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Datasheet for the decision of 29 November 2021

Case Number: T 1755/19 - 3.2.03

Application Number: 10794067.8

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IPC: B21B45/02, B21B39/14

Language of the proceedings: EN

Title of invention:
COOLING DEVICE FOR STEEL SHEET, AND MANUFACTURING DEVICE AND MANUFACTURING METHOD FOR HOT-ROLLED STEEL SHEET

Patent Proprietor:
NIPPON STEEL CORPORATION

Opponent:
SMS group GmbH

Headword:

Relevant legal provisions:
EPC Art. 111(1), 123(2)
RPBA Art. 12(4)
RPBA 2020 Art. 11, 13(2)

Keyword:
Main request and auxiliary request 1 - extension beyond the content of the application as filed (yes)
Late-filed auxiliary request 1 - request identical to request not admitted in first instance proceedings
Amendment after summons - exceptional circumstances (yes)
Auxiliary request 1a - extension beyond the content of the application as filed (no)
Remittal - (yes)

Decisions cited:
T 0172/17

Catchword:

Europäisches Patentamt
European Patent Office
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Beschwerdekammern

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Case Number: T 1755/19 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 29 November 2021

Appellant: (Patent Proprietor)	NIPPON STEEL CORPORATION 6-1, Marunouchi 2-chome, Chiyoda-ku, Tokyo (JP)
Representative:	Zimmermann & Partner Patentanwälte mbB Postfach 330 920 80069 München (DE)
Respondent: (Opponent)	SMS group GmbH Eduard-Schloemann-Strasse 4 40237 Düsseldorf (DE)
Representative:	Kross, Ulrich Hemmerich & Kollegen Patentanwälte Hammerstraße 2 57072 Siegen (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 16 April 2019 revoking European patent No. 2450116 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	C. Herberhold
Members:	G. Patton
	N. Obrovski

Summary of Facts and Submissions

I. European patent No. 2 450 116 B1 (hereinafter "the patent") relates to a cooling apparatus for a steel sheet, and to an apparatus and a method for manufacturing a hot-rolled steel sheet.

II. An opposition was filed against the patent as a whole, based on Article 100(a) EPC (lack of novelty and lack of inventive step) and Article 100(c) EPC (unallowable amendments).

The Opposition Division held that what was then the main request and the first and third to sixth auxiliary requests did not fulfil the requirements of Article 123(2) EPC. It did not admit the late-filed second auxiliary request on the grounds that it did not *prima facie* fulfil the requirements of Article 123(2) EPC, nor did it allow any further request from the patent proprietor.

The patent was revoked and the patent proprietor lodged an appeal against the Opposition Division's decision.

III. In a communication pursuant to Article 15(1) RPBA 2020 annexed to the summons to oral proceedings dated 28 January 2021, the Board informed the parties of its preliminary, non-binding opinion that the appeal was likely to be dismissed.

In response, the patent proprietor filed further auxiliary requests 1a, 8 and 9 by letter dated 1 June 2021, to which the opponent reacted by letter dated 28 September 2021.

Oral proceedings were held on 29 November 2021. For matters that arose during the oral proceedings, in particular the issues discussed with the parties and the parties' requests, reference is made to the minutes.

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

IV. The patent proprietor (hereinafter the "appellant") requested that the impugned decision be set aside and that the patent be maintained on the basis of the main request or one of the auxiliary requests, the main request and auxiliary requests 1 to 7 having been filed with the notice of appeal dated 14 June 2019 and auxiliary requests 1a, 8 and 9 having been filed with the submission dated 1 June 2021.

The opponent (hereinafter the "respondent") requested that the appeal be dismissed. It further requested that auxiliary requests 1, 1a, 2, 3, 5, 8 and 9 not be admitted into the proceedings and that the case be immediately remitted to the Opposition Division if any auxiliary request was admitted. It also requested that the case be remitted to the Opposition Division for further prosecution if any of the requests was found to fulfil the requirements of Article 123(2) EPC.

V. Claim 1 of the **main request** reads as follows with the feature numbering used by the parties; the amendments as compared with claim 1 of the application as originally filed are shown in bold with the deletions in strikethrough:

1. A cooling apparatus **(20)** of a steel sheet which is **adapted for being** disposed on a

~~lower~~ **downstream** process side of a final stand **(11g)** in a row of hot finish rolling mills **(11)**~~,~~ and which comprises

1.1 a plurality of cooling nozzles **(21c, 22c)** arranged in a manner capable of cooling a steel sheet **(1)** being transported on transporting rolls **(12)**, wherein

1.1.1 the cooling nozzles are arranged on an upper surface side and a lower surface side of an area in which the steel sheet passes, so as to spray cooling water over the area;

1.2 **the cooling apparatus (20) is provided with** a lower surface guide **(40)** ~~is~~ arranged on the lower surface side, **and**

1.3 **optionally with an upper surface guide (30) arranged on the upper surface side;**

1.2.1 the lower surface guide **(40) and optionally the upper surface guide (30) respectively** comprise~~s~~: inlet holes **(32, 42)** through which the cooling water sprayed from the cooling nozzles ~~on the lower surface side~~ passes; and

1.2.2 outlet holes **(33, 43)** through which the cooling water passes~~, dropping downwardly~~ to be discharged~~; and~~,

characterized in that

1.2.3 **the lower surface guide (40) comprises a guide sheet (41) which is in a sheet shape,**

1.3.3 **optionally the upper surface guide (30) comprises a guide sheet (31) which is in a sheet shape,**

1.2.4 the inlet holes **(32, 42)** and the outlet holes **(33, 43)** are ~~arranged alternately~~ **respectively aligned** in a ~~moving~~ **width** direction of the steel sheet, **forming rows (32A, 42A) of inlet holes and rows (33A, 43A) of outlet holes, respectively;**

1.2.5 **the rows (32A, 42A) of inlet holes and the rows (33A, 43A) of outlet holes are arranged**

alternately in a moving direction of the steel sheet; and

1.2.6 **the rows of outlet holes are provided with devices (33s, 43s) for preventing entering of a steel sheet, by having a part of the guide sheet (31, 41) remain between the outlet holes (33, 43), resulting in a top portion of the transported steel sheet (1) being prevented from entering the outlet holes (33, 43).**

Claim 10 of the **main request** reads as follows:

"The cooling apparatus (20) of a steel sheet according to any one of claims 1 to 9, wherein the upper surface guide (30) comprises, on an upper side of the outlet holes (33), portions (35) forming a water discharging passage which are members extending in the width direction of the steel sheet, comprising a recess-shaped cross section surrounded with members (35a, 35b, 35c), the recess-shaped cross section being opposite to the outlet holes (33); and
rectifying members (36), which are in a protruding shape, are disposed on a part of the portion forming a water discharging passage, the part being opposite to the outlet holes (33)."

Claim 1 of **auxiliary request 1** reads as follows; the amendments as compared with claim 1 of the application as originally filed are shown in bold with the deletions in strikethrough:

1. A cooling apparatus **(20)** of a steel sheet which is **adapted for being** disposed on a ~~lower~~ **downstream** process side of a final stand **(11g)** in a row of hot finish rolling mills **(11)**~~,~~ and which comprises

1.1 a plurality of cooling nozzles **(21c, 22c)** arranged in a manner capable of cooling a steel sheet **(1)** being transported on transporting rolls **(12)**, wherein

1.1.1 the cooling nozzles are arranged on an upper surface side and a lower surface side of an area in which the steel sheet passes, so as to spray cooling water over the area;

1.2' **the cooling apparatus (20) is provided with** a lower surface guide **(40)** ~~is~~ arranged on the lower surface side;

1.2.1' the lower surface guide **(40)** comprises: inlet holes **(42)** through which the cooling water sprayed from the cooling nozzles ~~on the lower surface side~~ passes; and

1.2.2' outlet holes **(43)** through which the cooling water passes, dropping downwardly to be discharged~~; and~~,

characterized in that

1.2.3' **the lower surface guide (40) comprises: a guide sheet (41) which is in a sheet shape; and a portion (45) forming a water supplying and discharging passage, the portion (45) disposed on the lower surface side of the guide sheet (41),**

1.2.4' the inlet holes **(42)** and the outlet holes **(43)** are ~~arranged alternately~~ **respectively aligned** in a ~~moving~~ **width** direction of the steel sheet, **forming rows (42A) of inlet holes and rows (43A) of outlet holes, respectively;**

1.2.5' **the rows (42A) of inlet holes and the rows (43A) of outlet holes are arranged alternately in a moving direction of the steel sheet; and**

1.2.6' **the rows of outlet holes are provided with devices (43s) for preventing entering of a steel sheet, by having a part of the guide sheet (41)**

remain between the outlet holes (43), resulting in a top portion of the transported steel sheet (1) being prevented from entering the outlet holes (43).

Claim 10 of the main request was deleted in auxiliary request 1.

By comparison with claim 1 of auxiliary request 1, feature 1.2.3' was amended as follows in claim 1 of **auxiliary request 1a** (amendments are shown in bold):

1.2.3'' the lower surface guide (40) comprises: a guide sheet (41) which is in a sheet shape **and is provided with the inlet holes (42) and the outlet holes (43)**; and a portion (45) forming a water supplying and discharging passage, the portion (45) disposed on the lower surface side of the guide sheet (41),

In view of the outcome regarding auxiliary request 1a, there is no need to recite the wording of claim 1 of each of auxiliary requests 2 to 9.

VI. The appellant essentially argued as follows (where appropriate, the arguments are discussed in more detail in "Reasons for the Decision" below):

Main request

Claim 1 of the application as originally filed provided a basis for the alternative without an upper surface guide in claim 1 of the main request.

Deleting "*dropping downwardly*" in claim 1 of the main request as compared with claim 1 as originally filed

had a basis in the original description, e.g. paragraph 29, as the discharge of water was disclosed without mentioning "*dropping downwardly*". The feature was not disclosed as being essential in the application as originally filed, was not indispensable for solving the intended problem specified in paragraph 29 of the original description, i.e. appropriately discharging the cooling water, as the water could pass through the outlet holes, and deleting it did not necessitate any modification to the other features of claim 1 as originally filed. At any rate, it was implicit in claim 1 of the main request that the water had to drop downwardly through the outlet holes to be evacuated. Hence, "*dropping downwardly*" was deleted in claim 1 of the main request merely for conciseness; doing so did not lead to an unallowable amendment.

The wording "*forming rows*" in feature 1.2.4 inherently encompassed a causal link between the presence of the inlet holes and the outlets holes and their respective alignment, in the same manner as in paragraph 47 of the application as originally filed with the wording "*to form rows*".

Feature 1.2.5 had a basis in paragraphs 47 and 68 of the application as originally filed.

The portions 35 were aimed at improving water discharge, so they were not inextricably linked to the presence of an upper guide sheet and the arrangement in that sheet of the outlet holes, whose primary purpose was to prevent the entry of the steel sheet. The portions 35 merely represented a preferred embodiment and the guide sheet of the upper surface guide could be provided without said portions 35. Hence, the absence

of the portions in feature 1.2.6 of claim 1 did not lead to an unallowable intermediate generalisation.

Claim 1 as originally filed already specified that the inlet holes and the outlet holes were provided in a general manner in the lower surface guide. Furthermore, paragraph 46 of the original application was a basis for an upper guide sheet without inlet holes and outlet holes. At any rate, in view of the wording of feature 1.2.6, the guide sheet was implicitly provided with the outlet holes. The technical effect of preventing the transported steel sheet from entering the outlet holes, as disclosed in the embodiment in paragraph 48 on which feature 1.2.6 was based, was obtained by feature 1.2.6. Hence, the inlet holes were not inextricably linked to the features of feature 1.2.6 and did not need to be specified in claim 1.

The application as originally filed included various embodiments with different arrangements of the water discharging passage with respect to the inlet and the outlet holes, as shown for instance in Figures 7A, 7B, 8A and 8B. Hence, there was a basis for the combination of features defined in claim 10 of the main request.

In view of the above, the main request fulfilled the requirements of Article 123(2) EPC.

Auxiliary request 1

Auxiliary request 1 corresponded in substance to the former second auxiliary request filed during the oral proceedings before the Opposition Division. The former second auxiliary request had represented a reaction to an objection raised for the first time at the oral proceedings. It should have been admitted by the

Opposition Division, so auxiliary request 1 should be admitted into the appeal proceedings.

In so far as the objections raised against the main request were still valid in view of the amendments made, the arguments in relation to the main request applied *mutatis mutandis* to auxiliary request 1.

Auxiliary request 1a

With the reply to the statement setting out the grounds of appeal, the respondent raised a new added-matter objection for the first time in the opposition-appeal proceedings. Auxiliary request 1a represented a direct response to this new objection and immediately overcame the objection without giving rise to any new issues or objections. It should therefore be admitted into the proceedings.

In so far as the objections raised against auxiliary request 1 were still valid in view of the amendments made, the arguments in relation to auxiliary request 1 applied *mutatis mutandis* to auxiliary request 1a.

VII. The respondent essentially argued as follows (where appropriate, the arguments are discussed in more detail in "Reasons for the Decision" below):

Main request

Claim 1 of the main request comprised two alternatives:

a) a cooling apparatus with a lower surface guide and an upper surface guide

b) a cooling apparatus with a lower surface guide and no upper surface guide

Alternative b) had no basis in the application as originally filed.

Deleting the feature "*dropping downwardly*" in claim 1 of the main request with respect to claim 1 of the application as originally filed gave the skilled person new technical teaching, namely that the cooling water no longer had to drop downwardly in order to be appropriately discharged at a high flow density and a large volume as specified in paragraph 29 of the original description.

Paragraph 47 of the original description formed the basis for features 1.2.4 and 1.2.5. This paragraph specified that the alignment of the inlet holes led to the formation of the rows ("*inlet holes ... aligned ...* ***to form*** *a row of inlet holes*"). This causal link was, however, lost in the wording of amended feature 1.2.4 ("*forming rows*") as there was a difference between the inlet openings being aligned and forming rows (claim 1 of the main request), and the inlet openings being aligned **to form** rows (paragraph 47 of the original description).

Feature 1.2.5 did not specify that the rows of inlet holes were aligned in the sheet passing direction, contrary to paragraph 47 of the original description.

Omitting the portions 35 in claim 1 of the main request resulted in an unallowable intermediate generalisation. The guide sheet 31 of the upper surface guide of feature 1.2.6 (further specified in feature 1.3.3) was disclosed in paragraph 46 of the original description. This paragraph taught that the guide sheet 31 was structurally and functionally linked to the portions 35 forming a water discharging passage, intended for

solving the problem of rapidly discharging the cooling water. Without the portions 35, this problem stated in the original application was not solved.

Paragraph 47 of the original description disclosed that the guide sheet of the surface guide was provided with the inlet holes and the outlet holes. This feature was missing in claim 1 of the main request as features 1.2.1 and 1.2.2 merely specified that the inlet holes and the outlet holes were part of the surface guide, i.e. in a general manner. This led to an unallowable intermediate generalisation.

Claim 10 of the main request was based on paragraph 52 of the original description, which further stated the following:

- The recess-shaped opening overlaid the guide sheet in a manner including a part of the upper surface of the guide sheet and the row of outlet holes of the guide sheet.
- The rows of inlet holes were disposed in the predetermined spacing between adjacent portions forming a water discharging passage.

Omitting these features in claim 10 led to an unallowable intermediate generalisation.

Auxiliary request 1

The Opposition Division exercised its discretion correctly in not admitting the former second auxiliary request at the oral proceedings. The former second auxiliary request did not comprise an upper surface guide, yet the Opposition Division had already stated that an apparatus without an upper surface guide did not fulfil the requirements of Article 123(2) EPC. Hence, auxiliary request 1, which corresponded in

substance to this request not admitted in the first-instance proceedings, should not be admitted into the appeal proceedings either.

In view of the amendments made, the objections raised against the main request (upper surface guide being absent, features 1.2.4 and 1.2.5 not being based on paragraph 47 and the guide sheet not being provided with the inlet holes and the outlet holes) still applied to auxiliary request 1. The arguments in support of these objections against the main request applied *mutatis mutandis* to auxiliary request 1.

Auxiliary request 1a

As there were no exceptional circumstances for filing auxiliary request 1a after notification of the summons to oral proceedings, it should not be admitted into the appeal proceedings.

In view of the amendments made, the objections raised against the main request (the upper surface guide being absent and features 1.2.4 and 1.2.5 not being based on paragraph 47) still applied to auxiliary request 1a. The arguments in support of these objections against the main request applied *mutatis mutandis* to auxiliary request 1a.

Reasons for the Decision

1. *Main request*

The main request corresponds to the former first auxiliary request considered in the decision under appeal.

1.1 "*upper surface guide*"

1.1.1 The respondent asserted that claim 1 of the main request comprised two alternatives:

a) a cooling apparatus with a lower surface guide and an upper surface guide

b) a cooling apparatus with a lower surface guide and no upper surface guide

The respondent argued that alternative b) was not disclosed in the application as originally filed.

According to the respondent, the disclosure of the surface guides started from paragraph 37 of the description of the application as originally filed, which specified that the cooling apparatus comprised the two guides – both upper and lower. This applied throughout the entire original description, which did not include any disclosure that the upper surface guide was optional. Paragraph 92 of the original description even reflected the opposite as it referred to the possibility of using a conventional upper surface guide.

In the respondent's view, it was technically implausible for the cooling apparatus to comprise only one surface guide, otherwise the problem of preventing the steel sheet from entering the outlet holes as defined in feature 1.2.6 would not be solved (see dotted line in Figure 2A showing the passing of a steel sheet). The lower surface guide with features 1.2.3, 1.2.4 and 1.2.6, introduced into claim 1 of the main request, was originally disclosed only in combination with an upper surface guide. Together they (features 1.2.3, 1.2.4 and 1.2.6 of the lower surface guide **and**

the upper surface guide) made it possible to solve the problem of guiding the steel sheet and preventing it from entering the outlet holes, since the problem occurred on both the upper and lower sides. Hence, the lower surface guide, in particular features 1.2.3, 1.2.4 and 1.2.6, was structurally and functionally linked to the upper surface guide.

It was pure speculation to assume that the steel sheet did not follow the waved path as shown by the dotted line in Figure 2A. Hence, a lower surface guide without an upper surface guide did not make technical sense and there was no such embodiment in the application as originally filed. The structure of the description – describing the upper surface guide first and then the lower surface guide – did not imply a lack of a functional or structural link between the two.

Therefore, from the application as originally filed taken as a whole, the skilled person directly and unambiguously derived that the disclosed cooling apparatus necessarily comprised a lower surface guide and an upper surface guide, contrary to original claim 1.

Since the upper surface guide was not specified in alternative b) of claim 1, introducing features 1.2.3, 1.2.4 and 1.2.6 into claim 1 led to an unallowable intermediate generalisation (see decision under appeal, point 10.5).

1.1.2 The Board does not share the respondent's view for the following reasons.

As put forward by the appellant, **claim 1 of the application as originally filed** discloses a cooling

apparatus with a lower surface guide **only**. An upper surface guide is not even mentioned in the original set of claims, so this is a direct and unambiguous disclosure for the skilled person of a cooling apparatus in accordance with above-mentioned alternative b), i.e. without an upper surface guide. This is originally disclosed as the technical solution to the overall problem specified in paragraph 9 of the original description. For this reason alone, the objection with respect to the "*upper surface guide*" being absent from claim 1 is not convincing.

Claim 1 as originally filed provides a basis for a level of generalisation in which no upper surface guide is present. Further defining the lower surface guide in more detail using features of specific embodiments without also including the upper surface guide is a generalisation compared with the disclosure in the specific embodiments, but not an unallowable one.

The specific features 1.2.3, 1.2.4 and 1.2.6 of said lower surface guide introduced into claim 1 of the main request are disclosed in paragraphs 66 to 68 of the original description and shown in original Figure 9. As put forward by the respondent, they are indeed always disclosed in the application as originally filed in combination with an upper surface guide (see paragraphs 78 and 92). Contrary to the appellant's assertion, paragraph 92 does specify that the disclosed upper surface guide may be replaced with a conventional one.

However, the skilled person would directly and immediately realise that, firstly, the disclosed lower surface guide prevents a steel sheet from entering between the cooling nozzles, transporting rolls or pinch rolls arranged on the lower side (see paragraphs

68 and 79 of the original description) and that, secondly, the disclosed upper surface guide prevents a steel sheet from entering between the cooling nozzles arranged on the upper side (see paragraphs 48 and 55 of the original description). This is illustrated by the dotted line in Figure 2 showing the passing of the steel sheet.

The disclosed lower surface guide does not interact – either functionally or structurally – with the disclosed upper surface guide for preventing a steel sheet from entering between the cooling nozzles arranged on the upper side. By the same token, the disclosed upper surface guide does not interact – either functionally or structurally – with the disclosed lower surface guide for preventing a steel sheet from entering between the cooling nozzles, transporting rolls or pinch rolls arranged on the lower side.

This is also clear from the application as originally filed, in which the features of the disclosed upper surface guide are described in paragraphs 45 to 64 and Figures 4 to 8 and those of the disclosed lower surface guide are described in paragraphs 65 to 87 and Figures 9 to 13, i.e. independently from one another with no structural or functional interaction between them.

The fact that the disclosed upper surface guide may contribute to the overall goal of enabling a steel sheet to pass through the cooling apparatus merely indicates to the skilled person that the feature could plausibly be seen as an essential feature for this overall goal. It does not, however, imply any inextricable structural or functional link between the

upper surface guide and the lower surface guide, contrary to the respondent's view.

As a result, introducing features 1.2.3, 1.2.4 and 1.2.6 into claim 1 without specifying an upper surface guide does not result in an unallowable intermediate generalisation.

1.2 Features 1.2.4 and 1.2.5

1.2.1 The respondent considered that the amendment made in feature 1.2.4 and the introduction of feature 1.2.5 contravened Article 123(2) EPC.

It argued that paragraph 47 of the original description disclosed the way in which the rows of inlet holes of the upper guide sheet are implemented. This paragraph specified a causal link between the inlet holes and the resulting rows ("*inlet holes ... aligned ...* ***to form*** *a row of inlet holes*"), which was lost in the wording of amended feature 1.2.4.

Furthermore, it asserted – again on the basis of paragraph 47 of the original description – that new feature 1.2.5 did not specify that the rows of inlet holes were aligned in the sheet passing direction.

For these reasons, amended feature 1.2.4 and new feature 1.2.5 of claim 1 of the main request contravened Article 123(2) EPC.

1.2.2 The Board does not share the respondent's view for the following reasons.

As put forward by the appellant, it is directly and immediately apparent to the skilled person that the

inlet holes also form the rows of inlet holes in amended feature 1.2.4. Thus, a causal link between the presence of inlet holes and the occurrence of rows is inevitably present in claim 1 of the main request.

With respect to feature 1.2.5, the Board considers that this feature is disclosed at least in original Figures 4A and 5 for the upper surface guide and at least in original Figures 9A, 10, 11A and 12A for the lower surface guide, without the rows of inlet holes being aligned in the sheet passing direction

Hence, features 1.2.4 and 1.2.5 of claim 1 of the main request fulfil the requirements of Article 123(2) EPC.

1.3 Feature 1.2.6 - "*portions 35*"

1.3.1 According to the respondent, the guide sheet 31 of the upper surface guide of feature 1.2.6 (further specified in feature 1.3.3) was based on paragraph 46 of the original description. This paragraph taught that the guide sheet 31 was structurally and functionally linked to the portions 35 forming a water discharging passage, intended for solving the problem of rapidly discharging the cooling water. Without the portions 35, this problem stated in the original application was not solved. Since the portions 35 were not specified in claim 1 of the main request, introducing feature 1.2.6 resulted in an unallowable intermediate generalisation (decision under appeal, point 9.9).

1.3.2 The Board does not share the respondent's view for the following reasons.

As put forward by the appellant, the primary purpose of the upper guide sheet 31 is to prevent the steel sheet

from entering between the cooling nozzles 21 (see for instance paragraph 55, first sentence, and Figure 2A of the application as originally filed). As such, the outlet holes 33 in the guide sheet 31 are intended for discharging the cooling water. In this respect, the portions 35 merely relate to an improved and more efficient way of discharging the cooling water and keeping the retained water thin; see paragraphs 55 and 57 of the original description ("... *by further providing a water discharge passage* ..."). Hence, the portions 35 represent a preferred embodiment, so they are not structurally or functionally linked to the guide sheet specified in feature 1.2.6, which represents the general embodiment.

Reference is also made, for instance, to paragraph 62 of the original description, which clearly discloses that the guide sheet 31 and the portions 35 are not structurally linked; see also Figures 7A, 7B, 8A and 8B ("*portions ... separated from the guide sheet*").

1.4 Feature 1.2.6 - "*guide sheets provided with the inlet holes and the outlet holes*"

1.4.1 According to the respondent, paragraph 47 of the original description disclosed that the guide sheet 31 of the surface guide was provided with the inlet holes 32 and the outlet holes 33. This was contrary to features 1.2.1 and 1.2.2 of claim 1 of the main request, which merely specified that the inlet holes and the outlet holes were part of the surface guide, i.e. in a general manner, thus contravening Article 123(2) EPC.

1.4.2 In the appellant's view, claim 1 as originally filed already specified that the inlet holes and the outlet

holes were provided in the surface guide, i.e. in a general manner, in particular for the lower surface guide. Furthermore, paragraph 46 of the original application was a basis for an upper guide sheet without inlet and outlet holes. At any rate, in view of the wording "*[by having a] part of the guide sheet (31, 41) remain between the outlet holes (33, 43)*" in feature 1.2.6, the guide sheet was implicitly provided with the outlet holes. The technical effect of preventing the transported steel sheet from entering the outlet holes as disclosed in the embodiment of paragraph 48, on which feature 1.2.6 was based, was obtained by feature 1.2.6. Hence, the inlet holes were not inextricably linked to the features of feature 1.2.6 and did not need to be specified in claim 1.

1.4.3 The Board does not share the appellant's view for the following reasons.

Claim 1 as originally filed only refers to a surface guide in a general manner without specifying a guide sheet. Hence, it cannot form the basis for the surface guide(s) comprising guide sheet(s), as is now the case in claim 1 of the main request (see features 1.2.3 and 1.3.3). Introducing the guide sheets into claim 1 of the main request leads to the new technical teaching that **at least the inlet holes** do not need to be provided in the guide sheets even when these are present in the surface guides, assuming in the appellant's favour that feature 1.2.6 implicitly specifies that the outlet holes are present in the guide sheets.

Paragraph 46 (for the upper surface guide) and paragraph 66 (for the lower surface guide) of the original description cannot be taken as the basis for a

generalisation as they merely concern the introduction of the surface guides, which are described in the subsequent paragraphs. The guide sheets of the surface guides are explicitly provided with the inlet holes and the outlet holes (see paragraph 47 for the upper guide sheet and paragraph 67 for the lower guide sheet), in the same manner as in all the embodiments of the application as originally filed. For the Board, this directly and unambiguously teaches the skilled person that the inlet and the outlet holes are provided in the guide sheets of the surface guides in a structurally linked manner. Hence, the feature missing from claim 1 of the main request whereby the guide sheets of the surface guides are not provided with at least the inlet holes contravenes the requirements of Article 123(2) EPC.

Claim 1 of the main request thus provides the new technical teaching that the inlet holes of the surface guides do not necessarily need to be located in the guide sheets when these are present, which was not originally disclosed or even suggested.

1.5 In view of the above, the main request does not fulfil the requirements of Article 123(2) EPC.

2. Auxiliary request 1

2.1 Admittance

2.1.1 Under Article 12(4) RPBA 2007, the Board has the power not to admit into the appeal proceedings a claim request which was not admitted in the first-instance proceedings.

Auxiliary request 1 corresponds in substance to the second auxiliary request considered in the decision under appeal. The Opposition Division decided not to admit this claim request into the opposition proceedings because it considered it to have been filed late and to *prima facie* not overcome the objection under Article 123(2) EPC discussed in point 1.1 above (see minutes of the oral proceedings before the Opposition Division, page 3, first paragraph, and impugned decision, point 11.7).

2.1.2 The former second auxiliary request was filed in response to an objection which had been raised for the first time during the oral proceedings before the Opposition Division (see minutes, page 2, third-from-last paragraph, and impugned decision, points 11 and 11.2). The Board considers the filing of the former second auxiliary request during the oral proceedings before the Opposition Division to be a direct and immediate response to this new and late objection.

Furthermore, filing auxiliary request 1 with the notice of appeal constitutes a legitimate attempt to have this claim request considered in the appeal proceedings in the event that the Opposition Division's finding on the objection under Article 123(2) EPC - which the former second auxiliary request was *prima facie* deemed not to overcome - were to be overruled. In this regard, the Board did come to a different conclusion.

In view of all of the above, the Board exercised its discretion to admit auxiliary request 1 into the appeal proceedings pursuant to Article 12(4) RPBA 2007.

2.2 Immediate remittal

The Board did not grant the respondent's request to remit the case to the Opposition Division immediately after admitting auxiliary request 1, i.e. without any prior assessment as to whether it complied with Article 123(2) EPC.

No special reasons under Article 11 RPBA 2020 present themselves for doing so. The respondent did not raise any additional added subject-matter objection against auxiliary request 1 beyond those already raised against the main request. Hence, the Board considers it appropriate to assess whether auxiliary request 1 meets the requirements of Article 123(2) EPC as part of its review of the decision under appeal.

2.3 Added subject-matter

2.3.1 The set of claims of auxiliary request 1 differs from that of the main request *inter alia* in that claim 10 has been deleted and claim 1 contains "*dropping downwardly*" (feature 1.2.2') and features of the lower surface guide related to a portion forming a water supplying and discharging passage (feature 1.2.3'). Furthermore, all reference to the upper surface guide has been deleted in claim 1 of auxiliary request 1 (features 1.3 and 1.3.3 have been deleted and feature 1.2.1' has been amended).

2.3.2 As the parties' arguments on Article 123(2) EPC in relation to auxiliary request 1 are the same as those for the main request, auxiliary request 1 does not fulfil the requirements of Article 123(2) EPC, for the same reasons as provided under point 1.4.3 above.

2.3.3 The respondent raised additional objections under Article 123(2) EPC in relation to the main request which were not discussed under point 1 above (see also points VI and VII above). However, the respondent did not dispute that these objections were overcome by the amendments in auxiliary request 1, in particular by deleting claim 10 and reinserting the feature "*dropping downwardly*" into claim 1.

3. Auxiliary request 1a

3.1 Admittance

3.1.1 The appellant filed auxiliary request 1a by letter dated 1 June 2021, i.e. after notification of the summons to oral proceedings dated 28 January 2021. Consequently, Article 13(2) RPBA 2020 applies in view of the transitional provisions (Article 25(1) and (3) RPBA 2020).

3.1.2 The respondent objected to the admittance of auxiliary request 1a into the appeal proceedings under Article 13(2) RPBA 2020.

According to the respondent, there were no exceptional circumstances which justified admitting auxiliary request 1a. The appellant had already filed new claim requests five times during the opposition and appeal proceedings. Furthermore, the respondent's reply to the statement of grounds had been filed in due time and had finalised the legal and factual framework of the appeal proceedings. In any case, the appellant had had enough time to file auxiliary request 1a before the notification of the summons to oral proceedings.

3.1.3 The Board does not share the respondent's view for the following reasons.

The only valid objection remaining against auxiliary request 1 (see point 2.3 above) had been raised for the first time with the respondent's reply to the statement of grounds. Hence, the decision under appeal was not based on this objection and the appellant had had no reason to file auxiliary request 1a with the statement setting out the grounds of appeal.

While the appellant technically did not submit the amendment in auxiliary request 1a at the earliest opportunity after having been notified of the respondent's reply to the statement of grounds of appeal, the amendment was still submitted about five months before the oral proceedings before the Board, which was not detrimental to procedural economy.

The amendment directly addresses the only remaining objection under Article 123(2) EPC, and it is immediately apparent why it overcomes that objection. The amendment is also strictly limited to overcoming that objection; it does not shift the discussion or give rise to new objections.

In terms of procedural fairness, the amendment corresponds directly to what the respondent had argued was lacking under Article 123(2) EPC. The respondent could therefore not have been surprised by the amendment, and in any case had had sufficient time to react.

The Board considers the above circumstances to be exceptional under Article 13(2) RPBA 2020 and exercises its discretion under that provision (see T 172/17,

point 5.4 of the reasons) to take auxiliary request 1a into account in the appeal proceedings.

3.2 Immediate remittal

The Board did not grant the respondent's request to remit the case to the Opposition Division immediately after admitting auxiliary request 1a, for the same reasons as those given under point 2.2 above for auxiliary request 1 (Article 11 RPBA 2020).

3.3 Added subject-matter

Claim 1 of auxiliary request 1a further contains the feature whereby the guide sheet is provided with the inlet holes and the outlet holes (see point V above, feature 1.2.3'').

This amendment overcomes the only outstanding added subject-matter objection in relation to auxiliary request 1 (see points 1.4.3 and 2.3.2 above).

Hence, auxiliary request 1a fulfils the requirements of Article 123(2) EPC.

4. Remittal

Since the decision under appeal deals only with Article 123(2) EPC, the Board considers it appropriate to remit the case to the Opposition Division for further prosecution pursuant to Article 111(1) EPC and Article 11 RPBA 2020, in line with the respondent's request. The appellant also agreed to this.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the Opposition Division for further prosecution.

The Registrar: The Chairman:

C. Spira C. Herberhold

Decision electronically authenticated