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**Datasheet for the decision
of 14 October 2021**

Case Number: T 1294/19 - 3.2.03

Application Number: 13425097.6

Publication Number: 2821154

IPC: B21B43/00, B21C47/34

Language of the proceedings: EN

Title of invention:

Method for handling long rolled products coming from different strands of a rolling mill

Patent Proprietor:

Primetals Technologies Austria GmbH

Opponent:

Danieli & C. Officine Meccaniche S.p.A.

Headword:

Relevant legal provisions:

RPBA Art. 12(2), 12(4)

RPBA 2020 Art. 13(2)

EPC Art. 56

Keyword:

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

Statement of grounds of appeal - party's complete appeal case

Amendment after summons - exceptional circumstances (no)

Inventive step - (yes)

Decisions cited:

Catchword:



Beschwerdekammern

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Case Number: T 1294/19 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 14 October 2021

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
14 February 2019 concerning maintenance of the
European Patent No. 2821154 in amended form.**

Composition of the Board:

Chairman C. Herberhold
Members: G. Patton
F. Bostedt

Summary of Facts and Submissions

- I. European patent No. 2 821 154 B1 (hereinafter "the patent") relates to an apparatus for receiving, transporting and discharging long metal products such as bars, rods or the like, a system for handling a plurality of long products and a method for handling at least two long products.
- II. An opposition was filed against the patent as a whole, on the basis of Article 100(a) EPC (lack of novelty and inventive step), Article 100(b) EPC (insufficiency of disclosure) and Article 100(c) EPC (unallowable amendments).

The Opposition Division held that what was then the fifth auxiliary request, filed as the third auxiliary request with the letter dated 18 September 2018, fulfilled the requirements of the EPC.

The opponent lodged an appeal against the Opposition Division's decision to maintain the patent in amended form in accordance with the then fifth auxiliary request.

- III. Oral proceedings were held before the Board on 14 October 2021. For matters that arose during the oral proceedings, in particular the parties' requests and the issues discussed with the parties, reference is made to the minutes.

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

IV. The opponent (hereinafter the "appellant") requested

that the decision be set aside and
that European patent No. 2 821 154 be revoked.

The patent proprietor (hereinafter the "respondent")
requested

that the appeal be dismissed (main request),
subsidiarily,
that the patent be maintained on the basis of one
of the sets of claims filed as the sixth to tenth
auxiliary requests with the reply dated
31 October 2019 (first to fifth auxiliary
requests).

The respondent further requested that

the case be remitted to the Opposition Division if
the main request was not found allowable or if
late-filed documents D17 and D18 were admitted into
the proceedings.

V. Claim 1 of the **main request** reads as follows, with the
feature numbering (a) to (d) as used by the parties:

"Method for handling at least two long products (P1,P2)
(a) preferably coming from two different strands of a
rolling mill,
(b) characterized in that the method comprises the
following steps:
the method comprising the step of:
(c) a) introducing said at least two long products in
different channels of the same drum (10, 12)
simultaneously,

(d) b) subsequently discharging said at least two long products on the same notch of a cooling bed (14)."

The auxiliary requests play no part in this decision.

VI. The following documents considered in the opposition proceedings are relevant to the present decision:

D1: IT 1 225 986 B;
D2: WO 98/31483 A1;
D3: EP 0 553 930 A1;
D4: WO 02/070156 A1;
D5: US 3,497,084;
D6: US 4,054,047;
D7: EP 1 877 203 B1;
D8: WO 2007/003331 A1;
D9: IT 1051129;
D10: IT UD93A000149;
D11: US 7,219,521 B1;
D12: US 2013/0074567 A1;
D13: US 3,610,437;
D14: US 5,944,478;
D15: US 2007/0234774 A1; and
D16: Results of a file inspection at the USPTO of application number 14/902,994, 66 pages.

The appellant filed the following documents D17 and D18 for the first time in the proceedings with its statement setting out the grounds of appeal:

D17: LU 44263 A1
D18: IT VI2012A000001 A1

VII. The appellant essentially argued as follows:

Admittance of D17 and D18

Documents D17 and D18 were *prima facie* highly relevant for assessing the inventive step of the claimed subject-matter.

A proper defence strategy could not be devised until the decision under appeal had been received. This was because the Opposition Division's statement in the communication dated 13 March 2018 regarding claim 12 of the patent as granted (which corresponds to claim 1 of the current main request) had been too short, meaning the appellant could not respond properly during the opposition proceedings. The documents were thus submitted at the earliest possible moment, namely with the statement setting out the grounds of appeal.

The respondent had sufficient time to react to the introduction of D17 and D18 during the appeal proceedings.

Hence, documents D17 and D18 should be admitted into the proceedings.

Main request - inventive step

Feature (d) was the only distinguishing feature of claim 1 of the main request over document D1, taken as the closest prior art.

No problem to be solved could be defined on the basis of this distinguishing feature. Hence, for this reason alone, no inventive step could be acknowledged for the claimed subject-matter.

At best, the problem to be solved could be defined as providing an alternative method for handling long products.

Feature (d) belonged to the skilled person's common general knowledge, as confirmed by D2, or alternatively was disclosed by D1, page 2, second paragraph, or any of documents D2 to D16. Hence, distinguishing feature (d) could not justify an inventive step.

Main request - amendments and sufficiency of disclosure

The main request did not fulfil the requirements of Articles 123(2) and 83 EPC for the reasons provided during the opposition proceedings.

VIII. The respondent essentially argued as follows:

Admittance of D17 and D18

Documents D17 and D18 were *prima facie* irrelevant.

Moreover, the Opposition Division explicitly stated in its preliminary opinion provided prior to the oral proceedings that the appellant's objections against claim 12 of the patent as granted (claim 1 of the current main request) were not convincing in view of documents D1 to D15. Hence, the appellant should have reacted to this opinion and filed documents D17 and D18 during the opposition proceedings.

Nothing in the decision under appeal justified filing documents D17 and D18 for the first time in the appeal proceedings.

Main request - inventive step

Feature (d) was the only distinguishing feature of claim 1 of the main request over document D1, taken as the closest prior art.

In view of the associated technical effect, the problem to be solved was increasing the plant's production rate.

The late-raised inventive-step objection in relation to other passages of D1 should not be admitted into the proceedings. No evidence of the common general knowledge had been filed. Both D2 and D5 are patent documents, so their disclosure did not represent the skilled person's common general knowledge. D2 taught away from the claimed solution and the disclosure of D5 was not compatible with that of D1. At any rate, D5 did not disclose feature (d). An inventive step was thus to be acknowledged for the subject-matter of claim 1 of the main request.

Main request - amendments and sufficiency of disclosure

As regards the objections of unallowable amendments and insufficiency of disclosure, the appellant merely referred to previous submissions made in the opposition proceedings. This did not fulfil the requirements of Article 12(2) RPBA 2007 in order for them to be taken into account in the appeal proceedings.

Reasons for the Decision

1. *Admittance of documents D17 or D18*
 - 1.1 The appellant filed documents D17 and D18 for the first time with its statement setting out the grounds of appeal. Hence, their admission into the appeal proceedings is subject to the conditions set out in Article 12(4) RPBA 2007.
 - 1.2 According to the appellant, documents D17 (see for instance Figure 2) and D18 (see for instance Figures 2, 4 and 7) were aimed at showing that feature (d), which was regarded as the only distinguishing feature over the closest prior art D1, was known and obvious in the relevant technical field. Hence, these documents were *prima facie* highly relevant for assessing the inventive step of the claimed subject-matter and should be admitted into the proceedings.
 - 1.3 However, the *prima facie* relevance of late-filed submissions is not the leading criterion when applying Article 12(4) RPBA 2007, which states:

*"Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which **could have been presented** or were not admitted in the first instance proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2)" (emphasis by the Board).*

In this respect the issues at stake are whether the appellant could, i.e. "should" in a more lenient

approach, have submitted documents D17 and D18 during the first-instance proceedings, and whether and to what extent filing D17 and D18 can be regarded as an appropriate reaction to the decision under appeal.

As put forward by the respondent, the Opposition Division clearly stated in its communication dated 13 March 2018 (point 4, last paragraph, addressing the notice of opposition; see points IV.3, IV.4 and IV.6) that the appellant's novelty and inventive-step arguments against claim 1 of the current main request (claim 12 of the patent as granted) were not convincing in view of the documents cited up to that point, i.e. D1 to D15. The appellant was made aware of the importance of this issue at the latest with the respondent's letter dated 18 September 2018, in particular in view of the fact that the third auxiliary request, corresponding to what now constitutes the main request in the appeal proceedings, was filed along with said letter (see item V of the letter). The appellant chose not to react, either within the time available before the oral proceedings held on 19 November 2018 or at the oral proceedings before the Opposition Division. As a consequence, the Board considers that the appellant not only could but should have filed documents D17 and D18 during the opposition proceedings.

- 1.4 At the oral proceedings before the Board, the appellant argued that the Opposition Division's statement in the communication dated 13 March 2018 had been too short to allow the appellant to devise an adequate defence strategy. According to the appellant, the closest prior art had not been identified, the distinguishing features had not been stated and the problem-solution approach had not been applied. The appellant added that

it had been made aware of these points for the first time during the oral proceedings before the Opposition Division and thus had been unable to devise a proper defence strategy until it received the decision under appeal. Documents D17 and D18 were therefore submitted in due time with the statement setting out the grounds of appeal.

Lastly, the appellant considered that the respondent had had sufficient time to react during the appeal proceedings, which it had done by filing five new auxiliary requests with its reply.

- 1.5 The Board does not share the appellant's view for the reasons already given under point 1.3 above. In particular, the Opposition Division made it clear in its preliminary opinion that none of the novelty and inventive-step objections against claim 12 of the patent as granted (claim 1 of the current main request) based on documents D1 to D15 was convincing. In this respect, the Board notes that the Opposition Division did not have to provide full reasoning for this finding as the appellant itself had made a general reference in its notice of opposition (point IV.6) to the objections raised against product claim 1 of the patent as granted without addressing method claim 12 of the patent as granted in detail. Even in its last letter dated 17 September 2018 in preparation for the oral proceedings before the Opposition Division, the appellant merely made a general reference to objections raised against claim 1 of the patent as granted; see point I.3.

Furthermore, the appellant did not point to any specific arguments exchanged during the discussions at the oral proceedings before the Opposition Division

which would have taken the appellant by surprise. When claim 1 of the current main request (claim 12 of the patent as granted, corresponding to claim 1 of the then fifth auxiliary request) was discussed at the oral proceedings, the appellant was given the opportunity to clarify and flesh out its objections (see minutes, page 5, second to fourth paragraphs). In this respect, it based its arguments on D1, and the respondent's counter-arguments were essentially the same as those already provided in writing in its submissions dated 8 June 2017 (page 4, third paragraph under the heading "*Grounds of opposition according to Art. 54, 56 and Art. 100(a) EPC*") and in its letter dated 18 September 2018 (page 2, fifth paragraph and page 4, second paragraph). The decision under appeal reflects this exchange of arguments at the oral proceedings (see point 30), so they cannot be considered surprising for the appellant.

Hence, there is nothing in the decision under appeal that can be deemed to justify filing documents D17 and D18 for the first time in the appeal proceedings.

The fact that the respondent had allegedly had enough time to react in the appeal proceedings to the new objections raised on the basis of documents D17 and D18 is immaterial when assessing the admittance of those documents pursuant to Article 12(4) RPBA 2007.

- 1.6 In view of the above, the late-filed documents D17 and D18 are held inadmissible (Article 12(4) RPBA 2007).

2. *Main request - inventive step*

The appellant contested that the subject-matter of claim 1 of the main request involved an inventive step starting from D1 as the closest prior art in combination with:

- further teaching of D1
- the common general knowledge as illustrated and confirmed by document D2
- the teaching of document D2
- the teaching of document D5
- the teaching of any of documents D3, D4 and D6 to D16 or
- the teaching of documents D17 or D18

As regards the combination of D1 with documents D17 or D18, reference is made to point 1 above. Hence, those objections will not be addressed in the following.

2.1 Closest prior art

The Board agrees with the parties that D1 can be considered suitable as the closest prior art for claim 1 of the main request since, like claim 1, it concerns a method for handling at least two long products; see Figure 2.

2.2 Distinguishing features

Both parties agreed that feature (d) (method step b), i.e. "subsequently discharging said at least two long products on the same notch of a cooling bed") was the only distinguishing feature of claim 1 over D1. The Board shares this view; see Figures 1 and 2 (decision under appeal, point 30, first three paragraphs).

2.3 Technical effect(s) - problem to be solved

2.3.1 The technical effect associated with feature (d) is that there is no need to wait for the following notch of the cooling bed to discharge the second long product. In doing so, the method for handling the products is sped up; see contested patent, paragraph [0011].

2.3.2 The appellant contested that feature (d) allowed the method for handling the long products to be sped up.

It argued that the need to wait for the following notch of the cooling bed in order to discharge the second product did not arise in the method of D1 as the two long products were discharged substantially at the same time on two corresponding adjacent notches of the cooling bed. The issue of waiting could only possibly arise when the third and fourth long products were discharged, but even in that case it was unlikely that any waiting would be needed due to the usual synchronisation between the rotation speed of the drum and the advancing speed of the cooling bed.

In a first line of reasoning, presented at the oral proceedings, the appellant noted that the technical effect discussed in paragraph [0011] of the patent was not disclosed in combination with feature (d), which was recited only in paragraph [0056]. For the appellant, dropping two long products on the same notch necessarily implied that the cooling time took longer since the products lay next to each other, meaning that the overall process was being slowed down instead of sped up. Hence, feature (d) did not solve any technical problem, which was a requirement for acknowledging inventive step. At any rate, feature (d) could not

speed up the production plant on its own, i.e. further features not included in claim 1 were essential.

In a second line of reasoning, the appellant considered the claimed solution to be only one of several options at the skilled person's disposal for handling long products. The problem to be solved, also formulated at the oral proceedings, could then at best be providing an alternative method for handling long products.

- 2.3.3 The Board does not share the appellant's view, instead agreeing with the respondent that the bottleneck in a long-product production plant is the rotary drum. Long products have to be discharged from the rotary drum onto the cooling bed in such a manner as to deal with the incoming long products and avoid slowing down the production of the rolling mill. Once discharged onto the cooling beds, the long products do not impact the production speed any longer as they can be stored elsewhere. Hence, distinguishing feature (d) has the technical effect of increasing the plant's production rate.

However, even though the Board is convinced that it is indeed credible that the claimed method would increase the plant's production rate compared with the plant in D1, in the following the Board will accept the appellant's formulation of a less ambitious problem to be solved, namely providing an alternative method for handling long products, for the sake of discussion.

- 2.4 Combination with further teaching of D1

- 2.4.1 For the first time at the oral proceedings before the Board, the appellant alleged that feature (d) was disclosed in D1, page 2, second paragraph, which was

describing another embodiment of D1. Combining this passage with the rest of D1, which disclosed features (a) to (c), rendered the claimed subject-matter obvious to the skilled person.

2.4.2 This new objection represents an amendment to the appellant's appeal case made at the latest possible stage in the opposition-appeal proceedings. In addition, it is based on passages of D1 for which no translation into an official EPO language has ever been filed. Its admission into the proceedings is therefore subject to the requirements of Article 13(2) RPBA 2020. Since the appellant did not provide any reasons which could justify exceptional circumstances for the late submission despite being explicitly asked to do so during the oral proceedings before the Board, the objection is not admitted into the proceedings pursuant to Article 13(2) RPBA 2020.

2.5 Combination with the common general knowledge as illustrated and confirmed by document D2

2.5.1 The appellant considered the claimed solution to be obvious for the skilled person faced with the problem to be solved as it belonged to the skilled person's common general knowledge. This was confirmed by D2, which disclosed, on page 2, lines 8-9, that the claimed solution was a common procedure in the field of handling long products before the filing date of the contested patent.

2.5.2 The Board does not share this view. Document D2 is a patent document, which as such is generally not evidence of the skilled person's common general knowledge. In the case in hand, there is no indication that D2 discloses any such common general knowledge.

The same applies for document D5. It follows that no evidence of the skilled person's common general knowledge has been provided and the appellant's arguments thus amount to mere allegations.

Furthermore, and contrary to the appellant's view, D2 does not disclose that the claimed solution was a common procedure in the field of handling long products before the filing date of the contested patent. D2, page 2, lines 8-9, referred to by the appellant, merely discloses that it was known to discharge two bars at a time onto the underlying cooling bed. This does not amount to disclosing the discharge of two bars at a time onto the same notch, as claimed. As a result of the expression used ("*This solution...*"), the passage unambiguously refers to the technical disclosure of IT-83489A/88, which is the closest prior art D1. As mentioned under point 2.2 above, feature (d) is the distinguishing feature of claim 1 over D1.

Lastly, the Board agrees with the respondent that the "risk of cotting" mentioned on page 2, line 9 of D2 can also occur when discharging a single long product onto a notch of a cooling bed.

2.6 Combination with the teaching of document D2

As put forward in the decision under appeal, point 30, and as argued by the respondent, D2 explicitly teaches away from the claimed solution. The fact that D2 aims at avoiding discharging two bars for each tooth of the cooling bed (see page 4, lines 20-21, claim 1) does not mean *a contrario* that doing so would be a usual and known practice for the skilled person in the technical field under discussion, as argued by the appellant (see also point 2.5.2 above).

2.7 Combination with the teaching of document D5

2.7.1 According to the appellant, claim 1 did not specify how the long products were discharged onto the same notch. It argued that claim 1 did not exclude the possibility of feature (c) being repeated and of the long products in the same channel being bundled together. For these reasons, document D5 disclosed distinguishing feature (d), i.e. discharging each bundle onto a corresponding notch of the same bed. Combining the teaching of D5 with the method of D1 then rendered the claimed subject-matter obvious.

2.7.2 The Board does not share this view for the very reason that document D5 does not relate to the cooling of long products ("bars" 2), as put forward by the respondent. Hence, D5 does not disclose discharging the products (2) onto a cooling bed in accordance with feature (d), but rather discloses discharging them onto a transfer chain (86); see column 4, lines 26-73. As also argued by the respondent, it is foreseen in one embodiment that an operator performs the bundling in D5; see Figure 1 and column 4, lines 27-30. Hence, the long products had obviously already cooled before they reached a pocket (68) of the drum ("wheel" 60). As a consequence, D5 neither discloses nor suggests the claimed solution.

2.8 In combination with any of documents D3, D4 and D6 to D16

The objections as to lack of inventive step raised in the statement setting out the grounds of appeal (point IV.3) on the basis of documents D3, D4 and D6 to D16 are not dealt with in the decision under appeal, point

30, in relation to the main request. The appellant gave no reason why it had not raised them during the opposition proceedings.

Furthermore, the appellant did not give any reasons in the statement setting out the grounds as to why and how the disclosure of any one of these documents should be combined with the method disclosed in the closest prior art D1.

Consequently, these objections are not taken into account in the appeal proceedings pursuant to Article 12(4) RPBA 2007 because they do not meet the requirements of Article 12(2) RPBA 2007 (in this respect, see also the almost identically worded requirements of Article 12(3) RPBA 2020).

2.9 In view of the above, the Board sees no reason to deviate from the finding in point 30 of the reasons of the decision under appeal that the subject-matter of claim 1 of the main request is inventive (Article 56 EPC).

3. *Main request - amendments and sufficiency of disclosure*

The appellant failed to provide any arguments as to why the reasons given in the decision under appeal on these matters (points 13, 14 and 29) were incorrect. According to established case law, a mere reference to previous submissions in the opposition proceedings is insufficient in this respect.

Moreover, the Board notes that the appellant did not substantiate any objection raised against the current main request on the basis of Articles 123(2) and 83 EPC in its statement setting out the grounds of appeal. Its

arguments in support of these objections did not refer to the then fifth auxiliary request considered in the decision under appeal.

Hence, these objections are not taken into account in the appeal proceedings either, pursuant to Article 12(4) in conjunction with Article 12(2) RPBA 2007 (in this respect, see also Article 12(3) RPBA 2020).

4. *Further requests*

In view of the above, the respondent's request to remit the case to the Opposition Division is moot and there is no need to address the first to fifth auxiliary requests in the present decision.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Spira

C. Herberhold

Decision electronically authenticated