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Datasheet for the decision of 26 April 2013

Case Number: T 0133/10 - 3.2.06

Application Number: 03008787.8

Publication Number: 1356876

IPC: B21D43/00

Language of the proceedings: EN

Title of invention:
Method and apparatus for automatically feeding metal profiles in bar form in systems for machining said profiles

Patent Proprietor:
Schnell S.p.A.

Opponents:
OSCAM S.p.A.
Schilt Engineering B.V.

Headword:

Relevant legal provisions:
EPC Art. 105, 123(2)
EPC 1973 Art. 84
RPBA Art. 13(1)

Keyword:
Main request - added subject-matter (yes)
Auxiliary requests - clearly not allowable - not admitted

This datasheet is not part of the Decision.
It can be changed at any time and without notice.

Decisions cited:
T 1279/04

Catchword:

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Case Number: T 0133/10 - 3.2.06

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

Appellant: (Opponent 1)	OSCAM S.p.A. Via Canelli 104/106 10127 Torino (IT)
Representative:	Notaro, Giancarlo Buzzi, Notaro & Antonielli d'Oulx Via Maria Vittoria 18 10123 Torino (IT)
Respondent: (Patent Proprietor)	Schnell S.p.A. Via Borghetto 2 Zona Industriale San Liberio 61030 Montemaggiore al Metauro PS (IT)
Representative:	di Francia, Vincenzo Manzella & Associati Via Nosadella 9, 40123 Bologna (IT)
Party as of right: (Opponent 2)	Schilt Engineering B.V. Broeikweg 27 2871 RM Schoonhoven (NL)
Representative:	Luten, Martin Haaije Arnold & Siedsma Sweelinckplein 1 2517 GK Den Haag (NL)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 16 November 2009 concerning maintenance of the European Patent No. 1356876 in amended form.**

Composition of the Board:

Chairman:	M. Harrison
Members:	T. Rosenblatt
	W. Ungler

Summary of Facts and Submissions

I. By its interlocutory decision dated 16 November 2009 the opposition division considered that the European patent number 1 356 876 in its amended form submitted during the opposition procedure met the requirements of the EPC.

II. Independent claim 1 of the auxiliary request found allowable by the opposition division reads as follows:

"*1. A method for automatically feeding metal profiles in bar form in systems for machining said profiles, comprising the steps of:*
(a). gripping a set of metal profiles (2) in bar form in one or more accumulation sections, from a magazine (5) that collects said profiles (2);
(b). transferring said set of metal profiles (2) in bar form or the gripped portion of said set of metal profiles (2) in bar form into a raised position;
(c). arranging said metal profiles (2) in bar form or the gripped portion of said set of metal profiles (2) in bar form on a transfer device (10) provided with means (16) for separating said metal profiles (2);
(d). counting a preset number of metal profiles (2) to be fed at each work cycle;
(e). untangling said preset number of metal profiles (2) taken previously from the bundle to which they belong and counted, engaging said preset metal profiles (2) to be fed by way of auxiliary supporting means (40) coupled to said transfer device (10) and actuated gradually along the longitudinal axis of said metal profiles (2) in order to gradually lift the bars (2);
(e2). disengaging said auxiliary supporting means (40) from said profiles (2) so as to deposit said profiles (2) on an underlying pre-accumulation channel (46);

(f). transferring and unloading the metal profiles (2) thus selected onto a conveyance and measurement line (6) in order to feed at least one machine arranged downstream.

This auxiliary request further comprised a second (amended) independent claim 10. This claim is however not relevant for the present decision, so that its wording is not reproduced here.

III. On 25 January 2010 the appellant (opponent O1) filed an appeal against this decision and paid the appeal fee on the same day. The grounds of appeal were submitted with the letter dated 18 March 2010.

IV. An intervention under Article 105(1)(a) EPC was filed by Schilt Engineering B.V. (hereafter opponent O2) on 28 November 2011. The opposition fee was paid on the same day. The intervention was based on a writ of summons as served on 31 August 2011 concerning an infringement suit lodged before the 's-Gravenhage district court by the proprietor (respondent) of the patent in suit against opponent O2.

V. In preparation for the oral proceedings the Board informed the parties of its preliminary opinion on the case, according to which discussion appeared to be necessary *inter alia* on the question of whether amended independent claim 1 underlying the impugned decision met the requirement of Article 123(2) EPC.

VI. Oral proceedings before the Board of Appeal took place on 26 April 2013. During the oral proceedings the respondent withdrew auxiliary requests 1 to 5, which had been submitted as a response to the Board's communication in preparation for the oral proceedings,

and submitted new auxiliary requests 1 and 2 each constituted by a single method claim.

VII. The appellant and opponent O2 requested that the decision under appeal be set aside and that the European patent be revoked. The respondent requested as a main request that the appeal be dismissed, or that the patent be maintained on the basis of the first or second auxiliary request filed during the oral proceedings on 26 April 2013.

VIII. The single claim of auxiliary request 1 reads:

"*1) A method for automatically feeding metal profiles in bar form in systems for machining said profiles, comprising the steps of:*
(a). gripping a set of metal profiles (2) in bar form in one or more accumulation sections, from a magazine (5) that collects said profiles;
(b). transferring said set of metal profiles (2) in bar form or the gripped portion of said set of metal profiles (2) in bar form into a raised position;
(c). arranging said metal profiles (2) in bar form or the gripped portion of said set of metal profiles (2) in bar form on a transfer device (10) provided with means (16) for separating said metal profiles (2);
(d). counting a preset number of metal profiles (2) to be fed at each work cycle;
(e). untangling said preset number of metal profiles (2) taken previously from the bundle to which they belong and counted, engaging said preset metal profiles (2) to be fed by way of auxiliary supporting means (40) coupled to said transfer device (10) and actuated gradually along the longitudinal axis of said metal profiles (2) in order to gradually lift the bars (2);

(f). transferring and unloading the metal profiles (2) thus selected onto a conveyance and measurement line (8) in order to feed at least one machine arranged downstream;
said step of
(e). engaging said preset metal profiles (2) by means of auxiliary supporting means (40) furthermore entailing:
(e1). moving said auxiliary supporting means (40) longitudinally to said profiles (2) so as to untangle said preset metal profiles (2) to be fed at each work cycle from said collection magazine (5);
(e2) sliding said auxiliary supporting means (40) in opposite directions longitudinally to a beam (52) said beam (52) being arranged in a bridge-like fashion over said magazine (5), parallel to said bars (2) and supporting wheels at the opposite ends, which roll on a pair of transverse guides (53) that are monolithic with the fixed framework of the magazine (5)
(e3) said bars (2) resting on rollers (45) and being retained laterally by forks (41)
(e4) said auxiliary supporting means (4) reaching an unloading position at the end of said beam (52)
(e5). disengaging said auxiliary supporting means (40) from said profiles (2) so as to deposit said profiles (2) on an underlying pre-accumulation channel (46);
said underlying pre-accumulation channel (46) being supported in a cantilevered fashion longitudinally to said beam (52)."

IX. The claim of auxiliary request 2 reads:

"*1) A method for automatically feeding metal profiles in bar form in systems for machining said profiles, comprising the steps of:*

a. gripping a set of metal profiles (2) in bar form in one or more accumulation sections, from a magazine (5) that collects said profiles;
b. transferring said set of metal profiles (2) in bar form or the gripped portion of said set of metal profiles (2) in bar form into a raised position;
c. arranging said metal profiles (2) in bar form or the gripped portion of said set of metal profiles (2) in bar form on a transfer device (10) provided with means (16) for separating said metal profiles (2);
d. counting a preset number of metal profiles (2) to be fed at each work cycle;
e. untangling said preset number of metal profiles (2) taken previously from the bundle to which they belong and counted, engaging said preset metal profiles (2) to be fed by way of auxiliary supporting means (40) coupled to said transfer device (10) and actuated gradually along the longitudinal axis of said metal profiles (2) in order to gradually lift the preset number of metal profiles (2);
f. transferring and unloading the metal profiles (2) thus selected onto a conveyance and measurement line (8) in order to feed at least one machine arranged downstream;
said step of
e. engaging said preset metal profiles (2) by means of auxiliary supporting means (40) furthermore entailing:
e1. moving said auxiliary supporting means (40) longitudinally to said profiles (2) so as to untangle said preset metal profiles (2) to be fed at each work cycle from said collection magazine (5);
e2. sliding said auxiliary supporting means (40) in opposite directions longitudinally to a beam (52), said beam (52) being arranged in a bridge-like fashion over said magazine (5), parallel to said metal profiles (2)and supporting wheels at the opposite ends, which

roll on a pair of transverse guides (53) that are monolithic with the fixed framework of the magazine (5);
e3. said preset number of metal profiles (2) resting on rollers (45) and being retained laterally by two forks (41) of the auxiliary supporting means (40);
e4. said auxiliary supporting means (40) reaching an unloading position at the end of said beam (52), when said auxiliary supporting means (40) have exceeded the length of said preset number of metal profiles (2);
e5. disengaging said auxiliary supporting means (40) from said preset number of metal profiles (2) so as to deposit said preset number of metal profiles (2) on an underlying pre-accumulation channel (46);
said underlying pre-accumulation channel (46) being supported and tipping in a cantilevered fashion longitudinally to said beam (52);
the step (f) of transferring and unloading, comprising the step of
f1. actuating said beam (52) at said conveyance and measurement line (6) and tipping said pre-accumulation channel (46) to convey said preset number of metal profiles (2) onto said conveyance and measurement line (6)."

X. The arguments of the appellant and opponent O2 as far as relevant to the present decision may be summarised as follows. In the following, all references to the originally filed application refer to its published version.

a) *With respect to claim 1 of the main request in view of Article 123(2) EPC*:

The feature "*in order to gradually lift the bars (2)*" was disclosed in the application as filed

only in relation to the two preferred embodiments of the apparatus in paragraphs [0028], [0045] and in paragraph [0051]. These provided no basis for the generalisation of the feature in the way it had been introduced into claim 1.

The added feature "e2" was taken from original claim 3 in which it was defined in combination with a further step "e1" relating to a longitudinal movement of the auxiliary supporting so as to untangle the profiles from the collection magazine. Paragraphs [0028], [0046] and [0050] disclosed the same combination of longitudinal movement, untangling and disengaging. Paragraph [0046] stated more specifically that, as a result of this longitudinal movement of the auxiliary supporting means beyond the ends of the metal profiles, their deposition on the underlying pre-accumulation channel was completed by the disengagement of the metal profiles. The statements made in paragraphs [0048] to [0050] related to the preferred embodiment, which comprised several other features which were linked to the untangling and disengaging steps, such as a movable screw-feeder or two forks. These paragraphs did therefore not support the generalisation of the feature "e2". No basis could be found in the application for the step of disengaging for the purpose of depositing without the longitudinal movement of the auxiliary supporting means. The second embodiment mentioned in paragraph [0051] did not disclose how the step of disengaging the profiles should take place and could thus not serve as a basis for the omission of the step "e1" and the resulting generalisation of step "e2" from claim 3. This embodiment related

to lifting arms or elements replacing entirely the auxiliary supporting means and did not mention the disengaging of the bars or their deposition on an underlying pre-accumulation channel. Moreover, the lifting arms did not provide the same functions of supporting and untangling of the auxiliary supporting means as disclosed in paragraph [0028].

b) *With respect to auxiliary request 1 in view of Articles 84 and 123(2) EPC*:

Feature "e3" was drafted entirely disconnected from the auxiliary supporting means, whereas paragraph [0026] disclosed the features defined in "e3" only in relation to specific auxiliary supporting means, comprising two forks, rollers and also sliders. Consequently this amendment was objectionable under Articles 123(2) and 84 EPC. Paragraph [0046] described that the deposition was completed in the unloading position, and that this position was reached after the auxiliary supporting means had exceeded the length of the bars. These features had only partly been defined in the claims, thus infringing Article 123(2) EPC. Also the term "*unloading position*" lacked clarity because it was not clear what and where this position was. Paragraph [0048] disclosed that the transfer device had to be pivotable between a raised and lowered position in order to allow the loading of the bars, which was an essential condition for the engaging step of feature "e", and could thus not be omitted. Also in feature "f" the feature of a pivoting pre-accumulation channel should have been added, such as originally defined in claim 20.

The feature "*in order to gradually lift the bars*" still constituted a generalisation of the corresponding statement in paragraph [0045], which read "*gradually and continuously lift the bars*". The omission of "*continuously*" was also not allowable under Article 123(2) EPC. The claim still comprised inconsistent wording for the same subject-matter, such as "*bars*" and the different expressions of "*metal profiles*", which caused a lack of clarity. The request should not be admitted since it raised new issues at the oral proceedings which could not be dealt with without adjournment. The amendments were entirely based on features taken from the description, some of which could never have been expected to play a role in the proceedings, such as the bridge-like beam. This would have required an additional search in order to be able to discuss inventive step.

c) *With respect to auxiliary request 2 in view of Article 84 EPC*:

The further amendments did not overcome all objections raised against the previous request and introduced further defects. For example, the meaning of the pre-accumulation channel "*being supported and tipping in a cantilevered fashion*" was not clear.

XI. The respondent's arguments as far as relevant to the present decision may be summarised as follows:

a) *With respect to claim 1 of the main request in view Article 123(2) EPC*:

The amendments to claim 1 were directly and

unambiguously derivable from the general teaching which the skilled person received from the whole application as filed. In particular, paragraphs [0047] to [0050] referred to the invention in general and were not limited to a specific embodiment. In the two embodiments, see in particular paragraphs [0045] and [0051], the feature "*in order to gradually lift the bars (2)*" was disclosed as being the intended result of the movement (e.g. by sliding or lifting) of the auxiliary supporting means aimed at untangling the bars. This feature was also found in paragraph [0050] when read in combination with the paragraphs relating to the specific embodiments, i.e. [0045] and [0051], respectively.

The feature "e2" was literally disclosed in claim 3. Moreover, with respect to the first embodiment it was disclosed in paragraphs [0045], [0046] and [0051]. In the second embodiment referred to in paragraph [0051] and which presented all essential parts of the invention, this feature was at least implicit for the skilled person. Also in this embodiment, auxiliary supporting means were present in the form of the lifting elements and it became clear (from the fact that these were actuated gradually in an appropriate sequence) that the sliding movement was not essential for the untangling of the profiles from the bundle. The added feature "e2" in claim 1 provided for a fair protection of the invention by combining the teaching of the two embodiments in terms of their essential features as understood by the skilled reader in view of the original subject-matter in claim 1. The reader would also have understood this feature to be disclosed at least implicitly

in the part of the description referring to the invention in general in paragraphs [0047] to [0050], in particular in [0048] and [0050]. The skilled reader would have recognised that neither the step of "moving" nor any of the other features referred to in paragraph [0048] was essential for the invention. All that was necessary for defining the invention was the functional link between the steps of untangling by engaging and lifting of the profiles and the disengaging for the purpose of their deposition in the pre-accumulation channel, which link was present in the two embodiments and in the claim.

b) *With respect to auxiliary request 1 in view of Article 123(2) EPC*:

The amendments to claim 1 were based on original claim 3, which had now been entirely incorporated in the claim, together with the additional and partly renumbered features "e2", "e3", "e4" and "e5" from paragraphs [0015], [0045] and [0046]. The most representative features were taken from these passages to define with clarity all essential features of the method. Certain features, such as the sliders or the number of the forks, could thereby be omitted since they were not essential. Similarly, neither the movable transfer device referred to in paragraph [0048], nor the specific connection of the pre-accumulation channel for the purpose of the transfer of the metal profiles to a conveyance line according to feature "f", were essential to the accomplishment of the invention. The word "*continuously*" was not additionally required in the added feature "*in order to gradually lift the*

bars", since the auxiliary supporting means were defined in feature "e2" to be sliding which implied a continuous movement and hence also continuous lifting. The objections raised against the amendments all addressed structural features, whereas the claim related to a method. It was thus more important to define all actions of the method, which had been done. The amendments were filed to overcome the issues raised against the timely filed requests. They did not introduce any complex issues since they limited the subject-matter to the first embodiment. A single method claim simplified the issues to be dealt with, so that also in the light of complexity and procedural economy the auxiliary requests were clearly admissible.

c) *With respect to auxiliary request 2 in view of Article 84 and 123(2) EPC*:

The additional amendments were based on the same passages as indicated for auxiliary request 1 and introduced further features from the first embodiment. It thereby overcame all raised objections. The addition of the expression "*and tipping*" was based on lines 27 and 30 of paragraph [0028] and did not lead to a lack of clarity.

Reasons for the Decision

1. The appeal is admissible.

2. The intervention under Article 105 EPC is also admissible.

It may be noted that the respondent also did not contest the admissibility of the appeal or the intervention.

Main request

3. The subject-matter of amended claim 1 contravenes the requirement of Article 123(2) EPC for at least the following reason.

3.1 Compared to the granted patent, claim 1 of the main request has been amended by the insertion of, *inter alia*, step "e2", i.e. the step of

"*disengaging said auxiliary supporting means (40) from said profiles (2) so as to deposit said profiles (2) on an underlying pre-accumulation channel (46)*".

This wording is only found in original (and granted) claim 3, as also admitted by the respondent. Claim 3 however defines that

"*said step of: (e). engaging said preset metal profiles (2) by means of auxiliary supporting means (40) furthermore entails:*
(e1). moving said auxiliary supporting means (41) longitudinally to said profiles (2) so as to untangle said preset metal profiles (2) to be fed at each work cycle from said collection magazine;
(e2). disengaging said...".

Step "e2" added to claim 1 thus defines in more detail the step of "engaging" in feature "e" of claim 1 and is only disclosed in combination with a preceding step "e1" specifically relating to a longitudinal movement of the auxiliary supporting means which results in the

untangling of the metal profiles from the collection magazine. The application as filed lacks a disclosure of step "e2" without step "e1" in the context of a general method as defined in claim 1.

3.2 The respondent argued that the embodiments and the parts of the description relating to the invention in general allowed nevertheless for the omission of step "e1" and the resulting generalisation of the step "e2". The arguments are found unconvincing for the following reasons.

3.2.1 The respondent did not indicate any basis in the introductory portion of the application preceding the description of the preferred embodiments (paragraphs [0001-11]) or in the section following on from them (paragraphs [0051-60]), which related to the deposition of the metal profiles onto an underlying pre-accumulation channel in general. Nor can the Board itself see any such basis.

A method for automatically feeding metal profiles in bar form from a storage magazine to a machine for processing them is described in paragraphs [0030-46] in relation to a first embodiment of an apparatus for this purpose (the embodiment of the apparatus in paragraphs [0015-29]). The preferred apparatus used in this method comprises auxiliary supporting means which move or slide along the longitudinal axis of a beam supporting the apparatus (paragraphs [0015, 0027]). The sliding movement determines the gradual and continuous lifting of the bars, which thus untangle themselves from the bundle accommodated in an underlying storage magazine (second sentence of paragraph [0045], see also paragraph [0028]). These sliding auxiliary supporting means disengage from the bars when they reach an

unloading position at the end of the beam so as to complete the deposition on the underlying pre-accumulation channel supported in a cantilevered fashion longitudinally to the beam (paragraph [0046], first sentence). The description of the first embodiment of the apparatus and of the corresponding method of feeding the metal profiles to another machine does not however contain any statement allowing the isolation of, or generalisation of, the method step of disengaging as formulated in amended claim 1.

3.2.2 The second embodiment of the apparatus is disclosed in paragraph [0051] which reads: "*According to a different embodiment, not shown, said pre-accumulation channel 46 may be provided in multiple sections that are conveniently separated by a series of arms, provided with lifting elements, which are suitable to be actuated in an appropriate sequence in order to gradually lift the bars, in replacement of said sliding auxiliary supporting means 40.*" From this paragraph, which does not even mention a step of "disengaging", it cannot be determined how the deposition of the bars in the pre-accumulation channel is performed, whether it results from a step of disengaging an auxiliary supporting means from the bars or whether this is achieved in another way. The description of the second embodiment of the apparatus thus cannot provide a direct and unambiguous basis for the amendment to claim 1.

The further passage of the description in paragraphs [0047] to [0050], which the respondent considered to constitute a general teaching and not to be specifically linked to the first embodiment, refers in the first paragraph thereof to the "*method and apparatus according to the invention*" and to the aims

and advantages achieved by it, without mentioning the controversial feature at all. The first sentence of the following paragraph [0048] then states: "*This is achieved in particular thanks to the particular configuration of the apparatus, which has an element 10 for transferring the bars that cooperates with the movable auxiliary supporting means 40 which are actuated gradually along the longitudinal axis of the bars.*". Consequently, the passages in paragraphs [0048] to [0050] do not relate to a general method or apparatus; rather they refer to the previously described preferred embodiment. This is confirmed also by the numerous references to specific features (including their reference numerals) of the apparatus described in the preceding paragraphs. Paragraph [0050] again refers to the gradual movement of the auxiliary supporting means for allowing the easy untangling of the bars, before depositing them in the underlying pre-accumulation channel, without however mentioning the step of disengaging. Even if the reference to the deposition of the bars on the underlying pre-accumulation channel therein were understood by the skilled person to imply their disengagement by the auxiliary supporting means, this teaching would still relate to such means being longitudinally movable or sliding with at least the same functional features as defined also in the (omitted) feature "e1" of original claim 3.

3.2.3 It follows that the amendment to claim 1 is not directly and unambiguously derivable from the application as filed. The requirement of Article 123(2) EPC is thus not met for at least the above reason.

3.3 Since this reason by itself is sufficient to reach a conclusion on the respondent's main request, it is not

necessary for the purposes of this decision to consider the allowability of apparatus claim 10.

Auxiliary requests 1 and 2

4. According to Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) any amendment to a party's case, here the respondent's case, after it has filed its reply to the grounds of appeal may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of *inter alia* the need for procedural economy. In this respect the Boards frequently consider whether the proposed amendment is *prima facie* allowable in the sense that it at least overcomes the outstanding objections without giving rise to further ones, otherwise its admittance would be contrary to the requirement of procedural economy.

4.1 Compared to the main request, claim 1 of auxiliary request 1 has been further limited by introducing the entire subject-matter of original claim 3 - where former feature "e2" of claim 1 of the main request becomes feature "e5" in the auxiliary request 1 - and by adding further features "e2", "e3", "e4" and "f1". As a basis for the latter features, the respondent indicated in particular paragraphs [0015], [0045] and [0046]. The Board considers however that the added features are disclosed in the cited paragraphs only in combination with further features of the first embodiment of the apparatus to which they are closely structurally and functionally linked. The amendments thus lead to subject-matter which extends beyond the content of the application as originally filed, contrary to the requirement of Article 123(2) EPC.

4.1.1 For example, from the first sentence of paragraph [0046], which was indicated as a basis for feature "e4", it is clear that the disengagement of the auxiliary supporting means from the bars is not only a consequence of reaching an unloading position at the end of the beam but also of the fact that the auxiliary supporting means "*have exceeded the length of said bars*", i.e. they travelled beyond the ends of the bars. The claim however more generally states in feature "e4" that the auxiliary supporting means reach an (unspecified) unloading position at the end of the beam. Reaching an (unspecified) unloading position does not necessarily signify that the auxiliary supporting means have exceeded the length of the profiles, because the exact way of unloading is not defined in the claim either. According to the embodiment it may be concluded that the bars or metal profiles disengage from the auxiliary supporting means by falling on the underlying channel when the auxiliary supporting means have moved beyond the end of the bars. The claim is not limited to any particular manner of unloading and disengaging. The first sentence in paragraph [0046] states also that the deposition is completed as a consequence of disengaging in this unloading position ("*so as to complete...*"), which implies that the deposition already started before and is only completed in the unloading position. The claim in features "e4" and "e5" defines more broadly that the auxiliary supporting means disengage from the bars/metal profiles so as to deposit them on the underlying channel, which implies that the deposition takes place at that moment.

4.1.2 These two features, "*have exceeded the length...*" and "*so as to complete...*", are not implicitly defined by any of the features of amended claim 1, as alleged by the respondent. In the specific embodiment on which the

respondent relied as a source for the amendments, they are functionally linked to those added to the claim in features "e4" and "e5". The respondent also did not indicate any further basis in the application as filed which would have allowed a generalisation of these features taken from this preferred embodiment. The content of paragraphs [0047-50] does not provide a basis for the amendments either.

4.1.3 At least for this reason the amendment of claim 1 of auxiliary request 1 is at least not *prima facie* allowable.

4.2 The further amendments of claim 1 according to auxiliary request 2 are not *prima facie* allowable either. For example, the amendment to feature "e5" by the insertion of the expression "*and tipping*" in the definition of said pre-accumulation channel results in unclear subject-matter (Article 84 EPC 1973). The technical meaning of a channel "*being supported and tipping in a cantilevered fashion longitudinally to said beam*" cannot be properly understood. The respondent argued that this terminology was clear and would be understood by the skilled person in the light of the description paragraph [0028], in particular with respect to lines 27 and 30. Article 69 EPC and its protocol, to which the respondent had repeatedly referred during the discussions on *inter alia* the clarity of the amended claims, does not provide a basis for a limited construction of the claim in the light of the description. This is also confirmed in other decisions of the Boards - see for example T 1279/04 (see also "Case Law of the Boards of Appeal", 6th Edition, II.B.5.3.2), where that Board stated:

"*Article 69(1) EPC and the Protocol on its interpretation relate to the extent of protection conferred by the patent or patent application, primarily of concern in infringement proceedings. They serve to determine a fair protection – inter alia by reference to the description and drawings – in the context of an actual alleged infringer in circumstances where the claim wording is set in stone.*

In accordance with Article 69(1) EPC and the Protocol on its interpretation, this fair protection is a balance struck between a strict literal definitional approach to the claims – legally certain but potentially unfair to the proprietor, because of the inherent problems of claim drafting without a crystal ball – and a loose guidelines approach – potentially unfair, because of its uncertainty, to the alleged infringer.

By contrast, in examination and opposition proceedings the value of future legal certainty is paramount. In this forum the function of the claims is to define the matter for which protection is sought (Article 84 EPC, first sentence – which also applies to opposition). There is no case for anything other than a strict definitional approach given that in this procedural stage the claim may and should be amended to ensure legally certain patentability, in particular novelty and inventive step over any known prior art.

Amendment rather than protracted argument should be the answer to genuine difficulties of interpretation in all aspects of the examination and opposition procedure, it being acknowledged that amendments to a patent as granted shall be occasioned by grounds for opposition."

Although in that case the foregoing reasoning was given in the context of an argument on novelty, the present Board considers that the same considerations apply when examining the present amended claim for the requirement of clarity (Article 84 EPC 1973). If the terminology should only be understood in the way set out in the passage referred to by the respondent it would have been incumbent on the respondent, in the interest of legal certainty, to limit the claim accordingly by a clear definition with corresponding features.

4.3 Neither of auxiliary requests 1 or 2 is therefore *prima facie* allowable. In view of the need for procedural economy, the Board thus exercised its discretion under Article 13(1) RPBA not to admit these requests into the proceedings.

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. Patin M. Harrison

Decision electronically authenticated