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**Datasheet for the decision
of 4 April 2017**

Case Number: T 2356/14 - 3.2.08

Application Number: 03741737.5

Publication Number: 1545819

IPC: B23B27/16

Language of the proceedings: EN

Title of invention:

COUPLING IN TOOLS FOR CHIP REMOVING MACHINING A TOOL, A
CUTTING HEAD AND A HOLDER

Patent Proprietor:

Seco Tools AB

Opponent:

Iscar Ltd.

Headword:

Relevant legal provisions:

EPC Art. 123(2), 84

RPBA Art. 13, 12(4)

Keyword:

Amendments - allowable (yes)

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 2356/14 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 4 April 2017

Appellant: Seco Tools AB
(Patent Proprietor) 737 82 Fagersta (SE)

Representative: WSL Patentanwälte Partnerschaft mbB
Kaiser-Friedrich-Ring 98
65185 Wiesbaden (DE)

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

Representative: Vossius & Partner
Patentanwälte Rechtsanwälte mbB
Siebertstrasse 3
81675 München (DE)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 27 October 2014 revoking European patent No. 1545819 pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairwoman P. Acton
Members: M. Alvazzi Delfrate
P. Schmitz

Summary of Facts and Submissions

- I. By its decision posted on 27 October 2014 the opposition division revoked European patent No. 1 545 819.

The opposition division found that both the main and the auxiliary request then on file had been amended in opposition proceedings in a way contrary to Article 123(2) EPC. No decision was taken on the grounds of opposition under Article 100(a) and 100(b) EPC.

- II. The appellant (patent proprietor) lodged an appeal against this decision in the prescribed form and within the prescribed time limits. During the written proceedings the appellant submitted a main request and three auxiliary requests.

- III. Oral proceedings before the Board were held on 4 April 2017.

At the end of the oral proceedings the appellant submitted a new main request, which was mainly based on former auxiliary request 3. The final requests were as follows:

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request filed at the oral proceedings.

The respondent (opponent) requested that the appeal be dismissed and that the appellant's request not be admitted into the proceedings. If this request was admitted, remittal to the opposition division for

examination of novelty and inventive step was requested.

IV. The only claim of the **main request** reads as follows:

"A tool for chip removing machining comprising a coupling between a first part forming a holder (1; 201; 301; 401) and a second part forming a cutting head (15; 115; 215; 315; 415), wherein the coupling comprises two interacting surfaces (3, 17; 117; 203, 217; 303, 317; 403, 417), i.e. a first surface arranged on the cutting head and a second surface arranged on the holder, and members (21) in order to force the surfaces (3, 17; 117; 203, 217; 303, 317; 403, 417) together, wherein the surfaces (3, 17; 117; 203, 217; 303, 317; 403, 417) are profiled with male and female members, respectively (10, 19; 119; 219; 319A, 319B; 419A, 419B and 7A, 7B, 18A, 18B; 118A, 118B; 207; 307A, 307B; 407A, 407B, respectively) in order to enable form locking against each other, that said tool and said coupling have a longitudinal centre line (CL), wherein both the first part (1; 201; 301; 401) and the second part (15; 115; 215; 315; 415) are provided with a central hole (5, 14; 114; 205, 214; 305, 314; 405, 414) for clamping the parts (1, 15; 115; 201, 215; 301, 315; 401, 415) against each other, characterized in that the male and the female members (10, 19; 119; 219; 319A, 319B; 419A, 419B and 7A, 7B, 18A, 18B; 118A, 118B; 207; 307A, 307B; 407A, 407B, respectively) are so formed that the parts (1, 15; 115; 201, 215; 301, 315; 401, 415) can be mounted in only one position in relation to each other, wherein the members (20; 120; 219; 319A, 319B; 419A, 419B and 7A, 7B, 18A, 18B; 118A, 118B; 207; 307A, 307B, 407A, 407B, respectively) which shall provide that the surface (17; 117; 217; 317; 417) of the cutting head (15; 115; 215; 315; 415) can be mounted in only one

position in relation to the second surface are located asymmetrically in respect of the centre hole (14; 114; 214; 314; 414), wherein the first part has a channel (11; 211; 311; 411) for cooling medium which exits in the envelope surface of the first part (1; 201; 301; 401)."

- V. The arguments of the appellant in respect of the main request can be summarised as follows:

Admission of the main request into the proceedings

During the opposition proceedings the attempts to establish novelty and inventive step by limiting the patent as granted by means of features disclosed in the drawings and in the description had failed, due to the objections under Article 123(2) EPC upon which the appealed decision was based. Therefore, the attempt to provide similar limitations by means of features disclosed in the originally filed claims, as in the present main request, was a reaction to the appealed decision. Thus, the request should be admitted into the proceedings.

Article 123(2) EPC

The present claim was based on claims 1, 5 and 7-10 as originally filed.

It was true that the present claim, unlike original claim 9, did not explicitly mention a longitudinal centre line of the holder. However, the presence of a longitudinal centre line was implicit for the claimed holder.

It was also true that the present claim comprised the possibility that the longitudinal centre line of the tool was the same as the longitudinal centre line of the coupling, which was not stipulated by the original claims. However, the embodiments in the drawings clearly showed such a common centre line.

Lastly, it was clear that the cutting head as defined in original claim 8 had no link with the provision of a cooling channel in the holder, as defined in original claim 7 or 10. Hence, these features could be combined, as was actually the case in the embodiments.

Therefore, the claim complied with Article 123(2) EPC.

VI. The arguments of the respondent in respect of the main request can be summarised as follows:

Admission of the main request into the proceedings

The present main request, like all the other requests filed in the appeal proceedings, could have been filed in opposition. Moreover, it shifted the focus of the invention compared with the versions which had been the subject of the appealed decision. Therefore, it should not be admitted into the proceedings.

Article 123(2) EPC

Original claim 9, which defined the presently claimed features of the holder, mentioned also a longitudinal centre line of the holder. By contrast, the present claim did not stipulate said longitudinal centre line. Hence, if said line were to be seen as a limiting feature, the claim would have been amended in a way

which represented an unallowable intermediate generalisation.

Moreover, the present claim could be construed as requiring that the longitudinal centre line of the tool was the same as the longitudinal centre line of the coupling, whereas the originally filed claims did not stipulate that. The claim comprised added subject-matter for this reason also.

Lastly, originally filed claim 8, which introduced the feature that one part was a cutting head, did not depend directly on claim 7 or claim 10, which disclosed that the first part (claim 7), i.e the holder (claim 10), exhibited a cooling channel. Hence, there was no original disclosure for the combination of a cutting head with a cooling channel in the holder.

Therefore, the claim did not comply with Article 123(2) EPC.

Reasons for the Decision

1. Admission of the main request into the proceedings

During the opposition proceedings the appellant attempted to establish novelty and inventive step by limiting the patent as granted by means of features taken from the preferred embodiments shown in the drawings and set out in the description. However, the opposition division found that these amendments did not comply with Article 123(2) EPC.

The present main request is an attempt to establish novelty and inventive step by limiting the patent as

granted by means of features relating to the holder and the cutting head which are part of the tool. Contrary to the approach followed in opposition, the added limiting features are taken in essence from the originally filed claims, in order to avoid objections under Article 123(2) EPC. The main request is thus a *bona fide* reaction to the decision of the opposition division.

Moreover, the aspect of the asymmetrical arrangement of the members has been introduced as a limiting feature in both the present main request and the main request underlying the appealed decision. Thus there is no shift in the focus of the claimed invention.

Under these circumstances the Board decided to exercise its discretionary power under Articles 12(4) and 13 RPBA by admitting the main request into the proceedings.

2. Article 123(2) EPC

2.1 The claim is based on claims 1, 5 and 7-10 as originally filed.

2.2 As pointed out by the respondent, original claim 9, which defined the features of the holder, mentioned a longitudinal centre line of the holder. However, said line does not have any relationship with the other features of claim 9. Hence, the claim simply defines that the holder has a longitudinal centre line. This feature is inherent to any holder, because a longitudinal centre line can always be defined, irrespective of the specific shape of the holder.

Thus, despite the fact that the present claim does not mention *expressis verbis* the longitudinal centre line of the holder, no difference can be seen in this respect between the disclosure of original claim 9 and that of the present claim. As a consequence, no unallowable intermediate generalisation is present.

- 2.3 According to the respondent, the present claim may be construed as requiring that the longitudinal centre line of the tool is the same as the longitudinal centre line of the coupling, whereas the originally filed claims do not stipulate that.

It is true that original claims 1 (directed to the coupling) and 5 (directed to the tool) do not necessarily require that the longitudinal centre line of the tool coincides with that of the coupling. However, the same reference CL is used for both centre lines. Moreover, the drawings clearly show a single centre line CL common to the tool and the coupling. Hence an embodiment wherein the longitudinal centre line of the tool is the same as that for the coupling is directly and unambiguously derivable from the application as originally filed. Thus, no added subject-matter can be seen in this respect either.

- 2.4 Lastly, it is true that originally filed claim 8, which introduces the feature that one part is a cutting head, does not depend directly on claim 7 or claim 10, which disclose that the first part (claim 7), i.e the holder (claim 10), exhibits a cooling channel.

However, for the person skilled in the art it is clear that there is no functional or structural link between the provision of a cooling channel in the holder and the fact that the holder is coupled to a cutting head.

Thus he understands that these features can be combined.

Indeed, the embodiments disclosed in the description clearly show the combination of a holder with a cooling channel and a cutting head coupled to said holder (see for instance Figure 4).

Hence, the combination of a holder with a cooling channel and a cutting head coupled to said holder is also directly and unambiguously derivable from the application as originally filed.

2.5 As a consequence, the claim complies with Article 123(2) EPC.

3. Article 84 EPC

The objection under Article 84 raised during the oral proceedings in respect of the previous version of auxiliary request 3, relating to a lack of an antecedent for the wording "the second surface", is not relevant for the present main request, which explicitly defines such an antecedent, since "the coupling comprises two interacting surfaces (3, 17; 117; 203, 217; 303, 317; 403, 417), i.e. a first surface arranged on the cutting head and a second surface arranged on the holder". Therefore, the claim has not been amended in way that causes a lack of clarity.

4. Remittal

The appealed decision dealt only with the issue of added subject-matter (Article 123(2) EPC), without deciding upon the grounds of opposition under

Article 100(a) and (b) EPC, which were raised in the notice of opposition.

The Board already indicated in the communication annexed to the summons to oral proceedings that it intended to remit the case to the opposition division if said grounds of opposition were to be considered.

This course of action has been requested by the respondent and not objected to by the appellant. Hence, the Board considers it appropriate to remit the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairwoman:



C. Moser

P. Acton

Decision electronically authenticated