

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [ ] To Chairmen and Members  
(C) [X] To Chairmen  
(D) [ ] No distribution

**Datasheet for the decision  
of 19 March 2010**

**Case Number:** T 1370/07 - 3.5.02

**Application Number:** 99906150.0

**Publication Number:** 1050021

**IPC:** G07B 11/03

**Language of the proceedings:** EN

**Title of invention:**

Method and apparatus for the validation of tickets

**Patentee:**

P & S S.r.l.

**Opponent:**

ERG Limited

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 123(2)  
RPBA Art. 13(1),(3)

**Relevant legal provisions (EPC 1973):**

-

**Keyword:**

"Added subject-matter (yes) - main request"  
"Admissibility of late-filed requests (no) - first and second  
auxiliary requests"

**Decisions cited:**

-

**Catchword:**

-



Case Number: T 1370/07 - 3.5.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.02  
of 19 March 2010

**Appellant:**  
(Opponent)

ERG Limited  
Via Torino 107  
I-00184 Rome (IT)

**Representative:**

Iannone, Carlo Luigi  
Barzanò & Zanardo Roma S.p.A.  
Via Piemonte 26  
I-00187 Roma (IT)

**Respondent:**  
(Patent Proprietor)

P & S S.r.l.  
Via Orvieto, 39  
I-05022 Amelia TR (IT)

**Representative:**

Celestino, Marco  
ABM Agenzia Brevetti & Marchi  
Viale Giovanni Pisano, 31  
I-56123 Pisa (IT)

**Decision under appeal:**

Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
18 June 2007 concerning maintenance of European  
patent No. 1050021 in amended form.

**Composition of the Board:**

**Chairman:** M. Ruggiu  
**Members:** R. Lord  
H. Preglau

## Summary of Facts and Submissions

- I. This is an appeal of the opponent against the interlocutory decision of the opposition division concerning the European patent No. 1 050 021 that, account being taken of the amendments made by the patent proprietor, the patent and the invention to which it related met the requirements of the EPC.
  
- II. With a letter dated 19 February 2010 the respondent (patent proprietor) filed claims 1 to 3 according to a "main request". With a further letter dated 18 March 2010, the respondent filed claims 1 to 3 according to an "auxiliary request".
  
- III. Oral proceedings before the board took place on 19 March 2010.

The respondent's request of 19 February 2010 was discussed, in particular the board raised objections under Article 123(2) EPC concerning the references in claim 1 of that request to "*at least an optical reader*" and "*said or each optical reader*", noting that the claim seemed to relate to the embodiment of Fig. 6 of the patent, in which at least two optical readers were necessary. The board noted in this context also that there appeared to be no basis in the application as filed for the definition in claim 1 that the "*another apparatus*" is identical to the "*first apparatus*".

The respondent then filed claims 1 to 3 according to a new main request, and withdrew the main request of 19 February 2010. Following discussion of the admissibility of that new request, the board decided

not to admit the new request into the procedure.

The respondent's auxiliary request of 18 March 2010 was then briefly discussed.

The respondent then withdrew his new main request filed earlier during the oral proceedings, reintroduced his request of 19 February 2010 as his main request and withdrew his auxiliary request of 18 March 2010.

Furthermore he filed claims 1 to 3 according to first and second auxiliary requests, the first of which was, except for its title "First Auxiliary Request", identical to the main request filed earlier during the oral proceedings, and the second of which differed from the first only by the introduction of the additional feature which had been introduced in the auxiliary request of 18 March 2010.

The appellant (opponent) requested that the decision under appeal be set aside and that the European patent No. EP 1 050 021 be revoked.

The respondent (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of claims 1 to 3, filed with the letter of 19 February 2010 (main request), or subsidiarily on the basis of claims 1 to 3 of the first or second auxiliary request, received during the oral proceedings.

IV. Claim 1 according to the respondent's main request reads as follows:

"Validating apparatus (10) of transport tickets (1)

made of paper, wherein said validating apparatus is adapted to carry out a validation step comprising printing at least time and date of a first validation action on an issued but still unused ticket as well as a successive automatic control of an already validated ticket, comprising:

- a box-like body having a slot (9) for the introduction of said tickets (1),
- an internal printing head (13) arranged in said body in association with said slot (9),

characterised in that it comprises

- at least an optical reader (12,14) that is
- arranged in said body in association with said slot (9),

said or each optical reader (12,14) arranged in said body in coincidence with respective zones of coded data (5,6) printed on said ticket (1) by said head (13), at least a processing unit that is connected to said or each optical reader (12,14), in that

- during a first validation action of an unused ticket put in a slot of a first apparatus (10), said internal printing head is adapted to print in a first zone (5) of the ticket (1) a first set (5) of coded data (5) which can be read by optical means (12) and which comprise date and time of said first validation action;
- during said first validation action, said internal printing head is adapted to print in a second zone (7) of the ticket (1) a second set (7) of data written in eye readable characters that comprise date and time of said first validation action;

in that said optical reader (12) connected to said processing unit, during a successive validation attempt of said ticket (1) put in a slot of another apparatus

(10) that is identical to the first apparatus (10), is adapted to optically read said coded data (5) and to compare said optically read coded data with data stored in said processing unit; and optical reader (12) connected to said processing unit is adapted to produce a [sic] warning signal if when optically reading said coded data (5) from said first zone (5) and then comparing them with said stored data the successive validation is unallowable, wherein said unused ticket (1) has at least a further zone (3,4) on which at least a further set (3,4) of optically readable coded data (5) has been pre-printed, and in that said optical reader (11) connected to the processing unit is adapted to read said coded data (3,4) of said further zone (3,4) during said first validation action or said successive validation action of said ticket (1), and said processing unit is adapted to compare said optically read coded data (3,4) of said further zone (3,4) with data stored in said processing unit and to produce said warning signal if when reading said coded data (3,4) from said further zone (3,4) at the comparison thereof with said stored data the validation is unallowable."

Claim 1 according to the respondent's first auxiliary request reads as follows:

"Validating apparatus (10) of transport tickets (1) made of paper, wherein said validating apparatus is adapted to carry out a validation step comprising printing at least time and date of a first validation action on an issued but still unused ticket as well as a successive automatic control of an already validated ticket, comprising:

- a box-like body having a slot (9) for the introduction of said tickets (1),
- an internal printing head (13) arranged in said body in association with said slot (9),

characterised in that it comprises

- an optical reader (11,12,14) that is arranged in said body in association with said slot (9), said optical reader (11,12,14) arranged in said body in such a way that in use said optical reader (11,12,14) is in coincidence with respective zones of coded data (5,6) printed on said ticket (1) by said internal printing head (13),

a processing unit that is connected to said optical reader (11,12,14),

in that

- during a first validation action of an unused ticket put in a slot of a [sic] the apparatus (10), said internal printing head is adapted to print in a first zone (5) of the ticket (1) a first set (5) of coded data (5) which can be read by said optical reader and which comprise date and time of said first validation action;
- during said first validation action, said internal printing head is adapted to print in a second zone (7) of the ticket (1) a second set (7) of data written in eye readable characters that comprise date and time of said first validation action;

in that said optical reader connected to said processing unit, during a successive validation attempt of said ticket (1) put in the slot of the apparatus (10), is adapted to optically read said coded data (5) and to compare said optically read coded data with data stored in said processing unit; and said optical reader (12) connected to said processing

unit is adapted to produce a warning signal if when optically reading said coded data (5) from said first zone (5) and then comparing them with said stored data the successive validation is unallowable, and in that said optical reader (11) connected to the processing unit, during said first validation action or said successive validation action of said ticket (1) is adapted to read said coded data (3,4) of a further zone (3,4) of said ticket (1) on which at least a further set (3,4) of optically readable coded data (5) has been pre-printed, and said processing unit is adapted to compare said optically read coded data (3,4) of said further zone (3,4) with data stored in said processing unit and is adapted to produce said warning signal if when reading said coded data (3,4) from said further zone (3,4) at the comparison thereof with said stored data the validation is unallowable."

Claim 1 according to the respondent's second auxiliary request reads as follows:

"Validating apparatus (10) of transport tickets (1) made of paper, wherein said validating apparatus is adapted to carry out a validation step comprising printing at least time and date of a first validation action on an issued but still unused ticket as well as a successive automatic control of an already validated ticket, comprising:

- a box-like body having a slot (9) for the introduction of said tickets (1),
- an internal printing head (13) arranged in said body in association with said slot (9),

characterised in that it comprises



- an optical reader (11,12,14) that is arranged in said body in association with said slot (9), said optical reader (11,12,14) arranged in said body in such a way that in use said optical reader (11,12,14) is in coincidence with respective zones of coded data (5,6) printed on said ticket (1) by said internal printing head (13),

a processing unit that is connected to said optical reader (11,12,14),

in that

- during a first validation action of an unused ticket put in a slot of a [sic] the apparatus (10), said internal printing head is adapted to print in a first zone (5) of a side (2) of the ticket (1) a first set (5) of coded data (5) which can be read by said optical reader and which comprise date and time of said first validation action;
- during said first validation action, said internal printing head is adapted to print in a second zone (7) of said side (2) of the ticket (1) a second set (7) of data written in eye readable characters that comprise date and time of said first validation action;

in that said optical reader connected to said processing unit, during a successive validation attempt of said ticket (1) put in the slot of the apparatus (10), is adapted to optically read said coded data (5) and to compare said optically read coded data with data stored in said processing unit; and

said optical reader (12) connected to said processing unit is adapted to produce a warning signal if when optically reading said coded data (5) from said first zone (5) and then comparing them with said stored data the successive validation is unallowable,

and in that said optical reader (11) connected to the processing unit, during said first validation action or said successive validation action of said ticket (1) is adapted to read said coded data (3,4) of a further zone (3,4) of the said side (2) [sic] said ticket (1) on which at least a further set (3,4) of optically readable coded data (5) has been pre-printed, and said processing unit is adapted to compare said optically read coded data (3,4) of said further zone (3,4) with data stored in said processing unit and is adapted to produce said warning signal if when reading said coded data (3,4) from said further zone (3,4) at the comparison thereof with said stored data the validation is unallowable."

- V. The arguments of the appellant, in so far as they are relevant to the present decision, can be summarised as follows:

Claim 1 according to the main request contravened Article 123(2) EPC *inter alia* for the reasons indicated by the board during the oral proceedings.

The first and second auxiliary requests were late-filed, did not overcome the previously raised objections under Article 123(2) EPC, and introduced issues which the appellant could not be expected to address without an adjournment of the oral proceedings, namely in the first auxiliary request that the first and subsequent validations are carried out on the same ticket in the same apparatus, and in the second auxiliary request that all of the pre-printed and printed data is on the same side of the ticket. Thus, in accordance with Article 13(1) and (3) of the Rules of Procedure of the

Boards of Appeal (RPBA), these requests should not be admitted into the procedure. In this context it was particularly relevant that the respondent had not replied at all to the grounds of appeal until exactly one month before the oral proceedings, and that the request filed by the respondent on 18 March 2010 was filed so late that the appellant had not received it until immediately before the oral proceedings.

VI. The arguments of the respondent, in so far as they are relevant to the present decision, can be summarised as follows:

The amendment in claim 1 of the main request defining that the coded data in both the first and further zones is read by the same optical reader was introduced so as to cover a commercial arrangement as previously discussed during the procedure before the opposition division.

The appellant's main objections concerned lack of clarity (Article 84 EPC), and should therefore not be taken into account because this is not a ground for opposition.

Amendments for the purpose of clarification should always be allowed, so his first auxiliary request should be admitted into the procedure.

## **Reasons for the Decision**

1. The appeal is admissible.

2. *Main request - Added subject-matter (Article 123(2) EPC)*

2.1 Claim 1 according to the main request defines in the second last paragraph that "*said optical reader ... is adapted to optically read said coded data (5)*" and in the final paragraph that "*said optical reader ... is adapted to read said coded data (3,4) of said further zone*". The combination of these two passages in the claim introduces subject-matter which extends beyond the content of the application as originally filed.

2.1.1 As acknowledged by the respondent, the present claim 1 defines that the apparatus is arranged such that the first set of coded data printed in the first zone (which has reference number (5)) and the further set of coded data pre-printed in the further zone (which has reference numbers (3,4)) are read by the same optical reader. From the description of the application and patent, it is apparent that this claim relates to the embodiment described with reference to Fig. 6, since that is the only embodiment including the pre-printed data in the zones 3 and 4. However, from the description of that embodiment and that figure it is immediately apparent that the first set of data is read by an optical reader 12, whereas the further sets of data are read by a further optical reader 11. The application as originally filed contains no suggestion that the two sets of data can alternatively be read by the same optical reader. In particular the original claims relating to these reading steps (claims 1 and 3) did not specify whether the "optical means" involved were the same or separate.

2.1.2 The respondent stated that the definition that the same optical reader was to be used to read both sets of data was introduced so as to cover a commercial arrangement as discussed earlier in the procedure. This statement however has no bearing on the question as to whether the added feature had a basis in the originally filed application.

2.2 Claim 1 according to the main request also defines in the second last paragraph "*another apparatus (10) that is identical to the first apparatus (10)*". However, the application as originally filed contains no teaching as to whether the apparatus used for the "first validation action" (the "first apparatus") and that used for the "successive" (i.e. subsequent) validation (the "another apparatus") are identical or not, so that the introduction of this feature into the claim results in teaching extending beyond the content of the application as filed. The respondent has not presented any arguments in this respect.

2.3 The board concludes therefore that for both of the above reasons the respondent's main request does not meet the requirements of Article 123(2) EPC, so is not allowable.

3. *First auxiliary request - Admissibility (Article 13(1) and (3) RPBA)*

3.1 The respondent's first auxiliary request was filed only during the oral proceedings before the board, so that Article 13(3) RPBA is applicable. Moreover, the board considers the provisions of Article 13(1) RPBA, second sentence to also be relevant, although in the present

case the respondent did not specifically reply to the grounds of appeal.

3.2 Claim 1 according to the first auxiliary request defines in essentially the same manner as claim 1 of the main request that the apparatus is such that the first set of coded data printed in the first zone and the further set of coded data pre-printed in the further zone are read by the same (i.e. "said") optical reader. Thus, this claim does not overcome the objection under Article 123(2) EPC of paragraphs 2.1 and 2.1.1 above. Therefore, the board considers that the discussion of this request would serve no useful purpose, so that from the point of view of procedural economy, which is one of the criteria cited in Article 13(1) RPBA, it would not be appropriate to admit this request into the procedure.

3.3 This conclusion is reinforced by the fact that claim 1 of this request defines that the first validation action and the subsequent validation are carried out by the same apparatus and on the same ticket. As a result of the introduction of this feature not only would it be necessary to consider whether this amendment meets the requirement of Article 123(2) EPC, but also, if it were considered to meet that requirement, the appellant would need to review the prior art to determine whether this feature was disclosed or suggested there, in order to be able to address the questions of novelty and inventive step

3.3.1 Concerning the first of these issues, the board notes that the application as originally filed disclosed only that a ticket initially validated in one apparatus was

subsequently validated in another apparatus (or viewed from the point of view of a single apparatus, that the tickets subsequently validated in that apparatus had been initially validated in another apparatus). Thus *prima facie* this amendment appears to contravene Article 123(2) EPC.

3.3.2 Concerning the second of these issues, given the large number of documents involved, it cannot reasonably be expected that the appellant would be able to deal with the question of novelty and inventive step of the amended claim without adjournment of the oral proceedings, so that according to Article 13(3) RPBA the request should not be admitted.

3.4 The respondent did not present any arguments as to why this request had been filed only during the oral proceedings. His argument that the request should be admitted, because clarifications of an existing request should always be allowed, is not relevant to the reasoning of sections 3.2 and 3.3 above, because these amendments raise issues of added subject-matter, and thus go beyond mere clarifications. Similarly the board does not find his argument that the objections raised by the appellant should not be considered, because they concern Article 84 EPC, which is not a ground for opposition, to be convincing because it is also apparent from the above reasoning that at least some of those objections did not concern Article 84 EPC.

3.5 The board therefore decided not to admit the respondent's first auxiliary request into the procedure.

3.6 For the same reasons the board decided not to admit into the procedure the new main request which was both filed and subsequently withdrawn by the respondent during the oral proceedings before the board.

4. *Second auxiliary request - Admissibility (Article 13(1) and (3) RPBA)*

4.1 The additional features introduced in the respondent's second auxiliary request with respect to his first auxiliary request concern only the side of the ticket on which various data is printed, and thus have no bearing on any of the objections raised with respect to either the main request or the first auxiliary request discussed above. Therefore, the reasoning of paragraph 3.2 above applies correspondingly to this request.

4.2 Moreover, the additional features introduced in this request have no basis in the claims of the patent in suit, and are instead taken from the description. The appellant cannot be expected to have anticipated that such additional features would be introduced only at this late stage in the procedure, which as noted in section V above, he became aware of only immediately before the oral proceedings. Thus the conclusion of paragraph 3.3.2 above applies correspondingly to this request.

4.3 The board therefore decided not to admit the respondent's second auxiliary request into the procedure.



5. Since the respondent's main request is not allowable and his two auxiliary requests were not admitted into the procedure, the board concludes that the patent has to be revoked in accordance with the appellant's request.

## **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:

U. Bultmann

M. Ruggiu