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**Datasheet for the decision  
of 29 September 2016**

**Case Number:** T 0760/15 - 3.2.08

**Application Number:** 08008721.6

**Publication Number:** 1990120

**IPC:** B23D47/04, B27B5/07

**Language of the proceedings:** EN

**Title of invention:**  
Sawing machine of the vertical type

**Patent Proprietor:**  
Elcon Beheer BV

**Opponent:**  
Streibig AG

**Headword:**

**Relevant legal provisions:**  
EPC Art. 123(2), 123(3), 100(c)  
EPC R. 139, 140

**Keyword:**

Grounds for opposition - added subject-matter (yes)  
Amendments - allowable (no) - broadening of claim (yes)  
Correction of errors in decisions  
Correction of error - (no)

**Decisions cited:**

G 0001/10, G 0011/91

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0760/15 - 3.2.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.08**  
**of 29 September 2016**

**Appellant:** Elcon Beheer BV  
(Patent Proprietor) Waaier 2  
2451 VV Leimuïden (NL)

**Representative:** Assendelft, Jacobus H.W.  
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**Respondent:** Streibig AG  
(Opponent) Grossmatte 26  
6014 Littau (CH)

**Representative:** Bohest AG  
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**Decision under appeal:** **Decision of the Opposition Division of the European Patent Office posted on 11 February 2015 revoking European patent No. 1990120 pursuant to Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** M. Alvazzi Delfrate  
**Members:** M. Foulger  
P. Schmitz

## **Summary of Facts and Submissions**

- I. With the decision dated 11 February 2015 the opposition division revoked the European patent no. 1 990 120. The opposition division found that the feature "supporting bed bearing" in claim 1 of the patent as granted did not have a basis in the application as originally filed and that the auxiliary request contravened Article 123(3) EPC.
- II. The appellant (proprietor) filed an appeal against this decision within the given time limits. In the statement setting out the grounds of appeal, the rejection of the opposition and allowance of the auxiliary request were requested.
- III. Oral proceedings took place before the Board on 29 September 2016.
- IV. The appellant requested:
  - that the decision under appeal be set aside and that the opposition be rejected,
  - or in the alternative,
  - that the patent be maintained in amended form according to one of auxiliary requests 1-5 filed with letter dated 24 July 2016.
- V. The respondent (opponent) requested that the appeal be rejected as inadmissible or be dismissed.
- VI. Claim 1 according to the main request (patent as granted) reads:

"A sawing machine, of vertical type, with: a first clamping or retaining means (50) to accurately move upward a sheet (57) to be sawn against a supporting bed

bearing ;

**CHARACTERISED BY**

a) a second clamping or retaining means (53) to sideways displace a part cut from the sheet, consisting of a strip, present in the machine, bearing against the supporting bed,

b) which second clamping or retaining means (53) is designed to clamp said strip, and

c) the guidance of the second clamping or retaining means (53) is located merely at low level of the machine, preferably merely below a supporting part (51) onto which the located sheet bears with its lower edge into the machine,

d) the machine is designed to be operated such that the strip clamp engages one side edge of the strip and pushes it sideways through the machine, to take the opposite side edge beyond the sheet part within the machine"

Independent claim 7 reads:

"Method of operating a sawing machine, of vertical type, said machine comprising: a first clamping or retaining means (50) to accurately move in an upward direction a sheet (57) to be sawn against an upright supporting bed bearing ; and a second clamping or retaining means (53) to displace sideways a part, consisting of a strip, cut from the lower side of the sheet, which part is present in the machine, bearing against the supporting bed, said clamping or retaining means (53) are designed to clamp said strip; wherein said machine is operated such that a strip is cut from the lower side of the sheet and the second clamping or retaining means (53) engages one side edge of the strip, cut from the sheet, at low level, preferably at a lower corner, and pushes it sideways through the machine, while the strip bears with its

lower side onto a supporting part (51) of the machine, such that the second clamping or retaining means (53) takes the opposite side edge of the strip beyond the sheet part within the machine, during which the sheet and strip remain bearing against the supporting bed."

Auxiliary request 1:

The preamble of claim 1 of auxiliary request 1 reads: "A sawing machine, of vertical type, with: a first clamping or retaining means (50) to accurately move upward an against a supporting bed bearing sheet (57) to be sawn;"

Claim 7 of auxiliary request 1 has been modified in a corresponding manner.

Auxiliary request 2:

The preamble of claim 1 of auxiliary request 2 reads as follows:

"A sawing machine, of vertical type, with: a first clamping or retaining means (50) to accurately move upward a sheet (57) to be sawn bearing against a supporting bed;"

Claim 7 of auxiliary request 2 has been modified in a corresponding manner.

Auxiliary requests 3-5

The preamble of claim 1 and the corresponding part of claim 7 according to these requests is the same as for auxiliary request 2.

VII. The appellant argued essentially the following:

i) Admissibility of the appeal

The appeal was admissible because it was clearly stated what was requested, i.e. rejection of the opposition, see page 1 under "Requests" of the statement setting out the grounds of appeal. Moreover an auxiliary request had been filed and the reasons why the decision under appeal was incorrect had been set out on p.2 under "22" for the main request and page 3 for the auxiliary request.

ii) Main request

The phrase "to accurately move upward a sheet (57) to be sawn against a supporting bed bearing" in the preamble of claim 1 was ambiguous. It was grammatically not clear whether the sheet to be sawn was moved upwards against a supporting bed bearing or whether it was sawn against the supporting bed. The wording "supporting bed bearing" did not make sense technically. The reader would therefore refer to the rest of the patent specification, in particular paragraphs [0003] and [0017], in order to resolve the ambiguity. Paragraph [0006] then linked the cited prior art mentioned in paragraph [0003] to the claimed machine. The reader would therefore arrive at the conclusion that a sheet bearing against a supporting bed was meant. This was unambiguously disclosed in claim 1 of the application as originally filed. In order to support this argument, an affidavit by a British patent attorney regarding the interpretation of "supporting bed bearing" was referred to. The above arguments also applied to independent claim 7. The requirements of Article 123(2) EPC were therefore met.

iii) Auxiliary request 1

This request was filed as a correction to the decision to grant the patent in accordance with Rule 140 EPC. In the "Druckexemplar" so many amendments had been made to the claims by the examining division that the result was confusing and discerning their intention was difficult. It was therefore reasonable to admit the request to correct the decision to grant.

iv) Auxiliary request 2

The subject-matter of amended claims 1 and 7 was clearly and unambiguously disclosed in the application as originally filed. This request could therefore be seen as a correction of the patent in accordance with Rule 139 EPC. Such a correction did not extend the scope of protection of the patent and so the requirements of Article 123(3) EPC were also met.

v) Auxiliary requests 3-5

The above arguments also applied to the auxiliary requests.

VIII. The respondent argued essentially the following

i) Admissibility of the appeal

The appeal was inadmissible because no formally correct set of claims had been filed. It was moreover not clear what the appellant's requests were.



ii) Main request

There was no basis in the originally filed application for a "supporting bed bearing". Moreover because the preamble of claim 1 was ambiguous it could not be regarded as being directly and unambiguously disclosed in the originally filed application. The same arguments also applied to independent claim 7.

iii) Auxiliary request 1

According to decision G 1/10 a request to correct the text of the granted patent under Rule 140 EPC was inadmissible. Furthermore the printed patent specification accurately reflected the text proposed for grant, thus there was no error to be corrected. Furthermore, the proposed text did not comply with the requirements of Article 123(3) EPC.

iv) Auxiliary request 2

The modification had extended the scope of protection because the feature of moving the sheet upwards against the supporting bed bearing was no longer included in the independent claims. Thus the requirements of Article 123(3) EPC were not met.

v) Auxiliary request 3-5

The same arguments as for auxiliary request 2 applied to these requests.

## **Reasons for the Decision**

### 1. Admissibility of the appeal

In the statement setting out the grounds of appeal, the appellant requested the rejection of the opposition (see page 1), i.e. maintenance of the patent as granted. On pages 2 and 3, reasons were given why the decision under appeal was incorrect - point 22 of the impugned decision being explicitly referred to. Thus it is clear what the appellant's requests were and for what reasons the decision under appeal should be set aside. Therefore the requirements of Rule 99(2) EPC are met and the appeal is admissible.

### 2. Main request - Article 123(2) EPC

In the preamble of claim 1, the phrase "to accurately move upward a sheet (57) to be sawn against a supporting bed bearing" (which is not to be found in the originally filed application) is ambiguous. Either the sheet was borne by, i.e. rested against, the supporting bed bearing or the sheet was moved up against the supporting bed bearing. Both of these interpretations make sense technically.

However, even if, as argued by the appellant by reference to the affidavit, the skilled person were to consult the description in order to construe the claims, the skilled person would not resolve the ambiguity because the description does not define the meaning of the feature "to accurately move upwards a sheet (57) to be sawn against a supporting bed bearing". Furthermore, the passages cited by the appellant either relate to the prior art (i.e.

paragraph [0003]) or do not give any teaching as to what the supporting bed or supporting bed bearing should look like (paragraph [0017]). The first phrase of paragraph [0017] reads "[t]he sawing machine of the invention preferably has one or more of the following elements". Thus it is unambiguous that this paragraph relates to preferred embodiments of the invention rather than the invention defined in the independent claims. Moreover this paragraph only mentions a "bed" once - and this in conjunction with first and second guiding means and a coupling part which "comprise a portal structure and function as control and/or guiding means, to move the sawing element along a preferably straight track across the supporting bed". These features are not mentioned in the independent claims of the patent. Thus this passage also cannot provide a basis for interpreting the independent claims.

Therefore the application as originally filed does not disclose that the sheet is moved upwards against a supporting bed bearing. Hence it must be concluded that the subject-matter of claim 1 was not directly and unambiguously derivable from the application as originally filed. The same applies with respect to independent claim 7. Thus the requirements of Article 123(2) EPC are not satisfied.

3. Auxiliary request 1

During the oral proceedings, the appellant argued that auxiliary request 1 should be allowed as a correction of the text of the patent on the basis of Rule 140 EPC. However, as established in decision G 1/10 (OJ EPO 2013, 194), Rule 140 EPC is not available to correct the text of a granted patent and a request for such a correction is inadmissible (see Point 1 of the Order

and Points 13 and 14 of the Reasons). It does however remain open to a patent proprietor to seek to amend the patent during opposition proceedings and such an amendment could remove a perceived error. The amendment must nevertheless satisfy the legal requirements for amendments, including those of Article 123 EPC (Point 13 of the Reasons).

In the case of auxiliary request 1 the wording "a sheet to be sawn against a supporting bed bearing" has been altered to "an against a supporting bed bearing sheet to be sawn". Hence, the independent claims of this request do no longer comprise the feature of moving upward a sheet to be sawn against a supporting bed bearing. Thus the claim has been changed in such a way so as to extend the scope of protection and consequently the requirements of Article 123(3) EPC are not fulfilled.

Therefore, auxiliary request 1 is not allowable.

4. Auxiliary request 2

The appellant submitted during the oral proceedings that the amendment to claims 1 and 7 represented a correction in accordance with Rule 139 EPC. However a correction under Rule 139 EPC is a special case involving an amendment under Article 123 EPC, (G 11/91, OJ EPO 1993, 125, point 1 of the Reasons). Hence the correction must satisfy *inter alia* the requirements of Article 123(3) EPC.

As explained above claim 1 as granted can be understood in the sense that it required the sheet to be moved upwards against the supporting bed bearing. This is no longer the case in claim 1 of auxiliary request 2

because the claim, according to which the clamping or retaining means are "to accurately move upward a sheet (57) to be sawn bearing against a supporting bed", now covers also machines that do not realise the movement upwards against the supporting bed bearing.

Thus the scope of claim 1 of auxiliary request 2 encompasses embodiments which were not covered by the claims as granted and consequently the requirements of Article 123(3) EPC are not met. The same applies to independent claim 7.

5. Auxiliary requests 3-5

The arguments relating to the auxiliary request 2 apply equally to these requests because the same amendments to the preamble of claim 1 and to claim 7 have been made. Thus these requests also do not comply with requirements of Article 123(3) EPC.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:



C. Moser

M. Alvazzi Delfrate

Decision electronically authenticated