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**Datasheet for the decision  
of 30 October 2007**

**Case Number:** T 0913/05 - 3.4.01

**Application Number:** 97113399.6

**Publication Number:** 0805408

**IPC:** G06K 9/00

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for discriminating and counting documents

**Patentee:**

CUMMINS-ALLISON CORPORATION

**Opponents:**

DE LA RUE INTERNATIONAL LIMITED  
GIESECKE & DEVRIENT GmbH

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 100(c), 123(2)  
RPBA Art. 11(3)

**Keyword:**

"Added subject-matter (yes: all requests)"

**Decisions cited:**

G 0009/91, G 0010/91

**Catchword:**

By deleting all claims as granted of one category, restricting the defence of the patent to the subject-matter of a combination of granted claims of another category and relying on an alleged combinatory effect of the features of the thereby formed independent claim, the amendments made to the patent as granted have in substance created a fresh case which justifies examination as to whether the amended patent meets the requirements of the EPC (see point 2.1.1 of the Reasons).



Case Number: T 0913/05 - 3.4.01

**DECISION**  
of the Technical Board of Appeal 3.4.01  
of 30 October 2007

**Appellant:** DE LA RUE INTERNATIONAL LIMITED  
(Opponent 01) De La Rue House, Jays Close  
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**Representative:** Skone James, Robert Edmund  
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**Party as of right:** GIESECKE & DEVRIENT GmbH  
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**Representative:** -

**Respondent:** CUMMINS-ALLISON CORPORATION  
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**Representative:** Grünecker, Kinkeldey,  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
1 June 2005 concerning maintenance of European  
patent No. 0805408 in amended form.

**Composition of the Board:**

**Chairman:** B. Schachenmann  
**Members:** H. Wolfrum  
P. Fontenay

## Summary of Facts and Submissions

- I. Two oppositions both substantiated on the ground of lack of inventive step, pursuant to Articles 100(a) and 56 EPC), were filed against European patent No. 0 805 408.

An interlocutory decision of the opposition division was dispatched on 1 June 2005 maintaining the patent in amended form on the basis of a set of claims 1 to 11 filed on 11 April 2005 in oral proceedings before the opposition division.

An appeal was lodged against this decision by opponent 01 (De La Rue International Limited). The notice of appeal was received on 15 July 2005 and the prescribed fee was paid on 20 July 2005. A statement of grounds of appeal was filed on 3 October 2005.

Opponent 02 (Giesecke & Devrient GmbH) remained a party as of right to the appeal proceedings.

- II. According to corresponding requests of the appellant and the respondent (patentee Cummins-Allison Corporation), the parties were summoned to oral proceedings scheduled for 30 October 2007 by a notification dated 29 June 2007.

In a communication dated 4 July 2007 pursuant to Article 11(1) RPBA, the Board of Appeal addressed briefly the relevant issues to be discussed, mentioning *inter alia* that verifications as to the basis of disclosure of the claimed subject-matter may become vital (Article 123(2) EPC) .

III. In response thereto, the respondent declared by letter of 19 September 2007 that the applicant and representative would not file any further submissions and that they would not attend the oral proceedings.

By letter received on 10 October 2007, opponent 02 informed the Board that he would also not participate at the oral proceedings.

IV. Oral proceedings were held on 30 October 2007 in the absence of the respondent and of opponent 02.

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

The respondent requested in writing, according to a main request, that the appeal be dismissed or, alternatively, that the patent be maintained in amended form on the basis of further amended sets of claims according to one of auxiliary requests A to E filed by letter dated 18 April 2006.

VI. Claim 1 of the patentee's **main request** reads as follows :

*"1. A method for identifying documents in a document identification system, the system being capable of identifying documents that are of one or more document-types, comprising the steps of:*

*transporting documents, one at a time, from an input receptacle past a scanning section to an output along a transport path;*

*scanning a test document for variations in characteristic information;*

*generating an output signal from said scanning;*

*generating at least one scanned pattern from said output signals, said at least one scanned pattern representing and approximating analog amplitude variations in said characteristic information of said document;*

*performing a pattern comparison wherein at least one of said scanned patterns or portions thereof is compared with one or more master patterns or portions thereof from a set of master patterns, said master patterns being associated with genuine documents of the document types that the system is capable of identifying, said master patterns representing and approximating analog amplitude variations in characteristic information of an associated genuine document; and*

*generating an indication of the identity of said test document based on said pattern comparison when said test document is of a document-type that the system is capable of identifying, whereby said documents are transported to a single output receptacle at a rate in excess of about 800 documents per minute;*

*the output signal is generated from at least one scanhead;*

*said characteristic information in said scanned pattern originates from a segment of said document; and*

*said characteristic information in said master patterns originates from segments of an associated genuine document;*

**characterized in that**

*said scanning of the test document is effected along at least two laterally displaced segments located on a first side of said test document, said scanning being performed by at least two scanheads positioned at a first side of said transport path, at least two of said scanheads being laterally displaced relative to each other;*

*the method further comprises the steps of:*

*detecting color information from said test document before said scanning step;*

*performing a color comparison wherein said color information of said test document is compared with master color information associated with at least one genuine document; and*

*generating a preliminary set of potential matching documents for said test document based on said color comparison;*

*wherein said one or more master patterns from a set of master patterns of said pattern comparison step are chosen from said preliminary set."*

Claims 2 to 11 are dependent claims.

Claim 1 of the **auxiliary request A** is identical to claim 1 of the main request, the two requests differing only in the number of dependent claims.

Claim 1 of each of **auxiliary requests B** and **C** differs from claim 1 of the main request in that the features "and wherein said sensors are stationary and the method further comprising the steps of choosing selected sensors to scan said test document or choosing selected output signals or derivations thereof to generate

scanned patterns based on said color detection step", are added at the end of the claim.

Claim 1 of each of **auxiliary requests D** and **E** differs from claim 1 of the main request in that the claimed method is limited to the case of identifying documents that are of more document types and in that the features "*and wherein said sensors are stationary and the method further comprising the step of choosing selected sensors to scan said test document based on said color detection step*", are added at the end of the claim.

VII. In the oral proceedings, the appellant argued that in particular the step of "*performing a color comparison wherein said color information of said test document is compared with master color information associated with at least one genuine document*" together with the step of "*generating a preliminary set of potential matching documents for said test document based on said color comparison*" comprised in claim 1 of all requests on file had no basis of disclosure in the documents of the application as filed. Moreover, no basis of disclosure was apparent for the subject-matter of some of the dependent claims, such as claims 4, 9 and 10 of the main request.

VIII. In the contested decision, the opposition division considered claim 1 of the main request to be disclosed by a combination of originally-filed claims 7 and 14, claim 4 to be based on paragraphs 51 and 288 of the description, and claims 9 and 10 to originate from original claims 16 and 17 (see point 1 of the Reasons of the decision of 1 June 2005).



## Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

A. Main request

2. Added subject-matter (Article 123(2) EPC)

2.1 Competence of the Board to decide the issue

Claim 1 of the main request is identical to claim 14 of the patent as granted which is exclusively dependent on claim 7 of the patent as granted.

The opponents, in their respective notice of opposition, did not invoke Article 100(c) EPC as a ground of opposition. Nevertheless, the Board does not consider the issue a fresh ground of opposition which would require the consent of the patentee in order to be dealt with in the appeal for the following reasons.

2.1.1 Enlarged Board decisions G 9/91 (OJ EPO 1993, 408) and G 10/91 (OJ EPO 1993, 420) deal with the extent of the power of an opposition division and a Board of Appeal to decide on the maintenance of a European patent under Articles 101 and 102 EPC. The decisions stipulate that in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined

as to their compatibility with the requirements of the EPC (see point 19 of the Reasons).

In the present case, by deleting all claims as granted of one category, restricting the defence of the patent to the subject-matter of a combination of granted claims (ie claims 7 and 14) of another category and relying on an alleged combinatory effect of the features of the thereby formed independent claim, the amendments made by the patentee have in substance created a fresh case.

The Board notes in this context that according to common practice of the deciding bodies of the EPO decisions on a request in examination, opposition and appeal are generally made and judgments given as to the merits of the subject-matter of the independent claim(s) of such request. Usually, the subject-matter of dependent claims comes into focus only after it has been incorporated into an independent claim. Therefore, it would appear inequitable to deny an opponent a comparable level of procedural efficiency and to demand a different standard of scrutiny for the reasoning in a notice of opposition by forcing an opponent to deal already then for reasons of precaution with any possible feature combination which is comprised in the dependent claims of a patent as granted. The Board sees confirmation for its view in aforementioned decision G 9/91 (loc. cit.) which finds in its headnote *"However, subject-matters of claims depending on an independent claim, which falls in opposition or appeal proceedings, may be examined as to their patentability even if they have not been explicitly opposed, provided*

*their validity is prima facie in doubt on the basis of already available information."*

For these reasons, the amendments made to the patent qualify, in the Board's opinion, as amendments within the meaning of the above decisions of the Enlarged Board of Appeal. Consequently, dealing with the issue of added subject-matter pursuant to Article 123(2) EPC for the subject-matter of claim 1 of the main request does not amount to the introduction of a fresh ground of opposition. On the contrary, the Board merely responds to the obligation under Article 102(3) EPC according to which it has to be ascertained whether, taking into consideration the amendments made by the proprietor of a patent during the opposition proceedings, the amended patent meets the requirements of the EPC.

In fact, even if the appellant had not raised an objection under Article 123(2) EPC in the appeal proceedings, the Board would have considered this issue in the appeal, as was indicated in the Board's communication in preparation for the oral proceedings.

2.1.2 Further questions concerning added subject-matter arise for some of the dependent claims, insofar as the amendment to claim 1 leads to new claim dependencies and thus to combinations of features which are not comprised in the claims of the patent as granted.

2.1.3 Moreover, opponent 01 had already raised an objection under Article 123(2) EPC against the corresponding request of the patentee filed in the oral proceedings before the opposition division and, by addressing the

matter in its decision, the opposition division introduced factually the ground of Article 100(c) EPC into the opposition proceedings.

- 2.1.4 Finally, the Board notes that Article 11(3) RPBA stipulates that a Board is not obliged to postpone its decision in oral proceedings by reason only of the absence of any party duly summoned. This is all the more true as, in the present case, the parties had been informed by the Board's communication that verifications as to the basis of disclosure of the claimed subject-matter might become a point of debate in the oral proceedings.

## 2.2 Substantive matter

Present claim 1, which is directed to a method for identifying documents in a document identification system, comprises in its characterizing portion *inter alia* the steps of :

- (i) detecting color information from said test document before said scanning step;
- (ii) performing a color comparison wherein said color information of said test document is compared with master color information associated with at least one genuine document; and
- (iii) generating a preliminary set of potential matching documents for said test document based on said color comparison;

wherein said one or more master patterns from a set of master patterns of said pattern comparison step are chosen from said preliminary set.

2.2.1 The Board notes that only one out of the 14 claims which were originally filed, *ie* claim 13, is actually directed to a method for identifying documents. This claim, however, does not address detection of color information.

Indeed, "color comparison" involving comparison of color information of a document with "master color information" is mentioned only once in the originally-filed claims, *ie* in claim 6, which is directed to a currency identification system comprising a memory for storing "master color information" and signal processing means for performing said "color comparison" so as to additionally base identity indication of a bill under test on said color comparison. However, contrary to what is claimed by aforementioned features (i) to (iii) of present claim 1, originally-filed claim 6 does not provide any information as to a specific sequence of steps or as to the claimed use of the result of the color comparison step for generating a preliminary set of potential matching documents for subsequent steps of pattern recognition.

It follows that, contrary to the opposition division's reasoning which confused the claims as granted with the claims as originally filed, the subject-matter of claim 1 of the main request has no counterpart in the claims of the application documents as filed.

2.2.2 Furthermore, as regards the application specification as filed, it is noted that the term "master color information" is not used at all. It is also not apparent which piece of disclosure would support a step of "performing a color comparison" with "master color

information" of at least one genuine document as defined by feature (ii) for the purpose of a pre-selection of potential matching documents as defined by feature (iii).

In fact, the only basis of disclosure for a step of comparing color information detected from a document under test with information concerning the color of a genuine document for the purpose of generating a preliminary set of potential matching documents is given on page 46, line 52 to page 47, line 38, of the published application in combination with Figures 50a and 50b (corresponding to items [0288] to [0291] of the patent specification). According to this piece of disclosure, a bill is identified in a currency discriminator by determining, in a first step, the size of the bill. In a next step, it is determined whether the measured dimensions of the bill match the dimensions of at least one genuine bill. Provided a match is found, the bill is scanned and it is determined whether the color of the bill matches a color associated with a genuine bill having the measured dimensions. An error is generated if no such match is found. However, if a match is found, a preliminary set of potentially matching bills is generated and the bill is subsequently scanned for a characteristic pattern by comparing scanned patterns of the bill with the stored master patterns associated with genuine bills as dictated by the preliminary set.

It is by no means evident to the Board in which way the disclosed, rather simple step of determining whether the observed color of the bill under test matches a color of genuine bills would amount to an elaborate

step of performing a "color comparison" with "master color information" associated with at least one genuine document, as falling under the terms of the claim under consideration. Moreover, the cited information is much more specific than the claimed subject-matter in that it refers to the scanning of the color of bills (and not just of any type of document) and furthermore relies on an additional step of determining the size of the bill under test as a manifestly indispensable prerequisite for establishing by means of color comparison which bill out of a plurality of possibly genuine bills having perhaps different colors should be matched. It is indeed not conceivable how an automatically running system would ascertain which one of the possible colors of genuine bills has to be checked without first identifying the type of genuine bill by means of the observed size.

For the sake of completeness, the Board notes that during examination the applicant referred to page 45, second and third paragraph and page 46, first and second paragraph, of the original specification of the basic PCT case, corresponding to published page 19, line 48 to page 20, line 19, of the present application, as the alleged basis of disclosure of the features (i) to (iii) under consideration. However, this piece of disclosure does not mention any of the features in question but refers exclusively to measurements performed on genuine US currency bills so as to establish suitable master patterns associated with the green and/or black sides of the bills.

It follows from the above considerations that the application specification fails to directly and unambiguously disclose a step of performing a "color comparison" with "master color information" as defined by step (ii) for the purpose specified in step (iii).

- 2.2.3 Finally, the Board notes that in fact none of the passages of the application specification which mention the use of color information for generating a preliminary set of potential matching documents discusses a step of scanning the test document which would be effected along at least two laterally displaced segments located on a first side of said test document by making use of at least two laterally displaced scanheads positioned at a first side of said transport path, as is further claimed in claim 1 under consideration.

Therefore, no basis of disclosure can be found for the combination of features as claimed by claim 1 of the main request.

- 2.2.4 A further problem arises for claim 4 of the main request, which constitutes a combination of features that was not present in the claims of the patent as granted.

Claim 4 defines in indefinite terms a step of generating a preliminary set of potential matching documents, this time based on the detected size of a document under test. The subject-matter of claim 4 thus encompasses a method according to which two different preliminary sets of potential matching documents would



be generated according to different criteria. No basis of disclosure can be found for such subject-matter.

2.2.5 A still further problem arises for present claim 9 in that there is no discernable disclosure of the claimed alternative of "choosing selected output signals or derivations thereof to generate scanned patterns based on said color detection step" in combination with a step of color detection.

2.3 For the above reasons, the patentee's main request is not allowable.

B. Auxiliary requests A to E

3. The deficiencies under Article 123(2) EPC identified above for claims 1 and 4 of the main request apply with equal force to the subject-matter of claims 1 and 4 of all auxiliary requests on file.

4. Therefore, none of the patentee's auxiliary requests on file is allowable either.

**Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar

The Chairman

R. Schumacher

B. Schachenmann