

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 29 June 2021**

Case Number: T 1039/18 - 3.2.08

Application Number: 11001723.3

Publication Number: 2383054

IPC: B21F23/00, B21K27/02

Language of the proceedings: EN

Title of invention:

A deforming press with a device for controllably supplying a metal wire

Patent Proprietor:

Sacma Limbiate S.p.A.

Opponent:

WAFIOS Aktiengesellschaft

Headword:

Relevant legal provisions:

EPC Art. 54

RPBA 2020 Art. 13(2)

Keyword:

Novelty - public prior use - obligation to maintain secrecy
(no)

Amendment after summons - exceptional circumstances (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1039/18 - 3.2.08

D E C I S I O N
of Technical Board of Appeal 3.2.08
of 29 June 2021

Appellant:
(Patent Proprietor)

Sacma Limbiate S.p.A.
Viale dei Mille 126/128
20051 Limbiate (IT)

Representative:

Laghi, Alberto
De Dominicis & Mayer S.r.l.
Piazzale Marengo, 6
20121 Milano (IT)

Respondent:
(Opponent)

WAFIOS Aktiengesellschaft
Silberburgstrasse 5
72764 Reutlingen (DE)

Representative:

Patentanwälte
Ruff, Wilhelm, Beier, Dauster & Partner mbB
Kronenstraße 30
70174 Stuttgart (DE)

Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 27 February
2018 revoking European patent No. 2383054
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairwoman P. Acton
Members: M. Foulger
C. Schmidt

Summary of Facts and Submissions

- I. With the decision dated 27.2.18, the opposition division revoked the European patent No. 2 383 054. The opposition division found that the subject-matter of claim 1 as granted lacked novelty with respect to the public prior use W1 consisting of the sale of a machine of the type FUL 103 to the Correns Corporation, Tokyo.
- II. The patent proprietor (appellant) lodged an appeal against this decision.
- III. Oral proceedings took place before the Board by means of video-conference on 29 June 2021.
- IV. The appellant requested that the decision under appeal be set aside and that the opposition be rejected, or in the alternative that the patent be maintained in amended form according to one of the auxiliary requests 1 - 4 filed with the letter of 17 October 2021.
- V. The respondent (opponent) requested that the appeal be dismissed.
- VI. a) Main request

Claim 1 as granted reads:

"(1) A deforming press with a device (1) for controllably supplying a metal wire (F),
(2) including bottom guide discs (3, 4) and top guide discs (7, 8) for the metal wire (F) to be supplied,
(3) said discs (3, 4, 7, 8) having a circumferential slot (5, 6, 9, 10),
(4) wherein said device comprises wire (F) supplying

tubular guides (2) and

(5) said bottom (3, 4) and top (7, 8) discs are supported by gear wheels (19, 20) driven supporting bottom (18) and top (20) shafts,

characterized in that

(6) each bottom shaft (18) is operatively coupled to a respective controllable driving motor (15, 16) and

(7) that each of said top discs (7, 8) is supported by a respective slide (11, 12) which may slide with respect to a body of said device (1) and

(8) that each slide (11, 12) may be upward and downward driven (m) by a respective driving cylinder-piston unit (13, 14)."

(Feature references added in bold by the Board)

b) First auxiliary request

Claim 1 reads:

"A deforming press with a device (1) for controllably supplying a metal wire (F), including a bottom guide disc (3, 4) and a top guide disc (7, 8) for the metal wire (F) to be supplied, said discs (3, 4, 7, 8) having a circumferential slot (5, 6, 9, 10), wherein said device comprises wire (F) supplying tubular guides (2), that said bottom (3, 4) and top (7, 8) discs are supported by gear wheel (19) driven supporting bottom (18) and top (20) shafts, that said bottom shaft (18) is operatively coupled to a controllable driving motor (15, 16) and that each said top disc (7, 8) is supported by a slide (11, 12) which may slide with respect to a body of said device (1) and that said slide (11, 12) may be upward and downward

driven by a driving cylinder-piston unit (13, 14); each driving motor (15, 16) being operatively coupled to a respective transmission assembly (17, 22) each coupled to the shaft (18) actuating the corresponding disc (3, 4) and that said shaft (18) supports said gearwheel (19) for driving said top disc (7, 8) supporting top shaft (20); characterized in that each said disc (3, 4, 7, 8) rotatively driving transmission assembly (17, 22) are arranged supporting brackets (23, 24) supporting detecting (25, 26) and signaling means, such as encoder means."

c) Second auxiliary request

Claim 1 reads:

"A deforming press with a device (1) for controllably supplying a metal wire (F), including a bottom guide disc (3, 4) and a top guide disc (7, 8) for the metal wire (F) to be supplied, said discs (3, 4, 7, 8) having a circumferential slot (5, 6, 9, 10), wherein said device comprises wire (F) supplying tubular guides (2), that said bottom (3, 4) and top (7, 8) discs are supported by gear wheel (19) driven supporting bottom (18) and top (20) shafts, that said bottom shaft (18) is operatively coupled to a controllable driving motor (15, 16) and that each said top disc (7, 8) is supported by a slide (11, 12) which may slide with respect to a body of said device (1) and that said slide (11, 12) may be upward and downward driven by a driving cylinder-piston unit (13, 14); each driving motor (15, 16) being operatively coupled to a respective transmission assembly (17, 22) each coupled to the shaft (18) actuating the corresponding

disc (3, 4) and that said shaft (18) supports said gearwheel (19) for driving said top disc (7, 8) supporting top shaft (20); characterized in that each said disc (3, 4, 7, 8) rotatively driving transmission assembly (17, 22) are arranged supporting brackets (23, 24) supporting detecting (25, 26) and signaling means, such as encoder means."

d) Third auxiliary request

Claim 1 reads:

"A deforming press with a device (1) for controllably supplying a metal wire (F), including a bottom guide disc (3, 4) and a top guide disc (7, 8) for the metal wire (F) to be supplied, said discs (3, 4, 7, 8) having a circumferential slot (5, 6, 9, 10), wherein said device comprises wire (F) supplying tubular guides (2), that said bottom (3, 4) and top (7, 8) discs are supported by gear wheel (19) driven supporting bottom (18) and top (20) shafts, that said bottom shaft (18) is operatively coupled to a controllable driving motor (15, 16) and that each said top disc (7, 8) is supported by a slide (11, 12) which may slide with respect to a body of said device (1) and that said slide (11, 12) may be upward and downward driven by a driving cylinder-piston unit (13, 14); each driving motor (15, 16) being operatively coupled to a respective transmission assembly (17, 22) each coupled to the shaft (18) actuating the corresponding disc (3, 4) and that said shaft (18) supports said gearwheel (19) for driving said top disc (7, 8) supporting top shaft (20); characterized in that each said disc (3, 4, 7, 8) rotatively driving transmission

assembly (17, 22) are arranged supporting brackets (23, 24) supporting detecting (25, 26) and signaling means, such as encoder means."

e) Fourth auxiliary request

Claim 1 reads:

"A deforming press with a device (1) for controllably supplying a metal wire (F), including a bottom guide disc (3, 4) and a top guide disc (7, 8) for the metal wire (F) to be supplied, said discs (3, 4, 7, 8) having a circumferential slot (5, 6, 9, 10), wherein said device comprises wire (F) supplying tubular guides (2), that said bottom (3, 4) and top (7, 8) discs are supported by gear wheel (19) driven supporting bottom (18) and top (20) shafts, that said bottom shaft (18) is operatively coupled to a controllable driving motor (15, 16) and that each said top disc (7, 8) is supported by a slide (11, 12) which may slide with respect to a body of said device (1) and that said slide (11, 12) may be upward and downward driven by a driving cylinder-piston unit (13, 14); each driving motor (15, 16) being operatively coupled to a respective transmission assembly (17, 22) each coupled to the shaft (18) actuating the corresponding disc (3, 4) and that said shaft (18) supports said gearwheel (19) for driving said top disc (7, 8) supporting top shaft (20); characterized in that each said disc (3, 4, 7, 8) rotatively driving transmission assembly (17, 22) are arranged supporting brackets (23, 24) supporting detecting (25, 26) and signaling means, such as encoder means."

VII. The appellant (patent proprietor) argued essentially as follows:

a) Main request

i) Public availability of the alleged prior use

It had not been proven up to the hilt by the respondent that the machine sold to the Correns Corporation had been publicly available from the end of the year 2001. The documents W1-3, W1-4, W1-7 and W1-8 were documents to which only the respondent had access. They were also completely devoid of any element capable of proving their authenticity.

Correns Corporation, the company to which the machine was sent, was the opponent's Japanese sales trade representative and thus could not be considered as a third person. It was inherent that Correns Corporation was therefore bound to secrecy.

The appellant doubted that the scheduled delivery and installation was publicly made at the end customer Chita Kogyo factory in Kagamihara (JP).

ii) Disclosure of the alleged prior use

The alleged prior use showed neither a deforming press nor a cylinder-piston unit nor a controllable driving motor as required by the claim.

The subject-matter of claim 1 was thus new.

b) Auxiliary requests - admissibility

The auxiliary requests were filed in response to the

Board's communication dated 17 April 2020. According to decision T 1477/15 and the principle of party disposition, the Board did not have any discretion not to admit the new requests. Moreover, they were a reaction to the new clarity objection raised by the Board in its communication under Article 15(1) RPBA.

Thus they should be admitted into the proceedings.

VIII. The respondent argued essentially as follows:

a) Main request

i) Public availability of the prior use

The submitted evidence was sufficient to prove the prior use. Any gaps were arbitrarily constructed. In this context, it was emphasised that the machine sold, type FUL 103 with the machine number 2 2081 005, actually reached the end customer Chita Kogyo factory and had been in use at least until 2016. A confidentiality agreement did not exist. It offered evidence by hearing the witness M. Grauer.

ii) Disclosure of the alleged prior use

The prior use clearly disclosed a deforming press
(1) A deforming press ("spring coiling machine") with a device for controllably supplying a metal wire (see W1-1, Fig. 6-1, device 2),
(2) including bottom guide discs and top guide discs for the metal wire to be supplied (see W1-1, Figs. 6-1 and 6-3, also W1-6, right hand side),
(3) said discs having a circumferential slot (W1-6),
(4) wherein said device comprises wire supplying tubular guides (W1-1, Fig. 6-3, guides 3 and 4) and

(5) said bottom and top discs were supported by gear wheels driven supporting bottom and top shafts (see W1-6), wherein

(6) each bottom shaft was operatively coupled to a respective controllable driving motor (see W1-6 and W1-5, p. 9 where the motor was listed as being an "AC-Servomotor" and was, hence, "controllable") and

(7) that each of said top discs was supported by a respective slide which may slide with respect to a body of said device (see W1-6) and

(8) that each slide may be upward and downward driven (m) by a respective driving cylinder-piston unit (see W1-1, section 6.6.2 and W1-6).

Therefore all features of claim 1 were known from the prior use.

b) Auxiliary requests

These were filed after the notification of the summons to oral proceedings. It was correct that the Board had raised an objection under Article 84 EPC because of lack of antecedence basis for the feature "each said bottom disc rotatively driving assembly" (see communication pursuant to Article 15(1) RPBA, point 4). The modifications however went beyond what was necessary to reply to that objection and raised further objections under Articles 84, 123(2) and (3) EPC. Moreover, the appellant had not explained why exceptional circumstances existed let alone justified these with cogent reasons. These requests were not, therefore, to be admitted into the proceedings.

Reasons for the Decision

1. Main request - novelty.
 - 1.1 Public availability of the alleged prior use.
 - 1.1.1 Since the alleged sale and delivery of a spring coiling machine type FUL 103 with the machine number 2 2081 005 to Correns Corporation and then to the end customer Chita Kogyo, Kagamihara Factory is completely out of the sphere of the appellant, according to the case law of the Boards of Appeal, proof has to be provided "up to the hilt" by the respondent. The determination of the prior use thus requires that the facts giving rise to the prior use must be established without gaps in the chain of evidence (see: T 472/92, OJ 1998, 161, point 3.1 of the Reasons); however, this does not mean that the opponent has to provide each and every theoretically possible piece of evidence. Instead, it is sufficient that the evidence put forward convinces the Board (see: T 483/17, decision of 11 September 2020, point 2.1 of the Reasons).
 - 1.1.2 On the other hand, a prior use has not been sufficiently proven if the patent proprietor successfully points out any inconsistencies or draws attention to any gaps in the opponents chain of proof (see T 472/92 and T 483/17, op. cit.).
 - 1.1.3 Applying these principles, the Board considers it established that the alleged prior use took place.

The documents provided by the respondent prove that, under the order number M0183 (see W1-2) a FUL 103 spring coiling machine having the machine number 2 2081

005 has been ordered by Correns Corporation (see W1-3). The machine was designated for the end customer Chita Kogyo, Kagamihara Factory (see W1-4). Furthermore, document W1.13 proves this machine was mounted and started operating in November/December 2001 at Chita Kogyo, Kagamihara Factory. The instructions in W1-1 relate to version 4 of machine FUL 103 (the document carries the date 12 July 2005) and the instructions in W1-15 relate to a spring coiling machine FUL 103, machine number no 2.2081.005, construction year 2001. Finally W1-14 proves that a FUL 103 spring coiling machine with the machine number 2 2081 005 has been repaired in February/March 2016 in Lebanon (US) for US Chita. Thus, also the respondent's submission that the machine in question was still in use after it had been transferred to US Chita, Lebanon (US) is sufficiently proven.

- 1.1.4 The doubts about the prior use brought forward by the appellant do not point to a gap in the respondent's chain of proof for the following reasons:
- 1.1.5 Since the appellant itself did not claim - and the Board has no reason to believe - that the documents provided by the respondent are not authentic, the absence of elements capable of proving their authenticity does not preclude their evidentiary value. The Board is thus convinced that the content of the documents accurately reflects the actual course of events.
- 1.1.6 The Board notes that the possibilities mentioned by the appellant that the shipment might not have been successful or that the delivered machine might have been refused before installation because of damages during the shipment or dismissed by Correns Corporation

or Chita Kogyo, Kagamihara Factory have no basis in the file.

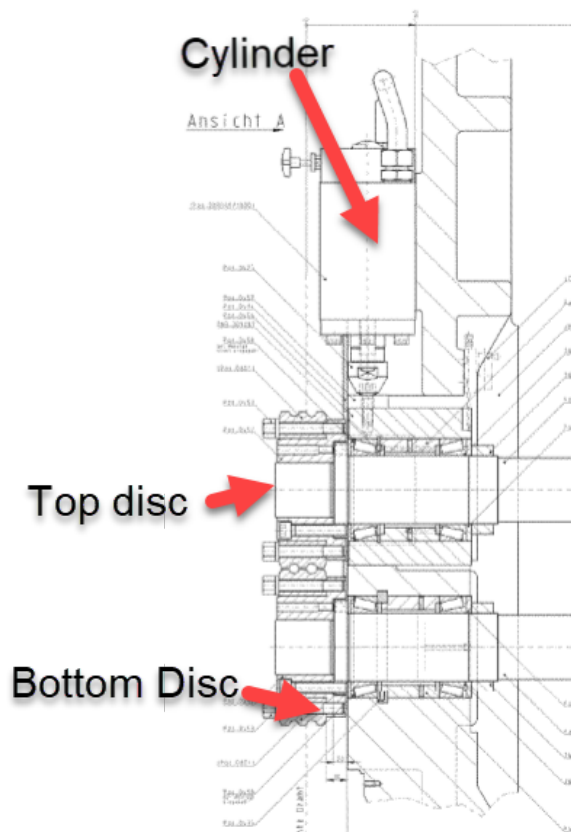
- 1.1.7 The fact that none of the documents proves the actual payment of the machine does not limit the evidential value of the submitted documents. In this respect the Board already emphasised in its decision T 483/17 (op. cit., point 2.3.1 of the Reasons) that any further possibly existing piece of evidence not having been provided does not reduce the significance of the evidence actually submitted. The Board maintains these principles.
- 1.1.8 The same applies to the fact that the respondent provided evidence for only one prior use. In this context the respondent in the oral proceedings before the Board correctly pointed out that a single prior use is sufficient.
- 1.1.9 Finally the appellant's argument fails whereby Correns Corporation was the opponent's Japanese trade representative and thus not external and at least implicitly bound to secrecy. The machine sold was designated to the - indisputably external - end customer Chita Kogyo. Therefore the relationship between the respondent and Correns Corporation is not relevant. A secrecy agreement between the respondent and Chita Kogyo has not been argued.

1.2 Disclosure of the prior use

The prior use concerns a wire coiling machine. The appellant disputed that the following features were known from this prior use:

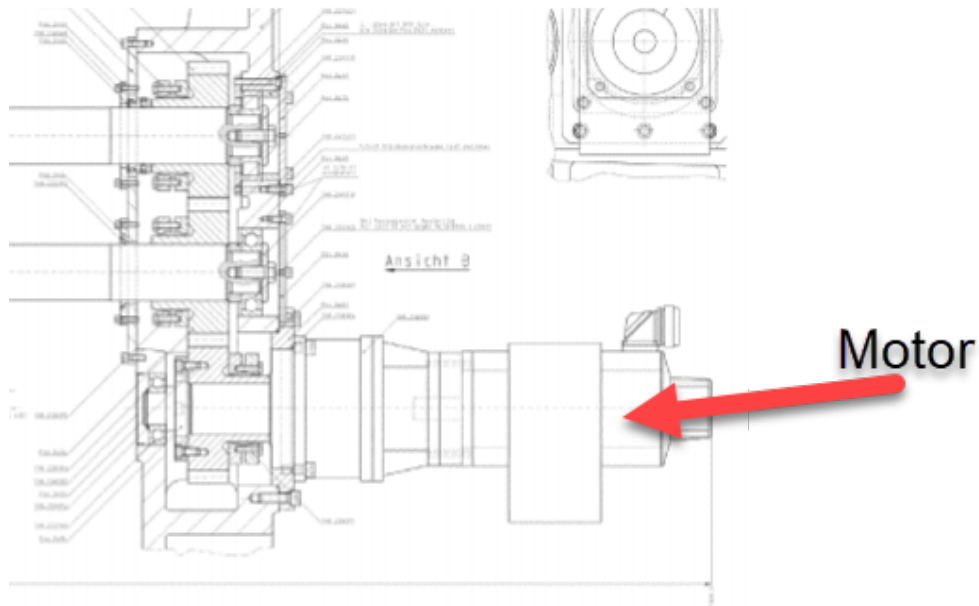
- 1) a deforming press
- 2) a cylinder-piston unit
- 3) a controllable driving motor

The Board however considers that the very indication of the machine as a "wire coiling device" indicates that it is a type of deforming press. Moreover, the cylinder unit is clearly visible in W1-6, see excerpt below from W1-6. The top and bottom guide discs are shown and on both a circumferential slot is evident.



In the figure below (also an excerpt from W1-6) the motor is visible and shown with a gearwheel on its output shaft. The gearwheel engages with a gear on the bottom shaft which in turn engages with a gear on the top shaft. In the parts list W 1-5 (see p. 9) the motor is listed as an "AC-Servomotor" and is therefore

"controllable".



Hence, features 1, 2 and 3 of claim 1 are known and the appellant's arguments are thus not persuasive.

The subject-matter of claim 1 is thus not new with respect to the public prior use.

2. Auxiliary requests - admissibility

These were filed after notification of the summons to oral proceedings which was dated 14 April 2020. Hence, Article 13(2) RPBA 2020 is applicable. According to this provision, any amendment to a party's appeal case after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

The appellant did not identify any exceptional circumstances nor did they provide any cogent reasons justifying them.

The argument that the Board did not have any discretion not to admit the requests is explicitly contradicted by Article 13(1) RPBA 2020. The decision cited by the appellant, T 1477/15, states at reasons 14 that the Board has no power to object to the withdrawal of auxiliary requests. The present Board agrees with this finding, the present case is however not comparable because the auxiliary requests were not simply withdrawn but replaced with new requests. It is the introduction of new requests that the Board finds objectionable.

It is correct that the Board had raised a new objection under Article 84 EPC because of lack of antecedence basis for the feature "each said bottom disc rotatively driving assembly" (see communication pursuant to Article 15(1) RPBA, point 4). However, the new auxiliary requests went beyond the modifications that would have been necessary to reply to the Board's objection at least insofar as granted claim 1 reads: "each said bottom shaft ...". This has been altered to read "said bottom shaft ...", i.e. without requiring that "each" bottom shaft was operatively coupled. This modification, however, went beyond what was necessary to reply to the objection by the Board and raised further objections under Articles 84, 123(2) and (3) EPC.

Hence, the auxiliary requests were not admitted into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



C. Moser

P. Acton

Decision electronically authenticated