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**Datasheet for the decision
of 17 July 2014**

Case Number: T 0427/11 - 3.2.05

Application Number: 01946818.0

Publication Number: 1282528

IPC: B42D15/10

Language of the proceedings: EN

Title of invention:

Passport production system

Patent Proprietor:

Datacard Corporation

Opponents:

Bundesdruckerei GmbH
Mühlbauer AG

Headword:

Relevant legal provisions:

EPC 1973 Art. 56, 111(1), 113(1)
EPC 1973 R. 67
RPBA Art. 11, 12(4), 13(1), 15(1)

Keyword:

Substantial procedural violation -
 appealed decision insufficiently reasoned (yes)
Reimbursement of appeal fee (equitable)
Inventive step - main request (no) -
 first auxiliary request (no)
Late-filed auxiliary requests - amendments after arrangement
of oral proceedings (not admitted)

Decisions cited:

G 0009/91, J 0010/07

Catchword:



**Beschwerdekammern
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Chambres de recours**

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Case Number: T 0427/11 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 17 July 2014

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
29 December 2010 concerning maintenance of the
European Patent No. 1282528 in amended form.**

Composition of the Board:

Chairman	M. Poock
Members:	P. Lanz
	G. Weiss

Summary of Facts and Submissions

- I. The appeals by appellants I (opponent 2) and II (opponent 1) are against the interlocutory decision of the opposition division holding that the opposed European patent No. 1 282 528 met the requirements of the European Patent Convention on the basis of the second auxiliary request.
- II. Both oppositions were directed against the patent as a whole and based on the grounds set out in Articles 100(a) EPC 1973 (lack of novelty, Article 54(2) EPC 1973, lack of inventive step, Article 56 EPC 1973).
- III. By letter dated 25 April 2014 the parties were summoned to oral proceedings before the board of appeal. As an annex to the summons, the board issued a communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA).
- IV. By letter received on 17 May 2014 opponent 3 withdrew its opposition and thereby ceased to be a party as of right to the present appeal proceedings as far as the substantive issues are concerned.
- V. Oral proceedings were held before the board of appeal on 17 July 2014.
- VI. The appellants I and II requested that the decision under appeal be set aside and that the European patent No. 1282528 be revoked. Furthermore, they requested the reimbursement of the appeal fees.

The respondent (patent proprietor) requested that the appeals be dismissed or, as auxiliary request 1, that

the decision under appeal be set aside and the patent be maintained in amended form on the basis of the claims filed as 3rd auxiliary request in the oral proceedings at the opposition division or, as auxiliary requests 2 to 4, on the basis of the claims filed with letter of 16 June 2014.

VII. The documents referred to in the appeal proceedings included the following:

D7: System description from Louda System GmbH (1992) relating to the public prior use of the "VISA system" (VBA);

D8: System drawings of 27 May 1992 relating to the public prior use of the "VISA system" (VBA);

E5': US-A-6 082 617;

E14: US-A-4 280 036;

E20: US-A-5 794 365.

VIII. The only independent claim of the main request reads as follows:

"1. A modular system (10) for personalizing a multiple page, bound passport (52), comprising:

(a) an input hopper module (12) constructed to receive a plurality of the bound passports to be personalized with personal information of the intended holder of the passport;

first and second leafing modules (14,18) disposed downstream from said input hopper module, each said

leafing module including apparatus for turning pages of the passport wherein the first leafing module is adapted to turn to any page within the passport, and said first leafing module is disposed upstream of said second leafing module;

first and second personalization modules (16, 20) disposed downstream from said input hopper module, each said personalization module is configured to personalize a page of the passport with personal information of the intended holder of the passport, and said first personalization module is disposed upstream of said second personalization module;

an output module constructed to receive passports personalized by said first and second personalization modules, said output module is downstream from said first and second leafing modules and said first and second personalization modules; and

wherein said input hopper module, said first and second leafing modules and said first and second personalization modules are arranged in the following order: said input hopper module, followed by the first leafing module, followed by the first personalization module, followed by the second leafing module, followed by the second personalization module."

- IX. Compared with the main request, the subject-matter of claim 1 of the first auxiliary request contains the following additional substantive features:

"wherein the first leafing module comprises a camera system, wherein the camera system is adapted to read an appropriate marker on the passport which indicates the current page at which the passport is open, and wherein

the first leafing module is adapted to turn from the known current page to a pre-selected other page in the passport which can be any page within the passport"

- X. Compared with the main request, the subject-matter of claim 1 of the second auxiliary request comprises the following additional features:

"wherein said first leafing module includes apparatus (234-242) for fully opening the bound passport to define first (274) and second (276) passport halves, and one of said personalization modules comprises a printer mechanism that includes a print head (252) and means (250, 260) for maintaining a generally constant distance between the first and second halves and the print head during printing."

- XI. The subject-matter of claim 1 of the third auxiliary request differs from the subject-matter of claim 1 of the second auxiliary request in the following additional features:

"wherein the means for maintaining a generally constant distance comprises a first roller (250) supporting the first half, a second roller (250) supporting the second half and spaced from the first roller defining a gap (256) therebetween, and

wherein the bound passport includes a spine, and the spine is positioned in the gap between the first and second rollers during printing."

- XII. Claim 1 of the fourth auxiliary request reads as follows:

"1. A modular system (10) for personalizing a multiple page, bound passport (52), comprising:

an input hopper module (12) constructed to receive a plurality of the bound passports to be personalized with personal information of the intended holder of the passport;

first and second leafing modules (14, 18) disposed downstream from said input hopper module, each said leafing module including apparatus for turning pages of the passport wherein the first leafing module is adapted to turn to any page within the passport, and said first leafing module is disposed upstream of said second leafing module;

first and second personalization modules (16, 20) disposed downstream from said input hopper module, each said personalization module is configured to personalize a page of the passport with personal information of the intended holder of the passport, and said first personalization module is disposed upstream of said second personalization module, wherein the second leafing module (18) and the second personalization module (20) are combined into a single module (24);

an output module constructed to receive passports personalized by said first and second personalization modules, said output module is downstream from said first and second leafing modules and said first and second personalization modules; and

wherein said input hopper module, said first and second leafing modules and said first and second personalization modules are arranged in the following

order: said input hopper module, followed by the first leafing module, followed by the first personalization module, followed by the second leafing module, followed by the second personalization module,

wherein said first leafing module includes apparatus (234-242) for fully opening the bound passport to define first (274) and second (276) passport halves, and the single module (24) comprises a printer mechanism that includes a print head (252) and means (250, 260) for maintaining a generally constant distance between the first and second halves and the print head during printing, the single module (24) comprising third and fourth rollers (248) rotatably mounted to a support structure with respect to the print head (252),

wherein the means for maintaining a generally constant distance comprises a first roller (250) supporting the first half, a second roller (250) supporting the second half and spaced from the first roller defining a gap (256) therebetween, the first, second, third, and fourth rollers (250, 248) arranged to receive the passport therebetween,

wherein the bound passport includes a spine, and the spine is positioned in the gap between the first and second rollers during printing,

wherein each of the first and second rollers (250) is separately rotatably mounted on H-shaped supports (254a, 254b), the gap (256) defined between ends of the first and second rollers (250) and ends of the H-shaped supports (254a, 254b), wherein the opposite ends of the H-shaped supports (254a, 254b) are pivotably mounted on a shaft (258), and bias springs (260) are disposed

around the shaft (258) with one end engaged with the single module (24) and an opposite end engaged with the H-shaped supports (254a, 254b) such that the rollers (250) are resiliency biased in a direction toward the third and fourth rollers (248)."

XIII. The arguments presented by the appellants in writing and during the oral proceedings can be summarised as follows:

In the impugned decision, the opposition division did not give sufficient consideration to all relevant submissions presented during the opposition proceedings on the issue of inventive step, and thereby violated the appellants' right to be heard. In particular, the submission that the subject-matter claimed merely corresponded to the automation of an officer's tasks when issuing a passport was not addressed. Moreover, it did not give any reasons why the public prior use according to documents D7 and D8 was closer to the subject-matter of claim 1 as maintained than the other prior art documents on file. The impugned decision was thus insufficiently reasoned on a point relevant for the dispute, and this amounted to a substantial procedural violation justifying the reimbursement of the appeal fees.

Regarding the present main and first auxiliary requests, both appellants submit that the subject-matter of independent claim 1 was not based on an inventive step when starting from the public prior use according to documents D7 and D8 as the closest prior art.

The subject-matter of claim 1 according to the main request differed therefrom in that

(1) the system is a modular one and its input hopper, first and second leafing mechanisms, first and second personalization mechanisms and output mechanism are modules; and in that

(2) the first leafing module is adapted to turn to any page within the passport.

The first distinguishing feature directed to the modular design of the claimed system was rendered obvious by document E5' or by document D8. In particular, sections A to F, G, H to L, M to N, P and R shown in document D8 could be regarded as separate modular stations, between which more stations could be arranged, if needed.

The second distinguishing feature relating to the ability of the first leafing module to turn to any page of a bound document implied no structural limitation and belonged to the common general knowledge at the date of priority. Reference was made in particular to documents E14 or E20, which both disclosed such a leafing module adapted to turn to any page within the passport, a feature which did not form part of the claims as granted. Since document E20 rendered the subject-matter of claim 1 according to the main request obvious, it should be admitted into the proceedings as *prima facie* highly relevant for the question of inventive step.

Moreover, the subject-matter of claim 1 according to the first auxiliary request was not based on an inventive step, since the leafing apparatus of document E20 was not only modular and adapted to turn to any page within the passport, but also equipped with

optical checking means for reading the current page number during the page-turning operation, thereby anticipating the additional feature of a camera.

The second, third and fourth auxiliary requests were filed only one month before the date of the oral proceedings without proper justification for their late submission. Their subject-matter did not converge with the subject-matter previously claimed, thereby opening new lines of defence at a very late stage of the proceedings. Furthermore, the newly added feature of *"one of said personalization modules comprises [...] means (250, 260) for maintaining a generally constant distance between the first and second halves and the print head during printing"*, which formed part of the respective independent claim of the second and third auxiliary requests, resulted from a post-grant amendment and *prima facie* did not comply with the provisions of Article 123(2) EPC. More particularly, the application as originally filed did not provide any basis for claiming that any of the personalization modules could be equipped with means for maintaining a generally constant distance between the first and second halves and the print head during printing. Finally, with the fourth auxiliary request a previously excluded embodiment was reintroduced together with corresponding design details taken from the description which required a new study of the prior art. The second, third and fourth auxiliary requests should thus not be admitted.

XIV. The respondent's arguments presented in writing and during the oral proceedings can be summarised as follows:

Addressing the main and the first auxiliary requests, the leafing device of document E20 only allowed for turning a single page in a forward or reverse direction and thus did not go beyond the content of the documents already considered during the opposition proceedings. In view of that, the contested patent should be maintained as decided by the opposition division, or, as an auxiliary measure, on the basis of the auxiliary requests.

The claims of the second, third and fourth auxiliary requests were essentially based on an embodiment covered by granted dependent claims, even if claim 1 of the fourth auxiliary request was clarified further by means of additional features disclosed only in the description. Moreover, they were filed within the time period of one month set by the board and constituted an foreseeable reaction to the board's negative preliminary opinion regarding the question of inventive step of the subject-matter of the main request and the first auxiliary request, which was, *inter alia*, based on the late-filed document E20. Moreover, the published PCT application, in particular page 14, lines 17 to 20 as well as Figures 17 and 18, provided a clear and unambiguous basis for claiming that any of the personalization modules could be equipped with means for maintaining a generally constant distance between the first and second halves and the print head during printing. Hence, the auxiliary requests were *prima facie* allowable and should be admitted into the appeal proceedings.

Reasons for the Decision

1. *Reimbursement of the appeal fees and remittal of the case*
- 1.1 Both appellants argue that, in the impugned decision, the opposition division did not give due consideration to all relevant the submissions presented during the opposition proceedings on the issue of inventive step, thereby violating the right to be heard as laid down in Article 113(1) EPC 1973. In particular, the submission that the subject-matter claimed merely corresponded to the automation of an officer's tasks when issuing a passport was not adequately addressed. Moreover, it did not give any reasons why the public prior use according to documents D7 and D8 was closer to the subject-matter of claim 1 as maintained than the other prior art documents on file, in particular document E5', which appellant I had used as a starting point in the opposition proceedings for challenging the inventiveness of the subject-matter claimed.
- 1.2 The board notes that the right to be heard generally requires that those involved in proceedings before the European Patent Office be given an opportunity not only to present comments on the facts and considerations pertinent to the decision but also to have those comments demonstrably heard and considered, that is, reviewed with respect to their relevance for the decision on the matter. In general, Article 113(1) EPC 1973 guarantees a party's right to have the relevant grounds, i.e. the party's arguments raising reasonable doubts as to the legal or factual basis underlying the reasons for the decision, fully taken into account in

the written decision, even though this can be done implicitly (cf. Case Law of the Boards of Appeal of the European Patent Office, 7th edition, 2013, chapter III.B.1.1.).

- 1.3 Applying these principles to the case in issue, the board judges that the appellant's submissions mentioned above in paragraph 1.1 are not irrelevant given the opposition division's positive decision on inventive step of the subject-matter of claim 1 of the (then) second auxiliary request, which corresponds to the main request in the present appeal proceedings. Moreover, the opposition division manifestly took note of these inventive step objections and summarised them in the contested decision (cf. points 6.3.1 and 6.3.2 of the reasons). In its reasoning on why the subject-matter claimed involved an inventive step it started from the public prior use according to documents D7 and D8 as the closest prior art, however, without giving any reasons for doing so (cf. point 6.3.3 of the reasons):

"The Opposition Division holds that the public prior use as disclosed in D7 and D8 represents the most relevant prior art for the contested invention."

More particularly, in the contested decision the opposition division remained silent both on why it considered the public prior use according to documents D7 and D8 a more promising starting point than document E5', which appellant I had relied upon, and on why a combination of the system of document E5' with the self-contained page-turning mechanism of document E4 did not involve an inventive step. Moreover, it did not provide any arguments on why the subject-matter claimed did not merely correspond to the automation of an officer's tasks when issuing a passport. Regardless of

the merits of the above objections, the decision is formally defective in that it is tainted by a lack of reasoning on a point relevant for the dispute, thereby resulting in a violation of the appellants' right to be heard guaranteed by Article 113(1) EPC 1973. This amounts to a substantial procedural violation justifying the reimbursement of the appeal fees of both appellants in the event that their appeals are allowable, Rule 67, first sentence, EPC 1973 (which continues to apply, cf. Article 1 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 published in Special Edition No. 1 of OJ EPO 2007, 197; Article 2 of the Decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the European Patent Convention 2000 published in OJ EPO 2007, 8; decision J 10/07, OJ EPO 2008, 567, Reasons No. 7).

- 1.4 Article 11 RPBA provides that a case shall be remitted to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

The board holds that special reasons speak against a remittal of the present case to the opposition division, in particular the length of the proceedings to date and the considerable further delay which would ensue from a remittal. Additionally, the opposition division evidently took note of all the inventive step objections raised, even though the corresponding reasoning in the decision under appeal is incomplete. Consequently, considering all the relevant facts, the board concludes that a remittal of the case to the

department of first instance would be inequitable. The board thus exercises its discretion under Article 111(1) EPC 1973 and Article 11 RPBA in the sense that it will itself decide on the merits of the appeals.

2. *Admission of late-filed document E20*

2.1 In the contested decision, the opposition division found that the subject-matter of claim 1 according to the present main request was based on an inventive step, in particular in view of the fact that the features of the claimed system are modular and that the first leafing module is adapted to turn to any page within the passport.

Together with the statement setting out the grounds of appeal, appellant I filed, *inter alia*, document E20 which shows leafing modules adapted to turn to any page within the passport, thereby allegedly rendering the subject-matter of the contested claim obvious.

2.2 The admission of a late submission is at the discretion of the board, Article 12(4) RPBA. Following established case law, a late filing of evidence together with the statement setting out the grounds of appeal can be exceptionally justifiable if it is an appropriate and immediate reaction to developments in the previous proceedings, in particular a finding in the contested decision, since the appellant who lost the opposition proceedings should be given the opportunity to fill a gap in its arguments by presenting further evidence before the second instance. Moreover, the board can take into account whether the late-filed evidence is *prima facie* highly relevant for the issues to be decided (cf. Case Law of the Boards of Appeal of the European Patent Office, 7th edition, 2013, IV.C.1.).

The board remarks that none of the features on which the opposition division based its decision on inventive step formed part of the claims as granted; they were introduced into the claims from the description and the drawings during the opposition proceedings. Document E20 was filed together with appellant I's statement setting out the grounds of appeal. It is directed to a leafing apparatus which is modular and adapted to turn to any page within the passport. The content of document E20 is thus *prima facie* highly relevant for the controversial issue of inventive step. The board is satisfied that its late filing constitutes an appropriate and immediate reaction to the findings in the contested decision. Document E20 is hence admitted into the appeal proceedings, Article 12(4) RPBA.

3. *Main request, Inventive step*

3.1 The parties do not contest the opposition division's finding that the public prior use according to documents D7 and D8 formed the closest prior art and that the subject-matter of claim 1 of the main request differed therefrom in that

(1) the system is a modular one and its input hopper, first and second leafing mechanisms, first and second personalization mechanisms and output mechanism are modules; and in that

(2) the first leafing module is adapted to turn to any page within the passport.

3.2 Regarding feature (1), the board holds that the VISA system which is the subject of the public prior use as shown in documents D7 and D8 is generally made up of

self-contained units, and is thus modular. Moreover, a person skilled in the art would understand from documents D7 and D8 that station A (corresponding to the claimed input hopper module), printing stations 11 and 16 (corresponding to the claimed first and second personalization modules) and station R (corresponding to the output module) are designed as self-contained modules. However, the available evidence is not sufficient to establish clearly and unambiguously that the leafing mechanisms of documents D7 (see page 1, items A.5 and A.6, page 2, items B.5 and B.6) and D8 (reference signs 7 to 9 and 13 to 15) are designed as modules.

Regarding differing feature (2), the board is in agreement with the parties that the leafing mechanisms of documents D7 and D8 are not suitable to turn to any page within the passport.

The board concludes that the subject-matter of claim 1 according to the main request differs from the public prior use according to documents D7 and D8 in that the leafing mechanisms have a modular design and in that the first leafing module is adapted to turn to any page within the passport.

3.3 The objective technical problem to be solved can thus be seen in providing a leafing mechanism for a system that can be easily assembled and configured to different passport requirements (cf. patent in suit, paragraphs [0009] and [0042]).

3.4 The solution to the problem is not based on an inventive step. Reference is made for instance to document E14, which belongs to the same technical field as the patent in suit and discloses in Figure 13 a

page-turning mechanism 203 with a modular design. According to the corresponding passage in the description of document E14 (cf. column 13, lines 3 to 13), *"there is provided a page turning mechanism which can turn over the leaves of an inserted passport in either direction. The use of such mechanism brings a solution to the following problem. That is, a user might insert his passbook opened at a wrong page into the depositing machine, requiring a leaf of the passbook to be turned over in the opposite direction within in the machine. Otherwise, a plurality of leaves might be turned over at a time by mistake during forward page turning, requiring the additional leaf or leaves to be returned in the reverse direction."* In order to achieve the above purpose, the leafing module of document E14 must be adapted to turn to any page within the passport.

Alternatively, reference is made to document E20, which is directed to an apparatus for turning pages of a book used in many kinds of applications, *inter alia*, in passbook printers (E20, column 1, lines 13 to 16). The fact that this page-turning apparatus is supposed to be integrated into various applications implies that it is designed as a self-contained unit and thus modular. Moreover, the apparatus is suitable to turn one or more pages in the forward and reverse directions (E20, column 5, lines 25 to 34). In column 6, lines 57 to 64, it is stated that in *"many applications, the turning of several pages simultaneously is not intended but can be accepted in order to quickly reach a certain page number. The value to which the contact force and/or contact time is decreased is therefore dependent on whether the turning of multiple pages is acceptable. In any case, the turning of multiple pages should be avoided, since the book can be damaged thereby."* A

skilled person would understand from this that the leafing module of document E20 is also adapted to turn to any page within the passport.

In view of the advantages cited above and the modular design of the prior art system of documents D7 and D8, a person skilled in the field of passport production would consider increasing the flexibility of the passport production system of documents D7 and D8 by using the leafing modules of documents E14 or E20. The subject-matter of claim 1 according to the main request is therefore not based on an inventive step, Article 56 EPC 1973.

4. *First auxiliary request, Inventive step*

4.1 Based on the above assessment of inventive step with respect to the main request, the board judges that the subject-matter of claim 1 according to the first auxiliary request differs from the public prior use according to documents D7 and D8 in that

- the leafing mechanisms have modular design, and in that

- the first leafing module comprises a camera system is adapted to read an appropriate marker on the passport which indicates the current page at which the passport is open, and wherein the first leafing module is adapted to turn from the known current page to a pre-selected other page in the passport which can be any page within the passport.

4.2 The objective technical problem to be solved can thus be seen in providing a leafing mechanism for a system that can be easily assembled and configured to

different passport requirements (cf. patent in suit, paragraphs [0009] and [0042]).

- 4.3 In view of the teaching of document E20, the solution to the above problem is not based on an inventive step. As already established for claim 1 of the main request, the leafing apparatus of document E20 is modular and adapted to turn to any page within the passport. Furthermore, it is equipped with optical checking means 104 for reading the current page number during the page-turning operation (E20, column 4, lines 23 to 27 and column 5, lines 25 to 34), thereby anticipating the additional feature of a camera.

Thus, document E20 provides the skilled person with a clear teaching for modifying the apparatus known from documents D7 and D8 in order to arrive at the subject-matter of claim 1 according to the first auxiliary request, which is therefore not based in an inventive step, Article 56 EPC 1973.

5. *Second, third and fourth auxiliary requests, Admissibility*

- 5.1 Under Article 13(1) RPBA, it is at the board's discretion to admit any amendment to a party's case after it has filed its grounds of appeal or reply:

"Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy."

In addition to the non-exhaustive list of criteria referred to in Article 13(1) RPBA, the following factors may, according to settled case law, be particularly decisive: there must be sound reasons for filing a request at a late stage in the proceedings, as may be the case where amendments are occasioned by developments during the proceedings. Besides the timing of the filing of the request, important aspects are whether the amended claims converge with or diverge from the subject-matter previously claimed and whether the amendments are *prima facie* clearly allowable (cf. Case Law of the Boards of Appeal of the European Patent Office, 7th edition, 2013, chapter IV.E.4.4.1).

As a rule, a board's decision should be based on the issues in dispute at first instance, which does not rule out the admission of new submissions, but does subject it to the fulfilment of certain criteria, given that no entirely "fresh case" should be created on appeal.

It is worth noting that the admission of an amendment to a party's case remains at the board's discretion under Article 13(1) RPBA even if it has been submitted within the time period set in a communication under Article 15(1) RPBA, the purpose of which is generally to give guidance for the oral proceedings in order to allow the parties to focus their arguments on issues that the board considers crucial for reaching its decision.

5.2 In the present case, the board's preliminary opinion as set out in its communication under Article 15(1) RPBA did not raise new questions but was essentially based on issues and arguments submitted by the appellants in their respective statements setting out the grounds of

appeal. In fact, the respondent knew the decisive inventive step objections based on the public prior use and documents E20 or E14 already from the outset of the appeal proceedings.

- 5.3 Moreover, the amended claims of the newly filed second and third auxiliary requests are directed to the aspect of a personalization module maintaining a generally constant thickness between the first and second passport halves and the print head during printing. Those claims therefore diverge from the subject-matter of the previously filed first auxiliary request, which focuses on the first leafing module comprising a camera system adapted to read an appropriate marker on the passport in order to indicate the current page at which the passport is open.

Beyond that, the independent claim of the fourth auxiliary request is aimed at an embodiment with a combined leafing/personalization module 24, which the respondent has explicitly stated is not covered by the claims during first instance proceedings. In that respect reference is made to paragraph [0053] of the description of the present main request as maintained by the opposition division:

"The leafer/printing module 24 according to an example not covered by the claims will now be described in reference to Figures 15-20."

Hence, the amended claims of the late-filed second, third and fourth requests do not converge with the subject-matter previously claimed but open new lines of defence at the final stage of the appeal proceedings.

5.4 Finally, the amended claims do not result from a combination of granted claims, as suggested by the respondent. In fact, independent claim 1 and dependent claim 2, on which the respective independent claims of the newly filed auxiliary requests are at least partially based, were substantially amended during the opposition proceedings by addition, *inter alia*, of the limitations regarding the modular set-up and the exact sequence of modules in the claimed system.

Common to the new second and third auxiliary requests is the amendment that it is one of said personalization modules which comprises the means for maintaining a generally constant distance between the first and second halves and the print head during printing. This was introduced after grant and is to be fully examined as to its compatibility with the requirements of the EPC, notably of Article 123(2) EPC (cf. decision G 9/91, OJ EPO 1993, 408, Reasons No. 19). In that respect, the board notes that a skilled person could derive from the published PCT application that the above "means" were originally foreseen either in a combined leaflet/printer module 24 or a printer module 20 (cf. page 14, lines 17 to 20 as well as Figures 1, 2, 17 and 18). In the terminology of the contested claims, the latter corresponds to the second personalization module. The application as originally filed does not, however, provide any basis for generalising this disclosure, so that any of the personalization modules can be equipped with the disputed means for maintaining a generally constant distance between the first and second halves and the print head during printing. The proposed amendment therefore violates the requirements of Article 123(2) EPC.

Turning to the fourth auxiliary request, the amendments to claim 1 not only comprise the reintroduction of a previously excluded embodiment as mentioned above, but also the addition of a considerable number of corresponding design details taken from the description which were previously never claimed, namely *"wherein each of the first and second rollers (250) is separately rotatably mounted on H-shaped supports (254a, 254b), the gap (256) defined between ends of the first and second rollers (250) and ends of the H-shaped supports (254a, 254b), wherein the opposite ends of the H-shaped supports (254a, 254b) are pivotably mounted on a shaft (258), and bias springs (260) are disposed around the shaft (258) with one end engaged with the single module (24) and an opposite end engaged with the H-shaped supports (254a, 254b) such that the rollers (250) are resiliency biased in a direction toward the third and fourth rollers (248)"*.

These amendments shift the subject-matter claimed in a divergent manner, the impact of which is impossible to assess without further investigations such as a new study of the prior art and potentially even an additional search.

The amended claims of the late-filed second, third and fourth auxiliary requests are thus not *prima facie* clearly allowable.

- 5.5 In view of the above, the board exercises its discretion under Articles 13(1) RPBA in the sense that it does not admit the second, third and fourth auxiliary requests into the appeal proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The requests for reimbursement of the appeal fees are allowed.

The Registrar:

The Chairman:



D. Meyfarth

M. Poock

Decision electronically authenticated