



Europäisches Patentamt  
Beschwerdekammern

European Patent Office  
Boards of Appeal

Office européen des brevets  
Chambres de recours

Veröffentlichung im Amtsblatt	<input checked="" type="checkbox"/> Ja/Nein
Publication in the Official Journal	<input checked="" type="checkbox"/> Yes/No
Publication au Journal Officiel	<input checked="" type="checkbox"/> Oui/Non

Aktenzeichen / Case Number / N° du recours : T 116/84

Anmeldenummer / Filing No / N° de la demande : 8090050.8

Publikations-Nr. / Publication No / N° de la publication : 0034143

Bezeichnung der Erfindung: A rotary cutterhead for an earth boring machine

Title of invention:

Titre de l'invention :

## ENTSCHEIDUNG / DECISION

vom / of / du 28 November 1984

Anmelder/Patentinhaber:

Applicant/Proprietor of the patent: The Robbins Company

Demandeur/Titulaire du brevet :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Article 54(3), 88(3)

"State of the art" - "Priority right"

Leitsatz / Headnote / Sommaire

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number: T 116 / 84

**DECISION**  
**of the Technical Board of Appeal 3.2.1**  
**of 28 November 1984**

**Appellant:** The Robbins Company  
650 South Orcas Street  
Seattle, WA 98108  
U S A

**Representative:** Iain Cameron Baillie  
c/o Ladas & Parry  
Isartorplatz 5  
D-8000 München 2

**Decision under appeal:** Decision of Examining Division 114 of the European Patent  
Office dated 15 December 1983 refusing European patent  
application No 80900050.8 pursuant to Article 97(1)  
EPC

**Composition of the Board:**

**Chairman:** G. Andersson

**Member:** C. Maus

**Member:** P. Ford

Summary of Facts and Submissions

- I. European patent application No. 80 900 050.8, filed on 14 August 1979 as international application No. PCT/US 79/00605 and published under international publication No. WO 81/00590, was refused by the decision of the Examining Division 114 dated 15 December 1983.

The decision was based on Claims 1 to 10 received on 18 September 1981.

- II. In the decision, the Examining Division stated that the subject-matter of the independent Claims 1 and 6 lacks novelty having regard to European patent application No. 79 901 428.7, claiming priority from US patent application No. 009 170 and, therefore, constituting part of the state of the art under Articles 54(3), 89 and 150(3) EPC.
- III. On 15 February 1984, the appellants lodged an appeal against this decision paying the fee for the appeal at the same time. The statement setting out the grounds of appeal was received on 16 April 1984.

The appellants requested in the notice of appeal that the decision should be set aside in its entirety. Furthermore, they requested that the appeal fee should be reimbursed.

- IV. The appellants were of the opinion that any priority claim in the cited application No. 79 901 428.7 was not valid as far as it concerned the invention of the present application. The only subject-matter in the cited application which was entitled to priority from

US application No. 009 170 was the additional structure added to the main frame of cutterhead, including face support ring members.

Claims 1 and 6 read as follows:

"1. A main frame for a rotary cutterhead of an earth boring machine, said main frame characterized by an annular beam (60) by which the cutterhead (20) is mounted onto the earth boring machine for rotation about an axis of rotation; a central hub structure (32) disposed forwardly of the annular beam (60); and a plurality of radial spoke beams (48) having inner ends integrally connected to the hub structure (32), intermediate portions extending rearwardly and radially outwardly from the hub structure (32) to the annular beam (60) and outer ends which are integrally connected with the annular beam (60) to thereby form the main frame in a generally dome shape, each of said radial spoke beams (48) having side portions (50, 52) defining an elongate opening extending through and substantially along the entire length of said beam (48)."

"6. A rotary cutterhead for an earth boring machine characterized by a main frame having an annular beam (60) by which the cutterhead (20) is mounted on an earth boring machine for rotation about an axis of rotation; a central hub structure (32) disposed forwardly of the annular beam (60) and having a central opening (47); a plurality of radial spoke beams (48) having inner ends which are integrally connected to the hub structure (32) and outer ends which are integrally connected to the annular beam (60), each of the radial spoke beams (48) including side portions defining an elongate opening extending through and along substantially the entire length of the radial spoke beam (48); roller cutter mounts (99) within the radial spoke beams (48), the cutter mounts (99) having wall

members (100, 102) which extend transversely of the radial spoke beams (48) to span across the radial spoke beam opening to form cutter compartments and to reinforce the radial spoke beams (48); wherein the cutter mounts (99) are adapted for installation and removal of roller cutters (26, 30) from the rear side of the cutterhead; and wherein the main frame is configured to provide an interior space (IS) for a workman which is large enough to provide room for installation and removal of the roller cutters (26, 30) from behind the cutterhead (20)."

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC; it is, therefore, admissible.
2. The statements of the appellants in their statement setting out the grounds of appeal justify the Board to point out the following:

The European Patent Organisation is not a party to the Paris Convention. The rights on the subject of claiming priority, which is valid according to Article 150 (3) EPC also for an international application for which the EPO acts as designated Office or selected Office, are governed by the provisions of Articles 87 to 89 and Rule 38 EPC. They form a complete, self-contained, code of rules of this law (cf. Decision T 15/80 - Official Journal EPO 7/1981, 213). It follows from these Articles that the right of priority has the effect that the date of priority shall count as the date of filing of the European patent application for the purpose of Article 54(3) EPC. According to Article 88(3) EPC the priority date is valid only to that extent in which the prior application or applications coincide with the content of the subsequent European patent application as filed, i.e. in case the original content of the subsequent European application comprises more subject-matter than the prior application, the priority of the prior application is not valid for a claim comprising additional matter.

Contrary to the opinion of the appellants it is, therefore, without importance as to whether features of the invention disclosed in the prior application are mentioned in an earlier application whose priority

is not claimed in the prior application. As is stipulated in Article 88(3) EPC, the only question to be examined is whether or not those features of the subsequent European patent application for which protection is sought in the later application are included in the application or applications whose priority is claimed.

3. The examination of the prior US patent application No. 009 170 whose priority is claimed in the cited European application No. 79 901 428.7 produces the following result:

3.1 The main frame for the cutterhead disclosed in the aforesaid US application comprises as the subject-matter of European patent application No. 79 901 428.7 the following features for which protection is sought also in present Claim 1:

- (a) an annular beam by which the cutterhead is mounted on the earth boring machine for rotation about an axis of rotation,
- (b) a central hub structure disposed forwardly of the annular beam and
- (c) a plurality of radial spoke beams having inner ends integrally connected to the hub structure, intermediate portions extending rearwardly and radially outwardly from the hub structure to the annular beam and outer ends which are integrally connected with the annular beam to thereby form the main frame in a generally dome shape, each of

said radial spoke beams having side portions defining an elongate opening extending through and substantially along the entire length of said beam (cf. particularly pages 7 and 13 of the copy of priority document).

With regard to those features the priority is, therefore, claimed validly.

3.2 However, the main frame according to the prior US application No. 009 170 and its subsequent European application No. 79 901 428.7 comprises additionally a plurality of face-support ring members which are radially spaced apart and are also located on the main frame (cf. pages 5,8,23 and the claims of the priority document and pages 4, 8, 15, 16 and Claims 1, 19 and 35 of European patent application No. 79 901 428 7). It follows from the whole content of the prior application and its subsequent application that this feature is as such an essential element of the invention according to these applications. Therefore, it is impossible to omit the feature "face-support ring member" without falling outside the scope of the prior invention.

3.3 Hence, it follows that the subject-matter of present Claim 1 differs from the main frame which must be considered as comprised in the state of the art according to Article 54(3) EPC by the fact that the radial spoke beams are connected together only by the annular beam on the one hand and by the central hub structure on the other hand.



- 3.4 The main frame according to Claim 1 is, therefore, novel having regard to the prior European application No. 79 901 428.7.
- 3.5 Furthermore, those features of the rotary cutterhead according to European application No. 79 901 428.7 which are mentioned in the present independent Claim 6 are likewise in the prior US patent application No. 009 170. Considering that the appellants have not disputed this fact, the Board deems it not necessary to give the reasons in detail.

From the statements made in paragraph 2, it follows that the priority is also validly claimed in respect of these features.

However, the rotary cutterhead according to the prior European patent application No. 79 901 428.7 comprises in any case also the aforesaid radially spaced apart face- support ring members.

The subject-matter of Claim 6 is, therefore, also novel having regard to the prior European application No. 79 901 428.7.

4. The Examining Division was of the opinion that the subject-matter of Claims 1 and 6 lacked novelty. Consequently, it has not yet examined whether or not the main frame according to a Claim 1 and the rotary cutterhead according to a Claim 6, whose characterising portion states the feature mentioned in paragraph 3.3, involve an inventive step. Under these circumstances, the Board deems it inappropriate to decide this issue, but makes use of the power, given to it by Article 111(1) EPC, to remit the case to the Examining

Division for further prosecution.

5. In seeking to justify their request for reimbursement of appeal fee, the appellants submitted that the Examining Division had not considered at all the earlier US patent application No. 931 384, when assessing the state of the art according to Article 54(3) EPC. The certified copy of US priority document 009 170 contained a specific cross-reference to this prior filed application.

It follows from what has been said in paragraph 2 that there was no occasion for the Examining Division to consider also US patent application No. 931 384 when it examined the problem as to whether or not the content of European patent application No. 79 901 428.7 as filed should be considered as comprised in the state of the art. A substantial procedural violation by reason of which the reimbursement would be equitable does not, therefore, exist.

Order

For these reasons,

it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.
3. The request to reimburse the appeal fee is refused.

signed: B.A. Norman

signed: G. Andersson