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# Datasheet for the decision of 18 April 2024

Case Number: T 0007/22 - 3.2.01

14150475.3 Application Number:

Publication Number: 2893995

B23C5/20, B23C5/06 IPC:

Language of the proceedings: EN

#### Title of invention:

A metal cutting insert and a milling tool

#### Patent Proprietor:

Sandvik Intellectual Property AB

#### Opponent:

Iscar Ltd.

#### Headword:

#### Relevant legal provisions:

EPC R. 80 EPC Art. 83, 52(1), 54, 111 RPBA 2020 Art. 11

# Keyword:

Amendment occasioned by ground for opposition - (yes)
Sufficiency of disclosure - (yes)
Novelty - main request (yes)
Appeal decision - remittal to the department of first instance for further prosecution (yes)

# Decisions cited:

T 0181/02, T 0263/05, T 0815/07

#### Catchword:



# Beschwerdekammern Boards of Appeal Chambres de recours

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Case Number: T 0007/22 - 3.2.01

DECISION
of Technical Board of Appeal 3.2.01
of 18 April 2024

Appellant: Sandvik Intellectual Property AB

(Patent Proprietor) 811 81 Sandviken (SE)

Representative: WSL Patentanwälte Partnerschaft mbB

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65185 Wiesbaden (DE)

Respondent: Iscar Ltd.
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Representative: Vossius & Partner

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Decision under appeal: Interlocutory decision of the Opposition

Division of the European Patent Office posted on 29 October 2021 concerning maintenance of the European Patent No. 2893995 in amended form.

#### Composition of the Board:

Chairman G. Pricolo
Members: V. Vinci
P. Guntz

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# Summary of Facts and Submissions

I. The appeal filed by the appellant (patent proprietor) is directed against the interlocutory decision of the opposition division maintaining the European patent  $N^{\circ}$  2 893 995 in amended form.

In its decision the opposition division held that the the subject-matter of independent claim 1 according to both the main request and the auxiliary request I was not novel in view of the following prior art

VP-03: US 8 231 311 82.

and decided to maintain the patent according to the auxiliary request II.

During the opposition proceedings the opponent also challenged novelty of independent claim 1 according to the main request in view of document:

VP-02: US 2013/0156515

II. With the communication according to Article 15(1) RPBA dated 15 January 2024 the Board informed the parties of its preliminary assessment of the case.

Oral proceedings pursuant to Article 116 EPC were held before the Board on 18 April 2024 by videoconference.

III. The appellant (patent proprietor) requested that the interlocutory decision of the Opposition Division be set aside and that the patent be maintained on the basis of the main request underlying the decision under appeal or, in the alternative, that the patent be

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maintained on the basis of one of the auxiliary requests I and II filed with the statement of grounds of appeal.

The respondent (opponent) requested that the appeal of the appellant (patent proprietor) be dismissed.

- IV. Claim 1 according to the main request corresponds to independent claim 1 of the main request filed on 16 June 2020 and reads as follows (labelling according to the decision under appeal, point 11.1):
  - F1.1 An indexable cutting insert (1) for a milling tool (101), the cutting insert comprising:
  - F1.2 an upper side (2) defining an upper extension plane (PU);
  - F1.3 a lower side (3) defining a lower extension plane (PL) parallel to the upper extension plane (PU);
  - F1.4 wherein a centre axis (C2) extends perpendicularly through the upper extension plane (PU) and the lower extension plane (PL);
  - F1.5 a side surface (4) connecting the upper side (2) and the lower side (3),
  - F1.5.1 the side surface (4) comprising a plurality of upper main clearance surfaces (5) and
  - F1.5.2 upper secondary clearance surfaces (6, 6a, 6b); and
  - F1.6 at least six identical and alternately usable upper cutting edges (7) extending around the upper side

- (2)**,**
- F1.6.1 wherein each cutting edge (7) comprises a chip removing main cutting edge portion (8) and
- F1.6.2 at least one secondary cutting edge portion (9, 10),
- F1.6.3 wherein the main cutting edge portion (8) is formed in a transition between the upper side (2) and one of said upper main clearance surfaces (5), and
- F1.6.4 the secondary cutting edge portion (9, 10) is formed in a transition between the upper side (2) and one of said secondary clearance surfaces (6, 6a, 6b) in a region between two main cutting edge portions (8),
- F1.7 each of said upper main clearance surfaces (5) is formed at an obtuse inner angle  $\alpha$  with respect to the upper extension plane (PU) as seen in side elevation view, and
- F1.8 the inner angle ( $\alpha$ ) between the upper extension plane (PU) and each of said upper main clearance surfaces (5) is within the range 98°  $\leq \alpha \leq$  114°,

#### characterized in that

- F7.1 the cutting insert (1) is double-sided with the lower side (3) identical to the upper side (2),
- F4.1 each of said secondary clearance surfaces (6, 6a, 6b) is formed at an inner angle  $\beta$  with respect to the upper extension plane (PU) as seen in side elevation view, wherein  $\beta$  <  $\alpha$  and in that

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F5.1 the inner angle  $\beta$  between the upper extension plane (PU) and the secondary clearance surface (6, 6a, 6b) below at least a part of the upper secondary cutting edge (9, 10) is within the range  $85^{\circ} \leq \beta \leq 100^{\circ}$ .

#### Reasons for the Decision

#### MAIN REQUEST

1. The main request complies with the requirements of Rule 80 EPC and therefore was correctly admitted in the opposition proceedings by the opposition division.

# Rule 80 EPC

2. The respondent (opponent) maintained that the amended main request filed on 16 June 202 during the first instance proceedings did not fulfil the requirements of Rule 80 EPC because it contained two independent claims 1 and 6 while the set of claims as granted included only a single independent claim. The respondent (opponent) argued that according to established case law of the Boards of Appeal the replacement of a single granted dependent claim by two or more independent claims could be considered to be occasioned by a ground of opposition and hence allowable under Rule 80 EPC only in exceptional cases, for example when a granted independent claim covers two specific embodiments or when two granted dependent claims are linked parallel to a single independent claim (decision T 181/02, Reasons 3.2 was referred to). respondent's (opponent's) view, none of situations applied here and therefore the main request should have not been admitted. Reference was also made

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to further decisions as for example T 610/05, T 223/97, T 1810/04 and T 2290/12.

2.1 The Board does not agree and sees no reasons to deviate from the view of the opposition division expressed in the minutes (see point 3.3) that the main request meets the requirements of Rule 80 EPC.

The reasons are the following:

2.2 The first independent claim 1 of the amended main request is based on a combination of claim 1 with dependent claims 4, 5 and 6 as granted, where dependent claim 4 is (also) directly dependent on independent claim 1. The second independent claim 6 of the amended main request is based on a combination of independent claim 1 with dependent claims 11 and 12 as granted, where claim 11 is (also) directly dependent independent claim 1. Therefore, the amendments under discussion fall under the second exception described in the cited decision T 181/02 cited by the respondent (opponent). Furthermore, as confirmed by the conclusion of the decision T 263/05 (see Reasons 4.7 and 4.8) referred to by appellant (patent proprietor) and citing the above mentioned T 181/02, the replacement of a single independent claim by two or more independent in an attempt to overcome claims a ground opposition is permitted if otherwise the patent proprietor, by filing a single independent claim, would be forced to abandon potentially valid subject-matter already contained in the dependent claims as granted. This would be the case here in view of the dependency of claim 11 from claims 1 to 10.

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## Article 83 EPC: Alleged Insufficient Disclosure

- 3. The main request complies with the requirements of Article 83 EPC.
- 3.1 The respondent (opponent) observed that feature F1.8 of claim 1 defined an exact range for the inner angle  $\alpha$ formed between the upper extension plane and each of the upper main clearance surfaces. It was stressed that it was crucial in order to carry out the invention that this parameter could be unambiguously and consistently determined for all different embodiments (reference was made in this respect to the Case Law of the Boards of Appeals, and in particular to the conclusion of T 815/07). The respondent (opponent) noted that claim 1 did not exclude that the clearance surfaces could also be curved and not mandatorily flat, as instead assumed by the appellant (patent proprietor), and pointed out that the opposed patent did not specify how the inner angle shall be measured. As there were different ways of measuring an angle between a planar and a curved surface, the inner angle  $\alpha$  recited in claim 1 could not be precisely and unambiguously determined. Figure 4a to 4c cited by the opposition division as an indication of possible ways to measure the inner angle  $\alpha$  did not show curved clearance surfaces and therefore could not be of any help. Finally the respondent (opponent) argued that the patent did not provide any information regarding how to measure the inner angle  $\boldsymbol{\alpha}$  with respect to the tangent of the clearance surface at the cutting edge as suggested by the opposition division in case of curved clearance surfaces. In view of all the above, respondent (opponent) concluded that the patent did not disclose how to consistently realize and verify the value of the inner angle if the upper clearing surfaces were curved, which were encompassed by claim 1, and

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therefore it did not sufficiently disclose how to carry out the invention over the whole scope of the claims.

3.2 The arguments of the respondent (opponent) are not convincing for the following reasons:

The Board concurs with the opposition division that the skilled person based on Figures 4a to 4c of the contested patent understands that the inner angle has to be measured with respect to the tangent of the upper clearance surface. This teaching is applicable to both planar and curved clearance surfaces. The Board cannot thus see any problem for the person skilled in the art to measure the actual angle formed with the upper extension plan (PU), and this irrespective of the geometry of the upper clearance surface. The contrary has not been demonstrated by the respondent (opponent) who based their assertion that the person skilled in the art was not able to measure the inner angle  $\alpha$  in case of a curved upper clearance surfaces on a mere allegation.

#### Articles 52(1) and 54 EPC: Novelty

- 4. Contrary to the findings of the opposition division the Board takes the view that the subject-matter of claim 1 according to the main request is novel within the meaning of Articles 52(1) and 54 EPC.
- 4.1 In the decision under appeal the opposition division followed the arguments of the respondent (opponent) and concluded that document VP-03 was prejudicial to novelty of independent claim 1 according to the main request. This finding is contested by the appellant (patent proprietor) with their appeal.

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# Novelty over VP-03

4.2 The following features of claim 1 according to the main request are under discussion:

### F1.2, F1.3 and F1.7

4.3 The appellant (patent proprietor) criticized the allegedly broad interpretation of these features provided by the opposition division resulting in the conclusion that the "peaks" of the circular cutting edge of the cutting insert shown in Figure 2 document VP-03 defined upper and lower extension planes within the meaning of features F1.2 and F1.3 of claim 1. It was alleged that a person skilled in the art reading features F1.2 and F1.3 in the context of claim 1 clearly understood that some kind of planar structure defining the claimed extension planes had provided, i.e. a flat upper or lower side of cutting insert or at least a circumferential cutting edge laying in the same plane. In the appellant's (patent proprietor's) opinion a cutting insert with undulated lower and upper cutting edges forming "peaks" and "troughs" as that shown in Figure 2 of VP-03 and deprived of an upper and lower planar structure did not fulfil features F1.2 and F1.3 of claim 1. The appellant (patent proprietor) argued that this view was confirmed by features F1.7 requiring an inner angle  $\alpha$  formed between the upper extension plane of feature F1.2 and each one of the upper main clearance surfaces. In this respect it was observed that in the case of VP-03 and with the only exception of the peaks, the upper clearance surface indicated by the reference number (56) in Figure 2 was not adjacent to and did not intersect the alleged upper extension plane identified by the opposition division, namely a plane passing

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through and containing all the 5 peaks of the upper cutting edge. Therefore, if the interpretation of the opposition division was adopted, no inner angle could be defined as instead required by feature F1.7. The appellant (patent proprietor) thus concluded that the finding of the opposition division that features F1.2 and F1.3 were directly and unambiguously disclosed in VP-03 was based on a too broad interpretation of the wording of the claim and was thus incorrect.

4.3.1 The arguments submitted by the appellant (patent proprietor) are not convincing:

The Board concurs with the opposition division and the respondent (opponent) that the wording of features F1.2 2 and Fl.3 reading "an upper side defining an upper extension plane" and "a lower side defining a lower extension plane" respectively must be construed broadly regarding the meaning of the term "defining " which is not further specified. This wording does not require that the upper and lower sides of the claimed cutting insert comprise/incorporate at least one structure as asserted by the appellant (patent proprietor). The Board thus shares the view of the opposition division and the respondent (opponent) that the five coplanar peaks/upmost points of the undulated lower and upper cutting edges of the cutting insert of VP-03 clearly visible in Figure 2 define respective lower and upper extension planes within the meaning of 1, namely the planes passing through containing these peaks. Regarding the argument of the appellant (patent proprietor) that the absence intersections between the main clearance surfaces and the extensions plane (with the exception of the peaks) in the cutting insert of VP-03 rendered impossible to define the inner angle  $\alpha$  required by feature F1.7 of

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claim 1, the Board follows the view of the respondent (opponent) presented with the aid of a sketch at the oral proceedings (see also reply dated 15.12.2022, page 2) that the inner angle  $\alpha$  between the upper main clearance surface and the upper extension plane can be defined also in the case of the cutting insert according to VP-03, namely by extending upwardly the upper main clearance surface until it intersects the upper extension plane defined by the peaks and measuring the angle formed between said extended upper main clearance surface and the upper extension plane. This additional argument of the appellant (patent proprietor) is thus not convincing.

- 4.3.2 Furthermore, there is no doubt that the inner angle  $\alpha$  formed between the upper extension plane of the cutting insert according to VP-03 and each of the upper main clearance surfaces can be defined and that this angle is an obtuse angle as required by feature F1.7 of claim 1. This information is clearly derivable for example from Figure 4a of this prior art document.
- 4.3.3 In conclusion the Board confirms the conclusion of the opposition division that features F1.2, F1.3 and F1.7 are directly and unambiguously disclosed in VP-03.

#### Feature F1.6

- The appellant (patent proprietor) contested the view of the opposition division and the respondent (opponent) that the cutting insert of VP-03 comprised "at least six identical and alternatively usable upper cutting edges extending around the upper side".
- 4.4.1 The opposition division supported by the appellant (opponent) observed that VP-03 generally disclosed (see

column 2, line 56 and claim 1) that the cutting insert described therein had a polygonal prismatic shape, hence with a number N of cutting edges > 2. Furthermore, the figures disclosed a specific embodiment with 5 cutting edges also claimed in claim 7. On the basis of this information provided in document VP-03 the opposition division applied the criteria usually adopted for assessing novelty of claimed ranges and concluded that VP-03 directly and unambiguously disclosed a cutting insert with six identical and alternatively usable upper cutting edges according to feature F1.6.

4.4.2 The Board cannot follow the reasoning and the conclusion of the opposition division and takes the view that feature F1.6 is not directly and unambiguously disclosed in document VP-03 for the following reasons:

In the present case, a discrete number of cutting edges is claimed and this feature has to be compared with the corresponding feature disclosed in VP-03. The Board is convinced that the well established general principle that a generic disclosure does not take away the novelty of any specific claimed embodiment falling within the terms of that generic disclosure has to be applied here to asses novelty of this feature instead of the criteria normally applied to assess novelty of ranges adopted by the opposition division. By doing that and contrary to the findings of the opposition division in the decision under appeal, the Board holds that the fact that document VP-03 discloses a cutting insert having a polygonal prismatic shape (general disclosure) only indicates that the cross section of the cutting insert has a plural number of sides forming a closed figure and a corresponding plural number of - 12 - T 0007/22

upper cutting edges. However, this does not result in a direct and unambiguous disclosure of a cutting insert with specifically at least six upper cutting edges as required by feature Fl.6 of claim 1.

4.4.3 Therefore, contrary to the assessment of the opposition division, feature F1.6 is not directly and unambiguously disclosed in VP-03.

#### Features F1.8 and F4.1

- 4.5 The appellant (patent proprietor) contested the findings of the opposition division that features F1.8 and F4.1 were directly and unambiguously disclosed in VP-03.
- 4.5.1 In order to correctly asses these features with respect to the disclosure of VP-03, it is necessary to correctly and consistently construe claim 1 in a way that makes technical sense in its technical context.
- 4.5.2 In this respect the appellant (patent proprietor) put forward that the person skilled in the art in view of the wording of features F1.6.1 and F1.6.2 understood that each cutting edge has exactly two and only two portions, namely a main cutting edge portion and a secondary cutting edge portion. The appellant (patent proprietor) further observed that there was indication in the contested patent suggesting that the upper main clearance surfaces could also be curved, whereby a planar upper main clearance surface implied an inner angle  $\alpha$  remaining constant along the entire extension of each main upper cutting edge and of the underlying upper main clearance surface. The appellant (patent proprietor) concluded that the person skilled in the art reading claim 1 in its technical context and

with a mind willing to understand and aiming to provide a logic interpretation had no doubt that the range claimed for the inner angle  $\alpha$  recited in Feature 1.8 had to be verified along the whole upper main clearance surface. The same applied to the inner angle  $\beta$  and to the relation specified in features F4.1.

4.5.3 This narrow interpretation was contested by respondent (opponent). It was put forward that claim 1 did not require at all that the main and secondary clearance surfaces were planar and hence that the inner angles  $\alpha$  and  $\beta$  were constant along them. Furthermore, the respondent (opponent) argued that claim 1, due to the use of the open formulation "comprises" in feature F1.6.1 (as opposed to "consists"), encompassed the possibility that the cutting edge comprised further identifiable portions in addition to the main secondary cutting edge portions, in which the claimed range of the inner angle  $\alpha$  specified in features F1.8  $\,$ and the condition  $\beta < \alpha$  of feature F4.1 did not need to be met to fulfil the claim. Such a design option encompassed by claim 1 was exactly that of the cutting insert of document VP-03 which therefore took away the novelty of features F1.8 and F4.1 of claim 1. of this interpretation the support (opponent) referred to paragraph [0036], lines 35-38 of the patent describing transition portions between the main and secondary clearance surfaces and hence between the main and secondary cuttings edges. The respondent (opponent) stressed that all what was required by feature F1.8 was that the inner angle  $\alpha$  was within a range of 98° to 114° at least in a section of the main cutting edge. The same applied to the relation  $\beta < \alpha$ recited in feature F4.1 which had to be fulfilled only in a section of the secondary cutting edge. The respondent (opponent) therefore concluded that the

narrow interpretation of claim 1 and in particular of features F1.8 and F4.1 provided by the appellant (patent proprietor) in support of the novelty of these features was not justified.

4.5.4 The Board - contrary to the assessment of the opposition division - takes the view that features F1.8 and F4.1 of claim 1 of the main request are not directly and unambiguously disclosed in VP-03 for the following reasons:

The findings of the opposition division supported by the respondent (opponent) are based on an artificial reading of the wording of claim 1 leading to the arbitrary assumption that claim 1 does not exclude that there are sections of the cutting edges where the conditions set in features F1.8 and F4.1 for the inner angle are not met. Such alleged geometry of the cutting insert would indeed correspond to the disclosure of VP-03. In fact it is undisputed that in a section of the main cutting edge extending backwards from the upper end 58 of the cutting edge in Figure 3 of VP-03 (where the inner angle  $\alpha$  is 100°) to an intermediate point of the same main cutting edge (where the inner angle  $\alpha$  is 98°) feature F1.8 is satisfied (see VP-03, column 7, lines 8 to 20). However, there is no hint in claim 1 read as a whole and in the description and interpretation drawings supporting the respondent (opponent) that the expression in feature "each of said upper main clearance surfaces" defines just a sub-section of the upper main clearance surface and hence just a sub-section of cutting edge where and only where the claimed range must be satisfied. For this reason the Board - contrary to the interpretation of the opposition division reads feature F1.8 as requiring that the claimed range

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for the inner angle  $\alpha$  must be fulfilled along the whole upper main clearance surface of each main cutting edge. This is clearly not the case of the cutting insert of VP-03 where the range of feature F1.8 is satisfied only on a sub-section of the upper main clearance surface as admitted by the respondent (opponent). Furthermore, this interpretation and this conclusion are valid also in case of curved main clearance surfaces where the (variable) inner angle has to be calculated with reference to the tangent to the main clearance surface.

- 4.5.5 The same interpretation and conclusions apply to feature F4.1 because for the same reasons presented above the limitation  $\beta < \alpha$  must be fulfilled along the entire secondary clearance surface of each secondary cutting edge. This is not the case with regard to the cutting insert of VP-03.
- 4.5.6 In conclusion and contrary to the assessment of the opposition division feature F1.8 and F4.1 of claim 1 of the main request are not directly and unambiguously disclosed in VP-03.

#### Feature F5.1

- 5. The appellant (patent proprietor) contests the view of the opposition division that this feature is directly and unambiguously disclosed in VP-03 with essentially the same arguments submitted in respect of features F1.8 and F4.1.
- 5.1 However, the Board observes that feature F5.1 is differently worded when compared to features F1.8 and F4.1 because it additionally specifies that the inner angle  $\beta$  is within the range 85° and 100° "below at

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least a part of the upper secondary cutting edge" (emphasis added). Consequently and differently from feature F1.8, the range claimed for the inner angle  $\beta$ does not need to be fulfilled along the whole secondary cutting edge, but merely along at least a portion of it. As correctly argued by the respondent (opponent), the inner angle  $\beta$  of the cutting insert of VP-03 indisputably falls within the range required by feature F5.1 at least in a section of the secondary cutting edge, functionally corresponding to the "at least one secondary cutting edge portion" of feature F1.6.2. This section is located between the secondary cutting edge lower end 78 where the inner angle  $\beta$  is 90° (see Figures 8 and 9 of VP-03) and the point where the inner angle  $\beta$  assumes the value of  $\beta=97^{\circ}$ , i.e. at the position of the secondary cutting edge where the angle  $\delta$  is = 7° (see VP-03, column 7, lines 21-29 and Figures, 3, 4, 8 and 9). Feature F5.1 of claim 1 according to the MR is thus disclosed in document VP-03.

6. In conclusion - contrary to the findings of the opposition division - the subject-matter of claim 1 according to the main request is novel over VP-03 and differs from this prior art document in the features F1.6, F1.8 and F1.4.

#### Novelty over VP-02

- 7. Regarding this further novelty attack the parties at the oral proceedings referred to their respective written submissions.
- 7.1 The respondent (opponent) contested the positive assessment of novelty of the opposition division over VP-02 and in particular that features F1.6, F4.1 and

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- F5.1 were not directly and unambiguously disclosed in this prior art document.
- 7.1.1 Regarding disputed feature F1.6, the respondent (opponent) put forward that although Figure 2A of VP-02 showed a cutting insert with four cutting edges, the person skilled in the art directly and unambiguously derived from the statement in paragraph [0074] the teaching that "it should be appreciated that the end surface may have any other polygonal shape, such that each circumferential cutting edge would include N cutting edge sections, that is, N first cutting edges and N second cutting edges, wherein N is a positive integer, and N>2", i.e. that all features described in document VP-02 also apply to any polygonal cutting insert including a cutting insert having at least six identical cutting edges.
- 7.1.2 However this reasoning, which corresponds to that provided in support of the disclosure of feature F1.6 in document VP-03, cannot be followed for the same reasons provided under point 4.4.2 above.
- 7.1.3 Regarding disputed features F4.1 and F5.1, the respondent (opponent) pointed out that VP-02 disclosed in paragraph [0069] that the inner angle of the main clearance surface is in the range of 85° to 100° and the inner angle of the secondary clearance surface is in the range of 65° to 83°. It was alleged that taking the error margins into account these ranges corresponded to the ranges defined in features F4.1 and F5.1 of claim 1 according to the main request.
- 7.1.4 However, the Board is satisfied by the argument of the appellant (patent proprietor) that paragraph [0069] of VP-02 only describes that the inner angle can be in the

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range between 65° and 83° which lies clearly outside the range required by feature F5.1.

7.2 In conclusion document VP-02 does not disclose features F1.6 and F5.1 at least.

#### REMITTAL

- 8. After announcing the result of the deliberation of the Board regarding novelty, the respondent (opponent) requested remittal of the case to the department of first instance for further prosecution under Article 111 EPC. As "special reasons" for the remittal within the meaning of Article 11 RPBA the respondent (opponent) mentioned that inventive step in respect of the main request had not been discussed before the opposition division and that the assessment of the distinguishing features with respect to VP-03 of the Board was based on a new interpretation of claim 1 regarding in particular features F1.8 and F4.1. These facts resulted in a new and more complex procedural scenario that required some preparation by respondent (opponent) and extensive discussion.
- The appellant (patent proprietor) objected to the remittal of the case to the opposition division. In this respect they argued that the case should have been already prepared by the respondent (opponent) in all its aspects and that the change of opinion of the Board at the oral proceedings with respect to the preliminary opinion regarding the actual distinguishing features could not be considered to represent "special reasons" justifying the remittal of the case. The appellant (patent proprietor) also pointed out that as the interpretation of claim 1 was always a main issue throughout the whole opposition and appeal

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proceedings, the respondent (opponent) had to be prepared to new scenarios and procedural developments in this respect. Finally, it was pointed out that also the need of procedural economy spoke against a remittal of the case.

The Board agrees with the respondent (opponent) that the assessment of the distinguishing features F1.6, F4.1 and F5.1 resulting from the discussion on novelty over VP-03 held at the oral proceedings does not only result in a change of opinion with respect to the preliminary view provided with the communication according to Article 15(1) RPBA, but also in a completely new and complex scenario never discussed before which therefore required adequate preparation. The Board takes the view that these circumstances represent "special reasons" within the meaning of Article 11 RPBA justifying the remittal of the case to the opposition division for further prosecution.

#### 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.

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The Registrar:

The Chairman:



M. Schalow G. Pricolo

Decision electronically authenticated