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**Datasheet for the decision
of 10 April 2013**

Case Number: T 1008/10 - 3.2.06
Application Number: 03720852.7
Publication Number: 1608484
IPC: B23Q16/10, B23Q7/02, B23B3/16
Language of the proceedings: EN

Title of invention:
TOOL-HOLDER TURRET

Patent Proprietor:
DIPLOMATIC AUTOMATION S.R.L.

Opponents:
Sauter Feinmechanik GmbH
EMAG Holding GmbH

Relevant legal provisions:
EPC 1973 Art. 54(2)
EPC Art. 123(2)
EPC R. 22, 85
RPBA Art. 12(4)

Keyword:
Admissibility of appeal - yes
Novelty (main request, first and second auxiliary requests) -
no
Admittance into the proceedings (third auxiliary request) - no



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1008/10 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 10 April 2013

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 27 April 2010
revoking European patent No. 1608484 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: M. Harrison
Members: G. Kadner
K. Garnett

Summary of Facts and Submissions

- I. The mention of grant of European patent No. 1 608 484, on the basis of European patent application No. 03720852.7 filed on 1 April 2003, was published on 24 December 2008.
- II. Two notices of opposition, in which revocation of the patent on the grounds of Article 100(a) EPC was requested, were filed against the granted patent.
- III. The proprietor did not file any response to the notices of opposition and the only relevant requests in the proceedings before the opposition division were those of the opponents for revocation of the patent. By way of its decision posted on 27 April 2010, the opposition division revoked the patent. The opposition division concluded that the subject-matter of claim 1 as granted lacked novelty when compared with the disclosure of:
- D1: DE-A-197 19 173.
- Also cited in the decision under appeal were:
- D3: DE-U-89 15 600; and
- D6: US-A-5 664 479 (a patent family member of D1)
- IV. Notice of appeal was filed against this decision by the appellant (patentee) on 11 May 2010, and the appeal fee was paid on the same day. The appellant filed its grounds of appeal on 12 August 2010 and pursued its request for maintenance of the patent with a main request and three auxiliary requests.

V. Claim 1 as granted (main request) reads as follows:

"A tool-holder turret of the type comprising a stationary base body (1) having a cavity(2) which extends along a longitudinal axis (X-X), a tool-holder disk (3, 3a) which can rotate with respect to the stationary base body about an axis of rotation which is coaxial with and coincides with the said longitudinal axis (X-X), immobilising means (11a) to immobilise and release the said tool-holder disk (3) in relation to the said stationary base body (1), a first tubular member (12) acting on the said immobilising means (11a) which can be moved axially between a first position in which the tool-holder disk (3) is immobilised on the stationary base body (1) and a second position in which the tool-holder disk (3) is released, actuator means (12a) to move the said first tubular member (12) between the said positions in which the turret is immobilised and released, control means (14, 17, 21) to move the said tool-holder disk (3) between working positions which are spaced angularly apart about the said longitudinal axis, the said control means to move the tool-holder disk between the working positions comprising a second tubular member (21) with an axial cavity (22) which is open at both ends (23, 24) positioned concentrically with the said longitudinal axis (X-X) within the said first tubular member (12), characterized in that the second tubular member (21) is at one end (23) coaxially connected to the said tool-holder disk (3) and at the other end (24) coaxially connected to the rotor (17) of an electric motor (14), the said motor being provided with a through axial cavity (18), the connections (25, 26) being made rigidly at both ends with respect to both axial and rotational movement."

VI. Claim 1 of the first auxiliary request is based on claim 1 of the main request, the following text being added at the end:

"... the rotor (17) of the said electric motor (14) is positioned radially within the stator and the said through axial cavity is made in the rotor of the motor."

VII. Claim 1 of the second auxiliary request is based on claim 1 of the first auxiliary request, the following text being added at the end:

"... and the electric motor has a casing axially secured to the base body and stationary together with the base body and the stator of the electric motor is fixed to the casing."

VIII. Claim 1 of the third auxiliary request is again based on claim 1 of the main request, the following text being added at the end:

"... the axial cavity (22) of the said second tubular member (21) is defined by a circular crown having a predetermined constant radial thickness (S) throughout the axial extent of the said tubular member."

IX. The arguments of the appellant submitted with the grounds of appeal can be summarized as follows:

- a) The amendments made to claim 1 of each request should be allowed. Claim 1 of the main request was the same as granted claim 1. In claim 1 of the first auxiliary request granted claims 1 and 8 had been combined. In claim 1 of the second auxiliary request further features as disclosed in the

description had been added. Claim 1 of the third auxiliary request was a combination of granted claims 1 and 5.

- b) As regards novelty of the subject matter of claim 1 of the main request over D1, the second tubular member (44, 45 in D1) was not positioned within the first tubular member (50 in D1), because it did not have a tubular form, and parts 22, 44 of the second tubular member were outside the first tubular member 50; claim 1 meant that all of the second tubular member was within the first tubular member. Because of these distinguishing features, claim 1 was novel over D1.

- c) In D1 the connection between the second tubular member 45 and the rotor 92 of the electric motor was not made rigidly with respect to both axial and radial movements since the rotor had a flexure section 101 to which the second tubular member was fixed by bolts. This was a further distinguishing feature.

- d) As regards novelty of the subject matter of claim 1 of the main request over D3, in D3 only one shaft 1 extended from a front end, where it was connected to the tool holder disk 2, to a rear free end, where it was not connected to any element. The rear end of the rotor was not connected to the rotor 14, and consequently the second tubular member 1 was not connected to the rotor, thus being distinguished from claim 1 by that feature.

- e) As regards the auxiliary requests, the feature added to claim 1 of the first auxiliary request was not disclosed in D1 because there the rotor 92 was positioned outside the stator 90 of the electric motor. The further feature added to claim 1 of the second auxiliary request was also not present in D1. The feature added to claim 1 of the third auxiliary request, that the axial cavity of the second tubular member was defined by a circular crown having a predetermined constant radial thickness throughout the extent of the tubular member, was nowhere disclosed in the prior art.

- f) As regards inventive step, when starting from the specific arrangement disclosed in D1 having a flexible connection between member T and the rotor 92, the skilled person would never have arrived at the claimed solution. The skilled person would also not have combined D1 with D3 since D3 dealt with a rotor-stator-arrangement which was quite different from that of D1.

- g) Each claim 1 according to the auxiliary requests was more restricted than that of the main request. The added features contributed to the claimed invention in an advantageous manner and were not disclosed in the cited prior art. Therefore they involved an inventive step.

X. In the response dated 18 November 2010 Respondent I argued that no reasons had been brought forward by the appellant which addressed the decision of the opposition division. In any event, the subject matter of claim 1 of the main request lacked novelty over D1, and the subject matter of claim 1 of each of the

auxiliary requests lacked inventive step over a combination of D1 and D3.

XI. In its reply dated 21 March 2011 Respondent II argued that the subject matter of claim 1 of the main request lacked novelty over both D1 and D3. Even then, the subject matter lacked inventive step, as did the subject matter of the auxiliary requests.

XII. In a communication accompanying the summons to oral proceedings, the Board expressed its preliminary view inter alia as follows (only the points relevant for the final decision are mentioned here):

a) With respect to the main request, it would need to be discussed whether the appellant's argument was correct that the characterising feature:

"that the second tubular member (21) is ... at the other end (24) coaxially connected to the rotor (17) of an electric motor (14), ... the connections (25, 26) being made rigidly at both ends with respect to both axial and radial movement"

was not disclosed in D1/D6. It was correct that D1 (col. 5, starting at line 13) states that:

"Die Schaftverlängerung 45 weist einen elastischen oder biegsamen Abschnitt 101 auf ..." (the corresponding portion in D6 (col. 4, lines 33 to 36) states "The shaft extension 45 has a flexure section 101. The flexure plate 94 and the flexure section 101 are made of strong flexibly resistant material").

However, claim 1 of the main request states that it is the "connections" which are "made rigidly" at both ends with respect to both axial and radial movement. The connection at the motor end is formed by the bolts (see e.g. the Figure - no reference numeral) which attach the outermost ends of the second tubular member (45, 22) to the rotor 92. The connection formed at that end gives no axial or rotational movement possibility, even though it could be accepted that the second member itself was able to flex in its thinner portion 101 located radially inwardly of the connections. This feature of claim 1 thus appeared to be disclosed in D1.

- b) The further feature argued by the appellant as not being disclosed in D1/D6 also appeared to be disclosed therein, because in D1/D6 the second tubular member 22, 45 was arranged radially within the first tubular member 50. The interpretation made by the appellant as regards the meaning of "tubular member" was not considered persuasive and also did not seemingly correspond to what was shown in the patent itself.
- c) The Board also added that, with regard to D3, which disclosed all other features of the claim, the feature discussed above (*under item (a)*) (which was the only feature argued by the appellant as not being disclosed in D3) in fact seemed to be present, whereby D3 was also prejudicial to the novelty of the subject-matter of claim 1.
- d) The Board noted that the appellant argued that, since D3 disclosed a one-piece shaft 1, there was

no (rigid) connection between the second tubular member and the rotor of an electric motor. It appeared to the Board that a skilled person would recognize that in D3 the upper part of the shaft 1 (i.e. to the right in the Figure) bearing the rotor 14 was the end belonging to the electric motor, and the lower part of the shaft (i.e. to the left in the Figure) was the end belonging to the immobilising arrangement 8, 9, 10, 11. Thus the end of that lower part of the shaft was seemingly rigidly connected to the rotor 14 of electric motor 13.

- e) In relation to the first auxiliary request, the feature added to granted claim 1 also seemed to be disclosed in at least D3. The rotor 14 (together with its shaft) was positioned within the stator 15 and had a "through axial cavity".
- f) Concerning the second auxiliary request, the Board pointed out that the wording of the added feature deviated from the text disclosed in paragraphs [0025] and [0026] of the originally filed application, particularly in that words "the inside of housing 15 represents an extension of cavity 2 of the stationary body ..." were omitted, thus seemingly leading to an inadmissible intermediate generalisation of the content of the application as originally filed, contrary to Article 123(2) EPC.
- g) In any event, since the skilled person was well aware that the upper (right) part of one-piece housing 5 in D3 belonged to the electric motor 13, and the lower (left) part was the casing or the base body containing the immobilising arrangement

8, 9, 10, 11, which were axially secured to one another, the features taken from the description were also seemingly disclosed in D3 (Article 54(2) EPC).

- h) With respect to the third auxiliary request, the Board noted that, as was also the case with the other auxiliary requests, no auxiliary requests had been filed during the proceedings before the department of first instance, and indeed no response at all had been filed to the notices of opposition within the time provided for by the Office's communication dated 29 October 2009. It appeared that the appellant could have presented these requests in those proceedings, for example in a written submission. A first matter to be resolved might therefore be whether the Board should exercise its power under Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA) not to admit this (and indeed the other) auxiliary requests into the appeal proceedings.
- i) It also appeared that this request did not form, with the other auxiliary requests, a coherent set of requests since claim 1 no longer contained the limitations introduced into the first and second auxiliary requests. The request also seemed to relate to subject matter which was entirely unrelated to the preceding requests. This would be another matter for consideration on the issue of whether or not to admit such a request into the appeal proceedings.
- j) The newly introduced feature of granted claim 5 seemed anyway to be clearly and unambiguously

disclosed, at least implicitly, in the arrangement disclosed in D3 (Article 54(2) EPC).

- XIII. The appellant did not reply substantively to that communication, but instead withdrew its request for oral proceedings with its letter dated 8 March 2013, and informed the Board with letter dated 12 March 2013 that it would not attend the oral proceedings.
- XIV. With letter dated 11 March 2013 respondent II objected to the admissibility of the appeal for the first time. It asserted that the appeal was not admissible because it had been filed by Duplomatic Automazione S.R.L. whereas the patent had been granted to Duplomatic Automazione S.P.A., which was the party to the opposition proceedings. These were different legal entities, and the change of ownership of the patent during opposition proceedings did not entitle the new entity to be a party to the proceedings.
- XV. As regards the identity of the proprietor / appellant, the file in fact shows that on 19 November 2009 the patentee filed a request for transfer of the patent from Duplomatic Automazione S.P.A. to Duplomatic Automation S.R.L. This was duly recorded by the EPO in the register with legal effect as of 19 November 2009. The change was communicated to the parties by communication dated 7 December 2009. The decision of the Opposition Division was made against Duplomatic Automation S.R.L. as proprietor. The notice of appeal and the statement of grounds of appeal were both filed in the name of Duplomatic Automation S.R.L.
- XVI. On 19 March 2013 Respondent II submitted by facsimile transmission that oral proceedings did not need to be held should the Board intend to reject the appeal.

XVII. On 28 March 2013 the parties were informed that the oral proceedings scheduled for 10 April 2013 had been cancelled.

XVIII. The appellant (patentee) requested in writing that the decision under appeal be set aside and the oppositions be rejected or that the European patent be maintained on the basis of the first, second or third auxiliary requests.

Respondent I (opponent 01) requested in writing that the appeal be dismissed.

Respondent II (opponent 02) also requested in writing that the appeal be dismissed.

Reasons for the Decision

1. Admissibility of the appeal

As is stated in Rule 85 EPC, Rule 22 EPC applies to transfers of European patents for which an application for transfer has been made during opposition proceedings, i.e. the case here. After registration of the transfer (see point XV, *supra*) the new proprietor Duplomatic Automation S.R.L took the place of the original proprietor and was and is the only party entitled as proprietor to continue the proceedings, including performing the act of filing an appeal.

The argument of respondent II that the previously named proprietor and the new proprietor are different legal entities is correct but irrelevant. A transfer of rights from a proprietor to another legal entity is

precisely what is intended by a transfer registered according to Rules 22 and 85 EPC.

Since the appeal was filed on 11 May 2010, i.e. subsequent to the date when the transfer took legal effect (19 November 2009), the appeal was correctly filed in the name of Duplomatic Automation S.R.L.

Since no other argument has been made as to why the appeal should be found inadmissible and the Board also finds that all other requirements for an admissible appeal are fulfilled, the Board concludes that the appeal is admissible.

2. Main request (Article 54(2) EPC 1973)

2.1 In its communication, the Board opined in respect of novelty of the subject-matter of claim 1 that all features seemed to be disclosed in D1 as well as in D3 (see items XII (a) to (d) *supra*).

2.2 The appellant did not respond substantively to the Board's preliminary opinion. The Board finds no reason to alter its preliminary assessment, and the reasons given in the Board's communication as to why the appellant's arguments on novelty with respect to D1 and D3 appeared to be incorrect remain unaltered and are hereby confirmed.

For completeness, in respect of the appellant's argument that the wording of claim 1 means that "all" of the second tubular member is within the first tubular member, and that this does not correspond to D1, it may be added however that nothing in claim 1 requires that "all" of the second member must be within the first member. It is sufficient to meet the terms of

the claim that part of the second tubular member is within the first tubular member and in D1 a substantial part is indeed within the first tubular member (see e.g. Fig.1). An interpretation such that all of the second tubular member should be within the first tubular member also does not correspond with the embodiment shown in Figure 1 of the patent, where the lower end of the second tubular member includes a bolted connection whereby the lower portion of the parts forming the second tubular member lie radially outward of the first tubular member (see lower end of Figure 1 and Figure 5 in the patent).

Consequently the Board confirms its provisional opinion, and finds that the subject-matter of claim 1 lacks novelty with respect to the disclosure of both D1 and D3. The request is therefore not allowable.

3. First auxiliary request (Article 54(2) EPC 1973)

In its communication (see item XII (e) *supra*) the Board considered that the feature added to granted claim 1 appeared to be disclosed in D3. Since no counterargument has been provided which would justify an alteration of its preliminary opinion, and since the Board itself cannot find any reason to come to a different opinion, the Board confirms its provisional opinion and concludes that the subject-matter of claim 1 lacks novelty over D3.

The first auxiliary request is thus not allowable.

4. Second auxiliary request (Article 123(2) EPC)

4.1 In its communication (see items XII (f) and (g) *supra*) the Board pointed out that the added feature deviated

from the text disclosed in paragraphs [0025] and [0026] of the description, and appeared to lead to an inadmissible intermediate generalisation of the content of the application as originally filed, contrary to Article 123(2) EPC. No reaction to this statement was made by the appellant and the Board finds no reason of its own to alter its provisional opinion. The Board thus confirms its preliminary opinion that the amendment made results in subject-matter which contravenes Article 123(2) EPC.

The second auxiliary request is therefore not allowable.

5. Third auxiliary request (Article 12(4) RPBA)

5.1 In its communication (see item XII (h) *supra*) the Board raised the question as to whether it should exercise its power under Article 12(4) of the Rules of Procedure of the Boards of Appeal not to admit one or more of the auxiliary requests into the appeal proceedings. The Board further stated (see item XII (i) *supra*) that the request seemed to relate to subject-matter which was entirely unrelated to the preceding requests.

5.2 The newly introduced feature of claim 5 had not been in discussion before the opposition division. No reason has been given by the appellant as to why this request could not have been presented before the opposition division (see Article 12(4) RPBA) rather than being filed first with the grounds of appeal, nor can the Board itself find any reason why this request was not presented earlier. It also goes in a different direction to the preceding auxiliary requests and does not form part of a coherent set of requests since the limitations of the preceding requests have been

omitted. Also, the newly introduced feature does not *prima facie* overcome the Board's objection made in its communication of lack of novelty of the subject-matter of claim 1 (see item XII (j) *supra*). For these reasons, the Board exercised its power under Article 12(4) RPBA not to admit this request into the proceedings.

6. Since none of the appellant's requests on file is both admitted into proceedings and allowable, the decision revoking the patent has to be confirmed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. H. A. Patin

M. Harrison

Decision electronically authenticated