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**Datasheet for the decision
of 8 April 2019**

Case Number: T 2302/15 - 3.2.07

Application Number: 11700836.7

Publication Number: 2525914

IPC: B02C17/18, B02C17/24, B02C25/00

Language of the proceedings: EN

Title of invention:
METHOD AND APPARATUS FOR DETACHING FROZEN CHARGE FROM A TUBE
MILL

Patent Proprietor:
ABB Schweiz AG

Opponent:
Siemens Aktiengesellschaft

Headword:

Relevant legal provisions:
EPC Art. 100(a), 104(1)
RPBA Art. 12(4), 13(1), 16

Keyword:

Late-filed evidence - request could have been filed in first instance proceedings (yes)

Late-filed argument - admitted (yes)

Apportionment of costs - (no)

Novelty - main request (yes)

Inventive step - main request (yes)

Decisions cited:

Catchword:



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Case Number: T 2302/15 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 8 April 2019

Appellant: Siemens Aktiengesellschaft
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Respondent: ABB Schweiz AG
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Representative: Zimmermann & Partner
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 16 October 2015
rejecting the opposition filed against European
patent No. 2525914 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman V. Bevilacqua
Members: A. Pieracci
C. Brandt

Summary of Facts and Submissions

- I. The appellant (opponent) filed an appeal within the prescribed time limit and in the prescribed form against the decision of the opposition division rejecting the opposition against European patent No. 2 525 914 B1.
- II. The opposition was filed against the patent as a whole based on the grounds for opposition pursuant to Article 100 (a) EPC (lack of novelty and inventive step). The opposition division found that the grounds for opposition under Article 100 (a) EPC did not prejudice the maintenance of the patent as granted.
- III. The appellant refers to the following document, which had formed part of the opposition proceedings:

E1: WO 2005/092508 A1

and the following documents filed together with the grounds of appeal:

E9: "Grinding Mill Application", ABB Switzerland, COE Minerals Processing, dated 28 September 2009.

E10: Copy of an Email from Mr. Michel Diaz to Ms. Milena Gergova, undated.

- IV. In the statement setting out the grounds of appeal the appellant requested that:

the appealed decision be set aside and the opposed patent be revoked in its entirety.

V. In its reply the respondent (patent proprietor) requested that:

the appeal be dismissed,
or, alternatively,
that the patent be maintained according to
auxiliary requests 1 to 3 filed with the reply to
the grounds of appeal.

The respondent also requested that:

should E9 be admitted, the case be remitted to the
opposition division for consideration of said
document and a decision on whether the appellant
should bear the resulting costs.

VI. In order to prepare for the oral proceedings, which
were scheduled at the request of both parties, 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 it envisaged not admitting
documents E9 and E10 into the proceedings in
application of Article 12(4) RPBA and that it
considered the subject-matter of claim 1 to be novel
and inventive.

VII. In a letter dated 8 March 2019 the appellant filed the
following documents:

Annex 1: Excerpt from FreePatentsOnline,
<http://www.freepatentonline.com/RE47077.html>,

Annex 2: Excerpt from a family search on Patbase
with respect to the opposed patent,

- Annex 3: Excerpt from the file inspection of USRE47077,
- Annex 4: Non-Final Rejection of application US 14/981620, dated 31 January 2018,
- Annex 5: Declaration of Mr. Hans-Hermann Jonas,
- Annex 6: Invoice Nr. R2019-0748 dated 7 March 2019,
- Annex 7: I.N. Bronstein et al., "Taschenbuch der Mathematik", Verlag Harri Deutsch, 4th Edition, 1999, pages IV, V, 48, 49, 56, 57,
- Annex 8: Excerpt from Wikipedia for the term "Niveau",
- Annex 9: Renate Wahrig-Berfeund, "WAHRIG - Deutsches Wörterbuch, ISBN: 978-3-577-10241-4, page 1074.

The appellant also requested an apportionment of the costs of the additional search it carried out to substantiate the public availability of document E9 on the basis of an alleged abuse of procedure by the respondent.

VIII. In a letter dated 8 March 2019 the respondent filed a set of claims according to a fourth auxiliary request, for the case document E9 were to be admitted into the proceedings.

IX. Oral proceedings before the Board took place on 8 April 2019. At the oral proceedings the respondent requested that its fourth auxiliary request be

considered independently of the admittance of document E9 into the proceedings.

Apart from this, both parties confirmed their requests filed during the written procedure.

For further details of the oral proceedings, reference is made to the minutes thereof.

The decision was announced at the end of the oral proceedings.

X. The parties argue as follows.

The appellant argues essentially that the feature "...increasing torque reference level..." of claim 1 can be read as meaning that the torque reference level is either monotonously increasing or strictly monotonously increasing. In both cases document E1 deprives the subject-matter of claim 1 of novelty. Furthermore, the subject-matter of claim 1 is obvious in view of the teaching of E1 in combination with common general knowledge. The appellant also argues that due to an abuse of procedure by the respondent the costs of the additional search relating to the public availability of E9 should be apportioned to the latter.

The respondent objects to the broad interpretation of claim 1 taken by the appellant and maintains that the subject-matter of claim 1 is novel in view of E1 and inventive in view of E1 in combination with common general knowledge. The respondent also argues that the appellant's request for the apportionment of costs is unfounded.

The above arguments will be addressed in detail in the reasons for the decision.

XI. Independent claim 1 according to the main request, i.e. according to the patent as granted, reads as follows:

"A method for detaching a frozen charge (14) from an inner wall (12) of a grinding pipe (10), the method comprising the steps of:

controlling a driving device of the grinding pipe (10) to detach a frozen charge from an inner wall (12) of the grinding pipe (10), which driving device is operable to apply a driving torque to the grinding pipe (10),

wherein controlling the driving device comprises varying the driving torque applied to the grinding pipe (10) about a predetermined and increasing torque reference level (20, 30)."

Independent claim 6 according to the main request, i.e. according to the patent as granted, reads as follows:

"A controller for detaching a frozen charge (14) from an inner wall (12) of a grinding pipe (10), adapted to control a drive device of a grinding pipe (10) such that a driving torque applied by the drive device varies about a predetermined and increasing torque reference level (20, 30)."

In view of the present decision, which has been taken on the basis of the main request, there is no need to recite the wording of the independent claims of the auxiliary requests.

Reasons for the Decision

1. *Admittance of document E9 into the proceedings*

Document E9, a document originating from the respondent, was filed for the first time together with the grounds of appeal. Document E10 was filed together with E9 to provide proof of the public availability of the latter, in particular to show that E9 was in the possession of the appellant before the priority date of the patent in suit.

1.1 The appellant argues that there is no absolute bar to the admittance of document E9 into the proceedings. Document E9 is highly relevant for assessing the patentability of the subject-matter of the claims, it is quite short and easy to evaluate. Furthermore, the fact that it had been filed at the beginning of the appeal proceedings meant that the respondent had the opportunity to react appropriately and to file amended claims.

The appellant also argues that although E9 was in its possession, a decision was taken not to file it at the beginning of the opposition proceedings for reasons of economy, due to the level of proof and the efforts required to demonstrate its public availability. The appellant subsequently considered it necessary to file document E9 because it could not infer from the decision of the opposition division, in particular point 2.2 b, why the division could not accept its argument relating to the last feature of claim 1 of the main request, according to which "controlling the driving device comprises varying the driving torque applied to the grinding pipe (10) about a predetermined and increasing torque reference level (20, 30)".

For these reasons the appellant asks the Board to exercise its discretion and admit document E9 into the appeal proceedings.

- 1.2 The Board disagrees, and concurs with the respondent, who argues that E9 should have been submitted when filing the opposition and that by filing it at this late stage of the procedure the appellant deprives him of the possibility of having the document assessed by two instances. The fact that the features of claim 1 identified above were a particularly contentious point of discussion in the opposition proceedings is apparent from the opposition letter (see page 2, last paragraph). The decision of the opposition division, despite being concisely written, does not present any surprising argument in this respect. Document E9 should therefore not be allowed into the proceedings.

The Board is unable to infer from the arguments of the appellant and from the history of the file that the decision of the opposition division involved a shift in the assessment of the disputed subject-matter which would justify the admittance of document E9 into the proceedings.

The opposition division simply decided to accept the argument of the respondent, as outlined in the notice of opposition, which is something the appellant needs to consider as a possible outcome of the proceedings, so that it can prepare itself accordingly.

With respect to the appellant's argument citing reasons of procedural economy as justification for not filing E9 in opposition proceedings, the Board notes that the parties should submit any fact, evidence or requests they wish to rely upon as soon as possible specifically for reasons of economy and for the efficiency of the

procedure, otherwise they run the risk of them being disregarded.

It is also noted that the alleged high degree of relevance and conciseness of E9 are not criteria that the Board has to observe when applying Article 12(4) RPBA.

The argument that the respondent is still in a position to react by amending the claims since the document E9 was filed at the beginning of the appeal proceedings can also not be accepted, as this is always the case for documents filed in appeal for the first time, and would render Article 12(4) RPBA first sentence ineffective.

Since appeal proceedings are primarily intended to review the outcome of the proceedings from which the appeal originates and not just to allow a change of strategy of the parties, considering that the appellant, according to its own submission (see E10), was in possession of document E9 before the priority date of the patent in suit, the delay in submitting document E9 does not appear to be appropriate. Document E9 is thus not admitted into the proceedings pursuant to Article 12(4) RPBA.

2. *Admittance of the new interpretation of the features of claim 1 by the appellant and of the corresponding new line of attack.*

In its submission filed after receiving the communication under Article 15(1) RPBA, the appellant argues for the first time that the feature "increasing torque reference value" has two possible interpretations, that the "increasing" is monotonous or

strictly monotonous. The first interpretation, which is the broadest, should be the one adopted when interpreting the claim.

2.1 The respondent contests that this interpretation amounts to the submission of a new line of argument, presented late in the proceedings, and goes against the interpretation and line of argument previously followed by the appellant in both the opposition and appeal proceedings (see for example the opposition letter, page 2, last paragraph and the letter dated 24 August 2015, page 2, third paragraph from the bottom). This interpretation of the claimed features and the corresponding new line of attack should therefore not be admitted into the proceedings.

2.2 The Board does not see any reason for not admitting the line of attack based on the above new interpretation of the claimed features into the proceedings. This interpretation is seen as a development of the line of attack previously submitted, being different but not contrary to what was previously argued by the appellant.

Furthermore, both the respondent and the Board are in the position of being able to address the new interpretation and corresponding line of attack without an adjournment of the oral proceedings.

The Board thus considers it appropriate to exercise its discretion under Article 13(1) RPBA by admitting the new interpretation of the claimed features and the corresponding line of attack into the proceedings.

3. *Interpretation of claim 1*

The parties disagree on how the following combination of features of claim 1 is to be interpreted:

"...wherein controlling the driving device comprises varying the driving torque applied to the grinding pipe about a predetermined and increasing torque reference value..."

3.1 The appellant argues that mathematically the torque reference value can increase either monotonously or strictly monotonously.

By interpreting the claim broadly, to include the monotonous increasing and not just the strictly monotonous, as done by the opposition division and by the respondent, the claim also covers embodiments in which the torque reference level increases stepwise and the driving torque varies about the torque reference level while the latter is constant.

According to the appellant, when reading the claim, the torque reference level has to be considered with its variation taking place within a time interval and not just locally. The fact that the torque reference level should be increasing steadily, or continuously, during the variation, i.e. should be strictly monotonous, is only apparent from paragraph [0008] of the patent specification. The respondent has however chosen not to incorporate this wording into the claim, so that the claim is not to be read as being limited by this paragraph.

3.2 The respondent argues that from reading the claim alone it is evident to the person skilled in the art that the driving torque is varied at the same time as the torque reference level is increased. Furthermore, this

interpretation is confirmed by the description of the patent (see paragraph [0008]), and by the fact that according to this reading of the claim the improved detachment of the frozen charge is achieved.

- 3.3 The Board cannot accept the arguments of the appellant and substantially concurs with the respondent for the following reasons.

The combination of features of the claim that is objected to reads as follows:

"...wherein controlling the driving device comprises varying the driving torque applied to the grinding pipe about a predetermined and increasing torque reference value..."

This passage does not refer to how the torque reference value varies over time, i.e. in terms of a temporal function, but states that at the time the driving torque is being varied, at that specific point in time, the torque reference value is being increased. According to the Board the only sensible interpretation of this passage is thus that the driving torque varies simultaneously with the increase of the torque reference value.

4. *Novelty of the subject-matter of claim 1 of the patent as granted (Articles 100 (a) and 54 EPC)*

- 4.1 The appellant argues that the feature of claim 1,

"...wherein controlling the driving device comprises varying the driving torque applied to the grinding pipe (10) about a predetermined and increasing torque reference level (20, 30)..."

is also disclosed in combination with the other features of claim 1 in document E1.

The appellant argues (see point C. of the grounds of appeal) that on page 8, lines 23-24, of E1 it is indicated that the grinding pipe oscillates about one or more positive rotation angles. This implies that the pipe changes its direction of rotation several times. By overlaying the torque values corresponding to these rotations to the torque reference levels a variation of torque over time is obtained, as represented in the figure on page 7 of the grounds of appeal, which is analogous to figures 2 and 3 of the opposed patent.

Furthermore, the same behaviour of the torque as a function of time according to the opposed patent is also obtained in E1 due to oscillations about different rotation angles when a controlled start of the motor of the grinding pipe takes place.

The appellant also argues that, due to the broad interpretation of the distinguishing features discussed in point 3.1 above, the example of Figure 5 of E1 for the time interval starting at the beginning of the time interval T2 and finishing at the end of the time interval T3 also deprives the subject-matter of the claim of novelty.

4.2 The respondent contests that the information provided on page 8, lines 23-24, of E1 implies a relationship of the torque over time that corresponds to the one depicted in the figure on page 7 of the grounds of appeal.

Figure 5 of E1 shows what is meant by oscillations about an angle. These oscillations take place during

the time periods T1-T4 about a constant value of the angle, which implies a constant value of the torque. The figure referred to on page 7 of the grounds of appeal is not present in E1 and cannot be derived from the information provided therein. E1 teaches instead that the reference angle and thus the torque remains constant during the oscillations.

The respondent also argues that, since the driving torque varies at the same time that the torque reference level increases, the example of Figure 5 of E1 in the time interval T2-T3 also does not deprive the subject-matter of the claim of novelty contrary to the argument of the appellant relating to the monotonous increase of the torque reference value.

- 4.3 The Board cannot accept the argument of the appellant and essentially concurs with the respondent that the disputed combination of features is not disclosed in E1.

The passage on page 8, lines 23-28 of E1 reads:

"...It is possible for the grinding pipe 1 to oscillate about one or more positive angles of rotation ϕ_1 . It is also possible for the grinding pipe 1 to oscillate about one or more negative angles of rotation ϕ_2 . The grinding pipe 1 can also be set to oscillate about one or more positive and about one or more negative angles of rotation ϕ_1 and ϕ_2 ..."

The above passage of E1 is preceded by two paragraphs which describe the oscillation of the grinding pipe about the angles ϕ_1 and ϕ_2 shown in Figures 4 and 5 and therefore also refer to the same angles ϕ_1 and ϕ_2 and to their variation over time. From Figures 4 and 5 and

from the cited passage of E1 it can be derived that the grinding pipe oscillates about a fixed value of the rotation angle within a given time period, which implies that the torque also oscillates about a fixed value, as also acknowledged by the appellant in the opposition proceedings (see Figure 4 of the appellant's submission dated 20 August 2015).

The statement of the appellant that a torque variation over time as depicted in the Figure on page 7 of the grounds of appeal can be derived from E1 appears to be unsubstantiated and cannot therefore be accepted.

The argument of the appellant, that there is an oscillation of the angle of the grinding pipe when its motor starts operation, can also not be accepted, since this is neither disclosed in the description of E1, nor in the figures, which show that the angle ϕ_1 is reached steadily, without any oscillation (see Figures 4, 5 and 6 of E1).

Since the Board is of the opinion that according to the claim the driving torque varies while, i.e. at the same time, the torque reference level is increased, the example of Figure 5 of E1 for the time interval between the start of time interval T2 and the end of time interval T3 also does not disclose the last step of the method claimed in claim 1.

The Board therefore comes to the conclusion that document E1 does not show that:

"controlling the driving device comprises varying the driving torque applied to the grinding pipe (10) about a predetermined and increasing torque reference level (20, 30)",

The subject-matter of claim 1 is thus novel.

5. *Inventive step of the subject-matter of claim 1 of the patent as granted (Article 100 (a) and 56 EPC)*

5.1 The appellant argues that E1 solves the same problem of the opposed patent, which is to make the removal of a frozen charge possible in a simple and efficient way. According to the appellant the person skilled in the art starting from E1 and with the aim of solving the above problem, would decide not to immediately reach the maximum angle of rotation ϕ , for example 70° , but would arrive at this angle by reaching subsequent intermediate angles and by oscillating the grinding pipe about these angles. In this way, the diagram of the torque as a function of time would be the figure on page 7 of the grounds of appeal, which corresponds to the torque behavior according to the opposed patent. According to the appellant this would be the most sensible course of action for the person skilled in the art, who would then arrive at a method according to the subject-matter of claim 1.

5.2 The respondent argues that the objective problem to be solved starting from document E1 is that of providing an improved method for removing a frozen charge from grinding mill pipe.

E1 teaches that predetermined angles of rotations should be reached and then the grinding pipe should be oscillated. The person skilled in the art wishing to improve the method of E1 would, at most, try to optimise the choice of the value of the angle of rotation or the amplitude or the frequency of the oscillations. The person skilled in the art has no

reason to modify the method of E1 to arrive to a method according to the claim of the opposed patent.

5.3 The Board notes the following.

The technical effect provided by the distinguishing features identified above (see point 4.3) can be seen as further increasing the variation of the acceleration of the frozen charge over time, thus further facilitating the dislodging of the frozen charge (see also page 2, lines 18-19, and page 4, lines 28-29, of the application as originally filed and published).

The objective problem to be solved can thus be seen, as essentially argued by the parties, as how to modify the method for detaching a frozen charge according to E1 so that the method is further improved.

The Board considers that the person skilled in the art would not reach the solution claimed in the opposed patent taking into consideration the teaching of E1 alone and would not do this by applying common general knowledge.

As discussed in relation to novelty, the distinguishing features of claim 1 are not disclosed in E1 and thus cannot be suggested by E1 itself.

The fact that for the skilled person the most reasonable course of action would be to oscillate the grinding pipe about increasing angles, is, in the opinion of the Board, a statement of the appellant which is not substantiated, in particular by the available prior art.

The Board shares the position of the respondent according to which the person skilled in the art, wishing to improve the method of E1, would rather optimise the choice of the value of the angle of rotation or the amplitude or the frequency of the oscillations of D1.

The Board concurs therefore with the opposition division that the subject-matter of claim 1 is based on an inventive step in view of the combination of document E1 with the common general knowledge of the person skilled in the art.

6. *Novelty and inventive step of the subject-matter of claim 6 of the patent as granted (Articles 100 (a), 54 and 56 EPC)*

The Board agrees with the parties and with the opposition division (see point 4 of the reasons for the decision) that, since claim 6 is directed to a controller which is adapted to control a drive device of a grinding pipe according to the same combination of features as the method of claim 1, the same arguments for claim 1 apply analogously to claim 6.

The Board is therefore of the opinion that the subject-matter of claim 6 of the main request is also novel and inventive.

7. *Apportionment of costs (Article 104 EPC)*

7.1 Under Article 104(1) EPC each party to opposition (appeal) proceedings must, as a rule, meet its own costs. However, the Board may for reasons of equity order a different apportionment of costs. In addition, according to Article 16(1) RPBA the Board may at the

request of a party order that one party should pay some or all of another party's costs, e.g. in case of abuse of procedure (Article 16(1)(e) RPBA).

- 7.2 The appellant requests that the respondent bears the costs relating to the additional search carried out to prove the public availability of document E9, as this additional search was made necessary by an abuse of procedure on the part of the respondent. The appellant argues that in the reply to the grounds of appeal the respondent contested the public availability of document E9, while before the US Patent Office it admitted that the document was publicly available in advance of the priority date of the patent in suit. Thus, by denying something it was aware of, the respondent caused an unnecessary additional search, for which it should cover the costs.

- 7.3 The Board does not share the appellant's view. It is a general rule that each party is responsible for presenting and substantiating its case. This means that if, as in the present case, a party bases an attack against novelty on a document (E9) whose public availability has been put into question by the other party, it has to provide (further) evidence in order to overcome these objections and consequently it has to bear the costs of the necessary respective investigations and searches.

In the present case the Board sees no reason to deviate from this rule.

It was therefore down to the appellant, wishing to use E9, to make its case about the public availability of this document. Contrary to the appellant's allegation the respondent could not be expected to provide the

missing evidence for the public availability of E9 and thereby support the appellant's case to its own detriment.

It is noted that, independently of what did or did not happen before the US Patent Office in the present case, the EPC does not include any provision - nor the Case Law of the Boards of Appeal any hint - which states that in opposition proceedings a party should generally disclose what it is aware of, in order to support the other party's case. This is all the more applicable since the case before the US Patent Office and the present opposition appeal case before the Board pertain to completely different proceedings based on different conditions and legal provisions.

Hence, the Board considers that the respondent has not committed any abuse of procedure under Article 16(1) (e) RPBA by contesting the public availability of document E9 in the present appeal proceedings.

The Board is thus of the opinion that each party of the present proceedings should bear its own costs as provided for by Article 104(1) EPC, first sentence, since a reason of equity for not doing so is not apparent (see Article 104 (1) EPC and Article 16 (1) (e) RPBA).

For these reasons the appellant's request for the apportionment of costs is not granted.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The appellant's request for the apportionment of costs is rejected.

The Registrar:

The Chairman:



G. Nachtigall

V. Bevilacqua

Decision electronically authenticated