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**Datasheet for the decision
of 30 November 2023**

Case Number: T 1519/21 - 3.2.05

Application Number: 15151331.4

Publication Number: 2894040

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B41F33/00

Language of the proceedings: EN

Title of invention:

Numbering device for typographic numbering having calibration detectors

Patent Proprietor:

KBA-NotaSys SA

Opponent:

Paul Leibinger GmbH & Co. KG Nummerier-
und Markierungssysteme

Relevant legal provisions:

EPC Art. 76(1)

Keyword:

Amendments - extension beyond the content of the earlier application as filed (auxiliary requests II, 3, 4, 5: yes; auxiliary request 6: no)



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Case Number: T 1519/21 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 30 November 2023

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Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
16 July 2021 concerning maintenance of the
European Patent No. 2894040 in amended form.

Composition of the Board:

Chairman P. Lanz
Members: T. Vermeulen
A. Bacchin

Summary of Facts and Submissions

- I. The opponent lodged an appeal against the interlocutory decision of the opposition division finding that European patent No. 2 894 040 ("the patent") as amended according to auxiliary request II met the requirements of the European Patent Convention.
- II. The patent originates from European patent application No. 15151331.4, a third generation divisional of the application No. 07789741.1 ("the earlier application") which was published under the PCT as WO 2007/148288 A2.
- III. The opposition was filed against the patent as a whole on the basis of the grounds for opposition under Article 100(a) together with Article 54(1) EPC (lack of novelty) and Article 56 EPC (lack of inventive step), under Article 100(b) EPC and under Article 100(c) EPC.
- IV. Oral proceedings before the board were held on 30 November 2023.
- V. The appellant (opponent) requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be dismissed or, alternatively, that the decision under appeal be set aside and the patent be maintained as amended on the basis of the claims of one of auxiliary requests 3 to 7, all filed in reply to the statement of grounds of appeal.

VI. Claims 1, 3 and 5 of auxiliary request II, on the basis of which the opposition division maintained the patent, have the following wording (the feature numbering used for claim 1 in the decision under appeal and the board's feature numbering for claims 3 and 5 appear in square brackets):

"1. [**F1**] A numbering device (1) for carrying out numbering in sheet-fed or web-fed numbering presses, said numbering device (1) comprising [**F2**] a casing and [**F3**] a numbering unit (6) with rotatable numbering wheels (7) carrying alpha-numerical symbols thereon, [**F4**] which numbering wheels (7) are disposed next to each other and rotate about a common rotation axis, [**F5**] said numbering device further comprising electro-mechanical actuation means for setting the position of said numbering wheels (7), [**F6**] wherein said electro-mechanical actuation means are mechanically autonomous, [**F7**] said electro-mechanical actuation means comprising a plurality of independent driving means (15, 18-23; 23*) for actuating a corresponding plurality of said numbering wheels (7), wherein [**F8**] said electro-mechanical actuation means are disposed in an inner space of the casing of said numbering device (1)) [*sic*], [**F8.1**] wherein the numbering wheels (7) are mounted for rotation about a common shaft (17; 17*) which is supported at both ends onto bearings provided in side frame parts (3, 3'; 303) of the casing, and [**F9**] wherein said numbering device further comprises calibration sensors (13) for calibrating the position of the numbering wheels (7) actuated by the electromechanical actuation means [**F9.1**] about the rotation axis, [**F10**] each calibration sensor (13) cooperating with at least one magnet (12) carried by the numbering wheel (7) to be calibrated, and [**F11***] wherein the calibration sensors (13) are carried by one

or two supporting members (14, 14') located in an upper part of the numbering device, [F12] which one or two supporting members (14, 14') extends or extend parallel to the rotation axis of the numbering wheels (7) [F12.1] and is or are mounted between the side frame parts (3, 3')."

"3. The numbering device according to claim 1 or 2, [F14] wherein the supporting member (14, 14') is rotatable away from the numbering unit (6) once a top cover member (4) is removed, thereby enabling assembling or disassembling of the numbering unit (6)."

"5. The numbering device according to any one of claims 1 to 4, further comprising [F15] a removable cover member (4) covering the upper part of the numbering device (1), which cover member (4) is provided with an opening (4a) through which emerges part of the numbering unit (6) and wherein the supporting member (14, 14') is located underneath the cover member (4)."

VII. Claim 1 of auxiliary request 3 differs from claim 1 of auxiliary request II in that the following feature was added at the end of the claim:

"[F13] wherein the numbering device further comprises a releasable indexing mechanism (7a, 50; 7a', 50'; 7a', 510, 520) for mechanically aligning and maintaining the position of the numbering wheels during a numbering operation".

Claim 1 of auxiliary request 4 differs from claim 1 of auxiliary request II by the addition of feature F14 at the end of the claim.

Claim 1 of auxiliary request 5 differs from claim 1 of auxiliary request 4 by the addition of feature F13 at the end of the claim.

Claim 1 of auxiliary request 6 differs from claim 1 of auxiliary request II by the addition of "wherein the numbering device comprises" followed by feature F15, feature F14 (with a change in article: "athe top cover member (4)"), and the following feature:

"[F16] and wherein the supporting member (14, 14') is rotatable between a first position where the supporting member (14, 14') is located next to an upper portion of the numbering unit (6), such that each calibration sensor (13) faces a corresponding numbering wheel (7) to be calibrated and cooperates with the corresponding magnet (12), and a second position where the supporting member (14, 14') is rotated away from the numbering unit (6), so as to enable assembling or disassembling of the numbering unit (6)".

VIII. The parties' submissions were essentially as follows.

- Appellant (opponent)

Features F9 to F12.1 of claim 1 of auxiliary request II were only disclosed in the earlier application together with the features of dependent claims 3 to 5 of auxiliary request II and with further features. As a consequence, claims 1, 3 and 5 of auxiliary request II contained subject-matter which extended beyond the content of the earlier application as filed, contrary to the requirements of Article 76(1) EPC.

According to established case law, it was generally not permissible to amend a claim by extracting isolated

features from a set of features originally disclosed only in combination with each other. However, this is exactly what happened here. A distinction had to be made between what the original documents of a patent directly and unambiguously disclosed to a skilled person and what said skilled person on the basis of this disclosure might do upon reflection and using their imagination.

Regarding the amendment concerning the supporting members in claim 1 of auxiliary request II, the passage of interest in the description of the earlier application was page 12, lines 10 to 23. Both this passage and the figures of the earlier application showed the supporting members in a structural and functional relationship with further features that were either left out of claim 1 or formulated as separate dependent claims. Furthermore, the location of the supporting members in an upper part of the numbering device as claimed in feature F11* was nowhere disclosed in the earlier application. Also supporting members located below the rotation axis of the numbering device illustrated in Figures 1 and 2 would be located in an upper part of the numbering device and thus fall within the wording of claim 1. However, such an arrangement was not originally disclosed. In contrast, all the figures of the earlier application clearly showed that the supporting members were always located above the rotation axis and, in particular, attached to the upper edge of the side frame parts. The skilled person would also immediately recognise that the supporting members illustrated in the figures of the earlier application prevented the assembly and disassembly of the numbering unit, unless they were mounted in such a way that they could be rotated away from their illustrated positions. Such a rotatable mounting was not only evident from the

figures of the earlier application, it was explicitly mentioned in the text passage cited above. However, this aspect was left out of claim 1 of auxiliary request II; it was only claimed as a separate embodiment in claim 3 of auxiliary request II, when dependent on claim 1 or claim 2. Also claim 5 of auxiliary request II concerned an inadmissible intermediate generalisation. The entire earlier application only disclosed a top cover member having an opening through which emerged part of the numbering unit. This feature was essential since it allowed printing through the top cover member. Nevertheless, it was only claimed in claim 5 of auxiliary request II.

The above objections were not overcome by the amendments in auxiliary requests 3, 4 and 5. The patent could therefore not be maintained in accordance with these requests either. In fact, claim 1 of auxiliary request 3 only had one additional feature compared to claim 1 of auxiliary request II. This amendment did not remedy any of the deficiencies mentioned in the context of auxiliary request II. In claim 1 of auxiliary requests 4 and 5, in turn, the additional feature of claim 3 of auxiliary request II had been added. Nevertheless, the objections raised against claims 3 and 5 of auxiliary request II still applied.

No objections were raised against the claims of auxiliary request 6. There was no need to further adapt the description in order to support the claims of auxiliary request 6.

- Respondent (patent proprietor)

The amendments to the claims of auxiliary requests II, 3, 4 and 5 did not introduce subject-matter which

extended beyond the content of the earlier application as filed.

Basis for the amendments F9 to F12.1 in claim 1 of auxiliary request II could be found in the light of the general statement on page 12, lines 10 to 13 of the earlier application. According to the passage on page 12, lines 22 and 23, the calibration sensors were provided either on one or on two supporting members. It was evident from Figures 2 and 4 of the earlier application that the supporting members were located in an upper part of the numbering device between the side frame parts and parallel to the rotation axis of the numbering wheels. That the supporting members were located in an upper part and not in a central or lower part of the numbering device was consistently shown in the figures of the earlier application. It was therefore clear to the person skilled in the art that an arrangement was disclosed in which the calibration sensors fulfilled their tasks while being accessible for maintenance or replacement purposes without the need for removing the numbering unit. It was not necessary to add features from claims 3, 4 or 5 of auxiliary request II to independent claim 1. These could be replaced by alternative means.

In claim 1 of auxiliary request 3 an indexing mechanism had been added. Claim 1 of auxiliary request 4 included the additional features of claim 3 of auxiliary request II. Except for the additional indexing mechanism, claim 1 of auxiliary request 5 corresponded to claim 1 of auxiliary request 4. Omitting the opening in the top cover member did not amount to an intermediate generalisation, because the description on page 12 of the earlier application did not necessarily refer to preceding page 11. Only because of the article in the

expression "the top cover member" on page 12, line 21 there was no mandatory link to the preceding description of the top cover member on page 11, lines 7 to 13.

Reasons for the Decision

1. Auxiliary request II on the basis of which the opposition division intended to maintain the patent

- (a) Claim 1

Compared to claim 1 of the earlier application, claim 1 of auxiliary request II was amended *inter alia* by the addition of features F9 to F12.1. They concern the arrangement of calibration sensors in the claimed numbering device. In particular, feature F11* requires that the sensors are carried by "one or two supporting members (14, 14') located in an upper part of the numbering device". The supporting member (or members) are only disclosed in a specific context in the earlier application. In fact, page 12, lines 10 to 23 is the only passage of the earlier application that provides information on the arrangement of the supporting member in the numbering device. In reference to the example of Figure 2, the passage points out that

"[s]upporting members 14, 14' are mounted between the side frame parts 3, 3' and can be rotated backwards from their illustrated positions away from the numbering unit 6 once the top cover member 4 is removed, thereby enabling assembling or disassembling of the numbering unit 6".

The first requirement is claimed by feature F12.1. The second requirement, however, does not form part of claim 1. Hence, claim 1 of auxiliary request II leaves open whether the supporting members are movable or fixed. A top cover member is not claimed either.

Nothing in the earlier application indicates that the supporting members can be mounted in a fixed manner or that the top cover member is an optional component. On the contrary, the requirements of the passage of the description cited above are confirmed by the figures of the earlier application. In Figure 1, the numbering device is depicted with a top cover member 4 and side cover members 8. Through an opening 4a of the top cover member part of the numbering wheels emerge. It is only after having omitted the top cover member and the side cover members in Figure 2 that supporting members 14 and 14' become visible. It is immediately evident from this figure that each supporting member is mounted between a left side frame part 3 and a right side frame part 3'. The drawings of Figures 4 and 6 show in more detail how this is done. The supporting member has lateral support arms, each with a cylindrical hole and a U-shaped groove extending parallel to the rotation axis of the device. A first pin is inserted both in the cylindrical hole and in a corresponding hole of one of side frame parts 3, 3'. A second pin projecting from a side frame part is inserted from below in the groove and abuts against the top surface of the groove. It is reasonable to conclude from this construction that each supporting member 14, 14' is adapted to rotate about the axis of the first pins, but is held in the illustrated position close to the numbering unit by virtue of its abutment with the second pins. It can also be inferred from the relative position of the supporting members in the numbering device shown in

Figure 2 that a rotation away from the numbering unit is only possible once top cover member 4 has been removed.

Even if the respondent is correct when arguing that the figures consistently show the supporting members in an upper part - and not in a central or lower part - of the numbering device, it has not been convincingly shown that the second requirement of the above-cited passage of the description are "merely optional and could be omitted or replaced by alternative means" (cf. point A.2.1 of the reasons for the contested decision; see also point 3.1 of the reply to the statement of grounds of appeal).

In view of the above, the subject-matter of claim 1 of auxiliary request II extends beyond the content of the earlier application as filed, contrary to the requirements of Article 76(1) EPC.

(b) Claim 3

Additional feature F14 of dependent claim 3 corresponds to the second requirement of the above-cited passage on page 12 of the description of the earlier application, at least insofar that the supporting member must be able to rotate away from the numbering unit once a top cover member is removed, thereby enabling assembling or disassembling of the numbering unit.

However, the passage uses the definite article when referring to the top cover member. In the board's view, this can only be understood as a reference to the top cover member described on page 11, lines 7 to 13 of the earlier application in the context of Figure 1. Contrary to the respondent's opinion, the references to

the top cover member on pages 11 and 12 of the description are clearly interlinked as they specifically refer to the same top cover member 4 depicted in Figure 1. Accordingly, top cover member 4 covers the upper part of numbering device 1 and is provided with an opening 4a through which emerges part of numbering unit 6. The passage on page 11, lines 19 to 21 then confirms that it is this top cover member 4 which, together with two side cover members 8, is removed in the drawing of Figure 2. Therefore, the appellant presented a convincing case that the rotatable arrangement of the supporting members in feature F14 only has basis in the earlier application together with the specific aspects of the top cover member as described on page 11 and as shown in Figure 1 of the earlier application.

Given that the top cover member of claim 3 of auxiliary request II is claimed without an opening through which emerges part of numbering unit 6, also the subject-matter of this claim extends beyond the content of the earlier application as filed (Article 76(1) EPC).

(c) Conclusion

The board has come to the conclusion that auxiliary request II, on the basis of which the opposition division intended to maintain the patent, is not allowable. Consequently, the decision under appeal has to be set aside.

2. Auxiliary request 3

The only amendment to the claims of auxiliary request 3 is the addition of feature F13 to claim 1. The additional feature concerns a releasable indexing

mechanism for the numbering wheels; it does not address any of the objections of added subject-matter raised in respect of claims 1 and 3 of auxiliary request II.

Therefore, the requirements of Article 76(1) EPC are not fulfilled so that auxiliary request 3 is not allowable either.

3. Auxiliary requests 4 and 5

The subject-matter of claim 1 of auxiliary request II was limited in each of auxiliary requests 4 and 5 by the addition of feature F14. Claim 1 of auxiliary request 5 further includes the additional feature F13.

For the same reasons as set out in respect of claim 3 of auxiliary request II above, the general reference to a top cover member in claim 1 of auxiliary requests 4 and 5, i.e. without claiming the opening through which emerges part of of the numbering unit, amounts to an unallowable extension of the claimed subject-matter beyond the content of the earlier application, contrary to the requirements of Article 76(1) EPC. Neither auxiliary request 4 nor auxiliary request 5 are therefore allowable.

4. Auxiliary request 6

The appellant had no objections against the claims of auxiliary request 6. The board does not have any reason for objecting against these claims.

The description of the patent including the amended paragraphs filed in reply to the statement of grounds of appeal were not objected to by the appellant, nor did the board have any objections.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent as amended in the following version:
 - claims:
No. 1 to 14 according to auxiliary request 6, filed with the reply to the statement of grounds of appeal,
 - description:
paragraphs: 1-26, 28, 30-89 of the patent specification,
paragraphs 27 and 29, as filed with the reply to the statement of grounds of appeal,
 - drawings: sheets 1/22-22/22 of the patent specification.

The Registrar:

The Chairman:



N. Schneider

P. Lanz

Decision electronically authenticated