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**Datasheet for the decision  
of 19 May 2023**

**Case Number:** T 0726/20 - 3.2.03

**Application Number:** 13702023.6

**Publication Number:** 2951357

**IPC:** E02F3/20, E02D17/13, E02F3/24,  
E02F5/08, E21B10/50, E02F3/92

**Language of the proceedings:** EN

**Title of invention:**  
HYDROMILL WHEEL WITH SINGLE DISC CUTTING ROLLERS

**Patent Proprietor:**  
VSL International AG

**Opponent:**  
Soletanche Freyssinet S.A.S.

**Relevant legal provisions:**  
EPC Art. 83, 123(2), 54, 111(1)  
RPBA 2020 Art. 12(4), 12(6)

**Keyword:**

Novelty - main request (no) - auxiliary request (yes)  
Amendment to case - amendment admitted (no)  
Late-filed request - admitted in first-instance proceedings  
(no) - circumstances of appeal case justify admittance (yes)  
Amendments - added subject-matter (no)  
Sufficiency of disclosure - (yes)  
Appeal decision - remittal to the department of first instance  
(yes)

**Decisions cited:**

T 2415/13



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Case Number: T 0726/20 - 3.2.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.03**  
**of 19 May 2023**

**Appellant:** VSL International AG  
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**Representative:** Cabinet Beau de Loménie  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 22 January 2020  
revoking European patent No. 2951357 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** C. Herberhold  
**Members:** B. Miller  
F. Bostedt

## **Summary of Facts and Submissions**

- I. European patent No. 2 951 357 ("the patent") relates to hydromills suitable for excavating trenches in hard rock.
- II. An opposition to the patent was filed on the grounds of Article 100(a), (b) and (c) EPC.

The opposition division decided to revoke the patent.

In the decision, the opposition division found the following.

- The grounds of opposition pursuant to Article 100(b) and (c) EPC did not prejudice maintenance of the patent as granted.
- The subject-matter of claim 1 lacked novelty (Article 100(a) in combination with Article 54 EPC).
- The subject-matter of claim 1 of the patent in amended form based on auxiliary requests 2 and 6, which were submitted during oral proceedings before the opposition division, lacked novelty.

Furthermore, the opposition division did not admit auxiliary requests 1 and 3 to 5, which were submitted during oral proceedings, since they were filed late and the amendments therein were considered not to be based on the dependent claims of the patent.

The patent proprietor ("the appellant") appealed against the decision.

III. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or alternatively that the patent be maintained in amended form on the basis of any of the sets of claims of auxiliary requests 1 to 8 as submitted with the letter setting out the grounds of appeal.

Auxiliary requests 2 and 5 to 7 correspond to auxiliary requests 1 and 3 to 5 in the opposition proceedings, which were not admitted by the opposition division (see II.4 and II.6 of the Reasons).

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

IV. Wording of the independent claims of the requests at issue in this decision

(a) Main request (claims as granted)

Claim 1

"A hydromill wheel (4) for excavating a trench in hard rock, the wheel (4) comprising:

- a drum (5) arranged to be rotated about its axis (A, B); and
- a plurality of single disc cutters (11) having disc projection spacing on the drum axis (A, B), mounted on the periphery of the drum (5), each of the single disc cutters (11) having a rotatable single cutting disc (11) arranged to come in contact with and crush or cut the rock during excavation,

wherein the spacing of the projections of at least some of the cutting discs (11) on the drum axis (A, B) is 5 % to 70 % of the cutting disc diameter."

Claim 14

"A hydromill comprising the hydromill wheel (4) according to any one of the preceding claims, and further comprising a frame (3) at one end of which the hydromill wheel (4) is mounted, and wherein the hydromill comprises four hydromill wheels (4) arranged in two pairs so that each of the hydromill wheels (4) of a first pair has a first rotational axis (A), whereas each of the hydromill wheels (4) of a second pair has a second rotational axis (B), the first and second rotational axes (A, B) being different."

Claim 15

"A method of excavating a trench in rock by use of a hydromill (1) having at least one drum (5) equipped with single disc cutters (11), the method comprising:

- rotating the drum (5) about its axis (A, B) by an engine;
- arranging a plurality of single disc cutters (11) mounted on the periphery of the drum (5) to come in contact with the rock, the single disc cutter (11) having a rotatable single cutting disc (11); and
- while lowering the drum (5) into the rock the single disc cutters (11) creating fractures in the rock for excavating the rock, the spacing of at least some consecutive fractures being 10 mm to 70 mm."

(b) Auxiliary request 1

Claim 1 is based on claim 1 of the main request, with the following feature added.

"wherein each single disc cutter (11) is arranged on a separate axis parallel to the rotation axis (A, B) of the drum (5), and"

Claim 14 corresponds to claim 14 of the main request. Claim 15 is based on claim 15 of the main request, with a reference to the hydromill according to claim 14 incorporated.

(c) Auxiliary request 2

Claim 1 is based on claim 1 of the main request, with the following feature added.

"characterized in that the disc cutters (11) are mounted on the drum periphery so that the distance from the vertical trench wall facing side of the wheel (4) is different for each disc cutter (11)."

Claim 14 corresponds to claim 14 of the main request. Claim 15 is based on claim 15 of the main request, with a reference to the hydromill according to claim 14 incorporated.

V. Prior art

The following document, which was already cited during the opposition proceedings, is of particular importance in the present decision.

D6: WO2010/050872

VI. With the summons to oral proceedings, the Board sent a communication pursuant to Article 15(1) RPBA 2020,

informing the parties of its preliminary opinion on the case. Inter alia, the Board pointed out that

- claim 1 as granted lacked novelty
- the amendment in auxiliary request 1 was prima facie not allowable according to Article 123(2) EPC
- claim 1 of auxiliary request 2 was novel.

VII. Furthermore, the parties were informed that the Board intended to remit the case to the opposition division if it proved necessary to discuss the grounds for opposition of Article 100(a) EPC in combination with Article 56 EPC.

VIII. With a letter dated 5 May 2023, the appellant submitted further comments regarding auxiliary requests 1 to 3.

IX. Oral proceedings were held on 19 May 2023.

X. The appellant's arguments, as far as they are relevant to this decision, can be summarised as follows.

(a) Article 100(a) and Article 54 EPC

In the context of hydromills the expression "single disc cutter" in claim 1 of the patent had to be understood as a cutting element having only one disc arranged on an axis for every angular position around the drum, so that the entire weight of the hydromill was condensed on a very small area of a single disc, i.e. the contact area of the single disc cutter in contact with the rock.

Although a few single disc cutters on different wheels could be in contact with the rock at a time, as stated in paragraph [0008] of the patent, it was nevertheless clear in the context of the patent that only one single



disc cutter per wheel should be in contact with the rock at any time. Consequently, it was inappropriate to use D6 to interpret claim 1 of the patent.

D6 did not disclose a "single disc cutter" as defined in claim 1 of the patent, since according to D6 a plurality of cutting discs was arranged on the same axis and hence there was always a plurality of cutting discs in contact with the rock at any time.

(b) Admittance of auxiliary request 1

The amendments in auxiliary request 1 were based on the overall teaching of the application as originally filed. The figures of the application confirmed that there was only one single cutting disc on each drum for every angular position. Moreover, the added feature was clear.

Therefore, the added feature did not give rise to new objections under Article 123(2) and Article 84 EPC.

The further arguments in relation to auxiliary request 1 as submitted in preparation for the oral proceedings before the Board were in response to the communication from the board, and should therefore be considered.

(c) Admittance of auxiliary request 2

Auxiliary request 2 was based on auxiliary request 1 as filed during the opposition proceedings. Although this request had not been admitted by the opposition division, it should be admitted into the appeal proceedings, since its re-filing constituted a direct response to the events during the opposition

proceedings. Moreover, and as also admitted by the respondent, the request overcame the novelty objection with regard to D6. Hence, special circumstances justified the admittance of auxiliary request 2 into the appeal proceedings.

(d) Article 123(2) EPC

The addition of the feature that the plurality of single disc cutters had "disc projection spacing on the drum axis" - present already in claim 1 as granted - was based on the disclosure on page 8, lines 11 to 13 of the application as originally filed. The fact that the disc cutters were mounted on the drum periphery so that the distance from the vertical trench wall facing side of the wheel was different for each disc cutter was disclosed in the sentence immediately before that, see lines 9 to 11 of page 8.

(e) Article 83 EPC

The objection relating to a lack of sufficient disclosure was a "disguised" clarity objection.

Dependent claim 3 specified that the rotational axis of at least some of the cutting discs was substantially parallel to the rotation axis (A, B) of the drum, while dependent claim 4 specified that the rotational axis of at least some of the cutting discs was not parallel to the rotation axis (A, B) of the drum.

Combining claims 3 and 4 did not result in a contradiction, since neither claim 3 nor claim 4 required all the single disc cutters to be oriented in a particular manner.

Determining a spacing of projections according to claim 1 did not require undue burden but could be achieved by routine measures. Since the wording of claim 1 ("projections of at least some of the cutting discs") did not specify that all projections had to be considered, the skilled person was not required to determine the distance of spacings of projections of discs of which the rotational axes were not parallel to the drum axis.

A skilled person with a mind willing to understand the patent had no difficulty in carrying out the invention according to claim 6.

XI. The respondent's arguments in response to each of the above points can be summarised as follows.

(a) Article 100(a) and Article 54 EPC

Claim 1 did not exclude the possibility that several single disc cutters were arranged next to each other on the hydromill wheel. Hence, the hydromill wheel according to claim 1 was not novel over the wheel disclosed in Figure 7 of D6.

(b) Admittance of auxiliary request 1

The application as filed did not disclose that the axis of each single disc cutter was parallel to the axis of the drum. On the contrary, Figure 5 and claim 4 as filed disclosed that at least one disc cutter was mounted on an axis which was not parallel to the axis of the drum. Therefore, the amendments in auxiliary request 1 were prima facie not allowable, since they contravened the requirements of Article 123(2) and Article 84 EPC.

(c) Admittance of auxiliary request 2

The subject-matter of auxiliary request 2 had not been searched, so this request should not be admitted into the appeal proceedings. Moreover, the appellant could already have filed the request at an earlier stage, during the opposition proceedings. The appellant should have been prepared for the possibility that, during the oral proceedings before the opposition division, the opposition division might in its final interpretation give the correct meaning to the expression "single disc cutter". Hence, the circumstances of the appeal case did not justify the admittance of auxiliary request 2.

(d) Article 123(2) EPC

The application as filed did not provide a literal basis for the amendment to claim 1 as granted, that the plurality of single disc cutters had a disc projection spacing on the drum axis. Nor was this feature directly and unambiguously derivable from the implicit disclosure of the application as filed.

(e) Article 83 EPC

The patent did not disclose a way to determine the disc projections and spacing in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

In particular, no information was available on how the spacing between two disc projections could be calculated if the rotational axis of some cutting discs was parallel to the drum axis but that of other discs was not.

This argument was supported by the fact that during examination proceedings it had been necessary to file an annotated version of Figure 5 of the application "for better illustration and understanding".

The skilled person could not carry out the invention according to claim 6, since a single disc cutter could not be arranged on opposing edges of a wheel drum, contrary to the definition in claim 6.

## Reasons for the Decision

1. Main request - Article 100(a) in combination with Article 54 EPC

1.1 D6 discloses a hydromill wheel for excavating a trench in hard rock, the wheel comprising a drum (4) arranged to be rotated about its axis (R) (see Figure 2), a plurality of single disc cutters (7) having disc projections spaced on the drum axis (see Figure 7). The discs are mounted at least partly on axes parallel to the drum axis (see page 6, lines 15 to 18 and 28 to 33). Hence, these discs are placed at right angles to the drum axis (R), and as such a projection drawn from some discs intersects the drum axis. Each of the single disc cutters has a rotatable single cutting disc arranged to come into contact with and crush or cut the rock during excavation (see page 6, lines 11 to 15).

The grooves that are cut into the rock are separated by 50 to 120 mm, and the disc diameters range from 200 to 500 mm (page 26, lines 12 to 21 of D6). As such, the ratio of groove spacing, which corresponds to disc spacing as defined in claim 1, to disc diameter also falls within the claimed range of 5% to 70%.

1.2 In the appellant's view, claim 1 is novel, since D6 discloses a hydromill wheel comprising only multiple disc cutters.

The appellant argues that in the context of hydromills according to claim 1 of the patent the expression "single disc cutter" has to be understood as referring to a single cutting element having only one disc

arranged on each axis parallel to the rotation axis of the drum. Thus, the entire weight of the hydromill is condensed on a very small area (the contact area of the single disc cutter in contact with the rock) of a single disc. Hence, the wording of claim 1 implies that there is only one single cutting disc on each drum for every angular position, and thus one single cutting disc "per row".

1.3 This argument is not convincing, since the interpretation espoused by the appellant is not in line with the actual wording of claim 1. Nor is it supported by the corresponding teaching of the description of the patent.

1.3.1 Claim 1 does not specify how the single disc cutters are arranged on the wheel periphery. In particular, claim 1 does not require only one single disc cutter to be present at any specific angular position on the drum, or in other words only one single disc cutter to be present "per row".

1.3.2 Even if the patent specification is considered when interpreting the wording of claim 1, it will not provide a teaching from which the skilled person would interpret the broad and general wording of claim 1 more narrowly. Rather, the patent specification does not provide a general statement that the expression "single disc cutters" necessarily implies that only one sole single disc cutter per wheel can be in contact with the rock at a time, either.

Indeed, paragraph [0008] of the patent explains that cutting discs can be distributed all around the circumference of the wheels and that "a few of the discs are in contact with the rock at any given time,

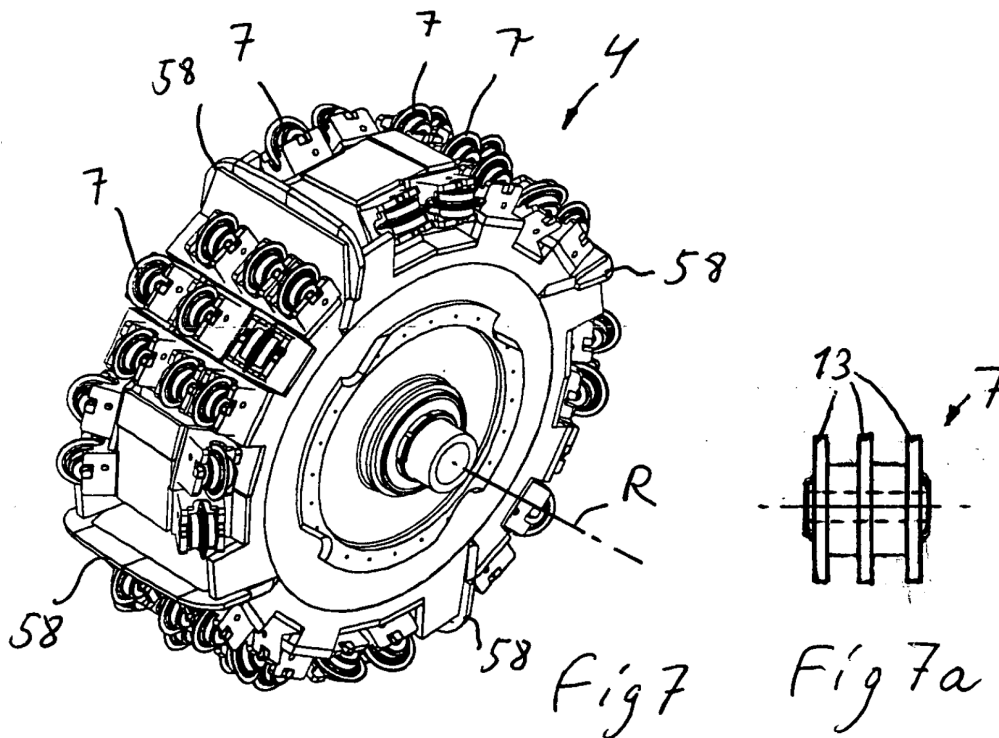
i.e., only those which happen to be at the bottom at that particular time". Although the wording of paragraph [0008] allows for an interpretation according to which "a few of the discs" that are present on various wheels "are in contact with the rock at any given time", it does not exclude the possibility that more than one single disc cutter per wheel is in contact with the rock at a time, nor does it specify in positive terms that only one single disc cutter per wheel (out of "a few of the discs") is in contact with the rock at any time.

Paragraph [0018] of the patent further discloses that "single disc cutters" differ from, for example, double or triple disc cutters in that the "single disc cutters" only have one cutting disc and not several. It therefore confirms that a "single disc cutter" is a cutting element with only one cutting disc. This general definition does not exclude the possibility that several single disc cutters could be arranged on the axis parallel to the rotation axis of the drum in the same angular position, or that several single disc cutters are arranged next to each other. There is no need to refer to the description of D6 to arrive at the above interpretation; it is based on the impugned patent alone.

- 1.3.3 D6 discloses, in Figures 7 and 7a, single disc cutters and multiple disc cutters (see also D6, page 19, lines 12-30).

Figure 7a discloses a cutter 7 with three discs 13, i.e. a multiple disc cutter. This cutter 7 can be used as an alternative to the cutter with only one disc (single disc cutter) that is used for the wheel depicted in Figure 7.





The meaning of a single disc cutter implied by the disclosure in paragraph [0018] of the patent thus corresponds to the teaching according to page 19, lines 12 to 30 of D6.

Hence, neither the patent nor the teaching in D6 supports the appellant's argument that, in Figure 7, D6 discloses a hydromill wheel with multiple disc cutters.

1.4 It follows that there is no reason to deviate from the finding in point II.3) of the contested decision that claim 1 of the patent lacks novelty over D6.

The board therefore concludes that the grounds for opposition according to Article 100(a) EPC in combination with Article 54 EPC prejudices maintenance of the patent as granted.

2. Admittance of auxiliary request 1

2.1 The appellant submitted auxiliary request 1 for the first time with its statement setting out the grounds of appeal.

As the decision under appeal was not based on this request, it constitutes an amendment within the meaning of Article 12(4), first sentence, RPBA 2020. Hence, admittance of this request falls under the discretion of the Board pursuant to Article 12(4), second sentence, RPBA 2020.

2.2 The amendments in claim 1 of auxiliary request 1 are prima facie not allowable under Article 123(2) EPC.

Claim 1 of auxiliary request 1 is based on claim 1 as granted, with the following feature added.

"each single disc cutter (11) is arranged on a separate axis parallel to the rotation axis (A, B) of the drum (5) "

No literal basis for this feature can be found in the application as filed (reference is made to the corresponding publication WO 2014/117814 A1, "the application").

2.3 Pointing to the teaching of the figures of the patent, the appellant argues that the amendment was "in accordance with the overall teaching of the patent in cause".

2.4 However, no specific passage which supports this amendment has been identified in the application.

Moreover, the overall teaching of the application, in particular the teaching provided by claim 4 and Figure 5 of the application, does not support the appellant's argument.

Figure 5 depicts a wheel according to the invention. In this wheel, not every single disc cutter is arranged on an axis parallel to the rotation axis of the drum. Rather, some single disc cutters are mounted on an axis that is inclined in relation to the drum axis.

Claim 4 and the corresponding description in the paragraph bridging pages 6 and 7 of the application also state that at least one single disc cutter is mounted on an axis which is not parallel to the axis of rotation of the drum.

Hence, the amendment made in claim 1 of auxiliary request 1 is prima facie not supported by the teaching of the application as originally filed.

2.5 In addition, in its submission of 5 May 2023, made shortly before the oral proceedings before the board, the appellant argues that the features added to claim 1 clarify its wording and imply that there is only one single cutting disc on each drum for every angular position.

Even if these further explanations are considered under Article 13(2) RPBA 2020, they are not convincing.

Claim 1 of auxiliary request 1 does not define the positioning of the single disc cutters in relation to angular positions. Rather, claim 1 of auxiliary request 1 refers to the orientation of the rotation axis of all single disc cutters in relation to the rotation axis of

the drum. Hence, the appellant's argument is not based on the actual wording of claim 1 of auxiliary request 1.

- 2.6 The amendment in claim 1 of auxiliary request 1 therefore prima facie fails to fulfil the requirements of Article 123(2) EPC.

Therefore, in exercise of its discretion under Article 12(4) RPBA, the Board does not admit auxiliary request 1.

3. Admittance of auxiliary request 2

- 3.1 Auxiliary request 2 corresponds to auxiliary request 1 underlying the contested decision. The opposition division did not admit the request because it had been filed late, during the oral proceedings, see point II. 4) of the decision.

Consequently, regarding the admittance of auxiliary request 2, Article 12(6), first sentence, RPBA 2020 applies, which reads as follows.

"The Board shall not admit requests, facts, objections or evidence which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance."

Therefore, according to Article 12(6), first sentence, RPBA 2020, there are two criteria which could justify the admittance of the request: an error in the use of discretion or the circumstances of the appeal case.

It is for the appellant to demonstrate that the opposition division erred in the exercise of its discretion.

3.2 Use of discretion by the opposition division

3.2.1 The opposition division justified its decision not to admit former auxiliary request 1 with the argument that this request was filed late (during the oral proceedings before the opposition division) and the amendments therein were not derivable from dependent claims. The opposition division based its reasoning on the Guidelines for Examination E-VI, 2.2 (presumably the 2019 edition), which state that late-filed requests based on subject-matter not previously covered by the claims will not normally be admitted.

3.2.2 This is in line with the case law (Case Law of the Boards of Appeal, 2022, 10th edition, Chapter IV.C. 5.1.4 Timeframe for filing amendments, see in particular T 2415/13), which confirms that claims can only be amended during the oral proceedings in a manner that the opponent could be expected to deal with during the oral proceedings. This has the purpose of enabling all parties and the opposition division to prepare the case adequately, and of ensuring procedural fairness and efficiency.

3.2.3 The amendments proposed in auxiliary request 2 (= auxiliary request 1 as filed in opposition) are not necessarily of a nature such that the opponent could have been expected to deal with them in an appropriate manner during the oral proceedings. The amendments do not consist in the incorporation of a definition of the expression "single disc cutter" taken from the description of the patent. The incorporation of such a

definition could have been considered foreseeable; but this was not done in the present case, simply because such a definition is not to be found in the patent. Rather, the amendments in auxiliary request 2 are an attempt to delimit the claimed subject-matter by including features which address the distribution of the single disc cutters over the periphery of the wheel drum. The amendments are thus based on the overall teaching of the description.

Hence, the appellant's attempt to demonstrate that the discretionary decision of the opposition division not to admit auxiliary request 1 (auxiliary request 2 of the appeal proceedings) to the oral proceedings for reasons of procedural efficiency suffered from an error is not successful.

### 3.3 Circumstances of the appeal case

3.3.1 In an annex to the summons to oral proceedings, the opposition division expressed a preliminary opinion that was favourable to the appellant. In particular, the opposition division explicitly stated, in point 6.1.1) of the annex to the summons to oral proceedings, that it considered D6 to disclose a hydromill wheel comprising multiple disc cutters and not a single disc cutter. It appears from the file that it was only in the light of the discussions during the oral proceedings that the division changed its view on interpretation of the expression "single disc cutter" and finally concluded that claim 1 as granted lacked novelty over D6.

3.3.2 The Board entirely agrees with the argument of the appellant that it is not derivable from the specific circumstances during the opposition proceedings that

the appellant should have submitted auxiliary request 2 to the opposition division at an earlier stage, in particular before the final date set by the opposition division according to Rule 116(1) and (2) EPC.

- 3.3.3 In the present case, submitting an auxiliary request of this kind at the same time as the statement of grounds of appeal, at the beginning of the appeal proceedings, can be considered an immediate and appropriate response to developments in the last phase of the opposition proceedings, and to the appealed decision. Moreover, it seems to clearly overcome the novelty objection regarding D6.

If the appellant had filed auxiliary request 2 for the first time with the statement of grounds of appeal, the Board would have admitted the request, exercising its discretion under Article 12(4) RPBA 2020.

- 3.3.4 In such a situation, it must not be to the appellant's disadvantage that it filed auxiliary request 2 at the oral proceedings held before the department of first instance. The fact that the appellant had already filed auxiliary request 2 in first-instance proceedings, so that it might be considered by the department of first instance, rather than withholding it and filing it only at the appeal stage, was neither detrimental to procedural economy nor a disadvantage for the respondent (or the Board) in the present case. In the present circumstances, this should not be held against the appellant when considering the requirement regarding "circumstances of the appeal case" in Article 12(6), first sentence, RPBA 2020.

- 3.3.5 The respondent argues that the subject-matter of claim 1 of auxiliary request 2 had not been searched

and that therefore the request should not be admitted into the appeal proceedings.

This argument is not convincing.

The respondent's argument seems to refer to its own prior-art search in preparation for the opposition. This argument could possibly have been considered by the opposition division during the oral proceedings.

However, the re-filing of auxiliary request 2 in appeal proceedings cannot come as a surprise to the respondent, nor does it deprive the respondent of the chance to supplement its own prior-art search during the appeal proceedings by taking into account the specific features added to the wording of claim 1.

- 3.3.6 In the light of the above, the Board decides to admit auxiliary request 2 (= auxiliary request 1 of the opposition proceedings) into the appeal proceedings.
- 4. Auxiliary request 2 - Article 123(2) EPC
  - 4.1 In claim 1 of auxiliary request 2, claim 1 as filed has been amended by specifying that the plurality of single disc cutters have "disc projection spacing on the drum axis". This amendment has been present already in claim 1 as granted.
  - 4.2 A literal wording of the amendment to claim 1 cannot be found in the application as filed. Nevertheless, its corresponding technical teaching can be identified in the sentence on page 8, lines 11 to 13 of the application:



"It has been discovered that the spacing of the disc traces, in other words their projection on the cutter wheel axis A, B, is preferably 5% to 70% of the disc diameter or if expressed directly in terms of length, then the lateral spacing (in the direction of the axis A, B) of the disc traces is preferably between 10 mm and 70 mm, and in some implementations between 10 and 40 mm."

This sentence refers to the spacing of the projections of the discs on the cutter wheel axis. It is clear from context, in particular from the whole passage at page 8, lines 9 to 24, that the disc traces refer to the disc cutters as defined in claim 1.

Hence, the board sees no reason to deviate from the finding in point II.2.6) of the contested decision, and concludes that the claims of auxiliary request 2 fulfil the requirements of Article 123(2) EPC.

The further amendment in claim 1 of auxiliary request 2 is based on page 8, lines 9 to 11. This was not contested by the respondent.

5. Auxiliary request 2 - Article 83 EPC

5.1 According to Article 83 EPC and established case law of the boards of appeal, a successful objection of lack of sufficiency of disclosure presupposes that there are serious doubts, substantiated by verifiable facts (Case Law of the Boards of Appeal, 10th edition, 2022, Chapter II.C.9). The mere fact that a claimed combination of features encompasses various alternatives or is in certain aspects vaguely defined does not constitute a reason to assume that the patent

does not fulfil the requirement of sufficient disclosure.

- 5.2 The patent does not explain in detail how the disc projections as defined in claim 1 should be determined, or how the spacing between two disc projections should be calculated. However, the respondent's arguments could not generate serious doubts substantiated by verifiable facts that the skilled person would be unable, or at least that it would require undue burden, to determine projections on an axis and to measure their distance ("spacing"). For the skilled person, this falls within customary practice.

The board observes that there might be a certain inaccuracy in measuring the distance between the projections of the cutting disc if they were not all parallel to each other.

However, on the one hand claim 1 does not require all the projections to be considered, and on the other hand this potential inaccuracy relates to the clarity of the wording of claim 1 and not to sufficiency.

Furthermore, the fact that an annotated version of Figure 5 of the application was filed for the purpose of further explanation and clarification of the claimed subject-matter during examination proceedings does not demonstrate that the claimed subject-matter is insufficiently disclosed.

Hence, the board sees no reason to deviate from the finding in point II.1.3) of the contested decision.

5.3 Claim 6 specifies that "at least one disc cutter is mounted at the opposing edges on the peripheral surface of the drum".

According to the respondent, this feature is obscure and could not be carried out by the skilled person, since a single disc cutter could not be mounted at opposing edges on the peripheral surface of the drum.

However, the question of whether a feature is obscure relates to the clarity of the claim wording. It does not necessarily relate to the sufficiency of disclosure of a patent. Moreover, even if a skilled person were in doubt as to what could be meant by the definition in claim 6, with the mind willing to understand they would immediately realise that the features of claim 6 require two disc cutters to be mounted at opposite edges of the drum.

Hence, the Board sees no reason to deviate from the finding in point II.1.5) of the contested decision.

5.4 The board therefore concludes that the invention defined in the claims of auxiliary request 2 is sufficiently disclosed by the patent, as required by Article 83 EPC.

6. Auxiliary request 2 - novelty

6.1 D6 discloses in Figure 7F that various single disc cutters are mounted on the drum periphery at the same distance from the vertical trench wall facing side of the wheel.

6.2 The subject-matter of claim 1 of auxiliary request 2 differs from the hydromill wheel according to D6 in

that the disc cutters (11) are mounted on the drum periphery so that the distance from the vertical trench wall facing side of the wheel (4) is different for each disc cutter (11).

6.3 It follows that the subject-matter of the claims of auxiliary request 2 is novel in view of D6. This has not been contested by the respondent.

7. Remittal to the opposition division

Under Article 11 RPBA 2020, the board may remit the case to the department whose decision was appealed if there are special reasons for doing so.

The opposition division has not decided on the issues arising from the inventive step objections raised by the respondent.

Under these circumstances, the Board considers that a special reason for remittal of the case exists.

Therefore, in accordance with Article 111(1) EPC, the Board decides to remit the case to the opposition division for further prosecution.

## Order

### For these reasons it is decided that:

1. The decision is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



C. Spira

C. Herberhold

Decision electronically authenticated