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**Datasheet for the decision
of 10 March 2026**

Case Number: T 0545/24 - 3.2.07

Application Number: 18209234.6

Publication Number: 3479975

IPC: B26D3/16, B26D5/22, B26D7/12,
B23Q3/155

Language of the proceedings: EN

Title of invention:
METHOD AND MACHINE FOR CUTTING LOGS OF WOUND WEB MATERIAL

Patent Proprietor:
Valmet Tissue Converting S.p.A.

Opponent:
Paper Converting Machine Company

Relevant legal provisions:
EPC Art. 114(1), 123(2), 76(1), 84, 100(b), 100(c), 111(1)
EPC R. 79
RPBA 2020 Art. 11, 12(2), 12(4), 12(6), 13(2)

Keyword:

Late-filed objection - admitted (no) - error in use of
discretion at first instance (no)

Amendments - added subject-matter (yes)

Amendment to case - admitted (yes)

Remittal - special reasons for remittal (yes)

Decisions cited:

G 0009/91, G 0010/91, T 0409/91, T 0435/91, T 0172/99,
T 0141/20, T 1865/23



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Case Number: T 0545/24 - 3.2.07

D E C I S I O N
of Technical Board of Appeal 3.2.07
of 10 March 2026

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 16 February
2024 rejecting the opposition filed against
European patent No. 3479975 pursuant to Article
101(2) EPC.**

Composition of the Board:

Chairman	G. Patton
Members:	V. Bevilacqua
	S. Ruhwinkel

Summary of Facts and Submissions

- I. The present appeal lies against the decision of the opposition division rejecting the opposition filed against European patent No. 3 479 975, with which the opponent (now appellant) requested revocation of the patent in its entirety on the grounds of lack of novelty (Articles 100(a) and 54 EPC), lack of inventive step (Articles 100(a) and 56 EPC), and inadmissible extension (Articles 100(c), 123(2) and 76(1) EPC).

The ground for opposition of insufficiency of disclosure, pursuant to Article 100(b) EPC, raised after expiry of the opposition period, was not admitted into the opposition proceedings.

- II. The appellant initially requested that
- the decision under appeal be set aside and that the patent be revoked in its entirety.

The respondent (patent proprietor) initially requested that

- the appeal be dismissed (main request), or alternatively
- that the patent be maintained in amended form in accordance with one of the first to tenth auxiliary requests, the first and second auxiliary requests corresponding respectively to the first and second auxiliary requests filed before the opposition division, and the third to tenth auxiliary requests having been first filed with the respondent's reply to the statement setting out the grounds of appeal.

III. In preparation for the oral proceedings, the board gave its preliminary opinion in a communication pursuant to Article 15(1) RPBA according to which

- the main request and the first to fifth auxiliary requests were not allowable, without taking documents D7 to D9 into account, and
- either the patent could be maintained on the basis of the sixth auxiliary request, or, alternatively,
- depending on the outcome of the discussion during oral proceedings, the case could be remitted to the opposition division for further prosecution.

IV. None of the parties filed a substantive written reply to the above-mentioned preliminary opinion.

V. Oral proceedings were held on 10 March 2026.

At the oral proceedings, both parties additionally requested that the case be remitted to the opposition division for further prosecution and confirmed their initial requests under point II above. The respondent's request for remittal was conditional on the admittance of documents D7 to D9.

Further details of the oral proceedings can be found in the minutes thereof.

VI. The present decision is based on the following documents, mentioned in the appealed decision:

D1: WO 2016/030124 A1 (parent application of the contested patent)

D5: US 4,173,846

The following further evidence has been filed with the statement setting out the grounds of appeal:

D7: EP 2 347 846 A1
D8: DE 101 17 951 B4
D9: US 7,520,386 B1.

VII. Claim 1 of the **main request**, with the feature identification used in point II.4 of the appealed decision, reads as follows:

- A "A method for cutting logs (L) of wound web material, comprising the steps of:
- B providing a feeding path (P) for the logs (L) to be cut;
- C arranging along the feeding path a cutting head (5) with at least one disc-shaped cutting blade (9), the cutting head moving the disc-shaped cutting blade with a cyclical motion to cut the logs and allow a forward movement of the rolls along the feeding path;
- Di providing at least one storage unit (73) for disc-shaped cutting blades (9: 9A-9E) associated with the cutting head;
- Dii wherein the storage unit comprises a blade-holder (72) provided with a plurality of seats (82) for the disc-shaped cutting blades (9; 9A-9E), arranged and configured to keep the disc-shaped cutting blades (9: 9A-9E) coaxial with one another;
- E moving logs (L) of web material sequentially along the feeding path (P) in a direction parallel to the log axis; cutting the logs (L) by means of the disc-shaped cutting blade (9) mounted on the cutting head (5) and severing the logs into small rolls (R) having an axial length smaller than the logs;
- F periodically grinding the disc-shaped cutting blade (9)

by means of a pair of grinding wheels (101) associated with the cutting head (5), the grinding wheels being arranged and controlled to periodically grind the disc-shaped cutting blade (9) mounted on the cutting head (5);

- G when the disc-shaped cutting blade (9) has so worn that [sic] must be replaced: temporarily stopping the forward movement of the logs (L); removing the worn disc-shaped cutting blade (9) from the cutting head (5); taking a new disc-shaped cutting blade (9; 9A-9E) from the storage unit (73), transferring the new disc-shaped cutting blade to the cutting head (5) and mounting it on the cutting head; once the new disc-shaped cutting blade (9; 9A-9E) has been mounted on the cutting head (5), re-start the forward movement of the logs (L) along the feeding path (P)."

Claim 3 of the **main request**, with the feature identification used in point II.4 of the appealed decision, reads as follows:

- AA. A cutting machine (1) for cutting logs (L) of web material, comprising:
- BB. a feeding path for the logs to be cut;
- CC. a cutting head (5) arranged along the feeding path (P), said cutting head comprising a coupling (35) for a disc-shaped cutting blade (9) and being configured to impart the disc-shaped cutting blade a rotary motion around the axis (X-X) thereof and a cyclic movement to cut the logs (L) into rolls (R), and
- EE. to allow the logs (L) to move forward along the feeding path (P);
characterized by further comprising:

- FF. a pair of grinding wheels (101) associated with the cutting head (5), which are arranged and controlled to periodically grind the disc-shaped cutting blade (9) mounted on the cutting head (5);
- DDi. at least one storage unit (73) for disc-shaped cutting blades (9; 9A-9E) associated with the cutting head (5);
- HH. at least one handling member (71)
- GG. to remove a worn disc-shaped cutting blade (9) from the cutting head (5) and replace the worn disc-shaped cutting blade with a new disc-shaped cutting blade (9; 9A-9E) taken from the storage unit (73);
- DDii. wherein the storage unit comprises a blade-holder (72) provided with a plurality of seats (82) for the disc-shaped cutting blades (9; 9A-9E), arranged and configured to keep the disc-shaped cutting blades (9; 9A-9E) coaxial with one another.

Claim 1 of **auxiliary request 1** is based on claim 1 of the main request, the only difference being that feature Dii has been amended as follows (amendments with respect to the main request are in bold, emphasis added by the board):

- Dii "wherein the storage unit comprises a blade-holder (72) provided with a plurality of seats (82) for the disc-shaped cutting blades (9; 9A-9E), arranged and configured to keep **spare disc-shaped cutting blades and worn the** disc-shaped cutting blades (9: 9A-9E) coaxial with one another;"

Claim 1 of **auxiliary request 2** corresponds to claim 1 of auxiliary request 1, the only difference being that feature G has been amended as follows (amendments with respect to auxiliary request 1 are in bold; emphasis added by the board):

- G "when the disc-shaped cutting blade (9) has so worn that [sic] must be replaced: temporarily stopping the forward movement of the logs (L); removing the worn disc-shaped cutting blade (9) from the cutting head (5) **and putting the worn disc-shaped cutting blade into the storage unit (73)**; taking a new disc-shaped cutting blade (9; 9A-9E) from the storage unit (73), transferring the new disc-shaped cutting blade to the cutting head (5) and mounting it on the cutting head; once the new disc-shaped cutting blade (9; 9A-9E) has been mounted on the cutting head (5), re-start the forward movement of the logs (L) along the feeding path (P)."

Claim 1 of **auxiliary request 3** corresponds to claim 1 of the main request, the only difference being that feature C has been amended as follows (amendments with respect to the main request are in bold; emphasis added by the board):

- C "arranging along the feeding path a cutting head (5) with at least one disc-shaped cutting blade (9), **said cutting head comprising a coupling (35) for a disc-shaped cutting blade (9) and being configured to impart the disc-shaped cutting blade a rotary motion around the axis (X-X) thereof and a cyclic movement to cut the logs (L) into rolls (R), such as to ~~the cutting head moving move~~** the disc-shaped cutting blade with a cyclical motion to cut the logs and allow a forward movement of the rolls along the feeding path;"

Claim 1 of **auxiliary request 4** corresponds to claim 1 of auxiliary request 3, with the addition of the amendment to feature Dii already introduced in auxiliary request 1 (see above).

Claim 1 of **auxiliary request 5** is based on claim 1 of auxiliary request 3, with the addition of the amendments to feature Dii and feature G already introduced in auxiliary request 2 (see above).

Claim 1 of **auxiliary request 6** is based on claim 1 of auxiliary request 3, with the addition of the following features at the end of feature G thereof:

"wherein at least one handling member (71) is provided, to remove a worn disc-shaped cutting blade (9) from the cutting head (5) and replace the worn disc-shaped cutting blade with a new disc-shaped cutting blade (9; 9A-9E) taken from the storage unit (73)."

VIII. The appellant's arguments are dealt with in detail in the reasons for the decision.

Reasons for the Decision

1. Non-admittance of the ground for opposition under Article 100(b) EPC

1.1 The appellant requests the board to set aside the opposition division's discretionary decision not to admit this late-filed ground for opposition.

It explains why that ground *prima facie* prejudices maintenance of the patent as granted, and therefore why the opposition division's findings in that respect are not correct, by relying on case law establishing that sufficiency of disclosure requires that the skilled person can obtain substantially all embodiments falling within the ambit of the claims without undue burden (T 409/91, T 435/91, T 172/99).

During oral proceedings before the board the appellant also referred for the first time to the arguments submitted in the third paragraph of page 4 of the notice of opposition, noting that these arguments, filed at the very outset of opposition proceedings, could equally support an objection of insufficiency of disclosure.

1.2 It is established case law that the opposition division may exceptionally consider, when applying Article 114(1) EPC, late-filed grounds for opposition if these, *prima facie*, in whole or in part would seem to prejudice the maintenance of the European patent (see Case Law of the Boards of Appeal of the European Patent Office, eleventh edition, 2025, "CLB" hereafter, IV.C. 3.4.1; G 10/91).

It is however also established case law that this exercise of discretion by the opposition division is reviewed by the boards and may be overturned only if it is concluded that the opposition division exercised its discretion according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (CLB, IV.C.4.5.2a), V.A.3.4.4).

1.3 It is first emphasised that it is undisputed between the parties, and the board agrees, that the opposition division had the discretion not to admit the ground for opposition under Article 100(b) EPC, as it was filed late.

1.4 The board is not convinced that the appellant's arguments demonstrate that the discretionary decision is to be overruled in appeal proceedings.

1.4.1 This is because the opposition division, when deciding, clearly applied the correct principle, which requires that the late-filed ground must *prima facie* seem to prejudice the maintenance of the patent as granted.

The minutes of the oral proceedings before the opposition division, page 1 show that, having discussed this issue with the parties, the opposition division reasonably concluded, as set out in the impugned decision, point II.3, last paragraph, that "*Even without any further explanations the person skilled in the art would have no problem in realizing a manual replacement of a worn cutting blade by a new cutting blade*".

The appellant's arguments, on the other hand, focus on demonstrating that the above assessment of the

opposition division on sufficiency of disclosure is factually not correct, instead of convincingly demonstrating that the opposition division had exercised its discretion according to wrong principles, without taking into account the right principles, or in an unreasonable way.

- 1.4.2 The argument that the third paragraph of page 4 of the notice of opposition could also support an objection of insufficiency of disclosure is not convincing either.

This is because this paragraph clearly addresses issues of added subject-matter and does not relate to sufficiency of disclosure.

It is also not apparent how an argument first filed during appeal oral proceedings should be taken into account in deciding whether the opposition division took the contested discretionary decision in a reasonable way, because at that moment in time this argument had not been directed to the issue at stake relating to insufficiency of disclosure, as also appears from the decision under appeal, point II.3.

In addition, the board notes that this passage of the notice of opposition does not contradict the opposition division's view that manual replacement was possible.

It only relies on the appellant's own view that the patent taught away from manual replacement due to possible dangers and drawbacks, without though providing any arguments on the inability of the skilled person to perform such manual replacement.

There are therefore no reasons for concluding that the *prima facie* assessment done by the opposition division,

acknowledging sufficiency of disclosure on the basis of the knowledge of the skilled person, does not fall within the bounds of reasonable discretion.

Because of that, the opposition division's discretionary decision not to admit this ground for opposition is not overturned.

1.5 As no consent has been given by the respondent to the introduction of the ground for opposition in appeal proceedings, this ground for opposition may not be dealt with in appeal proceedings (CLB, V.A.3.2.3.h), G 9/91, Reasons 18; G 10/91, Headnote 3).

2. Ground for opposition under Article 100(c) EPC

2.1 The opposition division found that the ground for opposition under Article 100(c) EPC does not hold against the patent in suit (impugned decision, point II.2).

The board disagrees with this finding, for the reasons set out below.

According to the appellant, the patent as granted does not meet the requirements of Article 123(2) EPC due to the omission in method claim 1 of a "handling member" which was originally disclosed in combination with a "blade-holder" added to claim 1. The same objection was raised in view of the parent application D1 pursuant to Article 76(1) EPC.

2.2 The respondent argues that the application as originally filed, read as a whole, discloses the blade-holder as a structural part of the storage unit, which is an element distinct from the handling member, and

that these two elements - blade-holder and handling member - are disclosed independently of one another. Hence the addition of a **blade-holder** in claim 1 of the patent as granted without specifying a handling member does not provide a new technical teaching to the skilled person.

According to the respondent, paragraph [0011] of the original description (reference is made to the 'A' publication EP 3 479 975 A1) corresponds to the subject-matter of the original claim 1, which does not mention a handling member.

Paragraph [0012] of the 'A' publication then introduces the handling member as an optional element, describing what it can do.

At the end of paragraph [0014] of the 'A' publication, an alternative embodiment is disclosed in which the cutting head "*does not perform movement useful for the blade replacement*". According to the respondent, this disclosure implies a *contrario* that the cutting head performs movements useful for the blade replacement, i.e. that the replacement of the disc-shaped cutting blade is performed by the cutting head itself. As a result, in this embodiment no handling member is necessary.

On this basis, the respondent submitted that the presence and structure of the storage unit, including the blade-holder, is independent of the handling member, i.e. the handling member has been disclosed as being optional, and hence is not inextricably linked with the storage unit comprising a blade-holder.

In the respondent's view, the original claim 1, which

discloses a storage unit without a handling member, inevitably implies the presence of a blade-holder as part of that storage unit. As a consequence, a blade-holder was already implicitly present for the skilled person in claim 1 of the application as originally filed, regardless of the handling member, which first appears in the dependent claims of the application as originally filed. This teaching of the implicit presence of a blade-holder in a storage unit is confirmed by claim 9 of the application as originally filed, in which the storage unit is disclosed as comprising a blade-holder.

The respondent also relied on the original claim 3 to argue that the storage unit and the handling member are distinct elements.

Finally, the respondent submitted that figures 9 and 15 of the application as originally filed represent specific embodiments only and do not reflect the overall teaching of the application, which is conveyed by paragraphs [0011] to [0014] and the original claims 3 and 9.

2.3 The appellant convincingly demonstrated the incorrectness of the appealed decision, for the following reasons.

Claim 1 of the application as originally filed does not mention a blade-holder, and it is not disputed that the blade-holder feature was added to claim 1 of the patent as granted together with other features of the original claims 9 and 18.

The appellant therefore argues that the combination of a blade-holder - as a feature of the storage unit -

with the absence of a handling member does not have a direct and unambiguous basis in the application as filed.

The board also finds that such basis is lacking.

The blade-holder feature is disclosed in the application as filed only in the original claims 9 and 10 and in paragraphs [0053] and [0128] of the original description.

The original claim 9 however depends on the independent product claim 3 as originally filed, which includes the handling member as an essential feature thereof. The original claim 10, which depends on claim 9, provides further specifications to the blade-holder of claim 9 and hence is not relevant to the issue at stake relating to intermediate generalisation on the basis of the presence of the blade-holder in general.

The situation is similar to that of the original claims 3 and 9 for the disclosures in paragraphs [0053] and [0128] of the original description, which relate respectively to the embodiment of figures 9A to 9O and to the embodiment of figures 14 to 16: in both embodiments, blade-holder (72, 75) and handling member (71, 77) are disclosed in combination as features of the same embodiment.

In these embodiments there is a clearly recognisable functional and structural relationship (CLB, II.E.1.9.1) between the blade-holder and the handling member, because these two elements interact with each other in the blade replacement operation.

The respondent's argument that the handling member is optional, as it is not a feature of the original claim 1 (being mentioned only in dependent claim 2 of the application as originally filed), is not decisive in that respect.

This is because the granted claim 1 contains more features than the original claim 1, being directed towards an embodiment which also contains a blade-holder, and as discussed above there is no original disclosure of a blade-holder without a handling member. In this respect the respondent's argument that a blade-holder is implicit in claim 1 of the application as originally filed is not convincing since the storage unit of said claim 1 (also called "store unit" in the application as originally filed: see point 6.3.2 below) does not require any blade-holder as it can merely be a box where the blades are stored with manual replacement of the worn blades. In this respect dependent claim 9 only specifies that the storage unit of the corresponding embodiment comprises a blade-holder, not that a storage unit according to the independent claim 1 of the application as originally filed also mandatorily comprises such a blade-holder.

The respondent's reliance on paragraphs [0011], [0012] and [0014] of the application as originally filed is not persuasive either.

Firstly, the same as above with respect to the storage unit of claim 1 of the application as originally filed also applies to paragraphs [0011] to [0014], where reference is only made to a storage unit in general without mentioning a blade-holder.

Secondly, paragraph [0011] merely refers to claim 1 as filed without providing any substantive disclosure of the method.

Paragraph [0012] introduces the handling member as the means by which the blades are taken, installed and removed, without any mention of the blade-holder.

Paragraph [0014] describes the possibility of keeping the cutting head fixed during blade replacement and does not refer to either the blade-holder or the handling member. More particularly, the board does not concur with the respondent's interpretation of the passage of paragraph [0014] that the cutting head "*does not perform movement useful for the blade replacement*". Contrary to the respondent's view, there is therefore no disclosure *a contrario* that the replacement of the disc-shaped cutting blade can be performed by the cutting head itself. On the contrary, paragraph [0014] clearly refers to "[t]he method defined above", which requires a "handling member" for replacing the disc-shaped cutting blades as explicitly disclosed in paragraphs [0012] and [0013].

None of these paragraphs therefore amounts to a disclosure of a blade-holder without a handling member.

The argument based on claim 3 of the application as originally filed is not convincing either.

While claim 3 describes the storage unit and the handling member as structurally distinct elements, this does not mean that the blade-holder, a specific feature of the storage unit, is disclosed as functionally independent of the handling member. This is all the more true since claim 3 is completely silent on a

blade-holder. As already discussed above, a storage unit can be seen as a box where the blades are stored. Thus a blade-holder is not directly and unambiguously disclosed in claim 3 of the application as originally filed.

At any rate, the structural distinctness of two elements does not imply that either can be claimed without the other, especially when as in the present application they are consistently disclosed in combination in all embodiments in which the blade-holder appears, see embodiments of figures 9A to 9O and figures 14 to 16 as discussed above.

For these reasons, the board concludes that the granted claim 1 contains subject-matter which extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

The ground for opposition under Article 100(c) EPC therefore holds against the main request, which is not allowable.

3. First to fifth auxiliary requests

3.1 The respondent did not provide any additional arguments concerning the issue discussed above of added subject-matter in relation to these requests.

3.2 As claim 1 of each of these auxiliary requests mentions a blade-holder but fails to include the handling member, none of these requests can be allowed, for the same reasons as discussed above in relation to the main request (Article 123(2) EPC).

4. Sixth auxiliary request - admittance

4.1 This auxiliary request was first filed with the reply to the statement setting out the grounds of appeal. When filing this request, the respondent declared (reply, page 20, second paragraph) that it was aimed at overcoming the objection of added subject-matter raised against the main request and discussed in section 2 above.

4.2 According to Article 12(4) RPBA, when an amendment to a party's case, such as a new request in the case of a patent proprietor, is submitted with the reply to the statement setting out the grounds of appeal, the patent proprietor, currently respondent, shall clearly identify each amendment and provide reasons for submitting it in the appeal proceedings, and also indicate the basis for the amendment in the application as filed and provide reasons why the amendment overcomes the objections raised.

According to Article 12(6), second sentence, RPBA, the board shall not admit requests which should have been submitted in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance.

4.3 The appellant argued, both in its letter of 28 May 2025 (point III, pages 20 and 21) and at the oral proceedings before the board, that the respondent, while having identified the amendments made to this request, had clearly failed to provide reasons for submitting it and also failed to invoke circumstances justifying its introduction with the reply to the statement of grounds of appeal.

At the oral proceedings before the board, the appellant further submitted, also referring to Rule 79 EPC, that, as the objection of added subject-matter had been raised from the very outset of the opposition proceedings, the respondent should have filed auxiliary requests to react to that objection regardless of how the opposition division assessed it.

For these reasons the appellant requested that the sixth auxiliary request not be admitted into the appeal proceedings.

4.4 The board disagrees with the appellant and considers the sixth auxiliary request admissible, for the following reasons.

4.4.1 Concerning Article 12(6), second sentence, RPBA, the board notes that the preliminary opinion of the opposition division (dated 26 May 2023, point II.2) did not concur with the objection of added subject-matter raised by the appellant.

Because of that, the respondent had no reason to file further auxiliary requests to overcome that objection before the opposition oral proceedings: although it could have done this at that stage of the opposition proceedings, there appears to be no reason why it should have done so (see also CLB, V.A.4.3.7c); T 141/20, Reasons 5.4; T 1865/23, Reasons 4.1).

The appellant's reference to Rule 79 EPC is not convincing either.

As a matter of fact, the board is of the view that the respondent could still have filed such requests during the oral proceedings if the opposition division had

changed its opinion on the issue of added subject-matter, which however did not happen, as the opposition was rejected. Again, there appears to be no reason why the respondent should have filed these requests at that stage of the opposition proceedings.

Therefore the respondent had no reason to file auxiliary requests to overcome the objection of added subject-matter during the opposition proceedings. Article 12(6), second sentence, RPBA does not therefore prejudice admittance of the sixth auxiliary request.

4.4.2 Concerning Article 12(4) RPBA, the board notes that the respondent identified that the sixth auxiliary request was an amendment to its case and provided reasons for submitting it in the appeal proceedings (see point 4.1 above). In particular, the request was filed with the respondent's reply, i.e. at the earliest stage of the appeal proceedings, expressly to overcome the objection of added subject-matter. It is therefore understood that the sixth auxiliary request was filed in anticipation of the board agreeing with the appellant and departing from the opposition division's findings on that issue. Furthermore, the respondent indicated the basis for the amendments in the application as filed (original claim 3) and provided reasons why the amendments overcome the objections raised, i.e. the handling member had been included. This for the board is sufficient to satisfy the requirements of Article 12(4) RPBA in the circumstances of this case.

4.4.3 Taking into account that the amendment appears *prima facie* to be suitable to address the objection under Article 123(2) EPC, the board exercised its discretion to admit this request into the proceedings. The sixth

auxiliary request is therefore admitted into the appeal proceedings.

5. Request for remittal submitted by the appellant

5.1 Following the admission of the sixth auxiliary request into the appeal proceedings, the appellant requested remittal of the case to the opposition division for further prosecution.

To substantiate this request, the appellant referred to potential new patentability issues raised by the now-admitted sixth auxiliary request, and argued that remittal to the opposition division was justified as this auxiliary request had not been dealt with in the contested decision or commented upon by the opposition division.

5.2 The respondent contested the remittal and stated that the appellant had already submitted its objections against the sixth auxiliary request in writing with its letter of 28 May 2025 and that therefore the case was ready for decision by the board, unless documents D7 to D9 were admitted into the proceedings.

5.3 The appellant's arguments in favour of remitting the case to the opposition division are not convincing, for the following reasons.

5.3.1 According to Article 11 RPBA, the board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so.

The board does not find that special reasons for remittal are present at the current stage of the appeal proceedings.

The discussion on the main request and on the first to fifth auxiliary requests has focused on the objection of added subject-matter.

The sixth auxiliary request was filed precisely to overcome this objection, by adding to claim 1 the handling member, which is the feature found to be missing from the main request (see section 2 above).

Therefore, although the decision under appeal was limited to the main request, discussing the objections of lack of clarity and added subject-matter raised against the sixth auxiliary request (see appellant's letter of 28 May 2025, point III, page 21) is not seen by the board as representing an undue burden which would amount to special reasons for remittal.

The request for remittal submitted by the appellant is therefore not granted.

6. Sixth auxiliary request - added subject-matter, clarity
- 6.1 Claim 1 of the sixth auxiliary request is based on claim 1 of the third auxiliary request and has been amended by adding thereto the additional features of the original claim 3 (see point VII above).
- 6.2 The appellant argues that claim 1 of the sixth auxiliary request contains added subject-matter and lacks clarity, as follows.

6.2.1 The requirements of Article 123(2) EPC are already not satisfied because method claim 1 has been amended by unallowably adding features coming from apparatus claims (original claims 3, 9 and 18).

The appellant further argues that the replacement in granted claim 1 of the expression "store unit", used in the original claims, by "storage unit" also results in added subject-matter, as both expressions designate different entities in the application as filed.

Still according to the appellant, the requirements of Article 76(1) EPC are not satisfied either as the same arguments apply, *mutatis mutandis*, with respect to the parent application D1.

6.2.2 The requirements of Article 84 EPC are not satisfied either because the features in claim 1 defining the cutting head as comprising a coupling and being configured to impart a rotary and cyclic movement to the blade define a result to be achieved rather than providing technically clear instructions.

The appellant further argued at the oral proceedings before the board that the scope of protection conferred by these features is not defined with sufficient precision, and that the structural relationship between the coupling and the other elements of the cutting head is not clear to the skilled person.

6.3 The board is not convinced by the appellant's arguments for the following reasons, as set out by the respondent.

6.3.1 The appellant argues that claim 1 of the sixth auxiliary request results from an unallowable

combination of features derived from claims of different categories. However, the basis for the features added to method claim 1 is not confined to the original product claims, but is also disclosed in paragraphs [0053] and [0128] of the original description.

As discussed in detail in point 2 above, both paragraphs disclose the handling member in combination with the blade-holder as part of the cutting machines and methods for cutting logs (figures 9A to 9O and figures 14 to 16 respectively). A basis is therefore provided for the amendments to claim 1 of the sixth auxiliary request.

The same applies with respect to the parent application D1 in view of the similar arguments put forward by the parties for the requirements of Article 76(1) EPC.

- 6.3.2 The argument that "store unit" and "storage unit" designate different entities and cannot be used interchangeably is not convincing.

As correctly noted by the opposition division (impugned decision, point II.2.1), both expressions are used throughout the description and claims as synonyms for a unit in which cutting blades are stored. Therefore the skilled person will directly and unambiguously derive that the two expressions are used for the same entity in the application as originally filed.

The appellant has not identified any passage in the application as filed from which it could be indicated that the two expressions refer to structurally or functionally different entities.

The mere fact that the two expressions are used in different parts of the description does not establish *per se* that they refer to different entities.

6.3.3 The board therefore concludes that the sixth auxiliary request meets the requirements of Articles 123(2) and 76(1) EPC.

6.3.4 On the issue of clarity, the board notes that, according to established case law (CLB, II.A.3.5), features cannot be considered unclear merely because they define a result to be achieved, provided that the skilled person knows, without exceeding their normal skills and knowledge, what they have to do in order to obtain said result. The board is convinced that this requirement is satisfied in the present case for imparting a rotary and cyclic movement to the blade, as this is known and usual in the present technical field.

The fact that a structural relationship between elements is not explicitly specified but may be derived by their interaction, i.e. their respective function, does not *per se* render the features defining the structural relationship unclear, especially when, as is currently the case, such interaction is common and well understood in mechanical engineering and in the present technical field.

The appellant's objections under Article 84 EPC are therefore not convincing.

7. Novelty objection based on D5 raised against the sixth auxiliary request - admittance

7.1 Both parties agreed at the oral proceedings that the inventive-step objections raised in the appellant's

statement of grounds of appeal against granted claim 3 were also validly raised against claim 1 of the sixth auxiliary request, in view of the substantial overlap between the subject-matter of those claims. The board had no reason to see it otherwise.

7.2 Following this agreement, the appellant submitted that the novelty objection raised in the statement of grounds of appeal against granted claim 3, addressed in point G.I of that document (pages 26 to 29), was equally applicable to claim 1 of the sixth auxiliary request.

7.3 The board disagrees, and does not admit this objection into the appeal proceedings, pursuant to Article 13(2) RPBA.

Claim 1 of the sixth auxiliary request differs from the granted claim 1 in that it additionally requires the presence of at least one handling member, to remove a worn disc-shaped cutting blade from the cutting head and replace it with a new disc-shaped cutting blade taken from the storage unit.

A review of point G.I of the statement of grounds of appeal (pages 26 to 29) confirms that the appellant's novelty analysis is directed exclusively to features A to G, Di and Dii of the granted claim 1, and contains no analysis of whether D5 discloses a handling member (features HH. and GG. of claim 3 of the patent as granted).

The section concludes with the statement that "*the subject-matter of the granted claim 1 is anticipated by D5, as all features of claim 1 are clearly and unambiguously derivable from document D5*".

This conclusion refers to granted claim 1, which does not include the handling member. As a result, the board does not concur with the appellant's view that the lack-of-novelty objection should be seen as at least implicitly raised against claim 3 of the patent as granted in point G.I of the statement setting out the grounds of appeal, since at least features HH and GG of said claim which were introduced in claim 1 of the sixth auxiliary request are not discussed therein.

Based on the above considerations it is clear that a novelty objection directed against claim 1 of the sixth auxiliary request, which does include the handling member, constitutes an amendment to the appellant's case.

No exceptional circumstances justifying the admittance of this amendment at the stage of oral proceedings before the board have been identified, nor have any been invoked by the appellant.

The novelty objection against claim 1 of the sixth auxiliary request submitted during oral proceedings is therefore not admitted into the appeal proceedings (Article 13(2) RPBA).

- 8. Documents D7 to D9 - admittance
- 8.1 Documents D7 to D9 were first filed with the statement setting out the grounds of appeal.
- 8.2 The respondent requests that these documents not be admitted into the appeal proceedings.

It argues that the admission of the sixth auxiliary

request does not constitute a change of situation justifying the admittance of D7 to D9, since the subject-matter of claim 1 of the sixth auxiliary request is essentially based on that of granted claim 3, which was before the opposition division throughout the proceedings.

Prior art against the patent in suit should have been filed before the expiry of the opposition period.

The respondent further submits that documents D7 to D9 are not *prima facie* more relevant than the prior art already on file, and also draws a parallel with the ground of sufficiency of disclosure, noting that the reasons against admitting that late-filed ground apply equally to admittance of these late-filed documents.

- 8.3 The appellant argues that documents D7 to D9 should be admitted because the opposition division had changed its position with respect to its preliminary opinion by interpreting the term "seats" in feature Dii as "specific" or "dedicated" seats, and also because the admittance of the sixth auxiliary request into the appeal proceedings justified the filing of evidence relevant to the assessment of the patentability of this new request.
- 8.4 As put forward at the oral proceedings before the board, the appellant also considers that D7 to D9 should be admitted in view of the new situation created by the admission of the sixth auxiliary request into the appeal proceedings.
- 8.5 The board therefore decides to admit documents D7 to D9 into the appeal proceedings as a matter of fairness to the appellant in view of the admission of the

respondent's sixth auxiliary request into the proceedings (Article 13(3) RPBA).

The board considers that the admission of the sixth auxiliary request in itself constitutes exceptional circumstances pursuant to Article 13(2) RPBA justifying the consideration of documents D7 to D9 in the proceedings.

It is emphasised that claim 1 of the sixth auxiliary request is a method claim which combines the features of granted claim 1 with some features of granted claim 3. Claim 1 of the sixth auxiliary request does not correspond to any of the claims of the patent as granted and has not been examined in opposition proceedings.

Documents D7 to D9 were filed by the appellant to address precisely this subject-matter, and their potential relevance needs to be assessed in view of the amended claim.

9. Request for remittal submitted by the respondent
- 9.1 Following the admission of documents D7 to D9 into the appeal proceedings, the respondent requested remittal of the case to the opposition division for further prosecution.
- 9.2 The appellant agreed with this request.
- 9.3 The board grants the respondent's request and decides to remit the case to the opposition division, for the following reasons.

According to Article 111(1) EPC, the board may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.

According to Article 11 RPBA, the board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so.

It is established case law that special reasons within the meaning of Article 11 RPBA may exist where the decision under appeal was confined to a limited set of issues and the board, following amendment of the case in appeal, would be required to decide on issues that have not been examined at first instance (CLB, V.A. 9.3.5b)).

The board considers that such special reasons are present in this case.

The decision under appeal was confined to an assessment of the grounds for opposition as raised against the main request.

With the admission of the sixth auxiliary request and of documents D7 to D9 into the present appeal proceedings, the scope of the case has significantly changed.

The opposition division has never examined the patentability of the subject-matter of claim 1 of the sixth auxiliary request, a method claim combining features of granted claims 1 and 3 that was not before the opposition division in that form, nor has it

assessed the relevance of documents D7 to D9 in that respect.

A decision by the board on patentability of new subject-matter in view of new documents at the latest stage of the proceedings, i.e. at the oral proceedings before the board, constitutes an undue burden leading to special reasons for remittal (see OJ EPO 2020, Supplementary publication 2, page 54).

The board further notes that both parties have explicitly requested remittal.

While the agreement of the parties is not decisive under Article 11 RPBA, it is a relevant consideration that reinforces the conclusion that remittal is appropriate in the circumstances of the present case.

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:



S. Lichtenvort

G. Patton

Decision electronically authenticated