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**Datasheet for the decision
of 29 November 2024**

Case Number: T 1908/22 - 3.2.07

Application Number: 13710053.3

Publication Number: 2800639

IPC: B21B43/00

Language of the proceedings: EN

Title of invention:

Method FOR THE PRODUCTION AND THE PACKAGING OF STEEL RODS AND
PROFILES

Patent Proprietor:

SMS Meer S.p.A.

Opponent:

DANIELI & C.
OFFICINE MECCANICHE SpA

Headword:

Relevant legal provisions:

EPC Art. 100(c), 123(2), 114(2), 100(b), 83, 100(a), 54, 56
RPBA 2020 Art. 12(2), 12(4), 13(2)

Keyword:

Grounds for opposition - added subject-matter (no) -
insufficiency of disclosure (no) - lack of patentability (no)
Amendments - change of claim category - intermediate
generalisation - extension beyond the content of the
application as filed (no) - added subject-matter (no)
Sufficiency of disclosure - (yes)
Novelty - (yes)
Inventive step - (yes)
Amendment to case - amendment within meaning of Art. 12(4) RPBA
2020 (yes) - admitted (no)
Amendment after notification of Art. 15(1) RPBA communication
- exceptional circumstances (no) - taken into account (no)

Decisions cited:

T 0182/89, T 0019/90, T 1914/12, T 1875/15

Catchword:



Beschwerdekammern
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Case Number: T 1908/22 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 29 November 2024

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 10 June 2022
rejecting the opposition filed against European
patent No. 2800639 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman E. Mille
Members: A. Cano Palmero
B. Paul

Summary of Facts and Submissions

- I. The opponent (appellant) lodged an appeal within the prescribed period and in the prescribed form against the decision of the opposition division to reject the opposition filed against European patent No. 2 800 639.
- II. The opposition was filed against the patent in its entirety and based on the grounds for opposition pursuant to Articles 100(a), (b) and (c) EPC (lack of novelty, lack of inventive step, insufficient disclosure and added subject-matter).
- III. In preparation for oral proceedings, scheduled upon the parties' requests, the board communicated its preliminary assessment of the case to the parties by means of a communication pursuant to Article 15(1) RPBA. The board indicated that the appeal was likely to be dismissed. None of the parties replied in the substance to this communication.
- IV. Oral proceedings before the board took place on 29 November 2024. At the conclusion of the proceedings the decision was announced. Further details of the proceedings can be found in the minutes thereof.
- V. The appellant requested

that the decision under appeal be set aside
and
that the patent be revoked.
- VI. The patent proprietor (respondent) requested

that the appeal be dismissed, *i.e.*

that the patent be maintained as granted.

VII. The lines of argument of the parties relevant for the present decision are dealt with in detail in the reasons for the decision.

VIII. **Independent claim 1** of the **main request** (*i.e.* according to the patent as granted) reads as follows:

"Method for the production and packaging of steel bars or rods and profiles, including the following steps:

rolling rods or profiles (1) of indefinite length, scrap separating the rods or profiles (1), diverting the rods or profiles (1), cutting said bars or profiles (1) in bar portions (1a, 1b) having at least a first fixed length (LH), changing the speed of the bar portions by means of a speed changing device (7) providing at least two cylinders or rotating drums (8a, 8b), each of the at least two cylinders or rotating drums (8a, 8b) having an outer surface provided with grooves or housings (18), which during the rotation pass from an upper position wherein the grooves or housings (18) receive the bar portions (1a, 1b), to a lower position, wherein the grooves or housings (18) download the bar portions (1a, 1b), the grooves or housings (18) having a second fixed length (L), greater than said first fixed length (LH) and greater than the commercial length of the bars, the speed changing device being able to handle said bar portions (1a, 1b) at a set speed rate such that said portions can be placed within respective

grooves or housings (18),
so that the grooves or housings (18) in the upper position receive relative bar portions (1a, 1b), while the grooves or housings (18) in the lower position download the bar portions (1a, 1b), which have been previously received in the upper position, on at least one cooling plate (13), wherein each rotating cylinder (8a, 8b) is associated with a different speed changing device (7), so that said grooves or housings (18) of different rotating cylinders (8a, 8b) receive said bar portions (1a, 1b) at different speeds, depending on the fact that said grooves or housings (18) belong to one first (8a) or to at least one second rotating cylinder (8b), and so that said bar portions (1a, 1b) have different stop positions in the relative housings (18), in a direction perpendicular to the direction of rotation of said cylinders (8a, 8b), **characterized in that** said bar portions (1a, 1b) have the same positions within said housings (18), both for said first rotating cylinder (8a) and for said second rotating cylinder (8b), so that said bar portions (1a, 1b) are arranged within said grooves or housings (18) of each respective rotating cylinder (8a; 8b) always in the same positions, so that, during the download of the bar portions (1a, 1b) on the at least one cooling plate (13), the bar portions (1a, 1b) do not overlap each other."

Reasons for the Decision

1. *Patent as granted - Added subject-matter, Articles 100(c) and 123(2) EPC*
- 1.1 The appellant argued in points 11 to 13 of the statement setting out the grounds of appeal that there was no direct and unambiguous basis for a switch of the claim category from a plant (as in original claim 1) to a method (as in claim 1 as granted). According to the appellant, the only faint reference to a method in original page 1, line 9 could not constitute a sufficient basis for the category change.
 - 1.1.1 The board disagrees with the appellant and concurs with the opposition division and with the respondent that the description in its whole provides a sufficient basis for a method for the production and packaging of steel bars or rods and profiles. In particular, the board is convinced that the skilled person is not presented with new technical information due to the change of claim category.
- 1.2 The appellant further argued that in claim 1 as granted there was a logical link between the combination of a) "*different stop positions of the bars in the respective cylinders*" with b) "*same positions of the bars for each cylinder*" and the technical effect of avoiding overlapping between the bars during the downloading of the same. According to the appellant, the combination of original claims 1 and 4 could not create such a logical link. The effect of avoiding an overlap was rather presented in the original description to feature b) alone. The appellant argued also that if original page 8, lines 5 to 18 was to be taken as basis for amended claim 1, as it was considered by the opposition

division in point 2 of the reasons for the decision under appeal, then the omission of the feature that the length of the bar portions LH is lower than half of the length L of the housing 18 ($LH < \frac{1}{2} L$) resulted in an unallowable intermediate generalisation, since this feature was presented as inextricably linked to the effect of avoiding overlapping.

1.2.1 The board is not persuaded by the appellant's arguments for the following reasons. As correctly found by the opposition division, original claim 4 referred back to original claim 1, which already includes the effect of avoiding overlapping. This feature is maintained in claim 1 as granted and defines the result of the entire combination of features of the claim, but it is not restricted to a particular feature, so that the board does not see any extension of subject-matter by combining original claims 1 and 4.

1.2.2 In addition, with respect to the cited passage (original description page 8, lines 5 to 18), the board underlines that the feature $LH < \frac{1}{2} L$ is preceded by the wording "in particular" and as such can be seen as one of many embodiments that could deliver the effect of no overlapping and therefore both, feature and effect, cannot be seen as being inextricably linked to each other. Therefore, the omission of that feature does not constitute an inadmissible intermediate generalisation.

1.3 During the oral proceedings before the board, the appellant presented three further arguments in the discussion under Article 123(2) EPC, namely:

- that the omission of the feature "in line" resulted in an unallowable intermediate generalisation;

- that the feature "different speed changing devices" had no basis in the original application; and
- that the omission in claim 1 as granted of one of the wording "depending on the fact" with respect to original claim 1 resulted in an infringement of Article 123(2) EPC.

1.3.1 The respondent argued that these objections were raised for the first time during the oral proceedings before the board and requested not to admit these into the appeal proceedings for being late-filed.

1.3.2 The appellant confirmed that these objections were submitted for the first time during the oral proceedings before the board. The appellant was of the view that the board had no discretion not to admit "arguments" into the appeal proceedings and referred to decisions T 1914/12 and T 1875/15. Furthermore, the appellant argued that the objections clearly prejudiced the maintenance of the patent as granted and that it should be the task of the board to guarantee that only valid patents are maintained.

1.3.3 The board is not convinced that the findings of T 1914/12 and T 1875/15 can be applied to the present case, since the case at hand underlies the RPBA 2020 and not the RPBA 2007. The board notes that Article 12(2) RPBA 2020 specifies that a party's appeal case shall be directed to the requests, facts, **objections**, **arguments** and evidence on which the decision under appeal was based.

According to Article 12(4) RPBA 2020, any part of a party's appeal case which does not meet the requirements of Article 12(2) RPBA 2020 is to be regarded as an amendment, which may be admitted only at

the discretion of the board. In addition, according to Article 13(2) RPBA 2020, any amendment to a party's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

- 1.3.4 In the board's view, these provisions of the RPBA 2020 are not at odds with Article 114(2) EPC, which focuses on the discretionary power to disregard late-filed facts and evidence, whereas the RPBA focuses rather on the discretionary power of a board of appeal to not admit an amendment which may, for example, consist of new arguments or objections as in the present case.
- 1.3.5 The circumstances in the present case are even more severe since the new arguments and/or objections filed for the first time during the oral proceedings before the board were directed against claim 1 as granted. The board is convinced that the appellant not only could but most importantly should have formed its complete case on Article 123(2) EPC already during opposition proceedings, at the latest during the discussion of this issue at the oral proceedings before the opposition division. Due to the appellant's course of action, the discussion of added subject-matter based on the three new arguments and/or objections could not be dealt with by the opposition division and consequently the decision under appeal is not based thereon. Since the appellant has not convincingly demonstrated that this part was admissibly raised and maintained in opposition proceedings and that it was not a mere development of the previous arguments, it results in an amendment which, according to Article 12(4) RPBA may only be admitted at the discretion of the board.

The appeal proceedings, which are largely determined by the factual and legal scope of the preceding proceedings, are not intended as an opportunity to bring an entirely fresh case to the board. This means that an appellant is not at liberty to shift its case as it pleases, and so to compel the board either to give a first ruling on the critical issues or to remit the case to the opposition division. Conceding such freedom to an appellant would run counter to orderly and efficient appeal proceedings, which are primarily directed to reviewing the correctness of the decision under appeal according to Article 12(2) RPBA.

Against this background, the board, exercising its discretion under Article 12(4) RPBA, does not admit the new lines of argument on added subject-matter brought forward for the first time during the oral proceedings before the board into the appeal proceedings.

- 1.3.6 Furthermore, the appellant has not justified with cogent reasons that there were exceptional circumstances for the submission of the new three arguments and/or objections under Article 123(2) EPC, so that these are also not considered in the appeal proceedings under Article 13(2) RPBA.
- 1.4 In consequence, the board concludes that the appellant has not admissibly and convincingly demonstrated the incorrectness of the finding of the opposition division, that the subject-matter of claim 1 as granted does not infringe Article 123(2) EPC.

2. *Patent as granted - Sufficiency of disclosure, Articles 100(b) and 83 EPC*

2.1 The appellant argued that, since claim 1 as granted encompassed any length LH of the bar portions, the skilled person could not carry out the invention, especially not the feature "*so that the bar portions (1a, 1b) do not overlap each other*" in cases where this length LH would be equal or higher than $\frac{1}{2} L$, being L the length of the housing 18. The requirements of the length LH of the bar portions could thus not be generalised. Furthermore, the patent in suit did not provide any indication or guidance to the skilled person of an appropriate length in order to achieve the desired result.

2.2 The board is not persuaded by the appellant's arguments. According to the established case law of the Boards of Appeal, an objection of lack of disclosure presupposes that there are serious doubts substantiated by verifiable facts. The burden of proof is upon the opponent to establish based on the balance of probabilities that a person skilled in the art, using his common general knowledge, would be unable to carry out the invention (see the Case Law of the Boards of Appeal of the European Patent Office, 10th Edition, 2022, II.C.9, first two paragraphs, in particular in relation to T 19/90 and T 182/89).

2.3 In the present case, the board concurs with the respondent that the appellant's argument that the scope of claim 1 could allow combinations of bar portions that do not meet the requirement of avoiding overlapping cannot amount to a successful objection of lack of sufficiency of disclosure. The board is satisfied with the respondent's argument that the

skilled person is capable, using its common general knowledge but also using the description and drawings of the patent in suit, to choose appropriate combinations of the bars' lengths in order to meet the requirement of no overlapping. In addition, the board is of the view that even if the subject-matter of claim 1 could theoretically cover embodiments with lengths that cannot possibly meet the above requirement, the skilled person would immediately rule out these non-working combinations. The board thus concludes that the appellant's allegation cannot amount to serious doubts that the claimed invention cannot be carried out.

2.4 The board thus concludes that the appellant has not convincingly demonstrated the incorrectness of the finding of the opposition division that the patent as granted is sufficiently disclosed.

3. *Patent as granted - Novelty, Articles 100(a) and 54 EPC*

3.1 The appellant acknowledged that document D1 (**WO 2005/123292 A1**) did not disclose the following feature:

b) *"that said bar portions have the same positions within said housings, both for said first rotating cylinder and for said second rotating cylinder, so that said bar portions are arranged within said grooves or housings of each respective rolling cylinder always in the same positions"*.

3.1.1 The board agrees with the opposition division that it is clear from the reading of claim 1 that each rotating cylinder is associated with a different speed changing device. Each of these different speed changing devices handles the bar portions at a set speed rate and

depending on the fact that said grooves or housings belong to one first or to at least one second rotating cylinder. Said bar portions (1a, 1b) have therefore different stop positions in the relative housings, but the stop positions are the same within one rotating cylinder, as shown in figure 8 of the patent in suit. In contrast, figure 5A of D1 shows bar portions with different stop positions within the same rotating cylinder. Therefore, the board is of the view that, despite the fact that the result of the method of D1 is that the bars do not overlap as in the patent, the subject-matter of the method claim 1 as granted is novel in view of D1.

- 3.1.2 The subject-matter of claim 1 as granted is therefore undisputedly novel over D1.

- 3.2 The appellant indicated that document D2 (**WO 2006/092404 A1**) was quite similar to D1 and also taught different speeds to receive the bar portions in the housing of the rotating cylinders (so that they have different stop positions in the relative housings), whereby no overlap of the bar portions occurs in the unloading process.
 - 3.2.1 The board, for the same reasons as for D1, is of the view that document D2 does not anticipate at least feature b), so that the subject-matter of claim 1 is novel over D2.

- 3.3 The appellant argued that document D3 (**WO 2007/003331 A1**) anticipated the subject-matter of claim 1 as granted. Since the bar portions follow paths having different lengths depending on which rotating cylinder they are conveyed to, the stop positions of the bar portions within the grooves

belonging to the different rotating cylinders T1, T2 or T3 were at least implicitly different. Moreover, the bar portions are received in the rotating cylinders at different speeds.

3.3.1 The board disagrees. As correctly found by the opposition division, D3 is silent about the stop positions of the bar portions in the grooves or housings of the first or at least second rotating cylinder. The fact that these positions could possibly be different does not result in that they are directly and unambiguously disclosed as different. Furthermore, as correctly pointed out by the respondent in point 5.1.3 of the reply to the statement setting out the grounds of appeal, D3 is not directed to the stop positions of the bar portions but rather to the braking and discharging of these bar portions. The braking system is adapted depending on the characteristics of the incoming bars, but not depending on the rotating cylinder they are directed to. The board thus concludes that D3 does not anticipate at least features a) and b) of claim 1 as granted.

3.4 In summary, the board concludes that the appellant has not convincingly demonstrated the incorrectness of the finding of the opposition division, that the subject-matter of claim 1 as granted is novel.

4. *Patent as granted - Inventive step, Articles 100(a) and 56 EPC*

4.1 The appellant argued that the subject-matter of claim 1 as granted was obvious starting from **D1 as closest prior art in combination with the teaching of either D2 or D3.**

4.2 The appellant further argued that the subject-matter of claim 1 as granted was obvious in view of **D1 alone**, namely because both D1 and the patent in suit avoided overlap of the bar portions on the cooling plate. The subject-matter of claim 1 was merely an obvious alternative to D1.

4.2.1 The board disagrees and is convinced by the finding of the opposition division that the patent in suit is not a mere alternative to the D1 arrangement. Indeed, claim 1 as granted in its whole requires that each speed changing device is directed to one rotating cylinder. This enables that each speed changing device can be driven at only one speed value which depends only on the rotating cylinder they are directed to, which results in a simpler control of the method. In contrast, the arrangement of D1 departs from the fundamental idea of delivering a flexible production by enabling different stop positions in the same rotatory device, for which more flexible speed changing devices and a more complicated control is required. For the sake of completeness, the speed changing devices of D3 are also flexible ones that depend on the incoming bar parameters and not on the rotating cylinder they are directed to, so that D3 can also not teach this solution.

4.2.2 In summary, the board is convinced that starting from D1 as closest prior art the skilled person would have no motivation to depart from the fundamental gist of providing a flexible production method and would therefore only arrive at the subject-matter of claim 1 as granted as a result of an *ex post facto* analysis. In addition, the board notes that even a forced combination of D1 with the teachings of D2 or D3 cannot

result in the subject-matter of claim 1 as granted, since feature b) would still be missing.

4.3 In consequence, the board concludes that the appellant has not convincingly demonstrated the incorrectness of the finding of the opposition division, that the subject-matter of claim 1 as granted is inventive.

5. *Conclusion*

In view of the above considerations, the board concludes that the appellant has not admissibly and/or convincingly demonstrated the incorrectness of the reasoned finding of the decision under appeal, that none of the grounds for opposition under Article 100 EPC prejudices the maintenance of the patent as granted. The appeal is thus to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Nachtigall

E. Mille

Decision electronically authenticated