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**Datasheet for the decision  
of 3 July 2024**

**Case Number:** T 0266/23 - 3.2.01

**Application Number:** 06796212.6

**Publication Number:** 2035652

**IPC:** E21B21/015

**Language of the proceedings:** EN

**Title of invention:**

BORING HEAD WITH NEW PROTECTION HOOD

**Patent Proprietor:**

Comacchio International S.A.

**Opponent:**

Casagrande SpA

**Headword:**

**Relevant legal provisions:**

EPC 1973 Art. 100(a), 56

RPBA 2020 Art. 12(3), 12(5), 12(6), 15(1)

**Keyword:**

Discretion not to admit submission - requirements of Art.  
12(3) RPBA 2020 met (no)  
Late-filed objection - no longer maintained in first-instance  
proceedings (yes) - admitted (no)  
Inventive step - (yes)

**Decisions cited:**

R 0006/14

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
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Case Number: T 0266/23 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 3 July 2024**

**Appellant:** Casagrande SpA  
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**Respondent:** Comacchio International S.A.  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 14 December  
2022 rejecting the opposition filed against  
European patent No. 2035652 pursuant to Article  
101(2) EPC.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** A. Pieracci  
M. Millet

## Summary of Facts and Submissions

- I. An appeal was filed by the opponent in the prescribed form and within the prescribed time limit against the decision of the opposition division to reject the opposition against the European patent No. 2 035 652.
- II. In preparation for the oral proceedings the Board communicated its preliminary assessment of the case to the parties with a communication pursuant to Article 15(1) RPBA, to which the parties did not reply.
- III. Oral proceedings before the Board took place on 3 July 2024. At the end of the oral proceedings the decision was announced.
- IV. The final request of the appellant (opponent) is:
- that the decision under appeal be set aside and that the patent be revoked.
- V. The final request of the respondent (patent proprietor) is:
- that the appeal be dismissed
- VI. The following documents are mentioned in the present decision:
- D1: US 3 834 470 A;  
D2: US 2003/0111266 A;  
D3: WO 2005/090738 A;  
D4: US 4 434 861 A;  
D5: EP 0 865 867 A;  
D6: NIOSH, "Handbook for dust control in mining",

DHHS 2003;

- D7: JP 2004-332501;
- D8: JP 4-237718 A;
- D9: US 2 122 517 A;
- D10: US 6 199 656 B;
- D11: US 3 339 435 A;
- D12: US 3 934 661 A;
- D13: DE 31 40 776 A;
- D14: US 2 702 181 A;
- D15: US 5 688 082 A;
- D16: JP 11-165234 A;
- D17: EP 0 295 225 A;
- D18: FR 2 716 822 A;
- D19: JP 2006-22568 A;
- D20: WO 2006/038851 A1.

VII. The relevant arguments of the parties are dealt with in detail in the reasons of the decision.

VIII. Claim 1 of the patent as granted reads as follows:

"Boring head (T) for boring machines,  
with couplings or drive units (T1, T2) for the  
rotation-translation of at least one boring rod and of  
at least one covering tube that are coaxial and hollow  
to allow the passage of pressurised water/air and the  
upward flow of the waste fluid consisting of water/air  
mixed with debris along the interspace between said rod  
and said covering tube,  
characterised by further comprising at least one  
protection screen or wall (Cp), completely enveloping  
said rod and said covering tube, suited to be placed  
near or at the level of the upper annular opening of  
said interspace, out of which said waste fluid flow in  
all directions and to convey it downwards,

wherein said screen or wall (Cp) can be extended vertically due to the effect of the relative displacement of at least one element (Ci) fixed to the bottom of said screen or wall (Cp) with respect to at least one further element (Cs) fixed to the top in a direction substantially parallel to the drive shaft (B) transmitting the rotary motion to said boring head (T), wherein said bottom element (Ci) translates in a direction that is substantially parallel to said rod, while said top element (Cs) is fixed to and integral with said boring head (T) itself, wherein it further comprises at least one mechanical and/or hydraulic and/or electric device (Pa) suited to cause and control said relative displacement of said bottom element (Ci) with respect to said top element (Cs), and wherein said displacement causes the vertical extension/retraction of said screen or wall (Cp), in order to cover/uncover said upper opening of said interspace."

### **Reasons for the Decision**

1. Admittance of the objection of lack of novelty of the subject-matter of claim 1 with respect to D1 and D2
  - 1.1 The opponent argued that the objections of lack of novelty with respects to D1 and D2 were not discussed at the oral proceedings before the opposition division but that they had not been withdrawn.
  - 1.2 Contrary to what argued by the opponent, the minutes of the oral proceedings before the opposition division and the appealed decision indicate that novelty with respect to D1 and D2 has been acknowledged by the

opponent and that the objection of lack of novelty has been withdrawn (see page 1, point 3, first paragraph of the minutes of the oral proceedings before the opposition division and page 4, point 13.1 of the appealed decision).

- 1.3 The Board notes that according to the established jurisprudence the minutes are considered to correctly reflect the course of the oral proceedings (see the Case Law of the Boards of Appeal, 10<sup>th</sup> edition, 2022, III.C.7.10.3).  
The minutes of the oral proceedings together with the statement of facts in the appealed decision are of decisive importance for the question of what actually took place during the oral proceedings. It is noted that in the present case the opponent has only implicitly challenged the correctness of the minutes with the statement of grounds of appeal but not immediately upon their receipt and, in particular, it did not challenge them by means of an application for rectification. It is to be expected from the parties that the content of a record is examined promptly after its receipt and - if there is an inaccuracy - challenged (see also R 6/14, point 7 of the reasons).
- 1.4 Therefore, in the present case, the Board can only take as a basis the facts of the case that result from the minutes and the written statement of reasons for the decision. The Board has in the present case no reason not to conclude that the minutes do provide a true account of the oral proceedings and thus that the novelty objection has been withdrawn.
- 1.5 Pursuant to Article 12(6) RPBA, second sentence, reading:

"The Board shall not admit requests, facts, objections or evidence which should have been submitted, or which were no longer maintained, in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance",

the Board decided not to admit the above objections of lack of novelty into the proceedings since they were no longer maintained in opposition proceedings and circumstances of the appeal case justifying their admittance were not apparent nor had any such circumstances been invoked by the opponent.

2. Inventive step of the subject-matter of claim 1 in view of D3 as the closest prior art in combination with the teaching of D2 (Article 100(a) and 56 EPC)

2.1 The opponent contested the finding of the opposition division that starting from D3 and combining its teaching with that of D2 the person skilled in the art would not arrive at the claimed subject-matter because the following features:

"and wherein said displacement causes the vertical extension/retraction of said screen or wall in order to cover/uncover said upper opening of said interspace",

are not disclosed in combination by D2 and D3 and in Figure 9 of D2 any potential covering/uncovering of an upper opening at an interspace would be done by moving the drilling system towards or away from the drilling surface.

2.2 The opponent argued at the oral proceedings that the problem formulated by the opposition division, namely



to provide access to the boring head in all the operating conditions, is already solved in document D3 (see D3, page 3, line 25 to page 4, line 10; figures 1 and 2) so that the objective technical problem can only be seen as providing an alternative to the screen (S) of D3 while providing the same functions. Document D3 stating that the screen S "is applied ... in order to cover the shaft (B) and the drivers (T1, T2) on at least three sides" (see D3, page 3, lines 25-27), so the opponent, would suggest already as an alternative a cover applied on all sides. The person skilled in the art would then use the compressible cylinder (30a) of D2 (see figures 8 to 10) to replace the screen (S) of D3 thus arriving at a boring head according to the subject-matter of claim 1.

2.3 The Board cannot follow the line of argument of the opponent and concurs with the patent proprietor.

As discussed at the oral proceedings, even by considering the problem to be solved as to provide an alternative to the screen of D3, the person skilled in the art, as also acknowledged by the opponent, would be looking for an alternative providing the same functions of the screen of D3, which is to prevent the uncontrolled spreading of the waste fluid flow while at the same time allowing access to the boring head in any operation conditions.

In D3 there is no indication that the compressible cylinder (30a) allows to achieve the above technical effects, in particular access to the boring head in any operating condition. Nor the contrary has been shown by the opponent.

The Board thus concludes that the objection of the opponent is the result on an analysis *ex post facto* and therefore not convincing.

3. Inventive step of the subject-matter of claim 1 in view of D3 as the closest prior art in combination with the teaching of either of D1, D4, D5 and D6 (Article 100(a) and 56 EPC)

3.1 The opponent contested the finding of the opposition division that the combination of D3 with either of D1, D4, D5 or D6 (see the appealed decision, page 10, point 23.2; page 11, point 25.2, page 12, point 27.2 and page 13, point 29.2) would still lack the feature:

"said top element (Cs) is fixed and integral with said boring head itself (T)."

So that the subject-matter of claim 1 is not rendered obvious by the combination of the teaching of these documents.

3.2 The opponent argued that since the objected feature is not described in detail in the patent in suit, it should be interpreted with the support of the examples, in particular since the expression "integral with" remains obscure and unclear. The feature should be interpreted as meaning that a top element Cs is fixed and its position does not change in relation to the position of the boring head T. This would also be what is shown in the documents D1, D4, D5 and D6.

3.3 The Board concurs with the patent proprietor that the contested feature is clear and does not need any interpretation and that according to that feature the top element of the protection screen is part of the boring head.

As the opponent has not contested the reasoned finding of the opposition division based on the latter

understanding of feature disputed, which understanding is shared by the Board, the Board sees no reason for deviating from the view taken by the opposition division in its decision.

Therefore, the issue of whether the opposition division erred in not admitting the objection of lack of inventive step in view of the combination of D3 with D1, which is contested by the opponent, does not need to be addressed.

4. Inventive step of the subject-matter of claim 1 in view of D3 as the closest prior art in combination with common general knowledge as shown in D7-D18 (Article 100(a) and 56 EPC)

4.1 The opponent also argued that compressible cylinders as the one shown in D2 are well known in the art as shown in many of the documents cited in the proceedings, such as D7-D18. To replace the screen of D3 with a compressible cylinder as known in the art would thus be an obvious technical solution for the person skilled in the art.

4.2 Even if the Board would agree that compressible cylinders are part of the common general knowledge, what would still be missing is an indication for the person skilled in the art to use such known compressible cylinders as a hood for a boring head to allow access to the boring head in any operating condition.

This line of argument is thus also not convincing.

5. Inventive step of the subject-matter of claim 1 in view of D2 as the closest prior art in combination with the teaching of D3 (Article 100(a) and 56 EPC)

5.1 The opposition division found that documents D2 discloses all the features of claim 1 except for the feature

"a coupling or drive unit for the rotation-translation of at least one covering tube".

The above distinguishing feature was considered to solve the technical problem of preventing the bored hole from collapsing by supporting the walls of the bored hole (see the appealed decision, page 6, point 18.1)

The opponent contested the finding of the opposition division that the person skilled in the art would not have combined the teaching of D2 with that of D3 due to the different field of application of the drilling machines of the two documents and in particular to the fact that the problem of boreholes collapsing is seen as non existent for D2 (see the appealed decision, page 6, point 18.1 and page 7, point 18.3).

5.2 The opponent argued that according to paragraph [0017] of D2, the invention of D2 can be used to drill holes in "almost any surface" and can be "customized for the particular drilling surface", furthermore D2 would describe embodiments with wet drilling in paragraphs [0063], [0085] and [0088]. Even if D3, so the opponent, refers to an earth drilling machine, the teaching of D2 and D3 can be combined since neither D2 nor D3 describes clearly that the drilling apparatus described therein can be used only for a specific soil hardness.

The person skilled in the art would then have provided the device of D2 with a covering tube according to D3 for supporting the walls of drilled hole.

5.3 The Board is not convinced by the arguments of the opponent for the following reasons.

The Board shares the view of the opposition division (see the appealed decision, page 7, fifth paragraph ) that the expression in D2 that the invention can be used "in almost any surface" in paragraph [0017] has to be read in the context of paragraph [0002], as meaning in almost any hard surface such as concrete, granite, marble, glass or wood, thus not in situation analogous to those in which the apparatus of D3 is meant to be used, such as drilling holes in the ground.

The Board also follows the finding of the opposition division (see the appealed decision, page 7, second and third paragraph from the bottom), that contrary to drilling holes in the ground as in D3 or in the patent in suit, when drilling hard material such as concrete, granite, etc., the problem of boreholes collapsing while drilling is not present.

The Board thus concurs with the finding of the opposition division that the person skilled in the art would not combine the teaching of D2 with that of D3 due to their different field of application.

The Board notes that should the skilled person have the need to drill holes in the ground or in an analogous material in which the problem of the boreholes collapsing arises, it would choose already from the beginning a boring machine adapted for that use and foreseen for that purpose, which is known to the person

skilled in the art, as acknowledged in the patent in suit (see paragraphs [0001] to [0003]), instead of starting from a boring machine foreseen for another purpose and then modify it.

6. Admittance of the objection of lack of inventive step of the subject-matter of claim 1 in view of D19 as the closest prior art in combination with the teaching of D20

6.1 The opponent indicated in its grounds of appeal that this attack made in opposition proceedings was maintained and that documents D19 and D20 relate to a similar use of that of the claimed invention.

6.2 Since the opponent has not indicated why the decision of the opposition division in relation of this line of attack is not correct (see the appealed decision, page 14, point 33.1) this objection is unsubstantiated in the sense of Article 12(3) RPBA and the Board considered appropriate to exercise its discretion not to admit it into the proceedings pursuant to Article 12 (5) RPBA.

7. Conclusions

Since the opponent has not convincingly demonstrated the incorrectness of the decision of the opposition division, the appeal cannot be allowed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

G. Pricolo

Decision electronically authenticated