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Aktenzeichen / Case Number / N^o du recours : T 331/87 - 3.2.2

Anmeldenummer / Filing No / N^o de la demande : 79 103 198.2

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 008 773

Bezeichnung der Erfindung: Punch press with laser cutting head attachment
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : B21D 28/24, B23K 26/00

ENTSCHEIDUNG / DECISION

vom / of / du 6 July 1989

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Houdaille Industries, Inc.

Einsprechender / Opponent / Opposant :

Voest-Alpine Aktiengesellschaft

Stichwort / Headword / Référence : "Removal of feature/HOUDAILLE"

EPU / EPC / CBE Article 100(c) and 123(2)

Schlagwort / Keyword / Mot clé :

"Amendment during prosecution - Deletion of
inessential feature allowed"

Leitsatz / Headnote / Sommaire

The replacement or removal of a feature from a claim may not violate Article 123(2) EPC provided the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it is not, as such, indispensable for the function of the invention in the light of the technical problem it serves to solve, and (3) the replacement or removal requires no real modification of other features to compensate for the change. (cf. point 6 of the Reasons; following the decision in Case T 260/85, OJ EPO 1989, 105)

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Chambres de recours



Case Number : T 331/87 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 6 July 1989

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Decision under appeal : Decision of Opposition Division of the European Patent
Office dated 25 June 1987 revoking European patent
No. 8 773 pursuant to Article 102(1) EPC.

Composition of the Board :

Chairman : G. Szabo
Members : H. Seidenschwarz
O. Bossung

Summary of Facts and Submissions

- I. European patent No. 0 008 773 comprising ten claims was granted to the Appellant on 20 October 1982 in response to European patent application No. 79 103 198.2 filed on 29 August 1979.
- II. Claim 1 as granted reads as follows:

"A machine tool punch press (10) having a frame (12), frame carried upper and lower spaced tool holders (13) respectively carrying punch tools and die tools, frame carried, vertically reciprocatable punch ram stations for operation at a work station (23), a worktable (11) extending outwardly from adjacent the lower tool holder at least to the sides and front thereof, having at least a stationary portion (11a) adjacent the lower tool holder (13), the stationary portion (11a) aligned with the work station (23) and spaced to a side thereof, a central automatic control (18) controlling the tool holders (13) and punch ram and further controlling a workpiece movement assembly (14) effective to move a workpiece (W.P.) with respect to at least the stationary portion (11a) of the worktable (11) and the work station (23) and having a further means for cutting large areas of the workpiece, characterised in that the said further means is constituted by a vertically movable laser cutting head (17) carried in fixed horizontal relationship to the frame (12), the work station (23) and the stationary portion (11a) of the worktable (11), the cutting head (17) including a hollow tip (52) adjacent the bottom thereof, and a beam focusing optical means (54) vertically movable with the cutting head (17), a laser beam generator (15), the laser beam generator being spaced and vibration isolated from the remainder of the machine tool punch

press (10) such that substantially no vibration of the machine tool punch press is transmitted to the beam generator (15), an optical beam pathway (16) interconnecting the cutting head (17) and the laser beam generator (15), a control means (18a,18b) for alternatively controlling punching operation and laser operation from said central automatic control (18)" (emphasis is added).

- III. Opposition was filed by the Respondent requesting the revocation of the patent on grounds of Article 100(c).
- IV. After considering the Grounds for Opposition, the Opposition Division informed the parties at the conclusion of the oral proceedings of 23 September 1986 that the patent can only be maintained on the basis of Claim 1 according to the subsidiary request filed by the Appellant with the letter of 18 July 1985. The corresponding communication pursuant to Rule 58(4) EPC has been dispatched on 14 November 1986.

As the Appellant did not approve the text in which the Opposition Division intended to maintain the patent, the Opposition Division revoked the patent on the grounds that Claim 1 according to the main request (also filed with the letter of 18 July 1985) did not satisfy the requirements of Article 100(c) EPC. The grounds for the decision were dispatched on 25 June 1987.

- V. On 24 August 1987, the Appellant filed an appeal against the decision, paying the appropriate fee simultaneously. In his Statement of Ground, filed on 15 October 1987, he requested the maintenance of the patent on the basis of the Claims 1 according to the "main request" or "subsidiary request" respectively as filed with the letter of 18 July 1985 during the opposition procedure.

The Appellant set out that the claim broadened during prosecution was supported by the specification as originally filed in that this claim itself was not contrary to anything in the specification. Therefore, it was possible to broaden Claim 1 after filing or after receiving the search report by dropping a limitation which is clearly not necessary for the invention and its patentability. Further, it could not be derived from the European Patent Convention that it was prohibited to amend a main claim by dropping a feature which was not necessary.

- VI. In his letter of 29 March 1988 the Respondent contested the arguments of the Appellant and was of the opinion that the application as filed only disclosed that the laser cutting head is "carried by the main frame". The original documents would not contain any hints that the laser cutting head could be mounted somewhere other than on to the main frame.
- VII. An oral proceedings took place on 6 July 1989.
- (i) Nobody was present on behalf of the Respondent, who had been duly summoned pursuant to Rule 71(1) EPC. The proceedings, therefore, have been continued without him (Rule 71(2) EPC).
 - (ii) In the oral proceedings the German language was used in accordance with Rule 2(4) EPC.
 - (iii) The Appellant specified his arguments in the sense that the feature, namely the laser cutting head "carried by the main frame", was of no relevance to the problem to be solved. Having regard to this problem it was only important to ensure the position of the laser cutting head

in relation to the place where it was thought to carry out its operation. Reading the application as filed the person skilled in the art would realise that the embodiment described in the application is only one way of carrying out the invention. It was clearly implied that the only essential requirement with respect to the frame was that the cutting head should be in a fixed horizontal relationship to it. Further, it would be evident to him that the punching and the cutting tools do not need to be part of one single machine, but that it is essential to control their functions from a central automatic control to reduce the necessity of workpiece handling between the operations of the tools. To simplify the position the Appellant abandoned his earlier requests based on amended claims and relied on Claim 1 as granted.

- (iv) The Appellant, therefore, requested that the decision under appeal be set aside and that the opposition be rejected.

- (v) According to his letter of 29 March 1988 the Respondent requests rejection of the appeal.

Reasons for the Decision

1. The appeal is admissible.

2. Claim 1 as granted differs mainly from Claim 1 as originally filed by omitting the feature "... laser cutting head carried by the main frame" and replacing it by the feature "... laser cutting head (17) carried in fixed horizontal relationship to the frame (12)".

It is the excision of the feature concerning the attachment of the cutting head to the frame, which was considered by the impugned decision to contravene Article 123(2) EPC, because it allegedly extended the subject-matter of the application of the European patent beyond the content of this application as filed.

3. For the determination whether an amendment of a claim does or does not extend beyond the subject-matter of the application as filed, it is necessary to examine if the overall change in the content of the application originating from this amendment (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art in what has been expressly mentioned (Guidelines, Part C, Chapter VI, No. 5.4). In other words, it is to examine whether the claim as amended is supported by the description as filed.
4. In the decision T 260/85 ("Coaxial connector/AMP, OJ EPO, 1989, 105) the Board of Appeal 3.5.1 came to the conclusion that "it is not permissible to delete from a claim a feature which the application as originally filed consistently presents as being an essential feature of the invention, since this would constitute a violation of Article 123(2) EPC" (cf. Point 12 and Headnote). In that case the application as originally filed contained no express or implied disclosure that a certain feature ("air space") could be omitted. On the contrary, the reasons for its presence were repeatedly emphasised in the specification. It would not have been possible to recognise the possibility of omitting the feature in question from the application (Point 8). It could be recognised from the

facts that the necessity for the feature was associated with a web of statements and explanations in the specification, and that its removal would have required amendments to adjust the disclosure and some of the other features in the case.

5. Nevertheless it is also apparent that in other, perhaps less complicated technical situations, the omission of a feature and thereby the broadening of the scope of the claim may be permissible provided the skilled person could recognise that the problem solving effect could still be obtained without it (e.g. T 151/84 - 3.4.1 of 28 August 1987, unreported). As to the critical question of essentiality in this respect, this is a matter of given feasibility of removal or replacement, as well as the manner of disclosure by the applicant.

6. It is the view of the Board that the replacement or removal of a feature from a claim may not violate Article 123(2) EPC provided the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it is not, as such, indispensable for the function of the invention in the light of the technical problem it serves to solve, and (3) the replacement or removal requires no real modification of other features to compensate for the change (following the decision in Case T 260/85 ...). The feature in question may be inessential even if it was incidentally but consistently presented in combination with other features of the invention. Any replacement by another feature must, of course, be examined for support in the usual manner (cf. Guidelines, Part C, Chapter VI, No. 5.4) with regard to added matter.

7. It is therefore necessary to examine whether the person skilled in the art reading the application as filed would

consider the feature "carried by the main frame" in respect of the cutting head as essential or not to the function of the machine as described in the application.

- 7.1 From US-A-4 063 059 being the prior art coming closest to the subject-matter of Claim 1 it is known to equip an automatic machine tool punch press with a plasma-arc torch which is able to cut large and/or irregularly shaped holes in the workpiece to be treated. Such cutting torches have the disadvantage that they cause relatively large kirfs, ragged edges and large heat distort areas adjacent to the cut: cf. application as filed, page 2, lines 4 to 10.
- 7.2 It is also generally known to utilise laser beam cutting machines for cutting large holes in workpieces without the aforementioned disadvantages. In addition laser beam cutting machines can be used as devices which permit surface marking of workpieces of a precisely predetermined position. However, as the laser beam generators are highly sensitive to shocks and vibrations such laser beam cutting machines are not yet combined in operation with a machine tool punch press which is subjected to pounding vibrations during punching operations: cf. application as filed, page 2, line 11 to page 3, line 1.
- 7.3 According to the application as filed (page 3, lines 2 to 8); "it would represent a major advance in the art of machine tools to provide a single machine tool capable of high speed, high accuracy workpiece punching, cutting and surface marking wherein all functions are controllable from a central automatic control and wherein workpiece movement is accomplished by a single mechanism so as to eliminate the necessity of workpiece handling between operations".

During the oral proceeding the Appellant explained that the term "single" machine tool would stand for a unit consisting of individual devices being controlled from one central control.

This interpretation corresponds to the object of the invention as specified in the application as filed (page 3, lines 11 to 15): "to provide a combined automatic turret punching machine tool and automatic laser cutting tool wherein both the punching tool and the cutting tool share a common control and a common workpiece movement system".

7.4 Having in mind this problem and knowing the advantages and disadvantages of a laser beam cutting machine (see above 7.2) it is clear to the person skilled in the art that for the solution of the problem it is necessary

- to position the laser beam generator independently from the machine tool punch press,
- to position the laser cutting head in a fixed horizontal relationship to the punch tools, and
- to provide control means for alternatively controlling punching and laser operations.

Only when these conditions are fulfilled, is the laser beam generator not affected by the jarring vibratory operation of the machine tool punch press and the laser cutting head can share the automatic control and the workpiece movement assembly of the machine tool punch press.

7.5 From this it results, without being mentioned expressis verbis in the application as filed, that the embodiment of

the invention as described in the original application, namely the cutting head being mounted to the mainframe or being carried by the main frame, only represents an advantageous embodiment of the invention. The disclosure never emphasised the strict necessity of this particular solution. Specific embodiment is not indispensable to the function of the invention. The removal of this from Claim 1 does not require any modification of the other features of the invention. Only the requirement for horizontal fixing in relation to the frame enters in lieu of the excised feature itself. Therefore, the excision of the feature "carried by the main frame" by replacing it by a feature being essential to the solution of the abovementioned problem does not contravene Article 123(2) EPC.

8. Since novelty and inventive step have never been disputed by the Respondent, there is no need to give in this decision reasons in detail.

9. Consequently, the Grounds for Opposition mentioned in Article 100 EPC do not prejudice the maintenance of the patent unamended.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The opposition is rejected.

The Registrar:

The Chairman:

S. Fabiani

G. Szabo