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**Datasheet for the decision
of 9 January 2024**

Case Number: T 1760/21 - 3.3.05

Application Number: 14701044.1

Publication Number: 2948571

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C22F1/057

Language of the proceedings: EN

Title of invention:
METHOD OF FORMING AN AL-MG ALLOY PLATE PRODUCT

Patent Proprietor:
Novelis Koblenz GmbH

Opponent:
C-Tec Constellium Technology Center/Constellium Rolled
Products Ravenswood LLC

Headword:
Al-Mg Alloy Plate Product/Novelis

Relevant legal provisions:
EPC Art. 123(2)
RPBA 2020 Art. 13(2)

Keyword:

Amendments - allowable (no)

Amendment after summons - exceptional circumstances (no)

Decisions cited:

Catchword:



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Case Number: T 1760/21 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 9 January 2024

Appellants: C-Tec Constellium Technology Center/Constellium
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 2 August 2021 rejecting the opposition filed against European patent No. 2948571 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman E. Bendl
Members: G. Glod
 R. Winkelhofer

Summary of Facts and Submissions

I. The opponents' (appellants') appeal lies from the opposition division's decision rejecting the opposition against European patent EP 2 948 571.

II. The wording of claim 1 of the patent is as follows:

"1. Method of obtaining a two- or three-dimensional formed structure of an AlMg alloy plate product, comprising the steps of:

- providing a plate product having a gauge of at least 10 mm and a chemical composition, in wt. %:

Mg 2.5% to 6%,

Mn 0 to 1.2%, and preferably 0.05% to 1.2%,

Sc 0 to 1 %,

Ag 0 to 0.5%,

Zn 0 to 2%,

Cu 0 to 2%,

Li 0 to 3%,

optionally at least one or more elements selected from the group consisting of (Zr 0.03% to 0.4%, Cr 0.03% to 0.4%, and Ti 0.005% to 0.3%), optionally one or more elements selected from the group of (Er, Dy, Gd, and Hf) in a total amount of 0.03% to 0.3%,

Fe 0 to 0.4%,

Si 0 to 0.25%,

inevitable impurities and balance aluminium, and

- shaping or forming said alloy plate at a temperature in a range of 200°C to 400°C wherein the shaping or forming process is selected from the group of bending, pressing, roll forming, stretch-forming, and creep-forming,

- heat treating the shaped or formed alloy plate."

III. During opposition proceedings the respondent (patent proprietor) had filed nine auxiliary requests.

- Claim 1 of the first auxiliary request is identical to claim 1 of the main request.
- Claim 1 of the second auxiliary request includes a limitation of Cu to $Cu \leq 0.04\%$.
- Claim 1 of the third auxiliary request further includes a limitation of Sc to Sc 0.05 to 0.4%.
- Compared with claim 1 of the main request, claim 1 of the fourth auxiliary request includes the underlined feature: providing a plate product having a gauge of at least 15 mm.
- Claim 1 of the fifth auxiliary request combines the limitations of claim 1 of the second, third and fourth auxiliary requests.
- Claim 1 of the sixth auxiliary request combines the limitations of claim 1 of the second and third auxiliary requests and limits the temperature range of shaping or forming to 300°C to 400°C.
- Claim 1 of the seventh auxiliary request includes the limitation of claim 1 of the second auxiliary request and the underlined feature: solution heat treating the shaped or formed alloy plate.
- Compared with claim 1 of the seventh auxiliary request, claim 1 of the eighth auxiliary request further includes the limitation of claim 1 of the third auxiliary request.
- Compared with claim 1 of the eighth auxiliary request, claim 1 of the ninth auxiliary request further includes the temperature limitation of claim 1 of the sixth auxiliary request.

IV. In their communication pursuant to Article 15(1) RPBA 2020, the board was of the preliminary opinion that the

patent was likely to be revoked, for not fulfilling the requirements of Article 123(2) and/or Article 56 EPC.

V. In response the respondent filed a tenth auxiliary request. In claim 1 of this auxiliary request, the expressions "or forming" and "or formed" were deleted compared with claim 1 of the main request.

VI. The respondent's arguments relevant to the present decision can be summarised as follows.

The requirements of Article 123(2) EPC were fulfilled. It was evident to the skilled person reading the application as originally filed that the terms shaping and forming had the same meaning. This was apparent from numerous passages in the description as originally filed, which showed the interchangeability of the terms. In particular, this interpretation was confirmed when comparing claims 1 and 2 as originally filed with the corresponding passages in the description as originally filed. The reference of claim 6 as originally filed to claim 1 as originally filed further corroborated this.

It was directly and unambiguously derivable from the combination of claims 1 and 2 as originally filed that the temperature range of 200°C to 400°C also applied to the forming of the alloy plate.

The tenth auxiliary request was not submitted until after the board's communication since there had not been any need to submit such a request before the opposition division. The board's preliminary opinion was very surprising and unexpected, which triggered the need for a further request.

VII. The appellants' arguments are reflected in the reasons given below.

VIII. The requests are thus as follows.

The appellants request that the decision under appeal be set aside and amended such that the patent be revoked.

The respondent requests that the appeal be dismissed (main request) or that the patent be maintained on the basis of one of the first to tenth auxiliary requests as filed before the opposition division (first to third auxiliary requests on 22 October 2019, fourth to ninth auxiliary requests on 28 August 2020) or on the basis of the tenth auxiliary request as filed on 30 October 2023.

Reasons for the Decision

Main request (patent as granted)

1. Article 123(2) EPC

The point of debate is whether forming at a temperature in a range of 200°C to 400°C is directly and unambiguously derivable from the application as originally filed.

Claim 1 of the application as originally filed relates to a forming method which includes shaping the alloy plate at a temperature in a range of 200°C to 400°C. The skilled person understands in that context that the meaning of the word "forming" is apparently broader than the expression "shaping". The forming process comprises the shaping step as part of it. In that

context the process is understood as one that should lead to a "two- or three-dimensional formed structure of an AlMg alloy plate product". Part of the overall process includes the shaping step in the given temperature range. Forming is thus understood as "making" or "obtaining". This understanding cannot come as a surprise since the term "obtaining" is also used in claim 1 as granted.

Furthermore, this is in line with the description of the application as originally filed. In particular page 2, lines 24 to 28 refers to a method of forming or shaping an AlMg plate product into a predetermined three-dimensional structure and consequently lists the two steps of providing a plate product and shaping the plate. The skilled person would understand that the shaping process only includes the provision of the specified plate product and the shaping in the stated temperature range of 200°C to 400°C, as indicated in the first paragraph on page 3 immediately following the cited passage. The forming process, on the other hand, might include further steps. Claim 1 of the application as originally filed is limited not to the shaping process but to the broader forming ("making") process.

Claim 6 of the application as originally filed refers to the "formed structure" and to the "forming operation". This means that the two- or three-dimensional structure of an AlMg alloy plate product obtained after the process steps of claim 1 is aged afterwards. This is also confirmed by the description (page 5, first paragraph), which explains that, firstly, the two- or three-dimensional structure is made and, subsequently, it undergoes further process steps.

Claim 2 as originally filed refers to a plate product being formed using a shaping or forming process. The "being formed" is construed in the context of claim 1 to refer to the broad meaning of claim 1 ("being made" or "being obtained"). Claim 2 as originally filed lists forming and shaping as different possibilities in view of the wording "or" in the making of an AlMg alloy plate product. This is also in line with the passages cited by the respondent (page 1, line 3; page 2, lines 24 and 27; page 8, line 17 of the application as originally filed). In the context of "using a shaping or forming process", forming is not considered to have the same meaning as "being formed" since it is limited to one or more of the specified process steps. It is not unambiguous that all the process steps listed, i.e. bending, pressing, roll forming, stretch-forming and creep-forming, are supposed to qualify as both shaping and forming. Some of the steps could be considered shaping while others would be forming. This understanding is not altered when consulting the description (page 3, lines 28 to 30). It is understood that a forming process taken from the indicated list would also impact the two- or three-dimensional structure of the product.

The skilled person would also understand that forming and shaping are different processes, otherwise listing the two of them would be meaningless; they would not directly and unambiguously be considered synonyms.

The application as originally filed does not disclose a forming process in a range of 200°C to 400°C. Such a temperature range is only specifically disclosed for shaping (see claim 1 as originally filed and page 4, lines 27 to 29 of the application as originally filed). This is also corroborated by the fact that the

description refers to "hot shaping" or "hot shaped" (page 3, line 17 and page 4, line 17) but not to "hot forming" (see for example page 3, lines 18, 19 and 31). Claims 3 and 4, which further specify the temperature range, only relate to "being shaped".

In view of the incoherent use of the terms "forming" "being formed" and "formed product" in the application as originally filed, there is ambiguity as to the intended meaning of "forming". Therefore it is not unambiguous that forming is supposed to be a synonym of shaping. Consequently the temperature range of 200°C to 400°C cannot be unambiguously associated with the forming step.

The step of "forming said alloy plate at a temperature in a range of 200°C to 400°C" is thus not directly and unambiguously derivable from the application as originally filed.

In summary, the requirements of Article 123(2) EPC prejudice the maintenance of the patent as granted.

First to ninth auxiliary requests

2. Article 123(2) EPC

It was not disputed that the conclusion reached for the main request also applied to auxiliary requests 1 to 9 with respect to Article 123(2) EPC. These requests are consequently not allowable either.

Tenth auxiliary request

3. Article 13(2) RPBA 2020

Under Article 13(2) RPBA 2020 any amendment to a party's appeal case made after notification of a summons to oral proceedings is, in principle, not to be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

In the case in hand there are no exceptional circumstances, for the following reasons.

The request was submitted after the board's communication pursuant to Article 15(1) RPBA 2020, which indicated that Article 100(c) EPC, in combination with Article 123(2) EPC, appeared to prejudice the maintenance of the patent as granted.

The objection under Article 100(c) EPC concerning the forming at a temperature in a range of 200°C to 400°C was first raised in the notice of opposition (see point 5 bridging pages 12 and 13). This objection was part of the opposition proceedings and was dealt with by the opposition division under point 4.1 of the impugned decision. The objection was reiterated in point 2 of the appellants' grounds of appeal. With their reply to the appeal the respondent did not file any request that dealt with said objection. However, pursuant to Article 12(3) RPBA 2020, the reply has to contain a party's complete appeal case.

In the communication pursuant to Article 15(1) RPBA 2020 the board argued why it regarded the objection under Article 100(c) EPC as persuasive. This was based

only on arguments which had been part of the proceedings since the filing of the opposition. There were no new facts which would have triggered the filing of a new request at such a late stage of the proceedings. However, the fact that the appellants did not repeat their arguments in the rejoinder, as argued by the respondent, is irrelevant since the objection under Article 100(c) EPC had not been withdrawn and Article 100(c) EPC was part of the appeal proceedings. The communication cannot per se be regarded as creating exceptional circumstances (Case Law of the Boards of Appeal of the EPO, 10th edition, 2022, V.A.4.5.6(c)).

Generally, patent proprietors have to anticipate that the board might evaluate a case differently from what they might have expected. Therefore the respondent should have reacted to all the appellants' objections immediately, even if they considered them to be completely without substance.

Furthermore, the communication pursuant to Article 15(1) RPBA 2020 is not an invitation to make new submissions (Case Law of the Boards of Appeal of the EPO, 10th edition, 2022, V.A.4.5.6(a)).

Therefore, the tenth auxiliary request is not taken into account and is thus not part of the proceedings.

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