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**Datasheet for the decision
of 8 July 2016**

Case Number: T 1659/14 - 3.2.08

Application Number: 05708580.5

Publication Number: 1725349

IPC: B21C47/14, F16C17/03

Language of the proceedings: EN

Title of invention:

LAYING HEAD WITH A VIBRATION DAMPING DEVICE

Patent Proprietor:

DANIELI & C. OFFICINE MECCANICHE S.p.A.

Opponents:

Siemens Industry, Inc.
SMS group GmbH

Headword:

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 13(1), 13(3)

Keyword:

Amendments - added subject-matter (yes)
Late-filed auxiliary requests - admitted (no)

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

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D E C I S I O N
of Technical Board of Appeal 3.2.08
of 8 July 2016

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
2 June 2014 concerning maintenance of the
European Patent No. 1725349 in amended form.

Composition of the Board:

Chairwoman P. Acton
Members: M. Foulger
 D. T. Keeling

Summary of Facts and Submissions

- I. The opposition division, with its decision dated 2 June 2014, found that the then valid auxiliary request 1 met the requirements of the EPC.
- II. Appellant 1 (patent proprietor) and appellant 2 (opponent 2) filed appeals against this decision. The notices of appeal and the statements setting out the grounds of appeal were filed in due form and within the given time limits.
- III. Oral proceedings took place before the Board of Appeal on 8 July 2016.
- IV. At the end of the oral proceedings the requests were as follows:

Appellant 1 requested that the decision under appeal be set aside and the patent be maintained as granted, or in the alternative, that the patent be maintained in amended form according to one of the auxiliary requests 1-4 filed during the oral proceedings.

Appellant 2 and the respondent (opponent 1) requested that the decision under appeal be set aside and the patent be revoked. Furthermore that the main request and the auxiliary requests filed during the oral proceedings not be admitted into the proceedings.

The respondent further requested that Mr Loth, appearing for appellant 1, not be allowed to speak during the oral proceedings.

V. Claim 1 of the main request reads as follows:

"A laying head for forming coils of continuous and substantially rectilinear rolled products comprising a support structure (2), a rotor (3) adapted to rotate about its own axis (X) under the action of motor means and held in rotation by the support structure (2) by means of bearings (4), **characterised in that** there are only two bearings and that at least one of the two bearings (4) incorporates vibrations damping means comprising an oil film bearing (10) of the hydrodynamic type."

Claim 1 of the first auxiliary request reads as follows:

"A laying head for forming coils of continuous and substantially rectilinear rolled products comprising a support structure (2), a rotor (3) adapted to rotate about its own axis (X) under the action of motor means and held in rotation by the support structure (2) by means of only two inlet and outlet bearings (4), **characterised in that** ~~there are only two bearings and that~~ at least one of the two said inlet and outlet bearings (4) incorporates vibrations damping means comprising an oil film bearing (10) of the hydrodynamic type."

Claim 1 of the second auxiliary request reads as follows:

"A laying head for forming coils of continuous and substantially rectilinear rolled products comprising a support structure (2), a rotor (3) adapted to rotate about its own axis (X) under the action of motor means and held in rotation by the support structure (2) by

means of only two bearings one of which is in the inlet side facing the rolled product feed channel, and the other is in the outlet side facing the rolled product outlet bearings (4), **characterised in that** ~~there are only two bearings and that~~ at least one of the two said inlet and outlet bearings (4) incorporates vibrations damping means comprising an oil film bearing (10) of the hydrodynamic type."

Claim 1 of the third auxiliary request reads as follows:

"A laying head for forming coils of continuous and substantially rectilinear rolled products comprising a support structure (2), a rotor (3) adapted to rotate about its own axis (X) under the action of motor means and held in rotation by the support structure (2) by means of bearings (4), **characterised in that** there are only two bearings and that at least one of the two bearings (4) incorporates vibrations damping means comprising an oil film bearing (10) of the hydrodynamic type and in that of the two bearings performs a constraining function in the axial direction."

Claim 1 of the fourth auxiliary request reads as follows:

"A laying head for forming coils of continuous and substantially rectilinear rolled products comprising a support structure (2), a rotor (3) adapted to rotate about its own axis (X) under the action of motor means and held in rotation by the support structure (2) by means only two inlet and outlet bearings (4), **characterised in that** ~~there are only two bearings and that~~ at least said inlet and outlet bearings (4) incorporates vibrations damping means comprising an oil

film bearing (10) of the hydrodynamic type and in that of the two bearings performs a constraining function in the axial direction."

(Deletions with respect to the patent as granted struck through and additions underlined.)

VI. Appellant 1 (patent proprietor) argued essentially the following:

a) Main request - Article 123(2) EPC

Basis for the modification in claim 1 to "only" two bearings could be found in the following passages: p. 1, l. 9-10; p. 3, l. 6-7; p. 3, l. 11; p. 5, l. 1-3.

Furthermore, the passage from p. 5, l. 31 to p. 6, l. 7, and more particularly p. 6, l. 1, specifically mentioned "two mechanical bearings". Thus, from this context, it is clear that only two mechanical bearings were meant.

Furthermore, the characterising feature of claim 1 that there are "only two bearings" had to be read in combination with the features of the preamble which defined a support structure which held the rotor in rotation. Thus through the limitation "held ... in rotation" it was clear when requiring only two bearings that radial bearings were meant and that axial bearings were excluded. The passage in the originally filed description on p. 8, l. 24-27, where the supports were listed, disclosed two radial bearings and one axial bearing. As the axial bearing did not hold the rotor in rotation, it was not a bearing in the sense of the preamble of claim 1. Consequently also in this passage, "only" two bearings were disclosed.

Therefore, the main request complied with the requirements of Article 123(2) EPC.

b) Auxiliary requests - admissibility

The basis for the amendments in the first auxiliary request could be found throughout the description and that of the second auxiliary request on p. 3, l. 7-8 and p. 4, l. 11-13 of the description as originally filed. The third auxiliary request was based on p. 6, l. 5-7 of the description as originally filed. The fourth auxiliary request was a combination of the second and third auxiliary requests. Thus the new requests were allowable in view of Article 123(2) EPC.

The requests were filed at this late stage in response to the decision of the opposition division and as an attempt to overcome the position of the Board.

The auxiliary requests should therefore be admitted into the proceedings.

VII. Appellant 2 (opponent 2) and the respondent argued essentially the following:

a) Main request - Article 123(2) EPC

Since a laying head was subject to massive axial forces, an axial support was necessary to hold the rotor in rotation. The support structure defined in the preamble of claim 1 must therefore include axial as well as radial bearings.

The passage on p. 6, l. 1-7 disclosed two bearings but did not disclose "only" two. Moreover this passage only

described two bearings in the context of one of the bearings performing a constraining function in the axial direction. Furthermore this passage did not describe two bearings in conjunction with the feature of claim 1 whereby the vibration damping means comprised an oil film bearing of the hydrodynamic type. This passage could therefore also not provide a basis for claim 1 as granted.

The passage on p. 8, l. 24-27, which was in conjunction with bearings of the hydrodynamic type, disclosed three bearings, i.e. the front radial bearing, the front axial bearing and the rear radial bearing. Three bearings was clearly not "only" two and hence this passage could not provide a basis for claim 1 as granted.

The other passages cited by appellant 1 did not provide any basis for two bearings, let alone "only" two.

b) Auxiliary requests - admissibility

The auxiliary requests were filed at an extremely late stage during the oral proceedings. They were not based on combinations of granted claims but rather on features taken from the description. Furthermore, these requests raised new questions with respect to Articles 56, 84, 123(2) and (3) EPC which, should these requests be accepted, would require remittal to the Opposition Division.

The requests should not therefore be admitted into the proceedings.

Reasons for the Decision

1. The Board decided, during the oral proceedings, to allow Mr Loth to speak for appellant 1 (patent proprietor) and to admit the main request into the proceedings. These decisions were taken in favour of the losing party and thus do not affect the final decision; they are therefore not addressed in this decision.
2. Main Request - added subject-matter (Article 123(2) EPC)
 - 2.1 Claim 1 of the main request - patent as granted - is based on claim 1 as originally filed further limited by the feature that "there are only two bearings" and that the vibration damping means comprise an oil film bearing of the hydrodynamic type. Of these it is the first modification that is controversial.

"Only two bearings" is not explicitly mentioned in the application as originally filed. The originally filed claim mentions two bearings. This is however generally accepted in patent matters as meaning "two or more" bearings and cannot in itself form a basis for the modification.
 - 2.2 With respect to the passages cited by appellant 1 (patent proprietor), p. 1, l. 9-10 concerns the prior art rather than the invention described in the application and, although it mentions two bearings, there is no indication that only two bearings are meant.

The passage, p. 3, l. 6-7, merely mentions that there

is an inlet and an outlet side without mentioning the type or number of bearings. The passage, p. 3, l. 11, mentions "the mechanical bearing placed on the wire outlet side" and thus gives the impression that there is a single mechanical bearing on the outlet side. This is however in combination with a magnetic device that damps vibrations rather than the hydrodynamic type which is specified in claim 1.

The passage, p. 5, l. 1-3, states that "the hydraulic device can replace both the conventional rolling bearings". This does not however imply that there are only two bearings as claimed but rather, if there were originally only two, that they have been replaced by the hydraulic device which is referred to in the singular. Hence, these passages do not provide a basis in the originally filed application for claim 1 as granted.

2.3 Page 8, lines 24-27 of the originally filed description reads "[a] particularly advantageous embodiment of the device of the invention provides that all the supports of the laying head are equipped with hydrodynamic or oil film bearings, namely the front radial bearing, the front axial bearing and the rear radial bearing." Thus this passage, through the phrase, "all the supports", provides an exclusive list of all the bearings used in this particular embodiment of which there are three listed.

The argument that the preamble of claim 1, with the phrase "held in rotation by the support structure (2) by means of bearings", limited the bearings, mentioned in the characterising part of the claim, to radial bearings is unpersuasive. "To be held in rotation" may in some cases imply simply radial bearings; however in

the current case of a laying head which is subject to considerable axial forces there must also be axial support of the rotor. This is also recognised in the context of the cited passage wherein an axial bearing is provided. Therefore, the person skilled in the art would understand that the support structure, mentioned in the preamble of the claim, must include some sort of axial support. With this understanding, the cited passage must be read as having three bearings in the sense of claim 1 and cannot therefore support the feature "only two bearings" in the characterising part of claim 1.

A further passage of the description cited by appellant 1 (patent proprietor), to support the view that the bearings referred to in the characterising portion could be of the radial type, was p. 5, l. 31 to p. 6, l. 7. This passage teaches that the rotor is held in rotation by means of two mechanical bearings. However, this passage goes on to teach that one of the bearings performs a constraining function in the axial direction (p. 6, l. 5 to l. 7) which is consistent with the skilled person's understanding (see above) that some sort of axial support is essential. Thus, leaving aside the question of whether "only" two bearings were indeed disclosed, if there were only two, then one of them also had to perform a constraining function in the axial direction. Thus, having only two bearings without axial constraint is not disclosed, and, hence, is an unallowable intermediate generalisation.

2.4 The subject-matter of claim 1 therefore extends beyond that of the application as originally filed and consequently the requirements of Article 123(2) EPC are not met.

3. Admission of auxiliary requests into the proceedings
- 3.1 The auxiliary requests were filed at a late stage during the oral proceedings. According to Article 13(1) RPBA in conjunction with Article 114(2) EPC, their admittance is at the Board's discretion.
- 3.2 These new requests are based on features taken from the description and not on combinations of granted claims. They could also have been presented earlier as essentially the subject-matter of the proceedings has not changed - in this respect the Board, with the communication in accordance with Article 15(1) RPBA dated 26 February 2016, had indicated that Article 123(2) EPC was to be discussed.
- 3.3 Furthermore, these requests raise further questions under Articles 84 and 123(2), (3) EPC as well as Article 56 EPC. Thus neither the Board nor the other parties could be expected to deal with these requests without adjournment of the oral proceedings and they are consequently not admitted into the proceedings (Article 13(3) RPBA).

Order

For these reasons it is decided that:

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

The Registrar:

The Chairwoman:



M. Kiehl

P. Acton

Decision electronically authenticated