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Datasheet for the decision of 16 October 2014

Case Number: T 0235/12 - 3.2.08

Application Number: 04425877.0

Publication Number: 1662010

IPC: C21D8/02, C21D8/12

Language of the proceedings: EN

Title of invention:
Magnetic hot rolled steel strip particularly suited for the production of electromagnetic lamination packs

Patent Proprietor:
ARVEDI, Giovanni

Opponent:
SMS Siemag AG

Headword:

Relevant legal provisions:
EPC Art. 100(b), 114(2)
RPBA Art. 13(1)

Keyword:
Sufficiency of disclosure

Decisions cited:

Catchword:

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Case Number: T 0235/12 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 16 October 2014

Appellant: (Opponent)	SMS Siemag AG Eduard-Schloemann-Strasse 4 40237 Düsseldorf (DE)
Representative:	Klüppel, Walter Hemmerich & Kollegen Patentanwälte Hammerstraße 2 57072 Siegen (DE)
Respondent: (Patent Proprietor)	ARVEDI, Giovanni Via Mercatello, 26 I-26100 Cremona (IT)
Representative:	Barbaro, Gaetano Società Italiana Brevetti S.p.A. Via G. Carducci, 8 20123 Milano (IT)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 5 December 2011 rejecting the opposition filed against European patent No. 1662010 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	T. Kriner
Members:	M. Alvazzi Delfrate
	D. T. Keeling

Summary of Facts and Submissions

I. By its decision posted on 5 December 2011 the opposition division rejected the opposition against European patent No. 1 662 010.

II. The appellant (opponent) lodged an appeal against that decision in the prescribed form and within the prescribed time limit.

III. Oral proceedings before the Board of Appeal were held on 16 October 2014.

IV. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed or, in the alternative, that the patent be maintained on the basis of auxiliary request 1 filed at the oral proceedings or the auxiliary request filed with letter of 15 September 2014 (in the following referred to as auxiliary request 2).

V. Claim 1 of the **main request** (patent as granted) reads as follows:

"A hot rolled magnetic steel strip suitable for manufacturing electrical steel sheet, having a thickness comprised between 0.65 and 1.0 mm and a fine grain structure, characterized by the fact of having a silicon content < 0.03%, parallelism rate < 0.02 mm and with the 70% of the ferritic grains comprised between grades 9 and 12 of the ASTM E 112 standard, these features being obtained without any additional steps of annealing and cold rolling with the following composition: C≤ 0.06%, Mn 0.10÷0.20%, Si < 0.03%, P≤

0.010%, S≤ 0.005%, Cr ≤ 0.10%, Ni ≤ 0.12%, Mo ≤ 0.03%, A1 0.030±0.050% [sic], the balance being Fe and unavoidable impurities."

Claim 1 of **auxiliary request 1** corresponds to claim 1 of the main request, wherein the term "parallelism rate" is replaced by

"parallelism".

Claim 1 of **auxiliary request 2** corresponds to claim 1 of the main request, this auxiliary request departing from the main request in that dependent claim 6 is deleted.

VI. The following documents played a role for the present decision:

A1: excerpt from DIZIONARIO D'INGEGNERIA, Unione Tipografico-Editrice Torinese, 1976, with translation into English of the relevant passages;
A3: excerpt from http://engineering.armstrong.edu/cameron/Geometric%20Dimensioning%20and%20Tolerancing.pdf; and
A4: excerpt from http://static.gest.unipd.it/esercizi/IM_IMC_disegno_tecnico_industriale/Dispense/DTI_VI_2007-08_Lez-09_GPS_tol_geometriche_parte_2.Pdf, with translation into English of the relevant passages.

VII. The arguments of the appellant can be summarised as follows:

Main request

The term "parallelism rate" was neither known to the person skilled in the art nor defined in the description. Nor could the parallelism rate be derived from the packing factor, because, as explained in paragraph [0014] of the patent in suit, there was no univocal correspondence between these two parameters. Therefore, the person skilled in the art was not in a position to verify compliance with the requirements of this parameter and put into practice the claimed invention. Therefore, the invention of claim 1 of the main request was not sufficiently disclosed.

Auxiliary request 1

Auxiliary request 1 was filed at an extremely late stage of the procedure, although the issue of sufficiency of disclosure linked to the wording "parallelism rate" was already raised in the notice of opposition. Therefore, there was no reason for the delay with which this request was submitted. Additionally this request was prima facie not allowable under Article 123(2) and 123(3) EPC. Hence, auxiliary request 1 should not be admitted into the proceedings.

Auxiliary request 2

Auxiliary request 2 was not allowable for the same reasons given for the main request.

VIII. The arguments of the respondent can be summarised as follows:

Main request

The person skilled in the art immediately understood what was meant by the term "parallelism rate", which corresponded to the term "parallelismo" used in the originally filed text in Italian. The meaning of this term was well known to the person skilled in the art, as documented for instance in A1, A3 or A4. The use of the term "rate" in the claim merely made clear that the parallelism was to be considered in respect of the thickness range defined in the claim.

Indeed from the patent as whole, for instance paragraph [0006], it was apparent that nothing else was intended. As to the packing factor, this parameter, although not having a univocal correspondence to the parallelism, provided an indication as to whether the strip exhibited good parallelism or not.

The parallelism of the steel strip could be easily measured by measuring the thickness of the strip or by measuring the surface profile of the strip after placing it on a reference plane.

Therefore, the information in the patent enabled the person skilled in the art to carry out the invention, which was sufficiently disclosed.

Auxiliary request 1

Auxiliary request 1 merely removed a possible ambiguity from the main request, since it clarified that the term "parallelism rate" meant "parallelism". Hence, it corresponded in essence to the main request and, as a consequence, did not extend its scope of protection and did not raise any new problem. Therefore, it should be admitted into the proceedings.

Auxiliary request 2

Claim 1 of auxiliary request 2 corresponded to claim 1 of the main request and was thus sufficiently disclosed for the same reasons explained for the main request. The deletion of dependent claim 6 was merely intended to avoid a discussion concerning the packing factor.

Reasons for the Decision

1. The appeal is admissible.

2. Main request

2.1 Claim 1 is directed to a hot rolled magnetic steel strip with a "parallelism rate" of less than 0.02 mm. Since the patent does not disclose a method which would inherently result in a steel strip with this property it is necessary, in order to carry out the claimed invention, to measure the "parallelism rate" of the strip and verify whether it complies with this condition. However, in order to carry out this measurement it is first necessary to understand what the term "parallelism rate" means.

The fact that a parallelism "rate" is stipulated by the claim suggests to the person skilled in the art that what is to be considered is not merely the parallelism of the strip, as submitted by the respondent, but rather its value relative to another quantity or the relationship between the parallelism and this other quantity. However, neither claim 1 nor the complete patent specification define what this other quantity is

and how the "parallelism rate" of a given strip is to be established.

The text in Italian of the originally filed application, which referred to "parallelismo", is of no relevance for the assessment of sufficiency of disclosure, since what is to be considered is the text (in English) of the patent as granted.

2.2 The respondent submitted, referring to documents A1, A3 and A4, that the person skilled in the art knew how the "parallelism rate" was defined and how to measure it. However, notwithstanding the fact that two of these documents (A3 and A4) are unsuitable to provide evidence as to the common general knowledge of the person skilled in the art before the priority date because they bear no indication of a publication prior to that date, none of A1, A3 and A4 mentions a "parallelism rate". Rather, they all relate to a "parallelism tolerance" or "parallelism error". Therefore, they cannot prove that the person skilled in art knew what was meant by "parallelism rate".

Moreover, the "parallelism tolerance" mentioned in these documents characterises a single plane which is considered in respect of a reference surface. Hence, even accepting that "parallelism rate" is the same thing as "parallelism tolerance" it would still have to be clarified how this concept is to be transposed to a rolled steel strip where not a single surface has to be considered but the two faces of the strip.

Hence, on the basis of the evidence on file, there is no indication that the person skilled in the art would have known what was meant by "parallelism rate".

2.3 The patent specification, in particular paragraph [0006] of the description mentioned by the respondent, does not comprise any further guidance in this respect, since it does not give a definition of this parameter.

2.4 Therefore, the patent in suit does not provide the person skilled in the art with the necessary information as to what the term "parallelism rate" of the strip means and how to measure it. Accordingly, it does not disclose the claimed invention in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art (Articles 100(b)and 83 EPC).

3. Auxiliary request 1

Since auxiliary request 1 was submitted after the reply to the statement of grounds of appeal, its admission into the proceedings is within the discretionary power of the Board, which exercises its discretion 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 (Article 114(2) EPC and Article 13(1) RPBA).

In the present case auxiliary request 1 was submitted at an extremely late stage of the proceedings, namely during the oral proceedings before the Board. Since the issue of sufficiency of disclosure linked to the term "parallelism rate", which this request is meant to address, was already raised in the notice of opposition and formed part of the debate during the whole course of the opposition and appeal proceedings, there is no justification for this delay.

Additionally, either the subject-matter of claim 1 of this request is the same as the subject-matter of the main request, in which case auxiliary request 1 would be superfluous, or, due to the change from "parallelism rate" to "parallelism", this subject-matter differs from that of the main request. In the latter case, given the uncertainty of the meaning of the term "parallelism rate", it would be at least prima facie doubtful whether the requirements of Article 123(3) EPC are complied with. Accordingly, in both cases the submission of this request could not be conducive to an efficient procedure.

Under these conditions, the Board decided not to admit auxiliary request 1 into the proceedings.

4. Auxiliary request 2

Auxiliary request 2 does not comply with the requirements of sufficiency of disclosure for the same reasons explained for the main request.

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:

V. Commare T. Kriner

Decision electronically authenticated