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**Datasheet for the decision
of 15 October 2019**

Case Number: T 1502/16 - 3.3.05

Application Number: 09382044.7

Publication Number: 2236639

IPC: C22C38/44

Language of the proceedings: EN

Title of invention:

Hot work tool steel with outstanding toughness and thermal conductivity

Patent Proprietor:

Rovalma, S.A.
Valls Anglés, Isaac

Opponents:

Uddeholms AB
voestalpine BÖHLER Edelstahl GmbH & Co KG
Deutsche Edelstahlwerke
Specialty Steel GmbH & Co. KG
Dörrenberg Edelstahl GmbH
Kind & Co., Edelstahlwerk, GmbH & Co. KG

Headword:

Hot work steel/Rovalma

Relevant legal provisions:

EPC Art. 107, 108, 123(2), 123(3), 83, 54, 111(1)
RPBA Art. 13(1)

Keyword:

Transfer of opposition - (yes)
Admissibility of appeal - (yes)
Late-filed document - admitted (yes)
Late-filed request - admitted (yes)
Amendments - allowable (yes)
Sufficiency of disclosure - (yes)
Novelty - (yes)
Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:

T 0724/08, T 0862/11, T 2001/12

Catchword:



Beschwerdekammern
Boards of Appeal
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Case Number: T 1502/16 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 15 October 2019

Appellant: Rovalma, S.A.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 25 April 2016
revoking European patent No. 2236639 pursuant to
Article 101(3)(b) EPC.**

Composition of the Board:

Chairman E. Bendl
Members: G. Glod
S. Fernández de Córdoba

Summary of Facts and Submissions

- I. The present appeal of the patent proprietors (appellants) lies from the decision of the opposition division to revoke European patent EP B 2 236 639.
- II. With the statement of grounds of appeal the appellants filed 34 auxiliary requests.
- III. In the letter of 13 April 2017, respondent 1 (opponent 1) referred for the first time to the following document:

E49: JPH0426739 A
- IV. In its communication under Article 15(1) RPBA, the board was of the preliminary opinion that the appeal was admissible, that the transfer of opposition of opponent 3 was not clear, and that none of the requests then on file appeared allowable under Articles 123(2) and 83 EPC.
- V. By letter of 16 September 2019, respondent 3 (opponent 3) submitted further evidence in support of the transfer of the opposition.
- VI. By letter of 7 October 2019, respondent 2 (opponent 2) submitted evidence that it had changed its name.
- VII. On 15 October 2019, oral proceedings took place, in which the appellants filed a new main request.

Claim 1 of that request is as follows:

"1. A steel, in particular a hot work tool steel, having the following composition, all percentages being in weight percent:

$$\%C_{eq} = 0.26-0.55$$

$$\%C = 0.2-0.55$$

$$\%N = 0-0.6$$

$$\%B = 0-0.45$$

$$\%Cr < 1.5$$

$$\%Ni = 1.0-9$$

$$\%Si < 0.4$$

$$\%Mn = 0-3$$

$$\%Al = 0-2.5$$

$$\%Mo = 2-10$$

$$\%W = 0-15$$

$$\%Ti = 0-3$$

$$\%Ta = 0-3$$

$$\%Zr = 0-3$$

$$\%Hf = 0-3$$

$$\%V = 0-4$$

$$\%Nb = 0-3$$

$$\%Cu = 0-4$$

$$\%Co = 0-6$$

$$\%S = 0-1$$

$$\%Se = 0-1$$

$$\%Te = 0-1$$

$$\%Bi = 0-1$$

$$\%As = 0-1$$

$$\%Sb = 0-1$$

$$\%Ca = 0-1,$$

the rest consisting of iron and unavoidable impurities, wherein $\%C_{eq} = \%C + 0.86 * \%N + 1.2 * \%B$, characterized in that $3 < \%Mo + 1/2 \%W < 11$,

and that %Mo is 1.2 to 3 times higher than %W, and that %W is not absent, and %Ni + 9 %Mn + 5 %Si < 8."

Claims 2 to 12 relate to preferred embodiments and include all the features of claim 1.

VIII. The appellants' arguments relevant to the present decision can be summarised as follows:

E49 should not be admitted into the proceedings, since, in line with T 724/08, it was immaterial whether the appellant had only come across this Japanese patent specification or the corresponding Patent Abstract of Japan by chance later or whether these documents had genuinely been difficult to find.

The new main request should be admitted since it was a reaction to the board's communication under Article 15(1) RPBA and overcame all objections raised in it.

IX. The respondents' arguments relevant to the present decision can be summarised as follows:

The appeal was not admissible, since the addresses of the appellants were not indicated. Furthermore, the appellants did not deal with the objection under Article 100(c) and/or 100(a) EPC, so the requirements of Rule 99(2) EPC were not fulfilled.

The new main request should not be admitted into the proceedings since all objections were known since the issuance of the communication under Article 15(1) RPBA, and the appellants waited until the last possible moment to file a new request. Their "salami tactics" should not be accepted since the respondents were continuously confronted with new requests that they had

no real chance to prepare for. If the request were admitted, the case should be remitted to the opposition division to give the respondents a fair chance to prepare their case against inventive step in view of the high number of documents and the many auxiliary requests filed previously.

- X. The appellants (patent proprietors) requested that the decision under appeal be set aside and that the patent be maintained in amended form based on the new main request, submitted during oral proceedings before the board or, in the alternative, that the patent be maintained in amended form based on one of auxiliary requests 15, 16 or 1 submitted with the grounds of appeal or that the patent be maintained as granted.

Respondents 1 to 5 (opponents 1 to 5) requested that the appeal be dismissed. Respondents 2, 3 and 5 further requested that the new main request not be admitted into the proceedings and, if admitted, that the case be remitted to the department of first instance for further prosecution.

Reasons for the Decision

1. Party status

The board indicated at the beginning of the oral proceedings that it accepted the change of name of respondent 2 to "voestalpine Böhler Edelstahl GmbH & Co KG" in view of the evidence filed on 7 October 2019. Furthermore the board added that the evidence filed by respondent 3 on 16 September 2019 showed that the assets of "Deutsche Edelstahlwerke GmbH" transferred to "Deutsche Edelstahlwerke Speciality Steel GmbH & Co.

KG" related to the business that originally filed the opposition. The patent proprietor did not object to this position. Consequently, the change of name of respondent 2 and the transfer of opposition of respondent 3 from "Deutsche Edelstahlwerke GmbH" to "Deutsche Edelstahlwerke Speciality Steel GmbH & Co. KG" are accepted.

2. Admissibility of the appeal

2.1 During oral proceedings, no further comments relating to the admissibility of the appeal were brought forward. The position presented in the communication under Article 15(1) RPBA is therefore maintained.

2.2 It is standard case law that the provisions of Rule 99(1)(a) EPC are considered satisfied if the party can be identified (Case Law of the Boards of Appeal of the EPO, 9th edition, 2019, V.A.2.5.2 a)). This is clearly the case here, since the appellants are the same as the patent proprietors.

2.3 It is accepted case law that irrelevancy and lack of cogency of the arguments do not render an appeal inadmissible (Case Law of the Boards of Appeal of the EPO, 9th edition, 2019, V.A.2.6.6). In the case at hand, the appellants explained in the statement of grounds of appeal (points II.1 and II.2) why they considered the requirements of Articles 123(2) and 83 EPC to be met and thereby gave their opinion on how the characterising part of claim 1 should be understood. In addition, they submitted auxiliary requests. Furthermore, the decision is only based on Articles 100(b) and 100(c) EPC (points 2.2.5 and 4 of the decision), while novelty of the main request (Article

100(a) EPC) was discussed as a kind of "obiter dictum" (point 2.3.1.2).

2.4 Therefore, the appeal is admissible.

3. Admissibility of E49

Document E49 was referred to by respondent 1 in its letter of 13 April 2017, which was approximately two and a half months after the four months set for the reply to the appeal. Its admission is at the board's discretion in accordance with Article 13(1) RPBA.

With the statement of grounds of appeal, the appellants had submitted 34 auxiliary requests that were not all converging. Some of these requests were considerably restricted compared to the requests filed before the opposition division. The numerous documents referred to in the "obiter dictum" of the opposition division's decision, which were considered relevant for the question of novelty, were mostly not relevant any more for some of the filed auxiliary requests. Therefore, in the present case, it is fair to give the respondents a chance to react to these numerous requests and to admit a *prima facie* relevant document into the proceedings. Although no translation of E49 was provided, it was immediately apparent from the table in it that some of the examples were highly relevant to the question of novelty of requests filed with the statement of grounds of appeal. Furthermore, the appellants acknowledged that they had been able to retrieve a machine translation of the document and to understand its content.

The situation is thus clearly different from T 724/08, relied on by the appellants, since in that case the

documents were filed to object to the novelty of a request already present before the opposition division. The filing of the documents could not be considered a reaction to new aspects of the case (Reasons, point 3.4).

Since the board considers in the present case the filing of E49, albeit shortly after the four-month time limit for filing the reply to the appeal, an acceptable reaction to the numerous non-converging requests filed with the statement of grounds of appeal, E49 was admitted into the proceedings.

4. Admissibility of the new main request

This new main request was filed during oral proceedings at the latest possible time. Although the appellants were aware that E49 was novelty-destroying for a previously filed request, they only filed the request after the board had given its opinion on the request. Its admission is at the board's discretion in accordance with Article 13(1) RPBA.

The present request is very similar to auxiliary request 15 filed with the statement of grounds of appeal. It differs only in that the objections under Article 123(2) EPC and 83 EPC have been overcome by deleting claims 5 and 6 and by replacing "provided" by "and" in claim 1. Furthermore, claim 14 of the auxiliary request 15 has been deleted.

The request clearly overcomes all previously raised objections (see below), does not give rise to new ones and is not completely surprising since it is based on a previously filed request. Furthermore, the additional feature compared to auxiliary request 2 on which the

decision was based originates from a dependent claim, thereby restricting the amounts of certain components. Therefore, the amendment is not complex. The board and the respondents can be expected to deal with the request with respect to the issues under debate so far in the appeal proceedings.

Therefore, the board decided to admit the request into the proceedings.

5. Amendments

The respondents did not have any objection with regard to the requirements of Article 123 EPC to this request, and the board sees no reason to take a different stance since claim 1 is restricted with respect to claim 1 as granted and is based on claims 1, 8, 9, 14 and description page 9, lines 11 and 12, of the application as filed.

Dependent claims 2 to 12 correspond to original claims 2-4, 7, 10-13, 15-16 and 18.

Thus, the requirements of Article 123(2) and (3) EPC are fulfilled.

6. Sufficiency of disclosure

6.1 The claims objected to in the communication under Article 15(1) RPBA have been deleted. The board agrees with respondent 1's position that the opposition division's reasoning related rather to Article 56 EPC than to Article 83 EPC (see its reply of 12 January 2017, page 2, last paragraph).

6.2 Claim 1 concerns a steel defined by its composition, and the skilled person would have undoubtedly been able to prepare a steel having the required composition. It is established case law that an objection of insufficient disclosure under Article 83 EPC cannot be based on an argument that the application would not have enabled the skilled person to achieve a non-claimed technical effect (T 862/11, reasons 5.5 (A) (b) (ii); T 2001/12, Reasons 3.4). In the present case, the arguments of the opposition division relate to the optimum steel properties for a hot-work tool steel. These properties are the desired effect that the claimed steel should achieve. This effect is not part of the claim and is, in the present case, irrelevant for the question of sufficiency of disclosure.

6.3 The requirements of Article 83 EPC are met.

7. Novelty

As already indicated in the communication under Article 15(1) RPBA, only E49 was still considered relevant for auxiliary request 2 underlying the impugned decision. Claim 1 of the current request is more restricted than claim 1 of the then auxiliary request 2. Examples 3, 6 and 13 cited by respondent 1 in its letter of 13 April 2017 do not disclose an amount of carbon in the range of 0.20 to 0.55.

Therefore, the requirements of Article 54 EPC are met.

8. Remittal

It is settled case law that parties do not have a fundamental right to have their case examined at two levels of jurisdiction (Case Law of the Boards of

Appeal of the EPO, 9th edition, 2019, V.A.7.2.1). However, in the present case, the appellants filed the main request only at the latest possible time during the oral proceedings before the board. Since many non-converging requests had been submitted earlier and many documents are on file, the respondents could not necessarily have been expected to be able to deal with the question of inventive step not part of the impugned decision of the now main request during the oral proceedings. Under the present circumstances and taking into consideration that inventive step was not discussed in the impugned decision (see also Reasons 2.3.2), it is fair to provide the parties with the opportunity to present their case also before the opposition division.

Therefore, the board has decided to remit the case to the opposition division in accordance with Article 111(1) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated