts a first tangential abutment surface located on the abutment surface (30) of the at least one cutting insert (10), a second of the two tangential location surfaces (98, 100) abuts a second tangential abutment surface located on the abutment surface (30)."

XXVI. The respective claim 1 of each of auxiliary requests 2 to 6 as filed with the proprietor's letter dated 24 September 2012 are based on claim 1 as maintained by the opposition division. This claim 1 has been amended with respect to claim 1 as granted by the replacement of "characterized in that" by "wherein", and the addition (at the end) of the wording:

"(j) characterized in that the shape of the major cutting edges (54) is generally straight in a side view"

These auxiliary requests also contain the following further individual amendments:

(1) Claim 1 according to auxiliary request 2 is based on that of the first auxiliary request as found allowable by the opposition division, to which the following wording is added:

"(g) two minor edges (44) formed at the intersection of the minor side surfaces (16) with each end surface (12),

(h) each minor edge (44) being divided into a first section (46) extending from an adjacent raised corner (24) and a second section (48) extending from the first section (46) to an adjacent lowered corner (26),"

the features (g) to (j) have been renamed to (i) to (l), and at the end of the claim, the following was also added:

"(m) and in that the first section (46) is approximately straight and is perpendicular to an adjacent major side surface (16) in a side view."

(2) Claim 1 according to auxiliary request 3 is based on that of auxiliary request 2 to which the following was added at the end:

"(n) and in that the second section (48) extends slopingly towards the lowered corner in a side view."



(3) Claim 1 according to auxiliary request 4 is based on that of auxiliary request 3, the words "and in that" in feature (k) being replaced by the word "wherein" and the following being added at the end:

"(o) wherein each cutting edge (52) further comprises a minor cutting edge (56) and a corner cutting edge (58) formed, respectively, by the intersection of minor and corner side surfaces (16, 22) with either end surface (12)."

(4) Claim 1 according to auxiliary request 5 is based on that of auxiliary request 4 to which the following was added at the end:

"(p) wherein adjacent each cutting edge (52) in the end surface (12) is a rake surface (6) along which chips, removed from a workpiece during a milling operation flow."

(5) Claim 1 according to auxiliary request 6 is based on that of auxiliary request 5, there being inserted after feature (g):

"(g') a minor cutting edge (56), extending along at least half of the length of its associated minor edge (44)."

and there being added at the end:

"(q) wherein each major cutting edge (54), extends from a respective raised corner (24) along substantially the whole length of its associated major edge (42);

(r) and wherein each cutting edge (52) comprises a corner cutting edge (58) associated with a raised corner (24) and at which the major and minor cutting edges (54, 56) merge."

XXVII. The arguments of the proprietor can be summarized as follows:

(1) The correction of the name in the notice of appeal should not be allowed since the request was not based on an obvious error. Indeed it had been intended to file the appeal in the name of Kennametal Technologies because the name had been checked against the representative's internal database. The debit order was also filed in the name of Kennametal Technologies. No error therefore occurred at the time when the appeal was filed. The declarations filed on 22 May 2013 in response to the Board's communication were not clear as to what had truly happened. For example, Ms Ebenbeck's declaration stated that she had "apparently inadvertently changed ... the name of the opponent", which gave no clear proof. At least, if the Board was minded to allow the correction, the case should be stayed until a decision of the Enlarged Board of Appeal in case G 1/12 was given. The case there was similar to the present case since an appeal had been filed in the name of an entity not entitled to file an appeal. An answer applicable to the present case could be expected from the Enlarged Board's decision as to whether the erroneously used name could be corrected. If the Board was not minded to stay the proceedings, the proprietor's supplementary question should be referred to the Enlarged Board.

(2) The oral proceedings of 26 June 2013 should not have been continued because the proprietor was unable to

deal with the new issues which had been raised by the intervener.

(3) The subject-matter of claim 1 according to the main request was novel when compared with the disclosure of D1. As already described in the introduction of the patent specification, a square shoulder using a milling cutter could only be achieved with a cutting insert having a positive rake angle. In the mind of the skilled person such a positive rake angle was implicitly but directly related to the generally parallelogrammatic shape of the opposing side surfaces. When compared with the cutting insert disclosed in D1 the skilled person would immediately recognize that it was not possible to achieve a positive rake angle with this known cutter and therefore it was not suitable as a cutting insert for a milling cutter. In the formulation of claim 1, the tangential cutting insert was not only suitable for use in a milling cutter but it was also an important feature characterizing the form of the cutting insert. The claim had to be read as it would by a skilled person and with a mind willing to understand what the features meant. In doing so, the skilled person would recognise that the objects of the invention identified in paragraphs [0006], [0007] and [0008] had to be fulfilled by the solution given in claim 1 and that claim 1 had thus to be interpreted in a more limited sense. Having regard to Exhibit 4 it was evident that the use of a cutting insert of the form of D1 in a milling machine did not provide surfaces of industrial quality, which was the only reasonable measure to be applied when considering "suitability" of the insert for milling. Furthermore the shape of the milling cutter disclosed in D1 was not generally parallelogrammatic since it had curved edges. Although column 6, lines 51 to 53 of the patent stated that the

major cutting edges could have any desired shape, this was qualified by the fact that the edge however had to slope downwardly from the raised corner to the lower corner, which was not the case in D1. This section of the patent could therefore not be used to infer that the shape shown in D1 was generally parallelogrammatic. Also, the term "generally parallelogrammatic" meant the same as "substantially parallelogrammatic". Therefore at least this feature distinguished the claim from the prior art and novelty was established.

(4) If clarity with respect to Auxiliary Request 1 as found allowable by the opposition division was an issue, as indicated in the Board's communication, the case should be remitted to the opposition division because the new arguments brought forward by the intervener had an influence on the consideration of clarity.

(5) The final Auxiliary Request 1 should be admitted into the proceedings since it overcame the lack of clarity objection, and the subject-matter of its claim 1 was novel with respect to D1, as D1 did not disclose a milling cutter. The amendments were occasioned by the discussion during the oral proceedings, so that the proprietor had responded at the first opportunity. The amendments made to claim 1 were clearly and unambiguously disclosed in the claims as granted together with the description (paragraph [0007]), where one of the objects of the patent in suit was disclosed in detail. A disclosure of this feature was also present in Figure 7 of the application as filed.

(6) The deletion of the further feature from claim 1 of all further auxiliary requests (see point XXI(5),

above) was made to deal with the clarity objection. These requests should therefore be admitted into the proceedings.

XXVIII. The opponent essentially argued as follows:

(1) The correction of the notice of appeal should be allowed since it was caused by a genuine error. It had never been intended to file an appeal in a name other than that of the opponent, Kennametal Inc. The error had occurred four years previously as a result of a mistake by an employee of Prinz & Partner in changing the name of the opponent in the firm's internal database (from Kennametal Inc to Kennametal Technologies). The error in the notice of appeal was immediately recognisable since the appellant had been identified there as "Opponent I", and it was clearly derivable from the file that the name of Kennametal Technologies GmbH was an incorrect name. The entity who really intended to file an appeal against the opposition division's decision was clearly identifiable as Kennametal Inc. Therefore the correction of the notice of appeal should follow under Rule 101(2) EPC in accordance with the case law of the Boards of Appeal. For these reasons the case was also distinguishable from the circumstances underlying the reference in G 1/12, where the name and address of the alleged appellant were mistaken, and where the appellant was not identified as the "opponent".

(2) The proceedings did not need to be adjourned or the case remitted to deal with the issues already in the proceedings and as raised by the opponent.

(3) The subject-matter of claim 1 according to the main request was not novel when compared with the disclosure

of D1. The cutting insert was equally suitable for axial and radial cutting as shown by Figures 11 and 13. The suitability of cutting inserts of the kind as claimed generally in tangential or radial milling operation was also confirmed by D5, which showed the two mounting alternatives of the cutting insert to a milling cutter in Figures 6A and 7 for tangential and radial cutting. Therefore the feature "for use" in a milling cutter did not distinguish the cutting insert from that disclosed in D1. The further feature of a "generally parallelogrammatic shape" was also present in D1 since, according to the description (paragraph [0033]), the major cutting edge could have "any desired shape". The cutting edges in D1 also sloped "generally downwardly". No interrelationship was indicated in the claim between a positive rake angle and a parallelogrammatic shape of the cutting insert, as allegedly were necessary for milling a square shoulder.

(4) The final auxiliary request 1 should not be admitted into the proceedings under Articles 13(1) and 13(3) of the Rules of Procedure of the Boards of Appeal ("RPBA"); the request should have been filed earlier and was *prima facie* not allowable. In any case, the last feature according to which "each main cutting edge has a positive rake angle when mounted as an operative cutting edge in the milling cutter" contravened Article 123(2) EPC because neither in the Figures nor the description was such a positive rake angle originally disclosed. Moreover, the new request contained new and complex subject-matter which the opponent and the Board could not reasonably be expected to deal with without adjournment of the proceedings.

(5) The deletion of the feature "the shape of the major cutting edges (54) is generally straight in a side view" should not be allowed because that amendment amounted to a change of the proprietor's case. The clarity objection which this amendment was intended to overcome had been a central point in the discussion of previous versions of this request and the deletion of this feature would completely change the case.

XXIX. As already noted, in order to avoid the need to adjourn the oral proceedings, the intervener agreed that it would not make any submissions regarding novelty with respect to claim 1 of the proprietor's main request in regard to D1 and would also withdraw its clarity objections to all the proprietor's auxiliary requests filed at the outset of the oral proceedings (see the minutes of the oral proceedings). The intervener's remaining submissions can thus be summarised as follows:

(1) Concerning the feature of a positive rake angle in the final auxiliary request, it also depended on the way in which the cutting insert was mounted to the milling cutter. No clear distinction could be determined between that feature and the prior art inserts.

(2) As to the embodiment shown in Figure 7 of the patent, the cutting edge of the insert as depicted did not have a positive rake angle. Thus the final auxiliary request 1 contravened Article 84 EPC because of the contradiction between the claim 1 and the patent specification.

XXX. Other evidence and arguments of the parties are referred to in the following part of this decision.

## Reasons for the Decision

### 1. *Admissibility of Appellant II's appeal*

1.1 It is not in doubt that the notice of opposition was filed by Kennametal Inc, a US corporation whose address was stated in the notice to be P.O. Box 231, Latrobe, PA 15650-0231, USA. The notice of opposition was filed on behalf of Kennametal Inc by Prinz & Partner acting by its authorised representative. The details of the opponent and its representative were duly entered in the register. At the oral proceedings before the Opposition Division, Opponent I, Kennametal Inc, is recorded in the minutes as appearing by this same representative. The decision, refusing the proprietor's main request but allowing its first auxiliary request, was made against Kennametal Inc and notified to Prinz & Partner as its representative.

1.2 A notice of appeal was then filed on Prinz & Partner's headed notepaper as follows:

"Patent Owner: Iscar Ltd  
Opponent I: Kennametal Technologies GmbH

In response to the Interlocutory Decision of 22 July 2009

We herewith

appeal

the above decision and request its revocation as well as the (sic) revocation of EP 1 572 407 ..."



The reference number for the case (K 1959 EP) was the same as that which had been used in the opposition proceedings.

- 1.3 The fact that the address of the appellant was not stated in the notice of appeal (cf Rule 99(1)(a) EPC) was not noticed by the Office, nor did it apparently occur to anyone that anything might be amiss with the name of the appellant in the notice of appeal until the day before the first hearing before the Board, on 24 October 2012 (see point IX, above). Evidence was subsequently filed on behalf of Kennametal Inc with a view to establishing that the reference to Kennametal Technologies was the result of a mistake (see points X, XI and XIII, above). The evidence was that although Kennametal Technologies was a company within the Kennametal group, there had been no transfer of the opposition from Kennametal Inc to Kennametal Technologies. A statement was provided by Mr H. Prokop, who in 2008 was working for Kennametal Technologies and involved in matters relating to inventions in the Kennametal group. He stated that in 2008 he was contacted by the head of the patent department of Kennametal Inc and was informed that he should become more involved and should assist the patent attorneys in Germany in the event that technical issues arose. He declares he informed Prinz and Partner that he would now be more involved in opposition proceedings and that they should contact him if assistance was required. A statement was also provided by Ms J. Edenbeck, an employee of Prinz & Partner, to the effect that she was contacted by Mr Prokop, who said that he had been appointed by Kennametal Inc to act as primary contact for technical issues in patent matters. In her statement she first says that this contact was a

"couple of years ago" (the statement is dated 17 May 2013) but subsequently says, on the basis of the firm's file in the opposition proceedings, that she believes the call was made in 2008. She then says: "I apparently inadvertently changed in our file K 1959 EP the name of the opponent to 'Kennametal Technologies GmbH' rather than adding them as an additional contact".

- 1.4 The public file shows that thereafter and until 23 October 2012 (see point IX, above) all communications in this matter from Prinz & Partner referred to Kennametal Technologies as Opponent I. Meanwhile, however, in its communications with the parties, the Office continued to identify Opponent I as being Kennametal Inc (see e.g. point 1.1, above) and the proprietor also continued to identify Kennametal Inc as opponent in its submissions.
- 1.5 Instructions were given by Kennametal Inc (and not Kennametal Technologies) to Prinz & Partner on 1 October 2009 to file an appeal (see point X, above). As to the notice of appeal itself, Mr J. Strass, the European patent attorney who signed the notice on behalf of Prinz & Partner, says that on 1 October 2009 he was asked, by a paralegal working for the attorney within the firm whose file it was, to sign the notice of appeal, this attorney being out of the office. He checked in the firm's database that the name of the opponent and the other details in the notice were the same as those recorded in the database, and then signed it.
- 1.6 The evidence of what happened is not perfect in all its details and the Board is conscious that the onus is on the opponent to establish the facts alleged to the

satisfaction of the Board, taking into account in particular the fact that the proprietor is not in any real position to challenge the evidence. Nevertheless, the evidence is credible and there is no real reason to doubt it. The Board accepts it.

- 1.7 Rule 101(2) EPC (and its predecessor Rule 65(2) EPC 1973) has been used in the past as a basis for correction of errors in a notice of appeal. The rule states:

"If the Board of Appeal notes that the appeal does not comply with Rule 99, paragraph 1(a), it shall communicate this to the appellant and shall invite him to remedy the deficiencies noted within a period to be specified. If the deficiencies are not remedied in due time, the Board of Appeal shall reject the appeal as inadmissible."

- 1.8 This rule was applied in T 97/98 to correct a notice of appeal in circumstances very similar to those in the present case. An opposition had been filed by, and the decision of the opposition division given against, Fresenius Medical Care Deutschland GmbH but in the notice of appeal a different legal entity, namely Fresenius AG, was indicated as "opponent" and thus as appellant. The appeal was filed by the same representative who had represented the opponent before the Opposition Division. It was explained that Fresenius Medical Care Deutschland GmbH and Fresenius AG were separate legal entities within the same group of companies. There was no question of any transfer of the opposition; the indication of Fresenius AG in the notice of appeal simply constituted an error. The Board held (Point 1.3 of the Reasons) that correction was possible, saying:

"It is the position of the board that there is a deficiency in the indication of the name and address of the appellant within the meaning of Rule 65(2) EPC not only when no such express indications at all have been made in the notice of appeal but also when incorrect indications have been made.

...

What is required under Rule 64(a) and 65(2) EPC is that there was indeed a deficiency, i.e. that the indication was wrong, so that its correction does not reflect a later change of mind as to whom the appellant should be, but on the contrary only expresses what was intended when filing the appeal. It must be shown that it was the true intention to file the appeal in the name of the person, who is, according to the request, to be substituted.

Furthermore, Rules 64(a) and 65(2) EPC 1973 cannot be construed as forming an exception to the basic principle that - the requirements for an admissible appeal having to be met on expiry of the time limit for filing the appeal - the appellant must be identifiable at that point in time. It must then be possible to determine whether or not the appeal was filed by a person entitled to appeal in accordance with Article 107 EPC. However ... it is sufficient therefore that it is possible to derive from the information in the appeal with a sufficient degree of probability, where necessary with the help of other information on file, e.g. as they appear in the impugned decision, by whom the appeal should be considered to have been filed ..."

The Board then considered the evidence filed by the appellant and concluded that "the overall factual

picture of all these elements sufficiently supports the conclusion that the indication 'Fresenius AG' in the appeal constituted a genuine error and did not reflect the wish to file the appeal in the name of 'Fresenius AG' but that it was the intention of the representative to appeal in the name of the opponent."

Returning to its earlier statement about the requirements of Rules 64(a) and 65(2) EPC 1973, the Board then continued:

As regards the question of what could be derived from the appeal the Board is satisfied that a person not knowing all the details considered here, presented later to the Board, could have derived from reading the appeal with the help of the indications in the impugned decision that the party on behalf of which the appeal was intended to be filed was the opponent, i.e. Fresenius Medical Care Deutschland GmbH, since this was the sole opponent, represented before the opposition division by the representative who had filed the appeal. Furthermore, there were no indications on file that a transfer of rights might have taken place in the meantime. Thus, in the present case it could be inferred by a third person from the circumstances of the appeal with a sufficient degree of probability that the opponent should be the appellant."

- 1.9 The reasoning and facts in that decision fit the facts of the present case. The evidence filed and summarised in points 1.1 to 1.5 above shows to the Board's satisfaction that it was not the intention to file an appeal by Kennametal Technologies but by the opponent, Kennametal Inc. As to what would have been apparent on inspecting the file, two notices of appeal were filed.

One was unmistakably from the proprietor. As to the other, the only other party remaining in the proceedings and thus the only other party entitled to file an appeal was the opponent. On the face of this notice of appeal it is apparent that something is wrong: Opponent I is stated to be Kennametal Technologies and yet Opponent I can be seen from the file to be Kennametal Inc. Further reading of the file would then have revealed that the confusing references to the opponent's name as Kennametal Technologies by the opponent's representative had started in early 2009 but that despite this neither the Office nor the proprietor had been under misapprehension about who in fact was the party acting as the opponent. For example, the party present as opponent at the oral proceedings before the Opposition Division on 2 July 2009 and against whom the decision was given was clearly understood by everyone to be Kennametal Inc.

- 1.10 The proprietor in its submissions argued strongly that the evidence filed by Mr Strass established that the intention was in fact to file an appeal by Kennametal Technologies since, according to Mr Strass' own evidence, after checking against the information in Prinz & Partner's files that the opponent's name was correct, he consciously signed the notice on behalf of Kennametal Technologies. However, the Board considers that this is part of the explanation for the mistake and must be looked at against the wider factual background. The evidence as a whole establishes that it was the intention to file a notice of appeal on behalf the entity that was the opponent.

1.11 The Board was also pressed by the proprietor to await the outcome of the reference to the Enlarged Board in G 1/12 or least to refer a separate question of its own. The facts in T 445/08, the referring decision in G 1/12, were very different. There, the patent had been granted to Zenon Environmental Inc but, following a subsequent transfer, the entry in the register was altered to record Zenon Technology Partnership as proprietor. The opposition division subsequently revoked the patent, correctly identifying Zenon Technology Partnership, a US company, as the proprietor. A notice of appeal was then filed headed:

"European Patent No 1140330 (99955620.2-062)  
Zenon Technology Partnership

The notice then stated:

"We hereby give Notice of Appeal against the decision of the Examination Division (*sic*) dated 28<sup>th</sup> December 2007, to refuse the above patent application (*sic*). Cancellation of the Decision in its entirety is requested so that the patent may be maintained with claims as presently on file ...

The name, address and nationality of the Appellant is:

ZENON ENVIRONMENTAL INC  
845 Harrington Court  
Burlington  
Ontario L7N 3P3  
Canada

zenon environmental inc is a Canadian corporation ..."

The proprietor's attorney filed evidence that it was always the intention to file the appeal in the name of the patentee, Zenon Technology Partnership, and the mention of Zenon Environmental Inc as appellant was a simple error.

- 1.12 The Board observed that the notice of appeal on its face complied with the requirements of Rules 99(1)(a) and 41(2)(c) EPC and that the named appellant was a real company and was fully identified. The Board considered that Rule 101(2) EPC could only justify corrections of deficiencies that were directed to completing the appellant's identity where this was not fully provided in the notice of appeal and where the appellant was already identifiable from the notice of appeal. It is clear that the Board considered that *prima facie* there were no "deficiencies" in the notice as such. The Board noted, however, that some decisions of the Boards of Appeal had introduced the subjective notion of "true intention" and that uncertainty existed about whether and, if so, when it was possible to have recourse to the true intention of a party to assess whether there was a remediable deficiency under Rule 101(2) in conjunction with Rule 99(1)(a) EPC. (As an aside, the present Board observes that this point was clearly highly relevant since if the notice of appeal were to be corrected it was necessary to have recourse to evidence of the subjective intention of the representative who had filed the notice of appeal.) In the event the Board in T 445/08 referred a number of questions to the Enlarged Board, the first of which is in the following terms:



"When a notice of appeal, in compliance with Rule 99(1) (a) EPC, contains the name and the address of the appellant as provided in Rule 41(2) (c) EPC and it is alleged that the identification is wrong due to an error, the true intention having been to file on behalf of the legal person which should have filed the appeal, is a request for substituting this other legal or natural person admissible as a remedy to "deficiencies" provided by Rule 101(2) EPC?"

1.13 The question is drawn in fairly wide terms. Technically it does not cover the present case because in the present case the address of the appellant was not given in the notice of appeal, contrary to Rule 99(1) EPC. However the Board does not think that this is a material distinction. More significantly, however, the question referred also does not deal with the present case because here, in contrast to the situation in T 445/08, the notice of appeal cannot be said to contain the name of the appellant in compliance with Rule 99(1)(a) EPC, as provided in Rule 41(2) (c) EPC. Thus, in the present case, there is ambiguity on the face of the notice as to whether the appellant is Opponent I or Kennametal Technologies. The referring Board in T 445/08 was not concerned with this kind of case and the questions referred were not intended to deal with it.

1.14 The Board has therefore not found it necessary to await the outcome of the Enlarged Board's decision, as requested by the proprietor. Unlike the position in T 445/08, it is clear to the Board that there is objectively a deficiency in the notice of appeal. Not only this, there is no real doubt about how it should be corrected. See point 1.9, above. In this, it is not necessary to have recourse to any evidence filed as to

what the subjective intention of the opponent's representative was (although such evidence was filed). The matter can be decided on an objective basis. The present Board does not consider that the Board in T 445/08 intended to bring into doubt the jurisdiction to correct an error in the notice of appeal in such circumstances as those in T 97/98.

1.15 As to the question which the proprietor requested to be referred to the Enlarged Board, this is as follows:

"If the answer to question 1, 3, or 4 referred to the Enlarged Board of Appeal by T 445/08 (G 1/12) is yes, does the point of time at which the error occurred have any influence, particularly if it did not occur at the time of lodging the appeal, and more particularly, if it occurred way back in the first instance, and if so, what is the influence?"

Question 1 is already set out above. Questions 3 and 4 were as follows:

"(3) If the answer to the first question is no, may the appellant's intention nevertheless play a role and justify the application of Rule 139 EPC?"

(4) If the answer to questions (1) and (3) is no, are there any possibilities other than restitution in integrum (when applicable)?"

The point which the proprietor wishes to make is that in the present case the relevant mistake was made in 2008, ie when the incorrect information was entered in Prinz & Partner's computer records, not when the notice of appeal was filed on 1 October 2009. However, the Board

considers that the relevant mistake was made when the notice of appeal was filed, stemming from a mistake made earlier in the day when drafting and checking the notice. The explanation for the mistake lies in the earlier mistake made in 2008. The Board cannot, however, see that the timing of the mistake or of its cause has any bearing on the issue and does not consider it necessary to refer a question to the Enlarged Board for any of the reasons given in Article 112(1) EPC.

- 1.16 As the decision in T 445/08 points out, there is some uncertainty in the case law as to whether there is jurisdiction under Rule 139 EPC to correct an error in a notice of appeal. The third question referred to the Enlarged Board in G 1/12 concerns this issue. In the circumstances there is no need for the Board to consider the matter further, except to say that assuming that there is such jurisdiction and given the Board's conclusions on the mistake in this case, the order for correction is also made under this rule.
  
2. *The intervention by the intervener and the further conduct of the proceedings.*
  - 2.1 The notice of intervention satisfies the requirements of Article 105 EPC and the Implementing Regulations. This was also not disputed by the proprietor when given an opportunity to do so, even though the proprietor had initially requested that the intervention be held inadmissible. The Board thus concluded that the intervention is admissible.
  
  - 2.2 As already noted (see point XIX, above), at the oral proceedings of 26 June 2013 the Board was faced with the problem of how the proceedings should be continued

given the very late stage at which the intervention occurred and the new issues which had thereby been raised. The proprietor objected to the proceedings being continued on that day because it had not had sufficient opportunity to react to the new position. The Board was also not in a position to deal with these issues and, indeed, where an intervener raises a new ground of opposition (as the present intervention did) it should normally be remitted to the Opposition Division. See G 1/94 (OJ EPO 1994, 787), point 13 of the Reasons. Nevertheless, and after the matter had been discussed with the parties, the Board decided that the oral proceedings should be continued, at least with a discussion of the novelty objection raised by the opponent in respect of claim 1 of the main request. This was made possible because the intervener agreed that it would not make any submissions on this issue. This meant that the issue could be discussed without causing any unfairness to the proprietor, because the discussion would be limited to an issue already in the proceedings before the notice of intervention was filed. Proceeding in this way was also fair to the opponent, who had a legitimate interest in seeing the proceedings concluded without further delay. For these reasons, the Board therefore decided as a first step to continue with the oral proceedings by hearing the opponent's novelty objection against claim 1 of the main request. As had been agreed, the intervener did not make any submissions on this issue.

- 2.3 After this issue had been dealt with and the objection found to be prejudicial to the allowability of the main request, the proprietor then requested that the case be remitted for further consideration of the new issues. The Board decided not to remit the case but to continue the proceedings by hearing the opponent's clarity

objections against the auxiliary requests then on file (Article 84 EPC). This was again possible because the intervener agreed that it would withdraw all its own clarity objections to the proprietor's auxiliary requests then on file. The Board was therefore in a position to hear the arguments of the opponent and the proprietor on these issues of clarity without the intervener adding any further objections. Although the proprietor argued that the Board might already have been influenced by having read the written submissions of the intervener on clarity, the clarity objection of the opponent had itself however not been modified by the intervener's submission and the proprietor and the opponent were not in any way, as a result of any comments by the intervener, presented with any new case in that particular regard (nor was it argued that the proprietor had been presented with a new case in this sense). The proprietor's further argument in favour of remittal, that the way it would have to argue against the clarity objection of the opponent might then be affected by the intervener, was also not convincing, since the way in which the proprietor might wish to argue against a clarity objection due to the presence of the intervener was not related to the clarity objection itself but rather to possible tactical considerations outside the framework of the appeal.

3. *Main Request (Article 54(2) EPC 1973)*

3.1 D1 discloses a tangential cutting insert 38 (page 1, line 2) comprising:

- two identical opposing end surfaces 40 of a generally rectangular shape in an end view of the cutting insert 38 (Figs. 7 and 8)
- a peripheral side surface 42 extending between the two opposing end surfaces 40, the peripheral side

surface 42 comprising two identical opposing major side surfaces 46, two opposing minor side surfaces 44 and corner side surfaces 48 located between adjacent major and minor side surfaces 46, 44 (Figs. 5 and 6)

- a peripheral edge 50 formed at the intersection of each end surface 40 and the peripheral side surface 42, two sections 66, 68 of each peripheral edge 50

constituting cutting edges (page 11, line 29 to page 12, line 10),

- each cutting edge comprising a major cutting edge 66 formed by the intersection of a given major surface 46 with a given end surface 40,

- each end surface 40 having four corners (Fig. 8) and being provided with an abutment member 82 having an abutment surface (Fig. 15)

- the four corners of the end surface 40 comprise two diagonally opposed lowered corners 60 and two diagonally opposed raised corners 64, the lowered corners 60 being closer to a median plane M of the cutting insert 38 than the raised corners 64 (Fig. 6),

- wherein in each cross section of the cutting insert 38 taken in a plane parallel to a minor plane P2 of the cutting insert 38, the abutment surface of the particular end surface 40 is closer to the median plane M than a leading section of the major cutting edges 66 particular end surface 40 (Figs. 6, 7 and 8).

3.2 The proprietor argued that the expression "for use in a milling cutter" in claim 1 indicated a particular form of the claimed cutting insert in combination with the generally parallelogrammatic shape of the side surfaces (feature c1), and indicated that the cutting edge 52 had a positive rake angle. In contrast, the cutting insert according to D1 did not provide a positive rake angle and was therefore not suitable for use in a milling cutter.

3.3 D1 (page 1, lines 2 to 3) however states clearly that the tangential indexable cutting insert is designed for use in metal cutting processes in general. No structural feature can be identified which makes it unsuitable for use in a milling cutter. Since the claim is directed to the cutting insert as such, the intended use cannot distinguish it from the cutting insert according to D1. Moreover, in Exhibits 1 to 3 a milling cutter is shown with cutting inserts mounted to it which are similar to the cutting insert disclosed in D1. It cannot be denied that the cutting insert according to D1 is therefore also suitable for the use in a milling cutter.

In regard to the aspect of a positive rake angle, this is not part of the claimed insert but instead relates to how the insert is attached to the milling head, which attached relationship is however not claimed. Although the proprietor argued that a skilled person should understand claim 1 in the context of the objects to be solved by the invention given in paragraphs [0006, 0007 and 0008], those objects are also not defined in claim 1, nor are those objects necessarily fulfilled by the features in claim 1, even if particular embodiments of the insert falling under the claim may be suitable to solve those problems. For example, paragraph [0007] concerns a "further object of the present invention" related to a positive rake angle which occurs when the insert is mounted as an operative cutting edge in a milling cutter. Claim 1 however does not define such a mounted relationship and so is not in any sense limited by this further object.

Likewise the proprietor argued that Exhibit 4 showed that, if one mounted an insert of D1 into a milling

cutter, the resulting machined workpiece was not of acceptable industrial standard, and thus the insert was clearly unsuitable "for use in a milling cutter". However, the finish quality to be achieved is not part of the claim and industrially acceptable standards anyway depend on who is judging the finish quality and for what purpose the workpiece is required or may be subject to further machining. Thus, the proprietor's argument does not convince the Board that the insert of D1 is not suitable for use in a milling cutter. If anything, Exhibit 4 appears to demonstrate quite aptly that the cutting insert used in it is indeed suitable for that purpose.

- 3.4 As regards the "generally parallelogrammatic shape", the Board considers this feature as not clearly defining strict limits for the shape covered. Therefore the claim has to be interpreted in its broadest meaning. No disclosure can be found in the description that would support the proprietor's assertion that a generally parallelogrammatic shape necessarily excludes curved edges. In as far as column 6, lines 49 to 53 of the patent is concerned, this does not give a definition of what generally parallelogrammatic means, but refers to edges shown in Fig. 4 which are generally straight (without further defining what is meant), whereby however it is added that the edge "can have any desired shape as long as (sic) generally slopes downwardly from the raised corner to the lowered corner 26". Thus, even the patent itself gives a broader interpretation of how the insert can be shaped rather than something which must have straight edges. The proprietor argued that even if the broader meaning were taken from column 6, this anyway did not correspond to what was in D1 Fig. 6 because the edges did not generally slope downwardly. However, the Board can only



conclude from Fig. 6 of D1 that a general downward slope is present (varying in actual slope angle from one end to the other). Likewise, in reference to the end view shown in Fig. 3 of the patent for example, an angle  $\alpha$  is shown which purposefully deviates from a straight edge, even though the claim states (feature (b)) that this is "generally rectangular shape". Thus, the term "generally", even when considering how this is used in the context of the patent, must be given a broad interpretation. Further, the proprietor argued that "generally parallelogrammatic" meant the same as "substantially parallelogrammatic"; however here again, nothing in the patent supports such a view.

Nor can it be concluded that the terminology "for use in a milling cutter" together with the terminology "generally parallelogrammatic shape" implies a positive rake angle, since the insert *per se* is being claimed. The only part of the description where a positive rake angle is mentioned is paragraph [0007], relating to one of the objects of the invention and specifically when the insert is mounted. Regarding Figure 6 of D1, and considering the broad interpretation which must be given, the skilled reader would recognize the form of the insert shown there in a side view as being "generally parallelogrammatic". Therefore this feature in its broad meaning is also disclosed in D1.

3.5 Since the cutting insert of D1 discloses all features of claim 1 of the patent, the subject-matter claimed lacks novelty.

4. *Final Auxiliary Requests (Article 13 RPBA)*

4.1 According to Article 13(1) RPBA any amendment to a party's case after it has filed its grounds of appeal

may be admitted and considered at the Board's discretion. The discretion has to be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

4.2 According to Article 13(3) RPBA amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

4.3 The appellant's final requests were filed during the oral proceedings before the Board, i.e. at a very late stage of the proceedings.

For the reasons given below, none of the requests was admitted into the proceedings.

5. *Amendments to Auxiliary Request 1*

5.1 One of the main issues during the discussion of the opening requests was the feature "(j) the shape of the major cutting edges (54) is generally straight in a side view" which had been added to claim 1 in the form found allowable by the Opposition Division. A clarity objection had been raised by the opponent in respect of this feature in the proprietor's first auxiliary request filed with its grounds of appeal (see its grounds of appeal, page 5, and the Board's communication of 31 July 2012, page 2, and point VI, above). After this issue had been discussed (see point XX, above) and the Board had indicated its conclusion that this amendment contravened the requirement of clarity, this request was firstly replaced by a newly

amended Auxiliary Request 1. After the Board had given a preliminary opinion that this request was unlikely to be allowed into the proceedings, it was replaced by the final Auxiliary Request 1.

5.2 Claim 1 of this request includes features from claim 12 and claim 1 as granted and a feature taken from the description (paragraph [0007]) reading: "and wherein for a given direction of rotation of the milling cutter each main cutting edge has a positive axial rake angle when mounted as an operative cutting edge of the milling cutter".

5.3 Firstly, the claim is no longer directed to a cutting insert but to a milling cutter having the features of granted claim 12. A claim with these features had never been in proceedings before, resulting in the introduction of new and complex subject-matter at a very late stage of the proceedings.

5.4 Secondly, the text indicated by the proprietor as a basis for the disclosure of the added feature reads:

"It is a further object of the present invention to provide a double-sided indexable tangential cutting insert having four main cutting edges, for a given direction of rotation of the milling cutter, each main cutting edge having a positive rake angle when mounted as an operative cutting edge in a milling cutter."

While a positive rake angle is disclosed as an object of the invention, this object does not define the invention, nor the features which are required to achieve this. Also, none of the existing claims (as granted or as filed) nor the description of the various

embodiments disclosed this newly introduced feature in some way as being part of the invention. The proprietor argued that the skilled person would easily recognize that the intended object of the invention would result in this feature being present, and that Figure 7 as filed anyway disclosed the feature directly and unambiguously in combination with the further features claimed. However, Figure 7 does not clearly identify any rake angle, and the specific location of the cutting edge with respect to the workpiece and any rake angle that might result cannot be unambiguously determined. The description of Figure 7 gives no assistance in this regard. Also, since this feature is not disclosed in relation to the further features of the claimed invention in the patent, and any description of it is missing, the claim includes subject-matter extending beyond the content of the application as originally filed, contrary to Article 123(2) EPC.

5.5 The final Auxiliary Request 1 was thus not only late filed, but raised new and complex issues and was not clearly allowable. Having regard to Article 13(1) RPBA, the Board thus exercised its discretion not to admit this request into proceedings.

6. *Final Auxiliary Requests 2 to 6 (Article 13(3) RPBA)*

6.1 In each claim 1 of these auxiliary requests, the following feature was deleted:

"that the shape of the major cutting edges (54) is generally straight in a side view".

6.2 This feature occupied much of the discussion of Article 84 EPC in respect of the opening Auxiliary

Request I, which was then twice replaced. Deleting this feature at this late stage of the proceedings would have raised new issues which neither the Board nor the opponent could be reasonably expected to deal with without adjournment of the oral proceedings. Therefore, having regard to Article 13(3) RPBA, the amended Auxiliary Requests 2 to 6 were not admitted into the proceedings.

7. *Conclusion*

As already recorded (see point XVIII above), the Board decided during the course of the oral proceedings to allow the opponent's request for correction of the notice of appeal and to refuse the proprietor's corresponding requests to reject the opponent's appeal as inadmissible or to await the outcome of the decision of the Enlarged Board in G 1/12 or to refer a question to the Enlarged Board.

Since the proprietor's remaining substantive requests for maintenance of the patent were either not admitted into the proceedings or are not allowable, the patent has to be revoked.

**Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated