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**Datasheet for the decision  
of 3 November 2021**

**Case Number:** T 0106/18 - 3.3.05

**Application Number:** 08854046.3

**Publication Number:** 2231884

**IPC:** C21D1/63, C21D9/00, C21D9/04,  
B21B43/04, B21B43/06, B21B45/02

**Language of the proceedings:** EN

**Title of invention:**

PROCESS OF THERMAL TREATMENT OF RAILS AND DEVICE THEREOF

**Patent Proprietor:**

Danieli & C. Officine Meccaniche SpA

**Opponents:**

SMS Meer GmbH  
voestalpine Schienen GmbH

**Headword:**

THERMAL TREATMENT OF RAILS/Danieli

**Relevant legal provisions:**

RPBA 2020 Art. 13(2)

**Keyword:**

Amendment after summons - cogent reasons (no)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0106/18 - 3.3.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.05**  
**of 3 November 2021**

**Appellant 2:** Danieli & C. Officine Meccaniche SpA  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
6 November 2017 concerning maintenance of the  
European Patent No. 2231884 in amended form.**

**Composition of the Board:**

<b>Chairman</b>	E. Bendl
<b>Members:</b>	J. Roider
	O. Loizou

## **Summary of Facts and Submissions**

- I. The appeals of appellant 1 (opponent 2) and appellant 2 (patent proprietor) lie from the Opposition Division's interlocutory decision to maintain the patent on the basis of the then-auxiliary request 2, filed during the oral proceedings in opposition proceedings. Opponent 1 (respondent) did not put forward any written submissions.
- II. In its statement of grounds of appeal and its reply to appellant 2's grounds of appeal, appellant 1 raised, *inter alia*, objections under Articles 84 and 123(2) EPC.
- III. A summons to the oral proceedings in appeal proceedings was issued and posted by registered letter on 17 September 2020, thus deemed delivered on its 10th day of posting (Art. 119, Rule 126(2) EPC).
- IV. In the communication according to Article 15(1) RPBA issued on 13 October 2020, the Board expressed its preliminary opinion that the then-main request, auxiliary request 1 and auxiliary request 2 (claims as maintained by the Opposition Division) did not meet the requirements of Article 123(2) EPC, and auxiliary request 2 moreover did not meet the requirements of Article 84 EPC.
- V. On 8 January 2021, appellant 2 filed two sets of claims as a new main request and a new auxiliary request respectively, replacing all the claim requests on file.
- VI. Claim 1 of the new main request reads (mark-up with respect to the former auxiliary request 2):

"1. A process for in-line thermal treatment of a rail of steel having a percentage of carbon in the range between 0.7 and 0.9% and a manganese content in the range between 0.75 and 1.25% exiting from a rolling system including the following steps:

- a first cooling step in air of the rail of duration in a range between 40 and 90 sec until reaching a surface temperature of the rail head of at least 720°C
- a second cooling step for cooling the only rail head by means of a cooling liquid of duration in a range between 10 and 20 sec until reaching a surface temperature of the rail head from 50 to 150°C above the Ar3 temperature in order to avoid a phase transformation from austenite to pearlite;
- a third cooling step in air having a predetermined duration in the range between 10 and 60 sec whereby the heat of the inner layers tempers the superficial layers up to a temperature of 720-840°C and the surface temperature of the rail head is equalized up to the temperature of a superficial layer of the rail head, said superficial layer having a depth in the range between 15 and 25 mm from the surface;
- a fourth cooling step by means of a cooling liquid having a maximum duration in the range between 180 and 350 seconds and a cooling rate not higher than 3-4°C/sec until reaching a surface temperature of the rail head lower than 500°C whereby the phase transformation from austenite to pearlite occurs;

wherein said pearlite has a uniform structure with fine granulometry in said superficial layer."

Claim 1 of the new auxiliary request additionally contains the following features at the end:

*"...and wherein the second and fourth cooling steps are carried out by means of an immersion of the rail head in a tank containing said cooling liquid."*

VII. The arguments of appellant 1 can be summarised as follows:

The latest amendments to the requests changed appellant 2's case. They were presented after the notification of the summons to oral proceedings. No exceptional circumstances were present and no justification with cogent reasons was submitted. According to Article 13(2) RPBA 2020, the new requests were not to be taken into account.

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

The respondent endorsed the arguments put forward by appellant 1. Moreover, it asserted that the amendments, such as the cooling of the rail head in the second cooling step, related to objections under Article 123(2) EPC which had been extensively discussed during the opposition proceedings. The objections were thus not new as claimed by appellant 2.

Moreover, the amendments gave rise to new objections under Article 84 EPC. Indeed, the feature *"the only rail head"* could not be understood.

IX. The arguments of appellant 2 can be summarised as follows:

Many objections had been raised by appellant 1. It was assumed that it would be more economical for the procedure to address the points once the Board's opinion was known. And, indeed, the Board intended to accept some of the objections raised, whereas other objections were deemed unconvincing. Drawing up a full list of auxiliary requests taking into account all the

possible outcomes of the board's opinion would have resulted in an undue burden for the patent proprietor.

Moreover, appellant 2 was for the first time confronted with a precise assessment of the added subject-matter and the lack of clarity (letter accompanying the new requests, page 2, 4th para.).

At the beginning of the appeal proceedings, the RPBA 2007 were in force. The RPBA were changed shortly after the start of the present appeal procedure.

Appellant 1 put forward a new line of attack with its statement of grounds of appeal (page 5, 9th line from the bottom) which had not been put forward during opposition and consequently had not been dealt with in the interlocutory decision of the Opposition Division.

The feature objected to, "*the only rail head*", was an error in translation.

The changes were not detrimental to procedural economy as all the other requests had been withdrawn. The amendments overcame all the objections by the other parties and did not give rise to new objections.

This situation should thus be considered as constituting exceptional circumstances within the meaning of Article 13(2) RPBA 2020, and the Board should admit the new main request and auxiliary request using its discretionary powers.

- X. Appellant 1 and the respondent requested that the decision under appeal be set aside and the patent be revoked.

- XI. Appellant 2 requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the main request or alternatively the auxiliary request, both requests filed by letter dated 8 January 2021.

### **Reasons for the Decision**

1. The new requests are an amendment to appellant 2's case within the meaning of Article 12(4) RPBA 2020. The admission of amendments after the notification of a summons to oral proceedings in the case in hand is governed by Article 13(2) RPBA 2020 (see also Article 25(3) RPBA 2020).
2. According to Article 13(2) RPBA 2020, new requests shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons.

The explanatory remarks accompanying the introduction of Article 13(2) RPBA 2020 give the example that exceptional circumstances arise if the Board raises an objection for the first time.

This has, however, not been the case.

3. In the case at issue, the new main request is based on the previous auxiliary request 2 including a number of additional amendments. However, the corresponding objections had already been raised in the opposition

procedure.

For example, one of the amendments was made to overcome an objection under Article 84 EPC with respect to the feature "*cooling rate not higher than 3-4°C/sec*" which was deemed unclear because it defined a range as being the maximum.

This objection was validly raised during the oral proceedings in opposition (see interlocutory decision, para. 4.2).

It was also raised in the statement of grounds of appeal submitted by appellant 1 (section 4).

As this issue was constantly under dispute, appellant 2 must have been aware of the possibility that the Board might come to a different conclusion than that of the Opposition Division. Reacting to this possibility only after the Board had issued its preliminary opinion was not a timely and adequate reaction under either the previous or the current rules of procedure.

4. Whether additionally new objections were raised with the statement of grounds of appeal of appellant 1 is of no relevance to the case in hand. Even if this had been the case, a request to disregard the allegedly late-filed objections should have been raised and/or further amendments should have been submitted at the latest with the reply to appellant 1's grounds of appeal, but certainly not after the Board had given its preliminary opinion.
5. Furthermore, exceptional circumstances within the meaning of Article 13(2) RPBA 2020 do not include the fact that appellant 2 became aware of the Board's

preliminary opinion on the validly raised objection outlined above only with the communication under Article 15(1) RPBA.

6. The assessment in the communication according to Article 15(1) EPC was restricted to the objections raised by appellant 1. It was meant to assist the parties in preparing for the scheduled oral proceedings. A precise assessment of the objections in view of the parties' arguments does not justify claiming exceptional circumstances.
7. Moreover, an undue burden in view of a potential need to file auxiliary requests is not apparent. In the case at issue, few objections under Article 83 EPC, Article 84 EPC and Article 56 EPC, but a number of objections under Article 123(2) EPC, were raised by appellant 1.

The objections under Article 123(2) EPC relate to the intermediate generalisation of a feature which was isolated from the context of the example. This example has a limited number of interrelated features, such that there exist only a few amendments expedient to address the objections raised by the opponents. The filing of amended claims taking into account the objections raised by appellant 1 therefore does not constitute an undue burden in the present case.

8. The filing of amended claims at the earliest possible stage of the proceedings would not have been detrimental to procedural economy either, in the event that appellant 2 had convincingly demonstrated that it had had no earlier chance to do so.
6. The transition from the RPBA 2007 to the RPBA 2020 does not constitute exceptional circumstances either.

According to Article 25(1) RPBA 2020, the RPBA 2020 apply for all pending cases. Transitional provisions are set out in Articles 25(2) and (3) RPBA 2020. The transitional provision according to Article 25(3) RPBA 2020, which relates to the new Article 13(2) RPBA, does not apply to the case at issue because the summons to oral proceedings had been notified after the date of entry into force. No further transitional provisions are provided in relation to Article 13(2) RPBA.

Exceptional circumstances in the sense of Article 13(2) RPBA can thus not be acknowledged.

6. Finally, the amendments do *prima facie* give rise to discussions as to their meaning and interpretation. Indeed, since the context of the patent is the heat treatment of rails, the feature "*the only rail head*" appears to lack clarity.

The first step of the process refers to cooling the entire rail. In the second step "*the only rail head*" is cooled, which may either mean that only the rail head is cooled, or that (again) the entire rail is cooled in order to achieve a cooling of "*the only rail head*". Thus it cannot be clearly derived from the wording of claim 1 which process steps are to be performed.

Therefore the wording is ambiguous and necessitates further clarification and discussion.

6. For these reasons, the new main request and the new auxiliary request are not taken into account (Article 13(2) RPBA).

There are hence no pending requests on the basis of

which the patent in suit could be maintained.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated