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**Datasheet for the decision  
of 23 September 2020**

**Case Number:** T 0516/18 - 3.2.01

**Application Number:** 05795484.4

**Publication Number:** 1806192

**IPC:** B23B27/14, B23B51/00, B23C5/16,  
C23C16/30

**Language of the proceedings:** EN

**Title of invention:**

EDGE REPLACEMENT TYPE CUTTING TIP AND METHOD OF MANUFACTURING  
THE SAME

**Patent Proprietor:**

Sumitomo Electric Hardmetal Corp.

**Opponent:**

Iscar Ltd.

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2)  
RPBA 2020 Art. 11

**Keyword:**

Amendments - extension beyond the content of the application  
as filed (no)

Interpretation of unclear claims in the light of the  
description in order to assess compliance with Article 123(2)  
EPC

No added subject-matter (combination of range ends)

Remittal to the department of first instance for further  
prosecution

**Decisions cited:**

T 0925/98

**Catchword:**



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

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Case Number: T 0516/18 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 23 September 2020**

**Appellant:** Sumitomo Electric Hardmetal Corp.  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 7 December 2017  
revoking European patent No. 1806192 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** V. Vinci  
A. Jimenez

## **Summary of Facts and Submissions**

- I. The appeal was filed by the appellant (patent proprietor) against the decision of the opposition division to revoke the patent in suit pursuant to Article 101(3)(b) EPC.
  
- II. The opposition division decided that the subject-matter of claims 1 and 11 according to the amended main request did not comply with the requirements of Article 123(2) EPC and that the auxiliary requests 1 to 5 did not comply with the requirements of Article 123(3) EPC.
  
- III. Oral proceedings were held before the Board on 23 September 2020, at the end of which the decision was announced.
  
- IV. The appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division for examination of the remaining grounds of opposition with the set of claims according to the main request as filed on 8 September 2017 in the opposition proceedings or, in the alternative, according to the auxiliary request 1 filed with letter dated 23 July 2020, or any of auxiliary requests 2 to 8, filed as auxiliary requests 1 to 7 with letter dated 22 September 2019.

In the event that any of these auxiliary requests be found inadmissible, the appellant further requested that the case be remitted to the department of the first instance on the basis of any of the auxiliary requests 1 to 7 filed with the grounds of appeal or, if said auxiliary requests were also found inadmissible, of any of the auxiliary requests filed in the

opposition proceedings.

The respondent (opponent) requested that the appeal be dismissed.

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

**(A)** A coated cutting insert (1), comprising a substrate (8); a base layer (12) formed on the substrate (8); and an indicating layer (13) formed on a portion of the base layer (12),

**(B)** wherein in said substrate (8), at least one surface serves as a rake face (2), at least one other surface serves as a flank face (3), and a ridge where the rake face (2) and the flank face (3) cross serves as a cutting edge (4),

**(C)** said base layer (12) has a color which is different from that of said indicating layer (13),

**(D)** said indicating layer (13) is formed on said flank face (3), and on said base layer (12) the indicating layer being formed over an entirety or a portion of a region (A2), **characterized in that**

**(E1)** the indicating layer is not formed on region (A1) extending from said cutting edge (4) in a vertical direction with a distance of not less than 0.5 mm and less than 2.5 mm, wherein the thickness of the coated cutting insert is 2 mm to 8 mm, and

**(E2)** said region (A2) is a region excluding said region (A1) from said flank face (3).

Claim 11 of the main request reads as follows:

**(a)** A method of manufacturing a coated cutting insert (1) having a substrate (8), a base layer (12) which is formed on the substrate (8), and an indicating layer (13) which is formed on a portion of the base layer (12),

**(b)** wherein in said substrate (8), at least one surface serves as a rake face (2), at least one other surface serves as a flank face (3), and a ridge where the rake face (2) and the flank face (3) cross serves as a cutting edge (4), comprising the steps of:

**(c)** forming the base layer (12) on said substrate (8); forming the indicating layer (13) of which the color is different from that of said base layer (12) on said base layer (12); characterized by the step of:

**(d)** removing said indicating layer (13) from the rake face (2), the cutting edge (4),

**(e1)** a region (A1) adjacent to the cutting edge (4) and extending from the cutting edge (4) in a vertical direction with a distance of not less than 0.5 mm and less than 2.5 mm, wherein the thickness of the coated cutting insert is 2 mm to 8 mm, and

**(e2)** optionally from a portion of region (A2), which is a region excluding said region (A1) from the flank face (3) to form said indicating layer (13) over an entirety or a portion of the region (A2).

VI. The appellant's arguments can be summarised as follows:

The appellant contests the conclusion of the opposition division that the ordinary meaning that the person

skilled in the art would give to the expression "*said region (A2) is a region excluding said region (A1) from the flank face (3)*" (see features (E2) of claim 1) is that the region (A1) is not on the flank face. In the appellant's view the opposition division, when interpreting the claim, has not duly considered the whole content of the claim as well as the correspondent part of the description and drawings as it should have according to established Case Law of the Boards of Appeal. The appellant puts forward that the wording of feature (E2) that "*said region (A2) is a region excluding said region (A1)*" is unusual and obscure in itself. In fact it cannot be figured out how a region could perform the process of "*excluding*" another region from something or somewhere. The appellant further points out that the wording of the preceding feature E1 "*on region (A1) extending from said cutting edge in a vertical direction*" indicates that the region A1 extends on the flank. This is completely inconsistent with the interpretation given by the opposition division and by the respondent of feature (E2). Under these circumstances, the person skilled in the art would either disregard the obscure contribution of the feature (E2) to the subject-matter of claim 1 and conclude that the region A1 is on the flank face on the basis of feature (E1), or would refer to the original description, which can be considered to represent a sort of "*vocabulary*" for the claims, in order to clarify the obscure and apparently contradictory teaching of feature (E2). When looking at the description the person skilled in the art would refer to paragraphs [0072] and [0074], read in combination with Figures 2 and 5 of the published application, from which it can be directly and unambiguously derived that, according to the teaching of the invention, the region (A1) is on the flank face. As this teaching is

directly and unambiguously derivable from the description, the appellant asserts that the opposition division was wrong in concluding that the limitation implied by feature (E2) was not originally disclosed and that claim 1 does not comply with the requirements of Article 123(2) EPC. The same arguments and conclusions analogously apply to the feature (e2) of claim 11.

Regarding the further objections raised under Article 123(2) EPC by the respondent and directed to the range defined by features (E1) and (e1) of claims 1 and 11 respectively, and to the step of *"removing said indicating layer from the rake face"* according to feature (d) of claim 11, the appellant indicates that unambiguous support for these features can be found in paragraphs [0073] and [0089] respectively of the published original application.

VII. The arguments of the respondent can be summarised as follows:

The opponent does not see any obscurity in the wording of the feature (E2) in itself, which can only be read as meaning that the region (A1) is excluded from the flank face or, in other words, that the region (A1) is not on the flank face, but rather on the rake face. The wording of the feature (E1) offers a fully open definition of *"vertical direction"* which may be both along the flank face or the rake face, the second interpretation being compatible with the alleged meaning of the feature (E2) that the region (A1) is not on the flank face but rather on the rake face. As the feature (E2) is clear both in itself and when read in the context of the claim, it is not in contradiction with the preceding features and is also technically



plausible, the construction of claim 1 and the subject-matter defined therein are clear and in accordance with the interpretation given by the opposition division in the contested decision. Under these circumstances and in line with established Case Law of the Boards of Appeal, the person skilled in the art has no valid reason for ignoring the clear linguistic meaning of the wording of the claim and interpreting it differently in the light of the description and the drawings. Furthermore it is a matter of fact that the wording of the feature (E2) cannot be found in the originally filed application. The same arguments apply to the corresponding feature (e2) of claim 11.

Regarding the range specified in features (E1) and (e1) of claims 1 and 11 respectively, the opponent argues that it results from a selection of "preferable" and more "preferable values" derived from 2 different lists, and that such a selection is not disclosed in the originally filed application.

Finally, the respondent considers feature (d) of claim 11 to be the result of an unallowable intermediate generalisation because the passage of the description disclosing this feature contains further features which have been omitted from the claim.

## **Reasons for the Decision**

### **Article 100(c) in combination with Article 123(2) EPC**

Claim 1 and 11 of the main request

1. In order to assess compliance with Article 123(2) EPC of an amendment to a European patent application or to a European patent, it must be determined whether the skilled person, using common general knowledge, would directly and unambiguously derive this amendment from the originally filed application (so called "*gold standard*"). In the case at stake it is thus firstly necessary to determine the effective subject-matter resulting from the amendments introduced in the original claims 1 and 11 in order to be able to compare the claimed subject-matter with the disclosure provided by the application as filed.
- 1.1 According to Article 84 EPC the claims define the subject-matter for which protection is sought. For the purpose of determining the protection afforded, the claim must be read and constructed by a person skilled in the art with a mind willing to understand, thereby giving the words the meaning and the scope that they have in the technical field relevant for the invention also in view of the technical content of the claim. However, according to established Case Law of the Boards of Appeal, using the description and the drawings to interpret the claims is considered admissible and even necessary if the person skilled in the art, in an attempt to construct the claim with a mind willing to understand, is confronted with obscure and/or inconsistent features.
- 1.2 In the appealed decision the opposition division shared the view of the respondent that independent claim 1 as a whole and in particular its feature (E2) did not contain any obscure subject-matter, so that the claim can be constructed and understood by the person skilled in the art simply by giving the words their ordinary meaning without requiring an interpretation in view of

the drawings and the description. This led the opposition division to interpret the features (E2) of claim 1 and the corresponding feature (e2) of independent method claim 11 as meaning that the area A1 is not located on the flank face of the cutting insert. As this teaching was not considered to be explicitly disclosed in, or unambiguously derivable from, the originally filed application, the opposition division concluded that the main request was not allowable because it was not compliant with the requirements of Article 123(2) EPC.

- 1.3 The Board follows the arguments of the appellant and cannot agree with the conclusion of the opposition division for the following reasons:

It is undisputed that features (A) to (D) of claim 1 do not give rise to any unclear subject-matter. In the Board's view the fact that the wording of feature (D) leaves open whether the the indicating layer is formed only on the flank face or not, does not result in any lack of clarity, but rather in a broad formulation. Having regard to feature (E1), the Board observes that the expression "*..region (A1) extending from said cutting edge in a vertical direction..*" is unclear because the claim fails to define a horizontal direction to be taken as reference. The definition of the horizontal is in fact required in order to unambiguously identify the vertical direction and thus the direction along which the region (A1) extends. The respondent interprets the expression above as meaning that the region (A1) extends in a direction perpendicular to the cutting edge, thereby admittedly leaving open whether the surface (A1) is located on the flank face or on the rake face. In an attempt to clarify this ambiguity, the person skilled in the art

would look at the further feature (E2) which however, in the Board's view, contains an obscure and unclear wording.

1.4 The Board notes that whilst on the one hand the expression "*excluding from*" as such is linguistically consistent and clear in itself, on the other hand the appellant is correct in objecting that it cannot be figured out how a region could perform the "*action*" of excluding another region from something or somewhere. The view of the respondent that feature (E2) implies that the region A1 is not on the flank face is not convincing because it is based on a subjective interpretation of the unusual and obscure formulation of this feature of claim 1.

1.5 It follows that the Board shares the view of the appellant that the limitations implied by the wording of features (E1) and (E2) of claim 1 read in combination are unclear to such an extent as to prevent the skilled person from determining the effective subject-matter for which protection is sought. Under these circumstances, the Board considers it to be fully justified that the person skilled in the art turns to the description and the drawings in a meaningful attempt to unambiguously determine the effective subject-matter defined in the claim. With this purpose in mind, the person skilled in the art would realize that the embodiments described in paragraphs [0072] and [0074] in combination with Figures 2 and 5 of the published application are the only indicating a range for the extent of the regions (A1) in the sense of feature (E1) and , for this reason, are the ones better reflecting subject-matter intended to be covered by claim 1 as amended during the opposition procedure. In this respect, the Board agrees with the argument of the

appellant, which has not been contested by the respondent, that the other embodiments present in the original disclosure clearly do not fall within the scope of claim 1 (see for example embodiment in figure 6) and that, for this reason, they would be disregarded by the person skilled in the art attempting to interpret claim 1 in the light of the description and the drawings.

- 1.6 From these embodiments the person skilled in the art would directly and unambiguously derive that the correct interpretation of feature (E2) of claim 1, read in combination with feature E1, is that:

the region (A1) defined by feature (E1) is on the flank face.

- 1.7 Therefore, in view of the necessary interpretation of the wording of claim 1 in the light of the description and the drawings, it can be concluded that the feature (E2) of claim 1 as amended does not result in any new information with respect to the originally filed application. The same arguments and conclusions apply to the subject-matter of claim 11 and in particular to feature (e2) which corresponds to feature (E2) of claim 1.

Further objections under Article 123(2) EPC

- 1.8 The objection of the respondent that the range for the extension of the region (A1) suggested in independent claims 1 and 11 (see features (E1) and (e1) respectively) has no support in the originally filed application cannot be followed either:

As convincingly pointed out by the appellant, paragraph

[0073] of the published application, lines 27 to 32, discloses two alternative values for each one of the upper and lower limits of the range at stake. Contrary to the respondent's opinion, no arbitrary combination of separate ranges is defined in claims 1 and 11, but rather a lower limit and an upper limit have been selected among 2 disclosed alternative values. In this respect the Board considers that the person skilled in the art is directly and unambiguously provided with the information that any one of the upper and lower limits proposed can be combined in order to select a suitable range, irrespective of the fact that they are presented as "*preferable*" or "*more preferable*" values. Furthermore, the preferred and more preferable lower limit and the preferred and more preferable upper limit are disclosed in paragraph [0073] in combination with the same range suggested for the thickness of the cutting insert, namely 2mm to 8mm, as defined in claims 1 and 11. For completeness the Board notes that, in line with established Case Law of the Boards of Appeal (see for example T0925/98, point 2.), when a disclosure of a general and a preferred, narrower range is provided in the originally filed application, a combination of the narrower range with one of the partial ranges lying within the disclosed general range and located on either side of the narrower range shall be considered directly and unambiguously derivable from the originally disclosed ranges. This is exactly the case of the range defined in claims 1 and 11.

- 1.9 The respondent further argues that there is no support in the originally filed application for the feature (d) in claim 11 (this feature has been erroneously labelled (e3) in the contested decision and (e2) in the respondent's reply). However, the Board concurs with the view of the appellant that the step defined therein

of *"removing said indicating layer from the rake face"* is directly and unambiguously derivable from paragraph [0089] of the published application and that, contrary to the view of the respondent, no essential features disclosed in this paragraph have been omitted in claim 11. The alleged unallowable intermediate generalisation thus does not take place.

- 1.10 In conclusion and for the reasons given above, the Board cannot follow the decision of the opposition division that the subject-matter of claims 1 and 11 of the main request does not meet the requirements of Article 123(2) EPC.

The appealed decision is thus incorrect in this respect and must be set aside.

**Remittal of the Case to the first-instance department**

2. Lack of support in the originally filed application under Article 100(c) EPC was the only ground of opposition discussed at the oral proceedings before the opposition division and it was the only ground of opposition upon which a decision in respect of the main request was taken. In the event that the decision be set aside by the Board, the appellant has requested the remittal of the case to the opposition division for consideration of the further grounds of opposition that had been raised by the opponent in the notice of opposition (Article 100(b) in combination with Article 83 EPC and Article 100(a) in combination with Articles 54 and 56 EPC).

- 2.1 Although the EPC does not guarantee the parties an absolute right to have all the issues in a case considered by two instances, it is well recognised that

any party may be given the opportunity of two readings of the important elements of a case. The Board observes that the essential function of an appeal is to consider whether the decision issued by the first-instance department is correct. Hence, a case is normally to be referred back if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance (Article 111(1) EPC) as is the case in the decision under appeal.

2.2 In addition, at the oral proceedings, the respondent raised no objection to a remittal of the case to the department of the first instance should the main request be found to comply with the requirements of Article 123(2) EPC and the appealed decision set aside.

2.3 In the Board's view the circumstances above represent "*special reasons*", in the meaning of Article 11 RPBA 2020, justifying a remittal of the case to the department of first instance 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 department of first instance for further prosecution.



The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated