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**Datasheet for the decision
of 11 January 2019**

Case Number: T 1354/17 - 3.2.08

Application Number: 03725564.3

Publication Number: 1509354

IPC: B23C5/22

Language of the proceedings: EN

Title of invention:

TANGENTIAL CUTTING INSERT AND MILLING CUTTER

Patent Proprietor:

Iscar Ltd.

Opponent:

Kennametal Inc.

Headword:

Relevant legal provisions:

EPC Art. 84, 101(3) (a)

Keyword:

Claims - support in the description - after amendment (yes)

Decisions cited:

Catchword:



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Case Number: T 1354/17 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 11 January 2019

Appellant: Kennametal Inc.
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Representative: Prinz & Partner mbB
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Respondent: Iscar Ltd.
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Representative: Vossius & Partner
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
26 January 2017 concerning maintenance of the
European Patent No. 1509354 in amended form.

Composition of the Board:

Chairwoman: P. Acton
Members: M. Foulger
P. Schmitz

Summary of Facts and Submissions

- I. With the decision posted on 26 January 2017, the opposition division decided that taking into account the amendments made by the proprietor of the European patent during the opposition proceedings according to the then valid fifth auxiliary request, the patent and the invention to which it related met the requirements of the EPC.

- II. The appellant (opponent) filed an appeal against this decision. The appeal was filed in due form and within the given time limits. They requested that the decision under appeal be set aside and that the patent specification be adapted to the amended claims held as allowable by the opposition division. Oral proceedings were requested as an auxiliary request.

- III. The respondent (patent proprietor) requested that the appeal be dismissed. As an auxiliary measure, they requested that the patent be maintained on the basis of the amended description pages filed on 6 December 2016 being replaced by pages 7, 8, 11 to 16 as filed on 27 October 2017.

- IV. With the communication dated 29 May 2018, the Board informed the parties of its preliminary opinion that the patent as found allowable by the opposition division did not meet the requirements of Article 84 EPC. The Board however considered that the then valid auxiliary request did meet the requirements of Article 84 EPC.

- V. In reply, the respondent made the auxiliary request filed with letter dated 9 July 2018 into the new main

request.

VI. Claim 1 as upheld by the opposition division and as underlying the present main request, reads as follows:

"A milling cutter (80) comprising:
at least one tangential cutting insert (10, 10', 10")
comprising:
two identical opposing end surfaces (12, 12', 12")
having 180° rotational symmetry about a first axis A1
passing therethrough,
a peripheral side surface (14) extending between the
two opposing end surfaces (12, 12', 12"), and
a peripheral edge (40) formed at the intersection of
each end surface (12, 12', 12") and the peripheral side
surface (14), at least two sections of each peripheral
edge constituting cutting edges (52),
the peripheral side surface (14) comprising:
two identical opposing major side surfaces (18, 18')
having 180 degrees rotational symmetry about a second
axis A2 passing therethrough, the second axis A2 being
perpendicular to the first axis A1;
two identical opposing minor side surfaces (16, 16')
having 180 degrees rotational symmetry about a third
axis A3 passing therethrough, the third axis A3 being
perpendicular to the first axis A1 and the second axis
A2;
a minor plane P1 defined by the first axis A1 and the
second axis A2;
a major plane P2 defined by the first axis A1 and the
third axis A3;
a median plane M being defined by the second axis A2
and the third axis A3;
each end surface (12, 12', 12") having four corners;
each end surface (12, 12', 12") being provided with at
least one projecting abutment member (28, 28', 28")A,

28"C) having a projecting abutment surface (30, 30', 30A, 30C),
said four corners are two lowered corners (26) and two raised corners (24), the lowered corners (26) being closer to the median plane M than the raised corners (24) and in that in a side view of either major side surface (18, 18'), the projecting abutment surface (30, 30', 30A, 30C) lies on a concave surface,
a cutter body (82) having at least one insert pocket (84) in which the at least one cutting insert (10, 10', 10") is retained, the at least one insert pocket (84) comprising adjacent side and rear walls (88, 90) generally transverse to a base (92), the rear wall (90) being generally convex; the side wall (88) being provided with an axial location surface (94) that abuts a given minor side surface (16, 16') of the at least one cutting insert (10, 10', 10") at a given axial abutment region (96); the rear wall (90) being provided with two tangential location surfaces (98, 100), located on either side of a central region (102) of the rear wall (90), a first of the two tangential location surfaces (98) abuts a first tangential abutment surface (104, 104', 30A) located on the at least one cutting insert (10, 10', 10"), a second of the two tangential location surfaces (100) abuts a second tangential abutment surface (106, 106', 30C) located on the at least one cutting insert (10, 10', 10")."

VII. The appellant argued essentially the following:

The requirements of Rule 81(3) EPC that the description be adapted to the amended claims were not fulfilled. In particular, the following passages, where the cutting insert as such was purported to be the invention, were objectionable:

- page 7, lines 6 to 9

- page 7, lines 23 and 24
- page 8, lines 1 to 4
- page 8, lines 14 and 15
- page 8, lines 26 and 27
- page 12, lines 9 and 10
- page 13, lines 27 and 28

Thus, the patent as found allowable by the opposition division was not in accordance with the EPC.

VIII. The respondent argued essentially as follows:

The correct legal basis for the adaptation of the description was Article 84 EPC. The description did not cast any doubt on the scope of the claims and thus the requirements of Article 84 EPC were met.

The statement of invention in the introductory part of the description had been adapted to the revised claims.

Moreover, the term "invention" in all of the instances referred to by the appellant had been cancelled.

Hence, the requirements of Article 84 EPC were met.

Reasons for the Decision

1. Procedural aspects

The appellant requested oral proceedings in the event that the patent specification not be adapted to the amended claims. The respondent requested oral proceedings as a precautionary measure. As both parties' main request could be granted, oral proceedings are not required and the appeal may be decided in written proceedings.

2. Main Request

2.1 According to Article 101(3) (a) EPC a patent can only be maintained in amended form if the patent and invention to which it relates meet the requirements of the EPC. Thus the amendments to the patent must also meet the requirements of Article 84 EPC. It follows from Article 84 EPC, second sentence that the claims must be supported by the description and thus there should be no contradiction between the claims and the description (see Case Law of the Boards of Appeal, 8th edition 2016, II.A.5.3).

2.2 The invention according to the patent as amended during the opposition proceedings relates to a milling cutter comprising at least one tangential cutting insert as well as a cutter body. Hence, a cutting insert on its own cannot be regarded as being strictly in accordance with the invention because the cutter body is not present.

2.3 It is correct that the cutting inserts shown in the drawings are for use with the invention. However this

is not "in accordance with the invention". As defined by the claims, the invention is the insert in combination with a cutter body. The passages cited by the appellant in the appeal could be read as meaning that the inserts alone were "in accordance with the invention". This construction would be in contradiction to the claims.

- 2.4 The appellant's objection has been overcome by cancelling the term "invention" in all instances referred to. Moreover, the statement of invention in the introductory part of the description has been adapted to the revised claims. There is therefore no contradiction between claims and description, the claims of this request are clear and supported by the description (Article 84 EPC).

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 with the order to grant a patent based on:

Description:

pages 7, 8, 11-16 filed on 27 October 2017 with letter of 27 October 2017 (labelled "Auxiliary Request"),

pages 1, 2, 4-6, 9, 10, 17 filed during oral proceedings on 6 December 2016,

page 3 filed during oral proceedings on 6 December 2016 at 12:05,

Claims 1-5 received on 17 November 2014 with letter of 17 November 2014 (labelled "Auxiliary Request 5"),

Figures 1-16 of the patent specification

The Registrar:

The Chairwoman:



C. Moser

P. Acton

Decision electronically authenticated