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Datasheet for the decision of 8 August 2019

Case Number: T 1886/15 - 3.2.08

Application Number: 05702268.3

Publication Number: 1706224

IPC: B21C47/30, B21C47/32

Language of the proceedings: EN

Title of invention:
DEVICE AND METHOD FOR FORMING COILS OF ROLLED OR DRAWN LONG PRODUCTS

Patent Proprietor:
DANIELI & C. OFFICINE MECCANICHE S.p.A.

Opponent:
SMS Meer S.p.A.

Headword:

Relevant legal provisions:
EPC 1973 Art. 54
RPBA Art. 13(1), 13(3)

Keyword:
Public prior use
Late-filed request

Decisions cited:

Catchword:

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Beschwerdekammern

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Case Number: T 1886/15 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 8 August 2019

Appellant: (Opponent)	SMS Meer S.p.A. Via Udine 103 33017 Tarcento (UD) (IT)
Representative:	Banchetti, Marina Barzanò & Zanardo Roma S.p.A. Via Piemonte 26 00187 Roma (IT)
Respondent: (Patent Proprietor)	DANIELI & C. OFFICINE MECCANICHE S.p.A. Via Nazionale, 41 33042 Buttrio (UD) (IT)
Representative:	Petraz, Gilberto Luigi GLP S.r.l. Viale Europa Unita, 171 33100 Udine (IT)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 3 July 2015 rejecting the opposition filed against European patent No. 1706224 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairwoman	P. Acton
Members:	M. Alvazzi Delfrate
	G. Decker

Summary of Facts and Submissions

I. The subject of the proceedings is the appeal of the opponent (appellant) against the decision of the opposition division posted on 3 July 2015, which rejected the opposition against the European patent No. 1706224.

II. At the end of the oral proceedings before the Board, held on 8 August 2019, the requests were as follows:

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

The respondent (patent proprietor) requested that the appeal be dismissed i.e. that the patent be maintained as granted or in the alternative that the patent be maintained on the basis of the auxiliary request submitted at the oral proceedings.

III. Claims 1 and 12 of the **main request** reads as follows:

"1. Device for coiling a windable long, metal product (10), comprising a mandrel (12) having a substantially circular transverse section and rotating around a horizontal, vertical or inclined axis, a containing element (13) to contain said metal product (10), arranged in correspondence with said mandrel (12) and substantially orthogonal to said axis, and at least a guide and containing device (15, 16) able to be driven between a first working position wherein it cooperates with said mandrel (12), and a second inactive position wherein it is arranged distant from said mandrel (12), wherein said containing element (13) comprises an annular channel (14) which is made in proximity with an outer surface of said mandrel (12) and is coaxial with

the axis of rotation of said mandrel (12), and wherein said guide and containing device (15, 16) comprises a groove (20) that is able to define an accompanying guide for said metal product (10) along an outer circumference of said mandrel (12) towards said annular channel (14) and coaxial with said annular channel (14), when said guide and containing device (15, 16) is in said first working position, characterized in that said containing element (13) comprises a flange (30), applied substantially perpendicularly to said mandrel (12) and shaped so as to have an annular tooth (31) substantially coaxial with said mandrel (12), said annular tooth (31) defining at the lower part said annular channel (14)."

"12. Method for coiling a long metal product (10), performed by means of a coiling device having the features of claim 1 and which comprises a mandrel (12) having a substantially circular transverse section and rotating around a horizontal, vertical or inclined axis, an [*sic*] containing element (13) to contain said metal product (10), arranged at one end of said mandrel (12) and substantially orthogonal to said axis, and at least a guide and containing device (15, 16), able to be driven between a first working position wherein it cooperates with said mandrel (12), and a second inactive position wherein it is arranged distant from said mandrel (12), characterized in that it comprises the following steps:
- a first step wherein a leading end of said metal product (10) is inserted into a groove (20) of said guide and containing device (15) arranged in said first working position to guide said metal product (10) along an outer circumference of said mandrel (12);
- a second step wherein said metal product (10) is guided by said groove (20) inside an annular channel

(14) made on said containing element (13) in proximity with an outer surface of said mandrel (12) and coaxially with said axis of rotation of said mandrel (12);
- a third step wherein an initial segment of said metal product (10) is gripped and clamped in said annular channel (14) by means of friction forces generated between said metal product (10) and the walls of said annular channel (14);
- a fourth step wherein said metal product (10) is wound onto said mandrel (12) for a pre-determined segment of length;
- a fifth step wherein said guide and containing device (15) is taken from said first working position to said second inactive position; and
- a sixth step wherein said metal product (10) is wound for the remainder of its length."

In the **auxiliary request** the product claims were deleted.

IV. The following documents were relevant for the present decision:

D4: SIMAC drawings 60.017.03, sheets 1/3-3/3, dated 26 August 2003;
D5: Minutes of inspection at Acciaierie di Sicilia S.p.A., Catania (IT), dated 2 August 2004;
D6: Technical Expertise Report, dated 5 November 2004;
D17: Minutes of a hearing before Tribunale di Trieste, 19 April 2004;
D23: Declaration by Mr Piovesana, dated 11 November 2015;
D23a: Pictures of a coiling machine;
D23b: Letter from Mr D'Agostini, dated 6 August 2004;
D24: Purchase agreement reference offer No. 11029/A;

D25: SIMAC Invoice No. 032/04, dated 27 February 2004;
D26a, D27a, D28a, D29a, D30a, D31a, D32a, D33a: transport documents regarding D25;
D26b, D27b, D28b, D29b, D30b, D31b, D32b, D33b: packing lists regarding D25 and D26a-D33a;
D34: WO -A- 2005/084843.

V. The appellant's arguments can be summarised as follows:

Main request

The subject-matter of claim 1 lacked novelty in respect of the public prior use "PU1", concerning a coiling machine sold and delivered by SIMAC SpA to Acciaierie di Sicilia SpA before the effective date of filing of the patent and documented by the contract, invoice, delivery documents and packaging lists on file. None of these documents included a confidentiality agreement. Indeed, the testimonies of Mr Zucchi and Mr Moreschi minuted in D17 explicitly ruled out the existence of such an agreement. Moreover, it could not be inferred from D34 that any such obligation existed.

The coiling machine had been inspected by Mr Piovesana who took the photographs in D23a and drafted D5 and D6. It was clear that the photographed machine was the same as that to which the sale and delivery documents related not only from the fact that the machine bore the name SIMAC, but also from the number in the machine's drawings, which could also be found on the packing list.

The machine shown in the photographs of D23a exhibited all the features of claim 1. In particular, the flange with the tooth forming the annular channel was clearly visible in Pictures 7 and 8. In addition the tooth was

also shown in the sketch by Mr Piovesana in D5. The guide and containing device was shown in the inactive position in Pictures 1 and 2, with Picture 3 showing the details of this element. The presence of the hinges in Picture 1 made it clear that this guide and containing device could also be driven in a working position according to the claim. This was also described in D6 and shown in the drawings of D4, which represented supporting evidence.

Therefore, the subject-matter of claim 1 lacked novelty.

Auxiliary request

The auxiliary request had been submitted at an extremely late stage of the proceedings without good reason. The appellant was unprepared to address a completely new auxiliary request at this stage. Hence, it should not be admitted into the proceedings.

VI. The arguments of the respondent can be summarised as follows:

Main request

It could not be concluded that the coiling machine to which the delivery documents on file related was not subject to an obligation of confidentiality. Indeed, the deposition of Mr Moreschi in D17 revealed that there was an implicit obligation of confidentiality. This also had to be the case in view of D34, a patent application in the name of SIMAC SpA which claimed a priority date later than the delivery of the coiling machine to Acciaierie di Sicilia SpA and which appeared to relate to the same project. Without any such

confidentiality agreement the delivery of the coiling machine would have anticipated the invention in D34.

Moreover, it was not certain that the machine inspected and photographed by Mr Piovesana was the same as that delivered by SIMAC.

Finally, it had not been proven that the inspected machine exhibited all the features of claim 1. The drawings of D4 were not relevant in this respect because, as explained in D23b, the machine had been changed after the production of the drawings. The report D6 was not relevant either because it merely represented Mr Piovesana's opinion about the machine, which did not necessarily need to correspond to the the machine's real configuration. The pictures of D23a did not unambiguously show that the containing element comprised a flange, applied substantially perpendicularly to the mandrel and shaped so as to have an annular tooth substantially coaxial with the mandrel, said annular tooth defining at the lower part an annular channel.

The pictures did not show a guide and containing device according to claim 1 either. Even if the element shown in Picture 3 were to be seen as a guiding device in an inactive position, there was no information about any possible movement in a working position as claimed. The photographs only showed a static situation, not the operation of the depicted machine.

Hence, the subject-matter of claim 1 was novel.

Auxiliary request

The auxiliary request only included claims that were already present in the version as granted. They were patentable in view of the prior use because the photographs of D23a did not show the operation of the coiling machine. Thus, the auxiliary request should be admitted into the proceedings.

Reasons for the Decision

1. Main request

1.1 The novelty of the subject-matter of claim 1 is contested in view of the alleged public prior use "PU1". The effective date of filing of the patent in suit to be considered for the purpose of Article 54(2) EPC is 18 January 2005 because, as already established in the decision under appeal (page 6), the priority is not valid (this finding has not been disputed).

1.2 The prior use PU1 relates to a coiling machine sold and delivered by SIMAC SpA to Acciaierie di Sicilia SpA. The sale is documented by contract D24, invoice D25 and delivery documents and packing lists D26a to D33b. The machine was sold and delivered before the effective date of filing of the patent in suit (D25 is dated 27 February 2004).

1.3 Said documents and in particular D24 do not mention any obligation of confidentiality.

In his witness deposition on 14 March 2006 as part of infringement proceedings before the Tribunale di Trieste (Italy) minuted in D17, Mr Zucchi, a manager at

Acciaierie di Sicilia SpA, confirmed the absence of any confidentiality agreement (see D17, page 16: "*Sulla base di quanto ho detto non fu presa neppure in considerazione né si poneva alcuna esigenza di tutela di segretezza.*"). As to the possible implicit obligation of confidentiality mentioned by Mr Moreschi, an engineer at Acciaierie di Sicilia SpA, who was also heard as a witness in the proceedings of D17, this related only to the negotiation phase and not to the delivered product (see D17, page 18: "*Non è mai stata rappresentata l'esigenza di segretezza anche perché rientra nella corretezza di comportamenti di non divulgare a terzi i termini e gli aspetti dei prodotti e dei sistemi oggetto di negoziazione.*"). The Board sees no indication that the testimonies of the witnesses Mr Zucchi and Mr Moreschi were untruthful.

The respondent argued that the existence of an obligation of secrecy had to be assumed in view of D34, a patent application in the name of SIMAC SpA which claimed a priority date after the delivery of the coiling machine to Acciaierie di Sicilia SpA and which appeared to relate to the same project. However, even assuming there was such an obligation, for which no proof has been furnished, there would be no reason for such an agreement after the priority date of D34, i.e. 3 March 2004, well in advance of the effective date of filing of the patent in suit (i.e. 18 January 2005).

The Board is thus satisfied that before the effective date of filing of the patent in suit Acciaierie di Sicilia SpA was under no obligation of confidentiality in respect of the coiling machine delivered to it by SIMAC SpA. Said machine is thus part of the prior art.

1.4 D6 is a technical expertise report dated 5 November 2004 drafted by Mr Piovesana, an independent technical consultant appointed by the court in the same proceedings to which D17 relates. In D6 Mr Piovesana also reports on an inspection of the machine at Acciaierie di Sicilia SpA which took place on 2 August 2004. The pictures D23a and minutes D5 drafted on the same day, both annexed to D6, relate to this inspection (see also Mr Piovesana's declaration D23).

The respondent submitted that it had not been proven without any reasonable doubt that the machine inspected by Mr Piovesana was the same as that to which the documents of the prior use PU1 relate. However, there is nothing in the documents on file to corroborate this assertion. The machine inspected by Mr Piovesana was a SIMAC machine (see Picture 19 of D23a) which was based on the drawings of D4 (see D6, page 84, fourth paragraph and page 92, second paragraph as well as D23b, annexed to D6, first page, point 2)), which show the same number 60.017.03 that appears on the packing list D26b. Thus, the documents on file undoubtedly confirm that the machine inspected by Mr Piovesana was the same as that delivered by SIMAC according to the above-mentioned documents.

Hence, the Board is satisfied that the prior art machine delivered by SIMAC SpA is the same as that inspected by Mr Piovesana and depicted in the photographs of D23a.

1.5 The prior art machine depicted in D23a is a device for coiling a windable long, metal product, comprising a mandrel (the central part visible for instance in Picture 4) having a substantially circular transverse section and rotating around a vertical axis, a

containing element (the larger horizontal part on which the mandrel is based, visible for instance in Picture 4 or in more detail in Pictures 7 and 8) to contain said metal product, arranged in correspondence with said mandrel and substantially orthogonal to said axis. As shown in Pictures 7 and 8, in particular on the right-hand side of Picture 8, the containing element comprises an annular channel which is made in proximity with an outer surface of said mandrel and is coaxial with the axis of rotation of said mandrel. This arrangement is also reproduced in the sketch made by Mr Piovesana during the inspection visible on page 4 of D5 (see also the declaration D23).

Pictures 7 and 8 (in particular in their good-quality colour reproductions provided with the letter of 8 July 2019) clearly show, in particular on the right-hand side of Picture 8, an annular tooth substantially coaxial with the mandrel, said annular tooth defining at the lower part said annular channel. The tooth is also depicted in the aforementioned sketch on page 4 of D5 (where it is called "dente di posizionamento"). Pictures 7 and 8 also show that the tooth is part of an element substantially perpendicular to the mandrel and fixed to the rest of the containing element by means of screws. Since a flange is nothing more than a ridge or rim for strength or for attachment to another object, said element is to be regarded as a flange. Hence, contrary to the respondent's opinion, the pictures clearly show, without any reasonable doubt, that the containing element comprises a flange, applied substantially perpendicularly to the mandrel and shaped so as to have an annular tooth substantially coaxial with the mandrel, said annular tooth defining at the lower part said annular channel.

In Pictures 1 and 2 a white, vertical, semicircular element is visible (shown in detail in Picture 3) comprising a groove able to define an accompanying guide for the metal product. Thus, this element represents a guide and containing device. It is true that the pictures show this element only in a position wherein it is arranged distant from said mandrel, i.e. an "inactive position" in the wording of the claim. However, Picture 1 also shows that the element is provided with hinges that allow it to rotate in the horizontal position. It is thus clear for the person skilled in the art that it can be driven in a second position, a "working position" in the wording of the claim, where said guide and containing device is able to define an accompanying guide for the metal product along an outer circumference of the mandrel towards the annular channel defined by the tooth and coaxial with it. Any other function of this element would be unrealistic. Indeed this movement is visible in the drawings of D4, in particular sheet 1/3 and described by Mr Piovesana in his report D6 (pages 87 and 88). Although it is true that some details of the drawings of D4 differ from the delivered and installed device (see D23b, first page, point 2)) and that Mr Piovesana's understanding of the device may, at least in theory, not completely match the actual device, the fact that they correspond to the finding above is to be considered as secondary evidence which corroborates that finding. Thus, contrary to the respondent's view, the machine shown in the pictures exhibits, without any reasonable doubt, a guide and containing device able to be driven between a first working position wherein it cooperates with said mandrel, and a second inactive position wherein it is arranged distant from said mandrel, wherein said guide and containing device comprises a groove that is able to define an

accompanying guide for said metal product along an outer circumference of said mandrel towards said annular channel and coaxial with said annular channel, when said guide and containing device is in said first working position.

The Board is thus satisfied that the device to which the public prior use PU1 relates exhibits all the features of claim 1.

1.6 Therefore, the subject-matter of claim 1 lacks novelty.

2. Auxiliary request

Since the auxiliary request was submitted after the reply to the grounds of appeal, its admission into the proceedings was at the Board's discretion as foreseen in Article 13(1) RPBA. According to this article, the discretion should be exercised in view of *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. Moreover, where amendments are sought to be made after oral proceedings have been arranged, it should also be taken into account whether they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings (see Article 13(3) RPBA).

The auxiliary request was submitted at an extremely late stage of the proceedings (towards the end of the oral proceedings). The opponent had already asserted a lack of novelty of the main request in view of the public prior use in the notice of opposition, and had reiterated it (as the sole substantiated objection) in the statement of grounds of appeal. Hence, the

submission of the auxiliary request cannot be considered to be a reaction to the discussion during the oral proceedings. Therefore, there is no objective justification for the delay in the submission of the auxiliary request.

It is true that the sole independent claim of the auxiliary request was already present (as claim 12) in the patent as granted. However, nothing in the procedure preceding the oral proceedings hinted at the possibility that this claim could represent a fall-back position for the respondent. The only submission dealing with substantive matters was the rather concise reply to the statement of grounds of appeal (the respondent did not file any substantive reply to the Board's communication). In said submission there is no mention of claim 12 or indeed of the possibility of filing an auxiliary request at all. Moreover, the arguments presented in said reply do not imply that patentability could be based on features pertaining to the use of the claimed device. The sole features discussed (the flange and the tooth; see page 4, first paragraph) are unchanged in claim 1 as granted and in the independent claim of the auxiliary request. Indeed, the argument relating to the different working and inactive positions of the guide and containing device, and thus to some extent to the operation of the device, was presented for the first time during the appeal at the oral proceedings. Thus, the appellant was objectively justified in declaring themselves unprepared to address this auxiliary request. As a consequence, admitting the auxiliary request into the proceedings would have required an adjournment of the oral proceedings.

Under these circumstances the Board decided not to admit the auxiliary request into the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chairwoman:

D. Magliano P. Acton

Decision electronically authenticated