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**Datasheet for the decision  
of 20 October 2020**

**Case Number:** T 0540/18 - 3.2.01

**Application Number:** 12197927.2

**Publication Number:** 2745963

**IPC:** B23B29/04, B23B27/10, B23B27/08

**Language of the proceedings:** EN

**Title of invention:**  
Coupling for a cooling system in a cutting tool

**Patent Proprietor:**  
Seco Tools AB

**Opponent:**  
Iscar Ltd.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 123(2), 54, 56  
RPBA Art. 12(4)

**Keyword:**

Amendments - added subject-matter (no) - intermediate  
generalisation (no)

Novelty patent as maintained by the examining division - (yes)

Inventive step patent as maintained by the opposition division  
- (yes)

Late filed requests - could have been filed in the first  
instance proceedings (yes)

Late filed facts - could have been submitted in first instance  
proceedings (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0540/18 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 20 October 2020**

**Appellant:** Seco Tools AB  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
12 December 2017 concerning maintenance of the  
European Patent No. 2745963 in amended form.

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** V. Vinci  
O. Loizou

## **Summary of Facts and Submissions**

- I. The appeals were filed by the patent proprietor and by the opponent respectively against the interlocutory decision of the opposition division to maintain the European patent EP 2 745 963 in suit in amended form pursuant to Article 101(3) (a) EPC.
- II. The opposition division found that claimed subject-matter according to the patent as granted and as amended according to the auxiliary requests I to IV was not novel in the meaning of Article 52 (1) and 54 EPC, but that the auxiliary request V met all the requirements of the EPC. In order to come to these conclusions the opposition division considered, among others, the following documents:
- D1 : WO 2007/085281 A1  
D3 : US 7 431 543 B2  
D4 : US 2010/0254777 A1  
D7 : JP 8-39387  
D9 : US 4 705 435 A  
D10 : DE 102 51 922 D1  
D12 : US 7 004 692 B2
- III. Oral proceedings were held before the Board on 20. October 2020.
- IV. The appellant 2 (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted (main request), or auxiliary that the patent be maintained in amended form on the basis of one of the auxiliary requests 1 to 4 as filed with the statement of grounds of appeal.

The appellant 1 (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

V. Independent Claim 1 of the patent as granted according to the main request reads as follows:

A coupling (23) for a cooling system in a cutting tool (21), comprising a fastener (39) comprising a shank (43) having a first end (45) and a second end (47), the first end (45) of the shank (43) defining the first end (49) of the fastener (39), a head (51) at the second end of the shank (43), a top (53) of the head (51) defining a second end (55) of the fastener (39), characterized in that the head (51) is frustoconical with a narrowest end closest to the shank and the fastener (39) comprises a longitudinal passage (57) in the shank (43), and a radial opening (69) in the head (51) in flow communication with the longitudinal passage (57).

Independent claim 1 of the auxiliary request 1 reads as follows:

A coupling (23) for a cooling system in a cutting tool (21), comprising a fastener (39) comprising a shank (43) having a first end (45) and a second end (47), the first end (45) of the shank (43) defining the first end (49) of the fastener (39), a head (51) at the second end of the shank (43), a top (53) of the head (51) defining a second end (55) of the fastener (39), wherein the head (51) is frustoconical with a narrowest end closest to the shank and the fastener (39) comprises a longitudinal passage (57) in the shank (43), and a radial opening (69) in the head (51) in flow communication with the longitudinal passage (57),

characterized in that the coupling (23) comprises a blade holder (29) having an opening (37, 37') therein, the opening (37, 37') having a diameter at least as large as a diameter of the shank (43) and at least a portion of the opening having a diameter smaller than a diameter of the head, wherein the fastener (39) is made of a softer material than the blade holder (29).

Independent claim 2 of the auxiliary request 1 reads as follows:

A coupling (23) for a cooling system in a cutting tool (21 ), comprising a fastener (39) comprising a shank (43) having a first end (45) and a second end (47), the first end (45) of the shank ( 43) defining the first end ( 49) of the fastener (39), a head (51) at the second end of the shank (43), a top (53) of the head (51) defining a second end (55) of the fastener (39), wherein the head ( 51) is frustoconical with a narrowest end closest to the shank and the fastener (39) comprises a longitudinal passage (57) in the shank ( 43), and a radial opening ( 69) in the head ( 51) in flow communication with the longitudinal passage (57), characterized in that the coupling (23) comprises a blade holder (29) having an opening (37,37') therein, the opening (37, 37') having a diameter at least as large as a diameter of the shank (43) and at least a portion of the opening having a diameter smaller than a diameter of the head (51), the blade holder (29) comprises a passage (35) for cooling and/or lubricating fluid, the passage (35) extends in the blade holder (29) from the opening (37) to a point (41) near a replaceable cutting insert attached to the blade holder (29).

Independent claim 3 of the auxiliary request 1

corresponds to independent claim 1 as maintained by the opposition division and reads as follows:

A coupling (23) for a cooling system in a cutting tool (21), comprising a fastener (39) comprising a shank (43) having a first end (45) and a second end (47), the first end (45) of the shank (43) defining the first end (49) of the fastener (39), a head (51) at the second end of the shank (43), a top (53) of the head (51) defining a second end (55) of the fastener (39), wherein the head (51) is frustoconical with a narrowest end closest to the shank and the fastener (39) comprises a longitudinal passage (57) in the shank (43), and a radial opening (69) in the head (51) in flow communication with the longitudinal passage (57), characterized in that the longitudinal passage (57) extends from the first end (45) of the shank (43) to a point (59) in the head (51), wherein the longitudinal passage (57) is non-circular at the first end (45) of the shank (43).

Independent claim 1 of the auxiliary request 2 reads as follows:

A parting tool (21) comprising a coupling (23) for a cooling system in the a cutting parting tool (21), comprising a fastener (39) comprising a shank (43) having a first end (45) and a second end (47), the first end (45) of the shank (43) defining the first end (49) of the fastener (39), a head (51) at the second end of the shank (43), a top (53) of the head (51) defining a second end (55) of the fastener (39), wherein the head (51) is frustoconical with a narrowest end closest to the shank and the fastener (39) comprises a longitudinal passage (57) in the shank (43), and a radial opening (69) in the head (51) in

flow communication with the longitudinal passage (57), characterized in that the coupling (23) comprises a blade holder (29), the blade holder (29) having an opening (37,37') therein, the opening (37,37') having a diameter at least as large as a diameter of the shank (43) and at least a portion of the opening having a diameter smaller than a diameter of the head (51), wherein the fastener (39) is made of a softer material than the blade holder (29).

Independent claim 2 of the auxiliary request 2 reads as follows:

A parting tool (21) comprising a coupling (23) for a cooling system in a cutting the parting tool (21), comprising a fastener (39) comprising a shank (43) having a first end (45) and a second end (47), the first end (45) of the shank (43) defining the first end (49) of the fastener (39), a head (51) at the second end of the shank (43), a top (53) of the head (51) defining a second end (55) of the fastener (39), wherein the head (51) is frustoconical with a narrowest end closest to the shank and the fastener (39) comprises a longitudinal passage (57) in the shank (43), and a radial opening (69) in the head (51) in flow communication with the longitudinal passage (57), characterized in that the coupling (23) comprises a blade holder (29), the blade holder (29) having an opening (37, 37') therein, the opening (37, 37') having a diameter at least as large as a diameter of the shank (43) and at least a portion of the opening having a diameter smaller than a diameter of the head (51), the blade holder (29) comprises a passage (35) for cooling and/or lubricating fluid, the passage (35) extends in the blade holder (29) from the opening (37) to a point (41) near a replaceable cutting insert attached to the



blade holder (29).

Independent claim 3 of the auxiliary request 2 corresponds to independent claim 1 as maintained by the opposition division.

Independent claim 1 of the auxiliary request 3 corresponds to claim 1 of the auxiliary request 2.

Independent claim 2 of the auxiliary request 3 corresponds to claim 1 as maintained by the opposition division.

Independent claim 1 of the auxiliary request 4 corresponds to claim 2 of the auxiliary request 2.

Independent claim 2 of the auxiliary request 4 corresponds to claim 1 as maintained by the opposition division.

## **Reasons for the Decision**

### **MAIN REQUEST**

#### **Article 123(2) EPC**

1. Appellant 1 contested the conclusion of the opposition division that the feature of independent claim 1 of the main request that:

*"the head (51) is frustoconical with a narrowest end closest to the shank"*

is directly and unambiguously derivable from the application as originally filed.

1.1 Appellant 1 put forward that the expression "*frustoconical*" must be read and interpreted in a strict mathematical sense, i.e. as meaning that the head has an exact frustoconical shape. However, an exact frustoconical shape is not supported by the originally filed application which refers in paragraph [0017], lines 51-54 and in claim 12 to the head (51) and opening (37,37') having matching "generally frustoconical shapes". The figures do not show a head having an exact frustoconical shape either. It follows that the omission of the term "generally" in claim 1 leads to information not disclosed in the originally filed application, namely to a fastener with an exact frustoconical head and thus to an infringement of Article 123(2) EPC. The appellant 1 further argued that this objection applies to all the independent claims of each of the requests at stake.

1.2 The Board does not agree for the following reasons:

The wording of claim 1 of the patent as granted defines a fastener with a frustoconical head provided with a radial opening therein.

The person skilled in the art, reading the claim as a whole, i.e. taking the technical information provided by both features mentioned above into account, would understand the expression "*frustoconical head (51)..... having a radial opening (69)*" as meaning a head manufactured from an originally solid, exact frustoconically shaped element wherein a radial opening has been formed or cut. Therefore, contrary to the appellant 1's view, the person skilled in the art would not interpret the wording of claim 1 to mean that the head has a mathematically exact solid frustoconical shape (that indeed would have no support in the

application as filed) because this interpretation would imply, unlike claim 1, that no radial opening is provided. The person skilled in the art would rather directly and unambiguously derive from paragraph [0017], lines 51-54 in combination with figures 3 and claim 12 of the published application a head of the fastener according to claim 1, namely a frustoconical head with a radial opening provided therein. No new information with respect to the original filed application has thus been introduced in claim 1.

1.3 Furthermore, the Board concurs with the opposition division that the originally disclosed expression "generally frustoconical" is broader than the present expression "frustoconical" of claim 1 and that the original expression must include the latter. Therefore, the omission of the word "generally" does not extend the subject-matter of claim 1 beyond the content of the application as originally filed because what is claimed after deletion of the word "generally" is still a frustoconical head provided with a radial opening falling, for the reasons given under point 1.2 above, under the meaning of the originally disclosed expression "*generally frustoconical shape*".

1.4 The appellant 1 further alleged an unallowable intermediate generalisation engendered by the omission in claim 1 of the patent as granted of the blade holder (29) and of the opening (37,37') thereof which, in the aforesaid paragraph of the description as filed, in original claim 12 and in figure 3 are presented in combination with the "*frustoconical head*" of the fastener.

1.5 These arguments are not convincing either:

It is true that in the originally filed application the head of the fastener as well as the blade holder provided with openings matching the frustoconical shape of the head are presented in combination. However, claim 1 as filed was directed to a coupling system comprising the fastener alone. The blade holder (29) provided with openings (37,37') is disclosed as an additional/optional feature claimed for the first time in dependent claim 11 as filed. The person skilled in the art would thus directly and unambiguously realize from the claims structure that the fastener and the blade holder (29) with its openings (37,37') are not disclosed as being compulsorily provided in combination. Furthermore, the Board concurs with the view of the patent proprietor (appellant 2) that the term "ordinarily" in the cited passage of paragraph [0017] of the published application renders the feature that the head and the openings have "*matching, generally frustoconical shapes*", optional. For these reasons the Board concurs with the conclusion of the opposition division that the omission in claim 1 of the features relating to the blade holder (29) and to the opening (37',37) does not result in an unallowable intermediate generalisation infringing Article 123(2) EPC.

- 1.6 The appellant 1 further objects that there is no basis in the originally filed application for the feature of claim 1 that the frustoconical head has its "*narrowest end closest to the shank*". The Board cannot agree:

The expression "*narrowest end closest to the shrank*" merely defines the orientation of the frustoconicity of the head with respect to the shank of the fastener. This feature is directly and unambiguously derivable from all the figures that consistently show such an

orientation. The argument of the appellant 1 that figures 3, 5 and 6 might be interpreted as disclosing that the narrowest part of the head is not located closest to the shank, but rather in the middle of the head at the level of the radial opening (69), cannot be followed for the following reasons:

Claim 1 specifies that the radial opening (69) is provided "in the head (51)". The radial opening is located thus within the head of the fastener and it is part thereof. The person skilled in the art would thus unambiguously understand that the head of the fastener in the meaning of claim 1 is the whole frustoconical element provided with a radial opening. In figure 5 this element is visually distinct from the shank (43) by the shading. The narrowest end of the head cannot thus be a region located in the middle of the head as argued by the appellant 1 because, if this were the case, the "end" would not be longer the end of the head but rather an intermediate part thereof.

- 1.7 In conclusion the Board does not see any reason for deviating from the conclusion of the opposition division that claim 1 of the patent as granted meets the requirements of Article 123(2) EPC. This conclusion analogously applies for the same reasons to claim 1 of the auxiliary request 1 and of the patent as maintained by the opposition division which all include the amendments objected by the appellant 1 under Article 123(2) EPC.

**Novelty: Articles 52(1) and 54 EPC**

2. The subject-matter of claim 1 as granted lacks novelty over D3 (Articles 52(1) and 54 EPC).

2.1 The appellant 2 argues that the person skilled in the art, when reading claim 1 in the light of the specification, would unambiguously realize that the claim is directed to a coupling which is not intended to mechanically couple a first entity to another entity, but rather to a coupling for conveying cooling liquid or lubricant within the cooling system of a cutting tool. This is not the case of the coupling according to D3 which is rather intended to achieve a mechanical coupling between the cutting insert and the tool holder. Therefore D3 is not prejudicial to the novelty of claim 1 as granted.

2.2 The Board does not agree for the following reasons:

For the purpose of determining the protection afforded, the claim must be read by a person skilled in the art broadly and be constructed in such a way to give the words the meaning and the scope that they have in the relevant prior art also in view of the technical context of the claim. Claim 1 is wordily directed to a "*coupling for a cooling system in a cutting tool*". As correctly stated by the opposition division, the wording used in the preamble of the claim does not restrict the scope of the protection in such a way to exclude that the fastener is suitable to achieve both mechanical and fluid connection. Furthermore, as the Board considers that the wording of the claim is clear in itself, a narrower interpretation in view of the description, as proposed by the appellant 2, is neither required nor justified.

2.3 Therefore the Board shares the view of the opposition division that D3 discloses a fastener (44) suitable to be used in a cooling system in a cutting tool (see for example D3, from column , line 33 to column 2, line 4)

thus in accordance with the preamble of claim 1. The Board further observes that the appellant 2 does not contest that the remaining structural features of the coupling defined in claim 1 are disclosed in D3 as it can be directly and unambiguously derived from figures 1 and 2a and corresponding description.

- 2.4 In view of the above, the Board does not thus see any reason for deviating from the conclusion of the opposition division in the appealed decision that the subject-matter of claim 1 of the main request lacks novelty in the meaning of Articles 52(1) and 54 EPC over D3.

The main request is thus not allowable.

#### **AUXILIARY REQUEST 1**

##### **Amendments**

3. Claim 1 of the auxiliary request 1 differs from claim 1 according to the main request in the additional features that:

*"the coupling (23) comprises a blade holder (29) having an opening (37, 37') therein, the opening (37, 37') having a diameter at least as large as a diameter of the shank (43) and at least a portion of the opening having a diameter smaller than a diameter of the head, wherein the fastener (39) is made of a softer material than the blade holder (29)."*

The amended claim 1 is based on a combination of claims 1, 11 and 14 as filed, so that the requirements of Article 123(2) EPC are met.

**Inventive step: Articles 52(1) and 56 EPC**

- 3.1 The appellant 2 considered that the introduction of these additional features in claim 1 resulted in a further distinguishing feature over D3, namely that the fastener *"is made of a softer material than the blade holder"*. The Board agrees in this respect with appellant 2, but, in view of the above findings on lack of novelty for the main request, concludes that this is the sole distinguishing feature over D3.
- 3.2 Although appellant 1 considered that this feature is known from D3, there is no need to discuss this in detail here, since the Board concurs with appellant 1's alternative argument that it would fall within the customary practice followed by a person skilled in the art to manufacture the fastener of a material softer than the material of the tool holder in order to reliably seal the gap between the head of fastener and the corresponding opening in the tool holder. In fact, it is well known that this choice will ensure that the fastener can slightly deform when tightened onto the tool holder, thereby improving sealing between the surfaces in contact and minimizing the risk of leakage. Moreover, as correctly pointed out by the appellant 1, there is no apparent reasons as to why the person skilled in the art should select an extremely hard material for the fastener taking into account that such a choice would render the manufacturing process thereof more complex and expensive.
- 3.3 It follows that the subject-matter of claim 1 of the auxiliary request 1 does not involve an inventive step in the meaning of Articles 52(1) and 56 EPC with respect to D3 in view of the general knowledge of the



person skilled in the art.

3.4 The auxiliary request 1 is thus not allowable.

**AUXILIARY REQUESTS 2 and 3**

4. Claim 1 of each one of these auxiliary requests corresponds to claim 1 of the auxiliary request 1 with the only amendment being that the claim is now directed to a parting tool comprising the coupling previously claimed.

In the communication dated 4 March 2020 issued in preparation for the oral proceedings, the Board expressed the opinion that the subject-matter of independent claim 1 of these auxiliary requests lacks inventive step (Articles 52(1) and 56 EPC) over D3 in view of common general knowledge for the same reasons presented with respect to claim 1 of the auxiliary request 1. In the absence of any arguments from the appellant 2 at the oral proceedings, the Board sees no reasons to deviate from that opinion, which is hereby confirmed. In fact, the Board concurs with the appellant 1 that the common general knowledge of the person skilled in the art cited in combination with D3 against claim 1 of the auxiliary request 1 analogously applies to the parting tool to which independent claim 1 of these request are directed. A parting tool is, indeed, generally known and the skilled person would obviously consider using the coupling of D3, modified as explained above, see points 4. to 4.2 of this decision, in a parting tool.

4.1 It follows that irrespectively of a decision on the admissibility of these requests, which has been contested for the first time by the appellant 1 with

the letter dated of 14 September 2020, the auxiliary requests 2 and 3 are not allowable due to lack of inventive step pursuant to Articles 52(1) and 56 EPC.

#### **AUXILIARY REQUEST 4**

##### **Admissibility**

5. This auxiliary request has been submitted for the first time with the statement of the grounds of appeal of the patent appellant 2. Its admissibility is contested by the appellant 1 on the ground that it could have been filed during the first instance procedure.
- 5.1 According to Article 12(4) RPBA in the version 2007, which still applies to the present appeal, the Board has a discretion to hold inadmissible requests which could have been presented in the first instance proceedings.
- 5.2 After having heard the parties on this issue, the Board decided to apply the discretion conferred by Article 12(4) RPBA 2007 to not admit the auxiliary request 4 for the following reasons:
- 5.3 The main purpose of the appeal procedure is to conduct a review of the decision given by the first instance, rather than put in place a continuation of the first instance proceedings.
- 5.4 In the course of the opposition procedure the appellant 2 was given the opportunity to submit 5 auxiliary requests I to V in order to provide several fallback positions in the event that the opposition division would not have maintained the patent as granted. When filing these auxiliary requests the appellant 2 chose

to further limit the coupling according to the patent as granted. No lines of defense of the patent directed to the parting tool were presented.

As correctly noted by the appellant 1, the introduction of an additional independent claim directed to a new entity, namely to the parting tool, does not result in a line of defense converging from the higher ranking requests or from the patent as allowed in amended form by the opposition division, but rather in a first-time attempt to obtain protection for a new entity in the appeal procedure.

The Board observes that the auxiliary request 4 cannot represent a suitable fallback position against the appellant 1's appeal because independent claim 2 thereof corresponds to the independent claim 1 allowed by the contested decision of the opposition division.

- 5.5 The appellant 2 argued that the auxiliary request 4 represents an appropriate reaction to the view of the opposition division expressed in the decision that the subject-matter of the independent claims of the first instance requests were not limited to a particular kind of cutting tool, but rather embraced any kind of cutting tool including for example the rotating tools of D1 and D10 cited by the appellant 1. This argument is not convincing for the following reasons:

The issue of the relevance of D1 and D10 for the coupling according to the contested patent has been discussed by the parties at the oral proceedings at least in the context of the auxiliary requests IV (see in particular points 62, 63 and 69). In view of this discussion and its outcome, the appellant 2 still had the opportunity to clearly distinguish the subject-

matter of the independent claim from the cited prior art relating to rotating cutting tools (see for example D1 and D10) by filing a request directed to a parting tool. However, the appellant 2 decided though to defend the patent by maintaining the original auxiliary request V directed to a coupling for a generic cutting tool. In view of the above circumstances, the Board is convinced that the auxiliary request 4 at stake could and should have been presented in the first instance proceedings.

- 5.6 For the reasons above the auxiliary request 4 is not admitted in the appeal proceedings.

**PATENT AS MAINTAINED**

6. The patent as maintained by the opposition division according to the auxiliary request V filed at the first instance oral proceedings meets the requirements of Article 123(2) EPC for the reasons given under point 1. to 1.6 above.

**Novelty: Articles 52(1) and 54 EPC**

7. With the statement of the grounds of appeal the appellant 1 submitted several novelty attacks against claim 1 of the patent as maintained by the opposition division based on documents D3, D4, D7, D9 and D12.

**Admissibility of the novelty attacks based on D4, D7, D9 and D12**

8. The appellant 2 contested the admissibility of the lines of novelty attack based on D4, D7, D9 and D12 for the reason that they could have been presented during the

first instance proceedings.

- 8.1 The appellant 1 replied that although these novelty attacks had been fully developed during the first instance proceedings it was only in respect of claim 1 of the patent as granted, they were not withdrawn in respect of auxiliary request V but were not explicitly repeated in view of the fact that at the oral proceedings the opposition division indicated that these documents were not novelty-destroying for claim 1 as granted.
- 8.2 According to Article 12(4) RPBA in the version 2007, the Board has a discretion to not admit facts which could have been presented in the first instance proceedings.
- 8.3 The Board notes that the auxiliary request V of the opposition procedure had been submitted by the patent proprietor 2 months before the opposition oral proceedings. Furthermore, from the decision under appeal (see point 72) and from the minutes (see points 18 to 18.2), it can clearly be concluded that the only novelty attack raised in respect of claim 1 of the auxiliary request V at the oral proceedings was based on document D3. The assertion of the appellant 1 that the novelty attacks based on D4, D7, D9 and in particular on D12 raised during the first instance proceedings against claim 1 as granted have never been withdrawn and thus implicitly maintained also in respect of the auxiliary request V is not supported by any passage of the decision and/or the minutes which have not been contested. Moreover, this assertion is not convincing for the following reasons:

Claim 1 of the the auxiliary request V has been limited

with respect to the claim 1 as granted by introducing the additional structural feature that the passage in the shank is non-circular at the end thereof. The arguments of the appellant 1 in support of the alleged lack of novelty of claim 1 as granted in view of D4, D7, D9 and D12 are thus not automatically extendable to claim 1 of the auxiliary request V because they obviously do not address the additional limitations introduced in claim 1 of the auxiliary request V. No passage of the minutes and/or the appealed decision contains either an indication that appellant 1 has reiterated the lines of attack based on D4, D7, D9 and D12 also with respect to claim 1 as maintained and no explanation as to why the additional features introduced in claim 1 as maintained are also disclosed in these documents. In view of the above, the Board cannot share the view of the appellant 1 that the novelty attacks at stake have been already presented during the first instance proceedings in respect of claim 1 of the patent as maintained. Furthermore, in view of the fact that the auxiliary request V has been filed 2 months before the opposition oral proceedings, the Board considers that these novelty attacks could have been presented at the first instance proceedings.

- 8.4 Under these circumstances the Board considers appropriate to exercise the discretion provided by Article 12(4) RPBA 2007 to not admit the lines of novelty attack based on D4, D7, D9 and D12.

Novelty in view of D3

9. The appellant 1 argued that the tension nut (50) and the tension rod (44) according to figures 1 and 2a of D3 form a fastener in the meaning of claim 1 and that the nut (50) is provided with an opening of polygonal

and hence non-circular shape (see column 2, lines 29-37) fulfilling the last feature of claim 1. Regarding the remaining constructional features defined in claim 1, they are clearly disclosed in D3, so that this state of the art is prejudicial to novelty of the auxiliary request V.

- 9.1 The Board cannot agree and concurs with the view of the opposition division that the subject-matter of claim 1 of the auxiliary request V is novel over D3:

Regardless of whether the person skilled in the art would consider the combination of the tension rod (44) with the tension nut (50) of D3 as corresponding to the fastener of claim 1 or not, the tension nut (50) is surely not part of the shank of the tension rod (44), but rather a fully separate component which can be screwed on the shank. It is noted that according to the wording of claim 1 the longitudinal passage is in the shank. Therefore, the subject-matter of claim 1 is novel over D3 at least because this document does not disclose that the end of the longitudinal passage in the shank is non-circular at the first end of the shank. In fact while the nut of D3 has indeed a non-circular opening, the end of the passage in the shank is circular.

- 9.2 The subject-matter of claim 1 as maintained by the opposition division is thus novel in the meaning of Articles 52(1) and 54 EPC.

**Inventive step: Articles 52(1) and 56 EPC**

Admissibility of the new lines of attack

10. With the statement of the grounds of appeal the appellant 1 presented several lines of inventive step attack based on D4 or D1 in combination with D3 or with common general knowledge, alternatively, based on D10 in combination with D3. At the oral proceedings a further line of attack based on D1 in combination with D12 was submitted. The appellant 2 contested the admissibility of these lines of attack against claim 1 of the auxiliary request V because they could have been presented in the course of the opposition proceedings.

10.1 The Board notes that according to the appealed decision (see points 76 and 77) and the minutes (see point 20.1 to 20.4) the only inventive step attacks developed in respect of claim 1 of the auxiliary request V were based on D10 in view of D12 or D3.

10.2 Also in this case the Board considers it appropriate to exercise the discretion provided by Article 12(4) RPBA 2007 to not admit the new lines of inventive step attack based on D4 or D1 in combination with common general knowledge or D3 and of D1 in combination with D12 because they could have been presented at the first instance procedure. The same reasons provided under points 9. to 9.4 above apply.

Inventive step in view of D10 in combination with D3

10.3 The appellant 1 argued the D10 would disclose in figure 5 a coupling from which the subject-matter of claim 1 only differs in that:



*"the longitudinal passage (in the shank) is non-circular at the first end of the shank".*

This distinguishing feature enables an easy tightening of the fastener from its bottom by means of a tightening tool to be inserted in the non-circular and matching passage of the shank.

- 10.4 The technical problem to be solved is thus to propose a solution for tightening the fastener of D10.
- 10.5 The Board concurs with the view of the opposition division that document D10 does not provide any hint as to how the fastener is rotated and tightened. Moreover, the Board shares the view of the opposition division that the representation in figure 6 does not preclude that the upper end surface (29) be provided with some kind of engagement surface for a tightening tool. In any case D10 does not provide the person skilled in the art with any indication which would lead him to provide a non-circular channel at the lower end of the fastener. As it has been discussed under points 9.5 and 9.6 above, not even the coupling according to D3 shows a non-circular passage in the shank. Therefore, document D10, even in combination with D3, would not lead to a coupling according to claim 1 of the patent as maintained by the opposition division which thus involves an inventive step over the prior art in the meaning of Articles 52(1) and 56 EPC.
11. In view of the above, the Board does not see any reason for deviating from the conclusions of the opposition division in the appealed decision which is thus confirmed.

**Order**

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

1. The appeals are dismissed.

The Registrar:

The Chairman:



D. Magliano

G. Pricolo

Decision electronically authenticated