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**Datasheet for the decision
of 13 July 2023**

Case Number: T 1174/20 - 3.2.03

Application Number: 13425096.8

Publication Number: 2821153

IPC: B21B1/16, B21B15/00

Language of the proceedings: EN

Title of invention:

System and method for cutting to length long rolled products coming from different strands of a rolling mill

Patent Proprietor:

POMINI Long Rolling Mills S.r.l.

Opponent:

Danieli & C. Officine Meccaniche S.p.A.

Headword:

Relevant legal provisions:

EPC Art. 54, 56

RPBA 2020 Art. 13(2)

Keyword:

Novelty - after amendment - common general knowledge - main request (no) - auxiliary request (yes)
Inventive step - auxiliary request (yes) - non-obvious solution
Amendment after summons - further evidence - taken into account (no) - request with deleted claims - taken into account (yes)

Decisions cited:

T 0172/17, J 0014/19

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1174/20 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 13 July 2023

Appellant: POMINI Long Rolling Mills S.r.l.
(Patent Proprietor) Via Luigi Pomini 92
21050 Marnate (VA) (IT)

Representative: Franco Martegani S.r.l.
Via Carlo Alberto, 41
20900 Monza (IT)

Appellant: Danieli & C. Officine Meccaniche S.p.A.
(Opponent) Via Nazionale 41
33042 Buttrio (IT)

Representative: Celona, Antonio
Notarbartolo & Gervasi S.p.A.
Viale Achille Papa, 30
20149 Milano (IT)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
6 February 2020 concerning maintenance of the
European Patent No. 2821153 in amended form.**

Composition of the Board:

Chair C. Herberhold
Members: B. Miller
N. Obrovski

Summary of Facts and Submissions

- I. European patent No. EP 2821153 B1 ("the patent") relates to a system for cutting long rolled ferrous products coming from different strands of a rolling mill.
- II. An opposition to the patent was filed on the grounds of Article 100(a) EPC, referring to Articles 54 and 56 EPC. The opposition division concluded that the subject-matter of claim 1 as granted lacked novelty, and decided that the subject-matter of the set of claims of auxiliary request 2A, as submitted during the oral proceedings on 16 December 2019, fulfilled the requirements of the EPC.
- III. Both parties appealed against the interlocutory decision of the opposition division. As the patent proprietor and the opponent are both appellants and respondents in the appeal proceedings, for the sake of simplicity the Board will continue to refer to the parties as the patent proprietor and the opponent in the present decision.
- IV. The following documents, already cited during the opposition proceedings, are of particular importance in the present decision:

E1: US 2,924,136

E6: US 4,966,060

E9: US 3,834,260

In a letter dated 19 October 2022, the opponent referred to the following documents:

D23: EP 0 110 665 A2
D24: EP 1 166 980 A2
D25: GB 505 855
D26: GB 2 072 118 A
D27: GB 2 300 131 A
D28: US 2,248,375
D29: US 4,773,605
D30: US 5,445,054

V. With the summons to oral proceedings, the Board sent a communication pursuant to Articles 15(1) RPBA 2020, informing the parties that its preliminary opinion was that the subject-matter of claim 12 as granted lacked novelty and that the subject-matter of claim 11 of auxiliary request 1 was obvious.

VI. Oral proceedings were held on 13 July 2023 in hybrid form, in line with the requests by the parties.

At the end of the oral proceedings the following requests were confirmed.

The patent proprietor requested, as its main request, that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 13 as granted. In the alternative, it requested that the patent be maintained in amended form on the basis of main request A, auxiliary request 1, auxiliary request 1A or one of auxiliary requests 2 to 6; the main request A and auxiliary request 1A had been filed with the letter dated 6 October 2022, and auxiliary requests 1 to 6 had been filed with the letter of reply to the statement of grounds of the opponent.

The opponent requested that the decision under appeal be set aside and that the patent be revoked.

VII. Wording of the requests at issue in the present decision

(a) Main request

Claim 1

"System for cutting to length at least two strands of long rolled products (3, 5) preferably coming from a hot rolling mill, the system comprising:

- a shear comprising at least two rotatable drums (4, 6), each drums having cutting means (8, 8', 10, 10') arranged to cut simultaneously at least two strands of long rolled products into finished segments,
- at least a first and a second movable guides (12, 14), the guides being movable between a position wherein, in operation said at least two strands of long products are located outside of the trajectory of the cutting means in a position wherein said strands cannot be cut and a position wherein, said at least two strands are located on the trajectory of the cutting means and can be cut by the cutting means,

characterized in that:

- each guide comprising at least two channels, each channel being arranged to receive and guide at least one strand (3, 5) of long product,
- said first guide (12) is located upstream the shear and said second guide (14) is located downstream the shear in the travel direction of the strands."

Claim 12

"Method of cutting to length at least two strands of long rolled products (3, 5) into finished segments , said at least two strands preferably coming from a hot rolling mill, said method comprising:

- continuously moving forward said two strands,
- guiding simultaneously said at least two strands within the trajectory of cutting means able to cut simultaneously said at least two strands,
- cutting simultaneously said at least two strands with said cutting means,

characterized in :

- guiding simultaneously said at least two strands outside the trajectory of said cutting means."

Claims 2 to 11 and 13 define preferred embodiments of the system according to claim 1 and the method according to claim 12.

(b) Main request A

Main request A corresponds to the main request, with the method claims 12 and 13 deleted.

(c) Auxiliary request 1

Claim 1 is based on claim 1 as granted, with the feature from claim 6 as granted added:

"the guides (12, 14) are rotatable between said two positions."

Claim 11 is based on claim 12 as granted, with the feature from claim 13 as granted added:

"the guiding steps comprises rotating simultaneously said two strands."

(d) Auxiliary request 1A

Auxiliary request 1A corresponds to auxiliary request 1, with the method claim 11 deleted.

(e) The remaining auxiliary requests 2 to 6 are not relevant to the present decision.

VIII. The patent proprietor's arguments, as far as they are relevant to the present decision, can be summarised as follows.

(a) Admittance of documents D23 to D30

D23 to D30 had first been cited after notification of the summons to attend oral proceedings before the board. The documents were not *prima facie* relevant, since they did not support the argument by the opponent that a shaft was synonymous with a drum. Therefore the documents should not be admitted into the proceedings.

(b) Main request - novelty

E1 disclosed a system in which the shear comprised cutting means mounted on thin shafts. However, claim 1 as granted specified that the shear comprised cutting means on a drum. A drum was not a shaft. A drum had a larger radius than its width (axial length), and a greater mass than a shaft. The subject-matter of claim 1 was therefore novel over E1.

E1 disclosed a shear, wherein the guides were moved by a mechanical transmission system with several gears with teeth, wherein different gears were used to move the guides. Since the different gears resulted in different lateral-movement systems for the guides, the two strands of E1 were not guided simultaneously inside and outside the trajectory of the cutting means, as required by claim 12.

(c) Main request A and auxiliary request 1A -
admittance

The submission of main request A and auxiliary request 1A did not constitute an amendment to the case, since in both requests only the method claims had been deleted. In respect of the remaining, limited subject-matter defined in the claims of these requests, the same arguments applied as for the main request and auxiliary request 1.

(d) Main request A - inventive step

The subject-matter of claim 1 differed from the system of E1 in that the cutting means of the shear were arranged on drums.

The objective technical problem in view of E1 could be seen in the provision of an alternative system.

E1 did not provide an incentive to arrange the cutting means on a drum. The use of drums in the shear according to E1 would require a redesign of the system of E1, since drums needed more space than the shafts used in E1.

(e) Auxiliary request 1 - inventive step

The subject-matter of claim 11 differed from E1 in that the strands performed a rotation. There was no incentive in E1 to change the lateral-movement system of the guides of E1 to a system that rotated the inlet guides and the outlet guides and consequently the strands.

(f) Auxiliary request 1A - inventive step

The subject-matter of claim 1 differed from the system of E1 in that the cutting means of the shear were arranged on drums and in that both guides, i.e. the inlet guide and the outlet guide, had to be rotatable.

There was no incentive in E1 to change the lateral-movement system of the guides of E1 to a system that rotated the inlet guides and the outlet guides.

Modifying the system of E1 in order to allow the guides to be rotatable required a fundamental change and redesign of the system of E1, which was not obvious in the absence of any hint or incentive in E1.

IX. The opponent's arguments, as far as they are relevant to the present decision, can be summarised as follows.

(a) Admittance of documents D23 to D30

D23 to D30 had been cited as evidence of common general knowledge that the terms "drum" and "shaft" were used synonymously in mechanical engineering. The documents did not change the line of argument already put forward in the statement setting out the grounds of appeal and the reply to appeal, and should thus be admitted.

(b) Main request - novelty

E1 disclosed a system in which the shear comprised cutting means mounted on shafts. Neither claim 1 nor the patent specification as a whole provided a definition of the term "drum". The terms "drum" and "shaft" were used synonymously in the field of cutting tools. Using different words for the same item did not establish novelty. The subject-matter of claim 1 was therefore not novel over E1.

E1 disclosed a mechanical transmission system with several gears with teeth, wherein different gears were used to move the guides. The guides of E1 were movable between a position wherein two strands were located outside of the trajectory of the cutting means and a position wherein the strands were located within the trajectory of the cutting means.

The mechanism of E1 manipulated both pipes of the inlet guide simultaneously. In particular, both pipes of the inlet guide were fixed by a clevis element to the connecting rod. Thus, the two strands were guided simultaneously both within and outside the trajectory of the cutting means by the movement of the connecting rod.

The subject-matter of claim 12 therefore lacked novelty.

(c) Main request A and auxiliary request 1A -
admittance

The main request A and auxiliary request 1A were filed after notification of the summons to attend oral

proceedings, without cogent reasons. Therefore, the requests should not be admitted into the appeal proceedings.

(d) Main request A - inventive step

The subject-matter of claim 1 differed from the system of E1 in that the cutting means of the shear were arranged on drums.

The objective technical problem in view of E1 could be seen in the provision of an alternative system.

It was common general knowledge that cutting means could equivalently be arranged on a shaft or a drum.

Hence, it was obvious to modify the system of E1 by enlarging the shafts in the area of the cutting means, i.e. to use drums instead of the shafts as such.

In respect of providing a mere alternative, the skilled person did not require an incentive in the closest prior art. A redesign of the system of E1 was not required in order to use short, small drums instead of shafts.

(e) Auxiliary request 1 - inventive step

The subject-matter of claim 11 differed from E1 in that the two strands performed a rotation.

It was obvious to keep the inlet ends of the inlet guide stable at one position, in which case the guiding steps of the method of E1 comprised rotating the two strands simultaneously.

(f) Auxiliary request 1A - inventive step

Due to friction between the bottom shoes supporting the inlet pipes at one end, the inlet pipes performed a rotational movement. The connecting rods manipulating the outlet ends of the outlet guide moved at different speeds. While the inlet ends moved back and forth, the outlet ends of the outlet guide just moved in one direction. As a result of this different actuation, the outlet guide also performed a rotational movement.

The subject-matter of claim 1 differed from the system of E1 in that the cutting means of the shear were arranged on drums. Hence, the same arguments applied as to the main request.

Alternatively, even if the subject-matter of claim 1 differed in respect of the rotational movement of the inlet and outlet guides, the subject-matter of claim 1 was nevertheless obvious. In order to provide an alternative system, the skilled person would modify the guides in an obvious manner to provide a rotational movement.

Reasons for the Decision

1. Admittance of documents D23 to D30

1.1 Since documents D23 to D30 were filed after notification of the summons to attend oral proceedings before the Board, their admittance into the appeal proceedings falls within the discretion of the board under Article 13(2) RPBA 2020.

When exercising its discretion under Article 13(2) RPBA 2020, the board may rely on criteria as set out in Article 13(1) RPBA 2020 (see T 172/17, Reasons 5.4).

1.2 In the case at hand, the opponent argued from the beginning of the appeal proceedings that the terms "shaft" and "drum" were synonyms in the context of claim 1. In order to support this argument, the opponent cited documents D23 to D30 with the intention of proving the common general knowledge of the skilled person.

Irrespective of whether patent applications can indeed demonstrate the common general knowledge, documents D23 to D30 do not support the opponent's argument.

Although documents D23 to D30 disclose shafts and drums as alternative means in the general part of the description, this does not imply that the terms are synonyms even in these documents. On the contrary, most of the documents clearly use the terms "shaft" and "drum" with different meanings to indicate different mechanical parts, see for example:

D23, page 12, line 8:

"drum-like annulii 17 adapted to fit the shaft"

D25, Figure:

drum z, shaft y

D26, Figure 1:

snub drum 18, rotatable shaft 20

D27, page 4, second paragraph:

"drum shaft 4,6"

D28, col. 2, lines 21-23:

"the driven shaft 3 on which the cable drum ... is mounted"

D29, col. 2, lines 49-51:

"the shaft 5 is seen which rotates the drum ..."

D30, col. 5, lines 3-5:

"a drum 32 mounted for rotation on a shaft (not shown) for rotation"

Hence, the late-filed documents are not *prima facie* relevant in supporting the opponent's argument that the terms drum and shaft are used synonymously.

1.3 The Board considered the above circumstances pursuant to Article 13(2) RPBA 2020, and decided not to admit documents D23 to D30 into the appeal proceedings.

2. Main request - claim 1 - novelty over E1

2.1 E1 discloses, in Figure 1, a system for cutting to length at least two strands of long rolled products, comprising a shear and movable guides.

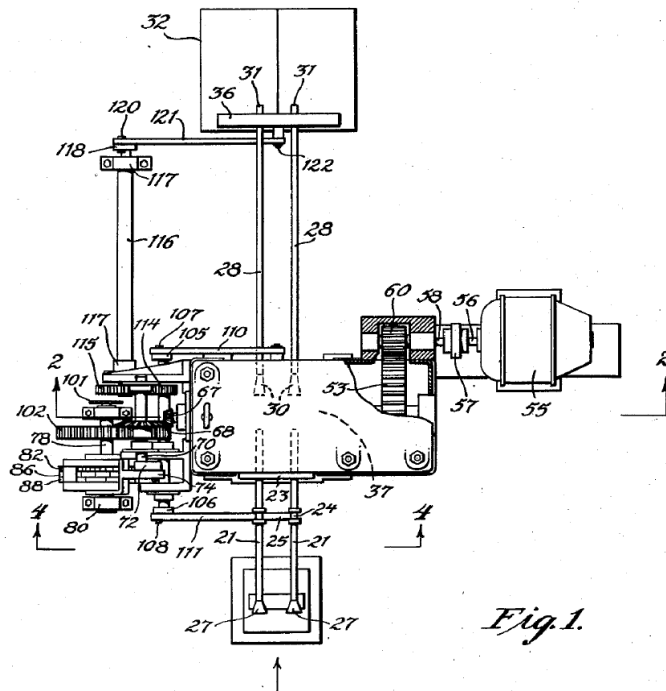


Fig. 1.

Each guide comprises two pipes (21, 28), each pipe being arranged to receive and guide one strand of long product.

One guide is located upstream of the shear and the other guide is located downstream of the shear.

The shear, as shown in Figure 2 of E1, comprises two rotatable shafts (41, 47), each shaft having cutting means (38, 45) arranged to simultaneously cut two strands of long rolled products into finished segments. In addition, there is a space (66) between the cutting means (38, 45) and a space (65) next to the cutting means, which allow the strands to pass the shear without being cut, see column 3, lines 38 to 49.

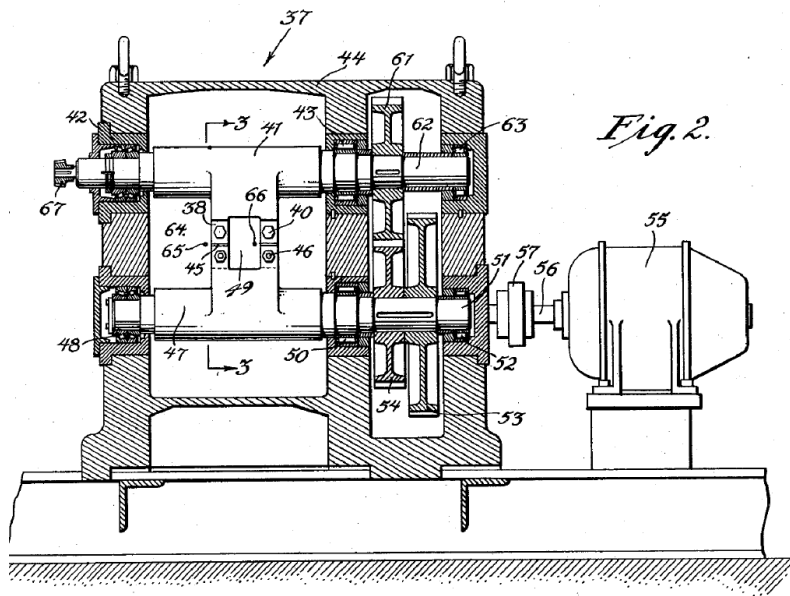


Fig. 2.

Hence, the guides of E1 are movable between

- a position wherein two strands are located outside of the trajectory of the cutting means in a position wherein said strands cannot be cut (see Figure 2 above, reference numerals 65, 66) and
- a position wherein the strands are located within the trajectory of the cutting means in a position wherein said strands can be cut.

2.2 The opponent argues that the rotation shafts (41, 47) of E1 can be considered drums according to claim 1 of the patent, in view of the common general knowledge that any rotating cylindrical element is a drum.

This argument is not convincing.

2.3 The wording of a claim needs to be interpreted in a way which is technically sensible in the technical field concerned, see Case Law of the Boards of Appeal, 10th edition, 2022, II.A.6.1.

Although a drum is usually a rotating cylindrical element, as argued by the opponent, it cannot be concluded that every rotating cylindrical element is a drum. For example, a disc is a cylindrical element of relatively low height. However, a disc is not usually referred to as a drum.

- 2.4 Furthermore, the patent refers to a shaft moving the guide (see claim 11, paragraphs [0019] and [0022]). Hence, in the context of the patent the term "shaft" is not used synonymously with the term "drum". The patent further confirms that not all cylindrical elements are drums in paragraph [0021], since that refers to rods (12d, 14d). The use of terms such as "shaft", "drum" and "rod" in the patent is therefore not arbitrary, contrary to the opponent's argument.

It follows that neither the common general knowledge nor the disclosure in the patent provides support for considering shafts and drums as synonyms in the context of the patent.

- 2.5 In view of the above, the Board concludes that the shear shafts (41, 47) of E1 cannot be considered drums (in the meaning of claim 1) on which the cutting means are mounted.

The subject-matter of claim 1 as granted is therefore novel over E1.

3. Main request - claim 12 - novelty over E1

- 3.1 E1 discloses a method of cutting two strands of long rolled products into finished segments by the flying shear illustrated in Figure 1. It is undisputed that,

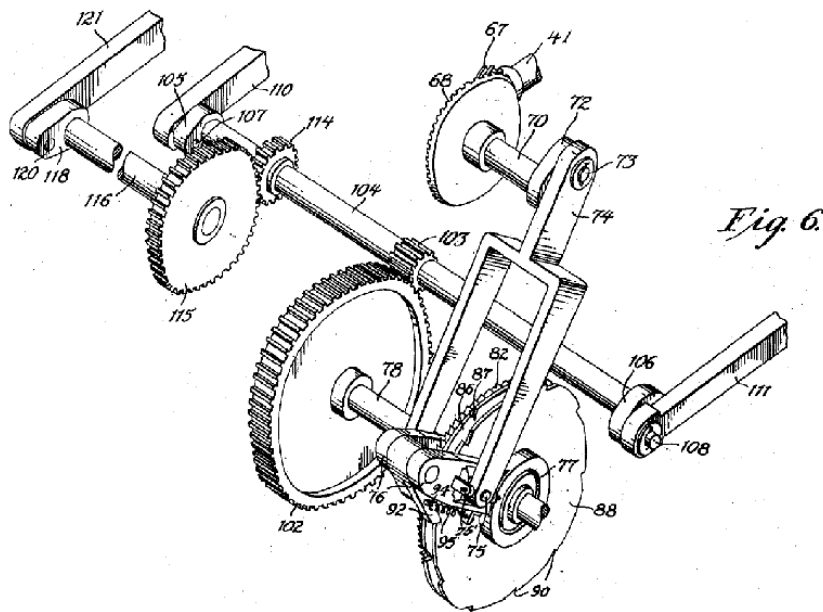
according to E1, two strands are continuously moved forward and are guided into the shear within the trajectory of cutting means able to cut said two strands.

- 3.2 However, the patent proprietor argues that in the cutting method of E1 the two strands are not guided **simultaneously** inside and outside the trajectory of the cutting means as a result of the use of a specific mechanical transmission system, as shown in Figures 5 and 6 of E1.

This argument is not convincing.

- 3.3 In view of the wording of claim 12, it is not relevant whether the movement of the outlet guide exactly mirrors the movement of the inlet guide. In order to obtain a simultaneous movement of the strands within and outside the trajectory of the cutting means, a movement of the inlet guide and an in some way adapted movement of the outlet guide are sufficient. This is the case in E1, as explained below.

The transmission system of E1 comprises several gears with teeth (Figure 6, column 3, line 63 to column 4, line 72).



The first connecting rod 110 and the second connecting rod 111 are mounted on the same crank shaft 104 and therefore move simultaneously. The connecting rod 110 imparts lateral movement to the downstream carrier 33 and the inlets 30 of the pipes 28 of the outlet guide (second guide 14, in the meaning of claim 1 of the patent).

A further connecting rod 121 in the mechanism of E1 manipulates the outlet end of the pipes 28 of the outlet guide (column 4, lines 60 to 64), in order to direct the cut strands alternately to two coilers, see column 4, lines 58 to 72.

For the movement in and out of the trajectory of the cutting means, the inlet guide is important.

The mechanism of E1 uses a single connecting rod 111 to manipulate pipes 21 of the inlet guide. The connecting rod 111 imparts lateral movement to the clevis element

25 and the pipes 21 of inlet guide (first guide 12, in the meaning of claim 1 of the patent), see Figures 5 and 6 of E1. Hence, the connecting rod 111 achieves a parallel movement of the pipes 21, since the pipes 21 are fixed by clevis element 25 to the connecting rod 111.

It follows that the two strands are guided simultaneously both within and outside the trajectory of the cutting means by the movement of the connecting rod 111.

Therefore, the subject-matter of claim 12 as granted lacks novelty over E1.

4. Admittance of main request A and auxiliary request 1A

4.1 As the main request A and auxiliary request 1A were filed after notification of the summons to attend oral proceedings before the Board, Article 13(2) RPBA 2020 applies.

The main request A and auxiliary request 1A correspond to the main request and auxiliary request 1, except that the method claims have been deleted.

4.2 Any part of a party's appeal case which is not directed to the requests, facts, objections, arguments and evidence contained in the statement of grounds of appeal or the reply constitutes an amendment to a party's appeal case within the meaning of Article 13(1) and (2) RPBA 2020. This includes the filing of an amended claim request (see J 14/19, Reasons 1.4 and 1.5).

- 4.3 In view of the above, and contrary to the patent proprietor's assertion, the deletion of one or more claims from a claim request also constitutes an amendment of the appeal case within the meaning of Article 13(1) and (2) RPBA 2020.
- 4.4 As stated above, when exercising its discretion under Article 13(2) RPBA 2020, the Board may also rely on criteria as set out in Article 13(1) RPBA 2020 (see T 172/17, Reasons 5.4).
- 4.5 In the case at hand, the Board had indicated in its communication under Article 15(1) RPBA 2020
- that the system of claim 1 of the main request was novel,
 - that the system of claim 1 of auxiliary request 1 was not obvious when starting from E1,
 - that the method of claim 12 of the main request was not novel, and
 - that the method of claim 11 of auxiliary request 1 was obvious in view of the teaching in E1.

In response, the patent proprietor filed the main request A and auxiliary request 1A. Both requests correspond to requests underlying the contested decision, with the sole difference that the method claims - i.e. the only claims which the Board considered unallowable - have been deleted. The amendment in both requests thus directly addresses the objection of lack of novelty and lack of inventive step which the Board had considered valid. Moreover, it is immediately apparent why both requests overcome those objections. The amendment is also strictly limited to overcoming those objections. It does not shift the discussion or give rise to any new objections. Furthermore, the amendment does not involve any

additional burden for the other party. It could also be expected, as the request that the opposition division had found to comply with the EPC does not contain any method claims either. Overall, although the patent proprietor amended its appeal case in response to the Board's preliminary opinion, it did so in a manner which clearly served procedural economy.

4.6 The Board considers the above circumstances to be exceptional under Article 13(2) RPBA 2020. It therefore exercises its discretion under that provision in taking the main request A and auxiliary request 1A into account in the appeal proceedings.

5. Main request A - inventive step

5.1 Both parties agree that E1 is the closest prior art, since it shows a system for cutting at least two strands of long rolled products according to the preamble of claim 1.

Claim 1 of main request A corresponds to claim 1 of the main request. As indicated above in point 2, the subject-matter of claim 1 differs from E1 in that the cutting means are mounted on a drum.

5.2 In line with the arguments of both parties, the objective technical problem can be seen as the provision of an alternative.

5.3 The patent proprietor argues that E1 does not provide a hint or incentive to arrange the cutting means on a drum. In its view, the use of drums in the shear according to E1 is not obvious, because it would require a redesign of the system of E1, given that drums need more space than shafts.

This argument is not convincing.

- 5.4 It is known in the art that driving means can be in the form of a rotating shaft or a rotating drum. Although "drum" and "shaft" are not synonymous terms, it is undisputed that both alternatives are part of the common general knowledge in the field concerned.

Equivalent mechanical parts are used by the skilled person as alternatives in the course of routine modifications to systems. A particular incentive is thus not required. Moreover, no reason can be seen why the skilled person would not replace the shaft in the flying shear of E1 by a known functional alternative, such as a small drum, when aiming to find a simple alternative.

Furthermore, the term "drum" according to claim 1 does not imply a minimum dimension or weight. Small drums that have the same dimension as the holding part on the shaft of the cutting means of E1 could be used, instead of the shaft as such, without any technical problems. Nor is the skilled person prevented from using relatively small drums by an allegedly required redesign of the shear of E1, since this does not appear to be necessary when using small drums, contrary to the argument made by the patent proprietor.

Therefore the Board concludes that the subject-matter of claim 1 of the main request A is obvious in view of E1 and consequently does not fulfil the requirements of Article 56 EPC.

6. Auxiliary request 1 - claim 11

6.1 With the summons to oral proceedings, the Board sent a communication pursuant to Article 15(1) RPBA 2020 informing the parties of its opinion, namely that the subject-matter of method claim 11 of this request does not involve an inventive step. The reasons for this are given below.

6.2 Claim 11 does not specify that the shear comprises drums. Furthermore, it merely requires that "the guiding steps comprises rotating simultaneously said two strands".

The Board is in agreement with the arguments of the opposition division in point II.3.3.2 of the decision, according to which it is obvious to keep the inlet ends of the guides 21 of E1 stable at one position, since this is common practice in the art, as shown for example in E6 (Figure 6: turning point 38) and E9 (Figure 1: turning point 10).

With the inlet ends kept at one position, the guiding step not only results in a movement of the two strands simultaneously, respectively within and outside the trajectory of the cutting means, but also comprises **simultaneously rotating** said two strands (the movement being analogous to the one shown in Figure 1 of the patent for the proximal guides 12).

6.3 This preliminary opinion by the Board was not disputed by the parties during the oral proceedings.

The Board does not therefore see any reason to deviate from this opinion, and concludes that the subject-matter of claim 11 of auxiliary request 1 is obvious

and so does not fulfil the requirements of Article 56 EPC.

7. Auxiliary request 1A - inventive step

7.1 The only objection raised by the opponent to auxiliary request 1A was an inventive-step objection, starting from document E1 as the closest prior art in combination with the common general knowledge.

7.2 Following on from point 2 above, the parties do not agree on whether E1 discloses that the outlet guide (pipes 28) and the inlet guide (pipes 21) are rotatable between two positions.

7.2.1 Outlet guide, pipes 28

E1 discloses a system wherein a connecting rod 121 manipulates the outlet ends of pipes 28 of the outlet guide at half the frequency of the inlet ends 30 of the pipes 28, see gear 114, which meshes with gear 115 in the gear system of Figure 6 of E1 and column 5, lines 16-19. In other words, while inlet ends 30 move back and forth (i.e. into the shear path and out again), the outlet ends 27 just move in one direction (either from position 1 to position 2 or vice versa). Only during the next back-and-forth movement of the inlet ends do they move back into their initial position.

Thus, the movement of the outlet guides cannot be described as a mere rotation between two positions.

Rather, it inevitably requires a translational movement as well, i.e. the outlet guide (pipes 28) disclosed in

E1 are not "rotatable between said two positions" as required by claim 1.

7.2.2 Inlet guide, pipes 21

The inlet guides of E1 are not rotatable either. Their movement is manipulated by a single carrier (111) which provides a left-right movement of the pipes 21 of the inlet guide.

The argument of the opponent, that this movement in E1 is an axial and hence rotating movement, is not convincing.

Even if the term "axial" could in isolation be interpreted in a different manner, it needs to be interpreted in the context of E1. In this regard it is not possible to infer from the mechanism of E1 how the movement of the single connecting rod in the system of E1 could achieve rotation of the pipes.

Indeed, the term "axial" in the sense of E1 refers to the axis of the wire. This becomes evident from the description of Figure 4, which shows "an enlarged axial section", see column 1, lines 71-72.

Moreover, the further argument made by the opponent, that friction between the pipes of the inlet guide on the one hand and the bottom shoes 22 and top shoes 23 on the other hand inevitably leads to a rotational movement of the guide, is not convincing.

The pipes of the inlet guide are mounted between these shoes for "axial motion", see column 2, lines 68 to 72. E1 does not provide a direct and unambiguous disclosure that the shoes reduce the extent of movement on the

outlet end of the inlet guide, in particular such as to provide a rotational movement of the guide between two positions. On the contrary, given the rigidity of the connection between the two pipes, and the single connecting rod, it is in fact clear to the skilled person that a rotational movement is clearly not intended in E1.

7.2.3 It follows that the subject-matter of claim 1 differs from the system of E1 in that the shear comprises drums and in that both the inlet guide and the outlet guide have to be rotatable between two positions.

7.3 The patent aims at a system for cutting to length long rolled products coming from different strands of a rolling mill simultaneously and in a simple manner while minimising the space needed to process multiple strands in a rolling mill plant, see paragraph [0011].

This general problem is already solved by the system of E1.

Starting from E1, the objective technical problem to be solved by claim 1 can be formulated as the provision of an alternative system, and this is in line with the arguments of both parties.

7.4 While the opposition division has convincingly argued that, because the strands exit the mill stands at a fixed location, the position where the strands enter the respective inlet guides would obviously be kept the same at all times (point II.3.3.2 of the decision), and even though, as argued in point 5 above, replacing the shafts by drums cannot establish an inventive step, E1 does not provide an incentive to change the movement of the outlet guides. Indeed, the translational movement

of the discharge end of the outlet guides of E1 is essential to switch from one coiler to the other (see E1, column 5, lines 26-28).

Moreover, in order to provide a rotational movement between two positions for the outlet and inlet guides, simple routine workshop modifications are not sufficient. Rather, a redesign of the complete gear system of E1 would be required. In the absence of a clear pointer in E1, this is not obvious to the skilled person.

It follows that, starting from E1, the subject-matter of claim 1 is not obvious and therefore fulfils the requirements of Article 56 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent as amended in the following version:
 - claims 1-10 of auxiliary request 1A, which was submitted with the letter dated 6 October 2022;
 - description columns 1 to 6, which was submitted during the oral proceedings before the Board; and
 - drawings, Figures 1 to 3 of the patent specification.

The Registrar:

The Chair:



C. Moser

C. Herberhold

Decision electronically authenticated