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Datasheet for the decision of 12 October 2023

Case Number: T 1521/19 - 3.4.01

Application Number: 08075212.4

Publication Number: 1967982

IPC: G06K1/12, B42D25/41, B23K26/12, B23K26/08, B23K26/067

Language of the proceedings: EN

Title of invention:
High-rate laser marking machine

Patent Proprietor:
Entrust Datacard Corporation

Opponent:
Mühlbauer GmbH & Co. KG

Headword:
Laser marking / ENTRUS DATACARD CORPORATION

Relevant legal provisions:
EPC Art. 100(b)

Keyword:
- Sufficiency of disclosure - (no)
- Decision in written proceedings - (yes) - announcement of non-attendance of the oral proceedings

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Beschwerdekammern

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Case Number: T 1521/19 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 12 October 2023

Appellant: (Opponent)	Mühlbauer GmbH & Co. KG Josef-Mühlbauer-Platz 1 93426 Roding (DE)
Representative:	Schmidt, Steffen J. Wuesthoff & Wuesthoff Patentanwälte PartG mbB Schweigerstrasse 2 81541 München (DE)
Respondent: (Patent Proprietor)	Entrust Datacard Corporation 1187 Park Place Shakopee, MN 55379 (US)
Representative:	Plasseraud IP 66, rue de la Chaussée d'Antin 75440 Paris Cedex 09 (FR)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 26 March 2019 rejecting the opposition filed against European patent No. 1967982 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	P. Scriven
Members:	B. Noll
	D. Rogers

Summary of Facts and Submissions

I. The opposition to the patent was based on the grounds for opposition of Articles 100(a) and (b) EPC (lack of inventive step and insufficient disclosure). It was rejected by the Opposition Division's decision.

II. The opponent appealed that decision. In the statement of grounds of appeal (point IV), objections to sufficiency of disclosure were raised.

III. In their response to the appeal, the proprietor (respondent) argued against the opponent's objections. Further, the proprietor re-filed, as auxiliary requests 1 and 2, claim sets which had been submitted during the opposition proceedings.

IV. In a communication under Rule 100(2) EPC, on the basis of a preliminary assessment, the Board expressed the view that the ground for opposition of Article 100(b) EPC prejudiced the maintenance of the patent on the basis of any of the proprietor's requests. The passages of this communication which are relevant to the decision are as follows:

> ...
> *Sufficiency of disclosure*
>
> *5. The opponent argues that the patent does not disclose a laser marking machine in*

which a laser beam can scan the marking locations and scan a marking location of one transfer path at the same time. In the opponent's view, the wording "at the same time" defined simultaneous scanning of the marking location and other areas, for example another marker location, whereas the patent disclosed only the scanning of one marking location at a time.

6. In claim 1, the wording

> the laser beam being capable of scanning the marking locations (...) and scanning a marking location (...) of one transfer path (...) at the same time

is ambiguous and needs interpretation. One of the possible interpretations is that the marking location of the one transfer path is simultaneously scanned with other, unspecified marking locations. It appears that in this interpretation claim 1 defines a subject-matter which is not sufficiently clearly and completely disclosed in the patent.

7. Claim 11 defines

> the laser beam [...] capable of scanning one of each of the marking stations [...] at the same time.

This wording is unclear and open to different interpretation. One of the possible interpretations is that the group of marking locations in the vertical plane can, in principle, be scanned all together at the same time. The patent, however, does not disclose a machine which is capable of scanning more than a single marking location at a time. It therefore appears that in this interpretation claim 11 defines a subject-matter which is not sufficiently clearly and completely disclosed in the patent.

8. The Board notes that the wording in question is the result of an - apparently unsuccessful - translation of the wording "un ... à la fois" of the priority document(see claim 9 of FR 2883503 A1). This wording means that, when one marking location is scanned, others are not. The mistranslation seems to say just the contrary of what was expressed in the priority document or, at least, to create an unclear text that is open to such an interpretation.

...

V. In response to a summons to oral proceedings, the proprietor submitted a further set of claims and indicated at the same time that it would not attend the oral proceedings.

VI. The oral proceedings were canceled.

VII. The opponent (appellant) requests that the decision under appeal be set aside and the patent revoked.

VIII. The proprietor (respondent) requests that the appeal be dismissed (main request), or that the appealed decision be set aside and the patent maintained on the basis of:
- auxiliary request 1 submitted during the opposition proceedings and re-filed with the response to the appeal,
- auxiliary request 2 submitted in response to the Board's preliminary assessment, or
- auxiliary request 3, submitted in the opposition proceedings as an auxiliary request 2 and re-filed with the response to the appeal.

IX. Claim 1 of the main request reads (reference signs omitted):

A high-rate laser marking machine for supports, optionally cards, optionally comprising integrated circuits, the marking machine comprising at least one transfer device comprising a transfer path transporting the supports to be marked or already marked, respectively to or out of the laser chamber, comprising:

- at least one laser chamber comprising at least two marking locations for receiving supports to be marked on at least one face

by at least one laser marking means producing a laser beam; said laser marking means comprising

- optical means arranged to deflect the laser beam onto one of the marking locations and to mark a support onto this marking location, characterized in that:

it is linked to an information system comprising a database storing marking data to be transferred to the laser marking machine and generating orientation data for orienting the optical means directing the laser beam to the one of the marking locations, the laser marking means are fixed and the optical means comprise a production element of a laser beam as a function of the marking data stored in the database of the information system, a deflection element of the laser beam receiving the laser beam produced to direct it to one of the marking locations and to direct it to the supports during laser marking, as a function of the orientation data received about the supports and a refining element of the laser beam the laser chamber comprises two distinct intra-chamber transfer paths, each activated by a respective drive mechanism and arranged parallel relative to one another, each intra-chamber transfer path comprising three locations including an inlet location, a marking location and an outlet location, the supports to be marked being housed horizontally in the locations, the

two inlet locations being arranged in the vicinity of the loading device comprising at least a divergence manipulator for loading the supports to be marked coming from the single-path transfer device on one of the two inlet locations of the intra-chamber paths, the two outlet locations being arranged in the vicinity of the unloading device comprising at least one convergence manipulator enabling the marked supports to be unloaded from one of the two outlet locations on the transfer device having one transfer path, the laser marking means being arranged facing the two marking locations and the axis of symmetry of the laser beam produced by the laser marking means being arranged in a plane perpendicular to the marking locations, the laser beam being capable of scanning the marking locations and scanning a marking location of one transfer path at the same time, and the drive mechanisms of the two intra-chamber transfer paths, of the convergence and divergence manipulators of the loading devices and, respectively, unloading devices and of the deflection element are controlled alternately by the information system, enabling a support housed on the marking location of a first intra-chamber transfer path to be marked, while the other intra-chamber transfer path supplies another support to be marked on its marking location.

X. Claim 1 of auxiliary request 1 defines the supports mandatorily as cards and further adds

...
the optical means are arranged to deflect the laser beam alternatively onto one of the marking locations and to mark a support onto this marking location while at least one loading/unloading device unloads a support already marked from another marking location onto the transfer path and loads a support to be marked from the transfer path onto said another marking location,

the deflection element of the laser beam comprises an inlet opening, an outlet opening and two mirrors whereof the inclination of each is controlled by a galvanometric device, the mirrors being arranged opposite one another, such that the laser beam, produced by the production element of a laser beam as a function of the marking data and passing through the inlet opening of the deflection element, projects onto a first mirror which reflects the laser beam and projects it onto a second mirror also reflecting the laser beam to direct it to the outlet opening of the deflection element and orient it to a marking location , the inclination of each of the two mirrors being activated by a drive mechanism controlled by the orientation data of the information system, one of the two mirrors inclining according to a vertical axis of rotation to have the laser beam deflect horizontally, and the

other mirror inclining according to its horizontal axis of rotation to have the laser beam deflect vertically.

XI. Claim 1 of auxiliary request 2 further adds to claim 1 of auxiliary request 1

...
wherein the machine comprises a personalising device of the integrated circuit of a smart card linked to the information system comprising personalisation data in its database capable of corresponding with the marking data of the support of the smart card, the information system comprising follow-up means of the personalisation and the marking of the smart cards.

XII. Claim 1 of auxiliary request 3 further adds to claim 1 of auxiliary request 1 that

...
each transfer path of the laser chamber comprises a return element arranged facing the marking location and comprising a rotary clip enabling, because of an axis of rotation aligned in the plane of the transfer paths, a marked support on one of these faces to be returned and to be repositioned on the same marking location, so as to mark the other face by the marking means according to the direction opposite the first face, the rotation of the clip of

a turning element being activated by a drive mechanism, the drive mechanism of the two transfer paths of the laser chamber, the mirrors of the deflection element and these return elements being controlled alternately by the information system.

Reasons for the Decision

1. The part of the communication reproduced above, expressed and explained the Board's view that the invention was not sufficiently clearly and completely disclosed.

2. In a response to the Board's communication, the Proprietor argued that the skilled person, with a mind willing to understand, would have read the claim as referring simply to the laser beam being capable of scanning the marking locations, and scanning a marking location of one transfer path at a time while the cards of the other transfer path were transported.

3. The proprietor's announcement in its letter of 1 September 2023 that it would not attend the oral proceedings is equivalent to a withdrawal of its request that oral proceedings be held.

4. The Board does not see any reason to depart from its preliminary opinion.

5. The Board cannot exclude an interpretation of the feature in question merely because the claim, with that

interpretation, would define an invention that is meaningful but not sufficiently clearly and completely disclosed. Thus claim 1 of the patent as granted does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Hence the ground of opposition under Article 100(b) EPC prejudices the maintenance of the patent upon the basis of the patent as granted.

6. This conclusion equally applies to claim 1 of the first and third auxiliary requests as set out in the Board's communication.

7. It also applies to claim 1 of the second auxiliary request, submitted in response to the Board's communication, since the amendments in this claim do not affect the feature in question, or its interpretation.

8. Hence none of these requests satisfy the requirements of Article 83 EPC.

Order

For these reasons it is decided that:

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

The Registrar: The Chairman:

D. Meyfarth P. Scriven

Decision electronically authenticated